

EXHIBIT L

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13 *Attorneys for Plaintiff Microsoft Corporation*

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

17 MICROSOFT CORPORATION, a
18 Washington corporation,

19 Plaintiff,

20 v.

21 TIVO INC., a Delaware corporation,

22 Defendant.

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

**PLAINTIFF MICROSOFT
CORPORATIONS' DISCLOSURE OF
ASSERTED CLAIMS AND
INFRINGEMENT CONTENTIONS**

(Patent Local Rules 3-1 and 3-2)

23 AND RELATED COUNTERCLAIMS.
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1 Pursuant to Patent Local Rules (“P.L.R.”) 3-1 of the Local Rules of Practice for Patent
2 Cases before the United States District Court for the Northern District of California, Plaintiff
3 Microsoft Corporation (“Microsoft”) makes the following Disclosure of Asserted Claims and
4 Infringement Contentions. Microsoft’s statements are based on publicly available sources that
5 describe or show aspects of the accused infringing devices. Discovery in this action has only
6 recently begun, no third party discovery has yet been taken, no source code has been reviewed,
7 and the claims of the patents-in-suit have not yet been construed by the Court. Pursuant to the
8 Federal Rules of Civil Procedure and the Patent Local Rules, Microsoft therefore reserves the
9 right to supplement, amend and/or modify this Disclosure as its theories of the case are more fully
10 developed over the course of discovery.

11 This disclosure is made solely for the purpose of this action. This disclosure is subject to
12 all objections as to competence, relevance, materiality, propriety, and admissibility, and to any
13 and all other objections on any grounds that would require the exclusion of statements contained
14 herein if such disclosure were asked of, or statements contained herein were made by, a witness
15 present and testifying in court, all of which objections and grounds are expressly reserved and
16 may be interposed at the time of trial.

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18 **I. P.L.R. 3-1: DISCLOSURE OF ASSERTED CLAIMS AND INFRINGEMENT
CONTENTIONS FOR U.S. PATENT NO. 6,008,803**

19 **A. Asserted Claims**

20 Microsoft alleges that Defendant TiVo Inc. (“TiVo”) infringes at least claims 1 and 2 of
21 United States Patent No. 6,008,803 (“the ’803 Patent”)(the “Asserted ’803 Patent Claims”). The
22 contentions of Asserted ’803 Patent Claims are, at this stage in the proceedings, necessarily
23 limited in the sense that Microsoft has had limited access to information concerning the structure
24 and function of TiVo’s accused products, software, and services. Microsoft reserves the right to
25 supplement these contentions as it obtains additional information concerning TiVo’s accused
26 products and/or services over the course of discovery.

1 **B. Accused Instrumentalities**

2 Subject to the foregoing reservations, and based on information presently known to it,
3 Microsoft believes that at least the following apparatuses, products, devices, processes, methods,
4 acts, or other instrumentalities of TiVo infringe or are covered by the Asserted '803 Patent
5 Claims: Series2, Series2 DT, Series3 HD, TiVo HD, TiVo HD XL, TiVo Premiere, and TiVo
6 Premiere XL. Microsoft reserves the right to add, amend, or remove TiVo products as discovery
7 continues.

8 **C. Preliminary Claim Charts**

9 A claim chart identifying where each element of each Asserted '803 Patent Claim is found
10 within the Accused Instrumentalities is attached hereto as Attachment A. This claim chart is
11 based solely on publicly-available documents and information because no documents have been
12 provided yet by TiVo. Therefore, additional claims, and infringement positions may become
13 applicable as information regarding TiVo's instrumentalities is acquired through the discovery
14 process and otherwise. Microsoft expressly reserves the right to augment, supplement and revise
15 its infringement contentions and charted information as discovery progresses.

16 **D. Indirect Infringement**

17 Microsoft also and/or alternatively contends that TiVo indirectly infringes at least the '803
18 Patent Asserted Claims by actively inducing third parties (i.e., customers, subscribers and
19 business partners) to infringe by providing third parties with specific and detailed explanations,
20 instructions, and information as to arrangements, applications, and uses of its products, software
21 and services that promote and demonstrate how to use its products, software and services in an
22 infringing manner.

