

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SUPERCELL OY,
Petitioner,

v.

GREE, INC.,
Patent Owner.

IPR2020-01553
Patent 10,076,708 B2

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

BROWNE, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review

35 U.S.C. § 314

Denying Petitioner's Motion to Seal

37 C.F.R. § 42.55

I. INTRODUCTION

A. *Background and Summary*

Supercell Oy ("Petitioner") filed a Petition (Paper 2, "Pet.")
requesting institution of an *inter partes* review of claims 1–3 of U.S. Patent

No. 10,076,708 B2 (Ex. 1001, “the ’708 patent”), along with a Motion to Seal Exhibit 1034 and for Entry of Protective Order (Paper 3). GREE, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 7, “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 8, “Prelim. Reply”), and Patent Owner filed a Sur-Reply to Petitioner’s Reply to Patent Owner’s Preliminary Response (Paper 9, “Prelim. 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. We also deny as moot Petitioner’s motion.

B. Real Parties in Interest

Petitioner identifies itself as the real party in interest. Pet. 1. Patent Owner identifies itself as the real party in interest. Paper 4, 2.

C. Related Matters

The parties indicate that the ’708 patent has been asserted in *GREE, Inc. v. Supercell Oy*, 2:19-cv-00310 (E.D. Tex.). Pet. 1; Paper 4, 3 (“the parallel district court proceeding”).

D. The ’708 Patent

The ’708 patent issued on September 18, 2018, and claims priority to foreign applications, the earliest of which was filed on June 21, 2012. Ex. 1001, codes (22), (30), (45), 1:7–10.

The ’708 patent “provides a game control method, a game server, and a program that can increase the variations on methods for acquiring battle cards . . . , increase the predictability of acquisition of a card . . . with a high rarity value . . . , and heighten interest in the game.” Ex. 1001, 1:48–53.

Figure 1 of the ’708 patent is reproduced below.

