

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SUPERCELL OY,
Petitioner,

v.

GREE INC.,
Patent Owner.

PGR2020-00043 (US 10,328,346 B2)
PGR2020-00046 (US 10,328,347 B2)
PGR2020-00049 (US 10,335,689 B2)
PGR2020-00053 (US 10,335,683 B2)

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

JUNG, *Administrative Patent Judge*.

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

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In an email sent to the Board on November 24, 2020, Supercell Oy (“Petitioner”) requested authorization to file in PGR2020-00046 and PGR2020-00053 as exhibits: (1) a Federal Circuit decision for PGR2018-00008 regarding a patent related to, at least, the ones at issue in PGR2020-00046 and PGR2020-00053 and (2) an order for case 2:19-cv-00152-JRG that puts on hold all jury trials in the U.S. District Court for the Eastern District of Texas until March 2021.

Petitioner argues that “[t]he Federal Circuit Decision shows a low likelihood of inconsistent results between forums, confirms the merits of the § 101 ground for claims not patentably distinct from the [related parent patent] claims, and is evidence that could not have been presented earlier.” Petitioner also argues that the “Order impacts the analysis of the Proximity Factor (Factor 2), as the three month court closure is likely to further delay the district court trial of these patents, and also could not have been presented earlier.” Petitioner represents that “[t]he parties have conferred, and Patent Owner does not oppose, but believes the new exhibits do not impact the issues presented in the rehearing request.”

Because the order from case 2:19-cv-00152-JRG “impacts the docket schedule and is not already of record,” Petitioner is authorized to file the order as an exhibit in each of the above-captioned proceedings within three business days of the date of this Order. *See, e.g.*, Paper 11 in PGR2020-00046 (authorizing the filing of papers that impact the docket schedule of related district court proceeding).

Also, because Petitioner contends that the order affects our analysis of one of the factors from *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11

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at 5–6 (PTAB Mar. 20, 2020) (precedential), Petitioner is authorized to file a brief with no more than five pages of argument discussing how the order affects the analysis of the Decision denying institution in these proceedings. The brief should be filed within one week of the date of this Order.

Patent Owner is authorized to file a brief of no more than five pages of argument responding only to the contentions in Petitioner’s brief within one week of service of Petitioner’s brief. At this time, no new evidence is authorized to be filed with the above-described briefs.

Finally, the panel appreciates Petitioner bringing the Federal Circuit decision to our attention, but we see no need to file a separate copy as an exhibit in the above-captioned proceedings. If the parties need to cite to the decision, they should cite to the slip opinion or another widely available case reporter.

ORDER

It is hereby:

ORDERED that Petitioner is authorized to file as an exhibit in each of the above-listed proceedings, within three business days of the date of this paper, the order for case 2:19-cv-00152-JRG that puts on hold all jury trials in the U.S. District Court for the Eastern District of Texas until March 2021;

FURTHER ORDERED that Petitioner is authorized to file a brief within one week of the date of this paper with no more than five pages of argument discussing how the district court order affects the analysis of the Decision denying institution in these proceedings; and

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FURTHER ORDERED that Patent Owner is authorized to file a brief of no more than five pages of argument responding only to the contentions in Petitioner's brief within one week of service of Petitioner's brief.

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