



April 10, 2012

Mail Stop Patent Board  
Director of the United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Attn: Lead Judge Michael Tierney  
Derivation Proposed Rules

Dear Sir:

Research In Motion Ltd. (RIM) is a leading designer, manufacturer and marketer of innovative wireless solutions for the worldwide mobile communications market. Through the development of integrated hardware, software and services that support multiple wireless network standards, RIM provides platforms and solutions for seamless access to time-sensitive information including email, phone, text messaging (SMS and MMS), Internet and intranet-based applications. RIM technology also enables a broad array of third party developers and manufacturers to enhance their products and services with wireless connectivity to data. RIM's portfolio of award-winning products, services and embedded technologies are used by thousands of organizations around the world and include the BlackBerry wireless platform, the RIM Wireless Handheld product line, software development tools, radio-modems and other hardware and software. RIM's flagship BlackBerry platform of wireless devices, software and services is available in over 175 countries, and serves approximately 55 million subscribers worldwide.

As a global company, RIM currently employs over 17,000 people throughout the world, 15.5% of which are employed in the United States. In 2010, RIM sold over \$9B of products and services in the United States.

RIM appreciates the opportunity to respond to Request for Comments (RFC) concerning proposed rules entitled Changes to Implement Derivation Proceedings of the Leahy-Smith America Invents Act<sup>1</sup> ("Proposed Rules"). The Proposed Rules are intended to implement the provisions of 35 U.S.C. 122 *et seq.* of the Leahy-Smith America Invents Act ("AIA").<sup>2</sup>

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<sup>1</sup> Federal Register Vol. 77, No. 28, Friday, February 10, 2012, pp. 7028-7041.

<sup>2</sup> Public Law 112-29—Sept. 16, 2011, 125 Stat. 284 *through* 125 Stat. 341.



**The Patent Office Should Clarify Whether the One Year Period Is Calculated from the Publication of the Petitioner's Claim or the Publication of the Respondent's Claim.**

Section 42.403 states:

A petition for a derivation proceeding must be filed within one year after the first publication of a claim to an invention that is the same or substantially the same as the earlier application's claim to the allegedly derived invention.<sup>3</sup>

It is not clear from the cited section whether the one year period is calculated from the publication of the petitioner's claim or the publication of the respondent's claim. The Discussion of Specific Rules section of the Federal Register notice states:

The proposed rule is consistent with 35 U.S.C. 135(a), as amended, because the earlier application's first publication of the allegedly derived invention triggers the one-year bar date. While the statute's use of the phrase "a claim" is ambiguous inasmuch as it could include the petitioner's claim as a trigger, such a broad construction could violate due process. For example, the petitioner could be barred by publication of its own claim before it had any knowledge of the respondent's application. Such problems may be avoided if the trigger for the deadline is publication of the respondent's claim. (Federal Register Vol. 77, No. 28, Friday, February 10, 2012, p 7029.)<sup>4</sup>

We agree with the Patent Office's determination that the one year period should be calculated from the publication of the respondent's claims. Therefore, we recommend that Section 42.403 be amended as follows to further clarify this determination and remove any ambiguity:

A petition for a derivation proceeding must be filed within one year after the first publication of a claim to an invention **by the respondent** that is the same or substantially the same as the **earlier later** application's claim **by the petitioner** to the allegedly derived invention.<sup>5</sup>

<sup>3</sup> Federal Register Vol. 77, No. 28, Friday, February 10, 2012, p. 7039 – 37 C.F.R. § 42.403.

<sup>4</sup> Federal Register Vol. 77, No. 28, Friday, February 10, 2012, p. 7030.

<sup>5</sup> Federal Register Vol. 77, No. 28, Friday, February 10, 2012, p. 7039 – 37 C.F.R. § 42.403, as proposed.



## **Conclusion**

RIM appreciates the opportunity to comment on the Proposed Rules. RIM would like to applaud and support the Patent Office's efforts to ensure that the first person to file the application is actually a true inventor. RIM believes that the modifications to the rules proposed above will greatly enhance the usefulness of the derivation proceeding by clarifying that the one year period is calculated from the publication of the respondent's claims. The Patent Office is requested to seriously consider and adopt these proposals in order to carry out the AIA's objective of establishing a more efficient and streamlined patent system.

If there are any questions related to our proposals, please contact me at 972-310-1197.

Respectfully Submitted,

**RESEARCH IN MOTION LTD.**

A handwritten signature in black ink, which appears to read 'Jon M. Jurgovan', is positioned above the printed name and title.

Jon M. Jurgovan  
Director, Patent Strategy