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15 UNITED STATES DISTRICT COURT
16 NORTHERN DISTRICT OF CALIFORNIA
17 SAN JOSE DIVISION

18 MICROSOFT CORPORATION,
19 a Washington corporation,

20 Plaintiff,

21 v.

22 TIVO INC., a Delaware corporation,

23 Defendant.

24 AND RELATED COUNTERCLAIMS.

Case No. 5:10-cv-00240-RS (PVT)

**MICROSOFT'S FIRST AMENDED
COMPLAINT**

JURY TRIAL DEMANDED

25
26 For its First Amended Complaint against Defendant TiVo Inc. ("Defendant" or "TiVo"),
27 Plaintiff Microsoft Corporation ("Microsoft") alleges as follows:
28

1 **Jurisdiction and Venue**

2 1. This is an action for patent infringement arising under the United States Patent
3 Act, 35 U.S.C. § 1, et seq. The Court has subject matter jurisdiction over the claims pleaded
4 herein under 28 U.S.C. §§ 1331 and 1338(a).

5 2. The Court has personal jurisdiction over Defendant TiVo because Defendant does
6 business in this District, maintains its corporate headquarters and principal place of business in
7 this District, and has committed acts of infringement in this District.

8 3. Under 28 U.S.C. §§ 1391 and 1400(b), venue is proper in this District because
9 Defendant is subject to personal jurisdiction in this District, has sold, offered to sell and/or
10 imported products and services at issue in and into this District and has committed acts of
11 infringement in this District.

12 **The Parties**

13 4. Microsoft is a corporation organized under the laws of the State of Washington,
14 with its principal place of business in Redmond, Washington and a place of business in this
15 District in Mountain View, California. Microsoft is a long-time leader in the development and
16 innovation of software technologies, including technologies for digital home entertainment.

17 5. Microsoft is informed and believes that: Defendant TiVo is a Delaware
18 corporation that maintains its principal place of business and corporate headquarters in this
19 District in Alviso, California. Defendant offers for sale, sells, distributes and imports products
20 and services in and into the United States for use in audio-video home entertainment systems.
21 Such products and services include set-top boxes known as digital video recorders or “DVRs,”
22 and subscription services provided through network connections between such set-top boxes and
23 computer servers. Defendant’s subscriber base includes approximately 2.7 million households.
24 Defendant further licenses and provides software for use in set-top boxes and servers that are
25 used, sold and/or distributed by or through media content providers. Defendant’s set-top box
26 products and subscription services permit users to obtain, control and watch television, videos,
27 movies, pictures and other content from cable, broadcast, broadband, satellite and/or other
28 sources.

1 **Count 1:**
2 **Claim for Relief from Infringement of U.S. Patent No. 6,008,803**

3 6. Microsoft incorporates by this reference the allegations set out in paragraphs 1-5
4 above.

5 7. Microsoft is the owner of the entire right, title and interest in and to U.S. Patent
6 No. 6,008,803 (the “’803 patent”), entitled “System for Displaying Programming Information.”
7 A copy of the ’803 patent is attached as Exhibit A hereto.

8 8. Microsoft is informed and believes that: Defendant has infringed the ’803 patent
9 by using, offering for sale, selling, and/or importing products, systems and/or processes in or into
10 the United States, and within the scope of one or more claims of the ’803 patent, without license
11 or authority. Such infringing products, systems and/or services include (without limitation)
12 Defendant’s set-top box products, subscription services and software.

13 9. Microsoft is informed and believes that: Defendant has contributorily infringed
14 the ’803 patent by using, offering for sale, selling, and/or importing products or components of
15 products that constitute a material part of the invention(s) claimed in the ’803 patent, without
16 license or authority, knowing that such products and/or components are especially made or
17 especially adapted for use in practicing the invention(s) claimed in the ’803 patent and not staple
18 articles or commodities of commerce suitable for substantial noninfringing uses. Such products
19 or components include (without limitation) those associated with Defendant’s set-top box
20 products and subscription service.

