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November 30, 1990

VIA FACSIMILE

Mr. G. Le Moenner
L'AIR LIQUIDE
Service Brevets & Marques
75, Quai d-Orsay
F-75321 Paris, Cedex 07
France

Re: Festal et al - USSN 07/785,862
DERIVATIVES FOR THIENO AND FURO-(2,3,-C)...
Our Reference: Festal = 1
Your Reference: Serie: 2711/750/22

Dear Mr. Le Moenner:

We are disspointed to report to you the receipt of an adverse decision from the Board of Patent Appeals and Interferences of the U.S. Patent and Trademark Office. A copy of this decision, dated November 28, 1990, is attached.

While we did not expect to be successful with the broad claims, we were hopeful that we would obtain allowance of at least claims 17-19.

Other than abandoning further attempts to obtain a patent on this invention in the U.S.A., there are three options to consider:
(1) we can request reconsideration within one month (due date December 28, 1990); (2) we can file an appeal to the Court of Appeals for the Federal Circuit within two months (due date January 28, 1991); or (3) we can refile the application such as in the form of a Rule 62 continuation application (due date January 28, 1991).

If the invention remains important to Lipha, we would recommend the third option, namely refiling of the application in the Form of a Rule 62 continuation. In that case, however, it is **absolutely essential** to provide the Patent Office with the type of comparison which was absent from the present parent file. In this regard, we again invite your attention to our report of January 18, 1989. Also see the attached decision of the Board of Appeals,

especially starting at the top of page 3 through the top of page 4, and most especially the sentences at the very bottom of page 3 extending over to page 4.

In summary, if the invention remains sufficiently important to Lipha to make further attempts to obtain a patent in the U.S.A., we would recommend two steps, namely refile the present application as a Rule 62 continuation, and carry out the necessary comparisons of compounds of the present invention with the closest compounds disclosed by Campbell with a view to presenting the results of such a comparison in the form of an affidavit or declaration in the new continuation application.

If we do not hear from you, we will permit this matter to lapse by taking no action.

Sincerely,

Sheridan Neimark

SN:jec

NEXT

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January 14, 1991

VIA FACSIMILE

RAU and SCHNECK
Koenigstrasse 2
D-8500 Nuernberg 1
FEDERAL REPUBLIC OF GERMANY

Re: SCHIPKE, N.- USSN 07/290,106
DEVICE FOR VIBRATION THERAPY
Your Ref.: S/SC
Our Ref.: SCHIPKE=1.1

Gentlemen:

This will acknowledge receipt of your December 28, 1990, instructions on the above identified case.

As instructed, we approached the Examiner to determine the possibility of obtaining allowed claims more specifically drafted to overcome the cited prior art. To facilitate conversation we offered a draft of amended claim 1, enclosed herewith. The Examiner maintained her position and directed our attention to column 3, lines 65 through 75 and continuing to column 4, lines 1-4 of Colston and column 1, lines 31-61 and column 8, lines 4-12 of Lane. The Examiner indicated that this language teaches the use of the cited devices for treating spinal columns.

Being unconvinced, we gave the Examiner the enclosed additional substitute claim and advised her that we believed that this claim defines over the cited references. We pointed out that the Mack patent teaches a leg support vibrating with the vibrating table and at best the references teach adding a leg support to the vibrating portion of Colston. No art is cited that teaches a leg support separate from the "swing base".

At this point the Examiner conceded that she had not searched for a "swing base" separated from an "adjustable leg support" but she said that this claim raised the issue of possible "new matter" as well as "new issues". She dismissed our argument that this claim is inherent to the structure shown in the drawings. She further maintained that the specification did not

support the substitute claim and pointed out being unable to find in the specification descriptions of the deck and the spring of the claim. She further indicated that the specification emphasizes the structure of the vibrator and provides little specificity on the operation of the "swing base" in relation to the leg support. We had no response other than indicating that the drawings showed the complete device. (We had advised you early by our July 27, 1990 that descriptions of a number of elements were missing in the specification.)

The Examiner then indicated her unwillingness to allow claims on any basis given 35 USC Section 112 problems. The conversation ended by her volunteering the enclosed "Examiner Interview Summary Record" which only reflects her unwillingness to allow claims but fails to reflect the details discussed above.

The date of response to the final rejection continues to run and any further action without incurring a late fee must be filed within three months from the date of the final rejection, i.e. by

March 3, 1991.

Of course extensions can be obtained in the usual way.

Given the Examiner's harsh handling, including failure to timely raise 35 USC Section 112 problems in the application, the only options available are as follows: as a CIP

1. File an amendment taking issue to the rejection;
2. Refile the application; or
3. Abandon the invention in the U.S..

We would advise against pursuing (1) above, given the exploratory conversations with the Examiner discussed above. Of course, if you choose to file an amendment, and we are correct about the Examiner's views, the Examiner will refuse its entry, which will provide the additional option of appeal; or we could even appeal directly on the basis of the old claims.

Assuming your interest in pursuing this case, we would recommend option (2) above, since we believe that ~~the~~ substitute claims ~~offered is~~ could be patentable over the prior art now cited by the Examiner.

However, to prevail the specification must be amended to be consistent with the drawings. Further, we have made no evaluation of whether the refiling must introduce "new matter" whereby the claims would only be entitled to the new filing date and the published German application(s) would be applied as prior art.

Of course, if the invention does not justify the costs of further prosecution, you may wish to abandon the case.

If you wish to further pursue this case through any of the above identified options and avoid incurring any late fees, we must receive your instructions prior to March 3, 1991. Accordingly, your early instructions would be appreciated.

A debit note for our services is also enclosed.

Sincerely,

Norman J. Latker

:sla
Enclosure