

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 No. 5,930,444

PETITIONER'S REPLY BRIEF

Pursuant to 37 CFR §§ 42.23 and 42.24(c)(1), Unified Patents Inc.

("Unified" or "Petitioner") hereby submits the following Reply in Support of its

Petition for *Inter Partes* Review ("IPR").

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I. Introduction

Respectfully, Patent Owner's Response ("PO Resp.") misinterprets or avoids the teachings of the prior art, which render obvious the limitations of the challenged claims. Patent Owner misconstrues the disclosure of U.S. Patent No. 5,930,444 ("the '444 patent"). Patent Owner also ignores the disclosures of PCT Publication WO 89/12896 to Ulmer ("*Ulmer*," Ex. 1018)¹ and U.S. Patent No. 5,241,428 to Goldwasser, *et al.* ("*Goldwasser*," Ex. 1003). Patent Owner selectively highlights portions of the three disclosures, attempting to show non-existent differences between the references and the challenged claims. And Patent Owner does not address the clear motivation to combine *Ulmer* and *Goldwasser*. As shown by the Petition and the evidence of record, the combined device of *Ulmer* and *Goldwasser* renders obvious claims 1, 2, 7, 8, 10, 13, and 14 ("the challenged claims") of the '444 patent. Petitioner respectfully requests that the Board cancel the challenged claims as unpatentable.

¹ *Ulmer* was filed as Exhibit 1002 in this proceeding. On April 14, 2015, however, the Board authorized Petitioner to file an updated version of *Ulmer* as Exhibit 1018. Exhibit 1018 contains the same translation of *Ulmer* previously filed with a new certificate of translation. Paper 43.

II. *Ulmer* and the '444 Patent Address the Same Problem

Ulmer and the '444 patent disclose devices that address the same problem—allowing for simultaneous recording and playback. While Patent Owner attempts to argue otherwise, Patent Owner's declarant Mr. Goldberg acknowledges they address the same problem. *See* Ex. 2022 at ¶ 25 (“Both the '444 Patent and *Ulmer* disclose a device allowing simultaneous recording and playback of TV programs.”). Patent Owner's and Mr. Goldberg's later attempts to then distinguish *Ulmer* from the '444 patent by claiming they are directed to different problems avoid addressing the admission, and are not persuasive.

Moreover, *Ulmer* discloses a device that addresses the same prior art deficiencies that are outlined in the specification of the '444 patent. Specifically, the '444 patent discloses that one of the issues it sought to solve was “the linear nature of access to information stored on the reel to reel media employed by these devices.” Ex. 1001 at 2:16-18. The '444 patent goes on to note that:

[e]ven though the rate at which modern electronic circuits and microprocessors is sufficiently fast to process both the storage of information from one received program and retrieval of stored program information so as to be effectively simultaneous from the user's perspective, *because the magnetic heads can only access the small portion of media between the reels, and because the overwhelming majority of the storage media is wound onto the reels at any given moment, it is virtually impossible to access the media for*

information storage and retrieval at more than one location in substantially simultaneous fashion.

Ex. 1001 at 2:16-32 (emphasis added). Thus, the '444 patent discloses that one of the primary problems of the prior art was an inability to store and access media simultaneously.

Ulmer's device does just that. *Ulmer* is directed to the same issue—simultaneous recording and playback—addressed by the '444 patent. *Ulmer* discloses that:

The present invention also relates to a device for recording television images and reproducing them after playback, characterized in that it uses a recording medium of the direct-access memory type and that it includes a playback mechanism and a recorder mechanism, *wherein the playback mechanism and the recorder mechanism are separate and independent, can operate simultaneously and can be placed and displaced independently of one another on the recording medium, and in that it includes buffer memories for synchronization and speed matching.*

Ex. 1018 at 3 (emphasis added).

Despite Mr. Goldberg admitting that *Ulmer* addresses the same issues as the '444 patent, Patent Owner now argues that *Ulmer* and the '444 patent are directed to solving “very different problems.” PO Resp. at 12. Patent Owner attempts to characterize the '444 patent as solely relevant for “interruptions,” and *Ulmer* as

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