

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 KRISTIL R. SAWERT,
Administrative Patent Judges.

SAWERT, *Administrative Patent Judge*.

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

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

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On January 10, 2020, Honeywell International Inc. (“Patent Owner”) filed a Motion for Leave to Request a Certificate of Correction. Paper 61 (“Motion for Leave” or “Mot.”). The Motion for Leave cites to, and was accompanied by, a declaration titled, “Declaration of Joseph Posillico in Support of Patent Owner’s Motion for Leave to Request a Certificate of Correction” (Exhibit 2167). *See* Mot. 5 (citing Ex. 2167 ¶¶ 8–10), 6 (citing Ex. 2167 ¶¶ 3–10). The motion also cites to, and was accompanied by, a proposed Certificate of Correction (Exhibit 2168). *See id.* at 5 (citing Ex. 2168). The proposed Certificate of Correction contains a declaration titled “Declaration of Joseph F. Posillico in Support of Certificate of Correction Pursuant to 37 C.F.R. § 1.323.” Ex. 2168, 9–15.

Arkema Inc. and Arkema France (“Petitioner”) filed a Notice of Deposition of Joseph F. Posillico on January 14, 2020. Paper 63. On January 17, 2020, Petitioner contacted the Board via e-mail requesting a conference call to resolve a dispute about the deposition. Ex. 3002. Specifically, Petitioner alleged that Patent Owner failed to confirm a date for the cross-examination of Mr. Posillico, and that “Patent Owner believes it is not required and/or is unwilling to produce Mr. Posillico for cross-examination as routine discovery under the rules.” *Id.*

The panel held a teleconference with counsel for the parties on January 22, 2020. A transcript of that conference call has been entered into the record. Ex. 1190.

During the conference call, Petitioner argued that, because this proceeding is on remand and the Board did not authorize Patent Owner to submit additional evidence, Patent Owner had no authority to submit

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Mr. Posillico's declaration. Ex. 1190, 6:19–25. But even if the Board considers Mr. Posillico's declaration, Petitioner argued, it is entitled to the cross-examination of Mr. Posillico as a matter of routine discovery under 37 C.F.R. § 42.51(b)(1)(ii). *Id.* at 6:5–9.

Patent Owner responded that cross-examination of Mr. Posillico is not a matter of routine discovery because, although Patent Owner had the right under 37 C.F.R. § 42.53(b)(1) to submit Mr. Posillico's testimony, Petitioner does not have the right under 37 C.F.R. § 42.51(b)(1)(ii) to cross-examine Mr. Posillico. Ex. 1190, 17:3–20. In this regard, Patent Owner argued that routine discovery may only take place “within such time period as the Board may set” and, here, the Board did not provide for a discovery period on remand. *Id.* at 12:4–17. Patent Owner argued that, “if [Petitioner] wished to take this deposition, given we're outside the authorized discovery period, [Petitioner] would need to file a motion for authorization” to compel testimony under 37 C.F.R. § 42.52(a). *Id.* at 13:6–13.

Patent Owner also argued that Mr. Posillico's declaration, submitted as Exhibit 2167, is substantially similar to Mr. Posillico's declaration in the proposed Certificate of Correction, submitted as Exhibit 2168, “[a]nd the rationale to attach [Exhibit 2167] was to give the Board the benefit of all the information [Petitioner would] be providing to the Director for the certificate of correction.” *Id.* at 11:14–19.

After considering the parties' respective arguments, we find that the cross-examination of Mr. Posillico in this case is in the interest of justice. *Id.* at 25:9–16. In particular, we agree with Petitioner that Patent Owner clearly relies on Mr. Posillico's factual averments in its Motion for Leave,

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and thus, as a matter of fairness, Petitioner shall have the right to cross-examine Mr. Posillico. *See* Mot. 5 (citing Ex. 2167 ¶¶ 8–10), 6 (citing Ex. 2167 ¶¶ 3–10). We also find that cross-examination of Mr. Posillico may be helpful to the Board in evaluating whether Patent Owner’s Motion for Leave sets forth a sufficient basis supporting Patent Owner’s position that a mistake may be correctable by a Certificate of Correction. *See Honeywell Int’l Inc. v. Arkema Inc.*, 939 F.3d 1345, 1349 (Fed. Cir. 2019) (“The Board has previously reviewed motions for leave to seek a Certificate of Correction from the Director to determine whether there is sufficient basis supporting Patent Owner’s position that the mistake may be correctable.” (quotation omitted)).

Typically, our rules provide for cross-examination as a matter of routine discovery. *See* 37 C.F.R. § 42.51(b)(1)(ii) (“Cross examination of affidavit testimony prepared for the proceeding is authorized within such time period as the Board may set.”). But, as Patent Owner points out, the Board did not previously set a time period under § 42.51(b)(1)(ii) for routine discovery to occur on remand. Ex. 1190, 12:4–17. We determine, however, that justice favors doing so now. Thus, we set the time period for cross-examination of Mr. Posillico to occur between January 27, 2020, and January 30, 2020.

Finally, to the extent the proper procedure in this case would have been for Petitioner to have sought the Board’s authorization to file a motion to compel Mr. Posillico’s testimony under 37 C.F.R. § 42.52(a), we waive that requirement. *See* 37 C.F.R. § 42.5(b) (“The Board may waive or suspend a requirement” of any rule under Part 42). The Board has

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established a goal to issue decisions on cases remanded from the Court of Appeals for the Federal Circuit within six months of the Board's receipt of the Federal Circuit's mandate. *See* Standard Operating Procedure 9: Procedure for Decisions Remanded from the Federal Circuit for Further Proceedings (available at https://www.uspto.gov/sites/default/files/documents/sop_9_%20procedure_for_decisions_remanded_from_the_federal_circuit.pdf). And here, the Federal Circuit issued its mandate on November 7, 2019. We determine that foregoing motions practice for compelling testimony in this proceeding will help to ensure the speedy and inexpensive resolution of the case. *See* 37 C.F.R. §§ 42.1(b), 42.5(a), (b) (stating that the rules are to be construed so as to ensure the just, speedy, and inexpensive resolution of a proceeding and, where appropriate, the rules may be modified to accomplish these goals).

It is therefore:

ORDERED that a cross-examination of Mr. Joseph Posillico shall take place no later than January 30, 2020;

FURTHER ORDERED that the time for cross-examination is limited to four (4) hours;

FURTHER ORDERED that Petitioner shall submit a copy of the cross-examination transcript in its entirety as an exhibit to Petitioner's Opposition to Patent Owner's Motion for Leave; and

FURTHER ORDERED that Petitioner shall inform the Board via e-mail of the date and time of the cross-examination at least twenty-four (24) hours prior to the cross-examination.

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