

IN THE UNITED STATES DISTRICT COURT FOR THE  
EASTERN DISTRICT OF VIRGINIA  
Alexandria Division

TRANTAFYLLOS TAFAS )  
)  
Plaintiff, )  
)  
v. ) 1:07cv846(JCC/TRJ)  
)  
JON. W. DUDAS, et al. )  
)  
Defendants. )

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CONSOLIDATED WITH

SMITHKLINE BEECHAM CORPORATION, )  
)  
Plaintiff, )  
)  
v. ) 1:07cv1008(JCC/TRJ)  
)  
JON W. DUDAS, et al. )  
)  
Defendants. )

**DECLARATION OF JOSEPH F. HETZ IN SUPPORT OF  
AMICUS CURIAE AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION'S  
BRIEF IN SUPPORT OF THE "GSK" PLAINTIFFS' MOTION FOR A TEMPORARY  
RESTRAINING ORDER AND PRELIMINARY INJUNCTION**

I, Joseph F. Hetz, do hereby state the following:

1. I am a shareholder at Brinks Hofer Gilson & Lione and have been practicing patent law since 1996. I graduated from the University of Michigan Law School in 1996, became licensed to practice law in the State of Illinois in 1996, and became registered to practice before the United States Patent and Trademark Office ("USPTO") in 1997. I concentrate my

practice on the preparation and prosecution of patent applications and have prosecuted over 1,000 patent applications before the USPTO and foreign patent offices. I am a member and former Chair of my Firm's Docket Oversight Committee and am an Adjunct Professor of Law at Valparaiso University School of Law, where I teach a course in patent prosecution.

2. I have spent a considerable amount of time studying the "Changes to Practice for Continued Examination Filings, Patent Applications Containing Patentably Indistinct Claims, and Examination of Claims in Patent Applications; Final Rule" ("the new Rules") and assisted in educating members of my Firm and clients on the new Rules.

3. My firm represents SanDisk Corporation ("SanDisk") in patent prosecution matters. It is my opinion that the retroactive impact of the new Rules will cause irreparable harm to SanDisk.

4. SanDisk has filed multiple applications with the same or very similar specifications but with different claim sets to provide a spectrum of protection for a set of inventive concepts. My firm is currently prosecuting 96 patent applications for SanDisk that were filed before the August 21, 2007 publication of the new Rules and that have not yet received a first Office Action on the merits. These 96 patent applications were filed as 24 "suites" of applications (i.e., two or more applications with the same or very similar specifications but different claim sets). Of those 96 applications, 30 applications were filed as method and system pairs, while 66 applications were filed in larger suites (ranging from a suite of four applications to a suite of 12 applications).

5. Under the new Rules, it is my understanding that claims from all applications in a particular suite will be counted as though they were contained in each application unless SanDisk commits the time and resources to combine the sets of claims into one application and abandon all the other applications in the suite. (The new Rules provide alternatives to combining sets of claims, but, as discussed in paragraph 8 below, these alternatives also impose financial and other burdens). Combining the 96 applications mentioned above into 24 applications (i.e., one application per suite) and filing Suggested Restriction Requirements (“SRRs”) in the hopes of receiving Restriction Requirements in order to file divisional applications to restore the number of total applications back to 96 is a very costly effort. At the very minimum, combining the 96 applications into 24 applications will result in SanDisk losing \$72,000 in basic application, search, and examination fees, not to mention attorneys fees paid in the 72 applications that will be abandoned. In addition, SanDisk will need to pay (i) extra claims fees and attorneys fees to prepare and file preliminary amendments to add claims (and any supporting text) from the 72 applications that will be abandoned to the 24 applications that will remain pending, (ii) attorneys fees associated with the preparation and filing of SRRs for each of the 24 applications that will remain pending, and (iii) USPTO and attorneys fees for preparing and filing divisional applications in response to any Restriction Requirements received in response to the SRRs.

6. If the USPTO does not issue a Restriction Requirement for an application or issues a Restriction Requirement for fewer groups than suggested in the SRR, SanDisk may be forced to use a continuation application (if one is still available) to pursue claims that SanDisk was otherwise free to pursue when the application was originally filed, or SanDisk may be forced to limit the number of claims it is pursuing. For example, if the Examiner does not agree with

SanDisk's SRR to divide out two claim sets in an application, SanDisk will be forced to either forego claim coverage of one claim set or use a continuation application to pursue the second claim set. The problem becomes amplified in larger suites. For example, in a suite of 10 applications where there may be more than 15 independent claims, if the Examiner does not agree with SanDisk's SRR, SanDisk may be forced to abandoned some of the pending independent claims given the 5/25 rule. As a result, fewer patents will issue, resulting in retroactive loss of intellectual property by operation of the new Rules.

7. Another aspect of the irreparable harm relates to the timing of the new Rules. There was not enough time between the date that the new Rules were published (August 21, 2007) and the date that the new Rules go into effect (November 1, 2007) to combine applications and prepare and file SRRs in every application suite. After November 1<sup>st</sup>, if the USPTO mails a Restriction Requirement or a first Office Action on the merits ("FAOM") in an application before we have the opportunity to combine the various applications and prepare and file the appropriate SRRs, we will lose our opportunity to do so. This would be immediate irreparable harm (i.e., harm that could happen as early as November 1<sup>st</sup> rather than at some time in the future), as we may not even have a chance to protect all embodiments if the USPTO mails a Restriction Requirement or a FAOM before we have the opportunity to perform this immense amount of work.

8. While the new Rules provide alternatives to combining sets of claims into one application, the financial and other burdens imposed by these alternatives make them an impractical option. For example, filing an Examination Support Document ("ESD") or explaining why claims are "patentably distinct" is not only expensive but also provides

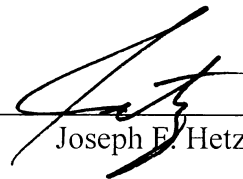
statements on the record that can potentially be asserted by an accused infringer in formulating its non-infringement and unenforcability defenses.

9. Another example of the unfairness of the retroactivity of the new Rules concerns Requests for Continued Examination (“RCEs”). SanDisk has used RCEs as part of what was considered the normal back-and-forth prosecution process with an Examiner. However, because of the retroactivity of the new Rules, after November 1<sup>st</sup>, SanDisk cannot file additional RCEs as a matter of right in those applications or in applications in the same family. The loss of additional RCEs as a matter of right will cause irreparable harm to SanDisk as it will limit SanDisk’s prosecution options in those applications.

10. I declare under penalty of perjury that the foregoing is true and correct.

Executed on: October 24, 2007

Signed: \_\_\_\_\_



Joseph E. Hetz