

From: Jon Jurgovan
Sent: Tuesday, October 02, 2012 3:39 PM
To: fitf_guidance
Subject: Examination Guidelines for Implementing the First-Inventor-to-File Provisions of the Leahy-Smith America Invents Act (Docket No. PTO-P-2012-0024)

Hello,

Attached please find comments from Research In Motion, Ltd. ("RIM") regarding the Examination Guidelines for Implementing the First-Inventor-to-File Provisions of the Leahy-Smith America Invents Act (Docket No. PTO-P-2012-0024).

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

Best Regards,

Jon M. Jurgovan
Patent Attorney
Director, Patent Strategy
Standards and Licensing Group



Research In Motion Corporation

5000 Riverside Drive
Brazos West, Building 5
3rd Floor, Room 351
Irving, TX 75039

☎ (972) 556.2605 | 📠 (972) 310.1197 | * jjurgovan@rim.com | RIM Phone 820.63605
| FAX (972) 409.1268

RIM CONFIDENTIAL INFORMATION

NOTE: The preceding e-mail message (including any attachments) contains information that may be confidential, be protected by the attorney-client or other applicable privileges, or constitute non-public information. It is intended to be conveyed only to the designated recipient(s). If you are not an intended recipient of this message, please notify the sender by replying to this message and then delete it from your system. Use, dissemination, distribution, or reproduction of this message by unintended recipients is not authorized and may be unlawful.

This transmission (including any attachments) may contain confidential information, privileged material (including material protected by the solicitor-client or other applicable privileges), or constitute non-public information. Any use of this information by anyone other than the intended recipient is prohibited. If you have received this transmission in error, please immediately reply to the sender and delete this information from your system. Use, dissemination, distribution, or reproduction of this transmission by unintended recipients is not authorized and may be unlawful.



October 2, 2012

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

Attn: Mary C. Till, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy

RE: *Examination Guidelines for Implementing the First –Inventor-to-File Provisions of the Leahy-Smith America Invents Act* (Docket No. PTO-P-2012-0024)

Dear Ms. Till:

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 request for comments entitled *Examination Guidelines for Implementing the First –Inventor-to-File Provisions of the Leahy-Smith America Invents Act* (hereinafter the “Proposed Guidelines”).¹ The Proposed Examination Guidelines 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 Examination Guidelines for Implementing the First –Inventor-to-File Provisions of the Leahy-Smith America Invents Act

RIM appreciates the excellent work and thoughtfulness embodied in the Proposed Guidelines. The Proposed Guidelines are a collaborative, balanced effort to provide meaningful guidance for transitioning to a new first-to-file system. At the same time, the Proposed Guidelines 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 Guidelines, particularly in light of the complexity of the patent laws to be implemented.

¹ 77 Fed. Reg. 43759-73 (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 Inability to Correct Inadvertent Addition of Claims or Mistaken References to Pending Patent Applications May Lead to Inappropriate Inequitable Conduct Charges Which Could Result in Patent Invalidation

The Proposed Guidelines indicate that a patent application will be evaluated under the AIA if a patent application “contains or contained at any time a claimed invention that has an effective filing date that is on or after March 16, 2013.”³ Such a rule would apply even if the application claims are cancelled or if the application is amended to delete the reference to a continuation, divisional, or continuation-in-part.⁴

In the notice of proposed rulemaking entitled *Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America Invents Act*, The Office appears to have considered and allowed for the situation in which an applicant fails to timely provide a statement indicating that claims or subject matter having an effective filing date after March 16, 2013 but claims benefit to an application filed before March 16, 2013.⁵ Specifically, an Applicant may provide a statement “and then later indicate...that the nonprovisional application contains a claim having an effective filing date on or after March 16, 2013.”⁶ The Office also appears to have allowed for the situation in which an applicant “later seeks to retract a previous statement that the nonprovisional application contains a claim having an effective filing date on or after March 16, 2013.”⁷