21 10. Microsoft is informed and believes that: Defendant has infringed the ’803 patent
22 by supplying or causing to be supplied in or from the United States, without license or authority,
23 components or products that are combined and/or used outside the United States in a manner that
24 falls within the scope of one or more claims of the ’803 patent. Such products or components
25 include (without limitation) those associated with Defendant’s set-top box products and
26 subscription service.

27 11. Microsoft is informed and believes that: Defendant also actively and knowingly
28 aids and abets the direct infringement of the ’803 patent by Defendant’s customers and/or

1 licensees, constituting active inducement to infringe under 35 U.S.C. § 271(b). Defendant
2 induces infringement of the '803 patent by actively instructing, directing or advising its customers
3 and/or licensees to operate (without limitation) Defendant's set-top box products and use its
4 subscription service in direct infringement of Microsoft's claims in the '803 patent. Defendant
5 knows of the '803 patent having received service of the original Complaint.

6 12. Defendant's infringement, contributory infringement, and infringement by
7 inducement of the '803 patent is ongoing. Unless enjoined, Defendant will continue to infringe
8 and induce infringement of the '803 patent, and Microsoft will suffer irreparable injury as a direct
9 and proximate result of Defendant's conduct.

10 13. Microsoft has been damaged by Defendant's conduct, and until an injunction
11 issues, will continue to be damaged in an amount yet to be determined.

12 **Count 2:**
13 **Claim for Relief from Infringement of U.S. Patent No. 6,055,314**

14 14. Microsoft incorporates by this reference the allegations set out in paragraphs 1-13
15 above.

16 15. Microsoft is the owner of the entire right, title and interest in and to U.S. Patent
17 No. 6,055,314 (the "'314 patent"), entitled "System and Method for Secure Purchase and
18 Delivery of Video Content Programs." A copy of the '314 patent is attached as Exhibit B hereto.

19 16. Microsoft is informed and believes that: Defendant has infringed the '314 patent
20 by using, offering for sale, selling, and/or importing products, systems and/or processes in or into
21 the United States, and within the scope of one or more claims of the '314 patent, without license
22 or authority. Such infringing products, systems and/or services include (without limitation)
23 Defendant's set-top box products, subscription services and software.

24 17. Microsoft is informed and believes that: Defendant has contributorily infringed
25 the '314 patent by using, offering for sale, selling, and/or importing products or components of
26 products that constitute a material part of the invention(s) claimed in the '314 patent, without
27 license or authority, knowing that such products and/or components are especially made or
28 especially adapted for use in practicing the invention(s) claimed in the '314 patent and not staple

1 articles or commodities of commerce suitable for substantial noninfringing uses. Such products
2 or components include (without limitation) those associated with Defendant's set-top box
3 products and subscription service.

4 18. Microsoft is informed and believes that: Defendant has infringed the '314 patent
5 by supplying or causing to be supplied in or from the United States, without license or authority,
6 components or products that are combined and/or used outside the United States in a manner that
7 falls within the scope of one or more claims of the '314 patent. Such products or components
8 include (without limitation) those associated with Defendant's set-top box products and
9 subscription service.

10 19. Microsoft is informed and believes that: Defendant also actively and knowingly
11 aids and abets the direct infringement of the '314 patent by Defendant's customers and/or
12 licensees, constituting active inducement to infringe under 35 U.S.C. § 271(b). Defendant
13 induces infringement of the '314 patent by actively instructing, directing or advising its customers
14 and/or licensees to operate (without limitation) Defendant's set-top box products and use its
15 subscription service in direct infringement of Microsoft's claims in the '314 patent. Defendant
16 knows of the '314 patent having received service of the original Complaint.

