

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SUPERCELL OY,  
Petitioner,

v.

GREE, INC.,  
Patent Owner.

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Case PGR2018-00037  
Patent 9,662,573 B2

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Before MICHAEL W. KIM, LYNNE H. BROWNE, and  
AMANDA F. WIEKER, *Administrative Patent Judges*.

WIEKER, *Administrative Patent Judge*.

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

## I. INTRODUCTION

### A. *Background*

Supercell Oy (“Petitioner”) filed a Petition for post-grant review of claims 1–11 (“the challenged claims”) of U.S. Patent No. 9,662,573 (Ex. 1001, “the ’573 patent”) pursuant to 35 U.S.C. §§ 321–329. Paper 1 (“Pet.”). GREE Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 324, which provides that a post-grant review may be instituted only if “the information presented in the petition . . . demonstrate[s] that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.”

Petitioner challenges the patentability of claims 1–11 of the ’573 patent under 35 U.S.C. §§ 101, 112(a), and 112(b). After considering the Petition and the Preliminary Response, as well as all supporting evidence, we conclude that the information presented in the Petition does not demonstrate that it is more likely than not that at least one of the challenged claims is unpatentable. Accordingly, we do not institute a post-grant review of the challenged claims.

### B. *Related Matters*

The parties state that there are no related matters. Pet. 1; Paper 4, 1.

### C. *The ’573 Patent*

The ’573 patent is entitled “Method For Controlling Server Device, Server Device, Computer-Readable Recording Medium and Game System.” Ex. 1001, (54). The ’545 patent aims to “enhance motivation of a player to invite another player to a social game.” *Id.* at (57).

The '573 patent identifies the popularity of social games that are “provided from a server device via a communication network to mobile terminals.” *Id.* at 1:11–13. Players may participate in such games by accessing the gaming platform directly, or by invitation from another player who already participates in the game. *Id.* at 1:55–58. For example, an existing player who invites another to the game may “get a predetermined incentive,” for example, “a coin or precious item[] such as a rare item that can be used in the social game,” when the invited user participates in the game. *Id.* at 1:63–2:1. However, according to the '573 patent, because the first player only receives an incentive when the invited user actually “participates in (registers)” with the game, the value of the incentive is “small relative to the effort of transmitting the invitation mail, [so] they will stop transmitting invitation mail.” *Id.* at 2:11–22. Thus, “it is difficult to increase the number of players who participate in the social game.” *Id.* at 2:29–30.

Accordingly, the '573 patent seeks to enhance the motivation of players to invite others to a social game. *Id.* at 2:32–37. Embodiments of the invention include a server device, connected to a network, which communicates with terminal devices, e.g., client computers or mobile terminals. *Id.* at 4:24–37, 15:6–7, Figs. 1–2. The '573 patent explains that “management range T1 refers to the range of information and processing that the provider can manage *in the platform*, e.g., including information on registered members, information on provided games (applications), and the processing relating to messages and e-mail among the members, for example.” *Id.* at 9:60–65 (emphasis added). “External service S1 is a service that is provided *outside of* the management range T1,” and which

“manages messages and e-mail exchanged between information processing terminals including the terminal devices . . . [and may] work with the message processing in the management range T1, whereby messages and e-mail can be exchanged in and out of the management range T1.” *Id.* at 10:4–12 (emphasis added).

Figure 7 of the '573 patent is reproduced below.

FIG. 7

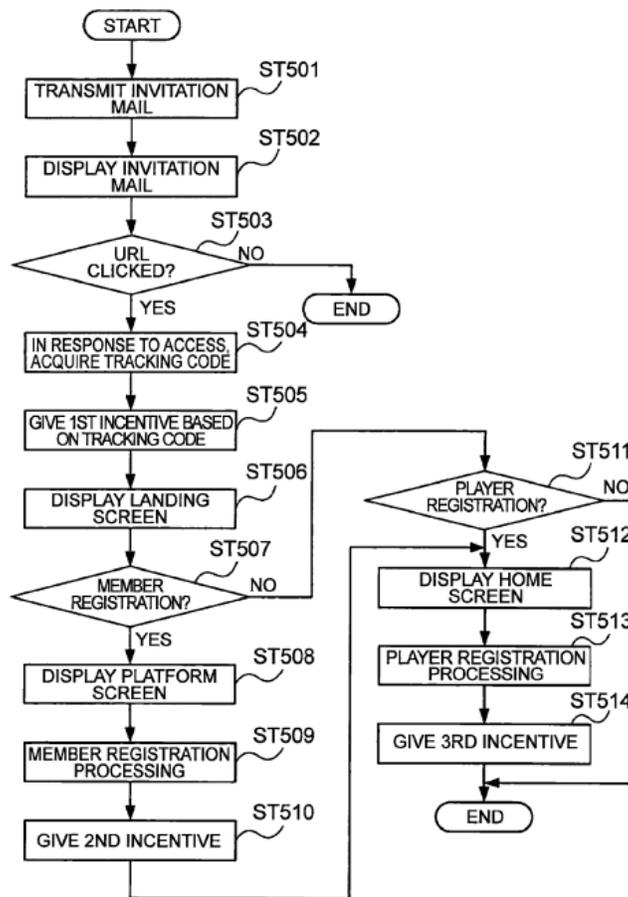


Figure 7 depicts a flowchart illustrating an exemplary process for giving incentives to a first player. *Id.* at 4:1–3.

As depicted in Figure 7, a first player, operating a first terminal device, transmits an invitation message to a second user of a second terminal device, via external service S1 (step ST501). *Id.* at 11:18–22. The invitation

message includes a URL that specifies a landing screen and contains a tracking code that identifies the first player from whom the invitation originated. *Id.* at 9:29–43. Next, the second user views the invitation (ST502), and determines whether to access the landing screen by clicking the URL (ST503). *Id.* at 11:23–26, 38–40, 48–49. If the second user accesses the landing screen from the URL, “the server device 100 can obtain the tracking code” to identify the first player (ST504). *Id.* at 9:43–49, 11:49–55, 11:55–62 (or, terminating process if URL is not clicked), 11:66–12:4. In response, the server “gives a first incentive to the [first] player who is identified with the tracking code (ST505)” and displays the landing screen to the second, invited user (ST506). *Id.* at 12:5–14 (emphasis added).

