

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SUPERCELL OY,
Petitioner,

v.

GREE, INC.,
Patent Owner.

Case PGR2018-00066
Patent 9,873,044 B2

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 1–10 (“challenged claims”) of U.S. Patent No. 9,873,044 B2 (Ex. 1001, “the ’044 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 1–10 of the ’044 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 litigation matters. Pet. 1; Paper 3, 1 (identifying PGR2018-00037, challenging U.S. Patent No. 9,662,573 (“the ’573 patent”), to which the ’044 patent claims priority as a continuation).

C. *The ’044 Patent*

The ’044 patent is entitled “Method For Controlling Server Device, Server Device, Server Device, Computer-Readable Recording Medium and

Game System.” Ex. 1001, (54). The ’044 patent aims to “enhance motivation of a player to invite another player to a social game.” *Id.* at (57).

The ’044 patent identifies the popularity of social games that are “provided from a server device via a communication network to mobile terminals.” *Id.* at 1:20–21. 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 1:64–67. By way of background, the ’044 patent describes scenarios in which 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 2:1–8. However, according to the ’044 patent, because the first player receives an incentive only 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 2:20–31. Thus, “it is difficult to increase the number of players who participate in the social game.” *Id.* at 2:35–40.

Accordingly, the ’044 patent seeks to enhance the motivation of players to invite others to a social game. *Id.* at 2:41–46. 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 4:37–, 15:9–34, Figs. 1–2. The ’044 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 10:1–6 (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 10:12–20 (emphasis added).

Figure 7 of the '044 patent is reproduced below.

FIG. 7

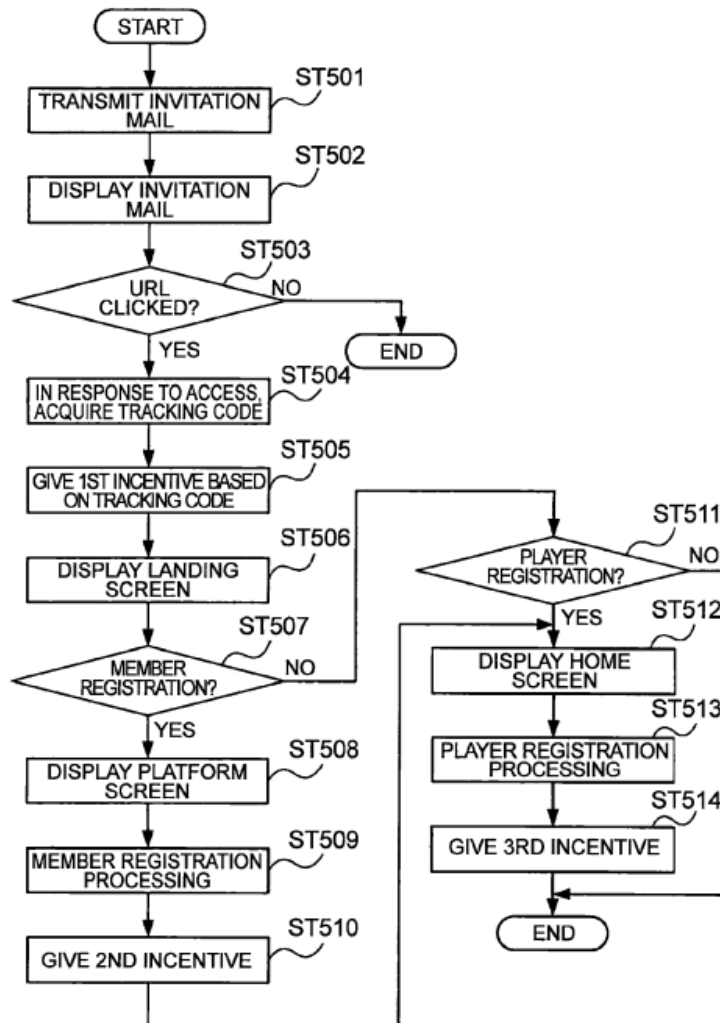


Figure 7 depicts a flowchart illustrating an exemplary process for giving incentives to a first player. *Id.* at 4:9–11.

