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Paper No. 14
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SUPERCELL OY,
Petitioner,

v.

GREE, INC.,
Patent Owner.

PGR2020-00041
Patent 10,307,677 B2

Before MICHAEL W. KIM, LYNNE H. BROWNE, and AMANDA F. WIEKER, *Administrative Patent Judges.*

BROWNE, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background and Summary

On March 3, 2020, Supercell Oy ("Petitioner") filed a Petition for post-grant review of claims 1–20 of U.S. Patent No. 10,307,677 B2 ("the '677 patent") (Ex. 1001). Paper 2 ("Pet."). On June 17, 2020, GREE, Inc. ("Patent Owner") filed a Preliminary Response. Paper 7 ("Prelim. Resp.").

With authorization, on July 6, 2020, Petitioner filed a Petitioner's Reply to Patent Owner's Preliminary Response. Paper 9 ("Prelim. Reply"). With authorization, on July 20, 2020, Patent Owner filed a Patent Owner's Sur-Reply. Paper 10 ("Prelim. Sur-Reply").

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. Real Parties in Interest

Petitioner indicates that it is the real-party-in-interest. Pet. 1. Patent Owner indicates that it is the real-party-in-interest. Paper. 4, 2.

C. Related Matters

Petitioner identifies *GREE, Inc. v. Supercell Oy*, Civil Action No. 2:19-cv-00200-JRG-RSP (E.D. TX.) ("the parallel district court proceeding"), which involves the same patent and parties as the present case, as a related matter. Pet. 2. Patent Owner identifies the same case. Paper 4, 3.

Patent Owner identifies the following post-grant review proceedings as related matters:

PGR2020-00034 (U.S. Patent No. 10,300,385 B2);

PGR2020-00038 (U.S. Patent No. 10,307,675 B2);

PGR2020-00039 (U.S. Patent No. 10,307,676 B2); and

PGR2020-00042 (U.S. Patent No. 10,307,678 B2).

Paper 4, 2.

D. The '677 Patent

The '677 patent "relates to a method for controlling a computer, a recording medium and a computer." Ex. 1001, 1:21–22. In particular, it relates to city building games "wherein a player builds a city within a virtual

space . . . provided in the game program." *Id.* at 1:34–36. The method utilizes "a computer that is provided with a storage unit configured to store game contents arranged within a game space, positions of the game contents, and a template defining positions of one or more of game contents." *Id.* at 2:1–5. The method "progresses a game by arranging the game contents within the game space based on a command by a player." *Id.* at 2:5–7.

E. Illustrative Claim

The '677 patent includes 20 claims, all of which Petitioner challenges. Ex. 1001, 26:32–28:65; Pet. 1. Of these, claims 1, 7, 13, and 17 are independent claims. Ex. 1001, 26:32–50, 27:10–25, 27:53–28–6, 28:21–41. Illustrative claim 1 is reproduced below.

> 1. A method performed by an information processing system the method comprising:
>
> receiving information for reproducing a template for defending an attack initiated by another player, the template defining positions of game contents in a game space and being created by a first terminal executing a game by arranging, based on a player's command, the game contents within the game space, the game contents including at least a game content for defending from an attack initiated by another player;
>
> storing the received information for reproducing the template; and
>
> sending, based on the stored information, information for reproducing the template to a second terminal different from the first terminal, the second terminal executing the game by arranging, based on a player's command, game contents within the game space, the game contents including at least a game content for defending from an attack initiated by another player.

F. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–20 are unpatentable based on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–20	101	Ineligible Subject Matter
1–20	103(a)	Clans,[1] Mastermind,[2] Kim[3]

Petitioner also relies on a Declaration of Mark L. Claypool, Ph.D. Ex. 1012.

G. Eligibility for Post Grant Review

The post-grant review ("PGR") provisions of the Leahy-Smith America Invents Act ("AIA") 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 '677 patent is available for post-grant review. Pet. 2. The '677 patent was filed on June 30, 2017, and claims

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[1] Clash of Clans, version 4.120 ("Clash") (Ex. 1014, "Takala Dec.").
[2] "Mastermind's In-Game Builder Idea (with LOADS of pictures!)" ("Mastermind"), *available at* https://web.archive.org/web/20130915081111/http:/forum.supercell.net:80/showthread/php/149687-Mastermind-s-In-Game-Builder-Idea-(with-LOADS-of-pictures!) (in two parts) (Ex. 1015, "Olesuik Dec.").
[3] US 9,079,105 B2, issued July 14, 2015 (Ex. 1016, "Kim").

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.*, code (63) (identifying domestic priority claims); Pet. 9. The Petition was filed on March 4, 2020, which is within nine months of the June 4, 2019, issue date of the '677 patent. Ex. 1001, code (45); Pet. 2. On this record, we determine that the '677 patent is eligible for post-grant review.

II. ANALYSIS

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 Petitioner raises the same prior art and arguments in a parallel district court proceeding filed more than one year ago and scheduled for trial in less than six months." Prelim. Resp. 1 (citing *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, at 19–20 (PTAB Sept. 12, 2018) (precedential)); *accord Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 6 (PTAB, Mar. 20, 2020) (precedential) (the "*Fintiv* Order"). Patent Owner asserts that "it would be an inefficient use of Board, party, and judicial resources to institute the present proceeding under these circumstances. Indeed the possibility of duplication of efforts here is high and the potential for inconsistent results due to both tribunals considering overlapping issues is present." *Id.* at 1–2 (citing *Supercell Oy v. GREE, Inc.*, IPR2020-00215, Paper 10, at 6–19 (PTAB June 10, 2020)). Petitioner disagrees. Prelim. Reply 1–5.

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

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