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Paper 8
Entered: October 18, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SUPERCELL OY,
Petitioner,

v.

GREE, INC.,
Patent Owner.

Case PGR2018-00064
Patent 9,737,816 B2

Before LYNNE H. BROWNE, HYUN J. JUNG, and
CARL M. DEFRANCO, *Administrative Patent Judges.*

BROWNE, *Administrative Patent Judge*.

DECISION
Denying Institution of Post-Grant Review
35 U.S.C. § 324(a)

GREE, Inc. ("GREE") is the owner of U.S. Patent No. 9,737,816 B2 ("the '816 patent"). Supercell Oy ("Supercell") filed a Petition requesting post-grant review of claims 1–8 of the '816 patent. Paper 1 ("Pet."). GREE, in turn, filed a preliminary response. Paper 6 ("Prelim. Resp."). After considering the Petition and the Preliminary Response, as well as all

supporting evidence, we determine the Petition does not demonstrate that it is more likely than not at least one of the challenged claims of the '816 patent is unpatentable. 35 U.S.C. § 324(a). Thus, we do not institute post-grant review of claims 1–8 of the '816 patent.

I. BACKGROUND

A. The '816 Patent

The '816 patent issued August 22, 2017, and claims priority to U.S. Patent No. 9,561,434 B2, filed February 6, 2014 ("the '434 patent"). Ex. 1001, cover [45], [63]. The '434 patent claims priority to JP 2013-031903 ("the '903 application"), filed February 21, 2013.[1] *Id.* at 1:8–14. After considering the Petition and Preliminary Response, we conclude that Petitioner fails to demonstrate that the '816 patent is eligible for post-grant review.

The '816 patent purports to disclose a game method, and corresponding computer and program, "to provide a ranking list display method in a game system, which can easily execute ranking confirmation of a user, who is a ranking confirmation target, such as the user himself/herself, a friend or a rival, and a system for executing this method." *Id.* at 1:66–2:3. The game has "the server group 2 for executing a main process for realizing the ranking list display method . . . and a plurality of computers 3-1 and 3-2 and mobile phones 4-1 and 4-2." *Id.* at 3:32–36 (emphasis omitted). The computers and mobile phones are used by users "connected to a network 1 such as the Internet via an access a point 5 or a base station 6." *Id.* at 3:36–39.

[1] Hereinafter, all reference to the disclosure of the '903 application is to the certified translation of this document (i.e. Ex. 1010).

According to the '816 patent, given the recent popularity of social networking service, the number of users of games using those services reaches several million users in some cases. *See* Ex. 1001, 1:28–30. As a consequence, "the Quantity of ranking information is enormous, the work of a user for confirming the ranking of the user himself/herself, a rival or a friend is time-consuming." *Id.* at 1:31–34. To address this problem, the '816 patent purports to make it "possible to easily execute ranking confirmation of a user, who is a ranking confirmation target, such as the user himself/herself, a friend or a rival." *Id.* at 2:16–19. In order to achieve this result, the server includes a CPU 32 that "cooperates with a client-side ranking list display process program 37-3 . . . which is stored in the storage device 37, and the CPU 32 executes the ranking list display method in the game system according to the embodiment and also executes overall control of the mobile phone." Ex 1001, 4:62–67 (emphasis omitted).

B. Representative Claim

The '816 patent includes 8 claims, of which claims 1, 2, and 8 are independent. All three independent claims recite essentially identical limitations and vary only as to type, where claim 1 is directed to a "method," claim 2 to an "electronic device," and claim 8 to a "non-transitory computer-readable medium." Ex. 1001, 10:64, 11:27, 12:32. Common across the independent claims are seven functional steps including controlling or control of a user interface by the electronic device's circuitry to display a ranking list in response to a user display request "wherein the position is

identified by the computer based on ranking data stored in the computer."

Id. at 10:64–11:54, 12:32–61. Claim 1 is representative and recites:

> 1. A method performed by an electronic device, the method comprising:
>
> transmitting, via a communication interface of the electronic device, a display request for a ranking list to a computer, the display request including identification information corresponding to a user who is a ranking confirmation target;
>
> controlling, by circuitry of the electronic device, the communication interface to receive, in response to the display request, a position in the ranking list of the user in relation to a display range of the ranking list from the computer, wherein the position is identified by the computer based on ranking data stored in the computer;
>
> displaying, by the circuitry, a pointer that corresponds to the position received by the communication interface determining, by the circuitry, based on a user input at the electronic device, whether the display range is changed;
>
> determining, by the circuitry, when it is determined that the display range is changed, a direction of the pointer based on the changed display range and the position received by the communication interface;
>
> determining, by the circuitry, that a user input is received at the pointer displayed by the electronic device;
>
> controlling, by the circuitry, the communication interface to receive the ranking data including another user based on the user input received at the pointer; and
>
> display, by the circuitry, the display range of the ranking list including a rank of the another user based on the received ranking data.

