

Nos. 2019-1864; 2019-1960

**United States Court of Appeals
for the Federal Circuit**

GREE, INC.

Appellant,

v.

SUPERCELL OY,

Cross Appellant.

Appeal from the United States Patent and Trademark Office,
Patent Trial and Appeal Board in No. PGR2018-00008

**CORRECTED PETITION FOR REHEARING OR REHEARING
EN BANC OF GREE, INC.**

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**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

CERTIFICATE OF INTEREST

Case Number 2019-1864; 2019-1960

Short Case Caption Gree, Inc.

Filing Party/Entity Supercell OY

Instructions: Complete each section of the form. In answering items 2 and 3, be specific as to which represented entities the answers apply; lack of specificity may result in non-compliance. **Please enter only one item per box; attach additional pages as needed and check the relevant box.** Counsel must immediately file an amended Certificate of Interest if information changes. Fed. Cir. R. 47.4(b).

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: 01/22/2021

Signature: /s/ John C. Alemanni

Name: John C. Alemanni

<p>1. Represented Entities. Fed. Cir. R. 47.4(a)(1).</p>	<p>2. Real Party in Interest. Fed. Cir. R. 47.4(a)(2).</p>	<p>3. Parent Corporations and Stockholders. Fed. Cir. R. 47.4(a)(3).</p>
<p>Provide the full names of all entities represented by undersigned counsel in this case.</p>	<p>Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.</p> <p><input checked="" type="checkbox"/> None/Not Applicable</p>	<p>Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.</p> <p><input checked="" type="checkbox"/> None/Not Applicable</p>
<p>GREE, Inc.</p>		

Additional pages attached

4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

None/Not Applicable Additional pages attached

Paul Hastings LLP	Phillip W. Citroen	
Joseph E. Palys	Scott E. Kolassa	
Naveen Modi		

5. Related Cases. Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. Do not include the originating case number(s) for this case. Fed. Cir. R. 47.4(a)(5). See also Fed. Cir. R. 47.5(b).

None/Not Applicable Additional pages attached

Gree, Inc. v. Supercell OY, Case No. 2:19-cv-00071 (EDTX)		
Gree, Inc. v. Supercell OY, Case No. 2:19-cv-00200 (EDTX)		

6. Organizational Victims and Bankruptcy Cases. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

None/Not Applicable Additional pages attached

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FEDERAL CIRCUIT RULE 35(b)(2) STATEMENT

Based on my professional judgment, I believe the panel decision is contrary to the following decisions of the Supreme Court of the United States and precedents of this court:

Alice Corp. Pty. Ltd. v. CLS Bank International, 573 U.S. 208 (2014); *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014); *Apple Inc. v. Samsung Electronics Co.*, 839 F.3d 1034 (Fed. Cir. 2016); *Aatrix Software, Inc. v. Green Shades Software, Inc.*, 882 F.3d 1121 (Fed. Cir. 2018); *Berkheimer v. HP Inc.*, 881 F.3d 1360 (Fed. Cir. 2018); *MyMail, Ltd. v. ooVoo, LLC*, 934 F.3d 1373 (Fed. Cir. 2019).

Based on my professional judgment, I believe this appeal requires an answer to one or more precedent-setting questions of exceptional importance:

Patents are valid under 35 U.S.C. § 101 unless a Post-Grant Review Petitioner proves by a preponderance of evidence that the claims: (1) are “directed to” an abstract idea, and (2) lack an “inventive concept,” *i.e.*, “additional features” to ensure “that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].” *Alice*, 573 U.S. at 217-18, 221 (alterations in original) (citation omitted). The second step of the *Alice* test is satisfied if the additional features—the claim elements or combinations of elements—are not “well-understood, routine, conventional.” *Id.* at 225 (citation omitted). “The 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.” *Berkheimer*, 881 F.3d at 1367.

The questions this Petition raises are:

1. May a Panel of this Court disregard the Patent Trial and Appeal Board’s finding that the Petition did not present evidence or arguments that features recited by claims 2-4 and 9 were well-known, routine, or conventional, and, instead make its own finding of fact that the features were well-known, routine, or conventional, without applying the correct standard of review or burden of proof, without citing to evidentiary support or analysis in the record, and without deference to the PTAB’s findings and analysis of the evidentiary record?

2. Where an earlier Panel of this Court has previously found that a nearly identical idea to which claims 2-4 and 9 are directed is non-abstract, may a Panel of this Court nevertheless find the claims here directed to an abstract idea without addressing that earlier Panel’s decision, thereby increasing the unpredictability and uncertainty of the *Alice* test and stifling innovation?

January 22, 2020

Respectfully submitted,

/s/ John C. Alemanni

John C. Alemanni

INTRODUCTION

The Panel decision that reversed the Board’s judgment of no unpatentability as to claims 2-4 and 9 of U.S. Patent No. 9,597,594 (“the ’594 Patent”) errs because it: (1) decides the factual questions presented under *Alice* step two anew in contravention of *Berkheimer* and *Aatrix*, without addressing the Board’s earlier factual findings under *Alice* step two or the proper standard of review on appeal and burden of proof Supercell bore before the Board, and (2) ignores a prior directly analogous decision of this Court addressing *Alice* step one regarding ideas that are non-abstract.¹

GREE and Supercell are competitors in the video game industry, and each designs mobile game applications used on mobile devices such as smartphones. Both parties have asserted multiple patents against each other throughout the world. On September 18, 2020, after a seven-day jury trial, a jury found that Supercell willfully infringed one or more of GREE’s five asserted patents including claim 2 of the ’594 Patent and awarded GREE \$8,500,000 in damages. *GREE, Inc. v. Supercell Oy*, No. 2:19-cv-00071, Dkt. 475 (E.D. Tex. Sept. 18, 2020).

In November 2017, Supercell petitioned for post-grant review of the ’594 Patent, asserting unpatentability under 35 U.S.C. § 101. *GREE, Inc. v. Supercell Oy*,

¹ GREE does not request rehearing of the Panel’s affirmance that claims 1, 8, and 10-20 are ineligible. In addition, the Panel affirmed that claims 5-7 are not ineligible.

