

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

DDR HOLDINGS, LLC,
Patent Owner.

IPR2018-01011
Patent 9,639,876 B1

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

BOUCHER, *Administrative Patent Judge*.

DECISION
Granting Petitioner's Request on
Rehearing of Final Written Decision
37 C.F.R. § 42.71(d)

I. INTRODUCTION

In our Final Written Decision, the Board held that, based on a preponderance of the evidence, Petitioner had shown that claims 1, 3, 5, 11–13, and 15 of U.S. Patent No. 9,639,876 B1 are unpatentable. Paper 34

(“Dec.”), 42–43. The Board additionally held that Petitioner had not shown that claims 4, 7, 8, 14, 17, and 18 are unpatentable. *Id.* Petitioner requests rehearing with respect to claims 7, 8, 17, and 18 solely on Petitioner’s ground that challenges those claims as unpatentable over the Digital River Publications. Paper 35 (“Req. Reh’g”), 1. “Petitioners do not seek rehearing of the Board’s other findings, including with regard to dependent claims 4 and 14 or other prior art.” *Id.*

For the reasons discussed below, we grant Petitioner’s Request for Rehearing, and modify our Final Written Decision accordingly.

II. LEGAL STANDARD

A request for rehearing “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). The burden of showing a decision should be modified on a request for rehearing lies with the party challenging the decision. *Id.*

III. ANALYSIS

In its Rehearing Request, Petitioner highlights certain findings made in the Final Written Decision with respect to independent claim 1 and the disclosure of the Digital River Publications. Req. Reh’g 3–4. Specifically, we found 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 the DR SSS acting as the recited ‘outsource provider’ by providing an integrated back-end commerce system.” Dec. 19–20. In addition, we found that the Digital River Publications teach that the DR SSS,

i.e., the recited outsource provider, causes display of the recited “commerce object information associated with the commerce object . . . , which commerce object includes at least one product available for sale through the computer system of the outsource provider,” at least in part because “the Digital River Publications teach generation and transmission of a second web page to a user in allowing the user to shop for products of another merchant.” *Id.* at 21–23.

Claim 7 depends from independent claim 1 and recites that “the commerce object correlated with the source web page is an electronic catalog listing a multitude of products offered for sale by the merchant through a website of an outsource provider, and wherein the composite web page contains one or more selectable URLs connecting a hierarchical set of additional web pages of the outsource provider website, each pertaining to a subset of the product offerings in the electronic catalog.” Ex. 1001, 28:33–41. In discussing this claim in the Final Written Decision, we stated 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,’ each of which pertains to a subset of product offerings.” Dec. 30. Petitioner disagrees with this characterization of the content of its original Petition and supporting evidence, particularly the Declaration of its witness, Michael I. Shamos, Ph.D. Req. Reh’g 4–11.

According to Petitioner, the Petition “organized its showing of [unpatentability] of claim 7 into two parts corresponding to the claim’s two separate ‘wherein’ clauses.” *Id.* at 4. The Final Written Decision highlighted a perceived deficiency in the Petition’s analysis of the second of those clauses. *See* Dec., dissenting opinion at 7 (“As for the first ‘wherein

clause, the majority appears to find Petitioner’s showing is sufficient.”). With respect to the second “wherein” clause, Petitioner asserts that “[t]he Petition and accompanying expert declaration demonstrated that the Digital River Publications teach a composite web page that displays commerce object information associated with one or more products of the electronic catalog.” Req. Reh’g 7–8. In particular, Petitioner highlights the Petition’s argument that the Digital River Publications disclose that the composite web page can be a buy page, as shown in Exhibit 1009. *Id.* (citing Paper 8 (“Pet.”), 25).

A portion of Exhibit 1009 is reproduced below.



The portion of Exhibit 1009 reproduced above illustrates the structure of the 21 Software Drive web page, notably showing “add to cart,” “view cart,”

“modify cart,” and “check out” links. Ex. 1009. In the context of this drawing, Petitioner specifically contends that “the panel majority overlooked or misapprehended Petitioners’ further showing that the Digital River Publications’ buy page identified above satisfies all of the added elements of the second ‘wherein’ clause of claim 7.” *Id.* at 8. Addressing the hierarchical set of additional web pages highlighted in the Final Written Decision, Petitioner draws our attention to the presence of the “add to cart,” “view cart,” “modify cart,” and “check out” links:

The links *do* connect a hierarchical set of additional pages, namely, pages that are accessed serially by selecting these progressive links within a buy sequence to “add,” “view,” “modify” and “check out,” where each page visited by selecting these links pertains to a subset (e.g., one or more) of the product offerings in the electronic catalog that the user has selected for purchase.

Id. at 9 (citing Pet. 25). Petitioner supports this argument by providing a reference to where it is made in the original Petition, as well as supporting evidence that includes testimony by Dr. Shamos. *See* Pet. 25 (citing Ex. 1009, 1; Ex. 1002 ¶ 107; Ex. 1006, 3–6).

Petitioner’s argument on rehearing is persuasive, particularly under the broadest-reasonable-interpretation standard of claim construction applied in this proceeding. *See* Dec. 12–13 (Final Written Decision noting that, for an *inter partes* review proceeding based on a petition filed prior to November 13, 2018, “the Board interprets claims of an unexpired patent using the broadest reasonable construction in light of the specification of the patent in which they appear”). Petitioner clarifies that the Petition identifies Exhibit 1009’s buy page as corresponding to the “composite web page contain[ing] one or more selectable URLs” recited in the claim and identifies

the “view cart,” “modify cart,” and “check out” pages linked to the “buy” page as corresponding to the recited “hierarchical set of additional pages.” *See* Req. Reh’g 11 (asserting “the Petition demonstrated that the ‘view cart,’ ‘modify cart,’ and ‘checkout’ links satisfy the second ‘wherein’ clause”).

