

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHOPIFY, INC., PRICELINE.COM LLC, and BOOKING.COM B.V.,
Petitioners,

v.

DDR HOLDINGS, LLC,
Patent Owner.

Case No.: IPR2018-01011¹
U.S. Patent 9,639,876

**PETITIONERS' CONSOLIDATED REQUEST FOR REHEARING
PURSUANT TO 37 C.F.R. § 42.71(D)**

¹ Priceline.com LLC and Booking.com B.V. filed a petition in IPR2019-00438 and have been joined as petitioners in this proceeding.

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Pursuant to 37 C.F.R. § 42.71(d), Petitioners Shopify, Inc., Priceline.com LLC and Booking.com B.V. (“Petitioners”) respectfully request rehearing of the limited portion of the Patent Trial and Appeal Board’s (“Board”) February 14, 2020 Final Written Decision (“FWD”) (Paper 34) finding that Petitioners failed to prove that dependent claims 7, 8, 17 and 18 of U.S. Patent No. 9,639,876 (“the ’876 patent”) are unpatentable in view of the Digital River Publications.² Petitioners do not seek rehearing of the Board’s other findings, including with regard to dependent claims 4 and 14 or other prior art. Petitioners agree with the Board’s finding that claims 1-3, 5, 11-13 and 15 are unpatentable in view of the Digital River Publications.

I. APPLICABLE STANDARDS

Pursuant to 37 C.F.R. § 42.71(d), a party may request rehearing of a final written decision by the Board. The party requesting rehearing has the burden of showing that the decision from which rehearing is sought should be modified, and “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” 37 C.F.R. § 42.71(d); *Apple Inc., et al. v. Uniloc Luxembourg S.A.*, IPR2017-00225, Paper 31, at 2 (P.T.A.B. Sept. 6,

² “Digital River Publications” refers collectively to Exhibits 1004-1009. (See FWD, at 7.)

2018) (“The burden here, therefore, lies with [the requester] to show we misapprehended or overlooked the matters it requests that we review.”).

II. ARGUMENT

Petitioners request that the Board reconsider the FWD, in part, and find that dependent claims 7, 8, 17 and 18 of the '876 patent are unpatentable in view of the Digital River Publications. Petitioners respectfully submit that the panel majority misapprehended or overlooked Petitioners' showing of unpatentability of these claims in the Petition³ and accompanying expert declaration, which was un rebutted by Patent Owner. Indeed, Administrative Patent Judge (“APJ”) DeFranco’s *dissenting-in-part* opinion states that claims 7 and 17 are unpatentable in view of the Digital River Publications in light of “Petitioner’s *actual* argument and evidence” in the Petition and accompanying expert declaration. (FWD, *dissenting-in-part* opinion, at 8 (italics in original); *see also id.*, at 10 (“I am uncertain as to what more the majority might expect from Petitioner to satisfy claim 7’s ‘hierarchical’ limitation.”) and 11 (finding that Petitioners demonstrated that dependent claims 8, 17 and 18 are unpatentable).)

A. The FWD Correctly Determined that Claims 1-3, 5, 11-13 and 15 of the '876 Patent are Unpatentable in View of the Digital River Publications and Petitioners Demonstrated that Dependent Claims 7 and 17 are Also Unpatentable

³ All references herein to the “Petition” are to the Corrected Petition (Paper 8).

The FWD correctly determined that claims 1-3, 5, 11-13 and 15 of the '876 patent are unpatentable in view of the Digital River Publications. (FWD, at 17-31 and 42.) The FWD held, however, that “Petitioner does not sufficiently address the claim’s requirement that the selectable URLs connect ‘a hierarchical set of additional web pages of the outsource provider website’” as claimed in dependent claims 7 and 17. (*Id.*, at 30-31.)

Contrary to the FWD’s latter holding, and consistent with APJ DeFranco’s *dissenting-in-part* opinion, Petitioners submit that the Petition and accompanying expert declaration also demonstrate that dependent claims 7 and 17 are unpatentable in view of the Digital River Publications.

1. Ground 1 of the Petition Demonstrated that the Digital River Publications Satisfy the “Hierarchical Set of Additional Web Pages” Limitation of Claims 7 and 17

The FWD held that the Digital River Publications satisfy all of the limitations of claim 1, including that “the Digital River Publications describe that the DR SSS brought together manufacturers and dealers to enable them to sell products via the Internet, with DR SSS acting as the recited ‘outsource provider’ by providing an integrated back-end commerce system.” (FWD, at 19-20; *id.* at 21 (holding that “Web pages are served by a server belonging to Digital River,” which was “not disputed by Patent Owner”); *id.* at 26-27 (identifying a Digital River buy page that contains shopping cart functionality (Ex. 1009) as a “composite web page”).) The

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