

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARKEMA AND ARKEMA FRANCE,
Petitioner

v.

HONEYWELL INTERNATIONAL INC.,
Patent Owner.

PGR2016-00011
Patent No. 9,157,017

**PATENT OWNER'S REPLY
IN SUPPORT OF ITS MOTION
FOR LEAVE TO REQUEST A CERTIFICATE OF CORRECTION**

TABLE OF CONTENTS

I. The Board Should Grant Honeywell’s Motion.....1

A. Honeywell Failed To Claim Its Proposed Chain By Mistake.....1

B. Honeywell’s Mistake Was Of Minor Character.....3

C. Honeywell’s Correction Would Not Require Reexamination4

D. Honeywell Did Not Intentionally Delay Seeking Its Correction7

E. Honeywell’s Correction Is Clear From The Record8

II. Granting Honeywell’s Motion Is Not Prejudicial.....9

Note: All emphasis is added unless otherwise indicated.

TABLE OF AUTHORITIES**Cases**

<i>In re Application G</i> , 11 U.S.P.Q.2d 1378 (Comm'r Patents & Trademarks 1989).....	8
<i>Application of Lund</i> , 376 F.2d 982 (C.C.P.A. 1967)	6
<i>In re Dinsmore</i> , 757 F.3d 1343 (Fed. Cir. 2014)	2
<i>Emerson Elec. v. SIPCO</i> , IPR2016-00984, Paper 52 (PTAB 2020).....	10
<i>Field Hybrids v. Toyota Motor</i> , 2005 WL 189710 (D. Minn. 2005).....	8
<i>G.D. Searle v. Lupin Pharms.</i> , 2014 WL 9869122 (E.D. Va. 2014)	2
<i>Honeywell Int'l v. Arkema</i> , 939 F.3d 1345 (Fed. Cir. 2019)	1, 7, 9, 10
<i>Inline Packaging v. Graphic Packaging</i> , IPR2015-01609, Paper 19 (PTAB 2016).....	10
<i>Kingston Techs. v. CATR</i> , IPR2015-00559, Paper 44 (PTAB 2015).....	10
<i>In re Lambrech</i> , 202 U.S.P.Q. 620 (Comm'r Pat. & Trademarks 1976)	9
<i>Prime Focus Creative Servs. Canada v. Legend3D</i> , IPR2016-01491, Paper 21 (PTAB 2017).....	7
<i>In re Rosuvastatin Calcium Patent Litig.</i> , 703 F.3d 511 (Fed. Cir. 2012)	3
<i>In re Serenkin</i> , 479 F.3d 1359 (Fed. Cir. 2007)	2

Sierra Club v. Thomas,
828 F.2d 783 (D.C. Cir. 1987).....10

Southwest Software v. Harlequin,
226 F.3d 1280 (Fed. Cir. 2000)10

Tronzo v. Biomet,
156 F.3d 1154 (Fed. Cir. 1998)6

Warner-Lambert v. Apotex,
316 F.3d 1348 (Fed. Cir. 2003)4

Statutes

35 U.S.C. §102.....6

35 U.S.C. §112.....5, 6, 8

35 U.S.C. §251.....2, 3

35 U.S.C. §255.....1, 4, 5, 7, 9

35 U.S.C. §303.....5

Regulation

37 C.F.R. §1.56.....5

Manual of Patent Examining Procedure

MPEP §1481.034, 8

MPEP §2136.036

MPEP §22426

Honeywell has “demonstrated a ‘sufficient basis’ that [its] mistake ‘may’ be correctable,” and none of Arkema’s arguments indicate otherwise. *Honeywell Int’l v. Arkema*, 939 F.3d 1345, 1349 (Fed. Cir. 2019). Arkema does not cite *any* precedent holding that a patentee improperly used a certificate of correction to correct its patent’s priority chain, as Honeywell seeks to do here. Nor has Arkema shown that it would be prejudiced if Honeywell’s motion were granted—much less that any prejudice Arkema *might* suffer could not be accommodated. The Board should grant Honeywell leave to ask the Director for a certificate of correction.

I. THE BOARD SHOULD GRANT HONEYWELL’S MOTION

A. Honeywell Failed To Claim Its Proposed Chain By Mistake

The Director can correct certain patentee “mistake[s]” that “occurred in good faith.” 35 U.S.C. §255. Arkema argues that Honeywell did not make a “mistake” during prosecution, and thus nothing needs to be corrected. Paper 71 at 2-6. Arkema is wrong on the law and the facts. There is at least a sufficient basis to conclude that the Director may find that Honeywell made a correctable “mistake.”

The law is entirely on Honeywell’s side. Honeywell has identified at least 10 cases in which courts and the PTO approved certificates of correction to remedy mistakes in priority chains, as here. Paper 61 at 8. Arkema, however, has not cited *any* case in which *any* court or agency held a correction was improper because the patentee did not make a “mistake” under §255. Instead, Arkema relies on cases

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.