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?


Act I

The Players

TiVo


10 reasons you'll love TiVo.
It's TV, about a thousand times better. See why >

Echostar

Hughes

Dish Network

US006233389B1

(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
4,665,431	5/1987	Cooper	358/145
5,202,761	4/1993	Cooper	358/149
5,371,551	12/1994	Logan et al.	348/571
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

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OTHER PUBLICATIONS

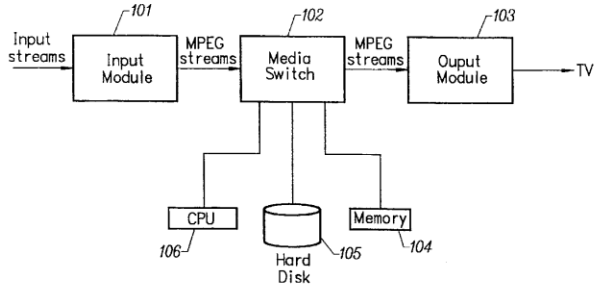
ASTARTE DVDirector™ Beta Testing Program.

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.

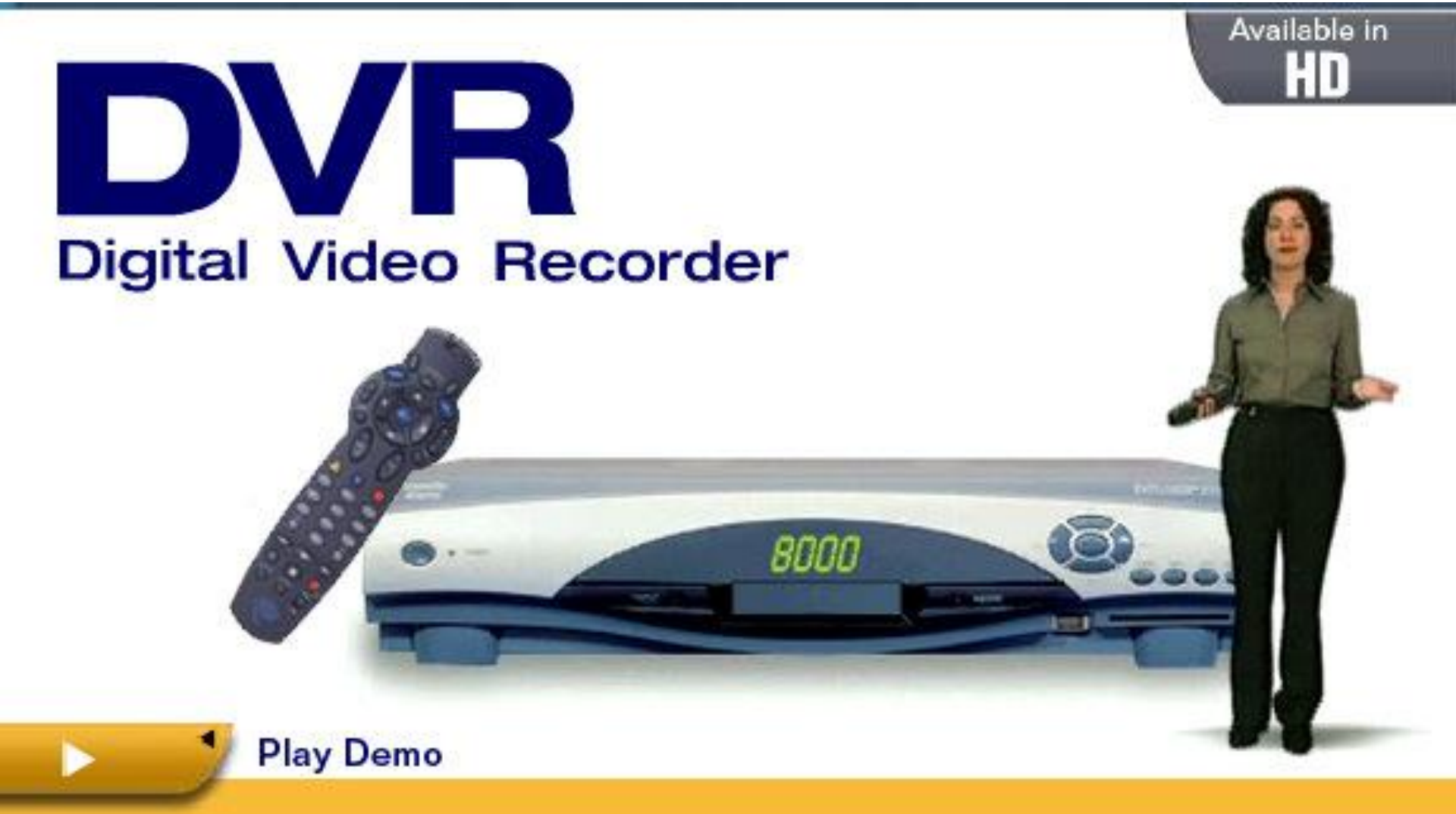
61 Claims, 12 Drawing Sheets

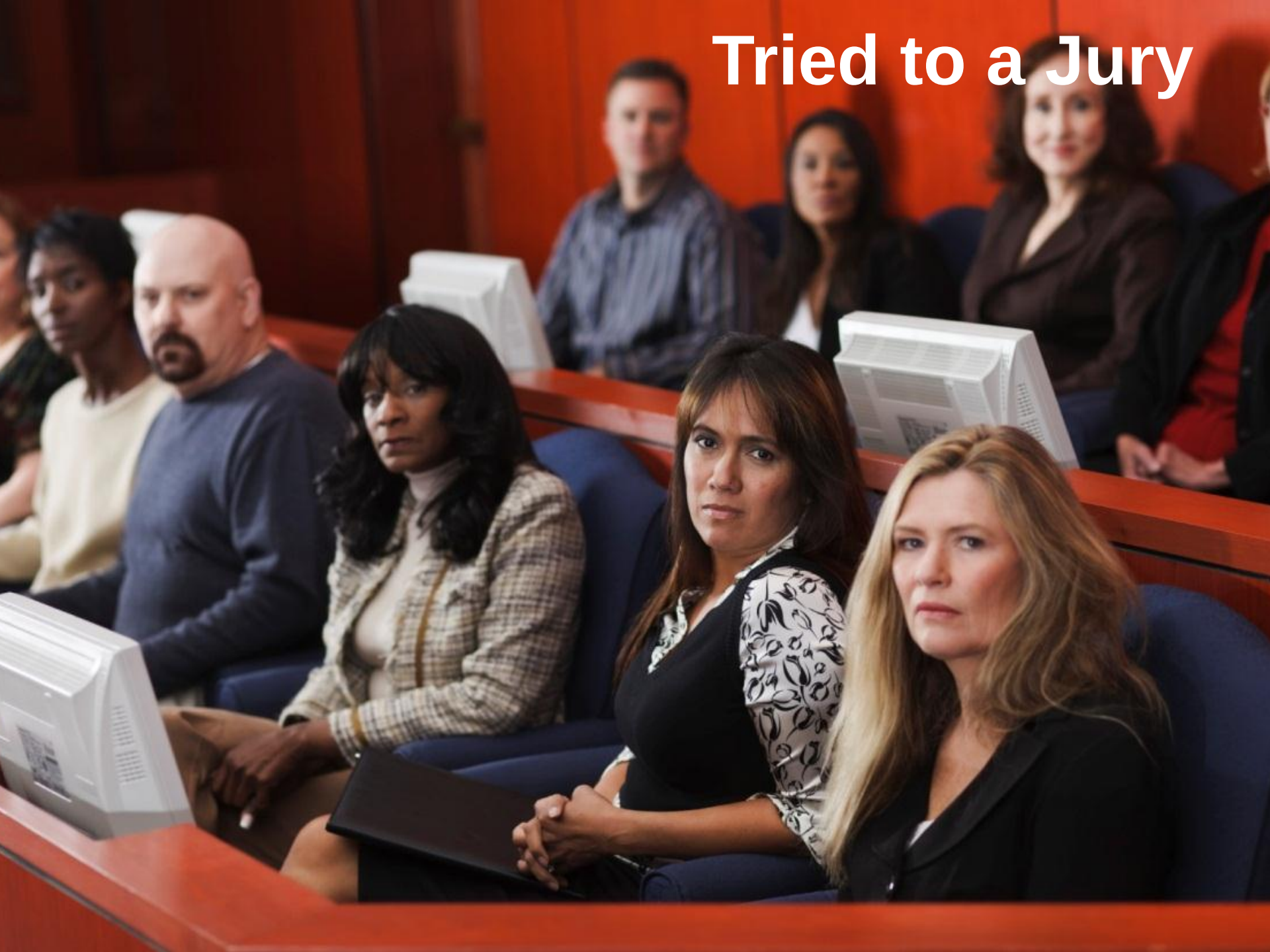


TiVo '389 Patent

Method and apparatus for time-shifting TV programs

DVR




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.

