

Nos. 19-1864, 19-1960

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

GREE, INC.,

Appellant,

v.

SUPERCELL OY,

Cross-Appellant.

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

**RESPONSE OF SUPERCELL OY TO
PETITION FOR REHEARING OR REHEARING *EN BANC***

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CERTIFICATE OF INTEREST

Counsel for Appellee and Cross-Appellant Supercell Oy certifies the following pursuant to Federal Circuit Rule 47.4:

1. The full name of every party or amicus represented by me is:
Supercell Oy
2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is:
As indicated in Item 1.
3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:
Supercell Oy discloses that Tencent Holdings Ltd. is the parent corporation of Plaintiff Supercell Oy. Tencent Holdings Ltd. is a publicly held corporation and owns 10% or more of Supercell Oy's stock.
4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court (and who have not or will not enter an appearance in this case) are:
None
5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal:
GREE, Inc. v. Supercell Oy, Case No. 2:19-cv-00071, filed on February 28, 2019, in the United States District Court for the Eastern District of Texas.
6. Organizational Victims and Bankruptcy Cases: Any information required under Fed. R. App. P. 26(1)(b) and 26.1(c).
None / Not Applicable

March 2, 2021

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TABLE OF CONTENTS

	Page
CERTIFICATE OF INTEREST	i
INTRODUCTION	1
A. The '594 Patent	4
B. Procedural History	7
ARGUMENT AGAINST REHEARING OR REHEARING EN BANC	9
I. THE PANEL DECISION FOLLOWS <i>DDR HOLDINGS</i> AND CREATES NO CONFLICT WITH IT	9
II. THE PANEL DID NOT FIND FACTS BUT RULED AS A MATTER OF LAW ON AN UNDISPUTED RECORD	12
CONCLUSION	16
CERTIFICATE OF COMPLIANCE PURSUANT TO FED. R. APP. P. 27	17
CERTIFICATE OF SERVICE	18

TABLE OF AUTHORITIES

	Page(s)
CASES	
<i>Aatrix Software, Inc. v. Green Shades Software, Inc.</i> , 882 F.3d 1121 (Fed. Cir. 2018)	12, 13
<i>Affinity Labs of Tex., LLC v. Amazon.com Inc.</i> , 838 F.3d 1266 (Fed. Cir. 2016)	15
<i>Alice Corp. Pty. Ltd v. CLS Bank Int’l</i> , 573 U.S. 208 (2014).....	<i>passim</i>
<i>Arthrex, Inc. v. Smith & Nephew, Inc.</i> , 941 F.3d 1320 (Fed. Cir. 2019)	1
<i>Berkheimer v. HP Inc.</i> , 881 F.3d 1360 (Fed. Cir. 2018)	3, 12, 13
<i>Berkheimer v. HP Inc.</i> , 890 F.3d 1369 (Fed. Cir. 2018)	13
<i>Bilski v. Kappos</i> , 561 U.S. 593 (2010).....	10
<i>cxLoyalty, Inc. v. Maritz Holdings Inc.</i> , 986 F.3d 1367 (Fed. Cir. 2021)	11
<i>Data Engine Technologies LLC v. Google LLC</i> , 906 F.3d 999 (Fed. Cir. 2018)	12
<i>DDR Holdings, LLC v. Hotels.com, L.P.</i> , 773 F.3d 1245 (Fed. Cir. 2014)	<i>passim</i>
<i>Dropbox Inc. v. Synchronoss Techs. Inc.</i> , 815 F. App’x 529 (Fed. Cir. 2020)	10
<i>Genetic Techs. Ltd. v. Merial L.L.C.</i> , 818 F.3d 1369 (Fed. Cir. 2016)	16

TABLE OF AUTHORITIES
(Continued)

