

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 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 Goldwasser¹ and Ulmer².

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.

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

² 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.

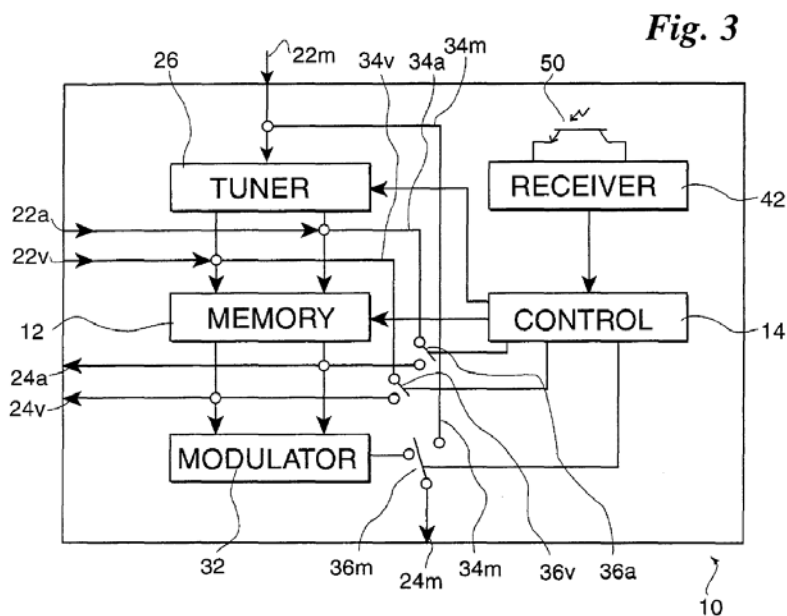


Figure 3 depicts recorder 10 and its components, including memory unit 12; control circuit 14; inputs 22a, 22v, and 22m; outputs 24a, 24v, and 24m; tuner 26; modulator 32; and receiver 42. *Id.* at 3:54–64, 4:35–53, 4:59–5:4, 6:7–18. An embodiment of a remote control unit for use with recorder 10 is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

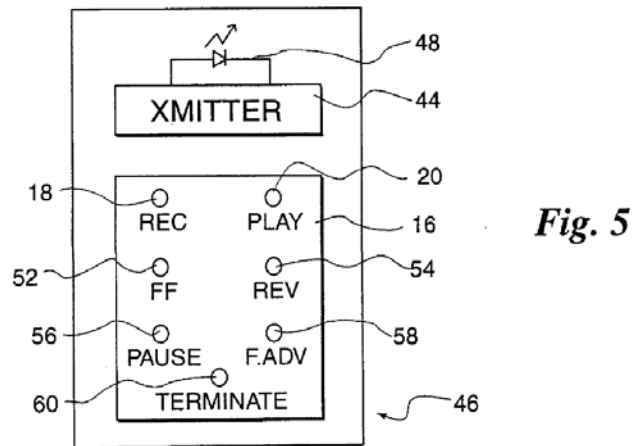


Figure 5 shows remote control unit 46 and its components, including keyboard 16 and transmitter 44. *Id.* at 6:7–12, 6:25–28. Transmitter 44 of remote control unit 46 and receiver 42 of recorder 10 provide communication between remote control unit 46 and recorder 10. *Id.* at 6:8–19, 6:25–28. Keyboard 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 broadcast³ 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

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

at least one output, said output being connected to a user's audio or video display device or both, said output further being connected to said memory unit so as to enable the transfer of program information from said memory unit to the user's display device, said control circuit being configured so that substantially simultaneous recording and playback of program information is achieved when said record key is first actuated to begin a recording by initiating storage of the broadcast program information in said memory unit, and said playback key is subsequently and solely actuated to begin time delay playback of the recording from the beginning thereof by initiating retrieval of the stored program information in said memory unit, with the interval of the time delay being the same as the time elapsed between the actuation of said record key and the subsequent actuation of said playback key.

Ex. 1001, 8:29–64.

II. ANALYSIS

A. *Claim Interpretation*

Petitioner proffers constructions for a number of claim terms. Pet. 18–24. No claim terms require express construction for purposes of this Decision.

