

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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UNIFIED PATENTS INC.,  
Petitioner,

v.

DRAGON INTELLECTUAL PROPERTY, LLC,  
Patent Owner.

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Case IPR2014-01252  
Patent 5,930,444

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Before GREGG I. ANDERSON, STACEY G. WHITE, and J. JOHN LEE,  
*Administrative Patent Judges.*

WHITE, *Administrative Patent Judge.*

FINAL WRITTEN DECISION  
*35 U.S.C. § 318(a) and 37 C.F.R. § 42.73*

## I. INTRODUCTION

Unified Patents Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1, 2, 7, 8, 10, 13, and 14 of U.S. Patent No. 5,930,444 (Ex. 1001, “the ’444 patent”). Paper 1 (“Pet.”). Dragon Intellectual Property, LLC (“Patent Owner”) filed a Preliminary Response. Paper 14. As we authorized in Paper 15, Petitioner filed a Reply Brief. Papers 18, 20. Based on our review of these submissions, we instituted *inter partes* review of claims 1, 2, 7, 8, 10, 13, and 14 of the ’444 patent on the proposed ground of unpatentability under 35 U.S.C. § 103 over Goldwasser<sup>1</sup> and Ulmer<sup>2</sup>.

After institution, Patent Owner filed a Patent Owner’s Response (Paper 47, “PO Resp.”), and Petitioner filed a Reply (Paper 51, “Reply”). An oral hearing was conducted October 13, 2015. A transcript of the oral hearing is included in the record. Paper 57 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73 as to the patentability of claims 1, 2, 7, 8, 10, 13, and 14. For the reasons discussed below, Petitioner has demonstrated by a preponderance of the evidence that claims 1, 2, 7, 8, 10, 13, and 14 are unpatentable.

### A. *Related Proceedings*

Petitioner indicates that Patent Owner has asserted the ’444 patent in ten district court cases in the District of Delaware. Pet. 4. In addition, the ’444 patent is at issue in IPR2015-00499, which is pending. PO Resp. 1.

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<sup>1</sup> U.S. Patent No. 5,241,428, filed Mar. 12, 1991, issued Aug. 31, 1993 (“Goldwasser”) (Ex. 1005).

<sup>2</sup> PCT Pub. WO 89/12896, published Dec. 28, 1989 (“Ulmer”) (Ex. 1018).

*B. The '444 Patent (Ex. 1001)*

The '444 patent discusses disadvantages in regards to known video cassette recorders' ("VCRs") inability to record and playback simultaneously. Ex. 1001, 1:47–2:35. The '444 patent notes that a person may encounter interruptions such as telephone calls while viewing a program. *Id.* at 1:47–49. The '444 patent explains that known VCRs allow a user to record the portion of the program starting at the time of the interruption for later viewing. *Id.* at 1:50–58. Such VCRs, however, did not allow the user to watch immediately the remainder of the program from the point of the interruption to the end of the program. *Id.* at 1:50–2:14.

The '444 patent addresses these issues with an audiovisual recording and playback device that provides substantially simultaneous recording and playback, allowing user-controlled programming delay. *Id.* at Abstract. An embodiment of such a recording and playback device is depicted in Figure 3 of the '444 patent, reproduced below.

