

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARKEMA AND ARKEMA FRANCE
Petitioner,
v.

HONEYWELL INTERNATIONAL INC.,
Patent Owner.

Case No.: PGR2016-00011
Patent No.: 9,157,017

**PATENT OWNER'S OPPOSITION TO PETITIONER'S
MOTION TO EXCLUDE UNDER 37 C.F.R. § 42.64(C)**

Honeywell opposes Arkema's motion to exclude Exhibits 2101, 2102, and 2103, all of which are documents (specifically, declarations) previously filed with the Patent Office during prosecution of the '017 patent and which are relied upon by Honeywell's experts. Arkema points to no case in which the PTAB has excluded portions of the file history of the challenged patent. Rather, Arkema contends, without legal support, that Exhibits 2101, 2102, and 2103 are hearsay. Arkema, again without legal support, also contends that the PTAB should exclude *portions* of Exhibit 1057, a document *Arkema* itself introduced into the record of this proceeding, because Arkema did "not cite or otherwise rely on" those portions. Paper 36 at 6.

Arkema's complaint about these documents is its claimed failure to cross-examine the authors, Richard Winick and Raymond Thomas. Yet Arkema fails to mention that it deposed Dr. Thomas—in addition to a host of other Honeywell employees and experts—in a prior litigation between Arkema and Honeywell concerning the '366 patent, a parent to the '017 patent. Indeed, Exhibit 2103 contains the same data presented in a declaration by Rajiv Singh—an inventor of the '017 and '366 patents—during prosecution of the '366 patent. And Arkema already cross-examined Dr. Singh concerning that prior declaration. Arkema cannot credibly claim "prejudice" now where it already had opportunities to

depose multiple Honeywell employees about data which Arkema itself injected into the record.

I. BACKGROUND

Arkema moves to exclude Exhibits 2101, 2102, and 2103, all of which are part of the prosecution history of the '017 patent (at issue here) and were relied upon by Honeywell's experts in this proceeding.

- Exhibits 2101 and 2102 are declarations from Richard Winick, Honeywell's Global Director of Sales for the Fluorine Products business.
- Exhibit 2103 is a declaration from Dr. Raymond Thomas, a named inventor on U.S. Pat. Nos. 7,534,366 ("the '366 patent") and 8,065,882 ("the '882 patent").

The '017 patent claims priority to the '366 patent. Exhibits 2101, 2102, and 2103 were originally filed in reexaminations of the '366 patent (Exs. 2101 and 2103) and '882 patent (Ex. 2102). They were also submitted during prosecution of the '017 patent.

Exhibit 2101, which deals generally with commercial success, supports "Honeywell[']s] expect[ation] that, between 2012 and 2017, it will have delivered over 20 million pounds of HFO-1234yf to customers." PO Response at 16 (citing Ex. 2126 ¶ 173; Ex. 2101 at 3); *see also* PO Response at 83; Ex. 2126 ¶ 173. Dr.

Bivens relies on this statement to conclude that Honeywell was expected to sell \$1 billion worth of HFO-1234yf in those five years. Ex. 2126 ¶ 173. Exhibit 2102, which also deals with commercial success, is cited to support the statement that “Honeywell’s customers of HFO-1234yf include General Motors and six other major automobile manufacturers.” Ex. 2126 ¶ 173 (citing Ex. 2102). Dr. Bivens was subject to cross-examination on his declaration and Arkema had a chance to question him about his reliance on Exs. 2101 and 2102. They chose not to do so.

Exhibit 2103 discusses miscibility and stability of HFOs with PAGs. It is substantially identical to Exhibit 1057 (introduced by Arkema), a declaration from Dr. Thomas initially filed in the reexamination of U.S. Pat. No. 8,033,120 (“the ‘120 patent”) and submitted during prosecution of the ‘017 patent. Dr. Bivens cites Exhibit 2103 to demonstrate that “HFO-1234yf and PAG lubricants are miscible at all lubricant concentrations below about 25°C.” Ex. 2126 ¶ 184 (citing Ex. 2103 ¶ 20). Paragraph 20 of Exhibit 2103 is substantially identical to paragraph 27 of Exhibit 1057. Dr. DesMarteau also cites Exhibit 2103 simply to explain how Dr. Thomas’ testing was conducted. *See* Ex. 2161 ¶ 55 (citing Ex. 2103 at 6-7); ¶ 58 (citing Ex. 2103 at 7). Pages 6-7 of Exhibit 2103 are substantially identical to paragraphs 28-33 of Exhibit 1057. Dr. Bivens was subject to cross-examination on his declaration and Arkema had a chance to question him about his reliance on Ex. 2103. They chose not to do so.

Table 3 of Exhibit 2103, also in Exhibits 1057 and 1180, reports the results of stability testing of HFO-1234yf with a PAG lubricant. Honeywell did not cite Table 3 of Exhibit 2103, but rather cited Table 3 of Exhibit 1057, which Arkema introduced.¹ Dr. DesMarteau relies on Table 3’s data in Exhibit 1057 for his opinion that HFO-1234yf has “unexpectedly superior stability” with a PAG lubricant compared to other HFOs. Ex. 2161 ¶ 63. Dr. DesMarteau was subject to cross-examination on his declaration and Arkema questioned him extensively about his reliance on Ex. 2103. *See* Ex. 1178 at 57:3-62:21.

Additionally, the information in Table 3 was also the subject of a declaration by Dr. Rajiv Singh submitted during prosecution of the ‘366 patent. *See* Ex. 2165 at 4 (Table 2). During litigation in the Eastern District of Pennsylvania between Arkema and Honeywell, Civ. A. No. 2:10-cv-2886, Arkema deposed Dr. Singh, cross-examining him regarding the data presented in his declaration. Ex. 2166 at 331:2-332:13, 359:21-371:15.

¹ Although Arkema moves to exclude portions of Exhibit 1057, it does not seek to exclude Exhibit 1180—also introduced by Arkema—which contains Table 3 at page 24.

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