

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*.

ORDER
Trial Hearing
37 C.F.R. § 42.70

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.

IPR2015-00915
IPR2015-00916
IPR2015-00917
Patent 8,710,282 B2

Patent Owner and Petitioner each request an oral hearing pursuant to 37 C.F.R. § 42.70. Papers 45, 46.² The requests are *granted*.

There is substantial overlap in the issues raised in the three cases, and we exercise our discretion to conduct a consolidated oral hearing. Each party will have 90 minutes of total argument time to present its arguments as to all three proceedings, with each party allotting their time among the three proceedings as they wish. Petitioner bears the ultimate burden of proof that the patent claims at issue in this review are unpatentable. Therefore, Petitioner will proceed first to present its case with regard to the challenged claims on which basis we instituted trial. Thereafter, Patent Owner will respond to Petitioner's arguments. Petitioner may reserve rebuttal time to respond to arguments presented by Patent Owner.

There is information in the record of these proceedings that has been sealed pending the outcome of the parties' Motions to Seal. Patent Owner requests that portions of the oral hearing be closed to the public, and that portions of the transcript be designated as confidential, in order to accommodate Patent Owner's confidential exhibits. Paper 45, 1. Petitioner opposes this request. Paper 46, 1.

There is a strong public policy for making all information filed in *inter partes* review proceedings open to the public. *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001 (PTAB May 14, 2014) (Paper 34). Because an *inter partes* review affects the rights of the public in an issued patent, it is important that a complete and understandable file

² For brevity, we refer to papers filed in IPR2015-00915. Similar papers were filed in each of the other proceedings.

IPR2015-00915
IPR2015-00916
IPR2015-00917
Patent 8,710,282 B2

history is maintained. The default rule is that all papers filed in an *inter partes* review will be open and available for access by the public, and that only confidential information may be protected from disclosure upon a showing of good cause. *See* 35 U.S.C. §§ 316(a)(1), 316(a)(7); 37 C.F.R. §§ 42.14, 42.54 (a).

We have considered the strong public interest in making all aspects of an *inter partes* review available to the public, while taking into account Patent Owner's interest in protecting truly confidential information. *See* 37 C.F.R. §§ 42.14, 42.54; Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,760 (Aug. 14, 2012). For example, in these proceedings, the public has a strong interest in knowing the evidence Patent Owner is relying on to establish that the date of its claimed invention is prior to the effective date of Smith³ and/or Sedat,⁴ the references relied upon in the grounds of unpatentability upon which the trials were instituted in these proceedings. Any confidential information that is relied upon or identified in a final written decision will be made public. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,761. Similarly, any argument or information that the parties consider to be persuasive at the oral hearing also should be open to the public.

We caution the parties to be mindful, at the oral hearing, not to make public information that the other party has asserted in a motion to be

³ Smith, WO 2009/138764 A1, published November 19, 2009 (IPR 2015-00915, Ex. 1003).

⁴ Sedat, French Patent App. Pub. No. 2 940 968, published July 16, 2010 (IPR2015-00915, Exs. 1004, 1005 (English translation)).

IPR2015-00915
IPR2015-00916
IPR2015-00917
Patent 8,710,282 B2

confidential and has requested to be sealed. The parties may present their arguments without disclosing specifically any allegedly confidential information during the oral hearing. Accordingly, we deny Patent Owner's request that portions of the oral hearing be closed to the public, and that portions of the transcript be designated confidential.

The hearing shall commence at 1:00 pm EDT on July 18, 2016. The hearing will be open to the public for in-person attendance on the ninth floor of Madison Building East, 600 Dulany Street, Alexandria, VA. In-person attendance will be accommodated on a first-come, first-served basis. The Board will provide a court reporter, and the transcript shall constitute the official record of the hearing.

Under 37 C.F.R. § 42.70(b), demonstrative exhibits, if any, must be served seven business days before the hearing. In contrast to what is expressly stated in § 42.70, however, the parties shall file the demonstrative exhibits no later than two business days before the hearing to allow the panel sufficient time to review the materials.

We remind the parties that demonstrative exhibits are not evidence, but are intended to assist the parties in presenting their oral arguments to the Board. We also remind the parties that demonstrative exhibits are not a mechanism for making arguments not previously addressed in the Papers. The parties are directed to *St. Jude Medical, Cardiology Division, Inc. v. The Board of Regents of the University of Michigan*, Case IPR2013-00041 (PTAB Jan. 27, 2014) (Paper 65), for guidance regarding the appropriate content of demonstrative exhibits. *See also CBS Interactive Inc. v. Helferich Patent Licensing, LLC*, Case IPR2013-00033 (PTAB Oct. 23, 2013) (Paper

IPR2015-00915
IPR2015-00916
IPR2015-00917
Patent 8,710,282 B2

118) (The Board has discretion to limit the parties' demonstratives to pages in the record should there be no easy resolution to objections over demonstratives.).

To the extent that the parties object to the propriety of any demonstrative exhibit, we expect that the parties will meet and confer in good faith to resolve any objections to demonstrative exhibits. Any issue regarding demonstrative exhibits should be resolved at least two business days prior to the hearing by way of a joint telephone conference with the Board. The parties are responsible for requesting such a conference sufficiently in advance of the hearing to accommodate this requirement. Any objection to demonstrative exhibits that is not timely presented will be considered waived. A hard copy of the demonstratives should be provided to the court reporter at the hearing.

Questions regarding specific audio-visual equipment should be directed to the Board at 571-272-9797. Requests for audio-visual equipment are to be made no later than 5 days in advance of the hearing date. The request is to be sent directly to Trials@uspto.gov. If the request is not received timely, the equipment may not be available on the day of the hearing. The parties are reminded that the presenter must identify clearly and specifically each demonstrative exhibit (e.g., by slide or screen number) referenced during the hearing to ensure the clarity and accuracy of the reporter's transcript.

The Board expects lead counsel for each party to be present in person at the oral hearing. However, any counsel of record may present the party's argument. If either party anticipates that its lead counsel will not be

IPR2015-00915
IPR2015-00916
IPR2015-00917
Patent 8,710,282 B2

attending the oral argument, the parties should initiate a joint telephone conference with the Board no later than two business days prior to the oral hearing to discuss the matter.

PETITIONER:

Jon H. Beaupré
Allen R. Baum
Allyn B. Elliott
Joshua E. Ney
Richard K. DeMille
BRINKS GILSON & LIONE
jbeaupre@brinksgilson.com
abaum@brinksgilson.com
aelliott@brinksgilson.com
jney@brinksgilson.com
rdemille@brinksgilson.com
Arkema_HoneywellIPRs@brinksgilson.com

PATENT OWNER:

Bruce J. Rose
Christopher TL Douglas
S. Benjamin Pleune
ALSTON & BIRD LLP
bruce.rose@alston.com
chris.douglas@alston.com
ben.pleune@alston.com