

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 REQUEST FOR RECONSIDERATION OF
DECISION INSTITUTING POST-GRANT REVIEW**

I. Precise Relief Requested.

GREE, Inc. (“Patent Owner”) requests that the Board reconsider its decision to institute post-grant review of claims 1-15 of U.S. Patent No. 9,636,583 (“the ’583 patent”). Paper 21.

II. Legal Standard for Reconsideration.

Pursuant to 37 C.F.R. § 42.71(d), a party may request rehearing of a decision by the Board to institute a trial. “The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, opposition, or reply.” *Id.* The Board will review the previous decision for an abuse of discretion. 37 C.F.R. § 42.71(c). “An abuse of discretion may be indicated if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors.” IPR2013-00369, Paper 39 at 2-3 (citing *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005)).

III. Factual Background.

Petitioner Supercell Oy (“Petitioner”) filed a petition requesting post-grant review of claims 1-15 of the ’583 patent on February 1, 2018. Petitioner alleged that the “Background section of the patent describes a prior art card game played on an electronic apparatus such as a smart phone or tablet, which is similar to the claimed invention of the independent claims.” Paper 1 at 14. Petitioner also

alleged that “[s]toring, selecting, and disposing of a ‘panel’ containing game information, as noted in the background of the ’583 specification, were previously well known in the art.” Paper 1 at 22 (citing Ex. 1001, 1:31-40). However, the Background of the ’583 specification does not mention the term “panel,” (*see* Ex. 1001, 1:28-45) nor did Petitioner identify any other evidence to support its argument that taking these actions regarding a “panel” was well-known.

In the Preliminary Response, Patent Owner stated that “use of ‘panels’ in the manner described and claimed by the ’583 patent was previously unknown in the art at the time of the invention.” Paper 13 at 30. Patent Owner further provided evidence as to why “panels” as claimed in the ’583 patent were not well-known, routine, or conventional in the art at the time of the ’583 patent. Paper 13 at 30-34 (citing Ex. 2002, ¶¶ 22-30).

In the Institution Decision, the Board stated that the ’583 patent “relates generally to a method of displaying a battle scene for a computer game in which users do battle against each other using cards or ‘panels’ collected in the game.” Paper 21 at 2 (citing Ex. 1001, 1:31-44, 4:18-22). In preliminarily determining that the challenged claims of the ’583 patent did not contain an “inventive concept” under *Alice* step two, the Board stated that “the Background section of the ’583 patent itself describes a prior art card game played on an electronic apparatus, such as a smart phone or a tablet, where each player owns *cards* (*corresponding to*

‘panels’) which are used against another player in a game of rock-paper-scissors or the like.” Paper 21 at 16 (citing Paper 1 at 14–15 and Ex. 1001, 1:31–40) (emphasis added). The Board, however, cited to no evidence nor any assertion by Petitioner that the cards described in the Background correspond to the “panels” in the challenged claims.

IV. The Board’s Findings Overlook and Misapprehend the Record

The Board’s decision to institute post-grant review is an abuse of discretion. The Board misapprehended or overlooked significant evidence and misapprehended the arguments raised by Petitioner in concluding that “cards” corresponded to “panels” as claimed.

The Board’s rules require that Petitioner include all of its arguments and citations to supporting evidence in the petition. 37 C.F.R. § 42.204(b). However, nowhere in the petition did Petitioner argue that prior-art “cards” corresponded to the “panels” described and claimed in the ’583 patent, much less present evidence supporting such an argument. Rather, Petitioner merely stated that the ’583 patent describes “a prior art card game played on an electronic apparatus such as a smart phone or tablet, which is similar to the claimed invention of the independent claims.” Paper 1 at 14. And Petitioner provided no further evidence or explanation as how the prior art card game was similar to the panel-based game claimed by the ’583 patent. It was Petitioner’s burden to prove that “panels” as claimed by the

'583 patent were well-known in the art under *Alice* step two, and Petitioner failed to do so.

Notwithstanding Petitioner's failure to meet its burden, the Board determined that "panels" as recited in the claims corresponded to prior-art "cards." Paper 21 at 16. However, the Board offered no explanation for this conclusion. While the Board cited a portion of the background of the '583 specification—Exhibit 1001 at 1:31-40—to support this conclusion, the background of the '583 specification makes no mention of "panels" whatsoever. Thus, the Board failed to identify any evidence to support a finding that "panels" as claimed corresponded to prior-art "cards." Therefore, the Board's conclusion that "panels" were well-known, routine, and conventional in the art is based on an unsupported finding. Paper 21 at 16.

In contrast, Patent Owner provided substantial evidence and argument that "panels" as claimed by the '583 patent were not well-known, routine, or conventional in the art such that the challenged claims of the '583 patent recite a sufficiently inventive concept as to pass muster under *Alice* step two. Paper 13 at 30-34. For instance, Patent Owner provided the expert testimony of David Crane, who explained that "panels" as described and claimed in the '583 patent were an inventive concept. Ex. 2004 ¶¶ 22-30. The Board should not have ignored this un rebutted testimony as to what would have been known by a person of ordinary

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.