

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

DRAGON INTELLECTUAL PROPERTY, LLC,  
Patent Owner.

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Case IPR2015-00499<sup>1</sup>  
Patent 5,930,444

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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*

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<sup>1</sup> 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 Goldwasser<sup>2</sup> and Yifrach;<sup>3</sup> and (2) claims 2–4 and 13 as obvious over Goldwasser, Yifrach, and Vogel.<sup>4</sup> *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.

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

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

<sup>4</sup> 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 Petitioner<sup>5</sup> 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

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<sup>5</sup> 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.

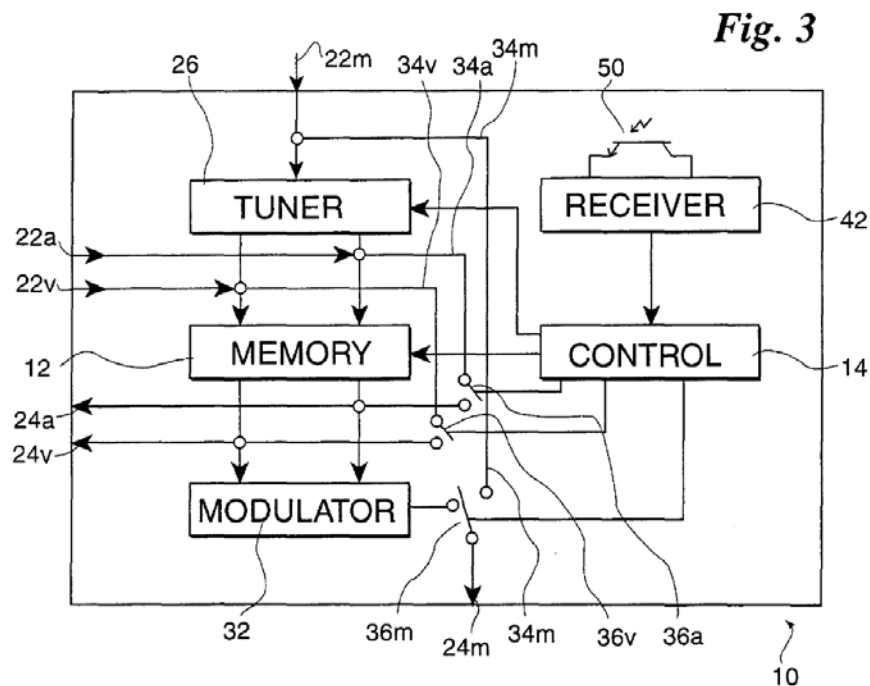
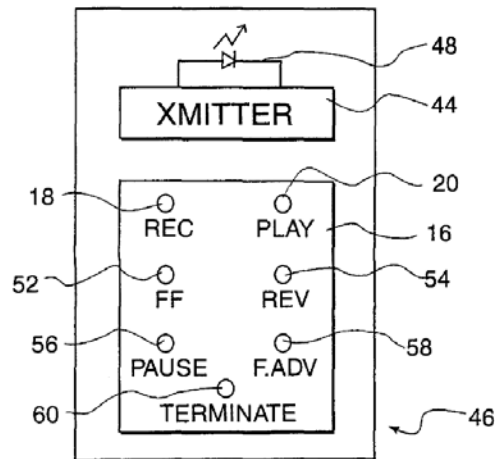


Figure 3 depicts recorder 10 and its components, including memory unit 12; control circuit 14; inputs 22a, 22v, and 22m; outputs 24a, 24v, and 24m; tuner 26; modulator 32; and receiver 42. *Id.* at 3:54–64, 4:35–53, 4:59–5:4, 6:7–18. An embodiment of a remote control unit for use with recorder 10 is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