

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SUPERCELL OY,

Petitioner

v.

GREE, INC.,

Patent Owner.

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Case PGR2018-00064

Patent No. 9,737,816

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**PATENT OWNER'S PRELIMINARY RESPONSE  
PURSUANT TO 37 C.F.R. § 42.207(a)**

Patent Owner, Gree, Inc. ("Gree"), respectfully submits this Preliminary Response to Petitioner's petition ("the Petition") seeking post-grant review ("PGR") of claims 1-8 of U.S. Patent No. 9,737,816 ("the '816 Patent").

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### Rules

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## LIST OF EXHIBITS

- 2001 Declaration of Bruce McNair
- 2002 Android Compatibility Program: Android 2.2 Compatibility  
Definition, Google Inc. (2010),  
<https://source.android.com/compatibility/2.2/android-2.2-cdd.pdf>

## I. INTRODUCTION

In order to be eligible for Post-Grant Review (PGR), a subject patent must meet the “first inventor to file” criteria of the America Invents Act (AIA) — this patent does not. For this reason alone, the petition fails.

U.S. Patent 9,737,816 (“’816 patent”) is a first to invent patent (i.e., pre-AIA) because it has an effective filing date of February 21, 2013. Applications filed on or after March 16, 2013 (AIA trigger date) may claim the benefit of an earlier priority date under 35 U.S.C. §§ 119, 120, 121, or 365 and thus can be entitled to an earlier effective pre-AIA filing date. The ’816 patent claims priority to a foreign application dated February 21, 2013, which predates the AIA. Claims 1-8 are fully supported by the foreign application, and therefore the ’816 patent is not subject to PGR.<sup>1</sup>

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<sup>1</sup> The “effective filing date” of a patent or application for patent is “the filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority under section 119, 365(a), 365(b), 386(a), or 386(b) or to the benefit of an earlier filing date under section 120, 121, 365(c), or 386(c).” 35 U.S.C. § 100(i)(1)(B) (2015). “[W]hen the priority claim is based on subject matter disclosed in a foreign patent application whose filing date is properly claimed ... the foreign application has the same effect as if filed in the United States.” *Frazer v. Schlegel*, 498 F.3d 1283 (Fed. Cir. 2007) (citing 35 U.S.C. § 119(a), (e)(1)). The invention disclosed in a foreign patent application “must be disclosed in the manner provided by the first paragraph of section 112.” *Id.* See also MPEP § 2163.03(III).

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