

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SUPERCELL OY,
Petitioner,

v.

GREE INC.,
Patent Owner.

PGR2020-00043
Patent 10,328,346 B2

Before LYNNE H. BROWNE, HYUN J. JUNG, and
RICHARD H. MARSCHALL, *Administrative Patent Judges*.

MARSCHALL, *Administrative Patent Judge*.

DECISION
Denying Institution of Post-Grant Review
35 U.S.C. § 324, 37 C.F.R. § 42.4

INTRODUCTION

Supercell Oy (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting institution of a post-grant review of claims 1–15 of U.S. Patent No. 10,328,346 B2 (Ex. 1001, “the ’346 patent”). GREE, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”). With our authorization, Petitioner filed a Reply to Patent Owner’s Preliminary Response (Paper 8, “Reply”) and Patent Owner filed a Sur-reply to Petitioner’s Reply (Paper 9, “Sur-reply”).

Upon consideration of the parties’ briefs and the evidence of record and for the reasons explained below, we exercise our discretion under 35 U.S.C. § 324(a) to deny institution of a post-grant review.

BACKGROUND

A. Real Parties in Interest

Petitioner states that “[t]he sole real party-in-interest for this Petition is Supercell Oy.” Pet. 1. Patent Owner states that “the real party-in-interest is GREE, Inc.” Paper 3, 2.

B. Related Matters

The parties indicate that the ’346 patent is involved in *GREE, Inc. v. Supercell Oy*, No. 2:19-cv-00237-JRG-RSP (E.D. Tex.) (“district court litigation”). Pet. 2–3; Paper 3, 3. Trial is set for March 1, 2021, in the district court litigation. Ex. 1051 (Amended Docket Control Order entered Oct. 7, 2020). Petitioner also identifies several post-grant review proceedings involving patents related to the ’346 patent. *See* Pet. 2 (citing *Supercell Oy v. Gree, Inc.*, PGR2018-00047, Paper 39 at 55, 58, 60 (PTAB Sept. 6, 2019); *Supercell Oy v. Gree, Inc.*, PGR2018-00029, Paper 45 at 52, 54, 56 (PTAB Aug. 14, 2019)).

C. The '346 Patent

The '346 patent issued on June 25, 2019, from an application filed on August 25, 2017, that claims priority to a series of three continuation applications and three foreign applications. Ex. 1001, codes (22), (30), (45), (63), 1:9–17. The earliest application to which the '346 patent claims priority was filed on May 30, 2014. *Id.* at codes (30), (63).

The '346 patent relates to a computer that stores “game program code instructions for a game in which a first user and a second user do battle.” *Id.* at code (57). The computer “perform[s] a data storage function of storing a first panel data that includes a plurality of panels associated with the first user” and “a control function of receiving information regarding a selection by the first user, the selection being for one or more panels indicating characters to be disposed in one or more divisions of a game display screen.” *Id.* “[T]he control function transmits information for displaying the panel as a moving character according to the information of motion associated with the panel when the panel is disposed in a target division.” *Id.*

D. Illustrative Claim

The '346 patent has 15 claims, all of which Petitioner challenges. Claims 1, 6–8, 14, and 15 are independent, and claim 1 is reproduced below.

1. A non-transitory computer readable recording medium storing game program code instructions for a game in which a first user and a second user do battle, and when the game program code instructions are executed by a computer, the game program code instructions cause the computer to perform:

- a data storage function of storing a first panel data that includes a plurality of panels associated with the first user to a storage unit; and
- a control function of receiving information regarding a selection by the first user, the selection being for one or more panels indicating one or more characters, wherein

the data storage function further stores each panel associated with information of motion to the storage unit, and

the control function further receives information related to selection of one or more divisions in which the one or more characters indicated in the selected one or more panels are to be displayed as one or more moving characters in a game display screen including one or more regions formed by the one or more divisions, and transmits information for displaying the one or more moving characters according to the information of motion associated with each panel stored in the storage unit.

Ex. 1001, 10:33–57.

E. Asserted Grounds

Petitioner asserts that claims 1–15 would have been unpatentable on the following grounds:

Claims Challenged	35 U.S.C. §	References/Basis
1–15	101	Eligibility
1–3, 6–10, 13–15	102	Clash Royale ¹
1–15	103	Sakamoto, ² Kings & Legends, ³ general knowledge
13	103	Sakamoto, Kings & Legends, Cho, ⁴ general knowledge

Petitioner also provides a Declaration of Stephen H. Lane, Ph.D.

Ex. 1003.

¹ Petitioner’s own “Clash Royale” product is an app for the iOS and Android operating systems, which Petitioner contends it released on January 4, 2016, distributed in February 2016, and launched globally on March 2, 2016. Pet. 23 (citing Ex. 1025 ¶¶ 3–4; Ex. 1026; Ex. 1027); Exs. 1029, 1030 (videos of Clash Royale).

² US 6,419,584 B1, issued July 16, 2002 (Ex. 1004) (“Sakamoto”).

³ Petitioner presents a YouTube web page print-out and YouTube video depicting an online game known as “Kings & Legends.” See Ex. 1005 (web page print-out); Ex. 1006 (video) (“Kings & Legends”).

⁴ US 2007/0105626 A1, published May 10, 2007 (Ex. 1010) (“Cho”).

F. Eligibility for Post-Grant Review

The post-grant review (“PGR”) provisions of the Leahy-Smith America Invents Act (“AIA”)⁵ 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). Because the application from which the ’346 patent issued was filed on August 25, 2017, and claims priority to applications filed on or after March 5, 2014, the ’346 patent is subject to the first inventor to file provisions of the AIA. Ex. 1001, codes (22), (30), (63), 1:9–17.

Also, “[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). The Petition was filed on March 24, 2020, which is within nine months of June 25, 2019, the issue date of the ’346 patent. Ex. 1001, code (45); *see also* Pet. 3 (arguing that the Petition is timely filed); Paper 5 (according a filing date of March 24, 2020). On this record, the ’346 patent is eligible for post-grant review.

ANALYSIS OF 35 U.S.C. § 324(a)

Patent Owner argues that “the Board should exercise its discretion under 35 U.S.C. § 324(a) to deny the Petition 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 five months.” Prelim. Resp. 1.

⁵ Pub L. No. 112-29, 125 Stat. 284 (2011).

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