

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Arkema France

Petitioner

v.

Honeywell International Inc.

Patent Owner

Trial No.: IPR2015-00916

U.S. Patent No. 8,710,282

PETITIONER'S MOTION TO EXCLUDE EVIDENCE

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	THE BOARD SHOULD EXCLUDE EXHIBIT 2007 BECAUSE IT IS UNAUTHENTICATED	3
III.	THE BOARD SHOULD EXCLUDE EXHIBIT 2009 BECAUSE IT IS UNAUTHENTICATED	5
IV.	THE BOARD SHOULD EXCLUDE EXHIBITS 2014, 2017, 2020, 2023, 2025, AND 2027 BECAUSE THEY ARE UNAUTHENTICATED	8
V.	THE BOARD SHOULD EXCLUDE EXHIBIT 2028	10
VI.	CONCLUSION.....	11

TABLE OF AUTHORITIES

CASES

<i>Kolmes v. World Fibers Corp.</i> , 107 F.3d 1534 (Fed. Cir. 1997)	7
<i>Kridl v. McCormick</i> , 105 F.3d 1446 (Fed. Cir. 1997)	5
<i>Microsoft Corp. v. SurfCast, Inc.</i> , IPR2013-00292, Paper 93 (P.T.A.B. October 14, 2014)	4, 5, 9, 10
<i>Neste Oil Oyj v. REG Synthetic Fuels, LLC</i> , IPR2013-00578, Paper 52 (P.T.A.B. March 12, 2015)	4, 9
<i>Price v. Symsek</i> , 988 F.2d 1187 (Fed. Cir. 1993)	4
<i>Vesom v. Atchison Hosp. Ass'n</i> , No. 04-2218-JAR, 2006 U.S. Dist. LEXIS 68576 (D. Kan. Sep. 22, 2006)	8

REGULATIONS

37 C.F.R. § 42.62	1
37 C.F.R. § 42.64	1

RULES

Federal Rules of Evidence 901	passim
Federal Rules of Evidence 902	passim

Pursuant to 37 C.F.R. § 42.64(c), Petitioner Arkema France (“Petitioner”) respectfully asks the Board to exclude Exhibits 2007, 2009, 2014, 2017, 2020, 2023, 2025, 2027, and 2028 submitted by Patent Owner Honeywell International, Inc. (“Patent Owner”) in support of its Response (Paper 21). As required by 37 C.F.R. § 42.62, Petitioner’s objections below apply the Federal Rules of Evidence (“FRE”).

I. Introduction

Trial in this proceeding was instituted on October 21, 2015. (Paper 16, p. 1.) In its Response, Patent Owner alleges that Smith is not prior art to U.S. Patent No. 8,710,282 (the ‘282 patent) because Patent Owner allegedly conceived of the subject matter of claims 1-20 before the priority date for Smith (May 15, 2009) and then purportedly was diligent in constructively reducing to practice the subject matter of claims 1-20 with the filing of the provisional application leading to the ‘282 patent on October 12, 2010. (Paper 21, pp. 34-47.) In support of and to corroborate its antedating arguments, Patent Owner submitted as exhibits a number of internal company documents, including Exhibits 2007, 2009, 2014, 2017, 2020, 2023, 2025, 2027, and 2028.

Exhibit 2007 is an email dated March 26, 2008 from Mr. Haluk Kopkalli (a listed inventor of the '282 patent) to Dr. Harry S. Tung¹ (another listed inventor), among others. Exhibit 2009 is a partially redacted Project Permit Change Form dated May 16, 2008, submitted by Selma Bektesevic (a listed inventor of the '282 patent). Exhibits 2014, 2017, 2020, 2023, 2025, and 2027 are Monthly Highlights prepared by Dr. Tung for the months of August 2008, September 2008, November 2008, January 2009, February 2009, and March 2009, respectively. Exhibit 2028 is a presentation entitled Apollo Technology Review Dehydrofluorination, dated May 13, 2009.