	Page(s)
<i>Internet Patents Corp. v. Active Network, Inc.</i> , 790 F.3d 1343 (Fed. Cir. 2015)	10
<i>Interval Licensing LLC v. AOL, Inc.</i> , 896 F.3d 1335 (Fed. Cir. 2018)	13
<i>Maxon, LLC v. Funai Corp., Inc.</i> , 726 F. App'x 797 (Fed. Cir. 2018)	14
<i>Soverain Software LLC v. Newegg Inc.</i> , 705 F.3d 1333 (Fed. Cir. 2013)	15
<i>Supercell Oy v. GREE, Inc.</i> , 2019 WL 3822162 (Aug. 14, 2019).....	1
<i>Supercell Oy v. GREE, Inc.</i> , 2019 WL 4180429 (Sept. 3, 2019)	1
<i>Supercell Oy v. GREE, Inc.</i> , 2019 WL 4239632 (Sept. 6, 2019)	1
<i>Supercell Oy v. GREE, Inc.</i> , 2019 WL 4732477 (Sept. 26, 2019)	1
<i>Supercell Oy v. GREE, Inc.</i> , 2019 WL 80477 (Jan. 2, 2019)	1
<i>Supercell Oy v. GREE, Inc.</i> , 2020 WL 2858715 (June 2, 2020)	1
<i>Supercell Oy v. GREE, Inc.</i> , No. PGR2018-00055, Paper No. 36 (P.T.A.B. Sept. 23, 2019)	1
<i>Trading Techs. Intl., Inc. v. CQG, Inc.</i> , 675 F. App'x 1001 (Fed. Cir. 2017)	12
<i>Voter Verified, Inc. v. Election Sys. & Software LLC</i> , 887 F.3d 1376 (Fed. Cir. 2018)	14

TABLE OF AUTHORITIES
(Continued)

Page(s)

STATUTES AND RULES

35 U.S.C. §101	<i>passim</i>
35 U.S.C. § 325(e)(2).....	9
Fed. R. App. P. 35(a)	4
Fed. R. App. P. 40.....	4

INTRODUCTION

Supercell is a mobile video game development company headquartered in Helsinki, Finland. Since its founding in 2010, Supercell has developed several successful mobile games, such as Clash of Clans. Founded in 2004, GREE is a publicly traded Japanese social media, investment, and patent assertion company. GREE has filed over thirty patent infringement lawsuits against Supercell in Japan, and since February 2019, has filed eleven lawsuits against Supercell in the Eastern District of Texas asserting thirty patents. Supercell has defended against GREE's campaign by filing post-grant and *inter partes* review petitions. The Patent Trial and Appeal Board has so far issued final written decisions finding invalid, in whole or part, seven of GREE's patents. *See Supercell Oy v. GREE, Inc.*, 2019 WL 80477 (Jan. 2, 2019); *Supercell Oy v. GREE, Inc.*, 2019 WL 4180429 (Sept. 3, 2019); *Supercell Oy v. GREE, Inc.*, No. PGR2018-00055, Paper No. 36 (P.T.A.B. Sept. 23, 2019); *Supercell Oy v. GREE, Inc.*, 2019 WL 4732477 (Sept. 26, 2019); *Supercell Oy v. GREE, Inc.*, 2020 WL 2858715 (June 2, 2020); *Supercell Oy v. GREE, Inc.*, 2019 WL 3822162 (Aug. 14, 2019) (vacated and held in abeyance pending resolution of *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320 (Fed. Cir. 2019)); *Supercell Oy v. GREE, Inc.*, 2019 WL 4239632 (Sept. 6, 2019) (same).

The panel in the current appeal from PGR issued a well-reasoned decision on patent ineligibility for claims 2-4 and 9 (the claims for which GREE seeks

rehearing), applying the two-step framework from *Alice Corp. Pty. Ltd v. CLS Bank Int'l*, 573 U.S. 208 (2014). At step one, the panel held that the patent is directed to an abstract idea. The purported invention is the use of a “template” in a video game to move one or more of the game pieces. But rather than disclose a concrete solution to achieve this result, the patent simply claims the idea of using templates on conventional computers. Claims 2-4 and 9 are no different—they add only the requirements of using a template from a different player or computer, or of combining templates.

GREE asserts that this ruling conflicts with *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014). Before the panel, GREE argued its patent was like *DDR*'s because it claimed a technical *solution*, a specific improvement to the graphical user interface of a video game. GREE has abandoned that argument in its petition. It now argues that its patent is non-abstract because the *problem* identified in the specification—“monotonous” and boring video games—is similar (or, according to GREE, “nearly identical”) to the problem of “retaining control over the attention of” internet shoppers in *DDR*. Petition (“Pet) at 18. But patent eligibility does not turn *only* on what problem a patent hopes to solve. Rather, it depends on whether the claims recite a specific technological solution to that problem. *DDR*, 773 F.3d at 1256. The panel’s holding—that GREE’s patent is directed to the mere idea of creating and applying templates and does not disclose any technology for

improving a graphical user interface—is correct and creates no conflict with *DDR*.

