

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARKEMA FRANCE,
Petitioner,

v.

HONEYWELL INTERNATIONAL, INC.,
Patent Owner.

Case IPR2015-00916
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
Petitioner's Motion to Exclude Evidence
37 C.F.R. § 42.64(c)

Arkema France (“Petitioner”) moves to exclude from evidence certain exhibits filed by Honeywell International, Inc. (“Patent Owner”) (Paper 46, “Mot.”). Patent Owner filed an Opposition (Paper 50, “Opp.”), and Petitioner filed a Reply (Paper 51, “Reply”). For the following reasons, Petitioner’s motion is *granted-in-part* and *denied-in-part*.

Pursuant to our Rules, a motion to exclude evidence must be filed to preserve any previously-made objections to evidence. 37 C.F.R. § 42.64(c). The motion must identify where in the record the objections were made, and must explain the objections. *Id.* Petitioner’s Motion seeks to exclude the following exhibits on the ground that they are not properly authenticated:

Exhibit	Description from Exhibit List (Paper 21, vi–vii)
2007	March 26, 2008 email from Haluk Kopkalli
2009	Project Permit Change Form to Permit # 626 dated May 16, 2008
2014	August 2008 Monthly Highlights Report of Dr. Tung
2017	September 2008 Monthly Highlights Report of Dr. Tung
2020	November 2008 Monthly Highlights Report of Dr. Tung
2023	January 2009 Monthly Highlights Report of Dr. Tung
2025	February 2009 Monthly Highlights Report of Dr. Tung
2027	March 2009 Monthly Highlights Report of Dr. Tung
2028	PowerPoint entitled “Apollo Technology Review Dehydrofluorination of 236ea and 245eb” and dated August 21, 2009

Petitioner identifies where in the record it previously served objections to these exhibits (Mot. 2 (citing Paper 23)), and the Motion is, therefore, procedurally proper. As the moving party, Petitioner bears the burden of proof to establish that it is entitled to the requested relief: the exclusion of the evidence as inadmissible under the Federal Rules of Evidence (“FRE”). *See* 37 C.F.R. §§ 42.20(c), 42.64(a).

Federal Rule of Evidence 901(a) states that, “[t]o 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.” The Rule provides several examples of evidence that may satisfy the requirement, including the testimony of a witness with knowledge that the item is what it is claimed to be. FRE 901(b)(1). Patent Owner argues that it “relies on testimony from multiple witnesses combined with the appearance, contents, and substance of each exhibit” in order to authenticate the exhibits. Opp. 1 (emphasis omitted).

A. *Exhibit 2007*

Patent Owner provides the testimony of named inventor Dr. Harry S. Tung that Exhibit 2007 is “a true and accurate copy of the Kopkalli Email dated March 26, 2008 and associated attachments which [Dr. Tung] received from Mr. Kopkalli in the ordinary course of business.” Ex. 2006 ¶ 11. Patent Owner argues that this testimony, along with the contents of Exhibit 2007, establishes that “there is at least a reasonable likelihood that Exhibit 2007 contains the Kopkalli e-mail.” Opp. 8–9.¹ Petitioner argues that, because Patent Owner relies on Exhibit 2007 to corroborate Patent Owner’s argument and Dr. Tung’s testimony that the claimed invention was conceived by March 26, 2008, “Dr. Tung’s declaration is insufficient to properly authenticate Exhibit 2007.” Mot. 3–5.

Normally, the testimony of Dr. Tung—a witness having personal knowledge of the documents—could be sufficient to “support a finding that

¹ Patent Owner also cites to additional testimony from Dr. Tung in the “Tung Supplement Declaration.” Opp. 9. Because the Tung Supplemental Declaration does not appear to be in the record, this testimony is unsupported and we do not consider it in our analysis.

the item is what the proponent claims it is,” the context in which this exhibit is offered requires more. Specifically, because Patent Owner relies on Exhibit 2007 to corroborate Dr. Tung’s testimony that Exhibit 2007 demonstrates conception of the claimed invention at least as early as March 26, 2008, independent evidence of authenticity is required:

It is well established that in order for a contemporaneous document to be accorded any corroborative value[,] the testimony of a witness *other than the inventor*, who is shown to have understood the recorded information, is generally necessary to *authenticate the document’s contents* as well as to explain the witness’ relationship to the document in question.

Horton v. Stevens, 7 U.S.P.Q. 2d 1245, 1988 WL 252359 at *4 (BPAI Mar. 8, 1988) (emphasis added). This is 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. *See In re NTP, Inc.*, 654 F.3d 1279, 1297 (Fed. Cir. 2011); *Chen v. Bouchard*, 347 F.3d 1299, 1308 (Fed. Cir. 2003) (rejecting authentication of a document because it was not established by anything other than the circular testimony of the inventor). The purpose of corroboration is to prevent fraud by providing independent confirmation of the inventor’s testimony. *See, e.g., Kridl v. McCormick*, 105 F.3d 1446, 1450 (Fed. Cir. 1997) (“The tribunal must also bear in mind the purpose of corroboration, which is to prevent fraud, by providing independent confirmation of the inventor’s testimony.”). A document authenticated only by an inventor does not achieve that purpose because it is not sufficiently independent.

