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12 AT&T Intellectual Property I, L.P. and
AT&T Intellectual Property II, L.P.

13 UNITED STATES DISTRICT COURT
14 NORTHERN DISTRICT OF CALIFORNIA
15 OAKLAND DIVISION

16 AT&T INTELLECTUAL PROPERTY I, L.P. and
AT&T INTELLECTUAL PROPERTY II, L.P.,

17 Plaintiffs,

18 v.

19 TIVO INC.,

20 Defendant.

21 TIVO INC.,

22 Counterclaim Plaintiff,

23 v.

24 AT&T INTELLECTUAL PROPERTY I, L.P. and
25 AT&T INTELLECTUAL PROPERTY II, L.P.,

26 Counterclaim Defendants.

Case No. 4:10-CV-01059-SBA

**AMENDED COMPLAINT FOR
PATENT INFRINGEMENT**

JURY TRIAL DEMANDED

1 Plaintiffs AT&T Intellectual Property I, L.P., and AT&T Intellectual Property II, L.P.
2 (collectively, “AT&T”), by its undersigned attorneys, allege in this Complaint against TiVo Inc.
3 (“TiVo”) as follows:

4 NATURE OF THE ACTION

5 1. This civil action arises out of patent infringement under the Patent Laws of the
6 United States, 35 U.S.C. § 100, *et seq.*, and, in particular, under the provisions of
7 35 U.S.C. § 271.

8 2. AT&T seeks relief from TiVo’s infringement of AT&T’s patent rights under U.S.
9 Patent Nos. 5,809,492; 5,922,045; 6,118,976; and 6,983,478, as set forth more fully below.

10 THE PARTIES

11 3. Plaintiffs AT&T Intellectual Property I, L.P. and AT&T Intellectual Property II,
12 L.P. are Nevada limited partnerships with headquarters in Atlanta, Georgia.

13 4. Defendant TiVo Inc. is a Delaware corporation with a principal place of business
14 at 2160 Gold Street, Alviso, California 95002.

15 JURISDICTION

16 5. This Court has subject matter jurisdiction over this dispute pursuant to
17 28 U.S.C. §§ 1331 and 1338(a).

18 6. This Court has personal jurisdiction over Defendant TiVo, which has conducted
19 and continues to conduct business in the State of California and in this Judicial District.
20 Defendant TiVo’s principal place of business is within this Judicial District, in Alviso,
21 California. Defendant TiVo has committed acts of patent infringement alleged herein within the
22 State of California and, more particularly, within this Judicial District. Moreover, Defendant
23 TiVo has purposefully and voluntarily placed its infringing products, processes, and services into
24 the stream of commerce with the expectation that they will be purchased by consumers in this
25 Judicial District. These infringing products, processes, and services have been and continue to
26 be purchased by consumers in this Judicial District.

1 **VENUE**

2 7. Venue is proper in the Northern District of California under 28 U.S.C. §§ 1391(b)
3 and 1400(b) because, upon information and belief, acts and transactions constituting at least a
4 subset of the violations alleged herein occurred in part in this Judicial District and because
5 Defendant TiVo is found and transacts business in this Judicial District. Venue is also proper in
6 this Judicial District under 28 U.S.C. § 1391(c) because Defendant TiVo is subject to personal
7 jurisdiction in this District.

8 **INTRADISTRICT ASSIGNMENT**

9 8. Because this action concerns claims for patent infringement, this case is not
10 subject to assignment to a particular location or division of the Court pursuant to Local Rule 3-
11 2(c).

12 **COUNT ONE: INFRINGEMENT OF U.S. PATENT NO. 5,809,492**

13 9. AT&T incorporates by reference Paragraphs 1 through 8, as if fully set forth
14 herein.

15 10. United States Patent No. 5,809,492, entitled “Apparatus and Method for Defining
16 Rules for Personal Agents” (hereinafter, the “‘492 patent”), duly and legally issued on
17 September 15, 1998 after a full and fair examination. AT&T Intellectual Property II, L.P. is the
18 assignee of all rights, title, and interest in the ‘492 patent, including the right to sue and recover
19 for all past infringement. A true copy of the ‘492 patent is attached as Exhibit A.

