March 5, 2012

Mail Stop Comments – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Nicole D. Haines, Legal Advisor
Office of Patent Legal Administration
Office of the Associate Commissioner for Patent Examination Policy

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 the Preissuance Submission by Third Parties Provision of the Leahy-Smith America Invents Act[1] ("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. 3, Thursday, January 5, 2012, pp.448-457.
[2] Public Law 112–29—Sept. 16, 2011, 125 Stat. 284 *through* 125 Stat. 341.

1. **The Patent Office should Notify a Third Party when a Preissuance Submission has been Accepted by the Patent Office**

The Patent Office should notify a third party when its preissuance submission has been accepted into the application file for consideration by the examiner. This would apply to submissions in which the third party has included a correspondence address along with the submission. This will allow the submitter to know the current status of the submission and whether any follow up is needed. The Propose Rules currently state that the Patent Office will not notify the third party under this circumstance.[3]

2. **The Patent Office should Notify a Petitioner when a Preissuance Submission is Defective**

The third party should be notified in the event the request is deemed not to comply with applicable rules. This would apply to those instances in which a Petitioner has provided a correspondence address with the submission. In addition, the third party should be afforded an opportunity to correct a defective petition or to explain why the petition complies with the rules. This will facilitate submission of relevant publications for substantive examination. There is currently no provision in the Proposed Rules addressing notification of the third party of a defective petition or providing the third party an opportunity to correct a defective submission.

3. **The Patent Office should Notify an Applicant when a Preissuance Submission has been filed against its Patent Application**

The PTO should promptly notify the applicant when a preissuance submission has been filed against its patent application. This will provide the applicant with additional time in which to consider the cited art and thereby lead to greater preparedness for the applicant to improve efficiency in the examination process. The Propose Rules currently state that the Patent Office will not notify the applicant under this circumstance.[4]

4. **The Patent Office should Protect the Anonymity of the Third party if so desired**

The rules should expressly state that third parties may remain anonymous if they so desire when providing preissuance submissions to the Patent Office. A third party will be more likely to submit relevant publications when they are assured the applicant will not be able to retaliate against them through knowledge of their identities.[5]

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[3] Proposed Rules – Changes to Implement the Preissuance Submissions by Third Parties Provision of the Leahy-Smith America Invents Act, Federal Register, Vol. 77, No. 3, Thursday, January 5, 2012, pp.449-450.

[4] *Id.*

[5] The AIA already has a similar provision for third partys of ex parte reexaminations to remain anonymous. Federal Register/ Vol. 77, No. 3/ Thursday, January 5, 2012 / Proposed Rules, p. 445.

5. The Patent Office should provide that Examiners will read the Concise Statements of Relevance of Submitted Publications

The rules should expressly require that examiners read a third party's statement of relevance of publications in a preissuance submission. This will ensure that the expertise of third parties is utilized by examiners in the examination process.

6. The Patent Office should Indicate in the Rules that the Standard of "potential relevance to the examination of the application" is intended to be a Low Threshold

According to 35 USC 122(e) of the AIA and the proposed regulations, preissuance submissions are to be of "potential relevance to the examination of the application". This 'potential relevance' standard is a low standard to encourage third parties to submit potentially relevant information. The rationale embodied in the AIA is to use third party expertise to increase the quality of information available to examiners when conducting substantive examination. The intent embodied in the AIA is thereby to improve patent quality. Preissuance submissions which are not frivolous or submitted solely to harass an applicant of a patent application should be liberally accepted by the Patent Office and entered into the file for careful consideration by the examiner. In other words, it should be extremely rare for the Patent Office to refuse to enter third party preissuance submissions in the record and to have the examiner consider the reasoned statement of relevance along with the submitted publication.

7. Clarification that Third Party is not Precluded from Presenting Arguments in Other Proceedings or Actions

The rules should expressly state that the third party is not precluded from raising arguments based on statements or publications in a preissuance submission in other proceedings or actions. Because the third party does not have the opportunity to present or discuss its preissuance submissions with the Patent Office and has limited control over whether and how the examiner chooses to apply the submitted information, it should be clear in the rules that the third party will have a fair opportunity to correct any oversight or misapprehension an examiner may have had regarding a preissuance submission. Such a provision would emphasize that the rules comport with due process of law and will lead to further improvement in patent quality by not excluding or discouraging presentation of meritorious arguments concerning the proper scope of claims of an application.

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 preissuance submission procedure for third parties as well as patent applicants. The Patent Office is requested to seriously consider and adopt these proposals to enhance to improve efficiency in substantive examination as well as to improve the quality of patents ultimately issuing from the Patent Office.

If there are any questions related to our proposals, please contact me at +1-972-556-2605.

Respectfully Submitted,

RESEARCH IN MOTION CORPORATION

Jon M. Jurgovan
Director, Patent Strategy