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 11:26–30. 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 9:37–46. Next, the second user views the invitation (ST502), and determines whether to access the landing screen by clicking the URL (ST503). *Id.* at 11:31–34, 46–48, 56–57. 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 9:51–57, 11:57–63, 11:63–12:1 (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 12:14–23 (emphasis added).

After the landing screen is displayed, the invited second user determines whether to register as a member with the game provider (ST507). *Id.* at 12:23–35. If the second user elects to register, the server displays the appropriate platform screen to allow member registration (ST508–509). *Id.* at 12:36–46; *see also id.* at 12:57–67 (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 12:46–51.

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 13:5–13. If player registration is completed, the server then gives a *third* incentive to the first player (ST514). *Id.* at 13:14–19.

The '044 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 13:64–14:4. Also, the number of times the incentives may be earned may be limited for a predetermined duration. *Id.* at 14:5–8. “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 14:19–22.

D. Illustrative Claim

Of challenged claims 1–10, each of claims 1, 9, and 10 are independent. Claim 10 is illustrative and is reproduced below.¹

10. 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 terminal device to send invitation information to a second terminal device, wherein the invitation information includes specific information to at least specify a landing screen associated with the game;

[b] detects when the second terminal device is operated to access the landing screen on a basis of the specific information; and

¹ Petitioner identifies claim 10 as “representative.” Pet. 13.

[c1] responsive to said detecting, gives a first incentive to a first player who operates the first terminal device; and [c2] gives a second incentive to the first player when a second player who operates the second terminal device participates in the game and achieves a specific matter that is predetermined in the game.

Ex. 1001, 17:16–18:17 (brackets added).

Additionally, independent claim 1 is directed to a “method for controlling a server device,” and independent claim 9 is directed to a “server device.” *Id.* at 16:2–20, 16:66–17:15. 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 1–10 of the ’044 patent on the following grounds (Pet. 11).

Statutory Basis	Claims
§ 101	1–10
§ 112(a)	1–10
§ 112(b)	1–10

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. 2002, the “Crane Declaration”).

F. Eligibility of Patent for Post-Grant Review

The post-grant review provisions of the Leahy-Smith America Invents Act (“AIA”)² 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 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 ’044 patent is “available for Post Grant Review” and “is subject to the post-AIA provisions of the Patent Statute.” Pet. 2, 11. Specifically, the ’044 patent was filed on April 19, 2017, and claims priority to: (1) the ’573 patent, filed on July 22, 2014, and (2) a Japanese application filed on July 22, 2013, wherein all dates fall after March 16, 2013. *Id.* at 10; Ex. 1001, (22), (63), (30). Also, the Petition was filed on June 7, 2018, which is within nine months of the January 23, 2018, issue date of the ’044 patent. Ex. 1001, (45); Pet. 2. On this record, we determine that the ’044 patent is eligible for post-grant review.

II. ANALYSIS

A. *Claim Construction*

In this post-grant review proceeding, filed prior to November 13, 2018, the claims are afforded their broadest reasonable interpretation in light

² Pub L. No. 112-29, 125 Stat. 284 (2011).

of the '044 patent specification. 37 C.F.R. § 42.200(b) (2016); *see also* *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016). Under the broadest reasonable interpretation 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 terms “incentive” and “specific matter,” and for the claimed concepts of “enable invitation” and “detect access.” Pet. 11–23 (citing Exs. 1001, 1003). Patent Owner disputes Petitioner’s positions. Prelim. Resp. 21–32 (citing Ex. 1001).

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, 9, 10. For example, independent claim 10 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 a second player . . . participates in the game and achieves a specific matter that is predetermined in the game.” *Id.* at 18:12–17.

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 '044 patent uses the term

differently. Pet. 18 (citing Ex. 1003, 3). According to Petitioner, the '044 patent “does not disclose informing the player of incentives prior to the invitation step, nor is an informing step recited in the claims.” *Id.* 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 '044 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.* at 19. Thus, Petitioner contends that “the broadest reasonable interpretation of ‘incentive’ is a reward provided to a player in exchange for meeting a condition.” *Id.*

