



Robert Greene Sterne
 Jorge A. Goldstein
 David K.S. Cornwell
 Robert W. Esmond
 Tracy-Gene G. Durkin
 Michele A. Cimbalà
 Michael B. Ray
 Robert E. Sokohl
 Eric K. Steffe
 Michael Q. Lee
 John M. Covert
 Robert C. Millonig
 Donald J. Featherstone
 Timothy J. Shea, Jr
 Michael V. Messinger
 Judith U. Kim
 Jeffrey T. Helvey
 Eldora L. Ellison

Donald R. Banowitz
 Peter A. Jackman
 Brian J. Del Buono
 Mark Fox Evans
 Vincent L. Capuano
 Elizabeth J. Haanes
 Michael D. Specht
 Kevin W. McCabe
 Glenn J. Perry
 Edward W. Yee
 Grant E. Reed
 Virgil Lee Beason
 Theodore A. Wood
 Joseph S. Ostroff
 Jason D. Eisenberg
 Tracy L. Muller
 Jon E. Wright
 LuAnne M. DeSantis

Ann E. Summerfield
 Helene C. Carlson
 Cynthia M. Bouchez
 Timothy A. Doyle
 Galy L. Longsworth
 Lori A. Gordon
 Laura A. Vogel
 Bryan S. Waide
 Bashir M.S. Ali
 Shannon A. Carroll
 Anbar F. Khal
 Michelle K. Holoubek
 Marsha A. Rose
 Scott A. Schaller
 Lei Zhou
 W. Blake Coblenz
 James J. Pohl
 John T. Haran

Mark W. Rygiel
 Michael R. Malek*
 Carla Ji-Eun Kim
 Doyle A. Stever*
 Ulrike Winkler Jenks
 Paul A. Calvo
 Robert A. Schwartzman
 C. Matthew Rozier*
 Shameek Ghose
 Randall K. Baldwin
 Daniel J. Nevny
 Registered Patent Agents*
 Karen R. Markowicz
 Matthew J. Dowd
 Mita Mukherjee
 Scott M. Woodhouse
 Peter A. Socarras

Jeffrey K. Mills
 Danielle L. Letting
 Lori Brandes
 Steven C. Oppenheimer
 Aaron S. Lukas
 Gaurav Asthana

Of Counsel
 Edward J. Kessler
 Kenneth C. Bass III
 Malvin C. Guthrie
 Christopher P. Wrist

*Admitted only in Maryland
 *Admitted only in Virginia
 *Practice Limited to Federal Agencies

October 29, 2007

WRITER'S DIRECT NUMBER:
 (202) 772-8550
 INTERNET ADDRESS:
 EKESLER@SKGF.COM

Commissioner for Patents
 PO Box 1450
 Alexandria, VA 22313-1450

Art Unit 3992

Attn: Mail Stop Ex Parte Reexam

Re: Reexamination of U.S. Patent No. 6,233,389
 Control No. 90/007,750; Filed: October 17, 2005
 For: **Multimedia Time Warping System**
 Inventor: BARTON et al.
 Our Ref: 2513.001REX0

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Reply to the Final Office Action in Ex Parte Reexamination and Statement of Substance of Interview Under 37 C.F.R. §1.560;
2. Certification of Service on Third Party Requestor of Reply to Final Office Action and Statement of Substance of Interview; and
3. Petition for Extension of Time Under 37 C.F.R. § 1.550(c);
4. Online payment authorization in the amount of **\$200.00** to cover:
 \$200.00 Payment for Petition for Extension of Time.

The above-listed documents are filed electronically through EFS-Web.

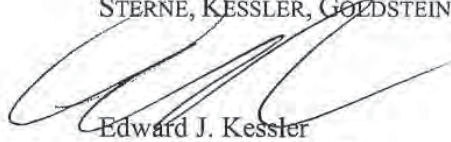
In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

Commissioner for Patents
October 29, 2007
Page 2

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Edward J. Kessler
Attorney for Applicant
Registration No. 25,688

EJK/jdp
Enclosures

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OCT 29 2007

CENTRAL REEXAMINATION UNIT

Fax Urgent Return reply requested Original will be sent as confirmation

To: **U.S. Patent & Trademark Office**
 Attention: **Special Program Examiner**
 Mark J. Reinhart
 From: **Edward J. Kessler**

Date: **October 29, 2007**
 Re: **Petition for Extension of Time**
 Under 37 C.F.R. 1.550(c)

Pages (including cover sheet): **4**
 Fax Number: **(571) 273-9900**

Our Reference: **2513.001REX0**
 Your Reference: **Reexam Control No.**
90/007,750; filed: October 17, 2005

Message

The original of this Petition and Reply to Final Office Action was electronically filed with the appropriate fee.

please sign and return this page as acknowledgment of receipt

If any portion of this transmission is not received clearly or in full, contact us at the numbers below.

This message is intended for the exclusive use of the individual or entity to which it is addressed. The message may contain information that is privileged, confidential, or otherwise exempt from disclosure under applicable law. If the reader of this message is not the intended recipient, you are hereby notified that any dissemination, distribution, copying or use of this communication in any way is strictly prohibited. If you have received this communication in error, please call us collect immediately, and return the original message to us at the above address via the U.S. Postal Service.

Sterne, Kessler, Goldstein & Fox P.L.L.C. : 1100 New York Avenue, NW : Washington, DC 20005 : 202.371.2600 f 202.371.2540

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

FAX RECEIVED

In re reexam of: U.S. Patent 6,233,289
(Barton)
Reexam Control No.: 90/007,750
Filed: October 17, 2005
For: **Multimedia Time Warping System**

Confirmation No.: 4653
Art Unit: 3992
Examiner: David E. Harvey
Atty. Docket No.: 2513.001REX0

OCT 29 2007

CENTRAL REEXAMINATION UNIT

Petition for Extension of Time Under 37 C.F.R. § 1.550(c)

Attn: Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Mail Stop: Ex Parte Reexam

Dear Sir:

Pursuant to 37 C.F.R. § 1.550(c), the patent owner, TiVo Inc. ("TiVo"), hereby requests an extension of time to respond to the Final Office Action mailed July 30, 2007.

A first extension of time was requested and granted. The currently extended due date is set to expire on October 30, 2007. An additional extension of time of one week, until November 5, 2007 is hereby requested. The extension of time is sought for the following reason.

On October 25, 2007, TiVo's representatives conducted an interview with Primary Examiner Ovidio Escalante, Primary Examiner Minh T. Nguyen, and Special Program Examiner Mark J. Reinhart. During that interview TiVo's representatives explained the differences between the invention, as recited in claim 1 and 32, and the cited reference, U.S. Patent No. 6,788,882 to Geer, et al (Geer). Subsequently, on October 26, 2007, a further telephone interview was conducted. Based on the results of those interviews, TiVo believes it is able to answer the questions raised by Primary Examiner Escalante and to clearly explain the differences between the present invention

- 2 -

Barton, *et al.*
Control No. 90/007,750


and the Geer disclosure. A response to the outstanding Office Action is being concurrently filed with this Petition.

This Petition is requested to enable the Examiner to review the response and act on it before the Patent Owner must take alternative action. It is hoped that the granting of this Petition and the Examiner's actions upon review of the Patent Owner's response will in fact expedite the disposition of this re-examination proceeding.

For the above reason, TiVo specifically requests that the extension of time to respond to the Office Action be granted for a period of one week to allow sufficient time for Examiner Escalante to review and act on the Patent Owner's response.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Edward J. Kessler
Attorney for Patent Owner
Registration No. 25,688

Date: October 29, 2007

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

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Atty. Docket No. 454030000041

PAGE 3/4 * RCVD AT 10/29/2007 10:30:10 AM [Eastern Daylight Time] * SVR:USPTO-EFXXRF-3/12 * DNIS:2739900 * CSID: * DURATION (mm-ss):01-12

Patent Under Reexamination: 6,233,389
Reexamination Control No.: 90/007,750
Examiner: Escalante, Ovidio
Art Unit: 3992

FAX RECEIVED
OCT 29 2007
CENTRAL REEXAMINATION UNIT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

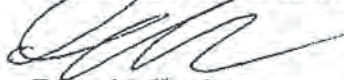
**CERTIFICATION OF SERVICE OF PETITION FOR EXTENSION OF TIME
UNDER 37 C.F.R. §1.550(c)**

In compliance with 37 C.F.R. § 1.550(f), the undersigned, on behalf of the patent owner, hereby certifies that a copy of this paper has been served on the third-party requester by first class mail on October 29, 2007. The name and address of the party served is as follows:

David L. Fehrman
Morrison & Foerster, LLP
555 W. Fifth Street, Suite 3500
Los Angeles, CA 90013

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Edward J. Kessler
Attorney for Patent Owner
Registration No. 25,688

Date: 29 Oct 2007
1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

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Litigation Search Report CRU 3999

Reexam Control No. 90/007,750

TO: Ovidio Escalante
Location: CRU
Art Unit : 3992
Date: 10/31/07

From: James R. Matthews
Location: CRU 3999
MDW 7C71
Phone: (571) 272-4233

Case Serial Number: 90/007,750

JamesR.Matthews@uspto.gov

Search Notes

U.S. Patent No6,233,389

- 1) I performed a KeyCite Search in Westlaw, which retrieves all history on the patent including any litigation.
- 2) I performed a search on the patent in Lexis CourtLink for any open dockets or closed cases.
- 3) I performed a search in Lexis in the Federal Courts and Administrative Materials databases for any cases found.
- 4) I performed a search in Lexis in the IP Journal and Periodicals database for any articles on the patent.
- 5) I performed a search in Lexis in the news databases for any articles about the patent or any articles about litigation on this patent.

Litigation was found and not stayed.

KEYCITE

HUS PAT 6233389 MULTIMEDIA TIME WARPING SYSTEM, Assignee: TiVo, Inc. (May 15, 2001)

History
Direct History

- => 1 **MULTIMEDIA TIME WARPING SYSTEM**, US PAT 6233389, 2001 WL 510913 (U.S. PTO Utility May 15, 2001) (NO. 09/126071)
Ruled Infringed by
- ▷ 2 **TiVo Inc. v. EchoStar Communications Corp.**, 446 F.Supp.2d 664 (E.D.Tex. Aug 17, 2006) (NO. 2:04 CV 1 DF)

Related References (U.S.A.)

- H 3 **TiVo, Inc. v. EchoStar Comm. Corp.**, 2005 WL 4131649 (E.D.Tex. Sep 26, 2005) (NO. CIVA 2:04CV1 (DF))

Court Documents
Verdict and Settlement Summaries (U.S.A.)

E.D.Tex.

- 4 **EchoStar Pauses After Jury Awards TiVo \$74M for Patent Infringement**, 2006 WL 1458443 (Verdict and Settlement Summary) (E.D.Tex. Apr. 13, 2006) (NO. 204CV00001)
- 5 **TiVo Inc. v. EchoStar Communications Corporation, Inc., EchoStar DBS Corporation, EchoStar Technologies Corporation and Echosphere Limited Liability Company**, 2006 WL 1493710 (Verdict and Settlement Summary) (E.D.Tex. Apr. 13, 2006) (NO. 2-04CV01DF)

Trial Court Documents (U.S.A.)

E.D.Tex. Trial Pleadings

- 6 **TIVO INC.**, a Delaware corporation, Plaintiff, v. 1. **ECHOSTAR COMMUNICATIONS CORPORATION**, a Nevada corporation, and 2. **Echostar Dbs Corporation**, a Colorado corporation, Defendant., 2004 WL 3357025 (Trial Pleading) (E.D.Tex. Jan. 5, 2004) **Complaint for Patent Infringement** (NO. 2-04CV-01DF)
- 7 **TIVO INC.**, a Delaware corporation, Plaintiff, v. 1. **ECHOSTAR COMMUNICATIONS CORPORATION**, a Nevada corporation, 2. **EchoStar DBS Corporation**, a Colorado corporation, 3. **EchoStar Technologies Corporation**, a Texas corporation, and 4. **Echosphere Limited Liability Company**, a Colorado limited liability company, Defendants., 2004 WL 3357040 (Trial Pleading) (E.D.Tex. Jan. 15, 2004) **Amended Complaint for Patent Infringement** (NO. 2-04CV01DF)
- 8 **TIVO INC.**, a Delaware corporation, Plaintiff, v. 1. **ECHOSTAR COMMUNICATIONS CORPORATION**, a Nevada corporation; 2. **EchoStar DBS Corporation**, a Colorado corporation; 3. **EchoStar Technologies Corporation**, a Texas corporation; and 4. **Echosphere Limited Liability Company**, a Colorado limited liability company, Defendants., 2004 WL 3357063 (Trial Pleading) (E.D.Tex. Mar. 1, 2004) **Defendants Echostar Technologies Corporation and Echosphere Limited Liability Company's Answer to Am** (NO. 2-04CV01DF)

- 9 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants. and Related Counterclaims., 2005 WL 1365521 (Trial Pleading) (E.D.Tex. Mar. 21, 2005) **Defendants Echostar Communications Corporation and Echostar DBS Corporation's Answer to Amended Comp (NO. 2-04CV01DF)**
- 10 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants. And Related Counterclaims., 2005 WL 3966191 (Trial Pleading) (E.D.Tex. Mar. 21, 2005) **Defendants Echostar Communications Corporation and Echostar DBS Corporation's Answer to Amended Comp (NO. 2-04CV01DF)**
- 11 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 3966192 (Trial Pleading) (E.D.Tex. Apr. 11, 2005) **TiVo Inc.'s Opening Brief on Claim Construction (NO. 2-04CV-01)**
- 12 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 3966190 (Trial Pleading) (E.D.Tex. May 18, 2005) **Echostar's Opening Claim Construction Brief (NO. 2-04CV01DF)**
- 13 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. Echostar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; 4. Echosphere Limited Liability Company, a Colorado limited liability company; and 5. Echostar Satellite LLC, a Colorado limited liability company, Defendants., 2006 WL 814167 (Trial Pleading) (E.D.Tex. Feb. 9, 2006) **Defendants Echostar Technologies Corporation, Echosphere Limited Liability Company, and Echostar Sat (NO. 2-04CV01DF)**
- 14 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. Echostar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; 4. Echosphere Limited Liability Company, a Colorado limited liability company; and 5. Echostar Satellite LLC, a Colorado limited liability company, Defendants., 2006 WL 814195 (Trial Pleading) (E.D.Tex. Feb. 9, 2006) **Defendants Echostar Communications Corporation and Echostar DBS Corporation's Second Amended Answer (NO. 2-04CV01DF)**

E.D.Tex. Trial Motions, Memoranda and Affidavits

- 15 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2004 WL 3768001 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Mar. 1, 2004) **Defendants' Motion to Dismiss and Transfer (NO. 2-04CV01DF)**
- 16 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2004 WL 3768004 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Mar. 1, 2004) **Defendants' Motion to Dismiss and Transfer (NO. 2-04CV01DF)**

- 17 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendant., 2004 WL 3357067 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Mar. 26, 2004) **Tivo's Opposition to Motion to Transfer** (NO. 204-CV-01-DF)
- 18 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar Dbs Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendant., 2004 WL 3357071 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Mar. 26, 2004) **Tivo's Opposition to Motion to Dismiss** (NO. 204-CV-01-DF)
- 19 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendant., 2004 WL 3768002 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Mar. 26, 2004) **TiVo's Opposition to Motion to Transfer** (NO. 204-CV-01-DF)
- 20 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendant., 2004 WL 3768003 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Mar. 26, 2004) **TiVo's Opposition to Motion to Dismiss** (NO. 204-CV-01-DF)
- 21 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2004 WL 3357075 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Apr. 5, 2004) **Defendants' Reply Brief in Support of Motion to Transfer** (NO. 2-04CV01DF)
- 22 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2004 WL 3357078 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Apr. 5, 2004) **Defendants' Reply Brief in Support of Motion to Dismiss** (NO. 2-04CV01DF)
- 23 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2004 WL 3768005 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Apr. 5, 2004) **Defendants' Reply Brief in Support of Motion to Transfer** (NO. 2-04CV01DF)
- 24 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2004 WL 3768006 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Apr. 5, 2004) **Defendants' Reply Brief in Support of Motion to Dismiss** (NO. 2-04CV01DF)

- 25 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar Dbs Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendant., 2004 WL 3357080 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Apr. 12, 2004) **Tivo's Sur-Reply in Support of Opposition to Motion to Transfer** (NO. 204-CV-01-DF)
- 26 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendant., 2004 WL 3768007 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Apr. 12, 2004) **TiVo's Sur-Reply in Support of Opposition to Motion to Transfer** (NO. 204-CV-01-DF)
- 27 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar Dbs Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendant., 2004 WL 3357083 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Apr. 16, 2004) **Tivo's Sur-Reply in Support of its Opposition to Motion to Dismiss** (NO. 204-CV-01-DF)
- 28 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendant., 2004 WL 3768008 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Apr. 16, 2004) **TiVo's Sur-Reply in Support of its Opposition to Motion to Dismiss** (NO. 204-CV-01-DF)
- 29 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 3966209 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Feb. 7, 2005) **Stipulated Protective Order** (NO. 2-04CV-01DF)
- 30 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 1365517 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Mar. 2, 2005) **Echostar Technologies Corporation and Echosphere Limited Liability Company's Motion to Compel Interr** (NO. 2-04CV01DF)
- 31 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 3966208 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Mar. 2, 2005) **Echostar Technologies Corporation and Echosphere Limited Liability Company's Motion to Compel Interr** (NO. 2-04CV01DF)
- 32 TiVo INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar Dbs Corporation, a Colorado corporation, 3. EchoStar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants, And Related Counterclaims., 2005 WL 4170701 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Mar. 16, 2005) **Tivo's Opposition to EchoStar's Motion to Compel a More Detailed Interrogatory Response** (NO. 2-04CV-01)

- 33 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, Echostar Dbs Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants, and Related Counterclaims., 2005 WL 1365519 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Mar. 17, 2005) **Tivo's Motion to Compel Echostar's Production of Documents, Interrogatory Responses, and Attendance a** (NO. 2-04CV-01)
- 34 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants, And Related Counterclaims., 2005 WL 3966211 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Mar. 17, 2005) **TiVo's Motion to Compel Echostar's Production of Documents, Interrogatory Responses, and Attendance** (NO. 2-04CV-01)
- 35 TIVO INC., a Delaware corporation, Plaintiff, v. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; EchoStar DBS Corporation, a Colorado corporation; EchoStar Technologies Corporation, a Texas corporation; and Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 3966212 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Mar. 17, 2005) **Defendants' Responses and Objections to ""First Set of Requests for Production of Documents to all D** (NO. 204CV01DF)
- 36 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 1365523 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Mar. 21, 2005) **Defendants' Memorandum of Points and Authorities in Opposition to Plaintiff Tivo Inc.'s Motion to Am** (NO. 2-04CV01DF)
- 37 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 1365526 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Mar. 23, 2005) **Reply Memorandum of Points and Authorities in Support of Echostar Technologies Corporation's and Ech** (NO. 2-04CV01DF)
- 38 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 3966214 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Mar. 23, 2005) **Reply Memorandum of Points and Authorities in Support of Echostar Technologies Corporation's and Ech** (NO. 2-04CV01DF)
- 39 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 1365529 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Mar. 24, 2005) **TiVo's Reply in Support of its Motion to Amend the Scheduling Order** (NO. 2-04CV-01)
- 40 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants, And Related Counterclaims., 2005 WL 1365532 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Mar. 29, 2005) **Defendants' Opposition to TiVo's Motion to Compel Echostar's Production of Documents, Interrogatory** (NO. 2-04CV01DF)

- 41 TIVO INC., a Delaware corporation, Plaintiff, v. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; EchoStar DBS Corporation, a Colorado corporation; EchoStar Technologies Corporation, a Texas corporation; and Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 3966215 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Mar. 29, 2005) **Defendants' Responses and Objections to ""First Set of Requests for Admissions to all Defendants (No (NO. 204CV01DF)**
- 42 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 1365534 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Mar. 30, 2005) **TiVo's Sur-Reply in Opposition to Echostar's Motion to Compel A More Detailed interrogatory Response (NO. 2-04CV-01)**
- 43 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants. And Related Counterclaims., 2005 WL 3966216 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Mar. 30, 2005) **TiVo's Sur-Reply in Opposition to Echostar's Motion to Compel a More Detailed Interrogatory Response (NO. 2-04CV-01)**
- 44 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar Dbs Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants. and Related Counterclaims, 2005 WL 1365536 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Apr. 5, 2005) **Tivo's Reply to Defendants' Opposition to Tivo's Motion to Compel Echostar's Production of Documents (NO. 2-04CV-01)**
- 45 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar Dbs Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 1365538 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Apr. 11, 2005) **Echostar's Opening Claim Construction Brief (NO. 2-04CV01DF)**
- 46 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar Dbs Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants. and Related Counterclaims, 2005 WL 1365540 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Apr. 27, 2005) **Tivo's Opposition to Defendants' Second Motion to Compel (NO. 2-04CV-01)**
- 47 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants. And Related Counterclaims., 2005 WL 3966217 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Apr. 27, 2005) **Tivo's Opposition to Defendants' Second Motion to Compel (NO. 2-04CV-01)**
- 48 TIVO INC., a Delaware corporation, Plaintiff, v. 1. SCHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2 EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 1365542 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Apr. 29, 2005) **Defendants' Third Motion to Compel (NO. 2-04CV01DF)**

- 49 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 3966218 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Apr. 29, 2005) **Defendants' Third Motion to Compel** (NO. 2-04CV01DF)
- 50 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 1365544 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. May 4, 2005) **Reply Brief in Support of Defendants' Second Motion to Compel** (NO. 2-04CV01DF)
- 51 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 1365546 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. May 9, 2005) **Defendants' Fifth Motion to Compel** (NO. 2-04CV01DF)
- 52 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. EchoStar DBS Corporation, a Colorado corporation, 3. EchoStar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 1365548 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. May 11, 2005) **Tivo's Opposition to Defendants' Third Motion to Compel** (NO. 2-04CV-01)
- 53 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. EchoStar DBS Corporation, a Colorado corporation, 3. EchoStar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 1365551 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. May 11, 2005) **Tivo's Sur-Reply to Defendants' Second Motion to Compel** (NO. 2-04CV-01)
- 54 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. EchoStar DBS Corporation, a Colorado corporation, 3. EchoStar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants. And Related Counterclaims., 2005 WL 3966219 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. May 11, 2005) **Tivo's Opposition to Defendants' Third Motion to Compel** (NO. 2-04CV-01)
- 55 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. EchoStar DBS Corporation, a Colorado corporation, 3. EchoStar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 3966220 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. May 12, 2005) **Tivo Inc.'s Opposition Brief on Claim Construction** (NO. 2-04CV-01)
- 56 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 1594130 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. May 16, 2005) **Defendants' Reply in Support of Its Third Motion to Compel** (NO. 2-04CV01DF)

- 57 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 3966195 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. May 16, 2005) **Defendants' Reply in Support of its Third Motion to Compel** (NO. 2-04CV01DF)
- 58 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 3966193 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. May 18, 2005) **TiVo Inc.'s Opening Brief on Claim Construction** (NO. 2-04CV-01)
- 59 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 3966194 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. May 18, 2005) **TiVo Inc.'s Opposition Brief on Claim Construction** (NO. 2-04CV-01)
- 60 TIVO INC., a Delaware corporation Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants; And Related Counterclaims., 2005 WL 1594131 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. May 23, 2005) **Tivo's Opposition to Defendants' Fifth Motion to Compel** (NO. 2-04CV-01)
- 61 TIVO INC., a Delaware corporation Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants; And Related Counterclaims., 2005 WL 1594132 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. May 23, 2005) **Tivo's Sur-Reply to Defendants' Third Motion to Compel** (NO. 2-04CV-01)
- 62 TIVO INC., a Delaware corporation Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants. And Related Counterclaims., 2005 WL 3966196 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. May 23, 2005) **TiVo's Opposition to Defendants' Fifth Motion to Compel** (NO. 2-04CV-01)
- 63 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 1594133 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Jun. 2, 2005) **Defendants' Sixth Motion to Compel** (NO. 2-04CV01DF)
- 64 TIVO INC., a Delaware corporation, Plaintiff, v. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, Echostar DBS Corporation, a Colorado corporation, Echostar Technologies Corporation, a Texas corporation, and Echosphere Limited Liability Company, a Colorado limited liability company, Defendants; And Related Counterclaims., 2005 WL 1924059 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Jun. 16, 2005) **Tivo's Opposition to Defendants' Sixth Motion to Compel** (NO. 2-04CV-01)

- 65 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants. And Related Counterclaims., 2005 WL 3966197 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Jun. 16, 2005) **TiVo's Opposition to Defendants' Sixth Motion to Compel** (NO. 2-04CV-01)
- 66 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR, COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 1924060 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Jun. 23, 2005) **Defendants' Reply Brief in Support of the Sixth Motion to Compel** (NO. 2-04CV01DF)
- 67 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 3966198 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Jun. 23, 2005) **Defendants' Reply Brief in Support of the Sixth Motion to Compel** (NO. 2-04CV01DF)
- 68 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 3966199 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Jul. 8, 2005) **Memorandum of Points and Authorities in Support of Echostar's Seventh Motion to Compel** (NO. 2-04CV01DF)
- 69 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 3966200 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Jul. 15, 2005) **Notice of Motion and Memorandum in Support of Motion for Partial Summary Judgment of Non-Infringemen** (NO. 2-04CV01DF)
- 70 TIVO INC., a Delaware Corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada Corporation, 2. Echostar DBS Corporation, a Colorado Corporation, 3. Echostar Technologies, Corporation, a Texas Corporation, and 4. Echosphere Limited Liability Company, a Colorado Limited Liability Company, Defendants., 2005 WL 2299354 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Jul. 20, 2005) **Tivo's Opposition to Defendants' Motion to Enforce May 24, 2005 Resolution** (NO. 2-04CV-01)
- 71 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants; and Related counterclaims., 2005 WL 2299364 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Jul. 20, 2005) **Tivo's Opposition to Defendants' Seventh Motion to Compel** (NO. 2-04CV-01)
- 72 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants. And Related Counterclaims., 2005 WL 3966201 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Jul. 20, 2005) **TiVo's Opposition to Defendants' Seventh Motion to Compel** (NO. 2-04CV-01)

- 73 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 2299368 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Jul. 26, 2005) **Reply in Support of Echostar's Motion to Enforce May 24, 2005 Resolution and for a Court Order Conce** (NO. 2-04CV01DF)
- 74 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 2299371 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Jul. 26, 2005) **Reply Memorandum of Points and Authorities in Support of Echostar's Seventh Motion to Compel** (NO. 2-04CV01DF)
- 75 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 3966202 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Jul. 26, 2005) **Reply Memorandum of Points and Authorities in Support of Echostar's Seventh Motion to Compel** (NO. 2-04CV01DF)
- 76 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. EchoStar DBS Corporation, a Colorado corporation, 3. EchoStar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants; and Related Counterclaims., 2005 WL 2299373 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Jul. 27, 2005) **Tivo's Opposition to Defendants' Eighth Motion to Compel; Request for Sanctions** (NO. 2-04CV-01)
- 77 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. EchoStar DBS Corporation, a Colorado corporation, 3. EchoStar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 2299377 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Jul. 27, 2005) **Tivo Inc.'s Opposition to Echostar's Motion for Partial Summary Judgment of Non-Infringement: (1) No** (NO. 2-04CV-01)
- 78 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 2299376 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Jul. 28, 2005) **Reply Brief in Support of Echostar'S Eighth Motion to Compel** (NO. 204-CV-00001-DF)
- 79 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 2299381 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Aug. 3, 2005) **Echostar's Reply Briece in Support of Motion for Partial Summary Judgment of non-Infringement: (1) no** (NO. 2-04CV01DF)
- 80 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 3966203 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Aug. 3, 2005) **Echostar's Reply Brief in Support of Motion for Partial Summary Judgment of Non-Infringement: (1) No** (NO. 2-04CV01DF)

- 81 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants; and Related Counterclaims., 2005 WL 2299384 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Aug. 9, 2005) **Defendants' Opposition to Tivo's Second Motion to Compel** (NO. 2-04CV01DF)
- 82 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 2666748 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Aug. 9, 2005) **Echostar's Reply in Support of Its Motion in Limine No. 2 - To Exclude Reference to Or Evidence Rega** (NO. 204-CV-00001-DF)
- 83 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants, And Related Counterclaims., 2005 WL 3966204 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Aug. 9, 2005) **Defendants' Opposition to Tivo's Second Motion to Compel** (NO. 2-04CV01DF)
- 84 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 2299387 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Aug. 10, 2005) **Plaintiff Tivo Inc.'s Third Motion to Compel** (NO. 2-04CV-01)
- 85 TIVO INC., a Delaware corporation Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants. And Related Counterclaims., 2005 WL 3966205 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Aug. 10, 2005) **Plaintiff Tivo Inc.'s Third Motion to Compel** (NO. 2-04CV-01)
- 86 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar Dbs Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 2666735 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Aug. 15, 2005) **Tivo's Reply in Support of its Second Motion to Compel** (NO. 204-CV-00001-DF)
- 87 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 3966206 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Aug. 18, 2005) **Notice of Motion, Motion and Memorandum in Support of Motion for Partial Summary Judgment of Invalid** (NO. 2-04CV01DF)
- 88 TIVO INC., a Delaware corporation, Plaintiff, v. 1. Echostar Communications Corporation, a Nevada corporation, 2. Echostar Dbs Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 2666736 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Aug. 26, 2005) **Tivo Inc.'s Motions in Limine Nos. 3A-3C** (NO. 204-CV-00001-DF)

- 89 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 2667079 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Aug. 26, 2005) **Tivo's Motion in Limine No. 2: To Preclude Evidence/Argument in Front of the Jury Regarding Echostar** (NO. 2-04CV-01)
- 90 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 2666700 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Aug. 30, 2005) **TiVo Inc.'s Opposition to Echostar's Motion For Partial Summary Judgment of Invalidity due to Indefi** (NO. 204-CV-00001-DF)
- 91 TIVO INC., a Delaware corporation Plaintiff, v. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, Echostar Dbs Corporation, a Colorado corporation, Echostar Technologies Corporation, a Texas corporation, and Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 2666701 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Aug. 31, 2005) **Tivo Inc.'s Opposition to Echostar's Motion Inlimine No. 4: to Preclude Tivo from Denying the Existe** (NO. 2-04-CV-00001-DF)
- 92 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar Dbs Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 2666738 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Aug. 31, 2005) **Tivo's Opposition to Echostar's Motion in Limine No. 2: Re: Written Opinion of Counsel** (NO. 204-CV-00001-DF)
- 93 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 2667080 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Aug. 31, 2005) **TiVo Inc.'s Opposition to Echostar's Motion in Limine No. 6 - to Preclude Reference to, Use of, or R** (NO. 2-04CV-01)
- 94 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants, And Related Counterclaims., 2005 WL 3966207 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Aug. 31, 2005) **Defendants' Protective Motion for Reconsideration of the Court's Order of August 17, 2005** (NO. 2-04CV01DF)
- 95 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. EchoStar DBS Corporation, a Colorado corporation, 3. EchoStar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants, And Related Counterclaims., 2005 WL 4170699 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Aug. 31, 2005) **Two Inc.'s Opposition to EchoStar's Motion in Limine No. 11: to Preclude ""Late Disclosed" Exhibits** (NO. 2-04CV-01)
- 96 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar Dbs Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 2666741 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Sep. 1, 2005) **Echostar's Surreply Brief in Support of its Motion for Partial Summary Judgment of Non-Infringement:** (NO. 204-CV-00001-DF)

- 97 TIVO INC., a Delaware corporation, Plaintiff, v. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, Echostar DBS Corporation, a Colorado corporation, Echostar Technologies Corporation, a Texas corporation, and Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 2666743 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Sep. 6, 2005) **Tivo Inc.'s Opposition to Echostar's Motion Inlimine No. 3: to Preclude any Reference To use Of, and** (NO. 204-CV-00001-DF)
- 98 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada Corporation; 2. EchoStar Dbs Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 2666702 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Sep. 7, 2005) **Echostar's Reply in Support of its Motion for Partial Summary Judgment of Invalidity Due to Indefini** (NO. 204-CV-00001-DF)
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- 101 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 2667082 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Sep. 7, 2005) **Echostar's Opposition to Tivo's Motion in Limine No. 2: to Preclude Evidence/Argument in Front of th** (NO. 2-04CV01DF)
- 102 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 2666703 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Sep. 9, 2005) **Echostar's Reply to Motion in Limine No. 1 - To Preclude Reference To, Use Of, And Reliance Upon The** (NO. 204-CV-00001-DF)
- 103 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar Dbs Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 2666704 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Sep. 9, 2005) **Echostar's Reply re Motion in Limine No. 10 - to Preclude Reference to, use of and Reliance upon oth** (NO. 2-04CV01DF)
- 104 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar Dbs Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 2666749 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Sep. 9, 2005) **Echostar's Reply in Support of its Motion in Limine No. 5 to Preclude Reference to, Use of, and Reli** (NO. 204-CV-00001-DF)

- 105 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 2666750 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Sep. 9, 2005) **Defendants' Motion to Strike Tivo Inc.'s Cross Motion Re: Partial Summary Judgment of Infringement o** (NO. 204-CV-00001-DF)
- 106 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 2667084 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Sep. 9, 2005) **Echostar's Reply re Motion in Limine No. 9 -- to Preclude Evidence on Doctrine of Equivalents** (NO. 2-04CV01DF)
- 107 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 4170700 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Dec. 29, 2005) **Motion to Reconsider the Court's Order of December 21, 2005.** (NO. 2-04CV01DF)
- 108 TIVO INC., a Delaware corporation Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants. And Related Counterclaims., 2006 WL 502210 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Jan. 6, 2006) **Tivo Inc.'s Sur-Reply to Echostar's Motion to Reconsider the Court's Order of December 21, 2005 [Doe** (NO. 2-04CV-01)
- 109 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, 4. Echosphere Limited Liability Company, a Colorado limited liability company, and 5. Echostar Satellite LLC, a Colorado limited liability company, Defendants. And Related Counterclaims., 2006 WL 1004918 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Jan. 30, 2006) **TiVo's Brief in Support of its Objections to Defendants' Trial Exhibits** (NO. 2-04CV-01)
- 110 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, 4. Echosphere Limited Liability Company, a Colorado limited liability company, and 5. Echostar Satellite LLC, a Colorado limited liability company, Defendants. And Related Counterclaims., 2006 WL 1004919 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Jan. 30, 2006) **TiVo's Brief in Opposition to Echostar's Objections to TiVo's Trial Exhibits** (NO. 2-04-CV-01)
- 111 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, 4. Echosphere Limited Liability Company, a Colorado limited liability company, and 5. Echostar Satellite LLC, a Colorado limited liability company, Defendants. And Related Counterclaims., 2006 WL 1004917 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Feb. 22, 2006) **TiVo's Motion for Reconsideration of Magistrate Judge's Ruling on TiVo Trial Exhibits 1514, 1515, 16** (NO. 2-04-CV-01)
- 112 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar dbs Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, 4. Echosphere Limited Liability Company, a Colorado limited liability company, and 5. Echostar Satellite LLC, a Colorado limited liability company, Defendants. And Related Counterclaims., 2006 WL 813706 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Feb. 22, 2006) **Tivo's Motion for Reconsideration of Magistrate Judge's Ruling on Tivo Trial Exhibits 1514, 1515, 16** (NO. 2-04-CV-01)

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- 114 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Sorporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, 4. Echosphere Limited Liability Company, a Colorado limited liability company, and 5. Echostar Satellite LLC, a Colorado limited liability company, Defendants. And Related Counterclaims., 2006 WL 1181339 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Mar. 3, 2006) **Tivo's Motion for Reconsideration of the Court's February 27, 2006 Order Denying Leave to Amend the** (NO. 2-04CV-01)
- 115 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, 4. Echosphere Limited Liability Company, a Colorado limited liability company, and 5. Echostar Satellite LLC, a Colorado limited liability company, Defendants. And Related Counterclaims., 2006 WL 1004921 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Mar. 20, 2006) **TiVo's Motion for Reconsideration of Magistrate Judge's Ruling on Admissibility of Exhibits on TiVo'** (NO. 2-04-CV-01)
- 116 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, 4. Echosphere Limited Liability Company, a Colorado limited liability company, and 5. Echostar Satellite LLC, a Colorado limited liability company, Defendants. And Related Counterclaims., 2006 WL 1181340 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Mar. 20, 2006) **TiVo's Motion for Reconsideration of Magistrate Judge's Ruling on Admissibility of Exhibits on Tivo'** (NO. 2-04-CV-01)
- 117 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. Echostar DBS Corporation, a Colorado corporation, 3. Echostar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, 5. Echostar Satellite LLC, a Colorado limited liability company, Defendants. And Related Counterclaims., 2006 WL 1004922 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Mar. 24, 2006) **Plaintiff TiVo Inc.'s Motion to Exclude the Testimony of Defendants' Witness Homer Knearl and all Re** (NO. 2-04CV-01)
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- 119 TIVO INC., a Delaware corporation, Plaintiff, v. 1. ECHOSTAR COMMUNICATIONS CORPORATION, a Nevada Corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; 4. Echosphere Limited Liability Company, a Colorado limited liability company; and 5. EchoStar Satellite LLC, a Colorado limited liability company, Defendants., 2006 WL 1181342 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Mar. 30, 2006) **Echostar's Opposition to Tivo's Motion for Reconsideration of Magistrate Judge's Rulings** (NO. 2-04CV01DF)

- 120 TIVO INC., a Delaware corporation, Plaintiff, v. 1. EHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; 4. Echosphere Limited Liability Company, a Colorado limited liability company; and 5. EchoStar Satellite LLC, a Colorado limited liability company, Defendants., 2006 WL 1004923 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Apr. 11, 2006) **Echostar's Motion for Judgment as a Matter of Law** (NO. 2-04CV01DF)
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- 122 TIVO INC., a Delaware corporation, Plaintiff, v. 1. EHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. EchoStar DBS Corporation, a Colorado corporation, 3. EchoStar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, 5. EchoStar Satellite LLC, a Colorado limited liability company, Defendants. And Related Counterclaims., 2006 WL 1004924 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Apr. 12, 2006) **Tivo's Opposition to Echostar's Renewed Motion for Judgment as a Matter of Law** (NO. 2-04CV-01)
- 123 TiVo INC., a Delaware corporation, Plaintiff, v. 1. EHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation, 2. EchoStar DBS Corporation, a Colorado corporation, 3. EchoStar Technologies Corporation, a Texas corporation, and 4. Echosphere Limited Liability Company, a Colorado limited liability company, 5. EchoStar Satellite LLC, a Colorado limited liability company, Defendants, And Related Counterclaims., 2006 WL 1503233 (Trial Motion, Memorandum and Affidavit) (E.D.Tex. Apr. 12, 2006) **Tivo's Opposition to Echostar's Renewed Motion for Judgment as a Matter of Law** (NO. 2-04CV-01)

E.D.Tex. Verdicts, Agreements and Settlements

- 124 TIVO INC., v. ECHO STAR COMMUNICATIONS CORPORATION et al., 2005 WL 5328264 (Verdict, Agreement and Settlement) (E.D.Tex. Sep. 7, 2005) **Local Rule 37-2 Joint Stipulation Re: Non-party Broadcom's Motion to Quash Subpoena** (NO. 204-CV-00001)
- 125 TIVO INC., a Delaware corporation, Plaintiff, v. 1. EHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; and 4. Echosphere Limited Liability Company, a Colorado limited liability company, Defendants., 2005 WL 4170193 (Verdict, Agreement and Settlement) (E.D.Tex. Oct. 6, 2005) **Stipulation Mooting Tivo's Motion in Limine No. 2 [Docket Number 218]** (NO. 2-04CV01DF)
- 126 TIVO INC., a Delaware corporation, Plaintiff, v. 1. EHOSTAR COMMUNICATIONS CORPORATION, a Nevada corporation; 2. EchoStar DBS Corporation, a Colorado corporation; 3. EchoStar Technologies Corporation, a Texas corporation; 4. Echosphere Limited Liability Company, a Colorado limited liability company; and 5. EchoStar Satellite LLC, a Colorado limited liability company, Defendants., 2006 WL 1006117 (Verdict, Agreement and Settlement) (E.D.Tex. Mar. 27, 2006) **Echostar's First Amended Proposed Verdict Form** (NO. 2-04CV01DF)
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- 132 SIMULTANEOUS STORAGE AND PLAYBACK OF MULTIMEDIA DATA METHOD E.G. FOR REAL TIME CAPTURE, STORAGE AND DISPLAY OF TELEVISION BROADCAST SIGNALS, DWPL 2000-205516

Assignments

- 133 Action: CORRECTIVE ASSIGNMENT TO CORRECT THE NAME OF RECEIVING PARTY PREVIOUSLY RECORDED ON REEL 018866 FRAME 0510. ASSIGNOR(S) HEREBY CONFIRMS THE SECURITY AGREEMENT., DATE RECORDED: Feb 12, 2007
- 134 Action: SECURITY AGREEMENT Number of Pages: 014, DATE RECORDED: Feb 08, 2007
- 135 ACTION: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS). NUMBER OF PAGES: 002, DATE RECORDED: Jul 30, 1998

Patent Status Files

- ... Request for Re-Examination, (OG date: Jan 31, 2006)
- ... Patent Suit(See LitAlert Entries),

Docket Summaries

- 139 "TIVO, INC. v. ECHOSTAR COMMUNICATIONS CORPORATION ET AL", 1:05CV02799, (N.D.GA. Oct 28, 2005), FRCP 45(B) MOTION TO QUASH OR MODIFY SUBPOENA
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Litigation Alert

- 141 LitAlert P2004-08-19, (Jan 15, 2004) Action Taken: A complaint was filed.
- 142 LitAlert P2002-10-46, (Jan 23, 2002) Action Taken: A complaint was filed.

Prior Art (Coverage Begins 1976)

- C 143 US PAT 4665431 APPARATUS AND METHOD FOR RECEIVING AUDIO SIGNALS TRANSMITTED AS PART OF A TELEVISION VIDEO SIGNAL, (U.S. PTO Utility 1987)
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- C 147 US PAT 5202761 AUDIO SYNCHRONIZATION APPARATUS, (U.S. PTO Utility 1993)

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- C 148 US PAT RE33535 AUDIO TO VIDEO TIMING EQUALIZER METHOD AND APPARATUS, (U.S. PTO Reissue 1991)
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- C 156 US PAT 5438423 TIME WARPING FOR VIDEO VIEWING, Assignee: Tektronix, Inc., (U.S. PTO Utility 1995)

US District Court Civil Docket

U.S. District - Georgia Northern
(Atlanta)

1:05cv2799

Tivo, Inc v. Echostar Communications Corporation et al

This case was retrieved from the court on Tuesday, February 13, 2007

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Litigants

Tivo, Inc A Delaware Corporation
Plaintiff

Attorneys

Christine WS Byrd
[COR LD NTC]
Irell & Manella
1800 Avenue of the Stars
Suite 900
Los Angeles , CA 90067
USA
310-277-1010

Perry M Goldberg
[COR LD NTC]
Irell & Manella
1800 Avenue of the Stars
Suite 900
Los Angeles , CA 90067
USA
310-277-1010
Email: Pgoldberg@irell.com

William Charles Buhay
[COR LD NTC]
Weinberg Wheeler Hudgins Gunn & Dial
950 East Paces Ferry Road
One Atlanta Plaza, Suite 3000
Atlanta , GA 30326-1382
USA
404-876-2700
Email: Wbuhay@wwhgd.com

Echostar Communications Corporation A Nevada
Corporation
Defendant

Alison M Tucher
[COR LD NTC]
Morrison & Foerster

425 Market Street
San Francisco , CA 94105-2482
USA
415-268-7000
Email: Atucher@mofocom

Charles Conrow Murphy, Jr
[COR LD NTC]
Vaughan & Murphy
260 Peachtree Street, NW
Suite 1600
Atlanta , GA 30303
USA
404-577-6550
Email: Cmurphy@vaughanandmurphy.com

Ellen G Schlossberg
[COR LD NTC]
Vaughan & Murphy
260 Peachtree Street, NW
Suite 1600
Atlanta , GA 30303
USA
404-577-6550
Email: Eschloss@vaughanandmurphy.com

Harold J McElhinny
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco , CA 94105-2482
USA
415-268-7265
Email: Hmcelhinny@mofocom

Marc J Pernick
[COR LD NTC]
Morrison & Foerster, LLP
755 Page Mill Road
Palo Alto , CA 94304-1018
USA
650-813-5718

Rachel Krevans
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco , CA 94105-2482
USA
415-268-7000
Email: Rkrevans@mofocom

Peter P Meringolo
[COR LD NTC]
[Term: 02/08/2007]
Morrison & Foerster
425 Market Street
San Francisco , CA 94105-2482
USA
415-268-6752

Alison M Tucher
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco , CA 94105-2482

Echostar Dbs Corporation A Colorado Corporation
Defendant

USA
415-268-7000
Email: Atucher@mofo.com

Charles Conrow Murphy, Jr
[COR LD NTC]
Vaughan & Murphy
260 Peachtree Street, NW
Suite 1600
Atlanta, GA 30303
USA
404-577-6550
Email: Cmurphy@vaughanandmurphy.com

Ellen G Schlossberg
[COR LD NTC]
Vaughan & Murphy
260 Peachtree Street, NW
Suite 1600
Atlanta, GA 30303
USA
404-577-6550
Email: Eschloss@vaughanandmurphy.com

Harold J McElhinny
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco, CA 94105-2482
USA
415-268-7265
Email: Hmcelhinny@mofo.com

Marc J Pernick
[COR LD NTC]
Morrison & Foerster, LLP
755 Page Mill Road
Palo Alto, CA 94304-1018
USA
650-813-5718

Rachel Krevans
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco, CA 94105-2482
USA
415-268-7000
Email: Rkrevans@mofo.com

Peter P Meringolo
[COR LD NTC]
[Term: 02/08/2007]
Morrison & Foerster
425 Market Street
San Francisco, CA 94105-2482
USA
415-268-6752

Echostar Technologies Corporation A Texas Corporation
Defendant

Alison M Tucher
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco, CA 94105-2482
USA
415-268-7000

Email: Atucher@mofo.com

Charles Conrow Murphy, Jr
[COR LD NTC]
Vaughan & Murphy
260 Peachtree Street, NW
Suite 1600
Atlanta, GA 30303
USA
404-577-6550
Email: Cmurphy@vaughanandmurphy.com

Ellen G Schlossberg
[COR LD NTC]
Vaughan & Murphy
260 Peachtree Street, NW
Suite 1600
Atlanta, GA 30303
USA
404-577-6550
Email: Eschloss@vaughanandmurphy.com

Harold J McElhinny
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco, CA 94105-2482
USA
415-268-7265
Email: Hmcelhinny@mofo.com

Marc J Pernick
[COR LD NTC]
Morrison & Foerster, LLP
755 Page Mill Road
Palo Alto, CA 94304-1018
USA
650-813-5718

Rachel Krevans
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco, CA 94105-2482
USA
415-268-7000
Email: Rkrevans@mofo.com

Peter P Meringolo
[COR LD NTC]
[Term: 02/08/2007]
Morrison & Foerster
425 Market Street
San Francisco, CA 94105-2482
USA
415-268-6752

Echosphere Limited Liability Company A Colorado Limited
Liability Company
Defendant

Alison M Tucher
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco, CA 94105-2482
USA
415-268-7000
Email: Atucher@mofo.com

Charles Conrow Murphy, Jr
[COR LD NTC]
Vaughan & Murphy
260 Peachtree Street, NW
Suite 1600
Atlanta , GA 30303
USA
404-577-6550
Email: Cmurphy@vaughanandmurphy.com

Ellen G Schlossberg
[COR LD NTC]
Vaughan & Murphy
260 Peachtree Street, NW
Suite 1600
Atlanta , GA 30303
USA
404-577-6550
Email: Eschloss@vaughanandmurphy.com

Harold J McElhinny
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco , CA 94105-2482
USA
415-268-7265
Email: Hmcelhinny@mofo.com

Marc J Pernick
[COR LD NTC]
Morrison & Foerster, LLP
755 Page Mill Road
Palo Alto , CA 94304-1018
USA
650-813-5718

Rachel Krevans
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco , CA 94105-2482
USA
415-268-7000
Email: Rkrevans@mofo.com

Peter P Meringolo
[COR LD NTC]
[Term: 02/08/2007]
Morrison & Foerster
425 Market Street
San Francisco , CA 94105-2482
USA
415-268-6752

Charles Conrow Murphy, Jr
[COR LD NTC]
Vaughan & Murphy
260 Peachtree Street, NW
Suite 1600
Atlanta , GA 30303
USA
404-577-6550
Email: Cmurphy@vaughanandmurphy.com

Ellen G Schlossberg

Homer Knearl
Movant

[COR LD NTC]
Vaughan & Murphy
260 Peachtree Street, NW
Suite 1600
Atlanta, GA 30303
USA
404-577-6550
Email: Eschloss@vaughanandmurphy.com

Harold J McElhinny
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco, CA 94105-2482
USA
415-268-7265
Email: Hmcelhinny@mofo.com

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[COR LD NTC]
Morrison & Foerster, LLP
755 Page Mill Road
Palo Alto, CA 94304-1018
USA
650-813-5718

Peter P Meringolo
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco, CA 94105-2482
USA
415-268-6752

Rachel Krevans
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco, CA 94105-2482
USA
415-268-7000
Email: Rkrevans@mofo.com

Alison M Tucher
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco, CA 94105-2482
USA
415-268-7000
Email: Atucher@mofo.com

Date	#	Proceeding Text
07/07/2005	1	MOTION to Quash subpoenas with Brief In Support by Echostar Technologies Corporation, Echosphere Limited Liability Company, Homer Knearl, Echostar Communications Corporation, EchoStar DBS Corporation. (Attachments: # 1 Exhibit 1# 2 Exhibit 1-A# 3 Exhibit 1-B# 4 Exhibit 1-C# 5 Exhibit 1-D# 6 Exhibit 1-E# 7 Exhibit 1-F# 8 Exhibit 1-G# 9 Exhibit 1-H# 10 Exhibit 1-I# 11 Exhibit 2# 12 Exhibit 2-A# 13 Exhibit 2-B# 14 Exhibit 2-C# 15 Exhibit 2-D# 16 Exhibit 2-E# 17 Exhibit 2-F)(fmm) (Entered: 07/15/2005)
07/26/2005	2	PROPOSED CONSENT ORDER For Extension of Time re: 1 MOTION to Quash subpoenas. (Buhay, William) (Entered: 07/26/2005)
07/27/2005	6	APPLICATION for Admission of Harold J. McElhinny Pro Hac Viceby Echostar Technologies Corporation, Echosphere Limited Liability Company, Homer Knearl, Echostar Communications Corporation, EchoStar DBS Corporation.Filing Fee received \$150.00, Receipt #539834. (fmm)

(Entered: 07/29/2005)

07/27/2005 7 APPLICATION for Admission of Peter P. Meringolo Pro Hac Viceby Echostar Technologies Corporation, Echosphere Limited Liability Company, Homer Knearl, Echostar Communications Corporation, EchoStar DBS Corporation.Filing Fee received \$150.00, Receipt #539834. (fmm) (Entered: 07/29/2005)

07/27/2005 8 APPLICATION for Admission of Marc J. Pernick Pro Hac Viceby Echostar Technologies Corporation, Echosphere Limited Liability Company, Homer Knearl, Echostar Communications Corporation, EchoStar DBS Corporation.Filing Fee received \$150.00, Receipt #539835. (fmm) (Entered: 07/29/2005)

07/28/2005 3 NOTICE of Appearance by William Charles Buhay on behalf of TiVo, Inc. (Buhay, William) (Entered: 07/28/2005)

07/28/2005 4 Second MOTION for Extension of Time Reply to Motion for Protective Order and to Quash re: 1 MOTION to Quash subpoenas, 2 Proposed Consent Order with Brief In Support by TiVo, Inc.. (Buhay, William) (Entered: 07/28/2005)

07/28/2005 5 PROPOSED ORDER Unopposed Motion to Extend Time to Reply to Motion for Protective Order and to Quash re: 4 Second MOTION for Extension of Time Reply to Motion for Protective Order and to Quash re: 1 MOTION to Quash subpoenas, 2 Proposed Consent Order. (Buhay, William) (Entered: 07/28/2005)

07/28/2005 9 ORDER GRANTING 4 Motion for Extension of Time. IT IS HEREBY ORDERED that Plaintiff shall have (3) three additional days in which to file its response to the Joint Motion . Signed by Judge William S. Duffey Jr. on 7/26/05. (kt) (Entered: 07/29/2005)

08/01/2005 10 ORDER GRANTING 5 Unopposed Motion to Extend time until 8/4/05 for TiVo to reply to EchoStar and Non-Party Homer Knearl's Joint Motion for a Protective Order and to Quash Rule 45 Subpoenas. Signed by Judge William S. Duffey Jr. on 8/1/05. (kt) (Entered: 08/02/2005)

08/02/2005 -- ORDER (by docket entry only) granting 6 Application for Admission Pro Hac Vice of Harold McElhinny, granting 7 Application for Admission Pro Hac Vice of Peter Meringolo, granting 8 Application for Admission Pro Hac Vice of Marc Pernick . Ordered by Judge William S. Duffey Jr. on 8/2/05. (jdb) (Entered: 08/02/2005)

08/03/2005 13 ORDER APPROVING 11 Third MOTION for Extension of Time to Reply to EchoStar and Non-Party Homer Knearl's Joint Motion for Protective Order and 1 Motion to Quash Rule 45 Subpoenas until 8/10/05. Signed by Judge William S. Duffey Jr. on 8/5/05. (kt) (Entered: 08/05/2005)

08/04/2005 11 Third MOTION for Extension of Time File Response re: 1 MOTION to Quash subpoenas with Brief In Support by TiVo, Inc.. (Buhay, William) (Entered: 08/04/2005)

08/04/2005 12 PROPOSED ORDER Granting Six (6) Day Extension re: 11 Third MOTION for Extension of Time File Response re: 1 MOTION to Quash subpoenas. (Buhay, William) (Entered: 08/04/2005)

08/05/2005 15 APPLICATION for Admission of Christine W.S. Byrd Pro Hac Viceby TiVo, Inc..Filing Fee received \$150.00, Receipt #540264. (fmm) (Entered: 08/11/2005)

08/05/2005 16 APPLICATION for Admission of Perry M. Goldberg Pro Hac Viceby TiVo, Inc..Filing Fee received \$150.00, Receipt #540264. (fmm) (Entered: 08/11/2005)

08/10/2005 14 Fourth MOTION for Extension of Time File Response re: 1 MOTION to Quash subpoenas with Brief In Support by TiVo, Inc.. (Attachments: # 1)(Buhay, William) (Entered: 08/10/2005)

08/12/2005 -- ORDER (by docket entry only) granting 15 Application for Admission Pro Hac Vice of Christine W.S. Byrd, granting 16 Application for Admission Pro Hac Vice of Perry M. Goldberg. Ordered by Judge William S. Duffey Jr. on 8/12/05. (jdb) (Entered: 08/12/2005)

08/12/2005 17 ORDER GRANTING 14 Unopposed Motion for Extension of Time to Reply to the Joint Motion until 8/31/05. Signed by Judge William S. Duffey Jr. on 8/11/05. (kt) (Entered: 08/12/2005)

08/31/2005 18 Fifth MOTION for Extension of Time re: 1 MOTION to Quash subpoenas with Brief In Support by TiVo, Inc.. (Attachments: # 1 Exhibit A # 2 Proposed Order)(Buhay, William) Modified on 9/1/2005 to describe attachments (fmm). (Entered: 08/31/2005)

09/01/2005 19 ORDER GRANTING 18 Motion for Extension of Time until 9/14/05 for TiVo Inc. to reply to the Joint Motion for Protective Order and to Quash Rule 45 Subpoenas. Signed by Judge William S. Duffey Jr. on 8/31/05. (kt) (Entered: 09/01/2005)

09/14/2005 20 Sixth MOTION for Extension of Time to Reply to Joint Motion for Protective Order and Quash Rule 45 Subpoenas re: 1 MOTION to Quash subpoenas with Brief In Support by TiVo, Inc.. (Attachments: # 1 Proposed Order)(Buhay, William) Modified on 9/15/2005 to describe attachments (fmm). (Entered: 09/14/2005)

09/15/2005 21 ORDER GRANTING 20 Unopposed Motion for Extension of Time to Reply to the Joint Motion until

10/06/05. Signed by Judge William S. Duffey Jr. on 9/15/05. (kt) (Entered: 09/16/2005)

10/06/2005 22 Seventh MOTION to Continue by TiVo, Inc.. (Attachments: # 1 Exhibit Texas Court's September 26th Order# 2 Text of Proposed Order Oder Granting Continuance)(Buhay, William) (Entered: 10/06/2005)

10/07/2005 23 ORDER GRANTING 22 Seventh Unopposed Motion to Extend Time to Reply to EchoStar and Non-Party Homer Knearl's Joint Motion for a Protective Order and to Quash Rule 45 Subpoeas until 10/13/05. Signed by Judge William S. Duffey Jr. on 10/07/05. (kt) (Entered: 10/07/2005)

10/07/2005 24 RESPONSE re 22 Seventh MOTION to Continue filed by Echostar Technologies Corporation, Echosphere Limited Liability Company, Echostar Communications Corporation, EchoStar DBS Corporation. (Schlossberg, Ellen) (Entered: 10/07/2005)

10/13/2005 25 DOCUMENT FILED IN ERROR Eighth MOTION for Extension of Time to Reply to Echostar and Non-Party Homer Knearl's Joint Motion for a Protective Order and to Quash Rule 45 Subpoeas; Motion to Dismiss Joint Motion as Moot with Brief In Support by TiVo, Inc.. (Attachments: # 1 Exhibit A to 8th Motion# 2 Exhibit Exhibit B to 8th motion# 3 Text of Proposed Order)(Buhay, William) Modified on 10/14/2005 (fmm). (Entered: 10/13/2005)

10/13/2005 26 REDOCKETED #25 MOTION AS Eighth MOTION for Extension of Time by 2 weeks to file response re: 1 MOTION for protective order and to Quash subpoenas or MOTION to Dismiss without prejudice the 1 MOTION for protective order and to Quash subpoenas by TiVo, Inc. (Attachments: # 1 Exhibit A# 2 Exhibit B# 3 Proposed Order)(fmm) (Entered: 10/14/2005)

10/14/2005 27 RESPONSE in Opposition re 26 MOTION to Dismiss MOTION for Extension of Time to file response to re: 1 MOTION to Quash subpoenas MOTION for Extension of Time to file response to re: 1 MOTION to Quash subpoenas filed by Homer Knearl. (Schlossberg, Ellen) (Entered: 10/14/2005)

10/28/2005 28 RESPONSE in Opposition re 1 MOTION to Quash subpoenas and Reply Brief to the 26 Motion to Dismiss filed by TiVo, Inc.. (Attachments: # 1 Text of Proposed Order Proposed Order denying Defendants' Motion for Protective Order and to Quash Subpoena and Granting Plaintiff's Motion to Dismiss Defendants' Motion as Moot)(Buhay, William) Modified on 10/31/2005 to add document link (fmm). (Entered: 10/28/2005)

10/28/2005 29 AFFIDAVIT in Opposition re 1 MOTION to Quash subpoenas and related Exhibits supporting TiVo's Response to the Motion to Quash and TiVo's Motion to Dismiss filed by TiVo, Inc.. (Attachments: # 1 Exhibit Exhibit A# 2 Exhibit Exhibit B# 3 Exhibit Exhibit C# 4 Exhibit Exhibit D# 5 Exhibit Exhibit E# 6 Exhibit Part 1 of Exhibit F# 7 Exhibit Part 2 of Exhibit F# 8 Exhibit Part 3 of Exhibit F)(Buhay, William) (Entered: 10/28/2005)

10/28/2005 30 AFFIDAVIT in Opposition re 1 MOTION to Quash subpoenas The Affidavit is actually a Declaration which attaches the Exhibits relied upon by TiVo filed by TiVo, Inc.. (Attachments: # 1 Exhibit Exhibit A - Filed Under Seal# 2 Exhibit Exhibit B# 3 Exhibit Exhibit C# 4 Exhibit Exhibit D# 5 Exhibit Exhibit E# 6 Exhibit Part 1 of Exhibit F# 7 Exhibit Part 2 of Exhibit F# 8 Exhibit Part 3 of Exhibit F)(Buhay, William) (Entered: 10/28/2005)

10/28/2005 31 MOTION to File Exhibit A to 29 Affidavit and 30 Affidavit Under Seal by TiVo, Inc. (Attachments: # 1 Proposed Order)(fmm) (Entered: 10/31/2005)

10/28/2005 32 Exhibit A to 29 Affidavit and 30 Affidavit by TiVo, Inc. (-- FILED UNDER SEAL --) (fmm) Modified on 2/13/2006 (kt). (Entered: 10/31/2005)

10/28/2005 -- Case reported statistically. Matter transferred from 1:05-mi-190. (kt) (Entered: 10/31/2005)

10/31/2005 33 MOTION to Supplement 28 Response in Opposition re 1 MOTION to Quash subpoenas and Reply Brief to the 26 Motion to Dismiss by TiVo, Inc. (Attachments: # 1 Exhibit G-1# 2 Exhibit G-2# 3 Exhibit G-3# 4 Exhibit H-1# 5 Exhibit H-2# 6 Proposed Order)(fmm) (Entered: 11/01/2005)

11/01/2005 -- Submission of 1 MOTION to Quash subpoenas, 26 MOTION to Dismiss MOTION for Extension of Time to file response to re: 1 MOTION to Quash subpoenas MOTION for Extension of Time to file response to re: 1 MOTION to Quash subpoenas, 11 Third MOTION for Extension of Time File Response re: 1 MOTION to Quash subpoenas, submitted to District Judge William S. Duffey. (fmm) (Entered: 11/01/2005)

11/14/2005 34 REPLY in support of 1 MOTION to Quash subpoenas, 33 MOTION to Supplement 28 Response in Opposition to Motion, filed by Homer Knearl. (Attachments: # 1 Exhibit A # 2 Exhibit B) (Murphy, Charles) Modified on 11/16/2005 to correct docket text to reflect e-filed document. (kt). (Entered: 11/14/2005)

11/15/2005 -- Submission of 31 MOTION to Seal Document 29 Affidavit in Opposition to Motion, 30 Affidavit in Opposition to Motion, 33 MOTION to Supplement 28 Response in Opposition to Motion, to District Judge William S. Duffey. (kt) (Entered: 11/15/2005)

11/16/2005 -- Notification of Docket Correction re 34 Reply to Response to Motion. Wrong event used and

double wording in attachments. (kt) (Entered: 11/16/2005)

11/17/2005 35 RESPONSE re 31 MOTION to Seal Document 29 Affidavit in Opposition to Motion,, 30 Affidavit in Opposition to Motion, filed by Echostar Technologies Corporation, Echosphere Limited Liability Company, Homer Knearl, Echostar Communications Corporation, EchoStar DBS Corporation. (Murphy, Charles) (Entered: 11/17/2005)

11/17/2005 36 RESPONSE re 33 MOTION to Supplement 28 Response in Opposition to Motion, filed by Homer Knearl. (Murphy, Charles) (Entered: 11/17/2005)

02/06/2006 37 NOTICE Of Filing order in related case by TiVo, Inc. (Attachments: # 1 Order in Colorado Case) (fmm) (Entered: 02/07/2006)

02/07/2006 -- Notification of Docket Correction re 37 Notice of Filing. Pleading incorrectly e-filed in closed miscellaneous case and moved to correct pending civil action. (fmm) (Entered: 02/07/2006)

02/10/2006 38 Minute Entry for proceedings held before Judge William S. Duffey Jr.: Telephone Conference held on 2/10/2006. (Court Reporter Nick Marrone.)(jdb) (Entered: 02/13/2006)

02/13/2006 39 ORDER granting in part and denying in part 1 Motion to Quash (See order for details.) IT IS FURTHER ORDERED that the documents required by this Order to be produced in response to the subpoena which are not subject to in camera review shall be produced by Mr. Knearl on or before February 20, 2006. IT IS FURTHER ORDERED that Mr. Knearl's deposition shall be arranged to be conducted on or before February 28, 2006. IT IS FURTHER ORDERED that the motion is DENIED with respect to the grounds the Mr. Knearl was not provided with reasonable notice, with reasonable time for compliance or that the information otherwise has been requested to be produced by other lawyers at Merchant & Gould. IT IS FURTHER ORDERED that if the Court in the Eastern District of Texas determines that the Subpoena response is outside the period allowed for discovery, compliance with this order shall not be required. IT IS FURTHER ORDERED that Plaintiff's Unopposed Motion for Extension of Time to Reply to Joint Motion for a Protective Order and to Quash Subpoenas 11, Plaintiff's Motion to Extend Time to Reply 26, Plaintiff's Motion to File Documents Under Seal 31, and Plaintiff's Motion for Leave to File a Supplement to its Response in Opposition 33 are GRANTED. Signed by Judge William S. Duffey Jr. on 2/13/06. (kt) (Entered: 02/13/2006)

02/14/2006 41 TRANSCRIPT of Proceedings held on February 10, 2006 before Judge William S. Duffey, Court Reporter: Nicholas A. Marrone. (kt) (Entered: 02/15/2006)

02/15/2006 40 APPLICATION for Admission of Alison M. Tucher Pro Hac Vice by Echostar Technologies Corporation, Echosphere Limited Liability Company, Echostar Communications Corporation, and EchoStar DBS Corporation.Filing Fee received \$150.00, Receipt #547386. (to WSD) (kt) (Entered: 02/15/2006)

02/17/2006 -- ORDER (by docket entry only) granting 40 Application for Admission Pro Hac Vice of Alison M. Tucher. Ordered by Judge William S. Duffey Jr. on 2/17/06. (jdb) (Entered: 02/17/2006)

02/28/2006 42 VACATED pursuant to 53 Order ORDER DIRECTING that Mr. Knearl is ORDERED to produce the documents enclosed in the packet transmitted today by Federal Express to counsel for Mr. Knearl. These documents shall be made available for inspection by Mr. Perry Goldberg, TiVo's outside counsel. The Produced Documents shall be produced for Mr. Goldberg's inspection on or before March 8, 2006. Mr. Goldberg will request Judge Folsom to determine if the Identified Documents are admissible in the litigation pending in Texas. Judge Folsome shall determine what, if any, restrictions will be placed on disclosure of any of the Identified Documents he will allow to be introduced at trial. Identified documents which are not admitted shall promptly be returned to counsel for Mr. Knearl. Signed by Judge William S. Duffey Jr. on 2/28/06. (kt) Modified on 5/15/2006 (kt). Modified on 6/8/2006 (kt). (Entered: 02/28/2006)

03/02/2006 43 Joint MOTION to Stay the Court's Order of February 28, 2006 with Brief In Support by Echostar Technologies Corporation, Echosphere Limited Liability Company, Homer Knearl, Echostar Communications Corporation, EchoStar DBS Corporation. (Attachments: # 1 Brief In Support of Joint Motion for a Stay of the Court's Order of February 28, 2006# 2 Text of Proposed Order) (Tucher, Alison) (Entered: 03/02/2006)

03/02/2006 44 Emergency MOTION 43 Joint MOTION to Stay the Court's Order of February 28, 2006 to Waive the Time Requirements of Rule 7.1 with Brief In Support by Echostar Technologies Corporation, Echosphere Limited Liability Company, Homer Knearl, Echostar Communications Corporation, EchoStar DBS Corporation. (Attachments: # 1 Text of Proposed Order)(Tucher, Alison) (Entered: 03/02/2006)

03/03/2006 45 ORDER DENYING 43 Motion to Stay the Court's Order of February 28, 2006, granting 44 Motion for Miscellaneous Relief. IT IS FURTHER ORDERED that because the Court has resolved the motion to quash at issue in this proceeding, the Clerk of Cour tis DIRECTED to close this case. Signed by Judge William S. Duffey Jr. on 3/3/06. (kt) (Entered: 03/03/2006)

03/03/2006 -- Civil Case Terminated. (kt) (Entered: 03/03/2006)

03/03/2006 46 NOTICE OF APPEAL as to 42 Order, by Echostar Technologies Corporation, Echosphere Limited Liability Company, Homer Knearl, Echostar Communications Corporation, EchoStar DBS Corporation. Filing fee \$ 255, receipt no. 548185Transcript Order Form due on 3/17/2006. (fem) (Entered: 03/06/2006)

03/06/2006 47 DOCUMENT ERROR Transmission of Certified Copy of Notice of Appeal, Judgment, Order and Docket Sheet to US Court of Appeals re 46 Notice of Appeal, (fem) Modified on 3/8/2006 (fem). (Entered: 03/06/2006)

03/08/2006 48 Transmission of Certified Copy of Notice of Appeal, Judgment, Order and Docket Sheet to US Court of Appeals, Washington, D.C re 46 Notice of Appeal, (fem) (Entered: 03/08/2006)

03/08/2006 -- Notification of Docket Correction to indicate transmission incorrectly forwarded to the Eleventh Circuit and should have been transmitted to the Federal Circuit re 47 Transmission of Notice of Appeal and Docket Sheet to USCA. (fem) (Entered: 03/08/2006)

03/09/2006 49 ORDER of USCA - Federal Circuit temporarily staying 42 district court's Order re: 46 Notice of Appeal. USCA - Federal Circuit Miscellaneous Docket Case No. 816. (kac) (Entered: 03/10/2006)

03/13/2006 50 TRANSCRIPT ORDER FORM re: 46 Notice of Appeal. USCA - Federal Circuit Miscellaneous Number 816. Certificate of Readiness due on 3/27/2006 (All necessary transcript(s) on file.) (kac) (Entered: 03/13/2006)

03/20/2006 51 USCA Acknowledgment of 46 Notice of Appeal filed by Echostar Technologies Corporation, Echostar Technologies Corporation, EchoStar DBS Corporation, Echosphere Limited Liability Company and Homer Knearl. Case Appealed to USCA - Federal Circuit. Appeal Case Number 2006-1293. (kac) (Entered: 05/03/2006)

04/27/2006 -- Appeal Deadline Terminated. Appealed to the USCA for the Federal Circuit. (kac) (Entered: 04/27/2006)

05/11/2006 52 Certified copy of ORDER of USCA for the Federal Circuit GRANTING Homer Knearl and EchoStar Communication Corporation's Petition for Writ of Mandamus. The district court is directed to vacate its 42 Order requiring production of documents. The district court may conduct any additional proceedings necessary in view of this Court's EchoStar order. USCA, Federal Circuit Case Number 2006-M816. (kt) Modified on 5/23/2006 to correct docket text. (dfb) (Entered: 05/15/2006)

05/15/2006 -- Submission of 52 USCA for the Federal Circuit Order to District Judge William S. Duffey. (kt) (Entered: 05/15/2006)

06/08/2006 53 ORDER DIRECTING that Mr. Knearl produce by 6/19/06, any materials responsive to the subpoena which are required to be produced pursuant to this Order and submit to the Court, by 6/30/06, those materials for which Mr. Knearl requests the Court to conduct an in camera review. IT IS FURTHER ORDERED that Mr. Knearl provide to Plaintiff the privilege log of withheld materials contemporaneous with its 6/19/06 production of materials. IT IS FURTHER ORDERED that the Court's February 28, 2006 Order is VACATED. Signed by Judge William S. Duffey Jr. on 6/8/06. (kt) (Entered: 06/08/2006)

07/11/2006 54 DOCUMENT FILING ERROR MOTION Motion to Enforce Court's Order of June 8, 2006 by TiVo, Inc.. (Attachments: # 1 Exhibit Exhibit 1# 2 Exhibit Exhibit 2# 3 Exhibit Exhibit 3# 4 Exhibit Exhibit 4# 5 Exhibit Exhibit 5# 6 Exhibit Exhibit 6# 7 Exhibit Exhibit 7# 8 Exhibit Exhibit 8) (Buhay, William) Modified text on 7/11/2006. Attorney to refile. (mas). (Entered: 07/11/2006)

07/11/2006 -- Notification of Docket Correction re 54 MOTION Motion to Enforce Court's Order of June 8, 2006. Modified entry to indicate there was a filing error. Attorney to refile. (mas) (Entered: 07/11/2006)

07/11/2006 55 MOTION to Enforce Court's Order of June 8, 2006 by TiVo, Inc.. (Attachments: # 1 Exhibit 1# 2 Exhibit 2# 3 Exhibit 3# 4 Exhibit 4# 5 Exhibit 5# 6 Exhibit 6# 7 Exhibit 7# 8 Exhibit 8)(Buhay, William) Modified on 8/15/2006 to remove double wording. (kt). (Entered: 07/11/2006)

07/28/2006 56 RESPONSE in Opposition re 55 MOTION Motion to Enforce Court's Order of June 8, 2006 filed by Echostar Technologies Corporation, Echosphere Limited Liability Company, Homer Knearl, Echostar Communications Corporation, EchoStar DBS Corporation. (Attachments: # 1 Affidavit of Alison M. Tucher# 2 Exhibit A-L to Tucher Declaration# 3 Exhibit M-T to Tucher Declaration) (Tucher, Alison) (Entered: 07/28/2006)

08/11/2006 57 REPLY to Response to Motion re 55 MOTION Motion to Enforce Court's Order of June 8, 2006 filed by TiVo, Inc.. (Attachments: # 1 Exhibit #1# 2 Exhibit # 2# 3 Exhibit # 3)(Buhay, William) (Entered: 08/11/2006)

08/14/2006 58 Motion for Leave to file Surreply with Brief In Support by Echostar Technologies Corporation, Echosphere Limited Liability Company, Homer Knearl, Echostar Communications Corporation,

EchoStar DBS Corporation. (Attachments: # 1 Exhibit Surreply)(Murphy, Charles) Modified on 8/15/2006 to remove double wording in docket text. (kt). (Entered: 08/14/2006)

08/15/2006 -- Notification of Docket Correction re 58 MOTION for Leave to File Motion for Leave to file Surreply. Edited docket text to remove double wording. (kt) (Entered: 08/15/2006)

08/16/2006 -- Submission of 55 MOTION to Enforce Court's Order of June 8, 2006, to District Judge William S. Duffey. (kt) (Entered: 08/16/2006)

08/16/2006 59 RESPONSE in Opposition re 58 MOTION for Leave to File Motion for Leave to file Surreply filed by TiVo, Inc.. (Buhay, William) (Entered: 08/16/2006)

08/19/2006 60 RESPONSE re Submission to District Judge and Mr. Knearl's August 18, 2006 correspondence regarding same filed by TiVo, Inc.. (Buhay, William) (Entered: 08/19/2006)

08/21/2006 61 RESPONSE re Submission to District Judge, 60 Response (Non-Motion) and Mr. Knearl's August 18, 2006 correspondence regarding the same filed by TiVo, Inc.. (Buhay, William) (Entered: 08/21/2006)

10/03/2006 -- Submission of 58 MOTION for Leave to File Surreply, to District Judge William S. Duffey. (kt) (Entered: 10/03/2006)

01/26/2007 62 ORDER that Homer Knearl shall execute, under oath, the affidavit attached as Attachment A and Alison M. Tucher shall execute, under oath, the affidavit attached as Attachment B, and both shall return their executed affidavits to the Court on or before February 15, 2007. IT IS FURTHER ORDERED that Mr. Knearl and EchoStar shall, on or before February 15, 2007, deliver to the Court for in camera review, those documents withheld from production to TiVo on the grounds of a legal privilege. IT IS FURTHER ORDERED that Homer Knearl's and EchoStar's Motion for Leave to File Surreply in Opposition to TiVo's Motion 58 is DENIED. Signed by Judge William S. Duffey Jr. on 1/26/07. (Attachments: # 1 Attachment A# 2 Attachment B)(jdb) (Entered: 01/26/2007)

01/29/2007 -- NOTICE of Undeliverable Electronic Mail re: 62 Order. Mail returned for Peter P. Meringolo. (aar) (Entered: 01/29/2007)

02/08/2007 63 NOTICE by Echostar Technologies Corporation, Echosphere Limited Liability Company, Homer Knearl, Echostar Communications Corporation, EchoStar DBS Corporation Notice of Disassociation of Counsel (Tucher, Alison) (Entered: 02/08/2007)

US District Court Civil Docket

U.S. District - Georgia Northern
(Atlanta)

1:05mi208

Tivo, Inc v. Echostar Communications Corporation et al

This case was retrieved from the court on Wednesday, September 14, 2005

Date Filed: 07/21/2005	Class Code: CLOSED
Assigned To: Judge William S Duffey, Jr	Closed: yes
Referred To:	Statute:
Nature of suit: Patent (830)	Jury Demand: None
Cause: FRCP 37(a) Motion to compel deposition testimony	Demand Amount: \$0
Lead Docket: None	NOS Description: Patent
Other Docket: USDC ED TX, 04cv01 DF	
Jurisdiction: Federal Question	

Litigants

Tivo, Inc A Delaware Corporation
Plaintiff

Echostar Communications Corporation A Nevada
Corporation
Defendant

Attorneys

Charles Conrow Murphy, Jr
[COR LD NTC]
Vaughan & Murphy
260 Peachtree Street, NW
Suite 1600
Atlanta, GA 30303
USA
404-577-6550
Email: Cmurphy@vaughanandmurphy.com

Ellen G Schlossberg
[COR LD NTC]
Vaughan & Murphy
260 Peachtree Street, NW
Suite 1600
Atlanta, GA 30303
USA
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Morrison & Foerster
425 Market Street
San Francisco, CA 94105-2482
USA
415-268-7265
Email: Hmcelhinny@mofo.com

Rachel Krevans
[COR LD NTC]
Morrison & Foerster

Echostar Dbs Corporation A Colorado Corporation
Defendant

425 Market Street
San Francisco , CA 94105-2482
USA
415-268-7000

Charles Conrow Murphy, Jr
[COR LD NTC]
Vaughan & Murphy
260 Peachtree Street, NW
Suite 1600
Atlanta , GA 30303
USA
404-577-6550
Email: Cmurphy@vaughanandmurphy.com

Ellen G Schlossberg
[COR LD NTC]
Vaughan & Murphy
260 Peachtree Street, NW
Suite 1600
Atlanta , GA 30303
USA
404-577-6550
Email: Eschloss@vaughanandmurphy.com

Harold J McElhinny
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco , CA 94105-2482
USA
415-268-7265
Email: Hmcelhinny@mofa.com

Rachel Krevans
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco , CA 94105-2482
USA
415-268-7000

Echostar Technologies Corporation A Texas Corporation
Defendant

Charles Conrow Murphy, Jr
[COR LD NTC]
Vaughan & Murphy
260 Peachtree Street, NW
Suite 1600
Atlanta , GA 30303
USA
404-577-6550
Email: Cmurphy@vaughanandmurphy.com

Ellen G Schlossberg
[COR LD NTC]
Vaughan & Murphy
260 Peachtree Street, NW
Suite 1600
Atlanta , GA 30303
USA
404-577-6550
Email: Eschloss@vaughanandmurphy.com

Harold J McElhinny
[COR LD NTC]
Morrison & Foerster

425 Market Street
San Francisco , CA 94105-2482
USA
415-268-7265
Email: Hmcelhinny@mofo.com

Rachel Krevans
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco , CA 94105-2482
USA
415-268-7000

Echosphere Limited Liability Company A Colorado Limited
Liability Company
Defendant

Charles Conrow Murphy, Jr
[COR LD NTC]
Vaughan & Murphy
260 Peachtree Street, NW
Suite 1600
Atlanta , GA 30303
USA
404-577-6550
Email: Cmurphy@vaughanandmurphy.com

Ellen G Schlossberg
[COR LD NTC]
Vaughan & Murphy
260 Peachtree Street, NW
Suite 1600
Atlanta , GA 30303
USA
404-577-6550
Email: Eschloss@vaughanandmurphy.com

Harold J McElhinny
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco , CA 94105-2482
USA
415-268-7265
Email: Hmcelhinny@mofo.com

Rachel Krevans
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco , CA 94105-2482
USA
415-268-7000

Scientific Atlanta, Inc
Movant

Date	#	Proceeding Text
07/21/2005	1	MOTION to Compel production of a document from third party Scientific Atlanta with Brief In Support by Echostar Technologies Corporation, Echosphere Limited Liability Company, Echostar Communications Corporation, EchoStar DBS Corporation. (Attachments: # 1 Exhibit 1# 2 Exhibit A# 3 Exhibit B# 4 Exhibit C# 5 Exhibit D# 6 Exhibit E# 7 Exhibit F# 8 Exhibit G)(fmm) (Entered: 07/22/2005)
07/28/2005	2	Withdrawal of Motion 1 MOTION to Compel production of a document from third party Scientific Atlanta filed by Echostar Communications Corporation,, Echostar Technologies Corporation,, EchoStar DBS Corporation,, Echosphere Limited Liability Company,, (Murphy, Charles) (Entered: 07/28/2005)

07/28/2005 -- Miscellaneous Case Terminated. (fmm) (Entered: 07/29/2005)

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US District Court Civil Docket

**U.S. District - Georgia Northern
(Atlanta)**

1:05mi190

Tivo, Inc v. Echostar Communications Corporation et al

This case was retrieved from the court on Tuesday, October 10, 2006

Date Filed: 07/07/2005	Class Code: CLOSED
Assigned To: Judge William S Duffey, Jr	Closed: yes
Referred To:	Statute:
Nature of suit: Patent (830)	Jury Demand: None
Cause: FRCP 45(b) Motion to quash or modify subpoena	Demand Amount: \$0
Lead Docket: None	NOS Description: Patent
Other Docket: USDC ED TX, 2-04cv01 DF	
Jurisdiction: Federal Question	

Litigants

Tivo, Inc A Delaware Corporation
Plaintiff

Echostar Communications Corporation A Nevada
Corporation
Defendant

Attorneys

Christine WS Byrd
[COR LD NTC]
Irell & Manella
1800 Avenue of the Stars
Suite 900
Los Angeles , CA 90067
USA
310-277-1010

Perry M Goldberg
[COR LD NTC]
Irell & Manella
1800 Avenue of the Stars
Suite 900
Los Angeles , CA 90067
USA
310-277-1010
Email: Pgoldberg@irell.com

William Charles Buhay
[COR LD NTC]
Weinberg Wheeler Hudgins Gunn & Dial
950 East Paces Ferry Road
One Atlanta Plaza, Suite 3000
Atlanta , GA 30326-1382
USA
404-876-2700
Email: Wbuhay@wwhgd.com

Charles Conrow Murphy, Jr
[COR LD NTC]
Vaughan & Murphy
260 Peachtree Street, NW
Suite 1600

Atlanta , GA 30303
USA
404-577-6550
Email: Cmurphy@vaughanandmurphy.com

Ellen G Schlossberg
[COR LD NTC]
Vaughan & Murphy
260 Peachtree Street, NW
Suite 1600
Atlanta , GA 30303
USA
404-577-6550
Email: Eschloss@vaughanandmurphy.com

Harold J McElhinny
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco , CA 94105-2482
USA
415-268-7265
Email: Hmcelhinny@mofo.com

Marc J Pernick
[COR LD NTC]
Morrison & Foerster, LLP
755 Page Mill Road
Palo Alto , CA 94304-1018
USA
650-813-5718

Peter P Meringolo
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco , CA 94105-2482
USA
415-268-6752
Email: Pmeringolo@mofo.com

Rachel Krevans
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco , CA 94105-2482
USA
415-268-7000

Echostar Dbs Corporation A Colorado Corporation
Defendant

Charles Conrow Murphy, Jr
[COR LD NTC]
Vaughan & Murphy
260 Peachtree Street, NW
Suite 1600
Atlanta , GA 30303
USA
404-577-6550
Email: Cmurphy@vaughanandmurphy.com

Ellen G Schlossberg
[COR LD NTC]
Vaughan & Murphy
260 Peachtree Street, NW
Suite 1600
Atlanta , GA 30303
USA

404-577-6550
Email: Eschloss@vaughanandmurphy.com

Harold J McElhinny
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco , CA 94105-2482
USA
415-268-7265
Email: Hmcelhinny@mofo.com

Marc J Pernick
[COR LD NTC]
Morrison & Foerster, LLP
755 Page Mill Road
Palo Alto , CA 94304-1018
USA
650-813-5718

Peter P Meringolo
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco , CA 94105-2482
USA
415-268-6752
Email: Pmeringolo@mofo.com

Rachel Krevans
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco , CA 94105-2482
USA
415-268-7000

Echostar Technologies Corporation A Texas Corporation
Defendant

Charles Conrow Murphy, Jr
[COR LD NTC]
Vaughan & Murphy
260 Peachtree Street, NW
Suite 1600
Atlanta , GA 30303
USA
404-577-6550
Email: Cmurphy@vaughanandmurphy.com

Ellen G Schlossberg
[COR LD NTC]
Vaughan & Murphy
260 Peachtree Street, NW
Suite 1600
Atlanta , GA 30303
USA
404-577-6550
Email: Eschloss@vaughanandmurphy.com

Harold J McElhinny
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco , CA 94105-2482
USA
415-268-7265
Email: Hmcelhinny@mofo.com

Marc J Pernick
[COR LD NTC]
Morrison & Foerster, LLP
755 Page Mill Road
Palo Alto , CA 94304-1018
USA
650-813-5718

Peter P Meringolo
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco , CA 94105-2482
USA
415-268-6752
Email: Pmeringolo@mof.com

Rachel Krevans
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco , CA 94105-2482
USA
415-268-7000

Echosphere Limited Liability Company A Colorado Limited
Liability Company
Defendant

Charles Conrow Murphy, Jr
[COR LD NTC]
Vaughan & Murphy
260 Peachtree Street, NW
Suite 1600
Atlanta , GA 30303
USA
404-577-6550
Email: Cmurphy@vaughanandmurphy.com

Ellen G Schlossberg
[COR LD NTC]
Vaughan & Murphy
260 Peachtree Street, NW
Suite 1600
Atlanta , GA 30303
USA
404-577-6550
Email: Eschloss@vaughanandmurphy.com

Harold J McElhinny
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco , CA 94105-2482
USA
415-268-7265
Email: Hmcelhinny@mof.com

Marc J Pernick
[COR LD NTC]
Morrison & Foerster, LLP
755 Page Mill Road
Palo Alto , CA 94304-1018
USA
650-813-5718

Peter P Meringolo
[COR LD NTC]
Morrison & Foerster
425 Market Street

Homer Knearl
Mqvant

San Francisco , CA 94105-2482
USA
415-268-6752
Email: Pmeringolo@mofocom

Rachel Krevans
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco , CA 94105-2482
USA
415-268-7000

Charles Conrow Murphy, Jr
[COR LD NTC]
Vaughan & Murphy
260 Peachtree Street, NW
Suite 1600
Atlanta , GA 30303
USA
404-577-6550
Email: Cmurphy@vaughanandmurphy.com

Ellen G Schlossberg
[COR LD NTC]
Vaughan & Murphy
260 Peachtree Street, NW
Suite 1600
Atlanta , GA 30303
USA
404-577-6550
Email: Eschloss@vaughanandmurphy.com

Harold J McElhinny
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco , CA 94105-2482
USA
415-268-7265
Email: Hmcelhinny@mofocom

Marc J Pernick
[COR LD NTC]
Morrison & Foerster, LLP
755 Page Mill Road
Palo Alto , CA 94304-1018
USA
650-813-5718

Peter P Meringolo
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco , CA 94105-2482
USA
415-268-6752
Email: Pmeringolo@mofocom

Rachel Krevans
[COR LD NTC]
Morrison & Foerster
425 Market Street
San Francisco , CA 94105-2482
USA
415-268-7000