17 20. Defendant's infringement, contributory infringement, and infringement by
18 inducement of the '314 patent is ongoing. Unless enjoined, Defendant will continue to infringe
19 and induce infringement of the '314 patent, and Microsoft will suffer irreparable injury as a direct
20 and proximate result of Defendant's conduct.

21 21. Microsoft has been damaged by Defendant's conduct, and until an injunction
22 issues, will continue to be damaged in an amount yet to be determined.

23 **Count 3:**
24 **Claim for Relief from Infringement of U.S. Patent No. 5,654,748**

25 22. Microsoft incorporates by this reference the allegations set out in paragraphs 1-21
26 above.

1 23. Microsoft is the owner of the entire right, title and interest in and to U.S. Patent
2 No. 5,654,748 (the "'748 patent"), entitled "Interactive Program Identification System." A copy
3 of the '748 patent is attached as Exhibit C hereto.

4 24. Microsoft is informed and believes that: Defendant has infringed the '748 patent
5 by using, offering for sale, selling, and/or importing products, systems and/or processes in or into
6 the United States, and within the scope of one or more claims of the '748 patent, without license
7 or authority. Such infringing products, systems and/or services include (without limitation)
8 Defendant's set-top box products, subscription services and software.

9 25. Microsoft is informed and believes that: Defendant has contributorily infringed
10 the '748 patent by using, offering for sale, selling, and/or importing products or components of
11 products that constitute a material part of the invention(s) claimed in the '748 patent, without
12 license or authority, knowing that such products and/or components are especially made or
13 especially adapted for use in practicing the invention(s) claimed in the '748 patent and not staple
14 articles or commodities of commerce suitable for substantial noninfringing uses. Such products
15 or components include (without limitation) those associated with Defendant's set-top box
16 products and subscription service.

17 26. Microsoft is informed and believes that: Defendant has infringed the '748 patent
18 by supplying or causing to be supplied in or from the United States, without license or authority,
19 components or products that are combined and/or used outside the United States in a manner that
20 falls within the scope of one or more claims of the '748 patent. Such products or components
21 include (without limitation) those associated with Defendant's set-top box products and
22 subscription service.

23 27. Microsoft is informed and believes that: Having received notice of the '748 Patent
24 at least through receipt of the allegations herein, Defendant is actively and knowingly aiding and
25 abetting the direct infringement of the '748 patent by Defendant's customers and/or licensees,
26 constituting active inducement to infringe under 35 U.S.C. § 271(b). Defendant induces
27 infringement of the '748 patent by actively instructing, directing or advising its customers and/or
28

1 licensees to operate (without limitation) Defendant's set-top box products and use its subscription
2 service in direct infringement of Microsoft's claims in the '748 patent.

3 28. Defendant's infringement, contributory infringement, and infringement by
4 inducement of the '748 patent is ongoing. Unless enjoined, Defendant will continue to infringe
5 and induce infringement of the '748 patent, and Microsoft will suffer irreparable injury as a direct
6 and proximate result of Defendant's conduct.

7 29. Microsoft has been damaged by Defendant's conduct, and until an injunction
8 issues, will continue to be damaged in an amount yet to be determined.

9 **Count 4:**
10 **Claim for Relief from Infringement of U.S. Patent No. 5,677,708**

11 30. Microsoft incorporates by this reference the allegations set out in paragraphs 1-29
12 above.

13 31. Microsoft is the owner of the entire right, title and interest in and to U.S. Patent
14 No. 5,677,708 (the "'708 patent"), entitled "System for Displaying a List on a Display Screen."
15 A copy of the '708 patent is attached as Exhibit D hereto.

16 32. Microsoft is informed and believes that: Defendant has infringed the '708 patent
17 by using, offering for sale, selling, and/or importing products, systems and/or processes in or into
18 the United States, and within the scope of one or more claims of the '708 patent, without license
19 or authority. Such infringing products, systems and/or services include (without limitation)
20 Defendant's set-top box products, subscription services and software.