Nos. 2019-1864, -1960, Dkt. 59 (Fed. Cir. Nov. 19, 2020) (“Op.”) at 6; Appx0091-0137. The Board instituted as to all claims. Appx0277.

In January 2019, the Board determined that Supercell failed to sufficiently address claims 2-4 and 9 in the Petition and its evidentiary submissions to meet its burden of proof, and thus confirmed the validity of those claims. Appx0043. On rehearing, the Board considered evidence Supercell offered in relation to the *Alice* step two analysis and found that it did not show that claims 2-4 and 9 were routine, conventional, or well-understood. Appx0273.

In November 2020, the Panel reversed as to claims 2-4 and 9. The Panel erred for two reasons. *First*, the decision contravenes prior panel decisions such as *Berkheimer* and *Aatrix* by deciding, without applying the proper standard of review or burden of proof, the factual questions under *Alice* step two contrary to the Board’s findings of eligibility of claims 2-4 and 9. Step two turns on “[w]hether the claim elements or the claimed combination are well-understood, routine, conventional”—“a question of fact.” *Aatrix*, 882 F.3d at 1128. This Court has consistently recognized that “[f]act-finding by the appellate court is simply not permitted.” *Atl. Thermoplastics Co., Inc. v. Faytex Corp.*, 5 F.3d 1477, 1479 (Fed. Cir. 1993). Other panels have held that they could not reach step two precisely because it “may involve subsidiary fact questions,” and “[i]t is improper . . . to determine factual issues in the first instance on appeal.” *MyMail*, 934 F.3d at 1380. Moreover, members of this

Court have criticized other decisions for making factual findings in § 101 analysis on appeal. *See, e.g., Ericsson Inc. v. TCL Commc'n Tech. Holdings Ltd.*, 955 F.3d 1317, 1331 (Fed. Cir. 2020) (Newman, J., dissenting).

The Panel ignored these holdings when it reversed the Board as to claims 2-4 and 9 without applying the appropriate standard of review or addressing the Board's findings regarding the evidence cited below. This error is particularly problematic here, where the Board's findings below are that the grounds as to these claims were "not presented adequately in the Petition" in the first instance and that the evidence Supercell submitted on rehearing before the Board did not disclose the recited limitations. Appx0273.

Panel or *en banc* rehearing is needed to apply *Berkheimer/Aatrix* and "to affirm [this Court's] understanding of the appellate function as limited to deciding the issues . . . only on the basis of the record made below, and as requiring appropriate deference be applied to the review of fact findings." *Apple*, 839 F.3d at 1039. This Court should grant rehearing and vacate its *Alice* step-two finding, both because the Panel overstepped the proper role of an appellate court and because, in doing so, it ignored the Board's conclusions regarding arguments not made in the Petition or supported by the evidence Supercell presented.

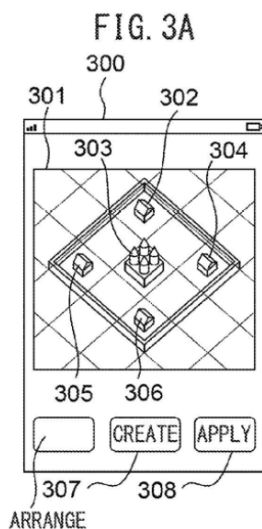
Second, the '594 Patent identifies the problem that it solves as retaining a player's interest in a video game. In *DDR*, this Court found that a nearly identical

problem, “th[e] challenge of retaining control over the attention of the customer in the context of the Internet,” is not abstract. *DDR*, 773 F.3d at 1258. GREE heavily relied on *DDR* on this issue before this Court in support of its arguments as to Step one, yet the Panel did not cite to, much less distinguish, *DDR*. Rehearing is appropriate to address this inconsistency among panels.

BACKGROUND

I. The '594 Patent.

In computer games that involve building and defending a virtual city, it can be difficult for a player to design a city with effective defenses. Such games have a competitive element where “a city built by one player is attacked by a different player, and the city (arrangement of items such as protective walls, buildings that are subject to an attack, protecting soldiers, weapons, etc.) is one of [the] factors for deciding the winning and losing, or superiority and inferiority.” Appx0077 at 1:44-50. Figure 3A from the '594 Patent shows a simplified version of such a city.

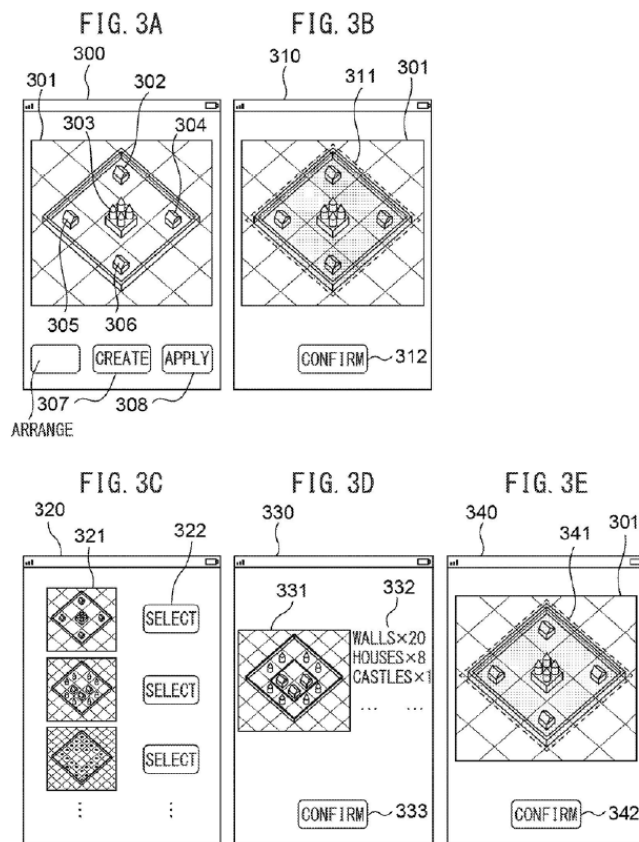


Appx0064, Fig. 3A.

