

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.

PGR2016-00011
PGR2016-00012¹
Patent 9,157,017 B2

Before MICHAEL P. TIERNEY, *Vice Chief Administrative Patent Judge*,
GRACE KARAFFA OBERMANN, and SHELDON M. MCGEE,
Administrative Patent Judges.

McGEE, *Administrative Patent Judge*.

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

¹ We use our discretion to issue a single Order to be entered in each case using a joint caption. The parties are not permitted to use the joint caption unless previously authorized by the Board. For convenience, we use the paper and exhibit numbers from PGR2016-00011.

I. BACKGROUND

These proceedings are on remand from the United States Court of Appeals for the Federal Circuit. *See Honeywell Int'l Inc. v. Arkema Inc.*, 939 F.3d 1345 (Fed. Cir. 2019) (vacating the Board's Final Written Decision and remanding proceedings to the Board). The Federal Circuit instructed us to "authorize Honeywell to file a motion seeking leave to petition the Director for a Certificate of Correction." *Id.* at 1351.

Pursuant to the Federal Circuit's mandate, we gave our authorization, and Patent Owner filed its Motion for Leave to Request a Certificate of Correction. Paper 61. After additional briefing from the parties was complete, we granted Patent Owner's Motion. Papers 71, 74, 76, 77.

On May 5, 2020, Patent Owner filed its Request for a Certificate of Correction, as well as a Petition to Accept [Unintentionally] Delayed Claim to Priority under 35 U.S.C. § 120 and 37 C.F.R. § 1.78. On May 6, 2020, Patent Owner supplemented these filings with supporting documents.

On February 15, 2022, the Petitions Branch of the Office entered its Decision, dismissing Patent Owner's Petition. Ex. 3006 ("Dismissal").

On February 22, 2022, Patent Owner emailed the Board, informing the panel that it intended to "petition the Director under 37 CFR § 1.181 for review of that dismissal," and requested that the Board "stay any certificate of cancellation under 37 C.F.R. § 42.80 until the Director acts upon Honeywell's petition." Ex. 3007.

II. DISCUSSION

35 U.S.C. § 328(b) provides:

If the Patent Trial and Appeal Board issues a final written decision . . . and the time for appeal has expired or any appeal

PGR2016-00011
PGR2016-00012
Patent 9,157,017 B2

has terminated, the Director shall issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to be patentable, and incorporating in the patent by operation of the certificate any new or amended claim determined to be patentable.

This statute does not authorize the Board to issue a certificate of cancellation because our final written decision of August 31, 2017 was vacated. *Honeywell*, 939 F.3d at 1351. Thus, prior to issuing a certificate of cancellation, we must first enter a final written decision in these proceedings.

To the extent Patent Owner wishes us to delay issuance of a new final written decision while the Director evaluates Patent Owner's Petition to reconsider the February 15, 2022 Dismissal, we direct Patent Owner to file such Petition within two weeks of this Order. We also direct Patent Owner to inform the Board of such filing, by email to trials@uspto.gov, and to file its Petition as an exhibit in this proceeding.

If Patent Owner fails to take these actions within two weeks of this Order, the panel may exercise its jurisdiction and authority under 37 C.F.R. § 42.3(a) to issue a new final written decision in these proceedings.

PGR2016-00011
PGR2016-00012
Patent 9,157,017 B2

Accordingly, it is

ORDERED that Patent Owner shall file its Petition to the Director under 37 C.F.R. § 1.181 to reconsider the February 15, 2022 Dismissal no later than March 23, 2022;

FURTHER ORDERED that Patent Owner shall inform the Board of such filing and files the Petition as an exhibit in this proceeding no later than March 23, 2022.

PGR2016-00011
PGR2016-00012
Patent 9,157,017 B2

PETITIONER:

Mark Sweet
Mark Feldstein
Erin Sommers
Charles Mitchell
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
mark.sweet@finnegan.com
mark.feldstein@finnegan.com
erin.sommers@finnegan.com
charles.mitchell@finnegan.com

PATENT OWNER:

Gregg LoCascio
Noah Frank
KIRKLAND & ELLIS LLP
glocascio@kirkland.com
noah.frank@kirkland.com