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Paper 13
Date: September 3, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SUPERCELL OY,
Petitioner,

v.

GREE, INC.,
Patent Owner.

PGR2020-00034
Patent 10,300,385 B2

Before LYNNE H. BROWNE, HYUN J. JUNG, and
AMANDA F. WIEKER, *Administrative Patent Judges*.

WIEKER, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Supercell Oy ("Petitioner") filed a Petition for post-grant review of claims 1–18 ("challenged claims") of U.S. Patent No. 10,300,385 B2 (Ex. 1001, "the '385 patent"). Paper 1 ("Pet."). GREE, Inc. ("Patent Owner") filed a Preliminary Response. Paper 7 ("Prelim. Resp."). With our authorization, Petitioner filed a Preliminary Reply (Paper 8, "Prelim. Reply") and Patent Owner filed a Preliminary Sur-reply (Paper 9, "Prelim. Sur-reply") to address, *inter alia*, 35 U.S.C. § 324(a).

Having considered the arguments and evidence of record, and for the reasons explained below, we exercise our discretion under 35 U.S.C. § 324(a) and deny institution of post-grant review.

B. Related Proceeding

The parties identify one matter related to the '385 patent: *GREE, Inc. v. Supercell OY*, No. 2:19-cv-00200 (E.D. Tex.) (the "parallel proceeding"). Pet. 1; Paper 4, 2.

C. The '385 Patent

The '385 patent is titled "Computer Control Method, Control Program and Computer," and issued on May 28, 2019, from U.S. Patent Application No. 16/112,057. Ex. 1001, codes (21), (45), (54).

The '385 patent discloses a method for controlling a computer in the context of "city building games." *Id.* at code (57). In accordance with the disclosed method, a template defining positions of game contents may be defined and applied to a predetermined area within a game space, such that the computer will move game contents within the game space to the positions defined by the template. *Id.*

D. Illustrative Claim

Of the challenged claims, claims 1, 9, 17, and 18 are independent. Claim 1 is illustrative and is reproduced below.

> 1. A user terminal used by a first player, the user terminal comprising:
>
> circuitry configured to:
>
> transmit first information to a server from the user terminal, the first information identifying a second player which is different from the first player and being designated by the first player, the server receiving second information from another user terminal executing a game, the second information being associated with the second player and the second information indicating types and positions of at least one of a set of game contents arranged within at least a part of a game space; and
>
> receive, at the user terminal, third information from the server based on the first information, the third information being associated with the second player, the third information being related to the second information, and the third information being used for reproducing the types and the positions of the at least one of the set of game contents arranged within the at least a part of the game space in the user terminal.

Ex. 1001, 26:31–52.

E. Evidence

Petitioner relies upon the following evidence:

Cho et al., U.S. Patent Publication No. 2007/0105626 A1, filed Aug. 21, 2006, published May 10, 2007 (Ex. 1009, "Cho");

Kim et al., U.S. Patent No. 9,079,105 B2, filed May 17, 2013, issued July 14, 2015 (Ex. 1011, "Kim"); and

Manual for Gratuitous Space Battles, Version 1.1 (Ex. 1010, "GSB").

Pet. 9–10. Petitioner also relies upon the Declaration of Mark L. Claypool Ph.D. Ex. 1005.

F. Asserted Grounds of Unpatentability

Petitioner challenges the patentability of claims 1–18 of the '385 patent based on the following grounds. Pet. 9–10.

Claims Challenged	35 U.S.C. §	References/Basis
1–18	101	Unpatentable subject matter
1–6, 8–14, 16–18	103	Cho, GSB
7, 15	103	Cho, GSB, Kim

G. Eligibility for Post-Grant Review

The post-grant review ("PGR") provisions of the Leahy-Smith America Invents Act ("AIA")[1] 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).

Petitioner asserts that the '385 patent is available for post-grant review. Pet. 2. The '385 patent was filed on August 24, 2018, and claims ultimate priority to a Japanese application filed September 27, 2013, both dates falling after March 16, 2013. Ex. 1001, codes (22), (30); *see also id.* at

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

code (63) (identifying domestic priority claims); Pet. 9. The Petition was filed on February 27, 2020, which is within nine months of the May 28, 2019, issue date of the '385 patent. Ex. 1001, code (45); Pet. 2. On this record, we determine that the '385 patent is eligible for post-grant review.

II. DISCUSSION

A. Discretion under 35 U.S.C. § 324(a)

Patent Owner urges the Board to exercise discretion to deny institution of post-grant review under 35 U.S.C. § 324(a) "because institution of this proceeding would not be consistent with the objective of the AIA to 'provide an effective and efficient alternative to district court litigation,'" in view of the ongoing parallel proceeding between the parties in the U.S. District Court for the Eastern District of Texas. Prelim. Resp. 2–3 (emphasis omitted); *see also id.* at 3–27; Prelim. Sur-reply 1–8; *see supra* § I.B. Petitioner disagrees. Prelim. Reply 1–6.

1. Legal Standards

35 U.S.C. § 324(a) states that

> [t]he 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, would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.

The portion of the statute reading "[t]he Director may not authorize . . . unless" mirrors the language of 35 U.S.C. § 314(a), which concerns *inter partes* review. This language of sections 314(a) and 324(a) provides the Director with discretion to deny institution of a petition. *See Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) ("[T]he agency's decision

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