Petitioner timely served Patent Owner with and filed objections to the admissibility of Exhibits 2007, 2009, 2014, 2017, 2020, 2023, 2025, 2027, and 2028 on January 29, 2016. (Paper 23.) Among other objections, Petitioner objected to the admission of Exhibits 2007, 2009, 2014, 2017, 2020, 2023, 2025, 2027, and 2028 under FRE 901(a) because Patent Owner did not produce sufficient admissible evidence to authenticate Exhibits 2007, 2009, 2014, 2017, 2020, 2023, 2025, 2027, and 2028, and did not produce admissible evidence to establish that Exhibits 2007, 2009, 2014, 2017, 2020, 2023, 2025, 2027, and 2028 were self-authenticating under FRE 902. (Paper 23, pp. 3-4.) Patent Owner responded to Petitioner's objections by serving Petitioner with supplemental declarations of

¹ Dr. Harry Tung is also referred to as Dr. Hsueh Sung Tung.

Bruce Bradford, Hsueh Sung Tung, and Angela Goodie. However, the supplemental declarations were not sufficient to authenticate Exhibits 2007, 2009, 2014, 2017, 2020, 2023, 2025, 2027, and 2028.

As discussed in greater detail below, Exhibits 2007, 2014, 2017, 2020, 2023, 2025, 2027, and 2028 are inadmissible because Patent Owner has attempted to authenticate these Exhibits using the testimony of inventor Dr. Tung. Patent Owner did not submit a supplemental declaration of a non-inventor witness to attempt to authenticate Exhibits 2007, 2014, 2017, 2020, 2023, 2025, 2027, and 2028. Additionally, as further discussed below, Exhibit 2009 is inadmissible because Patent Owner has not produced sufficient evidence to support a finding that the Exhibit is what Patent Owner claims it is. Patent Owner did not offer supplemental testimony of Ms. Goodie or any other witness with personal knowledge of Exhibit 2009. Additionally, Patent Owner did not sufficiently explain how Ms. Overton knows that Exhibit 2009 is a true and accurate copy of the original document.

II. The Board should exclude Exhibit 2007 because it is unauthenticated

In its Response, Patent Owner argues that it conceived the subject matter of claims 1-20 by March 26, 2008. (Paper 21, p. 37). Patent Owner relies upon Exhibit 2007, a March 26, 2008, email and attachments from Haluk Kopkalli to Dr. Tung and others, to purportedly corroborate Patent Owner's argument and

Dr. Tung's declaration. (*Id.* at pp. 37-38; *see also* Ex. 2006, ¶11.)² However, Dr. Tung's declaration is insufficient to properly authenticate Exhibit 2007. The proponent of corroborating evidence offered to show conception must provide sufficient proof of date and identity of the submitted evidence. *See Price v. Symsek*, 988 F.2d 1187, 1194-95 (Fed. Cir. 1993). Inventor testimony is not sufficient to authenticate a document offered to corroborate the inventor's testimony. *Microsoft Corp. v. SurfCast, Inc.*, IPR2013-00292, Final Written Decision, Paper 93, pp.16-17 (P.T.A.B. October 14, 2014); *see also Neste Oil Oyj v. REG Synthetic Fuels, LLC*, IPR2013-00578, Decision on Petitioner's Motion to Exclude Evidence, Paper 52, p. 4 (P.T.A.B. March 12, 2015) ("[t]his rule [that the testimony of a witness other than the inventor is necessary to authenticate a corroborating document] is proper to avoid 'circular' situations in which a party seeks to rely on a document to corroborate a witness' testimony, but relies on that witness' testimony to provide the date or other authentication of that document").

As explained in *SurfCast*, the corroborating document is meant to independently

² Patent Owner witnesses Drs. Lousenberg and Tung also rely on Exhibit 2007 for the contention that the subject matter of claims 1-20 was conceived by March 26, 2008. (*See* Ex. 2002, ¶¶145-146 and Ex. 2006, ¶11, respectively.) Patent Owner relies upon the testimony of Drs. Lousenberg and Tung on page 37 of its Response. (Paper 21, p. 37.)

confirm the testimony of the inventor. IPR2013-00292, Paper 93 at 16-17 (*citing Kridl v. McCormick*, 105 F.3d 1446, 1449 (Fed. Cir. 1997)). Thus, if the corroborating document is authenticated by the inventor, the corroboration is not sufficiently independent. *SurfCast*, IPR2013-00292, Paper 93 at 16-17.

