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2 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

3 _____
4 BEFORE THE PATENT TRIAL AND APPEAL BOARD
5 _____

6 Valeo North America, Inc. and Valeo

7 Embrayages

8 Petitioner,

9 v.

10 Schaeffler Technologies AG & Co. KG

11 Patent Owner.

12 _____
13 Case IPR2017-00442

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

15 _____
16 TELEPHONE CONFERENCE

17 April 19, 2017
18 _____

19 B E F O R E : JOSIAH COCKS, ESQ.

20 MICHAEL KIM, ESQ.

21 JAMES MAYBERRY, ESQ.
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24 Reported by: MARY F. BOWMAN, RPR, CRR

25 Job No: 122641

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April 19, 2017
11:00 a.m.

Telephone conference, held before
Mary F. Bowman, a Registered Professional
Reporter, Certified Realtime Reporter, and
Notary Public of the State of New Jersey.

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APPEARANCES:

On Behalf of Petitioners Valeo North America,
Inc. and Valeo Embrayages:

OBLON McCLELLAND MAIER & NEUSTADT

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On Behalf of Patent Owner Schaeffler
Technologies AG & Co.:

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BY: CARY KAPPEL, ESQ.

DAVID PETROFF, ESQ.

1 Proceedings - 4/19/17

2 (Conference commences)

3 JUDGE COCKS: Do we have counsel
4 for petitioner on the call?

5 MS. MANDRUSIAK: Yes, Lisa
6 Mandrusiak from Oblon representing
7 petitioner.

8 JUDGE COCKS: And do we have
9 counsel for patent owner?

10 MR. KAPPEL: Yes, Cary Kappel and
11 David Petroff for patent owner.

12 JUDGE COCKS: Thank you.
13 Who arranged for the court
14 reporter?

15 MS. MANDRUSIAK: Petitioner did.

16 JUDGE COCKS: All right, if you
17 would file a transcript of the call as
18 an exhibit when it becomes available.

19 MS. MANDRUSIAK: Yes, we will.

20 JUDGE COCKS: Mrs. Mandrusiak, I
21 believe you requested the call. Why
22 don't you fill us in, what you are
23 seeking.

24 MS. MANDRUSIAK: Thank you.
25 Petitioner is requesting leave to file

1 Proceedings - 4/19/17

2 a short reply to the patent owner's
3 preliminary response under 37 CFR
4 42.108(c).

5 I understand the canon of good
6 cause and good cause exists here to
7 allow a short directed reply because
8 patent owner has raised a legal
9 argument of first impression that could
10 not have been foreseen.

11 So to give a bit of background,
12 this petition is based on a 119(c) bar
13 to priority. Not to the propriety of
14 claiming priority under Section 119(a).

15 Section 119(c) is intended to
16 mirror Article 4-D-4 of the Paris
17 convention and it is intended to
18 prevent situations, exactly what we
19 have here, where Degler, a PTT
20 application filed by the patent owner,
21 was published eight days before the PTT
22 filing date of 374F patent, which is
23 the subject of this petition.

24 But because Degler's priority
25 document was the basis of Degler's

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