Patent Owner disagrees. Prelim. Resp. 23. First, Patent Owner argues that Petitioner disregards the law applicable to claim construction, as articulated in, e.g., *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005), by improperly focusing on dictionary definitions, rather than looking to the intrinsic record. *Id.* at 23–24. Second, Patent Owner argues that Petitioner’s position that the '044 patent does not disclose informing the first player of the incentives prior to the invitation step is inconsistent with the specification, which explains that “[p]layers may be informed” about the incentives. *Id.* at 24–25 (citing Ex. 1001, 14:19–22). Patent Owner also contends that the specification provides examples of the claimed incentives, which Petitioner disregards, and argues that Petitioner fails to provide any support for its position that the incentive could be anything. *Id.* at 25. Finally, Patent Owner alleges that Petitioner’s proposed construction is unsupported and inconsistent with the dictionary definition of “reward” offered by Petitioner. *Id.* at 25–26.

We are not persuaded by Petitioner’s position. We start with the claim language. Each claim specifies the conditions upon which the claimed incentives are given. For example, claim 10 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 . . . participates in the game and achieves a specific matter.” Ex. 1001, 18:12–17. 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. 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, 2:9–12. 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 2:16–19 (explaining that the number of players participating in the game will increase due to the transmission of invitation mail).

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 12:13–20. Similar descriptions are provided for the second and third incentives

given to the first player. *Id.* at 12:47–56, 13:14–22. 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 incentives are described as useful in playing the game. Ex. 2002 ¶¶ 33 (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 ’044 patent, a player “is not more motivated or ‘incentivized’ to invite others” because he does not know of any incentive for doing so. Pet. 18. First and foremost, this position is inconsistent with the intrinsic record. The ’044 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, 14:19–22. Thus, the specification *does* describe that players are informed of the incentives available for referring other users to the game. *Contra* Pet. 18 (“The ’044 patent does not disclose informing the player of incentives prior to the invitation step.”).

The only extrinsic evidence of record on this point is from Patent Owner—the Crane Declaration—and that evidence is consistent with the intrinsic record. Specifically, Mr. Crane testifies that “the quality and frequency” of incentives and the “increased reward-to-effort ratio,” as disclosed in the ’044 patent, incentivize behavior. Ex. 2002 ¶¶ 24, 25; *see*

also id. ¶ 23 (“[B]ehavior can be incentivized either through promise or reward.”), 28 (“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 the specification’s teachings and unrebutted testimony that a series of incentives associated with the same action (i.e., sending an invitation) can motivate behavior, we are not persuaded by Petitioner’s argument that a player is not informed of, or motivated by, applicable incentives.

On the record before us, we are persuaded that the ’044 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.

Furthermore, when read together with the remainder of the claim language, and in light of the specification, the claimed “incentive” has value only in the context of the social game. *See* Ex. 1001, 2:9–12 (“that can be used in the social game”), 12:18–20 (“in the game”); *see also* Ex. 2002 ¶ 33 (“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. “*specific matter*”

Each independent claim recites that the second incentive is given when a second player “achieves a specific matter that is predetermined in the game.” Ex. 1001, claims 1, 9, 10. Petitioner contends that “‘specific matter’ is defined in the specification only by way of example, such as ‘the player invited reaches a predetermined level.’ . . . A ‘specific matter’ could

therefore be anything.” Pet. 23 (citing Ex. 1001, 14:49–56). Thus, Petitioner contends that this term’s “plain meaning should apply.” *Id.*

Again, Patent Owner argues that Petitioner disregards the law applicable to claim construction by ignoring the specification. Prelim. Resp. 30. Patent Owner argues that the specification provides examples of what is meant by the claimed “specific matter,” and contends that “Petitioner cites to no authority for the proposition that a disclosure in the specification can be disregarded simply because it is presented by way of example.” *Id.* at 30–31. Patent Owner also contends that Petitioner fails to provide any support for its position that “a ‘specific matter’ could therefore be *anything*.” *Id.* at 31–32. Finally, Patent Owner argues that Petitioner fails to explain what the “plain meaning” of this term would be. *Id.* at 32.

We are not persuaded by Petitioner’s position. We start with the intrinsic record. The ’044 patent explains that an incentive may be given to a first player “when the player invited achieves a specific matter that is predetermined in the game (e.g., the player invited reaches a predetermined level, participates in a predetermined event or acquires a predetermined item).” Ex. 1001, 14:51–56. Thus, contrary to Petitioner’s position, the claimed “specific matter” is not *anything*, but is described by reference to specific occurrences or achievements, realized in the context of game play. Petitioner has not shown persuasively that these examples should be discounted when construing this claim term.