In *SurfCast*, the patent owner submitted documents, including emails exchanged between inventors, to corroborate the inventors' testimony related to conception. *Id.* at 15-16. The patent owner submitted inventor testimony in an attempt to authenticate the corroborating documents, including the emails. *Id.* at 16. However, the Board held that the inventor testimony did not authenticate the corroborating documents, including emails, because it was not sufficiently independent. *Id.* at 52. Here, Patent Owner provides no testimony other than inventor Dr. Tung's testimony to authenticate Exhibit 2007. Thus, Exhibit 2007 is not properly authenticated under FRE 901(a), is not self-authenticating under FRE 902 and is accordingly inadmissible.

III. The Board should exclude Exhibit 2009 because it is unauthenticated

Patent Owner relies on Exhibit 2009, a Project Permit Change Form dated May 16, 2008, as evidence of purported diligence. (Paper 21, p. 39; Ex. 2006,

¶17.)³ However, Patent Owner does not produce sufficient evidence to authenticate Exhibit 2009. To satisfy the requirement of authenticating or identifying an item of evidence, the proponent must produce evidence sufficient to support a finding that the item is what the proponent claims it is. FRE 901(a). Patent Owner submits the declarations of Angela Goodie and Diana Overton in an attempt to authenticate Exhibit 2009, but neither declaration is sufficient for authentication.

Declarant Angela Goodie testifies that she performed experiments in line with the July 16, 2008 Instructions using the lab setup described in the Project Permit Change Form of Exhibit 2009. However, Ms. Goodie never states that Exhibit 2009 is a true and accurate copy of the original Project Permit Change Form dated May 16, 2008. In contrast, Ms. Goodie does state that Exhibit 2011 is a true and accurate copy of the original July 16 Instructions she received and utilized to perform the experiment (using the lab setup described in Exhibit 2009). In fact, Ms. Goodie attests to the truth and accuracy of a number of documents in

³ Dr. Tung relies on Exhibit 2009 in his declaration in support of diligence. (Ex. 2006, ¶17). Patent Owner relies upon Dr. Tung's testimony on page 39 of its Response. (Paper 21, p. 39.)

her original declaration. (Ex. 2037, ¶¶4-6).⁴ Thus, Patent Owner showed its ability to authenticate documents using the testimony of Ms. Goodie. However, Patent Owner either chose not to or was unable to use Ms. Goodie’s testimony to authenticate Exhibit 2009. Patent Owner also attempts to use the testimony of Diana Overton to authenticate Exhibit 2009. However, Ms. Overton did not start her position as Health, Safety, and Environment (HS&E) Manager for Buffalo Research Laboratory (BRL) until June 8, 2015. Exhibit 2009 is dated May 16, 2008, seven years before Ms. Overton started her position. Thus, Ms. Overton has no personal knowledge related to Exhibit 2009. Ms. Overton offers testimony related to maintenance of documents by the HS&E department in the regular course and scope of business of Patent Owner. (Ex. 2040, ¶5.) However, Ms. Overton provides no specific time frame for the general information she provides, which is particularly pertinent since she did not start her position until seven years after Exhibit 2009 was produced. Ms. Overton also does not provide any specific information regarding how she knows what procedures were used at the time that Exhibit 2009 was created. *Kolmes v. World Fibers Corp.*, 107 F.3d 1534, 1542-43 (Fed. Cir. 1997) (excluding testimony on authentication for lack of testimony on

⁴ For example, Ms. Goodie states that Exhibits 2011, 2012, and 2015 are all “true and accurate” copies of the original documents. (Ex. 2037, ¶¶4, 5, and 6, respectively.)

the record-keeping process related to the documents); *see also Vesom v. Atchison Hosp. Ass'n*, No. 04-2218-JAR, 2006 U.S. Dist. LEXIS 68576, at *23 (D. Kan. Sep. 22, 2006) (excluding most of a doctor's declaration for lack of personal knowledge because the events concerned in the declaration occurred after the doctor retired as a chief executive officer of AHA).

