

**American Bar Association
Section of Intellectual Property Law**

**Symposium of the SIPO/US Bar Liaison
Council with China's State Intellectual
Property Office (SIPO) and the All China
Patent Attorney Association (ACPAA)**

TiVo v. EchoStar

Patrick J. Coyne
Finnegan

New York, New York
June 3, 2013

Is it Better to Ask Permission?



or Forgiveness?



A background image of a theater stage with red curtains. The curtains are pulled back, revealing a dark stage floor. The text "Act I" is centered in the middle of the image.

Act I

The Players



<http://www.shutterstock.com/gallery-410482p1.html?cr=00&pl=edit-00>>ID1974 / Shutterstock.com

TiVo

10 reasons you'll love TiVo.

It's TV, about a thousand times better. See why >



Echostar

Hughes

Dish Network





US006233389B1

TiVo '389 Patent

(12) **United States Patent**
Barton et al.

(10) **Patent No.:** US 6,233,389 B1
(45) **Date of Patent:** May 15, 2001

(54) **MULTIMEDIA TIME WARPING SYSTEM**

(75) Inventors: **James M. Barton**, Los Gatos;
Roderick James McInnis, Milpitas;
Alan S. Moskowitz, San Francisco;
Andrew Martin Goodman, Menlo
Park; **Ching Tong Chow**, Fremont;
Jean Swey Kao, Cupertino, all of CA
(US)

(73) Assignee: **TiVo, Inc.**, Alviso, CA (US)

(*) Notice: Subject to any disclaimer, the term of this
patent is extended or adjusted under 35
U.S.C. 154(b) by 0 days.

(21) Appl. No.: **09/126,071**

(22) Filed: **Jul. 30, 1998**

(51) **Int. Cl.**⁷ **H04N 5/92**

(52) **U.S. Cl.** **386/46; 386/68**

(58) **Field of Search** 386/1, 33, 45,
386/46, 111-112, 125-126, 68; 369/60;
366/7, 33; 348/7, 10, 571, 714, 722, 725;
H04N 5/76, 5/92, 9/79, 5/14

(56) **References Cited**

U.S. PATENT DOCUMENTS

Re. 33,535	2/1991	Cooper	358/149
4,313,135	1/1982	Cooper	358/149
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5,438,423	8/1995	Lynch et al.	358/335
5,550,594	8/1996	Cooper et al.	348/513
5,572,261	11/1996	Cooper	348/512

(List continued on next page.)

FOREIGN PATENT DOCUMENTS

0726574 8/1996 (EP) G11B/27/034

OTHER PUBLICATIONS

ASTARTE DVDirector™ Beta Testing Program.

Primary Examiner—Thai Tran

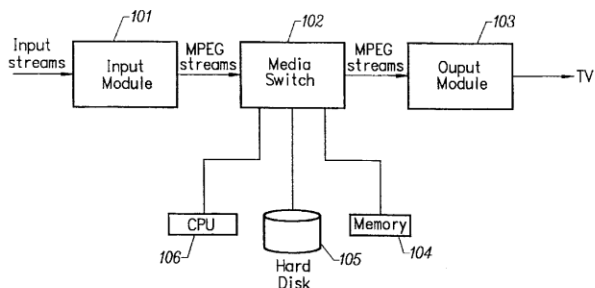
(74) *Attorney, Agent, or Firm*—Michael A. Glenn; Kirk
Wong

(57) **ABSTRACT**

A multimedia time warping system. The invention allows the user to store selected television broadcast programs while the user is simultaneously watching or reviewing another program. A preferred embodiment of the invention accepts television (TV) input streams in a multitude of forms, for example, National Television Standards Committee (NTSC) or PAL broadcast, and digital forms such as Digital Satellite System (DSS), Digital Broadcast Services (DBS), or Advanced Television Standards Committee (ATSC). The TV streams are converted to an Moving Pictures Experts Group (MPEG) formatted stream for internal transfer and manipulation and are parsed and separated it into video and audio components. The components are stored in temporary buffers. Events are recorded that indicate the type of component that has been found, where it is located, and when it occurred. The program logic is notified that an event has occurred and the data is extracted from the buffers. The parser and event buffer decouple the CPU from having to parse the MPEG stream and from the real time nature of the data streams which allows for slower CPU and bus speeds and translate to lower system costs. The video and audio components are stored on a storage device and when the program is requested for display, the video and audio components are extracted from the storage device and reassembled into an MPEG stream which is sent to a decoder. The decoder converts the MPEG stream into TV output signals and delivers the TV output signals to a TV receiver. User control commands are accepted and sent through the system. These commands affect the flow of said MPEG stream and allow the user to view stored programs with at least the following functions: reverse, fast forward, play, pause, index, fast/slow reverse play, and fast/slow play.

