

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.

IPR2019-00436
Patent 9,043,228 B1

Before CARL M. DEFRANCO, PATRICK M. BOUCHER, and
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

FINAMORE, *Administrative Patent Judge*.

DECISION
Instituting *Inter Partes* Review
and
Granting Motion for Joinder
35 U.S.C. §§ 314, 315(c)

I. INTRODUCTION

Priceline.com LLC and Booking.com B.V. (collectively “Petitioner”) filed a Petition (Paper 3, “Pet.”) requesting *inter partes* review of claims 1, 3, 5, 7–9, 11–13, 15, and 16 of U.S. Patent No. 9,043,228 B1 (Ex. 1001), hereinafter “the ’228 patent.” Pet. 1. Concurrently with its Petition, Petitioner filed a Motion for Joinder (Paper 4, “Mot.”), whereby Petitioner seeks to join the instituted *inter partes* review in *Shopify, Inc. v. DDR Holdings, LLC*, Case IPR2018-01009 (PTAB filed May 3, 2018). Mot. 1.

DDR Holdings LLC, (“Patent Owner”) waived its Preliminary Response. Paper 8, 2. Also, Patent Owner consented to Petitioner’s Motion for Joinder. *Id.*

For the reasons below, we institute *inter partes* review of challenged claims 1, 3, 5, 7–9, 11–13, 15, and 16 of the ’228 patent. We grant Petitioner’s Motion for Joinder and join Petitioner to IPR2018-01009. In view of this joinder, we terminate this present proceeding.

II. BACKGROUND

A. Related Matters

1. Court Proceedings

The parties identify the following three pending court proceedings:

- (1) *DDR Holdings, LLC v. Priceline.com LLC*, No. 1:17-cv-498-ER (D. Del. filed May 2, 2017);
- (2) *DDR Holdings, LLC v. Booking.com B.V.*, No. 1:17-cv-499-ER (D. Del. filed May 2, 2017); and
- (3) *DDR Holdings, LLC v. Shopify, Inc.*, No. 1:17-cv-501-ER (D. Del. filed May 2, 2017).

IPR2019-00436
Patent 9,043,228 B1

Pet. 1–2; Paper 5, 1. According to Patent Owner, these three proceedings are consolidated under No. 1:17-cv-498-ER and are currently stayed.

Paper 5, 1.

The parties also identify the following six court proceedings that are no longer pending:

- (1) *DDR Holdings, LLC v. TicketNetwork, Inc.*,
No. 1:17-cv-500-ER (D. Del. dismissed May 9, 2018);
- (2) *DDR Holdings, LLC v. Travel Holdings, Inc.*,
No. 1:17-cv-502-ER (D. Del. dismissed May 9, 2018);
- (3) *DDR Holdings, LLC v. World Travel Holdings, Inc.*,
No. 2:13-cv-00646-JRG (E.D. Tex. dismissed Mar. 15, 2016);
- (4) *DDR Holdings, LLC v. Digital River, Inc.*, No. 2:13-cv-00647-
JRG (E.D. Tex. dismissed Apr. 14, 2014);
- (5) *DDR Holdings, LLC v. Hotels.com, L.P.*, 954 F.Supp.2d 509
(E.D. Tex. 2013); and
- (6) *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245
(Fed. Cir. 2014).

Pet. 2; Paper 5, 1–4.

2. Office Proceedings

The following twelve proceedings are pending before the Board:

- (1) *Priceline Grp. Inc. v. DDR Holdings, LLC*,
Case IPR2018-00482 (PTAB filed Jan. 16, 2018);
- (2) *Shopify, Inc. v. DDR Holdings, LLC*, Case IPR2018-01008
(PTAB filed May 3, 2018);

- (3) *Shopify, Inc. v. DDR Holdings, LLC*, Case IPR2018-01009 (PTAB filed May 3, 2018);
- (4) *Shopify, Inc. v. DDR Holdings, LLC*, Case IPR2018-01010 (PTAB filed May 4, 2018);
- (5) *Shopify, Inc. v. DDR Holdings, LLC*, Case IPR2018-01011 (PTAB filed May 2, 2018);
- (6) *Shopify, Inc. v. DDR Holdings, LLC*, Case IPR2018-01012 (PTAB filed May 2, 2018);
- (7) *Shopify, Inc. v. DDR Holdings, LLC*, Case IPR2018-01014 (PTAB filed May 2, 2018);
- (8) *Priceline.com LLC v. DDR Holdings, LLC*, Case IPR2019-00435 (PTAB filed Dec. 14, 2018);
- (9) *Priceline.com LLC v. DDR Holdings, LLC*, Case IPR2019-00437 (PTAB filed Dec. 14, 2018);
- (10) *Priceline.com LLC v. DDR Holdings, LLC*, Case IPR2019-00438 (PTAB filed Dec. 14, 2018);
- (11) *Priceline.com LLC v. DDR Holdings, LLC*, Case IPR2019-00439 (PTAB filed Dec. 14, 2018); and
- (12) *Priceline.com LLC v. DDR Holdings, LLC*, Case IPR2019-00440 (PTAB filed Dec. 14, 2018).

Pet. 5–6, Paper 5, 4–5.

The parties also identify the following two reexamination proceedings: (1) *Ex parte DDR Holdings, LLC*, No. 2009-013987 (BPAI 2010); and (2) *Ex parte DDR Holdings, LLC*, No. 2009-013988 (BPAI 2010). Pet. 4–5; Paper 5, 5. The parties further identify U.S. Patent Application Serial No. 15/582,105. Pet. 5; Paper 5, 4. Patent Owner

additionally identifies the following five patents: (1) U.S. Patent No. 6,629,135 B1; (2) U.S. Patent No. 6,993,572 B2; (3) U.S. Patent No. 7,818,399 B1; (4) U.S. Patent No. 8,515,825 B1; and (5) U.S. Patent No. 9,639,876 B1. Paper 5, 4.

B. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability. Pet. 7.

References	Basis	Claims
Loshin ¹	35 U.S.C. § 102(b) ²	1, 3–5, 7–9, 11–13, 15, and 16
Loshin and the InfoHaus Documents ³	35 U.S.C. § 103(a)	1, 3–5, 7–9, 11–13, 15, and 16
Loshin and Moore ⁴	35 U.S.C. § 103(a)	1, 3–5, 7–9, 11–13, 15, and 16

In asserting these grounds of unpatentability, Petitioner relies on a Declaration of Peter Kent (Ex. 1002).

III. ANALYSIS

A. Standing to Request Inter Partes Review

Pursuant to 37 C.F.R. § 42.104(a), Petitioner certifies that the '228 patent is available for *inter partes* review. Pet. 6. Based on the present

¹ Peter Loshin, *Selling Online with . . . First Virtual Holdings Inc.* (1996) (Exs. 1013A–B) (“Loshin”).

² Petitioner asserts Loshin is prior art under 35 U.S.C. § 102(b). Pet. 8.

³ First Virtual Seller Programs web page (June 1997) (Ex. 1014), First Virtual InfoHaus Guide web page (June 1997) (Ex. 1015), and First Virtual InfoHaus HelpMeister (June 1997) (Ex. 1016) (collectively “the InfoHaus Documents”).

⁴ U.S. Patent No. 6,330,575 B1 (Ex. 1010) (“Moore”).

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.