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Clarity

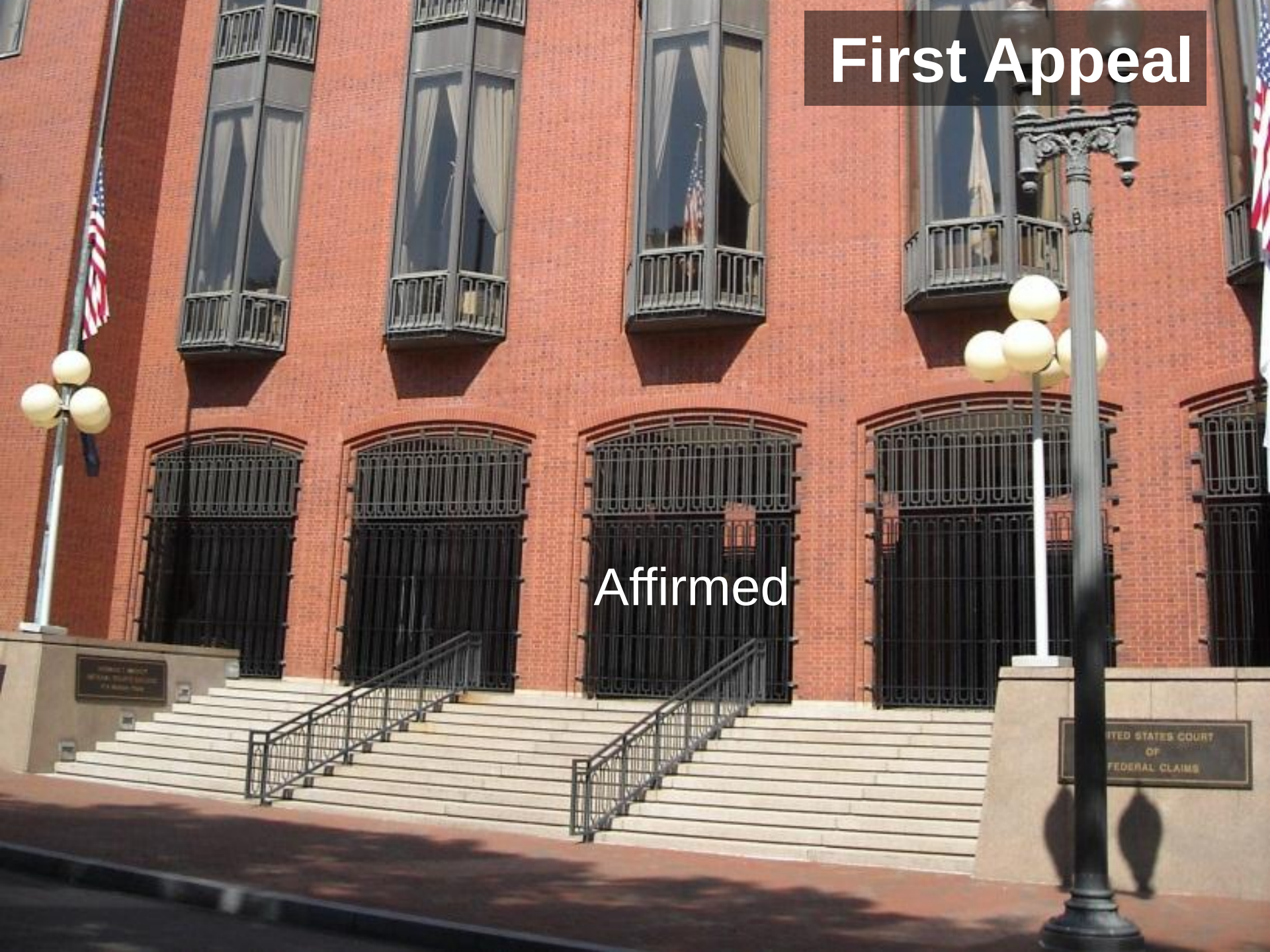

Clarity
Vague
Ambiguous

Disablement Provision

Disablement Provision

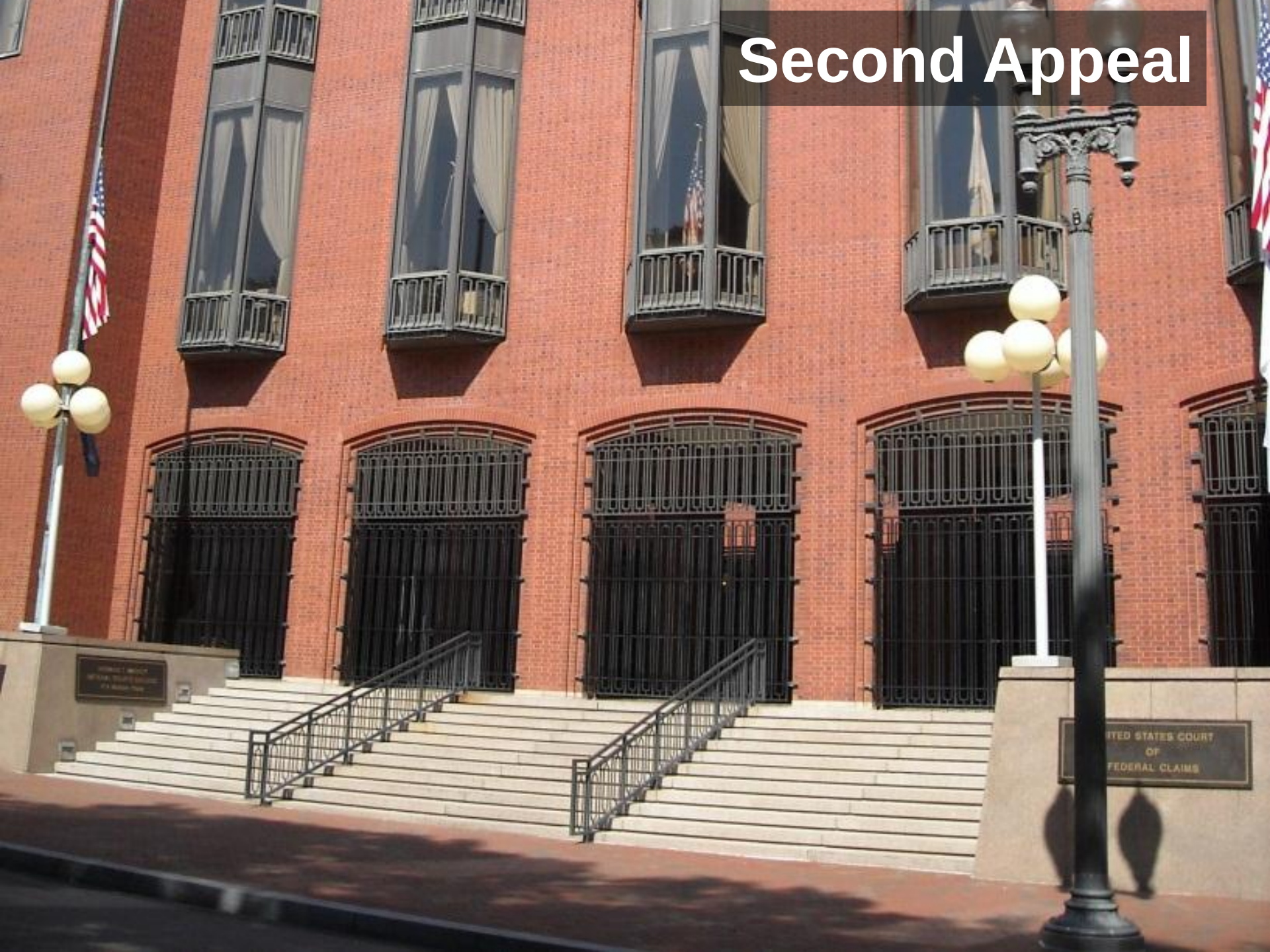
