

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARKEMA FRANCE,
Petitioner,

v.

HONEYWELL INTERNATIONAL INC.,
Patent Owner.

Case IPR2015-00915
IPR2015-00916
IPR2015-00917¹
Patent 8,710,282 B2

Before JO-ANNE M. KOKOSKI, JON B. TORNQUIST, and ROBERT A.
POLLOCK, *Administrative Patent Judges*.

KOKOSKI, *Administrative Patent Judge*.

DECISION
Motion for Additional Discovery
37 C.F.R. § 42.51(b)(2)

¹ This Order addresses identical issues in each of three related cases. We exercise our discretion to issue one Order to be entered in each case. The parties are not authorized to use this style heading in their papers.

I. INTRODUCTION

Pursuant to our Order, dated February 25, 2016 (Paper 22), Arkema France (“Petitioner”) filed a Motion for Additional Discovery (Paper 30, “Mot.”), and Honeywell International, Inc. (“Patent Owner”) filed an opposition (Paper 31, “Opp.”), in each of the three above-referenced proceedings.² Petitioner seeks additional discovery pertaining to Patent Owner’s contention that the inventors conceived of, and reduced to practice, the invention claimed in U.S. Patent No. 8,710,282 B2 (“the ’282 patent”) before the dates of the asserted prior art references. *See, e.g.*, Mot. 2–3. For the reasons stated below, Petitioner’s motion is *granted-in-part*.

II. ANALYSIS

In an *inter partes* review proceeding, a party seeking discovery beyond what is expressly permitted by rule must do so by motion, and must show that such additional discovery is “necessary in the interest of justice.” 35 U.S.C. § 316(a)(5); *see* 37 C.F.R. § 42.51(b)(2)(i). We consider various factors in determining whether additional discovery in an *inter partes* review proceeding is necessary in the interest of justice. Those factors include: (1) the request is based on more than a mere possibility of finding something useful; (2) the request does not seek the litigation positions of the other party; (3) the information is not reasonably available through other means; (4) the request is easily understandable; and (5) the request is not overly burdensome to answer. *See Garmin Int’l Inc. v. Cuozzo Speed Tech. LLC*,

² The parties filed similar papers in each of the proceedings. We refer to those filed in Case IPR2015-00915 for convenience.

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IPR2012-00001, slip op. at 6–7 (PTAB Mar. 5, 2013) (Paper 26)
(informative).

Petitioner requests the following additional discovery:

1. Deposition of non-declarant Dr. Selma Bektesevic;
2. April 2009 “Forward Engineering Request Form” referenced in the Morris Declaration (Ex. 2036 ¶ 5);
3. September 2009 “whitepaper to brief Honeywell top executives regarding 1234yf” referenced in the Morris Declaration (Ex. 2036 ¶ 9);
4. Formal minutes relating to the subject matter of the ’282 patent (including without limitation Invention Disclosure No. H0024680) from Patent Committee meetings held on January 11, 2010, April 5, 2010, and April 13, 2010;
5. Lab notebooks for experiments performed pursuant to lab instructions dated July 16, 2008 (Ex. 2011), July 28–29, 2008 (Ex. 2012), and September 15, 2008 (Ex. 2015);
6. Documents sufficient to show the date when Patent Owner first became aware of the applications published as FR 2940968, WO2010/081988, and/or US 2012-0022301; and
7. Draft patent application sent to Selma Bektesevic on September 29, 2010 as an attachment to Ex. 2032.

Mot. 1–2. We address each request in turn.

A. Deposition of Selma Bektesevic

Petitioner asserts that it requires the deposition of non-declarant Dr. Selma Bektesevic because, as “the first-named inventor of the ’282 patent,” she “authored most of the documents upon which Patent Owner relies to show conception, diligence, and reduction to practice.” Mot. 3–4. Petitioner asserts that Patent Owner’s exhibits “confirm that only Dr. Bektesevic has first-hand knowledge of the facts upon which Patent

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Owner relies.” *Id.* at 4. For example, Petitioner asserts that declarant Dr. Harry Tung, another named inventor on the ’282 patent, “observed only ‘some’ of the experiments” and “does not recall the dates of the experiments he did observe.” *Id.* at 4–5. According to Petitioner, “Dr. Bektesevic’s deposition will yield first-hand information that Dr. Tung cannot provide.” *Id.* at 5. Patent Owner responds that Petitioner has not satisfied the *Garmin* factors for this request. *Opp.* 5–8.