For this reason, Dr. Tung’s testimony cannot be used to authenticate Exhibit 2007, when Exhibit 2007 is offered to corroborate Dr. Tung’s

testimony regarding the conception date of the claimed invention. We determine that Exhibit 2007 should be excluded as lacking authentication under FRE 901.

B. Exhibit 2009

Patent Owner provides the testimony of Angela Goodie and Diana Overton in order to authenticate Exhibit 2009. Opp. 13–15 (citing Exs. 2037, 2040). Ms. Goodie testifies that she performed experiments in July 2008 according to instructions received from Dr. Selma Bektesevic, “using the lab setup described in the Project Permit Change Form (EX2009).” Ex. 2037 ¶ 4. Ms. Overton testifies to Patent Owner’s policies with respect to the preparation and retention of project permit change forms such as Ex. 2009, including that it is the policy

for researchers or scientists to prepare permits or permit change forms in order to pursue experiments and changes or addendums thereto (such as process, chemicals, people), respectively. Once the permit or permit change form is approved by the appropriate personnel, the signed original of the document is routed to the [Health, Safety and Environment] department, where it is maintained in the ordinary course of business.

Ex. 2040 ¶ 5.

Petitioner argues that “Ms. Goodie never states that Exhibit 2009 is a true and accurate copy of the original Project Permit Change Form dated May 16, 2008,” and Ms. Overton did not work at Patent Owner in her current capacity until June 2015, and thus does not have personal knowledge related to Exhibit 2009. Mot. 6–8. Patent Owner responds that “Ms. Goodie’s testimony *and* the ‘appearance, contents, [or] substance’ of Exhibit 2009 demonstrate at least a ‘reasonable likelihood’ that Exhibit 2009 contains the Project Permit Change Form received by Angela Goodie on or

near July 16, 2008.” Opp. 13. Patent Owner also argues that “Ms. Overton testified only to her personal knowledge as a record-keeper of the process for keeping records in the past.” *Id.* at 14–15.

We determine that Ms. Goodie’s testimony that she used the lab setup described in Exhibit 2009 to perform experiments following Dr. Bektesevic’s instructions, coupled with identifying information on Exhibit 2009 (such as the identification of Dr. Bektesevic as the “sender” of the form and the employee responsible for the project), is adequate to support a finding that Exhibit 2009 is the Project Permit Change Form to Permit # 626 dated May 16, 2008 as Patent Owner claims. Ms. Overton’s testimony regarding Patent Owner’s document retention practices further supports this determination. Accordingly, we decline to exclude Exhibit 2009.

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

Patent Owner provides testimony from Dr. Tung in order to authenticate Exhibits 2014, 2017, 2020, 2023, 2025, and 2027 (collectively, “the Tung Monthly Highlights”). Ex. 2006 ¶¶ 33, 39, 44, 47, 49, 51. Patent Owner argues that Dr. Tung testified from his personal knowledge that the Tung Monthly Highlights are true and accurate copies, and that Dr. Tung’s testimony, along with the date, title, and identified author of each exhibit, establishes that “there is at least a reasonable likelihood” that the Tung Monthly Highlights are authentic. Opp. 9–12. Petitioner argues that Patent Owner relies on the Tung Monthly Highlights “to support and corroborate arguments and testimony related to diligence,” and, as discussed above with respect to Exhibit 2007, Dr. Tung’s testimony cannot authenticate

corroborating documents because it is not sufficiently independent. Mot. 8–9.

For the reasons set forth above with respect to Exhibit 2007, Dr. Tung’s testimony cannot be used to authenticate the Tung Monthly Highlights, when the Tung Monthly Highlights are offered to corroborate Dr. Tung’s testimony regarding diligence. We determine that Exhibits 2014, 2017, 2020, 2023, 2025, and 2027 should be excluded as lacking authentication under FRE 901.

D. Exhibit 2028

Patent Owner provides testimony from Dr. Tung in order to authenticate Exhibit 2028. Ex. 2006 ¶ 53. Patent Owner argues that Dr. Tung testified “from his personal knowledge that Exhibit 2028 is a true and authentic copy of a presentation related to the caustic dehydrofluorination experiments given by Dr. Bektesevic at a meeting on May 13, 2009,” and that Dr. Tung’s testimony also “confirms the contents of the slides.” Opp. 12. Petitioner argues that Exhibit 2028 “does not have an indication of source or authorship” (Reply 5), and that, because Dr. Tung relies on Exhibit 2028 to support and corroborate arguments related to diligence, Dr. Tung’s testimony cannot authenticate Exhibit 2028 because it is not sufficiently independent (Mot. 10; Reply 5).

For the reasons set forth above with respect to Exhibit 2007, Dr. Tung’s testimony cannot be used to authenticate Exhibit 2028, when Exhibit 2028 is offered to corroborate Dr. Tung’s testimony regarding diligence. We determine that Exhibit 2028 should be excluded as lacking authentication under FRE 901.

ORDER

In consideration of the foregoing, it is

ORDERED that Petitioner's Motion to Exclude Evidence is *granted-in-part* with respect to Exhibits 2007, 2014, 2017, 2020, 2023, 2025, 2027, and 2028, and otherwise is *denied-in-part*.

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