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COVINGTON & BURLING, LLP
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EXAMINER

RAILEY, JOHNNY F

ART UNIT PAPER NUMBER

3991

MAIL DATE DELIVERY MODE

06/16/2016

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/013,709.

PATENT NO. RE38551 ET AL..

ART UNIT 3991.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

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DETAILED ACTION

Notice of Pre-AIA or AIA Status

The present application is being examined under the pre-AIA first to invent provisions.

Procedural Posture

The Third Party Request filed on 29 April 2016 for *ex parte* reexamination of claims 1-13 of United States Reissued Patent No. RE38,551 E to Kohn is acknowledged. The current Request has been assigned Control No. 90/013,709.

Decision Granting *Ex Parte* Reexamination

A substantial new question of patentability (SNQ) affecting claims 1-13 of United States Reissued Patent No. RE38,551 E is raised by the request for reexamination.

Status of Claims

Claims 1-13 of United States Reissued Patent No. RE38,551 E are currently subject to reexamination proceedings hereinbelow.

Priority

The application Serial No. 10/058,634 that issued as United States Reissued Patent No. RE38,551 E was filed on 28 January 2002 and is a reissue of United States Patent 5,773,475, issued on 30 June 1998 from application Serial No. 08/818,688, filed on 17 March 1997. Application Serial No. 08/818,688 claims benefit of provisional U.S. Application Serial No. 60/013,522, filed on 15 March 1996.

Information Disclosure Statement

The Information Disclosure Statement (Substitute for Form 1449/PTO) filed on 25 March 2016 has been considered.

Substantial New Question of Patentability (SNQ) Raised By the Request

For "a substantial new question of patentability" to be present, it is only necessary that:

- A. The prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim i.e. the prior art teaching is such that there is a substantial likelihood that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and it is not necessary that the prior art establish a prima facie case of unpatentability and;

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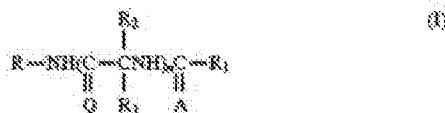
Discussion of Documents Cited in the *Ex Parte* Reexamination Request

The Requester considers that a substantial new question of patentability of claims 1-13 of the United States Reissued Patent No. RE38,551 E is raised by the combined teachings of The '301 Patent, The '729 Patent, Kohn 1991, and LeGall.

The teachings of **The '301 Patent**, **The '729 Patent**, **Kohn 1991**, and **LeGall** are discussed in the request at pages 37-66. The '301 Patent, The '729 Patent, and Kohn 1991 were each cited during the prosecution of the United States Reissued Patent No. RE38,551 E but were not applied in a ground of rejection. LeGall was not cited during that prosecution. Thus, the SNQ cited by the third party requester is not solely based upon previously considered prior art.

The '301 Patent discloses amino acid derivative anticonvulsant compounds, compositions and methods of treating CNS disorders using these compounds. Claim 39 recites a general formula and claims 40-47 recite specific designations as follows:

39. A compound of the formula



or the pharmaceutically acceptable salts thereof wherein

R is aryl, aryl lower alkyl, heterocyclic, heterocyclic lower alkyl, cycloalkyl or lower cycloalkyl lower alkyl, wherein R is unsubstituted or is substituted with at least one electron withdrawing group or an electron donating group;

R₂ is hydrogen or lower alkyl and R₃ is unsubstituted or substituted with at least one electron withdrawing group or at least one electron donating group;

A and Q are both O;

one of R₂ and R₃ is hydrogen and the other is lower alkyl which is substituted with an electron donating group or a electron withdrawing group and n is 1-4.

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