Date	#	Proceeding Text
07/07/2005	1	MOTION to Quash subpoenas with Brief In Support by Echostar Technologies Corporation, Echosphere Limited Liability Company, Homer Knearl, Echostar Communications Corporation, EchoStar DBS Corporation. (Attachments: # 1 Exhibit 1# 2 Exhibit 1-A# 3 Exhibit 1-B# 4 Exhibit 1-C# 5 Exhibit 1-D# 6 Exhibit 1-E# 7 Exhibit 1-F# 8 Exhibit 1-G# 9 Exhibit 1-H# 10 Exhibit 1-I# 11 Exhibit 2# 12 Exhibit 2-A# 13 Exhibit 2-B# 14 Exhibit 2-C# 15 Exhibit 2-D# 16 Exhibit 2-E# 17 Exhibit 2-F)(fmm) (Entered: 07/15/2005)
07/26/2005	2	PROPOSED CONSENT ORDER For Extension of Time re: 1 MOTION to Quash subpoenas. (Buhay, William) (Entered: 07/26/2005)
07/27/2005	6	APPLICATION for Admission of Harold J. McElhinny Pro Hac Viceby Echostar Technologies Corporation, Echosphere Limited Liability Company, Homer Knearl, Echostar Communications Corporation, EchoStar DBS Corporation.Filing Fee received \$150.00, Receipt #539834. (fmm) (Entered: 07/29/2005)
07/27/2005	7	APPLICATION for Admission of Peter P. Meringolo Pro Hac Viceby Echostar Technologies Corporation, Echosphere Limited Liability Company, Homer Knearl, Echostar Communications Corporation, EchoStar DBS Corporation.Filing Fee received \$150.00, Receipt #539834. (fmm) (Entered: 07/29/2005)
07/27/2005	8	APPLICATION for Admission of Marc J. Pernick Pro Hac Viceby Echostar Technologies Corporation, Echosphere Limited Liability Company, Homer Knearl, Echostar Communications Corporation, EchoStar DBS Corporation.Filing Fee received \$150.00, Receipt #539835. (fmm) (Entered: 07/29/2005)
07/28/2005	3	NOTICE of Appearance by William Charles Buhay on behalf of TiVo, Inc. (Buhay, William) (Entered: 07/28/2005)
07/28/2005	4	Second MOTION for Extension of Time Reply to Motion for Protective Order and to Quash re: 1 MOTION to Quash subpoenas, 2 Proposed Consent Order with Brief In Support by TiVo, Inc.. (Buhay, William) (Entered: 07/28/2005)
07/28/2005	5	PROPOSED ORDER Unopposed Motion to Extend Time to Reply to Motion for Protective Order and to Quash re: 4 Second MOTION for Extension of Time Reply to Motion for Protective Order and to Quash re: 1 MOTION to Quash subpoenas, 2 Proposed Consent Order. (Buhay, William) (Entered: 07/28/2005)
07/28/2005	9	ORDER GRANTING 4 Motion for Extension of Time. IT IS HEREBY ORDERED that Plaintiff shall have (3) three additional days in which to file its response to the Joint Motion . Signed by Judge William S. Duffey Jr. on 7/26/05. (kt) (Entered: 07/29/2005)
08/01/2005	10	ORDER GRANTING 5 Unopposed Motion to Extend time until 8/4/05 for TiVo to reply to EchoStar and Non-Party Homer Knearl's Joint Motion for a Protective Order and to Quash Rule 45 Subpoenas. Signed by Judge William S. Duffey Jr. on 8/1/05. (kt) (Entered: 08/02/2005)
08/02/2005	--	ORDER (by docket entry only) granting 6 Application for Admission Pro Hac Vice of Harold McElhinny, granting 7 Application for Admission Pro Hac Vice of Peter Meringolo, granting 8 Application for Admission Pro Hac Vice of Marc Pernick . Ordered by Judge William S. Duffey Jr. on 8/2/05. (jdb) (Entered: 08/02/2005)
08/03/2005	13	ORDER APPROVING 11 Third MOTION for Extension of Time to Reply to EchoStar and Non-Party Homer Knearl's Joint Motion for Protective Order and 1 Motion to Quash Rule 45 Subpoenas until 8/10/05. Signed by Judge William S. Duffey Jr. on 8/5/05. (kt) (Entered: 08/05/2005)
08/04/2005	11	Third MOTION for Extension of Time File Response re: 1 MOTION to Quash subpoenas with Brief In Support by TiVo, Inc.. (Buhay, William) (Entered: 08/04/2005)
08/04/2005	12	PROPOSED ORDER Granting Six (6) Day Extension re: 11 Third MOTION for Extension of Time File Response re: 1 MOTION to Quash subpoenas. (Buhay, William) (Entered: 08/04/2005)
08/05/2005	15	APPLICATION for Admission of Christine W.S. Byrd Pro Hac Viceby TiVo, Inc..Filing Fee received \$150.00, Receipt #540264. (fmm) (Entered: 08/11/2005)
08/05/2005	16	APPLICATION for Admission of Perry M. Goldberg Pro Hac Viceby TiVo, Inc..Filing Fee received \$150.00, Receipt #540264. (fmm) (Entered: 08/11/2005)
08/10/2005	14	Fourth MOTION for Extension of Time File Response re: 1 MOTION to Quash subpoenas with Brief In Support by TiVo, Inc.. (Attachments: # 1)(Buhay, William) (Entered: 08/10/2005)
08/12/2005	--	ORDER (by docket entry only) granting 15 Application for Admission Pro Hac Vice of Christine W.S. Byrd, granting 16 Application for Admission Pro Hac Vice of Perry M. Goldberg. Ordered by

Judge William S. Duffey Jr. on 8/12/05. (jdb) (Entered: 08/12/2005)

08/12/2005 17 ORDER GRANTING 14 Unopposed Motion for Extension of Time to Reply to the Joint Motion until 8/31/05. Signed by Judge William S. Duffey Jr. on 8/11/05. (kt) (Entered: 08/12/2005)

08/31/2005 18 Fifth MOTION for Extension of Time re: 1 MOTION to Quash subpoenas with Brief In Support by TiVo, Inc.. (Attachments: # 1 Exhibit A # 2 Proposed Order)(Buhay, William) Modified on 9/1/2005 to describe attachments (fmm). (Entered: 08/31/2005)

09/01/2005 19 ORDER GRANTING 18 Motion for Extension of Time until 9/14/05 for TiVo Inc. to reply to the Joint Motion for Protective Order and to Quash Rule 45 Subpoenas. Signed by Judge William S. Duffey Jr. on 8/31/05. (kt) (Entered: 09/01/2005)

09/14/2005 20 Sixth MOTION for Extension of Time to Reply to Joint Motion for Protective Order and Quash Rule 45 Subpoenas re: 1 MOTION to Quash subpoenas with Brief In Support by TiVo, Inc.. (Attachments: # 1 Proposed Order)(Buhay, William) Modified on 9/15/2005 to describe attachments (fmm). (Entered: 09/14/2005)

09/15/2005 21 ORDER GRANTING 20 Unopposed Motion for Extension of Time to Reply to the Joint Motion until 10/06/05. Signed by Judge William S. Duffey Jr. on 9/15/05. (kt) (Entered: 09/16/2005)

10/06/2005 22 Seventh MOTION to Continue by TiVo, Inc.. (Attachments: # 1 Exhibit Texas Court's September 26th Order# 2 Text of Proposed Order Oder Granting Continuance)(Buhay, William) (Entered: 10/06/2005)

10/07/2005 23 ORDER GRANTING 22 Seventh Unopposed Motion to Extend Time to Reply to EchoStar and Non-Party Homer Knearl's Joint Motion for a Protective Order and to Quash Rule 45 Subpoeas until 10/13/05. Signed by Judge William S. Duffey Jr. on 10/07/05. (kt) (Entered: 10/07/2005)

10/07/2005 24 RESPONSE re 22 Seventh MOTION to Continue filed by Echostar Technologies Corporation, Echosphere Limited Liability Company, Echostar Communications Corporation, EchoStar DBS Corporation. (Schlossberg, Ellen) (Entered: 10/07/2005)

10/13/2005 25 DOCUMENT FILED IN ERROR Eighth MOTION for Extension of Time to Reply to Echostar and Non-Party Homer Knearl's Joint Motionf or a Protective Order and to Quash Rule 45 Subpoenas; Motion to Dismiss Joint Motion as Moot with Brief In Support by TiVo, Inc.. (Attachments: # 1 Exhibit A to 8th Motion# 2 Exhibit Exhibit B to 8th motion# 3 Text of Proposed Order)(Buhay, William) Modified on 10/14/2005 (fmm). (Entered: 10/13/2005)

10/13/2005 26 REDOCKETED #25 MOTION AS Eighth MOTION for Extension of Time by 2 weeks to file response re: 1 MOTION for protective order and to Quash subpoenas or MOTION to Dismiss without prejudice the 1 MOTION for protective order and to Quash subpoenas by TiVo, Inc. (Attachments: # 1 Exhibit A# 2 Exhibit B# 3 Proposed Order)(fmm) (Entered: 10/14/2005)

10/14/2005 27 RESPONSE in Opposition re 26 MOTION to Dismiss MOTION for Extension of Time to file response to re: 1 MOTION to Quash subpoenas MOTION for Extension of Time to file response to re: 1 MOTION to Quash subpoenas filed by Homer Knearl. (Schlossberg, Ellen) (Entered: 10/14/2005)

10/28/2005 28 RESPONSE in Opposition re 1 MOTION to Quash subpoenas and Reply Brief to the 26 Motion to Dismiss filed by TiVo, Inc.. (Attachments: # 1 Text of Proposed Order Proposed Order denying Defendants' Motion for Protective Order and to Quash Subpoena and Granting Plaintiff's Motion to Dismiss Defendants' Motion as Moot)(Buhay, William) Modified on 10/31/2005 to add document link (fmm). (Entered: 10/28/2005)

10/28/2005 29 AFFIDAVIT in Opposition re 1 MOTION to Quash subpoenas and related Exhibts supporting TiVo's Response to the Motion to Quash and TiVo's Motion to Dismiss filed by TiVo, Inc.. (Attachments: # 1 Exhibit Exhibit A# 2 Exhibit Exhibit B# 3 Exhibit Exhibit C# 4 Exhibit Exhibit D# 5 Exhibit Exhibit E# 6 Exhibit Part 1 of Exhibit F# 7 Exhibit Part 2 of Exhibit F# 8 Exhibit Part 3 of Exhibit F)(Buhay, William) (Entered: 10/28/2005)

10/28/2005 30 AFFIDAVIT in Opposition re 1 MOTION to Quash subpoenas The Affidavit is actually a Declaration which attaches the Exhibits relied upon by TiVo filed by TiVo, Inc.. (Attachments: # 1 Exhibit Exhibit A - Filed Under Seal# 2 Exhibit Exhibit B# 3 Exhibit Exhibit C# 4 Exhibit Exhibit D# 5 Exhibit Exhibit E# 6 Exhibit Part 1 of Exhibit F# 7 Exhibit Part 2 of Exhibit F# 8 Exhibit Part 3 of Exhibit F)(Buhay, William) (Entered: 10/28/2005)

10/28/2005 31 MOTION to File Exhibit A to 29 Affidavit and 30 Affidavit Under Seal by TiVo, Inc. (Attachments: # 1 Proposed Order)(fmm) (Entered: 10/31/2005)

10/28/2005 32 Exhibit A to 29 Affidavit and 30 Affidavit by TiVo, Inc. (---FILED UNDER SEAL---) (fmm) (Entered: 10/31/2005)

10/28/2005 -- Miscellaneous Case Terminated. Case converted to 1:05-cv-2799. (kt) (Entered: 10/31/2005)

10/31/2005 33 First MOTION to Supplement 28 Response in Opposition to Motion,, 29 Affidavit in Opposition to

Motion, Motion for Leave to Supplement Response with Additional Exhibits with Brief In Support by TiVo, Inc.. (Attachments: # 1 Exhibit G-1# 2 Exhibit G-2# 3 Exhibit G-3# 4 Exhibit H-1# 5 Exhibit H-2# 6 Text of Proposed Order Granting Leave)(Buhay, William) (Entered: 10/31/2005)

02/06/2006 34 NOTICE Of Filing TiVo's Response to Motion to Quash by TiVo, Inc. re 28 Response in Opposition to Motion, Notice of Filing of Colorado Order (Attachments: # 1 Exhibit Colorado Order)(Buhay, William) (Entered: 02/06/2006)

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US District Court Civil Docket

U.S. District - Texas Eastern
(Marshall)

2:04cv1

Tivo Inc v. Echostar Comm, et al

This case was retrieved from the court on Wednesday, October 31, 2007

Date Filed: 01/05/2004	Class Code: CLOSED, APPEAL, FRC, JURY, MREFHM, PATENT
Assigned To: Judge David Folsom	Closed: yes
Referred To: Magistrate Judge Caroline Craven	Statute: 35:271
Nature of suit: Patent (830)	Jury Demand: Both
Cause: Patent Infringement	Demand Amount: \$0
Lead Docket: None	NOS
Other Docket: 5:05-cv-00081-DF	Description: Patent
Jurisdiction: Federal Question	

Litigants

Robert W Faulkner
Mediator

Tivo Inc A Delaware Corporation
Plaintiff

Attorneys

Robert W Faulkner
[COR LD NTC]
JAMS
8401 NORTH CENTRAL EXPRESSWAY
SUITE 610
DALLAS, TX 75225
214/744-5267
FAX: 214/720-6010
EMAIL: RFAULKNER@JAMSADR.COM
PRO SE

Alexander Chester Giza
[COR LD NTC]
Irell & Manella LLP
1800 Ave of the Stars
Ste 900
Los Angeles , CA 90067-4276
USA
310/ 203-7143
Fax: 13102037199
Email: Agiza@irell.com

Andrei Iancu
[COR LD NTC]
Irell & Manella -Los Angeles
1800 Avenue of the Stars
Suite 900
Los Angeles , CA 90067-4276
USA
310-277-1010
Fax: 310-203-7199

Email: Aiancu@irell.com

Samuel Franklin Baxter
[COR LD NTC]
McKool Smith -Marshall P O Box O
Marshall , TX 75671
USA
903/ 923-9000
Fax: 903-923-9099
Email: Sbaxter@mckoolsmith.com

Adam S Hoffman
[COR LD NTC]
Irell & Manella LLP
1800 Avenue of the Stars
Suite 900
Los Angeles , CA 90067-4276
USA
310/ 277-1010
Fax: 13102037199
Email: Ahoffman@irell.com

Ben Yorks
[COR LD NTC]
Irell & Manella -Newport Beach
840 Newport Center Drive
Suite 400
Newport Beach , CA 92660
USA
949/ 760-0991
Fax: 19497605200
Email: Byorks@irell.com

Brian Jones
[COR LD NTC]
Irell & Manella -Newport Beach
840 Newport Center Drive
Suite 400
Newport Beach , CA 92660
USA
949-760-0991
Fax: 19497605200
Email: Bjones@irell.com

Christine W S Byrd
[COR LD NTC]
Irell & Manella -Los Angeles
1800 Avenue of the Stars
Suite 900
Los Angeles , CA 90067-4276
USA
310/ 277-1010
Fax: 13102037199
Email: Cbyrd@irell.com

Michelle Armond
[COR LD NTC]
Irell & Manella -Newport Beach
840 Newport Center Drive
Suite 400
Newport Beach , CA 92660
USA
949-760-0991
Fax: 19497605200
Email: Marmond@irell.com

Morgan Chu

[COR LD NTC]
Irell & Manella -Los Angeles
1800 Avenue of the Stars
Suite 900
Los Angeles , CA 90067-4276
USA
310/ 277-1010
Fax: 13102037199
Email: McHu@irell.com

Perry M Goldberg
[COR LD NTC]
Irell & Manella LLP
1800 Avenue of the Stars
Suite 900
Los Angeles , CA 90067-4276
USA
310/ 277-1010
Fax: 13102037199
Email: Pgoldberg@irell.com

R Scott Feldmann
[COR LD NTC]
Crowell & Moring -Irvine
3 Park Plaza
20TH Floor
Irvine , CA 92614
USA
949/ 263-8400
Fax: 949/ 263-8414
Email: Sfeldmann@crowell.com

Randall I Erickson
[COR LD NTC]
Crowell & Moring -Irvine
3 Park Plaza
20TH Floor
Irvine , CA 92614
USA
949/ 261-8400
Fax: 949/ 263-8414
Email: Rerickson@crowell.com

Richard E Lyon
[COR LD NTC]
Irell & Manella LLP
1800 Avenue of the Stars
Suite 900
Los Angeles , CA 90067-4276
USA
310/ 277-1010
Fax: 13102037199
Email: Rlyon@irell.com

Steven P Rice
[COR LD NTC]
Crowell & Moring -Irvine
3 Park Plaza
20TH Floor
Irvine , CA 92614
USA
949/ 263-8400
Fax: 949/ 263-8414
Email: Srice@crowell.com

Van V Nguyen
[COR LD NTC]

Echostar Communications Corporation A Nevada
Corporation
Defendant

Crowell & Moring -Irvine
3 Park Plaza
20TH Floor
Irvine , CA 92614
USA
949/ 263-8400
Fax: 949/ 263-8414
Email: Vnguyen@crowell.com

Garret Wesley Chambers
[COR LD NTC]
McKool Smith -Dallas
300 Crescent Court
Suite 1500
Dallas , TX 75201
USA
214/ 978-4000
Fax: 12149784044
Email: Gchambers@mckoolsmith.com

Alison M Tucher
[COR LD NTC]
Morrison & Foerster LLP San Francisco
425 Market St
34TH Floor
San Francisco , CA 94105-2482
USA
415/ 268-7269
Fax: 415/ 268-7522
Email: Atucher@mofo.com

Ann Critin
[COR LD NTC]
[Term: 01/17/2006]
Morrison & Foerster -Denver
5200 Republic Plaza
370 17TH St
Denver , CO 80202
USA
303-592-1500
Fax: 303-592-1510
Email: Acitrin@mofo.com

Jason A Crotty
[COR LD NTC]
Morrison & Foerster LLP San Francisco
425 Market St
34TH Floor
San Francisco , CA 94105-2482
USA
415-268-7000
Fax: 415-268-7522
Email: Jcrotty@mofo.com

Rachel Krevans
[COR LD NTC]
Morrison & Foerster LLP San Francisco
425 Market St
34TH Floor
San Francisco , CA 94105-2482
USA
415/ 268-7178
Fax: 14152687522
Email: Rkrevans@mofo.com

Harold J McElhinny

[COR LD NTC]
Morrison & Foerster LLP San Francisco
425 Market St
34TH Floor
San Francisco , CA 94105-2482
USA
415/ 268-7265
Fax: 415/ 268-7522
Email: Hmcelhinny@mofo.com

Karl J Kramer
[COR LD NTC]
Morrison & Foerster -Palo Alto
755 Page Mill Road
Palo Alto , CA 94304
USA
650-813-5600
Fax: 650-494-0792
Email: Kkramer@mofo.com

Paul A Friedman
[COR LD NTC]
[Term: 01/09/2006]
Morrison & Foerster LLP
425 Market St
San Francisco , CA 94105-2482
USA
415/ 268-6220
Fax: 14152687522
Email: Pafriedman@mofo.com

Robert M Harkins, Jr
[COR LD NTC]
02 Micro, Inc
3118 Patrick Henry Dr
Santa Clara , CA 95054
USA
415-268-7000
Fax: 415-268-7522
Email: Robert.harkins@02micro.com

Zachariah A Higgins
[COR LD NTC]
[Term: 11/12/2004]
Kirkland & Ellis LLP -California
555 California St
Floor 24
San Francisco , CA 94104
USA
415/ 439-1887
Fax: 14154391500
Email: Zhiggins@kirkland.com

Damon Michael Young
[COR LD NTC]
Young Pickett & Lee
4122 Texas Blvd
PO Box 1897
Texarkana , TX 75504-1897
USA
903/ 794-1303
Fax: 19037925098
Email: Dyoung@youngpickettllaw.com

Echostar Dbs Corporation A Colorado Corporation
Defendant

Alison M Tucher
[COR LD NTC]

Morrison & Foerster LLP San Francisco
425 Market St
34TH Floor
San Francisco , CA 94105-2482
USA
415/ 268-7269
Fax: 415/ 268-7522
Email: Atucher@mofocom

Ann Critin
[COR LD NTC]
[Term: 01/17/2006]
Morrison & Foerster -Denver
5200 Republic Plaza
370 17TH St
Denver , CO 80202
USA
303-592-1500
Fax: 303-592-1510
Email: Acitrin@mofocom

Jason A Crotty
[COR LD NTC]
Morrison & Foerster LLP San Francisco
425 Market St
34TH Floor
San Francisco , CA 94105-2482
USA
415-268-7000
Fax: 415-268-7522
Email: Jcrotty@mofocom

Rachel Krevans
[COR LD NTC]
Morrison & Foerster LLP San Francisco
425 Market St
34TH Floor
San Francisco , CA 94105-2482
USA
415/ 268-7178
Fax: 14152687522
Email: Rkrevans@mofocom

Harold J McElhinny
[COR LD NTC]
Morrison & Foerster LLP San Francisco
425 Market St
34TH Floor
San Francisco , CA 94105-2482
USA
415/ 268-7265
Fax: 415/ 268-7522
Email: Hmcelhinny@mofocom

Karl J Kramer
[COR LD NTC]
Morrison & Foerster -Palo Alto
755 Page Mill Road
Palo Alto , CA 94304
USA
650-813-5600
Fax: 650-494-0792
Email: Kkramer@mofocom

Paul A Friedman
[COR LD NTC]
[Term: 01/09/2006]

Morrison & Foerster LLP
425 Market St
San Francisco , CA 94105-2482
USA
415/ 268-6220
Fax: 14152687522
Email: Pafriedman@mofocom

Robert M Harkins, Jr
[COR LD NTC]
02 Micro, Inc
3118 Patrick Henry Dr
Santa Clara , CA 95054
USA
415-268-7000
Fax: 415-268-7522
Email: Robert.harkins@02micro.com

Zachariah A Higgins
[COR LD NTC]
[Term: 11/12/2004]
Kirkland & Ellis LLP -California
555 California St
Floor 24
San Francisco , CA 94104
USA
415/ 439-1887
Fax: 14154391500
Email: Zhiggins@kirkland.com

Damon Michael Young
[COR LD NTC]
Young Pickett & Lee
4122 Texas Blvd
PO Box 1897
Texarkana , TX 75504-1897
USA
903/ 794-1303
Fax: 19037925098
Email: Dyoung@youngpickettllaw.com

"echostar Defendants"
Defendant

Ann Critin
[COR LD NTC]
[Term: 01/17/2006]
Morrison & Foerster -Denver
5200 Republic Plaza
370 17TH St
Denver , CO 80202
USA
303-592-1500
Fax: 303-592-1510
Email: Acitrin@mofocom

Emily A Evans
[COR LD NTC]
Morrison & Foerster -Palo Alto
755 Page Mill Road
Palo Alto , CA 94304
USA
650-813-5600
Fax: 650-494-0792
Email: Eevans@mofocom

Kristina Paszek
[COR LD NTC]
Morrison & Foerster LLP San Francisco

425 Market St
34TH Floor
San Francisco , CA 94105-2482
USA
415-268-7000
Fax: 415-268-7522
Email: Kpaszek@mofocom

Scott F Llewellyn
[COR LD NTC]
Morrison & Foerster -Denver
5200 Republic Plaza
370 17TH St
Denver , CO 80202
USA
303-592-1500
Fax: 303-592-1510
Email: Sllewellyn@mofocom

Alison M Tucher
[COR LD NTC]
Morrison & Foerster LLP San Francisco
425 Market St
34TH Floor
San Francisco , CA 94105-2482
USA
415/ 268-7269
Fax: 415/ 268-7522
Email: Atucher@mofocom

Harold J McElhinny
[COR LD NTC]
Morrison & Foerster LLP San Francisco
425 Market St
34TH Floor
San Francisco , CA 94105-2482
USA
415/ 268-7265
Fax: 415/ 268-7522
Email: Hmcelhinny@mofocom

John Michael Pickett
[COR LD NTC]
Young Pickett & Lee
4122 Texas Blvd
PO Box 1897
Texarkana , TX 75504-1897
USA
903/ 794-1303
Fax: 19037945098
Email: Jpickett@youngpickettllaw.com

Karl J Kramer
[COR LD NTC]
Morrison & Foerster -Palo Alto
755 Page Mill Road
Palo Alto , CA 94304
USA
650-813-5600
Fax: 650-494-0792
Email: Kkramer@mofocom

Paul A Friedman
[COR LD NTC]
[Term: 01/09/2006]
Morrison & Foerster LLP
425 Market St

San Francisco , CA 94105-2482
USA
415/ 268-6220
Fax: 14152687522
Email: Pafriedman@mofo.com

Rachel Krevans
[COR LD NTC]
Morrison & Foerster LLP San Francisco
425 Market St
34TH Floor
San Francisco , CA 94105-2482
USA
415/ 268-7178
Fax: 14152687522
Email: Rkrevans@mofo.com

Robert M Harkins, Jr
[COR LD NTC]
02 Micro, Inc
3118 Patrick Henry Dr
Santa Clara , CA 95054
USA
415-268-7000
Fax: 415-268-7522
Email: Robert.harkins@02micro.com

Echostar Satellite Llc
Defendant

Merchant & Gould Subpoena Recipient
Movant

Charles Conrow Murphy, Jr
[COR LD NTC]
Vaughan & Murphy
260 Peachtree Street NW
Suite 1600
Atlanta , GA 30303
USA
404-577-6550
Fax: 404-577-0060
Email: Cmurphy@vaughanandmurphy.com

Echostar Technologies Corporation
Defendant

Allison M Tucher
[COR LD NTC]
Morrison & Foerster LLP San Francisco
425 Market St
34TH Floor
San Francisco , CA 94105-2482
USA
415/ 268-7269
Fax: 415/ 268-7522
Email: Atucher@mofo.com

Ann Critin
[COR LD NTC]
[Term: 01/17/2006]
Morrison & Foerster -Denver
5200 Republic Plaza
370 17TH St
Denver , CO 80202
USA
303-592-1500
Fax: 303-592-1510
Email: Acitrin@mofo.com

Jason A Crotty

[COR LD NTC]
Morrison & Foerster LLP San Francisco
425 Market St
34TH Floor
San Francisco , CA 94105-2482
USA
415-268-7000
Fax: 415-268-7522
Email: Jcrotty@mofo.com

Rachel Krevans
[COR LD NTC]
Morrison & Foerster LLP San Francisco
425 Market St
34TH Floor
San Francisco , CA 94105-2482
USA
415/ 268-7178
Fax: 14152687522
Email: Rkrevans@mofo.com

Damon Michael Young
[COR LD NTC]
Young Pickett & Lee
4122 Texas Blvd
PO Box 1897
Texarkana , TX 75504-1897
USA
903/ 794-1303
Fax: 19037925098
Email: Dyoung@youngpickettllaw.com

Harold J McElhinny
[COR LD NTC]
Morrison & Foerster LLP San Francisco
425 Market St
34TH Floor
San Francisco , CA 94105-2482
USA
415/ 268-7265
Fax: 415/ 268-7522
Email: Hmcelhinny@mofo.com

Karl J Kramer
[COR LD NTC]
Morrison & Foerster -Palo Alto
755 Page Mill Road
Palo Alto , CA 94304
USA
650-813-5600
Fax: 650-494-0792
Email: Kkramer@mofo.com

Paul A Friedman
[COR LD NTC]
[Term: 01/09/2006]
Morrison & Foerster LLP
425 Market St
San Francisco , CA 94105-2482
USA
415/ 268-6220
Fax: 14152687522
Email: Pafriedman@mofo.com

Robert M Harkins, Jr
[COR LD NTC]
02 Micro, Inc

Echosphere Limited Liability Company
Defendant

3118 Patrick Henry Dr
Santa Clara , CA 95054
USA
415-268-7000
Fax: 415-268-7522
Email: Robert.harkins@02micro.com

Zachariah A Higgins
[COR LD NTC]
[Term: 11/12/2004]
Kirkland & Ellis LLP -California
555 California St
Floor 24
San Francisco , CA 94104
USA
415/ 439-1887
Fax: 14154391500
Email: Zhiggins@kirkland.com

Alison M Tucher
[COR LD NTC]
Morrison & Foerster LLP San Francisco
425 Market St
34TH Floor
San Francisco , CA 94105-2482
USA
415/ 268-7269
Fax: 415/ 268-7522
Email: Atucher@mofocom

Ann Critin
[COR LD NTC]
[Term: 01/17/2006]
Morrison & Foerster -Denver
5200 Republic Plaza
370 17TH St
Denver , CO 80202
USA
303-592-1500
Fax: 303-592-1510
Email: Acitrin@mofocom

Jason A Crotty
[COR LD NTC]
Morrison & Foerster LLP San Francisco
425 Market St
34TH Floor
San Francisco , CA 94105-2482
USA
415-268-7000
Fax: 415-268-7522
Email: Jcrotty@mofocom

Rachel Krevans
[COR LD NTC]
Morrison & Foerster LLP San Francisco
425 Market St
34TH Floor
San Francisco , CA 94105-2482
USA
415/ 268-7178
Fax: 14152687522
Email: Rkrevans@mofocom

Harold J McElhinny
[COR LD NTC]

Morrison & Foerster LLP San Francisco
425 Market St
34TH Floor
San Francisco , CA 94105-2482
USA
415/ 268-7265
Fax: 415/ 268-7522
Email: Hmcelhinny@mofo.com

Karl J Kramer
[COR LD NTC]
Morrison & Foerster -Palo Alto
755 Page Mill Road
Palo Alto , CA 94304
USA
650-813-5600
Fax: 650-494-0792
Email: Kkramer@mofo.com

Paul A Friedman
[COR LD NTC]
[Term: 01/09/2006]
Morrison & Foerster LLP
425 Market St
San Francisco , CA 94105-2482
USA
415/ 268-6220
Fax: 14152687522
Email: Pafriedman@mofo.com

Robert M Harkins, Jr
[COR LD NTC]
02 Micro, Inc
3118 Patrick Henry Dr
Santa Clara , CA 95054
USA
415-268-7000
Fax: 415-268-7522
Email: Robert.harkins@02micro.com

Zachariah A Higgins
[COR LD NTC]
[Term: 11/12/2004]
Kirkland & Ellis LLP -California
555 California St
Floor 24
San Francisco , CA 94104
USA
415/ 439-1887
Fax: 14154391500
Email: Zhiggins@kirkland.com

Damon Michael Young
[COR LD NTC]
Young Pickett & Lee
4122 Texas Blvd
PO Box 1897
Texarkana , TX 75504-1897
USA
903/ 794-1303
Fax: 19037925098
Email: Dyoung@youngpickettlaw.com

Alison M Tucher
[COR LD NTC]
Morrison & Foerster LLP San Francisco

Echostar Technologies Corporation
Counter Claimant

425 Market St
34TH Floor
San Francisco , CA 94105-2482
USA
415/ 268-7269
Fax: 415/ 268-7522
Email: Atucher@mofo.com

Ann Critin
[COR LD NTC]
[Term: 01/17/2006]
Morrison & Foerster -Denver
5200 Republic Plaza
370 17TH St
Denver , CO 80202
USA
303-592-1500
Fax: 303-592-1510
Email: Acitrin@mofo.com

Damon Michael Young
[COR LD NTC]
Young Pickett & Lee
4122 Texas Blvd
PO Box 1897
Texarkana , TX 75504-1897
USA
903/ 794-1303
Fax: 19037925098
Email: Dyoung@youngpickettllaw.com

Jason A Crotty
[COR LD NTC]
Morrison & Foerster LLP San Francisco
425 Market St
34TH Floor
San Francisco , CA 94105-2482
USA
415-268-7000
Fax: 415-268-7522
Email: Jcrotty@mofo.com

Karl J Kramer
[COR LD NTC]
Morrison & Foerster -Palo Alto
755 Page Mill Road
Palo Alto , CA 94304
USA
650-813-5600
Fax: 650-494-0792
Email: Kkramer@mofo.com

Robert M Harkins, Jr
[COR LD NTC]
02 Micro, Inc
3118 Patrick Henry Dr
Santa Clara , CA 95054
USA
415-268-7000
Fax: 415-268-7522
Email: Robert.harkins@02micro.com

Echosphere Limited Liability Company
Counter Claimant

Alison M Tucher
[COR LD NTC]
Morrison & Foerster LLP San Francisco
425 Market St

34TH Floor
San Francisco , CA 94105-2482
USA
415/ 268-7269
Fax: 415/ 268-7522
Email: Atucher@mofo.com

Ann Critin
[COR LD NTC]
[Term: 01/17/2006]
Morrison & Foerster -Denver
5200 Republic Plaza
370 17TH St
Denver , CO 80202
USA
303-592-1500
Fax: 303-592-1510
Email: Acitrin@mofo.com

Damon Michael Young
[COR LD NTC]
Young Pickett & Lee
4122 Texas Blvd
PO Box 1897
Texarkana , TX 75504-1897
USA
903/ 794-1303
Fax: 19037925098
Email: Dyoung@youngpickettllaw.com

Jason A Crotty
[COR LD NTC]
Morrison & Foerster LLP San Francisco
425 Market St
34TH Floor
San Francisco , CA 94105-2482
USA
415-268-7000
Fax: 415-268-7522
Email: Jcrotty@mofo.com

Karl J Kramer
[COR LD NTC]
Morrison & Foerster -Palo Alto
755 Page Mill Road
Palo Alto , CA 94304
USA
650-813-5600
Fax: 650-494-0792
Email: Kkramer@mofo.com

Robert M Harkins, Jr
[COR LD NTC]
02 Micro, Inc
3118 Patrick Henry Dr
Santa Clara , CA 95054
USA
415-268-7000
Fax: 415-268-7522
Email: Robert.harkins@02micro.com

Tivo Inc A Delaware Corporation
Counter Defendant

Adam S Hoffman
[COR LD NTC]
Irell & Manella LLP
1800 Avenue of the Stars
Suite 900

Echostar Communications Corporation A Nevada Corporation
Counter Claimant

Los Angeles , CA 90067-4276
USA
310/ 277-1010
Fax: 13102037199
Email: Ahoffman@irell.com

Alison M Tucher
[COR LD NTC]
Morrison & Foerster LLP San Francisco
425 Market St
34TH Floor
San Francisco , CA 94105-2482
USA
415/ 268-7269
Fax: 415/ 268-7522
Email: Atucher@mofo.com

Ann Critin
[COR LD NTC]
[Term: 01/17/2006]
Morrison & Foerster -Denver
5200 Republic Plaza
370 17TH St
Denver , CO 80202
USA
303-592-1500
Fax: 303-592-1510
Email: Acitrin@mofo.com

Jason A Crotty
[COR LD NTC]
Morrison & Foerster LLP San Francisco
425 Market St
34TH Floor
San Francisco , CA 94105-2482
USA
415-268-7000
Fax: 415-268-7522
Email: Jcrotty@mofo.com

Karl J Kramer
[COR LD NTC]
Morrison & Foerster -Palo Alto
755 Page Mill Road
Palo Alto , CA 94304
USA
650-813-5600
Fax: 650-494-0792
Email: Kkramer@mofo.com

Robert M Harkins, Jr
[COR LD NTC]
02 Micro, Inc
3118 Patrick Henry Dr
Santa Clara , CA 95054
USA
415-268-7000
Fax: 415-268-7522
Email: Robert.harkins@02micro.com

Echostar Dbs Corporation A Colorado Corporation
Counter Claimant

Allison M Tucher
[COR LD NTC]
Morrison & Foerster LLP San Francisco
425 Market St
34TH Floor

San Francisco , CA 94105-2482
USA
415/ 268-7269
Fax: 415/ 268-7522
Email: Atucher@mofo.com

Ann Critin
[COR LD NTC]
[Term: 01/17/2006]
Morrison & Foerster -Denver
5200 Republic Plaza
370 17TH St
Denver , CO 80202
USA
303-592-1500
Fax: 303-592-1510
Email: Acitrin@mofo.com

Jason A Crotty
[COR LD NTC]
Morrison & Foerster LLP San Francisco
425 Market St
34TH Floor
San Francisco , CA 94105-2482
USA
415-268-7000
Fax: 415-268-7522
Email: Jcrotty@mofo.com

Karl J Kramer
[COR LD NTC]
Morrison & Foerster -Palo Alto
755 Page Mill Road
Palo Alto , CA 94304
USA
650-813-5600
Fax: 650-494-0792
Email: Kkramer@mofo.com

Robert M Harkins, Jr
[COR LD NTC]
02 Micro, Inc
3118 Patrick Henry Dr
Santa Clara , CA 95054
USA
415-268-7000
Fax: 415-268-7522
Email: Robert.harkins@02micro.com

Tivo Inc A Delaware Corporation
Counter Defendant

Echostar Communications Corporation A Nevada
Corporation
Counter Claimant

Echostar Dbs Corporation A Colorado Corporation
Counter Claimant

Tivo Inc A Delaware Corporation
Counter Defendant

Echostar Satellite Lic
Counter Claimant

Karl J Kramer
[COR LD NTC]
Morrison & Foerster -Palo Alto
755 Page Mill Road

Palo Alto , CA 94304
USA
650-813-5600
Fax: 650-494-0792
Email: Kkramer@mofo.com

Echostar Technologies Corporation
Counter Claimant

Echosphere Limited Liability Company
Counter Claimant

Tivo Inc A Delaware Corporation
Counter Defendant

Date	#	Proceeding Text
01/05/2004	1	Original Complaint with JURY DEMAND filed. Cause: 35:271 Patent Infringement (poa) (Entered: 01/07/2004)
01/05/2004	--	Demand for jury trial by TIVO Inc (poa) (Entered: 01/07/2004)
01/05/2004	--	Magistrate consent forms mailed to TIVO Inc (poa) (Entered: 01/07/2004)
01/05/2004	2	Form mailed to Commissioner of Patents and Trademarks. (poa) (Entered: 01/07/2004)
01/09/2004	--	Summons(es) issued for Echostar Comm, Echostar DBS Corp & given to atty's runner (ktd) (Entered: 01/09/2004)
01/15/2004	3	Amended complaint by TIVO Inc , (Answer due 1/26/04 for Echostar DBS Corp, for Echostar Comm) amending [1-1] complaint adding dfts EchoStar Tech Corp, Echosphere Ltd Liab (ktd) (Entered: 01/15/2004)
01/15/2004	--	Summons(es) issued for EchoStar Tech Corp, Echosphere Ltd Liab & given to pla's runner (ktd) (Entered: 01/15/2004)
01/15/2004	6	Form mailed to Commissioner of Patents and Trademarks. (ktd) Additional attachment(s) added on 1/28/2005 (ehs,). (Entered: 01/22/2004)
01/20/2004	4	Return of service executed as to Echostar DBS Corp 1/12/04 Answer due on 2/2/04 for Echostar DBS Corp (ktd) Additional attachment(s) added on 1/28/2005 (ehs,). (Entered: 01/21/2004)
01/20/2004	5	Return of service executed as to Echostar Comm 1/12/04 Answer due on 2/2/04 for Echostar Comm (ktd) Additional attachment(s) added on 1/28/2005 (ehs,). (Entered: 01/21/2004)
01/26/2004	7	Return of service executed as to EchoStar Tech Corp, Echosphere Ltd Liab 1/16/04 Answer due on 2/5/04 for EchoStar Tech Corp, for Echosphere Ltd Liab (ktd) Additional attachment(s) added on 1/28/2005 (ehs,). (Entered: 01/27/2004)
01/29/2004	8	Secty's Return of service executed as to Echostar DBS Corp 1/20/04 Answer due on 2/9/04 for Echostar DBS Corp (ktd) Additional attachment(s) added on 1/28/2005 (ehs,). (Entered: 01/30/2004)
01/29/2004	9	Secty's Return of service executed as to Echostar Comm 1/20/04 Answer due on 2/9/04 for Echostar Comm (ktd) Additional attachment(s) added on 1/28/2005 (ehs,). (Entered: 01/30/2004)
02/04/2004	10	Secretary of State certificate of service served upon Echosphere Ltd Liab on 1/28/04 (poa) (Entered: 02/04/2004)
02/05/2004	11	Stipulation to extend time to close of business on 3/1/04 for dft's answer or response (ktd) (Entered: 02/05/2004)
02/09/2004	12	Secretary's Return of Service Executed as to EchoStar Technologies Corporation by c/rrr mail on 1/27/2004, answer due: 2/16/2004. (ktd,) (Entered: 02/13/2004)
02/27/2004	13	APPLICATION to Appear Pro Hac Vice by Attorney Rachel Krevans for Echostar Communications Corporation; Echostar DBS Corporation; EchoStar Technologies Corporation and Echosphere Limited Liability Company. (ktd,) (Entered: 03/01/2004)
02/27/2004	14	APPLICATION to Appear Pro Hac Vice by Attorney Zachariah A. Higgins for Echostar Communications Corporation; Echostar DBS Corporation; EchoStar Technologies Corporation and Echosphere Limited Liability Company. (ktd,) (Entered: 03/01/2004)
02/27/2004	15	APPLICATION to Appear Pro Hac Vice by Attorney Paul A. Friedman for Echostar

Communications Corporation; Echostar DBS Corporation; EchoStar Technologies Corporation and Echosphere Limited Liability Company. (ktd,) (Entered: 03/01/2004)

02/27/2004 16 APPLICATION to Appear Pro Hac Vice by Attorney Harold J. McElhinny for Echostar Communications Corporation; Echostar DBS Corporation; EchoStar Technologies Corporation and Echosphere Limited Liability Company. (ktd,) (Entered: 03/01/2004)

03/01/2004 -- Pro Hac Vice Filing fee paid by McElhinny; Krevans; Higgins; Friedman; Fee: \$100., receipt number: 102101 (ktd,) (Entered: 03/01/2004)

03/01/2004 17 CORPORATE DISCLOSURE STATEMENT filed by EchoStar Technologies Corporation, Echosphere Limited Liability Company, Echostar Communications Corporation, Echostar DBS Corporation (poa,) (Entered: 03/02/2004)

03/01/2004 18 Filed in Texarkana ANSWER to Amended Complaint ; COUNTERCLAIM against TIVO Inc for declaratory relief of invalidity, non-infringement and unenforceability by EchoStar Technologies Corporation, Echosphere Limited Liability Company.(ktd,) (Entered: 03/02/2004)

03/01/2004 19 MOTION to Change Venue to the Northern District Of California, MOTION to Dismiss by EchoStar Technologies Corporation, Echosphere Limited Liability Company, Echostar Communications Corporation, Echostar DBS Corporation. (poa,) (Entered: 03/02/2004)

03/05/2004 20 REPLY to 18 Answer to Amended Complaint, Counterclaim by TIVO Inc. (poa,) (Entered: 03/09/2004)

03/05/2004 21 APPLICATION to Appear Pro Hac Vice by Attorney Richard E Lyon for TIVO Inc, Perry M Goldberg for TIVO Inc, Ben Yorks for TIVO Inc, Morgan Chu for TIVO Inc. (ktd,) (Entered: 03/09/2004)

03/05/2004 -- Pro Hac Vice Filing fee paid by Chu; Goldberg; Yorks; Lyon; Fee: \$100., receipt number: 102128 (ktd,) (Entered: 03/09/2004)

03/16/2004 22 APPLICATION to Appear Pro Hac Vice by Attorney Adam S. Hoffman for TIVO Inc and TIVO Inc. (mpv,) (Entered: 03/17/2004)

03/16/2004 -- Pro Hac Vice Filing fee paid by Adam S Hoffman; Fee: \$25, receipt number: 102267 (mpv,) (Entered: 03/17/2004)

03/17/2004 23 MOTION for Leave to exceed page limit for pltf to file its oppositions to defts' motion to transfer and dismiss by TIVO Inc. (mll,) (Entered: 03/22/2004)

03/26/2004 24 ORDER granting 23 Motion for Leave to File Excess Pages for its oppositions to dfts' motion to transfer or dismiss. Signed by Judge David Folsom on 3/24/04. (ktd,) (Entered: 03/26/2004)

03/26/2004 25 RESPONSE in Opposition re 19 MOTION to Change Venue filed by TIVO Inc.(exhibits not scanned) (ktd,) (Entered: 03/26/2004)

03/26/2004 26 RESPONSE in Opposition re 19 MOTION to Dismiss filed by TIVO Inc. (ktd,) (Exhibits not scanned) Modified on 3/26/2004 (ktd,). Additional attachment(s) added on 2/15/2005 (ehs,). (Entered: 03/26/2004)

04/05/2004 27 AGREED MOTION for Defendants to File Replies to Plaintiff's Oppositions to Defendant's Motion to Transfer and Dismiss, by EchoStar Technologies Corporation, Echosphere Limited Liability Company, Echostar Communications Corporation, Echostar DBS Corporation. (kjr,) (Entered: 04/05/2004)

04/05/2004 28 REPLY to Response to Motion re 19 MOTION to Change Venue MOTION to Dismiss filed by EchoStar defendants. (ktd,) (Entered: 04/07/2004)

04/05/2004 29 REPLY to Response to Motion re 19 MOTION to Change Venue MOTION to Dismiss filed by "EchoStar defendants". (ktd,) (Entered: 04/07/2004)

04/12/2004 30 AGREED MOTION for Leave to File Excess Pages for TIVO's Sur-Reply in Support of its Opposition to Motion to Dismiss, by TIVO Inc. (kjr,) (Entered: 04/13/2004)

04/12/2004 32 SUR-REPLY in Support of Opposition to Motion re 19 MOTION to Change Venue, filed by TIVO Inc. (kjr,) (Entered: 04/13/2004)

04/13/2004 31 ORDER granting 27 Dfts' Motion for Leave to File Excess Pages for Replies to Plaintiff's Oppositions to Dfts' Motion to Transfer and to Dismiss. Signed by Judge David Folsom on 4/12/04. (kjr,) (Entered: 04/13/2004)

04/16/2004 33 ORDER granting 30 Motion for Leave to File Excess Pages to file Sur-Reply in support of its opposition to motion to dismiss. Signed by Judge David Folsom on 4/14/04. cc: attys (poa,) (Entered: 04/16/2004)

04/16/2004 34 SUR-REPLY to Response to Motion re 19 MOTION to Dismiss filed by TIVO Inc. (ktd,) (Entered: 04/19/2004)

07/20/2004 35 MOTION for Hearing /Scheduling Conference, or in the alternative, Request for Order Requiring Parties to Hold Rule 26(f) Conference by TIVO Inc. (Attachments: # 1 Text of Proposed Order) (Chambers, Garret) (Entered: 07/20/2004)

07/22/2004 36 RESPONSE in Opposition re 35 MOTION for Hearing /Scheduling Conference, or in the alternative, Request for Order Requiring Parties to Hold Rule 26(f) Conference filed by EchoStar Technologies Corporation, Echosphere Limited Liability Company. (Friedman, Paul) (Entered: 07/22/2004)

08/27/2004 37 ORDER to Conduct Rule 26(f) Conference. Signed by Judge David Folsom on 8/26/04. (mrm,) (Entered: 08/27/2004)

10/15/2004 38 NOTICE of Disclosure by TIVO Inc (Baxter, Samuel) (Entered: 10/15/2004)

10/20/2004 39 NOTICE of Disclosure by EchoStar Technologies Corporation, Echosphere Limited Liability Company, Echostar Communications Corporation, Echostar DBS Corporation (Young, Damon) (Entered: 10/20/2004)

10/25/2004 40 NOTICE by EchoStar Technologies Corporation, Echosphere Limited Liability Company, Echostar Communications Corporation, TIVO Inc of Joint Rule 26(f) Conference Report (Attachments: # 1Proposed Scheduling Order (Submitted by Defendant)# 2Proposed Scheduling Order (Submitted by Plaintiff Tivo))(Chambers, Garret) Modified on 10/26/2004 (fal). (Entered: 10/25/2004)

10/28/2004 -- Notified Attorney, Zachariah A. Higgins, Per GO 04-12, that we received several email bounce back by leaving 2 voice mail messages on his phone and his assistant phone on 10/20/04 and 10/21/04 and have no response from either as of 10/25/04. He is no longer with Morrison & Foerster.(djh,) (Entered: 10/28/2004)

11/03/2004 41 MOTION for Zachariah A Higgins to Withdraw as Attorney by "EchoStar defendants". (ktd,) (Entered: 11/04/2004)

11/12/2004 42 ORDER Setting Hearing on Motion 19 MOTION to Change Venue MOTION to Dismiss: Motion Hearing set for 12/8/2004 11:00 AM in Ctrm 319 (Texarkana) before Judge David Folsom.. Signed by Judge David Folsom on 11/11/04. (mrm,) (Entered: 11/12/2004)

11/12/2004 43 ORDER granting 41 Motion to Withdraw as Attorney. Attorney Zachariah A. Higgins terminated Signed by Judge David Folsom on 11/10/04. (mrm,) (Entered: 11/12/2004)

11/15/2004 44 ORDER The Court has set a Rule 16(b) Scheduling and Planning Conference for 12/8/2004 11:00 AM, following the court's hearing on Dfts Motion to Dismiss and Transfer in Ctrm 319 (Texarkana) before Judge David Folsom.. Signed by Judge David Folsom on 11/15/04. (mrm,) Modified on 11/18/2004 (mrm,). (Entered: 11/15/2004)

12/08/2004 45 Minute Entry for proceedings held before Judge David Folsom : Motion Hearing held on 12/8/2004 re 19 MOTION to Change Venue MOTION to Dismiss filed by Echostar Communications Corporation, Echostar DBS Corporation, EchoStar Technologies Corporation, Echosphere Limited Liability Company, Scheduling Conference held on 12/8/2004. (Court Reporter Libby Crawford.) (mrm,) (Entered: 12/08/2004)

12/13/2004 46 Joint MOTION for Protective Order by "EchoStar defendants", EchoStar Technologies Corporation, Echosphere Limited Liability Company, Echostar Communications Corporation, Echostar DBS Corporation, TIVO Inc. (Attachments: # 1 Exhibit A# 2 Text of Proposed Order) (Baxter, Samuel) (Entered: 12/13/2004)

12/22/2004 47 Proposed Pretrial Order [propoeed] scheduling order by "EchoStar defendants". (Friedman, Paul) Additional attachment(s) added on 12/22/2004 (rml,). (Entered: 12/22/2004)

01/04/2005 48 TRANSCRIPT of Proceedings (on motion to dismiss) held on 12/8/2004 before Judge David Folsom. Court Reporter: Libby Crawford. (sm,) (Entered: 01/04/2005)

02/07/2005 49 STIPULATED PROTECTIVE ORDER granting 46 Motion for Protective Order . Signed by Judge David Folsom on 2/7/05. (mrm,) (Entered: 02/07/2005)

02/09/2005 50 APPLICATION to Appear Pro Hac Vice by Attorney Andrei Iancu for TIVO Inc. (rml,) (Entered: 02/10/2005)

02/09/2005 51 APPLICATION to Appear Pro Hac Vice by Attorney Alexander C D Giza for TIVO Inc. (rml,) (Entered: 02/10/2005)

02/10/2005 -- Pro Hac Vice Filing fee paid by Andrei Iancu; Fee: \$25, receipt number: 103810 (rml,) (Entered: 02/10/2005)

02/10/2005 -- Pro Hac Vice Filing fee paid by Alexander Giza; Fee: \$25, receipt number: 103811 (rml,) (Entered: 02/10/2005)

03/02/2005 52 ***FILED IN ERROR PLEASE IGNORE*** MOTION to Compel Interrogatory Response Filed by

EchoStar Technologies Corporation, Echosphere Limited Liability Company. (Friedman, Paul) Modified on 3/2/2005 (mpv,). Modified on 3/2/2005 (mpv,). (Entered: 03/02/2005)

03/02/2005 53 ***FILED IN ERROR; PLEASE IGNORE*** AFFIDAVIT in Support re 52 MOTION to Compel Interrogatory Response Filed filed by EchoStar Technologies Corporation, Echosphere Limited Liability Company. (Attachments: # 1 Exhibit A# 2 Exhibit B# 3 Exhibit C# 4 Exhibit D# 5 Exhibit E# 6 Exhibit F# 7 Exhibit G# 8 Exhibit H# 9 Exhibit I# 10 Exhibit J)(Friedman, Paul) Modified on 3/2/2005 (mpv,). (Entered: 03/02/2005)

03/02/2005 54 ***FILED IN ERROR; PLEASE IGNORE*** Additional Attachments to Main Document: 52 MOTION to Compel Interrogatory Response Filed.. (Friedman, Paul) Modified on 3/2/2005 (mpv,). (Entered: 03/02/2005)

03/02/2005 55 MOTION to Compel Interrogatory Response REPLACES DOCUMENT #'s 52, 53 & 54 by EchoStar Technologies Corporation, Echosphere Limited Liability Company. (Attachments: # 1 Affidavit of Paul A. Friedman in Support of Motion to Compel# 2 Exhibit A to the Declaration of Paul A. Friedman# 3 Exhibit B to the Declaration of Paul A. Friedman# 4 Exhibit C to the Declaration of Paul A. Friedman# 5 Exhibit D to the Declaration of Paul A. Friedman# 6 Exhibit E to the Declaration of Paul A. Friedman# 7 Exhibit F to the Declaration of Paul A. Friedman# 8 Exhibit G to the Declaration of Paul A. Friedman# 9 Exhibit H to the Declaration of Paul A. Friedman# 10 Exhibit I to the Declaration of Paul A. Friedman# 11 Exhibit J to the Declaration of Paul A. Friedman# 12 Text of Proposed Order Granting Motion to Compel)(Friedman, Paul) Modified on 3/2/2005 (mpv,). (Entered: 03/02/2005)

03/02/2005 — ***FILED IN ERROR. Document # 52, 53, 54, Motion to Compel, Affidavit and Additional Attachments. PLEASE IGNORE. SEE #55 for correct document *** (mpv,) (Entered: 03/02/2005)

03/03/2005 56 SCHEDULING ORDER: Initial Pretrial Conference set for 9/1/2005 10:00 AM in Ctrm 319 (Texarkana) before Judge David Folsom. Amended Pleadings due by 2/1/2005. Discovery due by 6/10/2005. Joinder of Parties due by 2/1/2005. Jury instructions due by 9/20/2005 Jury Selection set for 10/4/2005 10:00 AM in Ctrm 106 (Marshall) before Judge David Folsom. Mediation Completion due by 8/24/2005. Motions due by 6/30/2005. Proposed Pretrial Order due by 8/18/2005. Claim Construction hearing 5/6/05 at 9:00 AM. Signed by Judge David Folsom on 3/3/05. (mpv,) (Entered: 03/03/2005)

03/09/2005 57 ORDER ON DEFENDANT'S MOTION TO DISMISS AND TRANSFER; denying 19 Motion to Change Venue, denying 19 Motion to Dismiss; Therefore, the court ORDERS that Dfts Motion to Dismiss is DENIED as to ECC and DENIED WITHOUT PREJUDICE as to EDBS. The court further ORDERS that Dfts Motion to Transfer is DENIED . Signed by Judge David Folsom on 3/9/05. (mrm,) (Entered: 03/09/2005)

03/11/2005 58 MOTION for Extension of Time to File Response/Reply Unopposed Motion for Extension of Time to Respond to Echostar's Motion to Compel Interrogatory Response by TIVO Inc. (Attachments: # 1 Text of Proposed Order)(Baxter, Samuel) (Entered: 03/11/2005)

03/16/2005 59 ***FILED IN ERROR. PLEASE IGNORE. NO CERTIFICATE OF SERVICE. SEE DOC #63.*** RESPONSE in Opposition re 55 MOTION to Compel Interrogatory Response filed by TIVO Inc. (Attachments: # 1 Declaration of Richard E. Lyon in Support of Opposition# 2 Ex. 1 to Lyon Decl.# 3 Ex. 2 to Lyon Decl.# 4 Ex. 3 to Lyon Decl.# 5 Ex. 4 to Lyon Decl.# 6 Ex. 5 to Lyon Decl.# 7 Ex. 6 to Lyon Decl.# 8 Ex. 7 to Lyon Decl.# 9 Ex. 8 to Lyon Decl.# 10 Ex. 9 to Lyon Decl.# 11 Ex. 10 to Lyon Decl.# 12 Ex. 11 to Lyon Decl.# 13 Ex. 12 to Lyon Decl.# 14 Ex. 13 to Lyon Decl.# 15 Ex. 14 to Lyon Decl.# 16 Ex. 15 to Lyon Decl.# 17 Ex. 16 to Lyon Decl.# 18 Ex. 17 to Lyon Decl.# 19 Ex. 18 to Lyon Decl.# 20 Ex. 19 to Lyon Decl.# 21 Ex. 20 to Lyon Decl.# 22 Proposed Order Denying Motion to Compel)(Lyon, Richard) Modified on 3/17/2005 (fal,). (Entered: 03/16/2005)

03/16/2005 60 ORDER GRANTING TIVO'S UNOPPOSED MOTION FOR EXTENSION OF TIME; granting 58 Motion for Extension of Time to File Response/Reply re 55 MOTION to Compel Interrogatory Response Responses due by 3/16/2005. Signed by Judge David Folsom on 3/16/05. (mrm,) (Entered: 03/16/2005)

03/16/2005 61 ***FILED IN ERROR. PLEASE IGNORE. NO CERTIFICATE OF SERVICE. SEE DOC #62.*** MOTION to Amend/Correct 56 Scheduling Order,, by TIVO Inc. (Attachments: # 1 Affidavit Declaration of Richard Lyon in support of Motion to Amend# 2 Exhibit 1# 3 Exhibit 2# 4 Exhibit 3# 5 Exhibit 4# 6 Exhibit 5# 7 Exhibit 6# 8 Exhibit 7# 9 Exhibit 8# 10 Exhibit 9# 11 Exhibit 10# 12 Exhibit 11# 13 Exhibit 12# 14 Exhibit 13# 15 Exhibit 14# 16 Exhibit 15# 17 Exhibit 16# 18 Exhibit 17# 19 Text of Proposed Order)(Giza, Alexander) Modified on 3/17/2005 (fal,). (Entered: 03/16/2005)

03/17/2005 62 ***REPLACES DOC #61.*** MOTION to Amend/Correct 56 Scheduling Order,, by TIVO Inc. (Attachments: # 1 Declaration of Richard Lyon in support of Motion to Amend# 2 Exhibit 1-17 to Lyon Decl# 3 Text of Proposed Order)(Giza, Alexander) Modified on 3/17/2005 (fal,).

(Entered: 03/17/2005)

03/17/2005 63 ***REPLACES DOC #59.*** RESPONSE in Opposition re 55 MOTION to Compel Interrogatory Response filed by TIVO Inc. (Attachments: # 1 Declaration of Richard E. Lyon in Support of Opposition# 2 Ex. 1 to Lyon Decl.# 3 Ex. 2 to Lyon Decl.# 4 Ex. 3 to Lyon Decl.# 5 Ex. 4 to Lyon Decl.# 6 Ex. 5 to Lyon Decl.# 7 Ex. 6 to Lyon Decl.# 8 Ex. 7 to Lyon Decl.# 9 Ex. 8 to Lyon Decl.# 10 Ex. 9 to Lyon Decl.# 11 Ex. 10 to Lyon Decl.# 12 Ex. 11 to Lyon Decl.# 13 Ex. 12 to Lyon Decl.# 14 Ex. 13 to Lyon Decl.# 15 Ex. 14 to Lyon Decl.# 16 Ex. 15 to Lyon Decl.# 17 Ex. 16 to Lyon Decl.# 18 Ex. 17 to Lyon Decl.# 19 Ex. 18 to Lyon Decl.# 20 Ex. 19 to Lyon Decl.# 21 Ex. 20 to Lyon Decl.# 22 Text of Proposed Order Denying Motion to Compel)(Lyon, Richard) Modified on 3/17/2005 (fal,). (Entered: 03/17/2005)

03/17/2005 64 MOTION to Compel EchoStar's Production of Documents, Interrogatory Responses, and Attendance at Deposition by TIVO Inc. (Attachments: # 1 Proposed Order# 2 Declaration of Richard E. Lyon# 3 Exhibit 1# 4 Exhibit 2# 5 Exhibit 3# 6 Exhibit 4# 7 Exhibit 5# 8 Exhibit 6# 9 Exhibit 7# 10 Exhibit 8# 11 Exhibit 9# 12 Exhibit 10# 13 Exhibit 11# 14 Exhibit 12# 15 Exhibit 13# 16 Exhibit 14# 17 Exhibit 15# 18 Exhibit 16# 19 Exhibit 17# 20 Exhibit 18# 21 Exhibit 19# 22 Exhibit 20# 23 Exhibit 21# 24 Exhibit 22# 25 Exhibit 23)(Lyon, Richard) (Entered: 03/17/2005)

03/21/2005 65 ANSWER to Amended Complaint for Patent Infringement, COUNTERCLAIM for Declaratory Relief of Invalidity, Non-Infringement and Unenforceability (counterclaim filed by Defendant Echostar Communications Corporation only) against TIVO Inc by Echostar Communications Corporation, Echostar DBS Corporation.(Friedman, Paul) (Entered: 03/21/2005)

03/21/2005 66 RESPONSE in Opposition re 62 MOTION to Amend/Correct 56 Scheduling Order,, filed by "EchoStar defendants". (Attachments: # 1 Affidavit of Ann Citrin# 2 Affidavit of Paul A. Friedman# 3 Exhibit 1 to Friedman Decl.# 4 Exhibit 2 to Friedman Decl.# 5 Exhibit 3 to Friedman Decl.# 6 Exhibit 4 to Friedman Decl.# 7 Exhibit 5 to Friedman Decl.)(Friedman, Paul) (Entered: 03/21/2005)

03/23/2005 67 REPLY to Response to Motion re 55 MOTION to Compel Interrogatory Response filed by EchoStar Technologies Corporation, Echosphere Limited Liability Company. (Friedman, Paul) (Entered: 03/23/2005)

03/24/2005 68 REPLY to Response to Motion re 62 MOTION to Amend/Correct 56 Scheduling Order,, filed by TIVO Inc. (Baxter, Samuel) (Entered: 03/24/2005)

03/28/2005 69 Joint MOTION to Amend/Correct 56 Scheduling Order,, by TIVO Inc. (Attachments: # 1 Text of Proposed Order)(Giza, Alexander) (Entered: 03/28/2005)

03/29/2005 70 RESPONSE in Opposition re 64 MOTION to Compel EchoStar's Production of Documents, Interrogatory Responses, and Attendance at Deposition filed by "EchoStar defendants". (Attachments: # 1 Affidavit Citrin Decl# 2 Affidavit Friedman Decl# 3 Exhibit A to Friedman Decl# 4 Exhibit B to Friedman Decl# 5 Exhibit C to Friedman Decl# 6 Exhibit D to Friedman Decl# 7 Exhibit E to Friedman Decl# 8 Exhibit F to Friedman Decl# 9 Exhibit G to Friedman Decl# 10 Exhibit H to Friedman Decl# 11 Exhibit I to Friedman Decl# 12 Exhibit J to Friedman Decl# 13 Exhibit K to Friedman Decl# 14 Exhibit L to Friedman Decl# 15 Exhibit M to Friedman Decl# 16 Exhibit N to Friedman Decl# 17 Exhibit O to Friedman Decl# 18 Exhibit P to Friedman Decl)(Friedman, Paul) (Entered: 03/29/2005)

03/30/2005 71 APPLICATION to Appear Pro Hac Vice by Attorney Jason A Crotty for Echostar Communications Corporation; Echostar DBS Corporation; EchoStar Technologies Corporation; Echosphere Limited Liability Company. (rml,) (Entered: 03/30/2005)

03/30/2005 -- Pro Hac Vice Filing fee paid by Jason Crotty; Fee: \$25, receipt number: 5-1-60 (rml,) (Entered: 03/30/2005)

03/30/2005 72 APPLICATION to Appear Pro Hac Vice by Attorney Karl J Kramer for Echostar Communications Corporation; Echostar DBS Corporation; EchoStar Technologies Corporation; Echosphere Limited Liability Company. (rml,) (Entered: 03/30/2005)

03/30/2005 -- Pro Hac Vice Filing fee paid by Karl Kramer; Fee: \$25, receipt number: 5-1-061 (rml,) (Entered: 03/30/2005)

03/30/2005 73 AMENDMENT TO SCHEDULING ORDER: Claim Construction Brief due at 4:00 pm PST on 4/11/05; Opposition Claim Construction Briefs due 5/9/05; Claim Construction hearing on 5/23/05; Discovery due by 6/24/2005.. Signed by Judge David Folsom on 3/30/05. (mrm,) (Entered: 03/30/2005)

03/30/2005 74 RESPONSE in Opposition re 55 MOTION to Compel Interrogatory Response (Sur-Reply) filed by TIVO Inc. (Attachments: # 1 Declaration of Richard E. Lyon in Support of Sur-Reply# 2 Ex. 1# 3 Ex. 2# 4 Ex. 3# 5 Ex. 4# 6 Ex. 5)(Lyon, Richard) (Entered: 03/30/2005)

04/01/2005 75 APPLICATION to Appear Pro Hac Vice by Attorney Robert M Harkins, Jr for Echostar

Communications Corporation; Echostar DBS Corporation; EchoStar Technologies Corporation; Echosphere Limited Liability Company. (rml,) (Entered: 04/01/2005)

04/01/2005 -- Pro Hac Vice Filing fee paid by Robert Harkins Jr; Fee: \$25, receipt number: 5-1-67 (rml,) (Entered: 04/01/2005)

04/04/2005 76 APPLICATION to Appear Pro Hac Vice by Attorney Ann Critin for "EchoStar defendants"; Echostar Communications Corporation; Echostar DBS Corporation; EchoStar Technologies Corporation; Echosphere Limited Liability Company;(rml,) (Entered: 04/04/2005)

04/04/2005 -- Pro Hac Vice Filing fee paid by Ann Critin; Fee: \$25, receipt number: 5-1-071 (rml,) (Entered: 04/04/2005)

04/05/2005 77 REPLY to Response to Motion re 64 MOTION to Compel EchoStar's Production of Documents, Interrogatory Responses, and Attendance at Deposition filed by TIVO Inc. (Attachments: # 1 Declaration of Richard E. Lyon in support of Reply Brief)(Lyon, Richard) (Entered: 04/05/2005)

04/11/2005 78 REPLY to EchoStar Communication Corporation's Counterclaim ANSWER to Counterclaim by TIVO Inc.(Lyon, Richard) (Entered: 04/11/2005)

04/11/2005 79 MOTION In Support of EchoStar's Opening Claim Construction Brief by "EchoStar defendants". (Attachments: # 1 Affidavit Harkins decl# 2 Exhibit a to Harkins# 3 Exhibit B to Harkins Decl# 4 Exhibit Harkins decl exhs C to M# 5 Affidavit Reader Decl and Exhs.# 6 Affidavit Rhyne Decl# 7 Text of Proposed Order Proposed Order)(Harkins, Robert) (Entered: 04/11/2005)

04/11/2005 80 MOTION for Hearing re TiVo's Opening Claim Construction Brief by TIVO Inc. (Attachments: # 1 Affidavit Giza Declaration and Exs. 1-2# 2 Affidavit Exs. 3-9 (Giza Decl.)# 3 Text of Proposed Order)(Giza, Alexander) (Entered: 04/11/2005)

04/18/2005 81 SEALED Second MOTION to Compel by "EchoStar defendants". (mpv,) Additional attachment(s) added on 8/7/2007 (ch,). (Entered: 04/18/2005)

04/19/2005 82 ORDER REFERRING MOTION to the Honorable Harry W. McKee: 81 MOTION to Compel filed by "EchoStar defendants", . Signed by Judge David Folsom on 4/19/05. (mrm,) (Entered: 04/19/2005)

04/26/2005 83 MOTION for Leave to File First Amended Answers to First Amended Complaint and Counterclaims, Unopposed by Tivo, by Echostar Communications Corporation, Echostar DBS Corporation, EchoStar Technologies Corporation, Echosphere Limited Liability Company. (Attachments: # 1 Exhibit A# 2 Exhibit B# 3 Text of Proposed Order)(Friedman, Paul) (Entered: 04/26/2005)

04/27/2005 84 RESPONSE in Opposition re 81 MOTION to Compel filed by TIVO Inc. (Attachments: # 1 Denny Decl. in support of Opposition# 2 Lyon Decl. in support of Opposition# 3 Exhibits to Lyon Decl.# 4 Text of Proposed Order)(Lyon, Richard) (Entered: 04/27/2005)

04/29/2005 85 Third MOTION to Compel by "EchoStar defendants". (Attachments: # 1 Affidavit of Jason A. Crotty# 2 Exhibit to J. Crotty Decl.# 3 Text of Proposed Order)(Friedman, Paul) (Entered: 04/29/2005)

05/04/2005 86 REPLY to Response to Motion re 81 MOTION to Compel (Second Set) filed by "EchoStar defendants". (Attachments: # 1 Affidavit of Paul A. Friedman# 2 Exhibit 1-3# 3 Exhibit 4# 4 Exhibit 5-6)(Friedman, Paul) (Entered: 05/04/2005)

05/06/2005 87 SEALED MOTION to Compel Deposition Testimony by Echostar Communications Corporation, Echostar DBS Corporation, EchoStar Technologies Corporation, Echosphere Limited Liability Company. (mpv,) Additional attachment(s) added on 7/30/2007 (ch,). (Entered: 05/09/2005)

05/06/2005 91 Minute Entry for proceedings held before Judge H. W. McKee : Telephone Conference on Motion to Compel held on 5/6/2005. (Court Reporter M. Morris.) (mjm,) (Entered: 05/10/2005)

05/09/2005 88 Fifth MOTION to Compel by "EchoStar defendants". (Attachments: # 1 Affidavit of Jason A. Crotty# 2 Exhibit A# 3 Exhibit B# 4 Exhibit C# 5 Text of Proposed Order)(Friedman, Paul) (Entered: 05/09/2005)

05/09/2005 89 Joint MOTION to Amend/Correct Scheduling Order by TIVO Inc. (Attachments: # 1 Text of Proposed Order Proposed Order Amending Scheduling Order)(Lyon, Richard) (Entered: 05/09/2005)

05/10/2005 90 NOTICE of Hearing:Motions Hearing set for 5/19/2005 02:00 PM before Magistrate Judge H. W. McKee in Tyler. (mjm,) (Entered: 05/10/2005)

05/11/2005 92 AMENDED SCHEDULING ORDER: 1. The parties will file their opposition claim construction briefs on 5/12/05. 2. Disclosure of expert testimony shall be made by the party with burden of proof on the issue by 5/16/05. Thereafter, the other party shall have until 6/6/05, to disclose rebuttal expert testimony.3. Discovery due by 6/27/2005. 4. Motions to transfer, motions to dismiss,

motions for summary judgment or other dispositive motions and Daubert motions due by 7/5/2005. 5. All other dates shall remain unchanged. Signed by Judge David Folsom on 5/11/05. (mrm,) (Entered: 05/11/2005)

05/11/2005 93 RESPONSE in Opposition re 85 Third MOTION to Compel filed by TIVO Inc. (Attachments: # 1 Lyon Declaration in support of Opposition# 2 Exhibits 1-2 to Lyon Declaration# 3 Exhibits 3-8 to Lyon Declaration# 4 Denny Declaration in support of Opposition# 5 Text of Proposed Order Denying Motion to Compel)(Lyon, Richard) (Entered: 05/11/2005)

05/11/2005 94 RESPONSE in Opposition re 81 MOTION to Compel (Sur-Reply) filed by TIVO Inc. (Attachments: # 1 Lyon Declaration in support of Sur-Reply# 2 Exhibits to Lyon Declaration# 3 Denny Declaration in support of Sur-Reply)(Lyon, Richard) (Entered: 05/11/2005)

05/12/2005 95 ORDER GRANTING AGREED MOTION TO ALLOW ECHOSTAR LEAVE TO FILE FIRST AMENDED ANSWERS TO FIRST AMENDED COMPLAINT AND COUNTERCLAIMS; granting 83 Motion for Leave to File First Amended Answers to First Amended Complaint and Counterclaims. Signed by Judge David Folsom on 5/12/05. (mrm,) (Entered: 05/12/2005)

05/12/2005 96 ***FILED IN ERROR. SEE CORRECTED DOCUMENT #97*** MOTION for Hearing Opposition Claim Construction Brief by TIVO Inc. (Attachments: # 1 Affidavit Declaration of Dr. Gibson# 2 Affidavit Declaration of Giza and Ex. 1# 3 Exhibit Giza Decl. Exs. 2-4# 4 Exhibit Giza Decl. Exs. 5-6)(Giza, Alexander) Modified on 5/13/2005 (ehs,). (Entered: 05/12/2005)

05/12/2005 97 ***REPLACES DOCUMENT #96 WHICH WAS FILED IN ERROR*** RESPONSE in Opposition re 79 MOTION In Support of EchoStar's Opening Claim Construction Brief filed by TIVO Inc. (Attachments: # 1 Affidavit Declaration of Dr. Gibson# 2 Affidavit Giza Decl. and Ex. 1# 3 Exhibit Giza Decl. Exs. 2-4# 4 Exhibit Giza Decl. Exs 5-6)(Giza, Alexander) Modified on 5/13/2005 (ehs,). (Entered: 05/12/2005)

05/12/2005 98 SEALED RESPONSE to 80 TIVO's Opening Brief on Claim Construction with attached Appendices and Declaration by "EchoStar defendants". (mpv,) Additional attachment(s) added on 7/30/2007 (ch,). (Entered: 05/13/2005)

05/16/2005 99 MOTION to Continue the May 23, 2005 Claim Construction Hearing by "EchoStar defendants". (Attachments: # 1 Exhibit A# 2 Text of Proposed Order)(Friedman, Paul) (Entered: 05/16/2005)

05/16/2005 100 Joint MOTION to Amend/Correct 92 Scheduling Order,, Case Scheduling Conference; Expedited Treatment of EchoStar's Motion to Continue The Claim Construction Hearing by TIVO Inc, EchoStar Technologies Corporation, Echosphere Limited Liability Company, TIVO Inc(a Delaware corporation), Echostar Communications Corporation, Echostar DBS Corporation, Echostar Communications Corporation, Echostar DBS Corporation, EchoStar Technologies Corporation, Echosphere Limited Liability Company. (Attachments: # 1 Text of Proposed Order)(Friedman, Paul) (Entered: 05/16/2005)

05/16/2005 101 REPLY to Response to Motion re 85 Third MOTION to Compel filed by "EchoStar defendants". (Friedman, Paul) (Entered: 05/16/2005)

05/17/2005 102 ORDER REFERRING MOTION to the Honorable Harry W. McKee: 85 Third MOTION to Compel filed by "EchoStar defendants",, 55 MOTION to Compel Interrogatory Response filed by EchoStar Technologies Corporation,, Echosphere Limited Liability Company,, [87] MOTION to Compel filed by Echostar Communications Corporation,, Echostar DBS Corporation,, EchoStar Technologies Corporation,, Echosphere Limited Liability Company,, 88 Fifth MOTION to Compel filed by "EchoStar defendants",, 64 MOTION to Compel EchoStar's Production of Documents, Interrogatory Responses, and Attendance at Deposition filed by TIVO Inc, . Signed by Judge David Folsom on 5/16/05. (mrm,) (Entered: 05/17/2005)

05/18/2005 103 RESPONSE in Opposition re 100 Joint MOTION to Amend/Correct 92 Scheduling Order,, Case Scheduling Conference; Expedited Treatment of EchoStar's Motion to Continue The Claim Construction Hearing filed by TIVO Inc. (Attachments: # 1 Exhibit Exhibits A, B and C)(Lyon, Richard) (Entered: 05/18/2005)

05/18/2005 104 ORDER denying 99 Motion to Continue the 5/23/05 Claim Construction Hearing. Signed by Judge David Folsom on 5/18/05. (mrm,) (Entered: 05/18/2005)

05/18/2005 105 FILED UNDER SEAL - Opposition to def't's [87] MOTION to Compel deposition testimony and Cross-Motion for Protective Order filed by TIVO Inc. (ehs) Additional attachment(s) added on 7/30/2007 (ch,). (Entered: 05/19/2005)

05/20/2005 106 SEALED REPLY to Response to Motion re [87] MOTION to Compel Deposition Testimony and Opposition to [105] Cross-Motion for Protective Order filed by "EchoStar defendants". (mpv,) Additional attachment(s) added on 7/30/2007 (ch,). (Entered: 05/20/2005)

05/23/2005 107 RESPONSE in Opposition re 88 Fifth MOTION to Compel filed by TIVO Inc. (Attachments: # 1 Declaration of Richard E. Lyon in Support of Opposition to Defendants' Fifth Motion to Compel)

(Lyon, Richard) (Entered: 05/23/2005)

05/23/2005 108 RESPONSE in Opposition re 85 Third MOTION to Compel (Sur-Reply) filed by TIVO Inc(a Delaware corporation). (Attachments: # 1 Declaration of Richard E. Lyon in Support of Sur-Reply to Defendants' Third Motion to Compel# 2 Exhibits to Lyon Declaration)(Lyon, Richard) (Entered: 05/23/2005)

05/23/2005 109 NOTICE of Hearing on Motions: [87] MOTION to Compel, 88 Fifth MOTION to Compel, 64 MOTION to Compel EchoStar's Production of Documents, Interrogatory Responses, and Attendance at Deposition, 55 MOTION to Compel Interrogatory Response, 81 MOTION to Compel, 85 Third MOTION to Compel: Motion Hearing set for 5/24/2005 09:30 AM in Tyler before Magistrate Judge H. W. McKee. (mjm,) (Entered: 05/23/2005)

05/23/2005 110 FILED UNDER SEAL - Sur-Reply in Opposition to Deft's re 88 Fifth MOTION to Compel testimony and Reply in Support of Cross-Motion for protective order filed by TIVO Inc. (ehs) Additional attachment(s) added on 7/30/2007 (ch,). (Entered: 05/23/2005)

05/23/2005 111 Minute Entry for proceedings held before Judge David Folsom : Markman Hearing held on 5/23/2005. (Court Reporter Libby Crawford.) (mrm,) (Entered: 05/24/2005)

05/24/2005 112 Minute Entry for proceedings held before Judge H. W. McKee : Motions Hearing held on 5/24/2005. The parties state that they believe the motions have been resolved. The Court will make a ruling after parties send in a status update by 6/17/2005 regarding motions (#55, 64, 81, 85, 87, 88). (Court Reporter Jan Mason.) (mjm,) (Entered: 05/24/2005)

05/24/2005 113 ORDER; The court, therefore, ORDERS that dfts shall have 10 days from the date of the claim construction hrg, or until 6/2/05, to file their responsive brief. The court further ORDERS that pif shall have 5 days to respond to dfts brief or until 6/7/05. The ptys briefs shall not exceed 10 pgs. The court further ORDERS the ptys shall file a Joint Claim Construcion Chart with the court by 6/7/05. Signed by Judge David Folsom on 5/24/05. (mrm,) (Entered: 05/24/2005)

06/01/2005 114 RESPONSE to 95 Order on Motion for Leave to File, REPLY to Counterclaims of EchoStar Communications Corporation by TIVO Inc. (Lyon, Richard) (Entered: 06/01/2005)

06/01/2005 115 RESPONSE to 95 Order on Motion for Leave to File, REPLY to Counterclaims of EchoStar Technologies Corp. and Ecosphere Limited Liability Company by TIVO Inc. (Lyon, Richard) (Entered: 06/01/2005)

06/02/2005 116 TRANSCRIPT of Proceedings/Markman Hearing held on 5/23/05 before Judge David Folsom. Court Reporter: Libby Crawford. (mpv,) (Entered: 06/02/2005)

06/02/2005 117 NOTICE by "EchoStar defendants" that EchoStar Will Not File Supplemental Claim Construction Briefing In Response to the Court's Order of May 24, 2005 (Kramer, Karl) (Entered: 06/02/2005)

06/02/2005 118 Sixth MOTION to Compel by "EchoStar defendants". (Attachments: # 1 Affidavit of Ann Citrin# 2 Exhibit A-I# 3 Exhibit J# 4 Exhibit K# 5 Exhibit L# 6 Text of Proposed Order)(Friedman, Paul) (Entered: 06/02/2005)

06/03/2005 119 TRANSCRIPT of Pretrial Hearing held on May 24, 2005 at 11:30 a.m. before Judge Harry W. McKee. Court Reporter: Jan Mason. (ehs) (Entered: 06/06/2005)

06/07/2005 120 STATUS REPORT JOINT CLAIM CONSTRUCTION CHART by TIVO Inc. (Giza, Alexander) (Entered: 06/07/2005)

06/10/2005 123 APPLICATION to Appear Pro Hac Vice by Attorney Christine W S Byrd for TIVO Inc. (ch,) (Entered: 06/16/2005)

06/10/2005 -- Pro Hac Vice Filing fee paid by Christine W.S. Byrd; Fee: \$25, receipt number: 2-1-351 (ch,) (Entered: 06/16/2005)

06/13/2005 121 Proposed Pretrial Order [proposed] Amendment to Scheduling Order by TIVO Inc, Echostar Communications Corporation, Echostar DBS Corporation, EchoStar Technologies Corporation, Echosphere Limited Liability Company. (Giza, Alexander) (Entered: 06/13/2005)

06/14/2005 122 MOTION for Extension of Time to File Response/Reply to EchoStar's Sixth Motion to Compel (Unopposed) by TIVO Inc. (Lyon, Richard) (Entered: 06/14/2005)

06/16/2005 124 RESPONSE in Opposition re 118 Sixth MOTION to Compel filed by TIVO Inc. (Attachments: # 1 Affidavit Declaration by Adam Hoffman In Support of TIVO's Opposition to EchoStar's Sixth Motion to Compel)(Lyon, Richard) (Entered: 06/16/2005)

06/20/2005 125 ORDER granting 122 Motion for Extension of Time to File Response to EchoStar's Sixth Motion to Compel. Responses due by 6/16/2005. Signed by Judge David Folsom on 6/20/05. (ehs) (Entered: 06/20/2005)

06/20/2005 126 STATUS REPORT REGARDING THE PARTIES' COMPROMISES ON PENDING MOTIONS TO COMPEL

(DOCKET NOS. 55, 64, 81, 85, 87, and 88) by TIVO Inc, Echostar Communications Corporation, Echostar DBS Corporation, EchoStar Technologies Corporation, Echosphere Limited Liability Company. (Lyon, Richard) (Entered: 06/20/2005)

06/23/2005 127 REPLY to Response to Motion re 118 Sixth MOTION to Compel filed by "EchoStar defendants". (Friedman, Paul) (Entered: 06/23/2005)

06/27/2005 128 RESPONSE in Opposition re 118 Sixth MOTION to Compel Sur-Reply filed by TIVO Inc. (Lyon, Richard) (Entered: 06/27/2005)

06/28/2005 129 APPLICATION to Appear Pro Hac Vice by Attorney Michelle Armond for TIVO Inc. (ch,) (Entered: 07/07/2005)

07/01/2005 -- Pro Hac Vice Filing fee paid by Armond; Fee: \$25, receipt number: 2-1-427 (ch,) (Entered: 07/07/2005)

07/08/2005 130 ***FILED IN ERROR. PLEASE IGNORE. SEE DOC #131.*** MOTION to Compel Enforce May 24, 2005 Resolution and for a Court Order Concerning Motions To Compel by "EchoStar defendants". (Attachments: # 1 Text of Proposed Order [Proposed] Stipulated Order Regarding the Parties' Compromises on Pending Motions to Compel)(Kramer, Karl) Modified on 7/11/2005 (fal,). (Entered: 07/08/2005)

07/08/2005 131 ***REPLACES DOC #130.*** MOTION to Compel to Enforce May 24, 2005 Resolution and for a Court Order Concerning Motions to Compel by "EchoStar defendants". (Attachments: # 1 Text of Proposed Order [Proposed] Stipulated Order Regarding The Parties' Compromises on Pending Motions to Compel# 2 Affidavit Declaration of Karl J. Kramer in Support of Echostar's Motion to Enforce May 24, 2005 Resolution and for a Court Order Concerning Motions to Compel# 3 Exhibit A# 4 Exhibit B# 5 Exhibit C# 6 Exhibit D# 7 Exhibit E# 8 Exhibit F# 9 Exhibit G) (Kramer, Karl) Modified on 7/11/2005 (fal,). (Entered: 07/08/2005)

07/08/2005 132 Seventh MOTION to Compel by "EchoStar defendants". (Attachments: # 1 Affidavit of Paul A. Friedman in Support of Motion# 2 Exhibit A# 3 Exhibit B# 4 Exhibit C# 5 Exhibit D# 6 Exhibit E# 7 Exhibit F# 8 Exhibit G# 9 Exhibit G2# 10 Exhibit H# 11 Exhibit I# 12 Exhibit J# 13 Exhibit K# 14 Exhibit L# 15 Exhibit M# 16 Exhibit N# 17 Exhibit O# 18 Text of Proposed Order) (Friedman, Paul) (Entered: 07/08/2005)

07/11/2005 -- ***FILED IN ERROR. PLEASE IGNORE Doc #130, Motion to Compel. Replaced with Doc #131.*** (fal,) (Entered: 07/11/2005)

07/11/2005 134 FILED UNDER SEAL - EXHIBIT C to #132 Seventh Motion to Compel by "EchoStar defendants", Echostar Communications Corporation, Echostar DBS Corporation, Echosphere Limited Liability Company.. (ehs) Additional attachment(s) added on 8/8/2007 (ch,). Additional attachment(s) added on 8/8/2007 (ch,). (Entered: 07/14/2005)

07/13/2005 133 ORDER REFERRING MOTIONS TO THE HONORABLE HARRY W. MCKEE: 131 MOTION to Compel to Enforce May 24, 2005 Resolution and for a Court Order Concerning Motions to Compel filed by "EchoStar defendants",, 118 Sixth MOTION to Compel filed by "EchoStar defendants",, 132 Seventh MOTION to Compel filed by "EchoStar defendants", . Signed by Judge David Folsom on 7/13/05. (mrm,) (Entered: 07/13/2005)

07/15/2005 135 Eighth MOTION to Compel by "EchoStar defendants". (Attachments: # 1 Text of Proposed Order)(Friedman, Paul) Additional attachment(s) added on 7/15/2005 (sm,). (Entered: 07/15/2005)

07/15/2005 136 MOTION for Partial Summary Judgment of Non-Infringement: (1) No Infringement by EchoStar's 7100/7200 Devices; and (2) No Infringement Under the Doctrine of Equivalents by "EchoStar defendants". Attachment: #(1) Text of Proposed Order, ****(SEALED EXHIBITS)**** #(2) Exhibit Kramer Declaration #(3) Exhibit A , #(4) Exhibit B Part 1, #(5) Exhibit B Part 2, #(6) Exhibit C, #(7) Exhibit D Part 1, #(8) Exhibit D (exhibits A-C), #(9) Exhibit D (DP-721), #(10) Exhibit D (DP-921), #(11) Exhibit D (DP-942), #(12) Exhibit D (DP-522/625), #(13) Exhibit D (DP-501/508/510), #(14) Exhibit E (Kramer, Karl) (Entered: 07/15/2005)

07/15/2005 137 FILED UNDER SEAL EXHIBIT to doc # 136. (poa,) (Entered: 07/19/2005)

07/15/2005 141 ***Document modified to attach correct document*** FILED UNDER SEAL - EXHIBIT to EchoStar's Eighth Motion to Compel #135 by EchoStar Technologies Corporation, (ehs) Modified on 7/21/2005 (ehs) Additional attachment(s) added on 7/30/2007 (ch,). (Entered: 07/21/2005)

07/20/2005 138 ORDER REFERRING MOTION to the Honorable Harry W. McKee: 135 Eighth MOTION to Compel filed by "EchoStar defendants", . Signed by Judge David Folsom on 7/20/05. (mrm,) (Entered: 07/20/2005)

07/20/2005 139 RESPONSE in Opposition re 131 MOTION to Compel to Enforce May 24, 2005 Resolution and for a Court Order Concerning Motions to Compel filed by TIVO Inc. (Attachments: # 1 Affidavit

Hoffman Declaration and Exhibits A and B# 2 Affidavit Chambers Declaration# 3 Text of Proposed Order)(Lyon, Richard) (Entered: 07/20/2005)

07/20/2005 140 RESPONSE in Opposition re 132 Seventh MOTION to Compel filed by TIVO Inc. (Attachments: # 1 Affidavit Hoffman Declaration and Exhibits A to G)(Lyon, Richard) (Entered: 07/20/2005)

07/22/2005 142 NOTICE of Hearing: Discovery Hearing set for 7/29/2005 09:30 AM in Ctrm 210 (Tyler) before Magistrate Judge Harry W. McKee. (srg,) (Entered: 07/22/2005)

07/26/2005 143 NOTICE by "EchoStar defendants" Letter Brief to Judge McKee Regarding Completion of Ramsay Deposition (Kramer, Karl) (Entered: 07/26/2005)

07/26/2005 144 RESPONSE in Support re 131 MOTION to Compel to Enforce May 24, 2005 Resolution and for a Court Order Concerning Motions to Compel filed by "EchoStar defendants". (Kramer, Karl) (Entered: 07/26/2005)

07/26/2005 145 REPLY to Response to Motion re 132 Seventh MOTION to Compel filed by "EchoStar defendants". (Attachments: # 1 Supplemental Declaration of Paul A. Friedman In Support of EchoStar's Seventh Motion to Compel# 2 Exhibit 1, Part 1 to Friedman Decl.# 3 Exhibit 1, Part 2 to Friedman Decl.# 4 Exhibit 1, Part 3 to Friedman Decl.# 5 Exhibit 1, Part 4 to Friedman Decl.# 6 Exhibit 1, Part 5 to Friedman Decl.# 7 Exhibit 1, Part 6 to Friedman Decl.# 8 Exhibit 1, Part 7 to Friedman Decl.# 9 Exhibit 1, Part 8 to Friedman Decl.)(Friedman, Paul) (Entered: 07/26/2005)

07/27/2005 146 NOTICE by "EchoStar defendants" Notice Removing EchoStar's Eighth Motion to Compel From Calendar (Kramer, Karl) (Entered: 07/27/2005)

07/27/2005 147 ***FILED IN ERROR. SEE CORRECTED DOCUMENT #149*** RESPONSE in Opposition re 136 MOTION for Partial Summary Judgment of Non-Infringement: (1) No Infringement by EchoStar's 7100/7200 Devices; and (2) No Infringement Under the Doctrine of Equivalents filed by TIVO Inc. (Attachments: # 1 Affidavit Giza Decl iso Opposition w/ Exs. 1-11# 2 Text of Proposed Order)(Giza, Alexander) Modified on 8/9/2005 (ehs,). (Entered: 07/27/2005)

07/27/2005 148 RESPONSE in Opposition re 135 Eighth MOTION to Compel filed by TIVO Inc. (Lyon, Richard) (Entered: 07/27/2005)

07/27/2005 149 ***REPLACES DOCUMENT #147WHICH WAS FILED IN ERROR*** RESPONSE in Opposition re 136 MOTION for Partial Summary Judgment of Non-Infringement: (1) No Infringement by EchoStar's 7100/7200 Devices; and (2) No Infringement Under the Doctrine of Equivalents filed by TIVO Inc. (Attachments: # 1 Affidavit Giza Decl. iso Opposition w/ Exs. 1-11# 2 Text of Proposed Order)(Giza, Alexander) Modified on 8/9/2005 (ehs,). (Entered: 07/27/2005)

07/28/2005 150 SEALED PER ORDER #176 - Second MOTION to Compel by TIVO Inc. (Attachments: # (1) Affidavit Hoffman Declaration and Exhibits # (2) Text of Proposed Order Proposed Order)(Lyon, Richard) (original sent to Marshall Ofc 9/13/05) (Entered: 07/28/2005)

07/28/2005 151 REPLY to Response to Motion re 135 Eighth MOTION to Compel filed by "EchoStar defendants". (Friedman, Paul) (Entered: 07/28/2005)

07/29/2005 152 ORDER regarding motions heard before the court on 7/29/05 as set forth herein. Signed by Judge H. W. McKee on 7/20/05. (ehs) (Entered: 08/01/2005)

07/29/2005 153 Minute Entry for proceedings held before Judge H. W. McKee : Motion Hearing held on 7/29/2005 re 131 MOTION to Compel to Enforce May 24, 2005 Resolution and for a Court Order Concerning Motions to Compel filed by "EchoStar defendants",, 135 Eighth MOTION to Compel filed by "EchoStar defendants",, 118 Sixth MOTION to Compel filed by "EchoStar defendants",, 132 Seventh MOTION to Compel filed by "EchoStar defendants"; An order will be entered regarding these motions. (Court Reporter Jill McFarland.) (mjm,) (Entered: 08/01/2005)

08/01/2005 156 TRANSCRIPT of Motion hearing held on July 29, 2005 at 10:37 am before Judge Harry W McKee. Court Reporter: Jill E McFadden. (ehs) (Entered: 08/03/2005)