After the landing screen is displayed, the second, invited user determines whether to register as a member with the game provider (ST507). *Id.* at 12:14–19. If the second user elects to register, the server displays the appropriate platform screen to allow member registration (ST508–509). *Id.* at 12:26–37; *see also id.* at 12:48–58 (or, declining to register). In such a circumstance, the server gives a second incentive to the first player, who sent the invitation message (ST510). *Id.* at 12:38–47.

A home screen is then displayed to the second user (ST512), through which the second user may also elect to register as a player in the game (ST513). *Id.* at 12:59–13:4. If player registration is completed, the server then gives a third incentive to the first player (ST514). *Id.* at 13:5–8.

The ’573 patent also explains that the incentives may “change[] gradually in accordance with the degree of importance of the operation,” for example, “the first incentive may be the smallest,” “[t]he second incentive may be the largest because it is given to the operation that becomes a great

advantage for the provider,” and “[t]he third incentive may be at the medium level.” *Id.* at 13:53–62. Also, the number of times the incentives may be earned may be limited for a predetermined duration. *Id.* at 13:63–14:3.

“Players may be informed of the number of times of incentives given or their contents by a predetermined method, whereby the players can be encouraged to transmit invitation messages.” *Id.* at 14:10–13.

#### *D. Illustrative Claim*

Of challenged claims 1–11, each of claims 1, 6, and 8–11 are independent. Claim 9 is illustrative and is reproduced below.<sup>1</sup>

9. A non-transitory computer-readable recording medium having a program that can be readable by a computer that provides a game, in which a plurality of players can participate, and that is connected to terminal devices operated by the players via a communication line and which program, when executed by said computer, provides an incentive giving function that:

- [a] enables a first player who operates a first terminal device to send invitation information to a second player who operates a second terminal device, wherein the invitation information includes solicitation information to at least suggest participating in the game and specific information to at least specify a landing screen associated with a home screen of the game;
- [b] detects when the second terminal device is operated to access the landing screen on a basis of the specific information; and
- [c1] responsive to said detecting, gives a first incentive to the first player; and
- [c2] gives a second incentive to the first player when the second player registers as a member of a provider that is accessed via the landing screen.

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<sup>1</sup> Petitioner identifies claim 9 as “representative,” a designation with which Patent Owner disagrees. Pet. 12; Prelim. Resp. 36.

Ex. 1001, 17:25–46 (brackets added).

Additional independent claims 1 and 6 are directed to a “method for controlling a server device”; independent claims 8 and 11 are directed to a “server device”; and independent claim 10 is directed to a “game system comprising[] a server device.” *Id.* at 16:44–65, 17:5–24, 18:1–45. Each independent claim recites, with some variation, limitations directed to [a] enabling the sending of invitation information, [b] detecting access to a landing screen, and giving [c1] first incentives and [c2] second incentives. Hereinafter, we will refer to the limitations concerning first and second incentives as a “sequence of incentives.”

*E. Asserted Grounds of Unpatentability*

Petitioner challenges the patentability of claims 1–11 of the ’573 patent on the following grounds (Pet. 11).

<b>Statutory Basis</b>	<b>Claims</b>
§ 101	1–11
§ 112(a)	1–11
§ 112(b)	1–11

With its Petition, Petitioner does not provide declarant testimony, for example, from a person of ordinary skill in the art. Patent Owner relies on the testimony of Mr. David Crane (Ex. 2001, the “Crane Declaration”). *See, e.g.*, Prelim. Resp. 32.

*F. Eligibility of Patent for Post-Grant Review*

The post-grant review provisions of the Leahy-Smith America Invents Act (“AIA”)<sup>2</sup> apply only to patents subject to the first inventor to file provisions of the AIA. AIA § 6(f)(2)(A). Specifically, the first inventor to

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<sup>2</sup> Pub L. No. 112-29, 125 Stat. 284 (2011).

file provisions apply to any application for patent, and to any patent issuing thereon, that contains or contained at any time a claim to a claimed invention that has an effective filing date on or after March 16, 2013. AIA § 3(n)(1). Furthermore, “[a] petition for a post-grant review may only be filed not later than the date that is 9 months after the date of the grant of the patent or of the issuance of a reissue patent (as the case may be).” 35 U.S.C. § 321(c); *see also* 37 C.F.R. § 42.202(a) (setting forth the same).

Petitioner asserts that the ’573 patent is “available for Post Grant Review” and “is subject to the post-AIA provisions of the Patent Statute.” Pet. 2, 10. Specifically, the ’573 patent was filed on July 22, 2014, and claims priority to a Japanese application filed July 22, 2013, both dates falling after March 16, 2013. *Id.* at 10; Ex. 1001, (22), (30). Also, the Petition was filed on February 27, 2018, which is within nine months of the May 30, 2017, issue date of the ’573 patent. Ex. 1001, (45); Pet. 2. On this record, we determine that the ’573 patent is eligible for post-grant review.

## II. ANALYSIS

### A. Claim Construction

In a post-grant review, a claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears. 37 C.F.R. § 42.200(b); *see also* *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016). Under the broadest reasonable construction standard, claim terms are generally given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). However, a “claim term will not receive its ordinary meaning if the patentee acted as his own lexicographer

and clearly set forth a definition of the disputed claim term in either the specification or prosecution history.” *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002).

Petitioner proposes constructions for the claim term “incentive,” and for the claimed concepts of “enabling invitation” and “detecting access.” Pet. 19–24 (citing Exs. 1001, 1003). Patent Owner disputes Petitioner’s positions. Prelim. Resp. 27–35 (citing Exs. 1001, 2001).

