

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.

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

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

PER CURIAM.

JUDGMENT

Final Written Decision on Remand
35 U.S.C. §§ 144, 328(a)

¹ Because resolution of issues common to both post-grant reviews resolves the outstanding disputes between the parties as to all challenged claims of the patent at issue, we exercise our discretion to issue a single Final Written Decision to be entered in each case.

I. INTRODUCTION

In these post-grant reviews designated PGR2016-00011 (“PGR11”) and PGR2016-00012 (“PGR12”), Arkema Inc. and Arkema France (collectively, “Petitioner”) challenge the patentability of claims 1–20 of U.S. Patent No. 9,157,017 B2 (Ex. 1001², “the ’017 patent”), assigned to Honeywell International Inc. (“Patent Owner”). We have jurisdiction under 35 U.S.C. § 6. For the reasons discussed below, we determine that Petitioner has shown by a preponderance of the evidence that claims 1–20 (“the challenged claims”) are unpatentable. This Final Written Decision is issued pursuant to 35 U.S.C. § 328(a) and 37 C.F.R. § 42.208.

A. Procedural History

Petitioner filed two Corrected Petitions for post-grant review of claims 1–20 of the ’017 patent. PGR11 Paper 3 (“PGR11 Pet.”); PGR12 Paper 7 (“PGR12 Pet.”). On September 2, 2016, pursuant to 35 U.S.C. § 324, we instituted post-grant reviews of claims 1–20 of the ’017 patent on certain grounds of unpatentability alleged in the Petitions. *See* PGR11 Paper 13 (“PGR11 Dec. on Inst.”); PGR12 Paper 13 (“PGR12 Dec. on Inst.”).

After institution, Patent Owner filed Patent Owner Responses. *See* PGR11 Paper 24 (“PGR11 Resp.”); PGR12 Paper 22 (“PGR12 Resp.”). And Petitioner filed Replies. PGR11 Paper 31 (“PGR11 Reply”); PGR12 Paper 27 (“PGR12 Reply”). In PGR11, both parties filed motions to exclude evidence, and the briefing on those motions included oppositions and

² Unless otherwise noted, all exhibits referenced in this Decision were entered into the record in both PGR11 and PGR12. For ease of reference, we refer to the exhibits filed in PGR12 only unless otherwise noted.

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

replies. *See* PGR11 Papers 36, 38, 41, 42, 45, 47, 50, 51, 52. Also in PGR11, Patent Owner filed Observations on Statements in Petitioner’s Reply following Board authorization. PGR11 Paper 40.

The Board held a consolidated oral hearing on June 7, 2017. A transcript has been entered into the record. PGR11 Paper 53; PGR12 Paper 33 (“Tr.”).

After the consolidated oral hearing, we issued our Final Written Decisions which held claims 1–20 of the ’017 patent unpatentable. PGR11 Paper 54; PGR12 Paper 34 (“first Final Decision”). Patent Owner filed a Notice of Appeal of the first Final Decision with the Court of Appeals for the Federal Circuit. PGR11 Paper 55; PGR12 Paper 35. In that Notice of Appeal, Patent Owner indicated that the issues on appeal may include, *inter alia*, “[w]hether the Board’s denial of Honeywell’s November 28, 2016 request for authorization to file a motion seeking permission to file a Certificate of Correction to correct the series of applications in the ’017 patent’s priority chain was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law.” PGR11 Paper 55, 2; PGR12 Paper 35, 2.

On October 1, 2019, the Federal Circuit held that we “abused [our] discretion by assuming the authority that 35 U.S.C. § 255 expressly delegates to the Director: to determine when a Certificate of Correction is appropriate,” and vacated our Final Written Decision. *Honeywell Int’l Inc. v. Arkema Inc.*, 939 F.3d 1345 (Fed. Cir. 2019). 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.

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

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. PGR11 Paper 61; PGR12 Paper 41. After additional briefing from the parties was complete, we granted Patent Owner’s Motion. PGR11 Paper 77; PGR12 Paper 57. 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. PGR11 Ex. 2174; PGR12 Ex. 2172.

On February 15, 2022, the Petitions Branch of the Office entered its Decision, dismissing Patent Owner’s Petition. PGR11 Ex. 3006; PGR12 Ex. 3006 (“Dismissal”). On March 15, 2022, Patent Owner subsequently filed another Petition under 37 C.F.R. § 1.182 to Hold the Final Written Decision in Abeyance Pending Patent Owner’s Petition under 37 C.F.R. § 1.181 requesting reconsideration of the Petition’s Office Dismissal. PGR11 Ex. 2175; PGR12 Ex. 2175. On May 26, 2022, the Petitions Branch dismissed that further Petition. PGR11 Ex. 3008; PGR12 Ex. 3008. On July 2, 2022, Patent Owner filed a “Second Renewed Petition for Reconsideration of Decision Denying Petition for Certificate of Correction.” Ex. 3009. That Petition was dismissed on August 25, 2022. Ex. 3010.

As a result, the ’017 patent’s claim to priority is the same as when our first Final Decision issued.

B. Related Matters

Petitioner filed a Corrected Petition for *inter partes* review of the ’017 patent on February 26, 2016. The Board denied institution on the grounds presented in that Petition. *Arkema Inc. v. Honeywell Int’l Inc.*, Case

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

IPR2016-00643 (PTAB Sept. 2, 2016) (Paper 11). In addition, both parties identify several proceedings in the United States and in the United States Patent and Trademark Office (“Office”) involving the ’017 patent and patents related to the ’017 patent, as well as several proceedings in other countries involving foreign counterparts to the ’017 patent and its related patents. PGR11 Pet. 3–7; PGR12 Pet. 2–3; PGR11 Paper 11, 1–4; PGR12 Paper 11, 1–4.

C. The ’017 Patent

The ’017 patent, titled “Compositions Containing Fluorine Substituted Olefins and Methods and Systems Using Same,” is directed to “the use of fluorine substituted olefins, including tetra- and penta-fluoropropenes, in a variety of applications.” Ex. 1001 (Abstract). Those applications, according to the ’017 patent, include “methods of depositing catalyst on a solid support, methods of sterilizing articles, cleaning methods and compositions, methods of applying medicaments, fire extinguishing/suppression compositions and methods, flavor formulations, fragrance formulations, and inflating agents.” *Id.* The written description of the ’017 patent states that a preferred use of the disclosed fluorine substituted olefins is in “refrigeration systems, and [in] methods and systems utilizing such compositions.” *Id.* at 1:30–32.

The ’017 patent explains that “[c]oncern has increased in recent years about potential damage to the earth’s atmosphere and climate” from “certain chlorine-based compounds” such as chlorofluorocarbons (CFCs) and hydrochlorofluorocarbons (HCFCs). *Id.* at 2:1–6. The ’017 patent states that these compounds are widely used in air-conditioning and refrigeration

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.