

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SUPERCELL OY,
Petitioner,

v.

GREE INC.,
Patent Owner.

PGR2020-00049
Patent 10,335,689 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
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 1–12 of U.S. Patent No. 10,335,689 B2 (Ex. 1001, “the ’689 patent”). GREE, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”).

With our authorization, the parties also filed a Petitioner’s Reply to Patent Owner’s Preliminary Response (Paper 8, “Reply”) and Patent Owner’s Sur-reply to Petitioner’s Reply to Patent Owner’s Preliminary Response (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.

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 4, 2.

C. Related Matters

The parties indicate that the ’689 patent is involved in *GREE, Inc. v. Supercell Oy*, No. 2:19-cv-00237-JRG-RSP (E.D. Tex.). Pet. 1; Paper 4, 2–3. Trial is set for March 1, 2021, in the parallel district court proceeding. Ex. 1028 (Amended Docket Control Order entered Oct. 7, 2020).

D. The ’689 Patent (Ex. 1001)

The ’689 patent issued on July 2, 2019, from an application filed on March 31, 2017, that is a continuation of an application filed on September 10, 2014, and claims priority to a foreign application filed on December 27, 2013. Ex. 1001, codes (22), (30), (45), (63), 1:9–13.

The ’689 patent relates to “a battle game in which users each operate a unit” on a computer. *Id.* at code (57). The computer “var[ies] the unit parameter of a first unit on the field based on the group information associated with the first unit and the group information associated with a second unit on the field, the second unit having a predetermined positional

relationship with the first unit” and then “conduct[s] a battle between the first unit and other units using the varied unit parameter.” *Id.*

E. Illustrative Claim

The '689 patent has 12 claims, all of which Petitioner challenges. Claims 1, 5, and 9 are independent, and claim 1 is reproduced below.

1. A non-transitory computer readable recording medium having stored thereon instructions to be executed on a computer, the instructions causing the computer to perform steps of:

deploying a plurality of units on a field displayed on a display, the plurality of units being movable in the field;

varying an attack strength of a first unit among the plurality of units so that the attack strength of the first unit, in response to the first unit and a second unit among the plurality of units satisfying a first positional relationship by a movement of at least one of the first unit and the second unit, is decreased to be lower than the attack strength of the first unit when the first unit and the second unit do not satisfy the first positional relationship, wherein the attack strength is an attack strength for attacking a stronghold on the field and attacking a third unit, the first unit and the third unit not belonging to an identical group; and

attacking the stronghold by the first unit and the second unit,

wherein the first positional relationship is satisfied by the movement causing the second unit to be located within a first range of the first unit.

Ex. 1001, 14:19–41.

F. Asserted Prior Art and Proffered Testimonial Evidence

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

(1) Loe, Casey, *Valkyria Chronicles: BradyGames Official Strategy Guide*, BradyGames, 2008 (Ex. 1003, “VCSG”); and

(2) forum posts titled “stats/orders/potentials guide * spoilers* posted on Valkyria Chronicles Message Board for PlayStation 3, Gamefaqs, Parts 1 and 2, (available at <https://web.archive.org/web/20120423232250/http://www.gamefaqs.com/boards/942165-valkyria-chronicles/50848418> and <https://web.archive.org/web/20120501133143/http://www.gamefaqs.com/boards/942165-valkyria-chronicles/50848418?page=1>) (Ex. 1004, “Busard”).

Petitioner also provides a Declaration of Stephen H. Lane, Ph.D.
Ex. 1012.

G. Asserted Grounds

Petitioner asserts that claims 1–12 would have been unpatentable on the following grounds:

Claims Challenged	35 U.S.C. §	References/Basis
1–12	101	Eligibility
1, 3–5, 7–9, 11, 12	103	VCSG, Busard
2, 6, 10	103	VCSG, Busard, general knowledge

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 claimed invention that has an effective filing date on or after March 16, 2013. AIA § 3(n)(1). Because the application from which the ’689 patent issued was filed on March 31, 2017, and claims priority to a foreign application filed on December 27, 2013, the ’689 patent is subject to the first inventor to file provisions of the AIA. Ex. 1001, codes (22), (30), 1:9–13.

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

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 April 1, 2020, which is within nine months of July 2, 2019, the issue date of the ’689 patent. Ex. 1001, code (45); *see also* Pet. 2 (arguing that the Petition is timely filed); Paper 3 (according a filing date of April 1, 2020). On this record, the ’689 patent is eligible for post-grant review.

II. 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.

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.

Like 35 U.S.C. § 314(a) that applies to *inter partes* reviews, the language of § 324(a) expressly provides the Director with discretion to deny institution of a post-grant review. *See Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.