08/02/2005 154 NOTICE by "EchoStar defendants" and [Defendants' Proposed] Order on Motions Argued At July 29, 2005 Hearing (Attachments: # 1 Exhibit A)(Friedman, Paul) (Entered: 08/02/2005)

08/02/2005 155 NOTICE by TIVO Inc [Proposed] Order Re EchoStar's Motion to Enforce May 24, 2005 Resolution and 7th Motion to Compel (Lyon, Richard) (Entered: 08/02/2005)

08/03/2005 157 REPLY to Response to Motion re 136 MOTION for Partial Summary Judgment of Non-Infringement: (1) No Infringement by EchoStar's 7100/7200 Devices; and (2) No Infringement Under the Doctrine of Equivalents filed by "EchoStar defendants". (Friedman, Paul) (Entered: 08/03/2005)

08/04/2005 158 ORDER granting 131 Motion to Compel, granting in part and denying in part 132 Motion to Compel as set forth herein. Signed by Judge T. John Ward on 8/4/05. (ehs,) (Entered: 08/05/2005)

08/05/2005 159 MOTION to Continue the Deadline for Summary Judgment Motions On Issues of Infringement or Non-Infringement by "EchoStar defendants". (Friedman, Paul) Additional attachment(s) added on 8/10/2005 (fal,). (Entered: 08/05/2005)

08/08/2005 160 ORDER REFERRING MOTION to the Honorable Harry W. McKee for decision: [150] Second MOTION to Compel filed by TIVO Inc, . Signed by Judge David Folsom on 8/5/05. (mrm,) (Entered: 08/08/2005)

08/08/2005 -- Notified Attorney, Ben Yorks, Per GO 04-12, this court no longer accepts pleadings in paper form. The Clerk will no longer mail or fax notices or orders to parties. All notices and orders generated by this court shall be sent electronically. (ehs,) (Entered: 08/08/2005)

08/09/2005 161 RESPONSE in Opposition re 159 MOTION to Continue the Deadline for Summary Judgment Motions On Issues of Infringement or Non-Infringement filed by TIVO Inc. (Attachments: # 1 Text of Proposed Order)(Giza, Alexander) (Entered: 08/09/2005)

08/09/2005 162 RESPONSE in Opposition re [150] Second MOTION to Compel filed by "EchoStar defendants". (Attachments: # 1 Affidavit of Paul A. Friedman and Exs. A-E# 2 Exhibit F-P# 3 Exhibit Q-U) (Friedman, Paul) (Entered: 08/09/2005)

08/09/2005 163 REPLY to Response to Motion re 159 MOTION to Continue the Deadline for Summary Judgment Motions On Issues of Infringement or Non-Infringement filed by "EchoStar defendants". (Friedman, Paul) (Entered: 08/09/2005)

08/09/2005 164 FILED UNDER SEAL - EXHIBIT 12 to Declaration of Alexander C.D. Giza in support of TiVo Inc's opposition to Echostar's motion for partial summary judgment of non-infringement by TIVO Inc. (ehs,) (Entered: 08/10/2005)

08/10/2005 165 Third MOTION to Compel by TIVO Inc. (Attachments: # 1 Affidavit Declaration of Michelle Armond# 2 Exhibit A-J# 3 Text of Proposed Order)(Baxter, Samuel) (Entered: 08/10/2005)

08/10/2005 166 FILED UNDER SEAL - EXHIBITS B - C to declaration of Michelle Armond in support of pltf's third motion to compel #165 by TIVO Inc (ehs,) (Entered: 08/10/2005)

08/10/2005 167 MOTION for Leave to File Excess Pages TIVO'S MOTION FOR LEAVE TO FILE TIVO'S SURREPLY IN OPPOSITION TO ECHOSTAR'S MOTION FOR PARTIAL SUMMARY JUDGMENT OF NON-INFRINGEMENT: (1) NO INFRINGEMENT BY ECHOSTAR'S 7100/7200 DEVICES; AND (2) NO INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS IN EXCESS OF PAGE LIMIT by TIVO Inc. (Attachments: # 1 Text of Proposed Order)(Baxter, Samuel) (Entered: 08/10/2005)

08/10/2005 170 FILED UNDER SEAL - EXHIBIT A to Declaration of Paul A Friedman in Support of Deft's opposition to Tivo's second motion to compel by "EchoStar defendants".(ehs,) (Entered: 08/11/2005)

08/11/2005 168 RESPONSE in Opposition re 167 MOTION for Leave to File Excess Pages TIVO'S MOTION FOR LEAVE TO FILE TIVO'S SURREPLY IN OPPOSITION TO ECHOSTAR'S MOTION FOR PARTIAL SUMMARY JUDGMENT OF NON-INFRINGEMENT: (1) NO INFRINGEMENT BY ECHOSTAR'S 7100/7200 DEVICES; AND filed by "EchoStar defendants". (Friedman, Paul) (Entered: 08/11/2005)

08/11/2005 169 Consent MOTION to Seal TIVO'S SECOND MOTION TO COMPEL by TIVO Inc. (Attachments: # 1 Text of Proposed Order)(Baxter, Samuel) (Entered: 08/11/2005)

08/11/2005 171 FILED UNDER SEAL - EXHIBIT B to Declaration of Paul A Friedman in support of def't's opposition to Tivo's second motion to compel by "EchoStar defendants". (ehs,) (Entered: 08/11/2005)

08/11/2005 172 FILED UNDER SEAL - EXHIBIT D to Declaration of Paul A Friedman in support of def't's opposition to Tivo's second motion to compel by "EchoStar defendants".(ehs,) (Entered: 08/11/2005)

08/11/2005 173 FILED UNDER SEAL - EXHIBIT P to Declaration of Paul A Friedman in Support of Deft's opposition to Tivo's second motion to compel by "EchoStar defendants". (ehs,) (Entered: 08/11/2005)

08/12/2005 174 ORDER granting in part and denying in part 159 Motion to Continue the ddl for Summary Judgment Motions on Issues of Infringement or Non-Infringement is GRANTED-IN-PART and DENIED-IN-PART and that the ddl for summary judgment motions on issues of infringement or non-infringement is hereby CONTINUED to 8/25/05. Signed by Judge David Folsom on 8/11/05. (mrm,) (Entered: 08/12/2005)

08/15/2005 175 REPLY to Response to Motion re [150] Second MOTION to Compel filed by TIVO Inc. (Baxter, Samuel) (Entered: 08/15/2005)

08/15/2005 178 Minute Entry for proceedings held before Judge H. W. McKee : Telephone Conference held on 8/15/2005. (Court Reporter S. Guthrie.) (mjm,) (Entered: 08/17/2005)

08/16/2005 176 ORDER granting 169 Motion to Seal . Signed by Judge David Folsom on 8/15/05. (mrm,) (Entered: 08/16/2005)

08/17/2005 177 ORDER that EchoStar produce all such documents created before suit was filed, and make available any witnesses with knowledge of relevant pre-suit communications. EchoStar to make Mr. Ergen available for five hours of deposition . Signed by Judge H. W. McKee on 8/17/05. (ehs,) (Entered: 08/17/2005)

08/17/2005 179 ORDER; ORDERED that each pty shall file a motion no later than 5:00pm Friday, 8/26/05, providing an estimate of the total time that pty needs to complete the presentation of testimony, including direct examination, cross examination, re-direct, and rebuttal. . Signed by Judge David Folsom on 8/17/05. (mrm,) (Entered: 08/17/2005)

08/17/2005 180 ORDER; The Court hereby CONVERTS said initial pretrial conference to a status conference to be held at the same time and place. Status Conference set for 9/1/2005 10:00 AM in Ctrm 319 (Texarkana) before Judge David Folsom.. Signed by Judge David Folsom on 8/17/05. (mrm,) (Entered: 08/17/2005)

08/17/2005 181 FILED UNDER SEAL - MOTION for Leave to File second amended complaint to Join Echostar Satellite LLC by TIVO Inc. (ehs,) (Entered: 08/18/2005)

08/17/2005 182 FILED UNDER SEAL - NOTICE of motion for and Memorandum in support of Echostar's MOTION for Partial Summary Judgment re damages period by "EchoStar defendants". (ehs,) Additional attachment(s) added on 8/16/2007 (ch,). Additional attachment(s) added on 8/16/2007 (ch,). Additional attachment(s) added on 8/16/2007 (ch,). Additional attachment(s) added on 8/16/2007 (ch,). (Entered: 08/18/2005)

08/17/2005 -- ***FILED IN ERROR. ATTACHED WRONG DOCUMENT to Document # 181, Motion for leave. PLEASE IGNORE.*** (ehs,) (Entered: 08/18/2005)

08/17/2005 186 FILED UNDER SEAL - replaces document #181 - MOTION for Leave to File second amended complaint to join Echostar Satellite LLC by TIVO Inc. (ehs,) (Entered: 08/18/2005)

08/18/2005 183 MOTION for Extension of Time to File and for Clarification of Pre-Trial Submissions by TIVO Inc. (Attachments: # 1 Text of Proposed Order)(Armond, Michelle) (Entered: 08/18/2005)

08/18/2005 184 RESPONSE in Opposition re 183 MOTION for Extension of Time to File and for Clarification of Pre-Trial Submissions filed by "EchoStar defendants". (McElhinny, Harold) (Entered: 08/18/2005)

08/18/2005 185 CLAIM CONSTRUCTION ORDER. Signed by Judge David Folsom on 8/18/05. (mrm,) (Entered: 08/18/2005)

08/18/2005 187 NOTICE by "EchoStar defendants" of Readiness to File Joint Pre-Trial Order (McElhinny, Harold) (Entered: 08/18/2005)

08/18/2005 188 **WITHDRAWN AS PER ORDER # 333** MOTION in Limine No. 11 to Preclude Late Disclosed Exhibits by "EchoStar defendants". (Attachments: # 1 Text of Proposed Order Proposed Order# 2 Affidavit Evans Decl. ISO w/ Exhibits A-G# 3 Affidavit Evans Decl. Ex. H# 4 Affidavit Evans Decl. Exs. H Cont. - I)(Kramer, Karl) Modified on 9/20/2005 (mrm,). (Entered: 08/18/2005)

08/18/2005 189 MOTION for Partial Summary Judgment of Invalidity Due to Indefiniteness by "EchoStar defendants". Responses due by 8/30/2005 (Attachments: # 1 Exhibit A part 1# 2 Exhibit A part 2# 3 Exhibit B# 4 Text of Proposed Order)(Harkins, Robert) (Entered: 08/18/2005)

08/18/2005 190 FILED UNDER SEAL - NOTICE of MOTION and Memorandum in support of motion for partial Summary Judgment of no willful infringement Volume 1 by "EchoStar defendants". (ehs,) Additional attachment(s) added on 8/29/2007 (ch,). (Entered: 08/19/2005)

08/18/2005 191 FILED UNDER SEAL - Declaration of Karl J Kramer in Support of def't's motion for partial summary judgment of non-willfulness of infringement #190 Volume 1 of Exhibits A-C, Volume #2 by "EchoStar defendants". (ehs,) Additional attachment(s) added on 8/29/07 (ch) Modified on 8/29/2007 (ch,). (Entered: 08/19/2005)

08/18/2005 192 FILED UNDER SEAL - Declaration of Karl J. Kramer in Support of def't's motion for partial summary judgment of non-willfulness of infringement #190 Volume II of Exhibits D-V, Volume #3 by "EchoStar defendants". (ehs,) Additional attachment(s) added on 8/30/2007 (ch,). Additional attachment(s) added on 8/30/2007 (ch,). (Entered: 08/19/2005)

08/18/2005 193 FILED UNDER SEAL - MOTION in Limine No. 1 - to preclude reference to, use of and reliance upon the expert report and testimony of John R Hauser; Declaration of Karl J Kramer in support thereof by "EchoStar defendants". (ehs,) Additional attachment(s) added on 7/27/2007 (ch,). (Entered: 08/19/2005)

08/18/2005 194 FILED UNDER SEAL - MOTION in Limine No. 2 - to exclude reference to or evidence regarding written opinion of counsel; Declaration of Karl J Kramer in support thereof by "EchoStar

defendants". (ehs,) Modified on 8/19/2005 (ehs,) ATTACHED CORRECT DOCUMENT TO ENTRY. Additional attachment(s) added on 7/26/2007 (ch,). (Entered: 08/19/2005)

08/18/2005 195 FILED UNDER SEAL - MOTION in Limine No. 3 - to preclude any reference to, use of or reliance upon PTO Museum Display, or Alternatively, to allow discovery by "EchoStar defendants". (ehs,) Additional attachment(s) added on 7/26/2007 (ch,). (Entered: 08/19/2005)

08/18/2005 196 FILED UNDER SEAL - MOTION in Limine No. 4 - to preclude TIVO from denying the existence of non-infringing alternatives; Declaration of Karl J Kramer in support thereof by "EchoStar defendants". (ehs,) Additional attachment(s) added on 7/26/2007 (ch,). (Entered: 08/19/2005)

08/18/2005 197 FILED UNDER SEAL - MOTION in Limine No. 5 - to preclude reference to, use of, or reliance on the expert report and opinion of Alan Gordon on Willfulness; Declaration of Karl J Kramer in support thereof by "EchoStar defendants". (ehs,) Additional attachment(s) added on 7/26/2007 (ch,). (Entered: 08/19/2005)

08/18/2005 198 FILED UNDER SEAL - MOTION in Limine No. 6 - to preclude reference to, use of, and reliance upon the preamble of any asserted claim as a limitation; Declaration of Karl J Kramer in support thereof by "EchoStar defendants". (ehs,) Additional attachment(s) added on 7/27/2007 (ch,). (Entered: 08/19/2005)

08/18/2005 199 FILED UNDER SEAL - MOTION in Limine No. 7 - to preclude reference to, use of, or reliance on alleged convoyed sales of TIVO's subscription services; Declaration of Karl J. Kramer in Support thereof by "EchoStar defendants". (ehs,) (Entered: 08/19/2005)

08/18/2005 200 FILED UNDER SEAL - MOTION in Limine No. 8 - to preclude reference to, use of, or reliance on the expert report and testimony of Keith R Ugone on damages; Declaration of Karl J. Kramer in support thereof by "EchoStar defendants". (ehs,) (Entered: 08/19/2005)

08/18/2005 201 FILED UNDER SEAL - MOTION in Limine No. 9 - to preclude evidence on doctrine or equivalents; Declaration of Karl J Kramer in support thereof by "EchoStar defendants". (ehs,) (Entered: 08/19/2005)

08/18/2005 202 FILED UNDER SEAL - MOTION in Limine No. 10 - to preclude reference to, use of, and reliance upon other Echostar Litigation; Declaration of Karl J. Kramer in support thereof by "EchoStar defendants". (ehs) (Entered: 08/19/2005)

08/22/2005 203 First MOTION to Amend/Correct 167 MOTION for Leave to File Excess Pages TIVO'S MOTION FOR LEAVE TO FILE TIVO'S SURREPLY IN OPPOSITION TO ECHOSTAR'S MOTION FOR PARTIAL SUMMARY JUDGMENT OF NON-INFRINGEMENT: (1) NO INFRINGEMENT BY ECHOSTAR'S 7100/7200 DEVICES; AND (Unopposed) by TIVO Inc. (Attachments: # 1)(Baxter, Samuel) (Entered: 08/22/2005)

08/22/2005 204 NOTICE by TIVO Inc re 165 Third MOTION to Compel Withdrawing Third Motion to Compel In Light of EchoStar's Agreement to Provide the Requested Discovery (Armond, Michelle) (Entered: 08/22/2005)

08/23/2005 205 ***FILED IN ERROR; PLEASE IGNORE; REPLACED BY #208 CORRECTED DOCUMENT*** Third MOTION in Limine to Preclude any reference to, use of, and reliance upon PTO museum display, or alternatively, to allow discovery by "EchoStar defendants". (Kramer, Karl) Modified on 8/24/2005 (mpv,). (Entered: 08/23/2005)

08/23/2005 206 ORDER granting 203 First MOTION to Amend/Correct 167 MOTION for Leave to File Excess Pages TIVO'S MOTION FOR LEAVE TO FILE TIVO'S SURREPLY IN OPPOSITION TO ECHOSTAR'S MOTION FOR PARTIAL SUMMARY JUDGMENT OF NON-INFRINGEMENT: (1) NO INFRINGEMENT BY ECHOSTAR'S 7100/7200 DEVICES; AND (Unopposed) by TIVO Inc.. Signed by Judge David Folsom on 8/23/05. (mrm,) (Entered: 08/23/2005)

08/23/2005 -- ***FILED IN ERROR. Document # 205, Third Motion in Limine. PLEASE IGNORE. REPLACED BY #208 CORRECTED DOCKET ENTRY*** (mpv,) (Entered: 08/24/2005)

08/24/2005 207 ORDER re 183 MOTION for Extension of Time to File and for Clarification of Pre-Trial Submissions filed by TIVO Inc, Final Pretrial Conference set for 10/11/2005 in Ctrm 106 (Marshall) before Judge David Folsom. Jury Selection set for 10/12/2005 10:00 AM in Ctrm 106 (Marshall) before Judge David Folsom. Proposed Pretrial Order due by 8/26/2005 at 5pm. Objections to exhibits shall be filed no later than 9/9/05 at 5pm. Signed by Judge David Folsom on 8/24/05. (mrm,) (Entered: 08/24/2005)

08/24/2005 208 AFFIDAVIT in Support re [195] MOTION in Limine No. 3--To Preclude Any Reference to, Use of, and Reliance Upon PTO Museum Display (by Declarant Jonathan Bockman) filed by "EchoStar defendants". (Kramer, Karl) (Entered: 08/24/2005)

08/24/2005 209 FILED UNDER SEAL - Surreply in Opposition re 136 MOTION for Partial Summary Judgment of Non-Infringement: (1) No Infringement by EchoStar's 7100/7200 Devices; and (2) No

Infringement Under the Doctrine of Equivalents filed by TIVO Inc. (ehs,) (Entered: 08/25/2005)

08/25/2005 210 ORDER denying as moot 55 Motion to Compel, finding as moot 64 Motion to Compel . Signed by Judge H. W. McKee on 8/25/05. (ehs,) (Entered: 08/25/2005)

08/25/2005 211 NOTICE by "EchoStar defendants" Letter Brief to Judge McKee Regarding Completion of Gibson Deposition (Kramer, Karl) Modified on 8/30/2005 (fal,). Modified on 9/22/2005 (mpv,). (Entered: 08/25/2005)

08/25/2005 212 FILED UNDER SEAL - MOTION for Partial Summary Judgment of Non-Infringement (3 VOLUMES) by "EchoStar defendants". (ehs,) Additional attachment(s)(Volume 1 of 3) added on 8/29/2007 (ch,). Additional attachment(s)(Volume 1 of 3) added on 8/29/2007 (ch,). Additional attachment(s)(Volume 2 of 3) added on 8/29/2007 (ch,). Additional attachment(s)(Volume 2 of 3) added on 8/29/2007 (ch,). Modified on 8/29/2007 (ch,). (Entered: 08/26/2005)

08/25/2005 213 Received Submission of Documents Pursuant to 8/5/05 order filed by BenQ defendants (ehs,) Additional attachment(s) added on 8/26/2005 (ehs,). (Entered: 08/26/2005)

08/25/2005 -- ***FILED IN ERROR. Document # 213, Submission of Documents. PLEASE IGNORE.*** (ehs,) (Entered: 08/26/2005)

08/25/2005 -- ***FILED IN ERROR. Document # 212, Motion ATTACHED WRONG DOCUMENT. PLEASE IGNORE.*** (ehs,) (Entered: 08/26/2005)

08/25/2005 214 FILED UNDER SEAL - MOTION for Partial Summary Judgment of Non-Infringement (3 VOLUMES) by "EchoStar defendants". (ehs,) (Entered: 08/26/2005)

08/25/2005 215 TRANSCRIPT of Telephonic Motion Hearing Proceedings held on 8/15/05 at 9:37 a.m. in Tyler, Tx before Honorable US Magistrate Judge Harry W. McKee. Court Reporter: Shea Sloan. (ch,) (Entered: 08/26/2005)

08/25/2005 228 FILED UNDER SEAL - MOTION for Partial Summary Judgment of Infringement of Claims 1 and 32 by TIVO Inc. (ehs,) (Entered: 08/29/2005)

08/25/2005 229 FILED UNDER SEAL - DECLARATION of Michelle Armond in Support of motion for partial summary judgment of infringement of claims 1 and 32 by TIVO Inc. (ehs,) (Entered: 08/29/2005)

08/25/2005 230 FILED UNDER SEAL - DECLARATION of Jerry Gibson, Ph.D. in Support in support of motion for partial summary judgment of infringement of claims 1 and 32 by TIVO Inc. (ehs,) Modified on 9/5/2007 (ch,). (Entered: 08/29/2005)

08/26/2005 216 MOTION for More Definite Statement to Clarify Order of August 17, 2005 by "EchoStar defendants". (Attachments: # 1 Affidavit of Paul A. Friedman# 2 Text of Proposed Order) (Friedman, Paul) (Entered: 08/26/2005)

08/26/2005 217 ORDER that Tivo make Dr. Gibson available for deposition on 9/15/05. Signed by Judge H. W. McKee on 8/26/05. (ehs,) (Entered: 08/26/2005)

08/26/2005 218 Second MOTION in Limine To Preclude Evidence/Argument In Front of the Jury Regarding EchoStar's Inequitable Conduct Defense by TIVO Inc. (Attachments: # 1 Text of Proposed Order Proposed Order)(Armond, Michelle) (Entered: 08/26/2005)

08/26/2005 219 Third MOTION in Limine by TIVO Inc. (Attachments: # 1 Affidavit Declaration# 2 Text of Proposed Order)(Armond, Michelle) (Entered: 08/26/2005)

08/26/2005 220 Fifth MOTION in Limine by TIVO Inc. (Attachments: # 1 Affidavit Declaration# 2 Text of Proposed Order)(Armond, Michelle) (Entered: 08/26/2005)

08/26/2005 221 FILED UNDER SEAL - MOTION in Limine No. 4: Echostar may not offer evidence or argument or make other suggestions, inconsistent with the Court's Claim Construction rulings by TIVO Inc. (ehs,) (Entered: 08/26/2005)

08/26/2005 222 FILED UNDER SEAL - MOTION in Limine No.1: To preclude defendants from introducing into evidence or making arguments regarding agreements wholly between non-parties by TIVO Inc. (ehs,) (Entered: 08/26/2005)

08/26/2005 223 MOTION Regarding Estimated Time Required for Trial by "EchoStar defendants". (Attachments: # 1 Text of Proposed Order)(McElhinny, Harold) (Entered: 08/26/2005)

08/26/2005 224 MOTION Providing Estimate of Total Trial Time by TIVO Inc. (Armond, Michelle) (Entered: 08/26/2005)

08/26/2005 225 Proposed Pretrial Order by TIVO Inc, Echostar Communications Corporation, Echostar DBS Corporation, EchoStar Technologies Corporation, Echosphere Limited Liability Company. (Attachments: # 1 Exhibit Exhibit A# 2 Exhibit Exhibit B# 3 Exhibit Exhibit C# 4 Exhibit Exhibit

D# 5 Exhibit Exhibit E# 6 Exhibit Exhibit F# 7 Exhibit Exhibit G# 8 Exhibit Exhibit H# 9 Exhibit Exhibit I# 10 Exhibit Exhibit J# 11 Exhibit Exhibit K# 12 Exhibit Exhibit L# 13 Exhibit Exhibit M) (Lyon, Richard) (Entered: 08/26/2005)

- 08/26/2005 226 MOTION for Leave to File A Surreply Brief In Support of Its Motion for Partial Summary Judgment of Non-Infringement: (1) No Infringement by EchoStar's 7100/7200 Devices; and (2) No Infringement Under the Doctrine of Equivalents by "EchoStar defendants". (Attachments: # 1 EchoStar's Surreply Brief# 2 Text of Proposed Order)(Friedman, Paul) (Entered: 08/26/2005)
- 08/26/2005 227 MOTION Motion to Exclude Improperly Withheld Media4 and Burstware Documents and Witnesses by TIVO Inc. (Attachments: # 1 Affidavit Declaration# 2 Text of Proposed Order) (Armond, Michelle) (Entered: 08/26/2005)
- 08/26/2005 238 Minute Entry for proceedings held before Judge H. W. McKee : Telephone Conference held on 8/26/2005. (Court Reporter M. Morris.) (mjm,) (Entered: 08/31/2005)
- 08/29/2005 231 RESPONSE in Opposition re 181 MOTION for Leave to File Second Amended Complaint to Join EchoStar Satellite LLC filed by "EchoStar defendants". (Attachments: # 1 Affidavit of Paul A. Friedman# 2 Exhibit 1# 3 Exhibit 2)(Friedman, Paul) (Entered: 08/29/2005)
- 08/29/2005 232 FILED UNDER SEAL - RESPONSE in Opposition re Echostar's [182] MOTION for Partial Summary Judgment Re: Damages Period filed by TIVO Inc. (ehs) (Entered: 08/30/2005)
- 08/29/2005 233 FILED UNDER SEAL - RESPONSE in Opposition to Defendants' re 216 MOTION to Clarify Order of August 17, 2005 filed by TIVO Inc. (ehs,) (Entered: 08/30/2005)
- 08/30/2005 234 REPLY to Response to Motion re 216 MOTION for More Definite Statement to Clarify Order of August 17, 2005 filed by "EchoStar defendants". (Friedman, Paul) (Entered: 08/30/2005)
- 08/30/2005 235 RESPONSE in Opposition re 189 MOTION for Partial Summary Judgment of Invalidity Due to Indefiniteness filed by TIVO Inc. (Attachments: # 1 Exhibit 1)(Lyon, Richard) (Entered: 08/30/2005)
- 08/30/2005 236 MOTION for Extension of Time to File by TIVO Inc. (Attachments: # 1 Proposed Order)(Lyon, Richard) (Entered: 08/30/2005)
- 08/31/2005 237 RESPONSE to Motion re 236 MOTION for Extension of Time to File filed by "EchoStar defendants". (Attachments: # 1 Exhibit 1# 2 Exhibit 2# 3 Text of Proposed Order)(Friedman, Paul) (Entered: 08/31/2005)
- 08/31/2005 239 FILED UNDER SEAL - RESPONSE in Opposition re Echostar's [197] MOTION in Limine No. 5: RE; reference to, use of, and reliance on the expert testimony of Alan Gordon; Declaration of Richard Lyon in support thereof filed by TIVO Inc. (ehs,) (Entered: 08/31/2005)
- 08/31/2005 240 FILED UNDER SEAL - RESPONSE in Opposition to Echostar's [201] MOTION in Limine No. 9 to preclude evidence on doctrine of equivalents filed by TIVO Inc. with attached exhibits (ehs,) (Entered: 08/31/2005)
- 08/31/2005 241 RESPONSE in Opposition re 188 MOTION in Limine No. 11 to Preclude Late Disclosed Exhibits filed by TIVO Inc. (Attachments: # 1 Exhibit A)(Lyon, Richard) (Entered: 08/31/2005)
- 08/31/2005 242 RESPONSE in Opposition re [198] MOTION in Limine No. 6 filed by TIVO Inc. (Attachments: # 1 Armond Declaration)(Lyon, Richard) (Entered: 08/31/2005)
- 08/31/2005 243 RESPONSE in Opposition re [196] MOTION in Limine No. 4 (and Tivo's Cross-Motion) filed by TIVO Inc. (Attachments: # 1 Lyon Declaration and Exhibits# 2 Proposed Order Granting Cross-Motion)(Lyon, Richard) (Entered: 08/31/2005)
- 08/31/2005 244 RESPONSE in Opposition re [194] MOTION in Limine No. 2 filed by TIVO Inc. (Attachments: # 1 Lyon Declaration and Exhibits)(Lyon, Richard) (Entered: 08/31/2005)
- 08/31/2005 245 MOTION for Reconsideration re 177 Order, by "EchoStar defendants". (Attachments: # 1 Text of Proposed Order)(Friedman, Paul) (Entered: 08/31/2005)
- 08/31/2005 247 FILED UNDER SEAL - RESPONSE in Opposition to Echostar's [193] MOTION in Limine No. 1 to preclude reference to, use of, and reliance upon the expert report and testimony of John R. Hauser filed by TIVO Inc. (ehs,) Attachment #1 Exhibit A (Entered: 09/01/2005)
- 08/31/2005 248 FILED UNDER SEAL - RESPONSE in Opposition to Echostar's [199] MOTION in Limine No. 7 to preclude reference to, use of, and reliance on alleged conveyed sales of Tivo's Services filed by TIVO Inc. (Entered: 09/01/2005)
- 08/31/2005 249 FILED UNDER SEAL - RESPONSE in Opposition to Echostar's [200] MOTION in Limine No. 8 to preclude reference to, use of, and reliance on the expert testimony and opinion of Keith R. Ugone on damages filed by TIVO Inc. (ehs,) (Entered: 09/01/2005)
- 08/31/2005 250 FILED UNDER SEAL - RESPONSE in Opposition to Echostar's [202] MOTION in Limine No. 10 re:

reference to, use of, and reliance on Echostar's other litigation; Declaration of Richard Lyon filed by TIVO Inc. (ehs,) (Entered: 09/01/2005)

08/31/2005 251 SEALED RESPONSE in Opposition re [190] MOTION for Partial Summary Judgment of No Willful Infringement filed by TIVO Inc. (mpv,) (Entered: 09/01/2005)

09/01/2005 246 NOTICE by TIVO Inc TiVo's Objections Regarding the Temporal Scope of the August 17, 2005 Order (Attachments: # 1 Lyon Declaration)(Lyon, Richard) (Entered: 09/01/2005)

09/01/2005 252 Minute Entry for proceedings held before Judge David Folsom : Status Conference held on 9/1/2005. (Court Reporter Libby Crawford.) (mrm,) (Entered: 09/01/2005)

09/01/2005 253 ORDER; The Court now ORDERS that each side will have 27.5 hours for case presentation, excluding time related to JS, opening, closing, and transition statements. terminating 223 Motion Regarding the Estimated Time Required for Trial . Signed by Judge David Folsom on 9/1/05. (mrm,) (Entered: 09/01/2005)

09/01/2005 254 ORDER; ORDERED that TiVo's shall have one additional day, until 9/2/05, to file its oppositions to Echostar's motions in limine. granting 236 Motion for Extension of Time to File . Signed by Judge David Folsom on 9/1/05. (mrm,) (Entered: 09/01/2005)

09/01/2005 255 ORDER; proposed jury questionnaires due 9/12/05 at 5pm. Questionnaires are limited to total of 5 pgs. ORDERS the ptys to jointly determine the size and contents of the jury notebooks. Plf and Dfts are ea allowed one jury notebook. . Signed by Judge David Folsom on 9/1/05. (mrm,) (Entered: 09/01/2005)

09/01/2005 256 ORDER GRANTING ECHOSTAR'S MOTION FOR LEAVE TO FILE A SURREPLY BRIEF IN SUPPORT OF ITS MOTION FOR PARTIAL SUMMARY JUDGMENT ON NON-INFRINGEMENT: (1) NO INFRINGEMENT BY ECHOSTAR'S 7100/7200 DEVICES; AND (2) NO INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS; granting 226 Motion for Leave to File . Signed by Judge David Folsom on 9/1/05. (mrm,) (Entered: 09/01/2005)

09/01/2005 257 ECHOSTAR'S SURREPLY OPPOSITION BRIEF IN SUPPORT OF ITS MOTION FOR PARTIAL SUMMARY JUDGMENT OF NON-INFRINGEMENT: (1) NO INFRINGEMENT BY ECHOSTAR'S 7100/7200 DEVICES; AND (2) NO INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS; re 136 MOTION for Partial Summary Judgment of non-infringement filed by "EchoStar defendants". (mrm,) Modified on 9/14/2005 (mpv,). (Entered: 09/01/2005)

09/06/2005 258 SEALED REPLY Memorandum in Support of [182] MOTION for Partial Summary Judgment RE: Damages Period filed by "EchoStar defendants". (mpv,) (Entered: 09/06/2005)

09/06/2005 259 REPLY to Response to Motion re [186] MOTION for Leave to File Second Amended Complaint filed by TIVO Inc. (Lyon, Richard) (Entered: 09/06/2005)

09/06/2005 260 RESPONSE in Opposition re [195] MOTION in Limine No. 3 filed by TIVO Inc. (Attachments: # 1 Lyon Declaration# 2 Denny Declaration# 3 Singletary Declaration)(Lyon, Richard) (Entered: 09/06/2005)

09/06/2005 261 FILED UNDER SEAL - RESPONSE in Opposition re [228] MOTION for Partial Summary Judgment Of Infringement of Claims 1 and 32 filed by "EchoStar defendants". (mpv,) Additional attachment(s) added on 9/6/2007 (ch,). Modified on 9/6/2007 (ch,). (Entered: 09/07/2005)

09/07/2005 262 FILED UNDER SEAL - RESPONSE in Opposition re [221] MOTION in Limine #4 Echostar may not offer evidence or argument, or make other suggestions, inconsistent with the Court's Claim Construction Rulings; and Declaration of Karl J. Kramer filed by "EchoStar defendants". (mpv,) (Entered: 09/07/2005)

09/07/2005 263 FILED UNDER SEAL - RESPONSE in Opposition re 220 Fifth MOTION in Limine to Preclude Evidence and agrument relating to the reverse doctrine of equivalents; and Declaration of Karl J. Kramer filed by "EchoStar defendants". (mpv,) Additional attachment(s) added on 9/6/2007 (ehs,). (Entered: 09/07/2005)

09/07/2005 264 FILED UNDER SEAL - RESPONSE in Opposition re 227 MOTION Motion to Exclude Improperly Withheld Media4 and Burstware Documents and Witnesses filed by "EchoStar defendants". (mpv,) (Entered: 09/07/2005)

09/07/2005 265 RESPONSE in Opposition re [222] MOTION in Limine No. 1 filed by "EchoStar defendants". (Attachments: # 1 Affidavit Lynde Declaration In Support Of Opposition to TiVo's Motion In Limine No. 1) with Sealed attachments (Kramer, Karl) (Entered: 09/07/2005)

09/07/2005 266 RESPONSE in Opposition re 218 Second MOTION in Limine To Preclude Evidence/Argument In Front of the Jury Regarding EchoStar's Inequitable Conduct Defense filed by "EchoStar defendants". (Kramer, Karl) Additional attachment(s) added on 8/17/2007 (ehs,). (Entered: 09/07/2005)

09/07/2005 267 RESPONSE in Opposition re 219 Third MOTION in Limine Nos. 3A-3C filed by "EchoStar

defendants". Attachments: Declaration and Exhibits A-B filed under seal(Kramer, Karl) (Entered: 09/07/2005)

09/07/2005 -- Received SEALED DECLARATION OF NANCY S. HALPIN in Support of Echostar's opposition to TIVO's Motion in Limine No. 1 #265 (mpv,) (Entered: 09/07/2005)

09/07/2005 -- Received SEALED Declaration of Karl J. Kramer In Support of Echostar's Opposition to TIVO's motion in limine No. 2. Attachment to Document #266. (mpv,) (Entered: 09/07/2005)

09/07/2005 -- Received SEALED Declaration of Karl J. Kramer in Support of Echostar's opposition to TIVO's motions in limine Nos. 3A-3C attachment to Document #267. (mpv,) (Entered: 09/07/2005)

09/07/2005 268 MOTION for Protective Order Echostar's Motion for a Protective Order Prohibiting TiVo from Pursuing Discovery in Other Jurisdictions by Echostar Communications Corporation, Echostar DBS Corporation, EchoStar Technologies Corporation, Echosphere Limited Liability Company. (Kramer, Karl) Additional attachment(s) added on 9/13/2005 (fal,). (Entered: 09/07/2005)

09/07/2005 269 AFFIDAVIT in Support re 268 MOTION for Protective Order Echostar's Motion for a Protective Order Prohibiting TiVo from Pursuing Discovery in Other Jurisdictions Declaration of Karl J. Kramer in Support of Echostar's Motion for a Protective Order Prohibiting TiVo from Pursuing Discovery in Other Jurisdictions filed by "EchoStar defendants", Echostar Communications Corporation, Echostar DBS Corporation, EchoStar Technologies Corporation, Echosphere Limited Liability Company. (Attachments: # 1 Exhibit A# 2 Exhibit B# 3 Exhibit C# 4 Exhibit D# 5 Exhibit E# 6 Exhibit F# 7 Exhibit G# 8 Exhibit H# 9 Exhibit I)(Kramer, Karl) (Entered: 09/07/2005)

09/07/2005 270 REPLY to Response to Motion re 189 MOTION for Partial Summary Judgment of Invalidity Due to Indefiniteness filed by "EchoStar defendants". (Harkins, Robert) (Entered: 09/07/2005)

09/07/2005 271 FILED UNDER SEAL - RESPONSE in Opposition to Echostar's MOTION and Cross Motion RE: Partial Summary Judgment of Infringement of Claims 31 and 61 filed by TIVO Inc. (ehs,) Additional attachment(s) added on 9/5/2007 (ch,). Modified on 9/5/2007 (ch,). (Entered: 09/08/2005)

09/08/2005 272 TRANSCRIPT of Proceedings (JOINT Status Conference) held on 9/1/2005 before Judge David Folsom. Court Reporter: Libby Crawford. (sm,) (Entered: 09/08/2005)

09/08/2005 273 MOTION for Leave to File EchoStar's Unopposed Motion to File Declarations ISO of Replies for EchoStar's MIL Nos. 1 & 6-10 by "EchoStar defendants". (Attachments: # 1 Text of Proposed Order Proposed Order Granting Unopposed Motion to File Declarations ISO EchoStar's MIL Nos. 1 & 6-10)(Kramer, Karl) (Entered: 09/08/2005)

09/08/2005 274 NOTICE by "EchoStar defendants" re 188 MOTION in Limine No. 11 to Preclude Late Disclosed Exhibits - Defendant's Notice of Withdrawal of EchoStar's August 18, 2005 Motion in Limine No. 11 (Pickett, John) (Entered: 09/08/2005)

09/08/2005 275 Joint MOTION to Amend/Correct 207 Order,, Set Scheduling Order Deadlines,, Terminate Motions, by Echostar Communications Corporation, Echostar DBS Corporation, EchoStar Technologies Corporation, Echosphere Limited Liability Company. (Lyon, Richard) Additional attachment(s) added on 9/13/2005 (fal,). (Entered: 09/08/2005)

09/09/2005 276 ORDER GRANTING ECHOSTAR'S UNOPPOSED MOTION TO FILE DECLARATIONS IN SUPPORT OF REPLIES FOR ECHOSTAR'S MOTIONS IN LIMINE NOS. 1 AND 6-10; granting 273 Motion for Leave to File . Signed by Judge David Folsom on 9/9/05. (mrm,) (Entered: 09/09/2005)

09/09/2005 277 ORDER PER JOINT MOTION TO MODIFY AUGUST 24, 2005 ORDER; granting 275 Motion to Amend/Correct . Signed by Judge David Folsom on 9/9/05. (mrm,) (Entered: 09/09/2005)

09/09/2005 278 REPLY to Response to Motion re [193] MOTION in Limine No. 1 filed by "EchoStar defendants", (Kramer, Karl) (Entered: 09/09/2005)

09/09/2005 279 REPLY to Response to Motion re [194] MOTION in Limine No. 2 filed by "EchoStar defendants", (Kramer, Karl) (Entered: 09/09/2005)

09/09/2005 280 REPLY to Response to Motion re [196] MOTION in Limine No. 4 filed by "EchoStar defendants", (Kramer, Karl) (Entered: 09/09/2005)

09/09/2005 281 REPLY to Response to Motion re [197] MOTION in Limine No. 5 filed by "EchoStar defendants", (Kramer, Karl) (Entered: 09/09/2005)

09/09/2005 282 REPLY to Response to Motion re [201] MOTION in Limine No. 9 filed by "EchoStar defendants", (Kramer, Karl) (Entered: 09/09/2005)

09/09/2005 283 REPLY to Response to Motion re [202] MOTION in Limine No. 10 filed by "EchoStar defendants", (Kramer, Karl) (Entered: 09/09/2005)

09/09/2005 284 FILED UNDER SEAL REPLY to Response to Motion re [198] MOTION in Limine No. 6 with

declaration of Karl Kramer filed by "EchoStar defendants". (sm,) (Entered: 09/09/2005)

09/09/2005 285 FILED UNDER SEAL REPLY to Response to Motion re [200] MOTION in Limine No. 8 and Declaration of Karl Kramer filed by "EchoStar defendants". (sm,) (Entered: 09/09/2005)

09/09/2005 286 FILED UNDER SEAL REPLY to Response to Motion re [199] MOTION in Limine No. 7 and Declaration of Karl Kramer filed by "EchoStar defendants". (sm,) (Entered: 09/09/2005)

09/09/2005 287 FILED UNDER SEAL MOTION for Sanctions/Contempt Order with exhibits by "EchoStar defendants". (sm,) (Entered: 09/09/2005)

09/09/2005 288 ORDER Setting Hearing on Motions 188 MOTION in Limine No. 11 to Preclude Late Disclosed Exhibits, 218 Second MOTION in Limine To Preclude Evidence/Argument In Front of the Jury Regarding EchoStar's Inequitable Conduct Defense, [193] MOTION in Limine, 219 Third MOTION in Limine, [194] MOTION in Limine, 220 Fifth MOTION in Limine, [195] MOTION in Limine, [221] MOTION in Limine, [196] MOTION in Limine, [197] MOTION in Limine, [222] MOTION in Limine, [198] MOTION in Limine, [199] MOTION in Limine, [200] MOTION in Limine, [201] MOTION in Limine, [202] MOTION in Limine, 227 MOTION Motion to Exclude Improperly Withheld Media4 and Burstware Documents and Witnesses: Motion Hearing and Initial Pretrial Conference set for 9/22/2005 10:00 AM in Ctrm 319 (Texarkana) before Judge David Folsom. Further ORDERED to attend a Final Pre-trial Conference on 10/4/05 in Texarkana at 10:00 am. Signed by Judge David Folsom on 9/9/05. (mrm,) (Entered: 09/09/2005)

09/09/2005 -- Reset Scheduling Order Deadlines: Initial Pretrial Conference 9/22/05 10:00 Am in Ctrm 319 (Texarkana) before Judge David Folsom. Final Pretrial Conference set for 10/4/2005 10:00 AM in Ctrm 319 (Texarkana) before Judge David Folsom. (mrm,) (Entered: 09/09/2005)

09/09/2005 289 MOTION to Strike TiVo Inc.'s Cross Motion Re Partial Summary Judgment of Infringement of Claims 31 and 61 by "EchoStar defendants". (Attachments: # 1 Affidavit of Karl Kramer and exhibits# 2 Text of Proposed Order)(Kramer, Karl) (Entered: 09/09/2005)

09/09/2005 290 FILED UNDER SEAL - DECLARATION of Karl J. Kramer in Support of defts 278 Reply to Motion in Limine No. 1 - to preclude reference to, use of, and reliance upon the expert report and testimony of John R Hauser by "EchoStar defendants". (ehs,) (Entered: 09/12/2005)

09/09/2005 291 FILED UNDER SEAL - Declaration of Karl J. Kramer in Support of defts 282 Reply to Motion in Limine No. 9 - to preclude evidence on doctrine of equivalents by "EchoStar defendants". (ehs,) (Entered: 09/12/2005)

09/09/2005 292 FILED UNDER SEAL - Declaration in Support of deft's 283 Reply to Motion in Limine No. 10 - to preclude reference to, use of and reliance upon other Echostar litigation by "EchoStar defendants". (ehs,) (Entered: 09/12/2005)

09/12/2005 293 ORDER that EchoStar produce the notes Bozicevic, Field & Francis, LLP created in developing its opinion concerning infringement of the '389 patent. EchoStar to produce remaining documents pertaining to advice it received from counsel before suit was filed concerning infringement of the '389 patent. Becking & Cannon each be made available for 1 hour of deposition time concerning the notes they created regarding infringement of the '389 patent. Signed by Judge H. W. McKee on 9/12/05. (ehs,) (Entered: 09/12/2005)

09/12/2005 294 NOTICE by TIVO Inc, "EchoStar defendants" Joint Submission of Proposed Juror Questionnaires (Attachments: # 1 Exhibit A# 2 Exhibit B)(Kramer, Karl) (Entered: 09/12/2005)

09/12/2005 295 NOTICE of Disclosure by "EchoStar defendants" Pursuant to 35 U.S.C. Section 282 (Friedman, Paul) (Entered: 09/12/2005)

09/12/2005 296 STATUS REPORT Joint List of Pending Motions Other Than Motions In Limine by TIVO Inc, Echostar Communications Corporation, Echostar DBS Corporation, EchoStar Technologies Corporation, Echosphere Limited Liability Company. (Lyon, Richard) (Entered: 09/12/2005)

09/13/2005 297 FILED UNDER SEAL REPLY to Response to Motion re [190] MOTION for Summary Judgment of No Willful Infringement filed by "EchoStar defendants". (mpv,) (Entered: 09/13/2005)

09/13/2005 298 REPLY to Response to Motion re [195] MOTION in Limine No. 3-To Preclude Any Reference To, Use Of, and Reliance Upon PTO Museum Display, Or Alternatively, To Allow Discovery filed by "EchoStar defendants". (Friedman, Paul) (Entered: 09/13/2005)

09/13/2005 299 NOTICE by "EchoStar defendants" re 246 Notice (Other) Defendants' Opposition to Tivo's Objections Regarding the Temporal Scope of the August 17, 2005 Order (Friedman, Paul) (Entered: 09/13/2005)

09/13/2005 300 FILED UNDER SEAL - Sur-Reply in Opposition to Echostar's [182] MOTION for Partial Summary Judgment re damages period filed by TIVO Inc. (ehs,) (Entered: 09/14/2005)

09/13/2005 301 FILED UNDER SEAL - Unopposed MOTION for Leave to File Tivo's Reply regarding Tivo's motion for partial summary judgment of infringement of Claims 1 and 32 and Echostar's request for

entry of partial summary judgment of non-infringement of Claims 1 and 32 in excess of page limit by TIVO Inc. (ehs,) (Entered: 09/14/2005)

09/13/2005 302 FILED UNDER SEAL - Opposition to deft's protective motion for reconsideration of the court's order of August 17, 2005 filed by TIVO Inc. (ehs,) (Entered: 09/14/2005)

09/13/2005 312 Minute Entry for proceedings held before Judge H. W. McKee : Telephone Conference held on 9/13/2005. (Court Reporter M. Morris.) (mjm,) (Entered: 09/15/2005)

09/14/2005 303 APPLICATION to Appear Pro Hac Vice by Attorney Emily A Evans for "EchoStar defendants". (rml,) (Entered: 09/14/2005)

09/14/2005 304 FILED UNDER SEAL - REPLY to Response to Motion re 214 MOTION for Partial Summary Judgment Of Non-Infringement of Claims 31 and 61 filed by "EchoStar defendants". (mpv,) (Entered: 09/14/2005)

09/14/2005 -- Pro Hac Vice Filing fee paid by Emily Evans; Fee: \$25, receipt number: 5-1-281 (rml,) (Entered: 09/14/2005)

09/14/2005 305 RESPONSE in Support re [222] MOTION in Limine TIVO'S REPLY IN FURTHER SUPPORT OF TIVO'S MOTION IN LIMINE NO. 1: TO PRECLUDE DEFENDANTS FROM INTRODUCING INTO EVIDENCE OR MAKING ARGUMENTS REGARDING AGREEMENTS WHOLLY BETWEEN NON-PARTIES filed by TIVO Inc. (Baxter, Samuel) (Entered: 09/14/2005)

09/14/2005 306 REPLY to Response to Motion re 218 Second MOTION in Limine To Preclude Evidence/Argument In Front of the Jury Regarding EchoStar's Inequitable Conduct Defense filed by TIVO Inc. (Lyon, Richard) (Entered: 09/14/2005)

09/14/2005 307 MOTION for Leave to File Tivo's Reply to Motion to Exclude Improperly Withheld Media4 and Burstware Documents and Witnesses by TIVO Inc. (Attachments: # 1 Proposed Order) (Chambers, Garret) (Entered: 09/14/2005)

09/14/2005 308 RESPONSE in Opposition re 189 MOTION for Partial Summary Judgment of Invalidity Due to Indefiniteness filed by TIVO Inc. (Armond, Michelle) (Entered: 09/14/2005)

09/14/2005 309 RESPONSE in Support re 219 Third MOTION in Limine filed by TIVO Inc. (Armond, Michelle) (Entered: 09/14/2005)

09/14/2005 310 RESPONSE in Support re [221] MOTION in Limine filed by TIVO Inc. (Armond, Michelle) (Entered: 09/14/2005)

09/14/2005 311 RESPONSE in Support re 220 Fifth MOTION in Limine filed by TIVO Inc. (Armond, Michelle) (Entered: 09/14/2005)

09/15/2005 313 APPEAL OF MAGISTRATE JUDGE DECISION to District Court by "EchoStar defendants" re 293 Order,, (Attachments: # 1 Exhibit A)(Friedman, Paul) (Entered: 09/15/2005)

09/15/2005 314 RESPONSE in Support re 227 MOTION Motion to Exclude Improperly Withheld Media4 and Burstware Documents and Witnesses filed by TIVO Inc. (Armond, Michelle) (Entered: 09/15/2005)

09/15/2005 315 Joint MOTION to Amend/Correct September 9, 2005 Order 277 by TIVO Inc, Echostar Communications Corporation, Echostar DBS Corporation, EchoStar Technologies Corporation, Echosphere Limited Liability Company. (Attachments: # 1 Text of Proposed Order Proposed Order)(Lyon, Richard) (Entered: 09/15/2005)

09/16/2005 316 MOTION to Withdraw 188 MOTION in Limine No. 11 to Preclude Late Disclosed Exhibits by "EchoStar defendants". (Attachments: # 1 Text of Proposed Order)(Pickett, John) (Entered: 09/16/2005)

09/16/2005 317 RESPONSE in Opposition re [199] MOTION in Limine No. 7: TO PRECLUDE REFERENCE TO, USE OF, AND RELIANCE ON ALLEGED CONVOYED SALES OF TIVO'S SERVICES filed by TIVO Inc. (Baxter, Samuel) (Entered: 09/16/2005)

09/16/2005 318 FILED UNDER SEAL - Sur-Reply in Opposition to Echostar's [198] MOTION in Limine No. 6 to preclude reference to, use of, or reliance upon the preamble of any asserted claim as a limitation filed by TIVO Inc. (ehs,) (Entered: 09/16/2005)

09/16/2005 319 FILED UNDER SEAL - SUR-REPLY in Opposition to Echostar's [201] MOTION in Limine No. 9 - to preclude evidence on doctrine of equivalents filed by TIVO Inc. (ehs,) (Entered: 09/16/2005)

09/16/2005 320 FILED UNDER SEAL - Sur-Reply BRIEF in opposition to Echostar's motion in Limine No.1 (#193) - to preclude reference to, use of, and reliance upon the expert report and testimony of John R Hauser filed by "EchoStar defendants". (ehs,) (Entered: 09/16/2005)

09/16/2005 321 RESPONSE in Opposition re [200] MOTION in Limine TIVO'S SUR-REPLY BRIEF IN OPPOSITION TO ECHOSTAR'S MOTION IN LIMINE NO. 8 [DOC 200] - TO PRECLUDE REFERENCE TO, USE OF,

AND RELIANCE UPON THE EXPERT TESTIMONY AND OPINION OF KEITH R. UGONE ON DAMAGES filed by TIVO Inc. (Baxter, Samuel) (Entered: 09/16/2005)

09/16/2005 322 RESPONSE in Opposition re [197] MOTION in Limine Sur-Reply filed by TIVO Inc. (Lyon, Richard) (Entered: 09/16/2005)

09/16/2005 323 RESPONSE in Opposition re [194] MOTION in Limine Sur-Reply filed by TIVO Inc. (Lyon, Richard) (Entered: 09/16/2005)

09/16/2005 324 RESPONSE in Opposition re [202] MOTION in Limine Sur-Reply filed by TIVO Inc. (Lyon, Richard) (Entered: 09/16/2005)

09/16/2005 325 RESPONSE in Opposition re [196] MOTION in Limine Sur-Reply filed by TIVO Inc. (Lyon, Richard) (Entered: 09/16/2005)

09/19/2005 326 RESPONSE in Opposition re [222] MOTION in Limine Surreply filed by "EchoStar defendants". (Kramer, Karl) (Entered: 09/19/2005)

09/19/2005 327 RESPONSE in Opposition re 220 Fifth MOTION in Limine Surreply filed by "EchoStar defendants". (Kramer, Karl) (Entered: 09/19/2005)

09/19/2005 328 RESPONSE in Opposition re 227 MOTION Motion to Exclude Improperly Withheld Media4 and Burstware Documents and Witnesses Surreply filed by "EchoStar defendants". (Kramer, Karl) (Entered: 09/19/2005)

09/19/2005 329 RESPONSE in Opposition re 268 MOTION for Protective Order Echostar's Motion for a Protective Order Prohibiting TiVo from Pursuing Discovery in Other Jurisdictions filed by TIVO Inc. (Attachments: # 1 Affidavit Garret Chambers Declaration)(Chambers, Garret) (Entered: 09/19/2005)

09/19/2005 330 Joint MOTION to Amend/Correct March 3, 2005 Scheduling Order 56 by TIVO Inc, Echostar Communications Corporation, Echostar DBS Corporation, EchoStar Technologies Corporation, Echosphere Limited Liability Company. (Attachments: # 1 Text of Proposed Order Proposed Order)(Lyon, Richard) (Entered: 09/19/2005)

09/19/2005 331 FILED UNDER SEAL - RENEWED MOTION to Strike [271] Tivo's late Cross-motion for partial summary judgment of Infringement of Claims 31 and 61, or, in the alternative, Echostar's opposition to Tivo's Cross-Motion for partial summary judgment of infringement of claims 31 and 61 by "EchoStar defendants". (mpv,) Additional attachment(s) added on 9/5/2007 (ch,). Modified on 9/5/2007 (ch,). (Entered: 09/20/2005)

09/20/2005 332 ORDER; ORDERED to meet and confer on each of the pending motions in limine, including the motion filed as dkt no. 227, to determine whether the ptys can reach agreement on any motion or portion of a motion . Signed by Judge David Folsom on 9/20/05. (mrm,) (Entered: 09/20/2005)

09/20/2005 333 ORDER granting 316 Motion to Withdraw 188 MOTION in Limine No. 11 to Preclude Late Disclosed Exhibits . Signed by Judge David Folsom on 9/20/05. (mrm,) (Entered: 09/20/2005)

09/20/2005 334 FILED UNDER SEAL - SURREPLY to Response to Motion re [228] MOTION for Partial Summary Judgment of Infringement of Claims 1 and 32 and ECHOSTAR's Request for Entry of Partial Summary Judgment of Non-Infringement of Claims 1 and 32 filed by "EchoStar defendants". (mpv,) (Entered: 09/20/2005)

09/20/2005 335 ORDER granting 307 Motion for Leave to File Its Reply in Support of Its Motion to Exclude Improperly Withheld Media4 and Burstware Documents and Witnesses. TiVo shall have until 9/15/05 to file said Reply. Signed by Judge David Folsom on 9/20/05. (mrm,) (Entered: 09/20/2005)

09/20/2005 336 ORDER PER JOINT MOTION TO MODIFY SEPTEMBER 9, 2005 ORDER; granting 315 Motion to Amend/Correct . Signed by Judge David Folsom on 9/20/05. (mrm,) (Entered: 09/20/2005)

09/20/2005 337 REPLY to Response to Motion re 245 MOTION for Reconsideration re 177 Order, filed by "EchoStar defendants". (Attachments: # 1 Affidavit of Paul A. Friedman)(Friedman, Paul) (Entered: 09/20/2005)

09/20/2005 338 ***FILED IN ERROR. SEE CORRECTED DOCUMENT #344*** RESPONSE to Motion re [287] MOTION for Sanctions Sur-Reply filed by TIVO Inc. (Lyon, Richard) Modified on 9/21/2005 (ehs,). (Entered: 09/20/2005)

09/20/2005 339 Exhibit List Objections by "EchoStar defendants".. (Attachments: # 1 Exhibit A)(Friedman, Paul) (Entered: 09/20/2005)

09/20/2005 340 Exhibit List Objections by TIVO Inc.. (Attachments: # 1 Exhibit Objections to EchoStar's Preliminary Exhibit List)(Lyon, Richard) (Entered: 09/20/2005)

09/20/2005 342 FILED UNDER SEAL - Sur-Reply in Opposition to Echostar's MOTION for Partial Summary

Judgment of no willful infringement filed by TIVO Inc. (ehs,) (Entered: 09/21/2005)

09/20/2005 343 FILED UNDER SEAL - TIVO'S (1) Reply in support of TIVO'S Objections re: The temporal Scope of the August 17, 2005 Order, and (2) Motion for (Proposed) Order Nunc Pro Tunc Extending Filing Deadline by TIVO Inc. (ehs,) (Entered: 09/21/2005)

09/21/2005 341 NOTICE of Disclosure by "EchoStar defendants" - Defendants' Pre-Trial Disclosures Under Federal Rule of Civil Procedure 26(a)(3) (Pickett, John) (Entered: 09/21/2005)

09/21/2005 344 ***REPLACES DOCUMENT #338***WHICH WAS FILED IN ERROR*** RESPONSE to Motion re [195] MOTION in Limine Sur-Reply in Further Opposition filed by TIVO Inc. (Lyon, Richard) Modified on 9/21/2005 (ehs,). (Entered: 09/21/2005)

09/21/2005 345 RESPONSE in Support re 268 MOTION for Protective Order Echostar's Motion for a Protective Order Prohibiting TiVo from Pursuing Discovery in Other Jurisdictions Reply Brief in Support of EchoStar's Motion for a Protective Order Prohibiting TiVo from Pursuing Discovery in Other Jurisdictions filed by "EchoStar defendants", Echostar Communications Corporation, Echostar DBS Corporation, EchoStar Technologies Corporation, Echosphere Limited Liability Company. (Kramer, Karl) (Entered: 09/21/2005)

09/21/2005 346 ORDER, granting 330 Joint MOTION to Amend/Correct March 3, 2005 Scheduling Order 56 filed by TIVO Inc., Echostar Communications Corporation,, Echostar DBS Corporation,, EchoStar Technologies Corporation,, Echosphere Limited Liability Company,. Jury instructions and Verdict Form due by 9/23/2005. Signed by Judge David Folsom on 9/21/05. (mrm,) (Entered: 09/21/2005)

09/21/2005 347 RESPONSE in Opposition re 289 MOTION to Strike TiVo Inc.'s Cross Motion Re Partial Summary Judgment of Infringement of Claims 31 and 61 filed by TIVO Inc. (Attachments: # 1 Text of Proposed Order)(Giza, Alexander) (Entered: 09/21/2005)

09/21/2005 348 RESPONSE in Opposition re 214 MOTION for Partial Summary Judgment TiVo Inc.'s Surreply in Further Opposition to EchoStar's Motion for Partial Summary Judgment of Non-Infringement of Claims 31 and 61 filed by TIVO Inc. (Giza, Alexander) (Entered: 09/21/2005)

09/22/2005 349 Minute Entry for proceedings held before Judge David Folsom : Motion Hearing held on 9/22/2005 re [201] MOTION in Limine filed by "EchoStar defendants",, 227 MOTION Motion to Exclude Improperly Withheld Media4 and Burstware Documents and Witnesses filed by TIVO Inc.,, [202] MOTION in Limine filed by "EchoStar defendants",, 218 Second MOTION in Limine To Preclude Evidence/Argument In Front of the Jury Regarding EchoStar's Inequitable Conduct Defense filed by TIVO Inc.,, [193] MOTION in Limine filed by "EchoStar defendants",, 219 Third MOTION in Limine filed by TIVO Inc.,, [194] MOTION in Limine filed by "EchoStar defendants",, 220 Fifth MOTION in Limine filed by TIVO Inc.,, [195] MOTION in Limine filed by "EchoStar defendants",, [221] MOTION in Limine filed by TIVO Inc.,, [196] MOTION in Limine filed by "EchoStar defendants",, [222] MOTION in Limine filed by TIVO Inc.,, [197] MOTION in Limine filed by "EchoStar defendants",, [198] MOTION in Limine filed by "EchoStar defendants",, [199] MOTION in Limine filed by "EchoStar defendants",, [200] MOTION in Limine filed by "EchoStar defendants",, (Court Reporter Libby Crawford.) (mrm,) (Entered: 09/22/2005)

09/22/2005 350 Joint MOTION for Extension of Time to File Response/Reply Briefs re Motion for Contempt Order [Doc 287] by TIVO Inc, Echostar Communications Corporation, Echostar DBS Corporation, EchoStar Technologies Corporation, Echosphere Limited Liability Company. (Lyon, Richard) Additional attachment(s) added on 9/23/2005 (mpv,). (Entered: 09/22/2005)

09/22/2005 351 FILED UNDER SEAL - Surreply in further in Opposition to Echostar's Motion for Partial Summary Judgment of Non-Infringement of Claims 31 and 61 (#214) filed by TIVO Inc. (ehs,) (Entered: 09/23/2005)

09/22/2005 352 FILED UNDER SEAL - RESPONSE in Opposition to Echostar's [287] MOTION for Contempt Order filed by TIVO Inc. (ehs,) (Entered: 09/23/2005)

09/23/2005 353 NOTICE by "EchoStar defendants" of Filing of Correspondence Regarding Deposition of Dan Landreth In Further Opposition to Tivo's Motion to Exclude (Attachments: # 1 Exhibit A) (Kramer, Karl) (Entered: 09/23/2005)

09/23/2005 354 ***SEE CORRECTED ORDER # 357*** ORDER; ORDERS: Echostar to produce all notes, communications, or other documentation created by or relating to the infringement analysis of the '389 patent undertaken by Bozicevic, Field & Frances, LLP, at any time; Echostar to produce the two Merchant & Gould opinions and all notes, communications, or other documentation related to any infringement analysis of the '389 patent undertaken by Merchant & Gould. Echostar is to produce these materials within 7 days of this order. The Court further ORDERS Echostar to produce Frank Becking, Alan Cannon, Kerry Miller, Homer Knearl and Timothy Scull for deposition concerning their analysis of the '389 patent and any potential infringement by Echostar. TiVo is granted an additional 5 hrs of deposition time; These witnesses are not be made available no later than 10/14/05 . Signed by Judge David Folsom on 9/23/05. (mrm,)

Modified on 9/26/2005 (mrm,). (Entered: 09/23/2005)

09/23/2005 355 NOTICE by "EchoStar defendants" 35 U.S.C. Section 282 Supplemental Disclosure (Friedman, Paul) (Entered: 09/23/2005)

09/23/2005 356 Proposed Jury Instructions by TIVO Inc, "EchoStar defendants". (Attachments: # 1 Exhibit Exhibit A# 2 Exhibit Exhibit B# 3 Exhibit Exhibit C# 4 Exhibit Exhibit D# 5 Exhibit Exhibit E# 6 Exhibit Exhibit F)(Lyon, Richard) (Entered: 09/23/2005)

09/26/2005 357 *VACATED AS PER ORDER # 729* ***REPLACES ORDER # 354*** ORDER; ORDERS: Echostar to produce all notes, communications, or other documentation created by or relating to the infringement analysis of the '389 patent undertaken by Bozicevic, Field & Frances, LLP, at any time; Echostar to produce the two Merchant & Gould opinions and all notes, communications, or other documentation related to any infringement analysis of the '389 patent undertaken by Merchant & Gould. Echostar is to produce these materials within 7 days of this order. The Court further ORDERS Echostar to produce Frank Becking, Alan Cannon, Kerry Miller, Homer Knearl and Timothy Scull for deposition concerning their analysis of the '389 patent and any potential infringement by Echostar. TiVo is granted an additional 5 hrs of deposition time; These witnesses are not be made available no later than 10/14/05 . Signed by Judge David Folsom on 9/26/05. (mrm,) Modified on 5/16/2006 (mrm,). (Entered: 09/26/2005)

09/26/2005 358 ORDER PER JOINT MOTION FOR EXTENSION TO SERVE AND FILE BRIEFS RE MOTION FOR CONTEMPT ORDER; granting 350 Motion for Extension of Time to File Response/Reply re [287] MOTION for Sanctions Responses due by 9/22/2005 Replies due by 9/30/2005. Signed by Judge David Folsom on 9/26/05. (mrm,) (Entered: 09/26/2005)

09/26/2005 360 FILED UNDER SEAL - REPLY in Support of its Cross-Motion #271 for Partial Summary Judgment of Infringement of Claims 31 and 61 by TIVO Inc. (ehs,) (Entered: 09/28/2005)

09/27/2005 359 NOTICE by "EchoStar defendants" of Compliance (Evans, Emily) (Entered: 09/27/2005)

09/27/2005 361 ORDER finding as moot 81 Motion to Compel, finding as moot 85 Motion to Compel, finding as moot [87] Motion to Compel, finding as moot 88 Motion to Compel, finding as moot 118 Motion to Compel . Signed by Judge H. W. McKee on 9/27/05. (ehs,) (Entered: 09/28/2005)

09/28/2005 362 REPLY to Response to Motion re 289 MOTION to Strike TIVO Inc.'s Cross Motion Re Partial Summary Judgment of Infringement of Claims 31 and 61 filed by "EchoStar defendants". (Kramer, Karl) (Entered: 09/28/2005)

09/29/2005 363 ORDER to produce Dr. Rhyne for 2 hours of deposition time before 10/14/05. Signed by Judge H. W. McKee on 9/29/05. (ehs,) (Entered: 09/29/2005)

09/29/2005 364 FILED UNDER SEAL REPLY to Response to Motion re [287] MOTION for Sanctions/Contempt Order Based on Tivo's violation of the protective order filed by "EchoStar defendants". (mpv,) (Entered: 09/29/2005)

09/30/2005 365 Exhibit List Trial Exhibit List by TIVO Inc.. (Attachments: # 1 Supplement Part 2 of trial exhibit list# 2 Supplement Part 3 of trial exhibit list# 3 Supplement Part 4 of trial exhibit list# 4 Supplement Part 5 of trial exhibit list# 5 Supplement Part 6 of trial exhibit list# 6 Supplement Part 7 of trial exhibit list# 7 Supplement Part 8 of trial exhibit list# 8 Supplement Part 9 of trial exhibit list)(Giza, Alexander) (Entered: 09/30/2005)

09/30/2005 366 Exhibit List Objections to EchoStar's Trial Exhibit List by TIVO Inc.. (Attachments: # 1 Supplement Part 2 to Objections to EchoStar's Trial Exhibit List# 2 Supplement Part 3 to Objections to EchoStar's Trial Exhibit List# 3 Supplement Part 4 to Objections to EchoStar's Trial Exhibit List# 4 Supplement Part 5 to Objections to EchoStar's Trial Exhibit List)(Giza, Alexander) (Entered: 09/30/2005)

09/30/2005 367 Proposed Pretrial Order Amendments to Exhibits D, H, and K by "EchoStar defendants". (Attachments: # 1 Exhibit D (Revised)# 2 Exhibit H (Amended) Part 1# 3 Exhibit H (Amended) part 2# 4 Exhibit K (Addendum 1)# 5 Exhibit K (Addendum 2))(Kramer, Karl) (Entered: 09/30/2005)

09/30/2005 368 Exhibit List Objections by "EchoStar defendants".. (Attachments: # 1 Exhibit A)(Kramer, Karl) (Entered: 09/30/2005)

09/30/2005 369 NOTICE of Disclosure by "EchoStar defendants" Pursuant to Rule 26(a)(3) "Expect to Offer, May Offer" Designations (Attachments: # 1 Exhibit A)(Kramer, Karl) (Entered: 09/30/2005)

09/30/2005 371 APPLICATION to Appear Pro Hac Vice by Attorney Kristina Paszek for "EchoStar defendants". (rml,) (Entered: 10/03/2005)

09/30/2005 -- Pro Hac Vice Filing fee paid by Kristina Paszek; Fee: \$25, receipt number: 5-1-300 (rml,) (Entered: 10/03/2005)

10/03/2005 370 NOTICE of Disclosure by "EchoStar defendants" - Defendants' Supplemental Pre-Trial

Disclosures Under Federal Rule of Civil Procedure 26(a)(3) (Pickett, John) (Entered: 10/03/2005)

10/03/2005 372 Proposed Pretrial Order Exhibit I - Addendum by TIVO Inc. (Lyon, Richard) (Entered: 10/03/2005)

10/03/2005 373 NOTICE by TIVO Inc of Compliance with Fed. R. Civ. Proc. 26(a)(3) (Lyon, Richard) (Entered: 10/03/2005)

10/03/2005 374 FILED UNDER SEAL - Surreply in support of def't's RESPONSE in Opposition re Tivo's [331] MOTION to Strike [271] Response in Opposition to Motion for partial summary judgment of infringement of claims 31 and 61 filed by "EchoStar defendants". (ehs,) (Entered: 10/04/2005)

10/04/2005 375 Minute Entry for proceedings held before Judge David Folsom : Initial Pretrial Conference held on 10/4/2005. (Court Reporter Libby Crawford.) (mrm,) (Entered: 10/05/2005)

10/05/2005 376 APPLICATION to Appear Pro Hac Vice by Attorney Alison M Tucher for Echostar Communications Corporation; Echostar DBS Corporation; Echostar Communications Corporation; Echosphere Limited Liability Company. (rml,) (Entered: 10/05/2005)

10/05/2005 -- Pro Hac Vice Filing fee paid by Alison Tucher; Fee: \$25, receipt number: 5-1-303 (rml,) (Entered: 10/05/2005)

10/05/2005 377 RESPONSE in Opposition re 289 MOTION to Strike TiVo Inc.'s Cross Motion Re Partial Summary Judgment of Infringement of Claims 31 and 61 (Sur-Reply) filed by TIVO Inc. (Giza, Alexander) (Entered: 10/05/2005)

10/06/2005 378 SEALED TRANSCRIPT of Proceedings (Motions in Limine, Excerpt of Proceedings regarding motion) held on 9/22/2005 before Judge David Folsom. Court Reporter: Libby Crawford. (sm,) (Entered: 10/06/2005)

10/06/2005 379 TRANSCRIPT of Proceedings (Motions in Limine except for a portion of which is excerpted and sealed under separate cover - #378) held on September 22, 2005 before Judge David Folsom. Court Reporter: Libby Crawford. (sm,) (Entered: 10/06/2005)

10/06/2005 380 *VACATED AS PER ORDER # 729* ORDER OF CLARIFICATION OF THE COURT'S SEPTEMBER 26,2005 OPINION AND ORDER re 357 Order (attachments with order are Exhibit 1 and Exhibit 2). Signed by Judge David Folsom on 10/6/05. (mrm,) Modified on 10/6/2005 (mrm,). Modified on 5/16/2006 (mrm,). (Entered: 10/06/2005)

10/06/2005 381 ORDER granting 268 Motion for Protective Order Prohibiting TiVo from Pursuing Discovery in Other Jurisdictions. Signed by Judge David Folsom on 10/6/05. (mrm,) (Entered: 10/06/2005)

10/06/2005 382 STIPULATION re 218 Second MOTION in Limine To Preclude Evidence/Argument In Front of the Jury Regarding EchoStar's Inequitable Conduct Defense As Moot by TIVO Inc, "EchoStar defendants". (Kramer, Karl) (Entered: 10/06/2005)

10/06/2005 384 FILED UNDER SEAL - Sur-Reply in Opposition to Echostar's [287] MOTION for a contempt order filed by TIVO Inc. (ehs,) (Entered: 10/07/2005)

10/07/2005 383 Emergency MOTION to Stay Court's Order of October 6, 2005 by Echostar Communications Corporation, Echostar DBS Corporation, EchoStar Technologies Corporation, Echosphere Limited Liability Company. (Attachments: # 1 Text of Proposed Order Proposed Order# 2 Text of Proposed Order Alternative Proposed Order)(McElhinny, Harold) (Entered: 10/07/2005)

10/07/2005 385 RESPONSE to Motion re 383 Emergency MOTION to Stay Court's Order of October 6, 2005 filed by TIVO Inc. (Baxter, Samuel) (Entered: 10/07/2005)

10/07/2005 386 *VACATED AS PER ORDER # 729* ORDER GRANTING DEFENDANTS' REQUEST FOR AN EMERGENCY STAY OF THE COURT'S ORDER OF OCTOBER 6, 2005; granting 383 Emergency MOTION to Stay Court's Order of October 6, 2005 . Signed by Judge David Folsom on 10/7/06. (mrm,) Modified on 5/16/2006 (mrm,). (Entered: 10/07/2005)

10/07/2005 387 Proposed Jury Instructions by TIVO Inc, "EchoStar defendants". (Lyon, Richard) (Entered: 10/07/2005)

10/11/2005 388 STATUS REPORT TIVO'S REPORT ON ITS OBJECTIONS TO DEFENDANTS' EXHIBITS by TIVO Inc. (Baxter, Samuel) (Entered: 10/11/2005)

10/11/2005 389 NOTICE by TIVO Inc NOTICE OF LODGING OF TIVO'S DESIGNATED DEPOSITION TESTIMONY FOR FIRST WEEK OF TRIAL (Baxter, Samuel) (Entered: 10/11/2005)

10/11/2005 390 TRANSCRIPT of Pre-Trial Hearing Proceedings held on 10/4/05 at 9:55 a.m. In Texarkana, Tx Judge Honorable Judge David Folsom. Court Reporter: Libby Crawford. (ch,) (Entered: 10/11/2005)

10/11/2005 391 NOTICE by "EchoStar defendants" of Filing of Petition for Writ of Mandamus in the U.S. Court of

Appeals for the Federal Circuit (Attachments: # 1 Exhibit A (Writ)# 2 Exhibit A (Addendum part 1)# 3 Exhibit A (Addendum part 2)# 4 Exhibit A (Addendum part 3))(Tucher, Alison) (Entered: 10/11/2005)

10/11/2005 392 Minute Entry for proceedings held before Judge David Folsom : Final Pretrial Conference held on 10/11/2005. (Court Reporter Libby Crawford.) (mrm,) (Entered: 10/12/2005)

10/14/2005 393 FILED UNDER SEAL NOTICE OF FILING LETTER BRIEF filed per Judge's request by "EchoStar defendants". (mpv,) Additional attachment(s) added on 10/2/2007 (ehs,). (Entered: 10/14/2005)

10/14/2005 394 NOTICE by "EchoStar defendants" of Order from the Court of Appeals for the Federal Circuit Directing Briefing Concerning EchoStar's Writ of Mandamus (Kramer, Karl) (Entered: 10/14/2005)

10/14/2005 395 NOTICE by "EchoStar defendants" of Filing of Letter Brief (Kramer, Karl) (Entered: 10/14/2005)

10/14/2005 396 MOTION for Extension of Time to File UNOPPOSED MOTION BY PLAINTIFF TIVO INC. TO EXTEND DATE FOR LODGING OF DEPOSITION TESTIMONY THAT TIVO EXPECTS TO OFFER DURING THE FIRST WEEK OF TRIAL AND MATERIALS RELATED THERETO by TIVO Inc. (Attachments: # 1 Text of Proposed Order Proposed Order)(Byrd, Christine) (Entered: 10/14/2005)

10/17/2005 397 ORDER; Therefore, it is hereby ORDERED that trial in this case is CONTINUED until March 2006. It is further ORDERED that all motion practice is hereby STAYED unless leave from this Court is first obtained and all discovery is STAYED pending a status conference to be scheduled when the Court has more information concerning its November schedule . Signed by Judge David Folsom on 10/17/05. (mrm,) (Entered: 10/17/2005)

10/17/2005 399 Received NOTICE OF DOCKETING from USCA that a petition for writ of mandamus has been filed with the court. MISC NO 803 on 10/12/05 (ehs,) (Entered: 10/18/2005)

10/18/2005 398 ORDER ON UNOPPOSED MOTION BY PLAINTIFF TIVO INC. TO EXTEND DATE FOR LODGING OF DEPOSITION TESTIMONY THAT TIVO EXPECTS TO OFFER DURING THE FIRST WEEK OF TRIAL AND MATERIALS RELATED THERETO; granting 396 Motion for Extension of Time to File . Signed by Judge David Folsom on 10/17/05. (mrm,) (Entered: 10/18/2005)

10/18/2005 400 TRANSCRIPT of Proceedings/Pretrial Hearing held on 10/11/05 before Judge David Folsom. Court Reporter: Libby Crawford. (mpv,) (Entered: 10/19/2005)

10/20/2005 401 APPLICATION to Appear Pro Hac Vice by Attorney Charles Conrow Murphy, Jr for Merchant & Gould. (mpv,) (Entered: 10/20/2005)

10/20/2005 -- Pro Hac Vice Filing fee paid by Charles Conrow Murphy Jr; Fee: \$25, receipt number: 5-1-318 (mpv,) (Entered: 10/20/2005)

10/28/2005 402 NOTICE from USCA Federal Circuit showing Notice of Docketing a petition for writ of mandamus having been filed on 10/25/05 giving Misc No 805 In RE: Echostar Communications (ehs,) (Entered: 10/31/2005)

10/31/2005 403 MOTION for Extension of Time to File Unopposed Motion To Further Extend Date For Lodging Of Deposition Testimony That Tivo Expects To Offer During The First Week Of Trial And Materials Related Thereto by TIVO Inc. (Lyon, Richard) Proposed Order added on 11/1/2005 (mpv,). Modified on 11/1/2005 (mpv,). (Entered: 10/31/2005)

10/31/2005 405 NOTICE from USCA Federal Circuit that Tivo Inc is directed to respond to Merchant & Gould's petition no later than 11/3/05 (ehs,) (Entered: 11/03/2005)

11/01/2005 -- Shipped to FRC on 3/29/05, Accession Number 021-05-0102, Location E-16-047-1-6, Box 5 Vols 1-2 of 2 of 7 Boxes. [For internal information only - case is either pending and imaged or closed.] (ch,) (Entered: 11/01/2005)

11/02/2005 404 ORDER RE UNOPPOSED MOTION BY PLAINTIFF TIVO INC. TO FURTHER EXTEND DATE FOR LODGING OF DEPOSITION TESTIMONY THAT TIVO EXPECTS TO OFFER DURING THE FIRST WEEK OF TRIAL AND MATERIALS RELATED THERETO; granting 403 Motion for Extension of Time to File; Tivo shall lodge with the ct on 11/16/05, deposition transcripts w/ both Tivo's designations and dfts counter-designations highlighted, and a compilation of the objections to each other's designations . Signed by Judge David Folsom on 11/2/05. (mrm,) (Entered: 11/02/2005)

11/16/2005 406 NOTICE by TIVO Inc of Lodging of Tivo's Designated Deposition Testimony for First Week of Trial (Lyon, Richard) (Entered: 11/16/2005)

12/21/2005 407 ORDER; The Court now ORDERS that each side shall have 17.5 hours for case presentation, excluding trial related to jury selection, opening statement, closing argument, and transition statements. Signed by Judge David Folsom on 12/21/05. (mrm,) (Entered: 12/21/2005)

12/22/2005 408 ORDER The above-styled case is set for trial on this Court's in Martch 2006 docket. Status Conference set for 1/18/2006 01:30 PM in Ctrm 319 (Texarkana) before Judge David Folsom to determine a hearing date for summary judgment motions and to address any outstanding discovery issues. The Court notes that scheduled discovery is closed; should either party seek additional discovery, leave from this Court is required and will only be granted upon a showing of good cause. Signed by Judge David Folsom on 12/22/05. (mpv,) (Entered: 12/22/2005)

12/29/2005 409 MOTION for Reconsideration re 407 Order of December 21, 2005 by "EchoStar defendants". (Attachments: # 1 Text of Proposed Order)(McElhinny, Harold) (Entered: 12/29/2005)

01/04/2006 410 RESPONSE in Opposition're 409 MOTION for Reconsideration re 407 Order of December 21, 2005 filed by TIVO Inc. (Armond, Michelle) (Entered: 01/04/2006)

01/04/2006 411 REPLY to Response to Motion re 409 MOTION for Reconsideration re 407 Order of December 21, 2005 filed by "EchoStar defendants". (McElhinny, Harold) (Entered: 01/04/2006)

01/06/2006 412 REPLY to Response to Motion re 409 MOTION for Reconsideration re 407 Order of December 21, 2005 filed by TIVO Inc. (Armond, Michelle) (Entered: 01/06/2006)

01/06/2006 413 MOTION for Paul A. Friedman to Withdraw as Attorney by "EchoStar defendants". (Attachments: # 1 Text of Proposed Order)(Friedman, Paul) (Entered: 01/06/2006)

01/09/2006 414 ORDER granting 413 Motion to Withdraw as Attorney for Defendants; terminated: Paul A. Friedman. Signed by Judge David Folsom on 1/9/2006. (mrm,) (Entered: 01/09/2006)

01/09/2006 -- Attorney Paul A. Friedman terminated. (as per order # 414). Signed by Judge David Folsom on 1/9/2006. (mrm,) (Entered: 01/09/2006)

01/12/2006 415 MOTION for Ann E. Citrin to Withdraw as Attorney by "EchoStar defendants". (Attachments: # 1 Text of Proposed Order)(Paszek, Kristina) (Entered: 01/12/2006)

01/17/2006 416 ORDER granting 415 Motion to Withdraw Ann E. Citrin as Attorney for Dfts. After considering the request, the Court finds that it has merit, GRANTS the request, and ORDERS the withdrawal of Mrs. Citrin as attorney for Dfts. The Clerk shall remove Mrs. Citrin from the Court's ECF email service list for this matter. All other Morrison & Foerster LLP attorneys remain counsel of record for Dfts . Signed by Judge David Folsom on 1/17/06. (mpv,) (Entered: 01/17/2006)

01/19/2006 417 ORDER granting [301] Motion for Leave to File. It is therefore ORDERED that Tivo's Unopposed Motion for LEave to file Tivo's Reply Regarding Tivo's Motion for Partial Summary Judgment of Infringement of Claims 1 and 32 and Echostar's Request for Entry of Partial Summary Judgment of Non-Infringement of Claims 1 and 32 In Excess of Page Limit is GRANTED. Signed by Judge David Folsom on 1/19/06. (mpv,) (Entered: 01/19/2006)

01/19/2006 418 ORDER granting [186] Motion for Leave to File Second Amended Complaint to Join Echostar Satellite LLC. Signed by Judge David Folsom on 1/19/06. (mpv,) (Entered: 01/19/2006)

01/23/2006 419 RESPONSE in Opposition re [202] MOTION in Limine No. 10 (Partial Opposition) filed by TIVO Inc. (Lyon, Richard) (Entered: 01/23/2006)

01/24/2006 420 AMENDED COMPLAINT SECOND AMENDED COMPLAINT FOR PATENT INFRINGEMENT against Echostar Satellite LLC, Echostar Communications Corporation, Echostar DBS Corporation, EchoStar Technologies Corporation, Echosphere Limited Liability Company, filed by TIVO Inc. (Attachments: # 1 Exhibit A)(Baxter, Samuel) (Entered: 01/24/2006)

01/25/2006 421 ORDER; The Cour hereby ORDERS TiVo, within 5 days after the entry of this Order, to file a motion with the Court seeking to withdraw asserted claims and stating whether or not the claims are to be withdrawn with or without prejudice. No motion need be filed should TiVo choose not to withdraw any asserted claims. Signed by Judge David Folsom on 1/25/06. (mrm,) (Entered: 01/25/2006)

01/26/2006 422 ORDER denying [193] Motion in Limine, denying [194] Motion in Limine, granting [195] Motion in Limine, denying [196] Motion in Limine, denying [197] Motion in Limine, granting [198] Motion in Limine, denying [199] Motion in Limine, denying [200] Motion in Limine, taking under advisement [201] Motion in Limine, granting as modified [202] Motion in Limine, denying 218 Motion in Limine, denying 219 Motion in Limine, denying 220 Motion in Limine, denying [221] Motion in Limine, denying [222] Motion in Limine; Accordingly the Court hereby ORDERS that the ptys motions in limine are granted, denied, or modified as set forth herein . Signed by Judge David Folsom on 1/26/06. (mrm,) (Entered: 01/26/2006)

01/27/2006 423 NOTICE by TIVO Inc of Lodging of TiVo's Shortened Designated Deposition Testimony (Lyon, Richard) (Entered: 01/27/2006)

01/30/2006 424 NOTICE by TIVO Inc TiVo's Brief In Support of Its Objections to Defendants' Trial Exhibits (Attachments: # 1 Exhibit Exhibit A through H)(Byrd, Christine) (Entered: 01/30/2006)

01/30/2006 425 NOTICE by TIVO Inc TiVo's Brief in Opposition to EchoStar's Objections to TiVo's Trial Exhibits

(Attachments: # 1 Exhibit Exhibit A# 2 Exhibit Exhibit B# 3 Exhibit Exhibit D-K)(Byrd, Christine) (Entered: 01/30/2006)

01/30/2006 426 ORDER REFERRING parties' objections to deposition designations and exhibits to Magistrate Judge Caroline Craven for decision. Signed by Judge David Folsom on 1/30/06. (mrm,) (Entered: 01/30/2006)

01/30/2006 427 NOTICE by "EchoStar defendants" Defendants' Submission Regarding Evidentiary Objections To Be Heard By The Magistrate Judge (Attachments: # 1 Appendix A# 2 Appendix B# 3 Affidavit of Kristina Paszek# 4 Exhibit A-E to Paszek Decl.)(Kramer, Karl) (Entered: 01/30/2006)

01/31/2006 428 NOTICE by "EchoStar defendants" of Filing of Letter Brief (Krevans, Rachel) (Entered: 01/31/2006)

01/31/2006 429 Minute Entry for proceedings held before Judge David Folsom : Motion Hearing held on 1/31/2006 re [228] MOTION for Partial Summary Judgment filed by TIVO Inc., [182] MOTION for Partial Summary Judgment filed by "EchoStar defendants",, 214 MOTION for Partial Summary Judgment filed by "EchoStar defendants",, 189 MOTION for Partial Summary Judgment of Invalidity Due to Indefiniteness filed by "EchoStar defendants",, [190] MOTION for Summary Judgment filed by "EchoStar defendants",, 136 MOTION for Partial Summary Judgment of Non-Infringement: (1) No Infringement by EchoStar's 7100/7200 Devices; and (2) No Infringement Under the Doctrine of Equivalents filed by "EchoStar defendants",. (Court Reporter Libby Crawford.) (mrm,) (Entered: 02/01/2006)

02/01/2006 430 MOTION Withdraw Asserted Claims 6, 20, 37, and 51 by TIVO Inc. (Attachments: # 1 Text of Proposed Order)(Armond, Michelle) (Entered: 02/01/2006)

02/01/2006 431 NOTICE by TIVO Inc of Submission of Previously Submitted Letters Re Jury Notebook (Hoffman, Adam) (Entered: 02/01/2006)

02/02/2006 432 ORDER granting in part and denying in part 227 Motion to Exclude Improperly Withheld Media4 and Burstware Documents & Witnesses; ORDERS that fact witnesses Dan Landreth and Fred Tuck are hereby Dan Landreth and Fred Tuck, from EchoStar's witness list and are PRECLUDED from testifying but DENIES all other requested relief . Signed by Judge David Folsom on 2/2/06. (mrm,) (Entered: 02/02/2006)

02/02/2006 433 ORDER granting in part and denying in part [201] EchoStar's ninth Motion in Limine and ORDERS that TiVo is PRECLUDED from presenting expert testimony regarding whether EchoStar's 7100 and 7200 digital video recorder products infringe the '389 patent and DENIES EchoStar's motion to preclude Dr. Gibson from testifying regarding infringement under the doctrine of equivalents . Signed by Judge David Folsom on 2/2/06. (mrm,) (Entered: 02/02/2006)

02/02/2006 434 ORDER denying 289 Motion to Strike, denying [331] Motion to Strike. The Court hereby DENIES EchoStar's motion and renewed motion to strike TIVO's Cross Motion for Partial Summary Judgment of Infringement of Claims 31 and 61. This order does not affect the Court's consideration of EchoStar's Opposition to TiVo's Cross Motion for Partial Summary Judgment of Infringement of Claims 31 and 61 Dkt. #[331] . Signed by Judge David Folsom on 2/2/06. (mpv,) (Entered: 02/02/2006)

02/02/2006 435 NOTICE by TIVO Inc of Filing of Letter Brief (Armond, Michelle) (Entered: 02/02/2006)

02/03/2006 436 ***PLEASE IGNORE - MOTION MUST HAVE LEAVE TO FILE REPLACED BY #437*** MOTION for Reconsideration Concerning Section II C of the Court's February 2, 2006 Order by "EchoStar defendants". (Attachments: # 1 Affidavit of Karl J. Kramer# 2 Text of Proposed Order)(Kramer, Karl) Modified on 2/3/2006 (rml,). Modified on 2/6/2006 (mpv,). Modified on 2/6/2006 (mpv,). (Entered: 02/03/2006)

02/03/2006 437 MOTION for Reconsideration Concerning Section II C of the Court's February 2, 2006 Order by "EchoStar defendants". (Attachments: # 1 Exhibit A-C# 2 Affidavit of Karl J. Kramer# 3 Text of Proposed Order)(Kramer, Karl) (Entered: 02/03/2006)

02/03/2006 438 NOTICE by "EchoStar defendants" of Filing of Letter Brief (Krevans, Rachel) (Entered: 02/03/2006)

02/03/2006 -- ***FILED IN ERROR. Document # 436, MOTION for Reconsideration Concerning Section II C of the Court's February 2, 2006 Order by "EchoStar defendants". PLEASE IGNORE. DOCUMENT NOW REPLACED BY #437*** (mpv,) (Entered: 02/06/2006)

02/05/2006 439 NOTICE by "EchoStar defendants" re 431 Notice (Other) of Filing of Letter Brief Regarding Proposed Jury Notebooks (Krevans, Rachel) (Entered: 02/05/2006)

02/06/2006 440 ***FILED IN ERROR; PLEASE IGNORE; DOCUMENT WILL BE REFILED UNDER SEAL*** REPLY to Response to Motion re 436 MOTION for Reconsideration Concerning Section II C of the Court's February 2, 2006 Order reply re proposed exhibit 2449 (MJ Craven) filed by TIVO Inc.

