

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

TRIANAFYLLOS TAFAS,

Plaintiff,

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 the UNITED STATES PATENT AND TRADEMARK OFFICE,

Defendants.

**CIVIL ACTION: 1:07cv846 (JCC/TRJ)
and Consolidated Case (below)**

SMITHKLINE BEECHAM CORPORATION,

Plaintiff,

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 the UNITED STATES PATENT AND TRADEMARK OFFICE,

Defendants.

**PLAINTIFF TRIANAFYLLOS TAFAS’
MOTION FOR SUMMARY JUDGMENT**

The Plaintiff, Dr. Triantafyllos Tafas (“Tafas”), by and through his undersigned attorneys, KELLEY DRYE & WARREN LLP, and pursuant to Rule 56 of the Federal Rules of Civil Procedure and Local Rule 56, hereby moves for summary judgment on all claims in his First Amended Complaint dated September 7, 2007 (the “Amended Complaint”).

As set forth more particularly in Tafas’ supporting memorandum of law, Tafas’ supporting Declaration and the Declarations of Robert Fenili, Ph.D and Michael Rueda, Esq.,

being filed along herewith, and based on the administrative record¹ proffered by Defendant United States Patent and Trademark Office (“USPTO”), there are no genuine issues as to any material fact and Tafas is entitled to judgment as a matter of law.

More particularly, this action is brought for declaratory judgment pursuant to 28 U.S.C. § 2201 *et seq.*, and for judicial review under the Administrative Procedure Act (“APA”), 5 U.S.C. § 706, and the Regulatory Flexibility Act (“RFA”), 5 U.S.C. § 611. Tafas seeks the entry of summary judgment, *inter alia*, to: (1) permanently enjoin Defendants from implementing sections 1.75, 1.78, 1.104, 1.105, 1.110, 1.114, 1.142, 1.265 and 1.704 of certain new federal regulations promulgated by the USPTO, with an effective date of November 1, 2007, which were published at 72 Fed. Reg. 46716, 46835-43 (Aug. 21, 2007) and are to be codified at 37 C.F.R. Part 1 (the “Revised Rules”); (2) declaring the Revised Rules, *in toto*, null, void and without legal effect, *inter alia*, as being beyond the rule making power of the USPTO and as inconsistent with various federal statutes and the United States Constitution, including Article I, Section 8, Cl. 8 and the Fifth Amendment; and, (3) vacating and remanding the Revised Rules, including requiring Defendants to comply with the requirements of the APA, 5 U.S.C. § 553, and the RFA, 5 U.S.C. § 601 *et seq.*, in promulgating any regulations in the future concerning the subject matter of the Revised Rules.

As set forth more specifically in Tafas’ memorandum of law, the Revised Rules should be permanently enjoined and declared null and void, among other reasons, because they: (1) violate and conflict, in whole or in part, with Sections 2, 41, 101, 102, 111, 112, 120, 121, 122, 131, 132, and 151 of the Patent Act (35 U.S.C. § 1 *et seq.*) and Sections 200-203 of the

¹ Tafas has challenged the sufficiency and completeness of the USPTO’s administrative record and Tafas’ Objection to Magistrate Thomas Rawles Jones, Jr. Order denying discovery is still *sub-judice* with the Court. In the event that the Court should subsequently overrule Magistrate Jones and permit discovery, Tafas reserves the right to move to supplement his present summary judgment motion.

Bayh-Dole Act (35 U.S.C. § 200 *et seq.*), and exceed the USPTO’s rule making authority delegated by Congress and under the U.S. Constitution; (2) violate and conflict with Sections 553(b)-(c) and 706(2) of the APA (5 U.S.C. §§ 553(b)-(c) and 706(2)), among other ways, because the USPTO purported to enact rules with retroactive effect; denied the public of its right to be informed of and meaningfully comment on “the terms or substance of the proposed rule”; by promulgating rules that are arbitrary, capricious, an abuse of discretion, otherwise not in accordance with law, contrary to Plaintiff’s constitutional rights and in excess of the USPTO’s statutory jurisdiction and authority; and (3) violate and conflict with the RFA, 5 U.S.C. §§ 601-612, because the USPTO erroneously certified under RFA Section 605(b) that the Revised Rules would not have a significant impact on a substantial number of small businesses and, as such, failed to prepare a Final Regulatory Flexibility Analysis in contravention of RFA Section 604.

CONCLUSION

WHEREFORE, for all the foregoing reasons, as well as those set forth in Tafas’ supporting memorandum of law and Declaration, and the Declarations of Robert Fenili, Ph.D and Michael Rueda, Esq., Plaintiff Tafas respectfully moves the Court to grant Tafas summary judgment in his favor, and to enter the proposed form of Order being submitted along herewith as follows, along with such other, further and different relief as the Court deems just, equitable and proper:

Respectfully submitted,

/s/ Joanna Baden-Mayer
Joanna Baden-Mayer (VSB # 67920)
Joseph D. Wilson (VSB # 43693)
Steven J. Moore, Esq. (*pro hac vice*)
James E. Nealon, Esq. (*pro hac vice*)
KELLEY DRYE & WARREN LLP
Washington Harbor, Suite 400
3050 K Street, NW

Washington, DC 20007
Telephone: (202) 342-8400
Facsimile: (202) 342-8451
E-mail: jwilson@kelleydrye.com
jbaden-mayer@kelleydrye.com
jnealon@kelleydrye.com
smoore@kelleydrye.com

