



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
Post-Grant Review 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 Post-Grant Review Proceedings¹ ("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").²

¹ Federal Register Vol. 77, No. 28 Friday, February 10, 2012, Proposed Rules, pp.7060-7080.

² Public Law 112-29—Sept. 16, 2011, 125 Stat. 284 through 125 Stat. 341.



1. RIM Generally Applauds the Proposed Rules for Post-Grant Review (PGR)

RIM appreciates the excellent work embodied in the Proposed Rules for PGR. The Proposed Rules are succinct yet provide meaningful guidance. They also provide flexibility by not over-specifying the manner in which trials or judicial review should be conducted, leaving freedom to the parties to manage the proceeding where possible. RIM thanks Lead Judge Tierney and the Board for the excellent work in preparing the Proposed Rules.

2. The Patent Office Should Provide the Resources Necessary to Conduct All PGRs Requested

The Proposed Rules provide that the Director may impose a limit on the number of PGRs that may be requested in each of the first four one-year periods in which 35 U.S.C. 321 is in effect.³ RIM respectfully requests that the Patent Office provide the resources to cover the demand that may exist for PGRs by applying the fees obtained for initiating such proceedings.

3. The Patent Trial and Appeal Board (Board) Should State the Reason(s) for Denial of a PGR

The Board should state the reason(s) for denying any ground of a request for PGR. This will enable the petitioner, the patent owner and the public generally to know the reason for denial, which may help interested parties to understand the proper scope of a patent claim. For example, a petitioner may incorporate in its petition the claim language used by a patent owner in an assertion against the petitioner. In this circumstance, the Board's explicit statement that the claim language has been interpreted too broadly in the petition using the patent owner's claim interpretation may enable the parties to settle a dispute.

Our proposed revision is indicated in bold and underlining as follows:

§ 42.208 Institution of post-grant review.

(a) When instituting post-grant review, the Board may authorize the review to proceed on all or some of the challenged claims and on all or some of the grounds of unpatentability asserted for each claim.

(b) At any time prior to institution of post-grant review, the Board may deny some or all grounds for unpatentability for some or all of the challenged claims. Denial of a ground is a Board decision not to institute post-grant review on that ground. **The Board shall provide a written statement explicitly stating each reason for denial of the ground.**

(c) *Sufficient grounds.* Post-grant review shall not be instituted for a ground of unpatentability, unless the Board decides that the petition supporting the ground would, if un rebutted, demonstrate that it is more likely than not that at least one of the

³ Federal Register, Vol. 77, No. 28, Friday, February 10, 2012, Proposed Rules, p. 7079 – 37 C.F.R. §42.202(b), as proposed.



claims challenged in the petition is unpatentable. The Board's decision will take into account a preliminary patent owner response where such a response is filed.⁴

4. The Board Should Authorize Motions for Supplemental Information After One Month of Institution of a Trial When New Issues are Raised by the Patent Owner

The Proposed Rule provides that once a trial has been instituted, a petitioner may request authorization to file a motion identifying supplemental information relevant to a ground for which the trial has been instituted, and that this request must be made within one month of the date on which the trial is instituted. However, it is possible that the patent owner will raise new issues such as the introduction of secondary reasons for nonobviousness after this time period in response to which the petitioner may desire to submit supplemental information. Therefore, we propose modification to the proposed rule as follows:

§ 42.223 Filing of supplemental information.

Once a trial has been instituted, a petitioner may request authorization to file a motion identifying supplemental information relevant to a ground for which the trial has been instituted. The request must be made within one month of **(a) the date the trial is instituted or (b) the filing of any submission raising a new issue for a ground to which the supplemental information would be informative or responsive.**⁵

The above modification will ensure that a party has the opportunity to introduce supplemental evidence relevant to a new issue introduced by another party which is permitted in the proceeding by a Judge or the Board. This modification ensures that a party has an opportunity to respond to a new issue raised by another party, in conformance with Due Process of Law under the 5th Amendment.

⁴ Federal Register, Vol. 77, No. 28, p. 7080 – 37 C.F.R. §42.208, as proposed.

⁵ Federal Register Vol. 77 No. 28, p. 7080 – 37 C.F.R. §42.223, as proposed .



Conclusion

RIM appreciates the opportunity to comment on the Proposed Rules. RIM believes that the modifications to the rules proposed above will greatly enhance usefulness of the Post-Grant Review for the petitioner, patent owner, and other interested parties. The Patent Office is requested to seriously consider and adopt these proposals to enhance to improve the benefits and efficiencies obtainable through Post-Grant Review.

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, appearing to read "Jon M. Jurgovan", is written over a horizontal line. The signature is fluid and cursive.

Jon M. Jurgovan
Director, Patent Strategy