IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Valeo North America, Inc. and Valeo Embrayages,
Petitioners,

v.

Schaeffler Technologies AG & Co. KG,
Patent Owner.

Case IPR2017-00442

U.S. Patent No. 8,573,374

REPLY TO PATENT OWNER PRELIMINARY RESPONSE

There is no case law holding that the requirements of § 119(a) are equally applicable to § 119(c). Rather, § 119(c) is a standalone provision that should be evaluated independently.

Regardless, even for § 119(a), there is no case law firmly requiring a common inventor among the applications. Instead, *Bos. Sci. Scimed, Inc. v. Medtronic Vascular, Inc.* holds that a nexus between the inventor and the foreign applicant is sufficient to award priority under § 119(a).

Thus, irrespective of the applicability of § 119(a), the '374 patent should not be entitled to the benefit of priority under § 119(c).

A. Sections 119(a) and 119(c) are standalone provisions.

None of the cases cited by Patent Owner unambiguously holds that the requirements of § 119(a) are applicable to § 119(c). These are standalone provisions. Section 119(a) discusses the *benefit* of priority for foreign applications filed within a 12-month window. Section 119(c) serves as a *bar* to priority, and is not subject to a 12-month limit as described in § 119(a). Because § 119(c) has no 12-month limitation, the "first filed" application referred to in § 119(a) *cannot* be the "first filed" application of § 119(c). Thus, any requirements for

the first-filed application in § 119(a) cannot be automatically extended to § 119(c). The MPEP supports this independent interpretation. *See* MPEP §§ 213.02.II (common inventor discussed specifically with regard to § 119(a)) and 213.03.II (explanation of § 119(c) with no mention of common inventor).

B. The case law does not mandate a common inventorship requirement for either § 119(a) or § 119(c).

Regardless, Patent Owner overstated its position. There is no firm requirement for § 119(a)—and thus § 119(c), based on Patent Owner's position—that the applications share one common inventor. *Scimed* addressed a specific situation where an inventor attempted to claim priority to two European patent applications filed by a company at a time where there was no legal relationship between the company and the inventor. 497 F.3d 1293, 1296 (Fed. Cir. 2007). In holding that this was impermissible, the Court made it clear that the foreign application "may be filed by someone other than the inventor" provided that a "nexus exist between the inventor and the foreign applicant at the time the foreign application was filed." *Id.* at 1297. Here, the inventors of the '374 patent *were* Patent Owner's employees when the Degler priority document was filed, and thus there is a

nexus between the inventor and the foreign applicant. In fact, *Scimed* goes on to state that "an applicant for a United States patent can rely on priority on the 'first filed' application by an assignee on his behalf" without specifying that common inventorship is a requirement. Similarly, the Board has observed that "the proposition that the inventive entity must be the same in both the foreign and the corresponding U.S. application in order to obtain benefit can no longer be accepted, if it ever was, as a hard and fast rule in view of the liberalization of the requirements for filing a U.S. application … wrought by the 1984 amendment of 35 U.S.C. § 116." *Reitz v. Inoue*, 39 USPQ2d 1838, 1840 (BPAI 1995). As such, pre-1984 cases such as *Vogel v. Jones* cited by Patent Owner or *Olson v. Julia* (209 USPQ 159 (BPAI 1979)) are outdated and not controlling. Therefore, a first-filed application by the assignee can serve as a bar to an applicant for a United States applicant even if the applications do not have common inventorship, as is the case here. Applying *Scimed* to the '374 patent means that the '374 patent could claim priority only to subject matter that was *not* disclosed and used as a basis for priority in Degler.

Respectfully submitted,

Dated: April 26, 2017

/s/ Robert C. Mattson

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