

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARKEMA INC. and ARKEMA FRANCE,
Petitioner,

v.

HONEYWELL INTERNATIONAL INC.,
Patent Owner.

Case IPR2016-00643, Case PGR2016-00011, Case PGR2016-00012
Patent 9,157,017 B2¹

Before MICHAEL P. TIERNEY, GRACE KARAFFA OBERMANN, and
MICHELLE N. ANKENBRAND, *Administrative Patent Judges*.

ANKENBRAND, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ This Order addresses issues common to all three cases; therefore, we issue a single order to be entered in each case. The parties are not authorized to use this style heading for any subsequent papers.

On February 22, 2016, Petitioner filed Petitions requesting *inter partes* review and post-grant review of claims 1–20 of U.S. Patent No. 9,157,017 B2 (“the ’017 patent”). Paper 2.² On February 23, Petitioner filed a second Petition requesting post-grant review of the ’017 patent. Case PGR2016-00011, Paper 2. On February 26, 2016, Petitioner filed Corrected Petitions in IPR2016-00643 and PGR2016-00011, without prior Board authorization. Paper 3. On March 1, 2016, the Board issued a Notice of Filing Date Accorded in each of the three proceedings, which set a due date of June 1, 2016 for Patent Owner’s preliminary responses. *See* Paper 4, 2.

A conference call was held on March 29, 2015, among respective counsel for Petitioner and Patent Owner, and Judges Tierney, Obermann, and Ankenbrand. Patent Owner requested the call to: (1) request authorization to file motions to terminate PGR2016-00011 and PGR2016-00012 (collectively, “the PGR proceedings”), and (2) discuss the due date for Patent Owner’s preliminary responses in IPR2016-00643 and PGR2016-00011.

During the call, Patent Owner argued that a motion to terminate the PGR proceedings was appropriate so that the Board could determine whether the ’017 patent was eligible for post grant review; that is, whether the ’017 patent is subject to the first inventor to file provisions of the Leahy Smith America Invents Act. Petitioner opposed Patent Owner’s request. We *denied* Patent Owner’s request for authorization, determining that the preliminary response was a more appropriate vehicle for Patent Owner to raise its argument. We explained further that permitting the motion to

² Citations are to IPR2016-00643 as representative unless otherwise indicated.

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terminate would circumvent the preliminary response page limits, as well as disrupt the schedule in the proceedings.

As to the second issue discussed, both Patent Owner and Petitioner agreed that Patent Owner would file a preliminary response to the Corrected Petition filed in each of IPR2016-00643 and PGR2016-00011, but sought clarification regarding the due date of each preliminary response. We determined that, given the circumstances, we would extend the due date for Patent Owner's preliminary responses to June 6, 2016. We also reminded the parties of their obligation to request authorization before filing, *inter alia*, corrected papers.

It is therefore

ORDERED that Patent Owner's request for authorization to file a motion to terminate PGR2016-00011 and PGR2016-00012 is *denied*; and

FURTHER ORDERED that Patent Owner shall file its preliminary response to each of the Corrected Petitions no later than June 6, 2016.

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