

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
Alexandria Division**

SMITHKLINE BEECHAM,)
CORPORATION,)
d/b/a GLAXOSMITHKLINE,)
SMITHKLINE BEECHAM PLC, and)
GLAXO GROUP LIMITED, d/b/a)
GLAXOSMITHKLINE,)
)
)
Plaintiffs,)
)
)
v.)
)
JON W. DUDAS, in his official capacity as)
Under-Secretary of Commerce for)
Intellectual Property and Director of the)
United States Patent and)
Trademark Office, and)
)
)
UNITED STATES PATENT AND)
TRADEMARK OFFICE,)
)
)
Defendants.)
)
_____)

CIVIL ACTION NO. 1:07cv1008 (JCC/TRJ)

DECLARATION OF JOHN L. LEGUYADER

I, John L. LeGuyader, make the following declaration based upon my personal knowledge of the facts set forth herein. I hereby testify and declare the following:

1. I hold the position of Group Director in Technology Center 1600 of the U.S. Patent and Trademark Office (“USPTO”). I have held this position since March 2006. Technology Center (“TC”) 1600 is one of eight major divisions of the examination corps. TC 1600 employs approximately 570 patent examiners and is focused on the examination of applications related to biotechnology and organic chemistry.

2. As a Group Director, I exercise administrative and technical authority over patent examination. I am responsible for the comprehensive planning and management functions

essential to effective patent examining group operations. I recommend or initiate programs and procedures to implement official policies, and assist in the development of, and maintenance of, quality, timeliness, and quantity performance standards. I perform related duties, which include adjudicating petitions for the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office. I also perform staff functions related to human resource management and manpower utilization, training and career development, patent examining practice and procedures, support for automation affecting the Technology Center, and classification and documentation of the technical arts.

3. I was previously employed by the USPTO as an Executive Assistant to the Office of the Commissioner for Patents (March 2005 to March 2006), a Supervisory Patent Examiner (December 1999 to March 2005), and a Patent Examiner (December 1990 to December 1999). In total, I have been employed by the USPTO for seventeen years.

4. I reviewed U.S. Patent No. 7,235,551 and its complete file history. I also reviewed all applications claiming the benefit of U.S. Patent No. 7,235,551 and their entire file histories. These applications were/are under examination in TC 1600, in particular, TC 1624.

5. On March 2, 2000, Plaintiffs filed a provisional patent application (No. 60/186,429) in the USPTO (“Provisional Application”).¹

¹ A “provisional application” is a type of patent application filed in the USPTO that is not examined by the USPTO and will be automatically treated as abandoned after twelve months from filing. 35 U.S.C. § 111(b); 37 C.F.R. § 1.53(c); U.S. Pat. & Trademark Off., Manual of Patent Examining Procedure (“MPEP”) § 201.04(b) (8th ed. 2001, rev. Aug. 2006). A provisional application has a specification, but is not required to include claims. *Id.* An applicant typically uses a provisional patent application to establish an early filing date for an invention by filing a nonprovisional application or an international application claiming the benefit of the filing date of the provisional application.

6. One year later, on March 2, 2001, Plaintiff filed an international application (No. WO 01/64679) (“International Application”), claiming the benefit of the filing date of the Provisional Application.²

7. On August 28, 2002, Plaintiffs’ International Application entered the United States under 35 U.S.C. § 371 as U.S. Application No. 10/220,103 (“Parent Application”).³ The Parent Application is entitled “1,5-Disubstituted-3,4-Dihydro-1H-Pyrimido[4,5-D]Pyrimidin-2-One Compounds And Their Use In Treating CSBP/P38 Kinase Mediated Diseases.” The Parent Application claimed the benefit of the filing date of the Provisional Application.

8. During the prosecution of the Parent Application, Plaintiffs filed a single request for continued examination pursuant to 35 U.S.C. § 132(b).