(Attachments: # (1) Supplement Reply re: Exhibit 2449)(Byrd, Christine) Additional attachment (s) added on 2/6/2006 (mpv,). Modified on 2/6/2006 (mpv,). (Entered: 02/06/2006)

02/06/2006 -- ***FILED IN ERROR. Document # 440, REPLY to Response to Motion re 436 MOTION for Reconsideration Concerning Section II C of the Court's February 2, 2006 Order reply re proposed exhibit 2449 (MJ Craven), PLEASE IGNORE. DOCUMENT WILL BE REFILED UNDER SEAL*** (mpv,) (Entered: 02/06/2006)

02/06/2006 442 RESPONSE in Opposition re 430 MOTION Withdraw Asserted Claims 6, 20, 37, and 51 filed by "EchoStar defendants". (Attachments: # 1 Affidavit of Karl J. Kramer# 2 Text of Proposed Order # 3 Text of Proposed Order (Alternative))(Kramer, Karl) (Entered: 02/06/2006)

02/06/2006 443 Additional Attachments to Main Document: 442 Response in Opposition to Motion,.. (Attachments: # 1 Exhibit A)(Kramer, Karl) (Entered: 02/06/2006)

02/06/2006 444 TRANSCRIPT of Proceedings/Status Conference held on 1/18/06 before Judge David Folsom. Court Reporter: Libby Crawford. (mpv,) (Entered: 02/07/2006)

02/07/2006 446 NOTICE by TIVO Inc of Filing of Letter Brief re Jury Notebooks (Byrd, Christine) (Entered: 02/07/2006)

02/07/2006 447 NOTICE by TIVO Inc re 438 Notice (Other) of Filing of Responsive Letter Brief re EchoStar's Letter Brief on SJ Motions claims 1 & 32 (Giza, Alexander) (Entered: 02/07/2006)

02/07/2006 448 NOTICE by "EchoStar defendants" re 424 Notice (Other) Defendants' Supplemental Brief Regarding Plaintiff's Objection To Defendants' Proposed Trial Exhibit No. 2449 (Attachments: # 1 Affidavit of Karl J. Kramer)(Kramer, Karl) (Entered: 02/07/2006)

02/07/2006 449 ORDER re: 430 Motion to Withdraw Asserted Claims 6, 20, 37, and 51 with Prejudice; ORDERS: 1) Any claims by TiVo against Dfts for infringement of claims 6, 20, 37, and 51 of US Patent No 6,233,389 are hereby DISMISSED WITH PREJUDICE. 2) Any defenses or counterclaims that have been brought by Dfts against TiVo with regard to claims 6, 20, 37, and 51 of US Patent No 6,233,389 are hereby DISMISSED WITH PREJUDICE. 3) Evidence of this dismissal shall not be admissible at trial . Signed by Judge David Folsom on 2/7/06. (mrm,) (Entered: 02/07/2006)

02/07/2006 451 ORDER regarding certain disputed exhibits. EchoStar's objections to TIVO's Nos. 1514, 1515, 1645,1683, 1698, 1703, 1705 and 1709 are sustained. Signed by Judge Caroline Craven on 2/7/06. (ehs,) (Entered: 02/08/2006)

02/08/2006 450 ORDER; ORDERS that each party will have 20 hours for case presentation, excluding time related to jury selection, opening statement, closing argument, and transition statements. Motions terminated: 409 MOTION for Reconsideration re 407 Order of December 21, 2005 filed by "EchoStar defendants",... Signed by Judge David Folsom on 2/7/06. (mrm,) (Entered: 02/08/2006)

02/08/2006 453 STATUS REPORT to Mag. Judge Craven by TIVO Inc, Echostar Satellite LLC, Echostar Communications Corporation, Echostar DBS Corporation, EchoStar Technologies Corporation, Echosphere Limited Liability Company. (Attachments: # 1 Text of Proposed Order Deposition Designations# 2 Text of Proposed Order Expert Reports)(Byrd, Christine) (Entered: 02/08/2006)

02/08/2006 454 RESPONSE to Motion re 437 MOTION for Reconsideration Concerning Section II C of the Court's February 2, 2006 Order filed by TIVO Inc. (Armond, Michelle) (Entered: 02/08/2006)

02/09/2006 455 ORDER Jury Selection set for 3/6/2006 09:00 AM in Ctrm 106 (Marshall) before Judge David Folsom. Jury Trial set for 3/27/2006 9:00 AM in Ctrm 106 (Marshall) before Judge David Folsom. Signed by Judge David Folsom on 2/9/06. (mrm,) (Entered: 02/09/2006)

02/09/2006 456 ***FILED IN ERROR; DEFICIENT DOCUMENT; EXCEEDS PAGE LIMIT; ATTORNEY MUST FILE MOTION FOR LEAVE TO EXCEED PAGE LIMIT*** REPLY to Response to Motion re 437 MOTION for Reconsideration Concerning Section II C of the Court's February 2, 2006 Order filed by "EchoStar defendants". (Attachments: # 1 Affidavit of Karl J. Kramer# 2 Exhibit A to Kramer Decl.)(Kramer, Karl) Modified on 2/9/2006 (mpv,). (Entered: 02/09/2006)

02/09/2006 -- NOTICE of Deficiency regarding the REPLY to Response to Motion re 437 MOTION for Reconsideration Concerning Section II C of the Court's February 2, 2006 Order submitted by "EchoStar defendants". Exceeds Page Limit. Correction should be made by 2/9/06 (mpv,) (Entered: 02/09/2006)

02/09/2006 457 ORDER on parties' objections to trial exhibits. Ruling set forth herein. Signed by Judge Caroline Craven on 2/9/06. (ehs,) (Entered: 02/09/2006)

02/09/2006 458 ORDER on deposition designations per hearing held before Judge Craven. Deadlines set for filing of documents. Court will hear arguments on any disputes on 2/27/06 at 10:00 am . Signed by Judge Caroline Craven on 2/9/06. (ehs,) (Entered: 02/09/2006)

02/09/2006 -- Set/Reset Hearings: Hearing set for 2/27/2006 10:00 AM before Magistrate Judge Caroline Craven. (ehs,) (Entered: 02/09/2006)

02/09/2006 459 MOTION for Leave to File Excess Pages to file EchoStar's Reply in Support of its Motion for Reconsideration Concerning Section II C of the Court's February 2, 2006 Order by "EchoStar defendants". (Attachments: # 1 Exhibit A PART 1# 2 Exhibit EXHIBIT A PART 2# 3 Exhibit A PART 3# 4 Text of Proposed Order)(Pickett, John) (Entered: 02/09/2006)

02/09/2006 460 Second Amended ANSWER to Amended Complaint Second Amended Complaint for Patent Infringement, COUNTERCLAIM for Declaratory Relief of Invalidity, Non-Infringement and Unenforceability by EchoStar Communications Corporation against TIVO Inc by Echostar Communications Corporation, Echostar DBS Corporation.(Kramer, Karl) (Entered: 02/09/2006)

02/09/2006 461 Second Amended ANSWER to Amended Complaint Second Amended Complaint for Patent Infringement, COUNTERCLAIM for Declaratory Relief of Invalidity, Non-Infringement and Unenforceability against TIVO Inc by Echostar Satellite LLC, EchoStar Technologies Corporation, Echosphere Limited Liability Company.(Kramer, Karl) (Entered: 02/09/2006)

02/10/2006 463 ORDER granting 459 Motion for Leave to Exceed Page Limit to file their Reply in Support of their Motion for Reconsideration . Signed by Judge David Folsom on 2/10/06. (mrm,) (Entered: 02/10/2006)

02/10/2006 464 REPLY in Support re 437 MOTION for Reconsideration Concerning Section II C of the Court's February 2, 2006 Order filed by "EchoStar defendants". (Attachments: # 1 Exhibit a# 2 Exhibit b)(mrm,) (Entered: 02/10/2006)

02/10/2006 465 ORDER vacating Section 2 C of 2/6/2006 Order re 437 Motion for Reconsideration and will allow the testimony of Dan Landreth at trial; MOTION for Reconsideration filed by "EchoStar defendants"; agreement that Echostar will not call Fred Tuck, . Signed by Judge David Folsom on February 10, 2006. (rml,) (Entered: 02/10/2006)

02/10/2006 466 ORDER denying [452] motion and setting briefing schedule;February 16th by 5 p.m. Deadline for TiVo to file an opening brief;the brief shall not exceed 15 pages.February 24th by 5 p.m. Deadline for EchoStar to file a response brief;the brief shall not exceed 15 pages.March 1st by 5 p.m. Deadline for TiVo to file a reply brief;the brief shall not exceed 5 pages.March 6th . Following the conclusion of jury selection, the parties will be heard on this issue; each party will have 20 minutes for argument. Signed by Judge David Folsom on February 10, 2006. (rml,) Modified on 2/10/2006 (rml,). (Entered: 02/10/2006)

02/13/2006 467 STATUS REPORT Joint Report on Remaining Disputed Objections to TiVo Exhibits by TIVO Inc, Echostar Satellite LLC, Echostar Communications Corporation, Echostar DBS Corporation, EchoStar Technologies Corporation, Echosphere Limited Liability Company. (Attachments: # 1 Exhibit Exhibit A# 2 Exhibit Exhibit B# 3 Text of Proposed Order Proposed Order)(Byrd, Christine) (Entered: 02/13/2006)

02/13/2006 484 APPLICATION to Appear Pro Hac Vice by Attorney Randall I Erickson for TIVO Inc. APPROVED (poa,) (Entered: 02/21/2006)

02/13/2006 -- Pro Hac Vice Filing fee paid by Erickson; Fee: \$25, receipt number: 2-1-1164 (poa,) (Entered: 02/21/2006)

02/13/2006 485 APPLICATION to Appear Pro Hac Vice by Attorney Steven P Rice for TIVO Inc.APPROVED (poa,) (Entered: 02/21/2006)

02/13/2006 -- Pro Hac Vice Filing fee paid by Rice; Fee: \$25, receipt number: 2-1-1165 (poa,) (Entered: 02/21/2006)

02/13/2006 486 APPLICATION to Appear Pro Hac Vice by Attorney R Scott Feldmann for TIVO Inc. APPROVED (poa,) (Entered: 02/21/2006)

02/13/2006 493 APPLICATION to Appear Pro Hac Vice by Attorney R Scott Feldmann for TIVO Inc.APPROVED (poa,) (Entered: 02/24/2006)

02/13/2006 -- Pro Hac Vice Filing fee paid by Feldmann; Fee: \$25, receipt number: 2-1-1166 (poa,) (Entered: 02/24/2006)

02/13/2006 494 APPLICATION to Appear,Pro Hac Vice by Attorney Van V Nguyen for TIVO Inc.APPROVED (poa,) (Entered: 02/24/2006)

02/13/2006 -- Pro Hac Vice Filing fee paid by Nguyen; Fee: \$25, receipt number: 2-1-1167 (poa,) (Entered: 02/24/2006)

02/14/2006 468 ORDER the courts 2/7/06 and 2/9/06 addressed two sets of objections that EchoStar raised to TiVos Trial Exhibits. The parties having to met and conferred on the remaining EchoStar objections, and having provided the Court with a list of the objection remaining in dispute the parties shall file briefs on these objections and exhibits on the following schedule as set forth

herein. Signed by Judge Caroline Craven on 2/14/06. (ch,) (Entered: 02/14/2006)

02/15/2006 473 ORDER sua sponte that the Court will hear any disputes on the depositions designations on 2/27/06 starting at 10:00 a.m. In order for the Court to prepare for the hearing, EchoStar shall provide to the Court on or before 2/24/06, in a format substantially similar to the one utilized by TiVo, copies of the deposition excerpts to be considered at the hearing. Signed by Judge Caroline Craven on 2/15/06. (poa,) (Entered: 02/16/2006)

02/16/2006 470 ***FILED IN ERROR; PLEASE IGNORE; INCORRECT DATE; WILL BE REFILED*** TRANSCRIPT of Proceedings/Hearing on Summary Judgment Motions held on 1/31/06 before Judge David Folsom. Court Reporter: Libby Crawford. (mpv,) Modified on 2/16/2006 (mpv,). (Entered: 02/16/2006)

02/16/2006 -- ***FILED IN ERROR. Document # 470, Transcript. PLEASE IGNORE. INCORRECT DATE; WILL BE REFILED*** (mpv,) (Entered: 02/16/2006)

02/16/2006 471 FILED IN ERROR; PLEASE IGNORE; INCORRECT DOCUMENT ATTACHED; SHOULD BE SEALED; ATTORNEY WILL CORRECT AND REFILE*** MOTION for Leave to File Excess Pages FOR TIVO'S REPLY IN SUPPORT OF ITS MOTION TO RECONSIDER THE COURT'S ORDER RE: ECHOSTAR'S MOTION IN LIMINE NO. 6 by TIVO Inc. (Attachments: # (1) Exhibit # (2) Text of Proposed Order)(Armond, Michelle) Additional attachment(s) added on 2/16/2006 (mpv,). Modified on 2/16/2006 (mpv,). (Entered: 02/16/2006)

02/16/2006 -- ***FILED IN ERROR. Document # 471, MOTION for Leave to File Excess Pages FOR TIVO'S REPLY IN SUPPORT OF ITS MOTION TO RECONSIDER THE COURT'S ORDER RE: ECHOSTAR'S MOTION IN LIMINE NO. 6 by TIVO Inc. PLEASE IGNORE. INCORRECT DOCUMENT; ATTORNEY WILL REFILE WITH CORRECT DOCUMENT; PREVIOUS DOCUMENT CONTAINED SEALED MATERIAL; NOW REMOVED FROM DOCKET*** (mpv,) (Entered: 02/16/2006)

02/16/2006 472 MOTION for Leave to File Excess Pages re TiVo's Reply In Support of Its Motion to Reconsider the Court's Order re EchoStar's Motion in Limine No. 6 (REPLACES #471) by TIVO Inc. (Attachments: # 1 Exhibit 1# 2 Text of Proposed Order)(Armond, Michelle) Modified on 2/16/2006 (mpv,). (Entered: 02/16/2006)

02/16/2006 474 NOTICE by TIVO Inc Brief in Opposition to Remaining Disputes Re: EchoStar Objections to TiVo's Trial Exhibits (Attachments: # 1 Exhibit Exhibits A-E)(Byrd, Christine) (Entered: 02/16/2006)

02/16/2006 475 NOTICE by TIVO Inc, Echostar Satellite LLC, Echostar Communications Corporation, Echostar DBS Corporation, EchoStar Technologies Corporation, Echosphere Limited Liability Company [Joint Proposed] Stipulation and Order on Objections to Third Party Documents As Trial Exhibits (Attachments: # 1 Exhibit Exhibit A)(Byrd, Christine) (Entered: 02/16/2006)

02/16/2006 481 TRANSCRIPT of Proceedings/Hearing on Summary Judgment Motions held on 1/31/06 before Judge David Folsom. Court Reporter: Libby Crawford. REPLACES #470 (mpv,) (Entered: 02/21/2006)

02/16/2006 482 TRANSCRIPT of Proceedings/Pretial Hearing/Deposition Designations and Exhibit Objections held on 1/31/06 before Judge Caroline M Craven. Court Reporter: Libby Crawford. (mpv,) (Entered: 02/21/2006)

02/17/2006 476 ORDER granting 472 Motion for Leave to File Excess Pages in TIVO's reply in support of motion to reconsider court order. Signed by Judge David Folsom on February 17, 2006. (rml,) (Entered: 02/17/2006)

02/17/2006 478 NOTICE by TIVO Inc of Reply in Support of TiVo's Motion to Reconsider the Court's Order re Echostar's Motion in Limine No. 6 [Docket #422] and for a Ruling on the Merits that the Preamble is a Limitation [Docket #452] (Attachments: # 1 Declaration)(Armond, Michelle) (Entered: 02/17/2006)

02/17/2006 480 NOTICE by TIVO Inc re 474 Notice (Other) of Errata In TiVo's Brief In Opposition To Remaining Disputes Re:EchoStar Objections to TiVo Trial Exhibits (Byrd, Christine) (Entered: 02/17/2006)

02/21/2006 483 REVISED ORDER; The Court hereby RESETS the expedited briefing schedule as follows: 2/22/06 by 5pm ddl for TiVo to file opening brief; 2/27/06 by 5pm ddl for EchoStar to file response brief; 3/1/06 by 5pm ddl for TiVo to file reply brief; 3/6/06 following the conclusion of jury selection the ptys will be heard on this issue; each pty will have 20 minutes for argument. Signed by Judge David Folsom on 2/21/06. (mrm,) (Entered: 02/21/2006)

02/21/2006 -- Set/Reset Hearings: Hearing set for 3/6/2006 after jury selection in Ctrm 106 (Marshall) before Judge David Folsom. (mrm,) (Entered: 02/21/2006)

02/22/2006 488 NOTICE by TIVO Inc re 483 Order, TiVo's Brief on Claim Construction of the Preamble (Attachments: # 1 Declaration)(Armond, Michelle) (Entered: 02/22/2006)

02/22/2006 489 NOTICE by "EchoStar defendants" Brief In Support of Objections to TiVo's Trial Exhibits

(Attachments: # 1 Exhibit A# 2 Exhibit B)(Kramer, Karl) (Entered: 02/22/2006)

02/22/2006 490 MOTION for Reconsideration of Magistrate Judge's Ruling on TiVo Trial Exhibits 1514, 1515, 1683, 1703, 1705, and 1709 by TIVO Inc. (Attachments: # 1 Text of Proposed Order Proposed Order# 2 Affidavit Declaration of Christine Byrd in Support of Motion to Reconsideration of Magistrate Judge's Ruling on TiVo Trial Exhibits# 3 Exhibit Exhibit A to Byrd Declaration# 4 Exhibit Exhibit B to Byrd Declaration# 5 Exhibit Exhibit C to Byrd Declaration# 6 Exhibit Exhibit D to Byrd Declaration# 7 Exhibit Exhibit E to Byrd Declaration# 8 Exhibit Exhibit F to Byrd Declaration# 9 Exhibit Exhibit G to Byrd Declaration# 10 Exhibit Exhibit H to Byrd Declaration# 11 Exhibit Exhibit I to Byrd Declaration# 12 Exhibit Exhibit J to Byrd Declaration# 13 Exhibit Exhibit K to Byrd Declaration# 14 Exhibit Exhibit L to Byrd Declaration# 15 Exhibit Exhibit M to Byrd Declaration# 16 Exhibit Exhibit N to Byrd Declaration# 17 Exhibit Exhibit O to Byrd Declaration# 18 Exhibit Exhibit P to Byrd Declaration)(Byrd, Christine) (Entered: 02/22/2006)

02/23/2006 492 ORDER re 475 Notice (Other) Joint Proposed] Stipulation and Order on Objections to Third Party Documents As Trial Exhibits . Signed by Judge Caroline Craven on 2/22/06. (mpv,) (Entered: 02/23/2006)

02/24/2006 495 NOTICE by "EchoStar defendants" of Lodging of EchoStar's Shortened Designated Deposition Testimony (Kramer, Karl) (Entered: 02/24/2006)

02/24/2006 496 Second Amended ANSWER to Counterclaim by EchoStar Communications Corp. by TIVO Inc(a Delaware corporation).(Hoffman, Adam) (Entered: 02/24/2006)

02/24/2006 497 Second Amended ANSWER to Counterclaim by EchoStar Technologies Corp., EchoSphere LLC, and EchStar Satellite LLC by TIVO Inc(a Delaware corporation).(Hoffman, Adam) (Entered: 02/24/2006)

02/27/2006 498 ***VACATED PER ORDER # 521 *** ORDER denying [469] Sealed Motion to Amend the Proposed Joint Pre-trial Order. Signed by Judge David Folsom on 2/27/06. (mrm,) Modified on 3/13/2006 (mrm,). (Entered: 02/27/2006)

02/27/2006 499 Minute Entry for proceedings held before Judge Caroline Craven : Hearing on Depo Designations and trial exhibits held on 2/27/2006. (Court Reporter Leslie Bates.) (lf,) (Entered: 02/27/2006)

02/28/2006 501 Minute Entry for proceedings held before Judge David Folsom : Telephone Conference held on 2/28/2006. (mrm,) (Entered: 03/01/2006)

03/01/2006 502 NOTICE by TIVO Inc re 483 Order, TiVo's Reply In Support of Its Brief on Claim Construction of the Preamble (Armond, Michelle) (Entered: 03/01/2006)

03/01/2006 503 ORDER regarding the parties' objections to deposition designations and exhibits, the Court issues the rulings as set forth herein. Signed by Judge Caroline Craven on 3/1/06. (ehs,) (Entered: 03/02/2006)

03/03/2006 504 MOTION for Leave to File a Surreply Brief In Support of the Court's Ruling on Motion in Limine No. 6 that the Preamble is Not a Limitation to the Claims by "EchoStar defendants". (Attachments: # 1 Text of Proposed Order)(Kramer, Karl) (Entered: 03/03/2006)

03/03/2006 505 MOTION for Reconsideration re 498 Order on Sealed Motion Denying Leave to Amend the Proposed Joint Pre-Trial Order by TIVO Inc. (Attachments: # 1 Declaration# 2 Exhibit A# 3 Exhibit B# 4 Exhibit C# 5 Text of Proposed Order)(Armond, Michelle) Additional attachment(s) added on 3/3/2006 (ch,). (Entered: 03/03/2006)

03/03/2006 506 NOTICE by TIVO Inc, "EchoStar defendants" of Filling of Joint Proposed Order on Deposition Designations Per Hearing Before Magistrate Judge Craven on February 27, 2006 (Attachments: # 1 Joint Proposed Order on Deposition Designations)(Kramer, Karl) (Entered: 03/03/2006)

03/06/2006 509 ORDER on Deposition Designations per Hearing before Magistrate Judge Craven on 2/27/06, ruling set forth herein . Signed by Judge Caroline Craven on 3/6/06. (ehs,) (Entered: 03/07/2006)

03/06/2006 510 Minute Entry for proceedings held before Judge David Folsom : Jury Selection and Hearing held on 3/6/2006. (mrm,) (Entered: 03/07/2006)

03/07/2006 511 ORDER; The Court hereby SETS an expedited briefing schedule as follows: 3/9th by 5pm ddl for Echostar to file a response, if any; 3/10th by 5pm ddl for TiVo to file a reply, if any. Signed by Judge David Folsom on 3/7/06. (mrm,) (Entered: 03/07/2006)

03/07/2006 512 ORDER GRANTING ECHOSTAR'S MOTION FOR LEAVE TO FILE A SURREPLY BRIEF IN SUPPORT OF THE COURT'S RULING ON MOTION IN LIMINE NO 6 THAT THE PREAMBLE IS NOT A LIMITATION TO THE CLAIMS; granting 504 Motion for Leave to File . Signed by Judge David Folsom on 3/7/06. (mrm,) (Entered: 03/07/2006)

03/07/2006 -- NOTICE TO PARTIES: The surreply referred to in ORDER # 512, was not filed because, it was not attached to the motion. It is the Ptys responsibility to file their Surreply. (mrm,) (Entered: 03/07/2006)

03/07/2006)

03/09/2006 515 TRANSCRIPT of Motion Hearing held on March 6, 2006 at 2:45 pm before Judge David Folsom. Court Reporter: Susan Simmons. (ehs,) (Entered: 03/09/2006)

03/09/2006 516 ORDER denying 490 Motion for Reconsideration of Magistrate Judge's Ruling on TiVo Trial Exhibits 1516, 1515, 1683, 1703, 1705, 1709 . Signed by Judge Caroline Craven on 3/9/06. (ehs,) (Entered: 03/09/2006)

03/10/2006 517 ***FILED IN ERROR; PLEASE IGNORE; COURT WILL REDOCKET SINCE OPPOSITION SHOULD HAVE BEEN FILE PRIOR TO THIS DOCUMENT*** RESPONSE in Support re 505 MOTION for Reconsideration re 498 Order on Sealed Motion Denying Leave to Amend the Proposed Joint Pre-Trial Order filed by TIVO Inc. (Armond, Michelle) Modified on 3/13/2006 (mpv,). (Entered: 03/10/2006)

03/10/2006 -- ***FILED IN ERROR. DOCKETED INCORRECTLY DUE TO CLERICAL ERROR BY COURT Document # 517, RESPONSE in Support re 505 MOTION for Reconsideration re 498 Order on Sealed Motion Denying Leave to Amend the Proposed Joint Pre-Trial Order. PLEASE IGNORE. Court will refile *** (mpv,) (Entered: 03/13/2006)

03/10/2006 519 REPLY to Response to Motion re 505 MOTION for Reconsideration re 498 Order on Sealed Motion Denying Leave to Amend the Proposed Joint Pre-Trial Order filed by TIVO Inc. (mpv,) (Entered: 03/13/2006)

03/13/2006 520 ORDER; The Court finds that the preambles to the asserted claims of the '389 patent are not limitations . Signed by Judge David Folsom on 3/13/06. (mrm,) (Entered: 03/13/2006)

03/13/2006 521 ORDER, granting 505 MOTION for Reconsideration re 498 Order on Sealed Motion Denying Leave to Amend the Proposed Joint Pre-Trial Order filed by TIVO Inc. Accordingly, it is further ORDERED that the Court's 2/27/06 Order is VACATED and TiVo's Motion for Leave to Amend the Proposed Joint Pretrial Order [469] is GRANTED. Proposed Pretrial Order due by 3/24/2006 at 5pm. Ptys shall provide supplemental expert reports directed exclusively to dependent claims 5 and 36 by 3/20/06 at 5pm. Each pty shall have 5 additional hrs of deposition to depose respective experts. Depositions shall be completed prior to trial; Ptys shall confer by 3/15/06 to discuss issues of claim construction re: claims 5 and 36. Ptys shall have until 3/20/06 by 5pm to file Markman Briefs and until 3/22/06 by 5pm to respond. Both initial and responses shall be limited to 5 pgs. Signed by Judge David Folsom on 3/13/06. (mrm,) (Entered: 03/13/2006)

03/13/2006 522 ***FILED IN ERROR; PLEASE IGNORE; DOCUMENT SHOULD HAVE BEEN FILED UNDER SEAL; DOCUMENT MOTION REFERS TO HAS NOT BEEN FILED*** MOTION to Expedite Briefing on EchoStar's Motion to Exclude or Strike Dr. Ugone's New Market Share Analysis Disclosed for the First Time on March 10, 2006 by "EchoStar defendants". (Kramer, Karl) Modified on 3/14/2006 (mpv,). (Entered: 03/13/2006)

03/13/2006 523 ***FILED IN ERROR; DEFICIENT DOCUMENT; NO CERTIFICATE OF CONFERENCE; ATTY MUST REFILE; PLEASE IGNORE*** MOTION for Reconsideration of Magistrate Judge's Ruling on TiVo Exhibit 1656 by TIVO Inc. (Attachments: # 1 Exhibit A# 2 Text of Proposed Order Proposed Order)(Byrd, Christine) Modified on 3/14/2006 (mpv,). (Entered: 03/13/2006)

03/13/2006 -- ***FILED IN ERROR. Document # 522, MOTION to Expedite Briefing on EchoStar's Motion to Exclude or Strike Dr. Ugone's New Market Share Analysis Disclosed for the First Time on March 10, 2006. SHOULD HAVE BEEN FILED UNDER SEAL AFTER THE MOTION TO STRIKE IS FILED: PLEASE IGNORE.*** (mpv,) (Entered: 03/14/2006)

03/13/2006 -- NOTICE of Deficiency regarding the #523 MOTION for Reconsideration of Magistrate Judge's Ruling on TiVo Exhibit 1656 submitted by TIVO Inc. No Certificate of Conference. Correction should be made by 3/15/06 (mpv,) (Entered: 03/14/2006)

03/14/2006 524 ***FILED IN ERROR; PLEASE IGNORE; DOCUMENT SHOULD HAVE BEEN FILED UNDER SEAL; WILL BE REFILED*** RESPONSE to Motion re 522 MOTION to Expedite Briefing on EchoStar's Motion to Exclude or Strike Dr. Ugone's New Market Share Analysis Disclosed for the First Time on March 10, 2006 filed by TIVO Inc.(Byrd, Christine) Modified on 3/14/2006 (mpv,). (Entered: 03/14/2006)

03/14/2006 -- ***FILED IN ERROR. Document # 524, RESPONSE to Motion re 522 MOTION to Expedite Briefing on EchoStar's Motion to Exclude or Strike Dr. Ugone's New Market Share Analysis Disclosed for the First Time on March 10, 2006. SHOULD BE FILED UNDER SEAL AFTER MOTION TO STRIKE AND MOTION FOR EXPEDITED BRIEFING IS FILED; PLEASE IGNORE.*** (mpv,) (Entered: 03/14/2006)

03/15/2006 528 ORDER denying [190] Motion for Partial Summary Judgment of No Willful Infringement. Signed by Judge David Folsom on 3/15/06. (mrm,) (Entered: 03/15/2006)

03/15/2006 529 ORDER denying [228] Motion for Partial Summary Judgment of Infringement of Claims 1 and 32 . Signed by Judge David Folsom on 3/15/06. (mrm,) (Entered: 03/15/2006)

03/15/2006 530 ORDER denying 214 Motion for Partial Summary Judgment of Non-Infringement and denying [271] TiVo's Cross Motion for Partial Summary Judgment of Infringement . Signed by Judge David Folsom on 3/15/06. (mrm,) (Entered: 03/15/2006)

03/15/2006 532 MOTION for Reconsideration replacing document #523 by TIVO Inc. (Attachments: # 1 Exhibit Exhibit A# 2 Text of Proposed Order Proposed Order)(Byrd, Christine) (Entered: 03/15/2006)

03/15/2006 533 MOTION to Continue the Trial by "EchoStar defendants". (Attachments: # 1 Text of Proposed Order)(McElhinny, Harold) (Entered: 03/15/2006)

03/15/2006 534 MOTION for Additional Time at Trial by "EchoStar defendants". (Attachments: # 1 Text of Proposed Order)(McElhinny, Harold) (Entered: 03/15/2006)

03/16/2006 536 ORDER denying 136 Motion for Partial Summary Judgment of Non-Infringement: (1) No Infringement by EchoStar's 7100/7200 Devices; and (2) No Infringement Under the Doctrine of Equivalents . Signed by Judge David Folsom on 3/16/06. (mrm,) (Entered: 03/16/2006)

03/16/2006 537 ORDER re 533 MOTION to Continue the Trial filed by "EchoStar defendants", The Court hereby SETS the following expedited briefing schedule on this motion: 3/17/06 ddl for TiVo to file a response; 3/21/06 ddl for EchoStar to file a reply. Signed by Judge David Folsom on 3/16/06. (mrm,) (Entered: 03/16/2006)

03/16/2006 538 ORDER re 534 MOTION for Additional Time at Trial filed by "EchoStar defendants", The Court hereby SETS the following expedited briefing schedule on this motion: 3/17/06 ddl for TiVo to file a response; 3/21/06 ddl for EchoStar to file a reply. Signed by Judge David Folsom on 3/16/06. (mrm,) (Entered: 03/16/2006)

03/16/2006 539 ORDER re [527] SEALED MOTION filed by "EchoStar defendants",, [525] SEALED MOTION filed by "EchoStar defendants", The Court hereby SETS the following expedited briefing schedule on EchoStar's Motion to Exclude or Strike Dr. Ugone's New Market Share Analysis Disclosed for the First Time on 3/10/06: 3/17/06 ddl for TiVo to file a response; 3/21/06 ddl for EchoStar to file a reply. Signed by Judge David Folsom on 3/16/06. (mrm,) (Entered: 03/16/2006)

03/16/2006 540 NOTICE by TIVO Inc, Echostar Satellite LLC, Echostar Communications Corporation, Echostar DBS Corporation, EchoStar Technologies Corporation, Echosphere Limited Liability Company [Joint Proposed] Order on Objections to TiVo's Trial Exhibits (Attachments: # 1 Exhibit A) (Hoffman, Adam)(OK Per Judge) Modified on 3/17/2006 (mpv,). (Entered: 03/16/2006)

03/17/2006 541 ORDER re 540 Notice (Other), Notice (Other) filed by TIVO Inc,, Echostar Communications Corporation,, Echostar DBS Corporation,, EchoStar Technologies Corporation,, Echosphere Limited Liability Company,, Echostar Satellite LLC,. Based upon the Magistrate Judge's comments and rulings, and upon further meeting and conferring, the parties agree that the attached Exhibit List (Attached to #540) reflects Judge Craven's decisions on EchoStar's objections to TiVo's trial exhibits. In order to allow the parties to seek reconsideration of particular rulings pursuant to Appendix B of the Local Rules, the parties jointly request that this Order be entered without prejudice to the parties' positions on the rulings contained therein. Signed by Judge Caroline Craven on 3/17/06. (mpv,) (Entered: 03/17/2006)

03/17/2006 542 TRANSCRIPT of Jury Voir Dire Proceedings held on 3/6/06 @ 10:00 a.m. In Marshall, Tx before Honorable Judge David Folsom. Court Reporter: Susan Simmons & Judith Werlinger. (150 pages) (ch,) (Entered: 03/17/2006)

03/17/2006 543 RESPONSE in Opposition re 533 MOTION to Continue the Trial filed by TIVO Inc. (Armond, Michelle) (Entered: 03/17/2006)

03/17/2006 544 RESPONSE in Opposition re 534 MOTION for Additional Time at Trial filed by TIVO Inc. (Armond, Michelle) (Entered: 03/17/2006)

03/20/2006 546 ORDER granting 534 Motion for Additional Time at Trial; The Court hereby ORDERS that ea pty will have 22 hours for case presentation, excluding time related to jury selection, opening statement, closing argument, and transition statements , Signed by Judge David Folsom on 3/20/06. (mrm,) (Entered: 03/20/2006)

03/20/2006 547 ***MISSING SIGNATURE PAGE. SEE CORRECTED ORDER # 569***/b>

 ORDER re 533 Motion to Continue; ORDERS the trial schedule MODIFIED so that opening statements and the presentation of evidence is to commence on WEDNESDAY, 3/29/06 at 9:00 am. Signed by Judge David Folsom on 3/20/06. (mrm,) Modified on 3/23/2006 (mrm,). (Entered: 03/20/2006)

03/20/2006 548 ORDER that the Court has review the parties' positions and declines to claify 457 Order. The February 9, 2006 Order on Objections to Expert Reports as Trial Exhibits remains in effect.. Signed by Judge Caroline Craven on 3/20/06. (poa,) (Entered: 03/20/2006)

03/20/2006 549 SEALED PATENT DOCUMENT EchoStar's Opening Claim Construction Brief Regarding Claims 5 and 36. (Attachments: # (1) Affidavit of Nathaniel Polish and Exhibit 1# (2) Affidavit of Karl J.

Kramer# (3) Exhibit A to Kramer Decl.# (4) Exhibit B to Kramer Decl.# (5) Exhibit C to Kramer Decl.# (6) Exhibit D to Kramer Decl.# (7) Exhibit E to Kramer Decl.# (8) Exhibit F to Kramer Decl.)(Kramer, Karl) (Entered: 03/20/2006)

03/20/2006 550 NOTICE by TIVO Inc re 521 Order,,,, Terminate Motions,,,, Set Scheduling Order Deadlines,,,, TiVo's Brief on Claim Construction of Claims 5 and 36 (Attachments: # 1 Declaration# 2 Exhibit A# 3 Exhibit B# 4 Exhibit C)(Armond, Michelle) (Entered: 03/20/2006)

03/20/2006 551 SEALED PATENT DOCUMENT EchoStar's Reply In Support of Motion to Exclude or Strike Dr. Ugone's New Market Share Analysis Disclosed for the First Time on March 10, 2006. (Kramer, Karl) (Entered: 03/20/2006)

03/20/2006 552 SEALED PATENT DOCUMENT TiVo's Opposition to EchoStar's Motion to Exclude Undisclosed Expert Testimony By Lay Witnesses and Expert Testimony Based Thereon. (Attachments: # (1) Affidavit Declaration of Christine Byrd in Support of TiVo's Opposition to EchoStar's Motion to Exclude Undisclosed Testimony By Lay Witnesses and Expert Testimony Based Thereon# (2) Exhibit A to Byrd Declaration# (3) Exhibit B to Byrd Declaration# (4) Exhibit C to Byrd Declaration# (5) Exhibit D to Byrd Declaration# (6) Exhibit E to Byrd Declaration)(Byrd, Christine) (Entered: 03/20/2006)

03/20/2006 553 MOTION for Reconsideration of Magistrate Judge's Ruling on Admissibility of Exhibits on TiVo's Products by TIVO Inc. (Attachments: # 1 Affidavit Declaration of Christine Byrd In Support of TiVo's Motion for Reconsideration of Magistrate Judge's Ruling on Admissibility of Exhibits on TiVo's Products# 2 Exhibit A to Byrd Declaration# 3 Exhibit B to Byrd Declaration# 4 Exhibit C to Byrd Declaration# 5 Exhibit D to Byrd Declaration# 6 Exhibit E to Byrd Declaration# 7 Exhibit F to Byrd Declaration# 8 Exhibit G to Byrd Declaration# 9 Exhibit H to Byrd Declaration# 10 Exhibit I to Byrd Declaration# 11 Exhibit J to Byrd Declaration# 12 Exhibit K to the Byrd Declaration# 13 Exhibit L to the Byrd Declaration)(Byrd, Christine) Additional attachment(s) added on 3/21/2006 (sm,). (Entered: 03/20/2006)

03/20/2006 554 FILED IN ERROR - PLEASE IGNORE - Additional Attachments to Main Document: 553 MOTION for Reconsideration of Magistrate Judge's Ruling on Admissibility of Exhibits on TIVO's Products. (Byrd, Christine) Modified on 3/21/2006 (sm,). (Entered: 03/20/2006)

03/20/2006 -- ***FILED IN ERROR, PLEASE IGNORE, (DOCUMENT IS REALLY A PROPOSED ORDER TO #553). Document # 554, Additional Attachment. PLEASE IGNORE.*** (sm,) Modified on 3/22/2006 (mpv,). (Entered: 03/21/2006)

03/20/2006 569 ***REPLACES ORDER # 547 IT WAS MISSING THE SIGNATURE PAGE*** ORDER re 533 Motion to Continue; ORDERS the trial schedule MODIFIED so that opening statements and the presentation of evidence is to commence on WEDNESDAY, 3/29/06 at 9:00 am. . Signed by Judge David Folsom on 3/23/06. (mrm,) (Entered: 03/23/2006)

03/21/2006 555 ORDER OUTLINING COURTROOM PROCEDURES. Signed by Judge David Folsom on 3/21/06. (mrm,) (Entered: 03/21/2006)

03/21/2006 556 ORDER; The Court attaches hereto as Exhibit "A" its Proposed Preliminary Jury Instructions. Any comments on these instructions should be made by letter submitted to the Court and opposing counsel no later than Friday, 3/24/06 at 5pm . Signed by Judge David Folsom on 3/21/06. (Attachments: # 1 Exhibit A) Proposed Preliminary Jury Instructions)(mrm,) (Entered: 03/21/2006)

03/21/2006 557 NOTICE by "EchoStar defendants" of Lodging of EchoStar's Amended Proposed Jury Notebook (Attachments: # 1 Exhibit A)(Krevans, Rachel) (Entered: 03/21/2006)

03/21/2006 558 ORDER REGARDING JURY NOTEBOOKS. Signed by Judge David Folsom on 3/21/06. (mrm,) (Entered: 03/21/2006)

03/22/2006 560 ORDER granting [514] Sealed Motion for Leave to File in Excess of Page Limit TiVo's Brief in Opposition to EchoStar's Motion for Reconsideration of the Magistrate Judge's Order of 2/7/06. Signed by Judge David Folsom on 3/22/06. (mrm,) (Entered: 03/22/2006)

03/22/2006 561 SEALED PATENT DOCUMENT; TIVO'S BRIEF IN OPPOSITION TO ECHOSTAR'S MOTION FOR RECONSIDERATION OF THE MAGISTRATE JUDGE'S ORDER OF FEBRUARY 7, 2006. (Attachments: # (1) Exhibit A# (2) Exhibit B# (3) Exhibit C# (4) Exhibit D# (5) Exhibit E# (6) Exhibit F# (7) Exhibit G# (8) Exhibit H# (9) Exhibit I# (10) Exhibit J# (11) Exhibit K# (12) Exhibit L Part 1# (13) Exhibit L Part 2# (14) Exhibit L Part 3# (15) Exhibit L Part 4# (16) Exhibit M# (17) Exhibit N# (18) Exhibit O# (19) Exhibit P)(mrm,) (Entered: 03/22/2006)

03/22/2006 562 ORDER re: courtesy copies. Signed by Judge David Folsom on 3/22/06. (mrm,) (Entered: 03/22/2006)

03/22/2006 563 ORDER granting [535] Sealed Motion to Exceed Page Limit to file their Reply Brief in Support of its Motion for Reconsideration by the District Judge of the Magistrate Judge's Order of February 7, 2006. Signed by Judge David Folsom on 3/22/06. (mrm,) (Entered: 03/22/2006)

03/22/2006 564 SEALED PATENT DOCUMENT; ECHOSTAR'S REPLY BRIEF IN SUPPORT OF ITS MOTION FOR RECONSIDERATION BY THE DISTRICT JUDGE OF THE MAGISTRATE JUDGE'S ORDER OF FEBRUARY 7,2006 (mrm,) (Entered: 03/22/2006)

03/22/2006 565 NOTICE by TIVO Inc TiVo's Sur-Reply to EchoStar's Motion to Exclude or Strike Dr. Ugone's Market Share Analysis (Armond, Michelle) (Entered: 03/22/2006)

03/22/2006 566 ***FILED IN ERROR; DEFICIENT DOCUMENT; ATTORNEY MUST REFILE; PLEASE IGNORE*** SEALED PATENT MOTION EchoStar's Motion for Leave to File a Surreply Brief in Support of Its Motion for Reconsideration by the District Judge of the Magistrate Judge's Order of February 7, 2006 by "EchoStar defendants". (Attachments: # (1) Exhibit A)(Kramer, Karl) Modified on 3/23/2006 (mpv,). (Entered: 03/22/2006)

03/22/2006 567 SEALED PATENT RESPONSE by "EchoStar defendants" to 550 Notice (Other), Notice (Other) EchoStar's Responsive Claim Construction Brief Regarding Claims 5 and 36. (Attachments: # (1) Affidavit of Karl J. Kramer and Exhibit A)(Kramer, Karl) (Entered: 03/22/2006)

03/22/2006 568 SEALED PATENT DOCUMENT TIVO'S REPLY BRIEF ON CLAIM CONSTRUCTION OF CLAIMS 5 AND 36. (Attachments: # (1) Declaration# (2) Exhibit # (3) Declaration# (4) Exhibit)(Armond, Michelle) (Entered: 03/22/2006)

03/22/2006 -- NOTICE of Deficiency regarding #566 SEALED PATENT MOTION EchoStar's Motion for Leave to File a Surreply Brief in Support of Its Motion for Reconsideration by the District Judge of the Magistrate Judge's Order of February 7, 2006 submitted Sealed document attached to motion for leave to file, under new procedures as of 3/22/06 cannot be filed. Atty must refile.. Correction should be made by one business day. (mpv,) (Entered: 03/23/2006)

03/23/2006 570 ORDER denying [182] Motion for Partial Summary Judgment re: Damages Period . Signed by Judge David Folsom on 3/23/06. (mrm,) (Entered: 03/23/2006)

03/23/2006 571 ORDER sua sponte re [508] SEALED MOTION filed by "EchoStar defendants". The deadline to file a reply on this motion is 3/27/06 at 1:00 p.m. CST . Signed by Judge David Folsom on 3/23/06. (mpv,) (Entered: 03/23/2006)

03/23/2006 572 ORDER re 532 MOTION for Reconsideration replacing document #523 filed by TIVO Inc. To protect Its Position RE: Magistrate Judge's Ruling on RIVo Exhibit 1656, Dkt # 532. It is hereby ORDERED: The RESPONSE is due on 3/27/06 at 1:00 p.m. CST. The REPLY is due on 3/28/06 at 1:00 p.m. CST. Signed by Judge David Folsom on 3/23/06. (mpv,) (Entered: 03/23/2006)

03/23/2006 573 ORDER sua sponte re 553 MOTION for Reconsideration of Magistrate Judge's Ruling on Admissibility of Exhibits on TiVo's Products filed by TIVO Inc. It is hereby ORDERED: The RESPONSE is due on 3/27/06 at 1:00 p.m. CST. The REPLY is due on 3/28/06 at 1:00 p.m. CST. Signed by Judge David Folsom on 3/23/06. (mpv,) (Entered: 03/23/2006)

03/23/2006 574 MOTION for Leave to File a Surreply Brief In Support of Its Motion for Reconsideration by the District Judge of the Magistrate Judge's Order of February 7, 2006 by "EchoStar defendants". (Attachments: # 1 Text of Proposed Order)(Kramer, Karl) (Entered: 03/23/2006)

03/23/2006 576 Proposed Pretrial Order (Amended) by TIVO Inc, Echostar Satellite LLC, Echostar Communications Corporation, Echostar DBS Corporation, EchoStar Technologies Corporation, Echosphere Limited Liability Company. (Attachments: # 1 Exhibit A: TiVo's Contentions# 2 Exhibit B: EchoStar's Contentions# 3 Exhibit C: TiVo's Witness List# 4 Exhibit D: EchoStar's Witness List# 5 Exhibit E: EchoStar's Objections to TiVo's Witness List# 6 Exhibit F: TiVo's Objections to EchoStar's Exhibit List# 7 Exhibit G: TiVo Exhibit List# 8 Exhibit H: EchoStar's Exhibit List# 9 Exhibit I: TiVo Deposition Designations# 10 Exhibit J: EchoStar's Deposition Designations)(Byrd, Christine) (Entered: 03/23/2006)

03/24/2006 577 ORDER denying 189 Motion for Partial Summary Judgment of Invalidity Due to Indefiniteness. Signed by Judge David Folsom on 3/24/06. (mrm,) (Entered: 03/24/2006)

03/24/2006 578 ORDER GRANTING ECHOSTAR'S UNOPPOSED MOTION FOR LEAVE TO FILE A SURREPLY BRIEF IN SUPPORT OF ITS MOTION FOR RECONSIDERATION BY THE DISTRICT JUDGE OF THE MAGISTRATE JUDGE'S ORDER OF FEBRUARY 7, 2006; granting 574 Motion for Leave to File . Signed by Judge David Folsom on 3/24/06. (mrm,) (Entered: 03/24/2006)

03/24/2006 579 JOINT FINAL PRETRIAL ORDER. Signed by Judge David Folsom on 3/24/06. (Attachments: # 1 Exhibit A) TiVo's Contentions# (2) Exhibit B) (Corrected) EchoStar's Contentions# 3 Exhibit C) TiVo's Witness List# (4) Exhibit D) (Corrected)EchoStar's Witness List# 5 Exhibit E) Objections to TiVo's Witness List# 6 Exhibit F) Objections to EchoStar's Witness List# 7 Exhibit G) TiVo's Exhibit List# (8) Exhibit H) EchoStar's Exhibit List# 9 Exhibit I) TiVo's Deposition Designations# 10 Exhibit J) EchoStar's Deposition Designations)(mrm,) Additional attachment(s) added on 3/27/2006 (mrm,). Modified on 3/27/2006 (mrm,). Additional attachment(s) added on 3/28/2006 (mrm,). Additional attachment(s) added on 3/28/2006 (mrm,). (Entered: 03/24/2006)

03/24/2006 580 MOTION to Exclude The Testimony of Defendats' Witness Homer Knearl And All Reference To His Opinion Work by TIVO Inc. (Attachments: # 1 Declaration# 2 Exhibit F# 3 Exhibit B# 4 Exhibit C# 5 Exhibit D# 6 Exhibit E# 7 Exhibit F# 8 Exhibit G# 9 Text of Proposed Order)(Armond, Michelle) (Entered: 03/24/2006)

03/24/2006 581 ORDER re [575] SEALED PATENT MOTION for Reconsideration by the District Judge of the Magistrate Judge's Order of March 17, 2006 filed by "EchoStar defendants"; ORDERED: RESPONSE is due on Monday, 3/27/06 at 5pm cst; REPLY is due on Tuesday, 3/28/06 at 1pm cst. Signed by Judge David Folsom on 3/24/06. (mrm,) (Entered: 03/24/2006)

03/24/2006 582 ORDER OF CLARIFICATION; re: jury notebooks. Signed by Judge David Folsom on 3/24/06. (Attachments: # 1 Exhibit A)(mrm,) (Entered: 03/24/2006)

03/24/2006 583 SUPPLEMENTAL CLAIM CONSTRUCTION ORDER . Signed by Judge David Folsom on 3/24/06. (mrm,) (Entered: 03/24/2006)

03/24/2006 584 SEALED PATENT DOCUMENT - EchoStar's Surreply Brief in Support of its Motion for Reconsideration by the District Judge of the Magistrate Judge's Order of February 7, 2006. (Pickett, John) (Entered: 03/24/2006)

03/26/2006 585 Consent MOTION to Amend/Correct 576 Proposed Pretrial Order,, Exhibits B and D by "EchoStar defendants". (Attachments: # 1 Exhibit B# 2 Exhibit D# 3 Text of Proposed Order)(Kramer, Karl) (Entered: 03/26/2006)

03/27/2006 586 MOTION to Exclude Testimony of V. Thomas Rhyne Regarding Claims 5 and 36 by TIVO Inc. (Attachments: # 1 Declaration# 2 Exhibit A# 3 Exhibit B# 4 Text of Proposed Order)(Armond, Michelle) (Entered: 03/27/2006)

03/27/2006 587 SEALED PATENT DOCUMENT Notice of Filing of Letter Brief with Magistrate Judge Craven. (Attachments: # (1) Exhibit Letter Brief to Magistrate Re EchoStar Request for Better Copies of Documents# (2) Exhibit EchoStar Trial Exhibit 788# (3) Exhibit EchoStar Trial Exhibit 2888# (4) Exhibit EchoStar Trial Exhibit 1840# (5) Exhibit 3/23/06 E-Mail to Counsel)(Byrd, Christine) (Entered: 03/27/2006)

03/27/2006 588 Consent MOTION for Leave to File Excess Pages to EchoStar's Reply Re Motion to Exclude Undisclosed Expert Opinion Testimony By Lay Witnesses and Expert Testimony Based Thereon by "EchoStar defendants". (Attachments: # 1 Text of Proposed Order)(Kramer, Karl) (Entered: 03/27/2006)

03/27/2006 589 RESPONSE to Motion re 532 MOTION for Reconsideration replacing document #523 filed by "EchoStar defendants". (Kramer, Karl) (Entered: 03/27/2006)

03/27/2006 590 SEALED PATENT RESPONSE to SEALED PATENT MOTION re 553 MOTION for Reconsideration of Magistrate Judge's Ruling on Admissibility of Exhibits on TIVO's Products filed by "EchoStar defendants". (Attachments: # (1) Affidavit of Karl J. Kramer# (2) Exhibit A# (3) Exhibit B# (4) Exhibit C# (5) Exhibit D)(Kramer, Karl) (Entered: 03/27/2006)

03/27/2006 591 SEALED PATENT DOCUMENT EchoStar's Reply Re Motion to Exclude Undisclosed Expert Opinion Testimony By Lay Witnesses and Expert Testimony Based Thereon. (Attachments: # (1) Affidavit of Karl J. Kramer# (2) Exhibit A)(Kramer, Karl) (Entered: 03/27/2006)

03/27/2006 592 Proposed Jury Instructions by "EchoStar defendants". (Attachments: # 1 Exhibit D-Jury Instructions# 2 Exhibit F-Verdict Form)(Kramer, Karl) (Entered: 03/27/2006)

03/27/2006 593 Consent MOTION to Amend/Correct 585 Consent MOTION to Amend/Correct 576 Proposed Pretrial Order,, Exhibits B and D by "EchoStar defendants". (Attachments: # 1 Exhibit D# 2 Text of Proposed Order)(Kramer, Karl) (Entered: 03/27/2006)

03/27/2006 594 ORDER GRANTING ECHOSTAR'S UNOPPOSED MOTION TO CORRECT EXHIBITS B AND D TO THE JOINT FINAL PRE-TRIAL ORDER; granting 585 Motion to Amend/Correct . Signed by Judge David Folsom on 3/27/06. (mrm,) (Entered: 03/27/2006)

03/27/2006 -- NOTICE of docket correction; 579 Joint Final Pre-trial Order corrected as per order # 594, exhibits B and D substituted (mrm,) (Entered: 03/27/2006)

03/27/2006 595 ORDER; EchoStar is hereby ORDERED to submit to the Court a copy of Exhibit No. 3490 and of Exhibit No. 3497 no later than TUESDAY, MARCH 28th at 1pm . Signed by Judge David Folsom on 3/27/06. (mrm,) (Entered: 03/27/2006)

03/27/2006 596 ORDER re 580 MOTION to Exclude The Testimony of Defendats' Witness Homer Knearl And All Reference To His Opinion Work filed by TIVO Inc, ORDERED: RESPONSE is due on FRIDAY, 3/31/06 and the REPLY is due on MONDAY, 4/3/06 at 1pm . Signed by Judge David Folsom on 3/27/06. (mrm,) (Entered: 03/27/2006)

03/27/2006 597 ORDER re 586 MOTION to Exclude Testimony of V. Thomas Rhyne Regarding Claims 5 and 36 filed by TIVO Inc, ORDERED: RESPONSE is due on Friday, 3/31 and REPLY is due on Monday,

4/3/06 at 1pm . Signed by Judge David Folsom on 3/27/06. (mrm,) (Entered: 03/27/2006)

03/27/2006 598 ORDER granting [559] Sealed Motion for Leave to File a Surreply Brief in Opposition to EchoStar's Motion for Reconsideration of the Magistrate Judge's Order of 2/7/06. Signed by Judge David Folsom on 3/27/06. (mrm,) (Entered: 03/27/2006)

03/27/2006 599 SEALED PATENT DOCUMENT, TIVO'S SURREPLY IN OPPOSITION TO ECHOSTAR'S MOTION FOR RECONSIDERATION OF THE MAGISTRATE JUDGE'S ORDER OF 2/7/06; re [487] SEALED MOTION for Reconsideration of the Magistrate Judge's Order of 2/7/06 filed by TIVO Inc. (mrm,) Modified on 3/28/2006 (mrm,). (Entered: 03/27/2006)

03/27/2006 600 SEALED PATENT RESPONSE to SEALED PATENT MOTION re 580 MOTION to Exclude The Testimony of Defendats' Witness Homer Knearl And All Reference To His Opinion Work filed by "EchoStar defendants". (Attachments: # (1) Affidavit of Alison M. Tucher# (2) Exhibit A-F) (Tucher, Alison) (Entered: 03/27/2006)

03/27/2006 601 NOTICE by "EchoStar defendants" Regarding EchoStar Trial Exhibit Nos. 3490 and 3497 (Attachments: # 1 Exhibit A# 2 Exhibit B)(Kramer, Karl) (Entered: 03/27/2006)

03/27/2006 602 SEALED PATENT DOCUMENT TIVo Opposition to EchoStar Motion for Reconsideration By the District Judge of the Magistrate's Order of March 17, 2006. (Attachments: # (1) Affidavit Hoffman Declaration in Support of TIVo Opposition# (2) Exhibit A# (3) Exhibit B# (4) Exhibit C# (5) Exhibit D# (6) Exhibit E# (7) Exhibit F)(Byrd, Christine) Certificate of Authorization to File Sealed Document added on 3/30/2006 (mpv,). Modified on 3/30/2006 (mpv,). (Entered: 03/27/2006)

03/27/2006 603 NOTICE by "EchoStar defendants" of Filing of Letter Brief to Magistrate Judge Craven (Kramer, Karl) (Entered: 03/27/2006)

03/28/2006 604 NOTICE by "EchoStar defendants" of Filing of Letter Brief to Magistrate Judge Craven (Kramer, Karl) (Entered: 03/28/2006)

03/28/2006 605 RESPONSE in Support re 580 MOTION to Exclude The Testimony of Defendats' Witness Homer Knearl And All Reference To His Opinion Work filed by TIVO Inc. (Attachments: # 1 Declaration# 2 Exhibit H)(Armond, Michelle) (Entered: 03/28/2006)

03/28/2006 606 ORDER granting 588 Motion to Exceed Page Limit to file their Reply Re Motion to Exclude Undisclosed Expert Opinion Testimony by Lay Witnesses and Expert Testimony Based Thereon. Signed by Judge David Folsom on 3/28/06. (Reply is already on file as dkt # [591], was filed prior to order being granted) (mrm,) (Entered: 03/28/2006)

03/28/2006 607 ORDER granting 593 Motion to Correct Exhibit D to the Joint Final Pre-trial Order. Signed by Judge David Folsom on 3/28/06. (mrm,) (Entered: 03/28/2006)

03/28/2006 -- NOTICE OF DOCKET CORRECTION: Exhibit D to Document # 579, Final Pre-trial Order, substituted as per order # 607. (mrm,) (Entered: 03/28/2006)

03/28/2006 608 Proposed Jury Instructions by TIVO Inc. (Byrd, Christine) (Entered: 03/28/2006)

03/28/2006 609 SEALED PATENT DOCUMENT EchoStar's Reply Brief In Support of its Motion for Reconsideration by the District Judge of the Magistrate Judge's Order of March 17, 2006. (Kramer, Karl) Certificate of Authorization to File Sealed Document added on 3/31/2006 (mpv,). Modified on 3/31/2006 (mpv,). (Entered: 03/28/2006)

03/28/2006 610 SEALED PATENT RESPONSE to SEALED PATENT MOTION re 553 MOTION for Reconsideration of Magistrate Judge's Ruling on Admissibility of Exhibits on TIVo's Products Reply in Support of Motion filed by TIVO Inc. (Byrd, Christine) Certificate of Authorization to File Sealed Document added on 3/30/2006 (mpv,). Modified on 3/30/2006 (mpv,). (Entered: 03/28/2006)

03/28/2006 611 Consent MOTION to Amend/Correct 579 Pretrial Order,, Exhibit H by "EchoStar defendants". (Attachments: # 1 Exhibit H# 2 Text of Proposed Order)(Kramer, Karl) (Entered: 03/28/2006)

03/28/2006 612 ORDER re: Preliminary Jury Instructions. Signed by Judge David Folsom on 3/28/06. (Attachments: # 1 Exhibit A)(mrm,) (Entered: 03/28/2006)

03/28/2006 613 ORDER granting 611 Motion to Correct Exhibit H to the Joint Final Pre-trial Order. Signed by Judge David Folsom on 3/28/06. (mrm,) (Entered: 03/28/2006)

03/28/2006 -- NOTICE OF DOCKET CORRECTION: Exhibit H of Document # 579, Joint Final Pre-trial Order substituted per order # 613(mrm,) (Entered: 03/28/2006)

03/28/2006 614 SEALED PATENT DOCUMENT TIVo's Sur-Reply to EchoStar's Motion to Exclude "Undisclosed Expert Opinion Testimony by Lay Witnesses And Expert Testimony Based Thereon". (Armond, Michelle) (Entered: 03/28/2006)

03/28/2006 615 SEALED PATENT MOTION TIVo's Motion to Preclude any Testimony or Argument that EchoStar's 7100 and 7200 Products and EchoStar's '000 Patent are Prior Art by TIVO Inc. (Attachments: #

(1) Declaration# (2) Exhibit A# (3) Exhibit B# (4) Exhibit C# (5) Exhibit D# (6) Text of Proposed Order)(Armond, Michelle) (Entered: 03/28/2006)

03/29/2006 616 SEALED PATENT DOCUMENT TiVo's Brief in Support of Its Objections to EchoStar's New Exhibits and In Opposition to EchoStar's New Objections to TiVo's Exhibits. (Attachments: # (1) Exhibit A# (2) Exhibit B# (3) Exhibit 3564# (4) Exhibit 3567# (5) Exhibit 2110# (6) Exhibit 2111# (7) Exhibit 2112# (8) Exhibit 2113# (9) Exhibit 2114# (10) Exhibit 2115# (11) Exhibit 2116# (12) Exhibit 2117# (13) Exhibit 2118# (14) Exhibit 2120# (15) Exhibit 2121# (16) Exhibit 2122# (17) Exhibit 2123# (18) Exhibit 2124# (19) Exhibit 2125# (20) Exhibit 2125# (21) Exhibit 2127# (22) Exhibit 1899# (23) Exhibit 2105# (24) Exhibit 2106# (25) Exhibit 2107)(Hoffman, Adam) (Entered: 03/29/2006)

03/29/2006 617 MOTION for Reconsideration of Magistrate Judge's Rulings by TIVO Inc. (Attachments: # 1 Exhibit A# 2 Exhibit B# 3 Exhibit C)(Byrd, Christine) Proposed Order added on 3/30/2006 (mpv,). Modified on 3/30/2006 (mpv,). (Entered: 03/29/2006)

03/29/2006 618 NOTICE by "EchoStar defendants" EchoStar's Submission of "Agreed Upon" EchoStar Trial Exhibits (Attachments: # 1 Exhibit A)(Kramer, Karl) (Entered: 03/29/2006)

03/29/2006 619 ORDER re [615] SEALED PATENT MOTION TiVo's Motion to Preclude any Testimony or Argument that EchoStar's 7100 and 7200 Products and EchoStar's '000 Patent are Prior Art filed by TIVO Inc; ORDERED: RESPONSE is due on Friday, 3/31/06 at 1pm and REPLY is due on Monday, 4/3/06 at 10:00 am . Signed by Judge David Folsom on 3/29/06. (mrm,) (Entered: 03/29/2006)

03/29/2006 620 ORDER re [616] Sealed Patent Document, TiVo's Brief in Support of its Objections to New EchoStar Exhibits and in Opposition to EchoStar's New objections to TiVo's Trial Exhibits; ORDERED: RESPONSE is due on Friday, 3/31/06 at 1pm and REPLY is due on Monday, 4/3/06 at 10:00 am . Signed by Judge David Folsom on 3/29/06. (mrm,) (Entered: 03/29/2006)

03/29/2006 621 ORDER re 617 MOTION for Reconsideration of Magistrate Judge's Rulings filed by TIVO Inc; ORDERED: RESPONSE is due on Friday, 3/31/06 at 1pm and REPLY is due on Monday, 4/3/06 at 10:00 am. Signed by Judge David Folsom on 3/29/06. (mrm,) (Entered: 03/29/2006)

03/30/2006 622 Proposed Jury Instructions by "EchoStar defendants". (Kramer, Karl) (Entered: 03/30/2006)

03/30/2006 623 NOTICE by TIVO Inc Response to EchoStar's Request for A Limiting Jury Instruction Regarding Copying (Attachments: # 1 Exhibit A# 2 Exhibit B)(Armond, Michelle) (Entered: 03/30/2006)

03/30/2006 624 MOTION for a Limiting Jury Instruction Regarding Copying by "EchoStar defendants". (Attachments: # 1 Affidavit of Karl J. Kramer# 2 Text of Proposed Order)(Kramer, Karl) (Entered: 03/30/2006)

03/30/2006 625 ***FILED IN ERROR; PLEASE IGNORE; NO SIGNATURE ON DECLARATION: REPLACED BY # [626]*** SEALED PATENT RESPONSE to SEALED PATENT MOTION re [615] SEALED PATENT MOTION TiVo's Motion to Preclude any Testimony or Argument that EchoStar's 7100 and 7200 Products and EchoStar's '000 Patent are Prior Art filed by "EchoStar defendants". (Attachments: # (1) Affidavit of Karl J. Kramer# (2) Exhibit A# (3) Exhibit B)(Kramer, Karl) Modified on 3/31/2006 (mpv,). (Entered: 03/30/2006)

03/30/2006 626 ***CORRECTS DEFICIENT DOCUMENT #625*** SEALED PATENT RESPONSE to SEALED PATENT MOTION re [615] SEALED PATENT MOTION TiVo's Motion to Preclude any Testimony or Argument that EchoStar's 7100 and 7200 Products and EchoStar's '000 Patent are Prior Art filed by "EchoStar defendants". (Attachments: # (1) Affidavit of Karl J. Kramer# (2) Exhibit A# (3) Exhibit B)(Kramer, Karl) Modified on 3/31/2006 (mpv,). (Entered: 03/30/2006)

03/30/2006 627 MOTION to Preclude Introduction of Exhibits to Dr. Gibson's Expert Report by "EchoStar defendants". (Kramer, Karl) Certificate of Conference (Inadvertently omitted per.atty) added on 3/31/2006 (mpv,). Modified on 3/31/2006 (mpv,). Proposed Order added on 3/31/2006 (mpv,). Modified on 3/31/2006 (mpv,). (Entered: 03/30/2006)

03/30/2006 628 RESPONSE in Opposition re 617 MOTION for Reconsideration of Magistrate Judge's Rulings filed by "EchoStar defendants". (Kramer, Karl) (Entered: 03/30/2006)

03/30/2006 -- NOTICE of Deficiency regarding the SEALED PATENT RESPONSE to SEALED PATENT MOTION re 615 SEALED PATENT MOTION TiVo's Motion to Preclude any Testimony or Argument that EchoStar's 7100 and 7200 Products and EchoStar's '000 Patent are Prior Art #625 submitted Declaration not signed. Corrected by #626. (mpv,) (Entered: 03/31/2006)

03/31/2006 629 RESPONSE in Opposition re 627 MOTION to Preclude Introduction of Exhibits to Dr. Gibson's Expert Report Tivo's Opposition to EchoStar's Motion to Preclude Introduction of Exhibits to Dr. Gibson's Expert Report filed by TIVO Inc. (Attachments: # 1 Exhibit A# 2 Exhibit B# 3 Exhibit C# 4 Exhibit D# 5 Exhibit E# 6 Exhibit F)(Hoffman, Adam) (Entered: 03/31/2006)

03/31/2006 630 SEALED PATENT RESPONSE to SEALED PATENT MOTION re 586 MOTION to Exclude Testimony

of V. Thomas Rhyne Regarding Claims 5 and 36 filed by "EchoStar defendants". (Attachments: # (1) Affidavit of Karl J. Kramer# (2) Exhibit A-D)(Kramer, Karl) (Entered: 03/31/2006)

03/31/2006 631 SEALED PATENT RESPONSE by "EchoStar defendants" to [616] Sealed Patent Document,, EchoStar's Response to TiVo's Brief In Support of its Objections to New EchoStar Exhibits and In Opposition to EchoStar's New Objections to TiVo's Trial Exhibits. (Kramer, Karl) (Entered: 03/31/2006)

03/31/2006 632 SEALED PATENT RESPONSE to SEALED PATENT MOTION re [615] SEALED PATENT MOTION TiVo's Motion to Preclude any Testimony or Argument that EchoStar's 7100 and 7200 Products and EchoStar's '000 Patent are Prior Art filed by TIVO Inc. (Armond, Michelle) (Entered: 03/31/2006)

03/31/2006 633 ORDER; Both parties are hereby ORDERED to submit to the Court their proposed final jury instructions and their proposed final jury verdict form saved as an electronic file formatted in WordPerfect. The electronic copies shall be submitted no later than MONDAY, 4/3/06 at 1pm . Signed by Judge David Folsom on 3/31/06. (mrm,) (Entered: 03/31/2006)

03/31/2006 634 NOTICE by TIVO Inc Response to EchoStar's Objections Re Demonstrative Exhibits to be Used with Dr. Ugone (Attachments: # 1)(Armond, Michelle) (Entered: 03/31/2006)

04/02/2006 635 NOTICE by "EchoStar defendants" re 634 Notice (Other) EchoStar's Reply to TiVo's Response to EchoStar's Objections Re Demonstrative Exhibits to be Used with Dr. Ugone (Kramer, Karl) (Entered: 04/02/2006)

04/02/2006 636 SEALED PATENT DOCUMENT Notice of Response to TiVo's Objection to EchoStar's Trial Exhibit Nos. 1282 and 2449 and To EchoStar's Written Opinions of Counsel. (Attachments: # (1) Affidavit of Karl J. Kramer# (2) Exhibit A# (3) Exhibit B# (4) Exhibit C# (5) Exhibit D# (6) Exhibit E# (7) Exhibit F# (8) Exhibit G# (9) Exhibit H)(Kramer, Karl) (Entered: 04/02/2006)

04/02/2006 637 MOTION to Seal Specified Portions of the Trial Transcripts of March 29, 2006 by TIVO Inc. (Attachments: # 1 Text of Proposed Order Proposed Order)(Byrd, Christine) (Entered: 04/02/2006)

04/03/2006 638 RESPONSE in Support re 586 MOTION to Exclude Testimony of V. Thomas Rhyne Regarding Claims 5 and 36 filed by TIVO Inc. (Armond, Michelle) (Entered: 04/03/2006)

04/03/2006 639 NOTICE by TIVO Inc re 634 Notice (Other) SURREPLY IN OPPOSITION TO ECHOSTAR'S OBJECTIONS RE DEMONSTRATIVE EXHIBITS TO BE USED WITH DR. UGONE (Byrd, Christine) (Entered: 04/03/2006)

04/03/2006 640 NOTICE by TIVO Inc Proposed Verdict Form (Byrd, Christine) (Entered: 04/03/2006)

04/03/2006 641 Proposed Jury Instructions by TIVO Inc. (Byrd, Christine) (Entered: 04/03/2006)

04/03/2006 642 SEALED PATENT DOCUMENT TiVo's Reply Brief in Further Support of Its Objections to New EchoStar Exhibits and In Further Opposition to EchoStar's New Objections to TiVo's Trial Exhibits (docket #616). (Byrd, Christine) (Entered: 04/03/2006)

04/03/2006 643 RESPONSE in Support re 617 MOTION for Reconsideration of Magistrate Judge's Rulings filed by TIVO Inc. (Byrd, Christine) (Entered: 04/03/2006)

04/03/2006 644 SEALED PATENT DOCUMENT TIVO'S REPLY IN SUPPORT OF TIVO'S OBJECTION TO ECHOSTAR'S TRIAL EXHIBIT NOS. 1282 AND 2449 AND TO ECHOSTAR'S WRITTEN OPINIONS OF COUNSEL. (Hoffman, Adam) (Entered: 04/03/2006)

04/03/2006 645 Proposed Jury Instructions by "EchoStar defendants". (Attachments: # 1 Part 2 of Jury Instruction# 2 part 3 of Jury Instruction)(Kramer, Karl) (Entered: 04/03/2006)

04/03/2006 646 NOTICE by "EchoStar defendants" EchoStar's Second Amended Proposed Verdict Form (Kramer, Karl) (Entered: 04/03/2006)

04/03/2006 647 ORDER granting 637 Motion to Seal Specified Portions of the Trial Transcripts of March 29, 2006. Signed by Judge David Folsom on 4/3/06. (mrm,) (Entered: 04/03/2006)

04/03/2006 648 ORDER; The Court hereby DENIES TiVo's motion to present a product demonstration under Federal Rule of Evidence 403 . Signed by Judge David Folsom on 4/3/06. (mrm,) (Entered: 04/03/2006)

04/03/2006 649 ORDER; re: [525] Motion to Exclude or Strike Dr. Ugone's New Market Share Analysis; ORDERED that, pursuant to Rule 37 (c), paragraph 4.c and exhibits 35 through 38 of Dr. Ugone's March 10, 2006 expert report is hereby EXCLUDED. Signed by Judge David Folsom on 4/3/06. (mrm,) (Entered: 04/03/2006)

04/03/2006 650 NOTICE by "EchoStar defendants" of Filing of Letter Brief (McElhinny, Harold) (Entered: 04/03/2006)

04/03/2006 651 SEALED PATENT DOCUMENT EchoStar's Surreply In Opposition to TiVo's Brief Regarding New Objections [Docket No. 616]. (Kramer, Karl) (Entered: 04/03/2006)

04/03/2006 652 SEALED PATENT RESPONSE to SEALED PATENT MOTION re [615] SEALED PATENT MOTION TiVo's Motion to Preclude any Testimony or Argument that EchoStar's 7100 and 7200 Products and EchoStar's '000 Patent are Prior Art (EchoStar's Surreply) filed by "EchoStar defendants". (Kramer, Karl) (Entered: 04/03/2006)

04/03/2006 653 NOTICE by "EchoStar defendants" Offer of Proof Related to Claim Construction Order (Krevans, Rachel) (Entered: 04/03/2006)

04/04/2006 654 SEALED PATENT MOTION TiVo's Motion to Exclude Improper Supplemental Expert Report of Nathaniel Polish Served March 17, 2006 by TIVO Inc. (Attachments: # (1) Declaration# (2) Exhibit A# (3) Exhibit B# (4) Exhibit C# (5) Exhibit D# (6) Text of Proposed Order)(Armond, Michelle) (Entered: 04/04/2006)

04/05/2006 655 SEALED PATENT RESPONSE to SEALED PATENT MOTION re [654] SEALED PATENT MOTION TiVo's Motion to Exclude Improper Supplemental Expert Report of Nathaniel Polish Served March 17, 2006 (EchoStar's Opposition) filed by "EchoStar defendants". (Attachments: # (1) Affidavit of Karl J. Kramer# (2) Exhibit A# (3) Exhibit B# (4) Exhibit C# (5) Exhibit D)(Kramer, Karl) (Entered: 04/05/2006)

04/05/2006 656 SEALED PATENT DOCUMENT Tivo's Offer of Proof Regarding Excluded Summary Charts from Dr. Jerry Gibson. (Attachments: # (1) Declaration# (2) Exhibit A# (3) Exhibit B# (4) Exhibit C# (5) Exhibit D# (6) Exhibit E# (7) Exhibit F# (8) Exhibit G# (9) Exhibit H# (10) Exhibit I# (11) Exhibit J# (12) Exhibit K# (13) Exhibit L)(Armond, Michelle) (Entered: 04/05/2006)

04/05/2006 657 NOTICE by TIVO Inc TiVo's Offer of Proof Regarding Excluded TiVo Product Demonstration (Armond, Michelle) (Entered: 04/05/2006)

04/06/2006 658 MOTION to Preclude Any Further Evidence or Argument Regarding EchoStar's Patent Applications And '000 Patent by TIVO Inc. (Attachments: # 1 Declaration# 2 Exhibit A# 3 Proposed Jury Instruction)(Armond, Michelle) Additional attachment(s) added on 4/6/2006 (ehs,). (Entered: 04/06/2006)

04/06/2006 659 NOTICE by TIVO Inc of Filing of Proposed Limiting Instruction Regarding the 7100/7200 Products and EchoStar's Patent Application (Armond, Michelle) (Entered: 04/06/2006)

04/06/2006 660 NOTICE by "EchoStar defendants" of Filing of Proposed Limiting Instruction Regarding the 7100/7200 Products and EchoStar's Patent Application (Kramer, Karl) (Entered: 04/06/2006)

04/07/2006 661 SEALED PATENT RESPONSE to SEALED PATENT MOTION re [654] SEALED PATENT MOTION TiVo's Motion to Exclude Improper Supplemental Expert Report of Nathaniel Polish Served March 17, 2006 filed by TIVO Inc. (Attachments: # (1) Reply Declaration# (2) Exhibit E)(Armond, Michelle) (Entered: 04/07/2006)

04/07/2006 662 TRIAL BRIEF re REQUEST FOR A CURATIVE INSTRUCTION REGARDING IMPROPER CLAIM CONSTRUCTION TESTIMONY by TIVO Inc. (Byrd, Christine) (Entered: 04/07/2006)

04/07/2006 663 NOTICE by "EchoStar defendants" of Deposition Testimony Played on April 7, 2006 (Attachments: # 1 Exhibit A)(Kramer, Karl) (Entered: 04/07/2006)

04/07/2006 664 NOTICE by "EchoStar defendants" of Filing of Exhibit and Deposition Excerpts (Attachments: # 1 Exhibit A# 2 Exhibit B# 3 Exhibit C)(Kramer, Karl) (Entered: 04/07/2006)

04/08/2006 665 SEALED PATENT DOCUMENT EchoStar's Objections to Storer Testimony. (Attachments: # (1) Affidavit of Karl J. Kramer# (2) Exhibit A# (3) Exhibit B# (4) Exhibit C# (5) Exhibit D)(Kramer, Karl) (Entered: 04/08/2006)

04/08/2006 666 Proposed Jury Instructions by "EchoStar defendants". (Attachments: # 1 Exhibit A)(Kramer, Karl) (Entered: 04/08/2006)

04/09/2006 667 NOTICE by TIVO Inc re 666 Proposed Jury Instructions TiVo's Brief and Objection To EchoStar's Newly-Proposed Jury Instruction on Non-Infringing Alternatives (Byrd, Christine) (Entered: 04/09/2006)

04/09/2006 668 NOTICE by TIVO Inc re 666 Proposed Jury Instructions TiVo's Brief and Objection Re EchoStar's Newly-Proposed Jury Instruction on Reasonable Royalty (Byrd, Christine) (Entered: 04/09/2006)

04/09/2006 669 TRIAL BRIEF re EchoStar's Response in Opposition to TiVo's Request for a Curative Instruction Regarding Improper Claim Construction Testimony by "EchoStar defendants". (Kramer, Karl) (Entered: 04/09/2006)

04/10/2006 670 NOTICE by "EchoStar defendants" EchoStar's Offer of Proof Regarding Testimony of Homer Knearl, Kerry Miller, and James Gambrell (Kramer, Karl) (Entered: 04/10/2006)

04/10/2006 671 SEALED PATENT DOCUMENT Notice of EchoStar's Objections to TiVo's Proposed Rebuttal Witnesses and Evidence. (Attachments: # (1) Affidavit of Alison M. Tucher# (2) Exhibit A# (3) Exhibit B)(Tucher, Alison) (Entered: 04/10/2006)

04/10/2006 672 NOTICE by "EchoStar defendants" EchoStar's Offer of Proof Regarding EchoStar Exhibit 3519 (U.S. Patent 6,490,000 Prosecution History) (Kramer, Karl) (Entered: 04/10/2006)

04/10/2006 673 NOTICE by "EchoStar defendants" re 667 Notice (Other) EchoStar's Opposition to TiVo's Brief Re: EchoStar's Newly-Proposed Jury Instruction on Non-Infringing Alternatives (Kramer, Karl) (Entered: 04/10/2006)

04/10/2006 674 NOTICE by "EchoStar defendants" EchoStar's Offer of Proof Regarding Excluded Testimony of Dr. Nathaniel Polish, Ph.D. (Kramer, Karl) (Entered: 04/10/2006)

04/10/2006 675 NOTICE by "EchoStar defendants" EchoStar's Offer of Proof Regarding EchoStar Exhibits 3554 and 3562 (Request for Reexamination and PTO Order Granting) (Kramer, Karl) (Entered: 04/10/2006)

04/10/2006 676 NOTICE by TIVO Inc TIVO'S BRIEF ON DEMONSTRATIVES RE: CLAIMS 5 AND 36 (Attachments: # 1 Exhibit)(Baxter, Samuel) (Entered: 04/10/2006)

04/11/2006 677 NOTICE by "EchoStar defendants" EchoStar's Amended Offer of Proof Regarding Excluded Testimony of Dr. Nathaniel Polish, Ph.D. (Kramer, Karl) (Entered: 04/11/2006)

04/11/2006 678 SEALED PATENT DOCUMENT Offer of Proof re: Preamble. (Attachments: # (1) Affidavit Armond Declaration ISO Offer of Proof re Preamble# (2) Exhibit A to Armond Decl)(Armond, Michelle) (Entered: 04/11/2006)

04/11/2006 679 APPLICATION to Appear Pro Hac Vice by Attorney Brian Jones for TIVO Inc. (ch,) (Entered: 04/11/2006)

04/11/2006 -- Pro Hac Vice Filing fee paid by Jones; Fee: \$25, receipt number: 2-1-1349 (ch,) (Entered: 04/11/2006)

04/11/2006 680 NOTICE by "EchoStar defendants" EchoStar's Supplemental Submission Regarding Verdict Form (Kramer, Karl) (Entered: 04/11/2006)

04/11/2006 681 MOTION for Judgment as a Matter of Law by "EchoStar defendants". (Kramer, Karl) (Entered: 04/11/2006)

04/12/2006 682 NOTICE by "EchoStar defendants" EchoStar's Proposed Modifications to Verdict Form (Attachments: # 1 Exhibit A (Redline Verdict Form))(Kramer, Karl) (Entered: 04/12/2006)

04/12/2006 683 Proposed Jury Instructions by "EchoStar defendants". (Attachments: # 1 Exhibit A (Redline Jury Instructions))(Kramer, Karl) (Entered: 04/12/2006)

04/12/2006 684 Proposed Jury Instructions by TIVO Inc. (Byrd, Christine) (Entered: 04/12/2006)

04/12/2006 685 NOTICE by TIVO Inc Proposed Modifications to Verdict Form (redline format) (Byrd, Christine) (Entered: 04/12/2006)

04/12/2006 686 RESPONSE to Motion re 681 MOTION for Judgment as a Matter of Law filed by TIVO Inc. (Byrd, Christine) (Entered: 04/12/2006)

04/12/2006 687 NOTICE by TIVO Inc, Echostar Satellite LLC, Echostar Communications Corporation, Echostar DBS Corporation, EchoStar Technologies Corporation, Echosphere Limited Liability Company Joint Report on TiVo Trial Exhibits and EchoStar Objections Thereto (Byrd, Christine) (Entered: 04/12/2006)

04/12/2006 688 MOTION to Seal Confidential Trial Exhibits by TIVO Inc. (Attachments: # 1 Exhibit Attachment A)(Hoffman, Adam) (Entered: 04/12/2006)

04/13/2006 689 ORDER; After both parties were fully heard in a trial by jury, each moved the Court for Judgment as a Matter of Law pursuant to Rule 50 of the Federal Rules of Civil Procedure. The Court, having considered these motions and the arguments from counsel, finds the parties' motions are not well taken. Accordingly, it is hereby ORDERED that the parties' respective motions are DENIED on all counts. Signed by Judge David Folsom on 4/13/06. (mrm,) (Entered: 04/13/2006)

04/13/2006 690 JURY VERDICT. (mrm,) (Entered: 04/13/2006)

04/13/2006 691 Jury Instructions. (mrm,) (Entered: 04/13/2006)

04/13/2006 692 Minute Entry for proceedings held before Judge David Folsom : Jury Trial held on 3/29/2006 thru 4/13/2006. (Court Reporter Judy Werlinger.) (mrm,) (Entered: 04/18/2006)

04/13/2006 693 Jury Trial Witness List. (mrm,) (Entered: 04/18/2006)

04/13/2006 694 Jury Trial Exhibit List. (Attachments: # 1 TiVo's Agreed Exhibit List# 2 EchoStar's Agreed

Exhibit List)(mrm,) (Entered: 04/18/2006)

04/13/2006 695 SEALED Jury Notes. (1 note, in Texarkana Vault)(mrm,) (Entered: 04/18/2006)

04/18/2006 697 TRANSCRIPT of Trial Proceedings held on March 29, 2006 at 9:00 am before Judge David Folsom. Court Reporter: Susan Simmons. (ehs,) (Entered: 04/19/2006)

04/18/2006 698 SEALED PORTION OF TRANSCRIPT of Trial Proceedings held on March 29, 2006 at 9:00 am before Judge David Folsom. Court Reporter: Susan Simmons. (ehs,) (Entered: 04/19/2006)

04/18/2006 699 TRANSCRIPT of Trial Proceedings held on March 29, 2006 1:30 pm before Judge David Folsom. Court Reporter: Susan Simmons. (ehs,) (Entered: 04/19/2006)

04/18/2006 700 SEALED PORTION OF TRANSCRIPT of Trial Proceedings held on March 29, 2006 at 1:30 pm before Judge David Folsom. Court Reporter: Susan Simmons. (ehs,) (Entered: 04/19/2006)

04/18/2006 701 TRANSCRIPT of Trial Proceedings held on March 30, 2006 at 9:15 am before Judge David Folsom. Court Reporter: Susan Simmons. (ehs,) (Entered: 04/19/2006)

04/18/2006 702 TRANSCRIPT of Proceedings held on March 30, 2006 at 1:45 pm before Judge David Folsom. Court Reporter: Susan Simmons. (ehs,) (Entered: 04/19/2006)

04/18/2006 703 SEALED PORTION OF TRANSCRIPT of Trial Proceedings held on March 30, 2006 at 1:45 pm before Judge David Folsom. Court Reporter: Susan Simmons. (ehs,) (Entered: 04/19/2006)

04/18/2006 704 TRANSCRIPT of Trial Proceedings held on March 31, 2006 at 8:30 am before Judge David Folsom. Court Reporter: Susan Simmons. (ehs,) (Entered: 04/19/2006)

04/18/2006 705 SEALED PORTION OF TRANSCRIPT of Trial Proceedings held on March 31, 2006 at 8:30 am before Judge David Folsom. Court Reporter: Susan Simmons. (ehs,) (Entered: 04/19/2006)

04/18/2006 706 TRANSCRIPT of Trial Proceedings held on March 31, 2006 at 1:30 pm before Judge David Folsom. Court Reporter: Susan Simmons. (ehs,) (Entered: 04/19/2006)

04/19/2006 696 NOTICE by TIVO Inc of Letter to the U.S. Court of Appeals for the Federal Circuit (Armond, Michelle) (Entered: 04/19/2006)

04/20/2006 707 TRANSCRIPT of Trial Proceedings held on 4/4/06 @ 10:00 a.m. in Marshall, Tx before Honorable Judge David Folsom and a Jury. Court Reporter: Susan Simmons & Judith Werlinger. (106 pages) (ch,) (Entered: 04/20/2006)

04/20/2006 708 SEALED PORTION OF TRANSCRIPT of Trial Proceedings held on 4/4/06 @ 10:00 a.m. in Marshall, Tx before Honorable Judge David Folsom. Court Reporter: Susan Simmons & Judith Werlinger. (ch,) (Entered: 04/20/2006)

04/20/2006 709 TRANSCRIPT of Trial Proceedings held on 4/4/06 @ 1:30 p.m. in Marshall, Tx before Judge David Folsom. Court Reporter: Susan Simmons & Judith Werlinger. (152 pages) (ch,) (Entered: 04/20/2006)

04/20/2006 710 SEALED PORTION OF TRANSCRIPT of Trial Proceedings held on 4/4/06 @ 1:30 p.m. in Marshall, Tx before Judge David Folsom. Court Reporter: Susan Simmons & Judith Werlinger. (ch,) (Entered: 04/20/2006)

04/20/2006 711 TRANSCRIPT of Trial Proceedings held on 4/5/06 @ 9:00 a.m. in Marshall, Tx before Judge David Folsom. Court Reporter: Susan Simmons & Judith Werlinger. (130 pages) (ch,) (Entered: 04/20/2006)

04/20/2006 712 TRANSCRIPT of Trial Proceedings held on 4/5/06 @ 1:30 p.m. in Marshall, Tx before Judge David Folsom. Court Reporter: Susan Simmons & Judith Werlinger. (149 pages) (ch,) (Entered: 04/20/2006)

04/20/2006 713 TRANSCRIPT of Trial Proceedings held on 4/6/06 @ 9:00 a.m. in Marshall, Tx before Judge David Folsom. Court Reporter: Susan Simmons & Judith Werlinger. (141 pages) (ch,) (Entered: 04/20/2006)

04/20/2006 714 TRANSCRIPT of Trial Proceedings held on 4/6/06 @ 1:30 p.m. in Marshall, Tx before Judge David Folsom. Court Reporter: Susan Simmons & Judith Werlinger. (160 pages) (ch,) (Entered: 04/20/2006)

04/20/2006 715 NOTICE by "EchoStar defendants" EchoStar's Offer of Proof Regarding Cross-Examination of Dr. Storer (Kramer, Karl) (Entered: 04/20/2006)

04/21/2006 716 TRANSCRIPT of Trial Proceedings held on 4/7/06 @ 9:00 a.m. in Marshall, Tx before Judge David Folsom. Court Reporter: Susan Simmons & Judith Werlinger. (149 pages) (ch,) (Entered: 04/21/2006)

04/21/2006 717 TRANSCRIPT of Trial Proceedings held on 4/7/06 @ 1:45 p.m. in Marshall, Tx before Judge David Folsom. Court Reporter: Susan Simmons & Judith Werlinger. (84 pages) (ch,) (Entered: 04/21/2006)

04/21/2006)

04/21/2006 718 SEALED PORTION OF TRANSCRIPT of Trial Proceedings held on 4/7/06 @ 1:45 p.m. in Marshall, Tx before Judge David Folsom. Court Reporter: Susan Simmons & Judith Werlinger. (ch,) (Entered: 04/21/2006)

04/21/2006 719 TRANSCRIPT of Trial Proceedings held on 4/10/06 @ 9:00 a.m. in Marshall, Tx before Judge David Folsom. Court Reporter: Susan Simmons & Judith Werlinger. (120 pages) (ch,) (Entered: 04/21/2006)

04/21/2006 720 TRANSCRIPT of Trial Proceedings held on 4/10/06 @ 1:30 p.m. in Marshall, Tx before Judge David Folsom. Court Reporter: Susan Simmons & Judith Werlinger. (176 pages) (ch,) (Entered: 04/21/2006)

04/21/2006 721 SEALED TRANSCRIPT OF IN-CHAMBERS CONFERENCE Proceedings held on 4/10/06 @ 5:30 p.m. in Marshall, Tx before Judge David Folsom. Court Reporter: Susan Simmons & Judith Werlinger. (ch,) (Entered: 04/21/2006)

04/21/2006 722 TRANSCRIPT of Trial Proceedings held on 4/11/06 @ 9:00 a.m. in Marshall, Tx before Judge David Folsom. Court Reporter: Susan Simmons & Judith Werlinger. (136 pages) (ch,) (Entered: 04/21/2006)

04/21/2006 723 TRANSCRIPT of Trial Proceedings held on 4/11/06 @ 1:30 p.m. in Marshall, Tx before Judge David Folsom. Court Reporter: Susan Simmons & Judith Werlinger. (87 pages) (ch,) (Entered: 04/21/2006)

04/21/2006 724 TRANSCRIPT of Trial Proceedings held on 4/13/06 @ 9:00 a.m. in Marshall, Tx before Judge David Folsom. Court Reporter: Susan Simmons & Judith Werlinger. (191 pages) (ch,) (Entered: 04/21/2006)

04/21/2006 725 SEALED PORTION OF TRANSCRIPT of Trial Proceedings held on 4/13/06 @ 9:00 a.m. in Marshall, Tx before Judge David Folsom. Court Reporter: Susan Simmons & Judith Werlinger. (ch,) (Entered: 04/21/2006)