At step two, the panel held on two distinct grounds that claims 2-4 and 9 fail to provide an inventive concept. First, those claims recite nothing more than the same abstract idea limited to a multiplayer game, while continuing to invoke only generic computers. Slip. Op. (“Op”) at 12. Second, the record also shows that the claims merely describe the automation of routine, well understood, and conventional activity in gaming, found, for example in correspondence chess. *Id.* Here, GREE accuses the panel of exceeding the scope of its appellate authority by “finding facts” contrary to those found by the Board. But neither the Board nor the panel found any facts. On an undisputed record, the Board held that Supercell had not met its burden to show ineligibility of these claims. The panel reversed, ruling the claims ineligible as a matter of law. Moreover, while there was no material fact dispute regarding how to play correspondence chess, the panel’s first grounds for the ineligibility of these claims rested only on the patent itself, without the need even to consider the evidence regarding correspondence chess. Again, the panel’s decision creates no conflict with precedent. This Court has expressly recognized that “not every § 101 determination contains genuine disputes over the underlying facts material to the § 101 inquiry.” *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1368 (Fed. Cir. 2018) (“*Berkheimer I*”). Where no dispute of fact exists claims can properly be deemed ineligible at step two as a matter of law. *Id.* at 1365.

GREE identifies no point of fact or law that the panel overlooked or misapprehended, or any conflict between the panel's decision and this Court's precedent that warrants rehearing. Fed. R. App. P. 35(a), 40. The Court should deny the petition.

BACKGROUND

A. The '594 Patent

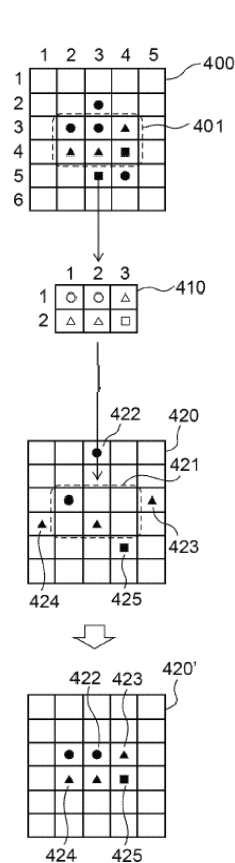
U.S. Patent No. 9,594,594 (“the '594 patent”) states that video games played on mobile devices have become increasingly common. Appx0077 at 1:29-30. Such mobile games include “city building games” where a player builds a city within a “virtual space”—which the patent refers to as a “game space.” *Id.* Prior art city building games were designed so that one player's city can be attacked by another player, and the object of these games is to build a city that can defend against attacks by arranging the game contents strategically. Appx0077 at 1:30-33.

The specification notes that it may be cumbersome for players to rearrange manually each game piece in a city, and it may be difficult to predict how a new city design will impact gameplay. Appx0077. These difficulties discourage changes in strategy and make the game monotonous. *Id.* The patent purports to solve this problem by using “templates” wherein game pieces “are automatically moved to the defined positions” on the game space. Appx0078 at 3:33-34, 4:34-37. GREE

admitted below that this “generic idea of a template existed prior to the invention.”

Appx0168.

An excerpt of Figure 4, below, illustrates the idea:



Appx0065 at Fig. 4. Grid (400) depicts a game space with game pieces. The player selects an arrangement of game pieces to save as a template (401). Appx0080 at 7:17-37. The computer stores a record (410) of the type and location of game pieces. The player commands that the computer apply the template in the game space (421), and then the computer moves the game pieces in accordance with the template (420). Appx0080 at 7:18-53. No technical details for implementing these steps are disclosed beyond the use of generic computers and black boxes such as a “storage

unit,” “game progression unit,” “operation unit,” and a “template application unit,” each of which is defined in terms of the function it performs. *E.g.*, Appx0078 at 4:55-63; Appx0079 at 6:30-32; Appx0080 at 8:64-67; Appx0081 at 9:6-9, 9:13-15; Appx0082 at 11:10-28; Appx0085 at 18:3-10, 18:30-51.

The specification also describes three embodiments of the invention (Appx0078-89), the second of which relates to invalidated claims at issue in GREE’s petition. In this embodiment, the template is used “in a multi-player environment,” with a player applying the template of another player or computer. Appx0084-86 at 16:25-20:20. In this embodiment as in the others, the result of creating and applying the template is achieved using only generic computer equipment. The claimed computer could take any form—“for example, a portable device, a desktop device, a server, etc., as long as it can execute the above procedure.” Appx0077 at 2:12-14.

Claim 2 exemplifies the “multi-player environment” embodiment:

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.