1. “*incentive*”

Each independent claim recites that first and second incentives are given to a first player upon satisfaction of certain claimed conditions. *See* Ex. 1001, claims 1, 6, 8–11. For example, independent claim 9 recites that a program provides an incentive-giving function that, “responsive to said detecting [when the second terminal device accesses the landing screen], gives a first incentive to the first player” and “gives a second incentive to the first player when the second player registers.” *Id.* at 17:39–46.

Petitioner contends that although the “plain meaning of ‘incentive’ is ‘thing that motivates or encourages one to do something,’” that meaning should be discounted, in this case, because the ’573 patent uses the term differently. Pet. 19–20 (citing Ex. 1003, 3). According to Petitioner, the ’573 patent “does not disclose informing the player of incentives prior to the invitation step, nor is an informing step recited in the claims.” *Id.* at 20. Thus, Petitioner contends that the first player “is not more motivated or ‘incentivized’ to invite others” because he does not know of any incentive for doing so. *Id.* Rather, “what the ’573 patent refers to as ‘incentives’ are instead rewards absent such knowledge: ‘a thing given in recognition of one’s service, effort, or achievement.’” *Id.* (citing Ex. 1003, 4). Petitioner

also alleges that the claimed incentives could be *anything*. *Id.* Thus, Petitioner contends that “the BRI of ‘incentive’ is a reward provided to a player in exchange for meeting a condition.” *Id.*

Patent Owner disagrees. Prelim. Resp. 28. First, Patent Owner argues that the Petition is legally deficient because it does not demonstrate the appropriate level of skill in the art. *Id.* at 29–30. Without such information, Patent Owner alleges that Petitioner cannot assert how a person of ordinary skill in the art would have understood “incentive,” in the context of the ’573 patent. *Id.* Patent Owner also argues that Petitioner’s position that incentives require prior knowledge is unfounded attorney argument and inconsistent with the specification. *Id.* at 30.

Patent Owner also contends that the specification is clear that an “incentive” is something like a coin or precious item “that can be used to play the social game more favorably.” *Id.* at 31–32 (citing Ex. 1001, 1:27–28, 1:67–2:3, 8:52–55, 12:5–10; Ex. 2001 ¶ 29). According to Patent Owner, the claims themselves identify when each incentive is given, such that the “in exchange for meeting a condition” portion of Petitioner’s construction is unnecessary. *Id.* at 33–34.

We are not persuaded by Petitioner’s position. We start with the claim language. Patent Owner is correct that each claim specifies the conditions upon which the incentives are given. *Id.* For example, claim 9 specifies that the first incentive is given “responsive to said detecting [access to the landing screen],” and the second incentive is given “when the second player registers as a member of a provider.” Ex. 1001, 17:39–46. Thus, on this record, we are persuaded that the “in exchange for meeting a condition” portion of Petitioner’s construction is redundant.

We also are not persuaded that the specification uses “incentive” differently from its proffered plain meaning as “a thing that motivates or encourages one to do something,” or that the claimed incentives could be *anything*, as Petitioner argues. *See* Prelim. Resp. 19–20; Ex. 1003, 3. For example, in describing the prior art, the specification states that, “the player transmitting [] invitation mail will get a predetermined incentive[, which] may be a coin or precious item[] such as a rare item that can be used in the social game. That is, the player can play the social game favorably” with the item given as an incentive. Ex. 1001, 1:63–2:3. Thus, the specification explains that the coin or item is given to motivate or encourage the player to transmit invitation mail. *See also id.* at 2:7–10 (explaining that the number of players participating in the game will increase due to the transmission of invitation mail). The specification also explains that the incentive is beneficial to the user in playing the game. *Id.* at 1:63–2:3.

Likewise, in describing the invention, the specification states that “the first incentive is given” when a specified event occurs, e.g., “when an access is made to the landing screen V1 based on the invitation message. This can increase a coin, an item or the like in the game of the player.” *Id.* at 12:7–11. Similar descriptions are provided for the second and third incentives given to the first player. *Id.* at 12:45–47, 13:10–13. Again, the specification describes these incentives as things given to motivate or encourage preferred behavior, e.g., the first player sending an invitation message through which a second user can access a landing screen, register as a member with the provider, and register as a player in the game. And again, these incentive are described as useful in playing the game. *See also id.* at 3:42–47; Ex. 2001 ¶¶ 29 (Mr. Crane testifying that “[i]n social gaming, players

typically accumulate ‘virtual goods’ – assets [that] have no real-world existence, but are useful in some way within the game context”), 14–18 (describing gaming referral reward structures).

We are unpersuaded by Petitioner’s position that, in the context of the ’573 patent, a player “is not more motivated or ‘incentivized’ to invite others” because he does not know of any incentive for doing so. Pet. 20. First, Petitioner provides no evidence in support of this argument. As Patent Owner correctly notes, Petitioner does not identify the appropriate level of ordinary skill in the art, and does not provide any basis for us to conclude that this opinion would be held by an ordinarily skilled artisan. Prelim. Resp. 29–30. “Attorney’s argument in a brief cannot take the place of evidence.” *Cf. In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974).

Second, this position is inconsistent with the intrinsic record. The ’573 patent specification explains that “[p]layers may be informed of the number of times of incentives given or their contents by a predetermined method, whereby the players can be encouraged to transmit invitation messages.” Ex. 1001, 14:10–13. Thus, the specification *does* describe that players are informed of the incentives available for referring other users to the game. *Contra* Pet. 20 (“The ’573 patent does not disclose informing the player of incentives prior to the invitation step.”).

And finally, the only extrinsic evidence of record on this point—the Crane Declaration—discredits Petitioner’s argument. Mr. Crane testifies that “the quality and frequency” of incentives and the “increased reward-to-effort ratio,” as disclosed in the ’573 patent, incentivize behavior. *See* Ex. 2001 ¶¶ 20, 21; *see also id.* at ¶¶ 19 (“[B]ehavior can be incentivized either through promise or reward.”), 24 (“By applying dynamically-

changing separate incentive limits to the three incentive-earning events over a predetermined duration, a player is given to understand that additional invitations may be rewarded”). Therefore, in light of unrebutted testimony that, for example, a series of incentives associated with the same action (i.e., sending an invitation) can motivate behavior, we are not persuaded by Petitioner’s unsupported argument that prior knowledge is required.