05/01/2006 726 APPLICATION to Appear Pro Hac Vice by Attorney Scott F Llewellyn for "EchoStar defendants". (rml,) (Entered: 05/01/2006)

05/01/2006 -- Pro Hac Vice Filing fee paid by Scott Llewellyn; Fee: \$25, receipt number: 5-1-563 (rml,) (Entered: 05/01/2006)

05/01/2006 727 TRANSCRIPT of Proceedings (Jury Charge Conference) held on April 12, 2006 before Judge David Folsom. Court Reporter: Libby Crawford. (sm,) (Entered: 05/02/2006)

05/05/2006 728 ORDER Telephonic Status Conference set for 5/16/2006 01:30 PM in Ctrm 319 (Texarkana) before Judge David Folsom, for the purposes of determining whether any post-trial briefing will be submitted and the schedule therefore. In advance of this conference, by way of letter, the parties should inform the Court of any outstanding issues which they contend need to be addressed before entry of a final judgment. The telephonic conference call shall be initiated by Pifs counsel. Signed by Judge David Folsom on 5/4/06. (mrm,) (Entered: 05/05/2006)

05/16/2006 729 ORDER; ORDERS EchoStar to produce all documents created by the Merchant & Gould law firm that relate to any infringement or validity analysis of the '389 patent where said documents (1) were communicated to EchoStar or (2) reflect a communication to EchoStar. EchoStar may redact any information that it considers unrelated to infringement or validity or that it considers primarily related to trial strategy. These documents shall be produced no later than 5/19/06; vacating 380 Order, vacating 357 Order, vacating 386 Order on Motion to Stay. Signed by Judge David Folsom on 5/16/06. (mrm,) (Entered: 05/16/2006)

05/16/2006 730 ORDER Bench Trial set for 6/26-27/2006 10:00 AM in Ctrm 319 (Texarkana) before Judge David Folsom. Motion Hearing set for 6/28/06 10:00 AM. Proposed Findings of Fact due by 7/7/2006. Pretrial briefing no later than 6/13/06. Each pty is limited to 5hrs for trial presentation. Each pty is limited to 2.5 hrs for motion argument. ORDERED that, absent advance leave of Court for good cause, the ptys are limited to 30pgs for any brief, motion, or response and are limited to 15pgs for any reply. Absent advance leave of Court for good cause, no sur-reply or supplemental briefing shall be filed. Signed by Judge David Folsom on 5/16/06. (mrm,) (Entered: 05/16/2006)

05/16/2006 731 Minute Entry for proceedings held before Judge David Folsom : Telephone Conference held on 5/16/2006. (Court Reporter non.) (mrm,) (Entered: 05/17/2006)

05/22/2006 732 SEALED PATENT MOTION For Prejudgment Interest and Supplemental Damages by TIVO Inc. (Attachments: # (1) Exhibit Exhibit 1# (2) Exhibit Exhibit 2# (3) Exhibit Exhibit 3# (4) Affidavit Declaration of Dr. Keith R. Ugone in support of Motion for Prejudgment Interest and Supplemental Damages# (5) Exhibit Exhibit A to Ugone Declaration# (6) Exhibit Exhibit B to Ugone Declaration# (7) Exhibit Exhibit C to Ugone Declaration# (8) Exhibit Exhibit D to Ugone

Declaration# (9) Exhibit Exhibit E to Ugone Declaration# (10) Exhibit Exhibit F to Ugone Declaration# (11) Exhibit Exhibit G to Ugone Declaration# (12) Exhibit Exhibit H to Ugone Declaration# (13) Text of Proposed Order Proposed Order on TiVo's Motion for Prejudgment Interest and Supplemental Damages)(Byrd, Christine) (Entered: 05/22/2006)

05/25/2006 734 NOTICE by TIVO Inc of Motion to Treble Damages and for a Determination that this Case is "Exceptional" Entitling TiVo's to Attorneys' Fees (Attachments: # 1 Affidavit Declaration of Adam Hoffman In Support of TiVo's Motion for Enhanced Damages and a Determination the this Case is Exceptional# 2 Exhibit 1# 3 Exhibit 2# 4 Exhibit 3# 5 Exhibit 4# 6 Exhibit 5# 7 Exhibit 6# 8 Exhibit 7# 9 Exhibit 8# 10 Exhibit 9# 11 Exhibit 10# 12 Exhibit 11# 13 Exhibit 12# 14 Errata 13# 15 Exhibit 14# 16 Exhibit 15# 17 Exhibit 15# 18 Exhibit 17# 19 Exhibit 18# 20 Exhibit 19# 21 Exhibit 20# 22 Exhibit 21# 23 Exhibit 22# (24) Exhibit 23# 25 Exhibit 24# 26 Exhibit 25# 27-Exhibit 26# 28 Exhibit 27# 29 Exhibit 28# 30 Exhibit 29# 31 Exhibit 30# 32 Exhibit 31# 33 Exhibit 32# 34 Exhibit 33# 35 Exhibit 34# 36 Exhibit 35# 37 Exhibit 36# 38 Exhibit 37# 39 Exhibit 38# 40 Exhibit 39# 41 Exhibit 40# 42 Exhibit 41# 43 Exhibit 42# 44 Exhibit 43# 45 Exhibit 44# 46 Exhibit 45# 47 Text of Proposed Order)(Hoffman, Adam) Additional attachment(s) added on 5/26/2006 (sm,). (Entered: 05/26/2006)

06/05/2006 735 ORDER re [733] SEALED PATENT MOTION for Injunction filed by TIVO Inc, & ORDER RE: ECHOSTAR'S MOTION FOR STAY PENDING APPEAL. Pursuant to the agreement of the parties and for good cause shown, the Court hereby ORDERS that (i) EchoStar shall combine its motion for stay pending appeal with its response to TiVo's motion for an injunction (due 6/6/06); (ii) EchoStar shall have a total of 40 pages for its combined response and motion for stay; (iii) TiVo shall combine its response to EchoStar's motion for stay with its reply in support of its motion for an injunction (due 6/13/06); and (iv) EchoStar's reply in support of its motion for stay shall be due 6/20/06. Signed by Judge David Folsom on 6/5/06. (mpv,) (Entered: 06/05/2006)

06/06/2006 736 SEALED PATENT RESPONSE to SEALED PATENT MOTION re [732] SEALED PATENT MOTION For Prejudgment Interest and Supplemental Damages filed by "EchoStar defendants". (Attachments: # (1) Affidavit of Matthew R. Lynde# (2) Exhibit A-K to Lynde Decl.# (3) Affidavit of Karl Kramer# (4) Exhibit A-J to Kramer Decl.)(Kramer, Karl) (Entered: 06/06/2006)

06/06/2006 737 SEALED PATENT MOTION EchoStar's (1) Opposition to TiVo's Motion for Entry of Judgment and Permanent Injunction and (2) Cross-Motion to Stay Any Injunction Pending Appeal by "EchoStar defendants". (Attachments: # (1) Affidavit of Erik Carlson# (2) Affidavit of Jody Martin# (3) Affidavit of Dan Minnick# (4) Affidavit of John J. Yodzis# (5) Affidavit of Robert Harkins# (6) Exhibit 1-17 of Harkins Decl.# (7) Exhibit 18-22 of Harkins Decl.# (8) Text of Proposed Order) (Harkins, Robert) (Entered: 06/06/2006)

06/09/2006 738 ORDER RE: TIVO'S BRIEF (i) IN FURTHER SUPPORT OF ITS MOTION FOR PERMANENT INJUNCTION AND (ii) IN RESPONSE TO ECHOSTAR'S MOTION FOR STAY PENDING APPEAL; the Court hereby ORDERS that (i) TIVO shall have a total of 25 pgs for its combined reply in support of its motion for an injunction and response in opposition to EchoStar's motion for stay pending appeal, (ii) TiVo's combined brief shall be due 6/14/06 and (iii) EchoStar's reply in support of its motion for stay shall be due 6/21/06. All other dates remain unchanged. Signed by Judge David Folsom on 6/9/06. (mrm,) (Entered: 06/09/2006)

06/09/2006 739 SEALED PATENT DOCUMENT EchoStar's Opposition to TiVo's Motion for Enhanced Damages and Attorneys' Fees. (Attachments: # (1) Affidavit of Rachel Krevans# (2) Exhibit 1-4# (3) Exhibit 5 part 1# (4) Exhibit 5 part 2# (5) Exhibit 6 part 1# (6) Exhibit 6 part 2# (7) Exhibit 7-12# (8) Exhibit 13-22# (9) Exhibit 23# (10).Exhibit 24-28)(Krevans, Rachel) (Entered: 06/09/2006)

06/09/2006 740 SEALED PATENT ADDITIONAL ATTACHMENTS to Main Document: [739] Sealed Patent Document,. (Attachments: # (1) Exhibit 29 part 2# (2) Exhibit 29 part 3# (3) Exhibit 29 part 4# (4) Exhibit 29 part 5# (5) Exhibit 29 part 6# (6) Exhibit 29 part 7# (7) Exhibit 29 part 8) (Krevans, Rachel) (Entered: 06/09/2006)

06/09/2006 741 SEALED PATENT ADDITIONAL ATTACHMENTS to Main Document: [739] Sealed Patent Document,. (Attachments: # (1) Exhibit 30 part 2# (2) Exhibit 30 part 3# (3) Exhibit 30 part 4# (4) Exhibit 30 part 5# (5) Exhibit 30 part 6# (6) Exhibit 30 part 7# (7) Exhibit 30 part 8# (8) Exhibit 31-32)(Krevans, Rachel) (Entered: 06/09/2006)

06/09/2006 742 SEALED PATENT ADDITIONAL ATTACHMENTS to Main Document: [739] Sealed Patent Document,. (Attachments: # (1) Exhibit 33 part 2# (2) Exhibit 33 part 3# (3) Exhibit 33 part 4# (4) Exhibit 33 part 5# (5) Exhibit 33 part 6# (6) Exhibit 33 part 7# (7) Exhibit 33 part 8) (Krevans, Rachel) (Entered: 06/09/2006)

06/09/2006 743 SEALED PATENT ADDITIONAL ATTACHMENTS to Main Document: [739] Sealed Patent Document,. (Attachments: # (1) Exhibit 39 part 1# (2) Exhibit 39 part 2# (3) Exhibit 39 part 3# (4) Exhibit 39 part 4)(Krevans, Rachel) (Entered: 06/09/2006)

06/13/2006 744 SEALED PATENT REPLY to Response to PATENT Motion re [732] SEALED PATENT MOTION For Prejudgment Interest and Supplemental Damages filed by TIVO Inc. (Attachments: # (1)

Affidavit Declaration of Christine Byrd# (2) Exhibit Exhibit A# (3) Exhibit Exhibit B# (4) Exhibit Exhibit C# (5) Exhibit Exhibit D)(Byrd, Christine) (Entered: 06/13/2006)

06/13/2006 745 SEALED PATENT DOCUMENT EchoStar's Pretrial Brief on Equitable Estoppel, Laches, and Inequitable Conduct. (Kramer, Karl) (Entered: 06/13/2006)

06/14/2006 746 SEALED PATENT DOCUMENT TIVO'S TRIAL BRIEF ON THIS COURT'S PERSONAL JURISDICTION OVER ECC AND EDBS. (Byrd, Christine) (Entered: 06/14/2006)

06/16/2006 749 ORDER RE: (1) TIVO'S REPLY IN SUPPORT OF ITS MOTION FOR TREBLE DAMAGES AND A DETERMINATION THAT THIS IS AN "EXCEPTIONAL CASE" (2) ECHOSTAR'S RESPONSE TO TRIAL BRIEF ON THIS COURT'S PERSONAL JURISDICTION OVER ECC AND EDBS; ORDERS that (i) TiVo's Reply Brief of its Motion for Treble Damages and a Determination that this case is an "Exceptional Case" is due 6/19/06; (ii) EchoStar's Response to TiVo's Trial Brief on this Court's Personal Jurisdiction over ECC and EDBS is due 6/22/06. Signed by Judge David Folsom on 6/16/06. (mrm,) (Entered: 06/16/2006)

06/17/2006 750 Bench Trial Witness List by TIVO Inc. (Byrd, Christine) (Entered: 06/17/2006)

06/19/2006 751 NOTICE by "EchoStar defendants" of Withdrawal of Personal Jurisdiction Affirmative Defense (Krevans, Rachel) (Entered: 06/19/2006)

06/20/2006 752 SEALED PATENT DOCUMENT TIVO'S REPLY IN SUPPORT OF ITS MOTION FOR TREBLE DAMAGES AND THE DESIGNATION OF THIS CASE AS 'EXCEPTIONAL'. (Attachments: # (1) Exhibit A# (2) Exhibit B# (3) # (4) Exhibit D# (5) Exhibit E# (6) Exhibit F# (7) Exhibit G# (8) Exhibit H# (9) Exhibit I)(Hoffman, Adam) (Entered: 06/20/2006)

06/20/2006 753 SEALED PATENT DOCUMENT TiVo's Trial Brief on Equitable Estoppel, Laches, and Inequitable Conduct. (Attachments: # (1) Jones Declaration# (2) Exhibit 1# (3) Exhibit 2# (4) Exhibit 3# (5) Exhibit 4)(Armond, Michelle) (Entered: 06/21/2006)

06/21/2006 754 SEALED PATENT REPLY to Response to PATENT Motion re [737] SEALED PATENT MOTION EchoStar's (1) Opposition to TiVo's Motion for Entry of Judgment and Permanent Injunction and (2) Cross-Motion to Stay Any Injunction Pending Appeal filed by "EchoStar defendants". (Attachments: # (1) Affidavit of Rachel Krevans# (2) Exhibit A# (3) Exhibit B# (4) Exhibit C# (5) Exhibit D)(Krevans, Rachel) Modified on 6/22/2006 (mpv,). Modified on 6/22/2006 (mpv,). (Entered: 06/21/2006)

06/26/2006 755 Minute Entry for proceedings held before Judge David Folsom : Bench Trial held on 6/26/2006 - 6/27/06. (Court Reporter Keith Johnson.) (mrm,) (Entered: 06/29/2006)

06/26/2006 757 Bench Trial Witness List. (mrm,) (Entered: 06/29/2006)

06/26/2006 758 Bench Trial Exhibit List. (Attachments: # 1 Additional Exhibit Lists)(mrm,) Modified on 6/29/2006 (mrm,). (BT exhibits in Texarkana vault some exhibits are SEALED) (Entered: 06/29/2006)

06/28/2006 756 Minute Entry for proceedings held before Judge David Folsom : Motion Hearing held on 6/28/2006 re [737] SEALED PATENT MOTION EchoStar's (1) Opposition to TiVo's Motion for Entry of Judgment and Permanent Injunction and (2) Cross-Motion to Stay Any Injunction Pending Appeal filed by "EchoStar defendants",, [732] SEALED PATENT MOTION For Prejudgment Interest and Supplemental Damages filed by TIVO Inc,, [733] SEALED PATENT MOTION for Injunction filed by TIVO Inc,. (Court Reporter Keith Johnson.) (mrm,) (Entered: 06/29/2006)

07/06/2006 759 SEALED PATENT RESPONSE by "EchoStar defendants" to [753] Sealed Patent Document EchoStar's Opposition to TiVo's Arguments Regarding Timeliness and Unclean Hands. (Attachments: # (1) Affidavit of Rachel Krevans# (2) Exhibit A-G to Krevans Declaration) (Krevans, Rachel) (Entered: 07/06/2006)

07/07/2006 760 Proposed Findings of Fact by TIVO Inc. (Armond, Michelle) (Entered: 07/07/2006)

07/07/2006 761 SEALED PATENT DOCUMENT EchoStar's Proposed Findings of Fact and Conclusions of Law on Equitable Estoppel, Laches, and Inequitable Conduct. (Krevans, Rachel) (Entered: 07/07/2006)

07/07/2006 762 SEALED PATENT RESPONSE by TIVO Inc to [759] Sealed Patent Response to Non-Motion, EchoStar's Opposition Re: Timeliness and Unclean Hands. (Jones, Brian) (Entered: 07/07/2006)

07/20/2006 763 NOTICE by TIVO Inc regarding letter brief submitted July 20, 2006 (Jones, Brian) (Entered: 07/20/2006)

07/24/2006 764 SEALED PATENT MOTION EchoStar's Rule 50(b) Renewed Motion for Judgment as a Matter of Law by "EchoStar defendants". (Attachments: # (1) Affidavit of Rachel Krevans# (2) Exhibit A-B to Krevans Decl.# (3) Text of Proposed Order)(Krevans, Rachel) (Entered: 07/24/2006)

07/24/2006 765 SEALED PATENT MOTION EchoStar's Rule 59 Motion for New Trial and/or Remittitur by

"EchoStar defendants". (Attachments: # (1) Affidavit of Rachel Krevans# (2) Exhibit 1 - 9 of Krevans Decl.# (3) Affidavit of Matthew R. Lynde# (4) Exhibit 1 of Lynde Exhibit# (5) Text of Proposed Order First Alternative Proposed Order# (6) Text of Proposed Order Second Alternative Proposed Order# (7) Text of Proposed Order Third Alternative Proposed Order) (Krevans, Rachel) (Entered: 07/24/2006)

07/25/2006 766 NOTICE by "EchoStar defendants" re 763 Notice (Other) Notice of Filing of Letter Brief (McElhinny, Harold) (Entered: 07/25/2006)

08/01/2006 -- Sealed Order #767 sent via US Mail to all party attys of record 8/1/06. (mpv,) (Entered: 08/01/2006)

08/01/2006 768 Joint MOTION re: Briefing Schedule On (1) EchoStar's Rule 50(b) Renewed Motion for Judgment as a Matter of Law and (2) EchoStar's Rule 59 Motion for New Trial and/or Remittitur by TIVO Inc. (Attachments: # 1 Text of Proposed Order Joint Proposed Order Re: Briefing Schedule) (Byrd, Christine) (Entered: 08/01/2006)

08/03/2006 769 ORDER; re: 768 Joint MOTION re: Briefing Schedule On (1) EchoStar's Rule 50(b) Renewed Motion for Judgment as a Matter of Law and (2) EchoStar's Rule 59 Motion for New Trial and/or Remittitur by TIVO Inc; TiVo shall file its opposition brief on or before 8/21/06 and EchoStar shall file its reply brief on or before 8/31/06 . Signed by Judge David Folsom on 8/3/06. (mrm,) (Entered: 08/03/2006)

08/07/2006 770 NOTICE by TIVO Inc re 766 Notice (Other) Notice of Letter Brief (Byrd, Christine) (Entered: 08/07/2006)

08/11/2006 771 NOTICE by TIVO Inc of Letter to Court (Jones, Brian) (Entered: 08/11/2006)

08/17/2006 772 FINDINGS OF FACT AND CONCLUSIONS OF LAW. Signed by Judge David Folsom on 8/17/06. (mrm,) (Entered: 08/17/2006)

08/17/2006 773 ORDER granting [733] Sealed Patent Motion for Entry of Judgment and Permanent Injunction, denying [737] Sealed Patent Motion to Stay Any Injunction Pending Appeal. Signed by Judge David Folsom on 8/17/06. (mrm,) (Entered: 08/17/2006)

08/17/2006 774 ORDER granting [732] Sealed Patent Motion for Prejudgment Interest and Supplemental Damages. Signed by Judge David Folsom on 8/17/06. (mrm,) (Entered: 08/17/2006)

08/17/2006 775 ORDER denying 734 Motion for Treble Damages and for a Determination that this Case is "Exceptional" Entitling TiVo's to Attorneys' Fees filed by TIVO Inc, . Signed by Judge David Folsom on 8/17/06. (mrm,) (Entered: 08/17/2006)

08/17/2006 776 FINAL JUDGMENT AND PERMANENT INJUNCTION. Signed by Judge David Folsom on 8/17/06. (mrm,) (Entered: 08/17/2006)

08/17/2006 777 ***FILED IN ERROR; DOCKETED INCORRECTLY; PLEASE IGNORE*** NOTICE by "EchoStar defendants" Notice of Appeal (Krevans, Rachel) Modified on 8/18/2006 (mpv,). (Entered: 08/17/2006)

08/17/2006 778 ***FILED IN ERROR; DOCKETED INCORRECTLY; PLEASE IGNORE*** NOTICE by "EchoStar defendants" Corrected Notice of Appeal (Krevans, Rachel) Modified on 8/18/2006 (mpv,). (Entered: 08/17/2006)

08/17/2006 -- NOTICE of Deficiency regarding the Notice of Appeal and Corrected Notice of Appeal #777 & 778 submitted Docketed Incorrectly. Correction should be made by one business day (mpv,) (Entered: 08/18/2006)

08/17/2006 779 NOTICE OF APPEAL as to 776 Judgment, Permanent Injunction by "EchoStar defendants". Filing fee \$ 455, receipt number 5-1-671. (mpv,) (Entered: 08/18/2006)

08/18/2006 -- USCA Appeal Fees received \$ 455 receipt number 5-1-671 re 779 Notice of Appeal filed by "EchoStar defendants", (mpv,) (Entered: 08/18/2006)

08/18/2006 -- Transmission of Notice of Appeal and Docket Sheet to US Court of Appeals for the Federal Circuit Court re 779 Notice of Appeal (ehs,) (Entered: 08/18/2006)

08/18/2006 -- Appeal Remark re 779 Notice of Appeal: transcript order forms for the Federal Circuit Court of Appeal sent to cnsI for the defendants (ehs,) (Entered: 08/18/2006)

08/21/2006 780 SEALED PATENT RESPONSE to SEALED PATENT MOTION re [764] SEALED PATENT MOTION EchoStar's Rule 50(b) Renewed Motion for Judgment as a Matter of Law filed by TIVO Inc. (Giza, Alexander) (Entered: 08/21/2006)

08/21/2006 781 SEALED PATENT RESPONSE to SEALED PATENT MOTION re [765] SEALED PATENT MOTION EchoStar's Rule 59 Motion for New Trial and/or Remittitur filed by TIVO Inc. (Attachments: # (1) Affidavit Hoffman Declaration In Support Of TiVo's Opposition to EchoStar's Renewed JMOL and TiVo's Oppostion to EchoStar's Motion for a New Trial and/or Remittitur# (2) Exhibit A# (3)

Exhibit C# (4) Exhibit D# (5) Exhibit E# (6) Exhibit F# (7) Exhibit G# (8) Exhibit H# (9) Exhibit I# (10) Exhibit J# (11) Exhibit K# (12) Exhibit L# (13) Exhibit M# (14) Exhibit N)(Hoffman, Adam) (Entered: 08/21/2006)

08/22/2006 782 SEALED PATENT ADDITIONAL ATTACHMENTS to Main Document: [781] Sealed Patent Response to Sealed Patent Motion,,. (Attachments: # (1) Exhibit Corrected Exhibit F# (2) Exhibit Corrected Exhibit G# (3) Exhibit Corrected Exhibit H# (4) Exhibit Corrected Exhibit M# (5) Exhibit O# (6) Exhibit P# (7) Exhibit Q# (8) Exhibit R# (9) Exhibit S# (10) Exhibit T# (11) Exhibit U# (12) Exhibit V# (13) Exhibit W# (14) Exhibit X# (15) Exhibit Y# (16) Exhibit Z# (17) Exhibit AA# (18) Exhibit BB# (19) Exhibit DD# (20) Exhibit EE# (21) Exhibit FF)(Hoffman, Adam) (Entered: 08/22/2006)

08/22/2006 783 SEALED PATENT ADDITIONAL ATTACHMENTS to Main Document: [781] Sealed Patent Response to Sealed Patent Motion,,. (Attachments: # (1) Exhibit B Part 1# (2) Exhibit B Part 2# (3) Exhibit B Part 3# (4) Exhibit B Part 4# (5) Exhibit B Part 5# (6) Exhibit B Part 6# (7) Exhibit B Part 7# (8) Exhibit CC Part 1# (9) Exhibit CC Part 2)(Hoffman, Adam) (Entered: 08/22/2006)

08/22/2006 784 SEALED PATENT RESPONSE to SEALED PATENT MOTION re [765] SEALED PATENT MOTION EchoStar's Rule 59 Motion for New Trial and/or Remittitur Amended Opposition (identical to Opposition filed under docket no. 781 except footer and table of authorities corrected; supporting Hoffman Declaration and exhibits still under docket nos. 781, 782, and 783) filed by TIVO Inc. (Hoffman, Adam) (Entered: 08/22/2006)

08/22/2006 786 USCA for the Federal Circuit Court - Case Number 2006-1574 for 779 Notice of Appeal filed by "EchoStar defendants",. (ehs,) (Entered: 08/29/2006)

08/28/2006 785 US Federal Circuit Court of Appeals Case Number 2006-1574 for 779 Notice of Appeal filed by "EchoStar defendants". (ehs,) (Entered: 08/28/2006)

08/29/2006 787 SEALED PATENT REPLY to Response to PATENT Motion re [764] SEALED PATENT MOTION EchoStar's Rule 50(b) Renewed Motion for Judgment as a Matter of Law filed by "EchoStar defendants". (Krevans, Rachel) (Entered: 08/29/2006)

08/29/2006 788 SEALED PATENT REPLY to Response to PATENT Motion re [765] SEALED PATENT MOTION EchoStar's Rule 59 Motion for New Trial and/or Remittitur filed by "EchoStar defendants". (Krevans, Rachel) (Entered: 08/29/2006)

08/29/2006 789 TRANSCRIPT of Proceedings/Hearing on Tivo's Objections to Defendants' Trial Exhibits and Defendants' Evidentiary Objections held on 2/1/06 before Judge Caroline Craven. Court Reporter: Leslie P Bates. (mpv,) (Entered: 08/29/2006)

08/29/2006 790 TRANSCRIPT of Proceedings/Hearing on Tivo's Objections to Defendants' Trial Exhibits and Defendants' Evidentiary Objections held on 2/27/06 before Judge Caroline Craven. Court Reporter: Leslie P Bates. (mpv,) (Entered: 08/29/2006)

08/29/2006 791 ***FILED IN ERROR; DEFICIENT DOCUMENT; PLEASE IGNORE*** SEALED PATENT DOCUMENT Supplemental Declaration of Dr. Keith Ugone re Prejudgment Interest and Supplemental Damages for July 31 - August 17, 2006. (Attachments: # (1) Affidavit Supplemental Declaration of Dr. Keith Ugone)(Byrd, Christine) Modified on 8/30/2006 (mpv,). (Entered: 08/29/2006)

08/29/2006 792 NOTICE of Deficiency regarding the SEALED PATENT DOCUMENT Supplemental Declaration of Dr. Keith Ugone re Prejudgment Interest and Supplemental Damages for July 31 - August 17, 2006. #791 submitted No Certificate of Authorization to file sealed document included in pleading. Correction should be made by one business day. (mpv,) (Entered: 08/30/2006)

08/30/2006 793 TRANSCRIPT of Proceedings held on 6/26/06 before Judge David Folsom. Court Reporters: Kimberly Julian and D. Keith Smith. (mpv,) (Entered: 08/30/2006)

08/30/2006 794 TRANSCRIPT of Proceedings held on 6/27/06 before Judge David Folsom. Court Reporters: Kimberly Julian and D Keith Johnson. (mpv,) (Entered: 08/30/2006)

08/30/2006 795 TRANSCRIPT of Proceedings held on 6/28/06 before Judge David Folsom. Court Reporters: Kimberly Julian and D Keith Johnson. (mpv,) (Entered: 08/30/2006)

08/30/2006 796 ***REPLACES #791*** SEALED PATENT DOCUMENT Supplemental Declaration of Dr. Keith Ugone re Prejudgment Interest and Supplemental Damages for July 31 - August 17, 2006. (Attachments: # (1) Exhibit Ex. 1 - Declaration of Dr. Keith Ugone)(Giza, Alexander) Modified on 8/30/2006 (mpv,). (Entered: 08/30/2006)

08/30/2006 797 BILL OF COSTS by TIVO Inc. (Attachments: # 1 Affidavit Brief summarizing costs# 2 Exhibit Ex. A to Brief summarizing costs# 3 Exhibit Ex. B (part 1) to Brief summarizing costs# 4 Exhibit Ex. B (part 2) to Brief summarizing costs# 5 Exhibit Ex. B (part 3) to Brief summarizing costs# 6 Exhibit Ex. B (part 4) to Brief summarizing costs# 7 Exhibit Ex. C to Brief summarizing costs# 8 Exhibit Ex. D to Brief summarizing costs)(Giza, Alexander) (Entered: 08/30/2006)

08/31/2006 798 Joint MOTION to Amend/Correct /Extend 10-Day Period Provided For In Federal Rule of Civil

Procedure 62(a) by "EchoStar defendants". (Attachments: # 1 Text of Proposed Order) (Krevans, Rachel) (Entered: 08/31/2006)

08/31/2006 799 TRANSCRIPT REQUEST by "EchoStar defendants" for all proceedings held Transcripts already on file before Judge David Folsom.. (mpv,) (Entered: 08/31/2006)

08/31/2006 800 Joint MOTION to Amend/Correct Final Judgment and Permanent Injunction by TIVO Inc. (Attachments: # 1 Exhibit Ex. A (TiVo proposed order)# 2 Exhibit Ex. B (EchoStar proposed order))(Giza, Alexander) (Entered: 08/31/2006)

09/01/2006 801 ORDER granting 798 Motion to Amend/Correct 10-Day period provided for In FRCP 62(a). IT IS, THEREFORE, ORDERED, ADJUDGED AND DECREED that the period provided for in Rule 62(a) is hereby extended, through 9/5/06. Accordingly, no execution shall issue upon the money judgment nor shall proceedings be taken for its enforcement until after 9/5/06 . Signed by Judge David Folsom on 9/1/06. (mpv,) (Entered: 09/01/2006)

09/05/2006 802 Joint MOTION to Extend 10-Day Period Provided For In Federal Rule of Civil Procedure 62(a) by "EchoStar defendants". (Attachments: # 1 Text of Proposed Order)(Krevans, Rachel) (Entered: 09/05/2006)

09/08/2006 803 ORDER granting 802 Motion to extend 10 day period provided in federal rules of civil procedure and the period provided for in Rule 62 is hereby extended, through September 11, 2006 . Signed by Judge David Folsom on 9/8/2006. (sm,) Modified on 9/8/2006 (sm,). (Entered: 09/08/2006)

09/08/2006 804 NOTICE OF APPEAL by "EchoStar defendants". Filing fee \$ 455, receipt number 869142. (Krevans, Rachel) (Entered: 09/08/2006)

09/08/2006 805 Joint SEALED PATENT MOTION for Approval of Alternate Security Under Rule 62(d) and for Stay of Enforcement of Money Judgment by "EchoStar defendants". (Attachments: # (1) Text of Proposed Order)(Krevans, Rachel) Revised Proposed Order added on 9/11/2006 (mpv,). Modified on 9/11/2006 (mpv,). (Entered: 09/08/2006)

09/08/2006 806 AMENDED FINAL JUDGMENT AND PERMANENT INJUNCTION. Signed by Judge David Folsom on 9/8/06. (mpv,) (Entered: 09/11/2006)

09/11/2006 807 RESPONSE to 797 Bill of Costs, EchoStar's Objection to TiVo's Bill of Costs by "EchoStar defendants". (Krevans, Rachel) (Entered: 09/11/2006)

09/12/2006 808 ORDER granting [805] Sealed Patent Motion . Signed by Judge David Folsom on 9/12/06. (mpv,) (Entered: 09/12/2006)

09/21/2006 809 NOTICE OF CROSS APPEAL by TIVO Inc. Filing fee \$ 455, receipt number 881854. (Giza, Alexander) (Entered: 09/21/2006)

09/22/2006 810 Amended BILL OF COSTS by TIVO Inc. (Attachments: # 1 Affidavit Amended Bill of Costs Brief# 2 Exhibit Ex. A to Amended Bill of Costs Brief# 3 Exhibit Ex. B1 to Amended Bill of Costs Brief# 4 Exhibit Ex. B2 to Amended Bill of Costs Brief# 5 Exhibit Ex. B3 to Amended Bill of Costs Brief# 6 Exhibit Ex. B4 to Amended Bill of Costs Brief# 7 Exhibit Ex. C to Amended Bill of Costs Brief# 8 Exhibit Ex. D to Amended Bill of Costs Brief)(Giza, Alexander) (Entered: 09/22/2006)

09/27/2006 811 RESPONSE to 810 Bill of Costs, EchoStar's Objection to TiVo's Amended Bill of Costs by "EchoStar defendants". (Krevans, Rachel) (Entered: 09/27/2006)

10/04/2006 812 NOTICE by "EchoStar defendants" of Order (Attachments: # 1 Exhibit A)(McElhinny, Harold) (Entered: 10/04/2006)

10/04/2006 813 RESPONSE to 811 Response to Non-Motion EchoStar's Objection to TiVo's Amended Bill of Costs by TIVO Inc. (Giza, Alexander) (Entered: 10/04/2006)

10/09/2006 814 RESPONSE to 813 Response to Non-Motion EchoStar's Objection to TiVo's Amended Bill of Costs by "EchoStar defendants". (Krevans, Rachel) (Entered: 10/09/2006)

10/27/2006 815 USCA Federal Circuit Case Number 2007-1022 for 809 Notice of Cross Appeal filed by TIVO Inc. (ehs,) (Entered: 10/27/2006)

11/27/2006 816 ORDER denying [764] Sealed Patent Motion EchoStar's Rule 50(b) Renewed Motion for Judgment as a Matter of Law, denying [765] Sealed Patent Motion EchoStar's Rule 59 Motion for New Trial and/or Remittitur by "EchoStar defendants". Signed by Judge David Folsom on 11/27/06. (mrm,) (Entered: 11/27/2006)

01/03/2007 817 Sealed Document. (Attachments: # (1) Exhibit Exhibits)(Byrd, Christine) (Entered: 01/03/2007)

01/03/2007 818 STIPULATION JOINT STIPULATION RE SUPPLEMENTAL DAMAGES AND PREJUDGMENT INTEREST FOR THE PERIOD OF AUGUST 1, 2006 TO SEPTEMBER 8, 2006 by TIVO Inc. (Attachments: # 1 Text of Proposed Order Proposed Order)(Byrd, Christine) (Entered: 01/03/2007)

01/23/2007 819 ORDER RE: SUPPLEMENTAL DAMAGES AND PREJUDGMENT INTEREST FOR THE PERIOD OF AUGUST 1, 2006 TO SEPTEMBER 8, 2006; re 818 Stipulation filed by TIVO Inc, . Signed by Judge David Folsom on 1/23/07. (mrm,) (Entered: 01/23/2007)

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US District Court Civil Docket

**U.S. District - California Northern
(San Francisco)**

3:02cv365

Tivo Inc, v. Sonicblue Incorporated et al

This case was retrieved from the court on Thursday, April 18, 2002

Date Filed: 01/23/2002	Class Code:
Assigned To: Honorable D Lowell Jensen	Closed: no
Referred To:	Statute: 35:271
Nature of suit: Patent (830)	Jury Demand: Both
Cause: Patent Infringement	Demand Amount: \$0
Lead Docket: None	NOS Description: Patent
Other Docket: None	
Jurisdiction: Federal Question	

Litigants

Tivo Inc, , A Delaware Corporation
Plaintiff

Perry M Goldberg
[COR LD NTC]
Irell & Manella LLP
1800 Avenue of the Stars, Suite 900
Los Angeles , CA 90067-4276
USA
(310)277-1010

Michael A Schaldenbrand
[COR LD NTC]
Irell & Manella
1800 Avenue of the Stars
Suite 900
Los Angeles , CA 90067-4276
USA
310-277-1010

Sonicblue Incorporated, A Delaware Corporation
Defendant

Replaytv, Inc, A Delaware Corporation
Defendant

Replaytv, Inc, A Delaware Corporation
Counter-Claimant

Sonicblue Incorporated, A Delaware Corporation
Counter-Claimant

Tivo Inc, , A Delaware Corporation
Counter-Defendant

Attorneys

Date	#	Proceeding Text
01/23/2002	1	COMPLAINT for Patent Infringement against Replaytv, Inc., Sonicblue Incorporated (Filing fee

$150 receipt number 5504550). Filed by Tivo Inc., (hdj,) (Entered: 01/30/2002)

01/23/2002 2 ADR SCHEDULING ORDER: Case Management Statement due by 5/16/2002. Case Management Conference set for 5/23/2002 at 10:00 AM. (hdj,) (Entered: 01/30/2002)

01/23/2002 -- Summons Issued as to Replaytv, Inc. ; Sonicblue Incorporated (hdj,) (Entered: 01/30/2002)

01/29/2002 3 SUMMONS Returned Executed, by Tivo Inc., Replaytv, Inc. ; Sonicblue Incorporated (hdj,) (Entered: 01/31/2002)

02/11/2002 4 NOTICE of Related Case 01-4865-RMW by Replaytv, Inc., Sonicblue Incorporated. (hdj,) (Entered: 02/12/2002)

02/11/2002 5 ANSWER to Complaint, COUNTERCLAIM against Tivo Inc., by Replaytv, Inc., Sonicblue Incorporated. (hdj,) (Entered: 02/12/2002)

02/11/2002 6 Certificate of Interested Entities by Replaytv, Inc., Sonicblue Incorporated. (hdj,) (Entered: 02/12/2002)

02/19/2002 7 Declination to Proceed Before a U.S. Magistrate Judge by Replaytv, Inc., Sonicblue Incorporated. (hdj,) (Entered: 02/20/2002)

02/26/2002 8 NOTICE re 4 Opposition to Defendants' Notice of Related Cases by Tivo Inc., (hdj,) (Entered: 02/27/2002)

03/01/2002 9 Reply ANSWER to Counterclaim by Tivo Inc., (hdj,) (Entered: 03/04/2002)

03/11/2002 10 Reply to Opposition re 8 filed by Replaytv, Inc., Sonicblue Incorporated. (hdj,) (Entered: 03/13/2002)

03/13/2002 11 ORDER Impending Reassignment to a United States District Court Judge. Signed by Judge Maria-Elena James on 3/13/02. (hdj,) (Entered: 03/14/2002)

03/13/2002 12 ORDER REASSIGNING CASE. Case reassigned to Judge D. Lowell Jensen for all further proceedings. Judge Maria-Elena James no longer assigned to case. Signed by Judge Executive Committee on 3/13/02. (hdj,) (Entered: 03/15/2002)

03/20/2002 13 CLERK'S NOTICE Case Management Conference set for 6/7/2002 at 01:30 PM. Case Management Statement due by 5/28/2002. (kc,) (Entered: 03/25/2002)

04/09/2002 14 ORDER NOT RELATING CASE to C-01-21198-RMW. Signed by Judge Ronald M. Whyte on 4/9/02. (jv,) Additional attachment(s) added on 4/17/2002 (jv,). Modified on 4/17/2002 to reflect that Judge Jensen is assigned to C-02-365 (jv,). (Entered: 04/09/2002)

US District Court Civil Docket

**U.S. District - California Northern
(Oakland)**

4:02cv365

Tivo Inc, v. Sonicblue Incorporated et al

This case was retrieved from the court on Friday, August 22, 2003

Date Filed: 01/23/2002	Class Code: ADRMOP, CLOSED
Assigned To: Honorable D Lowell Jensen	Closed: yes
Referred To:	Statute: 35:271
Nature of suit: Patent (830)	Jury Demand: Both
Cause: Patent Infringement	Demand Amount: \$0
Lead Docket: None	NOS Description: Patent
Other Docket: None	
Jurisdiction: Federal Question	

Litigants

Tivo Inc, , A Delaware Corporation
Plaintiff

Sonicblue Incorporated, A Delaware Corporation
Defendant

Replaytv, Inc, A Delaware Corporation

Attorneys

Perry M Goldberg
[COR LD NTC]
Irell & Manella LLP
1800 Avenue of the Stars, Suite 900
Los Angeles , CA 90067-4276
USA
(310)277-1010

Perry M Goldberg
[COR LD NTC]
Irell & Manella LLP
1800 Avenue of the Stars, Suite 900
Los Angeles , CA 90067-4276
USA
(310)277-1010

William F Abrams
[COR LD NTC]
Pillsbury Winthrop LLP
2550 Hanover Street
Palo Alto , CA 94304
USA
650-233-4500

William F Abrams
[COR LD NTC]
Pillsbury Winthrop LLP
2550 Hanover Street
Palo Alto , CA 94304
USA
650-233-4500

Nicole M Townsend

Defendant

[COR LD NTC]
Pillsbury Winthrop LLP
2550 Hanover Street
Palo Alto , CA 94304-1115
USA
(650)233-4650

Nicole M Townsend
[COR LD NTC]
Pillsbury Winthrop LLP
2550 Hanover Street
Palo Alto , CA 94304-1115
USA
(650)233-4650

David A Jakopin
[COR LD NTC]
Pillsbury Winthrop LLP
2550 Hanover Street
Palo Alto , CA 94304-1115
USA
(650)233-4500

David A Jakopin
[COR LD NTC]
Pillsbury Winthrop LLP
2550 Hanover Street
Palo Alto , CA 94304-1115
USA
(650)233-4500

Replaytv, Inc, A Delaware Corporation
Counter-Claimant

William F Abrams
[COR LD NTC]
Pillsbury Winthrop LLP
2550 Hanover Street
Palo Alto , CA 94304
USA
650-233-4500

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[COR LD NTC]
Pillsbury Winthrop LLP
2550 Hanover Street
Palo Alto , CA 94304
USA
650-233-4500

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Nicole M Townsend
[COR LD NTC]
Pillsbury Winthrop LLP
2550 Hanover Street
Palo Alto , CA 94304-1115
USA
(650)233-4650

Nicole M Townsend
[COR LD NTC]
Pillsbury Winthrop LLP
2550 Hanover Street
Palo Alto , CA 94304-1115
USA
(650)233-4650

David A Jakopin
[COR LD NTC]

Pillsbury Winthrop LLP
2550 Hanover Street
Palo Alto , CA 94304-1115
USA
(650)233-4500

David A Jakopin
[COR LD NTC]
Pillsbury Winthrop LLP
2550 Hanover Street
Palo Alto , CA 94304-1115
USA
(650)233-4500

Tivo Inc, , A Delaware Corporation
Counter-Defendant

Michael A Schaldenbrand
[COR LD NTC]
Irell & Manella
1800 Avenue of the Stars
Suite 900
Los Angeles , CA 90067-4276
USA
310-277-1010

Michael A Schaldenbrand
[COR LD NTC]
Irell & Manella
1800 Avenue of the Stars
Suite 900
Los Angeles , CA 90067-4276
USA
310-277-1010

Morgan Chu
[COR LD NTC]
Irell & Manella LLP
1800 Avenue of the Stars
Suite 900
Los Angeles , CA 90067-4271
USA
310/ 277-1010
310-203-7199

Morgan Chu
[COR LD NTC]
Irell & Manella LLP
1800 Avenue of the Stars
Suite 900
Los Angeles , CA 90067-4271
USA
310/ 277-1010
310-203-7199

Date	#	Proceeding Text
01/23/2002	1	COMPLAINT for Patent Infringement against Replaytv, Inc., Sonicblue Incorporated (Filing fee \$150 receipt number 5504550). Filed by Tivo Inc., (hdj,) (Entered: 01/30/2002)
01/23/2002	2	ADR SCHEDULING ORDER: Case Management Statement due by 5/16/2002. Case Management Conference set for 5/23/2002 at 10:00 AM. (hdj,) (Entered: 01/30/2002)
01/23/2002	--	Summons Issued as to Replaytv, Inc. ; Sonicblue Incorporated (hdj,) (Entered: 01/30/2002)
01/29/2002	3	SUMMONS Returned Executed, by Tivo Inc., Replaytv, Inc. ; Sonicblue Incorporated (hdj,) (Entered: 01/31/2002)
02/11/2002	4	NOTICE of Related Case 01-4865-RMW by Replaytv, Inc., Sonicblue Incorporated. (hdj,) (Entered: 02/12/2002)

02/11/2002	5	ANSWER to Complaint, COUNTERCLAIM against Tivo Inc., by Replaytv, Inc., Sonicblue Incorporated. (hdj,) (Entered: 02/12/2002)
02/11/2002	6	Certificate of Interested Entities by Replaytv, Inc., Sonicblue Incorporated. (hdj,) (Entered: 02/12/2002)
02/19/2002	7	Declination to Proceed Before a U.S. Magistrate Judge by Replaytv, Inc., Sonicblue Incorporated. (hdj,) (Entered: 02/20/2002)
02/26/2002	8	NOTICE re 4 Opposition to Defendants' Notice of Related Cases by Tivo Inc., (hdj,) (Entered: 02/27/2002)
03/01/2002	9	Reply ANSWER to Counterclaim by Tivo Inc., (hdj,) (Entered: 03/04/2002)
03/11/2002	10	Reply to Opposition re 8 filed by Replaytv, Inc., Sonicblue Incorporated. (hdj,) (Entered: 03/13/2002)
03/13/2002	11	ORDER Impending Reassignment to a United States District Court Judge. Signed by Judge Maria-Elena James on 3/13/02. (hdj,) (Entered: 03/14/2002)
03/13/2002	12	ORDER REASSIGNING CASE. Case reassigned to Judge D. Lowell Jensen for all further proceedings. Judge Maria-Elena James no longer assigned to case. Signed by Judge Executive Committee on 3/13/02. (hdj,) (Entered: 03/15/2002)
03/20/2002	13	CLERK'S NOTICE Case Management Conference set for 6/7/2002 at 01:30 PM. Case Management Statement due by 5/28/2002. (kc,) (Entered: 03/25/2002)
04/09/2002	14	ORDER NOT RELATING CASE to C-01-21198-RMW. Signed by Judge Ronald M. Whyte on 4/9/02. (jv,) Additional attachment(s) added on 4/17/2002 (jv,). Modified on 4/17/2002 to reflect that Judge Jensen is assigned to C-02-365 (jv,). (Entered: 04/09/2002)
04/17/2002	15	AMENDED ORDER: deeming C01-21198RMW and C02-365DLJ NOT RELATED . Signed by Judge Ronald M. Whyte on 4/9/02. (kk,) (Entered: 05/02/2002)
05/10/2002	16	STIPULATION selecting Mediation by Replaytv, Inc., Sonicblue Incorporated, Tivo Inc., (kc,) (Entered: 05/10/2002)
06/21/2002	--	Received Document stipulation & proposed order resetting initial case management conference by Tivo Inc., (kk,) (Entered: 06/24/2002)
06/27/2002	17	STIPULATION AND ORDER resetting Case Management Conference for 10/18/2002 at 01:30 PM. Signed by Judge D. Lowell Jensen on 6/27/02. (kc,) (Entered: 06/28/2002)
11/12/2002	18	Stipulation and ORDER DISMISSING CASE without prejudice, each party to bear its own costs. Signed by Judge D. Lowell Jensen on 11/12/02. (kc,) (Entered: 11/14/2002)
12/13/2002	19	NOTICE re 18 by Replaytv, Inc., Sonicblue Incorporated. (kk,) (Entered: 12/16/2002)

Source: [Command Searching > Utility, Design and Plant Patents](#)

Terms: **patno=6233389** ([Edit Search](#) | [Suggest Terms for My Search](#))

126071 (09) 6233389 May 15, 2001

UNITED STATES PATENT AND TRADEMARK OFFICE GRANTED PATENT

6233389

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[Link to Claims Section](#)

May 15, 2001

Multimedia time warping system

REEXAM-LITIGATE: October 17, 2005 - Reexamination requested October 17, 2005 by Echostar Communications Corporation, Englewood, CO, (Attny. Is: David L. Fehrman, Morrison & Foerster, LLP, Los Angeles, CA), Reexamination No. 90/007,750 (O.G. January 31, 2006) Ex. Gp.: 3992

NOTICE OF LITIGATION

Tivo Inc. v. Sonicblue Incorporated, et al, Filed Jan. 23, 2002, D.C. N.D. California, Doc. No. C-02-365

NOTICE OF LITIGATION

Tivo, Inc v. Echostar Communications Corporation et al, Filed October 28, 2005, D.C. N.D. Georgia, Doc. No. 1:05cv2799

11/3/2005

NOTICE OF LITIGATION

Tivo, Inc v. Echostar Communications Corporation et al, Filed July 21, 2005, D.C. N.D. Georgia, Doc. No. 1:05mi208

7/25/2005

NOTICE OF LITIGATION

Tivo, Inc v. Echostar Communications Corporation et al, Filed July 7, 2005, D.C. N.D. Georgia, Doc. No. 1:05mi190

7/18/2005

NOTICE OF LITIGATION

Tivo Inc v. Echostar Comm, et al, Filed January 5, 2004, D.C. E.D. Texas, Doc. No. 2:04cv1

INVENTOR: Barton, James M. - Los Gatos, California, United States (US); McInnis, Roderick James - Milpitas, California, United States (US); Moskowitz, Alan S. - San Francisco, California, United States (US); Goodman, Andrew Martin - Menlo Park, California, United States (US); Chow, Ching Tong - Fremont, California, United States (US); Kao, Jean Swey - Cupertino, California, United States (US)

APPL-NO: 126071 (09)

FILED-DATE: July 30, 1998

GRANTED-DATE: May 15, 2001

ASSIGNEE-PRE-ISSUE: July 30, 1998 - ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS)., TIVO, INC. SUITE 100 894 ROSS DRIVESUNNYVALE, CALIFORNIA, 94089, Reel and Frame Number: 009377/0779

ASSIGNEE-AT-ISSUE: TiVo, Inc., Alviso, California, United States (US), United States company or corporation (02)

ASSIGNEE-AFTER-ISSUE: February 8, 2007 - SECURITY AGREEMENT, CITYGROUP GLOBAL MARKETS REALTY CORP. 390 GREENWICH STREET NEW YORK NEW YORK 10013, Reel and Frame Number: 018866/0510

February 12, 2007 - CORRECTIVE ASSIGNMENT TO CORRECT THE NAME OF RECEIVING PARTY PREVIOUSLY RECORDED ON REEL 018866 FRAME 0510. ASSIGNOR(S) HEREBY CONFIRMS THE SECURITY AGREEMENT., CITIGROUP GLOBAL MARKETS REALTY CORP. 390 GREENWICH STREET NEW YORK NEW YORK 10013, Reel and Frame Number: 018875/0933

LEGAL-REP: Glenn, Michael A.; Wong, Kirk

PUB-TYPE: May 15, 2001 - Utility Patent having no previously published pre-grant publication (B1)

PUB-COUNTRY: United States (US)

US-MAIN-CL: 386#46

US-ADDL-CL: 348#E05.007, 348#E05.108, 386#68

CL: 386, 348

SEARCH-FLD: 386#1, 386#33, 386#45, 386#46, 386#68, 369#60, 366#7, 366#33, 348#7, 348#10, 348#571, 348#714, 348#722, 348#725, 386#111-112, 386#125-126

IPC-MAIN-CL: [7] H04N 005#92

PRIM-EXMR: Tran, Thai

REF-CITED:

RE 33535, February, 1991, Cooper, United States (US), 358#149

4313135, January, 1982, Cooper, United States (US), 358#149
4665431, May, 1987, Cooper, United States (US), 358#145
5202761, April, 1993, Cooper, United States (US), 358#149
5371551, December, 1994, Logan et al., United States (US), 348#571
5438423, August, 1995, Lynch et al., United States (US), 358#335
5550594, August, 1996, Cooper et al., United States (US), 348#513
5572261, November, 1996, Cooper, United States (US), 348#512
5675388, October, 1997, Cooper, United States (US), 348#461
5696868, December, 1997, Kim et al., United States (US), 386#46
5706388, January, 1998, Isaka, United States (US), 386#125
5787225, July, 1998, Honjo, United States (US), 386#111
5920842, July, 1999, Cooper et al., United States (US), 704#503
5937138, August, 1999, Fukuda et al., United States (US), 386#112
0726574, August, 1996, European Patent Office (EP), G11#B 2.7034

NON-PATENT LITERATURE: ASTARTE DVDirector[TM] Beta Testing Program.

CORE TERMS: buffer, stream, video, audio, input, segment, decoder, user, fast, storage, transform, pipeline, stored, sink, parser, forward, analog, sequence, switch, engine, viewer, pause, broadcast, extracted, logical, capture, slow, multimedia, recorded, circular

ENGLISH-ABST:

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.

NO-OF-CLAIMS: 61

EXMPL-CLAIM: 1

NO-OF-FIGURES: 13

NO-DRWNG-PP: 12

SUMMARY:

BACKGROUND OF THE INVENTION

1. Technical Field

The invention relates to the time shifting of television broadcast signals. More particularly, the invention relates to the real time capture, storage, and display of television broadcast signals.

2. Description of the Prior Art

The Video Cassette Recorder (VCR) has changed the lives of television (TV) viewers throughout the world. The VCR has offered viewers the flexibility to time-shift TV programs to match their lifestyles.

The viewer stores TV programs onto magnetic tape using the VCR. The VCR gives the viewer the ability to play, rewind, fast forward and pause the stored program material. These functions enable the viewer to pause the program playback whenever he desires, fast forward through unwanted program material or commercials, and to replay favorite scenes. However, a VCR cannot both capture and play back information at the same time.

One approach to solving this problem is to use several VCRs. For example, if two video tape recorders are available, it might be possible to Ping-Pong between the two. In this case, the first recorder is started at the beginning of the program of interest. If the viewer wishes to rewind the broadcast, the second recorder begins recording, while the first recorder is halted, rewound to the appropriate place, and playback initiated. However, at least a third video tape recorder is required if the viewer wishes to fast forward to some point in time after the initial rewind was requested. In this case, the third recorder starts recording the broadcast stream while the second is halted and rewound to the appropriate position. Continuing this exercise, one can quickly see that the equipment becomes unwieldy, unreliable, expensive, and hard to operate, while never supporting all desired functions. In addition, tapes are of finite length, and may potentially end at inconvenient times, drastically lowering the value of the solution.

The use of digital computer systems to solve this problem has been suggested. U.S. Pat. No. 5,371,551 issued to Logan et al., on Dec. 6, 1994, teaches a method for concurrent video recording and playback. It presents a microprocessor controlled broadcast and playback device. Said device compresses and stores video data onto a hard disk. However, this approach is difficult to implement because the processor requirements for keeping up with the high video rates makes the device expensive and problematic. The microprocessor must be extremely fast to keep up with the incoming and outgoing video data.

It would be advantageous to provide a multimedia time warping system that gives the user the ability to simultaneously record and play back TV broadcast programs. It would further be advantageous to provide a multimedia time warping system that utilizes an approach that decouples the microprocessor from the high video data rates, thereby reducing the microprocessor and system requirements which are at a premium.

SUMMARY OF THE INVENTION

The invention provides a multimedia time warping system. The invention utilizes an easily manipulated, low cost multimedia storage and display system that allows the user to view a television broadcast program with the option of instantly reviewing previous scenes within the program. In addition, 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, analog forms such as 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). Analog TV streams are converted to an Moving Pictures Experts Group (MPEG) formatted stream for internal transfer and manipulation, while pre-formatted MPEG streams are extracted from the digital TV signal and presented in a similar format to encoded analog streams.

The invention parses the resulting MPEG stream and separates it into its video and audio components. It then stores the components into 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. This decoupling allows for slower CPU and bus speeds which translate to lower system costs. The video and audio components are stored on a storage device. When the program is requested for display, the video and audio components are extracted from the storage device and reassembled into an MPEG stream. The MPEG stream 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.

Other aspects and advantages of the invention will become apparent from the following detailed description in combination with the accompanying drawings, illustrating, by way of example, the principles of the invention.

DRWDESC:

BRIEF DESCRIPTION OF THE DRAWINGS

FIG. 1 is a block schematic diagram of a high level view of a preferred embodiment of the invention according to the invention;

FIG. 2 is a block schematic diagram of a preferred embodiment of the invention using multiple input and output modules according to the invention;

FIG. 3 is a schematic diagram of an Moving Pictures Experts Group (MPEG) data stream and its video and audio components according to the invention;

FIG. 4 is a block schematic diagram of a parser and four direct memory access (DMA) input engines contained in the Media Switch according to the invention;

FIG. 5 is a schematic diagram of the components of a packetized elementary stream (PES) buffer according to the invention;

FIG. 6 is a schematic diagram of the construction of a PES buffer from the parsed components in the Media Switch output circular buffers;

FIG. 7 is a block schematic diagram of the Media Switch and the various components that it communicates with according to the invention;

FIG. 8 is a block schematic diagram of a high level view of the program logic according to the invention;

FIG. 9 is a block schematic diagram of a class hierarchy of the program logic according to the invention;

FIG. 10 is a block schematic diagram of a preferred embodiment of the clip cache component of the invention according to the invention;

FIG. 11 is a block schematic diagram of a preferred embodiment of the invention that emulates a broadcast studio video mixer according to the invention;

FIG. 12 is a block schematic diagram of a closed caption parser according to the invention; and

FIG. 13 is a block schematic diagram of a high level view of a preferred embodiment of the invention utilizing a VCR as an integral component of the invention according to the invention.

DETDESC:

DETAILED DESCRIPTION OF THE INVENTION

The invention is embodied in a multimedia time warping system. A system according to the invention provides a multimedia storage and display system that allows the user to view a television broadcast program with the option of instantly reviewing previous scenes within the program. The invention additionally provides the user with the ability to store selected television broadcast programs while simultaneously watching or reviewing another program and to view stored programs with at least the following functions: reverse, fast forward, play, pause, index, fast/slow reverse play, and fast/slow play.

Referring to FIG. 1, a preferred embodiment of the invention has an Input Section 101, Media Switch 102, and an Output Section 103. The Input Section 101 takes 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). DBS, DSS and ATSC are based on standards called Moving Pictures Experts Group 2 (MPEG2) and MPEG2 Transport. MPEG2 Transport is a standard for formatting the digital data stream from the TV source transmitter so that a TV receiver can disassemble the input stream to find programs in the multiplexed signal. The Input Section 101 produces MPEG streams. An MPEG2 transport multiplex supports multiple programs in the same broadcast channel, with multiple video and audio feeds and private data. The Input Section 101 tunes the channel to a particular program, extracts a specific MPEG program out of it, and feeds it to the rest of the system. Analog TV signals are encoded into a similar MPEG format using separate video and audio encoders, such that the remainder of the system is unaware of how the signal was obtained. Information may be modulated into the Vertical Blanking Interval (VBI) of the analog TV signal in a number of standard ways; for example, the North American Broadcast Teletext Standard (NABTS) may be used to modulate information onto lines 10 through 20 of an NTSC signal, while the FCC mandates the use of line 21 for Closed Caption (CC) and Extended Data Services (EDS). Such signals are decoded by the input section and passed to

the other sections as if they were delivered via an MPEG2 private data channel.

The Media Switch 102 mediates between a microprocessor CPU 106, hard disk or storage device 105, and memory 104. Input streams are converted to an MPEG stream and sent to the Media Switch 102. The Media Switch 102 buffers the MPEG stream into memory. It then performs two operations if the user is watching real time TV: the stream is sent to the Output Section 103 and it is written simultaneously to the hard disk or storage device 105.

The Output Section 103 takes MPEG streams as input and produces an analog TV signal according to the NTSC, PAL, or other required TV standards. The Output Section 103 contains an MPEG decoder, On-Screen Display (OSD) generator, analog TV encoder and audio logic. The OSD generator allows the program logic to supply images which will be overlaid on top of the resulting analog TV signal. Additionally, the Output Section can modulate information supplied by the program logic onto the VBI of the output signal in a number of standard formats, including NABTS, CC and EDS.

With respect to FIG. 2, the invention easily expands to accommodate multiple Input Sections (tuners) 201, 202, 203, 204, each can be tuned to different types of input. Multiple Output Modules (decoders) 206, 207, 208, 209 are added as well. Special effects such as picture in a picture can be implemented with multiple decoders. The Media Switch 205 records one program while the user is watching another. This means that a stream can be extracted off the disk while another stream is being stored onto the disk.

Referring to FIG. 3, the incoming MPEG stream 301 has interleaved video 302, 305, 306 and audio 303, 304, 307 segments. These elements must be separated and recombined to create separate video 308 and audio 309 streams or buffers. This is necessary because separate decoders are used to convert MPEG elements back into audio or video analog components. Such separate delivery requires that time sequence information be generated so that the decoders may be properly synchronized for accurate playback of the signal.

The Media Switch enables the program logic to associate proper time sequence information with each segment, possibly embedding it directly into the stream. The time sequence information for each segment is called a time stamp. These time stamps are monotonically increasing and start at zero each time the system boots up. This allows the invention to find any particular spot in any particular video segment. For example, if the system needs to read five seconds into an incoming contiguous video stream that is being cached, the system simply has to start reading forward into the stream and look for the appropriate time stamp.

A binary search can be performed on a stored file to index into a stream. Each stream is stored as a sequence of fixed-size segments enabling fast binary searches because of the uniform time stamping. If the user wants to start in the middle of the program, the system performs a binary search of the stored segments until it finds the appropriate spot, obtaining the desired results with a minimal amount of information. If the signal were instead stored as an MPEG stream, it would be necessary to linearly parse the stream from the beginning to find the desired location.

With respect to FIG. 4, the Media Switch contains four input Direct Memory Access (DMA) engines 402, 403, 404, 405 each DMA engine has an associated buffer 410, 411, 412, 413. Conceptually, each DMA engine has a pointer 406, a limit for that pointer 407, a next pointer 408, and a limit for the next pointer 409. Each DMA engine is dedicated to a particular type of information, for example, video 402, audio 403, and parsed events 405. The buffers 410, 411, 412, 413 are circular and collect the specific information. The DMA engine increments the pointer 406 into the associated buffer until it reaches the limit 407 and then loads the next pointer 408 and limit 409. Setting the pointer 406 and next pointer 408 to the same value, along with the corresponding limit value creates a circular buffer. The next pointer 408 can be set to a different address to provide vector DMA.

The input stream flows through a parser 401. The parser 401 parses the stream looking for MPEG distinguished events indicating the start of video, audio or private data segments. For example, when the parser 401 finds a video event, it directs the stream to the video DMA engine 402. The parser 401 buffers up data and DMAs it into the video buffer 410 through the video DMA engine 402. At the same time, the parser 401 directs an event to the event DMA engine 405 which generates an event into the event buffer 413. When the parser 401 sees an audio event, it redirects the byte stream to the audio DMA engine 403 and generates an event into the event buffer 413. Similarly, when the parser 401 sees a private data event, it directs the byte stream to the private data DMA engine 404 and directs an event to the event buffer 413. The Media Switch notifies the program logic via an interrupt mechanism when events are placed in the event buffer.

Referring to FIGS. 4 and 5, the event buffer 413 is filled by the parser 401 with events. Each event 501 in the event buffer has an offset 502, event type 503, and time stamp field 504. The parser 401 provides the type and offset of each event as it is placed into the buffer. For example, when an audio event occurs, the event type field is set to an audio event and the offset indicates the location in the audio buffer 411. The program logic knows where the audio buffer 411 starts and adds the offset to find the event in the stream. The address offset 502 tells the program logic where the next event occurred, but not where it ended. The previous event is cached so the end of the current event can be found as well as the length of the segment.

With respect to FIGS. 5 and 6, the program logic reads accumulated events in the event buffer 602 when it is interrupted by the Media Switch 601. From these events the program logic generates a sequence of logical segments 603 which correspond to the parsed MPEG segments 615. The program logic converts the offset 502 into the actual address 610 of each segment, and records the event length 609 using the last cached event. If the stream was produced by encoding an analog signal, it will not contain Program Time Stamp (PTS) values, which are used by the decoders to properly present the resulting output. Thus, the program logic uses the generated time stamp 504 to calculate a simulated PTS for each segment and places that into the logical segment time stamp 607. In the case of a digital TV stream, PTS values are already encoded in the stream. The program logic extracts this information and places it in the logical segment time stamp 607.

The program logic continues collecting logical segments 603 until it reaches the fixed buffer size. When this occurs, the program logic generates a new buffer, called a Packetized Elementary Stream (PES) 605 buffer containing these logical segments 603 in order, plus ancillary control information. Each logical segment points 604 directly to the circular buffer, e.g., the video buffer 613, filled by the Media Switch 601. This new buffer is then passed to other logic components, which may further process the stream in the buffer in some way, such as presenting it for decoding or writing it to the storage media. Thus, the MPEG data is not copied from one location in memory to another by the processor. This results in a more cost effective design since lower memory bandwidth and processor bandwidth is required.

A unique feature of the MPEG stream transformation into PES buffers is that the data associated with logical segments need not be present in the buffer itself, as presented above. When a PES buffer is written to storage, these logical segments are written to the storage medium in the logical order in which they appear. This has the effect of gathering components of the stream, whether they be in the video, audio or private data circular buffers, into a single linear buffer of stream data on the storage medium. The buffer is read back from the storage medium with a single transfer from the storage media, and the logical segment information is updated to correspond with the actual locations in the buffer 606. Higher level program logic is unaware of this transformation, since it handles only the logical segments, thus stream data is easily managed without requiring that the data ever be copied between locations in DRAM by the CPU.

A unique aspect of the Media Switch is the ability to handle high data rates effectively and inexpensively. It performs the functions of taking video and audio data in, sending video and audio data out, sending video and audio data to disk, and extracting video and audio data from the disk on a low cost platform. Generally, the Media Switch runs asynchronously and autonomously with the microprocessor CPU, using its DMA capabilities to move large quantities of information with minimal intervention by the CPU.

Referring to FIG. 7, the input side of the Media Switch 701 is connected to an MPEG encoder 703. There are also circuits specific to MPEG audio 704 and vertical blanking interval (VBI) data 702 feeding into the Media Switch 701. If a digital TV signal is being processed instead, the MPEG encoder 703 is replaced with an MPEG2 Transport Demultiplexor, and the MPEG audio encoder 704 and VBI decoder 702 are deleted. The demultiplexor multiplexes the extracted audio, video and private data channel streams through the video input Media Switch port.

The parser 705 parses the input data stream from the MPEG encoder 703, audio encoder 704 and VBI decoder 702, or from the transport demultiplexor in the case of a digital TV stream. The parser 705 detects the beginning of all of the important events in a video or audio stream, the start of all of the frames, the start of sequence headers—all of the pieces of information that the program logic needs to know about in order to both properly play back and perform special effects on the stream, e.g. fast forward, reverse, play, pause, fast/slow play, indexing, and fast/slow reverse play.

The parser 705 places tags 707 into the FIFO 706 when it identifies video or audio segments, or is given private data. The DMA 709 controls when these tags are taken out. The tags 707 and the DMA addresses of the segments are placed into the event queue 708. The frame type information, whether it is a start of a video I-frame, video B-frame, video P-frame, video PES, audio PES, a sequence header, an audio frame, or private data packet, is placed into the event queue 708 along with the offset in the related circular buffer where the piece of information was placed. The program logic operating in the CPU 713 examines events in the circular buffer after it is transferred to the DRAM 714.

The Media Switch 701 has a data bus 711 that connects to the CPU 713 and DRAM 714. An address bus 712 is also shared between the Media Switch 701, CPU 713, and DRAM 714. A hard disk or storage device 710 is connected to one of the ports of the Media Switch 701. The Media Switch 701 outputs streams to an MPEG video decoder 715 and a separate audio decoder 717. The audio decoder 717 signals contain audio cues generated by the system in response to the user's commands on a remote control or other internal events. The decoded audio output from the MPEG decoder is digitally mixed 718 with the separate audio signal. The resulting signals contain video, audio, and on-screen displays and are sent to the TV 716.

The Media Switch 701 takes in 8-bit data and sends it to the disk, while at the same time extracts another stream of data off of the disk and sends it to the MPEG decoder 715. All of the DMA engines described above can be working at the same time. The Media Switch 701 can be implemented in hardware using a Field Programmable Gate Array (FPGA), ASIC, or discrete logic.

Rather than having to parse through an immense data stream looking for the start of where each frame would be, the program logic only has to look at the circular event buffer in DRAM 714 and it can tell where the start of each frame is and the frame type. This approach saves a large amount of CPU power, keeping the real time requirements of the CPU 713 small. The CPU 713 does not have to be very fast at any point in time. The Media Switch 701 gives the CPU 713 as much time as possible to complete tasks. The parsing mechanism 705 and event queue 708 decouple the CPU 713 from parsing the audio, video, and buffers and the real

time nature of the streams, which allows for lower costs. It also allows the use of a bus structure in a CPU environment that operates at a much lower clock rate with much cheaper memory than would be required otherwise.

The CPU 713 has the ability to queue up one DMA transfer and can set up the next DMA transfer at its leisure. This gives the CPU 713 large time intervals within which it can service the DMA controller 709. The CPU 713 may respond to a DMA interrupt within a larger time window because of the large latency allowed. MPEG streams, whether extracted from an MPEG2 Transport or encoded from an analog TV signal, are typically encoded using a technique called Variable Bit Rate encoding (VBR). This technique varies the amount of data required to represent a sequence of images by the amount of movement between those images. This technique can greatly reduce the required bandwidth for a signal, however sequences with rapid movement (such as a basketball game) may be encoded with much greater bandwidth requirements. For example, the Hughes DirecTV satellite system encodes signals with anywhere from 1 to 10 Mb/s of required bandwidth, varying from frame to frame. It would be difficult for any computer system to keep up with such rapidly varying data rates without this structure.

With respect to FIG. 8, the program logic within the CPU has three conceptual components: sources 801, transforms 802, and sinks 803. The sources 801 produce buffers of data. Transforms 802 process buffers of data and sinks 803 consume buffers of data. A transform is responsible for allocating and queuing the buffers of data on which it will operate. Buffers are allocated as if "empty" to sources of data, which give them back "full". The buffers are then queued and given to sinks as "full", and the sink will return the buffer "empty".

A source 801 accepts data from encoders, e.g., a digital satellite receiver. It acquires buffers for this data from the downstream transform, packages the data into a buffer, then pushes the buffer down the pipeline as described above. The source object 801 does not know anything about the rest of the system. The sink 803 consumes buffers, taking a buffer from the upstream transform, sending the data to the decoder, and then releasing the buffer for reuse.

There are two types of transforms 802 used: spatial and temporal. Spatial transforms are transforms that perform, for example, an image convolution or compression/decompression on the buffered data that is passing through. Temporal transforms are used when there is no time relation that is expressible between buffers going in and buffers coming out of a system. Such a transform writes the buffer to a file 804 on the storage medium. The buffer is pulled out at a later time, sent down the pipeline, and properly sequenced within the stream.

Referring to FIG. 9, a C++ class hierarchy derivation of the program logic is shown. The TiVo Media Kernel (Tmk) 904, 908, 913 mediates with the operating system kernel. The kernel provides operations such as: memory allocation, synchronization, and threading. The TmkCore 904, 908, 913 structures memory taken from the media kernel as an object. It provides operators, new and delete, for constructing and deconstructing the object. Each object (source 901, transform 902, and sink 903) is multi-threaded by definition and can run in parallel.

The TmkPipeline class 905, 909, 914 is responsible for flow control through the system. The pipelines point to the next pipeline in the flow from source 901 to sink 903. To pause the pipeline, for example, an event called "pause" is sent to the first object in the pipeline. The event is relayed on to the next object and so on down the pipeline. This all happens asynchronously to the data going through the pipeline. Thus, similar to applications such as telephony, control of the flow of MPEG streams is asynchronous and separate from the streams themselves. This allows for a simple logic design that is at the same time powerful enough to support the features described previously, including pause, rewind, fast forward and others. In addition, this structure allows fast and efficient switching between stream

sources, since buffered data can be simply discarded and decoders reset using a single event, after which data from the new stream will pass down the pipeline. Such a capability is needed, for example, when switching the channel being captured by the input section, or when switching between a live signal from the input section and a stored stream.

The source object 901 is a TmkSource 906 and the transform object 902 is a TmkXfrm 910. These are intermediate classes that define standard behaviors for the classes in the pipeline. Conceptually, they handshake buffers down the pipeline. The source object 901 takes data out of a physical data source, such as the Media Switch, and places it into a PES buffer. To obtain the buffer, the source object 901 asks the down stream object in his pipeline for a buffer (allocEmptyBuf). The source object 901 is blocked until there is sufficient memory. This means that the pipeline is self-regulating; it has automatic flow control. When the source object 901 has filled up the buffer, it hands it back to the transform 902 through the pushFullBuf function.

The sink 903 is flow controlled as well. It calls nextFullBuf which tells the transform 902 that it is ready for the next filled buffer. This operation can block the sink 903 until a buffer is ready. When the sink 903 is finished with a buffer (i.e., it has consumed the data in the buffer) it calls releaseEmptyBuf. ReleaseEmptyBuf gives the buffer back to the transform 902. The transform 902 can then hand that buffer, for example, back to the source object 901 to fill up again. In addition to the automatic flow-control benefit of this method, it also provides for limiting the amount of memory dedicated to buffers by allowing enforcement of a fixed allocation of buffers by a transform. This is an important feature in achieving a cost-effective limited DRAM environment.

The MediaSwitch class 909 calls the allocEmptyBuf method of the TmkClipCache 912 object and receives a PES buffer from it. It then goes out to the circular buffers in the Media Switch hardware and generates PES buffers. The MediaSwitch class 909 fills the buffer up and pushes it back to the TmkClipCache 912 object.

The TmkClipCache 912 maintains a cache file 918 on a storage medium. It also maintains two pointers into this cache: a push pointer 919 that shows where the next buffer coming from the source 901 is inserted; and a current pointer 920 which points to the current buffer used.

The buffer that is pointed to by the current pointer is handed to the Vela decoder class 916. The Vela decoder class 916 talks to the decoder 921 in the hardware. The decoder 921 produces a decoded TV signal that is subsequently encoded into an analog TV signal in NTSC, PAL or other analog format. When the Vela decoder class 916 is finished with the buffer it calls releaseEmptyBuf.

The structure of the classes makes the system easy to test and debug. Each level can be tested separately to make sure it performs in the appropriate manner, and the classes may be gradually aggregated to achieve the desired functionality while retaining the ability to effectively test each object.

The control object 917 accepts commands from the user and sends events into the pipeline to control what the pipeline is doing. For example, if the user has a remote control and is watching TV, the user presses pause and the control object 917 sends an event to the sink 903, that tells it pause. The sink 903 stops asking for new buffers. The current pointer 920 stays where it is at. The sink 903 starts taking buffers out again when it receives another event that tells it to play. The system is in perfect synchronization; it starts from the frame that it stopped at.

The remote control may also have a fast forward key. When the fast forward key is pressed, the control object 917 sends an event to the transform 902, that tells it to move forward two

seconds. The transform 902 finds that the two second time span requires it to move forward three buffers. It then issues a reset event to the downstream pipeline, so that any queued data or state that may be present in the hardware decoders is flushed. This is a critical step, since the structure of MPEG streams requires maintenance of state across multiple frames of data, and that state will be rendered invalid by repositioning the pointer. It then moves the current pointer 920 forward three buffers. The next time the sink 903 calls nextFullBuf it gets the new current buffer. The same method works for fast reverse in that the transform 902 moves the current pointer 920 backwards.

A system clock reference resides in the decoder. The system clock reference is sped up for fast play or slowed down for slow play. The sink simply asks for full buffers faster or slower, depending on the clock speed.

With respect to FIG. 10, two other objects derived from the TmkXfrm class are placed in the pipeline for disk access. One is called TmkClipReader 1003 and the other is called TmkClipWriter 1001. Buffers come into the TmkClipWriter 1001 and are pushed to a file on a storage medium 1004. TmkClipReader 1003 asks for buffers which are taken off of a file on a storage medium 1005. A TmkClipReader 1003 provides only the allocEmptyBuf and pushFullBuf methods, while a TmkClipWriter 1001 provides only the nextFullBuf and releaseEmptyBuf methods. A TmkClipReader 1003 therefore performs the same function as the input, or "push" side of a TmkClipCache 1002, while a TmkClipWriter 1001 therefore performs the same function as the output, or "pull" side of a TmkClipCache 1002.

Referring to FIG. 11, a preferred embodiment that accomplishes multiple functions is shown. A source 1101 has a TV signal input. The source sends data to a PushSwitch 1102 which is a transform derived from TmkXfrm. The PushSwitch 1102 has multiple outputs that can be switched by the control object 1114. This means that one part of the pipeline can be stopped and another can be started at the users whim. The user can switch to different storage devices. The PushSwitch 1102 could output to a TmkClipWriter 1106, which goes onto a storage device 1107 or write to the cache transform 1103.

An important feature of this apparatus is the ease with which it can selectively capture portions of an incoming signal under the control of program logic. Based on information such as the current time, or perhaps a specific time span, or perhaps via a remote control button press by the viewer, a TmkClipWriter 1106 may be switched on to record a portion of the signal, and switched off at some later time. This switching is typically caused by sending a "switch" event to the PushSwitch 1102 object.

An additional method for triggering selective capture is through information modulated into the VBI or placed into an MPEG private data channel. Data decoded from the VBI or private data channel is passed to the program logic. The program logic examines this data to determine if the data indicates that capture of the TV signal into which it was modulated should begin. Similarly, this information may also indicate when recording should end, or another data item may be modulated into the signal indicating when the capture should end. The starting and ending indicators may be explicitly modulated into the signal or other information that is placed into the signal in a standard fashion may be used to encode this information.

With respect to FIG. 12, an example is shown which demonstrates how the program logic scans the words contained within the closed caption (CC) fields to determine starting and ending times, using particular words or phrases to trigger the capture. A stream of NTSC or PAL fields 1201 is presented. CC bytes are extracted from each odd field 1202, and entered in a circular buffer 1203 for processing by the Word Parser 1204. The Word Parser 1204 collects characters until it encounters a word boundary, usually a space, period or other delineating character. Recall from above, that the MPEG audio and video segments are collected into a series of fixed-size PES buffers. A special segment is added to each PES

buffer to hold the words extracted from the CC field 1205. Thus, the CC information is preserved in time synchronization with the audio and video, and can be correctly presented to the viewer when the stream is displayed. This also allows the stored stream to be processed for CC information at the leisure of the program logic, which spreads out load, reducing cost and improving efficiency. In such a case, the words stored in the special segment are simply passed to the state table logic 1206.

During stream capture, each word is looked up in a table 1206 which indicates the action to take on recognizing that word. This action may simply change the state of the recognizer state machine 1207, or may cause the state machine 1207 to issue an action request, such as "start capture", "stop capture", "phrase seen", or other similar requests. Indeed, a recognized word or phrase may cause the pipeline to be switched; for example, to overlay a different audio track if undesirable language is used in the program.

Note that the parsing state table 1206 and recognizer state machine 1207 may be modified or changed at any time. For example, a different table and state machine may be provided for each input channel. Alternatively, these elements may be switched depending on the time of day, or because of other events.

Referring to FIG. 11, a PullSwitch is added 1104 which outputs to the sink 1105.

The sink 1105 calls nextFullBuf and releaseEmptyBuf to get or return buffers from the PullSwitch 1104. The PullSwitch 1104 can have any number of inputs. One input could be an ActionClip 1113. The remote control can switch between input sources. The control object 1114 sends an event to the PullSwitch 1104, telling it to switch. It will switch from the current input source to whatever input source the control object selects.

An ActionClip class provides for sequencing a number of different stored signals in a predictable and controllable manner, possibly with the added control of viewer selection via a remote control. Thus, it appears as a derivative of a TmkXfrm object that accepts a "switch" event for switching to the next stored signal.

This allows the program logic or user to create custom sequences of video output. Any number of video segments can be lined up and combined as if the program logic or user were using a broadcast studio video mixer. TmkClipReaders 1108, 1109, 1110 are allocated and each is hooked into the PullSwitch 1104. The PullSwitch 1104 switches between the TmkClipReaders 1108, 1109, 1110 to combine video and audio clips. Flow control is automatic because of the way the pipeline is constructed. The Push and Pull Switches are the same as video switches in a broadcast studio.

The derived class and resulting objects described here may be combined in an arbitrary way to create a number of different useful configurations for storing, retrieving, switching and viewing of TV streams. For example, if multiple input and output sections are available, one input is viewed while another is stored, and a picture-in-picture window generated by the second output is used to preview previously stored streams. Such configurations represent a unique and novel application of software transformations to achieve the functionality expected of expensive, sophisticated hardware solutions within a single cost-effective device.

With respect to FIG. 13, a high-level system view is shown which implements a VCR backup. The Output Module 1303 sends TV signals to the VCR 1307. This allows the user to record TV programs directly on to video tape. The invention allows the user to queue up programs from disk to be recorded on to video tape and to schedule the time that the programs are sent to the VCR 1307. Title pages (EPG data) can be sent to the VCR 1307 before a program is sent. Longer programs can be scaled to fit onto smaller video tapes by speeding up the play speed or dropping frames.

The VCR 1307 output can also be routed back into the Input Module 1301. In this configuration the VCR acts as a backup system for the Media Switch 1302. Any overflow storage or lower priority programming is sent to the VCR 1307 for later retrieval.

The Input Module 1301 can decode and pass to the remainder of the system information encoded on the Vertical Blanking Interval (VBI). The Output Module 1303 can encode into the output VBI data provided by the remainder of the system. The program logic may arrange to encode identifying information of various kinds into the output signal, which will be recorded onto tape using the VCR 1307. Playing this tape back into the input allows the program logic to read back this identifying information, such that the TV signal recorded on the tape is properly handled. For example, a particular program may be recorded to tape along with information about when it was recorded, the source network, etc. When this program is played back into the Input Module, this information can be used to control storage of the signal, presentation to the viewer, etc.

One skilled in the art will readily appreciate that such a mechanism may be used to introduce various data items to the program logic which are not properly conceived of as television signals. For instance, software updates or other data may be passed to the system. The program logic receiving this data from the television stream may impose controls on how the data is handled, such as requiring certain authentication sequences and/or decrypting the embedded information according to some previously acquired key. Such a method works for normal broadcast signals as well, leading to an efficient means of providing non-TV control information and data to the program logic.

Additionally, one skilled in the art will readily appreciate that although a VCR is specifically mentioned above, any multimedia recording device (e.g., a Digital Video Disk-Random Access Memory (DVD-RAM) recorder) is easily substituted in its place.

Although the invention is described herein with reference to the preferred embodiment, one skilled in the art will readily appreciate that other applications may be substituted for those set forth herein without departing from the spirit and scope of the present invention. For example, the invention can be used in the detection of gambling casino crime. The input section of the invention is connected to the casino's video surveillance system. Recorded video is cached and simultaneously output to external VCRs. The user can switch to any video feed and examine (i.e., rewind, play, slow play, fast forward, etc.) a specific segment of the recorded video while the external VCRs are being loaded with the real-time input video. Accordingly, the invention should only be limited by the claims included below.

ENGLISH-CLAIMS:

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What is claimed is:

1. A process for the simultaneous storage and play back of multimedia data, comprising the steps of:

accepting television (TV) broadcast signals, wherein said TV signals are based on a multitude of standards, including, but not limited to, National Television Standards Committee (NTSC) broadcast, PAL broadcast, satellite transmission, DSS, DBS, or ATSC;

tuning said TV signals to a specific program;

providing at least one Input Section, wherein said Input Section converts said specific program to an Moving Pictures Experts Group (MPEG) formatted stream for internal transfer and manipulation;

providing a Media Switch, wherein said Media Switch parses said MPEG stream, said MPEG stream is separated into its video and audio components;

storing said video and audio components on a storage device;

providing at least one Output Section, wherein said Output Section extracts said video and audio components from said storage device;

wherein said Output Section assembles said video and audio components into an MPEG stream;

wherein said Output Section sends said MPEG stream to a decoder;

wherein said decoder converts said MPEG stream into TV output signals;

wherein said decoder delivers said TV output signals to a TV receiver; and

accepting control commands from a user, wherein said control commands are sent through the system and affect the flow of said MPEG stream.

2. The process of claim 1, wherein said Input Section directs said MPEG stream to the destination indicated by said control commands.

3. The process of claim 1, wherein said Output Section extracts said video and audio components from the storage device indicated by said control commands.

4. The process of claim 1, further comprising the step of:

creating custom video output sequences, wherein said sequences are specified by a user or program control.

5. The process of claim 1, wherein the storing and extracting of said video and audio components from said storage device are performed simultaneously.

6. The process of claim 1, wherein said Media Switch calculates and logically associates a time stamp to said video and audio components.

7. The process of claim 1, wherein said Media Switch extracts time stamp values from a digital TV stream and logically associates said time stamp values to said video and audio components.

8. The process of claim 1, further comprising the steps of:

placing said video component into a circular video buffer;

posting an event in a circular event buffer, wherein said event contains an indication that a video component was found and the location of said video component in said circular video buffer; and

sending notice of said event posting.

9. The process of claim 1, further comprising the steps of:

placing said audio component into a circular audio buffer;

posting an event in a circular event buffer, wherein said event contains an indication that an audio component was found and the location of said audio component in said circular audio buffer; and

sending notice of said event posting.

10. The process of claims 8 or 9, further comprising the steps of:

receiving said notice;

retrieving said event posting from said event buffer; and

indexing into the appropriate buffer indicated by the type and location information in said event buffer.

11. The process of claim 10, further comprising the steps of:

generating a buffer containing the logical audio or video segments in order, including ancillary information, wherein each of said logical segments points to the appropriate circular buffer location where corresponding audio or video components have been placed.

12. The process of claim 1, further comprising the step of:

increasing the decoder system clock rate for fast playback or fast reverse playback.

13. The process of claim 1, further comprising the step of:

decreasing the decoder system clock rate for slow playback or slow reverse playback.

14. The process of claim 1, further comprising the step of:

combining system audio cues and on-screen displays with said TV output signals.

15. The process of claim 1, further comprising the steps of:

decoding the Vertical Blanking Interval (VBI) data or private data channel information from said TV signal; and

examining said data to determine the starting or ending indicators of a specific program.

16. The process of claim 1, further comprising the step of:

scanning the words contained within the closed caption (CC) fields to determine program starting and ending times, wherein particular words or phrases are used to trigger the recording of a specific program and wherein the CC information is preserved in time synchronization with the audio and video, and can be correctly presented to the viewer when the stream is displayed.

17. The process of claim 16, further comprising the step of:

performing a specific action when a specific word is found in said CC information.

18. The process of claim 1, wherein said Media Switch has a data bus connecting it to a CPU and DRAM.

19. The process of claim 1, wherein said Media Switch shares an address bus with a CPU and

DRAM.

20. The process of claim 1, wherein said Media Switch operates asynchronously and autonomously with a CPU.

21. The process of claim 1, wherein said storage device is connected to said Media Switch.

22. The process of claim 1, wherein said Media Switch allows the CPU to queue up Direct Memory Access (DMA) transfers.

23. The process of claim 1, wherein said Media Switch is implemented in hardware.

24. The process of claim 1, further comprising the step of:

providing a multimedia recording device, including, but not limited to, a Video Cassette Recorder (VCR) or a Digital Video Disk-Random Access Memory (DVD-RAM) device, wherein said recording device is attached to the output side of said decoder, allowing said user to record said TV output signals.

25. The process of claim 24, wherein said user queues up programs from said storage device to be stored on said recording device.

26. The process of claim 24, wherein said user sets time schedules for said programs to be sent to said recording device.

27. The process of claim 24, wherein title pages may be sent to said recording device before sending a program to be stored on said recording device.

28. The process of claim 24, wherein a program that is longer in duration than a magnetic tape in said recording device allows, is sped up to fit within the desired time limit.

29. The process of claim 24, wherein a program that is longer in duration than a magnetic tape in said recording device allows, has frames dropped from it to fit within the desired time limit.

30. The process of claim 24, wherein the output of said recording device is routed to said Input Section, allowing said recording device to act as a storage back up system, said recording device accepts overflow storage, TV programs, software updates, or other data that are later retrieved and sent to said Input Section.

31. A process for the simultaneous storage and play back of multimedia data, comprising the steps of:

providing a physical data source, wherein said physical data source accepts broadcast data from an input device, parses video and audio data from said broadcast data, and temporarily stores said video and audio data;

providing a source object, wherein said source object extracts video and audio data from said physical data source;

providing a transform object, wherein said transform object stores and retrieves data streams onto a storage device;

wherein said source object obtains a buffer from said transform object, said source object converts video data into data streams and fills said buffer with said streams;

wherein said source object is automatically flow controlled by said transform object;

providing a sink object, wherein said sink object obtains data stream buffers from said transform object and outputs said streams to a video and audio decoder;

wherein said decoder converts said streams into display signals and sends said signals to a display;

wherein said sink object is automatically flow controlled by said transform object;

providing a control object, wherein said control object receives commands from a user, said commands control the flow of the broadcast data through the system; and

wherein said control object sends flow command events to said source, transform, and sink objects.

32. An apparatus for the simultaneous storage and play back of multimedia data, comprising:

a module for accepting television (TV) broadcast signals, wherein said TV signals are based on a multitude of standards, including, but not limited to, National Television Standards Committee (NTSC) broadcast, PAL broadcast, satellite transmission, DSS, DBS, or ATSC;

a module for tuning said TV signals to a specific program;

at least one Input Section, wherein said Input Section converts said specific program to an Moving Pictures Experts Group (MPEG) formatted stream for internal transfer and manipulation;

a Media Switch, wherein said Media Switch parses said MPEG stream, said MPEG stream is separated into its video and audio components;

a module for storing said video and audio components on a storage device;

at least one Output Section, wherein said Output Section extracts said video and audio components from said storage device;

wherein said Output Section assembles said video and audio components into an MPEG stream;

wherein said Output Section sends said MPEG stream to a decoder;

wherein said decoder converts said MPEG stream into TV output signals;

wherein said decoder delivers said TV output signals to a TV receiver; and

accepting control commands from a user, wherein said control commands are sent through the system and affect the flow of said MPEG stream.

33. The apparatus of claim 32, wherein said Input Section directs said MPEG stream to the destination indicated by said control commands.

34. The apparatus of claim 32, wherein said Output Section extracts said video and audio components from the storage device indicated by said control commands.

35. The apparatus of claim 32, further comprising:

a module for creating custom video output sequences, wherein said sequences are specified by a user or program control.

36. The apparatus of claim 32, wherein the storing and extracting of said video and audio components from said storage device are performed simultaneously.

37. The apparatus of claim 32, wherein said Media Switch calculates and logically associates a time stamp to said video and audio components.

38. The apparatus of claim 32, wherein said Media Switch extracts time stamp values from a digital TV stream and logically associates said time stamp values to said video and audio components.

