UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SUPERCELL OY,
Petitioner

v.

GREE, INC.,
Patent Owner

Case: PGR2018-00029
U.S. Patent No. 9,636,583

PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY TO PRELIMINARY RESPONSE

I. The Improvements of the '583 Patent are Captured in the Claims.

Petitioner asserts that "the challenged claims fail to capture the alleged improvements of the specification." Paper 16 ("Reply") at 1. Petitioner is wrong.

First, the problems solved by the '583 patent arise specifically from the technical field of two-dimensional computer card games. Ex. 2002, ¶ 27; Ex. 1001, 1:43-44. Although Petitioner attempts to characterize this field as presenting "an aesthetic or business problem," Petitioner presents no evidence that this is the case, citing only a non-precedential institution decision by a different panel of the Board. Reply at 1. Notably, Petitioner presents no evidence to directly contradict the specification and testimony of Patent Owner's expert, Mr. Crane on this point. Ex. 2002 ¶¶ 22-29. Petitioner also cites to no authority for the proposition that addressing user boredom in a video game—*i.e.*, visually improving the user's experience—is not a valid problem to be solved in this specific art. To the contrary, it is. Ex. 2002 ¶ 29; *see Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1339 (Fed. Cir. 2016) ("the claims are directed to a specific implementation of a solution to a problem in the software arts. Accordingly, we find the claims at issue are not directed to an abstract idea.")

Second, the improvements provided by the '583 patent are indeed captured in *all* the claims of the patent. According to the '583 patent, *panels* are able to, for example, "display a still image," "display a movie when the panels are emphasized

and displayed," and "zoom in." Ex. 1001, 7:27, 7:36, 7:55-56. Each and every independent claim of the '583 patent recites "panels." *See* claims 1, 14, 15. Petitioner's attempt to argue that panels as recited and captured in the independent claims possess none of the features that make the claims subject matter eligible—i.e., that these features are outside the scope of the independent claims—is nothing more than a belated claim construction argument that should have been raised in the petition but was not. Moreover, it is incorrect because it would unduly limit the claims to exclude the preferred embodiment of the claimed panels. *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996) (a claim construction that excludes a preferred embodiment is "rarely, if ever, correct").

A person of ordinary skill in the art of the '583 patent would also understand that the independent claims capture the improved visual interface described by the '583 patent. Ex. 2002 ¶¶ 57-59. As the '583 patent explains, "the game display screen 300 includes a battle display region 310 formed by one or more frames." Ex. 1001, 6:18-20. A person of ordinary skill in the art would understand that the independent claims describe and claim the invention as a game display divided into frames with panels disposed within. Ex. 2002 ¶¶ 50-52; 57-59. The independent claims thus cover the preferred embodiment of the '583 patent, and the preferred embodiment captures the improvements described throughout the specification of the '583 patent.

Third, Petitioner admits in its Reply that at least dependent claims 2-4 and 10 contain express limitations that capture aspects of the improvements disclosed in the specification of the '583 patent. Reply at 3. Petitioner wrongly alleges that the other dependent claims do not capture the improvements disclosed in the '583 patent. For example, dependent claim 5 recites "executing the divisions in which the panels are disposed by the panel layout function, based on panel information indicating characteristics of the panels disposed in the divisions." Ex. 1001, 54-57. The impact on the outcome of a battle based on the capabilities of panels is an aspect of the inventive gameplay mechanics disclosed—and claimed—in the '583 patent. Ex. 2002 ¶ 23. As another example, claim 11 recites "text display portions for displaying texts" and claim 12 recites frame portions that are "constructed in different colors." Ex. 1001, 10:6-7, 10:12-16. These are additional visual improvements described and claimed by the '583 patent. Ex. 2002 ¶ 29.

II. Under *Berkheimer*, the Petition Fails in its Burdens of Proof and Persuasion.

The specification of the '583 patent identifies known problems in the art, describes solutions to those problems, and claims them with specificity. Petitioner's assertions to the contrary are wrong, largely because Petitioner chose to analyze only isolated portions of the claim language—*e.g.*, "storing, selecting, disposing of, displaying, and emphasizing panels in a video game"—rather than the challenged claim limitations in their entirety, *and* as an ordered combination.

In other words, Petitioner failed to meet its burden. *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362 (Fed. Cir. 2015) (requiring the "consider[ation of] the elements of each claim both individually and as an ordered combination") (internal quotations and citation omitted).

Petitioner claims it identified "seven separate citations to evidence from the '583 specification and relies on nine different precedential cases." Reply at 4. First, precedential cases are not evidence, and none of those cases shows what was "well-understood, routine, and conventional" in the relevant art and at the time of the '583 patent. Rather, only Patent Owner offered evidence on that point, which establishes the claims recite patent-eligible subject matter. Second, the handful of citations by Petitioner are insufficient to meet Petitioner's burden—none of Petitioner's cites to the specification contradict improvements to a graphical user interface that the '583 patent describes and claims. For instance, Petitioner alleged "panels" were known in the art, citing 1:31-40 of the '583 patent. Pet. 22. But the cited portion contains no mention of panels at all, and Petitioner has not provided evidence as to why a person of ordinary skill would consider panels to be known in the art. Petitioner failed to meet its burden, and the petition should be denied.

Patent Owner does not suggest that there is any requirement for expert testimony in these proceedings. However, it was Petitioner's burden to proffer evidence—including expert testimony if it wished—in the Petition. Petitioner

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