B. The Asserted Grounds of Unpatentability

The Petition asserts that claims 1–8 of the '816 patent are unpatentable as: (1) being directed to non-statutory subject matter under 35 U.S.C. § 101 (Pet. 32–59); (2) failing to comply with the written description requirement of 35 U.S.C. § 112(a) (*id.* at 60–67); and (3) failing

to comply with the definiteness requirement of 35 U.S.C. § 112(b) (*id.* at 67–72).

II. ANALYSIS

The post-grant review provisions of the Leahy-Smith America Invents Act ("AIA")[2] 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). 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).

As noted *supra*, the '816 patent issued on August 22, 2017, and claims the benefit of the '903 application filed on February 21, 2013. The instant Petition was filed on May 2, 2018 (*see also* Paper 5, 1 (according the Petition a filing date of May 2, 2018)), which is within nine months of the date of the grant of the '816 patent.

Petitioner asserts that claims 1–3 and 5–8 of the '816 patent are not entitled to the filing date of the '903 application and that the "effective filing date of the challenged claims is no earlier than December 21, 2016." *See* Pet. 24–30. According to Petitioner, "[t]he '903 application never describes or mentions 'controlling, by circuitry of the electronic device, the communication interface to receive, in response to the display request, a

[2] Pub. L. No. 112-29, 125 Stat. 284 (2011).

position in the ranking list from the computer, wherein the position is identified by the computer based on ranking data stored in the computer.'" Pet. 27–28. Petitioner notes that "[n]o form of the term 'circuitry' can be found in the application in the context of receiving a position in response to the display request." *Id.* at 28 (footnote omitted). Petitioner further notes that "[i]n addition, 'communication interface' is not found within the '903 application, nor is 'controlling… the communication interface' to receive a position, whether by circuitry or otherwise." *Id.*

While admitting that the claim term "circuitry" does not appear in the '903 application, Patent Owner submits that "[t]he test for sufficiency of support in an application is not 'the presence or absence of literal support in the specification for the claim language.'" Prelim. Resp. 3 (citing *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983)). Patent Owner further submits that "[i]nstead, it is whether the disclosure of the application relied upon, including foreign applications, reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." *Id.* (citing *Vas–Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1560 (Fed. Cir. 1991), further citations omitted). Patent Owner is correct. We apply this standard in determining whether or not the '903 application provides sufficient disclosure of the subject matter claimed in claims 1–3 and 5–8[3] of the '816 patent, to entitle these claims to the benefit of the filing date of the '903 application.

Addressing Petitioner's allegation that the '903 application does not provide support for the claimed circuitry, Patent Owner notes that "Fig. 4

[3] We also apply this standard in determining the eligibility of claim 4, which Petitioner argues separately, addressed *infra*.

and its accompanying descriptions in the '903 application show components that make up an exemplary embodiment of a mobile phone, including but not limited to a CPU 32, memory 34, storage 37, and a display controller 39 all connected via a bus 31." Prelim. Resp. 5–6; *see also id.* at 11–12 (citing Ex. 1010 ¶¶ 47, 52–55 in a claim chart), 19–20 (citing Ex. 1010 ¶¶ 47, 52–55 for corresponding recitation in independent claim 2 in a claim chart), 26–27 (citing Ex. 1010 ¶¶ 47, 52–55 for corresponding recitation in independent claim 8 in a claim chart). Given this disclosure in the '903 application, Patent Owner asserts that "[a] POSITA would have readily recognized that such exemplary electronic components are circuitry." *Id.* at 6 (citing Ex. 2001 ¶¶ 37–41). Patent Owner further asserts that as "the '903 application discloses that the CPU 32 utilizes a client-side ranking list display processing program 37-3 to 'control the entire mobile phone 4 in addition to performing the ranking displaying method of a game system according to the embodiment of the present invention,'" "a POSITA would clearly and readily recognize that circuitry, such as CPU 32 working with other components of the mobile phone . . . is configured . . . to 'control' the entire mobile phone and performance of the disclosed methods of the invention." *Id.* (citing Ex. 1010 ¶¶ 34, 44; Ex. 2001 ¶¶ 47–51, 55).