The '594 Patent identifies a problem in user interfaces of such video games— as the user’s city becomes more complex, repositioning the structures “as the game progresses . . . becomes monotonous, and players might become bored with [the game].” Appx0077 at 1:58-60. To “improve the usability of city building games and

continuously attract players to the game,” the ’594 Patent describes and claims the use of templates that contain previously determined positions of game contents. Appx0077 at 1:63-65.

“When a template is applied, facilities arranged within the game space are automatically changed to the facilities defined in the template, and they are automatically moved to the defined positions.” Appx0078 at 4:34-37; *see also* Appx0089, claim 1 (“[M]oving, by the computer, the game contents arranged at the first positions within the game space to the second positions of the game contents defined by the template”). Creation and application of a template in the game space is illustrated in Figures 3A-3E (Appx0064).



The independent claims recite, for example, “storing first positions of game contents; creating a template defining game contents and second positions of one or more of the game contents...; and applying the template to a predetermined area within the game space.” Appx0090 at 28:11-25. Claims 2-4 and 9 are directed specifically to the sharing of templates between multiple players: “Claims 2–4 recite the additional limitations of storing templates of different players, applying the templates of different players, and obtaining and applying templates from different computers.” Op. 12 (citing ’594 Patent col. 26:47-27:7).

The ’594 Patent states that “by making the arrangement of facilities changeable by using templates, the usability of city building games is improved, and it becomes possible to continuously attract players to the game.” Appx0084 at 15:49-52. By eliminating the substantial time and effort involved in creating or recreating effective game spaces such as cities, the systems and methods described and claimed in the ’594 Patent decrease the amount of time users must spend to design and implement aspects of a game space, thus increasing user attention and engagement, avoiding the monotony that players otherwise experience.

II. Procedural History.

The ’594 Patent issued on March 21, 2017. Appx0060. While the parties were engaged in litigation in Japan over a related patent, Supercell petitioned for post-grant review of the ’594 Patent on November 6, 2017. The only invalidity ground it

raised was unpatentability under 35 U.S.C. § 101. Appx0091-0137. The Board's final written decision issued on January 2, 2019, affirming the patentability of claims 2-7 and 9, but finding claims 1, 8, and 10-20 unpatentable. Appx0001-0059.

The Board applied the "two-step framework" articulated in *Alice*. Appx0012. With respect to *Alice* step one, the Board concluded that the independent claims were directed to "creating and applying a template of positions of one or more game contents" and found this concept to be an abstract idea. Appx0024, Appx0031.

In so doing, the Board relied on a 2016 web page describing a method of playing chess called "correspondence chess" in which one player writes a chess move on a postcard and then mails the postcard to another player. Appx0014. The Board found "that this corresponds properly to 'creating and applying a template of positions of one or more game contents'" and thus the claims were directed to this abstract idea. Appx0036-0037.

With respect to *Alice* step two, the Board found no inventive concept was recited in the independent claims. Appx0042. With respect to dependent claims 2-4 and 9, however, the Board found that Supercell "did not provide any evidentiary support or analysis to show that 'a template based on a combination of more than one template' was 'well-understood, routine, conventional.'" Appx0043. Noting that Supercell "has not provided any evidence, identified any case law, or provided sufficient analysis that the aforementioned limitations were either 'conventional' or

‘obvious,‑‑’ the Board ultimately determined that Supercell failed in its burden with respect to claims 2-4 and 9. Appx0045, Appx0049.

Supercell requested rehearing, arguing that the same correspondence chess evidence supported a lack of inventive concept. Appx0269. The Board denied Supercell’s request, explaining:

[The Petitioner’s] argument does not sufficiently account for the above-identified portions of dependent claims 2 and 3, i.e., that the second player can both create and apply a template. Contrary to the Petition’s strained characterization of correspondence chess, i.e., in which a *player creates* a template and the *same player* also *applies* it by sending it to another player, we found that correspondence chess entails a *first player creating* a template and a *different, second player applying* the template. Institution Dec. 8; Final Dec. 14 (citing Pet. 22). As such, we fail to see how correspondence chess, where a *first player creates* a template and a second player plays or *applies* it, accounts for a concept in which a second player can *both create and apply* a template.

Appx0273.

After the Board upheld claims 2-7 and 9, GREE sued Supercell for infringement of claim 2 of the ’594 Patent and four unrelated patents. In September 2020, a jury found Supercell willfully infringed at least one claim and awarded GREE \$8,500,000 in damages. *GREE, Inc. v. Supercell Oy*, Case No. 2:19-cv-00071, Dkt. 475 (E.D. Tex. Sept. 18, 2020). In post-trial motions, Supercell asks the

district court to award a new trial based upon the Panel’s decision as to claim 2. *Id.* at Dkt. 381.

In reversing the Board as to claims 2-4 and 9, the Panel noted that “the claimed invention sought to address th[e] monotony problem” and addresses this problem by “employ[ing] templates to improve the usability of city building games.” Op. 3. With respect to step one of *Alice*, the Panel held that “[c]onsidered in their entirety, the claims of the ’594 Patent are directed to creating and applying templates to a game space to simplify game play.” Op. 3, 9.

With respect to step two, the Panel stated that “claims 2-4 and 9 recite generic computer components performing their standard functions, and *they are broad enough to encompass the implementation of long-standing and conventional correspondence chess on a computer.* We therefore conclude that the Board erred in concluding that claims 2-4 and 9 provide an inventive concept.” Op. 12 (emphasis added).

POINTS OF LAW OVERLOOKED BY THE PANEL

First, in reversing as to step two, the Panel made its own finding of fact without record support and in disregard of the standard of review. The Panel’s finding directly contradicts the Board’s findings on the same issue. The decision disregards the longstanding rule that appellate courts cannot “determine factual issues in the first instance on appeal.” *MyMail*, 934 F.3d at 1380.