Specifically, Patent Owner argues that Petitioner “has not provided any evidence that Dr. Bektesevic’s knowledge, as compared to Dr. Tung, will result in testimony that adds substantive value beyond that of Dr. Tung.” *Opp.* 5–6. Patent Owner argues that its “existing declarants provide Petitioner with ample opportunity to examine the date of conception.” *Id.* at 6. Patent Owner also argues that Petitioner does not identify the information that Petitioner contends Dr. Tung cannot provide. *Id.* at 7. Patent Owner further argues that Petitioner’s request is overly burdensome because Petitioner “has not provided any details regarding the scope of Dr. Bektesevic’s deposition.” *Id.* at 8.

We agree with Patent Owner that Petitioner has not shown sufficiently that the deposition request meets the standard of “necessary in the interest of justice.” In support of its assertions regarding the conception and reduction to practice of the invention claimed in the ’282 patent, Patent Owner submitted a number of declarations, from, among others: (1) named inventor Dr. Tung (Ex. 2006 ¶ 2); (2) Thomas Morris, who led the development and commercialization of refrigerants, including 1234yf (Ex. 2036 ¶ 1); (3) Angela Goodie, a lab technician that performed experiments related to

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caustic dehydrofluorination using KOH (Ex. 2037 ¶¶ 3–4); (4) Daniel C. Merkel, a principal engineer that witnessed the dehydrofluorination experiments performed by Ms. Goodie (Ex. 2038 ¶ 4); and (5) Joseph F. Posillico, Esq., who was involved in drafting the application that led to the issuance of the '282 patent (Ex. 2043 ¶¶ 2–4).

Petitioner has not explained adequately what information Dr. Bektesevic can provide that Petitioner cannot generate from Patent Owner's declarants. For example, as Patent Owner notes, Petitioner's failure to identify the information that the declarants cannot provide, "[p]aired with the deposition availability of both Dr. Tung, a co-inventor, and Mr. Merkel, the engineer who signed and corroborated the technical description in the invention notebook" weighs against granting Petitioner's request. Opp. 7. Additionally, the mere fact that Dr. Bektesevic authored documents upon which Patent Owner is relying to show conception, diligence, and reduction to practice is not enough to establish that Petitioner needs Dr. Bektesevic's testimony to support its contention that Patent Owner's invention does not antedate the asserted prior art.

Moreover, we are not persuaded that Petitioner's arguments relate solely to discovery, but instead are also directed to the weight and credibility that should be afforded the testimony of the proffered witnesses. The Board, in the ordinary course of writing the final decision, will accord each witness appropriate weight and credibility based on the particular knowledge of that witness and the circumstances of the case. Each party, in its briefing, has the opportunity to point out alleged weaknesses in the other side's evidence. Such perceived weaknesses, however, do not necessarily entitle a party to

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discovery above the mandatory and routine discovery provided for by the rules.

Accordingly, we conclude that Petitioner has not demonstrated that a deposition of Dr. Bektsevic is necessary in the interest of justice.

B. April 2009 Forward Engineering Request Form and September 2009 Whitepaper

Petitioner asserts that “[b]oth Patent Owner’s Response and the Morris Declaration specifically reference an April 2009 ‘Forward Engineering Request Form’ and September 2009 ‘Whitepaper to brief Honeywell top executives’ to show diligence leading to reduction to practice.” Mot. 7 (citing Paper 19, 41, Ex. 2036 ¶¶ 5, 9). Petitioner asserts that these documents only support Patent Owner’s diligence positions “if such activity relates to the subject matter claimed in the ’282 patent.” *Id.*

Although Petitioner requests production of the identified documents as additional discovery, under the facts presented, we determine that the requested documents are routine discovery under 37 C.F.R. § 42.51(b)(1). Routine discovery includes production of “any exhibit cited in a paper or testimony.” 37 C.F.R. § 42.51(b)(1)(i). We reviewed the Morris Declaration, and find that Mr. Morris relies on the requested documents to support his testimony that there was ongoing activity in 2009 with respect to Patent Owner’s investigation of 1234yf. Ex. 2036 ¶¶ 5, 9. Therefore, the documents requested by Petitioner qualify as “exhibit[s] cited in a paper or testimony” under 37 C.F.R. § 42.51(b)(1)(i) and are routine discovery.