61 Claims, 12 Drawing Sheets

Method and apparatus for time-shifting TV programs



DVR

DVR

Digital Video Recorder

Available in
HD



Play Demo

Tried to a Jury



Jury Verdict

Infringement

Willfulness

Damages



Permanent Injunction



Infringement Provision

IT IS FURTHER ORDERED THAT Each Defendant, its officers, agents, servants, employees and attorneys, and those persons in active concert or participation with them who receive actual notice hereof, are hereby restrained and enjoined, pursuant to 35 U.S.C. § 283 and Fed. R. Civ. P. 65(d), from making, using, offering to sell or selling in the United States, the Infringing Products, either alone or in combination with any other product and all other products that are only colorably different therefrom in the context of the Infringed Claims, whether individually or in combination with other products or as a part of another product, and from otherwise infringing or inducing others to infringe the Infringed Claims of the '389 patent.

Infringement Provision

IT IS FURTHER ORDERED THAT Each Defendant, its officers, agents, servants, employees and attorneys, and those persons in active concert or participation with them who receive actual notice hereof, are hereby restrained and enjoined, pursuant to 35 U.S.C. § 283 and Fed. R. Civ. P. 65(d), *from making, using, offering to sell or selling in the United States, the Infringing Products*, either alone or in combination with any other product and all other products that are only colorably different therefrom in the context of the Infringed Claims, whether individually or in combination with other products or as a part of another product, and from otherwise infringing or inducing others to infringe the Infringed Claims of the '389 patent.

Disablement Provision

Defendants are hereby **FURTHER ORDERED** to, within thirty(30) days of the issuance of this order, disable the DVR functionality (i.e., disable all storage to and playback from a hard disk drive of television data) in all but 192,708 units of the Infringing Products that have been placed with an end user or subscriber. The DVR functionality, i.e., disable all storage to and playback from a hard disk drive of television data) shall not be enabled in any new placements of the Infringing Products.

Disablement Provision

Defendants are hereby **FURTHER ORDERED** to, within thirty(30) days of the issuance of this order, *disable the DVR functionality* (i.e., disable all storage to and playback from a hard disk drive of television data) in all but 192,708 units of the Infringing Products that have been placed with an end user or subscriber. The DVR functionality, i.e., disable all storage to and playback from a hard disk drive of television data) shall not be enabled in any new placements of the Infringing Products.

