



April 9, 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
Rules of Practice for Trials Before the Patent Trial and Appeal Board and
Judicial Review of Patent Trial and Appeal Board Decisions

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 the Rules of Practice for Trials and Judicial Review¹ ("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. 27, Thursday, February 9, 2012, pp.6879-6914.

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



1. RIM Generally Applauds the Proposed Rules for Trials Before the Patent Trial and Appeal Board (Board) and Judicial Review of Board Decisions

RIM appreciates the excellent work embodied in the Proposed Rules for Trials and Judicial Review. 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 and discovery where possible. RIM thanks the Board for the excellent work in preparing the Proposed Rules.

2. RIM Supports the Provisions for Sanctions in the Proposed Rules

RIM applauds the proposed rule concerning sanctions as proposed by the Board.³ RIM appreciates the Board's willingness to use its sanction authority when necessary to curb abuses in proceedings.

3. RIM Generally Agrees with the Proposed Fees for Inter Partes Review (IPR), Post-Grant Review (PGR), Covered Business Method (CBM); Derivation Fees Appear Too Low

RIM supports the fee levels set by the Board for the IPR, PGR and CBM proceedings. RIM generally supports the proposal that the petitioner in the proceeding should share in its costs. However, in cases where the proceeding is necessitated by the patent owner's assertion of claims which are clearly overbroad, RIM supports transferring at least some of the fee burden to the patent owner. Similarly, if the patent owner protracts the proceeding by insisting on overly-broad claims, RIM supports imposition of at least some of the costs of the proceeding to the patent owner and their recovery by the petitioner. This could be accomplished by appropriate sanctions, for example.

The Derivation fee appears to us too low⁴ and would not approach covering the cost of the proceeding. In our view, this low level may invite those with questionable claims to file a derivation proceeding in the hope of capitalizing upon other's innovations. We suggest the Patent Office increase the fee to a level sufficiently high to cover a significant portion of the cost of the proceeding and thereby discourage frivolous proceedings.

4. The Board Should Allow Additional Discovery When a Party Raises a New Issue in the Proceeding

RIM generally agrees that a moving party seeking additional discovery should show that the additional discovery is in the interests of justice, as provided in the proposed rule. However, RIM's view is that additional discovery should be permitted when it is needed to respond to any new issue raised by a party. RIM proposes to modify the proposed rule as indicated in bold and underlining below:

³ Federal Register Vol. 77, No. 27, Thursday, February 9, 2012, pp.6909 - 37 C.F.R. §42.12 Sanctions, as proposed.

⁴ The proposed fee is \$400.00 for filing a petition to initiate a derivation proceeding. Federal Register Vol. 77, No. 27, Thursday, February 9, 2012, pp.6909 - 37 C.F.R. §42.15 Fees, as proposed.



§ 42.51 Discovery.

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(c) *Additional discovery.* (1) A party may move for additional discovery. Except in post-grant reviews, the moving party must show that such additional discovery is in the interests of justice. **Additional discovery is generally in the interests of justice when it is necessary to respond to a new issue raised by a party and permitted by the Board in a proceeding, or to provide information relevant thereto.**

The Board may specify conditions for such additional discovery.

This modification explicitly emphasizes that the proposed rule complies with basic principles of fairness and due process of law.

5. The Board Should Provide that a Party Requesting Discovery Pays for the Discovery Unless Otherwise Agreed

RIM generally agrees with the concept embodied in proposed 37 C.F.R. §42.53(f) in which the party requesting direct testimony pays for it. RIM would like to extend this concept to discovery in general by inclusion of the following in proposed rule 37 C.F.R. §42.51.

§ 42.51 Discovery.

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(d) *Costs of discovery.* Each party shall bear the costs of the discovery that such party seeks unless otherwise agreed by the parties or ordered by the Board.

This provision helps to ensure that the parties to a proceeding will use discovery judiciously. This will help to accomplish the stated goal of the proposed rules, namely, to achieve just, speedy, and inexpensive resolution of proceedings before the Board.⁵

6. RIM Strongly Agrees with the Requirement to provide an English Translation of Any Document Relied Upon in a Proceeding

RIM agrees that an English translation that is relied upon by a party should be made available to the other party, as set forth in proposed rule 37 C.F.R. §42.63(b). This is especially important given the limited time for conducting a proceeding and the limited availability of translation services for many languages.

⁵ Federal Register, Vol. 77, No. 27, p. 6907 – proposed 37 C.F.R. §42.1(b).



Conclusion

RIM appreciates the opportunity to comment on the Proposed Rules regarding Trials and Judicial Review. RIM believes that the modifications to the rules proposed above will greatly enhance usefulness of the IPR, PGR, CBM and Derivation proceedings for petitioners, patent owners and third parties. The Board is requested to seriously consider and adopt these proposals to accomplish the stated goal of just, speedy and inexpensive resolution of proceedings before the Board.

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