Petitioner submits that Exhibit 2009 is not properly authenticated under FRE 901(a), is not self-authenticating under FRE 902 and is accordingly inadmissible.

IV. The Board should exclude Exhibits 2014, 2017, 2020, 2023, 2025, and 2027 because they are unauthenticated

Patent Owner relies on Exhibits 2014, 2017, 2020, 2023, 2025, and 2027 to support and corroborate arguments and testimony related to diligence.⁵ These six exhibits are monthly highlight reports prepared by Dr. Tung during the period of August 2008 to March 2009. Exhibit 2014 is the monthly highlight report prepared for August 2008. (Ex. 2006, ¶33). It incorporates information contained in Dr. Bektesevic's monthly technology reports for July and August 2008. *Id.* Exhibit 2017 is the monthly highlight report prepared for September 2008. (Ex. 2006, ¶39). It incorporates information contained in Dr. Bektesevic's

⁵ Dr. Tung relies on Exhibits 2014, 2017, 2020, 2023, 2025, and 2027 to support diligence. (Ex. 2006, ¶¶33, 39, 44, 47, 49, and 51.) Patent Owner relies on Dr. Tung's testimony on pages 41-42 of its Response. (Paper 21, pp. 41-42.)

September 2008 monthly technology report. *Id.* Exhibit 2020 is the monthly highlight report prepared for November 2008 (Ex. 2006, ¶44), Exhibit 2023 is the monthly highlight report prepared for January 2009 (Ex. 2006, ¶47), Exhibit 2025 is the monthly highlight report prepared for February 2009 (Ex. 2006, ¶49), and Exhibit 2027 is the monthly highlight report prepared for March 2009 (Ex. 2006, ¶51). Each of the reports of Exhibits 2020, 2023, 2025, and 2027 incorporates information contained in Dr. Bektesevic's corresponding monthly technology report. (*Id.* at ¶¶44, 47, 49, and 51, respectively.)

Patent Owner attempts to authenticate Exhibits 2014, 2017, 2020, 2023, 2025, and 2027 using the testimony of inventor Dr. Tung. (Ex. 2006, ¶¶33, 39, 44, 47, 49, and 51). However, as discussed above with regard to Exhibit 2007, inventor testimony to authenticate a corroborating document is not sufficient because such testimony is not "sufficiently independent." *SurfCast*, IPR2013-00292, Paper 93 at 52; *Neste Oil Oyj*, IPR2013-00578, Paper 52 at 4. Patent Owner provides no testimony other than inventor Dr. Tung's testimony to authenticate Exhibits 2014, 2017, 2020, 2023, 2025, and 2027. Thus, Exhibits 2014, 2017, 2020, 2023, 2025, and 2027 are not properly authenticated under FRE 901(a), are not self-authenticating under FRE 902 and are accordingly inadmissible.

V. The Board should exclude Exhibit 2028

Patent Owner relies on Exhibit 2028, a redacted copy of a May 13, 2009 presentation, to support and corroborate arguments in its Response and the testimony of Dr. Tung.⁶ Patent Owner attempts to authenticate Exhibit 2028 using the testimony of inventor Dr. Tung. (Ex. 2006, ¶53.) However, for the same reasons discussed above with regard to Exhibits 2007, 2014, 2017, 2020, 2023, 2025, and 2027, Dr. Tung's testimony is not sufficiently independent to authenticate Exhibit 2028. *See SurfCast*, IPR2013-00292, Paper 93 at 52. Patent Owner does not provide any other testimony to authenticate Exhibit 2028. Thus, Exhibit 2028 is not properly authenticated under FRE 901(a), is not self-authenticating under FRE 902 and is accordingly inadmissible.

⁶ Dr. Tung relies on Exhibit 2028 in support of diligence. (Ex. 2006, ¶53.) Patent Owner relies on Dr. Tung's testimony on page 43 of its Response. (Paper 21, p. 43.)

VI. Conclusion

For the foregoing reasons, the Board should exclude Patent Owner's Exhibits 2007, 2009, 2014, 2017, 2020, 2023, 2025, 2027, and 2028.

Dated: June 13, 2016

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing PETITIONER'S MOTION
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