39. The apparatus of claim 32, further comprising:

a module for placing said video component into a circular video buffer;

a module for posting an event in a circular event buffer, wherein said event contains an indication that a video component was found and the location of said video component in said circular video buffer; and

a module for sending notice of said event posting.

40. The apparatus of claim 32, further comprising:

a module for placing said audio component into a circular audio buffer;

a module for posting an event in a circular event buffer, wherein said event contains an indication that an audio component was found and the location of said audio component in said circular audio buffer; and

a module for sending notice of said event posting.

41. The apparatus of claims 39 or 40, further comprising:

a module for receiving said notice;

a module for retrieving said event posting from said event buffer; and

a module for indexing into the appropriate buffer indicated by the type and location information in said event buffer.

42. The apparatus of claim 41, further comprising:

a module for generating a buffer containing the logical audio or video segments in order, including ancillary information, wherein each of said logical segments points to the appropriate circular buffer location where corresponding audio or video components have been placed.

43. The apparatus of claim 32, further comprising:

a module for increasing the decoder system clock rate for fast playback or fast reverse playback.

44. The apparatus of claim 32, further comprising:

a module for decreasing the decoder system clock rate for slow playback or slow reverse playback.

45. The apparatus of claim 32, further comprising:

a module for combining system audio cues and on-screen displays with said TV output signals.

46. The apparatus of claim 32, further comprising:

a module for decoding the Vertical Blanking Interval (VBI) data or private data channel information from said TV signal; and

a module for examining said data to determine the starting or ending indicators of a specific program.

47. The apparatus of claim 32, further comprising:

a module for scanning the words contained within the closed caption (CC) fields to determine program starting and ending times, wherein particular words or phrases are used to trigger the recording of a specific program and wherein the CC information is preserved in time synchronization with the audio and video, and can be correctly presented to the viewer when the stream is displayed.

48. The apparatus of claim 47, further comprising:

a module for performing a specific action when a specific word is found in said CC information.

49. The apparatus of claim 32, wherein said Media Switch has a data bus connecting it to a CPU and DRAM.

50. The apparatus of claim 32, wherein said Media Switch shares an address bus with a CPU and DRAM.

51. The apparatus of claim 32, wherein said Media Switch operates asynchronously and autonomously with a CPU.

52. The apparatus of claim 32, wherein said storage device is connected to said Media Switch.

53. The apparatus of claim 32, wherein said Media Switch allows the CPU to queue up Direct Memory Access (DMA) transfers.

54. The apparatus of claim 32, further comprising:

a multimedia recording device, including, but not limited to, a Video Cassette Recorder (VCR) or a Digital Video Disk-Random Access Memory (DVD-RAM) device, wherein said recording device is attached to the output side of said decoder, allowing said user to record said TV output signals.

55. The apparatus of claim 54, wherein said user queues up programs from said storage device to be stored on said recording device.

56. The apparatus of claim 54, wherein said user sets time schedules for said programs to be sent to said recording device.

57. The apparatus of claim 54, wherein title pages may be sent to said recording device before sending a program to be stored on said recording device.

58. The apparatus of claim 54, wherein a program that is longer in duration than a magnetic tape in said recording device allows, is sped up to fit within the desired time limit.

59. The apparatus of claim 54, wherein a program that is longer in duration than a magnetic tape in said recording device allows, has frames dropped from it to fit within the desired time limit.

60. The apparatus of claim 54, wherein the output of said recording device is routed to said Input Section, allowing said recording device to act as a storage back up system, said recording device accepts overflow storage, TV programs, software updates, or other data that are later retrieved and sent to said Input Section.

61. An apparatus for the simultaneous storage and play back of multimedia data, comprising:

a physical data source, wherein said physical data source accepts broadcast data from an input device, parses video and audio data from said broadcast data, and temporarily stores said video and audio data;

a source object, wherein said source object extracts video and audio data from said physical data source;

a transform object, wherein said transform object stores and retrieves data streams onto a storage device;

wherein said source object obtains a buffer from said transform object, said source object converts video data into data streams and fills said buffer with said streams;

wherein said source object is automatically flow controlled by said transform object;

a sink object, wherein said sink object obtains data stream buffers from said transform object and outputs said streams to a video and audio decoder;

wherein said decoder converts said streams into display signals and sends said signals to a display;

wherein said sink object is automatically flow controlled by said transform object;

a control object, wherein said control object receives commands from a user, said commands control the flow of the broadcast data through the system; and

wherein said control object sends flow command events to said source, transform, and sink objects.

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*448 F.3d 1294, *, 2006 U.S. App. LEXIS 11162, **;
78 U.S.P.Q.2D (BNA) 1676*

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IN RE ECHOSTAR COMMUNICATIONS CORPORATION, ECHOSTAR DBS CORPORATION,
ECHOSTAR TECHNOLOGIES CORPORATION, and ECHOSPHERE LIMITED LIABILITY COMPANY,
and MERCHANT & GOULD P.C., Petitioners.

MISCELLANEOUS DOCKET NOS. 803, 805

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

448 F.3d 1294; 2006 U.S. App. LEXIS 11162; 78 U.S.P.Q.2D (BNA) 1676

May 1, 2006, Decided

SUBSEQUENT HISTORY: Writ of mandamus granted [In re Knearl](#), 184 Fed. Appx. 955,
2006 U.S. App. LEXIS 14772 (Fed. Cir., May 8, 2006)

Rehearing denied by, Rehearing, en banc, denied by [In re Echostar Communs. Corp.](#), 2006
U.S. App. LEXIS 17511 (Fed. Cir., July 5, 2006)

US Supreme Court certiorari denied by [Tivo, Inc. v. Echostar Comm'n Corp.](#), 127 S. Ct. 846,
166 L. Ed. 2d 665, 2006 U.S. LEXIS 9478 (U.S., Dec. 11, 2006)

PRIOR HISTORY: [TIVO Inc. v. EchoStar Comm. Corp.](#), 2005 U.S. Dist. LEXIS 42481 (E.D.
Tex., Sept. 26, 2005)

DISPOSITION: The court granted the firm's motion for leave to intervene. It also granted
the petition for mandamus as to certain classifications of documents.

Case in Brief (\$) [?]

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CASE SUMMARY

PROCEDURAL POSTURE: Petitioner communication companies sought a writ of
mandamus directing the United States District Court for the Eastern District of Texas to
vacate orders compelling production of documents created by specially-retained outside
counsel after they asserted an advice-of-counsel defense against a separate willful patent
infringement suit filed by a patentee. The law firm also moved to intervene in the
proceedings under the petition.

OVERVIEW: After production of all documents on a ruling that the assertion of the
advice-of-counsel defense constituted a full waiver of privileges, a writ of mandamus
seeking vacation of the orders was sought. The firm moved to intervene. The court


granted intervention and granted the petition to a limited extent. Noting that mandamus was available to correct clear abuses of discretion and that it was required to apply Federal Circuit law and not that of the regional circuit, it held that the broad scope used by the district court in finding waivers of both the attorney-client privilege and work-product doctrine was an abuse of discretion. It held that the attorney-client privilege and the work product doctrine were not interdependent, that neither was absolute, and that a waiver of one did not necessarily waive the other. Second, assertion of this defense did not give the patentee's counsel unfettered discretion to rummage through their files and their litigation strategies. Thus, while documents between the companies and counsel were properly disclosed, privilege as to documents created by counsel but not communicated to the companies was not waived and production thereof was not proper.


OUTCOME: The court granted the firm's motion for leave to intervene. It also granted the petition for mandamus as to certain classifications of documents.

CORE TERMS: work product, attorney-client, work-product, advice, infringement, communicated, infringer, in-house, subject matter, immunity, willful, waive, patent, advice-of-counsel, writ of mandamus, discovery, waived, disclosure, mental impressions, preparation, state of mind, advice of counsel, legal opinion, abuse of discretion, conveyed, patent infringement, opinion letter, willfulness, shield, leave to intervene


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[Civil Procedure > Equity > Irreparable Injury](#) 


[Civil Procedure > Remedies > Writs > Common Law Writs > Mandamus](#) 

HN1  The remedy of mandamus is available in extraordinary situations to correct a clear abuse of discretion or usurpation of judicial power. A party seeking a writ bears the burden of proving that it has no other means of obtaining the relief desired and that the right to issuance of the writ is clear and indisputable. A writ of mandamus may be sought when the challenged order turns on questions of privilege. [More Like This Headnote](#)


[Civil Procedure > Equity > Adequate Remedy at Law](#) 


[Civil Procedure > Equity > Irreparable Injury](#) 


[Patent Law > Jurisdiction & Review > Subject Matter Jurisdiction > General Overview](#) 


HN2  The U.S. Court of Appeals for the Federal Circuit does not require, as a prerequisite to the filing of a writ of mandamus relating to a court order, that a party refuse to comply at all with that order, if it seeks to challenge only a part thereof. Such a rule would encourage parties not to comply with district court orders that, in large part, they do not challenge, so that they could preserve a challenge only to the portions that they believe are erroneous. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)


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HN3  In reviewing a petition for a writ of mandamus filed by a party to a patent infringement action, the U.S. Court of Appeals for the Federal Circuit applies its own law rather than the law of the regional circuit. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)

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[Governments](#) > [Courts](#) > [Judicial Precedents](#) 


[Patent Law](#) > [Jurisdiction & Review](#) > [Subject Matter Jurisdiction](#) > [General Overview](#) 


HN4  The law of the U.S. Court of Appeals for the Federal Circuit applies when deciding whether particular written or other materials are discoverable in a patent case, if those materials relate to an issue of substantive patent law. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)


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[Patent Law](#) > [Remedies](#) > [Damages](#) > [General Overview](#) 


HN5  A remedy for willful patent infringement is specifically provided for in the Patent Act. 35 U.S.C.S. §§ 284-285. Therefore, questions of privilege and the discoverability of documents that arise from assertion of the advice-of-counsel defense necessarily involve issues of substantive patent law. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)


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[Evidence](#) > [Privileges](#) > [Attorney-Client Privilege](#) > [General Overview](#) 


[Evidence](#) > [Privileges](#) > [Attorney-Client Privilege](#) > [Scope](#) 

HN6  The attorney-client privilege protects disclosure of communications between a client and his attorney. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)


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HN7  Once a party announces that it will rely on advice of counsel in response to an assertion of willful infringement of a patent, the attorney-client privilege is waived. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)

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HN8  The widely applied standard for determining the scope of a waiver of attorney-client privilege is that the waiver applies to all other communications relating to the same subject matter. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)


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HN9  Whether legal counsel is employed by a client or hired under an outside contract, the advice or opinion that is offered is advice of counsel or an opinion of counsel for the purposes of the rule that reliance on the defense of advice of counsel in a patent infringement case waives the privilege. Use of in-house counsel may affect the strength of the defense, but it does not affect the legal nature of the advice. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)


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HN10  When a defendant which has been sued for willful infringement of a patent under 35 U.S.C.S. §§ 284-285 of the Patent Act chooses to rely on the advice of in-house counsel, it waives the attorney-client privilege with regard to any


attorney-client communications relating to the same subject matter, including communications with counsel other than in-house counsel. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)

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[Patent Law](#) > [Jurisdiction & Review](#) > [Standards of Review](#) > [Abuse of Discretion](#) 


HN11  The U.S. Court of Appeals for the Federal Circuit reviews a district court's determination as to the scope of a waiver of the attorney client privilege in connection with a suit for intentional patent infringement for an abuse of discretion. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)


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HN12  The attorney-client privilege and the work-product doctrine, though related, are two distinct concepts, and waiver of one does not necessarily waive the other. In general, a party may obtain discovery of any matter that (1) is not privileged and (2) is relevant to the claim or defense of any party. Fed. R. Civ. P. 26(b)(1). Among other things, attorney-client communications are designated as "privileged." [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)


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HN13  Attorney-client communications are designated as privileged. The privilege protects the confidentiality of communications between attorney and client made for the purpose of obtaining legal advice. The purpose of the privilege is to promote full and frank communication between a client and his attorney so that the client can make well-informed legal decisions and conform his activities to the law. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)


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HN14  The invocation of the attorney-client privilege is at the discretion of the client. The client can waive the attorney-client privilege when, for instance, it uses the advice to establish a defense. However, selective waiver of the privilege may lead to the inequitable result that the waiving party could waive its privilege for favorable advice while asserting its privilege on unfavorable advice. In such a case, the party uses the attorney-client privilege as both a sword and a shield. To prevent such abuses, the rule is that when a party defends its actions by disclosing an attorney-client communication, it waives the attorney-client privilege as to all such communications regarding the same subject matter. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)


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HN15  In contrast to the attorney-client privilege, the work-product doctrine (or work-product immunity as it is also called) can protect "documents and tangible things" prepared in anticipation of litigation that are both non-privileged and relevant. Fed. R. Civ. P. 26(b)(3). Unlike the attorney-client privilege, which protects all communication whether written or oral, work-product immunity protects documents and tangible things, such as memorandums, letters, and e-mails. Courts recognize work-product immunity because it promotes a fair and

efficient adversarial system by protecting the attorney's thought processes and legal recommendations from the prying eyes of his or her opponent. Proper preparation of a client's case demands that he assemble information, sift what he considers to be the relevant from the irrelevant facts, prepare his legal theories and plan his strategy without undue and needless interference. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)


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HN16  The work-product doctrine is not absolute. First, a party may discover certain types of work product if they have substantial need of the materials in the preparation of the party's case and that the party is unable without undue hardship to obtain the substantial equivalent by other means." Fed. R. Civ. P. 26 (b)(3). This rule, however, only allows discovery of "factual" or "non-opinion" work product and requires a court to protect against the disclosure of the mental impressions, conclusions, opinions, or legal theories of an attorney or other representative. Second, a party may discover work product if the party waives its immunity. However, work product waiver is not a broad waiver of all work product related to the same subject matter like the attorney-client privilege. Instead, work-product waiver only extends to "factual" or "non-opinion" work product concerning the same subject matter as the disclosed work product. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)


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HN17  The U.S. Court of Appeals for the Federal Circuit recognizes that the line between "factual" work product and "opinion" work product is not always distinct, especially when an attorney's opinion may itself be "factual" work product. When faced with the distinction between where that line lies, however, a district court should balance the policies to prevent sword-and-shield litigation tactics with the policy to protect work product. That being said, the appeals court recognizes at least three categories of work product that are potentially relevant to the advice-of-counsel defense when asserted in a patent infringement case. They include: (1) documents that embody a communication between the attorney and client concerning the subject matter of the case, such as a traditional opinion letter; (2) documents analyzing the law, facts, trial strategy, and so forth that reflect the attorney's mental impressions but were not given to the client; and (3) documents that discuss a communication between attorney and client concerning the subject matter of the case but are not themselves communications to or from the client. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)


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HN18  There are at least three categories of work product. When a defendant relies on the advice-of-counsel as a defense to a claim of willful infringement, the party waives its attorney-client privilege for all communications between the attorney and client, including any documentary communications such as opinion letters and memoranda. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)


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HN19  Once a defendant to a willful patent infringement case asserts the defense of advice of counsel, this opens to inspection the legal advice received by that defendant during the entire course of the alleged infringement. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)


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HN20  By asserting a advice-of-counsel defense to a charge of willful infringement, an accused infringer and its counsel do not give an opponent unfettered discretion to rummage through all of their files and pillage all of their litigation strategies. Courts generally find a work-product waiver only if facts relevant to a particular, narrow subject matter are at issue and have been disclosed under circumstances where it would be unfair to deny the other party an opportunity to discover other facts relevant to that subject matter. Work-product waiver extends only so far as to inform the court of the infringer's state of mind. Counsel's opinion is not important for its legal correctness. It is important whether it is thorough enough, as combined with other factors, to instill a belief in the infringer that a court might reasonably hold the patent is invalid, not infringed, or unenforceable. It is what the alleged infringer knew or believed, and by contradistinction not what other items counsel may have prepared but did not communicate to the client, that informs the court of an infringer's willfulness. The overarching goal of waiver is to prevent a party from using the advice he received as both a sword, by waiving privilege to favorable advice, and a shield, by asserting privilege to unfavorable advice. To the extent the work-product immunity could have such an effect, it is waived. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)


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HN21  Work product that is never communicated to the client is not discoverable. Under [Fed. R. Civ. P. 26\(b\)\(3\)](#), this so-called "opinion" work product deserves the highest protection from disclosure. While an accused infringer may waive the immunity for work product that embodies an opinion in letters and memorandum communicated to the client, he does not waive the attorney's own analysis and debate over what advice will be given. Upon waiver of attorney-client privilege, communicative documents, such as opinion letters, become evidence of a non-privileged, relevant fact, namely what was communicated to the client. However, counsel's legal opinions and mental impressions that were not communicated do not acquire such factual characteristics and are, therefore, not within the scope of the waiver. Thus, if a legal opinion or mental impression was never communicated to the client, then it provides little if any assistance to the court in determining whether the accused knew it was infringing, and any relative value is outweighed by the policies supporting the work-product doctrine. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)


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HN22  When an alleged infringer asserts its advice-of-counsel defense regarding willful

infringement of a particular patent, it waives its immunity for any document or opinion that embodies or discusses a communication to or from it concerning whether that patent is valid, enforceable, and infringed by the accused. This waiver of both the attorney-client privilege and the work-product immunity includes not only any letters, memorandum, conversation, or the like between the attorney and his or her client, but also includes, when appropriate, any documents referencing a communication between attorney and client. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)

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HN23 ↓ The assertion, by a defendant in a patent infringement case, of the advice-of-counsel defense to willfulness requires the court to decide, inter alia, whether counsel's opinion was thorough enough to instill a belief in the infringer that a court might reasonably hold the patent is invalid, not infringed, or unenforceable. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)

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[U.S. Circuit Court Motion\(s\)](#)

JUDGES: **[**1]** Before SCHALL, GAJARSA, and PROST, Circuit Judges.

OPINION BY: Arthur Gajarsa

OPINION

[*1296] ON PETITION FOR WRIT OF MANDAMUS

ORDER

[EchoStar Communications Corporation](#), [EchoStar DBS Corporation](#), [EchoStar Technologies Corporation](#), and [Echosphere Limited Liability Company](#) (collectively "EchoStar") petition for a writ of mandamus, in Miscellaneous Docket No. 803, to direct the United States District Court for the Eastern District of Texas, in case 2: 04-CV-1, to vacate its September 26, 2005 and October 6, 2005 orders that compelled EchoStar to produce documents created by the law firm Merchant & Gould P.C. that EchoStar asserts are protected from discovery by the work-product doctrine. Merchant & Gould moves for leave to intervene in Miscellaneous Docket No. 803 and submits its own petition for a writ of mandamus, filed as Miscellaneous Docket No. 805. [TiVo, Inc.](#) ↓ opposes the petitions and responds to the motion for leave to intervene. EchoStar and Merchant & Gould reply. We grant Merchant & Gould's unopposed motion for leave to intervene **[*1297]** in Miscellaneous Docket No. 803. The motions for leave to file the replies are also granted. To the extent set forth below, we grant the petition for mandamus.

[2]** I

TiVo sued EchoStar for infringement of its U.S. Patent No. **6,233,389** ("the '389 patent"). In response to the allegation of willful infringement, EchoStar asserted the defense of reliance on advice of counsel. Prior to the filing of the action, EchoStar relied on advice of in-house counsel. After the action was filed, EchoStar obtained additional legal advice from Merchant & Gould but elected not to rely on it. Presumably to explore further EchoStar's state of mind in

determining that it did not infringe the patent, TiVo sought production of documents in the possession of EchoStar and Merchant & Gould. The district court held that by relying on advice of in-house counsel EchoStar waived its attorney-client privilege and attorney work-product immunity relating to advice of any counsel regarding infringement, including Merchant & Gould. The district court indicated that the scope of the waiver included communications made either before or after the filing of the complaint and any work product, whether or not the product was communicated to EchoStar. The district court also held that EchoStar could redact information related only to trial preparation or information unrelated to infringement. **[**3]** EchoStar produced communications, including two infringement opinions from Merchant & Gould, but did not produce any work product related to the Merchant & Gould opinions. ¹

FOOTNOTES

¹ EchoStar also provided notes and communications relating to infringement prepared by another firm.

Thereafter, the parties sought clarification of the district court's order. TiVo argued that the district court should order EchoStar to produce all Merchant & Gould documents that relate to the advice-of-counsel defense, even if EchoStar was not in possession of the documents because they were never communicated to EchoStar. EchoStar argued that it should only be required to produce documents that were provided to it by Merchant & Gould.

On October 5, 2005, the district court issued an order that clarified its previous order and stated that the waiver of immunity extended to all work product of Merchant & Gould, whether or not communicated to EchoStar. The district court determined that the documents could be relevant or lead to the discovery of admissible evidence because they might contain information that was conveyed to EchoStar, even if the documents were not themselves conveyed to **[**4]** EchoStar. EchoStar petitions this court for a writ of mandamus with respect to the Merchant & Gould documents not provided to EchoStar, ² challenging the district court's rulings. Merchant & Gould moves for leave to intervene in EchoStar's petition and submits its own petition for a writ of mandamus.

FOOTNOTES

² No in-house counsel documents are at issue in the petition.

II

HN1 The remedy of mandamus is available in extraordinary situations to correct a clear abuse of discretion or usurpation of judicial power. *In re Calmar, Inc.*, 854 F.2d 461, 464 (Fed. Cir. 1988). A party seeking a writ bears the burden of proving that it has no other means of obtaining the relief desired, *Mallard v. U.S. Dist. Court*, 490 U.S. 296, 309, 109 S. Ct. 1814, 104 L. Ed. 2d 318 (1989), and that the right to issuance of the writ is "clear and indisputable," *Allied Chem. Corp. v. Daiflon, Inc.*, 449 U.S. 33, 35, 101 S. Ct. 188, 66 L. Ed. 2d 193 (1980). A writ of mandamus may be **[*1298]** sought when the challenged order turns on questions of privilege. *In re Regents of Univ. of Cal.*, 101 F.3d 1386, 1387 (Fed. Cir. 1996); *In re Pioneer Hi-Bred Int'l, Inc.*, 238 F.3d 1370, 1374 (Fed. Cir. 2001). **[**5]**

EchoStar argues that a writ of mandamus should issue, among other reasons, because the district court erred in determining that (1) the attorney-client privilege had been waived and (2) the waiver of any privilege extended to work-product that was not communicated to

EchoStar because, *inter alia*, the documents are not relevant to whether EchoStar had a good faith belief that it did not infringe. Merchant & Gould also argues that the district court erred in requiring the production of documents that Merchant & Gould did not provide to EchoStar because any such documents could not be relevant to whether EchoStar reasonably had a good faith belief that it did not infringe, based upon advice from counsel.

In response, TiVo argues, *inter alia*, that (1) EchoStar is not entitled to a writ of mandamus because it has complied, in large part, with the district court orders it now challenges, (2) the attorney-client privilege was waived when EchoStar asserted a defense of reliance on advice of in-house counsel, (3) the relevance of the Merchant & Gould documents can be determined when they are offered as evidence, and (4) even though the Merchant & Gould documents may not have been **[**6]** provided to EchoStar, they may contain information that was otherwise conveyed to EchoStar.

Regarding TiVo's first argument, that EchoStar is not entitled to mandamus because it has complied in large part with the order, ^{HN2} we do not believe it is a requirement that a party refuse to comply at all with an order, if it seeks to challenge only a part of the order. Such a rule would encourage parties not to comply with district court orders that, in large part, they do not challenge, so that they could preserve a challenge only to the portions that they believe are erroneous. EchoStar cannot undo the disclosures it has made to TiVo, but it can challenge the portions of the order that require additional disclosures.

We now turn to the more substantive arguments underlying this petition.

III

^{HN3} In this petition, we apply our own law, rather than the law of the regional circuit. This case involves the extent to which a party waives its attorney-client privilege and work-product immunity when it asserts the advice-of-counsel defense in response to a charge of willful patent infringement. ^{HN4} "Federal Circuit law applies when deciding whether particular written or other materials are discoverable **[**7]** in a patent case, if those materials relate to an issue of substantive patent law." *Advanced Cardiovascular Sys. v. Medtronic, Inc.*, 265 F.3d 1294, 1307 (Fed. Cir. 2001). ^{HN5} A remedy for willful patent infringement is specifically provided for in the Patent Act, see 35 U.S.C. §§ 284-285; therefore, questions of privilege and discoverability that arise from assertion of the advice-of-counsel defense necessarily involve issues of substantive patent law, see *In re Spalding Sports Worldwide, Inc.*, 203 F.3d 800, 803-04 (Fed. Cir. 2000) (applying Federal Circuit law to question of attorney-client privilege between patent attorney and patentee).

A

EchoStar first challenges the district court's holding that EchoStar waived the attorney-client privilege when it asserted its defense in response to the charge of willful infringement. ^{HN6} The attorney-client privilege protects disclosure of communications between a client and his **[*1299]** attorney. *United States v. Zolin*, 491 U.S. 554, 562, 109 S. Ct. 2619, 105 L. Ed. 2d 469 (1989); *Upjohn Co. v. United States*, 449 U.S. 383, 389, 101 S. Ct. 677, 66 L. Ed. 2d 584 (1981). **[**8]**

^{HN7} Once a party announces that it will rely on advice of counsel, for example, in response to an assertion of willful infringement, the attorney-client privilege is waived. ^{HN8} "The widely applied standard for determining the scope of a waiver of attorney-client privilege is that the waiver applies to all other communications relating to the same subject matter." *Fort James Corp. v. Solo Cup Co.*, 412 F.3d 1340, 1349 (Fed. Cir. 2005).

EchoStar argues that it did not assert the advice-of-counsel defense because it intended to

rely only on an "in-house investigation supervised by in-house counsel." The district court held that the opinion formed by in-house counsel and conveyed to EchoStar executives, although not a traditional opinion of counsel, constituted a legal opinion. We see no error in the district court's determination.

EchoStar summarily asserts that "an internal investigation involving in-house engineers and in-house counsel is simply a different subject matter from legal opinions commissioned at a later date from outside lawyers." This argument is without merit. ^{HN9} Whether counsel is employed by the client or hired by outside contract, the offered advice or opinion **[**9]** is advice of counsel or an opinion of counsel. Use of in-house counsel may affect the strength of the defense, but it does not affect the legal nature of the advice. See *Underwater Devices, Inc. v. Morrison-Knudsen Co.*, 717 F.2d 1380, 1390 (Fed. Cir. 1983) (overruled in part on other grounds by *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337 (Fed. Cir. 2004) (en banc)).

Thus, ^{HN10} when EchoStar chose to rely on the advice of in-house counsel, it waived the attorney-client privilege with regard to any attorney-client communications relating to the same subject matter, including communications with counsel other than in-house counsel, which would include communications with Merchant & Gould. See *Akeva LLC v. Mizuno Corp.*, 243 F. Supp. 2d 418, 423 (M.D.N.C. 2003).

B

EchoStar next asserts that the district court's order cast too wide a net by including within the waiver's scope documents that were never communicated from Merchant & Gould (the attorney) to EchoStar (the client). The district court stated:

EchoStar had the benefit of choice, as explained by the Federal Circuit in *Knorr-Bremse Systeme* **[**10]** *Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, of whether to introduce [in-house counsel's] opinion. But once EchoStar chose to introduce the opinion, it opened to inspection all related advice sought and developed regarding EchoStar's potential infringement of the '389 patent. Regardless of when the opinions or materials were transcribed or communicated to EchoStar, such information necessarily relates to the opinion being offered by [in-house counsel] and goes to show EchoStar's state of mind with respect to willful infringement. This is particularly true where, as is the case here, EchoStar's willfulness witness was privy to the substance of the willfulness opinions developed by outside counsel both pre-and post-filing. ...

TiVo, Inc. v. EchoStar Comm. Corp., 2005 U.S. Dist. LEXIS 42481, No. 2: 04-CV-1, at 13 (E. D. Tex. Sept. 26, 2005) ("September Order"). Noting that district courts had ruled differently on whether the waiver of work-product protection covered documents that were not disclosed to the client, the district court discussed the **[*1300]** reasons for requiring production of uncommunicated work product:

Still, other courts have mandated production of all material regardless of whether they **[**11]** were disclosed, maintaining that the discovery of such information is necessary to uncover what the client was actually told by opinion counsel. See *Aspex Eyewear Inc. v. E'Lite Optik Inc.*, 276 F. Supp. 2d 1084, 1092-93 (D. Nev. 2003); *Novartis Pharms. Corp. v. EON Labs Mfg., Inc.*, 206 F.R.D. 396 (D. Del. 2002). In *Novartis*, the court stated, "it is critical for the patentee to have a full opportunity to probe, not only the state of mind of the infringer, but also the mind of the infringer's lawyer upon which the infringer so firmly relied." *Id.* at 399. The rationale behind this approach is that, by imposing broad waiver, the advice of counsel defense will only be invoked by "infringers who prudently and

sincerely sought competent advice from competent counsel ..." and "moreover, focusing on the infringer's waiver rather than state of mind may reduce the chances of legal gamesmanship creeping into the practice of rendering infringement and validity opinions." *Id.* "If negative information was important enough to reduce to a memorandum, there is a reasonable possibility that the information was conveyed in some form or fashion [**12] to the client." *Beneficial Franchise Co. Inc. v. Bank One N. A.*, 205 F.R.D. 212, 218 (N. D. Ill. 2001).

September Order at 11-12.

In a subsequent order, the district court further explained why the scope of the waiver should include work product that was not disclosed to EchoStar:

Were discovery of "uncommunicated" materials not allowed, accused infringers could easily shield themselves from disclosing any unfavorable analysis by simply requesting that their opinion counsel not send it. This would be unfair.

TiVo, Inc. v. EchoStar Comm. Corp., No. 2: 04-CV-1, at 3 (E. D. Tex. Oct. 6, 2005) ("October Order").

HN11 ¶ We review the district court's determination as to the scope of the waiver for an abuse of discretion. *In re Pioneer*, 238 F.3d at 1373 n. 2 ("It appears that virtually all the circuits review the decision of a district court [regarding waiver of privilege] underlying a petition for writ of mandamus for abuse of discretion."). EchoStar asserts that to apply the broad scope employed by the district court to the waiver of both attorney-client privilege and work-product doctrine was an abuse of discretion. We agree.

[**13] **HN12** ¶ The attorney-client privilege and the work-product doctrine, though related, are two distinct concepts and waiver of one does not necessarily waive the other. See *Carter v. Gibbs*, 909 F.2d 1450, 1451 (Fed. Cir. 1990) (*en banc*), *superseded in non-relevant part*, Pub. L. No. 103-424, § 9(c), 108 Stat. 4361 (1994), *as recognized in Mudge v. United States*, 308 F.3d 1220, 1223 (Fed. Cir. 2002); *see also United States v. Nobles*, 422 U.S. 225, 238 n. 11, 95 S. Ct. 2160, 45 L. Ed. 2d 141 (1975). In general, a party may obtain discovery of any matter that (1) is "not privileged" and (2) "is relevant to the claim or defense of any party." Fed. R. Civ. P. 26(b)(1). Among other things, **HN13** ¶ attorney-client communications are designated as "privileged." See *Upjohn*, 449 U.S. at 389; *Genentech, Inc. v. Int'l Trade Comm'n*, 122 F.3d 1409, 1415 (Fed. Cir. 1997). "The attorney-client privilege protects the confidentiality of communications between attorney and client made for the purpose of obtaining legal advice." *Id.* We recognize the privilege in order to promote full and frank communication [**14] between a client and his attorney so that the client can make [**1301] well-informed legal decisions and conform his activities to the law. See *Upjohn*, 449 U.S. at 389; *XYZ Corp. v. United States*, 348 F.3d 16, 22 (1st Cir. 2003). **HN14** ¶ This privilege is at the discretion of the client. *Knorr-Bremse*, 383 F.3d at 1345; *Carter*, 909 F.2d at 1451. The client can waive the attorney-client privilege when, for instance, it uses the advice to establish a defense. See *id.* However, selective waiver of the privilege may lead to the inequitable result that the waiving party could waive its privilege for favorable advice while asserting its privilege on unfavorable advice. *XYZ Corp.*, 348 F.3d at 24. In such a case, the party uses the attorney-client privilege as both a sword and a shield. *Id.*; *Fort James Corp.*, 412 F.3d at 1349. To prevent such abuses, we recognize that when a party defends its actions by disclosing an attorney-client communication, it waives the attorney-client privilege as to all such communications regarding the same subject matter. *Id.*

HN15 ¶ In contrast to the attorney-client privilege, [**15] the work-product doctrine, or work-product immunity as it is also called, can protect "documents and tangible things"

prepared in anticipation of litigation that are both non-privileged and relevant. Fed. R. Civ. P. 26(b)(3). Unlike the attorney-client privilege, which protects all communication whether written or oral, work-product immunity protects documents and tangible things, such as memorandums, letters, and e-mails. See generally Judicial Watch, Inc. v. Dep't of Justice, 369 U.S. App. D.C. 49, 432 F.3d 366 (D. C. Cir. 2005). We recognize work-product immunity because it promotes a fair and efficient adversarial system by protecting "the attorney's thought processes and legal recommendations" from the prying eyes of his or her opponent. Genentech, 122 F.3d at 1415 (citations omitted); accord Hickman v. Taylor, 329 U.S. 495, 511-14, 67 S. Ct. 385, 91 L. Ed. 451 (1947) ("Proper preparation of a client's case demands that he assemble information, sift what he considers to be the relevant from the irrelevant facts, prepare his legal theories and plan his strategy without undue and needless interference.... Were such materials open ****16** to opposing counsel on mere demand, much of what is now put down in writing would remain unwritten.... Inefficiency, unfairness and sharp practices would inevitably develop in the giving of legal advice and in the preparation of cases for trial. The effect on the legal profession would be demoralizing. And the interests of the clients and the cause of justice would be poorly served."); see also Nobles, 422 U.S. at 237; Coastal States Gas Corp. v. Dep't of Energy, 199 U.S. App. D.C. 272, 617 F.2d 854, 864 (D. C. Cir. 1980). Essentially, the work-product doctrine encourages attorneys to write down their thoughts and opinions with the knowledge that their opponents will not rob them of the fruits of their labor. Hickman, 329 U.S. at 511; Id. at 516 (Jackson, J. concurring) ("[A] common law trial is and always should be an adversary proceeding. Discovery was hardly intended to enable a learned profession to perform its functions either without wits or on wits borrowed from the adversary."); United States v. Adlman, 68 F.3d 1495, 1501 (2d Cir. 1995) ("The purpose of the doctrine is to establish ****17** a zone of privacy for strategic litigation planning and to prevent one party from piggybacking on the adversary's preparation."); Coastal States, 617 F.2d at 864 (noting that the effect of no immunity would mean "less work-product would be committed to paper, which might harm the quality of trial preparation").

Like the attorney-client privilege, however, ^{HN16} the work-product doctrine is not absolute. See In re Martin Marietta Corp., 856 F.2d 619, 626 (4th Cir. 1988). ****1302** First, a party may discover certain types of work product if they have "substantial need of the materials in the preparation of the party's case and that the party is unable without undue hardship to obtain the substantial equivalent ... by other means." Rule 26(b)(3). This rule, however, only allows discovery of "factual" or "non-opinion" work product and requires a court to "protect against the disclosure of the mental impressions, conclusions, opinions, or legal theories of an attorney or other representative." Id.; accord United States v. Adlman, 134 F.3d 1194, 1197 (2d Cir. 1998); Martin Marietta Corp., 856 F.2d at 626.

Second, a party may discover ****18** work product if the party waives its immunity. See id. at 622-23; Thorn EMI N. Am. v. Micron Tech., 837 F. Supp. 616, 621 (D. Del. 1993). However, work product waiver is not a broad waiver of all work product related to the same subject matter like the attorney-client privilege. Martin Marietta Corp., 856 F.2d at 626. Instead, work-product waiver only extends to "factual" or "non-opinion" work product concerning the same subject matter as the disclosed work product. See id. at 625 (noting that a party "impliedly waived the work-product privilege as to all non-opinion work-product on the same subject matter as that disclosed.") (citing Nobles, 422 U.S. at 239).

^{HN17} We recognize that the line between "factual" work product and "opinion" work product is not always distinct, especially when, as here, an attorney's opinion may itself be "factual" work product. When faced with the distinction between where that line lies, however, a district court should balance the policies to prevent sword-and-shield litigation tactics with the policy to protect work product.

That being said, we recognize at least three ****19** categories of work product that are potentially relevant to the advice-of-counsel defense here. They include: (1) documents that

embody a communication between the attorney and client concerning the subject matter of the case, such as a traditional opinion letter; (2) documents analyzing the law, facts, trial strategy, and so forth that reflect the attorney's mental impressions but were not given to the client; and (3) documents that discuss a communication between attorney and client concerning the subject matter of the case but are not themselves communications to or from the client. See *Thorn EMI*, 837 F. Supp. at 622-623. ³ *HN18* ¶ As to the first category, we already noted in section A that when a party relies on the advice-of-counsel as a defense to willful infringement the party waives its attorney-client privilege for all communications between the attorney and client, including any documentary communications such as opinion letters and memoranda. See also *Akeva LLC*, 243 F. Supp. 2d at 423. ⁴ As to the other two categories, scholars have noted that our prior opinions do not clearly define **[*1303]** the scope of the work-product waiver. ⁵ As a result, the district **[**20]** courts that have addressed this issue are split on just how far to extend that scope. Compare *Thorn EMI*, 837 F. Supp. at 621-623 and *Steelcase, Inc. v. Haworth, Inc.*, 954 F. Supp. 1195, 1198-99 (W. D. Mich. 1997) with *Mushroom Assoc. v. Monterey Mushrooms, Inc.*, 1992 U.S. Dist. LEXIS 19664, 24 U.S.P.Q. 2d 1767 (N. D. Cal. 1992); *FMT Corp. v. Nissei ASB Co.*, 1992 U.S. Dist. LEXIS 21500, 24 U.S.P.Q. 2d 1073 (N. D. Ga. 1992); and *Handgards, Inc. v. Johnson & Johnson*, 413 F. Supp. 926 (N. D. Cal. 1976). As we discuss in more detail below, we conclude that waiver extends to the third category but does not extend so far as the second.

FOOTNOTES

³ We by no means anticipate that all work product in every case will fit into one of these three categories.

⁴ EchoStar contends that waiver of opinions does not extend to advice and work product given after litigation began. While this may be true when the work product is never communicated to the client, it is not the case when the advice is relevant to ongoing willful infringement, so long as that ongoing infringement is at issue in the litigation. See *Akeva LLC*, 243 F. Supp. 2d at 423 *HN19* ¶ ("Once a party asserts the defense of advice of counsel, this opens to inspection the advice received during the entire course of the alleged infringement."); see also *Crystal Semiconductor Corp. v. Tritech Microelectronics Int'l, Inc.*, 246 F.3d 1336, 1351-1353 (Fed. Cir. 2001) (noting that an infringer may continue its infringement after notification of the patent by filing suit and that the infringer has a duty of due care to avoid infringement after such notification). **[**21]**

⁵ See David O. Taylor, *Wasting Resources: Reinventing the Scope of Waiver Resulting from the Advice-of-Counsel Defense to a Charge of Willful Patent Infringement*, 12 *Tex. Intell. Prop. L.J.* 319, 320-21 (2004); William F. Lee & Lawrence P. Cogswell, III, *Understanding and Addressing the Unfair Dilemma Created by the Doctrine of Willful Patent Infringement*, 41 *Hous. L. Rev.* 393, 436-37 (2004).

HN20 ¶ By asserting the advice-of-counsel defense to a charge of willful infringement, the accused infringer and his or her attorney do not give their opponent unfettered discretion to rummage through all of their files and pillage all of their litigation strategies. See *Thorn EMI*, 837 F. Supp. at 621-623 ("Courts generally find a [work-product] waiver only if facts relevant to a particular, narrow subject matter are at issue and have been disclosed under circumstances where it would be unfair to deny the other party an opportunity to discover other facts relevant to that subject matter."). Work-product waiver extends only so far as to inform the court of the *infringer's* state of mind. Counsel's opinion is not important for its **[**22]** legal correctness. It is important to the inquiry whether it is "thorough enough, as combined with other factors, to instill a belief in the infringer that a court might reasonably hold the patent is invalid, not infringed, or unenforceable." *Ortho Pharm. Corp. v. Smith*, 959 F.2d 936, 944 (Fed. Cir. 1992). It is what the alleged infringer knew or believed,

and by contradistinction not what other items counsel may have prepared but did not communicate to the client, that informs the court of an infringer's willfulness.

The overarching goal of waiver in such a case is to prevent a party from using the advice he received as both a sword, by waiving privilege to favorable advice, and a shield, by asserting privilege to unfavorable advice. See *Fort James Corp.*, 412 F.3d at 1349; *Martin Marietta Corp.*, 856 F.2d at 626; *In re Sealed Case*, 219 U.S. App. D.C. 195, 676 F.2d 793, 818 (D. C. Cir. 1982) ("When a party seeks greater advantage from its control over work product than the law must provide to maintain a healthy adversary system[,], then the balance of interests recognized in *Hickman* ... shifts."). To the extent the **[**23]** work-product immunity could have such an effect, it is waived.

HN21 ¶ The second category of work product, which is never communicated to the client, is not discoverable. Under Rule 26(b)(3), this so-called "opinion" work product deserves the highest protection from disclosure. See *Adlman*, 134 F.3d at 1197. While an accused infringer may waive the immunity for work product that embodies an opinion in letters and memorandum communicated to the client, he does not waive the attorney's own analysis and debate over what advice will be given. See *Ortho Pharm.*, 959 F.2d at 944. Upon waiver of attorney-client privilege, communicative documents, such as opinion letters, become evidence of a non-privileged, relevant fact, namely what was communicated to the client, see *Nobles*, 422 U.S. at 239 n. 14 ("Where ... counsel attempts to make a testimonial use of [work-product] materials the normal rules **[*1304]** of evidence come into play with respect to ... production of documents."); however, counsel's legal opinions and mental impressions that were not communicated do not acquire such factual characteristics and are, therefore, not within the scope of the waiver. **[**24]** As the *Martin Marietta Corp.* court noted,

There is relatively little danger that a litigant will attempt to use a pure mental impression or legal theory as a sword and as a shield in the trial of a case so as to distort the factfinding process. Thus, the protection of lawyers from the broad repercussions of subject matter waiver in this context strengthens the adversary process, and, unlike the selective disclosure of evidence, may ultimately and ideally further the search for the truth.

856 F.2d at 626. Thus, if a legal opinion or mental impression was never communicated to the client, then it provides little if any assistance to the court in determining whether the accused knew it was infringing, and any relative value is outweighed by the policies supporting the work-product doctrine.

The third category of work product material falls admittedly somewhere interstitially between the first and second. In some instances there may be documents in the attorney's file that reference and/or describe a communication between the attorney and client, but were not themselves actually communicated to the client. For example, if an attorney writes a memorandum **[**25]** or an e-mail to his associate referencing a phone call with the client, in which he indicates that he discussed the client's potential infringement, then such a memorandum is discoverable. Unlike work product that was uncommunicated, this work product references a specific communication to the client. Though it is not a communication to the client directly nor does it contain a substantive reference to what was communicated, it will aid the parties in determining what communications were made to the client and protect against intentional or unintentional withholding of attorney-client communications from the court.

Still, we must emphasize that such communications may contain work product of the second kind--legal analysis that was not communicated. In those situations, the parties should take special care to redact such information, and if necessary the district court may review such material *in camera*. See Rule 26(b)(3); see also *id.* advisory committee's note (1970) ("The

courts will sometimes find it necessary to order disclosure of a document but with portions deleted."); *Martin Marietta Corp.*, 856 F.2d at 626.

Therefore, ^{HN22} when an alleged infringer asserts **[**26]** its advice-of-counsel defense regarding willful infringement of a particular patent, it waives its immunity for any document or opinion that embodies or discusses a communication to or from it concerning whether that patent is valid, enforceable, and infringed by the accused. This waiver of both the attorney-client privilege and the work-product immunity includes not only any letters, memorandum, conversation, or the like between the attorney and his or her client, but also includes, when appropriate, any documents referencing a communication between attorney and client. ⁶

FOOTNOTES

⁶ Merchant & Gould contends that it alone retains the right to deny a party access to work product not communicated to a client. While we do not answer this question directly; here, the client, EchoStar, holds the right to waive privilege for attorney-client communications, *Carter*, 909 F.2d at 1451, and therefore the right to waive privilege to evidence of those communications contained in Merchant & Gould's files. As we stated before, there may be a redaction of information which reflects legal opinions and mental impressions of Merchant & Gould attorneys that were not communicated to EchoStar. Rule 26(b)(3).

[27]** **[*1305]** Here, Merchant & Gould work product that was not communicated to EchoStar or does not reflect a communication is not within the scope of EchoStar's waiver because it obviously played no part in EchoStar's belief as to infringement of the '389 patent. See *Steelcase*, 954 F. Supp. at 1198-99. It may very well be true, as TiVo suggests, that at times some parties would communicate draft opinion letters or the contents thereof to the client confidentially in order to avoid disclosing that communication during potential discovery if and when the attorney-client privilege is waived, but we cannot eviscerate the legitimate policies of the work-product doctrine and chill the principles of our adversary system as a whole on account of the possibility that, from time to time, there may be occurrences of ethical transgressions.

In sum, ^{HN23} the advice-of-counsel defense to willfulness requires the court to decide, *inter alia*, whether counsel's opinion was thorough enough to "instill a belief in the infringer that a court might reasonably hold the patent is invalid, not infringed, or unenforceable." *Ortho Pharm.*, 959 F.2d at 944. If a Merchant & Gould document **[**28]** was not communicated to EchoStar or if a Merchant & Gould document does not reference a communication between Merchant & Gould and EchoStar, its relevant value is outweighed by the policies of the work-product doctrine. Thus, it was an abuse of discretion for the district court to determine that the scope of the waiver of privilege extended to such documents.

Accordingly,

IT IS ORDERED THAT:

The petitions are granted. The district court is directed to vacate its orders, to the extent noted above. TiVo is entitled to discovery of Merchant & Gould documents consistent with, and in the manner set forth in, this opinion.

FOR THE COURT

5-1-06

Date

s/Arthur J. Gajarsa

Circuit Judge







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2007 U.S. Dist. LEXIS 20579, *

STATIC CONTROL COMPONENTS, INC., PLAINTIFF/COUNTERCLAIM DEFENDANT V. LEXMARK INTERNATIONAL, INC., DEFENDANT/COUNTERCLAIM PLAINTIFF V. WAZANA BROTHERS INTERNATIONAL, INC., d/b/a MICRO SOLUTIONS ENTERPRISES, PENDL COMPANIES, INC., and NER DATA PRODUCTS, INC., COUNTERCLAIM DEFENDANTS

CIVIL ACTION NO. 04-84-GFVT

UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF KENTUCKY, CENTRAL DIVISION

2007 U.S. Dist. LEXIS 20579

March 22, 2007, Decided

SUBSEQUENT HISTORY: Motion granted by [Static Control Components, Inc. v. Lexmark Int'l, Inc.](#), 2007 U.S. Dist. LEXIS 22128 (E.D. Ky., Mar. 26, 2007)

PRIOR HISTORY: [Static Control Components, Inc. v. Lexmark Int'l, Inc.](#), 2007 U.S. Dist. LEXIS 5398 (D. Colo., Jan. 25, 2007)

CORE TERMS: advice, trial counsel, work product, attorney-client, work-product, protective order, patent, infringement, subject matter, immunity, advice-of-counsel, communicated, waive, work product, opinion letter, subpoena duces tecum, trial strategy, preparation, mental impressions, discovery, infringer, waived, patent infringement, attorney client privilege, deposition, privileged, disclosure, subpoena, in-house, embody

COUNSEL: [*1] For Static Control Components, Inc., Plaintiff: [Allison W. Freedman](#) ↘, [Christopher D. Landgraff](#) ↘, [James B. Heaton, III](#) ↘, [Jason L. Peltz](#) ↘, LEAD ATTORNEYS, Bartlit Beck Herman Palenchar & Scott, LLP - Chicago, Chicago, IL; [Christopher Lee](#), LEAD ATTORNEY, Bethesda, MD; [John J. Dabney](#) ↘, [Melise R. Blakeslee](#) ↘, [Paul E. Poirot](#) ↘, [Stefan M. Meisner](#) ↘, [William H. Barrett](#) ↘, LEAD ATTORNEYS, McDermott, Will & Emery - Washington, Washington, DC; [John M. Hughes](#) ↘, [Joseph C. Smith, Jr.](#) ↘, LEAD ATTORNEYS, Bartlit Beck Herman Palenchar & Scott, LLP - Denver, Denver, CO; [Kevin M. Bolan](#) ↘, LEAD ATTORNEY, McDermott, Will & Emery - Boston, Boston, MA; [Mickey T. Webster](#), [W. Craig Robertson, III](#) ↘, LEAD ATTORNEYS, Wyatt, Tarrant & Combs LLP - Lexington, Lexington, KY; [Seth D. Greenstein](#) ↘, LEAD ATTORNEY, Constantine Cannon, PC, Washington, DC US; [Stanley L. Amberg](#), LEAD ATTORNEY, Chappaqua, NY; [William L. London, III](#), LEAD ATTORNEY, Static Control Components, Sanford, NC.

For Lexmark International, Inc., Defendant: [Allen E. Hoover](#) ↘, [Bradley Rademaker](#) ↘, [Mark T. Banner](#) ↘, [Matthew P. Becker](#) ↘, [Michael L. Krashin](#) ↘, [Robert H. Resis](#) ↘, [Binal J. Patel](#) ↘, LEAD ATTORNEYS, [Christopher J. Renk](#) ↘, [Jason S. Shull](#) ↘, Banner & Witcoff, Ltd. - IL, Chicago, [*2] IL; [Christopher B. Roth](#) ↘, [Frederic M. Meeker](#) ↘,

Robert F. Altherr ↘, LEAD ATTORNEYS, Joseph M. Potenza ↘, Banner & Witcoff, LTD - DC, Washington, DC US; Hada V. Haulsee ↘, Mark N. Poovey ↘, W. Andrew Copenhaver ↘, LEAD ATTORNEYS, Womble, Carlyle, Sandridge & Rice PLLC - NC, Winston-Salem, NC; Charles E. Shivel, Jr. ↘, Hanly A. Ingram ↘, Steven Brian Loy ↘, LEAD ATTORNEY, Stoll Keenon Ogden, PLLC - Lexington, Lexington, KY.

For Wazana Brothers International, Inc., Counter Claimant: A. Steven Dotan ↘, Geronimo Perez, Jr., Ned Gelhaar ↘, O. Andrew Wheaton ↘, Stephen J. Rafferty, LEAD ATTORNEYS, Darren S. Enenstein ↘, Moldo, Davidson, Fraioli, Seror & Sestanovich, LLP - LA, Los Angeles, CA; Elizabeth L. Swanson, LEAD ATTORNEY, Swanson & Associates, Beverly Hills, CA, US; Steven P. Bogart ↘, LEAD ATTORNEY, Reinhart, Boerner, Van Deuren, Milwaukee, WI.

JUDGES: JAMES B. TODD, UNITED STATES MAGISTRATE JUDGE.

OPINION BY: JAMES B. TODD

OPINION

MEMORANDUM OPINION AND ORDER

I. INTRODUCTION

In the interests of judicial economy, the nature of this action, including claims asserted herein, as set out in greater detail in the Memorandum Opinion and Order entered on December 18, 2006 [DE # 566], is incorporated herein by [*3] reference.

This matter is before the court on the Motion For Protective Order Regarding Pendl's Advice of Counsel Defense [DE # 444] filed by counterclaim defendant Pendl Companies, Inc., ("Pendl"). This motion has been fully briefed and is ripe for review. ¹

FOOTNOTES

¹ At the initial pretrial conference conducted on March 12, 2007, the presiding district judge referred this motion to the Magistrate Judge for resolution on the merits. See DE # 825.

II. PENDL'S MOTION FOR PROTECTIVE ORDER

Pendl's motion for protective order concerns a subpoena duces tecum Lexmark served to Pendl's trial counsel, Joel T. Beres, Stites & Harbison, PLLC (hereafter "Stites"), in Louisville, Kentucky, on October 18, 2006, requesting the production of certain documents on October 27, 2006, and that Mr. Beres appear for deposition on November 2, 2006. The subpoena in question served by Lexmark resulted from the fact that on October 12, 2006, Pendl advised Lexmark that Pendl intended to rely on the advice-of-counsel defense as [*4] one of its defenses to Lexmark's claims against Pendl for willful patent infringement.

As grounds for its motion for a protective order relieving it from complying with Lexmark's subpoena duces tecum, Pendl contends that this subpoena seeks deposition testimony and documents from its trial counsel, Stites, on topics concerning privileged information and work product related to each claim in this action. Pendl states that after it was made a party to this action by virtue of Lexmark's counterclaim, it retained Stites as trial counsel to defend it

herein and that prior to being retained to defend against Lexmark's counterclaim, Stites had never performed any legal work of any kind for Pendl. Pendl also states that it has never received any advice from Stites either as to the validity of any Lexmark patent or as to the validity of the advice contained in the 1999 Becker opinion letter ², which forms the basis of its advice-of-counsel defense. In addition to information protected by the attorney/client privilege, Pendl also asserts that it is entitled to a protective order because Lexmark's subpoena also seeks information protected by the work product doctrine and the common interest [*5] privilege.

FOOTNOTES

² This letter is an 8-page letter dated August 26, 1999, addressed to Mr. Randy Pendl from opinion counsel, Robert D. Becker, an attorney with Coudert Brothers in San Francisco, California, has been filed under seal, and is identified as Exhibit G to Lexmark's Opposition to Pendl's Motion for Protective Order Regarding Pendl's Advice of Counsel Defense - DE # 459.

In response, Lexmark argues that since Pendl has asserted the advice-of-counsel defense, it has automatically waived its attorney/client and/or work product privileges for all communications, including those with trial counsel, regarding the subject matter of the 1999 Becker opinion letter, which covers a wide range of topics, including the validity and enforceability of Lexmark's Prebate program in view of patent, contract, and antitrust laws. Lexmark asserts that in resisting this discovery, Pendl is trying to use information that ordinarily would be protected by the attorney/client and/or work product privileges as both a sword and [*6] a shield by disclosing the information favorable to its defense and withholding unfavorable information. In support of its argument, Lexmark relies primarily on *In re EchoStar Communications Corp.*, 448 F.3d 1294 (Fed. Cir. 2006). Lexmark also argues that the authorities on which Pendl relies in support of its motion for a protective order are not controlling because they predate *EchoStar* and *Fort James Corp. v. Solo Cup Corp.*, 412 F.3d 1340 (Fed. Cir. 2005).

In reply, Pendl reiterates that its trial counsel, Stites, was hired solely for this litigation and has only communicated with Pendl regarding litigation and trial strategy and that since Stites has never communicated with Pendl concerning its advice-of-counsel defense or the validity of the 1999 Becker opinion letter, there are no documents to produce in compliance with Lexmark's subpoena inasmuch as its advice-of-counsel defense does not waive privileged communications with trial counsel. Pendl also asserts that the authorities on which Lexmark relies in opposition to its motion for a protective order are either factually distinguishable or otherwise not controlling or applicable.

Analysis

[*7] At the outset, prior to reviewing the production of documents requested by Lexmark's subpoena duces tecum and/or the deposition topics listed therein, it is necessary to determine the legal consequences of Pendl's decision to raise the advice-of-counsel defense to Lexmark's infringement claim. Those consequences are discussed by the Federal Circuit at length in *EchoStar, supra*, which concerned petitions for a writ of mandamus filed in the Federal Circuit resulting from a decision of the trial court in a patent infringement action filed in the Eastern District of Texas styled *TIVO, Inc. v. EchoStar Communications Corp.*, identified as Civil Action No. 2:04-CV-1. The factual background of *EchoStar*, as summarized by the Federal Circuit, is set out below:

TIVO sued EchoStar for infringement of its U.S. Patent No. **6,233,389** ("the '389 patent"). In response to the allegation of willful infringement, EchoStar asserted

the defense of reliance on advice of counsel. Prior to the filing of the action, EchoStar relied on advice of in-house counsel. After the action was filed, EchoStar obtained additional legal advice from Merchant & Gould but elected not to rely on [*8] it. Presumably to explore further EchoStar's state of mind in determining that it did not infringe the patent, TiVo sought production of documents in the possession of EchoStar and Merchant & Gould. The district court held that by relying on advice of in-house counsel EchoStar waived its attorney-client privilege and attorney work-product immunity relating to advice of any counsel regarding infringement, including Merchant & Gould. The district court indicated that the scope of the waiver included communications made either before or after the filing of the complaint and any work product, whether or not the product was communicated to EchoStar. The district court also held that EchoStar could redact information related only to trial preparation or information unrelated to infringement. EchoStar produced communications, including two infringement opinions from Merchant & Gould, but did not produce any work product related to the Merchant & Gould opinions.

In re EchoStar, 448 F.3d at 1297.

A. Attorney/client privilege and work product doctrine

Upon review of the petitions for writ of mandamus filed in *In re Echostar, supra*, submitted [*9] by both EchoStar and Merchant & Gould, the Federal Circuit concluded that the broad scope of waiver employed by the district court concerning both the attorney/client privilege and work product doctrine was an abuse of discretion. In the following excerpt from *EchoStar*, the Federal Circuit explains in great detail how the attorney/client privilege and documents that otherwise would be exempt from disclosure by work product immunity are affected by the advice-of-counsel defense in a patent infringement action:

The attorney-client privilege and the work-product doctrine, though related, are two distinct concepts and waiver of one does not necessarily waive the other. See *Carter v. Gibbs*, 909 F.2d 1450, 1451 (Fed. Cir.1990) (*en banc*), *superseded in non-relevant part*, Pub.L. No. 103-424, § 9(c), 108 Stat. 4361 (1994), *as recognized in Mudge v. United States*, 308 F.3d 1220, 1223 (Fed. Cir.2002); see also *United States v. Nobles*, 422 U.S. 225, 238 n. 11, 95 S.Ct. 2160, 45 L.Ed.2d 141 (1975). In general, a party may obtain discovery of any matter that (1) is "not privileged" and (2) "is relevant to the claim or defense of [*10] any party." Fed.R.Civ.P. 26(b)(1). Among other things, attorney-client communications are designated as "privileged." See *Upjohn*, 449 U.S. at 389, 101 S.Ct. 677; *Genentech, Inc. v. Int'l Trade Comm'n*, 122 F.3d 1409, 1415 (Fed. Cir.1997). "The attorney-client privilege protects the confidentiality of communications between attorney and client made for the purpose of obtaining legal advice." *Id.* We recognize the privilege in order to promote full and frank communication between a client and his attorney so that the client can make well-informed legal decisions and conform his activities to the law. See *Upjohn*, 449 U.S. at 389, 101 S.Ct. 677; *XYZ Corp. v. United States*, 348 F.3d 16, 22 (1st Cir.2003). This privilege is at the discretion of the client. *Knorr-Bremse*, 383 F.3d at 1345; *Carter*, 909 F.2d at 1451. The client can waive the attorney-client privilege when, for instance, it uses the advice to establish a defense. See *id.* However, selective waiver of the privilege may lead to the inequitable result that the waiving party could waive [*11] its privilege for favorable advice while asserting its privilege on unfavorable advice. *XYZ Corp.*, 348 F.3d at 24. In such a case, the party uses the attorney-client privilege as both a sword and a shield. *Id.*; *Fort James Corp.*, 412 F.3d at 1349. To prevent such abuses, we recognize that when a party defends its actions by disclosing an attorney-client communication, it waives the

attorney-client privilege as to all such communications regarding the same subject matter. *Id.*

In contrast to the attorney-client privilege, the work-product doctrine, or work-product immunity as it is also called, can protect "documents and tangible things" prepared in anticipation of litigation that are both non-privileged and relevant. Fed.R.Civ.P. 26(b)(3). Unlike the attorney-client privilege, which protects all communication whether written or oral, work-product immunity protects documents and tangible things, such as memorandums, letters, and e-mails. See generally Judicial Watch, Inc. v. Dep't of Justice, 369 U.S. App. D.C. 49, 432 F.3d 366 (D.C. Cir.2005). We recognize work-product immunity because it promotes a fair and efficient [*12] adversarial system by protecting "the attorney's thought processes and legal recommendations" from the prying eyes of his or her opponent. Genentech, 122 F.3d at 1415 (citations omitted); accord Hickman v. Taylor, 329 U.S. 495, 511-14, 67 S.Ct. 385, 91 L.Ed. 451 (1947) ("Proper preparation of a client's case demands that he assemble information, sift what he considers to be the relevant from the irrelevant facts, prepare his legal theories and plan his strategy without undue and needless interference.... Were such materials open to opposing counsel on mere demand, much of what is now put down in writing would remain unwritten.... Inefficiency, unfairness and sharp practices would inevitably develop in the giving of legal advice and in the preparation of cases for trial. The effect on the legal profession would be demoralizing. And the interests of the clients and the cause of justice would be poorly served."); see also Nobles, 422 U.S. at 237; Coastal States Gas Corp. v. Dep't of Energy, 199 U.S. App. D.C. 272, 617 F.2d 854, 864 (D.C. Cir. 1980). Essentially, the work-product doctrine encourages attorneys to write down their thoughts and [*13] opinions with the knowledge that their opponents will not rob them of the fruits of their labor. Hickman, 329 U.S. at 511, 67 S.Ct. 385; *Id.* at 516, 67 S.Ct. 385 (Jackson, J. concurring) ("[A] common law trial is and always should be an adversary proceeding. Discovery was hardly intended to enable a learned profession to perform its functions either without wits or on wits borrowed from the adversary."); United States v. Adlman, 68 F.3d 1495, 1501 (2d Cir. 1995) ("The purpose of the doctrine is to establish a zone of privacy for strategic litigation planning and to prevent one party from piggybacking on the adversary's preparation."); Coastal States, 617 F.2d at 864 (noting that the effect of no immunity would mean "less work-product would be committed to paper, which might harm the quality of trial preparation").

Like the attorney-client privilege, however, the work-product doctrine is not absolute. See In re Martin Marietta Corp., 856 F.2d 619, 626 (4th Cir. 1988). First, a party may discover certain types of work product if they have "substantial need of the materials in the preparation of [*14] the party's case and that the party is unable without undue hardship to obtain the substantial equivalent ... by other means." Rule 26(b)(3). This rule, however, only allows discovery of "factual" or "non-opinion" work product and requires a court to "protect against the disclosure of the mental impressions, conclusions, opinions, or legal theories of an attorney or other representative." *Id.*; accord United States v. Adlman, 134 F.3d 1194, 1197 (2d Cir. 1998); Martin Marietta Corp., 856 F.2d at 626.

Second, a party may discover work product if the party waives its immunity. See *id.* at 622-23; Thorn EMI N. Am. v. Micron Tech., 837 F.Supp. 616, 621 (D. Del. 1993). However, work product waiver is not a broad waiver of all work product related to the same subject matter like the attorney-client privilege. Martin Marietta Corp., 856 F.2d at 626. Instead, work-product waiver only extends to "factual" or "non-opinion" work product concerning the same subject matter as the disclosed work product. See *id.* at 625 (noting that a party "impliedly waived

the work-product privilege as to all non-opinion [*15] work-product on the same subject matter as that disclosed.") (citing *Nobles*, 422 U.S. at 239, 95 S.Ct. 2160).

We recognize that the line between "factual" work product and "opinion" work product is not always distinct, especially when, as here, an attorney's opinion may itself be "factual" work product. When faced with the distinction between where that line lies, however, a district court should balance the policies to prevent sword-and-shield litigation tactics with the policy to protect work product.

That being said, we recognize at least three categories of work product that are potentially relevant to the advice-of-counsel defense here. They include: (1) documents that embody a communication between the attorney and client concerning the subject matter of the case, such as a traditional opinion letter; (2) documents analyzing the law, facts, trial strategy, and so forth that reflect the attorney's mental impressions but were not given to the client; and (3) documents that discuss a communication between attorney and client concerning the subject matter of the case but are not themselves communications to or from the client. See *Thorn EMI*, 837 F.Supp. at 622- 623. [*16] (footnote omitted).

448 F.3d at 1300-02.

The *EchoStar* court went on to hold that of the three categories of work product outlined above in the preceding paragraph, categories (1) and (3) are discoverable, but category (2) is not:

The second category of work product, which is never communicated to the client, is not discoverable. Under Rule 26(b)(3), this so-called "opinion" work product deserves the highest protection from disclosure. See *Adlman*, 134 F.3d at 1197. While an accused infringer may waive the immunity for work product that embodies an opinion in letters and memorandum communicated to the client, he does not waive the attorney's own analysis and debate over what advice will be given. See *Ortho Pharm.*, 959 F.2d at 944. Upon waiver of attorney-client privilege, communicative documents, such as opinion letters, become evidence of a non-privileged, relevant fact, namely what was communicated to the client, see *Nobles*, 422 U.S. at 239 n. 14, 95 S.Ct. 2160 ("[W]here ... counsel attempts to make a testimonial use of [work-product] materials the normal rules of evidence come into play with respect [*17] to ... production of documents."); however, counsel's legal opinions and mental impressions that were not communicated do not acquire such factual characteristics and are, therefore, not within the scope of the waiver. As the *Martin Marietta Corp.* court noted,

There is relatively little danger that a litigant will attempt to use a pure mental impression or legal theory as a sword and as a shield in the trial of a case so as to distort the factfinding process. Thus, the protection of lawyers from the broad repercussions of subject matter waiver in this context strengthens the adversary process, and, unlike the selective disclosure of evidence, may ultimately and ideally further the search for the truth.

856 F.2d at 626. Thus, if a legal opinion or mental impression was never communicated to the client, then it provides little if any assistance to the court in determining whether the accused knew it was infringing, and any relative value is outweighed by the policies supporting the work-product doctrine.

448 F.3d at 1303-04.

In view of the foregoing considerations, the *EchoStar* court concluded, as follows:

Therefore, when an alleged [*18] infringer asserts its advice-of-counsel defense regarding willful infringement of a particular patent, it waives its immunity for any document or opinion that embodies or discusses a communication to or from it concerning whether that patent is valid, enforceable, and infringed by the accused. This waiver of both the attorney-client privilege and the work-product immunity includes not only any letters, memorandum, conversation, or the like between the attorney and his or her client, but also includes, when appropriate, any documents referencing a communication between attorney and client.

Here, Merchant & Gould work product that was not communicated to EchoStar or does not reflect a communication is not within the scope of EchoStar's waiver because it obviously played no part in EchoStar's belief as to infringement of the '389 patent. See *Steelcase*, 954 F.Supp. at 1198-99. It may very well be true, as TiVo suggests, that at times some parties would communicate draft opinion letters or the contents thereof to the client confidentially in order to avoid disclosing that communication during potential discovery if and when the attorney-client privilege is waived, but [*19] we cannot eviscerate the legitimate policies of the work-product doctrine and chill the principles of our adversary system as a whole on account of the possibility that, from time to time, there may be occurrences of ethical transgressions.

In sum, the advice-of-counsel defense to willfulness requires the court to decide, *inter alia*, whether counsel's opinion was thorough enough to "instill a belief in the infringer that a court might reasonably hold the patent is invalid, not infringed, or unenforceable." *Ortho Pharm.*, 959 F.2d at 944. If a Merchant & Gould document was not communicated to EchoStar or if a Merchant & Gould document does not reference a communication between Merchant & Gould and EchoStar, its relevant value is outweighed by the policies of the work-product doctrine. Thus, it was an abuse of discretion for the district court to determine that the scope of the waiver of privilege extended to such documents. (footnote omitted).

448 F.3d at 1304-05.

B. Extension of waiver to trial counsel

Although *EchoStar* did not expressly address the issue of communications with trial counsel, the court in *Echostar* noted [*20] that the waiver concerns not only the communication with counsel containing the advice on which the alleged infringer relies, such as an opinion letter, but also "communications relating to the same subject matter" that the alleged infringer had with other counsel, which arguably could include trial counsel:

Thus, when EchoStar chose to rely on the advice of in-house counsel, it waived the attorney-client privilege with regard to any attorney-client communications

relating to the same subject matter, including communications with counsel other than in-house counsel, which would include communications with Merchant & Gould. See *Akeva LLC v. Mizuno Corp.*, 243 F.Supp.2d 418, 423 (M.D.N.C.2003).

448 F.3d at 1299.

In light of the foregoing applicable law, the court now turns to the present action. As additional support for its motion for a protective order, Pendl has also provided the court with the affidavit of its lead trial counsel, Joel T. Beres, which states in relevant part, as follows:

1. I am a Member of Stites & Harbison, PLLC and lead trial attorney representing Pendl Companies, Inc. ("Pendl") [in] Civil Action No. 04-CV-84-GFVT [*21] currently pending in United States District Court for the Eastern District of Kentucky.
2. After receiving Lexmark's Counterclaim, Pendl retained the law firm of Stites & Harbison as trial counsel for its defense.
3. Stites & Harbison had never performed legal work of any kind for Pendl before this retention.
4. Stites & Harbison was retained and has served solely as Pendl's trial counsel in this matter.
5. The retention agreement between Stites & Harbison and Pendl limits Stites & Harbison's representation to defending Lexmark's suit.
6. Stites & Harbison has never provided Pendl advice as to validity of any Lexmark patent.
7. Stites & Harbison has never provided advice on the validity of Mr. Robert Becker's advice in 1999, which forms the basis for Pendl's advice of counsel defense.
8. Each and every communication between Stites & Harbison and Pendl has been limited to discussions of litigation or trial strategy.
9. Each and every document provided to Pendl has similarly dealt solely with such litigation and trial strategy.

Declaration of Joel T. Beres, 10/30/06 - Exhibit 1 to Pendl's Motion for Protective Order Regarding Pendl's [*22] Advice of Counsel Defense [DE # 444].

Based on the above-referenced affidavit of Pendl's lead trial counsel, Joel T. Beres, affirmatively stating (1) that Stites had never performed legal work of any kind for Pendl before this retention, (2) that Stites was retained and has served solely as Pendl's trial counsel in this matter, (3) that the retention agreement between Stites and Pendl limits Stites's representation to defending this action, (4) that Stites has never provided Pendl advice as to validity of any Lexmark patent, (5) that Stites has never provided advice to Pendl concerning the validity of Mr. Robert Becker's advice in 1999, which forms the basis for Pendl's advice of counsel defense, (6) that all communications between Stites and Pendl have been limited to discussions of litigation or trial strategy, and (7) that each and every document provided to Pendl has similarly dealt solely with such litigation and trial strategy, the Magistrate Judge concludes that Pendl's motion for a protective order has merit because Pendl's trial counsel affirmatively states that Stites did not give or offer Pendl advice

concerning the validity, enforcement, and infringement of Lexmark's [*23] patent at issue which Lexmark accuses Pendl of infringing.

Thus, while Pendl's assertion of the advice-of-counsel defense to Lexmark's claim of patent infringement operates to waive the attorney/client privilege and the work product immunity for any document or opinion that embodies or discusses a communication to or from Pendl concerning whether that patent is valid, enforceable, and infringed, Pendl's lead trial counsel affirmatively states that he has no such documents in his possession because his law firm has never offered or given Pendl advice concerning the validity, enforcement, and infringement of the Lexmark patent at issue. Consequently, Pendl's trial counsel has no documents to produce that are responsive to Lexmark's subpoena duces tecum.³

FOOTNOTES

³ Since Stites represents that it has had no communications with Pendl concerning the validity, enforcement, and infringement of Lexmark's patent, there is no need to engage in further analysis of this matter concerning "communications relating to the same subject matter."

[*24] Accordingly, **IT IS HEREBY ORDERED that:**

1. Pendl's Motion For Protective Order Regarding Pendl's Advice of Counsel Defense [DE # 444] is **GRANTED**.
2. Pendl is relieved from responding to the Requests For Production of Documents and Things set out in Lexmark's subpoena duces tecum served to Pendl's trial counsel on October 18, 2006, and Pendl's lead trial counsel, Joel T. Beres, is relieved from being deposed on any of the Deposition Topics listed in this same subpoena duces tecum.
3. Pendl's request for its costs and attorney's fees associated with the filing of its motion for protective order is **DENIED** as there is no evidence to suggest that Lexmark had any reason to know, prior to the filing of Pendl's motion for protective order, that Pendl's trial counsel had never offered or given Pendl any advice concerning the validity, enforcement, or infringement of the Lexmark patent at issue, information that was revealed in the affidavit of Pendl's lead trial counsel, Joel T. Beres.

This 22nd day of March, 2007.

JAMES B. TODD,

UNITED STATES MAGISTRATE JUDGE






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2006 U.S. Dist. LEXIS 64292, *

TIVO INC., Plaintiff, v. ECHOSTAR COMMUNICATIONS CORP., et al. Defendants.

2:04-CV-1-DFUNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF TEXAS, MARSHALL
DIVISION

2006 U.S. Dist. LEXIS 64292

August 17, 2006, Decided

August 17, 2006, Filed

SUBSEQUENT HISTORY: Motion granted by *TiVo Inc. v. Echostar Communs. Corp.*, 2006 U.S. Dist. LEXIS 64291 (E.D. Tex., Aug. 17, 2006)**PRIOR HISTORY:** *TIVO Inc. v. EchoStar Comm. Corp.*, 2005 U.S. Dist. LEXIS 42481 (E.D. Tex., Sept. 26, 2005)**CASE SUMMARY****PROCEDURAL POSTURE:** Plaintiff corporation filed a patent infringement suit against defendant competitors. A jury rendered a verdict finding willful infringement of each of the asserted claims by all of the accused products. The court held a bench trial on the competitors' affirmative defenses of equitable estoppel, laches, and inequitable conduct.**OVERVIEW:** The patent was issued to the corporation in 2001. The corporation negotiated with the competitors. No commercial agreement was reached, and the corporation filed suit in 2004. The competitors alleged that, during the negotiations, the corporation acknowledged that the competitors had their own technology and indicated that the corporation's patents were not an issue. The corporation denied making these statements. Because there was no other evidence that the corporation made any statements to reassure the competitors that the patents were not at issue, the equitable estoppel defense failed. The laches defense also failed; the two and one-half year period between the issuance of the patent and the filing of the suit was reasonable because of the parties' ongoing negotiations. Finally, the defense of inequitable conduct was not established. Although the corporation's attorneys failed to disclose two allegedly relevant patents to the Patent Office during the prosecution of the patent at issue, there was no evidence that they intended to deceive the Patent Office where they testified that they had not been aware of those patents and other patents were disclosed in the application.**OUTCOME:** The court issued findings of fact and conclusions of law, holding that the competitors failed to establish their affirmative defenses.

CORE TERMS: patent, inequitable conduct, prior art, equitable estoppel, convincing evidence, patentee's, laches, conclusions of law, headquartered, infringer's, withhold, failure to disclose, preponderance, materiality, succeed, patent infringement, intent to deceive, prosecuted, deceive, wholly owned subsidiary, law firm, case involving, reasonably infer, length of time, material information, good faith, infringement, negotiations, technology, misleading

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HN1 To succeed on the defense of equitable estoppel, a defendant must satisfy the following elements by a preponderance of the evidence: (1) that the patentee, through misleading conduct, leads the alleged infringer to reasonably infer that the patentee does not intend to enforce its patent against the alleged infringer; (2) that the alleged infringer relies on that conduct; and (3) due to its reliance, the alleged infringer will be materially prejudiced if the patentee is allowed to proceed with its claim. Even where the three elements of equitable estoppel are established, the trial court must take into consideration any other evidence and facts respecting the equities of the parties in exercising its discretion and deciding whether to allow the defense of equitable estoppel to bar the suit. [More Like This Headnote](#)

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HN2 To succeed on the equitable defense of laches, a defendant must satisfy the following elements by a preponderance of the evidence: (1) that the plaintiff delayed filing suit for an unreasonable and inexcusable length of time from the time the plaintiff knew or reasonably should have known of its claim against the defendant; and (2) that the delay operated to the prejudice or injury of the defendant. Whether the length of time is unreasonable has no fixed boundaries but rather depends on the circumstances. A court must also consider and weigh any justification offered by the plaintiff for its delay, including whether the plaintiff was in negotiations with the defendant. A presumption of laches arises where a patentee delays bringing suit for more than six years after the date the patentee knew or should have known of the alleged infringer's activity. [More Like This Headnote](#)

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HN3 Being accused of inequitable conduct can seriously damage an attorney's reputation and can risk their membership in their state bar and their ability to prosecute patents before the Patent Office. [More Like This Headnote](#)


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HN4 To succeed on a claim of inequitable conduct due to failure to disclose material information, the infringing defendant must prove by clear and convincing evidence: (1) prior art that was material; (2) knowledge chargeable to an applicant of that prior art and of its materiality; and (3) failure of the applicant to disclose the art resulting from an intent to mislead the Patent Office. Allegations of inequitable conduct for failure to disclose material information may be rebutted by a showing that: (a) the prior art was not material; (b) if the prior art was

material, a showing that the applicant did not know of that art; (c) if the applicant did know of that art, a showing that the applicant did not know of its materiality; or (d) a showing that the applicant's failure to disclose the art did not result from an intent to mislead the Patent Office. [More Like This Headnote](#)


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HN5  The United States Court of Appeals for the Federal Circuit has declared that a party seeking to have a patent declared unenforceable due to inequitable conduct has a heavy burden to meet. [More Like This Headnote](#)


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HN6  Absent proof of a threshold level of both materiality and intent, there can be no determination of inequitable conduct. [More Like This Headnote](#)

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HN7  In a case involving an omission of a material reference to the Patent Office, there must be clear and convincing evidence that the applicant made a deliberate decision to withhold a known material reference. Intent to deceive can not be inferred solely from the fact that information was not disclosed; there must be a factual basis for a finding of deceptive intent. Conjecture alone is not sufficient to show an intent to deceive to support the defense of inequitable conduct. [More Like This Headnote](#)

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HN8  The United States Court of Appeals for the Federal Circuit has stated that it will not find inequitable conduct on an evidentiary record that is completely devoid of evidence of the patentee's intent to deceive the Patent Office. [More Like This Headnote](#)






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HN9  In inequitable conduct cases involving allegations that prior art was not disclosed to the Patent Office, the absence of a good faith explanation cannot be clear and convincing evidence of deceptive intent. When the absence of a good faith explanation is the only evidence of intent, that evidence alone does not constitute clear and convincing evidence warranting an inference of intent. [More Like This Headnote](#)

COUNSEL: [*1] Robert W Faulkner, Mediator, Pro se, Dallas, TX.

For TIVO Inc, a Delaware corporation, Plaintiff: [Alexander C D Giza](#) , [Adam S Hoffman](#) , [Perry M Goldberg](#) , [Richard E Lyon](#) , Irell & Manella LLP, Los Angeles, CA; [Andrei Iancu](#) , [Christine W S Byrd](#) , Irell & Manella - Los Angeles, Los Angeles, CA; [Morgan Chu](#) , Irell & Manella, Los Angeles, CA; [Samuel Franklin Baxter](#) , Attorney at Law, Marshall, TX; [Ben Yorks](#) , Brian Jones, [Michelle Armond](#) , Irell & Manella - Newport Beach, Newport Beach, CA; [R Scott Feldmann](#) , [Randall I Erickson](#) , [Steven P Rice](#) , [Van V Nguyen](#) , Crowell & Moring - Irvine, Irvine, CA; [Garret Wesley Chambers](#) , McKool Smith - Dallas, Dallas, TX.

For Echostar Communications Corporation, a Nevada corporation, Echostar DBS Corporation, a Colorado corporation, EchoStar Technologies Corporation, Echosphere Limited Liability Company, Defendants: [Alison M Tucher](#) , [Jason A Crotty](#) , [Robert M Harkins, Jr](#) , Morrison & Foerster LLP San Francisco, San Francisco, CA; [Rachel Krevans](#) , [Harold J. McElhinny](#) 

☞, Morrison & Foerster LLP, San Francisco, CA; Karl J Kramer ↘, Morrison & Foerster - Palo Alto, Palo Alto, CA; Damon Michael Young ↘☞, Young Pickett & Lee, Texarkana, TX.

For "EchoStar defendants", [***2**] Defendant: Emily A Evans ↘, Morrison & Foerster - Palo Alto, Palo Alto, CA; Scott F Llewellyn ↘, Morrison & Foerster, Denver, CO; Kristina Paszek ↘, Alison M Tucher ↘, Robert M Harkins, Jr ↘, Morrison & Foerster LLP San Francisco, San Francisco, CA; Harold J. McElhinny ↘☞, Rachel Krevans ↘☞, Morrison & Foerster LLP, San Francisco, CA; John Michael Pickett ↘☞, Young Pickett & Lee, Texarkana, TX; Karl J Kramer ↘, Morrison & Foerster - Palo Alto, Palo Alto, CA.

For Merchant & Gould, Subpoena recipient, Movant: Charles Conrow Murphy, Jr ↘☞, Vaughan & Murphy, Atlanta, Ga.

For EchoStar Technologies Corporation, Echosphere Limited Liability Company, Counter Claimants: Alison M Tucher ↘, Jason A Crotty ↘, Robert M Harkins, Jr ↘, Morrison & Foerster LLP San Francisco, San Francisco, CA; Karl J Kramer ↘, Morrison & Foerster - Palo Alto, Palo Alto, CA; Damon Michael Young ↘☞, Young Pickett & Lee, Texarkana, TX.

For TIVO Inc, a Delaware corporation, Counter Defendant: Adam S Hoffman ↘, Irell & Manella LLP, Los Angeles, CA.

For EchoStar Communications Corporation, a Nevada corporation, EchoStar DBS Corporation a Colorado corporation, Counter Claimants: Alison M Tucher ↘, Jason A Crotty ↘, Robert M Harkins, Jr ↘, Morrison [***3**] & Foerster LLP San Francisco, San Francisco, CA; Karl J Kramer ↘, Morrison & Foerster - Palo Alto, Palo Alto, CA.

For Echostar Satellite LLC, Counter Claimant: Karl J Kramer ↘, Morrison & Foerster - Palo Alto, Palo Alto, CA.

JUDGES: DAVID FOLSOM, UNITED STATES DISTRICT JUDGE.

OPINION BY: DAVID FOLSOM

OPINION

FINDINGS OF FACT AND CONCLUSIONS OF LAW

TiVo filed this action asserting that Echostar infringed a number of claims in U.S. Patent No. **6,233,389** (the "'389 patent"). At the conclusion of a jury trial held during March and April 2006, the jury rendered a verdict finding willful infringement of each of the asserted claims by all of the accused products. Dkt. No. 690. In June 2006, a bench trial was held on the remaining issues of law.

I. Parties

Plaintiff TiVo is a publically traded company incorporated in Delaware and headquartered in California. Dkt. No. 579.

Defendant EchoStar Communications Corporation ↘ is a publicly-traded Nevada corporation headquartered in Colorado. Dkt. No. 579.

Defendant EchoStar DBS Corporation is a Colorado corporation headquartered in Colorado. Dkt. No. 579.

Defendant EchoStar Technologies Corporation is a Texas corporation headquartered in Colorado, [*4] and is a wholly owned subsidiary of EchoStar DBS Corporation. Dkt. No. 579.

Defendant Echosphere Limited Liability Company is a Colorado limited liability company headquartered in Colorado, and is a wholly owned subsidiary of EchoStar DBS Corporation. Dkt. No. 579.

Defendant EchoStar Satellite LLC is a Colorado limited liability company headquartered in Colorado, and a wholly owned subsidiary of EchoStar.

All above named Defendants are collectively referred to as "Defendants."

II. Jurisdiction and Venue

This Court has jurisdiction over this patent infringement case under 28 U.S.C. §§ 1331 and 1338(a). Subject matter jurisdiction is not disputed. Dkt No. 579 at 2.

III. Findings of Fact & Conclusions of Law on Defendants' Affirmative Defenses

A. Equitable Estoppel - Findings of Fact

Between the issuance of the '389 patent' in May 2001 and the filing of this action in January 2004, the parties had a number of discussions regarding possible commercial agreements between them. TiVo did not threaten EchoStar with litigation over the '389 patent' during these discussions. 6/27/06 Bench Trial Tr., 81:19-82:22 (Ramsay). [*5]

At the same time that TiVo and EchoStar were having discussions, TiVo was having discussions with other companies that resulted in commercial deals. 6/27/06 Bench Trial Tr., 80:1-17 (Ramsay).

TiVo did not expressly threaten litigation toward EchoStar or the other companies with which TiVo tried to forge a commercial relationship. 6/27/06 Bench Trial Tr., 82:6-11(Ramsay); 6/26/06 Bench Trial Tr., 52:4-6 (Ergen).

During the discussions between the parties, EchoStar already knew about TiVo's patent and about TiVo's commercial arrangements. PX-303; 6/26/06 Bench Trial Tr., 30:5-16 (Ergen).

EchoStar's CEO, Mr. Ergen, testified that during one of the discussions between the parties, TiVo's CEO, Mr. Ramsay, told Mr. Ergen that TiVo recognized EchoStar had its own DVR technology and indicated that TiVo's patents were "not an issue." 6/26/06 Bench Trial Tr., 32:13-20 (Ergen). Mr. Ergen testified that he understood Mr. Ramsay's statements to mean that TiVo would not sue EchoStar for infringement of the '389 patent'. 6/26/06 Bench Trial Tr., 32:23-33:13 (Ergen).

Other than Mr. Ergen's testimony, there is no evidence that Mr. Ramsay ever gave Mr. Ergen such assurances. No witness or documentary [*6] evidence corroborates Mr. Ramsay's alleged assurance. And Mr. Ramsay testified that he did not have such a conversation. 6/27/06 Bench Trial Tr., 85:12-86:13 (Ramsay).

B. Equitable Estoppel - Conclusions of Law

HN1 To succeed on the defense of equitable estoppel, a defendant must satisfy the following elements by a preponderance of the evidence: (1) that the patentee, through misleading conduct, leads the alleged infringer to reasonably infer that the patentee does not intend to enforce its patent against the alleged infringer; (2) that the alleged infringer relies on that

conduct; and (3) due to its reliance, the alleged infringer will be materially prejudiced if the patentee is allowed to proceed with its claim. A.C. Aukerman Co. v. R.L. Chaides Constr. Co., 960 F.2d 1020, 1028 & 1046 (Fed. Cir. 1992).

"[E]ven where the three elements of equitable estoppel are established, [the trial court must] take into consideration any other evidence and facts respecting the equities of the parties in exercising its discretion and deciding whether to allow the defense of equitable estoppel to bar the suit." Aukerman, 960 F.2d at 1043.

EchoStar has not [*7] demonstrated by a preponderance of the evidence that Mr. Ramsay assured EchoStar that it would not bring a lawsuit for patent infringement. EchoStar has not demonstrated that TiVo engaged in misleading conduct from which EchoStar could reasonably infer TiVo would not sue EchoStar for patent infringement.

EchoStar has not established the first required element of the defense of equitable estoppel and therefore cannot prevail on this defense.

D. Laches - Findings of Fact

The '389 patent issued on May 15, 2001.

This action was filed by TiVo on January 5, 2004.

During the 2 1/2 years between issuance of the patent and filing of this action, the parties engaged in discussions regarding possible commercial agreements between them. 6/26/06 Bench Trial Tr., 52:16-23 (Ergen) (TiVo and EchoStar "did have a lot of contact" for 21/2 years after the patent issued).

E. Laches - Conclusions of Law

^{HN2}To succeed on the equitable defense of laches, a defendant must satisfy the following elements by a preponderance of the evidence: (1) that the plaintiff delayed filing suit for an unreasonable and inexcusable length of time from the time the plaintiff knew or reasonably should have known [*8] of its claim against the defendant; and (2) that the delay operated to the prejudice or injury of the defendant. A.C. Aukerman Co., 960 F.2d at 1028, 1032 & 1045.

Whether the length of time is unreasonable has no fixed boundaries but rather depends on the circumstances. *Id.*

A court must also consider and weigh any justification offered by the plaintiff for its delay, including whether the plaintiff was in negotiations with the defendant. *Id.* at 1033.

A presumption of laches arises where a patentee delays bringing suit for more than six years after the date the patentee knew or should have known of the alleged infringer's activity. *Id.* at 1028.

EchoStar has not demonstrated by a preponderance of the evidence that TiVo's 2 1/2 year delay before filing this action was unreasonable given the ongoing negotiations between the parties during that period.

EchoStar has not established the first required element of laches and therefore cannot prevail on this defense.

F. Inequitable Conduct - Findings of Fact

EchoStar's allegation of inequitable conduct is based on the alleged failure to disclose U.S. Patent No. 5,442,390 (the "Hooper patent") [***9**] and U.S. Patent No. 5,701,383 (the "Russo patent") to the Patent Office during the prosecution of the '389 patent. Dkt. No. 745, 17-23.

Attorneys Michael Glenn and Kirk Wong prosecuted the application leading to the '389 patent. 6/26/06 Bench Trial Tr., 178:9-23 (Glenn); 6/26/06 Bench Trial Tr., 197:21-23 (Wong).

Wong drafted the application leading to the '389 patent and responded to an office action from the Patent Office. 6/26/06 Bench Trial Tr., 183:11-18 (Glenn); 6/26/06 Bench Trial Tr., 197:14-23 (Wong); 6/27/06 Bench Trial Tr., 101:11-19 (Wong).

Glenn supervised and mentored Wong during prosecution of the '389 patent. 6/26/06 Bench Trial Tr., 178:14-23 (Glenn).

Glenn testified that he did not review the Russo patent during the prosecution of the application leading to the '389 patent. 6/26/06 Bench Trial Tr., 184:22-186:5 (Glenn).

Glenn testified that he had no knowledge as to why the Russo patent was not cited to the PTO during the prosecution of the application leading to the '389 patent. 6/26/06 Bench Trial Tr., 186:20-187:7; 189:7-12 (Glenn).

Wong testified that he did not review the Russo patent during the prosecution of the application leading to the '389 patent. [***10**] 6/27/06 Bench Trial Tr., 102:1-5 (Wong).

The Russo patent was cited on an International Search Report ("ISR") in another TiVo patent application during the pendency of the application that lead to the '389 patent. 6/27/06 Bench Trial Tr., 104:22-105:13 (Wong). The other TiVo patent application was not within the same patent family as the application leading to the '389 patent. 6/27/06 Bench Trial Tr., 105:1-106:1 (Wong).

The Russo patent was listed as an "A" reference in the ISR. 6/27/06 Bench Trial Tr., 162:19-23 (Gordon).