B. *Obviousness of Claims 1, 2, 7, 8, 10, 13, and 14 over Ulmer and Goldwasser*

Petitioner alleges that claims 1, 2, 7, 8, 10, 13, and 14 of the '444 patent are unpatentable under 35 U.S.C. § 103 over Goldwasser and Ulmer. Pet. 24–35, 57–59. Petitioner relies on claim charts showing how these

references teach the claimed subject matter. *Id.* at 35–57. Petitioner further relies on a Declaration from Dr. Sheila S. Hemami. Ex. 1013.

For the reasons discussed below, we conclude that Petitioner has established by a preponderance of the evidence that claims 1, 2, 7, 8, 10, 13, and 14 would have been obvious over Goldwasser and Ulmer.

1. Overview of Ulmer (Ex. 1018)

Ulmer discloses a “[d]evice for simultaneous recording and playback of television images” and a method of operating such a device. Ex. 1018, 1. Ulmer’s device “comprises a playback mechanism and a recording mechanism, the playback mechanism and recording mechanism being separate and independent, with the possibility of operating simultaneously.” *Id.* at Abstract. Ulmer discloses that by providing a device and method for recording television images and playing them back after a short delay, its invention serves to eliminate advertising segments and other sequences from a television program. *Id.*

Ulmer teaches that its device “uses a recording medium of the direct-access memory type.” *Id.* at 3. Ulmer teaches that “[t]he direct-access memory of the recording medium comprises a double-gate linear memory of semiconductor or other type, permitting simultaneous write and read access.” *Id.* at 4.

Ulmer further teaches that its devices use a playback mechanism that is separate and independent of its recorder mechanism. *Id.* at 3. The playback and recorder mechanisms can operate simultaneously, and can be positioned and moved independently on the recording medium. *Id.*

In one instance, Ulmer describes a method that includes the following five steps:

- recording a television broadcast on the recording medium;
- waiting for a time T that corresponds almost to the duration of all of the advertising breaks that it is wished to eliminate from the broadcast that it is desired to watch;
- starting playback of the recording medium in order to reproduce the recorded images on a television screen;
- at the beginning of each advertising break, reproducing the images by playback at accelerated speed so that the end of the advertising break can be identified;
- at the end of the advertising break, reproducing the recorded images at normal speed.

Id. at 2.

Ulmer also discloses that:

[In addition, i]t is pointed out that it is the television viewer himself or herself who identifies the start and end of the advertising break that he or she wishes to eliminate, and that it is he or she who controls the device of the invention, for example with a remote.

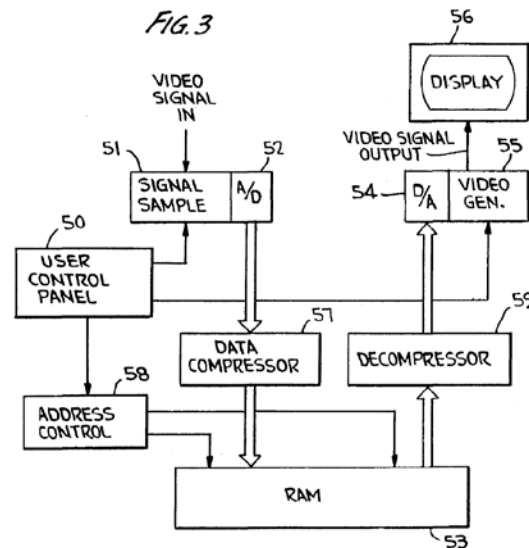
Id. at 1.

2. *Overview of Goldwasser (Ex. 1003)*

Goldwasser is a United States Patent titled “Variable-Delay Video Recorder” that issued August 31, 1993 from an application filed March 12, 1991. Ex. 1005, at [22], [45], [54]. Goldwasser describes “[a] video recorder and playback device allowing simultaneous recording and playback of program material.” *Id.* at Abstract. One of the problems that Goldwasser purports to solve is the inconvenience that arises from the inability of conventional VCRs to allow a user to view material as it is being recorded. *Id.* at 1:29–42. For example, “often one will be watching a particular program when one must temporarily cease watching it, for example to take a telephone call or the like. It would obviously be convenient to be able to

record the program from that point forward, complete the telephone call, and simply watch the remainder delayed by the length of time of the interruption.” *Id.* at 1:43–49.

