

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.,
Petitioner,

v.

DRAGON INTELLECTUAL PROPERTY, LLC,
Patent Owner.

Case IPR2014-01252
Patent 5,930,444

Before NEIL T. POWELL, GREGG I. ANDERSON, and
J. JOHN LEE, *Administrative Patent Judges*.

POWELL, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Unified Patents Inc. (“Petitioner” or “Unified Patents”) 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 14.¹ As we authorized in Paper 15, Petitioner has filed a Reply Brief. Papers 18, 20.² We have jurisdiction under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

We determine that the information presented in the Petition and supporting evidence shows that there is a reasonable likelihood that Petitioner would prevail with respect to its challenge to claims 1, 2, 7, 8, 10, 13, and 14 of the ’444 patent. Accordingly, we institute an *inter partes* review of claims 1, 2, 7, 8, 10, 13, and 14 of the ’444 patent.

¹ Patent Owner filed a redacted, public version (Paper 14) and an unredacted, confidential version (Paper 10) of its Preliminary Response, as well as public and confidential versions of many of the exhibits associated with the Preliminary Response. We have considered all of the information in both versions of the Preliminary Response and associated exhibits. In this Decision, we cite to the public version (Paper 14) of the Preliminary Response. The confidential version (Paper 10) currently remains under seal.

² Petitioner filed two versions of its Reply Brief. Paper 18 is an unredacted, confidential version of the Reply Brief. Paper 20 is a redacted, public version of the Reply Brief. We have considered all of the content in both versions of Petitioner’s Reply Brief. In this Decision, we cite to the public version (Paper 20). The confidential version (Paper 18) currently remains under seal.

A. *Related Proceedings*

Petitioner indicates that Patent Owner has asserted the '444 patent in ten district court proceedings in the District of Delaware, and that Petitioner is not a party to any of those district court proceedings. Pet. 4.

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

The '444 patent discusses perceived disadvantages with known video cassette recorders ("VCRs") that lacked the ability to record and play back simultaneously. *Id.* at col. 1, l. 47–col. 2, l. 35. The '444 patent notes that a person watching a program may encounter interruptions like telephone calls. *Id.* at col. 1, ll. 47–49. The '444 patent explains that known VCRs would allow a user to record the portion of the program that occurs during such an interruption for later viewing. *Id.* at col. 1, ll. 50–58. The '444 patent further explains, however, that such VCRs 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 col. 1, l. 50–col. 2, l. 14.

The '444 patent addresses these perceived problems with an audiovisual recording and playback device that can provide substantially simultaneous recording and playback, allowing user-controlled programming delay. *Id.* at Abst. The '444 patent shows one embodiment of such a recording and playback device in Figure 3, reproduced below.

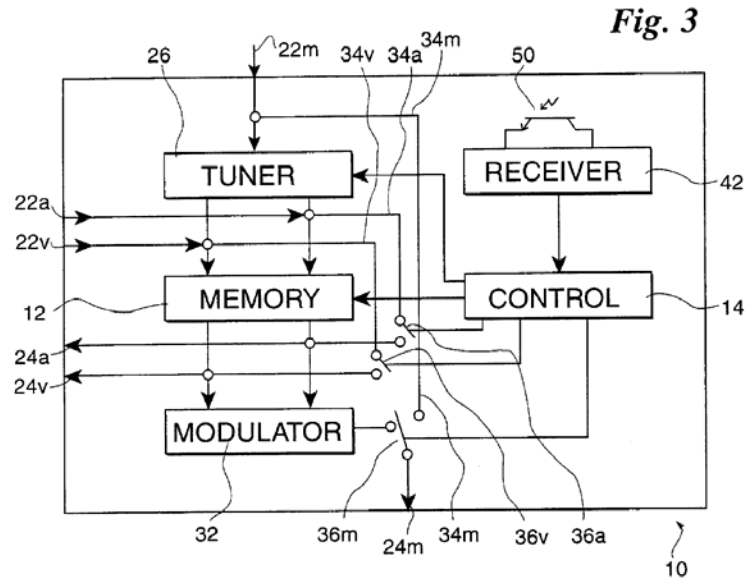


Fig. 3

Figure 3 shows recorder 10 and its components, including memory 12; control circuit 14; inputs 22a, 22v, and 22m; outputs 24a, 24v, and 24m; tuner 26; modulator 32; and receiver 42. *Id.* at col. 3, ll. 54–64, col. 4, ll. 35–53, col. 4, l. 59–col. 5, l. 4, col. 6, ll. 7–18. For use with recorder 10, the '444 patent shows one embodiment of a remote control unit in Figure 5, reproduced below.

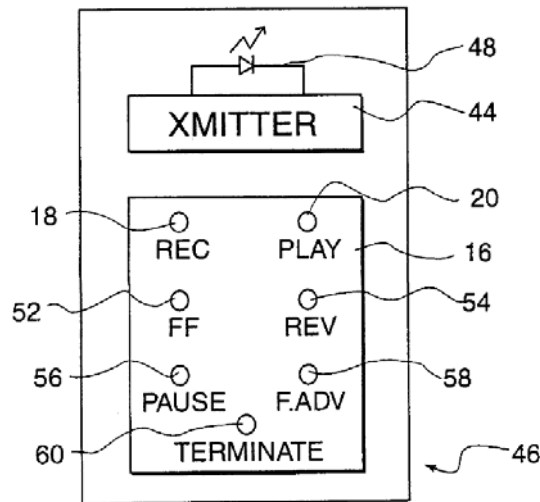


Fig. 5

Figure 5 shows remote control unit 46 and its components, including keyboard 16 and transmitter 44. *Id.* at col. 6, ll. 7–12, 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 col. 6, ll. 8–19, 25–28. Keyboard 16 has a number of keys, including record key 18 and playback key 20. *Id.* at col. 3, ll. 65–67.

When a user actuates record key 18, audio and video information from inputs 22a and 22v or input 22m is stored in memory 12. *Id.* at col. 4, ll. 42–53. When a user actuates playback key 20, audio and video information is retrieved and coupled to outputs 24a and 24v or input 24m. *Id.* at col. 4, l. 59–col. 5, l. 4.

A user may actuate record key 18, for example, when a telephone call interrupts a program. *Id.* at col. 5, ll. 20–24. In response, control circuit 14 begins storing within memory 12 information received via input 22. *Id.* at col. 5, ll. 24–25. When the interruption ends, the user may actuate playback button 20. *Id.* at col. 5, ll. 25–27. In response, the system retrieves and displays the recorded information, starting from the point of the interruption, while continuing to store simultaneously information from input 22. *Id.* at col. 5, ll. 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 program information based upon audio or video signals, or both, without

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