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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VALEO NORTH AMERICA, INC. and VALEO EMBRAYAGES,

Petitioner,
v.

SCHAEFFLER TECHNOLOGIES AG & CO. KG,

Patent Owner.

Case: IPR2017-00442
Patent 8,573,374 B2

PATENT OWNER'S PRELIMINARY RESPONSE

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I. Introduction

Pursuant to 35 U.S.C. §313 and 37 C.F.R. §42.107, Schaeffler Technologies AG & Co. KG ("Patent Owner"), submits the following Patent Owner's Preliminary Response in response to a Petition for *inter partes* review filed by Valeo North America, Inc. and Valeo Embrayages ("Petitioner") concerning claims 1, 3-5, 8, 10 and 14-16 of U.S. Patent No. 8,573,374 ("the '374 patent") (Ex. 1101).

Petitioner asserts two grounds of unpatentability: that claims 1, 3-5, 8, 10 and 14-16 are anticipated under 35 U.S.C. §102(a) by Degler International application, PCT Pub No. WO 2009/06798 (Ex. 1103) ("the Degler publication"); and that claims 1, 3-5, 8, 10 and 14-16 are anticipated under 35 U.S.C. §102(a) by W. Reik, The Centrifugal Pendulum Absorber Calming Down the Drivetrain ("Reik publication") (Ex. 1106/Ex. 1105).

The '374 patent names Magerkurth, Huegel, and Meissner as inventors (and applicants), is a 371 National Phase of PCT/DE2009/000819, and claims priority under 35 U.S.C. §119 to DE 10 2008 031 431 having a priority date of July 4, 2008 and DE 10 2008 037 808 having a priority date of August 14, 2008. (Ex. 1101) (the '374 Priority Applications).

Petitioner's sole basis for alleging that the Degler and Reik publications are prior art to the '374 patent is its allegation that neither of the '374 Priority Applications is the "first filed" application under 35 U.S.C. § 119 (a, c), and accordingly, the '374 patent is not

entitled to any priority under 35 U.S.C. § 119.

In particular, Petitioner contends that DE 10 2007 057 448.9, which names Degler, Krause, Schenck, Werner, and Englemann as inventors ("the Degler Priority Application") (Ex. 1104), and which was filed earlier than the '374 Priority Applications, qualifies as the "first filed" application under 35 U.S.C. § 119 (a, c), and that accordingly, under 35 U.S.C. §119 (c), the '374 patent is not entitled to rely on any priority under 35 U.S.C. §119.

Petitioner ignores the express language of 35 U.S.C. §119 and the controlling precedent in alleging that the Degler Priority Application, *which shares no common inventors* with the '374 patent, could have been the "first filed" application under 35 U.S.C. §119.

The law is clear. In order for a foreign-filed patent application to serve as the basis for a priority claim under 35 U.S.C. §119, the foreign-filed application must have been filed by or on behalf of one or more of the inventors of the U.S. patent application. As the Federal Circuit has explained, citing *Vogel v. Jones*, 486 F.2d 1068 (CCPA 1973) as binding authority:

> "§119 gives rise to a right of priority that is personal to the United States applicant."
>
> ***
>
> *Vogel* clearly held that the above-quoted passage "means that an applicant for a United States patent can rely for priority on the 'first filed' application by an assignee *on his behalf*." *Id.* Moreover, "the existence of an application made

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