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*C. Formal Minutes Relating to the
Subject Matter of the '282 Patent*

Petitioner requests production of the formal minutes from Patent Committee Meetings held on January 11, 2010, April 5, 2010, and April 13, 2010. Mot. 9–10. Petitioner asserts that Patent Owner’s in-house counsel Bruce Bradford “testified that it ‘was the regular practice of [Patent Owner] for minutes of the PC meeting to be recorded and kept in the ordinary course of business at or near the time of the meeting.’” *Id.* at 9 (citing Ex. 2041 ¶ 12). Petitioner asserts that, in the minutes from the Patent Committee Meeting held on July 12, 2010, the invention disclosure “had a status of ‘Hold,’” and “[i]t is more than mere speculation to suggest” that the requested documents “will also indicate the status for the invention disclosure at those times.” *Id.* According to Petitioner, “[t]he duration that the purported invention was on ‘Hold’ is certainly useful informa[tion].” *Id.* Petitioner also states that it “seeks only the portions of these meeting minutes pertaining to the purported invention and does not object to redaction of other information, similar to Exhibit 2042.” *Id.*

Patent Owner argues that Petitioner does not articulate a basis for the assertion that the requested documents will indicate the status of the invention disclosure. Opp. 11. Patent Owner also argues that Mr. Bradford’s testimony “provides the very patent committee meeting decisions that Petitioner is requesting.” *Id.* (citing Ex. 2041 ¶¶ 10–12). Thus, according to Patent Owner, Petitioner “has the information it seeks, rendering it improbable that additional, ‘useful’ information would be discovered.” *Id.* Patent Owner further argues that “Petitioner has the

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opportunity to cross-examine Mr. Bradford should it require additional information.” *Id.*

We disagree with Patent Owner. The fact that the July 12, 2010 Patent Committee Meeting minutes indicate the status of the invention disclosure makes it more than speculative that the requested Patent Committee Meeting minutes also will include an indication of status. In addition, Petitioner’s request is narrow, easily understandable, not unduly burdensome, and demonstrates more than a mere possibility of uncovering something useful. We are persuaded, therefore, that Petitioner demonstrates that production of the requested discovery is necessary in the interest of justice.

D. Lab Notebooks

Petitioner requests lab notebooks of experiments performed pursuant to lab instructions dated July 16, 2008 (Ex. 2011), July 28–29, 2008 (Ex. 2012), and September 15, 2008 (Ex. 2015). Mot. 10–12. Upon consideration of the evidence and arguments presented, we conclude that Petitioner sufficiently demonstrates that this request meets the interests of justice standard for additional discovery.

Patent Owner argues that Petitioner’s request “does not provide a clear explanation as to what Petitioner is attempting to obtain.” Opp. 12. According to Patent Owner, “Petitioner does not identify the requested documents, the author of the documents, or the topics of the documents with sufficient clarity to allow for Patent Owner to comply.” *Id.* at 12–13. Patent Owner also argues that information “relating to the results of the experiments is included in the appendices of the monthly technology

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reports,” and that Petitioner can depose Angela Goodie, the technician who performed the experiments. *Id.* at 12.

We disagree with Patent Owner that Petitioner’s request is not easily understandable. Petitioner identifies three exhibits that contain instructions on how to perform experiments (Exs. 2011, 2012, 2015), and is asking for lab notebooks that detail the experiments performed pursuant to those instructions. We are persuaded that Petitioner’s request is narrow and easily understandable. Mot. 10–12. Patent Owner does not argue that the request is overly burdensome, and does not contend that lab notebooks (or “invention notebooks,” as described by Daniel Merkel (Ex. 2038 ¶ 5)) corresponding to the identified instructions do not exist. Moreover, the details of the experiments used to synthesize the fluorinated olefins involved in this case are useful because Patent Owner relies on the instructions to show reduction to practice.

