

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SUPERCELLOY,  
Petitioner,

v.

GREE, INC.,  
Patent Owner.

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IPR2020-01628  
Patent 9,561,439 B2

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Before LYNNE H. BROWNE, HYUN J. JUNG, and  
RICHARD H. MARSCHALL, *Administrative Patent Judges*.

JUNG, *Administrative Patent Judge*.

DECISION  
Denying Institution of *Inter Partes* Review  
35 U.S.C. § 314

## I. INTRODUCTION

### A. *Background and Summary*

Supercell Oy (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting institution of an *inter partes* review of claims 1–7 of U.S. Patent No. 9,561,439 B2 (Ex. 1001, “the ’439 patent”). GREE, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”). With our authorization, Petitioner filed a Reply to Patent Owner’s Preliminary Response Pursuant to 37 C.F.R. § 42.108(c) (Paper 7, “Reply”), and Patent Owner filed a Sur-Reply to Petitioner’s Reply to Patent Owner’s Preliminary Response (Paper 8, “Sur-reply”).

After considering the parties’ briefs and the evidence of record, we exercise our discretion under 35 U.S.C. § 314(a) to deny *inter partes* review.

### B. *Real Parties in Interest*

Petitioner identifies only Supercell Oy as a real party in interest. Pet. 1. Patent Owner identifies only GREE, Inc. as a real party in interest. Paper 4, 2.

### C. *Related Matters*

The parties indicate that the ’439 patent has been asserted in *GREE, Inc. v. Supercell Oy*, 2:19-cv-00311 (E.D. Tex.). Pet. 2; Paper 4, 3. The parties also indicate that a related patent is at issue in IPR2020-001633. Pet. 2; Paper 4, 2.

### D. *The ’439 Patent (Ex. 1001)*

The ’439 patent issued on February 7, 2017 from an application filed on June 10, 2015 that is a division of an application filed on March 5, 2014 that, in turn, claims priority to foreign applications, the earliest of which was filed on March 12, 2013. Ex. 1001, codes (22), (30), (45), (62), 1:8–12.

According to the '439 patent, it addresses reduced motivation for low level players when playing a social game with guilds or groups of players that may be of higher level. *See* Ex. 1001, 1:22–24, 1:56–59, 2:14–15, 2:17–22. In one embodiment, while the game is being played, certain game pieces appear based on the level of the user. *See id.* at 21:32–46. When players in a guild collect all the required game pieces, a reward is given. *See id.* at 24:30–32. Thus, the appearance of some of the required game pieces to only users of a particular level encourages players to form a guild with both high and low level players. *See id.* at 24:22–29.

*E. Illustrative Claim*

The '439 patent includes claims 1–7, all of which Petitioner challenges. Of those, claims 1, 6, and 7 are independent, and claim 1 is reproduced below.

1. A game control method carried out by a game control device for providing a game to a plurality of communication terminals respectively used by a plurality of users, the game control device communicating with the plurality of communication terminals over a communication network and having a storage unit for storing information for each of the plurality of users, the method comprising the steps of:

- (a) grouping the plurality of users into one or more groups;
- (b) storing a correspondence between the plurality of users and the one or more groups in the storage unit;
- (c) transmitting information over the communication network to initiate a group event in which a first plurality of users forming a first group cooperatively participate in the game;
- (d) storing a parameter value for each of the plurality of users, wherein the parameter value for a respective user is increased as the respective user makes progress in the group event;
- (e) monitoring progress of the group event and updating the parameter value for each of the first plurality of users in

accordance with the progress of the first group in the group event;

(f) providing at least one of a plurality of game pieces to each of the first plurality of users in the group event, based on the parameter value for the corresponding user, wherein the plurality of game pieces are required to obtain a game item;

(g) storing allocation information indicating which game piece has been provided to which user, in the storage unit;

(h) determining whether all the required game pieces have been provided to the first plurality of users, based on the allocation information; and

(i) allocating in a memory, the game item to the first group or at least one of the first plurality of users, when it is determined that all the required game pieces have been provided within a predetermined period of time during which the group event is taking place.

Ex. 1001, 25:37–26:8.

*F. Asserted Prior Art and Proffered Testimonial Evidence*

Petitioner identifies the following references as prior art in the asserted grounds of unpatentability:

Name	Reference	Exhibit
Schulhof	US 8,376,838 B2, issued Feb. 19, 2013	1006
Englman	US 2011/0300926 A1, published Dec. 8, 2011	1004
Ronen	US 2013/0190094 A1, published July 25, 2013	1005

Pet. 3; *see also id.* at 4 (arguing that the effective filing date is no earlier than March 12, 2013). Petitioner also provides a Declaration of Emmet J. Whitehead, Jr., Ph.D. (Ex. 1003).

*G. Asserted Ground*

Petitioner asserts that claims 1–7 would have been unpatentable on the following ground:

Claims Challenged	35 U.S.C. §	References/Basis
1–7	103(a) <sup>1</sup>	Englman, Ronen, Schulhof

II. 35 U.S.C. § 314(a)

Patent Owner argues that “the Board should exercise its discretion under 35 U.S.C. § 314(a) to deny the Petition because Petitioner raises substantially the same prior art and arguments in a parallel district court proceeding filed more than one year ago and scheduled for trial in approximately two months (March 1, 2021).” Prelim. Resp. 1.

*A. Legal Standards*

35 U.S.C. § 314(a) states that

[t]he Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

The language of § 314(a) expressly provides the Director with discretion to deny institution of a post-grant review. *See Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”);

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<sup>1</sup> The relevant sections of the Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, 125 Stat. 284 (Sept. 16, 2011), took effect on March 16, 2013. Because the ’439 patent claims priority to an application filed before that date, our citations to 35 U.S.C. § 103 are to its pre-AIA version.

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