

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PRICELINE.COM LLC AND BOOKING.COM B.V.,
Petitioner

v.

DDR HOLDINGS, LLC,
Patent Owner

Case IPR2018-01008
U.S. Patent 9,639,876

**PATENT OWNER'S UPDATED MANDATORY NOTICES
PURSUANT TO 37 C.F.R. § 42.8**

Pursuant to 37 C.F.R. § 42.8(a)(2), Patent Owner, DDR Holdings, LLC provides updated Mandatory Notices in connection with the above-captioned Petition.

I. REAL PARTY-IN-INTEREST

The patent owner is DDR Holdings, LLC.

II. RELATED JUDICIAL OR ADMINISTRATIVE MATTERS

As of the filing date of this notice, related matters are:

A. Litigations Involving the Patent-at-Issue

U.S. Patent 9,639,876 (“the ‘876 Patent”) and two related patents are at issue in the following lawsuits, filed in the United States District Court in and for the District of Delaware on May 2, 2017:

DDR Holdings, LLC v. Priceline.com, LLC, Case No. 1:17-cv-498-ER

DDR Holdings, LLC v. Booking.com B.V., Case No. 1:17-cv-499-ER

DDR Holdings, LLC v. Shopify, Inc., Case No. 1:17-cv-501-ER

The above lawsuits have been consolidated under 1:17-cv-498-ER. In the consolidated matter, the Court held that the patent at issue here and two related patents were patent-eligible under 35 U.S.C. § 101). The matters are currently stayed.

Previous, and now-settled, lawsuits filed at the same time are:

DDR Holdings, LLC v. TicketNetwork, Inc., Case No. 1:17-cv-500-ER

DDR Holdings, LLC v. Travel Holdings, Inc. and Tourico Holidays, Inc.,

Case No. 1:17-cv-502-ER

Previous, and since-resolved, lawsuits filed some years ago are:

DDR Holdings, LLC v. Hotels.com, LLC, 773 F.3d 1245 (Fed. Cir. 2014), *aff'g in part*, 954 F. Supp. 2d 509 (E.D. Tex. 2013). The Federal Circuit affirmed a judgment finding related (parent) patent 7,818,399 not invalid and infringed by WTH Holdings. The Federal Circuit ruled that the patent was not indefinite (under 35 U.S.C. § 112(2)) nor directed to patent-ineligible subject matter (Section 101). The Federal Circuit reversed a judgment finding certain claims of related (parent) patent 6,993,572 valid and infringed, holding certain claims of that patent invalid as anticipated by Digital River prior art because the district court had allegedly misconstrued the claims as requiring a corresponding overall appearance. That limitation is expressly recited in the claims of the present patent.

The above-mentioned district court proceeding originally involved related U.S. Patents 6,629,135, 6,993,572, and 7,818,399, and eventually was styled *DDR Holdings, LLC v. Hotels.com, L.P. et al.*, Case No. 2:06-cv-00042-RG, filed in the United States District Court in and for the Eastern District of Texas.

In 2006, Patent Owner sued six independent companies for infringement of parent U.S. Patents 6,629,135 and 6,993,572. While the case was ongoing, parent U.S. Patent 7,818,399, issued (October 19, 2010), and Patent Owner amended its

complaint to assert that patent against five of the six defendants. Four of six defendants (Expedia, Travelocity, Orbitz, and International Cruise Excursions) settled in Fall 2012, one week or a few weeks before trial. The case proceeded to trial in October 2012 against two non-settling defendants: Digital River, Inc. for infringement of the '572 Patent and National Leisure Group, Inc. (NLG) for infringement of both the '572 and '399 Patents. Allegations of infringement of the '135 Patent were dropped before trial.

Patent Owner received a jury verdict holding the tried claims of the '572 and '399 Patent infringed and not invalid and judgment as a matter of law that the '399 Patent was not invalid based on anticipation or obviousness. The infringement verdict for '399 was against NLG only. The district court denied all post-trial motions seeking to overturn the verdict, *DDR Holdings, LLC, v. Hotels.com, L.P.*, 954 F. Supp. 2d 509 (E.D. Tex. 2013), and entered judgment for Patent Owner. Digital River settled in April 2014, while the case was on appeal.

While the appeal was pending, U.S. Patent 8,515,825 issued (August 20, 2013), and DDR filed the following related lawsuits in the United States District Court in and for the Eastern District of Texas, asserting infringement of the '825 Patent and also alleging infringement of the above-mentioned patents for activity by the respective defendants during the post-trial period:

DDR Holdings, LLC v. World Travel Holdings, Inc., 2-13-CV-00646-JRG

DDR Holdings, LLC v. Digital River, Inc., 2-13-CV-00647-JRG

The Digital River settlement in April 2014 mentioned above, and a last settlement, with NLG and its related company WTH in January 2015, terminated these two cases and the case decided by the Federal Circuit.

B. Proceedings Before the USPTO Involving This or Related Patents

The '876 patent is related to pending application Serial No. 15/582,105 and parent U.S. Patents 6,629,135, 6,993,572, 7,818,399, 8,515,825, and 9,043,228.

The following *inter partes review* proceeding involves a parent patent related to the patent involved here (the same patent upheld by the Federal Circuit):

IPR2018-00482, filed February 6, 2018, reconstituted with Priceline.com LLC and Booking.com B.V. (Petitioners here) as Petitioner, involves U.S. Patent 7,818,399. The PTAB entered a decision instituting this IPR proceeding on August 2, 2018.

The following *inter partes review* proceedings, all filed by Shopify, Inc. as Petitioner, involve this patent or a parent patent related to the patent involved here:

IPR2018-01009, filed May 3, 2018, involving U.S. Patent 9,043,228,

IPR2018-01010, filed May 4, 2018, involving U.S. Patent 8,515,825,

IPR2018-01011, filed May 2, 2018, involving U.S. Patent 9,639,876,

IPR2018-01012, filed May 2, 2018, involving U.S. Patent 9,043,228,

IPR2018-01014, filed May 2, 2018, involving U.S. Patent 8,515,825.

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