One embodiment disclosed by Goldwasser is a “random access embodiment” whereby the video signal is converted to a digital signal and recorded in random access memory, which could include magnetic or optical media or solid state memory. *Id.* at 2:16–21. This random access embodiment is depicted in Figure 3 of Goldwasser, reproduced below.



Goldwasser’s Figure 3 is a schematic diagram of its random access embodiment. *Id.* at 3:49–50. The recording device depicted in Figure 3 includes signal sampling circuit 51 and analog-to-digital converter 52, which are used together to create digital samples of the video signal being record. *Id.* at 6:25–28. These samples are stored in random access memory 53. *Id.* at 6:28–29. The storage of these digitized video samples is controlled by address controller 58, which is responsive to commands from user control panel 50. *Id.* at 6:44–48. Playback can take place from any portion of the memory at any speed without impacting the recording. *Id.* at 6:38–40.

3. *Claims 1 and 2*

Petitioner contends that claims 1 and 2 would have been obvious over Ulmer and Goldwasser. Pet. 35–51. We have reviewed Petitioner’s detailed explanation identifying where each limitation allegedly would have been taught by Ulmer and Goldwasser, along with the testimony of Petitioner’s declarant, Dr. Hemani. *See id.*; Ex. 1013; Reply 12–24. We also have reviewed Patent Owner’s assertions and evidence as to why Petitioner’s explanations and evidence are deficient. PO Resp. 17–49; Ex. 2022 (Declaration of Adam Goldberg). On this record, we are persuaded that Petitioner has shown by a preponderance of the evidence that Ulmer and Goldwasser teach each limitation of claims 1 and 2.

Petitioner asserts that Ulmer discloses a recording and playback apparatus for audio or video signals, as recited in the preamble of independent claim 1. Pet. 35–36. In addition, Petitioner notes that Goldwasser also discloses a recording and playback apparatus for audio or video signals. *Id.* at 36. Further addressing the preamble of claim 1, Petitioner asserts that “Goldwasser provides for the substantially immediate and seamless resumption of interrupted perception of program information without missing the program information presented during the interruption.” *Id.* at 36–37.

Patent Owner argues that Ulmer does not disclose an “interruption” as recited in the preamble. PO Resp. 14. According to Patent Owner, Ulmer does not deal with unplanned interruptions; instead it only allows users to time shift for a planned amount of time in order to avoid commercials. *Id.* Petitioner responds by arguing that the preamble is not limiting. Reply 6.

We need not decide whether the preamble is limiting because we find that the prior art relied upon teaches the recited interruption. Goldwasser recites:

Similarly, often one will be watching a particular program when one must temporarily cease watching it, for example, to take a telephone call or the like. It would obviously be convenient to be able to record the program from that point forward, complete the telephone call, and simply watch the remainder delayed by length of time of the interruption.

Pet. 36–37 (citing Ex. 1003, 1:43–49). We find that this passage teaches the recited interruption.

As to the body of claim 1, Petitioner asserts that the combination of Ulmer and Goldwasser teaches a keyboard having a record and a playback key. Pet. 28 (citing Ex. 1013 ¶ 59). Petitioner argues that Ulmer necessarily teaches the recited keyboard because it has a remote control that controls the operation of Ulmer’s device. *Id.* (citing Ex. 1001, 6:37–41; Ex. 1018, 1, 3; Ex. 1013 ¶ 60). According to Petitioner, “[t]he purpose of remotes at this time was to allow for the control of the device, be it a television or a VCR, using buttons and/or keys to input functions.” Reply 15 (citing Ex. 1013 ¶¶ 59–60). Petitioner provides evidence that it contends shows that a person of ordinary skill in the art would have been aware of VCR remote controls with such keys. *Id.* (citing Ex. 1013 ¶¶ 25, 27–28; Ex. 1004); Tr. 10–11 (citing Ex. 1013 ¶ 28; Ex. 1004, 2; Ex. 1008, 2:29–34). For example, Exhibit 1004 is a March 1992 article that describes reviewing VCRs based on the logical arrangement of the keys on the remote control. *Id.* at 11; *see* Pet. 8. In addition, Exhibit 1008 is patent issued in 1989 that discloses a remote control with buttons for record and playback. Tr. 11; *see* Pet. 13. Petitioner also argues that the specification of the ’444 patent acknowledges that VCRs operated by remote control were well-known in the art. Pet. 28

