

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SUPERCELL OY,
Petitioner,

v.

GREE INC.,
Patent Owner.

PGR2020-00046
Patent 10,328,347 B2

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

JUNG, *Administrative Patent Judge*.

DECISION

Denying Institution of Post-Grant Review
Granting Petitioner's Motion to Seal
35 U.S.C. § 324, 37 C.F.R. § 42.4

I. INTRODUCTION

A. Background and Summary

Supercell Oy ("Petitioner") filed a Petition (Paper 2, "Pet.") requesting institution of a post-grant review of claims 1–30 of U.S. Patent No. 10,328,347 B2 (Ex. 1001, "the '347 patent"). GREE, Inc.

(“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”). Petitioner also filed a Motion to Seal Exhibit 1026 and for Entry of Protective Order (Paper 8, “Mot.”). With our authorization, the parties further filed a Petitioner’s Reply to Patent Owner’s Preliminary Response (Paper 9, “Reply”) and Patent Owner’s Sur-reply to Petitioner’s Reply to Patent Owner’s Preliminary Response (Paper 10, “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.

B. 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.

C. Related Matters

The parties indicate that the ’347 patent is involved in *GREE, Inc. v. Supercell Oy*, No. 2:19-cv-00200-JRG-RSP (E.D. Tex.). Pet. 1; Paper 3, 3. Trial is set for December 7, 2020 in the parallel district court proceeding. Ex. 1027 (Fourth Amended Docket Control Order).

The ’347 patent issued from an application that is a continuation of U.S. Patent No. 9,597,594, which was at issue in *Supercell Oy v. GREE, Inc.*, PGR2018-00008. Ex. 1001, code (63). Certain claims of that related patent were determined to be unpatentable. *Supercell Oy v. GREE, Inc.*, PGR2018-00008, Paper 42 at 58 (PTAB Jan. 2, 2019) (Final Written Decision).

D. The ’347 Patent (Ex. 1001)

The ’347 patent issued on June 25, 2019 from an application filed on June 29, 2017 and claims priority to foreign applications, the earliest of

which was filed on September 27, 2013. Ex. 1001, codes (22), (30), (45), 1:7–16.

The '347 patent provides “a method for controlling a computer, etc., which makes it possible to improve the usability of city building games.” *Id.* at code (57). “The computer 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.* “The method includes when the template is applied to a predetermined area within the game space based on the command by the player, moving, by the computer, the game contents arranged within the game space to the positions of the game contents defined by the template.” *Id.*

E. Illustrative Claim

The '347 patent has 30 claims, all of which Petitioner challenges. Claims 1, 10, 19, and 28 are independent, and claim 1 is reproduced below.

A method performed by an electronic device, the method comprising:

executing a game by arranging game contents within a game space based on a command by a first player, the game contents including at least a game content for defending from an attack initiated by another player;

storing, in a memory, types and positions of the game contents arranged within the game space;

receiving, from a server, an event start notification corresponding to an event in the game;

receiving information for reproducing a template for defending an attack initiated by another player; and

applying the template to a game space by allocating one or more of the game contents to positions defined by the template based on a command received at an interface of the electronic device.

Ex. 1001, 26:35–50.

F. Asserted Prior Art and Proffered Testimonial Evidence

Petitioner identifies the following as prior art in the asserted grounds of unpatentability:

(1) Clash of Clans version 4.120 video game described in a Declaration of Antti Takala (Ex. 1010, “Clash of Clans”);

(2) Forum posts attached as Exhibit A to a Declaration of Sean Olesiuk who wrote the posts under the user name “Mastermind” (Ex. 1011, “Mastermind”); and

(3) U.S. Patent No. 9,079,105 B2, filed May 22, 2012, issued July 14, 2015 (Ex. 1012, “Kim”).

Pet. 41–42 (arguing that Clash of Clans and Mastermind are prior art under at least 35 U.S.C. § 102(a)(1) and Kim is prior art under at least § 102(a)(1) and (2)). Petitioner also provides a Declaration of Mark L. Claypool, Ph.D. Ex. 1008.

G. Asserted Grounds

Petitioner asserts that claims 1–30 would have been unpatentable on the following grounds:

Claims Challenged	35 U.S.C. §	References/Basis
1–30	101	Eligibility
1–30	103	Clash of Clans, Mastermind, Kim

H. 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

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

claimed invention that has an effective filing date on or after March 16, 2013. AIA § 3(n)(1). Because the application from which the '347 patent issued was filed on June 29, 2017 and the earliest foreign application it claims priority to was filed on September 27, 2013, the '347 patent is subject to the first inventor to file provisions of the AIA. Ex. 1001, codes (22), (30), 1:7–16.

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). The Petition was filed on March 24, 2020, which is within nine months of June 25, 2019, the issue date of the '347 patent. Ex. 1001, code (45); *see also* Pet. 2 (arguing that the Petition is timely filed). On this record, the '347 patent is eligible for post-grant review.

II. 35 U.S.C. § 324(a)

Patent Owner argues that we should exercise our discretion under 35 U.S.C. § 324(a) to deny institution “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.

A. *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.

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