

From: Jon Jurgovan
Sent: Tuesday, October 02, 2012 3:46 PM
To: fitf_rules
Subject: Changes to Implement the First Inventor to File Provisions of the Leahy-Smith America Invents Act (RIN 0681-AC77; Docket No. PTO-P-2012-0015)

Hello,

Attached please find comments from Research In Motion, Ltd. ("RIM") regarding the Changes to Implement the First Inventor to File Provisions of the Leahy-Smith America Invents Act (RIN 0681-AC77; Docket No. PTO-P-2012-0015).

RIM appreciates the opportunity to provide comments to the proposed Implementation Rules and hopes the Patent Office will give due consideration to our proposals.

Best Regards,

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October 2, 2012

Sent via electronic mail to ftf_rules@uspto.gov
Mail Stop Comments – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Susy Tsang-Foster, Legal Advisor, Office of Patent Legal Administration

RE: *Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act* (RIN 0681-AC77; Docket No. PTO-P-2012-0015)

Dear Ms. Tsang-Foster:

Research In Motion (RIM), a global leader in wireless innovation, revolutionized the mobile industry with the introduction of the BlackBerry® solution in 1999. Today, BlackBerry products and services are used by millions of customers around the world to stay connected to the people and content that matter most throughout their day. Founded in 1984 and based in Waterloo, Ontario, RIM operates globally in the Americas, Europe, the Middle East, Africa and Asia-Pacific. There are more than 630 carriers and distribution partners offering BlackBerry products and services in over 175 countries around the world. More than 90% of the Fortune 500, as well as countless government agencies, are among our customers.

RIM appreciates the opportunity to respond to the notice of proposed rulemaking entitled *Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act* (hereinafter the “Proposed Rules”).¹ The Proposed Rules are intended to implement the provisions of 35 U.S.C. §§100 *et seq.* of the Leahy-Smith America Invents Act (“AIA”).²

1. RIM Generally Applauds the Proposed Rules for Changes To Implement the First Inventor to File Provisions

RIM appreciates the excellent work and thoughtfulness embodied in the Proposed Rules. The Proposed Rules are a collaborative, balanced effort to provide meaningful guidance for transitioning to the new first-to-file system. At the same time, the Proposed Rules recognize that the current first-to-invent system will co-exist with the first-to-file system for many years. RIM thanks the United States Patent and Trademark Office (“the Office”) for the excellent work in preparing the Proposed Rules, particularly in light of the complexity of the patent laws to be implemented.

¹ 77 Fed. Reg. 43742-59 (proposed July 26, 2012) (to be codified at 37 C.F.R. pt. 1).

² Pub. L. No. 112-29, 125 Stat. 284-341 (2011).



2. The Office Should Provide a Mechanism on the Application Data Sheet For Applicant(s) Claiming Subject Matter or Claims with an Effective Filing Date On or After March 16, 2013

The Office is proposing that applicants provide a statement indicating that either claims or subject matter having an effective filing date on or after March 16, 2013 claims the benefit of a filing date prior to March 16, 2013. We propose that the Office provide a mechanism (e.g., a checkbox) on the Application Data Sheet so that the applicant(s) may make such a statement through the Application Data Sheet directly.

Therefore, we suggest amending the Proposed Rules as follows:

Proposed § 1.55(a)(4) would not require that the applicant identify how many or which claims in the nonprovisional application have an effective filing date on or after March 16, 2013, or that the applicant identify the subject matter in the nonprovisional application not also disclosed in the foreign application. Proposed § 1.55(a)(4) would require only that the applicant state that there is a claim in the nonprovisional application that has an effective filing date on or after March 16, 2013 (e.g., “upon reasonable belief, this application contains at least one claim that has an effective filing date on or after March 16, 2013”), or the applicant state that there is subject matter in the nonprovisional application not also disclosed in the foreign application (e.g., “upon reasonable belief, this application contains subject matter not also disclosed in the foreign application”).³ Such statements may be made by checking the corresponding acknowledgment box on the application data sheet.