(citing Ex. 1001, 6:37–41). Ulmer’s remote control is capable of “recording a television broadcast” and “starting playback of a recording medium”; thus, Petitioner argues it necessarily has keys on its remote control corresponding to these functions. Reply 15 (citing Ex. 1018, 2). In addition to the teachings of Ulmer, Petitioner also cites Goldwasser’s discussion of a user control panel by which a user can control the apparatus. Pet. 28. (citing Ex. 1013 ¶ 58). In the alternative, Petitioner argues that it would have been an obvious design choice to use a remote control with play and record buttons to control Ulmer’s device. Reply 20; Tr. 10:7–14. Petitioner contends that “[a] person of ordinary skill was well aware of these features, and in designing a digital VCR, they would select these features readily and with ease to suit their design goals.” Pet. 14 (citing Ex. 1013 ¶ 38).

Petitioner also asserts that Ulmer discloses a “memory unit,” “at least one input,” “at least one output,” and “substantially simultaneous recording and playback of program information,” as recited in claim 1. Pet. 29–31, 41–42, 45–47. Petitioner further asserts that a person of ordinary skill in the art would understand that Ulmer’s system includes the claim 1 limitation that

substantially simultaneous recording and playback of program information is achieved when said record key is first actuated to begin a recording by initiating storage of the broadcast program information in said memory unit, and said playback key is subsequently and solely actuated to begin time delay playback of the recording from the beginning thereof by initiating retrieval of the stored program information in said memory unit.

Id. at 48–49.

Because this claim language recites “said playback key is subsequently and solely actuated to begin time delay playback,” Petitioner

describes claim 1 as requiring “one button playback.” *See, e.g., id.* at 1–2, 15–16, 31–32. Petitioner asserts that a person of ordinary skill would understand that Ulmer’s system includes this limitation. *Id.* at 31–32, 48–49.

Petitioner asserts that a person of ordinary skill in the art would understand that the step of starting playback in Ulmer involves pressing the playback key only. Pet. 32. Petitioner explains that a person of ordinary skill in the art would understand as much because Ulmer’s system allows simultaneous recording and playback, such that starting playback would not require stopping, pausing, or otherwise disturbing the pausing operation. *Id.* (citing Ex. 1013 ¶¶ 68–69).

Relying on the testimony of Dr. Hemami, Petitioner also asserts that a person of ordinary skill in the art would understand that Ulmer’s system includes a “control circuit coupled responsively to said keyboard,” as recited in claim 1. *Id.* at 29, 38–41. Dr. Hemami explains that a person of ordinary skill in the art would understand that any remote-controlled/keyboard-controlled device needs a control circuit to execute commands entered at the keyboard. Ex. 1013 ¶ 61; Pet. 29. Additionally, given that Ulmer discloses control of the apparatus with the remote control, a person of ordinary skill in the art would understand that the control circuit is coupled responsively to the keyboard, Dr. Hemami explains. Ex. 1013 ¶ 62; Pet. 29.

Petitioner further asserts that the functional diagram illustrated in Figure 3 of Goldwasser could be used to implement the details of Ulmer’s apparatus and control circuit (*id.* at 25). Petitioner explains that a person of ordinary skill in the art would be motivated to combine Goldwasser’s

disclosure with Ulmer's because of the strong similarities in the purpose and configuration of the systems. *Id.* at 25–27 (citing Ex. 1013 ¶¶ 51–52).

Patent Owner argues that the combination of Ulmer and Goldwasser does not teach the '444 patent's "a keyboard having a record key and a playback key" or the recited "control circuit." PO Resp. 19. Patent Owner also argues that there is no motivation to combine the teachings of Ulmer and Goldwasser. *Id.* at 42. We address each of Patent Owner's arguments in turn.

