

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SUPERCELL OY,
Petitioner,

v.

GREE, INC.,
Patent Owner.

Case PGR2018-00039
Patent 9,669,308 B2

Before MICHAEL W. KIM, LYNNE H. BROWNE,
and CARL M. DEFRANCO, *Administrative Patent Judges*.

Browne, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING
37 C.F.R. § 42.71

I. INTRODUCTION

Supercell Oy (“Petitioner”) filed a Petition for post-grant review of claims 1–8 of U.S. Patent No. 9,669,308 B2 (Ex. 1001, “the ’308 patent”). Paper 1 (“Pet.”). GREE, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). The Board issued a Decision granting institution of post-grant review. Paper 8 (“Dec.”). On October 4, 2018, Patent Owner filed a Request for Reconsideration of the Decision. Paper 13 (“Request;” “Req.”). For the reasons that follow, the Request is *denied*.

II. ANALYSIS

A request for rehearing must identify specifically all matters the requesting party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d). When rehearing a decision on institution, the Board will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c).

Independent claim 1 of the ’308 patent recites, in pertinent part, “when the user has battled with the determined opponent in the past,” and “a second mode for executing the battle with fewer user operations received from the communication terminal than in the first mode.” Ex. 1001, 20:4–5, 7–10. Independent claims 7 and 8, recite the same limitations. *See id.* at 21:18–19, 21–24; 22:18–19, 21–24.

In our Decision granting institution, we stated:

we are not persuaded by Patent Owner’s argument that Petitioner fails to provide any factual evidence in support of the contention that the limitations of claims 1–8 were well-understood, routine, and conventional at the time of the invention. The Specification of the ’308 patent describes a battle game wherein the user selects commands to determine how the action progresses. *See* Ex. 1001, 1:41–43. The claimed “second mode” appears to be no more than the modeling of a previously manual procedure. Such modeling amounts to well understood, routine, and

conventional automation of a manual procedure in which the computer is merely used as a tool to perform the automation. *See [Leapfrog] Enterprises Inc. v. Fisher-Price Inc.*, 485 F.3d 1157 (Fed. Cir. 2007).

Patent Owner argues that the Board misapprehended or overlooked the Federal Circuit’s Decision in *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1367–68 (Fed. Cir. 2018). *See* Req. 3–4. According to Patent Owner, our reliance on *Leapfrog* is insufficient to meet the burden established in *Berkheimer*. *See id.* at 4. Patent Owner also argues that our reliance on the ’308 patent has no factual bearing on whether the limitations at issue were well-understood, routine, and conventional at the time of the invention. *See id.* at 4–5.

As Patent Owner correctly notes, “[i]n *Berkheimer*, the Federal Circuit held that ‘[t]he question of whether a claim element or combination of elements is well-understood, routine, and conventional to a skilled artisan in the relevant field is a question of fact.’” Req. 4 (citing *Berkheimer* at 1367–68). As an initial matter, we are unclear as to why the above portion of the ’308 patent¹ has *no* factual bearing with respect to the above claim

¹ Patent Owner asserts that “[n]otably, the Petition never points to those particular lines in the disclosure of the 308 Patent when discussing Step Two of the Alice analysis and never cites *Leapfrog*.” Req. 7–8. This portion of the ’308 patent was cited at page 32 of the Petition in the first paragraph under the headings “Alice Step 2: Claims 1-8 of the ’308 Patent Do Not Disclose An ‘Inventive Concept’ Sufficient to Transform Their Ineligible Abstract Idea into a Patent-Eligible Invention” and “Post Grant Review should be instituted because claims 1-8 lack a factual dispute regarding whether the invention describes well-understood, routine, and conventional activities.” While we acknowledge that *Leapfrog* was not cited in the Petition, we are unaware of any holding that restricts a tribunal to only relying on case law cited in a pleading.

limitations. For example, as noted by Patent Owner, the full quotation is “[i]n a conventional battle game, however, during one battle, the user needs to select a command to determine the action of the player character *many times . . .*” Ex. 1001, 1:41–43 (emphasis added). And by modeling that behavior in the future, the number of user operations are reduced.

Accordingly, while we acknowledge that it is plausible, during trial, that Patent Owner will be able to show that such a disclosure is insufficient evidentiary support for “a second mode for executing the battle with fewer user operations received from the communication terminal than in the first mode,” we disagree that it has *no* factual bearing on the above limitation.

Moreover, our Decision, with respect to the second step of *Alice*, did not rest solely on our determination that the claim elements or combinations of elements analyzed on pages 32–39 of the Petition were well-understood, routine, and conventional to a skilled artisan in the field. Rather, our Decision was also based on the sufficiency of Petitioner’s arguments in totality with respect to the second step of *Alice*, for example, that for some limitations, “the claimed improvements identified by Patent Owner do not improve the technological field. Rather, they improve game play for the user.” Dec. 17. Further, as we explained, “the claims recite the use of conventional computer activity to determine the outcome of the procedure. Such claims ‘defining a desirable information-based result and not limited to inventive means of achieving the result, fail under § 101’” and that “claim 1 merely indicates that these steps are performed by a server without further details.” Dec. 12–13 (citing *Elec. Power Group* 830 F.3d 1351; Ex. 1001, 19:52–20:11. While that analysis does concern the first step of *Alice*, it, nevertheless, does have some bearing on the second step as well.

Finally, Patent Owner identifies the Board's failure to explicitly address Patent Owner's countervailing evidence with respect to the above limitations, in particular, paragraphs 24 and 28–34 of Mr. Zyda's Declaration. Req. 8–9. While we acknowledge that it was not expressly referenced in our Decision, it was taken into account and determined that, while it is worthy of some weight, Petitioner's evidence and analysis presented a sufficient factual dispute for which trial is warranted.

Given the Petition's adequate analysis, at this stage of the proceeding, about the generic nature of the components recited in the '308 patent and the lack of inventive means for achieving the results claimed (Pet. 32–39), we are unpersuaded that our Decision granting institution was an abuse of discretion.

III. CONCLUSION

Patent Owner's Request for Rehearing is ***denied***.

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