23 **E. Doctrine of Equivalents**

24 While Microsoft alleges that TiVo has literally infringed each of the Asserted '803 Patent
25 Claims, it may also have infringed one or more of the Asserted '803 Patent Claims through the
26 doctrine of equivalents. To the extent that any differences are alleged to exist between the
27 Asserted Claims and the Accused Instrumentalities, such differences are insubstantial. TiVo's
28 products and/or methods perform substantially the same function, in substantially the same way,

1 to yield substantially the same result as the claimed subject matter, and therefore TiVo has
2 infringed the Asserted '803 Patent Claims both literally and under the doctrine of equivalents.

3 **F. Priority Dates**

4 Each of the Asserted '803 Patent Claims is entitled to a priority date at least as early as,
5 and possibly earlier than, November 29, 1994, the filing date of U.S. Application No. 08/346,442,
6 now U.S. Patent No. 5,623,613, the grandparent to the '803 Patent; and/or December 13, 1996,
7 the filing date of U.S. Application No. 08/766,808, now U.S. Patent No. 5,812,123, the parent to
8 the '803 Patent. The Asserted '803 Patent Claims may be entitled to an earlier priority date based
9 on their conception and/or actual reduction to practice dates.

10 **G. Willful Infringement**

11 TiVo has been willfully infringing the Asserted '803 Patent Claims since at least as early
12 as January 25, 2010, the date on which Microsoft served TiVo with the present Complaint.

13 **II. P.L.R. 3-1: DISCLOSURE OF ASSERTED CLAIMS AND INFRINGEMENT**
14 **CONTENTIONS FOR U.S. PATENT NO. 6,055,314**

15 **A. Asserted Claims**

16 Microsoft alleges that TiVo infringes at least claims 1-4, 6-8, 27, 29, 30, 32, 42, 63-64,
17 and 70 of United States Patent No. 6,055,314 ("the '314 Patent") (the "Asserted '314 Patent
18 Claims"). The contentions of Asserted '314 Patent Claims are, at this stage in the proceedings,
19 necessarily limited in the sense that Microsoft has had limited access to information concerning
20 the structure and function of TiVo's accused products, software and services. The '314 Patent
21 claims implicate non-public operation of circuits, logic, software, and/or firmware within TiVo's
22 DVRs that cannot be readily investigated from public information or research. Microsoft reserves
23 the right to supplement these contentions and/or provide additional evidence of infringement
24 following TiVo's and third parties' disclosure of that information concerning TiVo's accused
25 products and/or services over the course of discovery.

26 **B. Accused Instrumentalities**

27 Subject to the foregoing reservations, and based on information presently known to it,
28 Microsoft believes that at least the following apparatuses, products, devices, processes, methods,

1 acts, or other instrumentalities of TiVo infringe or are covered by the Asserted '314 Patent
2 Claims: Series3 HD, TiVo HD, TiVo HD XL, TiVo Premiere, and TiVo Premiere XL. Microsoft
3 reserves the right to add, amend, or remove TiVo products as discovery continues.

4 **C. Preliminary Claim Charts**

5 A claim chart identifying where each element of each Asserted '314 Patent Claim is found
6 within the Accused Instrumentalities is attached hereto as Attachment B. This claim chart is
7 based solely on publicly-available documents and information because no documents have been
8 provided yet by TiVo. Therefore, additional claims, and infringement positions may become
9 applicable as information regarding TiVo's instrumentalities is acquired through the discovery
10 process and otherwise. Microsoft expressly reserves the right to augment, supplement and revise
11 its infringement contentions and charted information as discovery progresses.

12 **D. Indirect Infringement**

13 Microsoft also and/or alternatively contends that TiVo indirectly infringes at least the
14 Asserted '314 Patent Claims by actively inducing third parties (i.e., customers, subscribers and
15 business partners) to infringe by providing third parties with specific and detailed explanations,
16 instructions, and information as to arrangements, applications, and uses of its products and
17 services that promote and demonstrate how to use its products and services in an infringing
18 manner.