On the record before us, we are persuaded that the ’573 specification uses the term “incentive” in a manner consistent with its plain meaning of “a thing that motivates or encourages one to do something.” Ex. 1003, 3. The evidence also makes clear that the incentive has value only in the context of the social game. *See* Ex. 1001, 1:63–2:3 (“that can be used in the social game”), 12:7–11 (“in the game”); Ex. 2001 ¶ 29 (“useful in some way within the game context”). Thus, for purposes of this Decision, we construe “incentive” as a thing that can be used to play the social game more favorably, which thereby motivates or encourages action.

## 2. “enabling invitation”

Each independent claim recites a limitation related, in some form, to “enabling invitation information” to be sent from a first terminal device to a second terminal device. *See* Ex. 1001, claims 1, 6, 8–11. For example, independent claim 9 recites that a program provides an incentive giving function that “enables a first player who operates a first terminal device to send invitation information to a second player who operates a second terminal device.” *Id.* at 17:32–38.

Petitioner contends that the plain meaning of “enabling” is to give a means of doing something,” and that this plain meaning should apply because “enabling” is not defined in the ’573 patent specification. Pet. 21–

22 (citing Ex. 1003, 2). According to Petitioner, “no steps precede the transmission of the invitation by the player . . . . ‘Enabling’ such an action by the server device is not described.” *Id.* at 21 (citing Ex. 1001, 9:20–21, 11:18–22, Fig. 7). Petitioner contends that “the invitation step is disclosed by the specification as user input commanded by [the] player; the computer merely executes the command.” *Id.* at 22 (citing Ex. 1001, 9:11–29).

Patent Owner disputes the relevance of the cited dictionary definition, and argues that extrinsic evidence should not be considered. Prelim. Resp. 34–35. Patent Owner also identifies portions of the ’573 patent specification that it contends demonstrate that home screen V3 enables the first player to send the invitation information from the first terminal device. *Id.* at 35, 62–63 (citing Ex. 1001, 9:60–65, 10:41–45, Fig. 5; Ex. 2001 ¶ 26).

We have reviewed the cited evidence and determine that the specification is consistent with the plain meaning of “enable” provided by Petitioner.<sup>3</sup> The ’573 patent describes management range T1 and external service S1, which, respectively, provide for communications within the

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<sup>3</sup> We note Patent Owner’s argument that extrinsic evidence should not be considered. Prelim. Resp. 34–35. In this case, we deem consideration of extrinsic evidence to be permissible. *See, e.g., Helmsderfer v. Bobrick Washroom Equip., Inc.*, 527 F.3d 1379, 1382 (Fed. Cir. 2008) (“When the intrinsic evidence is silent as to the plain meaning of a term, it is entirely appropriate . . . to look to dictionaries . . . to aid in arriving at the plain meaning of a claim term.”); Manual of Patent Examining Procedure 2111.01(II) (R-08.2017) (“MPEP”) (“Any meaning of a claim term taken from [extrinsic evidence] must be consistent with the use of the claim term in the specification and drawings. Moreover, when the specification is clear about the scope and content of a claim term, there is no need to turn to extrinsic evidence for claim interpretation.”) (citing *3M Innovative Proprs. Co. v. Tredegar Corp.*, 725 F.3d 1315, 1326–28 (Fed. Cir. 2013)).

game platform and outside of the game platform. *See* Ex. 1001 9:60–65, 10:4–12. Landing screen V1, platform screen V2, and home screen V3 are displayed by the server device and “are associated with each other in a management range T1 of the provider.” *Id.* at 9:50–60, Fig. 5. The patent explains that “[first] player A1 operates the terminal device 2 to use the external service S1 through the home screen V3 of the aforementioned game, thus transmitting an invitation message to the terminal devices 2 operated by his/her friends.” *Id.* at 10:41–45, 11:18–22 (sending an invitation message “via the external service S1 outside of the management range T1”), Fig. 5.

Thus, on this record, we agree with Patent Owner that home screen V3 enables the first player to send invitation information to other users via external service S1, i.e., home screen V3 “give[s] a means of” sending invitation information (Ex. 1003, 2). This is consistent with Mr. Crane’s testimony. Ex. 2001 ¶ 26 (“One of ordinary skill in the art would understand that the home screen element V3 serves to enable the sending of said invitation through the operation of the first terminal device.”). This, however, is also consistent with Petitioner’s position.

Accordingly, for purposes of this Decision, we accept the plain and ordinary meaning of “enable” proposed by Petitioner.

### 3. “*detecting access*”

Each independent claim recites a limitation related, in some form, to “detecting access.” *See* Ex. 1001, claims 1, 6, 8–11. For example, independent claim 9 recites that a program provides an incentive giving function that “detects when the second terminal device is operated to access the landing screen.” *Id.* at 17:39–41.

Petitioner contends that the plain meaning of “‘detecting’ is to discover the presence of,” and that this plain meaning should apply because “detecting” is not defined in the ’573 patent specification. Pet. 22–24 (citing Ex. 1003, 1). According to Petitioner, the second terminal device, not the server, determines whether the URL is clicked in order to access the landing screen, and the server only obtains a tracking code. *Id.* at 23. Thus, Petitioner argues that “the specification does not disclose how the server device would ‘detect’ the second terminal device access.” *Id.* (citing Ex. 1001, 11:48–55, 11:63–12:6).

Patent Owner again disputes the relevance of the cited dictionary definition. Prelim. Resp. 34–35. Additionally, Patent Owner identifies portions of the ’573 patent specification that it contends demonstrate that the server device detects that the second terminal device accessed the landing screen by obtaining a tracking code associated with the URL. *Id.* at 35, 63–65 (citing Ex. 1001, 9:43–49, 11:63–12:6; Ex. 2001 ¶ 28).