Section 1.78(a)(3) is proposed to be amended to require that if a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a provisional application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the later-filed application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, sixteen months from the filing date of the prior filed provisional application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the application. Such a statement may be made by checking the corresponding acknowledgment box on the application data sheet. Section 1.78(a)(3) is also proposed

³ 77 Fed. Reg. 43745 (proposed July 26, 2012) (to be codified at 37 C.F.R. pt. 1).



to be amended to require that if a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a provisional application filed prior to March 16, 2013, does not contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the provisional application, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the later-filed application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, or sixteen months from the filing date of the prior-filed provisional application.⁴ Such a statement may also be made by checking the corresponding acknowledgment box on the application data sheet.

§ 1.55 Claim for foreign priority.

(4) If a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a foreign application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, sixteen months from the filing date of the prior foreign application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the application. In addition, if a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a foreign application filed prior to March 16, 2013, does not contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the foreign application, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the later-filed application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, or sixteen months from the filing date of the prior foreign application.⁵ Such statements may be made by checking the corresponding acknowledgment box on the application data sheet.

⁴ *Id.* at 43747.

⁵ *Id.* at 43755.



§ 1.78 Claiming benefit of earlier filing date and cross-references to other applications.

(a) Claims under 35 U.S.C. 119(e) for the benefit of a prior-filed provisional application.

(3) Any nonprovisional application or international application designating the United States of America that claims the benefit of one or more prior-filed provisional applications must contain, or be amended to contain, a reference to each such prior-filed provisional application, identifying it by the provisional application number (consisting of series code and serial number). If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76(b)(5)). If a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a provisional application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the later-filed application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, sixteen months from the filing date of the prior filed provisional application, or the date that a first claim to a claimed invention that has an effective filing date on or after March 16, 2013, is presented in the application. In addition, if a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a provisional application filed prior to March 16, 2013, does not contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the provisional application, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the later-filed application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, or sixteen months from the filing date of the prior-filed provisional application.⁶ Such statements may be made by checking the corresponding acknowledgment box on the Application Data Sheet.

⁶ *Id.* at 43756.



3. The Office Should Provide a Mechanism for Applicant(s) to Claim the Benefit of a Foreign Filing in a Non-Participating Office when a Copy of the Foreign Application was Filed in an Application Subsequently Filed in a Participating Foreign Office

The Proposed Rules allows for the requirement of a certified copy of the foreign application for an application claiming the benefit of a foreign filing to be satisfied if the foreign application originally filed in a foreign intellectual property office is subsequently filed in a participating foreign intellectual property office. We recommend that the Office provide a mechanism (e.g., a checkbox) in the Application Data Sheet so that the Applicant may acknowledge such a scenario.

Therefore, we suggest amending the Proposed Rules as follows:

§ 1.55 Claim for foreign priority

(d)(2) If the foreign application was filed at a foreign intellectual property office that is not participating with the Office in a priority document exchange agreement, but a copy of the foreign application was filed in an application subsequently filed in a participating foreign intellectual property office, the request under paragraph (d)(1)(i) of this section must identify the participating foreign intellectual property office and the application number of the subsequent application in which a copy of the foreign application was filed.⁷ This identification may be provided in the appropriate space in the application data sheet.

4. Delete the Requirement to Identify Foreign Applications with Same Subject Matter Having a Filing Date Before That of the Application for Which Priority Is Claimed

The Proposed Rules indicate that a claim for foreign priority must identify “any foreign application for the same subject matter having a filing date before that of the application for which priority is claimed.”⁸ This requirement seems unnecessarily burdensome and there does not appear to be any justification as to why such information may be required to determine foreign priority. We recommend that the requirement be deleted and the specific provision is amended as follows:

§ 1.55 Claim for foreign priority.

(a)(2) In an original application filed under 35 U.S.C. 111(a), the claim for priority as well as a certified copy of the foreign application must both be filed within the later of four months from the actual filing date of the application or sixteen months from the

⁷ *Id.* at 43755.