2. The method according to claim 1, wherein the storage unit further stores a template related to a different player, and when the template related to the different player is applied to a predetermined area within the game space based on the command by the player, 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 related to the different player.

Appx0089 at 26:33-55.

B. Procedural History

On November 6, 2017, Supercell petitioned for post-grant review, asserting that all claims of the '594 patent are invalid under 35 U.S.C. §101. The Board instituted review and ruled that the independent claims (claims 1, 10, 11, and 12), and dependent claims 8 and 13-20, are patent-ineligible, but ruled that dependent claims 2-7 and 9 were not shown to be patent-ineligible. Appx0058. On appeal, the panel affirmed the Board's ruling except for claims 2-4 and 9, which it held were ineligible for patenting. Op11-13.

At step one of *Alice*, the panel ruled that the '594 patent is directed to the abstract idea of "creating and applying a template of positions of one or more game contents." Op8-9. "Overall, the claims focus on applying a template to a game space to move game contents from a first position to a second position." *Id.* at 9. While the dependent claims "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." *Id.* Further, claims 1-4 and 8-20 were "not directed

to a patentable improvement” because they cover the “automation of conventional correspondence chess.” Op9-10.

At step two, the panel ruled that claims 1, 8, and 10-20 fail to transform the abstract idea into a patentable invention. The claims only recite “‘ancillary’ computer limitations [that] ‘are described generically in functional terms and, as such are insufficient to impart an inventive concept.’” Op10. Further, the “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.” Op11. The panel held that claims 5-7 supply an inventive concept because they contain additional limitations specifying rules for how to apply the template under certain game conditions. Although it was a “close question,” the panel concluded these claims disclosed something more than merely automating correspondence chess and were thus eligible. *Id.*

The panel reversed the Board on claims 2-4 and 9, holding these claims ineligible. These claims recite additional limitations, such as using a template from another player or another computer, or a combination of templates. But these claims still lack an inventive concept as they do not claim a solution to any “technological problem encountered in the creation and application of templates in a computer game.” Op12. “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 longstanding and conventional correspondence chess on a computer.” *Id.* GREE seeks rehearing only of the panel’s ruling on these claims. Petition (“Pet”) at 1 n.1.¹

ARGUMENT AGAINST REHEARING OR REHEARING EN BANC

I. THE PANEL DECISION FOLLOWS *DDR HOLDINGS* AND CREATES NO CONFLICT WITH IT

GREE contends that the invalidated claims are directed to a “nearly identical idea” as the one the Court held non-abstract in *DDR*, and thus the panel’s opinion purportedly creates “unpredictability and uncertainty” in the application of §101. Pet. at viii, 18. In fact, the invalidated claims are easily distinguished from those at issue in *DDR*, and the panel’s opinion provides a straightforward application of the principles of that case.

This Court held the *DDR* patent eligible at step one of the *Alice* test because it provided a concrete solution to a problem arising on the Internet. A user visiting one website may wish to view products sold on a different website. Conventional use of hyperlinks required that the owners of the first website direct users to the second website, thus losing the user’s attention. To solve this problem, the patent

¹ GREE twice notes that a jury in the Eastern District of Texas found that Supercell infringed one or more claims of five patents asserted by GREE and that claim 2 of the ’594 patent was asserted in that case. Pet1, 9. That fact is wholly irrelevant to the petition: In that trial Supercell was estopped from asserting a defense of ineligibility for the ’594 patent under 35 U.S.C. § 325(e)(2).

claimed a series of steps for creating a hybrid web page that retained “look and feel” elements from the first website while displaying the products available from the second. *DDR*, 773 F.3d at 1257-58. The patent did not merely claim use of the Internet to perform an abstract idea; it offered a specific solution “rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks.” *Id.*

The invalidated claims of the ’594 patent recite no such solution. They claim the use of templates to move objects in a video game, but do not provide any means for achieving that movement beyond invoking generic computer hardware and functions. Op12; *see also Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1348 (Fed. Cir. 2015). The panel recognized this, noting that the claim limitations “merely limit the use of a template to the technological environment of a game space on a computer.” Op10. Thus, the claims are not like those in *DDR*, but rather are like those ineligible claims that take an abstract idea and direct the reader to “apply it with computer.” *See Alice*, 573 U.S. at 223; *Bilski v. Kappos*, 561 U.S. 593, 607 (2010); *see also Dropbox Inc. v. Synchronoss Techs. Inc.*, 815 F. App’x 529, 534 (Fed. Cir. 2020) (“an inventive concept exists when a claim recites a specific, discrete implementation of the abstract idea...”).

