

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SUPERCELL OY,
Petitioner,

v.

GREE, INC.,
Patent Owner.

Case IPR2020-01553
U.S. Patent No. 10,076,708

**PATENT OWNER'S RESPONSE TO PETITIONER'S ADDITIONAL
BRIEFING REGARDING OVERLAP FACTOR**

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LIST OF EXHIBITS

Exhibit No.	Description
2001	Sixth Amended Docket Control Order, <i>GREE, Inc. v. Supercell Oy</i> , Civil Action No. 2:19-cv-00310, Document 92 (E.D. Tex. Oct. 23, 2020)
2002	Order Regarding Sixth Amended Docket Control Order, <i>GREE, Inc. v. Supercell Oy</i> , Civil Action No. 2:19-cv-00310, Document 94 (E.D. Tex. Oct. 26, 2020)
2003	Joint Motion to Amend Docket Control Order, <i>GREE, Inc. v. Supercell Oy</i> , Civil Action No. 2:19-cv-00310, Document 91 (E.D. Tex. Oct. 22, 2020)
2004	Complaint, <i>GREE, Inc. v. Supercell Oy</i> , Civil Action No. 2:19-cv-00310, Document 1 (E.D. Tex. Sept. 16, 2019)
2005	Defendant Supercell Oy's Invalidity Contentions and Disclosures Under Local Patent Rules 3-3 and 3-4, <i>GREE, Inc. v. Supercell Oy</i> , Civil Action No. 2:19-cv-00310 (E.D. Tex.), dated April 7, 2020
2006	Excerpts of the Expert Report of Stacy Friedman, <i>GREE, Inc. v. Supercell Oy</i> , Civil Action No. 2:19-cv-00310 (E.D. Tex.), dated November 2, 2020
2007	Buehler, Katie, ' <i>Clash of Clans</i> ' Game Maker Owes \$8.5M, <i>Texas Jury Says</i> , Law360 (September 18, 2020)
2008	Order, <i>Solas OLED Ltd. v. Samsung Display Co., Ltd. et al.</i> , Civil Action No. 2:19-cv-001520, Document 302 (E.D. Tex.), dated November 20, 2020
2009	Claim Construction Memorandum Opinion and Order, <i>GREE, Inc. v. Supercell Oy</i> , Civil Action No. 2:19-cv-00310, Document 84 (E.D. Tex. Oct. 12, 2020)
2010	Seventh Amended Docket Control Order, <i>GREE, Inc. v. Supercell Oy</i> , Civil Action No. 2:19-cv-00310, Document 113 (E.D. Tex. Dec. 10, 2020)

Exhibit No.	Description
2011	Eighth Amended Docket Control Order, <i>GREE, Inc. v. Supercell Oy</i> , Civil Action No. 2:19-cv-00310, Document 128 (E.D. Tex. Dec. 17, 2020)
2012	Ninth Amended Docket Control Order, <i>GREE, Inc. v. Supercell Oy</i> , Civil Action No. 2:19-cv-00310, Document 171 (E.D. Tex. Jan. 20, 2021)
2013	February 19, 2021 Email Correspondence from Law Clerk to Judge Rodney Gilstrap, U.S. District Court for the Eastern District of Texas, <i>Order of Trials for March 2021, GREE, Inc. v. Supercell Oy</i> , Civil Action No. 2:19-cv-00310 (E.D. Tex.)
2014	Model Order Focusing Patent Claims and Prior Art to Reduce Costs, U.S. District Court for the Eastern District of Texas
2015	Order, <i>GREE, Inc. v. Supercell Oy</i> , Civil Action No. 2:19-cv-00200, Document 243 (E.D. Tex. March 11, 2021)
2016	March 11, 2021 Email Correspondence from Law Clerk to Chief Judge Rodney Gilstrap, U.S. District Court for the Eastern District of Texas, <i>Order of Trials for March 2021, GREE, Inc. v. Supercell Oy</i> , Civil Action Nos. 2:19-cv-00200, -237, -310, -311 (E.D. Tex.)
2017	March 11, 2021 Email Correspondence from Melissa Smith to Law Clerk to Chief Judge Rodney Gilstrap, U.S. District Court for the Eastern District of Texas, <i>Order of Trials for March 2021, GREE, Inc. v. Supercell Oy</i> , Civil Action Nos. 2:19-cv-00200, -237, -310, -311 (E.D. Tex.)

Patent Owner’s recent narrowing of the claims it will present at the parties’ imminent trial, as required by the District Court’s procedures, does not materially alter the weighing of *Fintiv* Factor 4. Patent Owner has not engaged in any “gamesmanship.” Rather, Patent Owner has followed common practice of selecting the claims it will present to the jury given the District Court’s directives in view of its time limits on trials. *See* Exs. 2014, 2015. Thus, the fact that the Petition challenges additional claims does not preclude a finding of overlap. *See Samsung Elecs. Co. Ltd. v. Clear Imaging Research, LLC*, IPR2020-01552, Paper 12, at 21–23 (P.T.A.B. Mar. 3, 2021) (“[T]he mere existence of non-overlapping claims does not support Petitioner’s position that this factor favors institution. ...”). Moreover, the fact that the parallel proceeding has progressed this far—through two pre-trial conferences and to the cusp of trial—strongly favors discretionary denial.

Under *Fintiv*, there need only be some “overlap” between issues in the petition and the parallel proceeding. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 6 (P.T.A.B. Mar. 20, 2020).¹ The Board has consistently found that this factor weighs in favor of discretionary denial even when there is not complete identity of

¹ Relatedly, Petitioner’s contention that “there is no overlap whatsoever in the art asserted in the Petition and in the parallel proceeding” (Paper 10, at 1) is belied by record facts, as previously discussed. *See, e.g.*, Paper 9, at 3–5.

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