20 11. As an example, and not to be limited to only a single infringing product, TiVo has
21 developed, has tested, promotes, markets, and sells DVR units that can execute software program
22 modules for managing the recording and deletion of programs, such as “Season Pass Manager.”
23 Such products (or the use or operation of such products) fall within the scope of one or more
24 claims of the ‘492 patent.

25 12. TiVo has infringed and continues to infringe the ‘492 patent, by, among other
26 acts, making, using, offering for sale, selling, and/or importing within this Judicial District and
27 elsewhere in the United States, without license or authority by AT&T, products covered by one
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1 or more claims of the '492 patent, including, but not limited to, DVR units that can execute
2 software program modules for managing the recording and deletion of programs.

3 13. On information and belief, TiVo induced and is actively inducing the
4 infringement of the '492 patent by, among other things, actively and knowingly aiding and
5 abetting others to directly make, use, offer for sale, sell, and/or import within this Judicial
6 District and elsewhere in the United States, without license or authority by AT&T, products
7 covered by one or more claims of the '492 patent, including, but not limited to, DVR units that
8 can execute software program modules for managing the recording and deletion of programs.

9 14. On information and belief, TiVo has contributed to the infringement and is
10 actively contributing to the infringement of the '492 patent by, among other things, selling,
11 offering for sale, and/or importing within this Judicial District and elsewhere in the United
12 States, without license or authority by AT&T, products or components of products that constitute
13 a material part of the '492 patent, knowing that such products and/or components are especially
14 made or especially adapted for use in the infringement of the '492 patent, and not staple articles
15 or commodities of commerce suitable for substantial non-infringing use.

16 15. On information and belief, TiVo's infringement of the '492 patent has been and
17 continues to be willful and deliberate.

18 16. As a consequence of TiVo's infringement, AT&T is entitled to recover damages
19 adequate to compensate it for the infringement complained of herein, but in no event less than a
20 reasonable royalty.

21 17. TiVo has caused and will continue to cause AT&T substantial damage and
22 irreparable injury by virtue of its past and continuing infringement of the '492 patent. TiVo will
23 continue to infringe the '492 patent unless enjoined by this Court. AT&T will suffer further
24 damage and irreparable injury unless and until TiVo is enjoined by this Court from continuing
25 such infringement.

1 **COUNT TWO: INFRINGEMENT OF U.S. PATENT NO. 5,922,045**

2 18. AT&T incorporates by reference Paragraphs 1 through 17, as if fully set forth
3 herein.

4 19. United States Patent No. 5,922,045, entitled “Method and Apparatus for
5 Providing Bookmarks when Listening to Previously Recorded Audio Programs” (hereinafter, the
6 “‘045 patent”), duly and legally issued on July 13, 1999 after a full and fair examination. AT&T
7 Intellectual Property II, L.P. is the assignee of all rights, title, and interest in the ‘045 patent,
8 including the right to sue and recover for all past infringement. A true copy of the ‘045 patent is
9 attached as Exhibit B.

10 20. As an example, and not to be limited to only a single infringing product, TiVo has
11 developed, has tested, promotes, markets, uses, and sells services for displaying streaming
12 television programs and movies. Such services (or the use or operation of such services) fall
13 within the scope of one or more claims of the ‘045 patent.

14 21. TiVo has infringed and continues to infringe the ‘045 patent, by, among other
15 acts, making, using, offering for sale, and/or selling within this Judicial District and elsewhere in
16 the United States, without license or authority by AT&T, services covered by one or more claims
17 of the ‘045 patent, including, but not limited to, services for displaying streaming television
18 programs and movies.

19 22. On information and belief, TiVo induced and is actively inducing the
20 infringement of the ‘045 patent by, among other things, actively and knowingly aiding and
21 abetting others to directly make, use, offer for sale, sell, and/or import within this Judicial
22 District and elsewhere in the United States, without license or authority by AT&T, products
23 and/or processes covered by one or more claims of the ‘045 patent, including, but not limited to,
24 products and/or processes for displaying streaming television programs and movies.

