

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Harold Kohn

Examiner: S. Kumar

Serial No.: 08/818,688

Art Unit: 1209

Filed: March 17, 1997

Docket: REI-10030

Reissue of Patent No.: 5,773,475

Issued: June 30, 1998

For: ANTICONVULSANT ENANTIOMERIC
AMINO ACID DERIVATIVES

Assistant Commissioner for Patents
Washington, DC 20231

DECLARATION IN SUPPORT OF REISSUE
DECLARATION UNDER 37 C.F.R. §1.175

Sir:

I, Harold Kohn, declare and state as follows:

1. I am a citizen of the United States, with my post office address and citizenship being stated hereinbelow next to my name. I have moved since the filing of the underlying application that matured into U.S. Patent No. 5,773,475.

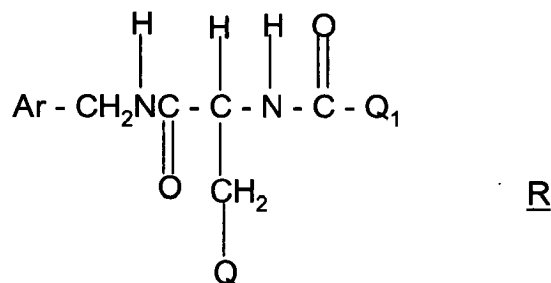
2. I am the sole inventor of the subject matter which is described and claimed in U.S. Patent No. 5,773,475 ('475 patent) and described and claimed in the above-identified reissue application.

3. I do not believe that the subject matter described and claimed in the '475 patent or the reissue application was ever known or used in the United States before my invention thereof.

4. I believe that I am the original and first inventor of the subject matter which is claimed in the '475 patent and in the above-identified reissue application, for which a reissue patent is sought.

5. I have reviewed and understand the contents of the specification and claims of the '475 patent and the specification and claims of the above-identified reissue application.

6. The '475 patent is directed, in part, to 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.

It is also directed, in part, to a method of treating central nervous system disorders in an animal comprising administering to said animal in need thereof an anti-convulsant effective amount of said compound.

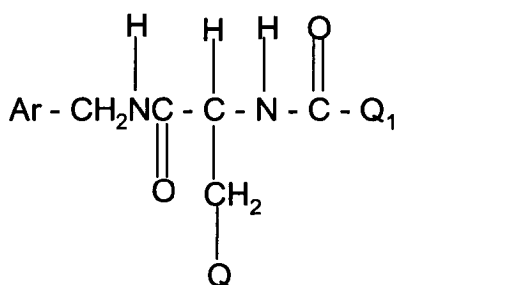
7. I believe that the '475 patent is partly inoperative by reason of the patentee claiming less than the patentee had the right to claim in the patent.

8. All errors which are being corrected in the present reissue application up to the filing of this Declaration arose without any deceptive intention on my part.

9. The error being corrected is the perfection of the claim of priority for a provisional application in which the claim of priority was made during the pendency of the underlying application for the '475 patent.

10. Attached hereto as Exhibit A is a true and accurate copy of the provisional application that was filed on March 15, 1996. It was given Serial Number U.S.S.N. 60/013,522.

11. It was directed, among other things, to 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 a lower alkoxy; and

Q₁ is methyl.

The application was also directed, among other things, to a method of treating central nervous system disorders in an animal which comprises administering to said animal in need thereof an anti-convulsant effective amount of the compound of Formula I.

12. The subject matter in Paragraph 11 is described and claimed in the '475 patent.

13. An application based on the subject matter of the provisional application was filed in the United States Patent and Trademark Office on March 17, 1997, and it was assigned Serial No. U.S.S.N. 818,688.

14. Upon information and belief, March 15, 1997 was a Saturday, and the first business day after the anniversary date of the filing of the provisional application was March 17, 1997.

15. The application as originally filed containing the following sentence:

“This application claims priority from U.S. Provisional Application No. 60/013,522, filed March 15, 1996.” A true and accurate copy of the first page of the U.S.S.N. 818,688 is attached hereto as Exhibit B.

16. As further evidence that a statement containing the reference to the earlier filed application was provided in the application that was originally filed, enclosed is a copy of the original filing receipt attached hereto as Exhibit C wherein it is printed thereon that the present application is claiming priority of provisional application No. 60/013,522.

17. Upon information and belief, it is my understanding of the American Inventors Protection Act, which was recently passed, that if the anniversary date of the filing of the provisional application falls on a Saturday, Sunday or Federal Holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day.

18. Upon information and belief, it is also my understanding that this provision is applicable to any application that was filed on or after June 8, 1995, with the exception of a patent which is the subject of litigation in an action commenced before November 29, 1999.

19. The filing of the underlying application for the '475 patent is subsequent to June 8, 1995.

20. Although U.S. Patent No. 5,773,475 has issued, the specific reference to the earlier filed application was submitted during the pendency of the above-identified application.

21. Accordingly, I hereby claim priority under 35 U.S.C. §119(e) of U.S.S.N. 60/013,522 filed on March 15, 1996.

22. Attached hereto as Exhibit D is a Declaration for the above-identified application in which the claim of priority to the provisional application is included.

23. I acknowledge the duty to disclose information which is material to the examination of this application in accordance with 37 C.F.R. §1.56.

24. I hereby appoint the following attorneys and/or agents to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith: Leopold Presser, Reg. No. 19,827; William C. Roch, Reg. No. 24,972; Kenneth L. King, Reg. No. 24,223; Frank S. DiGiglio, Reg. No. 31,346; Paul J. Esatto, Jr., Reg. No. 30,749; John S. Sensny, Reg. No. 28,757; Mark J. Cohen, Reg. No. 32,211; Richard L. Catania, Reg. No. 32,608, Edward Grolz, Reg. No. 33,705 and Steve Fischman, Reg. No. 34,594.

Address all telephone calls to: Leopold Presser

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Address all correspondence to: Leopold Presser, Esq.

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Garden City, NY 11530

25. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further

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