Design Around

Download


First Appeal
Affirmed

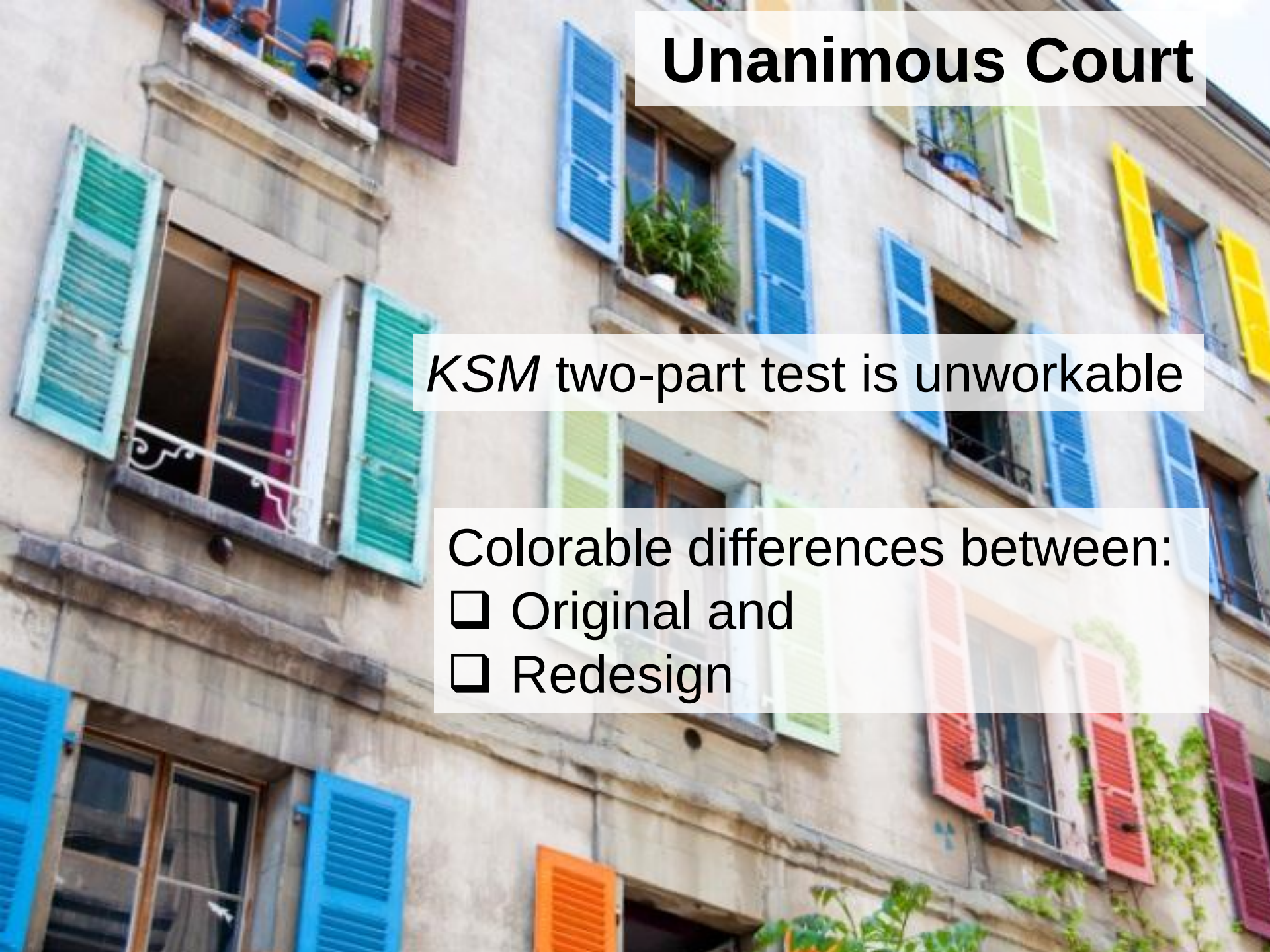

Contempt Motion


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

Infringement Provision


Majority
Disablement Provision

Dissent

Infringing feature removed

Cannot violate infringement provision


Dissent
Vague
Disablement Provision
Ambiguous
Cannot be Enforced

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.


