



GlaxoSmithKline

GlaxoSmithKline
Sherry M. Knowles
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October 10, 2007

VIA FACSIMILE

Re: Verified Complaint

James A. Toupin, Esq.
General Counsel
Stephen Walsh, Esq.
Acting Deputy General Counsel and Solicitor
United States Patent and Trademark Office
P.O. Box 15667
Arlington, VA 22202

Dear Mr. Toupin and Mr. Walsh:

I attach a Complaint that was filed in the U.S. Federal Court for the Eastern District of Virginia yesterday against the US Patent and Trademark Office to challenge the Final Rules published on August 21, 2007 (72 Fed. Reg. 46716-46843) that limit patent continuation and claims practice. GSK has strong respect for the US Patent and Trademark Office, and would welcome a conversation or meeting with you about this matter. Please feel free to contact me.

Sincerely,

A handwritten signature in black ink that reads "Sherry M. Knowles". The signature is written in a cursive, flowing style.

Sherry M. Knowles, Esq.

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. _____

VERIFIED COMPLAINT

Plaintiffs SmithKline Beecham plc, SmithKline Beecham Corporation d/b/a
GlaxoSmithKline, and Glaxo Group Limited d/b/a GlaxoSmithKline (collectively referred to as
"GSK") for their Complaint against Defendant 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 Defendant United States Patent and Trademark Office ("PTO"), hereby
allege as follows:

I. INTRODUCTION

1. On August 21, 2007, the Department of Commerce, Patent and Trademark Office ("PTO") published Final Rules titled "Changes To Practice for Continued Examination Filings, Patent Applications Containing Patentably Indistinct Claims, and Examination of Claims in Patent Applications." These Final Rules revise the rules of practice in patent applications relating to continuing applications, requests for continued examination, and for the examination of claims in patent applications. 72 Fed. Reg. 46716, 46716-47843 (Aug. 21, 2007).

2. These Final Rules amend, among other sections, 37 C.F.R. §§ 1.75, 1.78, and 1.114, and add 37 C.F.R. § 1.265. The changes to §§ 1.75 and 1.265 apply to any nonprovisional application pending on or after November 1, 2007 that has yet to receive a first Office Action on the merits. 72 Fed. Reg. at 46716. The changes to § 1.78, except for those changes to §§ 1.78(a) and 1.78(d)(1), apply to any nonprovisional application pending on November 1, 2007. *Id.* at 46717. The changes to § 1.114 apply to any application in which a request is made after November 1, 2007. *Id.* Thus, the changes affect GSK patent applications that have already been filed and are pending in the PTO. *Id.* at 46717.

3. Plaintiff GSK respectfully requests that the Court preliminarily and permanently enjoin the PTO from implementing the Final Rules on November 1, 2007 or thereafter as the Final Rules were promulgated without proper legal authority. The Final Rules are also vague, arbitrary and capricious, and prevent GSK from fully prosecuting patent applications and obtaining patents on one or more of its inventions.

4. The PTO's promulgation of the Final Rules will damages specific GSK patent applications and inventions. Presently, GSK has approximately one hundred or more pending applications in which two or more continuations or continuations-in-part have been filed, and