19 **E. Doctrine of Equivalents**

20 While Microsoft alleges that TiVo has literally infringed each of the Asserted '314 Patent
21 Claims, it may also have infringed one or more of the Asserted '314 Patent Claims through the
22 doctrine of equivalents. To the extent that any differences are alleged to exist between the
23 Asserted '314 Patent Claims and the Accused Instrumentalities, such differences are insubstantial.
24 TiVo's products and/or methods perform substantially the same function, in substantially the
25 same way, to yield substantially the same result as the claimed subject matter, and therefore TiVo
26 has infringed the Asserted '314 Patent Claims both literally and under the doctrine of equivalents.

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F. Priority Dates

Each of the Asserted Claims of the '314 Patent is entitled to a priority date at least as early as, and possibly earlier than, March 22, 1996, the filing date of U.S. Application No. 08/620,603, which issued as the '314 Patent. The Asserted Claims of both patents may be entitled to even earlier priority dates based on the respective conception and/or actual reduction to practice dates.

G. Willful Infringement

TiVo has been willfully infringing the '314 Patent since at least as early as January 25, 2010, the date on which Microsoft served TiVo with the present Complaint.

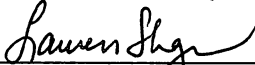
III. P.L.R. 3-2: PRODUCTION OF DOCUMENTS ACCOMPANYING DISCLOSURE

Pursuant to P.L.R. 3-2, Microsoft produces the following documents with its infringement contentions:

- Documents evidencing the conception, reduction to practice, design, and development of each claimed invention, which were created on or before the date of application for the patent in suit or the priority date identified pursuant to Patent L.R. 3-1(f), whichever is earlier (MS001-000001 - MS001-005776);
- A copy of the file history for the asserted patents and parent applications (MS001-005777 - MS001-006567); and
- Ownership evidence (MS001-006568 - MS001-006577).

DATED: May 27, 2010

Respectfully submitted,
PERKINS COIE LLP
PERKINS COIE BROWN & BAIN P.A.

By: 
Chad S. Campbell
Lauren Sliger
Farschad Farzan
Attorneys for Plaintiff Microsoft Corporation

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PROOF OF SERVICE – EMAIL AND FEDERAL EXPRESS

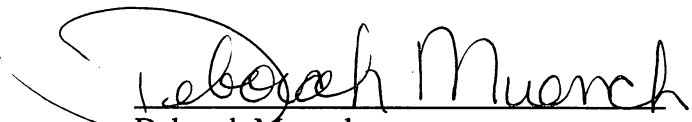
STATE OF CALIFORNIA, COUNTY OF LOS ANGELES

I am and was at all times herein mentioned employed in the County of Los Angeles, State of California. I am over the age of 18 years and not a party to the within action or proceeding. My business address is 1888 Century Park East, Suite 1700, Los Angeles, California 90067-1721.

On May 27, 2010, I served a true copy of **PLAINTIFF MICROSOFT CORPORATIONS’ DISCLOSURE OF ASSERTED CLAIMS AND INFRINGEMENT CONTENTIONS** on the interested parties in this action by **EMAIL**, I caused a copy of the document(s) to be sent from email address DMuench@perkinscoie.com to the person at the email addresses listed below. I did not receive, within a reasonable time after the transmission, any electronic message or other indication that the transmission was unsuccessful on the interested parties in this action by email; and **FEDERAL EXPRESS** by placing said document in a sealed envelope or package designated by the express service carrier with delivery fees paid or provided for, addressed to the person on whom it is to be served, thence placing the document in a mailbox, substation, box or facility regularly maintained by the express service carrier, or delivering to an authorized courier or driver authorized by the express service carrier to receive documents, addressed as follows:

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I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct; that I am employed in the office of a member of the Bar of this Court at whose direction this service was made; and that this Proof of Service was executed on May 27, 2010, at Los Angeles, California.


Deborah Muench