

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SUPERCELL OY,
Petitioner,

v.

GREE, INC.,
Patent Owner.

PGR2018-00060
Patent 9,694,287 B2

Before LYNNE H. BROWNE, HYUN J. JUNG, and
CARL M. DEFRANCO, *Administrative Patent Judges*.

JUNG, *Administrative Patent Judge*.

DECISION

Denying Patent Owner's Request on Rehearing of Final Written Decision
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Gree, Inc. (“Patent Owner”) Patent Owner filed a Request for Rehearing (Paper 33, “Req. Reh’g”) seeking review of the Board’s Final Written Decision (Paper 32, “Dec.”). In the Final Written Decision, we determined that Supercell Oy (“Petitioner”) had shown by a preponderance of the evidence that claims 1–24 of U.S. Patent No. 9,694,287 B2 (Ex. 1001, “the ’287 Patent”) are unpatentable, and we denied Patent Owner’s Contingent Motion to Amend (Paper 13, “Mot.” or “Motion”) because proposed substitute claims 25–48 are not patent eligible.

For the reasons set forth below, Patent Owner’s Request for Rehearing is *denied*.

II. ANALYSIS

A. *Legal Standard*

The applicable requirements for a request for rehearing are set forth in 37 C.F.R. § 42.71(d), which provides:

A party dissatisfied with a decision may file a single request for rehearing, without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believed the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

37 C.F.R. § 42.71(d); *see also* Req. Reh’g 2 (quoting from the same rule under “Legal Standard”).

We review our decision under an abuse of discretion standard. 37 C.F.R. § 42.71(c). An abuse of discretion may arise if 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. *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000).

B. The Final Written Decision

In the Final Written Decision, we denied Patent Owner’s Contingent Motion to Amend proposing substitute claims 25–48. Dec. 43–58. We first determined that the Motion met the statutory and regulatory requirements set forth in 35 U.S.C. § 326(d) and 37 C.F.R. § 42.221 as explained in *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 at 4 (PTAB Feb. 25, 2019) (precedential). *Id.* at 46–50. In analyzing the proposed substitute claims under the USPTO’s 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“2019 Revised Guidance” or “Guidance”), we determined by a preponderance of the evidence that proposed substitute claims 25–48 are not patent eligible. *Id.* at 55–58. In making this determination, we considered the entirety of the record, including the language of proposed substitute claims 25–48 and the arguments in Patent Owner’s Motion, Petitioner’s Opposition to Motion to Amend (Paper 22, “Opp.”), Patent Owner’s Reply to Opposition to Motion to Amend (Paper 24), and Petitioner’s Sur-Reply to Opposition to Patent Owner’s Motion to Amend (Paper 27). Based on the entirety of the record, we determined that proposed substitute claims 25–48 are directed to a method of organizing human activity, do not integrate the patent ineligible subject matter into a practical application, and do not amount to “significantly more” than patent ineligible subject matter. *Id.* at 43–58.

C. Patent Owner's Arguments on Rehearing

The sole issue on which Patent Owner requests rehearing of the Final Written Decision is with respect to the Board's determination that proposed substitute claims 25–48 were shown to be unpatentable as being directed to patent ineligible subject matter. Req. Reh'g 1–2. Patent Owner presents its arguments under three enumerated headings. *Id.* at 2–15.

1. Analysis of Proposed Substitute Claims 25–48

First, Patent Owner contends that the Board overlooked the differences between the original claims and the proposed substitute claims. Req. Reh'g 2–5 (heading “A”). Patent Owner points out that “substitute claims 25–48 are not identical to the original claims” and argues that the proposed substitute claims “require a separate and complete analysis to determine compliance with § 101.” *Id.* at 3. Focusing specifically on the limitations of proposed substitute claim 41 for (i) “a receiving step,” (ii) “a first item providing step,” and (iii) “a second item providing step,” Patent Owner contends that the modified features of the substitute claims set forth a practical application of the judicial exception under the 2019 Revised Guidance. *Id.* at 4. Patent Owner alleges that the Board erred by “merely referring back to the analysis of the original claims.” *Id.* at 5.

Patent Owner does not identify what argument we overlooked or misapprehended. *See id.* at 2–5. The mere fact that we referred to previous analysis in the Final Written Decision does not show we overlooked or misapprehended any matter such that we should modify the Final Written Decision. *See* 37 C.F.R. § 42.71(d).

Nonetheless, to the extent an argument was overlooked or misapprehended, we note that nothing in the Final Written Decision

indicates that the proposed substitute claims are identical to the original claims, as asserted by Patent Owner, or that a complete analysis of the proposed substitute claims was not performed. On the contrary, we addressed the additional details added to proposed substitute independent claims 25, 33, and 41, as characterized by Patent Owner in its Reply.

Dec. 55. The Final Written Decision applied each step of the 2019 Revised Guidance to the proposed substitute claims and weighed the arguments presented by Petitioner and by Patent Owner under each step. *See id.* at 55–56 (Guidance Step 2A, Prong I), 56–57 (Guidance Step 2A, Prong II), 57 (Guidance Step 2B).

We are not persuaded that it was an abuse of discretion for the Final Written Decision to refer to the analysis of the original claims when addressing the proposed substitute claims. Given the similarities between the proposed substitute claims and the original claims, and the similarity of Patent Owner’s corresponding arguments and evidence, it was appropriate for the Board to conserve its limited resources by referring to the similar analysis already set forth previously in the Final Written Decision.

Exemplary proposed substitute claim 41, which would have replaced original claim 17, is shown in the side-by-side comparison below:

Original Claim 17	Substitute Claim 41
A game control method for providing a plurality of items usable in a game to a plurality of communication terminals connected to the game over a network, the game control method comprising:	A game control method providing a plurality of items usable in a game to a plurality of communication terminals connected to the game over a network, the game control method comprising:

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