21 33. Microsoft is informed and believes that: Defendant has contributorily infringed
22 the '708 patent by using, offering for sale, selling, and/or importing products or components of
23 products that constitute a material part of the invention(s) claimed in the '708 patent, without
24 license or authority, knowing that such products and/or components are especially made or
25 especially adapted for use in practicing the invention(s) claimed in the '708 patent and not staple
26 articles or commodities of commerce suitable for substantial noninfringing uses. Such products
27 or components include (without limitation) those associated with Defendant's set-top box
28 products and subscription service.

1 34. Microsoft is informed and believes that: Defendant has infringed the '708 patent
2 by supplying or causing to be supplied in or from the United States, without license or authority,
3 components or products that are combined and/or used outside the United States in a manner that
4 falls within the scope of one or more claims of the '708 patent. Such products or components
5 include (without limitation) those associated with Defendant's set-top box products and
6 subscription service.

7 35. Microsoft is informed and believes that: Having received notice of the '708 Patent
8 at least through receipt of the allegations herein, Defendant is actively and knowingly aiding and
9 abetting the direct infringement of the '708 patent by Defendant's customers and/or licensees,
10 constituting active inducement to infringe under 35 U.S.C. § 271(b). Defendant induces
11 infringement of the '708 patent by actively instructing, directing or advising its customers and/or
12 licensees to operate (without limitation) Defendant's set-top box products and use its subscription
13 service in direct infringement of Microsoft's claims in the '708 patent.

14 36. Defendant's infringement, contributory infringement, and infringement by
15 inducement of the '708 patent is ongoing. Unless enjoined, Defendant will continue to infringe
16 and induce infringement of the '708 patent, and Microsoft will suffer irreparable injury as a direct
17 and proximate result of Defendant's conduct.

18 37. Microsoft has been damaged by Defendant's conduct, and until an injunction
19 issues, will continue to be damaged in an amount yet to be determined.

20 **Count 5:**
21 **Claim for Relief from Infringement of U.S. Patent No. 5,896,444**

22 38. Microsoft incorporates by this reference the allegations set out in paragraphs 1-37
23 above.

24 39. Microsoft is the owner of the entire right, title and interest in and to U.S. Patent
25 No. 5,896,444 (the "'444 patent"), entitled "Method and Apparatus for Managing
26 Communications Between a Client and a Server in a Network." A copy of the '444 patent is
27 attached as Exhibit E hereto.
28

1 40. Microsoft is informed and believes that: Defendant has infringed the '444 patent
2 by using, offering for sale, selling, and/or importing products, systems and/or processes in or into
3 the United States, and within the scope of one or more claims of the '444 patent, without license
4 or authority. Such infringing products, systems and/or services include (without limitation)
5 Defendant's set-top box products, subscription services and software.

6 41. Microsoft is informed and believes that: Defendant has contributorily infringed
7 the '444 patent by using, offering for sale, selling, and/or importing products or components of
8 products that constitute a material part of the invention(s) claimed in the '444 patent, without
9 license or authority, knowing that such products and/or components are especially made or
10 especially adapted for use in practicing the invention(s) claimed in the '444 patent and not staple
11 articles or commodities of commerce suitable for substantial noninfringing uses. Such products
12 or components include (without limitation) those associated with Defendant's set-top box
13 products and subscription service.

14 42. Microsoft is informed and believes that: Defendant has infringed the '444 patent
15 by supplying or causing to be supplied in or from the United States, without license or authority,
16 components or products that are combined and/or used outside the United States in a manner that
17 falls within the scope of one or more claims of the '444 patent. Such products or components
18 include (without limitation) those associated with Defendant's set-top box products and
19 subscription service.

