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Paper 11
Date: April 14, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SUPERCELL OY,
Petitioner,

v.

GREE, INC.,
Patent Owner.

Case PGR2020-00088
Patent 10,518,177 B2

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

BROWNE, *Administrative Patent Judge.*

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

I. INTRODUCTION

GREE, Inc. ("Patent Owner" or "GREE") is the owner of U.S. Patent No. 10,518,177 B2 ("the '177 patent"). Supercell Oy ("Petitioner" or "Supercell") filed a petition requesting post-grant review of claims 1–17 of the '177 patent. Paper 2 ("Pet."). Patent Owner, in turn, filed a preliminary response. Paper 7 ("Prelim. Resp."). With our prior authorization, Petitioner filed a preliminary reply. Paper 8 ("Prelim. Reply"). Also, with our prior authorization, Patent Owner filed a preliminary sur-reply. Paper 9 ("Prelim. Sur-Reply").

Having considered the arguments and evidence of record, and for the reasons explained below, we exercise our discretion under 35 U.S.C. § 324(a) and deny institution of post-grant review.

A. Related Proceedings

Petitioner indicates that the '177 patent is the subject of *GREE, Inc. v. Supercell Oy*, No. 2:19-cv-00413-JRG-RSP (ED Tex.). Pet. 1 (the "parallel district court proceeding"); *see also* Paper 4, 3 (Patent Owner identifying the same district court proceeding).

B. The '177 Patent

The '177 patent is directed to "a game control method, a system, and a non-transitory computer-readable recording medium for providing client devices with a battle game over a network." Ex. 1001, 1:15–17. Specifically, the '177 patent relates to "games with a function to allow groups of players to battle each other" during predetermined time slots. *Id.* at 1:35–38. According to the '177 patent, in this type of time slot group battle, "the participation rate of the group members in the battle tends to increase in the last half of the time slot," but game providers want "players

to participate actively in the battle throughout the entire time set." *Id.* at 1:66–2:1, 2:16–17. Another problem with this type of time slot group battle identified by the '177 patent is that these battles "are often not divided up by level" such that "beginners may end up passively participating in a group battle" and "may therefore be unsuccessful." *Id.* at 2:22, 2:29–31.

In order to increase player participation throughout the entire time set and even the playing field for beginner players, the '177 patent divides the battle game time slot into "a first portion, middle portion, and last portion" subdivisions and changes a battle condition in at least one of the subdivided time slots. Ex. 1001, 2:63–65. According to the '177 patent, these modifications increase participation at the beginning of the battle time slot and allow beginners to enjoy the battle by, for example, setting a battle condition that increases the attack strength of low-level characters during a subdivision. *Id.* at 3:1–13.

C. Representative Claim

The '177 patent includes seventeen claims, of which claims 1, 8, and 14–17 are independent. All of the independent claims recite similar limitations and vary only as to type, where claims 1 and 8 are directed to a "non-transitory computer-readable recording medium . . . causing the one or a plurality of computers to execute steps of," claims 14 and 15 are directed to a "battle game control method," and claims 16 and 17 are directed to a "battle game control system." Ex. 1001, 12:65–13:2, 13:55–59, 14:33–35, 15:1–3, 15:25–26, 16:17–18. Representative claim 1 is reproduced below:

> 1. A non-transitory computer-readable recording medium storing instructions to be executed by one or a plurality of computers capable of being used by a player conducting a

battle game, the instructions causing the one or a plurality computers to execute steps of:

displaying, on a first field, a plurality of cards selected from a deck which is a stack of virtual cards;

during a first term of the battle game, conducting a battle to a first opponent character based on a parameter set on a card selected by a player's operation under a first battle condition, wherein the first battle condition is not changed during the first term;

at a conclusion of the first term of the battle game, automatically initiating a second term of the battle game, and during the second term of the battle game continued from the first term, conducting the battle to a second opponent character based on the parameter set on the card selected by the player's operation under a second battle condition, wherein the second battle condition is different from the first battle condition and is predetermined independent from a battle result of the first term, and the first opponent character and the second opponent character are same or different, wherein the second battle condition is not changed during the second term;

during a third term of the battle game continued from the second term, conducting the battle to a third opponent character based on the parameter set on the card selected by the player's operation under a third battle condition, wherein the third battle condition is different from the second battle condition and is dependent on a battle result of the second term, and the second opponent character and the third opponent character are same or different, and wherein the third battle condition is not changed during the third term.

Ex. 1001, 12:65–13:32.

D. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–17 are unpatentable based on the following grounds.

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–17	101	Ineligible Subject Matter
1–17	103(a)	Master Hearthstone,[1] Gilson[2]

Petitioner relies on the Declaration of Steve Meretzky (Ex. 1005).

III. ANALYSIS

A. Discretion Under 35 U.S.C. § 324(a)

Patent Owner urges the Board to exercise discretion to deny institution of post-grant review under 35 U.S.C. § 324(a) "because Petitioner raises substantially the same arguments and prior art in a parallel district court proceeding filed more than one year ago and scheduled for trial in less than four months (May 10, 2021)." Prelim. Resp. 1 (citing *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 19–20 (PTAB Sept. 12, 2018) (precedential)); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (PTAB, Mar. 20, 2020) (precedential) ("*Fintiv*"). Patent Owner asserts that "it would be an inefficient use of Board, party, and judicial resources to institute the present proceeding under these circumstances. Indeed the possibility of duplication of efforts here is high, as is the potential for inconsistent results, due to both tribunals considering substantially the same issues." *Id.* at 2. Petitioner disagrees. Prelim. Reply 1–5.

1. Legal Standards

35 U.S.C. § 324(a) states that

> [t]he Director may not authorize a post-grant review to be instituted unless the Director determines that the information

[1] "Master Hearthstone in 10 Minutes!" (Ex. 1012, "MH").

[2] US 2013/0281173 A1, published October 24, 2013 (Ex. 1013, "Gilson").

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