9. On June 26, 2007, the USPTO issued Plaintiffs’ Parent Application as U.S. Patent No. 7,235,551.

10. On December 20, 2006, Plaintiffs filed a first continuation application (No. 11/613,517) of its Parent Application (“Continuation Application 1”), claiming the benefit of the filing dates of the Parent Application and the Provisional Application. Like the Parent Application, Continuation Application 1 is entitled “1,5-Disubstituted-3,4-Dihydro-1H-

² An “international application” is a type of patent application filed pursuant to the Patent Cooperation Treaty (“PCT”). 35 U.S.C. § 351. The PCT offers an alternative route to filing patent applications directly in the patent offices of those countries which are Contracting States to the PCT. MPEP § 1801.

³ An “international application” cannot be granted as “international patent.” Instead, after proceedings at the international level, the applicant may enter the “national stage” and have the “international application” recognized as a national patent application in as many Contracting States to the PCT as the applicant designates. 35 U.S.C. § 371. Once an “international application” enters the national stage, it is referred to as a “national application” and subject to examination under the patent law and rules of the Contracting State. 37 C.F.R. § 1.9; MPEP §§ 1801, 1893.

Pyrimido[4,5-D]Pyrimidin-2-One Compounds And Their Use In Treating CSBP/P38 Kinase Mediated Diseases.”

11. On October 11, 2007, Plaintiffs’ Continuation Application 1 published pursuant to 35 U.S.C. § 122(b)(1).

12. Plaintiffs’ Continuation Application 1, as presently pending, contains one independent claim and twenty-four total claims.

13. Plaintiffs’ Continuation Application 1 is currently awaiting a first Office action on the merits and/or a restriction requirement pursuant to 35 U.S.C. § 121.

14. On December 20, 2006, Plaintiffs also filed a second continuation application (No. 11/613,598) of its Parent Application (“Continuation Application 2”), claiming the benefit of the filing dates of the Parent Application and the Provisional Application. Continuation Application 2 has the same title as the Parent Application and Continuation Application 1, namely, “1,5-Disubstituted-3,4-Dihydro-1H-Pyrimido[4,5-D]Pyrimidin-2-One Compounds And Their Use In Treating CSBP/P38 Kinase Mediated Diseases.”

15. On July 19, 2007, Plaintiffs’ Continuation Application 2 published pursuant to 35 U.S.C. § 122(b)(1).

16. Plaintiffs’ Continuation Application 2, as presently pending, contains two independent claims and twenty-three total claims.

17. Plaintiffs’ Continuation Application 2 is currently awaiting a first Office action on the merits and/or a restriction requirement pursuant to 35 U.S.C. § 121.

18. On October 11, 2007, Plaintiffs filed a third continuation application (No. 11/871,039) of its Parent Application (“Continuation Application 3”), claiming the benefit of the filing dates of Continuation Application 1, the Parent Application, and the Provisional

Application. Continuation Application 3, like the Parent Application, Continuation Application 1, and Continuation Application 2, is entitled “1,5-Disubstituted-3,4-Dihydro-1H-Pyrimido[4,5-D]Pyrimidin-2-One Compounds And Their Use In Treating CSBP/P38 Kinase Mediated Diseases.”

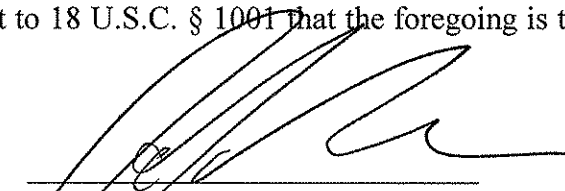
19. Plaintiffs’ Continuation Application 3 has not yet published, but will publish as soon as practical after eighteen months from the filing date of the Provisional Application pursuant to 35 U.S.C. § 122(b)(1).

20. Plaintiffs’ Continuation Application 3, as presently pending, contains two independent claims and twenty-five total claims.

21. Plaintiffs’ Continuation Application 3 is currently awaiting a first Office action on the merits and/or a restriction requirement pursuant to 35 U.S.C. § 121.

22. For an application being examined in TC 1624, the average time from the filing of the application to a first Office action on the merits in the application is 21.3 months based upon data compiled at the end of fiscal year 2007. The average time from the filing of the application to the issuance or abandonment of the application being examined in TC 1624 is 32.8 months, also based upon data compiled at the end of fiscal year 2007.

I declare under penalty of perjury pursuant to 18 U.S.C. § 1001 that the foregoing is true and correct.



John L. LeGuyader
10/26/07

Date