Moreover, as Patent Owner notes, Petitioner contends that this term’s “plain meaning should apply,” but fails to identify what that plain meaning should be. Prelim. Resp. 32; Pet. 23. Accordingly, on the record before us, we determine that express construction of this claim term is not necessary,

for purposes of this Decision, to resolve the disputes between the parties. *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999); *see infra* Section II.D.2.

3. “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. Ex. 1001, claims 1, 9, 10. For example, independent claim 10 recites that a program provides an incentive-giving function that “enables a first terminal device to send invitation information to a second terminal device.” *Id.* at 18:5–8.

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 ’044 patent specification. Pet. 19–20 (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 20 (citing Ex. 1001, 9:28–29, 11:26–30, 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 20 (citing Ex. 1001, 9:20–23). Thus, Petitioner contends that “the plain meaning should apply.” *Id.*

Again, Patent Owner argues that Petitioner disregards the law applicable to claim construction by focusing on a dictionary definition, rather than the intrinsic record. Prelim. Resp. 26–27. Patent Owner also recognizes that “enabling invitation” is not a term in the claims. *Id.* at 27. According to Patent Owner, Petitioner fails to discuss the intrinsic record and fails to support its conclusion that “enabling” is not described therein.

Id. Finally, Patent Owner states that, despite advocating that the “plain meaning should apply,” Petitioner fails to explain what that “plain meaning” should be. *Id.* at 28.

We have reviewed the parties’ arguments and the cited evidence, and we determine that the specification is consistent with the plain meaning of “enable” provided by Petitioner. The ’044 patent describes management range T1 and external service S1, which, respectively, provide for communications within the game platform and outside of the game platform. *See* Ex. 1001 10:1–20. 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 9:57–10:1, 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 10:49–53, 11:26–30 (sending an invitation message “via the external service S1 outside of the management range T1”), Fig. 5.

Thus, on this record, we determine 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. 2002 ¶ 30 (“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 as “to give a means of doing something.”

4. “*detecting access*”

Each independent claim recites a limitation related, in some form, to “detecting access.” Ex. 1001, claims 1, 9, 10. For example, independent claim 10 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 18:9–11.

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 ’044 patent specification. Pet. 20–22 (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 22. Thus, Petitioner argues that “the specification does not disclose how the server device would ‘detect’ the second terminal device access.” *Id.* (citing Ex. 1001, 12:7–12, 12:28–31). Accordingly, Petitioner contends that the term’s “plain meaning should apply.” *Id.* at 22.

Again, Patent Owner argues that Petitioner disregards the law applicable to claim construction by focusing on a dictionary definition. Prelim. Resp. 28. Patent Owner also notes that “detecting access” is not a term appearing in the claims. *Id.* Moreover, according to Patent Owner, “Petitioner does not state how the alleged absence of disclosure of ‘detecting’ [in the specification] results in the proposed construction (to use the ‘plain meaning’),” or what the plain meaning should be. *Id.* at 29.

We have reviewed the parties' arguments and the cited evidence, and we determine that the specification is consistent with the plain meaning of "detect" provided by Petitioner. The '044 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, 9:37–46. Thus, the '044 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 11:46–48. 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 12:4–12 (emphasis added), 9:51–57 ("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. 2002 ¶¶ 31–32.

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. 21–22), 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 “detect” proposed by Petitioner as “to discover the presence of.”

B. 35 U.S.C. § 101

Petitioner contends that claims 1–10 do not recite patent eligible subject matter under 35 U.S.C. § 101. Pet. 24–54 (citing Exs. 1001–1009). Patent Owner disputes Petitioner’s contentions. Prelim. Resp. 32–60 (citing Exs. 1001–1002, 2002).

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 (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and basic tools of scientific and technological work (*Gottschalk v. Benson*, 409 U.S. 63, 69 (1972)). Relevant to gaming technologies, 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. 175, 184 n.7 (1981)) and “tanning, dyeing, making waterproof cloth, vulcanizing India rubber, smelting ores,” and a process for manufacturing flour (*Benson*, 409 U.S. at 69).