We have reviewed the cited evidence and determine that the specification is consistent with the plain meaning of “detect” provided by Petitioner. The ’573 patent explains that the invitation message sent to a second user “contains URL (specific information) to specify a landing screen (page) V1 . . . . [Also, the] URL to specify V1 contains tracking code (identification information)” that identifies the first player from whom the invitation message was sent. Ex. 1001, 9:29–38. Thus, the ’573 patent explains that the URL (1) allows the second user to access landing screen V1, and (2) includes tracking code information about the sender. *Id.*

Upon receipt of the invitation, the second user “is allowed to visually identify (view) the contents of the invitation to the game and the URL.” *Id.*

at 11:38–40. Then, the second user determines whether to click on the URL. *Id.* at Fig. 7 (ST503). If the second user does click on the URL, “the second terminal device accesses the landing screen V1. . . . *In response to the access to the landing screen V1, the server device 100 acquires a tracking code . . . included in the invitation message.*” *Id.* at 11:49–55, 11:63–12:4 (emphasis added), 9:43–49 (“the server device 100 can obtain the tracking code”). Thus, the specification explains that server device 100 obtains the tracking code included in the URL, in response to the second user accessing landing screen V1, i.e., the server device “discover[s] the presence of” the tracking code and, necessarily, that the second user has accessed the landing screen (Ex. 1003, 1). This is consistent with Mr. Crane’s testimony. Ex. 2001 ¶ 28.

To the extent Petitioner argues that the server device is not “detecting” that the second terminal device accessed the landing screen, because the second terminal device is involved in making such a determination (Pet. 23), this argument is unsupported and is inconsistent with the claim language, which does not require that the server device detect access *independently*. Nor do the claims prescribe *how* the server detects access.

Accordingly, for purposes of this Decision, we accept the plain and ordinary meaning of “enable” proposed by Petitioner.

#### *B. 35 U.S.C. § 101*

Petitioner contends that claims 1–11 do not recite patent eligible subject matter under 35 U.S.C. § 101. Pet. 24–50 (citing Exs. 1001–1006). Patent Owner disputes Petitioner’s contentions. Prelim. Resp. 41–59 (citing Exs. 1001–1002, 2001).

### 1. *Relevant Law*

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101.

However, the U.S. Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: “[L]aws of nature, natural phenomena, and abstract ideas” are not patentable. *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S.Ct. 2347, 2354 (2014).

In determining whether a claim falls within the excluded category of abstract ideas, we are guided by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 77–78 (2012)). In accordance with that framework, we first determine whether the claim is “directed to” a patent-ineligible abstract idea. *Id.* at 2356 (“On their face, the claims before us are drawn to the concept of intermediated settlement, i.e., the use of a third party to mitigate settlement risk.”); *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”).

The patent-ineligible end of the spectrum includes fundamental economic practices (*Alice*, 134 S. Ct. at 2357; *Bilski*, 561 U.S. at 611); mathematical formulas (*Flook*, 437 U.S. at 594–95); and basic tools of scientific and technological work (*Benson*, 409 U.S. at 69). Relevant to gaming technologies, the U.S. Court of Appeals for the Federal Circuit has held that claims “directed to rules for conducting a wagering game” are comparable to the fundamental economic practices found to be abstract in *Alice*. *See In re Smith*, 815 F.3d 816, 818 (Fed. Cir. 2016). On the patent-eligible side of the spectrum are physical and chemical processes, such as

curing rubber (*Diamond v. Diehr*, 450 U.S. at 184 n.7 (1981)) and “tanning, dyeing, making waterproof cloth, vulcanizing India rubber, smelting ores,” and a process for manufacturing flour (*Gottschalk v. Benson*, 409 U.S. at 69 (1972)).

If the claim is “directed to” a patent-ineligible abstract idea, we turn to the second step of the *Alice* and *Mayo* framework and consider the elements of the claim, both individually and as an ordered combination, to determine whether the additional elements transform the nature of the claim into a patent-eligible application of the abstract idea. *Alice*, 134 S.Ct. at 2355. This second step is a search for 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.*

## 2. Analysis

Petitioner contends that the claims of the ’573 patent are drawn to an abstract idea. Pet. 34. In some instances, Petitioner identifies the abstract idea as “enabling a player to invite another player to a social game, detecting access to the game, and giving the player ‘incentive’ rewards.” *Id.* (heading), 43, 63.

Petitioner also argues that the claims are directed to generalized steps performed on a computer using conventional computer activity. Pet. 34. Petitioner relies upon its contentions, discussed in Section II.A.1, that the claimed “incentives” lack the ability to motivate a player to invite others, and can be *anything*. *Id.* at 35. Thus, Petitioner contends that the claims do not recite a particular, non-abstract way of achieving the functional results recited by the claims. *Id.*

Petitioner compares these claims to those found to be abstract by the U.S. Court of Appeals for the Federal Circuit, in *Affinity Labs of Texas v. DirecTV, LLC*, 838 F.3d 1253 (Fed. Cir. 2016), *Two-Way Media Ltd. v. Comcast Cable Communications, LLC*, 874 F.3d 1329, 1337 (Fed. Cir. 2017), *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016), *In re TLI Communications LLC Patent Litigation*, 823 F.3d 607 (Fed. Cir. 2016), and *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343 (Fed. Cir. 2015). *Id.* at 34–36. Petitioner contrasts the ’573 patent claims with those deemed non-abstract in *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299 (Fed. Cir. 2016) and *Enfish, LLC v. Microsoft Corporation*, 822 F.3d 1327 (Fed. Cir. 2016). *Id.* at 36–39.

Finally, Petitioner contends that the “scope of the claims of the ’573 patent . . . mirrors what is admitted as prior art, without a technological advance.” *Id.* at 40; *see also id.* at 47 (in the step 2 analysis, arguing “nothing is unconventional about the incentives being given in sequence” because they “operate exactly the same way as the prior art incentives”).