FIG. 1

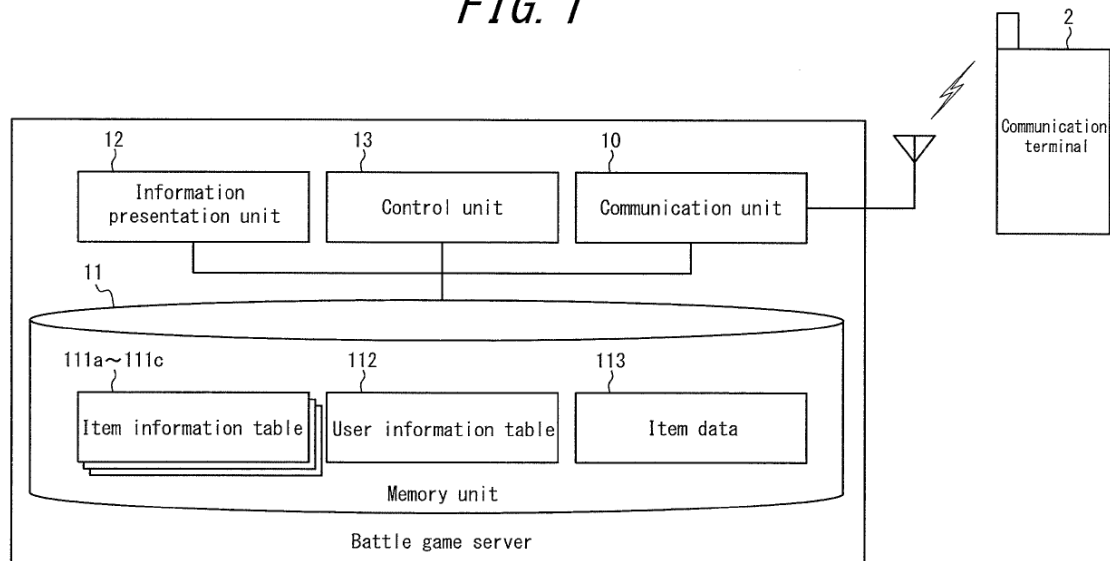


Figure 1 is a block diagram of battle game server 1. *Id.* at 3:38–39. Figure 1 also shows communication terminal 2 in wireless communication with battle game server 1. Battle game server 1 includes communication unit 10, memory unit 11, information presentation unit 12, and control unit 13. *Id.* at 3:63–4:2. Memory unit 11 stores information “on items to provide, a total count of items, item type, and an acquisition count” for each user that operates a communication terminal 2 in tables. *Id.* at 4:7–10, 4:17–18. “An ‘item’ refers to any of a variety of objects used within a game, such as a battle card constituting a user’s deck, a character, a weapon, armor, an ornament, a plant, food, and the like.” *Id.* at 4:11–14. The tables that store item information include item information tables 111 (e.g., 111a–111c) and user information table 112. *Id.* at 4:18–20. Memory unit 11 also stores item data 113. *Id.*

According to the ’708 patent, “when a request to present information is received from the communication terminal 2 via the communication unit 10, then based on the item information tables 111a to 111c, the information

presentation unit 12 tallies the total count of items for each item type.”

Ex. 1001, 4:65–5:2. “The information presentation unit 12 also refers to the user information table 112 to calculate the acquisition count of items for each item type based on the identification information of provided items and the table identification information that correspond to the user identification information pertaining to the communication terminal 2.” *Id.* at 5:2–8. “The information presentation unit 12 then presents the communication terminal 2, via the communication unit 10, with the result of [the] calculation as the acquirable item information.” *Id.* at 5:8–11.

E. Illustrative Claim

The ’708 patent includes independent claims 1–3, all of which Petitioner challenges. Claim 1 is reproduced below.

1. A game control method comprising the steps of:
 - (a) initializing a virtual game;
 - (b) displaying, during the virtual game, a plurality of cells and acquirable item information that is received from a server over a communication line, the plurality of cells being displayed in the same size, wherein each of a plurality of items extracted from an item information table pertaining to a user is associated with each of the plurality of cells, the plurality of items being selected randomly only from items in the item information table, and at least one of the cells including a character which indicates a rarity value of an item associated with the at least one of the cells;
 - (c) receiving, during the virtual game, a selection request selecting one of the plurality of cells and sending the selection request to the server; and
 - (d) displaying, during the virtual game, an item associated with the selected cell, which is determined by the server based on the selection request.

Ex. 1001, 13:51–14:13.

F. Asserted Grounds and Proffered Testimonial Evidence

Petitioner asserts that claims 1–3 would have been unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §	References/Basis
1–3	103(a) ¹	Hawkins, ² Robbers ³
1–3	103(a)	SCM, ⁴ Stroffolino ⁵

Pet. 3. Petitioner also provides a Declaration of Ravin Balakrishnan, Ph. D. Ex. 1007.

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 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 (citing *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, at 19–20 (P.T.A.B. Sept. 12, 2018) (precedential); *Apple Inc. v. Fintiv, Inc.*, IPR2020- 00019, Paper 11, at 6 (P.T.A.B. Mar. 20, 2020) (“*Fintiv*”) (precedential)).

A. Legal Standards

35 U.S.C. § 314(a) states that

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 ’708 patent claims priority to an application filed before that date, our citations to 35 U.S.C. § 103 are to its pre-AIA version.

² U.S. 9,511,285, issued December 6, 2016. Ex. 1022 (“Hawkins”).

³ U.S. 2009/0051114 A1, published February 26, 2009. Ex. 1023 (“Robbers”).

⁴ Scrabble Complete PC Manual, Infogrames Interactive, Inc., 2002. Ex. 1016 (“SCM”).

⁵ U.S. 8,352,542 B2, issued January 8, 2013. Ex. 1024 (“Stroffolino”).

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