

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. 1:07-CV-01008-JCC-TRJ

**DECLARATION OF SAMSON HELFGOTT IN SUPPORT OF BRIEF FOR *AMICUS*
CURIAE AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION IN
SUPPORT OF THE "GSK" PLAINTIFFS' MOTION FOR A TEMPORARY
RESTRAINING ORDER AND PRELIMINARY INJUNCTION**

1. I, Samson Helfgott, am a registered U.S. patent attorney, with over 35 years experience in domestic and international patent matters.
2. I worked for the General Electric Company for 15 years where I headed their International Patent Operation. I was founder of the patent law firm of Helfgott and Karas, PC with offices in the Empire State Building which operated for 15 years. For the last 6 years I have been a partner and Director of Patents at the law firm of KattenMuchinRosenman, LLP.

3. I have authored well over 50 articles and handbooks on patent law and have extensively lectured internationally on behalf of the World Intellectual Property Organization (WIPO), the Intellectual Property Law Section of the American Bar Association (ABA), the American Intellectual Property Law Association (AIPLA), the Intellectual Property Owners Association (IPO), and represented these organizations at diplomatic meetings around the world.
4. I am responsible for the patent portfolios of over 50 major clients with well over 10,000 patent applications.
5. I am a member of the American Intellectual Property Association (AIPLA) and various other professional organizations. I have chaired numerous committees, and served in various other capacities in such organizations, and have dealt with patent issues, including Patent Cooperation Treaty (PCT) issues.
6. A copy of my resume is attached as Exhibit A.
7. I am aware of the USPTO's New "Changes to Practice for Continued Examination Filings, Patent Applications Containing Patentably Indistinct Claims, and Examination of Claims in Patent Applications" Rules Package ("new Rules") published August 21, 2007, and am currently engaged in an intensive effort to determine what is required to comply with them, and to undertake the actions necessary to effect compliance.

8. I am aware of the objections to these rules stated in BRIEF FOR *AMICUS CURIAE* AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION IN SUPPORT OF PLAINTIFFS' MOTION FOR A TEMPORARY RESTRAINING ORDER AND PRELIMINARY INJUNCTION.

9. Because the new Rules have immediate impact, I believe they will cause immediate and irreparable harm to my clients' ability to protect their intellectual property as of the same day they go into effect.

10. Just a few of the many examples of such immediate harm, which could occur on the same day of entry of the new Rules, include at least the following:
 - a. If all continuing applications allowed according to the new Rules have been filed, including the "one more," and on the effective date of the new Rules my client receives a Notice of Allowance, and that day a reference comes to light in foreign prosecution (years after the original United States application was filed), my client would have no right to amend the claims to overcome the reference. My client, however, has an obligation to provide this material reference to the USPTO but the USPTO has no obligation to read it, let alone reopen the prosecution. My client must then choose between permitting issuance of possibly invalid claims or abandoning the application altogether.

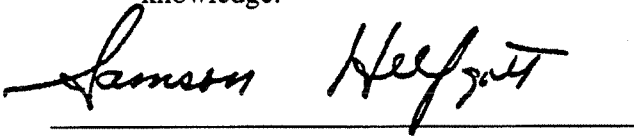
- b. Many of my clients have committed to filing strategies that utilize the international Patent Cooperation Treaty (PCT) filing process. If my client filed a PCT application claiming the benefit of a non-provisional application and if all continuing applications allowed according to the new Rules have been filed to such non-provisional application, and a PCT application must be filed on the day the new Rules go into effect, my client cannot use either the PCT process and enter the USPTO with a national stage application nor file a continuation of the PCT application. Any such application filing on that day of enactment of the new Rules would be barred. Many of my clients have committed to a filing strategy that would allow for such use of the PCT years before the new Rules were published. They will be irreparably harmed as of the day of enactment of the new Rules because of this change in the rules of practice.
- c. Many of my clients have committed to filing strategies that utilize the PCT examination process. In certain situations, however, the mere fact that my client has requested a PCT examination prevents the long-standing and well-accepted option of filing a continuation of the PCT application, thereby allowing them the benefits of the PCT process and US restriction practice. This will be applicable to such PCT applications requiring entry into the national stage as of the date of enactment of the new Rules.
- d. If my client has filed a number of continuation applications and has claimed various embodiments of his invention in such previous pending applications, and

on the day the new rules go into effect they must file a PCT national stage claiming the priority of one of such previous applications, he will not be able to do so unless he cancels claimed inventions in such continuations to free up claims for the national stage to be within the allowed restricted limit.