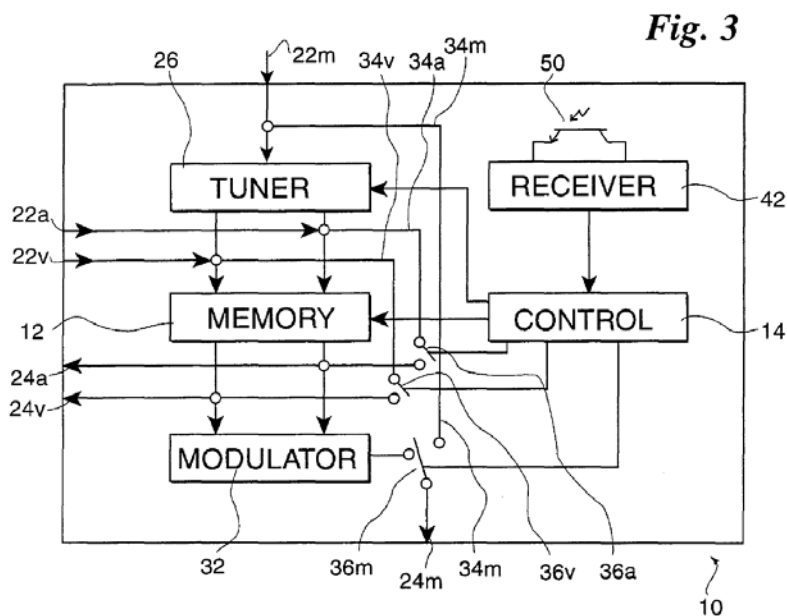
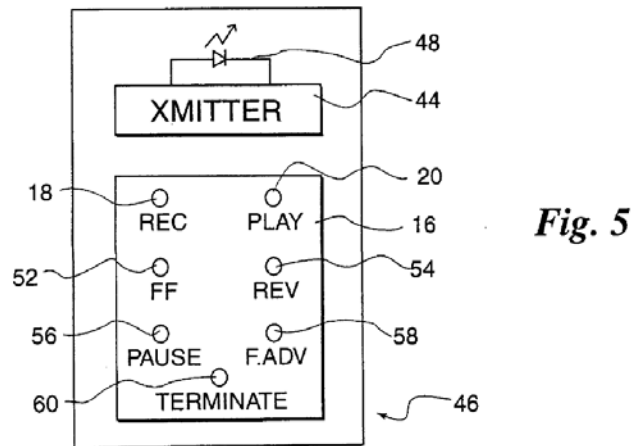


Figure 3 depicts recorder 10 and its components, including memory unit 12; control circuit 14; inputs 22a, 22v, and 22m; outputs 24a, 24v, and 24m; tuner 26; modulator 32; and receiver 42. *Id.* at 3:54–64, 4:35–53, 4:59–5:4, 6:7–18. An embodiment of a remote control unit for use with recorder 10 is depicted in Figure 5, reproduced below.



*Fig. 5*

Figure 5 shows remote control unit 46 and its components, including keyboard 16 and transmitter 44. *Id.* at 6:7–12, 6:25–28. Transmitter 44 of remote control unit 46 and receiver 42 of recorder 10 provide communication between remote control unit 46 and recorder 10. *Id.* at 6:8–19, 6:25–28. Keyboard 16 has a number of keys, including record key 18 and playback key 20. *Id.* at 3:65–67.

A user may actuate record key 18, for example, when a telephone call interrupts a program. *Id.* at 5:20–24. In response, control circuit 14 begins storing within memory unit 12 information received via input 22. *Id.* at 5:24–25. When the interruption ends, the user may actuate playback key 20. *Id.* at 5:25–27. In response, the system retrieves and displays the recorded information, starting from the point of the interruption, while simultaneously continuing to store information from input 22. *Id.* at 5:25–36.

*C. Illustrative Claim*

Petitioner challenges claims 1, 2, 7, 8, 10, 13, and 14 of the '444 patent. Claims 1 and 14 are independent. Claims 2, 7, 8, 10, and 13 depend, directly or indirectly, from claim 1. Claim 1 is illustrative and is reproduced below:

1. A recording and playback apparatus for the substantially immediate and seamless resumption of interrupted perception of broadcast<sup>3</sup> program information based upon audio or video signals, or both, without missing the program information presented during the interruption, comprising:
  - means for powering the apparatus;
  - a keyboard having a record key and a playback key;
  - a control circuit coupled responsively to said keyboard;
  - a memory unit coupled responsively to said control circuit, said memory unit having a medium for storage of information, said storage medium having structure which enables substantially random access to information stored in said medium for retrieval of the stored information from said storage medium;
  - at least one input, said input being connected to a user's audio/video program signal source and also being coupled to said memory unit so as to enable program information presented by the signal source to be transferred to and stored in said memory unit; and

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<sup>3</sup> A Certificate of Correction was issued March 5, 2013, replacing "perception of program information" with "perception of broadcast program information." Ex. 1001, 14.

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