Turning to Petitioner's allegation that the '903 application does not provide support for the claimed communication interface, Patent Owner asserts that "a POSITA would clearly and readily recognize that the exemplary electric devices in the '903 patent . . . which communicate with servers 2 over networks such as the internet, include communication interfaces, of which wireless communicating unit 33 is one example." Prelim. Resp. 7 (citing Ex. 2001 ¶¶ 42–46).

Paragraph 101 of the '903 application discloses components such as CPU 32 that one skilled in the art would have understood to constitute circuitry as claimed. *See* Ex. 1010 ¶ 101. Paragraph 101 also discloses a wireless communicating unit 33 that one skilled in the art would have understood to constitute a communication interface as claimed. *See also id.* Fig. 4 (showing "CPU" 32 coupled to "Wireless communicating part" 33 via "Bus" 31 and "Internet" in communication with "Wireless communicating part" 33). Given these disclosures, the limitations at issue are fully supported by the '903 application.

In addition, Petitioner asserts that "[t]he '903 application fails to disclose controlling, by the circuitry, the communication interface to receive ranking data." Pet. 29. In support of this assertion, Petitioner again argues that "[n]either 'circuitry' nor 'communication interface' is found within the specification in any context, and controlling the communication interface to receive ranking data, whether by circuitry or otherwise, is never disclosed at any point, in any form in the written description of the '903 application." Pet. 30. For the reasons discussed *supra*, Petitioner's arguments are unpersuasive.

The method described in the '903 application is shown in Figure 6. Similarly, the method described and claimed in the '816 patent is shown in its Figure 6. Comparison of Figure 6 of the '903 application to Figure 6 of the '816 patent shows that these Figures are substantially the same, with only minor differences in wording such as the use of the term "order" in the '903 application as opposed to the term "rank" in the '816 patent. *Compare* Ex. 1010, Fig. 6, S1 *with* Ex. 1001, Fig. 6, S1. One skilled in the art considering both Figure 6 of the '903 application and Figure 6 of the '816

patent would understand that the flowcharts depicted show how order or rank information is received via circuitry by the communication interface. Thus, the limitations at issue are also supported by Figure 6 of the '903 application. Accordingly, Petitioner fails to demonstrate that claims 1–3 and 5–8 are not entitled to the benefit of the filing date of the '903 application.

Specifically for claim 4, Petitioner asserts that "the '903 [application] does not provide adequate written description of configuring circuitry to display information when a user input is accepted." Pet. 31. Petitioner argues that "neither the word nor the subject matter of 'accepting' a predetermined user input to the pointer is contained within the '903 application whatsoever, and displaying information when predetermined user input to the pointer is accepted, whether by circuitry or otherwise, is never mentioned within the application." *Id.*

As a preliminary matter, we note that claim 4 requires circuitry that "is configured to display information . . . when a predetermined user input to the pointer is accepted." Ex. 1001, 12:17–19. Claim 4 does not require configuring of this circuitry. *See id.* Turning to Petitioner's assertions, Petitioner arguments are once again premised on the notion that in order to support the limitation at issue, the Specification of the priority document must describe the claimed invention in the exact same terms as used in the claims at issue. As discussed *supra*, word-to-word identity is not required.

Patent Owner identifies the support in the '903 application for the limitation of claim 4 in a claim chart. Prelim. Resp. 24. Patent Owner explains that whether a pointer selecting operation has been

performed is determined at S31. *Id.* (citing Ex. 1010 ¶¶ 82–83). Patent Owner notes that the pointer selection operation is double tapping or a long press of a button for example. *Id.* Patent Owner further explains that if the pointer selecting operation is determined to have been performed, the ranking data 41 including the order data 42 of the pointer setting target user ID 45 is acquired at S32 and a detailed information screen is displayed based on the acquired ranking data in S33. *Id.* Patent Owner's explanations are supported by paragraphs 82 and 83 of the '903 application. Thus, Petitioner fails to demonstrate that claim 4 is not entitled to the benefit of the filing date of the '903 application.

III. CONCLUSION

Claims 1–8 of the '816 patent are entitled to the benefit of the filing date of the '903 application. As the filing date of the '903 application is February 21, 2013, which is prior to March 16, 2013, the '816 patent is not subject to the first-inventor-to-file provisions of the AIA. Thus, claims 1–8 of the '816 patent are not eligible for post-grant review.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that institution of a post-grant review of the '816 patent is denied.

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