In doing so, Petitioner points us to specific portions of its Petition that we find provide sufficient support for this position. Specifically, the Petition cites to paragraph 107 of Dr. Shamos’s Declaration, and both the Petition and that Declaration cite multiple times to page 1 of Exhibit 1009. *See* Pet. 25; Ex. 1002 ¶ 107. In describing the correspondence to the “hierarchical set of additional pages,” Dr. Shamos testifies that “[t]he buy pages also provide a link (i.e., selectable URL) to a shopping cart, which, as described by the 21 Software Drive website, allows a user to add products to a shopping cart, view a shopping cart, modify a shopping cart, and check out.” Ex. 1002 ¶ 107 (citing Ex. 1009, 1). We credit this testimony, which is unrebutted on the record before us. Indeed, Dr. Shamos’s testimony that a skilled artisan would have understood Exhibit 1009’s sequence of URLs as satisfying the claimed “hierarchical set of additional webpages” is consistent with the manner in which the ’876 patent itself describes its shopping cart functionality—namely, as nothing more than the ability to “ADD TO CART,” “VIEW SHOPPING CART,” “UPDATE QUANTITIES,” and “CHECK OUT.” Ex. 1001, Fig. 22.

Petitioner thus demonstrates that the buy page shown in Exhibit 1009, i.e., the recited “composite web page,” contains one or more selectable URLs connecting the “view cart,” “modify cart,” and “check out” pages to the buy page, i.e., the recited “hierarchical set of additional web pages,” as required by the claim. Because each of those pages “pertain[s] to a subset of

the product offerings in the electronic catalog,” such as those selected for purchase, Petitioner demonstrates, by a preponderance of the evidence, that each limitation of the second “wherein” clause of claim 7 is met by the Digital River Publications.

Claim 8 depends from claim 7 and recites “automatically with the computer system, (i) using search parameters inputted at the visitor computing device to search for specific products within the catalog, and (ii) serving to the visitor computing device additional instructions directing the visiting computing device to display the results of the search.” Ex. 1001, 28:42–48. Because of the dependence from claim 7, the Board did not specifically address Petitioner’s reasoning as applied to this claim in the Final Written Decision. Dec. 30 (“Claim 8 depends from claim 7, and Petitioner’s showing is accordingly similarly deficient.”).

In addressing this limitation, the Petition observes that the Corel website shown in Exhibit 1007 “provided a structured search that allowed a user to search for software by product, platform, or program.” Pet. 26. Dr. Shamos provides testimonial support for Petitioner’s contention that a person of ordinary skill in the art would have understood the Digital River Publications to disclose a search engine as part of a web storefront for product searching. *Id.*; Ex. 1002 ¶ 108. Dr. Shamos also provides support for Petitioner’s assertion that “[n]ormal operation of a search engine in the eyes of a [person of ordinary skill in the art] would provide search results as required by the second clause of Claim 8.” Pet. 26; Ex. 1002 ¶ 108. We credit this support, which is sufficient for these limitations. We accordingly conclude that Petitioner makes a sufficient showing with respect to claim 8.

Claims 17 and 18 depend from claim 11 and otherwise include limitations that generally parallel the limitations recited in claims 7 and 8. Ex. 1001, 30:15–30. Petitioner’s arguments are thus persuasive also with respect to these claims, and we accordingly conclude that Petitioner makes a sufficient showing with respect to these claims.

IV. CONCLUSION

In light of these considerations, we modify our Final Written Decision to make the following conclusions.¹

Claims	35 U.S.C. §	Reference(s)	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1–5, 7, 8, 11–15, 17, 18	103(a)	Digital River Publications	1–3, 5, 7, 8, 11–13, 15, 17, 18	4, 14
1–5, 7, 8, 11–15, 17, 18	102(a)	Moore		1–5, 7, 8, 11– 15, 17, 18
1, 7, 11, 17	103(a)	Moore and Arnold		1, 7, 11, 17
1–5, 7, 8, 11–15, 17, 18	103(a)	Moore and the Digital River Publications		1–5, 7, 8, 11– 15, 17, 18
Overall Outcome			1–3, 5, 7, 8, 11–13, 15, 17, 18	4, 14

¹ Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this decision, we draw Patent Owner’s attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. See 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. See 37 C.F.R. §§ 42.8(a)(3), (b)(2).

V. ORDER

It is

ORDERED that Petitioner's Request for Rehearing is *granted*;

FURTHER ORDERED that, based on a preponderance of the evidence, claims 1–3, 5, 7, 8, 11–13, 15, 17, and 18 of U.S. Patent No. 9,639,876 B1 have been shown to be unpatentable; and

FURTHER ORDERED that parties to this proceeding seeking judicial review of our decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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PETITIONER:

Michael McNamara
mmcnamara@mintz.com
William Meunier
wameunier@mintz.com
Peter Snell
pfsnell@mintz.com

PATENT OWNER:

Louis Hoffman
donald@valuablepatents.com
Justin Lesko
justinlesko@patentit.com
Ian Crosby
icrosby@susmangodfrey.com