

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHOPIFY, INC.,
Petitioner

v.

DDR HOLDINGS, LLC,
Patent Owner

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

**PATENT OWNER'S 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

hereby files its 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. Another Pending IPR Involving the Patent-at-Issue

The '876 Patent is the subject of the following co-pending IPR proceeding:

Shopify, Inc. v. DDR Holdings, LLC, Case IPR2018-01011.

B. Pending Litigations Involving the Patent-at-Issue

The '876 Patent is at issue in the following pending lawsuits, filed in the United States District Court in and for the District of Delaware:

DDR Holdings, LLC v. Priceline.com, LLC et al., 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

These cases have been consolidated under 1:17-cv-498-ER.

C. Terminated Litigations Involving the Patent-at-Issue or Related Patents

The '876 Patent was at issue in the following lawsuits, filed in the United States District Court in and for the District of Delaware, and terminated May 9, 2018:

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

These cases were also consolidated under 1:17-cv-498-ER but have been terminated because the parties have settled.

Related U.S. Patents 6,629,135, 6,993,572, and 7,818,399 were at issue in the following lawsuit, filed in the United States District Court in and for the Eastern District of Texas, now terminated:

DDR Holdings, LLC v. Hotels.com, L.P. et al., Case No. 2:06-cv-00042-RG.

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 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. In disposing of the remaining defendant's appeal (NLG), the Federal Circuit held certain claims of the '572 Patent invalid, while affirming the judgment that the '399 Patent was patent-eligible, sufficiently definite, and infringed. *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014).

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 all of the cases discussed in this section.

D. Proceedings Before the USPTO Involving Related Patents

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

Select of the above-listed related patents are also the subject of the following IPR proceedings:

Priceline.com LLC et al. v. DDR Holdings, LLC - IPR2018-00482 (U.S. Patent 7,818,399)

Shopify, Inc. v. DDR Holdings, LLC - IPR2018-01009 (U.S. Patent 9,043,228)

Shopify, Inc. v. DDR Holdings, LLC - IPR2018-01010 (U.S. Patent 8,515,825)

Shopify, Inc. v. DDR Holdings, LLC - IPR2018-01012 (U.S. Patent 9,043,228)

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