Trials@uspto.gov
Tel: 571-272-7822

Paper 8
Entered: October 18, 2018

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*.

DECISION
Denying Institution of Post-Grant Review
35 U.S.C. § 324(a)

GREE, Inc. ("GREE") is the owner of U.S. Patent No. 9,737,816 B2 ("the '816 patent"). Supercell Oy ("Supercell") filed a Petition requesting post-grant review of claims 1–8 of the '816 patent. Paper 1 ("Pet."). GREE, in turn, filed a preliminary response. Paper 6 ("Prelim. Resp."). After considering the Petition and the Preliminary Response, as well as all

supporting evidence, we determine the Petition does not demonstrate that it is more likely than not at least one of the challenged claims of the '816 patent is unpatentable. 35 U.S.C. § 324(a). Thus, we do not institute post-grant review of claims 1–8 of the '816 patent.

I. BACKGROUND

A. The '816 Patent

The '816 patent issued August 22, 2017, and claims priority to U.S. Patent No. 9,561,434 B2, filed February 6, 2014 ("the '434 patent"). Ex. 1001, cover [45], [63]. The '434 patent claims priority to JP 2013-031903 ("the '903 application"), filed February 21, 2013.[1] *Id.* at 1:8–14. After considering the Petition and Preliminary Response, we conclude that Petitioner fails to demonstrate that the '816 patent is eligible for post-grant review.

The '816 patent purports to disclose a game method, and corresponding computer and program, "to provide a ranking list display method in a game system, which can easily execute ranking confirmation of a user, who is a ranking confirmation target, such as the user himself/herself, a friend or a rival, and a system for executing this method." *Id.* at 1:66–2:3. The game has "the server group 2 for executing a main process for realizing the ranking list display method . . . and a plurality of computers 3-1 and 3-2 and mobile phones 4-1 and 4-2." *Id.* at 3:32–36 (emphasis omitted). The computers and mobile phones are used by users "connected to a network 1 such as the Internet via an access a point 5 or a base station 6." *Id.* at 3:36–39.

[1] Hereinafter, all reference to the disclosure of the '903 application is to the certified translation of this document (i.e. Ex. 1010).

According to the '816 patent, given the recent popularity of social networking service, the number of users of games using those services reaches several million users in some cases. *See* Ex. 1001, 1:28–30. As a consequence, "the Quantity of ranking information is enormous, the work of a user for confirming the ranking of the user himself/herself, a rival or a friend is time-consuming." *Id.* at 1:31–34. To address this problem, the '816 patent purports to make it "possible to easily execute ranking confirmation of a user, who is a ranking confirmation target, such as the user himself/herself, a friend or a rival." *Id.* at 2:16–19. In order to achieve this result, the server includes a CPU 32 that "cooperates with a client-side ranking list display process program 37-3 . . . which is stored in the storage device 37, and the CPU 32 executes the ranking list display method in the game system according to the embodiment and also executes overall control of the mobile phone." Ex 1001, 4:62–67 (emphasis omitted).

B. Representative Claim

The '816 patent includes 8 claims, of which claims 1, 2, and 8 are independent. All three independent claims recite essentially identical limitations and vary only as to type, where claim 1 is directed to a "method," claim 2 to an "electronic device," and claim 8 to a "non-transitory computer-readable medium." Ex. 1001, 10:64, 11:27, 12:32. Common across the independent claims are seven functional steps including controlling or control of a user interface by the electronic device's circuitry to display a ranking list in response to a user display request "wherein the position is

identified by the computer based on ranking data stored in the computer."

Id. at 10:64–11:54, 12:32–61. Claim 1 is representative and recites:

> 1. A method performed by an electronic device, the method comprising:
>
> transmitting, via a communication interface of the electronic device, a display request for a ranking list to a computer, the display request including identification information corresponding to a user who is a ranking confirmation target;
>
> controlling, by circuitry of the electronic device, the communication interface to receive, in response to the display request, a position in the ranking list of the user in relation to a display range of the ranking list from the computer, wherein the position is identified by the computer based on ranking data stored in the computer;
>
> displaying, by the circuitry, a pointer that corresponds to the position received by the communication interface determining, by the circuitry, based on a user input at the electronic device, whether the display range is changed;
>
> determining, by the circuitry, when it is determined that the display range is changed, a direction of the pointer based on the changed display range and the position received by the communication interface;
>
> determining, by the circuitry, that a user input is received at the pointer displayed by the electronic device;
>
> controlling, by the circuitry, the communication interface to receive the ranking data including another user based on the user input received at the pointer; and
>
> display, by the circuitry, the display range of the ranking list including a rank of the another user based on the received ranking data.

B. The Asserted Grounds of Unpatentability

The Petition asserts that claims 1–8 of the '816 patent are unpatentable as: (1) being directed to non-statutory subject matter under 35 U.S.C. § 101 (Pet. 32–59); (2) failing to comply with the written description requirement of 35 U.S.C. § 112(a) (*id.* at 60–67); and (3) failing

to comply with the definiteness requirement of 35 U.S.C. § 112(b) (*id.* at 67–72).

II. ANALYSIS

The post-grant review provisions of the Leahy-Smith America Invents Act ("AIA")[2] apply only to patents subject to the first inventor to file provisions of the AIA. AIA § 6(f)(2)(A). Specifically, the first inventor to file provisions apply to any application for patent, and to any patent issuing thereon, that contains or contained at any time a claim to a claimed invention that has an effective filing date on or after March 16, 2013. AIA § 3(n)(1). Furthermore, "[a] Petition for a post-grant review may only be filed not later than the date that is 9 months after the date of the grant of the patent or of the issuance of a reissue patent (as the case may be)." 35 U.S.C. § 321(c); see also 37 C.F.R. § 42.202(a) (setting forth the same).

As noted *supra*, the '816 patent issued on August 22, 2017, and claims the benefit of the '903 application filed on February 21, 2013. The instant Petition was filed on May 2, 2018 (*see also* Paper 5, 1 (according the Petition a filing date of May 2, 2018)), which is within nine months of the date of the grant of the '816 patent.

Petitioner asserts that claims 1–3 and 5–8 of the '816 patent are not entitled to the filing date of the '903 application and that the "effective filing date of the challenged claims is no earlier than December 21, 2016." *See* Pet. 24–30. According to Petitioner, "[t]he '903 application never describes or mentions 'controlling, by circuitry of the electronic device, the communication interface to receive, in response to the display request, a

[2] Pub. L. No. 112-29, 125 Stat. 284 (2011).

DOCKET ALARM

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.