

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 REPLY IN SUPPORT OF ITS MOTION TO EXCLUDE
EVIDENCE**

I. Introduction

As explained in Petitioner’s Motion to Exclude Evidence, Exhibits 2007, 2009, 2014, 2017, 2020, 2023, 2025, 2027, and 2028 should be excluded because Patent Owner has not properly authenticated these exhibits. Patent Owner attempts to excuse its failed authentication efforts by accusing Petitioner of applying the wrong standard (Opposition at 5), but fails to cite a single PTAB case where the Board held that the testimony of an inventor, and no other witness, in combination with the appearance, contents, and substance of the document at issue, was sufficient to authenticate the document.

II. Exhibits 2007, 2014, 2017, 2020, 2023, 2025, 2027, and 2028 Should be Excluded in View of PTAB Precedent

A. Exhibit 2007

Exhibit 2007 purports to be an email between two inventors (Tung and Kopkalli) and several non-inventors. Exhibit 2007 also includes two attachments. The email should be excluded under *Microsoft Corp. v. SurfCast, Inc.*, IPR2013-00292, Final Decision, Paper 93 (PTAB October 14, 2014), and the two attachments should be excluded under *Neste Oil Oyj v. REG Synthetic Fuels, LLC*, IPR2013-00578, Paper 52 (PTAB March 12, 2015).

Patent Owner’s attempt to distinguish *Microsoft* mischaracterizes the facts of that case. In *Microsoft*, the Board excluded Exhibit 2024 submitted in that proceeding (“Microsoft 2024”), an email between the inventors and non-inventor

Dixon Dick regarding the subject matter of the patent at issue. The patent owner attempted to authenticate Microsoft 2024 with the testimony of inventor Mr. Santoro but failed to provide a declaration of a non-inventor, such as Mr. Dick. While the date of the email communication in Microsoft 2024 was redacted for a portion of the IPR proceedings, an unredacted version of the email was in the record for significant and relevant portions of the proceedings, including at the time of the Board's decision to exclude the document. *Microsoft*, Paper 88 at 5-6. Even with the unredacted date, the Board found that Microsoft 2024 lacked proper authentication. *Microsoft*, Paper 93 at 52 (“SurfCast later provided unredacted versions of exhibits [but this did not] cure Microsoft’s objection to the exhibits’ authenticity”) (citation omitted). When the Board considered the appearance, contents, and substance of Microsoft 2024 (namely, non-inventor email recipients, visible date, and email content) in combination with the testimony of inventor Santoro, the Board excluded the Exhibit noting that “[t]he testimony of an interested party, such as [an inventor or attorney], is not sufficient to authenticate a document offered for purposes of corroboration . . . because [the testimony] is not sufficiently independent.” *Microsoft*, Paper 93 at 52.

Here, just as in *Microsoft*, Exhibit 2007 includes an email between inventors and other non-inventor recipients that is dated and contains content that appears to relate to the subject matter of the patent at issue (liquid phase dehydrofluorination).

Patent Owner has only provided inventor testimony to authenticate the email. No other recipient testified as to the authenticity of the email. Therefore, the email portion of Exhibit 2007 should be excluded for the same reasons set forth in *Microsoft*.

Turning now to the attachments of Exhibit 2007, the first attachment is an undated one-page document with no indication of source or authorship. This document is similar to Exhibit 2003 in *Neste* (“Neste 2003”), which also was undated and bore no indicator of author. The Board excluded Neste 2003 because the patent owner only submitted inventor testimony to authenticate the same. The second attachment to Exhibit 2007 in this case is a two-page document depicting hand sketched flow diagrams. Both pages of the second attachment include the handwritten numbers 3/18/08 and handwritten letters that appear to be initials (YC/SC/HK/HT/KDU). This document is similar to Exhibit 2002 in *Neste* (“Neste 2002”), which was a laboratory notebook page that contained two corrections bearing the notation “RA 2/20” but no other explanation of date or source. The Board excluded Neste 2002 because the patent owner only submitted inventor testimony to authenticate the same. The attachments to Exhibit 2007 should be excluded for the same reasons that Neste 2002 and Neste 2003 were excluded.

B. Exhibits 2014, 2017, 2020, 2023, 2025, and 2027

Exhibits 2014, 2017, 2020, 2023, 2025, and 2027 should be excluded for the same reason that the Board excluded Exhibit 2037 in *Microsoft* (“Microsoft 2037”). These exhibits are dated monthly highlight documents apparently prepared by Harry Tung. The unredacted portions of the documents appear to relate to liquid phase dehydrofluorination.

In *Microsoft*, the Board excluded Microsoft 2037, a three page document described by the Board as a white paper. Like the monthly highlight documents, Microsoft 2037 related to the subject matter of the patented invention, was dated¹ and included an indication of authorship (a © symbol with the name of inventor Ovid Santoro). Patent owner SurfCast offered the testimony of inventor Santoro to authenticate Microsoft 2037. No other testimony was offered to corroborate Microsoft 2037. The Board held that the appearance, contents, or substance of Microsoft 2037 in combination with the testimony of inventor Santoro was not sufficient to authenticate the white paper. For the same reasons, Exhibits 2014, 2017, 2020, 2023, 2025, and 2027 should be excluded.

¹ As with other documents in *Microsoft*, the date on Exhibit 2037 was redacted from the parties and the Board for a portion of the IPR proceedings.

C. Exhibit 2028

Exhibit 2028 is a five page document with two pages completely redacted. The document contains a date of May 13, 2009, but does not have an indication of source or authorship. The content appears to relate to liquid phase dehydrofluorination. Patent Owner attempts to authenticate Exhibit 2028 with the testimony of inventor Dr. Tung. Exhibit 2028 is similar to the white paper of Microsoft 2037 discussed above except that the whitepaper had an indication of authorship whereas Exhibit 2028 does not. Applying the same analysis as applied by the Board to Microsoft 2037, Exhibit 2028 should be excluded.

III. Conclusion

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

Dated: July 5, 2016

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing PETITIONER'S REPLY
IN SUPPORT OF ITS MOTION TO EXCLUDE EVIDENCE has been served in
its entirety this 5th day of July, 2016 by electronic mail on:

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