Patent Owner disagrees, arguing that the claims “are not directed to an abstract idea, but rather a specific method of improving gameplay and the recruitment process of such gameplay.” Prelim. Resp. 42. Patent Owner contends that Petitioner fails to consider the claims “in their entirety,” and instead “picks and chooses only fragments of the claim language without viewing the claim as [a] whole.” *Id.* at 44 (citing *Enfish*, 822 F.3d at 1335; *Mayo*, 566 U.S. at 71; *McRO*, 837 F.3d at 1299; *Diamond*, 450 U.S. at 188; *Ex parte Jadran Bandic*, 2018 WL 2113303 (PTAB Apr. 30, 2018)).

For example, Patent Owner argues that Petitioner’s complaint that the patent “claims only results . . . without specifying any ‘process or

machinery’ by which those results would be achieved,” (Pet. 37–38), turns on Petitioner’s choice to ignore (1) “the implicit order” of incentives defined in the claims, (2) other physical components recited in the claims, e.g., a “server device,” “terminal devices,” and various screens (landing, home, platform), and (3) additional functions recited in the claims, e.g., providing a game, transmitting data, and a particular sequence of actions. *Id.* at 44–45, 48–49. According to Patent Owner, this mischaracterizes the claims and oversimplifies the analysis. *Id.* at 45–46. Patent Owner also contends that Petitioner’s reliance on an impermissibly broad construction of “incentive” compounds these issues. *Id.* at 47–48.

Assuming that Petitioner is correct in asserting that “enabling a player to invite another player to a social game, detecting access to the game, and giving the player ‘incentive’ rewards” is an abstract idea, for the reasons set forth above, Petitioner treats the “sequential” nature of giving such incentives as additional to the abstract idea, and analyzes it under step 2 of *Alice*. Pet. 40, 47; *see also id.* at 41–48.

To that end, we are unpersuaded by Petitioner’s argument that providing these sequential incentives, as claimed, was conventional and known in the prior art. Pet. 40, 47. Petitioner provides no evidence, relevant case law, or persuasive argument in support of this contention. As discussed above, Petitioner does not provide testimony from a person of ordinary skill in the art to demonstrate that this subject matter was conventional. Nor does Petitioner cite to contemporaneous prior art to support this argument. Petitioner’s reference to the ’573 patent specification (*id.* at 40 (citing Ex. 1001, 2:1–16)) is unpersuasive, because it did not disclose prior art use of *sequential* incentives. *See* Ex. 1001, 1:63–2:37.

For the foregoing reasons, Petitioner has not demonstrated that any challenged claim is more likely unpatentable than not under § 101.

*C. 35 U.S.C. § 112(a)*

Petitioner contends that claims 1–11 do not satisfy the written description requirement of 35 U.S.C. § 112(a). Pet. 51–58 (citing Ex. 1001). Patent Owner disputes Petitioner’s contentions. Prelim. Resp. 59–66 (citing Exs. 1001, 2001).

*1. Relevant Law*

Whether the written description requirement of 35 U.S.C. § 112(a) has been satisfied “requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). The specification must describe sufficiently an invention understandable to a person of ordinary skill in the art and “show that the inventor actually invented the invention claimed.” *Id.* In other words, a patent applicant must “convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the ‘written description’ inquiry, whatever is now claimed.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991) (emphasis omitted). “Such description need not recite the claimed invention in haec verba but must do more than merely disclose that which would render the claimed invention obvious.” *ICU Med., Inc. v. Alaris Med. Sys., Inc.*, 558 F.3d 1368, 1377 (Fed. Cir. 2009).

## 2. Analysis

### a. “enabling invitation”

Petitioner contends that the ’573 patent specification lacks sufficient written description support for the claim limitations related to “enabling invitation.” Pet. 52. According to Petitioner, the word “enable” does not appear in the specification, and the specification discloses “only the inviting itself, which is done by the player.” *Id.* at 53.

Patent Owner contends that the Petition is legally insufficient because it fails to address the level of ordinary skill in the art and, accordingly, cannot demonstrate that an ordinarily skilled artisan would have found the written description inadequate. Prelim. Resp. 60–61. Patent Owner also identifies portions of the specification it contends are relevant to the “enabling invitation” limitations. *Id.* at 62–63 (citing Ex. 1001, 9:60–65, 10:41–45, Fig. 5; Ex. 2001 ¶ 26).

We are not persuaded by Petitioner’s argument, for many of the same reasons discussed in Section II.A.2. Namely, the ’573 patent specification explains that “[first] player A1 operates the terminal device 2 to use the external service S1 through the home screen V3 of the aforementioned game, thus transmitting an invitation message to the terminal devices 2 operated by his/her friends.” *Id.* at 10:41–45, 11:18–22, Fig. 5. In light of this disclosure, we are persuaded that the specification demonstrates sufficiently that home screen V3 enables the first player to send invitation information to other users. That the specification does not utilize the term “enable,” in describing this process, is not dispositive, because *in haec verba* support is not required. *ICU Med.*, 558 F.3d at 1377.

Moreover, the specification's disclosure in this regard is consistent with the cited testimony of Mr. Crane, who states that "[o]ne of ordinary skill in the art would understand that the home screen element V3 serves to enable the sending of said invitation through the operation of the first terminal device." Ex. 2001 ¶ 26 (citing Ex. 1001, 10:41–45).

Petitioner does not discuss the specification's disclosure of using home screen V3 to invoke external service S1 to send invitation information. And, despite acknowledging that the written description inquiry "is conducted from the standpoint of one of skill in the art at the time the application was filed," *see* Pet. 52, Petitioner does not identify the relevant skill level and does not provide any declarant testimony to support its contention that the specification's written description is insufficient to demonstrate possession, when read by a skilled artisan. We recognize that, for purposes of institution, "a genuine issue of material fact created by [Patent Owner's] testimonial evidence will be viewed in the light most favorable to the petitioner." 37 C.F.R. § 42.208(c). However, in this case, no genuine issue of material fact exists, because Petitioner has offered no credible evidence to support its assertion that written description support is lacking. Petitioner cites only to the '573 patent which, as discussed above, supports Patent Owner's position.