If we conclude 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.*; *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1369 (Fed. Cir. 2018).

2. Analysis

Petitioner contends that the claims of the '044 patent are drawn to an abstract idea. Pet. 35. 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), 36, 39, 42, 50. Petitioner argues that the claims are directed to generalized steps performed on a computer using conventional computer activity. Pet. 35. 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 35–36. 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 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 (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 35–37. Petitioner contrasts the '044 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 37–40.

Finally, Petitioner contends that the “scope of the claims of the '044 patent . . . mirrors what is admitted as prior art, without a technological advance.” *Id.* at 41, 44–51. Namely, Petitioner contends that “nothing is

unconventional about the incentives being given in sequence,” because they “operate exactly the same way as the prior art incentives.” *Id.* at 50.

Patent Owner argues, *inter alia*, that

Petitioner’s assertion [that sequential incentives is conventional] is mere attorney argument, not evidence. . . . The Federal Circuit recently explained that “[w]hether a particular technology is well-understood, routine, and conventional goes beyond what was simply known in the prior art. The mere fact that something is disclosed in a piece of prior art, for example, does not mean it was well-understood, routine, and conventional.”

Prelim. Resp. 52 (citing *Berkheimer*, 881 F.3d at 1369) (emphasis omitted). According to Patent Owner, the sequential, tiered system of incentives claimed in the ’044 patent “is not conventional and provides a significant advantage over prior approaches in the gaming art.” *Id.* at 54 (also arguing that the prosecution history shows that the challenged claims are distinguishable from the prior art).

Even if we assume that Petitioner is correct in asserting that the claims are directed to an abstract idea—that is, “enabling a player to invite another player to a social game, detecting access to the game, and giving the player ‘incentive’ rewards”—for the reasons set forth above, we still must consider the second step of the *Alice* analysis. Petitioner treats the “sequential” nature of giving such incentives as additional to the abstract idea, and asserts that providing sequential incentives, as claimed, was conventional and known in the prior art. Pet. 44–51; *see also id.* at 41–43. However, on the record before us, we are unpersuaded by Petitioner’s argument.

Petitioner contends that a “referral bonus program is a longstanding commercial practice.” *Id.* at 43 (citing Ex. 1007, 108). Petitioner also contends that giving a second incentive is “directed to a longstanding

commercial activity. For example, referral programs may be conditioned on the length of how long the new customer stays with a referral program.” *Id.* at 43–44 (citing Ex. 1008, 47). However, Petitioner’s cited evidence is unpersuasive, because it does not address whether use of *sequential* incentives, as claimed, was a longstanding, conventional, commercial activity. *See* Ex. 1007, 108 (disclosing a “referral bonus” in which the customer receives a reward to bringing in a new customer); Ex. 1008, 47 (disclosing a referral program that provides incentives to existing customers, and explaining that, in most programs, the reward is given regardless of how long the new customer remains with the firm, which “creates the potential for abuse,” but not disclosing a series of incentives).

Moreover, although Petitioner contends that “nothing is unconventional about the incentives being given in sequence,” Petitioner provides no evidence, relevant case law, or persuasive argument in support of this contention. Pet. 50. For example, 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. *Cf.* Exs. 1007–1008. Petitioner’s references to the ’044 patent specification are unpersuasive, because the ’044 patent specification does not disclose prior art use of *sequential* incentives. Pet. 33–34 (citing Ex. 1001, 2:5–8, 2:25–27, 2:41–46).

Thus, 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 1–10 do not satisfy the written description requirement of 35 U.S.C. § 112(a). Pet. 54–62 (citing Ex. 1001). Patent Owner disputes Petitioner’s contentions. Prelim. Resp. 60–69 (citing Exs. 1001, 2002).

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, 1563–1564 (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 ’044 patent specification lacks sufficient written description support for the claim limitations related to “enabling

invitation.” Pet. 56. According to Petitioner, the word “enabling” does not appear in the specification, and the specification discloses “only the inviting itself, which is done by the player.” *Id.* at 56–57.

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. 62–63. Patent Owner also identifies portions of the specification it contends are relevant to the “enabling invitation” limitations. *Id.* at 65–66 (citing Ex. 1001, 10:1–6, 10:49–53, Fig. 5; Ex. 2002 ¶ 30).