Counsel for Plaintiff Triantafyllos Tafas

Of Counsel:

William R. Golden Jr., Esq.
KELLEY DRYE & WARREN LLP
101 Park Avenue
New York, New York 10178-0002
Telephone: (212) 808-7992
Facsimile: (212) 808-7897
E-mail: wgolden@kelleydrye.com

-- and ---

Shaun Gehan, Esq.
David Frulla, Esq.
KELLEY DRYE & WARREN LLP
Washington Harbor, Suite 400
3050 K Street, NW
Washington, DC 20007
Telephone: (202) 342-8400
Facsimile: (202) 342-8451
Email: sgehan@kelleydrye.com
dfrulla@kelleydrye.com

Dated: December 20, 2007

CERTIFICATE OF SERVICE

I hereby certify that on December 20, 2007, I electronically filed the foregoing with the Clerk of the Court using the CM/ECF system, which will send a notification of such filing (NEF) to the following:

Elizabeth Marie Locke
Kirkland & Ellis LLP
655 15th Street, NW
Suite 1200
Washington, DC 20005
Email: elocke@kirkland.com

Craig Crandell Reilly
Richard McGettingan Reilly & West PC
1725 Duke Street
Suite 600
Alexandria, VA 22314
Email: craig.reilly@rmrwlaw.com

Daniel Sean Trainor
Kirkland & Ellis LLP
655 15th Street, NW
Suite 1200
Washington, DC 20005
Email: dtrainor@kirkland.com

*Counsel for Plaintiffs SmithKline Beecham Corp.
d/b/a GlaxoSmithKline, SmithKline Beecham PLC,
and Glaxo Group Limited, d/b/a GlaxoSmithKline*

Thomas J. O'Brien
Morgan, Lewis & Bockius
1111 Pennsylvania Avenue, NW
Washington, DC 20004
Email: to'brien@morganlewis.com

*Counsel for Putative Amicus American Intellectual
Property Lawyers Association*

Dawn-Marie Bey
Kilpatrick Stockton LLP
700 13th Street NW
Suite 800
Washington, DC 20005
Email: dbey@kslaw.com

*Counsel for Putative Amicus Hexas, LLC, The
Roskamp Institute, Tikvah Therapeutics, Inc.*

James Murphy Dowd
Wilmer Cutler Pickering Hale & Dorr LLP
1455 Pennsylvania Avenue NW
Washington, DC 20004
Email: james.dowd@wilmerhale.com

*Counsel for Putative Amicus Pharmaceutical
Research and Manufacturers of America*

Randall Karl Miller
Arnold & Porter LLP
1600 Tysons Blvd
Suite 900
McLean, VA 22102
Email: randall_miller@aporter.com

*Counsel for Putative Amicus Biotechnology
Industry Organization*

Rebecca M. Carr
Pillsbury Winthrop Shaw Pittman, LLP
2300 N Street, NW
Washington, DC 20037
Email: Rebecca.carr@pillsburylaw.com

Scott J. Pivnick
Pillsbury Winthrop Shaw Pittman
1650 Tysons Boulevard
McLean, Virginia 22102-4856
Email: Scott.pivnick@pillsburylaw.com

*Counsel for Putative Amicus Elan
Pharmaceuticals, Inc.*

Robert E. Scully Jr.
Stites & Harbison PLLC
1199 North Fairfax Street, Suite 900
Alexandria, Virginia 22314
(703) 739-4900
Fax: (703) 739-9577
Email: rscully@stites.com

*Counsel for Putative Amicus Curiae Human
Genome Sciences, Inc.*

Matthew Schruers
Computer & Communications
Industry Association
900 17th Street, NW, Suite 1100
Washington, DC 20006
Tel.: (202) 7830070
Fax: (202) 7830534
Email: <mailto:mschruers@ccianet.org>
mschruers@ccianet.org

*Counsel for Putative Amici Curiae Public Patent
Foundation, Computer & Communications
Industry Association, AARP, Consumer Federation
of America, Essential Action, Foundation for
Taxpayer and Consumer Rights, Initiative for
Medicines, Access & Knowledge, Knowledge
Ecology International, Prescription Access
Litigation, Public Knowledge, Research on
Innovation, and Software Freedom Law Center*

Charles Gorenstein
Michael K. Mutter
Birch, Stewart, Kolasch and Birch, LLP
8110 Gatehouse Rd., Suite 100 East
Falls Church, Virginia 22042
Email: cg@bskb.com

*Counsel for Putative Amicus Intellectual Property
Institute of the William Mitchell College of Law*

Lauren A. Wetzler
Assistant United States Attorney
Justin W. Williams U.S. Attorney's Building
2100 Jamieson Avenue
Alexandria, Virginia 22134
Tel: (703) 299-3752
Fax: (703) 299-3983
Email: Lauren.Wetzler@usdoj.gov

Counsel for All Defendants

/s/ Joanna Baden-Mayer
Joanna Baden-Mayer (VSB # 67920)
KELLEY DRYE & WARREN LLP
Washington Harbor, Suite 400
3050 K Street, NW
Washington, DC 20007
Telephone: (202) 342-8400
Facsimile: (202) 342-8451
E-mail: jbaden-mayer@kelleydrye.com

Counsel for Plaintiff Triantafyllos Tafas