"A" references are considered less relevant than other categories of references on ISRs. 6/27/06 Bench Trial Tr., 106:5-12 (Wong); 6/27/06 Bench Trial Tr., 161:14-19; 162:13-18 (Gordon).

It is Wong's practice not to read the "A" references. 6/27/06 Bench Trial Tr., 106:13-17 (Wong). It is common for patent attorneys not to read "A" references. 6/27/06 Bench Trial Tr., 162:24-163:1 (Gordon).

Wong does not recall reviewing an ISR citing the Russo patent during the prosecution of the application leading to the '389 patent. 6/27/06 Bench Trial Tr., 107:15-19 (Wong).

Glenn testified the law firm that prosecuted the application leading to the '389 patent had a policy [***11**] in place whereby a staff paralegal was responsible for monitoring prior art cited in ISRs and compiling the citations of prior art for disclosure to the PTO on related Untied Sates applications. 6/26/06 Bench Trial Tr., 192:19-193:21 (Glenn). This is a common practice. 6/27/06 Bench Trial Tr., 164:11-165:7 (Gordon).

Wong testified that a paralegal or docketing clerk would have compiled the references cited in an ISR and prepared the disclosed statement for the PTO. 6/27/06 Bench Trial Tr., 107:4-7 (Wong). Wong does not recall reviewing the disclosures to the PTO during the prosecution of the application leading to the '389 patent. 6/27/06 Bench Trial Tr., 107:15-19 (Wong).

The Hooper patent was cited in an office action in another TiVo patent application while the application leading to the '389 patent' was being prosecuted. 6/27/06 Bench Trial Tr., 108:1-10 (Wong). The application it was cited in was not within the same patent family as the application leading to the '389 patent'. *Id.*

Glenn testified that he had no recollection of the Hooper patent. 6/26/06 Bench Trial Tr., 191:13-25; 192:7-11 (Glenn).

Wong testified that he did not review the Hooper patent during the prosecution [*12] of the application leading to the '389 patent'. 6/27/06 Bench Trial Tr., 102:1-5; 110:7-10 (Wong). Wong testified that he learned of the Hooper patent during the end of May 2001, after the '389 patent' issued. 6/27/06 Bench Trial Tr., 107:20-23 (Wong).

It was the practice at Glenn's law firm to disclose all of the prior art of which they were aware. 6/26/06 Bench Trial Tr., 180:22-182:5 (Glenn).

During the prosecution of the '389 patent', a number of prior art references were brought to the examiner's attention. 6/27/06 Bench Trial Tr., 173:1-21 (Gordon); PX-2267 at TIVO 400058, 400063, 400067 ('389 patent' IDS forms); see also 6/27/06 Bench Trial Tr., 104:8-15 (Wong); 6/26/06 Bench Trial Tr., 185:21-186:5 (Glenn); 6/27/06 Bench Trial Tr., 104:8-11 (Wong); DX-2267 at TIVO 400058, 400063 ('389 patent' IDS forms); 6/27/06 Bench Trial Tr., 173:1-21 (Gordon); 6/27/06 Bench Trial Tr., 66:19-25 (Sheridan).

Glenn testified that he did not want to be in a position where his honoring of his Rule 56 obligations might be called into question, so his policy was always to send prior art in. 6/26/06 Bench Trial Tr., 185:1-15 (Glenn). Glenn's testimony indicates that his practice was to carefully [*13] comply with his Rule 56 obligations. Glenn's testimony indicates he did not intentionally withhold prior art from the Patent Office.

Glenn and Wong had a strong motivation not to withhold references from the Patent Office.

Withholding known, material references from the Patent Office provides no benefit for an attorney or a client. 6/27/06 Bench Trial Tr., 35:25-36:3 (Sheridan); 6/27/06 Bench Trial Tr., 171:19-172:20 (Gordon).

HN3 Being accused of inequitable conduct can seriously damage an attorney's reputation and can risk their membership in their state bar and their ability to prosecute patents before the Patent Office. PX-2200, 8/1/05 Gordon Report, P 46; PX-2203, Gambrell Depo. 60:12-19. 6/27/06 Bench Trial Tr., 35:22-24, 36:17-20 (Sheridan).

EchoStar's own expert has acknowledged that attorneys want to submit all of the prior art they are aware of so they can obtain better patents with a clean record in the event the patent is eventually licensed or the subject of litigation. 6/27/06 Bench Trial Tr., 36:4-11 (Sheridan); 6/27/06 Bench Trial Tr., 171:19-172:20 (Gordon).

There is no evidence that Glenn or Wong knew of the content of Russo or Hooper, or knew of the alleged materiality [*14] of Russo or Hooper while the '389 patent' was pending.

Glenn and Wong could not have decided to withhold Russo or Hooper patents because they were not aware of these patents while the '389 patent' was pending.

G. Inequitable Conduct - Conclusions of Law

HN4 To succeed on a claim of inequitable conduct due to failure to disclose material information, the infringing defendant must prove by clear and convincing evidence: (1) prior art that was material; (2) knowledge chargeable to an applicant of that prior art and of its

materiality; and (3) failure of the applicant to disclose the art resulting from an intent to mislead the Patent Office. Molins PLC v. Textron, Inc., 48 F.3d 1172, 1178 (Fed. Cir. 1995).

Allegations of inequitable conduct for failure to disclose material information "may be rebutted by a showing that: (a) the prior art was not material; (b) if the prior art was material, a showing that the applicant did not know of that art; (c) if the applicant did know of that art, a showing that the applicant did not know of its materiality; or (d) a showing that the applicant's failure to disclose the art did not result from an intent to mislead the Patent Office. [*15] " Elk Corp. of Dallas v. GAF Bldg. Materials Corp., 168 F.3d 28, 30 (Fed. Cir. 1999).

HN5 "The Federal Circuit has declared that "[a] party seeking to have a patent declared unenforceable has a heavy burden to meet." Hoffmann-La Roche Inc. v. Promega Corp., 323 F.3d 1354, 1359 (Fed. Cir. 2003).

HN6 "Absent proof of a threshold level of both materiality and intent, there can be no determination of inequitable conduct." Key Pharms. v. Hercon Lab. Corp., 161 F.3d 709, 719 (Fed. Cir. 1998); see also Purdue Pharma L.P. v. Endo Pharms., Inc., 438 F.3d 1123, 1128 (Fed. Cir. 2006).

Intent is a separate requirement of inequitable conduct. Upjohn Co. v. Mova Pharm. Corp., 225 F.3d 1306, 1312 (Fed. Cir. 2000).

HN7 "In a case involving an omission of a material reference to the Patent Office, there must be clear and convincing evidence that the applicant made a deliberate decision to withhold a known material reference." Baxter Int'l, Inc. v. McGaw, Inc., 149 F.3d 1321, 1329 (Fed. Cir. 1998). "Intent to deceive can not be inferred solely from the fact that information was not disclosed; there must be a [*16] factual basis for a finding of deceptive intent." Upjohn, 225 F.3d at 1312 (internal citation omitted); see also In re Hayes Microcomputer Prods., Inc. Patent Litigation, 982 F.2d 1527, 1546 (Fed. Cir. 1992) ("Conjecture alone is not sufficient to show an intent to deceive to support the defense of inequitable conduct.").

HN8 "The Federal Circuit has stated that it "will not find inequitable conduct on an evidentiary record that is completely devoid of evidence of the patentee's intent to deceive the Patent Office." Amgen Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1358 (Fed. Cir. 2003).

HN9 "In inequitable conduct cases involving allegations that prior art was not disclosed to the Patent Office, the absence of a good faith explanation cannot be clear and convincing evidence of deceptive intent. M. Eagles Tool Warehouse, Inc. v. Fisher Tooling Co., Inc., 439 F.3d 1335, 1341 ("When the absence of a good faith explanation is the only evidence of intent, however, that evidence alone does not constitute clear and convincing evidence warranting an inference of intent.").

Based on the evidence and having observed their [*17] testimony, the Court finds Glenn and Wong's testimony to be credible and does not establish an intent to withhold the Russo or Hooper patents from the Patent Office while the '389 patent was pending.

Based on the evidence and having observed the testimony of Glenn and Wong, the Court finds no basis to infer an intent to deceive the Patent Office.

There is not clear and convincing evidence to establish that either Glenn or Wong had intended to deceive the Patent Office. 6/27/06 Bench Trial Tr., 171:10-18, 173:1-21 (Gordon).

Because EchoStar did not establish by clear and convincing evidence that either Glenn or

Wong intended to deceive the PTO during the prosecution of the application leading to the '389 patent, they cannot succeed on their inequitable conduct defense.

IV. CONCLUSION

As set forth above, the Court finds that Defendants have not met their burden of proof on the affirmative defenses of equitable estoppel, laches, or inequitable conduct and therefore have not prevailed on these defenses. It is so **ORDERED**.

To the extent that any findings of fact are deemed to be conclusions of law, they are incorporated herein as conclusions of law. Conversely, to the extent [*18] that any conclusions of law are deemed to be findings of fact, they are incorporated herein as findings of fact.

SIGNED this 17th day of August, 2006.

DAVID FOLSOM

UNITED STATES DISTRICT JUDGE







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2006 U.S. Dist. LEXIS 64291, *

TIVO INC., Plaintiff, v. ECHOSTAR COMMUNICATIONS CORP., et al. Defendants.

2:04-CV-1-DF

UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF TEXAS, MARSHALL
DIVISION

2006 U.S. Dist. LEXIS 64291

August 17, 2006, Decided

August 17, 2006, Filed

SUBSEQUENT HISTORY: Costs and fees proceeding at, Motion denied by [TiVo Inc. v. EchoStar Communs. Corp., 2006 U.S. Dist. LEXIS 64293 \(E.D. Tex., Aug. 17, 2006\)](#)

PRIOR HISTORY: [TiVo Inc. v. Echostar Communs. Corp., 2006 U.S. Dist. LEXIS 64292 \(E.D. Tex., Aug. 17, 2006\)](#)

CASE SUMMARY

PROCEDURAL POSTURE: Plaintiff patentee was awarded damages in a patent infringement case against defendants after a jury found that defendants' digital video recorders infringed each of the asserted claims and found that the infringement was willful. Plaintiff filed a motion for prejudgment interest and supplemental damages under [35 U.S.C.S. § 284](#).


OVERVIEW: The patentee sought prejudgment interest on the entire damages award from the time that the lawsuit was filed until the date of final judgment at the prime rate, compounded annually. Further, the patentee sought supplemental damages for the ongoing infringement that was not covered by the jury's award. Defendants argued that the prejudgment interest should be calculated at the one year U.S. Treasury bill rate and claimed that the patentee waived its right to supplemental damages by not requesting a post-verdict accounting in its pleadings or in the final pretrial order. The court granted the patentee's motion. The court held that the Treasury rate was inadequate and that the prime rate was appropriate for a prejudgment interest award. The court also found that the patentee was entitled to supplemental damages because such damages were compensatory in nature and the denial of such damages would result in a windfall to defendants. Because the patentee requested compensatory damages in its pretrial order, it did not waive its right to request such damages. The court awarded interest and supplemental damages in the amount calculated by the patentee's expert.

OUTCOME: The court granted the patentee's motion for prejudgment interest and supplemental damages.


CORE TERMS: supplemental, prejudgment interest, calculation, prime rate, infringement, royalty, infringing, interest rate, patentee, compensatory, prejudgment, accounting, jury verdict, compensatory damages, infringe, claimant, pretrial, damages award, calculating, patent infringement, jury awarded, lost profits, financial condition, mischaracterize, calculated, infringer, windfall, awarding, borrowed, lawsuit


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[Patent Law](#) > [Remedies](#) > [Damages](#) > [General Overview](#) 


HN1  Damage awards in patent infringement lawsuits are addressed in 35 U.S.C.S. § 284: Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court. The court may receive expert testimony as an aid to the determination of damages or of what royalty would be reasonable under the circumstances. Though not explicitly mentioned, prejudgment interest and supplemental damages are grounded in this statute. [More Like This Headnote](#)


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[Patent Law](#) > [Remedies](#) > [Collateral Assessments](#) > [Prejudgment Interest](#) 


HN2  Prejudgment interest shall be awarded in patent infringement cases absent some justification for withholding such an award. Such interest is compensatory in nature and should be awarded for both lost profits and reasonable royalty awards. [More Like This Headnote](#)

[Civil Procedure](#) > [Remedies](#) > [Judgment Interest](#) > [Prejudgment Interest](#) 




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HN3  Unlike postjudgment interest for which the interest rate is set by statute, there is no mandatory interest rate and no standard rate for prejudgment interest. Courts are afforded "wide latitude" in setting the prejudgment interest rate. As a result, courts have set different rates in different cases, but most often award prejudgment interest at either the prime rate or the U.S. Treasury rate. [More Like This Headnote](#)

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HN4  A patentee is entitled to damages for the entire period of infringement and should therefore be awarded supplemental damages for any periods of infringement not covered by the jury verdict. Such damages are compensatory in nature. Supplemental damages are calculated consistent with the damages awarded in the jury verdict. Failure to include a separate request for "supplemental" damages does not result in waiver because such damages are a component of any request for compensatory damages. [More Like This Headnote](#)

COUNSEL: [*1] Robert W Faulkner, Mediator, Pro se, Dallas, TX.

For TIVO Inc, a Delaware corporation, Plaintiff: [Alexander C D Giza](#) , [Adam S Hoffman](#) , [Perry M Goldberg](#) , [Richard E Lyon](#) , Irell & Manella LLP, Los Angeles, CA; [Andrei Iancu](#) , [Christine W S Byrd](#) , Irell & Manella - Los Angeles, Los Angeles, CA; [Morgan Chu](#) , Irell & Manella, Los Angeles, CA; [Samuel Franklin Baxter](#) , Attorney at Law, Marshall,

TX; Ben Yorks ↘, Brian Jones, Michelle Armond ↘, Irell & Manella - Newport Beach, Newport Beach, CA; R Scott Feldmann ↘, Randall I Erickson ↘✉, Steven P Rice ↘✉, Van V Nguyen ↘, Crowell & Moring - Irvine, Irvine, CA; Garret Wesley Chambers ↘, McKool Smith - Dallas, Dallas, TX.

For Echostar Communications Corporation, a Nevada corporation, Echostar DBS Corporation, a Colorado corporation, EchoStar Technologies Corporation, Echosphere Limited Liability Company, Defendants: Alison M Tucher ↘, Jason A Crotty ↘, Robert M Harkins, Jr ↘, Morrison & Foerster LLP San Francisco, San Francisco, CA; Rachel Krevans ↘✉, Harold J. McElhinny ↘✉, Morrison & Foerster LLP, San Francisco, CA; Karl J Kramer ↘, Morrison & Foerster - Palo Alto, Palo Alto, CA; Damon Michael Young ↘✉, Young Pickett & Lee, Texarkana, TX.

For "EchoStar defendants", [*2] Defendant: Emily A Evans ↘, Morrison & Foerster - Palo Alto, Palo Alto, CA; Scott F Llewellyn ↘, Morrison & Foerster, Denver, CO; Kristina Paszek ↘, Alison M Tucher ↘, Robert M Harkins, Jr ↘, Morrison & Foerster LLP San Francisco, San Francisco, CA; Harold J. McElhinny ↘✉, Rachel Krevans ↘✉, Morrison & Foerster LLP, San Francisco, CA; John Michael Pickett ↘✉, Young Pickett & Lee, Texarkana, TX; Karl J Kramer ↘, Morrison & Foerster - Palo Alto, Palo Alto, CA.

For Merchant & Gould, Subpoena recipient, Movant: Charles Conrow Murphy, Jr ↘✉, Vaughan & Murphy, Atlanta, Ga.

For EchoStar Technologies Corporation, Echosphere Limited Liability Company, Counter Claimants: Alison M Tucher ↘, Jason A Crotty ↘, Robert M Harkins, Jr ↘, Morrison & Foerster LLP San Francisco, San Francisco, CA; Karl J Kramer ↘, Morrison & Foerster - Palo Alto, Palo Alto, CA; Damon Michael Young ↘✉, Young Pickett & Lee, Texarkana, TX.

For TIVO Inc, a Delaware corporation, Counter Defendant: Adam S Hoffman ↘, Irell & Manella LLP, Los Angeles, CA.

For EchoStar Communications Corporation, a Nevada corporation, EchoStar DBS Corporation a Colorado corporation, Counter Claimants: Alison M Tucher ↘, Jason A Crotty ↘, Robert M Harkins, Jr ↘, Morrison [*3] & Foerster LLP San Francisco, San Francisco, CA; Karl J Kramer ↘, Morrison & Foerster - Palo Alto, Palo Alto, CA.

For Echostar Satellite LLC, Counter Claimant: Karl J Kramer ↘, Morrison & Foerster - Palo Alto, Palo Alto, CA.

JUDGES: DAVID FOLSOM, UNITED STATES DISTRICT JUDGE.

OPINION BY: DAVID FOLSOM

OPINION

ORDER

Before the Court is Plaintiff TiVo's Motion for Prejudgment Interest and Supplemental Damages. Dkt. No. 732. Also before the Court is Defendants' opposition and Plaintiff's reply. Dkt. Nos. 736 and 744, respectively. On June 28, 2006 the Court heard the parties on this motion. Having considered the motion, all other relevant briefing, and the applicable law, the Court finds Plaintiff's Motion for Prejudgment Interest and Supplemental Damages is well taken and should be **GRANTED** as set forth herein.

I. BACKGROUND

In this patent infringement action, Plaintiff claimed a number of Defendants' digital video recorders ¹ ("DVRs") infringe several claims in Plaintiff's U.S. Patent No. **6,233,389** (the "**389 patent**"). In March 2006-April 2006, the case was tried to a jury. The jury found that Defendants' accused DVRs infringed each of the asserted claims and further found [***4**] that Defendants' infringement was willful. None of the asserted claims was found invalid. The jury awarded Plaintiff \$ 32,663,906 in lost profits damages for 192,708 infringing DVRs and \$ 41,328,058 in reasonable royalty damages for 4,179,253 infringing DVRs. Dkt. No. 690.

FOOTNOTES

¹ The following of Defendants' DVR receivers were found to infringe: DP-501; DP-508; DP-510; DP-522; DP-625; DP-721; DP-921; and the DP-942.

Plaintiff now moves for an award of prejudgment interest and supplemental damages. Defendants oppose.

II. LEGAL PRINCIPLES

HN1 ¶ Damage awards in patent infringement lawsuits are addressed in 35 U.S.C. § 284:

Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court.

* * *

The court may receive expert testimony as an aid to the determination of [***5**] damages or of what royalty would be reasonable under the circumstances.

Though not explicitly mentioned, prejudgment interest and supplemental damages are grounded in this statute.

A. Prejudgment Interest

HN2 ¶ Prejudgment interest should be awarded "absent some justification for withholding such an award." Gen. Motors Corp. v. Devex Corp., 461 U.S. 648, 656, 103 S. Ct. 2058, 76 L. Ed. 2d 211 (1983). Such interest is compensatory in nature and should be awarded for both lost profits and reasonable royalty awards. Gen. Motors Corp., 461 U.S. at 656; Hoechst Celanese Corp. v. BP Chems., 846 F. Supp. 542, 551 (S.D. Tex. 1994), *aff'd* 78 F.3d 1575 (Fed. Cir. 1996); Gyromat Corp. v. Champion Spark Plug Co., 735 F.2d 549, 556 (Fed. Cir. 1984).

HN3 ¶ Unlike post-judgment interest for which the interest rate is set by statute, there is no mandatory interest rate and no standard rate. Courts are afforded "wide latitude" in setting the prejudgment interest rate. Uniroyal, Inc. v. Rudkin-Wiley Corp., 939 F.2d 1540, 1545 (Fed. Cir. 1991); Studiengesellschaft Kohle v. Dart Indus., Inc., 862 F.2d 1564, 1580 (Fed. Cir. 1988). [***6**] As a result, courts have set different rates in different cases, but most often award prejudgment interest at either the prime rate or the U.S. Treasury rate. *See, e.g., Lam, Inc. v. Johns-Manville Corp.*, 718 F.2d 1056 (Fed. Cir. 1983); Uniroyal, Inc. v. Rudkin-Wiley Corp., *supra*, 939 F.2d at 1545; Laitram Corp. v. NEC Corp., 115 F.3d 947, 955

(Fed. Cir. 1997); *Allen Archery, Inc. v. Browning Mfg. Co.*, 898 F.2d 787, 789 & 792 (Fed. Cir. 1990); *Datascope Corp. v. SMEC, Inc.*, 879 F.2d 820, 829 (Fed. Cir. 1989).

B. Supplemental Damages

^{HN4} A patentee is entitled to damages for the entire period of infringement and should therefore be awarded supplemental damages for any periods of infringement not covered by the jury verdict. See *Stryker Corp. v. Davol, Inc.*, 75 F. Supp. 2d 746 (W.D. Mich. 1999), *aff'd*, 234 F.3d 1252. Such damages are compensatory in nature. *Nat'l Instruments Corp. v. Mathworks, Inc.*, 2003 U.S. Dist. LEXIS 25863 (D. Tex. June 23, 2003) ("A failure to award such damages would grant an infringer a windfall by enabling it to infringe [*7] without compensating a patentee for the period of time between the jury's verdict and the judgment."). Supplemental damages are calculated consistent with the damages awarded in the jury verdict. *E.g.*, *id.* at *12; *Mikohn Gaming*, 2001 U.S. Dist. LEXIS 23416 at 64-65 (D. Nev. Aug. 1, 2001) (applying minimum royalty rate proposed by claimant of 28%). Failure to include a separate request for "supplemental" damages does not result in waiver because such damages are a component of any request for compensatory damages. *Id.* at *54-61 (Finding that the patentee's failure to separately request an "accounting" in the pretrial order was of no consequence and awarding supplemental reasonable royalty damages).

III. THE PARTIES' POSITIONS

Plaintiff requests prejudgment interest on the entire damages award from the time the lawsuit was filed in January 2004 until the date of the final judgment. Dkt. No. 732 at 3. According to Plaintiff, during this infringement period, Plaintiff maintained a revolving line of credit for which the interest rate was "the greater of prime or 4.00% per annum." *Id.* at 4. Thus Plaintiff argues that the prime rate, compounded annually, [*8] is the appropriate prejudgment interest rate and proffers calculations from its damages expert using this rate. *Id.* at 5 citing Ugone Decl. Plaintiff's expert's calculations result in a total prejudgment interest award of \$ 5,367,544 through July 31, 2006. Ugone Decl., Exh. C. Further calculations are not included but could presumably be performed according to the same formula.

Second, Plaintiff requests supplemental damages for infringing DVRs not covered by the jury's damages award. Dkt. No. 732 at 6. The damages award accounted for infringing DVRs placed through March 31, 2006, but does not account for placements made from April 1, 2006 through the date of the final judgment. Plaintiff argues that, because Defendants' infringement has continued, it is entitled to supplemental damages for the ongoing infringement that was not covered by the jury's award. *Id.* at 7.

According to Plaintiff, supplemental damages should cover both: newly-placed infringing units sold or leased by Defendants after March 31, 2006; and continuing infringing units (units on which the jury awarded monthly royalties only through March 31, 2006 but on which Defendants are still collecting fees from [*9] subscribers). ² Plaintiff proffers a calculation from its damages expert, based on the same reasonable royalty methodology he used for his trial damages calculation, amounting to \$ 10,317,108 in supplemental damages from April 1, 2006 -- July 31, 2006. Ugone Decl., Exh. H.

FOOTNOTES

² Plaintiff does not request lost profits on any portion of the units placed by Defendants after March 31, 2006. Dkt. No. 732 at 7 n.4.

Defendant argues that prejudgment interest should be calculated at the one year U.S.

Treasury rate. Dkt. No. 736. Defendants argue this rate is appropriate for three reasons: its sound financial condition warrants calculation of prejudgment interest at a risk-free rate; Plaintiff's evidence in support of the prime rate is highly speculative; and "both parties' damages experts agree that the one-year Treasury rate is an appropriate rate for calculating prejudgment interest." *Id.* at 8. Defendants, though not providing their own calculation of prejudgment interest, do not challenge Plaintiff's expert's [*10] calculation of prejudgment interest of \$ 2,903,718 through July 31, 2006 using the U.S. Treasury rate. Ugone Decl., Exh. F.

Defendants oppose Plaintiff's request for supplemental damages on the basis that Plaintiff waived its right to such damages by not requesting a post-verdict accounting in its pleadings or in the Final Pre-Trial Order. Dkt. No. 736 at 12-14.

In reply, Plaintiff disputes the strength of Defendants' financial condition and argues it is untrue that it "never faced 'a real risk' that it would not be compensated if [Defendants] were found liable." Dkt. No. 744 at 5. Plaintiff also argues that the Federal Circuit has "expressly held that a patentee need not demonstrate that it borrowed at the prime rate in order to be entitled to prejudgment interest at that rate." *Id.* at 6, citing *Studiengesellschaft Kohle*, 862 F.2d at 1579-80. And, Plaintiff argues Defendants mischaracterize its expert's statements. Plaintiff's expert offered a prejudgment interest calculation at the one-year Treasury rate as an alternative "in the event the Court should find this rate appropriate instead." *Id.* at 6 citing Ugone Decl. (emphasis supplied).

Regarding [*11] its supplemental damages request, Plaintiff argues Defendants mischaracterize the law by treating the right to request an accounting as the same thing as the right to supplemental damages. *Id.* at 7. Plaintiff argues Defendants cite only accounting cases; Plaintiff however asks for supplemental damages, which it argues are compensatory. Plaintiff requested compensatory damages in the pretrial order. Thus, Plaintiff argues, there has been no waiver. *Id.* at 8-9.

IV. DISCUSSION

The Court finds that Plaintiff is more likely to have had to borrow funds at the prime rate during the period of infringement and would likely have borrowed at the prime rate or higher. A calculation of prejudgment interest at the U.S. Treasury bill rate would be inadequate. *Uniroyal, Inc.*, 939 F.2d at 1545 (awarding prejudgment interest at the prime rate where patentee financed at rates above prime during the infringement period). Thus, prejudgment interest will be awarded at the prime rate beginning on January 4, 2004 and ending as of the date of this judgment.

Defendants do not dispute the calculation of prejudgment interest at the prime rate performed by Plaintiff's expert, [*12] Dr. Ugone. Therefore, the Court will award prejudgment interest in the amount of his calculation through July 31, 2006. No later than two weeks after the date of this order, Plaintiff shall submit a supplemental declaration from Dr. Ugone calculating the prejudgment interest accrued from July 31, 2006 to the date of this order.

Plaintiff is also entitled to supplemental damages. Such damages are compensatory in nature and the denial of such damages would result in a windfall to Defendants. Because Plaintiff requested compensatory damages in the pretrial order, Plaintiff did not waive its right to request such damages.

Defendants do not dispute the accuracy of Dr. Ugone's calculation of supplemental reasonable royalty damages, nor do they offer an alternative calculation. Therefore, the Court will award supplemental damages in the amount of his calculation through July 31, 2006. No later than two weeks after the date of this order, Plaintiff shall submit a

supplemental declaration from Dr. Ugone calculating the supplemental damages accrued from July 31, 2006 to the date of this order.

V. CONCLUSION

For all the above reasons, Plaintiff's Motion for Prejudgment Interest and [*13] Supplemental Damages, Dkt. No. 732, is hereby GRANTED as set forth herein.

SIGNED this 17th day of August, 2006.

DAVID FOLSOM

UNITED STATES DISTRICT JUDGE







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2006 U.S. Dist. LEXIS 64293, *

TIVO INC., Plaintiff, v. ECHOSTAR COMMUNICATIONS CORP., et al. Defendants.

2:04-CV-1-DFUNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF TEXAS, MARSHALL
DIVISION

2006 U.S. Dist. LEXIS 64293

August 17, 2006, Decided

August 17, 2006, Filed

SUBSEQUENT HISTORY: [Injunction granted at *TiVo Inc. v. EchoStar Communs. Corp.*, 446 F. Supp. 2d 664, 2006 U.S. Dist. LEXIS 64290 \(E.D. Tex., Aug. 17, 2006\)](#)**PRIOR HISTORY:** [TiVo Inc. v. Echostar Communs. Corp.](#), 2006 U.S. Dist. LEXIS 64291 (E.D. Tex., Aug. 17, 2006)**CASE SUMMARY**

PROCEDURAL POSTURE: Plaintiff patentee claimed defendant competitors' digital video recorders (DVRs) infringed claims in its patent. After finding that the accused DVRs infringed the asserted claims and that the infringement was willful, the jury awarded the patentee almost \$74 million in damages. The patentee then moved for treble damages under [35 U.S.C.S. § 284](#), and a determination that the case was exceptional warranting attorneys' fees under [35 U.S.C.S. § 285](#).


OVERVIEW: No enhancement of damages was warranted since the evidence did not show that the competitors acted in bad faith, and the jury's willfulness finding did not amount to a finding of bad faith. The competitors' excluded opinion-counsel report, when considered with the trial evidence, showed that the competitors' actions were not in wanton disregard of the patentee's rights. Thus, it was inappropriate to enhance damages under [35 U.S.C.S. § 284](#) based on the jury's willfulness finding. The patentee's request for a designation of the case as exceptional was made based on essentially the same factors as cited in support of its enhanced damages request; i.e., the jury's willfulness finding and the competitors' conduct during the litigation. However, the jury's willfulness finding was reached without the evidence of the competitors' post-filing retention of opinion counsel, which determined there had been no infringement. Considering the totality of the circumstances, the competitors' actions were not egregious and reckless and therefore an exceptional case designation was not warranted. Further, the competitors' behavior during the litigation did not warrant an exceptional case designation.


OUTCOME: The patentee's motion for treble damages and for a determination that the case was exceptional entitling it to recover attorneys' fees was denied.


CORE TERMS: willfulness, infringement, attorneys' fees, exceptional case, vexatious, infringe, infringing, bad faith, enhancement, discovery, infringer's, opinion letters, supplemental, exceptional, infringed, enhanced, in-house, patent, willful, treble damages, misconduct, vexatious litigation, prejudgment interest, totality, enhance, outside counsel, injunction, entitling, jury trial, jury verdict

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HN1  Under [35 U.S.C.S. § 284](#), a court may increase the damages up to three times the amount found or assessed. Enhanced damages are punitive, not compensatory, and therefore the imposition of such damages requires some degree of culpability. [More Like This Headnote](#)


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HN2  Determining whether to enhance damages requires a two-step process. First the factfinder must determine whether an infringer is guilty of conduct upon which increased damages may be based. The first step is satisfied where the accused infringer has acted in bad faith, either by engaging in vexatious litigation or in willful infringement. Second, exercising its sound discretion, the court determines whether, and to what extent, to increase the damages award given the totality of the circumstances. The paramount determination in deciding to grant enhancement and the amount thereof is the egregiousness of the defendant's conduct based on all the facts and circumstances. [More Like This Headnote](#)


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HN3  Although the determination of whether to enhance damages is made in light of the totality of the circumstances, the U.S. Court of Appeals for the Federal Circuit has compiled a non-exhaustive list of factors to consider: (1) whether the infringer deliberately copied the ideas of another; (2) whether the infringer investigated the scope of the patent and formed a good faith belief that it was invalid or not infringed; (3) the infringer's behavior as a party to the litigation; (4) the defendant's size and financial condition; (5) the closeness of the case; (6) the duration of the defendant's misconduct; (7) remedial action by the defendant; and (8) the defendant's motivation for willfully infringing. [More Like This Headnote](#)

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HN4  See [35 U.S.C.S. § 285](#).

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[Patent Law](#) > [Remedies](#) > [Collateral Assessments](#) > [Attorney Fees](#) 

HN5  Determining whether a case is exceptional and, thus, eligible for an award of attorneys' fees under [35 U.S.C.S. § 285](#) is a two-step process. First, the district court must determine whether a case is exceptional, a factual determination reviewed for clear error. After determining that a case is exceptional, the district court must determine whether attorney fees are appropriate. Most often, a case is deemed exceptional because of bad faith actions, such as vexatious litigation, or after a jury verdict of willful infringement. The district court judge has discretion in determining whether or not to award fees, even where the jury has found willful infringement. However, when a trial court denies attorney fees in spite of a finding

of willful infringement, the court must explain why the case is not exceptional within the meaning of the statute. [More Like This Headnote](#)

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HN6 In determining whether to award enhanced damages under 35 U.S.C.S. § 284, it is not a district court's role to reweigh the evidence of infringement; the jury verdict stands. However, the court must consider the willfulness evidence not before the jury when it made its determination. [More Like This Headnote](#)

COUNSEL: [*1] Robert W Faulkner, Mediator, Pro se, Dallas, TX.

For TIVO Inc, a Delaware corporation, Plaintiff: [Alexander C D Giza](#), [Adam S Hoffman](#), [Perry M Goldberg](#), [Richard E Lyon](#), [Irell & Manella LLP](#), Los Angeles, CA; [Andrei Iancu](#), [Christine W S Byrd](#), [Irell & Manella - Los Angeles](#), Los Angeles, CA; [Morgan Chu](#), [Irell & Manella](#), Los Angeles, CA; [Samuel Franklin Baxter](#), Attorney at Law, Marshall, TX; [Ben Yorks](#), [Brian Jones](#), [Michelle Armond](#), [Irell & Manella - Newport Beach](#), Newport Beach, CA; [R Scott Feldmann](#), [Randall I Erickson](#), [Steven P Rice](#), [Van V Nguyen](#), [Crowell & Moring - Irvine](#), Irvine, CA; [Garret Wesley Chambers](#), [McKool Smith - Dallas](#), Dallas, TX.

For EchoStar Communications Corporation, a Nevada corporation, Echostar DBS Corporation, a Colorado corporation, EchoStar Technologies Corporation, Echosphere Limited Liability Company, Defendants : [Alison M Tucher](#), [Jason A Crotty](#), [Robert M Harkins, Jr](#), [Morrison & Foerster LLP San Francisco](#), San Francisco, CA; [Rachel Krevans](#), [Harold J. McElhinny](#), [Morrison & Foerster LLP](#), San Francisco, CA; [Karl J Kramer](#), [Morrison & Foerster - Palo Alto](#), Palo Alto, CA; [Damon Michael Young](#), [Young Pickett & Lee](#), Texarkana, TX.

For "EchoStar defendants", [*2] Defendant: [Emily A Evans](#), [Morrison & Foerster - Palo Alto](#), Palo Alto, CA; [Scott F Llewellyn](#), [Morrison & Foerster](#), Denver, CO; [Kristina Paszek](#), [Alison M Tucher](#), [Robert M Harkins, Jr](#), [Morrison & Foerster LLP San Francisco](#), San Francisco, CA; [Harold J. McElhinny](#), [Rachel Krevans](#), [Morrison & Foerster LLP](#), San Francisco, CA; [John Michael Pickett](#), [Young Pickett & Lee](#), Texarkana, TX; [Karl J Kramer](#), [Morrison & Foerster - Palo Alto](#), Palo Alto, CA.

For Merchant & Gould, Subpoena recipient, Movant: [Charles Conrow Murphy, Jr](#), [Vaughan & Murphy](#), Atlanta, Ga.

For EchoStar Technologies Corporation, Echosphere Limited Liability Company, Counter Claimants: [Alison M Tucher](#), [Jason A Crotty](#), [Robert M Harkins, Jr](#), [Morrison & Foerster LLP San Francisco](#), San Francisco, CA; [Karl J Kramer](#), [Morrison & Foerster - Palo Alto](#), Palo Alto, CA; [Damon Michael Young](#), [Young Pickett & Lee](#), Texarkana, TX.

For TIVO Inc, a Delaware corporation, Counter Defendant: [Adam S Hoffman](#), [Irell & Manella LLP](#), Los Angeles, CA.

For EchoStar Communications Corporation, a Nevada corporation, EchoStar DBS Corporation, a Colorado corporation, Counter Claimants: [Alison M Tucher](#), [Jason A Crotty](#), [Robert M Harkins, Jr](#), [Morrison & Foerster LLP San Francisco](#), San Francisco, CA; [Karl J Kramer](#), [Morrison & Foerster - Palo Alto](#), Palo Alto, CA.

For Echostar Satellite LLC, Counter Claimant: [Karl J Kramer](#), [Morrison & Foerster - Palo Alto](#), Palo Alto, CA.

JUDGES: DAVID FOLSOM, UNITED STATES DISTRICT JUDGE.

OPINION BY: DAVID FOLSOM

OPINION

ORDER

Before the Court is Plaintiff TiVo's Motion for Treble Damages and for a Determination that this is an "Exceptional Case" Entitling TiVo to Recover Attorneys' Fees. Dkt. No. 734. Also before the Court is Defendants' opposition and Plaintiff's reply. Dkt. Nos. 739 and 752, respectively. On June 28, 2006 the Court heard the parties on this motion. Having considered the motion, all other relevant briefing, and the applicable law, the Court finds Plaintiff's Motion for Treble Damages and for a Determination that this is an "Exceptional Case" Entitling TiVo to Recover Attorneys' Fees should be **DENIED**.

I. BACKGROUND

In this patent infringement action, Plaintiff claimed a number of Defendants' digital video recorders ¹ ("DVRs") infringe several claims in Plaintiff's U.S. Patent No. **6,233,389** (the "389 patent"). In March 2006-April 2006, the case was tried to a jury. [*4] The jury found that Defendants' accused DVRs infringed each of the asserted claims and further found that Defendants' infringement was willful. None of the asserted claims was found invalid. The jury awarded Plaintiff \$ 73,991,964 million in compensatory damages.

FOOTNOTES

¹ The following of Defendants' DVR receivers were found to infringe; DP-501; DP-508; DP-510; DP-522; DP-625; DP-721; DP-921; and the DP-942.

Plaintiff now moves for treble damages and a determination that this was an "exceptional case" warranting attorneys' fees. Defendants oppose.

II. LEGAL PRINCIPLES

A. Enhanced Damages

^{HN1} Under 35 U.S.C. § 284, "the court may increase the damages up to three times the amount found or assessed." Enhanced damages are punitive, not compensatory, and therefore the imposition of such damages requires some degree of culpability. *Jurgens v. CBK, Ltd.*, 80 F.3d 1566, 1570 (Fed. Cir. 1996).

^{HN2} Determining whether to enhance damages requires a two-step process. First [*5] the fact-finder must determine whether an infringer is guilty of conduct upon which increased damages may be based. *Id.* The first step is satisfied where the accused infringer has acted in bad faith, either by engaging in vexatious litigation or in willful infringement. *Id.*

Second, exercising its sound discretion, the court determines whether, and to what extent, to increase the damages award given the totality of the circumstances. *Id.* "The paramount determination in deciding to grant enhancement and the amount thereof is the egregiousness of the defendant's conduct based on all the facts and circumstances." *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 826 (Fed. Cir. 1992).

^{HN3} Although the determination of whether to enhance damages is made in light of the totality of the circumstances, the Federal Circuit has compiled a non-exhaustive list of factors to consider (the "Read factors"): (1) whether the infringer deliberately copied the ideas of another; (2) whether the infringer investigated the scope of the patent and formed a good faith belief that it was invalid or not infringed; (3) the infringer's behavior as a party to the litigation; (4) the defendant's [*6] size and financial condition; (5) the closeness of the case; (6) the duration of the defendant's misconduct; (7) remedial action by the defendant; and (8) the defendant's motivation for willfully infringing. *Id.*

B. Attorney Fees

Section 285 provides, ^{HN4} "[t]he court in exceptional cases may award reasonable attorney fees to the prevailing party." 35 U.S.C. § 285 (2000). ^{HN5} Determining whether a case is exceptional and, thus, eligible for an award of attorney fees under § 285 is a two-step process. *Cybor Corp. v. FAS Techs.*, 138 F.3d 1448, 1460 (Fed. Cir. 1998). "First, the district court must determine whether a case is exceptional, a factual determination reviewed for clear error. After determining that a case is exceptional, the district court must determine whether attorney fees are appropriate. . . ." *Id.* (internal citation omitted); *Delta-X Corp. v. Baker Hughes Production Tools, Inc.*, 984 F.2d 410, 413 (Fed. Cir. 1993). Most often, a case is deemed "exceptional" because of bad faith actions, such as vexatious litigation, or after a jury verdict of willful infringement. See *Jurgens*, 80 F.3d at 1570. [*7] The district court judge has discretion in determining whether or not to award fees, even where the jury has found willful infringement. *Modine Mfg. Co. v. Allen Group, Inc.*, 917 F.2d 538, 543 (Fed. Cir. 1990). However, "when a trial court denies attorney fees in spite of a finding of willful infringement, the court must explain why the case is not 'exceptional' within the meaning of the statute." *Id.*

III. THE PARTIES' POSITIONS

Plaintiff moves for the trebling of all compensatory damages, including any supplemental damages and interest, and a determination that this is an exceptional case entitling it to recover all reasonable attorneys' fees incurred in this litigation. Dkt. No. 734 at 28.

Plaintiff argues that, based on all the *Read* factors, enhancement of damages "to the full extent authorized by Section 284" is warranted. *Id.* at 26. According to Plaintiff, the "most important factor" in considering whether or not to enhance damages is a good faith belief of non-infringement, which it argues Defendants did not have. *Id.* at 2.

According to Plaintiff, the jury's willfulness finding indicates that the jury found clear and convincing evidence [*8] that the Defendants had no reasonable basis to believe that their DVRs did not infringe the '389 patent. *Id.* at 3.

Anticipating Defendants' response, Plaintiff argues the jury's willfulness verdict should not be disregarded even though the Merchant & Gould ("M&G") opinion letters ² were excluded from the jury trial. Plaintiff argues that the M&G letters were properly excluded because Defendants had not complied with their disclosure obligations. *Id.* at 4. Further, because Defendants did not rely on the M&G letters to defend against the willfulness charge, Plaintiff argues the exclusion of the letters could not have caused Defendants prejudice. *Id.* at 4-5. And, as the M&G letters came after four years of Defendants' infringement, Plaintiff argues the letters could not have formed the basis for a good faith belief of non-infringement. *Id.* at 5.

FOOTNOTES

² The Court has dealt with the admissibility of the M&G opinion letters at length on the

record and has addressed the Defendants' discovery obligations at length both on the record and in docketed orders. Without setting forth the issues again here, it is sufficient to say that the Court excluded this evidence from the jury trial as it awaited a ruling from the Federal Circuit. The Federal Circuit ruled on May 1, 2006, after the jury trial had concluded. *In re EchoStar Communs. Corp.*, 448 F.3d 1294 (Fed. Cir. 2006).

[*9] Plaintiff also argues that Defendants' conduct during this litigation weighs in favor of enhancing damages. Plaintiff charges Defendants with employing a litigation strategy of using their "superior size and wealth to overwhelm the far smaller" Plaintiff and which has led to wasting the resources of both Plaintiff and this Court. *Id.* at 6. According to Plaintiff, "numerous courts across the country have repeatedly sanctioned or chastised" Defendants for their litigation conduct "painting the unmistakable picture of a company without appropriate respect for the law." *Id.* at 6-7, citing cases.

Plaintiff claims Defendants have engaged in largely vexatious behavior: vexatious motion practice; vexatious discovery practice; and vexatious evidentiary objections. *Id.* at 8-13. Plaintiff also claims that Defendants' vexatious strategy led Defendants to purchase certain patents and to then file a "retaliatory lawsuit" before this Court. *Id.* at 13-14 citing *EchoStar Tech. Corp. v. TiVo, Inc., and Humax USA, Inc.*, Case No. 5:05-cv-00081-DF-CMC.

Plaintiff argues that Defendants, with a \$ 13.5 billion market cap, is able to pay treble damages and, moreover, that "treble damages **[*10]** are necessary to effectively punish" Defendants for their conduct and to deter them from future misconduct. *Id.* at 14-15.

Regarding the "closeness of the case," Plaintiff argues none of the issues were close. *Id.* at 15. Plaintiff cites the jury's unanimous verdict, rendered after less than three hours of deliberation, finding for Plaintiff on every substantive issue. *Id.* Plaintiff further cites to evidence and testimony that it argues demonstrate no issue was close. *Id.* at 16-21 addressing validity, infringement, willfulness, and damages.

Plaintiff argues that the duration of Defendants' misconduct began in May 2001 and is ongoing. *Id.* at 21. According to Plaintiff, Defendants have made no changes to the accused products despite the jury's infringement and willfulness findings but instead continue to infringe. *Id.* at 22. Plaintiff also indicates that Defendants are motivated by financial gain. *Id.* at 23-24. And, according to Plaintiff, some Defendants have attempted to conceal misconduct by certain Defendants. *Id.* at 24-25.

Because the jury determined that Defendants willfully infringe the '389 patent, Plaintiff argues the Court should find this to **[*11]** be an exceptional case and award Plaintiff attorneys' fees. *Id.* at 26. Plaintiff argues that the *Read* factors, as addressed above, should be considered in determining whether this is an exceptional case. *Id.* at 27. According to Plaintiff, "equity demands that [Defendants] bear the cost of the litigation it made necessary through it [sic] willful infringement, and which it greatly increased through its strategy of vexatious litigation." *Id.*

Defendants respond that Plaintiff's "paper-thin case for enhancement and attorneys' fees is premised on multiple legal errors. . . ." Dkt. No. 739 at 1. According to Defendants, a willfulness finding is not tantamount to a finding of bad faith and there is "nothing in the record to suggest that the jury found that EchoStar acted in bad faith." *Id.* at 4-5. Defendants argue that an evaluation of the totality of the circumstances, including the *Read* factors, demonstrates that damages should neither be enhanced nor attorneys' fees awarded.

Defendants argue that Plaintiff has a weak willfulness case. According to Defendants, the evidence demonstrates that it began independently developing its own DVR technology long

before [*12] the '389 patent issued. *Id.* at 5-7. Defendants cite evidence that, shortly after the '389 patent issued, it independently conducted an in-house investigation and engaged outside counsel to evaluate whether its products infringed the patent. *Id.* at 7-8. These investigations concluded that Defendants' products did not infringe. *Id.* at 8-13. Its actions, Defendants argue, demonstrate that Defendants did not act egregiously or recklessly; instead, Defendants argue that the facts are "strikingly similar" to a recent Federal Circuit case that held such actions were reasonable and did not warrant a willfulness finding. *Id.* at 13 citing *Union Carbide Chems. & Plastics Tech. Corp. v. Shell Oil Co.*, 425 F.3d 1366, 1380 (Fed. Cir. 2005). As additional evidence their actions were reasonable, Defendants cite the M&G opinion letters, which concluded Defendants did not infringe. *Id.* at 14-16.

Defendants then argue that the willfulness evidence in the record "falls far short of demonstrating" that Defendants acted in bad faith; instead, Defendants argue that Plaintiff's "evidence of bad faith is . . . non-existent." *Id.* at 16. According to Defendants, relying [*13] on the internal investigation performed by its engineers and in-house counsel was not reckless. *Id.* at 16-17. Defendants argue their reliance on the investigation was reasonable, despite its shortcomings (Defendants' in-house counsel rendered the opinion orally and did not address infringement under the doctrine of equivalents among other points). *Id.* at 16-19. Defendants further argue that Plaintiff's willfulness expert's analysis was legally and factually wrong. *Id.* at 19-22.

Defendants urge the Court to consider the M&G opinions in reaching its conclusion on enhancement. *Id.* at 22.

Regarding the remaining "Read" factors, Defendants argue that none of the factors supports the motion for enhanced damages. *Id.* at 23. Defendants argue their behavior throughout this litigation has been proper and not vexatious. *Id.* at 23-26. Specifically Defendants respond to Plaintiff's allegation that it has been involved in a pattern of misconduct before numerous courts -- each of the cases Plaintiff cites, however, involved "different issues, different causes of action, different counsel, and different courts." *Id.* at 23. Defendants also compile a list of Plaintiff's [*14] "misconduct" during the litigation. *Id.* 23-26. According to Defendants, their size and financial condition do not warrant enhancement because the proper focus is the infringer's conduct. *Id.* at 26. Defendants also argue that substantive issues were close, that no remedial action was necessary, that it was not motivated to harm Plaintiff, and that they did not hide their conduct. *Id.* at 26-29.

IV. DISCUSSION

No enhancement of damages is warranted.

As prior orders will attest, this Court has examined at length the evidence of willfulness and has addressed aspects of the Defendants' duty to disclose certain willfulness evidence. Shortly before the October 2005 trial setting, the original trial setting, Defendants filed a writ of mandamus with the Federal Circuit after this Court issued an order requiring certain discovery from Defendants' opinion counsel. Dkt. No. 380. Due to the Court's efforts to accommodate the parties' request for a three week trial, this action could not be reached in October 2005 due to the trial docket. Dkt. No. 397. The trial setting was continued to March 2006. At the time of the March 2006 setting, the appellate court had not ruled on the [*15] writ. Instead of indefinitely delaying this action, however, trial was held.

Prior to commencing trial neither party moved for a continuance on the basis that the appellate court had not yet ruled. On the fifth day of trial, however, Defendants made an oral motion to continue on this basis. Dkt. No. 692 at 7-8. The motion was denied. *Id.* However, because willfulness related discovery could not be completed absent a ruling on the writ, certain evidence was excluded from the trial. Per the Court's rulings, Defendants were not allowed to introduce evidence that they sought and received two outside opinions of counsel,

the M&G opinion letters. Nor were Defendants allowed to proffer witness testimony regarding the M&G opinion letters.

Defendants' M&G opinion letters were evidence that could have gone to demonstrate Defendants' state of mind at least to post-filing infringement. They illustrate a detailed, thorough analysis on which a fact finder might have determined Defendants reasonably relied. These opinions, combined with the evidence of Defendants' other actions, could demonstrate a lack of willfulness on Defendants' part. Defendants introduced testimony and evidence that they [*16] independently learned of the '389 patent shortly after it issued, that they convened more than one meeting between engineers and in-house counsel to analyze and compare the patent to its own devices, that in-house counsel formed an opinion of no infringement, that outside counsel was engaged and that it was Defendants' understanding that outside counsel reached the conclusion Defendants did not infringe. These actions were taken before litigation was initiated and without any indication from Plaintiff that a lawsuit would be filed. Once Plaintiff filed this action, Defendants then engaged different outside counsel and received detailed opinions finding no liability.

That the pre-suit opinions were not reduced to writing, and done largely by in-house counsel and employees, weighs against Defendants' reasonable reliance. However, the totality of the circumstances, including the *Read* factors, must be taken into account when determining whether to enhance damages. As Plaintiff admits, this is not a copying case. 6/28/06 Hr. Tr. at 9:7-8; see also Dkt. No. 739 at 7. Defendants worked to develop their own DVR device for a number of years even before Plaintiff's company had been [*17] formed. *Id.* at 6. Defendants took several steps, both before and after this lawsuit was filed, to investigate the scope of the '389 patent and form a belief as to their liability. Although the jury rendered its unanimous decision after only a few hours of deliberation, this was a hard fought case. Both parties proffered volumes of evidence and lengthy witness testimony and a plaintiff's verdict was not assured. The evidence does not show Defendants acted in bad faith, nor does the jury's willfulness finding amount to a finding of bad faith.

HN6 It is not this Court's role to reweigh the evidence of infringement; the jury verdict stands. *Jurgens*, 80 F.3d at 1572. However, the Court must consider the willfulness evidence not before the jury when it made its determination. See e.g. *Delta-X*, 984 F.2d at 414. The excluded evidence, when considered along with the trial evidence, demonstrates that Defendants' actions were not in "wanton disregard" of Plaintiff's patent rights. *Johns Hopkins Univ. v. Cellpro*, 978 F. Supp. 184, 192 (D. Del. 1997). Thus, it would be inappropriate here to enhance damages based upon the jury's willfulness finding. [*18] *Id.*

Plaintiff also bases its enhanced damages request largely upon a consideration of the third *Read* factor, the infringer's behavior as a party to the litigation. Plaintiff accuses Defendants of engaging in vexatious conduct during litigation, citing not only a list of motions, objections, and discovery practices that it terms vexatious but also a collection of cases in which Defendants have been sanctioned or found to have acted in bad faith. Defendants respond with their own list of unsavory litigation tactics employed by Plaintiff, including "baseless" motions, instances of Plaintiff's counsel being remanded, Plaintiff's failed discovery motions, and so forth. Defendants also point out that Plaintiff's collection of other cases in which some or all current Defendants were parties each involve different counsel than in the present litigation.

As the Court has said a number of times on the record, nothing in this case has gone smoothly. A record number of motions have been filed -- numerous discovery motions, motions in limine, dispositive motions, motions to exclude testimony, motions appealing rulings of the magistrates, etc. Despite the magistrate judge's many orders [*19] ruling on the excessive number of evidentiary objections lodged by the parties, Defendants filed objections to the vast majority of those rulings without an appropriate basis. Dkt. Nos. 451,457, 468, 503, and 509. There is no question that both parties have contributed to the

nearly 150 motions filed before this Court in this action to date.

Having presided over this case, it is apparent that the volume of motion practice is but one indication of the difficult, time-consuming, protracted style of litigation in which these parties have engaged, sapping the resources of both parties and of the Court. The actions Plaintiff complains amount to vexatious litigation by Defendants are defended as responsible advocacy; the Court would expect a similar response to Defendants' list of Plaintiff's "vexatious" tactics. Where the parties cannot agree on which way is up and which way is down, nor if it is day or night outside, it is impossible for the Court to say which party is responsible for the vexatious nature of this litigation. Unfortunately there have been times when counsel from each party failed to observe the local rules pertaining to the expected standards of conduct in this district. [*20] See Local Rule AT-3 and Dkt. No. 555. Thus, even if the Court were to infer a vexatious litigation strategy, no enhancement of damages is warranted.

Plaintiff's request that this case be designated an "exceptional" will also be denied. The request was made based on essentially the same factors as cited in support of its enhanced damages request. As discussed above, the jury's willfulness finding was reached without the evidence of Defendants' post-filing retention of opinion counsel. Considering the totality of the circumstances, Defendants' actions were not egregious and reckless and therefore an exceptional case designation is not warranted on this basis. Further, as discussed above, Defendants' behavior during this litigation does not here warrant an exceptional case designation.

V. CONCLUSION

For all the above reasons, Plaintiff's Motion for Treble Damages and for a Determination that this is an "Exceptional Case" Entitling TiVo to Recover Attorneys' Fees, Dkt. No. 734, is hereby **DENIED**.

SIGNED this 17th day of August, 2006.

DAVID FOLSOM

UNITED STATES DISTRICT JUDGE

FINAL JUDGMENT AND PERMANENT INJUNCTION

Pursuant to Rule 58 of the Federal Rules of Civil Procedure [*21] and in accordance with the jury verdict delivered on April 13, 2006 and with the Court's contemporaneously filed orders, the Court thereby enters judgment for Plaintiff against Defendants for infringement of U.S. Patent No. 6,233,389 ("389 patent"), claims 1, 5, 21, 23, 32, 36, 52, 31 and 61 ("the Infringed Claims") by Defendants' following DVR receivers (collectively the "Infringing Products"): DP-501; DP-508; DP-510; DP-522; DP-625; DP-721; DP-921; and the DP-942.

IT IS THEREFORE ORDERED THAT Plaintiff shall have and recover from Defendants, jointly and severally, the total sum of \$ 73,991,964.00, together with prejudgment interest at the rate of prime, said prejudgment interest in the total sum of \$ 5,367,544.00 ¹, together with supplemental damages in the amount of \$ 10,317,108.00, together with post-judgment interest on the entire sum calculated pursuant to 28 U.S.C. § 1961. The amounts awarded in this judgment shall bear interest from the date of judgment at the lawful federal rate.

FOOTNOTES

¹ The prejudgment interest and supplemental damages award herein do not cover the

time period from August 1, 2006 to the date of entry of this Order. Consistent with the contemporaneously filed order addressing prejudgment interest and supplemental damages, the Court will award additional prejudgment interest and supplemental damages after receipt of additional information from Plaintiff's damages expert.

[*22] 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.

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 [*23] from a hard disk drive of television data) shall not be enabled in any new placements of the Infringing Products.

Defendants shall forthwith provide written notice of this judgment, and the injunction ordered herein, to: their officers, directors, agents, servants, representatives, attorneys, employees, subsidiaries and affiliates, and those persons in active concert or participation with them, including any and all manufacturers, distributors, retailers, and service providers who have been involved in the making, using, selling, offering for sale or importing of any Infringing Products; and to all other persons or entities involved in any way with the making, using, selling, offering for sale or importing of any Infringing Products. Defendants shall take whatever means are necessary or appropriate to ensure that this order is properly complied with.

This injunction shall run until the expiration of the '389 patent.

This Court retains jurisdiction over Defendants to enforce any and all aspects of this Judgment and Permanent Injunction.

The Court further retains jurisdiction to award Plaintiff amounts for supplemental damages, interest, costs, attorneys fees and such other or further [*24] relief as may be just and proper.

All relief not specifically granted herein is denied. All pending motions not previously ruled on are denied. This is a Final Judgment and is appealable.







SIGNED this 17th day of August, 2006.

DAVID FOLSOM

UNITED STATES DISTRICT JUDGE

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TIVO INC., Plaintiff, v. ECHOSTAR COMMUNICATIONS CORP., et al. Defendants.

2:04-CV-1-DFUNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF TEXAS, MARSHALL
DIVISION

446 F. Supp. 2d 664; 2006 U.S. Dist. LEXIS 64290

August 17, 2006, Decided

August 17, 2006, Filed

PRIOR HISTORY: [TiVo Inc. v. EchoStar Communs. Corp., 2006 U.S. Dist. LEXIS 64293](#)
(E.D. Tex., Aug. 17, 2006)**CASE SUMMARY**

PROCEDURAL POSTURE: Plaintiff corporation filed a patent infringement suit against defendant competitor. A jury found in that the competitor's digital video recorders (DVRs) infringed on the corporation's patents for its own DVRs and awarded the corporation more than \$ 73,000,000 in compensatory damages. The corporation moved for entry of a permanent injunction, and the competitor cross-moved to stay any injunction pending appeal.


OVERVIEW: The corporation alleged that the competitor's infringement caused the corporation to lose a critical market share and that such injury was irreparable because customers who bought DVRs tended to be "sticky customers" in that they tended to stay with the DVR service provider from whom they first purchased service. In granting the corporation's request for an injunction, the court agreed that the harm suffered by the corporation would be irreparable, particularly since the DVR market was in its formative years. The balance of hardships also favored granting the injunction because the corporation faced irreparable injury if the infringement continued, but the competitor had less to lose because it was primarily engaged in the satellite transmission business. Further, the public interest would not be disserved by the issuance of an injunction, as the public had an interest in maintaining a strong patent system by enforcing adequate remedies for infringement. The court also held that a stay of the injunction was not warranted because the competitor had not demonstrated a strong likelihood of success on appeal.


OUTCOME: The court granted the corporation's motion for entry of a permanent injunction and denied the competitor's cross-motion to stay the injunction pending appeal. The competitor was enjoined from making, using, selling, or importing its infringing DVRs and would have to disable the infringing features on DVRs that had already been placed with customers.


CORE TERMS: injunction, infringement, customer, infringing, public interest, irreparable harm, placements, patent, weigh, equitable, market share, enjoining, compete, irreparable injury, balance of hardships, injunctive relief, hardship, pending appeal, severe, monetary damages, irreparably, infringed, infringe, monetary, adequate remedy, subscribers, satellite, ongoing, lawsuit, patent cases


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HN1  The United States Supreme Court has revisited the propriety of issuing permanent injunctions as a matter of course after a finding of infringement in patent cases. The Supreme Court determined that equitable relief is not mandatory in patent cases, but instead should be decided in accordance with traditional equitable considerations. To this end, a plaintiff seeking a permanent injunction must satisfy a four-factor test before a court may grant such relief: A plaintiff must demonstrate: (1) that it has suffered an irreparable injury; (2) that remedies available at law, such as monetary damages, are inadequate to compensate for that injury; (3) that, considering the balance of hardships between the plaintiff and defendant, a remedy in equity is warranted; and (4) that the public interest would not be disserved by a permanent injunction. Further, the decision whether to grant or deny injunctive relief rests within the equitable discretion of the district courts, and such discretion must be exercised consistent with traditional principles of equity, in patent disputes no less than in other cases governed by such standards. It is clear that the Supreme Court by its decision did not intend to part with long-standing decisions in equity. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)

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HN2  Once a plaintiff has met its burden in showing that an injunction is necessary, no delay in the issuance of that injunction is appropriate absent extraordinary circumstances. In determining whether a stay is appropriate, courts consider four factors: (1) whether the stay applicant has made a strong showing that he is likely to succeed on the merits; (2) whether the applicant will be irreparably injured absent a stay; (3) whether issuance of the stay will substantially injure the other parties interested in the proceeding; and (4) where the public interest lies. Each factor is not necessarily entitled to equal weight; a stay is discretionary with the court. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)

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HN3  The public has an interest in maintaining a strong patent system. This interest is served by enforcing an adequate remedy for patent infringement. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)

COUNSEL: **[**1]** Robert W Faulkner, Mediator, Pro se, Dallas, TX.

For TIVO Inc, a Delaware corporation, Plaintiff: Alexander C D Giza ↘, Adam S Hoffman ↘, Perry M Goldberg ↘, Richard E Lyon ↘, Irell & Manella LLP, Los Angeles, CA; Andrei Iancu ↘, Christine W S Byrd ↘, Irell & Manella - Los Angeles, Los Angeles, CA; Morgan Chu ↘, Irell & Manella, Los Angeles, CA; Samuel Franklin Baxter ↘, Attorney at Law, Marshall, TX; Ben Yorks ↘, Brian Jones, Michelle Armond ↘, Irell & Manella - Newport Beach, Newport Beach, CA; R Scott Feldmann ↘, Randall I Erickson ↘, Steven P Rice ↘, Van V Nguyen ↘, Crowell & Moring - Irvine, Irvine, CA; Garret Wesley Chambers ↘, McKool Smith - Dallas, Dallas, TX.

For Echostar Communications Corporation, a Nevada corporation, Echostar DBS Corporation, a Colorado corporation, EchoStar Technologies Corporation, Echosphere Limited Liability Company, Defendants: Alison M Tucher ↘, Jason A Crotty ↘, Robert M Harkins, Jr ↘, Morrison & Foerster LLP San Francisco, San Francisco, CA; Rachel Krevans ↘, Harold J. McElhinny ↘, Morrison & Foerster LLP, San Francisco, CA; Karl J Kramer ↘, Morrison & Foerster - Palo Alto, Palo Alto, CA; Damon Michael Young ↘, Young Pickett & Lee, Texarkana, TX.

For "EchoStar defendants", **[**2]** Defendant: Emily A Evans ↘, Morrison & Foerster - Palo Alto, Palo Alto, CA; Scott F Llewellyn ↘, Morrison & Foerster, Denver, CO; Kristina Paszek ↘, Alison M Tucher ↘, Robert M Harkins, Jr ↘, Morrison & Foerster LLP San Francisco, San Francisco, CA; Harold J. McElhinny ↘, Rachel Krevans ↘, Morrison & Foerster LLP, San Francisco, CA; John Michael Pickett ↘, Young Pickett & Lee, Texarkana, TX; Karl J Kramer ↘, Morrison & Foerster - Palo Alto, Palo Alto, CA.

For Merchant & Gould, Subpoena recipient, Movant: Charles Conrow Murphy, Jr ↘, Vaughan & Murphy, Atlanta, Ga.

For EchoStar Technologies Corporation, Echosphere Limited Liability Company, Counter Claimants: Alison M Tucher ↘, Jason A Crotty ↘, Robert M Harkins, Jr ↘, Morrison & Foerster LLP San Francisco, San Francisco, CA; Karl J Kramer ↘, Morrison & Foerster - Palo Alto, Palo Alto, CA; Damon Michael Young ↘, Young Pickett & Lee, Texarkana, TX.

For TIVO Inc, a Delaware corporation, Counter Defendant: Adam S Hoffman ↘, Irell & Manella LLP, Los Angeles, CA.

For EchoStar Communications Corporation, a Nevada corporation, EchoStar DBS Corporation a Colorado corporation, Counter Claimants: Alison M Tucher ↘, Jason A Crotty ↘, Robert M Harkins, Jr ↘, Morrison **[**3]** & Foerster LLP San Francisco, San Francisco, CA; Karl J Kramer ↘, Morrison & Foerster - Palo Alto, Palo Alto, CA.

For Echostar Satellite LLC, Counter Claimant: Karl J Kramer ↘, Morrison & Foerster - Palo Alto, Palo Alto, CA.

JUDGES: DAVID FOLSOM, UNITED STATES DISTRICT JUDGE.

OPINION BY: DAVID FOLSOM

OPINION

ORDER

Before the Court is Plaintiff TiVo's Motion for Entry of Judgment and Permanent Injunction. Dkt. No. 733. Also before the Court is Defendants' (1) Opposition to TiVo's Motion for Entry of Judgment and Permanent Injunction and (2) Cross-Motion to Stay Any Injunction Pending

Appeal, TiVo's (1) Reply Re: Motion for Entry of Judgment and Permanent Injunction and (2) Opposition to EchoStar's Cross-Motion to Stay Injunction, and Defendants' Reply in Support of Cross-Motion to Stay Any Injunction Pending Appeal. Dkt. Nos. 737, 747, 754, respectively. On June 28, 2006 the Court heard the parties on these motions. Having considered the motions, all other relevant briefing, and the applicable law, the Court finds that Plaintiff's Motion for Injunction should be **GRANTED** and Defendants' Motion to Stay Any Injunction Pending Appeal should be **DENIED**.

I. BACKGROUND

In this **[**4]** patent infringement action, Plaintiff claimed a number of Defendants' digital video recorders ¹ ("DVRs") infringe several claims in Plaintiff's U.S. Patent No. **6,233,389** (the "**389 patent**"). In March 2006-April 2006, the case was tried to a jury. The jury found that Defendants' accused DVRs infringed each of the asserted claims and further found that Defendants' infringement was willful. None of the asserted claims was found invalid. The jury awarded Plaintiff \$ 73,991,964 million in compensatory damages.

FOOTNOTES

¹ The following of Defendants' DVR receivers were found to infringe: DP-501; DP-508; DP-510; DP-522; DP-625; DP-721; DP-921; and the DP-942.

Plaintiff now moves for entry of a permanent injunction. Defendants oppose any injunction and, alternatively, move to stay any injunction.

II. LEGAL PRINCIPLES

Recently ^{HN17} the Supreme Court revisited the propriety of issuing permanent injunctions as a matter of course after a finding of infringement in patent cases. *eBay Inc. v. MercExchange, L.L.C.*, 126 S. Ct. 1837, 1839-1841, 164 L. Ed. 2d 641 (U.S. 2006) **[**5]** (hereinafter "*eBay*"). Observing the existence of a "'general rule,' unique to patent disputes" that mandated the issuance of a permanent injunction once infringement and validity were decided, the Supreme Court explored the origins of this general rule and compared it to other instances in **[*666]** which courts are faced with deciding whether or not to issue equitable relief. *Id.* The Supreme Court determined that equitable relief is not mandatory in patent cases, but instead should be decided in accordance with traditional equitable considerations. *Id.*

To this end, a plaintiff seeking a permanent injunction must satisfy a four-factor test before a court may grant such relief:

A plaintiff must demonstrate: (1) that it has suffered an irreparable injury; (2) that remedies available at law, such as monetary damages, are inadequate to compensate for that injury; (3) that, considering the balance of hardships between the plaintiff and defendant, a remedy in equity is warranted; and (4) that the public interest would not be disserved by a permanent injunction.

Id. Further, the Supreme Court held that:

[T]he decision whether to grant or deny injunctive relief **[**6]** rests within the equitable discretion of the district courts, and that such discretion must be exercised consistent with traditional principles of equity, in patent disputes no less than in other cases governed by such standards.

Id. It is clear that the Supreme Court by its decision did not intend to part with long-standing decisions in equity. As noted by Chief Justice Roberts, "there is a difference between exercising equitable discretion pursuant to the established four-factor test and writing on an entirely clean slate." *Id.* at 1841 (Roberts, C.J. concurring). And, as Justice Kennedy notes in his concurrence, "the existence of a right to exclude does not dictate the remedy for a violation of that right," which aligns equitable decisions in patent cases with other cases. *Id.* at 1842 (Kennedy, J. concurring).

^{HN2} "Once a plaintiff has met its burden in showing that an injunction is necessary, no delay in the issuance of that injunction is appropriate absent extraordinary circumstances." *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 106 F. Supp. 2d 696, 708 (D.N.J. 2000) (internal quotation and citation omitted). **[**7]** In determining whether a stay is appropriate, courts consider four factors: "(1) whether the stay applicant has made a strong showing that he is likely to succeed on the merits; (2) whether the applicant will be irreparably injured absent a stay; (3) whether issuance of the stay will substantially injure the other parties interested in the proceeding; and (4) where the public interest lies." *Standard Havens Prods. v. Gencor Indus., Inc.*, 897 F.2d 511, 512 (Fed. Cir. 1990). Each factor is not necessarily entitled to equal weight; a stay is discretionary with the Court.

III. THE PARTIES' POSITIONS

Plaintiff argues that each of the four equitable factors "overwhelmingly weigh[s] in favor of enjoining EchoStar's continuing infringement." Dkt. No. 733 at 7.

Regarding the first and second factors, Plaintiff argues that because it is in direct competition with Defendants, their infringement has "direct, severe consequences" on its ability to compete. *Id.* According to TiVo, Defendants specifically target potential TiVo customers and Defendants' competition leads to Plaintiff's loss of critical market share. *Id.* TiVo argues that loss of customers and loss **[**8]** of market share are irreparable injuries that cannot be recouped through monetary awards. *Id.* at 8. Without an immediate injunction, Plaintiff argues, "new DVR customers on the EchoStar platform will likely adopt EchoStar's competing devices instead of TiVo's." According to TiVo, **[*667]** "[t]hese customers are lost, probably for good." *Id.* at 8. TiVo cites evidence that customers tend to stay with their current DVR service providers, i.e. that they are "sticky customers." *Id.*

Plaintiff also argues that, because the DVR market is in its "formative years and is currently growing at exponential rates," Plaintiff risks being marginalized due to Defendants' infringement by the time the market matures. *Id.* at 9. Such marginalization, Plaintiff argues, has been expressly recognized as a type of irreparable harm. *Id.*

Plaintiff further argues that it suffers irreparable harm from price erosion resulting from Defendants' offering the infringing products and service at "less than full value." *Id.* at 9-10. Plaintiff also argued Defendants' infringement has resulted in "value erosion" as potential business partners are reluctant to enter into agreements for the technology Defendants **[**9]** utilize for free. *Id.* at 10. Lastly, Plaintiff argues that Defendants' infringement causes irreparable harm insofar as it encumbers Plaintiff's ability to invest in its business and in additional research and development. *Id.* at 10.

Only an injunction, Plaintiff argues, can remedy the irreparable harm caused by Defendants' infringement. Without an injunction, Plaintiff argues it will lose market share, which is particularly important during the formative years of a market. *Id.* at 11. Such harms, Plaintiff argues, cannot be remedied with monetary damages. Plaintiff also argues that, absent an injunction, ongoing harm to its brand, reputation and good will cannot be remedied. *Id.* And, in the absence of an injunction, Plaintiff argues it will be unfairly forced into a compulsory license. Dkt. No. 747 at 6.

Addressing the third factor, Plaintiff argues that the balance of hardships weighs heavily in favor of enjoining Defendants' infringement. *Id.* at 12. Plaintiff argues that, because of its size and its dependence on its DVR technology, it will become extinct if it cannot exploit its technology in the market. *Id.* By contrast, Plaintiff argues that the EchoStar **[**10]** corporation is a multi-billion-dollar corporation whose primary business is providing satellite television signals. *Id.* Enjoining EchoStar's infringing DVRs will not affect its satellite transmissions, Plaintiff argues. *Id.* Thus, according to Plaintiff's, "an injunction causes EchoStar no hardship that is properly considered in this balancing." *Id.* Plaintiff further argues that, because Defendants' infringement is willful, it cannot complain of hardship. *Id.*

Regarding the public interest, Plaintiff argues that no interest would be served by allowing Defendants' infringement to continue. *Id.* at 13. To the contrary, Plaintiff argues that the public's interest in patent rights and the patent system would be served by enjoining Defendants' infringement. *Id.*

Plaintiff argues, anticipating Defendants will request a stay of any injunction, that the four factors for determining whether a stay is appropriate each weigh against a stay in this case. *Id.* at 16.

Lastly, Plaintiff addresses the specifics of the injunction they seek. Plaintiff requests that Defendants be immediately enjoined from "making, using, selling, offering for sale, and/or importing into the **[**11]** United States all of its infringing DVR products . . ." including not only the accused products but also products that are not more than colorably different. 6/28/06 Hr. Tr. at 146:11-18; Dkt. No. 733 at 19 (internal citation omitted). The injunction must extend, Plaintiff argues, to "new placements" (newly sold DVRs) as well as "existing placements" (DVRs already **[*668]** placed with customers). Dkt. No. 733 at 20-21.

In response, Defendants argue Plaintiff faces no irreparable harm absent a permanent injunction. Dkt. No. 737 at 7. According to Defendants, Plaintiff's delay in bringing this lawsuit weighs against an injunction. *Id.* at 8. Defendants also charge that Plaintiff's motive in this lawsuit was only to "give TiVo additional leverage to force EchoStar and TiVo's other prospective business partners to make more favorable deals with TiVo." *Id.* Thus, Defendants argue, it is not reasonable to conclude Plaintiff will be irreparably harmed if Defendants are "allowed to continue providing DVRs to [their] own subscribers." *Id.* at 8.

Defendants cite Plaintiff's "failure to seek a preliminary injunction" as further evidence Plaintiff faces no irreparable harm. *Id.* Defendants **[**12]** then argue that Plaintiff stands to reap more money for its infringement than Plaintiff would make if Defendants were enjoined because, according to Defendants, Plaintiff could not have provided enough DVRs to its customers to accrue the "windfall" awarded by the jury. *Id.* at 8-9.

Defendants also argue that because the DVR market is not a two-player market, Plaintiff's arguments rest on a fallacy. *Id.* at 9. Defendants also cast Plaintiff's price erosion concerns as "mak[ing] little sense." *Id.* And, Defendants argue, Plaintiff's evidence of commercial success while the infringing products have been on the market demonstrate that Plaintiff will not suffer irreparable harm. *Id.* at 10.

According to Defendants, monetary damages will fully compensate Plaintiff for all of the existing placements of infringing DVRs. *Id.* at 10. Defendants argue that Plaintiff's counsel at trial represented that injunctive relief would only apply to new DVR placements. *Id.* at 11 citing trial transcript. This, according to Defendants, amounted to an admission that monetary relief is an adequate remedy for existing placements. *Id.* Defendants then argue that the same rate of compensation **[**13]** for the existing placements must also be adequate for any future placements. *Id.* And, based on Plaintiff's counsel's representation, Defendants argue that Plaintiff cannot now seek an injunction on existing placements. *Id.*

Defendants argue that the public interest would not be served by an injunction. *Id.* at 12. According to Defendants, the injunction Plaintiff proposes "would immediately remove DVRs from three million families who are innocent of any wrongdoing . . . [depriving] those families of DVRs and force[ing] them to incur significant disruption and expense in order to replace them." *Id.* at 12. Defendants argue this is contrary to the public interest. *Id.* Denying an injunction, however, does "not harm the public interest in maintaining the integrity of the patent system" and, according to Defendants, will still leave Plaintiff in a better position than if Defendants had not infringed or if Defendants engaged in a business relationship with Plaintiff. *Id.* at 12-13.

Lastly, Defendants argue that the balance of hardships weighs against an injunction. *Id.* at 13. According to Defendants, Plaintiff faces no hardship if an injunction does not issue **[**14]** because monetary relief provides an adequate remedy at law. *Id.* However, Defendants argue, an injunction will cause them "severe and irremediable" harm. *Id.*

Defendants argue that enjoining their DVR sales will impact its ability to compete in the market for subscribers, leading to a "high risk of losing a significant percentage of existing subscribers, and . . . significantly impair[ing] [their] attracting **[*669]** new subscribers." *Id.* at 14. Defendant argues that small authorized distributors will also be severely impacted. *Id.*

Regarding the form of an injunction, Defendants argue only new placements should be enjoined because, at trial, Plaintiff's counsel represented that Plaintiff would seek only to enjoin new placements. *Id.* at 15-16. Now, Defendant argues, Plaintiff is bound to this limitation on injunctive relief. *Id.* Defendants also argue that because their DVRs have substantial non-infringing uses, Plaintiff's requested injunction is "improperly broad." *Id.* at 16. And, Defendants argue, the injunction should not extend to DVRs already distributed but not placed because they cannot infringe until the infringing software is downloaded. *Id.* at 17. **[**15]** Lastly, Defendants argue the injunction should extend only to the specific devices for which the jury found infringement. *Id.* at 17.

Should an injunction issue, Defendants argue a stay is warranted. Defendants argue that it is likely to prevail on its appeal of the infringement verdict. *Id.* at 19. Defendants list a number of claim construction and evidentiary rulings that they plan to appeal. *Id.* at 19-29. Largely reciting the same factors set forth in the discussion of the balance of hardships, Defendants argue they will be irreparably harmed absent a stay but that Plaintiff does not face such harm in the event of a stay. *Id.* at 29-31. Again, reciting many of the arguments set forth above, Defendant argue that the public interest warrants a stay. *Id.* at 32-33.

In reply, Plaintiff defends the form of injunction it requests. Plaintiff points out that Defendant does not dispute that it can turn off the DVR functionality of the already placed infringing DVRs. Dkt. No. 747 at 10. Plaintiff argues that its counsel did not represent that the injunctive relief Plaintiff would seek was as limited as Defendants argue; instead, Plaintiff's counsel represented only that **[**16]** no injunction would be pursued on the infringing units for which lost profit damages are received. *Id.* at 12.

Plaintiff also argues that a stay is not warranted because of the severe irreparable harm it faces in the interim. *Id.* at 12-13, 22-24. Further, because the jury found that Defendants willfully infringe, their alleged injury absent a stay is the result of their own deliberate doing. *Id.* at 13. Plaintiff addresses Defendants' list of appellate points and disputes that there is any reason to conclude that Defendant has a likelihood of success on any of its points. *Id.* at 13-22. Thus, Plaintiff argues, the present is not an exceptional case wherein a stay of injunctive relief is warranted.

In surreply, Defendants argue that the public interest in maintaining the status quo pending appeal favors entry of a stay. Dkt. No. 754 at 5-6.

IV. DISCUSSION

A. Permanent Injunction

Following the traditional four-factor test for equitable relief, the Court concludes that a permanent injunction is warranted.

Plaintiff has demonstrated both that it continues to suffer irreparable harm in the absence of an injunction and that there is no adequate remedy at law. **[**17]** Defendants compete directly with Plaintiff-Defendants market their infringing products to potential DVR customers as an alternative to purchasing Plaintiff's DVRs. The availability of the infringing products leads to loss of market share for Plaintiff's products. Loss of market share in this nascent market is a key consideration in finding that Plaintiff suffers irreparable harm -- Plaintiff is losing market share at a critical time in the market's development, market **[*670]** share that it will not have the same opportunity to capture once the market matures.

One thing the parties agree on is that DVR customers are "sticky customers," that is they tend to remain customers of the company from which they obtain their first DVR. Dkt. No. 737 at 30 (EchoStar); Dkt. No. 747 at 1 (Tivo). Thus, the impact of Defendants' continued infringement is shaping the market to Plaintiff's disadvantage and results in long-term customer loss. This is particularly key where, as is the case here, Plaintiff's primary focus is on growing a customer base specifically around the product with which Defendants' infringing product competes. And, as Plaintiff is a relatively new company with only one primary product, **[**18]** loss of market share and of customer base as a result of infringement cause severe injury. Thus, the Court concludes that the full impact of Defendants' infringement cannot be remedied by monetary damages.

Plaintiff's "delay" in bringing this lawsuit, which Defendants argue demonstrates there is no irreparable injury, was due to Plaintiff's attempts to enter into a business arrangement with Defendants. See Dkt. No. , Findings of Fact and Conclusions of Law. It does not demonstrate that there is no irreparable harm. Plaintiff's motives in bringing the lawsuit are irrelevant -- the jury found Plaintiff's patent valid and infringed by Defendants' DVRs. The Court also finds the statement by Plaintiff's counsel cited by Defendants does not amount to an admission that monetary relief is adequate.

The balance of hardships weighs in favor of granting a permanent injunction. As discussed, Plaintiff faces ongoing irreparable injury as Defendants' infringement continues. As a relatively new and small company, every day of Defendants' infringement affects Plaintiff's business. And, as discussed above, Plaintiff's primary product, its DVRs, are those with which Defendants' infringing **[**19]** products directly compete. The harm caused by such infringement weighs heavily in favor of an injunction.

Enjoining Defendants will likely cause some harm -- but on balance, Defendants will endure less harm than Plaintiff. The infringing products do not form the core of Defendants' satellite transmission business. And the injunction will not interfere with Defendants' satellite transmission.

The hardship of disabling DVR capabilities to Defendants' DVR customers is a consequence of Defendants' infringement and does not weigh against an injunction. Defendants do not dispute that, with software updates transmitted directly to the infringing products, the DVR capabilities of the infringing products can be disabled. This process, though cumbersome, is not on balance a weighty hardship for Defendants. Similarly, any impact of the injunction on Defendant's authorized distributors is also a consequence of Defendants' infringement and does not weigh against an injunction. Again, distributors' sales of Defendants' core products will not be affected by the injunction.

Lastly, the public interest would not be disserved by a permanent injunction. ^{HN3} The public has an interest in maintaining a **[**20]** strong patent system. This interest is served by enforcing an adequate remedy for patent infringement -- in this case, a permanent injunction. The infringing products are not related to any issue of public health or any other equally key interest; they are used for entertainment. The public does not have a greater interest in allowing Defendants' customers' to continue to use their infringing DVRs.

B. Stay of a Permanent Injunction

A stay of the permanent injunction is not warranted.

[*671] Defendants' identification of issues and rulings it plans to appeal is lengthy. Upon review, it seems that the Court has previously considered each at length. Although Defendants may prevail on some of the issues, they have not demonstrated a strong likelihood of success on appeal that would overturn the jury's verdict on all infringed claims.

Defendants raise appellate points regarding the Court's claim construction, but identify only one term, "decoder," common to both the hardware and software claims. Defendants' argue the proper construction of the term would "mandate a finding of non-infringement." Dkt. No. 737 at 26; Dkt. No. 754 at 14. In the half-page Defendants devote to this term in **[**21]** their brief, Defendants do not detail their argument for overturning the construction of this term. Dkt. No. 737 at 25-26.

As far as the exclusion of certain evidence, Defendants do not demonstrate that reversals of either of the rulings they identify for appeal will lead to overturning the infringement verdict on each of the asserted claims. In particular, the exclusion of the Merchant & Gould opinion letters is primarily related to the jury's willfulness determination, and overturning this ruling may amount to a retrial on this issue alone.

Although the injunction will likely result in some degree of customer loss and will impact Defendants' ability to compete in the market, Defendants will not be irreparably harmed. Again, Defendants' core business is not the supply of DVRs. Defendants have not demonstrated that an injunction on the infringing products would have a severe financial impact on their core business or will lead to loss of employees. Defendants' authorized retailers will still be able to sell and service Defendants' non-infringing products. Conversely, absent a stay, Plaintiff faces ongoing irreparable injury as detailed above.

Lastly, Defendants' argument that the **[**22]** public interest in maintaining the status quo - allowing Defendants' current DVR customers and its retailers to continue business as usual -- is served by granting a stay. Without a stronger showing that the jury's verdict will be overturned in its entirety on appeal, however, allowing the ongoing infringement is not within the public's interest.

C. Form of the Injunction

The Court will issue an injunction explicitly subject to 28 U.S.C. § 1498 contemporaneously with this order and its final judgment.

V. CONCLUSION

For all the above reasons, Plaintiff TiVo's Motion for Entry of Judgment and Permanent Injunction, Dkt. No. 733, is hereby **GRANTED** and Defendants' Cross-Motion to Stay Any Injunction Pending Appeal, Dkt. No. 737, is hereby **DENIED**.

SIGNED this 17th day of August, 2006.

DAVID FOLSOM

UNITED STATES DISTRICT JUDGE







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Defendants.No. C 02-3378 JSW (JL) E-FILING

UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF CALIFORNIA

454 F. Supp. 2d 957; 2006 U.S. Dist. LEXIS 53429

July 14, 2006, Decided

July 14, 2006, Filed


SUBSEQUENT HISTORY: Objection denied by, Affirmed by [Informatica Corp. v. Bus. Objects Data Integration, 2006 U.S. Dist. LEXIS 58976 \(N.D. Cal., Aug. 9, 2006\)](#)**PRIOR HISTORY:** [Informatica Corp. v. Bus. Objects Data Integration, Inc., 2006 U.S. Dist. LEXIS 10106 \(N.D. Cal., Feb. 23, 2006\)](#)**CASE SUMMARY****PROCEDURAL POSTURE:** Plaintiff patent holder filed a motion to compel answers to interrogatories and production of documents which defendant, an alleged patent infringer, withheld as protected by the attorney-client privilege and the work product doctrine under Fed. R. Civ. P. 26.**OVERVIEW:** Defendant asserted an advice-of-counsel defense in plaintiff's infringement action. Plaintiff asked the court to compel defendant to include all responsive attorney-client communications and work product regarding its non-infringement contentions in response to an interrogatory and to supplement all discovery responses to include responsive attorney-client communications and work product. The court found that defendant waived attorney-client privilege for both pre-filing and post-filing communications on the subject of the opinion on which it relied for its defense and for work product on the same subject which was communicated to defendant including documents that referenced any attorney-client communications on the subject. Because the primary concern was defendant's state of mind relative to infringement, the court held that the waiver applied to opinion counsel and trial counsel alike. Further, it was immaterial that opinion counsel and trial counsel were from the same law firm. Because plaintiff alleged that defendant continued to infringe its patents, plaintiff was entitled to information subject to waiver which defendant received even after plaintiff filed its complaint.**OUTCOME:** The court granted plaintiff's motion in part and directed defendant to provide attorney-client communications with any counsel on the subject of the opinion or advice on which defendant relied, work product communicated to defendant on the same subject,


and work product which reflected any communication on the subject with the exception of attorney legal opinions, impressions and trial strategy unrelated to the opinion on which defendant relied.

CORE TERMS: work product, attorney-client, patent, communicated, trial counsel, infringement, work product doctrine, advice-of-counsel, infringer, advice, state of mind, work-product, discovery, advice of counsel, immunity, willful, waives, interrogatory, subject matter, uncommunicated, post-filing, disclosure, impression, waived, legal opinions, discoverable, immaterial, infringed, infringe, trial strategy


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HN1  United States Court of Appeals for the Federal Circuit law, rather than the law of the regional circuit, applies to substantive legal issues in a patent case. [More Like This Headnote](#)


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HN2  United States Court of Appeals for the Federal Circuit law applies when deciding whether particular written or other materials are discoverable in a patent case, if those materials relate to an issue of substantive patent law. [More Like This Headnote](#)


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HN3  Questions of privilege and discoverability that arise from assertion of the advice-of-counsel defense necessarily involve issues of substantive patent law. The attorney-client privilege protects disclosure of communications between a client and his attorney. Once a party announces that it will rely on advice of counsel, for example, in response to an assertion of willful infringement, the attorney-client privilege is waived. The widely applied standard for determining the scope of a waiver of attorney-client privilege is that the waiver applies to all other communications relating to the same subject matter. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)


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HN4  In contrast to the attorney-client privilege, the work-product doctrine, or work-product immunity as it is also called, can protect documents and tangible things prepared in anticipation of litigation that are both non-privileged and relevant. [Fed. R. Civ. P. 26\(b\)\(3\)](#). Unlike the attorney-client privilege, which protects all communication whether written or oral, work-product immunity protects documents and tangible things, such as memorandums, letters, and e-mails. The work-product immunity promotes a fair and efficient adversarial system by protecting the attorney's thought processes and legal recommendations from the prying eyes of his or her opponent. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)


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HN5  A party may discover work product if the other party waives its immunity. However, work product waiver is not a broad waiver of all work product related to the same subject matter like the attorney-client privilege. Instead, work-product

waiver only extends to "factual" or "non-opinion" work product concerning the same subject matter as the disclosed work product. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)


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HN6  When a party relies on the advice of counsel as a defense to willful infringement, the party waives its attorney-client privilege for all communications between the attorney and client, including any documentary communications such as opinion letters and memoranda. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)


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HN7  In *Echostar*, the United States Court of Appeals for the Federal Circuit recognized at least three categories of work product that are potentially relevant to the advice-of-counsel defense: (1) documents that embody a communication between the attorney and client concerning the subject matter of the case, such as a traditional opinion letter; (2) documents analyzing the law, facts, trial strategy, and so forth that reflect the attorney's mental impressions but were not given to the client; and (3) documents that discuss a communication between attorney and client concerning the subject matter of the case but are not themselves communications to or from the client. The Federal Circuit has concluded that waiver extends to the first and third categories but not to the second. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)

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HN8  In *Echostar*, the United States Court of Appeals for the Federal Circuit found that the relevant inquiry is not into the attorneys's files, but into the infringer's state of mind. Work-product waiver extends only so far as to inform the court of the infringer's state of mind. Counsel's opinion is not important for its legal correctness. It is important to the inquiry whether it is thorough enough, as combined with other factors, to instill a belief in the infringer that a court might reasonably hold the patent is invalid, not infringed, or unenforceable. It is what the alleged infringer knew or believed, and by contradistinction not what other items counsel may have prepared but did not communicate to the client, that informs the court of an infringer's willfulness. Where there is an allegation of continuing infringement, waiver may extend to post-filing work product as well, if it is communicated to the client. Once a party asserts the defense of advice of counsel, this opens to inspection the advice received during the entire course of the alleged infringement. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)

COUNSEL: [1]** For Informatica Corporation, a Delaware corporation, Plaintiff: [Albert Lukas Sieber](#) , Fenwick & West LLP, San Francisco, CA; [Carolyn Chang](#) , [Darren E. Donnelly](#) , [J. David Hadden](#) , [David Douglas Schumann](#) , [Lynn H. Pasahow](#)  , Fenwick & West LLP, Mountain View, CA; [Kenneth B. Wilson](#)  , Perkins Coie LLP, San Francisco, CA; [Stefani E. Shanberg](#) , Perkins Coie LLP, San Francisco, CA; [Lynne A. Maher](#), Fenwick & West LLP, Palo Alto, CA.