We are not persuaded by Petitioner’s argument, for many of the same reasons discussed in Section II.A.3. Namely, the ’044 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 10:49–53, 11:26–30, 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 “enabling,” 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. 2002 ¶ 30 (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. 55, 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 '044 patent which, as discussed above, supports Patent Owner's position.

b. "detecting access"

Petitioner contends that the '044 patent specification lacks sufficient written description support for the claim limitations related to "detecting access" to the landing screen. Pet. 58. According to Petitioner, the word "detecting" 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 59.

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. 62–63. Patent Owner also identifies portions of the '044 patent specification that it contends are relevant to the "detecting access"

limitations. *Id.* at 66–68 (citing Ex. 1001, 9:51–57, 12:4–13, Ex. 2002 ¶¶ 31–32).

We are not persuaded by Petitioner’s argument, for many of the same reasons discussed in Section II.A.4. Namely, the ’044 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 12:4–12 (emphasis added); *see also id.* at 9:51–57. 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 “detecting” 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

[o]ne 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. 2002 ¶ 32 (citing Ex. 1001, 9:51–57, 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. 59 (citing Ex. 1001, 11:55–12:13)), 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 '044 patent which, as discussed above, supports Patent Owner's position.

c. "giving incentives"

Petitioner contends that the '044 patent specification lacks sufficient written description support for the claim limitations related to "giving incentives." Pet. 61. 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 62.

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 '044 patent specification. Prelim. Resp. 62–63. Patent Owner also argues that Petitioner's argument is based upon an improper interpretation of "giving incentives." *Id.* at 68–69.

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 10

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 a second player . . . participates in the game and achieves a specific matter.” Ex. 1001, 18:12–17. Moreover, we are persuaded that the ’044 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. For example, 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, 2:7–12. 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 2:16–19; Ex. 2002 ¶¶ 33 (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). As such, for purposes of this Decision, we construe “incentive,” as used in the challenged claims, 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 and in light of the specification’s disclosures as summarized in the preceding paragraph. 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 '044 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 1–10 do not comply with the definiteness requirement of 35 U.S.C. § 112(b). Pet. 62–67 (citing Ex. 1001). Patent Owner disputes Petitioner's contentions. Prelim. Resp. 69–71.

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 1–10 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. 64. Specifically, Petitioner alleges that “the claims of the ’044 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 64–66 (arguing it is unclear “how sending the invite is ‘enabled,’” “how detection is performed,” “the process or manner of awarding the incentives,” and “what ‘achieving’ a specific matter entails, or even what a predetermined’ specific matter is or how a specific matter becomes predetermined”).

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. 70. According to Patent Owner, the Petition “presents no facts from the perspective of the POSITA,” and merely offers unsupported attorney argument. *Id.* at 70–71.

On this record, we agree with Patent Owner. With respect to “enabling invitation,” “detecting access,” and “giving incentives,” Petitioner provides no independent basis to determine that claims 1–10 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. With respect to the claimed “specific matter,” as discussed in Section II.A.2, *supra*, the specification gives concrete examples that inform a POSITA’s understanding of this term. Petitioner has not explained persuasively why these examples are insufficient to “set out and circumscribe a particular area with a reasonable

degree of precision and particularity.” *In re Moore*, 439 F.2d at 1235. 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 1–10. Prelim. Resp. 4–16 (citing Ex. 1002). Petitioner appears to disagree. Pet. 29–34 (citing Exs. 1002, 1004–1006, 1009).

As an initial matter, we note that institution or denial of trial is done on a petition-by-petition basis, and that Petitioner also challenges claims under § 112(a) and § 112(b). In any case, however, 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 any of its challenges, under § 101 or otherwise. Accordingly, as we deny institution of post-grant review on that basis, we need not determine whether the petition should be denied based on our discretion under § 325(d).

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 1–10 of the '044 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.

PGR2018-00066
Patent 9,873,044 B2

PETITIONER:

Jennifer R. Bush
jbush@fenwick.com

Michael J. Sacksteder
msacksteder@fenwick.com

PATENT OWNER:

Timothy J. Maier
tjm@maierandmaier.com

Siddhesh V. Pandit
svp@maierandmaier.com

Christopher J. Maier
cjm@maierandmaier.com