*b. "detecting access"*

Petitioner contends that the '573 patent specification lacks sufficient written description support for the claim limitations related to "detecting access" to the landing screen. Pet. 54. According to Petitioner, the word "detect" does not appear in the specification, and "it appears that *a different*

*device,*” i.e., the second terminal device, not the server, “detects the access and transmits the tracking code to the server.” *Id.* at 55.

As above, Patent Owner contends that the Petition is insufficient because it fails to address the level of ordinary skill in the art. Prelim. Resp. 60–61. Patent Owner also identifies portions of the ’573 patent specification that it contends are relevant to the “detecting access” limitations. *Id.* at 62–63 (citing Ex. 1001, 9:43–49, 11:63–12:6, Ex. 2001 ¶ 28).

We are not persuaded by Petitioner’s argument, for many of the same reasons discussed in Section II.A.3. Namely, the ’573 patent specification explains that when the second user clicks the URL, “the second terminal device accesses the landing screen V1. . . . *In response to the access to the landing screen V1, the server device 100 acquires a tracking code . . . included in the invitation message.*” *Id.* at 11:49–55, 11:63–12:4 (emphasis added); *see also id.* at 9:43–49. Thus, we are persuaded that the specification explains that when a recipient user clicks the URL to access landing screen V1, server device 100 obtains the tracking code included with the URL, and necessarily detects that the landing screen has been accessed by the second terminal device. That the specification does not utilize the term “detect” in describing this process is not dispositive, because *in haec verba* support is not required. *ICU Med.*, 558 F.3d at 1377.

The specification’s disclosure also is consistent with Mr. Crane’s testimony that:

One of ordinary skill in the art would understand that the act of clicking . . . on a URL link to V1 necessarily results in the detection of access, generating a response. Further, the existence of tracking code information contained in the URL to V1 serves

not only to detect access by the second terminal but to also discriminate the identity of the terminal doing the accessing.

Ex. 2001 ¶ 28 (citing Ex. 1001, 9:43–49, Fig. 7).

To the extent Petitioner argues that the server is not “detecting” that the second terminal device accessed the landing screen, because the second terminal device is involved in making such a determination (Pet. 55 (citing Ex. 1001, 11:48–49)), this argument is unsupported and is inconsistent with the claim language, which does not require that the server device detect access *independently*. Nor do the claims prescribe *how* the server detects access.

Again, Petitioner does not provide any declarant testimony to support its contention that the specification’s written description is insufficient to demonstrate possession, when read by a skilled artisan. *See supra*, Section II.C.2.a. As above, no genuine issue of material fact exists, *see* 37 C.F.R. § 42.208(c), because Petitioner has offered no credible evidence to support its assertion that written description support is lacking. Petitioner cites only to the ’573 patent which, as discussed above, supports Patent Owner’s position.

*c. “giving incentives”*

Petitioner contends that the ’573 patent specification lacks sufficient written description support for the claim limitations related to “giving incentives.” Pet. 57. According to Petitioner, “the claim language allows for the incentives to be *anything* given to the player and the manner in which they are given can be *any* manner.” *Id.* at 57–58.

Again, Patent Owner contends that the Petition is insufficient because it fails to present any evidence regarding how a person of ordinary skill in the art would have understood the ’573 patent specification. Prelim.

Resp. 60–61. Patent Owner also argues that Petitioner’s argument is based upon an unreasonably broad interpretation of “giving incentives.” *Id.* at 66.

We are not persuaded by Petitioner’s argument, for many of the same reasons discussed in Section II.A.1. Namely, we do not agree that the incentives may be *anything*, given in any *manner*. Each claim specifies the conditions upon which the incentives are given. For example, claim 9 specifies that the first incentive is given “responsive to said detecting [when the second terminal device is operated to access the landing screen],” and the second incentive is given “when the second player registers as a member of a provider.” Ex. 1001, 17:39–46. Moreover, we are persuaded that the ’573 patent specification uses “incentive” in a manner consistent with its plain meaning of “a thing that motivates or encourages one to do something.” Ex. 1003, 3. As such, for purposes of this Decision, we construe “incentive” as a thing that can be used to play the social game more favorably, which thereby motivates or encourages action.

Petitioner has not provided persuasive evidence to demonstrate that the specification fails to provide adequate written description support for the giving of incentives, as properly construed. Again, Petitioner does not provide any declarant testimony to support its contentions. *See supra*, Section II.C.2.a. As above, no genuine issue of material fact exists, *see* 37 C.F.R. § 42.208(c), because Petitioner has offered no credible evidence to support its assertion that written description support is lacking. Petitioner cites only to the ’573 patent, which supports Patent Owner’s position and the construction discussed above.

For the foregoing reasons, Petitioner has not demonstrated that any challenged claim is more likely unpatentable than not, under 35 U.S.C. § 112(a).

*D. 35 U.S.C. § 112(b)*

Petitioner contends that claims 1–11 do not comply with the definiteness requirement of 35 U.S.C. § 112(b). Pet. 58–63 (citing Ex. 1001). Patent Owner disputes Petitioner’s contentions. Prelim. Resp. 66–68.

*1. Relevant Law*

In reviewing whether a claim is sufficiently definite, we consider whether the claim language is “cast in clear—as opposed to ambiguous, vague, indefinite—terms.” *In re Packard*, 751 F.3d 1307, 1313 (Fed. Cir. 2014); see MPEP 2173.02(II) (advising examiners that the indefiniteness standard is whether “the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement”). Exact precision is not required. The test for determining the question of indefiniteness may be formulated as whether the claims “set out and circumscribe a particular area with a reasonable degree of precision and particularity.” *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971). With regard to the reasonableness standard, one must consider the language in the context of the circumstances. *Packard*, 751 F.3d at 1313.