GREE’s attempt to create a conflict among this Circuit’s precedents fails. GREE contends that its patent is not abstract because it addresses a similar problem

as the *DDR* patent: The '594 patent seeks to prevent boredom during video games, just as the *DDR* patent sought to retain user attention during Internet browsing. Pet18. But §101 is about what the patent claims as the invention, not what general problem it seeks to address. The fact that a patent is addressed to a computer user's behavior says nothing about whether that patent claims a concrete invention or an abstraction. The Federal Circuit in *DDR* recognized this. While it noted that the patent sought to solve a problem unique to the Internet, the result turned on the nature of the claimed *solution* to the problem. *DDR*, 773 F.3d at 1257. Moreover, the *DDR* Court anticipated the argument that GREE advances here and rejected it, cautioning “that not all claims purporting to address Internet-centric challenges are eligible for patent.” *Id.* at 1258.

More generally, GREE faults the panel for not discussing *DDR* in its opinion. Pet. at viii. But before the panel, GREE argued that its patent was like *DDR* because it was directed to an improved graphical user interface. *E.g.*, Resp. & Reply Br. at 4. The panel considered that argument and found it “unavailing” because “the claims do not limit how the claimed device displays template creation or application to the player.” Op10. In other words, the claims do not even *require* a particular graphical user interface, let alone constitute an improvement to graphical user interface technology. The panel was correct, and its decision is consistent with this Court's other §101 cases concerning graphical user interfaces. *See, e.g. cxLoyalty, Inc. v.*

Maritz Holdings Inc., 986 F.3d 1367, 1376-77 (Fed. Cir. 2021) (claims expressly reciting a “graphical user interface” were still not directed to a “technological solution to a technological problem”); *Data Engine Technologies LLC v. Google LLC*, 906 F.3d 999, 1010-11 (Fed. Cir. 2018) (claims recited “a specific structure (i.e., notebook tabs) within a particular spreadsheet display that performs a specific function...”); *Trading Techs. Intl., Inc. v. CQG, Inc.*, 675 F. App’x 1001, 1004 (Fed. Cir. 2017) (claims required “a specific, structured graphical user interface paired with a prescribed functionality ... that is addressed to and resolves a specifically identified problem in the prior state of the art”).

Accordingly, the panel decision does not conflict with *DDR*, and GREE identifies no points of law or fact that the panel misunderstood.

II. THE PANEL DID NOT FIND FACTS BUT RULED AS A MATTER OF LAW ON AN UNDISPUTED RECORD

GREE also fails to create any issue justifying rehearing when it contends incorrectly that the panel ignored the standard of review, ignored the Board’s fact findings, and found its own facts on appeal. Pet12. It accuses the panel of deciding fact questions at *Alice* step two “in contravention of *Berkheimer* and *Aatrix*, without addressing the Board’s earlier factual findings” (Pet1), and argues this requires an *en banc* panel to “affirm” this Court’s “understanding of the appellate function.” Pet3. But the panel did not disregard its role as a court of review, and the rebuke GREE seeks is unwarranted.

Whether a patent claims eligible subject matter under §101 is a question of law. *Interval Licensing LLC v. AOL, Inc.*, 896 F.3d 1335, 1342 (Fed. Cir. 2018). While step two of *Alice* may involve underlying questions of fact, the court may still decide eligibility as a matter of law where there is no fact dispute regarding the conventionality of the claims. *Berkheimer v. HP Inc.*, 890 F.3d 1369, 1369-71 (Fed. Cir. 2018) (“*Berkheimer II*”); *Aatrix Software, Inc. v. Green Shades Software, Inc.*, 882 F.3d 1121, 1128 (Fed. Cir. 2018); *Berkheimer I*, 881 F.3d at 1368 (“Nothing in this decision should be viewed as casting doubt on the propriety” of cases resolving patent eligibility on motions to dismiss or summary judgment). After invoking the correct standard of review (Op7), the panel ruled on the eligibility of claims 2-4 and 9 as a matter of law on the undisputed record.