- e. If on the day the new Rules go into effect, my client must file a non-provisional application claiming the benefit of a previously filed provisional application, they must either limit their ability to claim all of the embodiments of their invention, or be forced to make statements that could be potentially used against them in any enforcement proceedings. Such Hobson's Choice will cause them to reconsider the entire benefit of any patent protection and force them to not disclose their invention to the public, thereby denying the public the benefit of the invention.

11. Each day that the new Rules continue in effect causes more commitment to strategic patent decisions under the new Rules, which decisions are irreversible and can never be recouped.

12. I declare under penalty of perjury that the foregoing is true and correct, to the best of my knowledge.



Samson Helfgott
Director of Patents
KattenMuchinRosenman LLP
575 Madison Avenue
New York, NY 10022-2585

10/25/07
Date

EXHIBIT A



Samson Helfgott

Partner

New York, New York

p_ 212.940.8683

f_ 212.940.8987

samson.helfgott@kattenlaw.com

Qualifications and Career Profile

Samson Helfgott has practiced for over 30 years in domestic and international patent, trademark and copyright matters, international patent strategy and patent and trademark administration before foreign patent tribunals. He is a prolific writer and lecturer, who is frequently published in the area of international litigation pertaining to patents, among others.

Associations and Committees

Mr. Helfgott is a member of the American Bar Association (IPL Section) where he heads all of the International Intellectual Property matters, serving as International Activities Coordinator. He is Chairman of the Harmonization Committee of the New York Patent, Trademark and Copyright Law Association (Board of Directors 1986-89). He is Chairman of the Foreign Practice Committee of the Intellectual Property Owners Association. He has chaired many committees at the American Intellectual Law Association. He is currently the Treasurer of the International Intellectual Property Society (President, 1994-96). He serves on the U.S. Bar, EPO Liaison Council, having previously been his Chairman. He was the founder and first Chairman of the U.S. Bar/JPO Liaison Council. He has represented the American Bar Association at international meetings and at international diplomatic conferences on world patent harmonization. He also is Advisory Board Member and contributor to World Intellectual Property Report, BNA International, Inc., London, England.

Mr. Helfgott is admitted to practice before the Supreme Court of the United States, the United States Court of Appeals for the Federal Circuit, the Southern and Eastern Districts of New York, the Supreme Court of the State of New York, and the United States Patent and Trademark Office.

Education

Mr. Helfgott earned an undergraduate degree *cum laude* (B.E.E., 1961) from the City College of the City University of New York, and graduate degrees from Yeshiva University (M.H.L., 1962) and New York University (M.E.E., 1963). Mr. Helfgott earned his law degree *cum laude*

(J.D., 1972) from Fordham University and a doctorate degree (D.H.L., 1974) from Yeshiva University. Mr. Helfgott speaks Hebrew and German.

Lectures and Articles

Mr. Helfgott is a widely acclaimed lecturer. For many years, he was the coordinator of an annual program on Global Intellectual Property for the Practicing Law Institute (PLI). He has lectured at all the major U.S. Bar Associations, including ABA, AIPLA and IPO. He has also lectured in Europe, Japan and the Middle East. Mr. Helfgott was Program Chair and guest speaker at the American Intellectual Property Association's Patent Cooperation Treat seminar series (July 2003).

Mr. Helfgott writes the quarterly news article on International Intellectual Property matters for the American Bar Association IPL Newsletter. He is also coordinator of the international IP List Serve for the ABA. The various articles Mr. Helfgott has authored are as follows:

