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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
90/013,709 04/29/2016 RE38551 34323-001 ReExam 7135

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COVINGTON & BURLING, LLP
Attn: Patent Docketing
One CityCenter
850 Tenth Street, NW
Washington, DC 20001-4956

EXAMINER

RAILEY, JOHNNY F

ART UNIT PAPER NUMBER

3991

MAIL DATE DELIVERY MODE

12/05/2016

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 E.

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)).

Office Action in Ex Parte Reexamination	Control No. 90/013,709	Patent Under Reexamination RE38551 ET AL.	
	Examiner JOHNNY F. RAILEY II	Art Unit 3991	AIA (First Inventor to File) Status No

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

- a. Responsive to the communication(s) filed on _____.
 A declaration(s)/affidavit(s) under 37 CFR 1.130(b) was/were filed on _____.
- b. This action is made FINAL.
- c. A statement under 37 CFR 1.530 has not been received from the patent owner.

A shortened statutory period for response to this action is set to expire TWO month(s) from the mailing date of this letter. Failure to respond within the period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c)**. If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892. 3. Interview Summary, PTO-474.
2. Information Disclosure Statement, PTO/SB/08. 4. _____.

Part II SUMMARY OF ACTION

- 1a. Claims 1-13 are subject to reexamination.
1b. Claims _____ are not subject to reexamination.
2. Claims _____ have been canceled in the present reexamination proceeding.
3. Claims _____ are patentable and/or confirmed.
4. Claims 1-13 are rejected.
5. Claims _____ are objected to.
6. The drawings, filed on _____ are acceptable.
7. The proposed drawing correction, filed on _____ has been (7a) approved (7b) disapproved.
8. Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some* c) None of the certified copies have

- 1 been received.
2 not been received.
3 been filed in Application No. _____ .
4 been filed in reexamination Control No. _____ .
5 been received by the International Bureau in PCT application No. _____ .

* See the attached detailed Office action for a list of the certified copies not received.

9. Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.
10. Other: _____

Art Unit: 3991

***Ex Parte* Reexamination
Non-Final Detailed Action**

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

Procedural Posture

1. The Third Party Request was filed on 29 April 2016 for *ex parte* reexamination of claims 1-13 of United States Reissued Patent No. RE38,551 E to Kohn.
2. An Order granting the *ex parte* reexamination of claims 1-13 was mailed on 16 June 2016.
3. The Patent Owner did not file a Patent Owner's Statement under 37 C.F.R. 1.530.

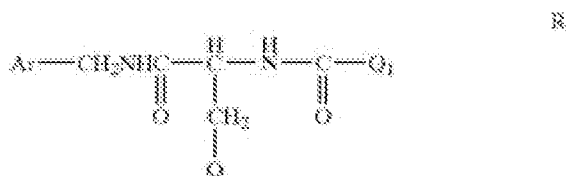
Status of Claims

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

Patented claims - United States Reissued Patent No. RE38,551 E

The patent consists of claims 1-13. Of the claims under reexamination, claim 1 is the only independent claim and is drawn to a compound:

1. A compound in the *R* configuration having the formula:



wherein

- Ar is phenyl which is unsubstituted or substituted with at least one halo group;
- Q is lower alkoxy, and
- Q₁ is methyl.

Claim Interpretation

During reexamination, claims are given the broadest reasonable interpretation consistent with the specification and limitations in the specification are not read into the claims (In re Yamamoto, 740 F.2d 1569, 222 USPQ 934 (Fed. Cir. 1984)).

Art Unit: 3991

Documents Cited

1. U.S. Patent 5,654,301. (5 August 1997). Kohn. [**"The '301 Patent"**]
2. U.S. Patent 5,378,729. (3 January 1995). Kohn *et al.* [**"The '729 Patent"**]
3. Kohn *et al.* (1991). "Preparation and Anticonvulsant Activity of a Series of Functionalized α -Heteroatom-Substituted Amino Acids," *J. Med. Chem.* 34:2444-2452. [**"Kohn 1991"**]
4. LeGall (December 1987). "2-Substituted-2-acetamido-N-benzylacetamides. Synthesis, Spectroscopic and Anticonvulsant Properties," A Thesis Presented to the Faculty of the Department of Chemistry. University of Houston-University Park. [**"LeGall"**]
5. Silverman, R. B. (1992). *The Organic Chemistry of Drug Design and Drug Action*. Academic Press. "Chapter 2: Drug Discovery, Design, and Development," pp. 4-50. [**"Silverman"**]
6. Castel-Branco, M.M. *et al.* (2009). "The Maximal Electroshock Seizure (MES) Model in the Preclinical Assessment of Potential New Antiepileptic Drugs," *Methods and Findings in Experimental and Clinical Pharmacology*. 31(2):101-106. [**"Castel-Branco"**]

References 1-5 were provided in the original request and cited on the Information Disclosure Statement of 25 March 2016. Castel-Branco is newly cited as evidentiary. The LeGall reference that was discussed regarding raising a SNQ in the Order mailed on 16 June 2016 has been reconsidered and does not rise to the level of prior art applicable in any grounds of rejection, as this document is not prior art. In the original request, beginning at page 25 it is asserted that the patent owner has admitted in District Court litigation that the LeGall thesis was publicly accessible more than one year before the earliest priority date for the '551 patent and constitutes a "printed publication" within the meaning of 35 U.S.C. § 102(b). See "Exhibit 1 – Plaintiffs' and Defendants' Joint Statement of Uncontested Facts" provided with the papers filed on 25 March 2016 (IPR2016-00204 -Exhibit 1004), at page 19 ¶ 87. However, ¶ 87 also clearly provides that this statement is "for purposes of this litigation." During the district court litigation, patent owner may have agreed to stipulate to certain facts to streamline matters at trial there, for example, or had other reasons to stipulate on the issue in a case involving different parties in a different forum, regardless of whether the thesis was, in fact, publicly assessable or not.

Whether a thesis constitutes prior art under 35 U.S.C. § 102 is a legal question based on underlying factual determinations. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568 (Fed. Cir. 1987); *Kyocera Wireless Corp. v. Int'l Trade Comm'n*, 545 F.3d 1340, 1350 (Fed. Cir. 2008). The Federal Circuit has held that "public accessibility" is the touchstone in determining whether a reference is a "printed publication" under § 102. *In re Hall*, 781 F.2d 897, 898-99 (Fed. Cir. 1986). "A reference is publicly accessible 'upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art

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