However, the Office does not appear to have considered the scenario in which an applicant inadvertently or mistakenly fails to submit a statement at any time. Such a situation may arise if, for example, during prosecution of a patent application filed after March 16, 2013 but claiming benefit to a filing date prior to March 16, 2013, the applicant amends or adds claim(s) believing that the claim(s) is supported by the written description in the patent application. Later, the applicant realizes that the claim is not supported by the specification and then cancels the claim. No statement is filed but the subsequently issued patent is now the subject of a patent infringement legal action. The opposing party files an inequitable conduct action for failing to disclose that the patent application contained at one time a claimed invention having an effective filing date after March 16, 2013. The relief sought is invalidation of the issued patent.

For at least the above mentioned reason, we recommend that The Office provide for instances of inadvertent additions of claims and/or references. We believe that this would be consistent with the Reissue provisions of the current patent law.⁸ The current Proposed Guidelines draw a bright line which does not allow an applicant any recourse but to be examined under the new AIA rules even when such additions were unintentional. Similar to a reissue oath, we recommend that The Office provide that an applicant is able to submit an affidavit indicating that the mistake was inadvertent and enable an applicant to amend the patent application and be

³ 77 Fed. Reg. 43772-73 (proposed July 26, 2012) (to be codified at 37 C.F.R. pt. 1).

⁴ *Id.*

⁵ See 77 Fed. Reg. 43745 (proposed July 26, 2012) (to be codified at 37 C.F.R. pt. 1).

⁶ *Id.*

⁷ *Id.*

⁸ See MPEP § 1401 (8th ed. Rev. 9, Aug. 2012)



examined under the pre-AIA Examination Guidelines.

Therefore, we suggest amending the Proposed Guidelines as follows:

AIA 35 U.S.C. 102 and 103 take effect on March 16, 2013. AIA 35 U.S.C. 102 and 103 apply to any patent application that contains or contained at any time a claimed invention that has an effective filing date that is on or after March 16, 2013. If a patent application contains or contained at any time a claimed invention having an effective filing date on or after March 16, 2013, 35 U.S.C. 102 and 103, as amended by the AIA, apply to the application. If even a single claim in the application ever has an effective filing date on or after March 16, 2013, AIA 35 U.S.C. 102 and 103 apply in determining the patentability of every claim in the application. This is the situation even if the remaining claimed inventions all have an effective filing date before March 16, 2013, and even if the claimed invention having an effective filing date on or after March 16, 2013, is canceled.⁹ However, in the event that a claim having an effective filing date on or after March 16, 2013 was inadvertently added at any time to a patent application having an effective filing date or claiming the benefit of an effective filing date before March 16, 2013, an applicant may sign and swear to an oath or file a declaration made by the inventor(s) indicating that the claims were inadvertently added.

In addition, AIA 35 U.S.C. 102 and 103 apply to any patent application that contains or contained at any time a specific reference under 35 U.S.C. 120, 121, or 365(c) to any patent or application that contains or contained at any time a claimed invention that has an effective filing date that is on or after March 16, 2013. Thus, AIA 35 U.S.C. 102 and 103 apply to any patent application that was ever designated as a continuation, divisional, or continuation-in-part of an application that contains or contained at any time a claimed invention that has an effective filing date that is on or after March 16, 2013. This is the situation even if the application is amended to delete its reference as a continuation, divisional, or continuation-in-part to the prior-filed application, and even if the claimed invention having an effective filing date on or after March 16, 2013, in the prior filed application, is canceled.¹⁰ However, in the event that a specific reference was inadvertently added to any patent or application that contains or contained at any time a claimed invention having an effective filing date on or after March 16, 2013 but has an effective filing date or claims the benefit of an effective filing date before March

⁹ *Id.* at 43772-73.

¹⁰ *Id.* at 43773.



16, 2013, an applicant may sign and swear to an oath or file a declaration made by the inventor(s) indicating that the specific reference was inadvertently added.