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Clarity



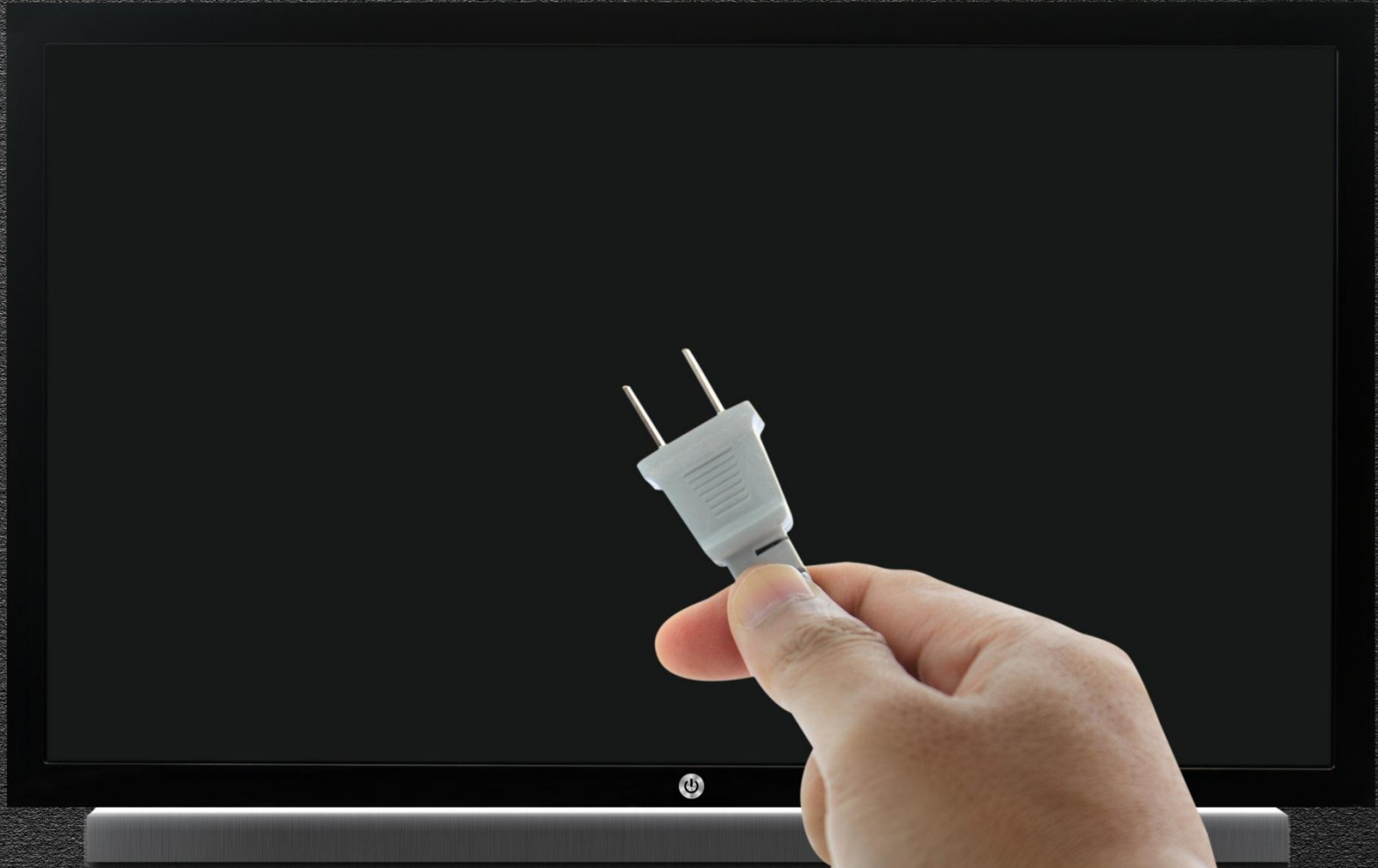
The image shows a series of mountain ranges receding into the distance. The mountains in the foreground are dark and detailed, while those further away become progressively lighter and less distinct, eventually blending into the hazy sky. This visual gradient serves as a metaphor for the concepts of clarity, vagueness, and ambiguity.

Clarity

Vague

Ambiguous

Disablement Provision



Disablement Provision



Design Around



Download





First Appeal

Affirmed

UNITED STATES COURT
OF
FEDERAL CLAIMS

A woman with reddish-brown hair, wearing a black judicial robe, sits on a brown leather bench. She is looking towards two people standing in front of her. The person on the left has long brown hair and is wearing a black top. The person on the right has dark hair and is wearing a patterned jacket. An American flag and a blue flag are visible in the background. The text "Contempt Motion" is overlaid in white.