The panel’s first ground for finding ineligibility at step two was that the invalidated claims did not add any inventive concept to the abstract idea of creating and applying a template; they limit that idea to games with more than one player or more than one template, while still reciting only generic computer components performing their standard functions. Op11-12. The panel made this determination as a matter of law based on the face of the patent. It did not require the panel to resolve any disputed fact issue, or overcome any contrary facts found by the Board (there were none), but rather merely to apply the admissions of GREE and the disclosures in the specification and the claims. *See Berkheimer I*, 881 F.3d at 1368,

1370; Op9 (citing Appx0168 (GREE admitting “the generic idea of a template existed prior to the invention”)). The panel’s eligibility decision can stand on this ground alone. *See, e.g., Voter Verified, Inc. v. Election Sys. & Software LLC*, 887 F.3d 1376, 1385–86 (Fed. Cir. 2018) (upholding invalidity determination at Rule 12(b)(6) stage); *Maxon, LLC v. Funai Corp., Inc.*, 726 F. App’x 797, 799 (Fed. Cir. 2018) (same).

The panel’s second ground was that the record shows that the invalidated claims cover automation of the routine, well understood, and conventional activity of correspondence chess. Op12. While this ground required looking to extrinsic evidence, it did not involve contravening any facts found by the Board. There was no fact dispute in the record below about how correspondence chess worked, whether it was a longstanding practice, or whether the evidence about it was credible. All that was undisputed. Nor did the Board find any facts about the evidence. Instead it held that Supercell failed to carry its burden at step two, because the Board did not view the correspondence chess evidence as including the process covered by claims 2 and 3.

Claims 2 and 3 require a multi-player environment, by reciting use of a template “related to a different player.” The Board summarized the chess evidence as follows:

In correspondence chess, **a player** records the current state of the chess game, indicates the player’s next move on a post card, and sends the

post card to **a second player who will modify their game board** to reflect the updated state of the chess game. Pet. 21, 22 (citing Ex. 1003). Petitioner asserts that, in creating the post card, **the first player creates a template defining game contents**, stores the created template, **and allows a second player to apply the template to a predetermined area.**

Appx0014 (emphasis added). The Board then concluded that the evidence failed to show that the “different player” could both *create* and *apply* a template. On appeal, however, the panel recognized that the Board erred, as the claims are not so limited—they require only that the template be “related to” a different player and are silent as to which player creates the template. *See* Op12; *see also* Appx0089 at 26:47-67. The panel concluded that the claims “are broad enough to encompass the implementation of longstanding and conventional correspondence chess on a computer” and reversed the Board’s legal decision based on the undisputed record. Op12.

Finally, GREE contends that the panel ignored the testimony of GREE’s expert. Pet12, 15. But that is incorrect as well, as that testimony did not raise any material fact dispute. An expert’s testimony on an ultimate legal conclusion is not “evidence.” *See Soverain Software LLC v. Newegg Inc.*, 705 F.3d 1333, 1341 (Fed. Cir. 2013). Moreover, testimony about the novelty of an idea is irrelevant to patent eligibility. *See, e.g., Affinity Labs of Tex., LLC v. Amazon.com Inc.*, 838 F.3d 1266, 1270 n.3 (Fed. Cir. 2016) (“[T]he eligibility finding does not turn on the lack of novelty of the claim; it turns on the fact that the claim is drawn to any embodiment

of an abstract idea.”). GREE’s expert offered no more than this. He opined that applying a template, *i.e.*, *the abstract idea itself*, was not a routine or conventional practice at the time of the patent. Appx0396-97, ¶¶ 32-34. The Board properly discounted this testimony (Appx0011 “to the extent we determine that any testimony lacks adequate support, we discount the weight accorded to that testimony appropriately”), and it was irrelevant to the panel’s legal analysis on appeal. *Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369, 1376 (Fed. Cir. 2016) (“The inventive concept necessary at step two ... cannot be furnished by the unpatentable law of nature (or natural phenomenon or abstract idea) itself.”)

CONCLUSION

For the foregoing reasons, the Court should deny the petition.

March 2, 2021

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**CERTIFICATE OF COMPLIANCE
PURSUANT TO FED. R. APP. P. 27**

1. This brief complies with the type volume limitation of Federal Circuit Rule 32(a). This brief contains 3,830 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(f) and Federal Circuit Rule 32(b).

2. The brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rule of Civil Procedure 32(a)(6). The brief has been prepared in a proportionally spaced typeface using Microsoft Office Word Version 2010 in 14-point Times New Roman.

March 2, 2021

FENWICK & WEST LLP

By: /s/ Michael J. Sacksteder
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CERTIFICATE OF SERVICE

The undersigned certifies that a complete copy of **Response of Supercell Oy to Petition for Rehearing or Rehearing *En Banc*** was served on all attorneys via electronic mail or CM/ECF delivery on March 2, 2021.

/s/ Michael J. Sacksteder _____

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