

PUBLIC VERSION

UNITED STATES INTERNATIONAL TRADE COMMISSION

Washington, D.C.

In the Matter of

**CERTAIN SET-TOP BOXES, AND HARDWARE
AND SOFTWARE COMPONENTS THEREOF**

Inv. No. 337-TA-761

**ORDER NO. 24: GRANTING IN PART TIVO'S MOTION TO PRECLUDE AND
STRIKE MICROSOFT'S UNTIMELY CONTENTIONS
REGARDING CONCEPTION DATES**

(November 18, 2011)

On September 16, 2011, Respondent TiVo Inc. ("TiVo") filed a motion seeking to preclude and strike "untimely contentions" by Complainant Microsoft Corporation ("Microsoft") relating to alleged conception dates for the two remaining asserted patents: the '838 and '258 patents. (Motion Docket No. 761-020.) TiVo alternatively requests permission to re-open discovery into the '838 patent. (Mot. at 1.) TiVo essentially objects to (i) Microsoft's assertion of "brand new" conception dates on the last day of discovery and (ii) Microsoft's production of documents supporting the '838 conception dates several weeks after the close of fact discovery under the guise of producing documents related to the '844 and '604 patents pursuant to Order No. 16. (Mot. Mem. at 7¹-14.) TiVo argues that it will be prejudiced by Microsoft's late disclosures and discovery because fact discovery has closed and therefore TiVo cannot explore Microsoft's new position and evidence. (*Id.* at 8, 15.)

On September 28, 2011, Microsoft opposed TiVo's motion. Microsoft identifies the discovery responses where it gave notice of its contentions relating to conception dates or

¹ TiVo's memorandum in support of its motion starts at page '7'.

PUBLIC VERSION

otherwise identified documents. (*See, e.g.*, Opp. at 3-5.) Microsoft also explains that it produced documents relating to the '838 patent's conception after the close of fact discovery pursuant to Order No. 16, although Microsoft does not explain how it was authorized to do so under Order 16. (*Id.* at 6-7.)

On October 4, 2011, TiVo filed a request for leave, which is hereby DENIED, to file a reply in support of its motion. (Motion Docket No. 761-024.) On October 7, 2011, Microsoft opposed TiVo's motion to file a reply. On October 12, 2011, TiVo filed a supplement to its motion. No other responses were received.

Based on a review of the motion papers and responses thereto, the Administrative Law Judge finds that under the circumstances TiVo's request to strike Microsoft's discovery responses identifying conception dates for the asserted patents served on August 8, 2011 should be DENIED. The Administrative Law Judge finds that Microsoft provided TiVo with discovery that should have put TiVo on notice that Microsoft would rely on conception dates earlier than the filing dates of the asserted patents. TiVo was under an obligation to review the documents Microsoft produced to determine their relevance, and pursue or compel discovery it deemed deficient. *See Certain Electronic Devices with Image Processing Systems, Components Thereof, and Associated Software*, Inv. No. 337-TA-724, Order No. 29 at 11-12 (U.S.I.T.C., March 11, 2011) (unreviewed).

With respect to the documents that Microsoft produced after the close of discovery, purportedly pursuant to Order No. 16, it is noted that Order No. 16 concerned two patents no longer in issue in this Investigation. (*See* Order Nos. 16, 23.) Microsoft says little to explain how an order compelling discovery with respect to the '844 patent justifies a document production with respect to the '838 patent. The Administrative Law Judge finds that the portion of TiVo's motion that seeks to preclude documents relating to the '838 patent produced after the close of fact discovery

PUBLIC VERSION

should be GRANTED. Any expert reliance on those untimely produced documents shall also be disregarded. All remaining portions of Motion Docket No. 761-020 are DENIED.

Within seven days of the date of this document, each party shall submit to the Office of the Administrative Law Judges a statement as to whether or not it seeks to have any portion of this document deleted from the public version. The parties' submissions may be made by facsimile and/or hard copy by the aforementioned date.

Any party seeking to have any portion of this document deleted from the public version thereof must submit to this office a copy of this document with red brackets clearly indicating any portion asserted to contain confidential business information. The parties' submissions concerning the public version of this document need not be filed with the Commission Secretary.

SO ORDERED.



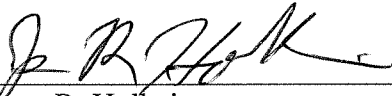
E. James Gildea
Administrative Law Judge

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337-TA-761

PUBLIC CERTIFICATE OF SERVICE

I, James R. Holbein, hereby certify that the attached **ORDER** has been served by hand upon the Commission Investigative Attorney, **Kecia Reynolds, Esq.**, and the following parties as indicated on November 28, 2011



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PUBLIC CERTIFICATE OF SERVICE – PAGE TWO

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