

Filed on behalf of Supercell Oy

By:

JENNIFER R. BUSH, Reg. No 50,784

MICHAEL J. SACKSTEDER

FENWICK & WEST LLP

801 California Street

Mountain View, CA 94041

Telephone: 650.988.8500

Facsimile: 650.938.5200

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

SUPERCCELL OY,  
Petitioner

v.

GREE, INC.,  
Patent Owner.

Post Grant Review No. PGR2018-00029  
Patent 9,636,583 B2

---

**PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY  
RESPONSE PURSUANT TO 37 C.F.R. §§ 42.23 AND 42.208(C)**

**TABLE OF AUTHORITIES**

**Page(s)**

**CASES**

*Alice Corp. Pty. V. CLS Bank Int’l*,  
134 S. Ct. 2347 (2014).....5

*Berkheimer v. HP Inc.*,  
Appeal 2017-1437, 2018 WL 774096  
(Fed. Cir. February 8, 2018) .....*passim*

*Content Extraction & Transmission LLC v. Wells Fargo Bank, N.A.*,  
776 F.3d 1343 (Fed. Cir. 2014) .....5

Pursuant to the Board’s June 8, 2018 Order, Petitioner Supercell Oy submits this Reply addressing *Berkheimer v. HP Inc.*, 881 F.3d 1360 (Fed. Cir. 2018).

**I. *Berkheimer* Supports Petitioner’s Position**

Patent Owner’s reliance on *Berkheimer* is misplaced. Although *Berkheimer* holds, in the context of Step 2 of the *Alice* test, whether “a claim element or combination of elements is well-understood, routine and conventional to a skilled artisan in the relevant field is a question of fact,” that conclusion by itself is far from dispositive, either in general or in the instant circumstances. *See Berkheimer*, 881 F.3d at 1368. Rather, no genuine dispute arises concerning patentability *unless* the challenged patent’s specification identifies one or more purported technological improvements to the prior art, and those improvements “are *captured in the claims.*” *Id.* at 1369 (emphasis added), *cited at* POPR, p. 22

Applying this analysis, *Berkheimer* affirmed the district court’s summary judgment finding of ineligibility of claims 1-3 and 9 because those claims *did not recite the purported improvement to computer functionality* described in the specification. *Id.* at 1370. The court reversed summary judgment of claims 4-7 only after finding that the specification-described improvement in computer functionality *was* captured in those claims. *Id.*

Here, like the ineligible claims in *Berkheimer*, the challenged claims fail to capture the alleged improvements of the specification. The ’583 patent

Patent No. 9,636,583 — Petitioner’s Reply to Patent Owner’s Preliminary Response specification, as the POPR admits, describes the problem proposed to be solved as: “a two-dimensional card in the battle scene is sometimes boring.” *See, e.g.*, POPR, pp. 2; 21; 23; 26; 30-31 (citing Ex. 1001, 1:42-43). As a preliminary matter, this is an aesthetic or business problem, not a technical one. *See, e.g.*, PGR2018-00008, Decision on Institution (Paper 15), p, 13. The POPR attempts to characterize the problem as one existing in the field of graphical user interfaces comparable to *Trading Techs. Int’l, Inc. v. CQG, INC.*, 675 F. App’x 1001, 1004 (Fed. Cir. 2017). *See* POPR, pp. 26-30. In that case, however, the patents solved a technical problem that existed with prior art GUIs, namely, that the best bid and best ask prices would change based on updates received from the market. *Id.* at 1002-03. The *Trading Technologies* patents recited a specific GUI with specific axes, regions for data, and rules delimiting the data in each region to allow a user to see and manipulate stock market data in real time, that resolved technical problems in the prior art. *Id.* at 1003-04. In contrast, the ’583 patent only purports to address a battle scene of the game described as “boring,” which is not a technical problem to be solved.

Even if the patent provided technological solutions to a problem rooted in computer technology, they are not captured in the claims. *Berkheimer* 881 F.3d at 1369. According to the POPR, seven different ways of showing the alleged improvement of “high visual effect” are described in the specification: (1) a battle “proceed[ing] in a format like a cartoon” (POPR, p. 2, citing 1:49-50; 6:42-46);

(2) “a battle display region divided by frames that can execute . . . in a predetermined order”; (3) “emphasize and display the panels” (POPR, p. 31, citing Ex. 1001, 6:36-38); the panels (4) can “display a still image”; (5) “display a movie when the panels are emphasized and displayed”; (6) “zoom in,” and frames of the panels that (7) have portions that can “display the texts showing the sound effect and/or an effect display portion” (*see* POPR, p. 31, citing Ex. 1001, 7:27, 7:36, 7:44-56).

All of these features, however, are *entirely absent* from independent claims 1, 14, and 15 (*see* Pet., p. 15), and some are absent from all of the claims. No claims recite the battle proceeding like a cartoon, nor displaying a movie, nor zooming in, nor a portion with text showing a sound effect. Thus, the POPR admits that *at least* independent claims 1, 14, and 15, and dependent claims 5-9 and 11-13 do not “capture” the alleged improvements described in the specification (“high visual effect”) and, therefore, present no fact issue under *Berkheimer*.

## **II. The Petition Contains Ample Evidence Under *Berkheimer***

Even if the Board were to conclude that one or more claims do capture the purported improvements, the facts still favor institution so that any dispute as to these facts may be put before the PTAB as the fact finder. *Id.* at 1369.

The POPR wrongly asserts that the Petition provided only attorney argument (*see* POPR, pp. 9, 21, 23). In fact the Petition provided ample support for its

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.