

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SUPERCELLOY,
Petitioner,

v.

GREE, INC.,
Patent Owner.

Case PGR2018-00029
Patent 9,636,583 B2

Before MICHAEL W. KIM, LYNNE H. BROWNE,
and CARL M. DEFRANCO, *Administrative Patent Judges*.

KIM, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING
37 C.F.R. § 42.71

I. INTRODUCTION

Supercell Oy (“Petitioner”) filed a Petition for post-grant review of claims 1–15 of U.S. Patent No. 9,636,583 B2 (Ex. 1001, “the ’583 patent”). Paper 1 (“Pet.”). GREE, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 13 (“Prelim. Resp.”). With our authorization, Petitioner filed a Reply to Patent Owner’s Preliminary Response (Paper 18) and Patent Owner filed a Sur-Reply (Paper 19). The Board issued a Decision granting institution of post-grant review. Paper 21 (“Dec.”). On September 4, 2018, Patent Owner filed a Request for Reconsideration of the Decision. Paper 23 (“Request;” “Req.”). For the reasons that follow, the Request is *denied*.

II. ANALYSIS

A request for rehearing must identify specifically all matters the requesting party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d). When rehearing a decision on institution, the Board will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c).

Independent claim 1 of the ’583 patent recites, in pertinent part, “a plurality of panels that the first user possesses,” “a plurality of panels that the second user possesses,” “a panel selection function,” and “a panel layout function.” Ex. 1001, 9:18–26.

In our Decision granting institution, we stated:

As noted by Petitioner, 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. Pet. 14–15 (citing Ex. 1001, 1:31–40).

Dec. 16 (emphasis added).

Patent Owner argues that the Board “misapprehended or overlooked significant evidence and misapprehended the arguments raised by Petitioner in concluding that ‘cards’ correspond to ‘panels’ as claimed.” Req. 3. Specifically, Patent Owner asserts that “nowhere in the petition did Petitioner argue that prior art ‘cards’ correspond to the ‘panels’ described and claimed in the ’583 patent, much less present evidence supporting such an argument,” and that the Board “cited to no evidence nor any assertion by Petitioner that the cards described in the Background correspond to the ‘panels’ in the challenged claims.” Req. 3. Hence, Patent Owner argues that “the Board’s conclusion that ‘panels’ were well-known, routine, and conventional in the art is based on an unsupported finding.” Req. 4 (citing Dec. 16).¹

As an initial matter, we disagree that the Petition did not argue, or provide supporting evidence, that the prior art “cards” correspond to “panels.” For example, Petitioner asserted that “[t]he 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* [which recite “panels”].” Pet. 14 (emphases added). Petitioner further argued that “[s]toring, selecting, and disposing of a *panel*’

¹ In a September 10, 2018 conference call held between counsel for the parties and the Board, Petitioner asserted that Patent Owner’s Request includes improper new argument that “panels” are not the same as “cards.” See Paper 24. While Patent Owner’s request echoes the assertion in the Preliminary Response that panels *as described and claimed* in the ’583 patent were unknown at the time of the invention (*see, e.g.*, Req. 2, 4; Prelim. Resp. 30), and argues with respect to what the Board allegedly misapprehended or overlooked, we find no argument in Patent Owner’s Request that panels in and of themselves are not the same as cards.

containing game information, *as noted in the background of the '583 specification* [which refers to “cards”], were previously well known in the art.” Pet. 22 (citing Ex. 1001, 1:31–40) (emphases added). Although the Petition did not explicitly use the word “correspond” in identifying a link between “panels” and the prior art “cards,” we understood from the Petition, and the cited portions of the Background section, that the “cards” in the Background section are the prior art analogue to the “panels” recited in the claims, and that they, thus, correspond to each other. *See* Dec. 16 (citing Pet. 14–15 (citing Ex. 1001, 1:31–40)); *see also* Ex. 1001, 1:41–44 (“since the use of a two-dimensional card in the battle scene is sometimes boring, there have been calls for improvement”) (cited at Dec. 2).

Patent Owner acknowledges that “the Board cited a portion of the background of the ’583 specification—Exhibit 1001 at 1:31–40—to support this conclusion,” but argues that this is insufficient evidence, because “the background of the ’583 specification makes no mention of ‘panels’ whatsoever.” Req. 4; *see also* Dec. 17 (“[B]y showing the prior use of cards, which correspond to the ‘panels,’ in an electronic game, the Background section of the Specification of the ’583 patent provides evidentiary support for the general proposition that using panels in an electronic game is conventional.”). On the current record, we are unpersuaded that lack of the explicit use of the term “panel” in the Background section is insufficient to support our finding that “cards” correspond to “panels.” Indeed, in its Preliminary Response, Patent Owner itself identified evidence that “cards” *do* correspond to “panels,” particularly portions of the Specification that liken “panels” to “cards” or use the terms interchangeably. *See* Prelim. Resp. 4 (citing Ex. 1001, 7:15–18 (“*Panels* can

have various shapes such as a circle, a triangle, and a polygon, as well as the rectangle (including a square) *such as a card* in the related art.”) (emphases added)); Prelim. Resp. 9 (citing Ex. 1001, 9:2–5 (“when three or more specific *panels* are disposed within one game display screen, it is also possible to generate a combo exhibiting the effect beyond the effects of *these cards*”) (emphases added)). Patent Owner even stated that “[i]n the case of the ’583 patent, the *claims are directed to* a known problem associated with *card* games played on electronic devices.” Prelim. Resp. 25–26 (citing Ex. 1001, 1:42-44) (emphases added) (Patent Owner’s statement cited at Dec. 11–12). We read the relevant statutes as requiring our consideration of a preliminary response, and everything cited therein, in rendering a decision on institution. *See* 35 U.S.C. § 323 (“If a post-grant review petition is filed under section 321, the patent owner shall have the right to file a preliminary response to the petition . . .”); 35 U.S.C. § 324 (“The Director may not authorize a post-grant review to be instituted unless the Director determines that the information presented in the petition filed under section 321, if such information is not rebutted . . .”).

Patent Owner argues further that, in rendering its Decision, the Board misapprehended or overlooked “substantial evidence and argument that ‘panels’ as claimed by the ’583 patent were not well-known, routine, or conventional in the art.” Req. 4 (citing Prelim. Resp. 31–34). For example, Patent Owner argues that its declarant, David Crane, “explained that ‘panels’ as described and claimed in the ’583 patent were an inventive concept” and

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.