



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
Practice Guide for Proposed Trial 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 Practice Guide for Proposed Trial Rules¹ ("Proposed Rules"). The Practice Guide for Proposed Trial Rules is 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.6868-6879.

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



1. RIM Generally Applauds the Practice Guide for Proposed Trial Rules

RIM appreciates the excellent work embodied in the Practice Guide for Proposed Trial Rules. The Practice Guide is succinct yet provides meaningful guidance. It also provides flexibility by not over-specifying the manner in which trials 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 Practice Guide.

2. RIM Suggests the Exemplary Time Period Provide for Discovery Parity between the Petitioner and Respondent

RIM understands the parties will have freedom to schedule a proceeding as desired within applicable time limitations. However, the example provided in the Practice Guide appears to favour the respondent relative to the petitioner in the amount of discovery afforded in the exemplary schedule set forth in the Practice Guide on p. 6869. This could be interpreted as supporting a bias favouring the Patent Owner/ Respondent in the amount of discovery afforded to such party.

In particular, RIM proposes that the first PO Discovery Period be decreased from 4 months to 2 months, and that the Petitioner Discovery Period be increased from 2 to 3 months. This would provide equal opportunity for the petitioner and patent owner to obtain discovery at 3 months each.³ Because the Patent Owner has 5 months from filing the petition to prepare for discovery, the Patent Owner/Respondent should not be disadvantaged, and the Petitioner should have better opportunity to respond to new issues raised by the Patent Owner in response to the petition or following a motion to amend.⁴

3. RIM Suggests Further Guidance Be Provided Regarding When and How Rules May Be Modified

The Practice Guide provides that rules are to be implemented so as to ensure the just, speedy, and inexpensive resolution of a proceeding and, where appropriate, the rules may be modified to accomplish these goals.⁵ RIM requests further clarification of the circumstances under which the rules may be modified. For example, may the petitioner or patent owner file motions to modify the rules? Or is the authority to modify the rules strictly within the Board's discretion? Clarification of these points would be helpful.

4. RIM Strongly Agrees that the Board should provide a Statement as to Why Requirements for Instituting a Trial Were Not Met in the Board's Decision

RIM strongly agrees that the Board's Decision not to institute a proceeding should include a statement of the reasons why the Board refused to institute the proceeding.⁶ In many cases, the Board's statement can be helpful in resolving a dispute, for example, where the patent

³ The patent owner/respondent would then have a total of 3 months of discovery including a first discovery period of 2 months and a second discovery period of 1 month.

⁴ Federal Register, Vol. 77 No. 27, Thursday, February 9, 2012, Proposed Rules, p.6869.

⁵ Federal Register, Vol. 77 No. 27, Thursday, February 9, 2012, Proposed Rules, p.6869-6870.

⁶ Federal Register, Vol. 77 No. 27, Thursday, February 9, 2012, Proposed Rules, p.6874.



owner takes an overly broad interpretation of claim language in reading it upon the respondent's technology in a patent dispute. A statement explaining the reasons for the Board's decision can be very helpful toward resolving a dispute between the petitioner and the patent owner/respondent.

5. The Board Should Allow Additional Motions When Necessary to Respond to a New Issue Raised by an Opposing Party

RIM proposes that the Practice Guide explicitly acknowledge that additional motions are permissible when necessary to respond to a new issue raised by an opposing party. For example, if the patent owner/respondent intends to rely upon objective evidence of nonobviousness, then the petitioner should be afforded the opportunity to file a motion to exclude such evidence. This could be achieved by addition of the language indicated in bold and underline below:

E. Initial Conference Call (One Month After Instituting Trial.

* * *
However, the Board may require prior authorization to file an additional motion and the set times are not likely to change as a consequence of the new motion. **Nonetheless, a party shall be afforded an opportunity to respond to a new issue raised in the proceeding.**⁷

This provision will help to ensure that a party is afforded the opportunity to respond to any new issue to accomplish the stated goal of the proposed rules, namely, to achieve just, speedy, and inexpensive resolution of proceedings before the Board.⁸

6. RIM Strongly Agrees that the Petitioner Should be Permitted to Supplement Evidence to Respond to New Issues Arising for Proposed Substitute Claims

The Practice Guide provides that the petitioner may supplement evidence to respond to new issues raised by a patent owner's submission of substitute claims.⁹ RIM strongly agrees that the petitioner should be afforded this opportunity to provide supplemental evidence, and believes this should be extended to any case in which a party introduces a new issue permitted by the Board in the proceeding.

⁷ Federal Register, Vol. 77 No. 27, Thursday, February 9, 2012, Proposed Rules, p.6874.

⁸ Federal Register, Vol. 77 No. 27, Thursday, February 9, 2012, Proposed Rules, p.6869.

⁹ Federal Register, Vol. 77 No. 27, Thursday, February 9, 2012, Proposed Rules, p.6875.



Conclusion

RIM appreciates the opportunity to comment on the Practice Guide. RIM believes that the modification to the Practice Guide as suggested above will greatly enhance its usefulness to petitioners, patent owners and third parties. The Board is requested to seriously consider and adopt this proposal 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.

Jon M. Jurgovan
Director, Patent Strategy