*E. Documents Sufficient to Show the Date When
Patent Owner First Became Aware of Published Applications
FR 2940968, WO2010/081988, and/or US 2012/0022301*

Petitioner asserts that, although “Dr. Bektesevic submitted the invention disclosure (Ex. 2029) on August 21, 2009,” there was no activity related to the invention until Patent Owner “requested outside counsel to prepare a patent application on August 19, 2010, with instructions that ‘[t]he application **must** be filed by September 30, 2010.’” Mot. 12. Petitioner asserts that, because one of the asserted prior art references, FR 2940968 (“Sedat”), published on July 16, 2010, “[t]hese facts demonstrate more than a possibility and mere allegation that documents exist showing that Patent Owner became aware of the Sedat publication shortly before Patent Owner

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sent instructions to outside counsel to prepare a patent application.” *Id.* at 13. According to Petitioner, the date that Patent Owner became aware of Sedat “is relevant to the issue of diligence and to whether Patent Owner was spurred by Petitioner’s publication to file its own application.” *Id.*

In the context of determining whether a discovery request is based on more than a mere possibility of finding something useful, “useful” means “favorable in substantive value to a contention of the party moving for discovery,” not just “relevant” or “admissible.” *Garmin*, IPR2012-00001, Paper 26, slip. op. at 7. Under this factor, a party should already be in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered. *Id.* at 2–3.

Petitioner has not shown sufficiently that this document request meets the standard of “necessary in the interest of justice.” Patent Owner notes that the Patent Committee Meeting during which “Patent Owner approved the relevant disclosure for filing” occurred on July 12, 2010, before Sedat published on July 16, 2010. Opp. 13; *see* Ex. 2041 ¶ 12. Thus, we are not persuaded that Petitioner is in possession of evidence tending to show beyond speculation that the requested documents are “favorable in substantive value to a contention of the party moving for discovery.”

Moreover, we agree with Patent Owner that the request is overly burdensome because “Petitioner does not limit this request to any particular persons, media (email, documents, search history, etc.), or time period.” Opp. 14. This request, therefore, is open-ended and not limited in any meaningful way.

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Upon consideration of the evidence and arguments presented, and the limited nature of additional discovery in *inter partes* review proceedings, we conclude that Petitioner has not demonstrated that the requested discovery is necessary in the interest of justice.

F. Draft Patent Application

Petitioner requests the production of a draft patent application sent from Patent Owner's counsel to the inventors on September 29, 2010. Mot. 14–15. Petitioner argues that the extent of work done to prepare the patent application, and the extent of revisions and comments provided by the inventors, is a factor “in determining whether or not a patent attorney and inventors were reasonably diligent in preparing an application for filing.” *Id.* at 14. According to Petitioner, “[t]he content that [the] drafting attorney added over other related patents and the inventor's information disclosure statement speaks directly to these issues,” and “there is more than a possibility and mere allegation that the production of the draft patent application” will yield useful results. *Id.* at 14–15.

Patent Owner responds that details of the work done to draft the patent application are identified in the Posillico Declaration and the provisional application, and that “Petitioner is able to obtain the requested information by deposing Mr. Posillico.” Opp. 15. Patent Owner also asserts that documents exchanged between a patent attorney and an inventor are not “absolutely necessary to establish diligence.” *Id.*

We conclude that Petitioner fails to present a threshold amount of evidence tending to show that the requested information supports its contention that the inventors and patent attorney were not diligent in

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preparing the patent application. Petitioner's argument that the draft patent application "speaks directly" to the issue of diligence is a mere allegation that something favorable in substantive value to Petitioner's contention will be found. The fact that the draft patent application may be relevant to the diligence issue is insufficient to demonstrate that the requested discovery is necessary in the interest of justice.

ORDER

It is therefore

ORDERED that Petitioner's Motion for Additional Discovery is *granted* as to the requests for (1) formal minutes relating to the subject matter of the '282 patent from Patent Committee Meetings held on January 11, 2010, April 5, 2010, and April 13, 2010; and (2) lab notebooks for experiments performed pursuant to lab instructions dated July 16, 2008 (Ex. 2011), July 28–29, 2008 (Ex. 2012), and September 15, 2008 (Ex. 2015);

FURTHER ORDERED that the April 2009 "Forward Engineering Form" and September 2009 "whitepaper to brief Honeywell top executives regarding 1234yf" referenced in the Morris Declaration (Ex. 2036 ¶¶ 5, 9) are routine discovery under 37 C.F.R. § 42.51(b)(1)(i);

FURTHER ORDERED that Patent Owner must serve Petitioner the additional and routine discovery by April 8, 2016; and

FURTHER ORDERED that Petitioner's motion is *denied* as to all other requests for additional discovery.

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