Second, in deciding step one, the Panel ignored that the problem identified and solved in the '594 Patent of retaining a player's interest in a video game is nearly identical to the problem addressed in *DDR*—"this challenge of retaining control over the attention of the customer in the context of the Internet." *DDR*, 773 F.3d at 1258. Such inconsistent results create uncertainty, thereby stifling innovation.

ARGUMENT

I. The Panel's Decision Exceeds this Court's Appellate Role by Determining Eligibility Under *Alice* Step Two in the First Instance on Appeal.

"It is improper for [the Federal Circuit] to determine factual issues in the first instance on appeal." *MyMail*, 934 F.3d at 1380; *3M Co. v. Avery Dennison Corp.*, 673 F.3d 1372, 1378 (Fed. Cir. 2012). At *Alice* step two, "[w]hether the claim elements or the claimed combination are well-understood, routine, [and] conventional is a question of fact." *Aatrix*, 882 F.3d at 1128; *see also Berkheimer*, 881 F.3d at 1368; *BSG Tech LLC v. Buyseasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018); *Cellspin Soft, Inc. v. Fitbit, Inc.*, 927 F.3d 1306, 1317-18 (Fed. Cir. 2019); *Am. Axle & Mfg., Inc. v. Neapco Holdings LLC*, 967 F.3d 1285, 1291-92 (Fed. Cir. 2020).

This Court "review[s] the PTAB's factual findings for substantial evidence and its legal conclusions de novo." *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 449 (Fed. Cir. 2015) (citation omitted). "If two 'inconsistent

conclusions may reasonably be drawn from the evidence in record, [the PTAB’s] decision to favor one conclusion over the other is the epitome of a decision that must be sustained upon review for substantial evidence.” *Elbit Sys. of Am., LLC v. Thales Visionix, Inc.*, 881 F.3d 1354, 1356 (Fed. Cir. 2018) (alteration in original) (citation omitted).

In addressing *Alice* step two and claims 2-7 and 9, the Panel failed to apply the correct standard of review, performed its own fact-finding, and ignored the Board’s findings of fact on this issue. As the Panel stated:

the Board concluded that claims 2-7 and 9 each recite an inventive concept. The Board agreed with Supercell’s characterization of claims 2-4 and 9, but rejected Supercell’s assertion that these claims confer no inventive concept, reasoning that Supercell failed to address “‘a template based on a combination of more than one template’ in some form or manner.”

Op. 6-7 (citation omitted).

Indeed, as the Board explicitly found when addressing claims 2-4 and 9, Supercell submitted no evidence—expert testimony or otherwise—as to what a person of ordinary skill in the art would have considered well-understood, routine, or conventional at the time of the ’594 Patent. *See* Appx0271-0272. In contrast, GREE submitted *unrebutted* evidence through both expert testimony of Mr. Crane and the disclosure of the ’594 Patent supporting the fact that the limitations of claims

2-4 and 9 were *not* routine, conventional, or well-understood. *See, e.g.*, Appx0396-0397 ¶¶ 32-34.

The Board correctly determined that Supercell failed to properly present its argument as to these claims in the first instance. Appx0043 (“[W]e are unpersuaded that Petitioner has met its burden of showing that dependent claims 2-4 and 9 do not contain an inventive concept beyond the abstract idea of ‘creating and applying a template of positions of one or more game contents.’”).

In its request for rehearing, Supercell asked the Board to evaluate the evidence of correspondence chess the Board analyzed for the independent claims, arguing that “[s]ince the evidence relied upon and the Board’s conclusion fully accounts for creating and applying a template ‘related to a different player’ in a multi-player environment, the Board should have found claims 2 and 3 patent ineligible under the same framework applied to claim 1.” Appx0263. In response, the Board reiterated that it had “determined that [Supercell’s] analysis and evidence for dependent claims 2 and 3, which was essentially limited to a sentence on page 33 of the Petition, was similarly insufficient.” Appx0271 (citations omitted).

The Board further noted that “according to the Petition itself, dependent claims 2 and 3 contain the additional details of ‘in a multi-player environment.’” Appx0272. With respect to these “additional details” the Board was “unpersuaded that a second player, that can both ‘create’ and ‘apply’ a template, is accounted for

adequately in the Petition. Specifically, even if we were to agree the Petition accounts for a second player ‘applying’ a template ‘in a multi-player environment’, the Petition makes *no mention* of the second player being able to *also create* the template. Appx0272 (citations omitted). The Board concluded that it “could not have overlooked or misapprehended something *not presented adequately* in the Petition.” Appx0273 (emphasis added).

Having found Supercell’s arguments insufficient to meet its burden, the Board nevertheless analyzed this evidence and likewise found it insufficient:

Contrary to the Petition’s strained characterization of correspondence chess, i.e., in which a *player creates* a template and the *same player* also *applies* it by sending it to another player, we found that correspondence chess entails a *first player creating* a template and a *different, second player applying* the template. As such, we fail to see how correspondence chess, where a *first player creates* a template and a second player plays or *applies* it, accounts for a concept in which a second player can *both create and apply* a template.

Appx0273 (citations omitted).

The Board’s finding regarding correspondence chess as to claims 2-4 and 9 is subject to the deferential substantial evidence standard. *Redline Detection*, 811 F.3d at 449. But the Panel did not acknowledge, let alone find error in this finding. Nor did the Panel even mention the appropriate standard of review in so holding. Instead,

the Panel merely held, without further elaboration, that correspondence chess did in fact render claims 2-4 and 9 routine, conventional, or well-understood.

It was error for the Panel to make contrary factual determinations in the first instance. The Panel did not recite the standard of review nor cite any portion of the Board's findings as to the record evidence for its conclusion regarding step two and correspondence chess. Op. 12. Rather, the Panel simply stated, without *any citation or explanation*, that "claims 2-4 and 9 recite generic computer components performing their standard functions, and they are broad enough to encompass the implementation of long-standing and conventional correspondence chess on a computer." *Id.* Thus, the Panel did not indicate why the Board erred in finding otherwise as to the disclosure of correspondence chess.