Contempt Motion



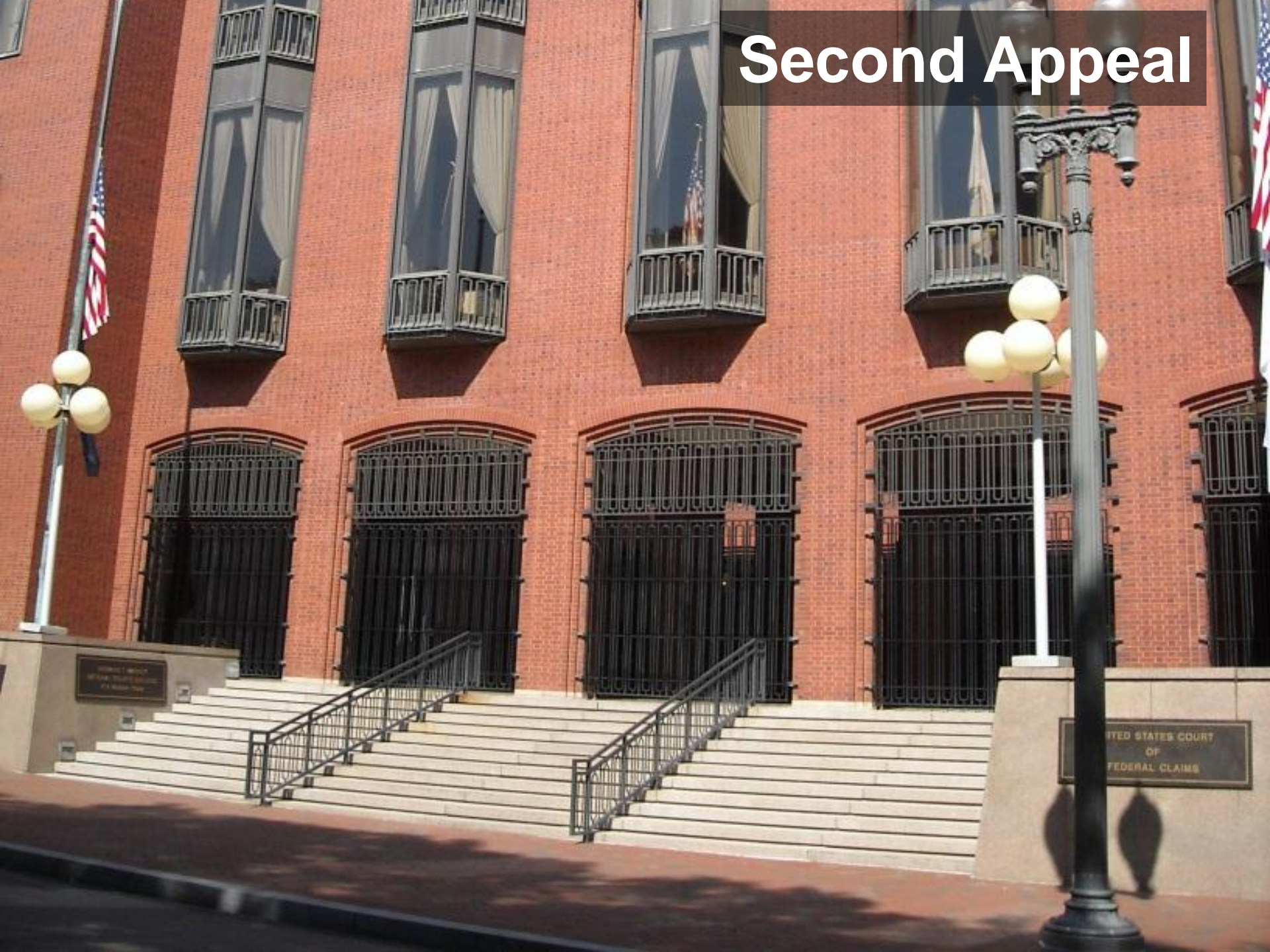
No colorable difference

Redesign infringes

Sanctions

Did not disable DVR

Second Appeal



Federal Circuit

Panel Affirmed

Rehearing En Banc



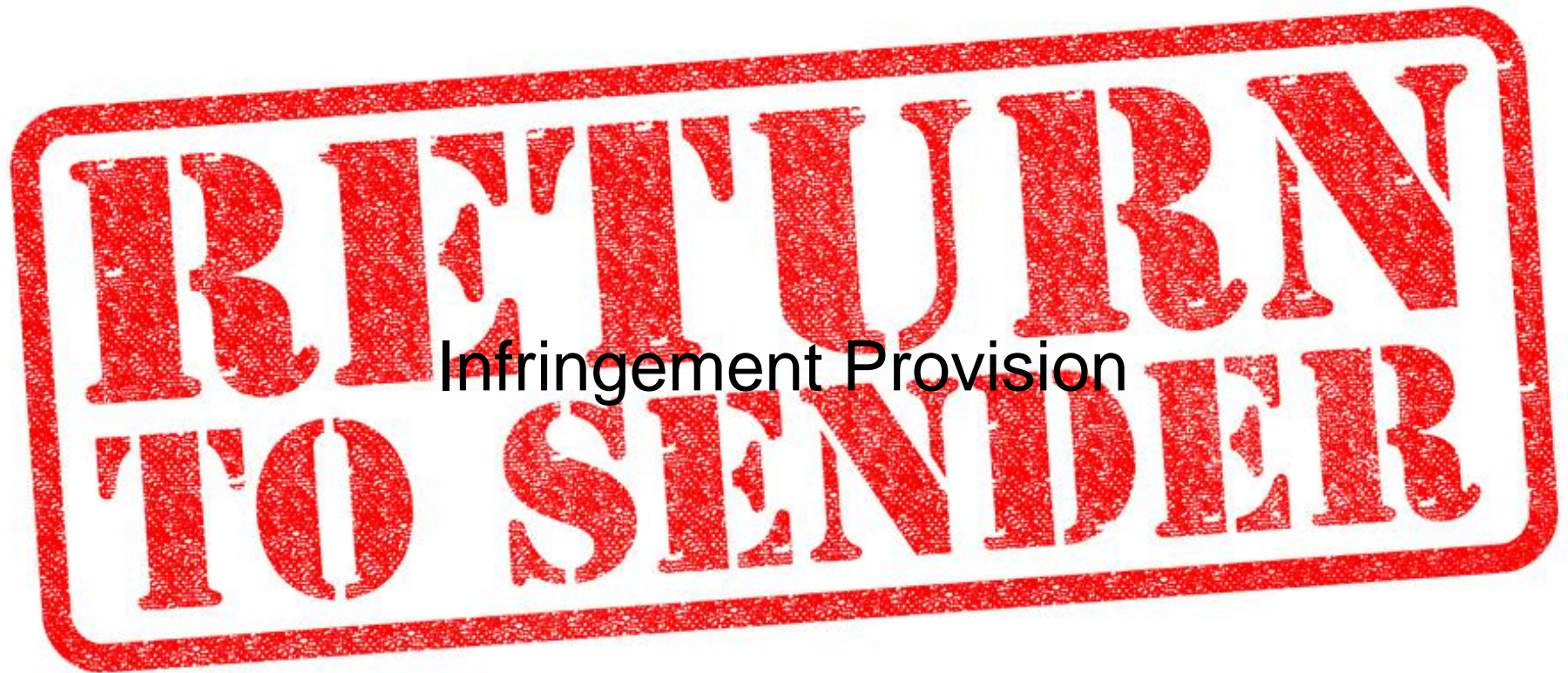
Unanimous Court

KSM two-part test is unworkable

Colorable differences between:

- ☐ Original and
- ☐ Redesign

Majority



A close-up photograph of two hands shaking in a firm grip. The hands are light-skinned and appear to be belonging to men. The person on the left is wearing a dark suit jacket, a white dress shirt, and a red tie with a small black pattern. The person on the right is wearing a dark suit jacket. The background is a solid dark grey. The text 'Majority' is in the top right, and 'Disablement Provision' is in a white box in the center.

Majority

Disablement Provision

Dissent

Infringing feature removed

Cannot violate infringement provision



Dissent

Vague

Disablement Provision

Ambiguous

Cannot be Enforced

Settlement

Dish and EchoStar Settle Patent Dispute With TiVo

By REUTERS

Published: May 2, 2011

Settlement

Dish Network and the [EchoStar Corporation](#) have agreed to pay [TiVo](#) \$500 million to settle a patent infringement lawsuit involving TiVo's video recording technology, putting an end to a long and costly legal battle.

Settlement

Dish and EchoStar, both controlled by [Charles W. Ergen](#), will make an initial payment of \$300 million to TiVo, with the remaining \$200 million to be paid in six equal annual installments from 2012 to 2017, the [companies said](#).

TiVo will license its technology to Dish and EchoStar, while EchoStar will license to TiVo certain DVR-related patents.

A background image of a theater stage with red curtains. The curtains are drawn back, revealing a dark stage floor. The top of the curtains is draped in a large, flowing arch. The sides of the curtains are held back by gold tassels.

Act II

Ninestar



17950

Ninestar



Available Now!



Available Now!

Replacement printer cartridges



Available Now!



Available Now!

Ninestar



Ninestar




A large cargo ship is docked at a port at night. A large crane is positioned on the left side of the ship, and its lights are illuminating the scene. The ship's hull is dark, and the water reflects the lights. The sky is a deep blue. The text "Ninestar" is in the top right corner, and "Exclusion Order" and "Cease and Desist Order" are overlaid on the ship's hull.

