

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEXICHEM AMANCO HOLDINGS S.A. DE C.V.
Petitioner,

v.

HONEYWELL INTERNATIONAL, INC.
Patent Owner

Case IPR2015-01309
Patent 8,623,808

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

Patent Owner's Motion to Exclude Exhibits 1039 and 1040 should be granted. The Opposition to Patent Owner's Motion (the "Opposition") submitted by Petitioner Mexichem Amanco Holdings S.A. de C.V. ("Petitioner" or "Mexichem") fails to show the relevance or probative value of Exhibits 1039 and 1040, or that Exhibit 1040 was properly authenticated and is not hearsay.

I. Exhibit 1039 (Podchernjaev – Russian Patent RU 2 0 73 058 C1)

First, Exhibit 1039 is irrelevant and inadmissible under FRE 401-402 because it does not rebut the fact that the industry's perception of unsaturated compounds as being too reactive, toxic, and flammable did not change until after Honeywell's invention of the claimed fluoropropene-carbon dioxide (CO₂) mixtures. Indeed, Mexichem admits that Exhibit 1039 contains no discussion about reactivity, toxicity, or flammability (Opposition, p. 2.).

Mexichem attempts to sidestep this deficiency of Exhibit 1039 by citing to MPEP § 2112(I), which states that the discovery of a new property of an old composition does not render the old composition patentable. Opposition, pp. 2-3. Mexichem's reliance on MPEP § 2112(I), which applies to *anticipating* prior art, fails to support the relevance of Exhibit 1039. *See In re Spormann*, 363 F.2d 444, 448 (C.C.P.A. 1966) ("That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown."); MPEP § 2141.02(V) ("Obviousness cannot be predicated on what is not known at the time an invention

is made, even if the inherency of a certain feature is later established.”) Even assuming, *arguendo*, that certain characteristics are inherent in the composition of Exhibit 1039—something Mexichem has not shown—Exhibit 1039’s silence as to these characteristics does not negate the conventional wisdom that unsaturated compounds were too reactive, toxic, and flammable.

Mexichem’s newly-minted contention that Exhibit 1039 “is relevant as it rebuts Honeywell’s main premise that it ‘discovered’ the claimed tetrafluoropropene compounds, the compounds found in Inagaki,” (Opposition, p. 2) is a red herring as it mischaracterizes Honeywell’s argument. As set forth in page 2 of Patent Owner’s Response, “Honeywell discovered that the claimed fluoropropene-carbon dioxide (CO₂) **mixtures** worked well.” (emphasis added).

Second, in considering FRE 403, Mexichem is unable to show that Exhibit 1039, which is from around the same time period as Inagaki, adds anything more to the record than Inagaki (Exhibit 1002). *See* Opposition, p. 2 (stating that Exhibit 1039 mentions the same compounds found in Inagaki). Mexichem admits that, like Inagaki, Exhibit 1039 never mentions anything about reactivity, toxicity, or flammability. Opposition, p. 2.

Therefore, Exhibit 1039 is irrelevant under FRE 401 and thus inadmissible under FRE 402, or is a waste of time or cumulative under FRE 403.

II. Exhibit 1040 (SNAP Petition)

First, Mexichem has not properly authenticated Exhibit 1040 under FRE 901. Mexichem contends that “the SNAP Petition falls within the purview of FRE 901(b)(4).” Opposition, p. 4. But Mexichem has not established a digital chain of custody showing that the alleged NRDC letter is in fact posted on the NRDC website by the NRDC. Other than providing a URL, Mexichem does not establish the date and time the document was loaded from the NRDC website, the date and time the document was posted on the NRDC website, or even that the submitted letter is an accurate record of the document posted at the URL.

Mexichem, citing to a prior *inter partes* reexamination proceeding, also notes “that the Patent Owner has previously seen Exhibit 1040 and never objected to its authenticity.” Opposition, p. 5. But Mexichem neglects to note that the Federal Rules of Evidence and discovery do not apply to reexamination proceedings. *See Merck & Cie v. Gnosis S.P.A.*, 820 F.3d 432, 435 (Fed. Cir. 2016) (“Once IPR is instituted, unlike in *inter partes* reexaminations, the Board applies the Federal Rules of Evidence . . .”) As such, Patent Owner did not have the opportunity to object to the authenticity of Exhibit 1040 in the earlier proceeding.

Second, Mexichem fails to show that Exhibit 1040 is anything but inadmissible hearsay under FRE 801-802. Mexichem argues that “the SNAP

Petition is allowable under at least FRE 807” – the residual hearsay exception. Opposition, p. 5. Exhibit 1040 does not satisfy the requirements of FRE 807, including the requirement that a statement must be “more probative on the point for which it is offered than any other evidence which the proponent can procure through reasonable efforts.” Mexichem contends: “[t]he manufacturing expense evidence provided in the SNAP Petition is offered to show what a PHOSITA at the time of filing the ‘808 patent would know and take into consideration when determining which refrigerant to use. **This goes to the heart of the argument that Honeywell did not fully consider the state of the art** and surrounding influences when providing its non-obviousness analysis.” Opposition, p. 5 (emphasis added). However, Mexichem neglects to consider that Exhibit 1040 is dated April 27, 2012—*eight years*—after the priority date of the ‘808 Patent. Mexichem fails to show how a document that speculates about production costs of two compounds, eight years after the ‘808 Patent priority date, is more probative than any other evidence about the state of the art, let alone that it “goes to the heart of the argument that Honeywell did not fully consider the state of the art.”

Additionally, Exhibit 1040, which was first raised more than a year since the petition for review was filed and several months since the Board instituted review, was not provided with “reasonable notice” to provide Patent Owner “a fair opportunity to meet it.” FRE 807(b).

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