Moreover, neither the Board nor the Panel ever considered GREE's *unrebutted evidence* demonstrating that the claims recite significantly more than what Supercell contended was an abstract idea. Specifically, as noted above, GREE presented *unrebutted evidence* demonstrating that the claims pass muster under step two. *See, e.g.*, Appx0396-0397 ¶¶ 32-34. However, the Board never reached this evidence since it concluded Supercell had failed to meet its burden of proof as to claims 2-4 and 9, and the Panel ignored this evidence altogether.

It was improper for the Panel to disregard the PTAB's conclusions and GREE's evidence and instead engage in fact-finding in the first instance, in

particular without providing any citation to record evidence or consideration of the un rebutted evidence submitted by GREE. *MyMail*, 934 F.3d at 1380. The Court should grant GREE’s combined petition “to affirm [its] understanding of the appellate function as limited to deciding the issues . . . only on the basis of the record made below.” *Apple*, 839 F.3d at 1039. Further, the Court should reverse the Panel’s decision as to claims 2-4 and 9 or, at a minimum, remand to the Board for further proceedings as to step two.

II. The Panel’s Decision Is Inconsistent with This Court’s Precedent Under *Alice* Step One and Should Be Rejected.

Congress created the Federal Circuit to increase the uniformity of patent law: “The establishment of the Court of Appeals for the Federal Circuit [] provides a forum that will increase doctrinal stability in the field of patent law.” *See* S. Rep. No. 97-275, at 5 (1981). The lack of uniformity of patent law prior to this Court’s establishment created uncertainty and thus discouraged innovation. *Id.* at 6. As President Carter noted, the creation of the Federal Circuit “would expand the Federal judicial system’s capacity for definitive adjudication of national law and thereby contribute to the uniformity and predictability of legal doctrine in these areas, which have long been marked by inconsistent appellate decisions, [and] encourage industrial innovation.”²

² Jimmy Carter, *Federal Civil Justice System Message to the Congress on Proposed Legislation* (February 27, 1979) (transcript available at

However, inconsistency, particularly in relation to patent eligibility, is an ongoing problem:

Our job, our mandate from Congress is to create a clear, uniform body of patent law. Our inability to do so in the § 101 space has not been a mess of our making.

American Axle & Manufacturing, Inc. v. Neapco Holdings LLC, 967 F.3d 1285, 1319 (Fed. Cir. 2020) (Moore, J., dissenting). And as Dr. Andrew Toole, the USPTO Chief Economist, recently noted:

...economic theory and evidence show that greater uncertainty tends to reduce investments. Higher levels of uncertainty may also negatively impact previously issued patents by lowering their expected value, reducing patent purchases and licensing transactions, and limiting opportunities to obtain entrepreneurial financing.³

The uneven application of *Alice*, as occurred in this case, frustrates the very purpose of this specialized Court.

A patent is valid under § 101 when the “claimed solution is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm” of that technology. *DDR*, 773 F.3d at 1257. This Court determined in *DDR*

<https://www.presidency.ucsb.edu/documents/federal-civil-justice-system-message-thecongress-proposed-legislation>).

³ Andrew Toole *et al.*, U.S. Patent and Trademark Office, *Adjusting to Alice: USPTO Patent examination outcomes after Alice Corp. v. CLS Bank International*, IP Data Highlights Number 3 (April 2020).

that “this challenge of retaining control over the attention of the customer in the context of the Internet” is such a problem and thus patent eligible. *DDR*, 773 F.3d at 1258.

The panel here similarly found that “the claims of the ’594 Patent are directed to creating and applying templates to a game space to simplify game play.” Op. 9. And the Panel acknowledged that “[t]he claimed invention sought to address th[e] monotony problem” and “[m]ore specifically, the claimed invention employs templates to improve the usability of city building games.” Op. 3.

Thus, the claims of the ’594 Patent address the problem of “retaining control over the attention of” a player’s interest in a video game. This is nearly identical to the problem this Court identified as a non-abstract technological problem in *DDR*. *See DDR*, 773 F.3d at 1258. Thus, as with the claims addressed in *DDR*, the claims of the ’594 Patent “do not merely recite the performance of some business practice known” from a time before computer video games along with the requirement to perform the practice on a computer. *Id.* at 1257. Here, as in *DDR* and notwithstanding the panel’s conclusion to the contrary, the claims are not directed to an abstract idea.

The Panel’s treatment of the claims here is difficult to reconcile with *DDR*. Such inconsistent treatment of similar concepts creates unpredictability and

uncertainty, which stifles innovation. The Court should grant GREE's combined petition to address this inconsistency in the application of the *Alice* test.

CONCLUSION

For the foregoing reasons, panel or *en banc* rehearing should be granted.

January 22, 2020

Respectfully submitted,

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ADDENDUM

NOTE: This disposition is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

GREE, INC.,
Appellant

v.

SUPERCELL OY,
Cross-Appellant

2019-1864, 2019-1960

Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in No. PGR2018-00008.

Decided: November 19, 2020

JOHN C. ALEMANNI, Kilpatrick Townsend & Stockton LLP, Raleigh, NC, for appellant. Also represented by STEVEN MOORE, San Francisco, CA; ANDREW WILLIAM RINEHART, Winston-Salem, NC.

MICHAEL JOHN SACKSTEDER, Fenwick & West, LLP, San Francisco, CA, for cross-appellant. Also represented by TODD RICHARD GREGORIAN; JENNIFER RENE BUSH, Mountain View, CA; GEOFFREY ROBERT MILLER, New York, NY; JESSICA KAEMPF, Seattle, WA.

Before LOURIE, HUGHES, and STOLL, *Circuit Judges*.

STOLL, *Circuit Judge*.