3. 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 but 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 Guidelines as follows:

The Office is concurrently proposing the following amendments to 37 CFR 1.55 and 1.78 a separate action (RIN 0651-AC77). First, the Office is proposing to require that if a nonprovisional application filed on or after March 16, 2013, claims the benefit of or priority to the filing date of a foreign, U.S. provisional, U.S. nonprovisional, or international application that was filed prior to March 16, 2013, and also contains or contained at any time a claimed invention having an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect. Second, the Office is proposing to require that if a nonprovisional application filed on or after March 16, 2013, does not contain a claim to a claimed invention having an effective filing date on or after March 16, 2013, but discloses subject matter not also disclosed in the foreign, provisional, or nonprovisional application, the applicant must provide a statement to that effect. This information will assist the Office in determining whether the application is subject to AIA 35 U.S.C. 102 and 103 or pre-AIA 35 U.S.C. 102 and 103.¹¹ Such statements may be made by checking the corresponding acknowledgment box on the application data sheet.

4. Allow for the Parties in a Joint Research Agreement to be Addressed in the Arrangement of Application Elements Section of the Patent Application

The Proposed Guidelines indicate that one of the conditions that must be satisfied in order to apply provision 35 U.S.C. 102(b)(2)(C) is that the patent application must list the "names of the parties to the joint research agreement."¹² We recommend that such a listing be included and addressed as part of 1 CFR Part 37, Part 1 § 1.77 entitled *Arrangement of*

¹¹ *Id.*

¹² *Id.* at 43771.



application elements. The specific provision which would be affected by this section is as follows:

35 U.S.C. 102(c) provides that subject matter disclosed, which might otherwise qualify as prior art, and a claimed invention are treated as having been owned by the same person or subject to an obligation of assignment to the same person in applying the provisions of 35 U.S.C. 102(b)(2)(C) if three conditions are satisfied. First, the subject matter disclosed must have been developed and the claimed invention must have been made by, or on behalf of, one or more parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention. The AIA defines the term “joint research agreement” as a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention. Second, the claimed invention must have been made as a result of activities undertaken within the scope of the joint research agreement. Third, the application for patent for the claimed invention must disclose, or be amended to disclose, the names of the parties to the joint research agreement in accordance with §1.77 Arrangement of application elements section of 1 CFR Part 37, Part 1. Proposed 37 CFR 1.104(c)(4)(ii) pertains to joint research agreement subject matter under AIA 35 U.S.C. 102 and 103, and proposed 37 CFR 1.104(c)(5)(ii) pertains to joint research agreement subject matter under pre-AIA 35 U.S.C. 102 and 103. If these conditions are met, the joint research agreement prior art is not available as prior art under 35 U.S.C. 102(a)(2).¹³

5. The Requirement that Only the “Same Subject Matter” Be Allowed to Invoke the 35 U.S.C. 102(b)(1)(B) Exception Is Counterintuitive to the Intent of the Statute and Renders 35 U.S.C. 102(b)(1)(B) and 35 U.S.C. 102(b)(2)(B) Useless

The AIA provides exceptions to the prior art provisions of or 35 U.S.C. 102(a). Specifically, the AIA provides 35 U.S.C.102(b)(1)(B) and 35 U.S.C. 102(b)(2)(B) disqualifies disclosures of “*subject matter...*[that has] been publically disclosed by the inventor or a joint inventor or another who obtained the *subject matter* disclosed directly or indirectly from the inventor or a joint inventor.”¹⁴ The Proposed Guidelines indicate that such subject matter must be the “same ‘subject matter,’ and prior art with “mere insubstantial changes, or only trivial or obvious variations” cannot invoke the exceptions under 35 U.S.C.102(b)(1)(B) and 35 U.S.C. 102(b)(2)(B).¹⁵

¹³ *Id.*

¹⁴ Pub. L. No. 112-29, 125 Stat. 284-341 (2011) (emphasis added).