For Business Objects Data Integration, Inc., a Delaware corporation, Defendant: [Theodore T. Herhold](#) , [Daniel J. Furniss](#)  , [Joseph A. Greco](#)  , [Robert D. Tadlock](#) , Townsend and Townsend and Crew LLP, Palo Alto, CA; [Ian L. Saffer](#)  , Townsend and

Townsend and Crew LLP, Denver, CO; Leonard Joseph Augustine, Jr. ↘, Townsend and Townsend and Crew LLP, San Francisco, CA.

For Business Objects Data Integration, Inc., a Delaware corporation, Counter-claimant: Daniel J. Furniss ↘, Joseph A. Greco ↘, Robert D Tadlock ↘, Townsend and Townsend and Crew LLP, Palo Alto, CA; Ian L. Saffer ↘, Townsend and Townsend and Crew LLP, Denver, CO.

For Informatica Corporation, a Delaware corporation, Counter-defendant: Carolyn Chang ↘, Fenwick & West LLP, Mountain View, CA.

For Business Objects Data **[**2]** Integration, Inc., a Delaware corporation, Counter-claimant: Joseph A. Greco ↘, Robert D Tadlock ↘, Townsend and Townsend and Crew LLP, Palo Alto, CA; Leonard Joseph Augustine, Jr. ↘, Townsend and Townsend and Crew LLP, San Francisco, CA.

For Informatica Corporation, a Delaware corporation, Counter-defendant: Albert Lukas Sieber ↘, Fenwick & West LLP, San Francisco, CA.

JUDGES: JAMES LARSON, Chief Magistrate Judge.

OPINION BY: JAMES LARSON

OPINION

[*958] ORDER GRANTING IN PART MOTION TO COMPEL (Docket # 187)

Summary

Plaintiff Informatica Corporation ↘ ("Informatica") moves to compel answers to interrogatories and production of documents which Defendant BODI withholds as protected by the attorney-client privilege and the work product doctrine. The motion is granted in part. This Court finds that BODI waived attorney-client privilege for both pre-and post-filing communications on the subject of the opinion on which it relies for its advice-of-counsel defense and for work product on the same subject which was communicated to BODI, including documents which reference any attorney-client communications on that **[*959]** subject. Such waiver applies to opinion counsel and trial counsel alike.

While opinion counsel **[**3]** and trial counsel can be walled off from each other, the immurement is immaterial - what matters, according to the Federal Circuit in *Echostar*, is the state of mind of BODI relative to infringement. It is immaterial whether BODI's opinion counsel and trial counsel are from the same firm, different firms or are even the same person. What matters is the following:

1. BODI relies on advice of counsel as a defense to Informatica's charge that it willfully infringed Informatica's patents;
2. Therefore, BODI waives any privilege for communications with counsel on the subject of the opinion or advice on which it relies, as well as work product on that subject communicated to BODI or which refers to communications on that subject; and
3. Informatica alleges that BODI continues to infringe Informatica's patents;
4. Therefore, Informatica is entitled to information subject to waiver which BODI received

even after Informatica filed its complaint; and

5. The categories of information which BODI must turn over to Informatica include (a) attorney-client communications with any counsel on the subject of the opinion or advice on which BODI relies; (b) work product communicated to BODI on [**4] that same subject; (c) work product which reflects any communication on that subject.

Background

Informatica Corporation ("Informatica") is suing Business Objects Data Integration, Inc. ("BODI", formerly Acta Technology) for patent infringement. All discovery in this case has been referred by the district court (Hon. Jeffrey S. White) as provided by 28 U.S.C. § 636(b) and Civil Local Rule 72. The district court on April 18 approved the parties' stipulation re damages, expert reports and the discovery cut-off. Fact discovery closed June 5, 2006.

BODI contends that disclosures of privileged information and the deposition of opinion counsel should be delayed until after the parties file their motions for summary judgment. Pursuant to the order setting dates, [Docket No. 147], BODI produced its written opinions of counsel on January 31, 2006. Tadlock Decl. P 11. Informatica recently has sought to depose both the attorney who authored the opinions, and also the BODI representative who received the opinion (who happens to be BODI's in-house counsel). *Id.* P 12. Such depositions would require further disclosure of attorney-client communications and attorney [**5] work product at a time when the parties are preparing expert reports and motions for summary judgment. *Id.* Summary judgment motions were scheduled to be filed by June 16, 2006 and argued on August 4, 2006. [Docket No. 147]. However, Judge White vacated the hearing on summary judgment because, although the parties agreed to try the case on the basis of representative claims, they cannot agree on what those claims are:

Although both parties agree that this Court may utilize a representative claims approach for trial, they disagree over what those representative claims should be. The Court exhorts the parties further meet and confer in person in an effort to resolve this dispute and submit a status report by no later than June 26, 2006. Until this dispute is resolved, the Court cannot proceed with the current schedule set for dispositive motions in this matter.

(Order filed 6/12/2006, at docket # 224)

The parties on June 26 advised the district court that they would be submitting a stipulation as to the representative claims. [**960] (Status Report at Docket # 225) The district court on July 5 approved the parties' stipulation extending damages expert discovery to August [**6] 31 (Docket # 229).

Discovery Dispute

This Court received the parties' joint letter brief arguing the merits of their positions on the scope of any waiver of the attorney-client privilege and the work product doctrine resulting from BODI's assertion of the advice-of-counsel defense. An additional wrinkle is that one of the attorneys who rendered an opinion on infringement is a member of the same firm which represents BODI in this litigation.

Informatica asks this Court to compel BODI to include all responsive attorney-client communications and work product regarding its non-infringement contentions in response to Interrogatory No. 3, and supplement all discovery responses to include responsive attorney-client communications and work product. Furthermore, Informatica asks the Court to order the Townsend firm and attorney Philip H. Albert to produce all attorney-client

communications and attorney work product regarding infringement or non-infringement of the patents-in-suit in response to the subpoenas issued by Informatica.

In its portion of the letter brief, BODI "respectfully requests that it be allowed full briefing on the merits if the Court were to consider granting Informatica's [**7] motion in whole or in part." (Letter brief, Docket # 187, at pages 3 and 4)

The Court was inclined to grant Informatica's motion and ordered the parties to brief the issue of the existence and scope of the waiver of both attorney-client privilege and the work product doctrine, particularly in light of the following authorities: *AKEVA L.L.C. v Mizuno Corporation*, 243 F. Supp. 2d 418 (M.D.N.C. 2003); *Novartis Pharms. Corp. v. Eon Labs Mfg.*, 206 F.R.D. 396 (D.Del. 2002); *Convolve, Inc. v. Compaq Computer Corp.*, 224 F.R.D. 98 (S.D.N.Y. 2004); David Hricik, *How Things Snowball: The Ethical Responsibilities and Liability Risks Arising from Representing a Single Client in Multiple Patent-related Representations*, Georgetown Journal of Legal Ethics, Spring 2005, 18 Geo. J. Legal Ethics 421.

The parties then requested an opportunity also to brief the impact on this case of the decision by the Federal Circuit in the case of *In re Echostar Communs. Corp.* 448 F.3d 1294 (Fed. Cir. 2006), which was decided May 1, 2006. The Court granted their request and briefing was submitted. [**8] The Court took the matter under submission.

Argument

BODI argues that this Court should give precedence to the Federal Circuit's decisions and specifically *Echostar*, which absolved from disclosure any work product not disclosed to the client.

When an alleged patent infringer asserts an advice-of-counsel defense regarding willful infringement, it waives its attorney-client privilege and work-product immunity for any document or opinion that embodies or discusses a communication to or from it concerning whether that patent is valid, enforceable, and infringed by the accused; waiver includes not only any letters, memorandum, conversation, or the like between the attorney and his or her client, but, when appropriate, any documents referencing a communication between attorney and client.

Id. at 1304.

BODI argues that there is a significant difference between the same individual lawyer being both opinion and litigation counsel and those roles being played by different lawyers with the same firm. BODI contends that "[w]here the same individual lawyer does not act as both trial [**961] and opinion counsel, the proper balance is to not require disclosure [**9] of such sensitive communications, which are not relevant to the alleged infringer's state of mind. [Docket No. 198, P 4-6.]"

BODI urges this Court to "not extend the waiver of attorney-client privilege to BODI's trial counsel, but rather follow the Northern District cases that find the trial counsel's communications are not discoverable. *E.g.*, *Sharper Image Corp. v. Honeywell International Inc.*, 222 F.R.D. 621 at 634-46 (N.D.Cal. 2004); *Collaboration Properties, Inc. v. Polycom, Inc.*, 224 F.R.D. 473 at 475-77 (N.D.Cal. 2004); *Terra Novo, Inc. v. Golden Gate Products, Inc.*, 2004 U.S. Dist. LEXIS 20429, 2004 WL 2254559 at * 3 (N.D.Cal. 2004) ."

This Court examined those cases and finds they are factually distinguishable: in *Sharper Image* there was separately retained litigation counsel. In *Collaboration Properties* trial counsel did not provide any pre-litigation advice. In *Terra Novo*, trial and litigation counsel

were with separate firms. Consequently, BODI's citation to these cases is not than convincing.

BODI asks this Court to interpret *EchoStar* to hold that attorney work product is not discoverable unless it is communicated to the client **[**10]** or discusses a communication with a client. *In re EchoStar*, 448 F.3d at 1305. ("counsel's legal opinions and mental impressions that were not communicated . . . are . . . not within the scope of the waiver . . . work product that was not communicated to EchoStar or does not reflect a communication is not within the scope of EchoStar's waiver because it obviously played no part in EchoStar's belief as to infringement of the '389 patent." *Id.*

The Federal Circuit reasoned that "if a legal opinion or mental impression was never communicated to the client, then it provides little if any assistance to the court in determining whether the accused knew it was infringing, and any relative value is outweighed by the policies supporting the work-product doctrine." *Id.* at 1304. Thus, says BODI, if this Court orders production of any of trial counsel's materials, it should extend only to materials that were communicated to BODI, not uncommunicated work product. BODI asks the Court not to ignore this clear mandate from *EchoStar*.

Informatica argues that BODI's trial counsel's uncommunicated work product is discoverable because Mr. Albert and BODI's trial **[**11]** counsel are from the same law firm. [Docket No. 206 at 7-8.] To the extent that Informatica relies on *Novartis* for this proposition, BODI asks the Court to find that case distinguishable because there the same individual attorney acted as both opinion and trial counsel. *Novartis Pharms. Corp. v. Eon Labs Mfg.*, 206 F.R.D. 392, 393 (D. Del. 2002) ("Eon's opinion counsel, Mr. Pontani, has actually entered an appearance in this matter.") BODI points to the appearance by opinion counsel in *Novartis* as distinguishing that case from the case at bar, where opinion counsel has not made an appearance.

Moreover, to the extent *Novartis* is inconsistent with *EchoStar*, BODI urges this Court to rule that the former is no longer good law and deny Informatica's motion to compel production of uncommunicated work product. BODI argues that *EchoStar* directly contradicts this argument. With regard to work product, the Federal Circuit determined that uncommunicated work product "provides little if any assistance" in determining a defendant's state of mind. *In re EchoStar*, 448 F.3d at 1305.

That Mr. Albert and BODI's trial counsel are members of the **[**12]** same firm, argues BODI, has no bearing on whether any given work product document was communicated to BODI, in which case it might **[*962]** affect BODI's state of mind, or uncommunicated, in which case it would not. BODI asks this Court to find, under the rationale of *EchoStar*, that the identity of the lawyer providing the opinion and that lawyer's affiliation, if any, with a law firm, is irrelevant and that the sole relevant inquiry is what the alleged infringer knew or did not know.

Informatica also claims that BODI's trial counsel must produce its communications and work product because Mr. Albert allegedly was not in any way separated from BODI's trial counsel. Mr. Albert has stated under oath that he has never been a member of the Townsend litigation team and that his last communication with trial counsel about the Informatica patents-in-suit was over three years ago, on November 14, 2002. [See Docket No. 199 P 6]. There is no evidence that Mr. Albert communicated with BODI's trial counsel, even though they are members of the same firm as Mr. Albert.

Finally, BODI asks the Court for procedural reasons not to compel any further response to Interrogatory 3, which it **[**13]** contends is improper for reasons that have nothing to do with the work product doctrine and the waiver resulting from the advice-of-counsel defense. BODI contends that any dispute over BODI's response to Interrogatory 3 was resolved during

the meet and confer between counsel, and the decision by the court in *EchoStar* does not affect this resolution. Prior to filing this motion, counsel for BODI agreed to supplement its response to Interrogatory 3, but at all times maintained that it would not conduct any product comparisons requested by the interrogatory that had not been previously conducted, and that it would not create work product that did not already exist. [Docket No. 201 PP 5-6 & Exh. 3.]

Counsel for Informatica admits that this is all that BODI's counsel agreed to do, [Docket No. 207 P 6], but now contends that this agreement was not a resolution of the dispute, but rather was a unilateral agreement by BODI to provide additional information, which Informatica could then review and either accept or reject. [Id. P 7.] BODI says it did not agree to provide a supplemental response simply so Informatica could review it and then file this motion [**14] anyway. Rather, says BODI, the agreement was that BODI's production of the supplemental response would resolve all disputed issues. [Docket No. 201 P 5, 9.]

This Court is not in a position to enforce agreements over which the parties now disagree. It can only apply the law to the facts in this case, and therefore declines to base its decision on any putative agreement between the parties. The legal and factual analysis follows.

Analysis

The question before this Court is the scope of the waiver of privilege by BODI after it asserted an advice-of-counsel defense.

HN1 Federal Circuit law, rather than the law of the regional circuit, applies to substantive legal issues in a patent case.

In this petition, we apply our own law, rather than the law of the regional circuit. This case involves the extent to which a party waives its attorney-client privilege and work-product immunity when it asserts the advice-of-counsel defense in response to a charge of willful patent infringement. *HN2* Federal Circuit law applies when deciding whether particular written or other materials are discoverable in a patent case, if those materials relate to an issue of substantive patent [**15] law."

In re EchoStar, 448 F.3d at 1298.

In the underlying case, TiVo sued EchoStar for infringement of its U.S. Patent [**963] No. 6,233,389 ("the '389 patent"). In response to the allegation of willful infringement, EchoStar asserted the defense of reliance on advice of counsel. Prior to filing the action, EchoStar relied on advice of in-house counsel. After the action was filed, EchoStar obtained additional legal advice from Merchant & Gould but elected not to rely on it. Presumably to explore further EchoStar's state of mind in determining that it did not infringe the patent, TiVo sought production of documents in the possession of EchoStar and Merchant & Gould.

The district court ultimately found waiver of immunity for all work product of Merchant and Gould, both pre and post-filing of the complaint, whether or not communicated to EchoStar. EchoStar petitioned the Federal Circuit for a writ of mandamus with respect to Merchant and Gould documents not communicated to EchoStar. No in-house counsel documents were at issue.

HN3 Questions of privilege and discoverability that arise from assertion of the advice-of-counsel defense necessarily involve issues of substantive [**16] patent law, see *In re Spalding Sports Worldwide, Inc.*, 203 F.3d 800, 803-04 (Fed.Cir.2000) (applying Federal Circuit law to question of attorney-client privilege between patent attorney and patentee). *Id.*

The attorney-client privilege protects disclosure of communications between a client and his attorney. *United States v. Zolin*, 491 U.S. 554, 562, 109 S. Ct. 2619, 105 L. Ed. 2d 469 (1989); *Upjohn Co. v. United States*, 449 U.S. 383, 389, 101 S. Ct. 677, 66 L. Ed. 2d 584 (1981). Once a party announces that it will rely on advice of counsel, for example, in response to an assertion of willful infringement, the attorney-client privilege is waived. "The widely applied standard for determining the scope of a waiver of attorney-client privilege is that the waiver applies to all other communications relating to the same subject matter." *Fort James Corp. v. Solo Cup Co.*, 412 F.3d 1340, 1349 (Fed.Cir. 2005). Cited in *In re EchoStar*, 448 F.3d at 1298-1299.

HN4 In contrast to the attorney-client privilege, the work-product doctrine, or work-product immunity as it is also called, can protect "documents and tangible things" prepared in anticipation of litigation that are both non-privileged and **[**17]** relevant. Fed.R.Civ.P. 26 (b)(3). Unlike the attorney-client privilege, which protects all communication whether written or oral, work-product immunity protects documents and tangible things, such as memorandums, letters, and e-mails. The work-product immunity promotes a fair and efficient adversarial system by protecting "the attorney's thought processes and legal recommendations" from the prying eyes of his or her opponent. *In re EchoStar*, 448 F.3d at 1301.

HN5 A party may discover work product if the other party waives its immunity. However, work product waiver is not a broad waiver of all work product related to the same subject matter like the attorney-client privilege. Instead, work-product waiver only extends to "factual" or "non-opinion" work product concerning the same subject matter as the disclosed work product. *Id.* at 1302 (internal citations omitted).

HN6 When a party relies on the advice of counsel as a defense to willful infringement the party waives its attorney-client privilege for all communications between the attorney and client, including any documentary communications such as opinion letters and **[**18]** memoranda. *Id.* (citing *AKEVA LLC*, 243 F.Supp.2d at 423).

HN7 The court in *Echostar* recognized at least three categories of work product that are potentially relevant to the advice-of-counsel defense: (1) documents that **[*964]** embody a communication between the attorney and client concerning the subject matter of the case, such as a traditional opinion letter; (2) documents analyzing the law, facts, trial strategy, and so forth that reflect the attorney's mental impressions but were not given to the client; and (3) documents that discuss a communication between attorney and client concerning the subject matter of the case but are not themselves communications to or from the client. The court concluded that waiver extends to the first and third categories but not to the second. *In re Echostar*, 448 F3d at 1303.

HN8 The court in *Echostar* found that the relevant inquiry is not into the attorneys's files, but into the infringer's state of mind:

Work-product waiver extends only so far as to inform the court of the infringer's state of mind. Counsel's opinion is not important for its legal correctness. It is important to the inquiry whether it is "thorough **[**19]** enough, as combined with other factors, to instill a belief in the infringer that a court might reasonably hold the patent is invalid, not infringed, or unenforceable." It is what the alleged infringer knew or believed, and by contradistinction not what other items counsel may have prepared but did not communicate to the client, that informs the court of an infringer's willfulness.

In re EchoStar, 448 F.3d at 1303 (internal citation omitted)

Where there is an allegation of continuing infringement, waiver may extend to post-filing work product as well, if it is communicated to the client.

EchoStar contends that waiver of opinions does not extend to advice and work product given after litigation began. While this may be true when the work product is never communicated to the client, it is not the case when the advice is relevant to ongoing willful infringement, so long as that ongoing infringement is at issue in the litigation.

See *AKEVA LLC*, 243 F.Supp.2d at 423 ("[O]nce a party asserts the defense of advice of counsel, this opens to inspection the advice received during the entire course of the alleged infringement.") *In re EchoStar*, 448 F.3d at 1303. **[**20]**

In the case at bar, Informatica alleges that BODI continues to infringe Informatica's patents (Complaint at paragraphs 13, 15, 17, 18, 20, 24, 25, 27, 29 and 31.)

Conclusion and Order

This Court, after weighing all the persuasive authority, concludes that the Federal Circuit has the final word in a patent case on the subject of the scope of waiver of attorney-client privilege and the work product protection for discovery relevant to a substantive issue after assertion of the advice-of-counsel defense. The court in *Echostar* makes it crystal clear that attorney-client communications on the subject of the opinion BODI relies on for its defense are subject to waiver, as well as documents, including work product, which reference these communications. Similarly, both pre-and post-filing work product is potentially relevant to the alleged infringer's intent where there is an allegation of continuing infringement and are therefore also subject to waiver. However, only work product which has either been communicated to the alleged infringer or refers to communications is relevant to intent and therefore subject to waiver by assertion of the advice-of-counsel defense.

This Court **[**21]** finds that, according to the analysis in *Echostar*, what is significant is the state of mind of BODI and not the affiliation of BODI's attorneys, and that privilege has been waived with respect to pertinent communications and work product of all counsel in this case. Attorney legal opinions, impressions and trial strategy **[*965]** unrelated to the opinion on which BODI relies may be redacted from documents to be produced to Informatica. The Federal Circuit in *Echostar* cautioned that the parties should protect such information.

Still, we must emphasize that such communications may contain work product of the second kind-legal analysis that was not communicated. In those situations, the parties should take special care to redact such information, and if necessary the district court may review such material in camera.

In re EchoStar, 448 F.3d at 1304.

While opinion counsel and trial counsel can be walled off from each other, the immurement is immaterial - what matters, according to the decision by the Federal Circuit in *Echostar*, is the state of mind of BODI.

For all the above reasons, Informatica's motion to compel further responses from BODI is granted. **[**22]** This Court finds that, by asserting advice of counsel as a defense to a charge of willful infringement of Informatica's patents, BODI waived privilege for both pre- and post-filing pertinent attorney-client communications and work product. Under the

analysis in *Echostar*, it is immaterial whether BODI's opinion counsel and trial counsel are from the same firm, different firms or are even the same person. What matters is that:

1. BODI relies on advice of counsel as a defense to Informatica's charge that it willfully infringed Informatica's patents;
2. Therefore, BODI waives privilege for communications with counsel on the subject of the opinion or advice on which it relies as well as work product on that subject communicated to BODI or which refers to communications on that subject;
3. Informatica alleges that BODI continues to infringe Informatica's patents;
4. Therefore Informatica is entitled to information subject to waiver which BODI received even after Informatica filed its complaint;
5. The categories of information which BODI must turn over to Informatica include (a) attorney-client communications with any counsel on the subject of the opinion or advice on which BODI **[**23]** relies; (b) work product communicated to BODI on that same subject; (c) work product which reflects any communication on that subject.

Attorney legal opinions, impressions and trial strategy unrelated to the opinion on which BODI relies may be redacted from documents to be produced to Informatica.

All responsive discovery which is being withheld as privileged for which privilege has been waived as discussed above shall be produced within twenty days of the e-filing of this order. BODI shall at the same time produce a privilege log for all other withheld documents, in compliance with the decision in *In re Grand Jury Investigation*, 974 F.2d 1068, 1070 (9th Cir. 1992), citing *Dole v. Milonas*, 889 F.2d 885, 888 n. 3, 890 (9th Cir. 1989).

IT IS SO ORDERED.

DATED: July 14, 2006

JAMES LARSON

Chief Magistrate Judge







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2006 U.S. Dist. LEXIS 34023, *

INDIANA MILLS & MANUFACTURING, INC., Plaintiff, vs. DOREL INDUSTRIES, INC., and
DOREL JUVENILE GROUP, INC., Defendants.

1:04-cv-01102-LJM-WTL

UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF INDIANA,
INDIANAPOLIS DIVISION

2006 U.S. Dist. LEXIS 34023

May 26, 2006, Decided

May 26, 2006, Filed

NOTICE:

[*1] THIS OPINION WAS WITHDRAWN BY THE COURT

SUBSEQUENT HISTORY: Opinion withdrawn by [Ind. Mills & Mfg. v. Dorel Indus., 2006 U.S. Dist. LEXIS 47852 \(S.D. Ind., July 14, 2006\)](#)Summary judgment granted by, Summary judgment denied by [Ind. Mills & Mfg. v. Dorel Indus., 2006 U.S. Dist. LEXIS 60929 \(S.D. Ind., Aug. 25, 2006\)](#)**PRIOR HISTORY:** [Ind. Mills & Mfg. v. Dorel Indus., 2006 U.S. Dist. LEXIS 45637 \(S.D. Ind., Feb. 16, 2006\)](#)**CASE SUMMARY****PROCEDURAL POSTURE:** Plaintiff patent holder alleged that defendant competitor's child restraint seat infringed two claims of the holder's patent. The holder also alleged that the competitor willfully infringed those claims. The holder brought the instant emergency motion for reconsideration on the holder's objection to the magistrate judge's order regarding willfulness-related discovery.**OVERVIEW:** The most pertinent aspect of the holder's invention was the configuration of a belt adjuster for a harness system of a patented child restraint seat. In the instant motion, the holder sought to broaden the scope of discovery allowed by the court's order in light of the Federal Circuit's opinion which further defined the scope of the waiver of the attorney-client and work-product privileges when a defendant asserted an advice-of-counsel defense to allegations of willful infringement. First, the instant court was unwilling to broaden the temporal scope of the waiver post-filing in the present case. Second, with respect to the scope of the work-product privilege waiver, the present court's prior definition was too narrow. The court did concern itself with the documents relied upon by opinion counsel that may not have been disclosed to the client, however, the court did not address documents that reflected conversations or communications with the client that


were never disclosed to the client. It was this later category of documents that the Federal Circuit clearly stated were discoverable. As such, the order was modified to include discovery of such documents.


OUTCOME: The court granted in part and denied in part the holder's motion for reconsideration. The competitor was ordered to produce pre-filing documents that reflected conversations or communications with the client that were never disclosed to the client.


CORE TERMS: work-product, attorney-client, work product, infringement, discovery, subject matter, temporal, willful, advice, non-infringement, immunity, communicated, infringer's, advice-of-counsel, in-house, patent, waived, summary judgment, trial counsel, discoverable, post-filing, reconsider, in camera, protective order, deposition, privileged, reconsideration, advice of counsel, privileged information, willfulness


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HN1  A motion to reconsider is appropriate where there is a controlling or significant change in the law or facts since the submission of the issue to the court. An order that is interlocutory in nature may be reconsidered at any time prior to final judgment. A court may, however, decline to reconsider an issue already decided under the "law of the case" doctrine. [More Like This Headnote](#)


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HN2  The widely applied standard for determining the scope of a waiver of attorney-client privilege is that the waiver applies to all of other communications relating to the same subject matter. [More Like This Headnote](#)


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HN3  In contrast to the attorney-client privilege, the work-product doctrine, or work-product immunity as it is also called, can protect "documents and tangible things" prepared in anticipation of litigation that are both non-privileged and relevant. Fed. R. Civ. P. 26(b)(3). Unlike the attorney-client privilege, which protects all communication whether written or oral, work-product immunity protects documents and tangible things, such as memorandums, letters and e-mails. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)

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HN4  Like the attorney-client privilege, however, the work-product doctrine is not absolute. First, a party may discover certain types of work product if they have a substantial need of the materials in preparation of the party's case and that the party is unable without undue hardship to obtain the substantial equivalent by other means. Fed. R. Civ. P. 26(b)(3). Second, a party may discover work product if the party waives its immunity. However, work product waiver is not a broad waiver of all work product related to the same subject matter like the attorney-

client privilege. Instead, work-product waiver only extends to "factual" or "non-opinion" work product concerning the same subject matter as the disclosed work product. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)


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HN5 ↓ The line between "factual" work product and "opinion" work product is not always distinct, especially when an attorney's opinion may itself be "factual" work product. When faced with the distinction between where that line lies, however, a district court should balance the policies to prevent sword-and-shield litigation tactics with the policy to protect work product. [More Like This Headnote](#)

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HN6 ↓ By asserting the advice-of-counsel defense to a charge of willful infringement, the accused infringer and his or her attorney do not give their opponent unfettered discretion to rummage through all of their files and pillage all of their litigation strategies. Rather, a court must ensure that the work-product waiver extends only so far as to inform the court of the infringer's state of mind. Legal correctness of the opinion is not the issue, but whether the opinion is thorough enough to instill a belief in the infringer that a court may hold the patent not infringed. The overarching goal of waiver in such a case is to prevent a party from using the advice he received as both a sword, by waiving privilege to favorable advice, and a shield, by asserting privilege to unfavorable advice. [More Like This Headnote](#)

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HN7 ↓ Work product that is never communicated to the client provides little if any assistance to the court in determining whether the accused knew it was infringing, and any relative value is outweighed by the policies supporting the work-product doctrine. However, in the category of documents that discuss a communication between attorney and client concerning the subject matter of the case but are not themselves communicated to or from the client, there may be work-product material that would have bearing on what the accused infringer knew, but were never themselves communicated to the client. Such communications will aid the parties in determining what communications were made to the client and protect against intentional or unintentional withholding of attorney-client communications from the court. If necessary, where there are several types of communication in one document, some of which requires redaction, the district court may review such material in camera. [More Like This Headnote](#) | [Shepardize: Restrict By Headnote](#)

COUNSEL: For INDIANA MILLS & MANUFACTURING, INC., Plaintiff: Daymon L. Ruttenberg, Samuel Ellet Shehadeh, Timothy Quinn Delaney, BRINKS HOFER GILSON & LIONE, Chicago, IL; A. James Richardson, Lawrence A. Steward, Sanders N. Hillis, BRINKS HOFER GILSON & LIONE, Indianapolis, IN.

For DOREL INDUSTRIES, INC., DOREL JUVENILE GROUP, INC., Defendants: Gregory Andrew Duff, Jay G. Taylor, John F. Prescott, Jr, Michael A. Swift, ICE MILLER LLP, Indianapolis, IN.

JUDGES: LARRY J. MCKINNEY, CHIEF JUDGE.

OPINION BY: LARRY J. MCKINNEY

OPINION

ORDER ON PLAINTIFF'S EMERGENCY MOTION FOR RECONSIDERATION

This cause is now before the Court on plaintiff's, Indiana Mills & Manufacturing, Inc. ("IMMI"), Emergency Motion for Reconsideration of February 16, 2006, Order on Plaintiff's Objection to Magistrate Judge's Order Regarding Willfulness-Related Discovery. In the February 16, 2006, order ("Feb. Order"), the Court sustained in part and overruled in part IMMI's objection to an October 14, 2005, order ("MJ Order"), by Magistrate Judge Lawrence that denied IMMI's motion to compel willfulness discovery and granted defendants', Dorel Industries, Inc. and Dorel Juvenile Group, Inc. (collectively, "Dorel"), motion for [*2] protective order.

In the instant motion, IMMI seeks to broaden the scope of discovery allowed by the Feb. Order in light of the Federal Circuit's recent opinion in In re EchoStar Communications Corp., 448 F.3d 1294, 2006 U.S. App. LEXIS 11162, Misc. Nos. 803, 805, 2006 WL 1149528 (Fed. Cir. May 1, 2006), in which the Federal Circuit further defined the scope of the waiver of the attorney-client and work-product privileges when a defendant asserts an advice-of-counsel defense to allegations of willful infringement. Dorel argues that IMMI reads *EchoStar* too broadly and that the facts of this case are distinguishable.

The Court held a hearing on the matter on May 24, 2006, to give the parties an opportunity to discuss with the Court the salient points of the *EchoStar* opinion before it issued a ruling. For the reasons stated herein, the Court **GRANTS in part and DENIES in part** IMMI's motion for reconsideration.

I. FACTUAL & PROCEDURAL BACKGROUND

This is a patent infringement suit in which IMMI alleges that Dorel's child restraint seat infringes claims 8 and 11 of U.S. Patent No. 4,660,889 (the "'889 patent"). IMMI also alleges that Dorel willfully infringed those claims. It is important [*3] to note that the most pertinent aspect of the claimed invention is the configuration of a belt adjuster for the harness system of the patented child restraint seat.

On or about August 18, 2005, Dorel notified IMMI that it would rely upon an advice-of-counsel defense to IMMI's allegations of willful infringement. Dorel produced to IMMI the relevant opinion letters and offered to make available Mr. Glover to testify to his reasonable reliance upon an attorney's, Mr. Jay Taylor, opinion that the Dorel adjuster and the Dorel car seats utilizing that adjuster do not infringe the ''889 patent'. However, Dorel also moved for a protective order to prevent IMMI from deposing Mr. Taylor, asserting that such a deposition is unlikely to lead to any admissible evidence.

On September 13, 2005, IMMI filed its Motion to Compel Willfulness Discovery and Opposition to Dorel's Motion for Protective Order. IMMI argued that having waived privilege with respect to Mr. Taylor's opinions, the Court should compel Dorel to produce all documents and witnesses related to the subject matter of its waiver. In addition, IMMI asked that the Court deny Dorel's Motion for Protective Order.

Predictably, IMMI argued [*4] that the scope of Dorel's waiver extended to all the opinions encompassed by Mr. Taylor's opinions, including validity opinions, and that the waiver should apply to communications on the issues of infringement and validity post-filing. In contrast, and predictably, Dorel argued that the scope of the waiver was narrow because the only opinion disclosed in the communications by Mr. Taylor to Dorel related to infringement. Moreover, the waiver should not apply past the point at which IMMI issued to Dorel a cease and desist letter.

The MJ Order, dated October 14, 2005, granted Dorel's Motion for Protective Order and denied IMMI's Motion to Compel Willfulness Discovery. Specifically, it reads, in pertinent part:

1. Defendants have waived their attorney-client privilege only with respect to communications between Defendants and their Counsel directly related to the non-infringement analysis regarding the '889 Patent set forth in the October 3, 2001, November 2, 2002, and April 8, 2003, non-infringement opinions relied upon by Defendants as part of their advice-of-counsel defense.
2. The scope of this waiver extends to, but not later than, Defendants['] receipt of the cease [*5] and desist request contained in Mr. Wallen's letter to Mr. Cartwright on April 23, 2004.
3. Defendants have waived their attorney work-product protection only with respect to actual communications between Defendants and their Counsel prior to April 23, 2004, which directly relate to the non-infringement analysis regarding the '889 Patent set forth in the October 23, 2001, November 8, 2002, and April 8, 2003, non-infringement opinions relied upon by Defendants as part of their advice-of-counsel defense [sic].
4. Defendants shall review their privilege logs (Exhibits J, K and L attached to Plaintiff's Motion to Compel) and produce to Plaintiff those documents, if any, which fall within the scope of the waiver outlined above.
5. Plaintiff shall not take the depositions of Mr. Bruce Cazanave or Mr. Jeffrey Cartwright.
6. Any depositions taken of Messrs. Taylor, Ster, Weisenthal, Reynolds, or Balensiefer will be strictly limited in scope in accordance with the limited waiver of the attorney-client privilege as set forth above.

Oct. Order, at 1-2.

On October 31, 2005, IMMI objected to the MJ Order arguing that the order was clearly erroneous and contrary to [*6] law because it held: (1) that the subject matter of Dorel's waiver did not include validity of the '889 patent; (2) that discovery of documents related to the opinion of counsel should be limited to the date that Dorel received notice of a cease and desist letter on April 23, 2004; and (3) that the work product waiver extended only to communications shared with Dorel that are "directly related to" the opinions of counsel. ¹

FOOTNOTES

¹ There were other allegations of error, however, they are inextricably intertwined the these three decisions and were not specifically addressed by the instant motion. Therefore, the Court limits the current discussion to these three allegations of error in the MJ Order, and subsequently, the Court's resolution of those issues in February 2006.

On February 16, 2006, the Court issued its order on IMMI's objections to the MJ Order. The Feb. Order held, in relevant part:

- (1) that the scope of the waiver did not extend to counsel's opinion regarding validity because there is no evidence [*7] that Dorel relied upon same in its assertion of non-infringement;
- (2) that the scope of the waiver did not extend beyond the filing of the instant law suit because there is no evidence to suggest that Dorel changed its non-infringement arguments post-filing and the danger of using the attorney-client

and work-product privileges as a sword was minimal under the circumstances of this case; and

(3) that the scope of the work product waiver extended only to communications with the client, unless those communications precluded IMMI from discovering the factual basis for the opinions themselves, in which case the Court concluded these work-product documents were included in the waiver.

On April 3, 2006, Dorel filed a Motion for Summary Judgment on IMMI's Claims of Willful Infringement, to which IMMI filed a response on May 8, 2006.

On May 1, 2006, the Federal Circuit issued its opinion in *EchoStar*. Shortly thereafter, on May 12, 2006, IMMI filed the motion at issue here. In the instant motion, IMMI contends that *EchoStar* changed the law on the scope of the waiver of attorney-client and work-product privileges in willfulness-related discovery and, therefore, before [*8] further briefing occurs on Dorel's Motion for Summary Judgment on IMMI's Willful Infringement Claim, the Court should reconsider its prior ruling on the issue.

IMMI contends that *EchoStar* held: (1) that it is improper to limit the temporal scope of the waiver to pre-suit communication; (2) that the work-product waiver extends to any attorney documents that reference or describe a communication with the client; (3) that the Court should review *in camera* any documents in which there is a question whether material should be redacted; and (4) that the scope of the waiver includes any documents or opinions that embodies or discusses a communication to or from it concerning whether that patent is valid, enforceable, and infringed by the accused, and is not dependent upon what the accused infringer actually relied upon. In light of this interpretation of *EchoStar*, IMMI asserts that the Court's Feb. Order conflicts with the holdings in *EchoStar* because it limits the temporal scope of the waiver to the date the complaint was filed, July 1, 2004, although ongoing infringement continued until the patent expired on December 17, 2005, because it limits the work product waiver to [*9] documents "actually communicated" to the client, because it requires no *in camera* inspection of redacted documents, and because it limits the privilege waiver based on the alleged infringer's position as to which opinion it relied upon.

Dorel contends that IMMI has read *EchoStar* too broadly and that it is distinguishable on its facts. Moreover, Dorel contends that the Court's Feb. Order correctly applied the law of waiver even *post-EchoStar* and, in any event, the Court must consider in this case the circumstances presented where opinion counsel and trial counsel are one and the same.

II. STANDARD

^{HN1} A motion to reconsider is appropriate where there is "a controlling or significant change in the law or facts since the submission of the issue to the Court." *Bank of Waunakee v. Rochester Cheese Sales, Inc.*, 906 F.2d 1185, 1191 (7th Cir. 1990). As the Court's Feb. Order was interlocutory in nature, it may be reconsidered at any time prior to final judgment. See *Matter of 949 Erie St., Racine Wis.*, 824 F.2d 538, 541 (7th Cir. 1987) (citing *Cameo Convalescent Ctr., Inc. v. Percy*, 800 F.2d 108 (7th Cir. 1986)). A court may, [*10] however, decline to reconsider an issue already decided under the "law of the case" doctrine. *Id.* at 541-2 (citing *Messenger v. Anderson*, 225 U.S. 436, 32 S. Ct. 739, 56 L. Ed. 1152 (1912)).

III. DISCUSSION

The first issue for the Court is whether or not *EchoStar* was a controlling or significant change

in the law; IMMI contends that it was, Dorel asserts it was not. The Court finds that the *EchoStar* decision clarified issues left undecided by the Federal Circuit's *en banc* decision in *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337 (Fed. Cir. 2004), and that the clarification has some effect on the decisions made by the Court in its Feb. Order.

A review of the facts in *EchoStar*, as presented by the Federal Circuit, is warranted. The Federal Circuit recites the following background facts:

TiVo sued EchoStar for infringement of its U.S. Patent No. **6,233,389** ("the '389 patent"). In response to the allegation of willful infringement, EchoStar asserted the defense of reliance on advice of counsel. Prior to the filing of the action, EchoStar relied on advice of in-house counsel. After the action was filed, EchoStar obtained [*11] additional legal advice from Merchant & Gould but elected not to rely on it. Presumably to explore further EchoStar's state of mind in determining that it did not infringe the patent, TiVo sought production of documents in the possession of EchoStar and Merchant & Gould. The district court held that by relying on advice of in-house counsel EchoStar waived its attorney-client privilege and attorney work-product immunity relating to advice of any counsel regarding infringement, including Merchant & Gould. The district court indicated that the scope of the waiver included communications made either before or after the filing of the complaint and any work product, whether or not the product was communicated to EchoStar. The district court also held that EchoStar could redact information related only to trial preparation or information unrelated to infringement. EchoStar produced communications, including two infringement opinions from Merchant & Gould, but did not produce any work product related to the Merchant & Gould opinions.

* * *

The district court issued an order that clarified its previous order and stated that the waiver of immunity extended to all work product of Merchant [*12] & Gould, whether or not communicated to EchoStar. The district court determined that the documents could be relevant or lead to the discovery of admissible evidence because they might contain information that was conveyed to EchoStar, even if the documents were not themselves conveyed to EchoStar. EchoStar petitions this court for a writ of mandamus with respect to the Merchant & Gould documents not provided to EchoStar, challenging the district court's rulings.

EchoStar, 2006 U.S. App. LEXIS 11162, 2006 WL 1149528 at Part I. (footnotes omitted).

The *EchoStar* court applied the law of the Federal Circuit to the substantive questions of the scope of the waiver of attorney-client privilege and work-product immunity in the advice-of-counsel defense context. *Id.* at Part III. The Court addressed the scope of the attorney-client waiver first because EchoStar argued that its reliance on in-house counsel is different subject matter from an outside opinion of counsel. To address this argument, the *EchoStar* court reiterated that^{HN2} "the widely applied standard for determining the scope of a waiver of attorney-client privilege is that the waiver applies to all of other communications relating [*13] to the same subject matter." *Id.* Part III.A. (quoting *Fort James Corp. v. Solo Cup Co.*, 412 F.3d 1340, 1349 (Fed. Cir. 2005)). The *EchoStar* court stated that EchoStar's argument was without merit. It held that "when EchoStar chose to rely on the advice of in-house counsel, it waived the attorney-client privilege with regard to any attorney-client communications relating to the same subject matter, including communications with counsel other than in-house counsel, which would include communications with Merchant & Gould." *Id.* (citing *Akeva LLC v. Mizuno Corp.*, 243 F. Supp.

2d 418, 423 (M.D.N.C. 2003)).

The *EchoStar* court next addressed whether the district court's order was too broad when it included "within the waiver's scope documents that were never communicated from Merchant & Gould (the attorney) to EchoStar (the client)." *Id.* Part III.B. The *EchoStar* court relied on traditional work-product immunity waiver law to decide this issue starting with Federal Rule of Civil Procedure 26(b). The court stated:

^{HN3} ¶ In contrast to the attorney-client privilege, the work-product doctrine, [*14] or work-product immunity as it is also called, can protect "documents and tangible things" prepared in anticipation of litigation that are both non-privileged and relevant. Fed. R. Civ. P. 26(b)(3). Unlike the attorney-client privilege, which protects all communication whether written or oral, work-product immunity protects documents and tangible things, such as memorandums, letters and e-mails. See generally Judicial Watch, Inc. v. Dep't of Justice, 369 U.S. App. D.C. 49, 432 F.3d 366 (D.C. Cir. 2005). We recognize work-product immunity because it promotes a fair and efficient adversarial system by protecting "the attorney's thought processes and legal recommendations" from the prying eyes of his or her opponent.

* * *

^{HN4} ¶ Like the attorney-client privilege, however, the work-product doctrine is not absolute. See In re Martin Marietta Corp., 856 F.2d 619, 626 (4th Cir. 1988). First, a party may discover certain types of work product if they have "substantial need of the materials in preparation of the party's case and that the party is unable without undue hardship to obtain the substantial equivalent . . . by other means." Rule [*15] 26(b)(3). . . .

Second, a party may discover work product if the party waives its immunity. [citations omitted] However, work product waiver is not a broad waiver of all work product related to the same subject matter like the attorney-client privilege. Martin Marietta Corp., 856 F.2d at 626. Instead, work-product waiver only extends to "factual" or "non-opinion" work product concerning the same subject matter as the disclosed work product. See *id.* at 625 (noting that a party "impliedly waived the work-product privilege as to all non-opinion work-product on the same subject matter as that disclosed.") (citing [sic] [United States v. Nobles], 422 U.S. [225,] 239, 95 S. Ct. 2160, 45 L. Ed. 2d 141 [1975]).

We recognize that ^{HN5} ¶ the line between "factual" work product and "opinion" work product is not always distinct, especially when, as here, an attorney's opinion may itself be "factual" work product. When faced with the distinction between where that line lies, however, a district court should balance the policies to prevent sword-and-shield litigation tactics with the policy to protect work product.

Id.

When it applied this standard, [*16] the *EchoStar* court did so to three categories of work product at issue in the case before it:

- (1) documents that embody a communication between the attorney and client concerning the subject matter of the case, such as a traditional opinion letter; (2) documents analyzing the law, facts, trial strategy, and so forth that reflect the attorney's mental impressions but were not given to the client; and (3)

documents that discuss a communication between attorney and client concerning the subject matter of the case but are not themselves communicated to or from the client.

Id. The *EchoStar* court held that the first category of work product is discoverable. *Id.*

But in addressing the later two categories, the *EchoStar* court acknowledged that ^{HN6} "by asserting the advice-of-counsel defense to a charge of willful infringement, the accused infringer and his or her attorney do not give their opponent unfettered discretion to rummage through all of their files and pillage all of their litigation strategies." *Id.* Rather, a court must ensure that the "work-product waiver extends only so far as to inform the court of the infringer's state of mind." *Id.* (emphasis [*17] in original). Legal correctness of the opinion is not the issue, but whether the opinion is thorough enough to instill a belief in the infringer that a court may hold the patent not infringed. *Id.* "The overarching goal of waiver in such a case is to prevent a party from using the advice he received as both a sword, by waiving privilege to favorable advice, and a shield, by asserting privilege to unfavorable advice." *Id.* (citing *Fort James Corp.*, 412 F.3d at 1349; *Martin Marietta Corp.*, 856 F.2d at 626; *In re Sealed Case*, 219 U.S. App. D.C. 195, 676 F.2d 793, 818 (D.C. Cir. 1982)).

Therefore, the *EchoStar* court concluded that ^{HN7} work product that is never communicated to the client "provides little if any assistance to the court in determining whether the accused knew it was infringing, and any relative value is outweighed by the policies supporting the work-product doctrine." *Id.* However, in the third category of documents, there may be work-product material that would have bearing on what the accused infringer knew, but were never themselves communicated to the client. *Id.* Such communications, the *EchoStar* court concluded, "will [*18] aid the parties in determining what communications were made to the client and protect against intentional or unintentional withholding of attorney-client communications from the court." *Id.* The *EchoStar* court suggested that, if necessary, where there are several types of communication in one document, some of which requires redaction, "the district court may review such material *in camera*." *Id.*

Applying these holdings to the Court's Feb. Order, the Court finds that it must reconsider its ruling on the temporal scope of the waiver in this case and it must reconsider the scope of the work-product waiver. The Court declines to entertain IMMI's arguments with respect to the Court's decision to limit the waiver to documents reflecting opinions of counsel on infringement as the Court does not agree with IMMI that the *EchoStar* opinion squarely addressed that issue.

With respect to the temporal scope of the waiver, the Court decided that in determining the temporal scope of the waiver, the Court should consider the circumstances of the case and, consistent with the principle of fairness, ensure that a party not be allowed to rely on self-serving statements while withholding [*19] contradictory information under the pretense of attorney-client or work-product privilege. In making this balance, the Court found that there was no evidence that Dorel had changed its position on infringement at any time either prior to or post filing. Because Dorel had been consistent in its contentions on non-infringement, there was no reason to extend the waiver post filing.

Even in light of the *EchoStar* opinion, the Court does not change its opinion in this case. The *EchoStar* court opined that even post filing attorney-client privileged and work-product privileged information that has bearing on the question of willful infringement is discoverable. However, the *EchoStar* opinion made such a ruling in the context of discovery from an outside attorney who had provided opinion on the infringement issue after suit. There is no indication that the *EchoStar* court intended to extend this waiver to communication of trial counsel or to work product of trial counsel. In fact, that issue was not before the Court. The facts of this case are different. There is no allegation in this case that Dorel received

additional advice of counsel post filing, other than advice from counsel [*20] in the course of litigation.

Even if the *EchoStar* opinion is read to have held that discovery of post-filing privileged information regardless of its source, and the Court recognizes that such an argument could have merit, ² the *EchoStar* court appears to agree with this Court that a balancing of the need for discovery with the need to protect attorney-client and work-product privilege communications and/or documents is necessary. In the instant case, there is no evidence that discovery of post-filing attorney-client privileged or work-product privileged documents would uncover anything contrary to the opinions provided prior to trial. In such a case, the information would be cumulative and its probative value would be outweighed by the policies protecting attorney-client privileged and work-product privileged information. As such, the Court is unwilling to broaden the temporal scope of the waiver post filing in this case.

FOOTNOTES

² 2The *EchoStar* court paints with a broad brush when discussing the temporal scope of the waiver in this case and cites *Akeva LLC v. Mizuno Corp.*, 243 F. Supp. 2d 418 (M.D.N.C. 2003), in support of its holding that the Merchant & Gould documents at issue in the case were discoverable. The *Akeva* court found that even the opinions of trial counsel on the infringement issue were discoverable. *Id.* at 423. But, *Akeva* never addressed the question of work product, only attorney-client privilege. *Id.* at 423 n.6.

As the Court explained in its prior order, there is merit in extending the temporal scope of the waiver beyond filing of the suit in cases where there is a fear that post-filing non-infringement opinions, whether they be of trial counsel, in-house counsel, or third-party outside counsel, differ from those pre-filing and have bearing on the reasonableness of the alleged infringer's reliance on advice of counsel. However, the Court does not agree with IMMI that the *EchoStar* case holds that the temporal scope of the waiver always extends post filing.

[*21] With respect to the scope of the work-product privilege waiver, the Court finds that according to *EchoStar*, the Court's prior definition was too narrow. The Court did concern itself with the documents relied upon by opinion counsel that may not have been disclosed to the client, however, the Court did not address documents that reflect conversations or communications with the client that were never disclosed to the client. It is this later category of documents that the Federal Circuit in *EchoStar* clearly stated were discoverable. As such, the Court's Feb. Order must be modified to include discovery of such documents, pre-filing, in this case.

IV. CASE MANAGEMENT PLAN DEADLINES GOING FORWARD

The Court recognizes that both parties are interested in keeping the current August 21, 2006, trial date for any issues that will remain in this matter after the Court rules on the multiple pending summary judgment motions. Therefore, the parties shall follow this schedule regarding the additional discovery allowed by this order:

1. Defendant shall supplement its discovery on or before Friday, June 2, 2006. If there are questionable documents, they shall be submitted [*22] to the Court for *in camera* inspection on or before Thursday, June 1, 2006.
2. Plaintiff shall have to and including Monday, June 12, 2006, to complete any supplemental depositions that are required.

3. Plaintiff shall have to and including Friday, June 16, 2006, to submit any supplemental response to Defendant's Motion for Summary Judgment on IMMI's Willful Infringement Claim.

4. Defendant's reply on its Motion for Summary Judgment on IMMI's Willful Infringement Claims shall be due on or before Wednesday, June 28, 2006.

Any currently-pending briefing deadlines on the pending motions for summary judgment are hereby vacated.

V. CONCLUSION

For the foregoing reasons, plaintiff's, Indiana Mills & Manufacturing, Inc., Emergency Motion for Reconsideration of February 16, 2006, Order on Plaintiffs Objection to Magistrate Judge's Order Regarding Willfulness-Related Discovery, is **GRANTED in part and DENIED in part**. Defendant's, Dorel Industries, Inc. and Dorel Juvenile Group, Inc., Motion for Extension of Time to File Reply is **GRANTED**. The parties shall proceed as directed in this Order.

IT IS SO ORDERED this 26th day of May, 2006.

LARRY J. [*23] MCKINNEY, CHIEF JUDGE

United States District Court

Southern District of Indiana







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2005 U.S. Dist. LEXIS 42481, *

TIVO INC., Plaintiff, v. ECHOSTAR COMM. CORP.; et al., Defendants.

CIVIL ACTION NO. 2:04-CV-1 (DF)

UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF TEXAS, MARSHALL
DIVISION

2005 U.S. Dist. LEXIS 42481

September 26, 2005, Decided

September 26, 2005, Filed

SUBSEQUENT HISTORY: Writ of mandamus granted [In re Echostar Communs. Corp., 448 F.3d 1294, 2006 U.S. App. LEXIS 11162 \(Fed. Cir., 2006\)](#)
Related proceeding at [Echostar Techs. Corp. v. TiVo, Inc., 2006 U.S. Dist. LEXIS 48431 \(E.D. Tex., July 14, 2006\)](#)

Findings of fact/conclusions of law at [TiVo Inc. v. Echostar Communs. Corp., 2006 U.S. Dist. LEXIS 64292 \(E.D. Tex., Aug. 17, 2006\)](#)

CORE TERMS: infringement, advice of counsel, infringer's, advice, discovery, work product, patent, waived, subject matter, post-filing, lawsuit, willfulness, state of mind, attorney-client, documentation, deposition, citations omitted, communicated, in-house, willful, reconsideration, trial strategy, internal investigation, non-infringement, disclosure, infringe, engineers, in camera, substantial part, work-product

COUNSEL: [*1] For TIVO Inc, a Delaware corporation, Plaintiff: Alexander C D Giza, Adam S Hoffman, Christine W S Byrd, Morgan Chu, Perry M Goldberg, Richard E Lyon, Irell & Manella LLP, Los Angeles, CA; Andrei Iancu, Irell & Manella -- Los Angeles, Los Angeles, CA; Samuel Franklin Baxter, Attorney at Law, Marshall, TX; Ben Yorks, Brian Jones, Michelle Armond, Irell & Manella -- Newport Beach, Newport Beach, CA; R Scott Feldmann, Randall I Erickson, Steven P Rice, Van V Nguyen, Crowell & Moring -- Irvine, Irvine, CA; Garret Wesley Chambers, McKool Smith -- Dallas, Dallas, TX.

For EchoStar Communications Corporation, a Nevada corporation, EchoStar DBS Corporation, a Colorado corporation, EchoStar Technologies Corporation, Echosphere Limited Liability Company, Defendants: Alison M Tucher, Jason A Crotty, Rachel Krevans, Robert M Harkins, Jr, Harold J. McElhinny, Morrison & Foerster LLP San Francisco, San Francisco, CA; Karl J Kramer, Morrison & Foerster -- Palo Alto, Palo Alto, CA; Damon Michael Young, Young Pickett & Lee, Texarkana, TX.

For "EchoStar defendants", Defendant: Scott F Llewellyn, Morrison & Foerster, Denver, CO; Emily A Evans, Karl J Kramer, Morrison & Foerster -- Palo Alto, [*2] Palo Alto, CA; Kristina Paszek, Robert M Harkins, Jr, Alison M Tucher, Harold J. McElhinny, Morrison & Foerster LLP

San Francisco, San Francisco, CA; John Michael Pickett, Young Pickett & Lee, Texarkana, TX.

For Merchant & Gould, Subpoena recipient, Movant: Charles Conrow Murphy, Jr, Vaughan & Murphy, Atlanta, Ga.

For EchoStar Technologies Corporation, Echosphere Limited Liability Company, Counter Claimants: Alison M Tucher, Jason A Crotty, Robert M Harkins, Jr, Morrison & Foerster LLP San Francisco, San Francisco, CA; Karl J Kramer, Morrison & Foerster -- Palo Alto, Palo Alto, CA; Damon Michael Young, Young Pickett & Lee, Texarkana, TX.

For TIVO Inc, a Delaware corporation, Counter Defendant: Adam S Hoffman, Irell & Manella LLP, Los Angeles, CA.

For Echostar Communications Corporation, a Nevada corporation, Echostar DBS Corporation, a Colorado corporation, Counter Claimants: Alison M Tucher, Jason A Crotty, Robert M Harkins, Jr, Morrison & Foerster LLP San Francisco, San Francisco, CA; Karl J Kramer, Morrison & Foerster -- Palo Alto, Palo Alto, CA.

For Echostar Satellite LLC, Counter Claimant: Karl J Kramer, Morrison & Foerster -- Palo Alto, Palo Alto, CA. **[*3]**

JUDGES: DAVID FOLSOM, UNITED STATES DISTRICT JUDGE.

OPINION BY: DAVID FOLSOM

OPINION

INTRODUCTION

Before the Court are Plaintiff TiVo's Objections Regarding the Temporal Scope of the August 17, 2005 Order which Defendant EchoStar opposes. Also before the Court is EchoStar's Motion for Reconsideration of the Court's Order of September 12, 2005, attaching Defendant's Protective Motion for Reconsideration of the Court's Order of August 17, 2005 which was previously decided by Magistrate Judge McKee. The Court considers these pleadings, however styled, competing motions for reconsideration of Magistrate Judge McKee's August 17, 2005 Order and the related September 12, 2005 Order.

I.

BACKGROUND

A. Factual Background

TiVo alleges that EchoStar willfully infringes U.S. Patent No. **6,233,389** ("389 patent"). TiVo argues that EchoStar has asserted an "advice of counsel" defense to this charge, having disclosed that it will rely on the non-infringement conclusions reached prior to the filing of this lawsuit by its in-house counsel, Kerry Miller. On June 16, 2005, shortly before the July 7, 2005 close of discovery, EchoStar for the first time disclosed that it planned to **[*4]** have Mr. Miller testify regarding his infringement investigation and the opinions he derived therefrom. TiVo argues this was an "eleventh hour" disclosure designed to inhibit TiVo's ability to seek discovery while EchoStar responds that the disclosure was timely per the parties' agreement. Dkt. Nos. 246 at 2 and 299 at 3.

EchoStar maintains that, shortly after the 389 patent issued, Mr. Miller worked with several

EchoStar software and engineering employees to analyze EchoStar's potential infringement of the '389 patent. Dkt. No. 299 at 1-2. These EchoStar employees concluded that EchoStar did not infringe the patent. *Id.* EchoStar plans to call Mr. Miller to testify regarding this opinion at trial.

In addition to the infringement analysis conducted by Mr. Miller, EchoStar sought opinions of counsel from Bozicevic, Field & Frances, LLP, in 2001 and from the Merchant & Gould law firm after this lawsuit was filed. EchoStar maintains that it has not waived privilege regarding these opinions and/or communications because by relying on "an internal investigation [] conducted by a group of engineers and a single in-house lawyer . . . [its] defense rests on the premise that it [*5] looked at the patent's claims and at the features of its own products and itself identified a number of differences that meant it was not infringing." Dkt. No. 337 at 2. Planning to rely upon "its internal investigation conducted in substantial part by engineers," EchoStar argues it is not asserting a "traditional 'advice of counsel' defense." Dkt. No. 162 at 5. Thus, it has not waived any privilege or work product protection. EchoStar further argues that, if the Court is to conclude that privilege has been waived, the waiver applies only to pre-litigation materials.

EchoStar admits it commissioned an opinion of counsel from the Bozicevic firm but maintains that it did not pursue a final opinion in light of Mr. Miller's analysis. *Id.* The Bozicevic firm apprised Mr. Miller orally that it would prepare an opinion letter that concluded EchoStar did not infringe the '389 patent, but the opinion was never finished. See Miller Depo. Tr. at 23:14-24:3. Soon after the lawsuit was filed, however, the Bozicevic firm turned over a draft opinion and a number of notes created in the course of its infringement analysis. EchoStar argues that because it did not receive this documentation [*6] from the firm until after the lawsuit was filed, the documentation should be considered "post-filing" material outside the scope of any waiver.

EchoStar further maintains that Merchant & Gould was hired to provide legal advice only after the lawsuit was filed, and that EchoStar has not waived privilege as to the two opinion letters that firm prepared. Mr. Miller admitted in deposition, however, that he has read both of the opinions drafted by the firm. Miller Depo. Tr. at 18:1-9.

TiVo argues that, having decided to assert the "advice of counsel" defense in response to the willfulness charge, EchoStar has waived privilege to all subject matter related to this defense. Therefore, TiVo seeks discovery of both post-filing and pre-filing opinions and communications.

TiVo has also requested leave from the Court to take depositions of all witnesses, including counsel, that TiVo identifies as potentially having testimony regarding the advice of counsel defense. EchoStar objects to this request, in part, on the basis that the parties previously agreed to limit the amount of deposition time each would be allotted, and TiVo has already used its time.

B. Procedural History

Pursuant [*7] to the provisions of 28 U.S.C. § 636(b)(1) and (3) and the Amended Order for the Adoption of Local Rules for Assignment of Duties to United States Magistrate Judges dated January 15, 1994, TiVo's motion to compel discovery on the advice of counsel defense was referred to the Honorable Harry McKee for the purposes of hearing and determining said motion. Dkt. No. 160; see also Dkt. No. 150. On August 15, 2005, Judge McKee held a telephone conference to consider TiVo's motion and EchoStar's opposition. In his Order of August 17, 2005 ("August 17 Order"), Judge McKee found that EchoStar "waived the attorney client privilege as to all communications related to the patent in suit that occurred before TiVo initiated this action, but not as to any subsequent communications or opinions." Dkt. No. 177. Based on this finding, Judge McKee ordered EchoStar to produce "all such

documents created before suit was filed, and make available any witnesses with knowledge of relevant pre-suit communications." *Id.*

EchoStar moved for clarification and then for reconsideration of the August 17 Order arguing that the scope of its waiver, if any, regarding the advice of counsel [*8] defense was not so broad as to allow for the discovery ordered. Dkt. Nos. 216 and 245. TiVo responded to the motion to clarify and EchoStar replied. Dkt. Nos. 233 and 234, respectively.

Judge McKee again heard from the parties and then issued an order on September 12, 2005. ("September 12 Order"). He found that EchoStar's reliance on Mr. Miller's non-infringement testimony waived privilege/work product protection but the scope of the waiver extended only to the subject matter of the advice. "[T]herefore, EchoStar has waived privilege as to advice received concerning infringement, but TiVo may not discover any privileged information relating to the issue of validity." September 12 Order at 1-2.

Judge McKee also found that EchoStar's waiver extended to documentation concerning EchoStar's infringement of TiVo's '389 patent created by the Bozicevic firm. Although EchoStar received no formal written opinion from the firm, it received an oral opinion prior to filing and received the documentation developed to arrive at that opinion shortly after TiVo filed this lawsuit. Thus, Judge McKee found it was "reasonable to believe that the contents of the notes were communicated, to some degree, [*9] to EchoStar before suit was filed." September 12 Order at 2.

EchoStar was ordered to produce the Bozicevic firm's draft opinion as well as notes created in developing its opinion concerning infringement of the '389 patent. EchoStar was also ordered to produce any remaining documents pertaining to advice it received from counsel before suit was filed concerning infringement of the '389 patent. *Id.* at 2. Further, TiVo was allowed to depose each of the two attorneys that created the draft opinion and notes. *Id.* at 2-3.

EchoStar now moves for reconsideration of both the August 17 Order and the September 12 Order. EchoStar first argues that its reliance on Mr. Miller's opinion does not result in any privilege or work product protection waiver. Second, EchoStar argues that, if there has been waiver, the notes and communications with the Bozicevic firm not in EchoStar's possession at the time the lawsuit was filed are outside the scope of this waiver. Further, EchoStar takes issue with the order to make additional witnesses available for deposition. To the contrary, TiVo requests that the Court broaden Judge McKee's orders to permit TiVo to engage in discovery concerning the advice [*10] of counsel EchoStar received both pre-and post-filing. Dkt. Nos. 246, 299, and 302.

II.

DISCUSSION

This Court may set aside or modify the Magistrate Judge's order only if the order was based on a clearly erroneous finding of fact or if it was contrary to law. *See* 28 U.S.C. 636(b)(1)(A). As explained below, the Court concludes that findings in the Magistrate Judge's August 17 Order and the related September 12 Order were clearly erroneous.

"For good cause, the court may order discovery of any matter relevant to the subject matter involved in the action." *Fed.R.Civ.P. 26(b)(1)(2002)*. While the scope of discovery under this rule is broad, it is far from unlimited. The rule requires a district court, when considering a motion to compel, to determine whether the material sought is relevant to the subject matter of the litigation. The court must prevent discovery from being used as a fishing expedition. In addition to limiting discovery to material relevant to the subject matter of the litigation, *Rule 26* provides for further limitations. A court may limit discovery when it is "obtainable from some other source [*11] that is more convenient, less burdensome, or less expensive."

Fed.R.Civ.P. 26(b)(2)(2002). In addition, discovery should not be allowed when "the burden or expense of the proposed discovery outweighs its likely benefit." Fed.R.Civ.P. 26(b)(2)(2002).

The issues presented by the present motions are (1) the waiver of attorney-client privilege and work-product protection and (2) the scope of any such waiver. As an initial matter, the advice of counsel defense and the disclosure of an infringement opinion appears to fall within the realm of subjects "unique to patent cases," for which Federal Circuit law is controlling. See *In re Spalding Sports Worldwide Inc.*, 203 F.3d 800, 803-04 (Fed. Cir. 2000); *Sharper Image Corp. v. Honeywell Intern., Inc.* 222 F.R.D. 621, 625 n. 3 (N.D. Cal. 2004). However, the Federal Circuit has found, in context other than the advice of counsel defense, that privilege/work product protection waiver is a procedural matter for which the law of the regional circuit is applied. *In re Pioneer Hi-Bred Int'l, Inc.*, 238 F.3d 1370, 1374 (Fed. Cir. 2001). [*12] There is a split of authority among the district courts as to whether the scope of waiver resulting from the advice of counsel defense is a matter unique to patent law or a matter to be determined by precedent from the regional circuit courts. *Intex Rec. Corp. v. Metalast, S.A.*, 2005 U.S. Dist. LEXIS 10149, *7-9 (D.D.C. March 2, 2005)(internal citations omitted). Finding that the scope of privilege/work product protection waiver as it relates to the advice of counsel defense to a willful infringement charge is an issue "unique to patent cases," this Court will look to Federal Circuit decisions regarding the defense. See *Intex Rec. Corp.*, 2005 U.S. Dist. LEXIS 10149, *8-9.

Willfulness is a factual determination made based on the totality of the circumstances. *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337, 1343 (Fed. Cir. 2004) (en banc), see also *Am. Med. Sys., Inc. v. Med. Eng'g Corp.*, 6 F.3d 1523, 1530 (Fed. Cir. 1993). The Federal Circuit has identified a non-exclusive list of factors to assist the trier of fact in determining whether a putative infringer has engaged in willful infringement; [*13] on the list is whether an accused infringer, with knowledge of a patent, investigated the scope of the patent and formed a good-faith belief it was invalid or not infringed. *Read Corp v. Portec, Inc.*, 970 F.2d 816, 826-28 (Fed. Cir. 1987). These factors, along with any other relevant factors or circumstances, weigh in a fact-finder's determination of whether the accused infringer had a good-faith belief of non-infringement. Because willfulness is a question of the infringer's state of mind, the primary focus of the inquiry is on the reasonableness of the infringer's beliefs and actions. *Ortho Pharm. Corp. v. Smith*, 959 F.2d 936, 944 (Fed. Cir. 1992); *Am. Med.*, 6 F.3d at 1523, 1531 (Fed. Cir. 1993).

In a recent Federal Circuit decision, *Knorr-Bremse Systeme Fur Nutzfahrzeuge GmbH v. Dana Corp.*, the court reversed its established precedent by holding that "an alleged infringer's failure to obtain or produce an exculpatory opinion of counsel" no longer creates an adverse inference that an opinion was, or would have been, unfavorable. 383 F.3d 1337, 1341 (Fed. Cir. 2004) (en banc). Prior to this opinion, an accused infringer [*14] all but had to produce an opinion of counsel, which in turn waived privilege. *Id.* at 1345. In *Knorr-Bremse*, the Federal Circuit effectively created a choice for defendants: "A defendant may of course choose to waive the privilege and produce the advice of counsel. However, the assertion of attorney-client and/or work-product privilege and the withholding of the advice of counsel shall no longer entail an adverse inference as to the nature of the advice." *Id.*

The scope of the privilege waived when a defendant chooses to rely on the advice of counsel, however, remains unresolved and has produced varying opinions. As Judge Brazil recently explained:

While the courts generally agree that a defendant who invokes the "advice of counsel" defense to a claim of willfulness waives the protections of the attorney-client privilege for communications that occurred before the suit was filed and that relate to the subjects addressed in the invoked advice, there is considerable division of opinion about how far (if at all) the waiver extends to work product

that counsel generated before the suit was filed but did not share with the defendant. . . . There also are [*15] sharp divisions of opinion about whether any waiver reaches into the period after the defendant was served with the complaint.

Sharper Image Corp. v. Honeywell Intern., Inc. 222 F.R.D. 621, 625 n. 4 (N.D. Cal. 2004) (internal citation omitted). Not surprisingly, these are precisely the issues involved here.

The scope of privilege/work product waiver, once an advice of counsel defense is asserted, should be guided by fairness. See *Intex Rec. Corp.*, 2005 U.S. Dist. LEXIS 10149, *10-13; *Saint-Gobain/Norton Indus. Ceramics Corp., v. GE*, 884 F. Supp. 31, 33 (D. Mass. 1995). An accused infringer "is not required to rely upon advice of counsel as a defense against [a] claim of willful infringement; however, if an alleged infringer [] elects to defend against a charge of willful infringement by producing an opinion of counsel to the patentee, [] any privilege over that advice and related subjects is waived." *Texas Instruments, Inc. v. Hyundai Elec. Indus., Co. Ltd.*, 1999 U.S. Dist. LEXIS 21523, at *5-6 (E.D. Tex. Mar. 5, 1999) (Heartfield J.) (citing *Rolls-Royce Ltd. v. GTE Valeron Corp.*, 800 F.2d 1101, 1109-10 (Fed. Cir. 1986)). [*16] "Considerations of fairness require that a litigant should not be able to claim reliance on advice of counsel as a defense, and hence a sword in litigation, while at the same time asserting attorney-client privilege or work product doctrine as a shield to protect against the opposing party testing the legitimacy of that claim." *Intex Rec. Corp.*, 2005 U.S. Dist. LEXIS 10149, *10-11 (citations omitted).

A. The Extent of Waiver to Post-Filing Communications

In *Convolve, Inc. v. Compaq Computer Corp.*, 224 F.R.D. 98 (S.D. N.Y. 2004), the court found that waiver of the privilege "should extend from the time [the defendant] became aware of the plaintiffs' patents until such time in the future that [the defendant] ceases its alleged infringement." *Id.* at 104. The rationale underpinning such broad privilege waiver is that as long as the alleged infringement continues so does an alleged infringer's duty to exercise due care and to seek the advice of counsel. As one court has stated:

The waiver of attorney-client privilege or work product protection does not . . . exist solely at a particular point of time, such as when [*17] the client receives the opinion from counsel. As recognized by the Federal Circuit in [*Crystal Semiconductor Corp. v. Tritech Microelectronics Int'l, Inc.*, 246 F.3d 1336 (Fed. Cir. 2001)] because infringement is a continuing activity, the requirement to exercise due care and seek and receive advice is a continuing duty. Therefore, once a party asserts the defense of advice of counsel, this opens to inspection the advice received during the entire course of the alleged infringement. Consequently, the waiver of attorney-client privilege or work product protection covers all points of time, including up through trial. The waiver also is not limited to the advice given by opinion counsel. Since the waiver encompassed the subject matter of advice, that means that all opinions received by the client must be revealed, even those opinions the client receives from attorneys other than opinion counsel. Practical reasons exist for this rule. The exercise of due care requires a potential infringer to act reasonably. The infringer may not pick and choose between what opinions will be relied upon and which will be discarded. The totality of the circumstances test requires that [*18] all knowledge gained by the infringer relating to the advice subject matter must be revealed so that the factfinder can make its own determination as to whether the reliance was reasonable.

AKEVA LLC v. Mizuno Corp., 243 F. Supp. 2d 418, 423 (M.D.N.C. 2003) (citations omitted).

On the other side of the spectrum, some courts have found that waiver extends only to materials before litigation ensued. See, e.g., *Motorola, Inc. v. Vosi Techs., Inc.*, 2002 U.S. Dist. LEXIS 15655, 2002 WL 1917256, *2 (N.D.Ill.2002) (limiting waiver to communications that preceded the filing of the suit); *Carl Zeiss Jena GmbH v. Bio-Rad Lab. Inc.*, 2000 U.S. Dist. LEXIS 10044, 2000 WL 1006371, *2 (S.D.N.Y.2000) (same); and *Dunhall Pharms., Inc. v. Discus Dental, Inc.*, 994 F.Supp. 1202, 1206 (C.D.Cal. 1998) (same). In *Dunhall*, the court stated: "Once the lawsuit is filed, the waiver of work product protection ends. This temporal limitation follows from the enhanced interest in protecting against disclosure of trial strategy and planning." *Dunhall Pharms. Inc.*, 994 F. Supp. at 1206.

Following this logic, discovery of infringement opinions arrived at by trial counsel may [*19] be denied while discovery of infringement positions arrived at by opinion counsel may be allowed, regardless of whether arrived at pre-or post-filing. *Sharper Image Corp.*, 222 F.R.D. at 640-46. Where documents or communications may contain both information related to the advice of counsel defense as well as information related solely to trial strategy, in camera review may be necessary. See e.g. *Saint-Gobain*, 884 F. Supp. at 34 (considering but denying as unnecessary in camera review).

B. The Extent of a Defendant's Knowledge

Likewise, courts differ regarding whether to extend waiver to attorney work product that is not communicated to the client but is developed while analyzing potential infringement. As explained in *Simmons, Inc. v. Bombardier, Inc.*, "[a]n important factor in determining whether a defendant willfully infringed upon another's patent is the defendant's reasonable reliance upon a competent opinion of counsel. However, the alleged infringer's intent -- not that of counsel -- remains the relevant issue." 221 F.R.D. 4, 9 (D.D.C. 2004) (citation omitted). Based on this reasoning, several courts have refused [*20] discovery of work-product materials, such as counsel's notes or even draft opinions, that were never sent to the client. *Id.*; see also *Nitinol Med. Techs. Inc. v. AGA Med. Corp.*, 135 F. Supp. 2d 212, 218-19 (D. Mass. 2000).

Still, other courts have mandated production of all material regardless of whether they were disclosed, maintaining that the discovery of such information is necessary to uncover what the client was actually told by opinion counsel. See *Aspex Eyewear Inc. v. E'Lite Optik Inc.*, 276 F. Supp. 2d 1084, 1092-93 (D. Nev. 2003); *Novartis Pharms. Corp. v. EON Labs Mfg. Inc.*, 206 F.R.D. 396 (D. Del. 2002). In *Novartis*, the court stated, "it is critical for the patentee to have a full opportunity to probe, not only the state of mind of the infringer, but also the mind of the infringer's lawyer upon which the infringer so firmly relied." *Id.* at 399. The rationale behind this approach is that, by imposing broad waiver, the advice of counsel defense will only be invoked by "infringers who prudently and sincerely sought competent advice from competent counsel . . ." and "[m]oreover, focusing on the infringer's [*21] waiver rather than state of mind may reduce the chances of legal gamesmanship creeping into the practice of rendering infringement and validity opinions." *Id.* "[I]f negative information was important enough to reduce to a memorandum, there is a reasonable possibility that the information was conveyed in some form or fashion to the client." *Beneficial Franchise Co. Inc. v. Bank One N.A.*, 205 F.R.D. 212, 218 (N.D. Ill. 2001).

Refusing to presume deceit, however, other courts have rejected this approach and have limited waiver to those materials actually communicated to the client. See *Chimie v. PPG Indus. Inc.*, 218 F.R.D. 416, 420 (D. Del. 2003).

C. Application

It is clear that, by offering Mr. Miller's testimony, EchoStar has asserted an advice of counsel defense to willfulness. Mr. Miller, EchoStar's in-house counsel, met with EchoStar technical staff on no fewer than two occasions specifically to determine whether EchoStar products fell

within the scope of the '389 patent claims. 9/22/05 Hr. Tr. at (representations by EchoStar counsel). Based on his analysis of the patent and input from other EchoStar employees, Mr. Miller [*22] formed an opinion as to why EchoStar products did not infringe any claims in the '389 patent. *Id.* He communicated this opinion to other EchoStar executives who in turn relied upon Mr. Miller's opinion. *Id.* EchoStar maintains this was "an internal investigation conducted in substantial part by engineers." Dkt. No. 162 at 5. Though EchoStar argues Mr. Miller's opinion does not amount to a "traditional" opinion of counsel, EchoStar admits that Mr. Miller's is a legal opinion. *Id.* and 9/22/05 Hr. Tr. at (representations by EchoStar counsel).

In-house counsel, in conjunction with other in-house staff, are often called upon to investigate and render legal advice regarding the infringement or invalidity of a patent. See *Minn. Mining and Mfr. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559 (Fed. Cir. 1992); *Chiron Corp. v. Genentech, Inc.*, 268 F. Supp. 2d 1117 (E.D. Cal. 2002). Whether the resulting advice is relayed orally or in writing and whether the counsel rendering the advice is sufficiently independent to be considered objective goes to the competency of the opinion and the reasonableness of an accused infringer's [*23] reliance thereon -- not to whether or not the advice amounts to "advice of counsel." See *Minn. Mining and Mfr.*, 976 F.2d at 1580-81; *Chiron Corp.*, 268 F. Supp. 2d at 1121-1122. Mr. Miller's oral opinion amounts to advice of counsel -- and EchoStar's reliance on this advice in defense of the willfulness charge results in waiver. This conclusion cannot be circumvented by calling the opinion merely an "internal investigation conducted in substantial part by engineers." Dkt. No. 162 at 5. The scope of the resulting waiver is then determined by the subject matter that a party relies upon. Because Mr. Miller offers only a non-infringement opinion, as found in the September 12 Order, this is the scope of the subject matter waiver.

EchoStar had the benefit of choice, as explained by the Federal Circuit in *Knorr-Bremse Systeme Fur Nutzfahrzeuge GmbH v. Dana Corp.*, of whether to introduce Mr. Miller's opinion. But once EchoStar chose to introduce the opinion, it opened to inspection all related advice sought and developed regarding EchoStar's potential infringement of the '389 patent. Regardless of when the opinions or materials were transcribed or communicated [*24] to EchoStar, such information necessarily relates to the opinion being offered by Mr. Miller and goes to show EchoStar's state of mind with respect to willful infringement. This is particularly true where, as is the case here, EchoStar's willfulness witness was privy to the substance of the willfulness opinions developed by outside counsel both pre-and post-filing. Miller Depo. Tr. at 23:14-24:3 and 18:1-9.

The Court notes that EchoStar is under a continuing duty to act in good faith, and this duty extends to actions after the filing of the lawsuit. TiVo is thus entitled to determine EchoStar's state of mind with regard to its post-filing actions as well as its pre-filing actions, and the latter opinions of counsel may go directly to this issue. To here deny TiVo the opportunity to question Mr. Miller regarding post-filing opinions and how they affect or might have affected the conclusions he reached pre-filing would be unfair. Thus, this Court finds that the scope of Defendant's waiver extends to all pre-and post-filing communications pertaining to advice of counsel on the issue of EchoStar's potential infringement of the '389 patent.

To uphold EchoStar's right to protect its trial [*25] strategy, however, EchoStar will be allowed to redact information that it views as solely related to such strategy. This, in the Court's opinion, reconciles the fear that such discovery could compromise trial preparation and give Plaintiff an unfair advantage with Plaintiff's inquiry into state of mind.

III.

ORDER

The Court, having considered the motions, responses, and all other relevant pleadings and

papers, **ORDERS:**

EchoStar to produce all notes, communications, or other documentation relating to the infringement analysis of the '389 patent' undertaken by Bozicevic, Field & Frances, LLP, at any time; and

EchoStar to produce the two Merchant & Gould opinions and all notes, communications, or other documentation related to any infringement analysis of the '389 patent' undertaken by Merchant & Gould. EchoStar may redact any information that it considers unrelated to infringement or that it considers primarily related to trial strategy. EchoStar will produce copies of the redacted materials to TiVo and will submit both redacted and un-redacted copies of the material to the Court for in camera review. EchoStar is to produce these materials within seven (7) days of [***26**] this order.

The Court further **ORDERS:**

EchoStar to produce Frank Becking, Alan Cannon, Kerry Miller, Homer Knearl, and Timothy Scull for deposition concerning their analysis of the '389 patent' and any potential infringement by EchoStar. TiVo is granted an additional five (5) hours of deposition time; the allotment of this time per witness is left to TiVo's discretion. These witnesses are to be made available no later than October 14, 2005.

SIGNED this 26th day of September, 2005.

DAVID FOLSOM

UNITED STATES DISTRICT JUDGE







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TiVo Statement on Decision by U.S. Court of Appeals to Stay Permanent Injunction Issued by District Court in Lawsuit Against EchoStar PR Newswire US October 3, 2006 Tuesday 8:52 PM GMT

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October 3, 2006 Tuesday 8:52 PM GMT

LENGTH: 535 words

HEADLINE: TiVo Statement on Decision by U.S. Court of Appeals to Stay Permanent Injunction Issued by District Court in Lawsuit Against EchoStar

DATELINE: ALVISO, Calif. Oct. 3

BODY:

ALVISO, Calif., Oct. 3 /PRNewswire-FirstCall/ -- TiVo Inc. (NASDAQ:TIVO), the creator of and leader in television services for digital video recorders (DVR), today announced that U.S. Court of Appeals for the Federal Circuit granted the request of EchoStar Communications Corp. ("ECC") to stay the permanent injunction imposed by the U.S. District Court to prevent ECC from making, using, offering for sale or selling in the United States the DVR products involved in the case (DP-501, DP-508, DP-510, DP-721, DP-921, DP-522, DP-625, DP-942, and all EchoStar DVRs that are not more than colorably different from any of these products) pending the outcome of ECC's appeal.

TiVo sued EchoStar in Federal District Court on January 5, 2004, alleging that ECC and certain subsidiaries are violating a key TiVo patent (U.S. Patent No. **6,233,389** issued to TiVo in May 2001, known as the "Time Warp" patent). The Time Warp patent discloses systems and methods for the simultaneous storage and playback of programs, supporting advanced capabilities such as pausing live television, fast-forwarding, rewinding, instant replays, and slow motion. On April 13, 2006, a Marshall, Texas jury concluded that EchoStar had willfully infringed TiVo's Time Warp patent.

"We are confident that the jury's decision in TiVo's favor will be upheld once the Federal Circuit has the opportunity to review the entire record in this case. It is important to note that most injunctions in patent cases are stayed pending appeal, and the appeal itself will be decided on a totally different standard of review," stated the company.

About TiVo

Founded in 1997, TiVo pioneered a brand new category of products with the development of the first commercially available digital video recorder (DVR). Sold through leading consumer

electronic retailers, TiVo has developed a brand which resonates boldly with consumers as providing a superior television experience. Through agreements with leading satellite and cable providers, TiVo also integrates its full set of DVR service features into the set-top boxes of mass distributors. TiVo's DVR functionality and ease of use, with such features as Season Pass(TM) recordings and WishList(R) searches, has elevated its popularity among consumers and has created a whole new way for viewers to watch television. With a continued investment in its patented technologies, TiVo is revolutionizing the way consumers watch and access home entertainment. Rapidly becoming the focal point of the digital living room, TiVo's DVR is at the center of experiencing new forms of content on the TV, such as broadband delivered video, music and photos. With innovative features such as, TiVoToGo (TM) and online scheduling, TiVo is expanding the notion of consumers experiencing "TiVo, TV your way." The TiVo(R) service is also at the forefront of providing innovative marketing solutions for the television industry, including a unique platform for advertisers and audience measurement research. The company is based in Alviso, Calif.

CONTACT: Media, Whit Clay, +1-212-446-1864, or wclay@sloanepr.com ; or Investors, Derrick Nueman, +1-408-519-9677, or dnueman@tivo.com

Web site: <http://www.tivo.com/>

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M2 Presswire

August 18, 2006

LENGTH: 1335 words**HEADLINE:** [www.MarketGainer.com: Issues Updates on TiVo Inc](#)**BODY:**M2 PRESSWIRE-AUGUST 18, 2006-[www.MarketGainer.com: Issues Updates on TiVo Inc](#)
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Market Gainer is quickly emerging as the one stop shop for international small-cap investors looking to stay a step ahead of the markets. Today's activity on the Nasdaq exchange has brought TiVo Inc (NASDAQ:TIVO) to the attention of our research team. Our goal is to create a community of international investors who consistently and effectively capitalize on the enormous gains the small-cap Canadian and American exchanges offer.

Shares up \$1.29 out of the gate to a high of \$7.78 on the Nasdaq Friday. Momentum comes as TiVo Inc. (Nasdaq: TIVO - News), the creator of and a leader in television services for digital video recorders (DVR), today announced that U.S. District Court Judge David Folsom granted TiVo's motion for permanent injunction to prevent EchoStar Communications Corp. (Nasdaq: DISH; "ECC") from making, using, offering for sale or selling in the United States their DVR products at issue in the case (DP-501, DP-508, DP-510, DP-721, DP-921, DP-522, DP-625, DP-942, and all EchoStar DVRs that are not more than colorably different from any of these products). Judge Folsom also ordered ECC to pay TiVo approximately \$73.992 million in damages as awarded by the jury, prejudgment interest at the prime rate through July 31, 2006 of approximately \$5.638 million, and supplemental damages for infringement through July 31, 2006 in the amount of approximately \$10.317 million. Judge Folsom denied EchoStar's request to stay the injunction pending appeal. The injunction extends to all of ECC's affiliates, employees, agents and representatives, and any persons in active concert or participation with them who have notice of the order. The Judge's ruling is final and is appealable.

TiVo sued EchoStar in Federal District Court on January 5, 2004, alleging that ECC and certain subsidiaries are violating U.S. Patent No. **6,233,389** issued to TiVo in May 2001, known as the "Time Warp" patent. The Time Warp patent discloses systems and methods for the simultaneous storage and playback of programs, supporting advanced capabilities such as pausing live television, fast-forwarding, rewinding, instant replays, and slow motion. On April 13, 2006, a Marshall, Texas jury concluded that EchoStar had willfully infringed TiVo's Time Warp patent.

The company said, "TiVo is pleased that Judge Folsom has granted a permanent injunction against EchoStar's DVR products along with supplemental damages and interest. This decision recognizes that our intellectual property is valuable and will ensure that moving forward EchoStar will be unable to use our patented technology without our authorization.

"TiVo is built on a strong foundation of innovative technology and intellectual property. Beyond the U.S. Time Warp patent, we now hold more than 86 patents in our worldwide patent portfolio and have more than 138 patent applications pending. TiVo has a long list of licensees in the consumer electronics, cable and satellite markets, and we will continue to license our technology under appropriate circumstances and arrangements. We will also continue to vigorously defend our intellectual property for the benefit of our licensees and shareholders."

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This release contains "forward-looking statements" within the meaning of Section 27A of the Securities Act of 1933, as amended, and Section 21E the Securities Exchange Act of 1934, as amended and such forward-looking statements are made pursuant to the safe harbor provisions of the Private Securities Litigation Reform Act of 1995. "Forward-looking statements" describe future expectations, plans, results, or strategies and are generally preceded by words such as "may", "future", "plan" or "planned", "will" or "should", "expected," "anticipates", "draft", "eventually" or "projected". You are cautioned that such statements are subject to a multitude of risks and uncertainties that could cause future circumstances, events, or results to differ materially from those projected in the forward-looking statements, including the risks that actual results may differ materially from those projected in the forward-looking statements as a result of various factors, and other risks identified in a companies' annual report on Form 10-K or 10-KSB and other filings made by such company with the Securities and Exchange Commission.

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*TiVo: Court grants injunction, damages against EchoStar MarketWatch August 18, 2006
Friday 6:13 AM EST*

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MarketWatch

August 18, 2006 Friday 6:13 AM EST

LENGTH: 147 words**HEADLINE:** TiVo: Court grants injunction, damages against EchoStar**BYLINE:** Steve Goldstein**BODY:**

LONDON (MarketWatch) -- TiVo Inc. (tivo) said U.S. District Court Judge David Folsom granted TiVo's motion for a permanent injunction to prevent EchoStar Communications (dish) from making, using, offering for sale or selling in the United States their digital video recorder products. EchoStar will also have to pay over \$89.6 million in damages, TiVo said. TiVo sued EchoStar, alleging that ECC and certain subsidiaries are violating U.S. Patent No. **6,233,389** issued to TiVo in May 2001, known as the "Time Warp" patent. The Time Warp patent discloses systems and methods for the simultaneous storage and playback of programs, supporting advanced capabilities such as pausing live television, fast-forwarding, rewinding, instant replays, and slow motion.

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TiVo Statement on Order Granting Injunction Against EchoStar and Damages of Over \$89.6 Million PR Newswire US August 18, 2006 Friday 10:00 AM GMT

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August 18, 2006 Friday 10:00 AM GMT

LENGTH: 958 words

HEADLINE: TiVo Statement on Order Granting Injunction Against EchoStar and Damages of Over \$89.6 Million

DATELINE: ALVISO, Calif. Aug. 18

BODY:

ALVISO, Calif., Aug. 18 /PRNewswire-FirstCall/ -- TiVo Inc. (NASDAQ:TIVO), the creator of and a leader in television services for digital video recorders (DVR), today announced that U.S. District Court Judge David Folsom granted TiVo's motion for permanent injunction to prevent EchoStar Communications Corp. (Nasdaq: DISH; "ECC") from making, using, offering for sale or selling in the United States their DVR products at issue in the case (DP-501, DP-508, DP-510, DP-721, DP-921, DP-522, DP-625, DP-942, and all EchoStar DVRs that are not more than colorably different from any of these products). Judge Folsom also ordered ECC to pay TiVo approximately \$73.992 million in damages as awarded by the jury, prejudgment interest at the prime rate through July 31, 2006 of approximately \$5.638 million, and supplemental damages for infringement through July 31, 2006 in the amount of approximately \$10.317 million. Judge Folsom denied EchoStar's request to stay the injunction pending appeal. The injunction extends to all of ECC's affiliates, employees, agents and representatives, and any persons in active concert or participation with them who have notice of the order. The Judge's ruling is final and is appealable.

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This release contains certain forward-looking statements within the meaning of the Private Securities Litigation Reform Act of 1995. These statements relate to, among other things, TiVo's business, services, financial statements, future product strategy, and the impact of the EchoStar litigation. Forward-looking statements generally can be identified by the use of forward-looking terminology such as, "believe," "expect," "may," "will," "intend," "estimate," "continue," or similar expressions or the negative of those terms or expressions. Such statements involve risks and uncertainties, which could cause actual results to vary materially from those expressed in or indicated by the forward-looking statements. Factors that may cause actual results to differ materially include delays in development, competitive service offerings and lack of market acceptance, as well as the other potential factors described under "Risk Factors" in the Company's public reports filed with the Securities and Exchange Commission, including the Company's Annual Report on Form 10-K for the fiscal year ended January 31, 2006, as updated by subsequent Quarterly Reports on Form 10-Q and Current Reports on Form 8-K. The Company cautions you not to place undue reliance on forward-looking statements, which reflect an analysis only and speak only as of the date hereof. TiVo disclaims any obligation to update these forward-looking statements.


CONTACT: investors, Derrick Nueman of TiVo, +1-408-519-9677, or dnueman@tivo.com ; or media, Elliot Sloane, +1-212-446-1860, or esloane@sloanep.com , for TiVo

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