

## ***TiVo v. EchoStar: A Timeline of Events***

- **March, 1999** - TiVo puts its revolutionary DVR device into the market.
- **January, 2004** – TiVo files a complaint in the United States District Court for the Eastern District of Texas against EchoStar for infringing on TiVo’s ‘389 patent.
- **April, 2006** – A jury in the Eastern District of Texas finds EchoStar had willfully infringed on TiVo’s patent claims, and awards TiVo \$74 million in damages.
- **August, 2006** - The trial judge, finding that EchoStar’s infringement caused irreparable harm to TiVo that could never be adequately remedied with money damages, issues an injunction ordering EchoStar to cease infringement and to disable its infringing technology in its adjudged products that were already placed with customers.
- **October, 2006** – After successfully arguing for a stay while appealing the lower court ruling on the basis it would lose \$90 million a month in the event of a DVR shutdown, EchoStar makes trivial changes to its software and continues its infringement.
- **November, 2007** –The United States Patent and Trademark Office (PTO) reexamines the ‘389 patent claims (at EchoStar’s behest) and confirms the validity of all claims.
- **January, 2008** – The US Court of Appeals for the Federal Circuit affirms the District Court’s judgment of infringement on claims 31 and 61 of the ‘389 patent and the permanent injunction. The same day, EchoStar unilaterally announces that because of its slightly modified software, the injunction will have “no effect.”
- **April, 2008** - The Federal Circuit denies EchoStar’s *en banc* request.
- **May, 2008** – At a status conference back in the trial court, EchoStar argues that its “workaround” should be evaluated prior to determining whether it is in violation of the disablement provision of the injunction. Only minutes after the conference concludes, EchoStar files a complaint in Delaware against TiVo seeking a declaratory judgment of non-infringement of TiVo patent claims due to the workaround it just asked the trial judge in Texas to review (EchoStar’s case was later transferred to the judge in Texas).
- **October, 2008** – The U.S. Supreme Court denies EchoStar’s request to review the Federal Circuit’s judgment upholding the jury verdict and injunction.
- **November, 2008** – EchoStar again requests the USPTO to reexamine the validity of TiVo’s patent. The PTO agrees.
- **February, 2009** – Following months of discovery, a three-day hearing is held before the trial judge to evaluate whether EchoStar’s alleged workaround is no more than “colorably different” and whether EchoStar ignored the language of the disablement provision. At the hearing, the

counsel who provided EchoStar with non-infringement opinions admits to never evaluating the final software code in EchoStar's workaround, and EchoStar's CEO states that complying with the injunction would cost EchoStar approximately \$200 million per month.

- **June, 2009** – The trial judge rules that EchoStar's redesign continues to infringe TiVo's patent claims. TiVo is awarded \$103 million in damages.
- **September, 2009** – The trial judge awards TiVo an additional \$200 million in damages and sanctions due to EchoStar's flouting of a court order.
- **March, 2010** – A Federal Circuit panel rejects EchoStar's second appeal (by a two to one vote) and upholds the trial judge's finding that EchoStar's redesign still infringes the '389 patent and that EchoStar ignored a clearly worded permanent injunction.
- **May, 2010** – EchoStar is granted an en banc review and the Federal Circuit's panel decision is vacated pending *en banc* review by the entire Federal Circuit.
- **October, 2010** – The USPTO reaffirms the validity of TiVo's '389 patent claims during its second reexamination at the request of EchoStar. This decision by the PTO is final and not appealable.
- **November 9, 2010** – TiVo and EchoStar will present their oral arguments before an *en banc* hearing of the Federal Circuit.