"Statistical Study of the Japanese Patent Office's Handling of Foreign Patent Applications," Patents & Licensing, published by Japan Engineering News, Inc., Tokyo, Japan, Vol. 13, No. 2, April, 1983; "Foreign Patent Litigation," Patents, Copyrights, Trademarks and Literary Property course Handbook Series, Number 171, Practicing Law Institute, New York, N.Y., 1983; "The Declining Use of Patent Oppositions," IIC-International Review of Industrial Property & Copyright Law, published by Max-Planck Institute for Foreign & International Patent, Copyright and Competition Law, Munich, Germany, Vol. 16, No.2, 1985; "National Patenting in Western Europe," Continuing Legal Education Institute on Worldwide Protection of Intellectual Property, AIPLA - American Intellectual Property Law Association, January, 1985; "Selecting Foreign Countries for Patent Coverage," Journal of the Patent and Trademark Office Society, Arlington, Virginia, Vol. 68, No. 2, February, 1986; "Genuine Unauthorized Goods," EIPR - European Intellectual Property Review, London, England, Vol.8, Issue 3, March 1986; "National Filing vs. EPC Filing," Intellectual Property Law, Washington, D.C., Spring, 1986; "Novelty Effect of Prior Filed Applications," ABA-Section of Patent, Trademark and Copyright Law, 1986 Committee Reports, New York, N.Y., 1986; "Guide to Selecting Foreign Countries for Patent Coverage," Introduction to Patents Throughout the World," Third Edition, August, 1986, Trade Activities Division of Clark Boardman Co., New York, N.Y.; "Prior Art Effect of Previously Filed subsequently Published Applications," AIPLA Selected Legal Papers, Vol. IV, No.2, P.193, December, 1986; "Willful Infringement & Right to Use Opinions of Counsel," ABA-PTC Section, Intellectual Property Law, 4th Spring Educational Program, March 1989; "Harmonization of Patent Laws & Procedures." Fifth Annual Joint Seminar-Patent Practice Update, New York, N.Y., April 1989. "Use and Interpretation of Dependent Claims Around the World", World Intellectual Property Report (BNA), Vol.3, No. 9, September 1989. "Cultural Differences Between the U.S. and Japanese Patent Systems", World Intellectual Property Report (BNA), Vol. 3, No. 12, December 1989; reprinted: Patents & Licensing, Tokyo, Japan, Vol.19, No.6, December 1989; reprinted: Journal of the Patent and Trademark Office Society, Arlington, VA, Vol.72, No.3, March 1990. "Claim Practice Around the World", Journal of the Japanese Group AIPPI, Tokyo, Japan, Vol.36, No.6, June, 1991 (Japanese language); Journal

of Proprietary Rights (Prentice Hall), Vol.4, No.4, April, 1992. "A Global Patent Application", Global Intellectual Property Series, No.319, Practising Law Institute, New York, NY, Oct., 1991; reprinted: Journal of the Patent and Trademark Office Society, Arlington, VA, Vol.74, No.1, Jan.1992. "Differences Between U.S. & Japanese Patent Applications", Journal of the Japanese Group AIPPI, Tokyo, Japan, Vol.37, No.7, Oct., 1992 (Japanese language); University of Baltimore Intellectual Property Law Journal, Vol.1, No.1, p.1, Fall, 1992. Global Intellectual Property Series, No.34, Practising Law Institute, New York, NY, Oct., 1992. "Patent Filing Costs Around the World", Journal of the Patent and Trademark Office Society, Arlington, VA, Vol.75, No.7, July, 1993. Global Intellectual Property Series, No.366, Practising Law Institute, New York, NY, Oct., 1993. "Effective Utilization of the Japanese Patent System", Intellectual Property Law Annual 1994, New York Intellectual Property Law Association, Inc. New York, NY, March, 1994. "Correcting Errors in European Patent Applications", Tenth Annual Joint Seminar of the Conn., N.J., N.Y. and P.A. Intellectual Property Law Associations, April, 1994. "Why Must Filing in Europe Be So Costly?", Journal of the Patent and Trademark Office Society, Arlington, VA, Vol.76, No.10, Oct.1994. "Eastern European Patent Activities", Journal of the Japanese Group AIPPI, Tokyo, Japan, Vol.40, No.5, May 1995 (Japanese Language). "Prior Art Date of PCT Applications," Patents and Licensing, published by Japan Engineering News, Inc. Tokyo, Japan, Vol.29, No.2, April 1999. "Changes Afoot on International Patents", New York Law Journal Silicon Alley Supplement, Dec. 3, 2001. Letter to the Editor, Journal of the Patent and Trademark Office Society, Jan. 2002. "Securing IP Rights Abroad", Moderator, ABA-IPL Section Spring CLE Program, Wash. D.C., April 11-12, 2002. "Foreign Companies With R&D Facilities in the United States", World Intellectual Property Report, April 2002. "A Harmonized Approach To Applying Secret Prior Act", World Intellectual Property Report, January 2004.