This appeal relates to eligibility under 35 U.S.C. § 101. GREE, Inc. appeals from a final written decision by the Patent Trial and Appeal Board holding claims 1, 8, and 10–20 of U.S. Patent No. 9,597,594 ineligible. Supercell Oy cross-appeals the Board’s determination that Supercell did not show claims 2–7 and 9 of the ’594 patent to be patent ineligible. We affirm the Board’s determination that claims 1, 8, and 10–20 of the ’594 patent are directed to patent-ineligible subject matter and its determination that claims 5–7 are not directed to patent-ineligible subject matter. We reverse the Board’s determination that claims 2–4 and 9 are not directed to patent-ineligible subject matter.

BACKGROUND

GREE is the assignee of the ’594 patent, titled “Computer Control Method, Control Program and Computer.” The specification of the ’594 patent describes the invention in the context of “city building games,” in which “a player builds a city within a virtual space (hereinafter referred to as ‘game space’) provided in the game program” in a computer. ’594 patent col. 1 ll. 27–30. Cities include arrangements of “game contents,” i.e., “items such as protective walls, buildings[,] . . . soldiers, weapons, etc.” *Id.* at col. 1 ll. 46–48, 50–51. A computer “progresses a game by arranging game contents within a game space based on a command by a player.” *Id.* at col. 3 ll. 19–21.

“[I]n recent city building games, a city built by one player is attacked by a different player, and the city . . . is one of [the] factors for deciding the winning and losing” players. *Id.* at col. 1 ll. 45–49. As players build more complicated cities, “it is very complicated for a player to change positions, types, levels, etc., of individual items” in the

cities. *Id.* at col. 1 ll. 50–53. “Therefore, many players have limited themselves to change only certain kinds of items, such as soldiers and weapons, for which changing positions, types, levels, etc., is easy.” *Id.* at col. 1 ll. 55–58. This leads to the undesirable result, as the game progresses, that players may find the game increasingly “monotonous.” *Id.* at col. 1 ll. 58–60. The claimed invention sought to address this monotony problem by “provid[ing] a method for controlling a computer, a recording medium and a computer that improve the usability of city building games and continuously attract players to the game.” *Id.* at col. 1 ll. 61–65.

More specifically, the claimed invention employs templates to improve the usability of city building games. Among other things, the claimed systems and methods involve creating a template defining positions of one or more game contents and subsequently applying the template to a predetermined area within the game space. *Id.* at col. 26 ll. 33–46, col. 27 l. 44–col. 28 l. 23. “When the template is applied,” the computer “moves the game contents arranged within the game space to the positions of the game contents defined by the template.” *Id.* at col. 3 ll. 27–29.

In some embodiments, the numbers of game contents of each type defined by the template match the numbers of game contents of each type in the game space to which the template is to be applied. *Id.* at col. 7 ll. 37–48 (disclosing an embodiment in which “[t]he number of types of facilities and the number of facilities in each type arranged within the game space 420 are equal to the number of types of facilities and the number of facilities in each type . . . defined by the template”). In that case, “all [game contents] arranged within the game space 420 are moved to positions of [game contents] as defined by the template.” *Id.* at col. 7 ll. 43–45.

In other embodiments, there is a mismatch between the numbers of game contents of each type defined by the

template and the numbers of game contents of each type in the game space to which the template is to be applied. *E.g.*, *id.* at col. 7 l. 54–col. 8 l. 29; *see also id.* at col. 11 ll. 25–28, 38–63. For example, the number of game contents of each type within the game space may be larger than the number of game contents of each type defined by the template. In that case, “those [game contents] with the smallest moving distance (e.g., Manhattan distance) to positions of [game contents] defined by the template” may be “moved to the positions of [game contents]” as defined by the template. *Id.* at col. 7 ll. 61–64. Alternatively, the number of game contents of each type arranged within the game space may be smaller than the number of game contents of each type defined by the template. In that case, “all [game contents] arranged within the game space” may be “moved to positions of [game contents] defined by the template 410, to which the moving distance is the smallest,” with “positions on which no [game contents] are arranged among the positions of [game contents] defined by the template . . . illustrated in a condition where the [game content] type is discernible.” *Id.* at col. 8 ll. 18–29. We refer to these embodiments in which the number of game contents defined by the template is not equal to the number of game contents in the game space to which the template is to be applied as “mismatched template scenarios.”

Claims 1, 10, 11, and 12 are independent claims. Claim 1 recites:

1. A method for controlling a computer that is provided with a storage unit configured to store game contents arranged within a game space, first positions of the game contents within the game space, and a template defining second positions of one or more of the game contents, and that progresses a game by arranging the game contents within the game space based on a command by a player, the method comprising:

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 at the first positions within the game space to the second positions of the game contents defined by the template within the predetermined area.

Id. at col. 26 ll. 33–46.

Claims 5–7 ultimately depend from claim 1 and are directed to mismatched template scenarios. They recite:

5. The method according to claim 1, wherein when the number of game contents arranged within the game space is smaller than the number of game contents for which the second positions are defined by the template, the computer moves the game contents arranged at the first positions within the game space to the second positions of the game contents defined by the template to which the moving distance is the smallest.

6. The method according to claim 5, wherein out of the second positions of the game contents defined by the template, the computer displays positions on which no game contents are arranged and the game contents, in a discernible condition.

7. The method according to claim 1, wherein when the number of game contents arranged within the game space is larger than the number of game contents for which the second position[s] are defined by the template, the computer moves the game contents arranged at the first positions within the game space for which the moving distance to the second positions of the game contents defined by the template is the smallest, to the positions.

Id. at col. 27 ll. 8–30.

Supercell petitioned for post-grant review of the '594 patent in November 2017, asserting that claims 1–20 are patent ineligible under 35 U.S.C. § 101. The Board instituted review of all challenged claims and, following trial proceedings, issued its final written decision finding claims 1, 8, and 10–20 of the '594 patent ineligible under § 101.