According to Patent Owner, Petitioner's inherency argument fails because Ulmer does not necessarily disclose the recited keyboard. Patent Owner notes that the focus of Ulmer's device is commercial skipping and not the manner in which recording or playback is achieved. *Id.* at 22. As such, it provides no specifics as to what keys may exist on its remote control. *Id.* (citing Ex. 2022 ¶¶ 34–36). Patent Owner contends that (1) Ulmer may be controlled via something other than a keypad, and (2) even if Ulmer has a keypad, that keypad may only need a key to eliminate commercials. *Id.* at 23.

As to the first argument, Patent Owner cites VCR Plus as a system known at the time of the invention that could be used to control a VCR without the use of a keyboard. Ex. 2022 ¶ 39. Using VCR Plus, a VCR could record a program by entering a code found in a television newspaper listing. *Id.* Another possibility that Patent Owner cites are VCRs that are programmed to record shows by using a bar code scanning wand. *Id.* ¶ 40. As to the second argument, Patent Owner asserts that commercials could be skipped via a "fast forward" key. *Id.* at 24 (citing Ex. 2022 ¶ 36).

In an obviousness analysis, it is proper to use inherency to account for a claim limitation that is not expressly disclosed by the prior art. *PAR Pharm., Inc. v. TWI Pharms., Inc.*, 773 F.3d 1186, 1194–1195 (Fed. Cir. 2014); *see also In re Napier*, 55 F.3d 610, 613 (Fed. Cir. 1995) (affirming a 35 U.S.C. § 103 rejection based in part on inherent disclosure in one of the references). Our reviewing court, however, has limited the application of inherency in obviousness analysis to situations where the limitation at issue is the “natural result” of the combination of prior art elements. *Id.* at 1195. We are not persuaded by Patent Owner’s arguments against inherency because they are premised upon a very limited view of Ulmer’s device. Specifically, Patent Owner takes the view that Ulmer’s device is only for commercial skipping and, as such, its remote control would only need to handle that one function. This is not consistent with Ulmer’s specification. As described in Ulmer the “[user] controls *the device of the invention*, for example with a remote.” Ex. 1018, 2 (emphasis added). This statement indicates that the remote control is used to control “the device of the invention” and not just a single function performed by the device. Ulmer’s device is described expressly as having both record and playback functionality. *Id.* at Abstract, 2 (noting the separate record and playback mechanisms). Thus, Ulmer’s remote control *must* be able to control both recording and playback. Therefore, we find that the use of buttons to control Ulmer’s device is not based on mere probabilities or possibilities, but on the requirement that it must have such buttons to control the device. *See PAR Pharm.*, 773 F.3d at 1195 (citing *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981)). As Petitioner correctly notes, Patent Owner’s proposed alternative methods for controlling Ulmer’s device only provide for recording

functionality and do not address playback. Reply 19–20. As to Patent Owner’s argument that Ulmer’s functionality could be achieved via a fast forward key, Ulmer describes the use of a fast forward key as a prior art mechanism, and Ulmer states that its device provides a mechanism superior to the prior art’s use of fast forward to eliminate commercials. Ex. 1018, 1–2. Thus, we agree with Petitioner’s arguments and find that Ulmer’s device cannot be implemented by using only a fast forward key.

In addition, we also find persuasive Petitioner’s argument that it would have been an obvious design choice to use play and record buttons on a remote control to control Ulmer’s device. *See* Pet. 14 (citing Ex. 1013 ¶ 38). Petitioner has provided evidence that such remote controls were well known at the time of the application for the ’444 patent. *See* Reply 15 (citing Ex. 1013 ¶¶ 25, 27–28; Ex. 1004); Tr. 10–11 (citing Ex. 1013 ¶ 28; Ex. 1004, 2; Ex. 1008, 2:29–34). Based on this evidence, we are persuaded it would have been within the knowledge and abilities of one of ordinary skill in the art to control Ulmer’s device with a remote control that includes play and record buttons.