¹⁵ 77 Fed. Reg. 43767 & 43769 (proposed July 26, 2012) (to be codified at 37 C.F.R. pt. 1) (emphasis added).



In essence, according to the Proposed Guidelines, only an exact copy of the later filed application appears to be the only acceptable disclosure for which the exceptions may apply. Such a result appears to be counterintuitive to the intent of the statute and essentially renders the statutory exceptions useless.

As such, we recommend that the requirement that subject matter eligible to invoke the exceptions be the same subject matter be deleted. Specifically, we recommend that the following sections with the Proposed Guidelines be edited as follows:

~~The exception in 35 U.S.C. 102(b)(1)(B) applies if the “‘subject matter’ disclosed [in the prior art disclosure] had, before such [prior art] disclosure, been publicly disclosed by the inventor or a joint inventor * * * .” Thus, the exception in 35 U.S.C. 102(b)(1)(B) requires that the subject matter in the prior disclosure being relied upon under 35 U.S.C. 102(a) be the same “subject matter” as the subject matter publicly disclosed by the inventor before such prior art disclosure for the exception in 35 U.S.C. 102(b)(1)(B) to apply. Even if the only differences between the subject matter in the prior art disclosure that is relied upon under 35 U.S.C. 102(a) and the subject matter publicly disclosed by the inventor before such prior art disclosure are mere insubstantial changes, or only trivial or obvious variations, the exception under 35 U.S.C. 102(b)(1)(B) does not apply.¹⁶~~

~~As discussed previously with respect to 35 U.S.C. 102(b)(1)(B), the exception in 35 U.S.C. 102(b)(2)(B) requires that the subject matter in the prior disclosure being relied upon under 35 U.S.C. 102(a) be the same “subject matter” as the subject matter publicly disclosed by the inventor before such prior art disclosure for the exception in 35 U.S.C. 102(b)(2)(B) to apply. Even if the only differences between the subject matter in the prior art disclosure that is relied upon under 35 U.S.C. 102(a) and the subject matter publicly disclosed by the inventor before such prior art disclosure are mere insubstantial changes, or only trivial or obvious variations, the exception under 35 U.S.C. 102(b)(2)(B) does not apply.¹⁷~~

Alternatively, we propose that an acceptable standard for determining whether the claimed subject matter was described printed publication may be whether *one of ordinary skill in the art* would consider the claimed subject matter to be that of described in the printed publication. Such a standard already exists for other patent determinations and may be a standard easily applied in this scenario as well.

6. The Office Should Require Corroborating Evidence from an Inventor to Prove Entitlement to a Prior Art Exception under AIA 35 U.S.C. § 102(b) (AIA §102(b))

The Office should require corroborating evidence from an inventor to prove entitlement to a prior art exception under AIA §102(b). This practice would be consistent with the current

¹⁶ *Id.* at 43767.

¹⁷ *Id.* at 43769.



system in which, for example, inventor testimony regarding conception or reduction to practice are not given evidentiary weight unless supported by corroborating evidence.¹⁸ This practice should be extended to the exceptions under AIA §102(b) due to the inventor's self-interest in obtaining patent protection. Exemplary language that could be added to the Proposed Guidelines to accomplish this result could be as follows:

1. Prior Art Exception Under 35 U.S.C. 102(b)(1)(A) to 35 U.S.C. 102(a)(1)

* * *

Grace period non-inventor disclosure: 35 U.S.C. 102(b)(1)(A) also provides that a disclosure which would otherwise qualify as prior art under 35 U.S.C. 102(a)(1) is not prior art if the disclosure was made: (1) One year or less before the effective filing date of the claimed invention; and (2) by another who obtained the subject matter directly or indirectly from the inventor or a joint inventor. Thus, if the disclosure upon which the rejection is based is by someone who obtained the subject matter from the inventor or a joint inventor, the inventor could provide an affidavit or declaration which may overcome the rejection. However, in this case, substantial corroborating evidence is required to support inventor's testimony, as is required in all cases in which the inventor's testimony is relied upon by the applicant to prove entitlement to a prior art exception under §102(b). This is similar to the current practice of requiring corroboration of inventor testimony in providing a date of invention.