At step one of the *Alice* two-step framework for determining patent eligibility, the Board agreed with Supercell that the claims of the '594 patent are directed to the abstract idea of “creating and applying a template of positions of one or more game contents.” *Supercell Oy v. GREE, Inc.*, No. PGR2018-00008, 2019 WL 80477, at *10, *16 (Jan. 2, 2019); see *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208 (2014). The Board also found persuasive Supercell's characterization of the independent claims of the '594 patent as simply automating the known game of correspondence chess, in which a “first player fills out a post card with information that represents the current state of the board and makes an indication on the post card of [the first] player's intended move” and mails the post card to a second player who, “having already set up a chess board, moves a piece on the board in accordance with the instruction on the post card.” *GREE*, 2019 WL 80477, at *15 (citation omitted). The Board reasoned that the first player in correspondence chess “creates a template defining game contents” “by indicating on the post card the first player's intended move.” *Id.* (citation omitted).

At *Alice* step two, the Board concluded that claims 1, 8, and 10–20 lacked an inventive concept. The Board determined that the computer implementations recited in independent claims 1 and 10–12 “are ancillary, as opposed to a computer-specific improvement.” *Id.* at *18. With respect to claims 8 and 13–20, the Board discerned no meaningful distinctions of patentable significance over the independent claims. See *id.* at *20–22. By contrast, the Board concluded that claims 2–7 and 9 each recite an inventive concept. The Board agreed with Supercell's

characterization of claims 2–4 and 9, but rejected Supercell’s assertion that these claims confer no inventive concept, reasoning that Supercell failed to address “a template based on a combination of more than one template’ in some form or manner.” *Id.* at *19. Finally, with respect to claims 5–7, the Board rejected Supercell’s assertion that these claims merely amount to “insignificant extra-solution activity.” *Id.* at *20. Using claim 5 as an example, the Board concluded that the added limitations “further define the concept of, or solution to, ‘creating and applying a template’ itself,” because “there are potentially infinite ways” to apply a template, and the “claim limitation explicitly specifies one such way” that Supercell had not demonstrated to be “conventional” or “obvious.” *Id.* As such, the Board held that at *Alice* step two, Supercell did not meet its “burden of showing that dependent claims 5–7 do not contain an *inventive concept* beyond the abstract idea of ‘creating and applying a template of positions of one or more game contents.’” *Id.* (emphasis added).

GREE and Supercell appeal. We have jurisdiction pursuant to 28 U.S.C. § 1295(a)(4).

DISCUSSION

I

We review the Board’s factual findings for substantial evidence, 5 U.S.C. § 706(2)(E), and review de novo its legal conclusions. *Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1048 (Fed. Cir. 2017) (citing *Synopsys, Inc. v. Mentor Graphics Corp.*, 814 F.3d 1309, 1314 (Fed. Cir. 2016)). Patent eligibility under § 101 is ultimately a question of law that may contain underlying issues of fact. *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1365 (Fed. Cir. 2018) (first citing *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1338 (Fed. Cir. 2017); and then citing *Mortg. Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1325 (Fed. Cir. 2016)). We review de novo the Board’s conclusions with respect to patent eligibility

under § 101. *Credit Acceptance*, 859 F.3d at 1053 (citing *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1236 (Fed. Cir. 2016)).

Section 101 defines patent-eligible subject matter as “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” 35 U.S.C. § 101. The Supreme Court has held that this provision “contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice*, 573 U.S. at 216 (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)). The “Supreme Court articulated a two-step test for examining patent eligibility when a patent claim is alleged to involve one of these three types of subject matter.” *CardioNet, LLC v. InfoBionic, Inc.*, 955 F.3d 1358, 1367 (Fed. Cir. 2020); *see Alice*, 573 U.S. at 217–18. “At step one, we consider the claims ‘in their entirety to ascertain whether their character as a whole is directed to excluded subject matter.’” *CardioNet*, 955 F.3d at 1367 (quoting *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016)). If the answer is yes, we then consider the claim elements, “both individually and ‘as an ordered combination,’” to determine whether they contain an “inventive concept” sufficient to “‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 573 U.S. at 217 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 79, 72, 78 (2012)). “This inventive concept must do more than simply recite ‘well-understood, routine, conventional activity.’” *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093 (Fed. Cir. 2016) (quoting *Mayo*, 566 U.S. at 79–80).

II

A

Beginning our analysis with *Alice* step one, we agree with the Board that the claims of the ’594 patent are

directed to the abstract idea of creating and applying a template¹ of positions of one or more game contents. Considered in their entirety, the claims of the '594 patent are directed to creating and applying templates to a game space to simplify game play. Though the dependent claims of the '594 patent recite additional limitations with respect to creation, storage, selection, and application of a template, none of these implementation details change the overall nature of the claims. Overall, the claims focus on applying a template to a game space to move game contents from a first position to a second position. The additional limitations recited in the '594 patent claims merely limit the use of a template to the technological environment of a game space on a computer, and GREE admitted that “the generic idea of a template existed prior to the invention,” J.A. 168.

We also agree with the Board that certain claims of the '594 patent are broad enough to cover simply implementing the long-standing and conventional game of correspondence chess using chess templates on a computer. In particular, claims 1–4 and 8–20 are broad enough to cover automation of conventional correspondence chess. We thus agree with the Board that claims 1–4 and 8–20 encompass the application of conventional correspondence chess

¹ GREE argues that the Board erred in broadly construing “template” as merely a record. We agree and conclude that the Board erred in its construction because it overlooked the function of a template. We note, however, that the Board did not rely on this construction in its *Alice* step one analysis. Adopting GREE’s position on the meaning of “template” for purposes of our de novo § 101 analysis, we agree with the Board’s articulation of what the '594 patent claims are directed to at *Alice* step one. Accordingly, we find any error arising from the Board’s overly broad construction harmless.

templates to a generic computer environment. *See GREE*, 2019 WL 80477, at *15–16. As such, they are not directed to a patentable improvement. *See Credit Acceptance*, 859 F.3d at 1055 (“[M]ere automation of manual processes using generic computers does not constitute a patentable improvement in computer technology.”).

GREE’s arguments that the claims of the ’594 patent are directed to an improved graphical user interface are unavailing. The claims do not limit how the claimed device displays template creation or application to the player. Claim 6, the sole claim requiring display of any information to the player, provides no detail regarding how the information is displayed, mandating only that the information be displayed “in a discernible condition.” ’594 patent col. 27 ll. 17–21. We therefore agree with the Board that there is nothing about the claim language that indicates an improvement to a graphical user interface.

