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Paper 7
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SUPERCELL OY,
Petitioner,

v.

GREE, INC.,
Patent Owner.

Case PGR2018-00070
Patent 9,770,656 B2

Before LYNNE H. BROWNE, HYUN J. JUNG, and
CARL M. DEFRANCO, *Administrative Patent Judges.*

DEFRANCO, *Administrative Patent Judge*.

DECISION
Denying Institution of Post-Grant Review
35 U.S.C. § 324(a)

GREE, Inc. ("GREE") is the owner of U.S. Patent No. 9,770,656 B2 ("the '656 patent"). Supercell Oy ("Supercell") filed a petition requesting post-grant review of claims 1–6 of the '656 patent. Paper 2 ("Pet."). GREE filed a preliminary response in opposition. Paper 6 ("Prelim. Resp."). After considering the petition and the preliminary response, along with the

evidence of record, we determine the petition fails to demonstrate that at least one of the challenged claims is more likely than not unpatentable. 35 U.S.C. § 324(a). Thus, institution of post-grant review of claims 1–6 of the '656 patent is *denied*.

I. BACKGROUND

A. The '656 Patent

The '656 patent issued September 26, 2017, and claims priority to a foreign application filed June 20, 2013.[1] Ex. 1001, cover. The '656 patent is directed to an online social video game played on a mobile device through a communications network. *Id.* at 1:19–24. As described, the game entails multiple users engaging in various missions to acquire a game item as a reward for clearing a mission. *Id.* at 1:25–32. A conventional game of this type, however, "is not so interesting for the user" because the "missions are the same for all users" and the number of missions a user can select "is limited." *Id.* at 1:36–44. The '656 patent overcomes this problem by "increas[ing] chances for a user to select a mission, and [thereby] maintain and increase the user's interest in continuing a game." *Id.* at 1:45–47.

According to the '656 patent, a list of "missions" is displayed on the mobile device to a user from which the user chooses to play the game. *Id.* at 1:48–52, 2:25–30, 2:39–48, 3:20–23. After a predetermined period of time has elapsed, the list of displayed missions will automatically update to present the user with a new mission or group of missions. *Id.* at 3:23–32. In

[1] Because Supercell filed the petition within nine months of the '656 patent's issue date and the earliest possible priority date for the '656 patent is after March 16, 2013 (the effective date for the first inventor to file provisions of the Leahy-Smith America Invents Act), the '656 patent is eligible for post-grant review. *See* 35 U.S.C. § 321.

addition, the game server may update a mission in the mission list with a new mission in response to a request received from the user's mobile device. *Id.* at 3:44–46. Hence, if the user clears a mission quickly, the user can select a new mission without waiting for the predetermined period to elapse. *Id.* at 3:46–48. A mission in the displayed list of missions may be changed to another mission by activating an "operational element" on the mobile device. *Id.* at 1:56–63; *see also id.* at 7:32–42 (describing the operational element in terms of an "exchange button"). By providing this operational element or exchange button, "the chances of the user selecting the missions increase, making it possible to maintain and increase the user's interest in continuing the game." *Id.* at 3:48–51; *see also id.* at 1:45–47, 14:5–11 (describing the same benefit).

B. Representative Claim

The '656 patent includes six claims, of which claims 1, 5, and 6 are independent. Claim 1 is directed to a "method for providing a game," claim 5 is directed to a "non-transitory storage medium having stored therein a control program for a server device providing a game," and claim 6 is directed to a "server device for providing a game." Claims 1 and 5 recite the same method steps, while claim 6 differs from claims 1 and 5 only in that it recites "units" configured to perform the method steps of claims 1 and 5. Claim 1 is representative of the independent claims and recites the following:

> 1. A method for providing a game, over a communication network, to a plurality of user devices from a server device having a storage unit for storing user information relating to a plurality of users, the method comprising the steps of:

(a) responsive to the user information for the plurality of users, generating a plurality of missions for each of the plurality of users;

(b) storing in the storage unit a plurality of relations between a plurality of items and the plurality of missions;

(c) transmitting over the communication network, to a first user device, displaying information for presenting a list of the missions generated for a first user on the first user device, the list indicating each of the missions, an item associated with a mission which the first user can acquire by clearing the mission, and *an exchange element for changing a displayed mission to another mission to be presented in the list, wherein the exchange element is enabled based on at least one of the missions in the list being cleared*;

(d) receiving an identifier of an item from the first user device;

(e) identifying a second mission in which the item specified by the received identifier can be acquired, responsive to the stored relations between the plurality of items and the plurality of missions; and

(f) updating the displaying information so that said at least one of the missions included in the list is replaced with said identified second mission generated for the first user, *when the exchange element is activated*.

Ex. 1001, 14:46–15:8 (emphases added).

C. Asserted Grounds of Unpatentability

The petition asserts that claims 1–6 of the '656 patent are unpatentable as (1) being directed to non-statutory subject matter under 35 U.S.C. § 101 (Pet. 22–49), (2) failing to comply with the written description requirement of 35 U.S.C. § 112(a) (*id.* at 50–55), and (3) failing to comply with the definiteness requirement of 35 U.S.C. § 112(b) (*id.* at 55–58). Supercell does not submit declarant testimony in support of its

petition. GREE, on the other hand, submits the testimony of Dr. Michael Shamos (Ex. 2001, "the Shamos declaration").

II. ANALYSIS

A. Claim Construction

At this stage, neither party proposes a construction for any particular claim term. *See* Pet. 18–19; Prelim. Resp. 4–17. In considering the parties' submissions, we determine that no express construction of the claim terms is necessary for purposes of determining whether institution is appropriate.

B. The Challenge Under 35 U.S.C. § 101

Supercell challenges claims 1–6 of the '656 patent for failing to recite patent eligible subject matter under 35 U.S.C. § 101. Pet. 22–49 (citing Exs. 1001–1004). GREE disagrees. Prelim. Resp. 39–68. The U.S. Supreme Court has long interpreted 35 U.S.C. § 101 to exclude from patenting "[l]aws of nature, natural phenomena, and abstract ideas." *Alice Corp. Pty. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355 (2014) ("*Alice*"). Central to this case is whether the challenged claims cover the excluded category of abstract ideas. That determination involves a two-step analysis, as explained by the Supreme Court in *Alice*. *Id.* (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 78–79, 132 S. Ct. 1289, 1297–98 (2012) ("*Mayo*")). First, we determine whether a claim is "directed to" a patent-ineligible abstract idea. *Alice*, 134 S. Ct. at 2355. If the claim is directed to an abstract idea, we then consider whether any claim elements, either individually or as an ordered combination, transform the nature of the claim into an "inventive concept"—an element or combination of elements sufficient to ensure that the claim amounts to "significantly more" than the abstract idea itself. *Id.*

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