2. Prior Art Exception Under 35 U.S.C. 102(b)(1)(B) to 35 U.S.C. 102(a)(1)

* * *

An affidavit or declaration under 37 CFR 1.130(a)(1) could be used to establish that the subject matter disclosed had been publicly disclosed by the inventor or a joint inventor before the disclosure of the subject matter on which the rejection is based. Such an affidavit or declaration under 37 CFR 1.130(a)(1) must establish that the subject matter disclosed in the cited prior art had been publicly disclosed by the inventor or a joint inventor before the disclosure of the subject matter on which the rejection is based. Specifically, the inventor or joint inventor must establish the date and content of their earlier public disclosure. If the earlier disclosure was a printed publication, the affidavit or declaration

¹⁸ E.g., MPEP § 2138.04 (8th ed. Rev. 9, Aug. 2012).



must be accompanied by a copy of the printed publication. If the earlier disclosure was not a printed publication, the affidavit or declaration must describe the earlier disclosure with sufficient detail and particularity to determine that the earlier disclosure is a public disclosure of the subject matter. Substantial corroborating evidence is required in cases in which the inventor's testimony is relied upon by the applicant to prove entitlement to a prior art exception under §102(b).

2. Prior Art Exception Under 35 U.S.C. 102(b)(2)(A) to 35 U.S.C. 102(a)(2)

* * *

Non-Inventor Disclosure Exception: 35 U.S.C. 102(b)(2)(A) provides that a disclosure which would otherwise qualify as prior art under 35 U.S.C. 102(a)(2) is not prior art if the disclosure was made by another who obtained the subject matter directly or indirectly from the inventor or a joint inventor. This means that if the disclosure of the subject matter upon which the rejection is based is by another who obtained the subject matter from the inventor or joint inventor, then the inventor could provide an affidavit or declaration to establish that the inventor or joint inventor is the inventor of the subject matter of the disclosure and that such subject matter was communicated to the other entity. Thus, an applicant may benefit from the earlier disclosure by another during the grace period, if the applicant can establish that the inventor or a joint inventor is the actual inventor of the subject matter of the disclosure and that the subject matter was obtained directly or indirectly from the inventor or a joint inventor. Substantial corroborating evidence is required in cases in which the inventor's testimony is relied upon by the applicant to prove entitlement to a prior art exception under §102(b).

3. Prior Art Exception Under 35 U.S.C. 102(b)(2)(B) to 35 U.S.C. 102(a)(2)

* * *

As discussed previously, an affidavit or declaration under 37 CFR 1.130(a)(1) could be used to establish that the subject matter disclosed in the cited patent or published application to be disqualified had been publicly disclosed by the inventor or a joint inventor before the date the subject matter in the patent or published application to be disqualified was effectively filed. Specifically, the inventor or joint inventor must establish the date and content of their earlier public disclosure. If the earlier disclosure was a printed publication, the affidavit or declaration



must be accompanied by a copy of the printed publication. If the earlier disclosure was not a printed publication, the affidavit or declaration must describe the earlier disclosure with sufficient detail and particularity to determine that the earlier disclosure is a public disclosure of the subject matter. Substantial corroborating evidence is required in cases in which the inventor's testimony is relied upon by the applicant to prove entitlement to a prior art exception under §102(b).

Conclusion

RIM appreciates the opportunity to comment on the *Examination Guidelines for Implementing 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 Examination Guidelines. 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, reading 'Jon M. Jurgovan', is written over the typed name.

Jon M. Jurgovan
Director, Patent Strategy