20 43. Microsoft is informed and believes that: Having received notice of the '444 Patent
21 at least through receipt of the allegations herein, Defendant is actively and knowingly aiding and
22 abetting the direct infringement of the '444 patent by Defendant's customers and/or licensees,
23 constituting active inducement to infringe under 35 U.S.C. § 271(b). Defendant induces
24 infringement of the '444 patent by actively instructing, directing or advising its customers and/or
25 licensees to operate (without limitation) Defendant's set-top box products and use its subscription
26 service in direct infringement of Microsoft's claims in the '444 patent.

27 44. Defendant's infringement, contributory infringement, and infringement by
28 inducement of the '444 patent is ongoing. Unless enjoined, Defendant will continue to infringe

1 and induce infringement of the '444 patent, and Microsoft will suffer irreparable injury as a direct
2 and proximate result of Defendant's conduct.

3 45. Microsoft has been damaged by Defendant's conduct, and until an injunction
4 issues, will continue to be damaged in an amount yet to be determined.

5 **Count 6:**
6 **Claim for Relief from Infringement of U.S. Patent No. 6,725,281**

7 46. Microsoft incorporates by this reference the allegations set out in paragraphs 1-45
8 above.

9 47. Microsoft is the owner of the entire right, title and interest in and to U.S. Patent
10 No. 6,725,281 (the "'281 patent"), entitled "Synchronization of Controlled Device State Using
11 State Table and Eventing in Data-Driven Remote Device Control Model." A copy of the '281
12 patent is attached as Exhibit F hereto.

13 48. Microsoft is informed and believes that: Defendant has infringed the '281 patent
14 by using, offering for sale, selling, and/or importing products, systems and/or processes in or into
15 the United States, and within the scope of one or more claims of the '281 patent, without license
16 or authority. Such infringing products, systems and/or services include (without limitation)
17 Defendant's set-top box products, subscription services and software.

18 49. Microsoft is informed and believes that: Defendant has contributorily infringed
19 the '281 patent by using, offering for sale, selling, and/or importing products or components of
20 products that constitute a material part of the invention(s) claimed in the '281 patent, without
21 license or authority, knowing that such products and/or components are especially made or
22 especially adapted for use in practicing the invention(s) claimed in the '281 patent and not staple
23 articles or commodities of commerce suitable for substantial noninfringing uses. Such products
24 or components include (without limitation) those associated with Defendant's set-top box
25 products and subscription service.

26 50. Microsoft is informed and believes that: Defendant has infringed the '281 patent
27 by supplying or causing to be supplied in or from the United States, without license or authority,
28 components or products that are combined and/or used outside the United States in a manner that

1 falls within the scope of one or more claims of the '281 patent. Such products or components
2 include (without limitation) those associated with Defendant's set-top box products and
3 subscription service.

4 51. Microsoft is informed and believes that: Having received notice of the '281 Patent
5 at least through receipt of the allegations herein, Defendant is actively and knowingly aiding and
6 abetting the direct infringement of the '281 patent by Defendant's customers and/or licensees,
7 constituting active inducement to infringe under 35 U.S.C. § 271(b). Defendant induces
8 infringement of the '281 patent by actively instructing, directing or advising its customers and/or
9 licensees to operate (without limitation) Defendant's set-top box products and use its subscription
10 service in direct infringement of Microsoft's claims in the '281 patent.

11 52. Defendant's infringement, contributory infringement, and infringement by
12 inducement of the '281 patent is ongoing. Unless enjoined, Defendant will continue to infringe
13 and induce infringement of the '281 patent, and Microsoft will suffer irreparable injury as a direct
14 and proximate result of Defendant's conduct.

15 53. Microsoft has been damaged by Defendant's conduct, and until an injunction
16 issues, will continue to be damaged in an amount yet to be determined.

17 **Count 7:**
18 **Claim for Relief from Infringement of U.S. Patent No. 5,648,824**

19 54. Microsoft incorporates by this reference the allegations set out in paragraphs 1-53
20 above.

21 55. Microsoft is the owner of the entire right, title and interest in and to U.S. Patent
22 No. 5,648,824 (the "'824 patent"), entitled "Video Control User Interface for Controlling Display
23 of a Video." A copy of the '824 patent is attached as Exhibit G hereto.

