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Paper 9
Date: February 19, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SUPERCELL OY,
Petitioner,

v.

GREE, INC.,
Patent Owner.

IPR2020-01633
Patent 9,079,107 B2

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 1–11 of U.S. Patent No. 9,079,107 B2 (Ex. 1001, "the '107 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. 2. Patent Owner identifies only GREE, Inc. as a real party in interest. Paper 4, 2.

C. Related Matters

The parties indicate that the '107 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 IPR2020-001628. Pet. 2; Paper 4, 2.

D. The '107 patent (Ex. 1001)

The '107 patent issued on July 14, 2015 from 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), 1:8–11.

According to the '107 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 id.* at 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 21:32–38, 23:50–53. When players in a guild collect all the required game pieces, a reward is given. *See id.* at 23:62–64. Thus, the appearance of some of the required game pieces

to only users of a particular level encourages players to form a guild with high level and low level players. *See id.* at 23:50–57.

E. Illustrative Claim

The '107 patent includes claims 1–11, all of which Petitioner challenges. Of those, claims 1, 9, and 10 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 and having a storage unit, the method comprising the steps of:
>
> (a) storing skill level information indicative of skill levels of each of the plurality of users of the game, in the storage unit;
>
> (b) grouping the plurality of users into one or more groups;
>
> (c) providing one or more of a plurality of game pieces to a first plurality of users in a first group of said one or more groups, based on the skill level information, while the first plurality of users are at certain events in the game;
>
> (d) storing allocation information indicating which game piece has been provided to which user with a respective skill level, and a number and type of game pieces required to obtain a game item as a reward, in the storage unit;
>
> (e) determining whether all of the game pieces required to obtain said game item have been provided to the first group, based on the allocation information stored in the storage unit; and
>
> (f) 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.

Ex. 1001, 24:65–25:24.

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
Thompson	US 7,824,253 B2, issued Nov. 2, 2010	1007
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 Grounds

Petitioner asserts that claims 1–11 would have been unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §	References/Basis
1–7, 9–11	103(a)[1]	Englman, Ronen, Schulhof
8	103(a)	Englman, Ronen, Schulhof, Thompson

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.

[1] 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 '107 patent claims priority to an application filed before that date, our citations to 35 U.S.C. § 103 are to its pre-AIA version.

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."); Consolidated Trial Practice Guide November 2019 ("TPG") at 55 (available at https://www.uspto.gov/TrialPracticeGuideConsolidated).

In exercising the Director's discretion under § 314(a), the Board may consider "events in other proceedings related to the same patent, either at the Office, in district court, or the ITC." TPG at 58. *NHK Spring* explains that the Board may consider the advanced state of a related district court proceeding, among other considerations, as a "factor that weighs in favor of denying the Petition under § 314(a)." *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (precedential). Additionally, the Board's precedential order in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential) ("the *Fintiv* Order") identifies several factors for analyzing issues related to the Director's discretion to deny institution, with the goal of balancing efficiency, fairness, and patent quality.

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