Ninestar

Exclusion Order

Cease and Desist Order

Violation of Commission's Orders



Exclusion Order
Cease and Desist Order

Federal Circuit

Appeal



Federal Circuit



Affirmed

Ninestar's Defense

Patent Exhaustion

Quanta v. LG Electronics

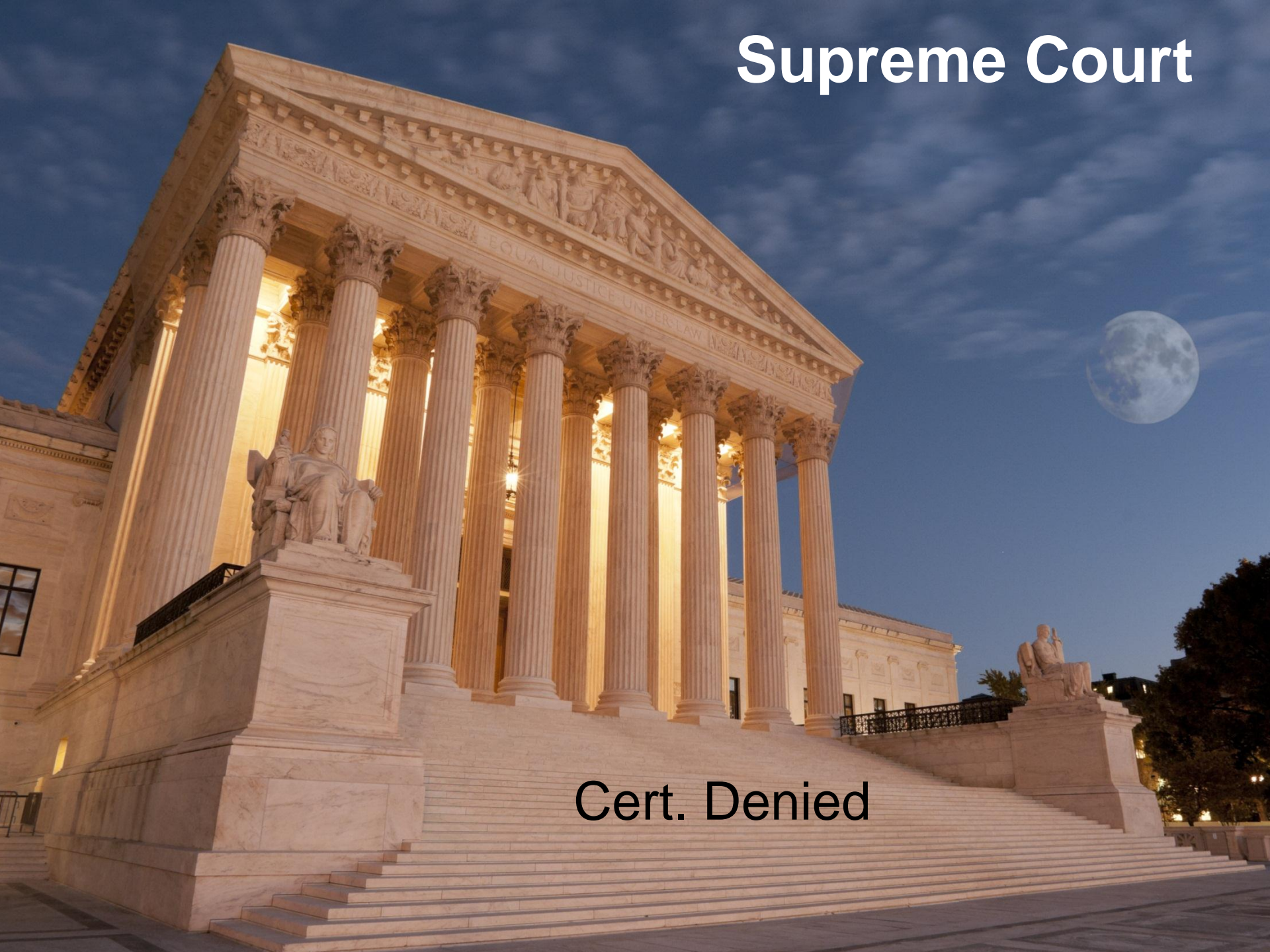
Kirtsaeng v. John Wiley & Sons

But, Ninestar Also Lied

False Declarations



Supreme Court

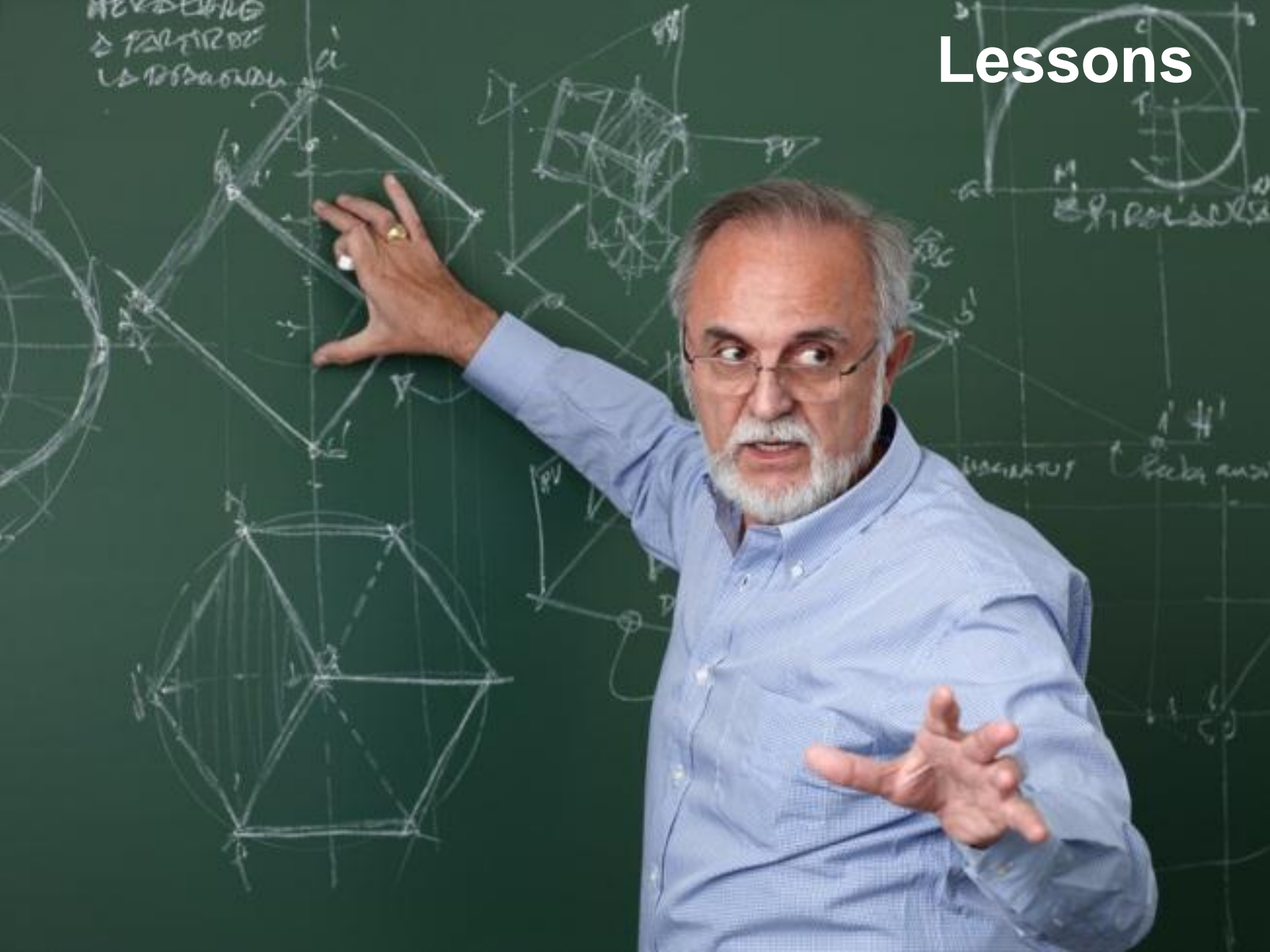


Cert. Denied

A background image of a theater stage with red curtains. The curtains are drawn back, revealing a dark stage floor. The top of the curtains is draped in a large, flowing arch. The sides of the curtains are held back by gold tassels.

Act III

Lessons



Redesign



Opinion of Counsel



Motion to Clarify





Appeal

UNITED STATES COURT
OF
FEDERAL CLAIMS

Credibility





The End

Thank You for Your Time and Attention