*2. Analysis*

Petitioner contends that challenged claims 1–11 are indefinite “because the meaning of every term used in the claims and the scope of the claims is not apparent from the face of the claims or from the specification.”

Pet. 60. Specifically, Petitioner alleges that “the claims of the ’573 patent lack sufficient written description support in the specification. As a result, they omit matter essential to the claims and also are indefinite.” *Id.* at 61–63 (arguing it is unclear “how sending the invite is ‘enabled,’” “how detection is performed,” and “the process or manner of awarding the incentives”).

Patent Owner responds that “indefiniteness is a separate and distinct analysis from written description, with the former focusing on the claims, and the latter focusing on the specification.” Prelim. Resp. 67. According to Patent Owner, the Petition “presents no facts from the perspective of the POSITA,” and merely offers unsupported attorney argument. *Id.* at 67–68.

On this record, we agree with Patent Owner. Petitioner provides no independent basis to determine that claims 1–11 are indefinite, aside from its arguments made with respect to the sufficiency of the written description, which we found unpersuasive, and which are directed to different statutory requirements. Moreover, we determine that the Petitioner has not demonstrated that the claims, read in light of the specification by a person of ordinary skill in the art, are not sufficiently clear and precise to satisfy the definiteness requirement of 35 U.S.C. § 112(b). Petitioner neither provides persuasive argument nor provides evidence from a person of ordinary skill demonstrating that the claims would not be sufficiently understood by an ordinarily skilled artisan.

For the foregoing reasons, Petitioner has not demonstrated that any challenged claim is more likely unpatentable than not, under 35 U.S.C. § 112(b).

*E. 35 U.S.C. § 325(d)*

Patent Owner contends that we should exercise our discretion under 35 U.S.C. § 325(d) to deny Petitioner’s 35 U.S.C. § 101 challenge to claims 1–11. Prelim. Resp. 12–23 (citing Ex. 1002). Petitioner appears to disagree. Pet. 30–33 (citing Exs. 1002, 1004–1006).

*1. Relevant Law*

Our discretion as to whether to institute a post-grant review is guided, in part, by 35 U.S.C. § 325(d), which provides: “[T]he Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d); *see generally Cultec, Inc. v. Stormtech LLC*, Case IPR2017-00777 (PTAB Aug. 22, 2017) (Paper 7) (informative), *Hospira, Inc. v. Genentech, Inc.*, Case IPR2017-00739 (PTAB July 27, 2017) (Paper 16) (informative), *Unified Patents, Inc. v. Berman*, Case IPR2016-01571 (PTAB Dec. 14, 2016) (Paper 10) (informative); *see also Neil Ziegmann, N.P.Z., Inc. v. Stephens*, Case IPR2015-01860, slip op. at 6–14 (PTAB Sept. 6, 2017) (Paper 13) (expanded panel) (explaining the rationale and purpose of § 325(d)).

Our discretion under § 325(d) involves a balance between competing interests. *See Hospira*, slip op. at 18. ““On the one hand, there are the interests in conserving the resources of the Office and granting patent owners repose on issues and prior art that have been considered previously.”” *Id.* (quoting *Fox Factory, Inc. v. SRAM, LLC*, Case IPR2016-01876, slip op. at 7 (PTAB Apr. 3, 2017) (Paper 8)). ““On the other hand there are the interests of giving petitioners the opportunity to be heard and correcting any errors by the Office in allowing a patent.”” *Id.*

## 2. Analysis

Patent Owner argues that we should exercise our discretion under § 325(d) and deny Petitioner’s 35 U.S.C. § 101 challenge because the Petition “provides no new evidence and merely reiterates the same § 101 arguments already presented to the Office during prosecution of the ‘573 Patent.” Prelim. Resp. 17; *see also id.* at 12–23. Although the Petition does not address § 325(d) directly, Petitioner argues that the Office’s guidance on subject matter eligibility evolved during the course of prosecution, that the Examiner’s first office action did not cite the Federal Circuit’s decisions in *McRO* or *BASCOM*, and that when the examiner did consider *BASCOM*, the “examiner erred in his application” of the case. Pet. 30–33.

As discussed above, we determine that Petitioner has not met its burden of demonstrating that it is more likely than not to prevail on the merits of its § 101 challenge to claims 1–11, and we deny institution of post-grant review on that basis. *See supra*, Section II.B.2. Thus, we need not determine whether the ground should be denied based on our discretion under § 325(d). *But see* Ex. 1002, 15 (Examiner’s Reasons for Allowance discussing two-step *Alice* test, and applicability of *BASCOM*), 30 (similar Interview Summary), 41–43 (applicant’s discussion of, e.g., *BASCOM*), 51–58, 74–77, 87 (Examiner’s Interview Summary discussing, e.g., *McRO*), 101–102, 114–121 (Examiner’s non-final rejection citing, e.g., 2014 Interim Guidance, July 2015 Update: Subject Matter Eligibility, *Alice*, *Mayo*); *compare* Pet. 30 (arguing that “Examiners had not been instructed to determine whether the patents merely recite ‘generalized steps to be performed on a computer using conventional computer activity,’ as the Federal Circuit’s *Enfish* and *In re TLI Commc’ns* decisions instructed”), *with*

Ex. 1004, 2 (May 19, 2016, USPTO Memorandum—which issued before the Examiner’s August 8, 2016 first office action—informing Examiners of *Enfish* and *In re TLI Communications*, and providing the statement quoted by Petitioner).

### III. CONCLUSION

For the foregoing reasons, we determine that Petitioner has not demonstrated that it is more likely than not that at least one of challenged claims 1–11 of the ’573 patent is unpatentable. Accordingly, we do not institute a post-grant review.

### IV. ORDER

Upon consideration of the record before us, it is:

ORDERED that the Petition is *denied* as to all challenged claims and all asserted grounds, and no trial is instituted.

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Patent 9,662,573 B2

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