

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DISH NETWORK L.L.C., and SIRIUS XM RADIO INC.,
Petitioner,

v.

DRAGON INTELLECTUAL PROPERTY, LLC,
Patent Owner.

Case IPR2015-00499¹
Patent 5,930,444

Before NEIL T. POWELL, 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

¹ Case IPR2015-01735 has been joined with this proceeding

I. INTRODUCTION

DISH Network L.L.C. filed a Petition requesting *inter partes* review of claims 1–10, 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 6. Based on our review of these submissions, we instituted *inter partes* review of claims 1–4, 7–10, 13, and 14 of the ’444 patent on the proposed grounds of unpatentability under 35 U.S.C. § 103. Paper 7 (“Dec.”). Specifically, we authorized this *inter partes* review to proceed as to the following grounds: (1) claims 1, 7–10, and 14 as obvious over Goldwasser² and Yifrach;³ and (2) claims 2–4 and 13 as obvious over Goldwasser, Yifrach, and Vogel.⁴ *Id.* at 20.

After institution, Sirius XM Radio Inc. filed a petition requesting *inter partes* review of the ’444 patent on the same grounds asserted by Dish Network and a motion seeking joinder with this proceeding. *Sirius XM Radio Inc. v. Dragon Intellectual Prop., LLC*, Case IPR2015-01735, Papers 1 (petition), 3 (motion for joinder). Patent Owner filed a partial opposition to Sirius XM’s motion for joinder. IPR2015-01735, Paper 7. We instituted an *inter partes* review and joined it with the case at bar. Paper 30.

² U.S. Patent No. 5,241,428, filed Mar. 12, 1991, issued Aug. 31, 1993 (“Goldwasser”) (Ex. 1005).

³ U.S. Patent No. 5,126,982, filed Sept. 10, 1990, issued June 30, 1992 (“Yifrach”) (Ex. 1003).

⁴ PCT Pub. WO 90/15507, published Dec. 13, 1990 (“Vogel”) (Ex. 1004).

Patent Owner filed a Patent Owner's Response (Paper 12, "PO Resp."), and Petitioner⁵ filed a Reply (Paper 27, "Reply"). An oral hearing was conducted on February 9, 2016. A transcript of the oral hearing is included in the record. Paper 33 ("Tr.").

We have jurisdiction under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73 as to the patentability of claims 1–4, 7–10, 13, and 14. For the reasons discussed below, Petitioner has demonstrated by a preponderance of the evidence that claims 1–4, 7–10, 13, and 14 are unpatentable.

A. Related Proceedings

Petitioner informs us that the '444 patent is at issue in *Dragon Intellectual Property, LLC v. DISH Network L.L.C.*, No. 13–CV–2066 (RGA) (D. Del). Pet. 1. In addition, the '444 patent was at issue in IPR2014-01252, and a final written decision was entered in that proceeding finding claims 1, 2, 7, 8, 10, 13, and 14 to be unpatentable. *Unified Patents Inc., v. Dragon Intellectual Prop., LLC*, Case IPR2014-01252, slip op. at 21 (Feb. 5, 2016) (Paper 64). An appeal of that case currently is pending before the Federal Circuit.

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

⁵ We refer to Dish Network and Sirius XM Radio collectively as "Petitioner."

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.

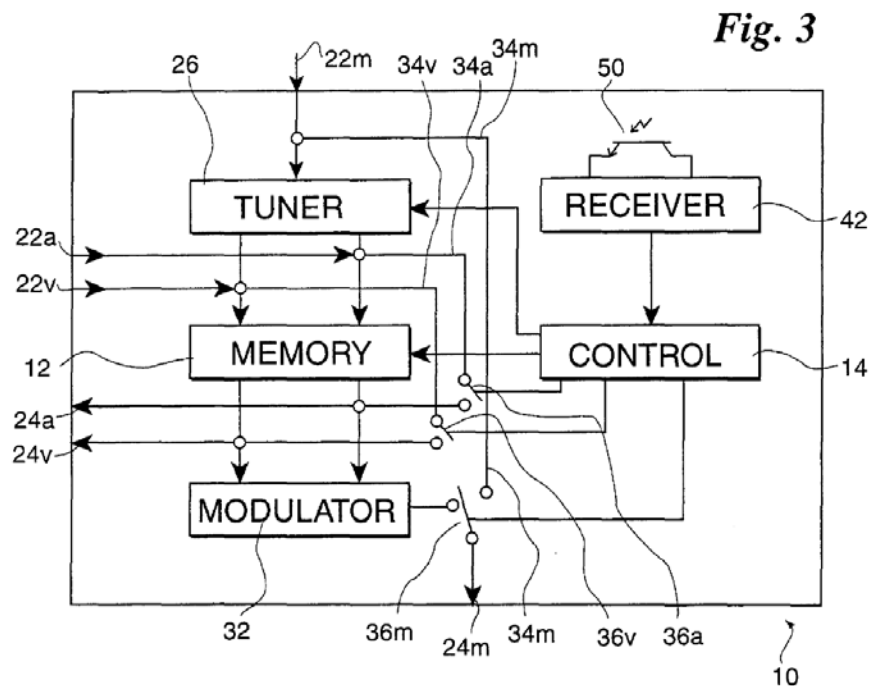


Figure 3 depicts recorder 10 and its components, including memory unit 12; control circuit 14; inputs 22a, 22v, and 22m; outputs 24a, 24v, and 24m; tuner 26; modulator 32; and receiver 42. *Id.* at 3:54–64, 4:35–53, 4:59–5:4, 6:7–18. An embodiment of a remote control unit for use with recorder 10 is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

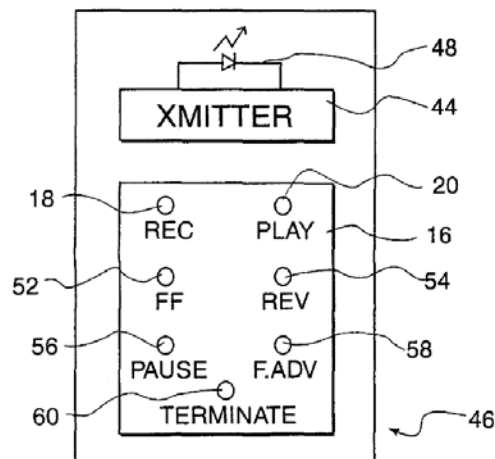


Fig. 5

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 6:8–28. 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 1–4, 7–10, 13, and 14 of the '444 patent of which claims 1 and 14 are independent. Claim 1 is illustrative of the challenged claims and is reproduced below:

1. A recording and playback apparatus for the substantially immediate and seamless resumption

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