

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. 27: DENYING RESPONDENT’S MOTION TO PRECLUDE
COMPLAINANT FROM RELYING ON FACTS AND THEORIES
NOT DISCLOSED DURING DISCOVERY**

(November 21, 2011)

On October 11, 2011, Respondent TiVo Inc. (“TiVo”) filed a motion seeking to preclude and strike allegedly untimely contentions and evidence by Complainant Microsoft Corporation (“Microsoft”) relating to Microsoft’s technical domestic industry allegations with respect to the ‘838 patent. (Motion Docket No. 761-026.) TiVo alternatively requests permission to re-open discovery into the ‘838 patent. (Mot. Mem. at 21.) TiVo essentially reargues its position with respect to Motion Docket Nos. 761-021 and 761-025.

On October 24, 2011, Microsoft opposed TiVo’s motion. Microsoft explains that TiVo was on notice of its contentions regarding technical domestic industry because Microsoft has consistently disclosed them. (Opp. at 2-4.)

On October 24, 2011, the Commission Investigative Staff (“Staff”) responded, supporting TiVo’s motion in part. Staff argues that the motion should be granted to the extent that TiVo seeks to preclude Microsoft from asserting that it satisfies the technical domestic industry requirement based on Mediaroom software testing and on the allegation that an industry is in the process of being established. (Staff Resp. at 1.) Staff opposes any schedule changes or added discovery, and

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believes any request to strike the Merzon, Pettit, and Harden declarations is moot in light of Order No. 22. (*Id.* at 4.)

Based on a review of the motion papers and responses thereto, the Administrative Law Judge is not persuaded that Microsoft unfairly withheld its contentions with respect to technical domestic industry. On the contrary, the Administrative Law Judge finds that there are sufficient disclosures in the Complaint and in Microsoft's interrogatory responses to put TiVo on notice with respect to Microsoft's contentions. If TiVo had concerns regarding the extent of Microsoft's disclosures, it had some obligation to affirmatively discover or compel more information. *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). Despite TiVo and Staff's characterizations, this does not appear to be an example of a shifting sands approach to discovery. Accordingly, the Administrative Law Judge finds that TiVo's motion to strike Microsoft's allegedly untimely disclosed theories (Motion Docket No. 761-026) should be 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

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concerning the public version of this document need not be filed with the Commission Secretary.

SO ORDERED.

A handwritten signature in black ink that reads "E. James Gildea". The signature is written in a cursive style with a long horizontal flourish at the end.

E. James Gildea
Administrative Law Judge

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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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U.S. International Trade Commission
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PUBLIC CERTIFICATE OF SERVICE – PAGE TWO

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