⁸ *Id.* at 43754.



filing date of the prior foreign application. The claim for priority must be presented in an application data sheet (§ 1.76(b)(6)). The claim must identify the foreign application for which priority is claimed, ~~as well as any foreign application for the same subject matter having a filing date before that of the application for which priority is claimed,~~ by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. The time periods in this paragraph do not apply in an application under 35 U.S.C. 111(a) if the application is:

- (i) A design application; or
- (ii) An application filed before November 29, 2000.⁹

5. Clarify Why Information Regarding a Patent Application Having New Subject Matter But No New Claims Associated with the New Subject Matter Should be Identified Under the AIA

The Proposed Rules suggest that applicants should provide a statement indicating that new subject matter having an effective filing date on or after March 16, 2013 and claims benefit to a foreign application filed prior to March 16, 2013 but does not actually contain a claim related to the new subject matter. We request additional clarification as to the necessity of such a statement and how such information would be impacted and related to the AIA. The specific provision that we are referencing is highlighted as follows:

§ 1.55 Claim for foreign priority.

(a)(4) If a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a foreign application filed prior to March 16, 2013, and also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, sixteen months from the filing date of the prior foreign application, or the date that a first claim to a claimed invention in that has an effective filing date on or after March 16, 2013, is presented in the application. In addition, if a nonprovisional application filed on or after March 16, 2013, claims the benefit of the filing date of a foreign application filed prior to March 16, 2013, does not contain a claim to a claimed invention that has an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the foreign application, the applicant must provide a statement to that effect within the later of four months from the actual filing date of the

⁹ *Id.*



later-filed application, four months from the date of entry into the national stage as set forth in § 1.491 in an international application, or sixteen months from the filing date of the prior foreign application.¹⁰

6. The Requirement for Filing a Certified Copy of the Foreign Application Should Not Include the Requirement for Actual Receipt of the Foreign Application by the Office

37 CFR § 1.55 indicates that a claim for foreign priority includes a requirement for a certified copy of the foreign application. The Proposed Rules state that the requirement for the certified copy of the foreign application will be considered satisfied if the applicant (1) files the request; (2) the application is identified in an application data sheet; and (3) the foreign application is received by the Office. We suggest that the requirement should be considered satisfied upon fulfillment of (1) and (2). Requiring that the applicant be responsible also for (3) would place an undue burden on the applicant, especially if the reason that the certified copy of the foreign application was not received by the Office was a clerical or other error solely within the Office's or the foreign office's control (e.g., failure to request the foreign application by the Office or the failure of the foreign office to send the foreign application).

For the aforementioned reasons, we recommend amending the relevant section as follows:

§ 1.55 Claim for foreign priority.

(d)(1) The requirement in this section for the certified copy of the foreign application will be considered satisfied if:

(i) The applicant files a request, in a separate document, that the Office obtain a copy of the foreign application from a foreign intellectual property office participating with the Office in a bilateral or multilateral priority document exchange agreement (participating foreign intellectual property office (see § 1.14 (h)(1)); and

(ii) The foreign application is identified in an application data sheet (§ 1.76(a)(6)); and

~~(iii) The copy of the foreign application is received by the Office within the period set forth in paragraph (a) of this section or by such later time as may be set by the Office.¹¹~~

¹⁰ *Id.* at 43755 (emphasis added).

¹¹ *Id.*



Conclusion

RIM appreciates the opportunity to comment on the *Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act*. RIM believes that the modifications to the rules proposed will greatly enhance the usefulness of the First to File Provisions. The Office is requested to seriously consider and adopt these proposals.

If there should be any questions related to our proposals, please feel free to contact me at 972-310-1197.

Respectfully Submitted,

RESEARCH IN MOTION LTD.

A handwritten signature in blue ink, which appears to read "Jon M. Jurgovan". The signature is fluid and cursive, written over the printed name and title.

Jon M. Jurgovan
Director, Patent Strategy