Given the breadth of the ’594 patent claims, we agree with the Board that the claims are directed to an abstract idea at *Alice* step one.

B

At *Alice* step two, we must examine the elements of the claims to determine whether they contain an “inventive concept” sufficient to transform the claimed abstract idea into a patent-eligible application. *Alice*, 573 U.S. at 217–18 (quoting *Mayo*, 566 U.S. at 72). We agree with the Board’s holding that claims 1, 8, and 10–20 are not patent eligible, and that claims 5–7 are patent eligible, but we conclude that the Board erred in holding claims 2–4 and 9 patent eligible.

The Board correctly determined that claims 1, 8, and 10–20 lack an inventive concept. As the Board concluded, the “ancillary” computer limitations of these claims “are described generically in functional terms and, as such, are insufficient to impart an inventive concept.” *GREE*,

2019 WL 80477, at *18, *21. Rather than “transform[ing] the nature of the claim’ into a patent-eligible application,” *Alice*, 573 U.S. at 217 (quoting *Mayo*, 566 U.S. at 78), these claims merely invoke generic computer components performing their standard functions to limit the use of the abstract idea itself to the technological environment of a game space on a computer. *E.g.*, ’594 patent col. 27 ll. 31–36 (requiring that “the computer stores positions of game contents . . . as the template, in the storage unit”); *id.* at col. 28 ll. 10–23 (reciting a memory device that stores software instructions and a hardware processor that is configured to execute software instructions and perform operations). Additionally, claims 1, 8, and 10–20 are so broad that they encompass automation of the “well-understood, routine, conventional activity” of correspondence chess. *Mayo*, 566 U.S. at 79–80. Accordingly, the Board did not err in holding claims 1, 8, and 10–20 ineligible under § 101.

We also agree with the Board’s differing conclusion with respect to claims 5–7, although we recognize that this is a close question. In reciting specific steps for applying templates in mismatched template scenarios, these claims require something more than automating correspondence chess. Indeed, Supercell has not shown that conventional correspondence chess template application included any technique—let alone the specifically claimed technique—for applying a template in the claimed mismatched template scenarios. We also agree with the Board that the added limitations in claims 5–7 “further define the concept of, or solution to, ‘creating and applying a template’ itself,” because “there are potentially infinite ways” to apply a template, and claims 5–7 expressly specify particular ways. *GREE*, 2019 WL 80477, at *20. We thus agree with the Board that Supercell has not shown these claims to lack an inventive concept under *Alice* step two, and, accordingly, we affirm the Board’s determination of eligibility of these claims.

We disagree, however, with the Board's conclusion that claims 2–4 and 9 are patent eligible under *Alice* step two. Claims 2–4 recite the additional limitations of storing templates of different players, applying the templates of different players, and obtaining and applying templates from different computers. '594 patent col. 26 l. 47–col. 27 l. 7. Claim 9 recites creating a template by combining a plurality of templates based on a command from the player or from another player, without further limitation. *Id.* at col. 27 ll. 37–43. Though these limitations narrow the scope of claims 2–4 and 9, we see no inventive concept sufficient to transform the claimed abstract idea into a patent-eligible application. *See Alice*, 573 U.S. at 217–18. Unlike claims 5–7, claims 2–4 and 9 do not claim a solution for applying a template in a mismatched template scenario. Nor do they claim a solution to any other technological problem encountered in the creation and application of templates in a computer game. Instead, like claims 1, 8, and 10–20, claims 2–4 and 9 recite generic computer components performing their standard functions, and they are broad enough to encompass the implementation of long-standing and conventional correspondence chess on a computer. We therefore conclude that the Board erred in concluding that claims 2–4 and 9 provide an inventive concept.

C

Finally, we note that certain statements in the Board's opinion appear inconsistent with the appropriate framework for addressing eligibility under § 101. For example, in conducting the *Alice* step one analysis, the Board stated: "Identifying the concept to which the claim is 'directed' merely addresses some claim limitations in connection with the first aspect of the *Alice* inquiry." *GREE*, 2019 WL 80477, at *7. The Board also determined that under the *Alice* framework, "Petitioner only needed to account for each claim limitation under either a formulation of the concept a claim is 'directed to' or under *Alice* step two." *Id.* at *8. To the extent that the Board meant that a proper

§ 101 analysis may consider some claim limitations only at *Alice* step one and others only at *Alice* step two, we do not agree with its reading of Supreme Court precedent. Instead, both steps of the *Alice* inquiry require that the claims be considered in their entirety. See *CardioNet*, 955 F.3d at 1367 (“At step one, we consider the claims ‘*in their entirety*’ to ascertain whether their character as a whole is directed to excluded subject matter.” (emphasis added) (quoting *McRO*, 837 F.3d at 1312)); *Alice*, 573 U.S. at 217 (noting, at step two, that courts “consider the elements of each claim *both individually and ‘as an ordered combination’* to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” (emphasis added) (quoting *Mayo*, 566 U.S. at 79, 78)).

CONCLUSION

We have considered the parties’ remaining arguments and do not find them persuasive. For the foregoing reasons, we affirm the Board’s decision that claims 1, 8, and 10–20 are ineligible and that claims 5–7 are not ineligible, and we reverse the Board’s decision that claims 2–4 and 9 are not ineligible.

AFFIRMED-IN-PART AND REVERSED-IN-PART

COSTS

No costs.

CERTIFICATE OF SERVICE

I hereby certify that on January 22, 2020, a true and correct copy of the foregoing **CORRECTED PETITION FOR REHEARING OR REHEARING EN BANC OF GREE, INC.** was filed with the Clerk of the United States Court of Appeals for the Federal Circuit and served on all counsel of record by the Court's CM/ECF system.

/s/ John C. Alemanni _____

John C. Alemanni

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATIONS

Case Number: 2019-1864; 2019-1960

Short Case Caption: Gree, Inc. v. Supercell OY

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