24 56. Microsoft is informed and believes that: Defendant has infringed the '824 patent
25 by using, offering for sale, selling, and/or importing products, systems and/or processes in or into
26 the United States, and within the scope of one or more claims of the '824 patent, without license
27 or authority. Such infringing products, systems and/or services include (without limitation)
28 Defendant's set-top box products, subscription services and software.

1 57. Microsoft is informed and believes that: Defendant has contributorily infringed
2 the '824 patent by using, offering for sale, selling, and/or importing products or components of
3 products that constitute a material part of the invention(s) claimed in the '824 patent, without
4 license or authority, knowing that such products and/or components are especially made or
5 especially adapted for use in practicing the invention(s) claimed in the '824 patent and not staple
6 articles or commodities of commerce suitable for substantial noninfringing uses. Such products
7 or components include (without limitation) those associated with Defendant's set-top box
8 products and subscription service.

9 58. Microsoft is informed and believes that: Defendant has infringed the '824 patent
10 by supplying or causing to be supplied in or from the United States, without license or authority,
11 components or products that are combined and/or used outside the United States in a manner that
12 falls within the scope of one or more claims of the '824 patent. Such products or components
13 include (without limitation) those associated with Defendant's set-top box products and
14 subscription service.

15 59. Microsoft is informed and believes that: Having received notice of the '824 Patent
16 at least through receipt of the allegations herein, Defendant is actively and knowingly aiding and
17 abetting the direct infringement of the '824 patent by Defendant's customers and/or licensees,
18 constituting active inducement to infringe under 35 U.S.C. § 271(b). Defendant induces
19 infringement of the '824 patent by actively instructing, directing or advising its customers and/or
20 licensees to operate (without limitation) Defendant's set-top box products and use its subscription
21 service in direct infringement of Microsoft's claims in the '824 patent.

22 60. Defendant's infringement, contributory infringement, and infringement by
23 inducement of the '824 patent is ongoing. Unless enjoined, Defendant will continue to infringe
24 and induce infringement of the '824 patent, and Microsoft will suffer irreparable injury as a direct
25 and proximate result of Defendant's conduct.

26 61. Microsoft has been damaged by Defendant's conduct, and until an injunction
27 issues, will continue to be damaged in an amount yet to be determined.
28

Requested Relief

Microsoft requests the entry of judgment that:

- a. The '803, '314, '748, '708, '444, '281, and '824 patents are valid and enforceable;
- b. Defendant is liable for infringement, contributory infringement and inducing infringement of the '803, '314, '748, '708, '444, '281, and '824 patents;
- c. Defendant and all affiliates, subsidiaries, officers, directors, employees, agents, representatives, licensees, successors, assigns, and all those acting in concert with, or for or on behalf of, Defendant shall be enjoined from direct or indirect infringement of the '803, '314, '748, '708, '444, '281, and '824 patents;
- d. Defendant shall pay damages to Microsoft;
- e. This action be determined to be an exceptional case and Microsoft be awarded its attorney's fees, costs and expenses; and
- f. Microsoft be awarded such further relief as the Court deems appropriate.

Demand for Jury Trial

Microsoft demands a trial by jury of all issues that are triable to a jury.

DATED: June 30, 2010

Respectfully submitted,

PERKINS COIE LLP
PERKINS COIE BROWN & BAIN
P.A.

By: /s/ Lauren Sliger
Chad S. Campbell
Lauren Sliger
Christopher Kao
Farschad Farzan
Attorneys for Plaintiff Microsoft Corporation

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CERTIFICATE OF SERVICE

I hereby certify that on **June 30, 2010**, I electronically filed the foregoing with the Clerk of the Court using the CM/ECF system which will send notification of such filing to the email addresses on file with the Clerk of the Court.

/s/ Lauren Sliger
Lauren Sliger