Patent Owner also argues that the asserted combination does not teach the recited control circuit. As recited in claim 1, the control circuit is coupled responsively to the keyboard and the memory and it is “configured so that substantially simultaneous recording and playback of program information is achieved when said record key is first actuated to begin a recording by initiating storage of the broadcast program information in said memory unit.” Ex. 1001, 8:29–64. According to Patent Owner’s declarant, “Ulmer requires only that the device of Ulmer perform simultaneous recording and playback, and that it enable a user to ‘eliminate’ commercials

during playback by controlling the rate of playback.” Ex. 2022 ¶ 56. Mr. Goldberg maintains that the claims of the ’444 patent require more. Specifically, he states that the claims require “that the device contain a control circuit that achieves simultaneous recording and playback when the user first actuates the ‘record key,’ and then subsequently and solely actuates the ‘playback key.’” *Id.* Petitioner maintains that Ulmer describes separate record and playback mechanisms that allow for simultaneous recording and playback and that, as such, Ulmer must necessarily have the recited control circuit. Pet. 29–31. Patent Owner argues that Ulmer does not necessarily include a control circuit. PO Resp. 35–36. We, however, do not find this argument persuasive. Ulmer describes an electronic device and, as such, it has circuitry to control its functions. We find that Petitioner has provided sufficient evidence to show that Ulmer teaches the recited simultaneous recording and playback. Thus, we find that Ulmer *must* have a circuit to control this functionality. As we have discussed above, Ulmer must have record and playback buttons as well. Therefore, we find that Ulmer inherently includes the recited control circuit.

In its Patent Owner Response, Patent Owner raised the argument that there was no motivation to combine Ulmer and Goldwasser. PO Resp. 42–47. At the Oral Hearing, however, Patent Owner withdrew this argument. Tr. 32:4–11. Regardless, we find that Petitioner has provided sufficient evidence of a motivation to combine. Petitioner explains that a person of ordinary skill in the art would be motivated to combine Goldwasser’s disclosure with Ulmer’s because both references “address the same problem: providing simultaneous recording and playback as a mechanism to allow a viewer to skip commercials.” Pet. 25. Petitioner elaborates that due to

extensive overlap between the systems of Ulmer and Goldwasser, a person of ordinary skill in the art would have been led to use various design details from Goldwasser's teachings in a combination of Ulmer's and Goldwasser's systems. *Id.* at 25–26

We find that Petitioner's assertions and evidence provide rational underpinning for a conclusion that it would have been obvious to combine the teachings of Ulmer and Goldwasser. And we are persuaded Petitioner's assertions and evidence show sufficiently that the resulting system would include each of the limitations of independent claim 1 and dependent claim 2. Claim 2 depends from claim 1 and recites that the claimed apparatus "further compris[es] a remote control unit, and wherein said keyboard is housed in said remote control unit." Petitioner notes that Ulmer explicitly discloses that its system includes a remote control unit. *Id.* at 28, 37, 51. We agree with Petitioner's analysis of the recited art's disclosures as applied to claim 2. Accordingly, we are persuaded that Petitioner has demonstrated by a preponderance of the evidence the unpatentability of independent claim 1 and dependent claim 2 over Ulmer and Goldwasser.

4. *Claims 7, 8, and 10*

Petitioner asserts that Ulmer's system includes the limitations of dependent claims 7, 8, and 10. Pet. 34–35, 51–56. With respect to the additional limitations of each of these claims, Petitioner asserts either that Ulmer explicitly discloses the limitation, or that a person of ordinary skill would understand that Ulmer's system includes the limitation. *Id.* Patent Owner makes no additional argument as to the patentability of these dependent claims. PO Resp. 49. We have reviewed Petitioner's argument and evidence, and we find them to be sufficient to establish the

unpatentability of these dependent claims. Thus, we adopt Petitioner's analysis of these claims and find that Petitioner has demonstrated by a preponderance of the evidence the unpatentability of dependent claims 7, 8, and 10 over Ulmer and Goldwasser.

5. *Claim 13*

Regarding the recitation in dependent claim 13 of "a timer circuit adapted to enable the preprogrammed unattended initiation of recording," Petitioner asserts that Goldwasser discloses such a timer circuit. Pet. 27, 56–57. Relying on the testimony of Dr. Hemami, Petitioner argues that a person of ordinary skill in the art would have had reason to modify Ulmer's system to include Goldwasser's timer circuit "to provide the benefit of delayed recording," asserting that "[t]his was a common and important feature of VCRs in 1992, and users would simply demand such functionality if it were not already provided." *Id.* at 27 (citing Ex. 1013 ¶ 53). Patent Owner makes no additional argument as to the patentability of this dependent claim. PO Resp. 49. We have reviewed Petitioner's argument and evidence, and we find them to be sufficient to establish the unpatentability of claim 13. Thus, we adopt Petitioner's analysis of this claim and find that Petitioner's assertions and evidence establish by a preponderance of the evidence the unpatentability of dependent claim 13 over Ulmer and Goldwasser.