25 23. On information and belief, TiVo has contributed to the infringement and is
26 actively contributing to the infringement of the ‘045 patent by, among other things, selling,
27 offering for sale, and/or importing within this Judicial District and elsewhere in the United
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1 States, without license or authority by AT&T, products or components of products that constitute
2 a material part of the '045 patent, knowing that such products and/or components are especially
3 made or especially adapted for use in the infringement of the '045 patent, and not staple articles
4 or commodities of commerce suitable for substantial non-infringing use.

5 24. On information and belief, TiVo's infringement of the '045 patent has been and
6 continues to be willful and deliberate.

7 25. As a consequence of TiVo's infringement, AT&T is entitled to recover damages
8 adequate to compensate it for the infringement complained of herein, but in no event less than a
9 reasonable royalty.

10 26. TiVo has caused and will continue to cause AT&T substantial damage and
11 irreparable injury by virtue of its past and continuing infringement of the '045 patent. TiVo will
12 continue to infringe the '045 patent unless enjoined by this Court. AT&T will suffer further
13 damage and irreparable injury unless and until TiVo is enjoined by this Court from continuing
14 such infringement.

15 **COUNT THREE: INFRINGEMENT OF U.S. PATENT NO. 6,118,976**

16 27. AT&T incorporates by reference Paragraphs 1 through 26, as if fully set forth
17 herein.

18 28. United States Patent No. 6,118,976, entitled "Asymmetric Data Communications
19 System" (hereinafter, the "'976 patent"), duly and legally issued on September 12, 2000 after a
20 full and fair examination. AT&T Intellectual Property I, L.P. is the assignee of all rights, title,
21 and interest in the '976 patent, including the right to sue and recover for all past infringement. A
22 true copy of the '976 patent is attached as Exhibit C.

23 29. As an example, and not to be limited to only a single infringing product, TiVo has
24 developed, has tested, promotes, markets, and sells DVR units that allow for user interaction
25 through a communications channel ("interactive DVR units"). Such products (or the use or
26 operation of such products) fall within the scope of one or more claims of the '976 patent.

1 30. TiVo has infringed and continues to infringe the '976 patent, by, among other
2 acts, making, using, offering for sale, selling, and/or importing within this Judicial District and
3 elsewhere in the United States, without license or authority by AT&T, products and/or processes
4 covered by one or more claims of the '976 patent, including, but not limited to, interactive DVR
5 units.

6 31. On information and belief, TiVo induced and is actively inducing the
7 infringement of the '976 patent by, among other things, actively and knowingly aiding and
8 abetting others to directly make, use, offer for sale, sell, and/or import within this Judicial
9 District and elsewhere in the United States, without license or authority by AT&T, products
10 and/or processes covered by one or more claims of the '976 patent, including, but not limited to,
11 interactive DVR units.

12 32. On information and belief, TiVo has contributed to the infringement and is
13 actively contributing to the infringement of the '976 patent by, among other things, selling,
14 offering for sale, and/or importing within this Judicial District and elsewhere in the United
15 States, without license or authority by AT&T, products or components of products that constitute
16 a material part of the '976 patent, knowing that such products and/or components are especially
17 made or especially adapted for use in the infringement of the '976 patent, and not staple articles
18 or commodities of commerce suitable for substantial non-infringing use.

19 33. On information and belief, TiVo's infringement of the '976 patent has been and
20 continues to be willful and deliberate.

21 34. As a consequence of TiVo's infringement, AT&T is entitled to recover damages
22 adequate to compensate it for the infringement complained of herein, but in no event less than a
23 reasonable royalty.

24 35. TiVo has caused and will continue to cause AT&T substantial damage and
25 irreparable injury by virtue of its past and continuing infringement of the '976 patent. TiVo will
26 continue to infringe the '976 patent unless enjoined by this Court. AT&T will suffer further
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1 damage and irreparable injury unless and until TiVo is enjoined by this Court from continuing
2 such infringement.

3 **COUNT FOUR: INFRINGEMENT OF U.S. PATENT NO. 6,983,478**

4 36. AT&T incorporates by reference Paragraphs 1 through 35, as if fully set forth
5 herein.

