

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SUPERCELL OY,
Petitioner,

v.

GREE, INC.,
Patent Owner.

Case PGR2018-00064
Patent 9,737,816 B2

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

BROWNE, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On September 20, 2018, a conference call was held, between counsel for the parties and Judges Browne, Jung, and DeFranco, concerning Petitioner's request to file a reply to Patent Owner's Preliminary Response (Paper 38, "Prelim. Resp."), which presents arguments regarding the effective filing date of the challenged patent. The panel observed that the Petition already contains arguments addressing the effective filing date. Petitioner agreed but asserted that it believes the Preliminary Response presents genuine issues of fact that it should be allowed to address. According to Petitioner, the Preliminary Response improperly incorporates by reference several paragraphs from the declaration filed by Patent Owner and the testimony in the declaration does not identify the underlying facts and data on which the declarant based his conclusions.

Patent Owner responded that Petitioner is attempting to gain another opportunity to address the issue of the effective filing date and that Petitioner chose to forego the opportunity to support the issue with declaratory evidence by choosing not to file a declaration in this proceeding. Patent Owner also responded that there are no issues of material fact presented by the record thus far, that the Preliminary Response does not improperly incorporate declarant testimony, and that the testimony is supported by the record. Patent Owner further noted that additional briefing is normally granted when the Board has not heard from both parties with respect to an issue.

We agree with Patent Owner. Concerning potential issues of material fact, Petitioner has informed the Board of its belief, and so the Board will take it into account. If there are no genuine issues of material fact, then further briefing is not warranted from the Petitioner. If the Preliminary Response does contain improper incorporations of declarant testimony or if that testimony is not supported by

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reference to the underlying facts and data, the Board will be able to make those determinations, without need for a reply from Petitioner.

Accordingly, it is

ORDERED that Petitioner's request to file a reply to Patent Owner's Preliminary Response is *denied*.

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