6. *Claim 14*

Patent Owner contends that its arguments regarding claim 1 also apply to claim 14. PO Resp. 47. For reasons discussed above, we do not find those arguments to be persuasive. Patent Owner also argues that Petitioner did not put forth sufficient evidence to show that one would use Ulmer's device to perform the steps of claim 14. *Id.* We disagree and find that

Petitioner's analysis of claim 14 is sufficient to establish the unpatentability of this claim.

Petitioner's arguments and evidence as to claim 14 may be summarized as follows. Petitioner asserts that the limitations of claim 14 are nearly identical to those of independent claim 1. Pet. 57; *see also* PO Resp. 47 (noting that “[t]he method of Claim 14 includes providing a device substantially according to the invention of Claim 1”). Petitioner notes that claim 14 differs from claim 1 because claim 14 includes the language “begin playback of the stored program information by initiating retrieval of the program information stored in said memory unit from the beginning thereof.” Pet. 57. Petitioner states that “[t]his limitation basically requires starting playback from the beginning of the recording.” *Id.* Petitioner cites Ulmer's disclosure that “[f]or reading, the RAR is initialized: - to zero if image reproduction is to start at the beginning of the memory” (Ex. 1018, 4) as teaching playback from the beginning of the recording. *Id.*

Petitioner also notes that claim 14 recites “actuating said record key upon the beginning of the interruption to initiate storage of the broadcast program information in said memory unit” and “actuating said playback key upon the conclusion of the interruption to initiate retrieval and display of the program information stored in said memory unit from the beginning thereof, while continuing to store the broadcast program information.” *Id.* at 57–58. Petitioner refers to these portions of claim 14 as the “actuating elements.” *Id.*

Petitioner asserts that a person of ordinary skill in the art would understand that the actuating elements necessarily are present in Ulmer. *Id.* at 58 (citing Ex. 1013 ¶ 56). Petitioner notes that Ulmer describes an

example of a person starting to record a program and later starting to watch the program, in order that the person may fast forward through commercial breaks. *Id.* Given this, Petitioner reasons that a person of ordinary skill in the art would recognize that Ulmer's delayed playback feature would lend itself to use during an interruption, and that users naturally would operate the device in this manner. *Id.*

Additionally, Petitioner notes that Goldwasser expressly teaches using its apparatus in the manner recited in the actuating elements of claim 14. *Id.* Petitioner further argues that the overlap between Goldwasser's and Ulmer's recorders provides strong evidence that users and those of skill in the art would use Ulmer's apparatus for the same purpose, asserting that common sense requires the same result. *Id.* at 58–59 (citing Ex. 1013 ¶¶ 55–57).

As such, we adopt Petitioner's analysis of claim 14 and find that Petitioner's assertions and evidence demonstrate by a preponderance of the evidence that of independent claim 14 is unpatentable over Ulmer and Goldwasser.

III. CONCLUSION

Based on the arguments in the Petition, as well as the evidence of record, we determine that Petitioner has demonstrated by a preponderance of the evidence the unpatentability of claims 1, 2, 7, 8, 10, 13, and 14 of the '444 patent.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 1, 2, 7, 8, 10, 13, and 14 of the '444 patent are held unpatentable;

FURTHER ORDERED that, because this is a final written decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

Certain materials have been sealed in this proceeding, but have not been relied upon in this Decision. *See* Paper 40. The record will be maintained undisturbed pending the outcome of any appeal taken from this Decision. At the conclusion of any appeal proceeding, or if no appeal is taken, the materials will be made public. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,760-61 (Aug. 14, 2012). Further, either party may file a motion to expunge the sealed materials from the record pursuant to 37 C.F.R. § 42.56. Any such motion will be decided after the conclusion of any appeal proceeding or the expiration of the time period for appealing.

IPR2014-01252
Patent 5,930,444

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