6 37. United States Patent No. 6,983,478, entitled “Method and System for Tracking
7 Network Use” (hereinafter, the “‘478 patent”), duly and legally issued on January 3, 2006 after a
8 full and fair examination. AT&T Intellectual Property I, L.P. is the assignee of all rights, title,
9 and interest in the ‘478 patent, including the right to sue and recover for all past infringement. A
10 true and correct copy of the ‘478 patent is attached as Exhibit D.

11 38. As an example, and not to be limited to only a single infringing product, TiVo has
12 developed, has tested, promotes, markets, uses and sells services for tracking DVR-use patterns,
13 such as “Stop||Watch” and “Power||Watch.” Such services (or the systems used to provide such
14 services) fall within the scope of one or more claims of the ‘478 patent.

15 39. TiVo has infringed and continues to infringe the ‘478 patent, by, among other
16 acts, making, using, offering for sale, and/or selling within this Judicial District and elsewhere in
17 the United States, without license or authority by AT&T, services covered by one or more claims
18 of the ‘478 patent, including, but not limited to, services for tracking DVR-use patterns.

19 40. On information and belief, TiVo induced and is actively inducing the
20 infringement of the ‘478 patent by, among other things, actively and knowingly aiding and
21 abetting others to directly make, use, offer for sale, sell, and/or import within this Judicial
22 District and elsewhere in the United States, without license or authority by AT&T, products
23 and/or processes covered by one or more claims of the ‘478 patent, including, but not limited to,
24 products and/or processes for tracking DVR-use patterns.

25 41. On information and belief, TiVo has contributed to the infringement and is
26 actively contributing to the infringement of the ‘478 patent by, among other things, selling,
27 offering for sale, and/or importing within this Judicial District and elsewhere in the United
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1 States, without license or authority by AT&T, products or components of products that constitute
2 a material part of the '478 patent, knowing that such products and/or components are especially
3 made or especially adapted for use in the infringement of the '478 patent, and not staple articles
4 or commodities of commerce suitable for substantial non-infringing use.

5 42. On information and belief, TiVo's infringement of the '478 patent has been and
6 continues to be willful and deliberate.

7 43. As a consequence of TiVo's infringement, AT&T is entitled to recover damages
8 adequate to compensate it for the infringement complained of herein, but in no event less than a
9 reasonable royalty.

10 44. TiVo has caused and will continue to cause AT&T substantial damage and
11 irreparable injury by virtue of its past and continuing infringement of the '478 patent. TiVo will
12 continue to infringe the '478 patent unless enjoined by this Court. AT&T will suffer further
13 damage and irreparable injury unless and until TiVo is enjoined by this Court from continuing
14 such infringement.

15 **JURY DEMAND**

16 AT&T hereby demands a jury trial on all issues so triable.

17 **PRAYER**

18 WHEREFORE, AT&T prays for relief against TiVo as follows:

19 a. A judgment that TiVo has infringed the claims of U.S. Patent Nos. 5,809,492;
20 5,922,045; 6,118,976; and 6,983,478 (collectively, "the patents-in-suit");

21 b. A permanent injunction enjoining TiVo, its officers, agents, servants, employees,
22 representatives, licensees, successors, assigns, and those persons in active concert or
23 participation with any of them, from making, using, selling, offering to sell, and importing
24 products, services, or processes that infringe the patents-in-suit;
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1 c. Awarding AT&T damages adequate to compensate for the infringement by TiVo,
2 but in no event less than a reasonable royalty for the use made of the invention by TiVo, together
3 with interest and costs under 35 U.S.C. § 284;

4 d. Awarding pre-judgment and post-judgment interest on the damages assessed;

5 e. A judgment that this is an exceptional case and that AT&T be awarded their
6 attorneys' fees, costs, and expenses in this action;

7 f. Awarding treble damages upon a finding of willful infringement, and

8 g. Awarding to AT&T such other and further relief as the Court deems just.
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11 Dated: December 17, 2010

Respectfully submitted,

12 BAKER BOTTS L.L.P.

13
14 */s/ Bryant C. Boren, Jr.*

15 Bryant C. Boren, Jr.
16 Attorneys for Plaintiffs
AT&T Intellectual Property I, L.P. and
AT&T Intellectual Property II, L.P.
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