Act II


Ninestar
G & G
NINESTAR
TECHNOLOGY CO., LTD.
17950

Ninestar

Replacement printer cartridges


Ninestar


Ninestar


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

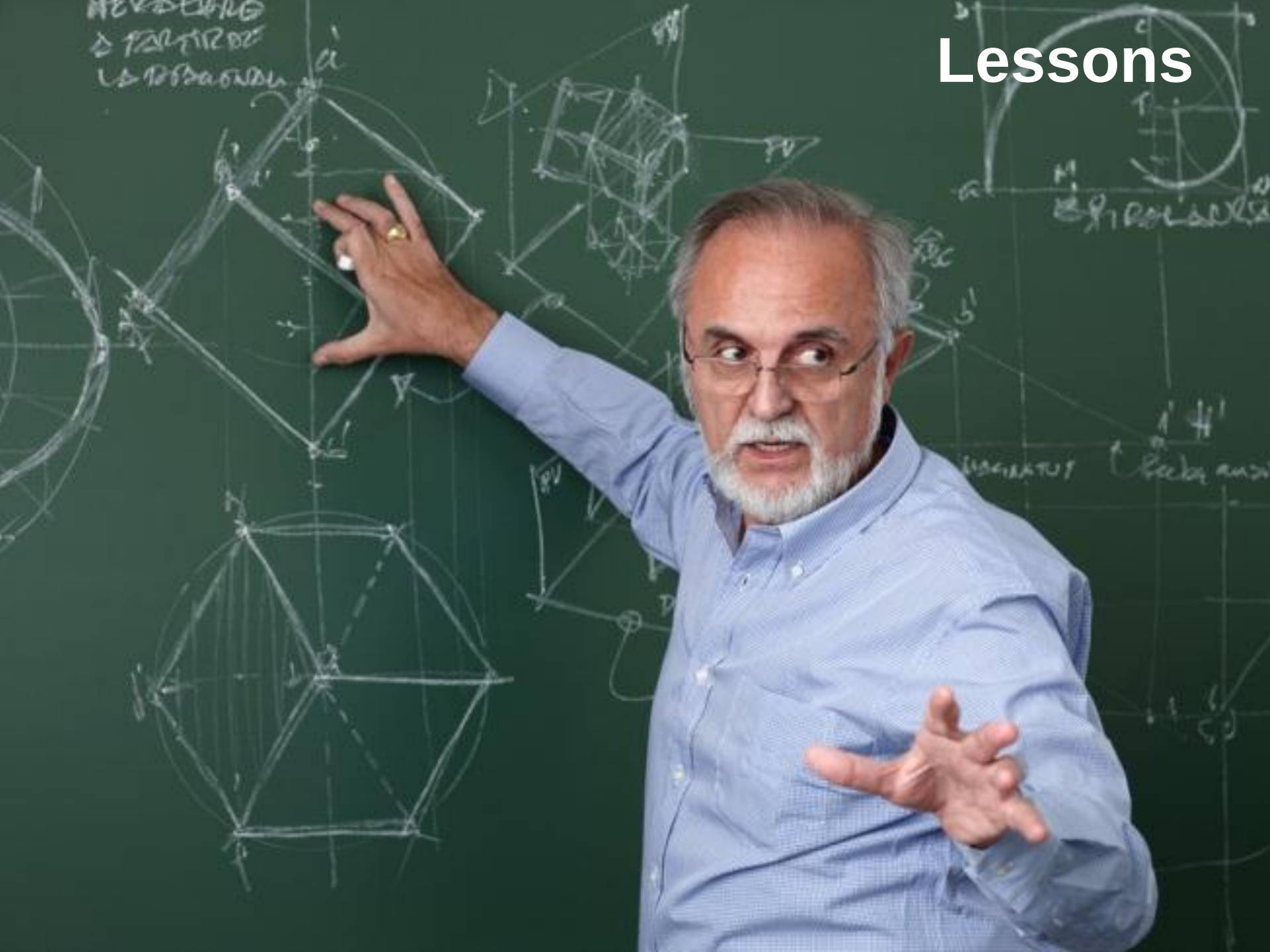
But, Ninestar Also Lied

False Declarations


Supreme Court
Cert. Denied


Act III

Lessons



Redesign

Opinion of Counsel


Motion to Clarify


Appeal

Credibility

Thank You for Your Time and Attention