

Susman Godfrey Wins Long-Running Licensing Dispute with TiVo

On November 22, 2017, Judge Roy Payne of the United States District Court for the Eastern District of Texas entered Final Judgment in favor of Susman Godfrey LLP client Personalized Media Communications (PMC) in its long-running licensing dispute with TiVo, formerly known as Gemstar-TV Guide International and Rovi Guides. In his ruling, Judge Payne adopted the arbitration order of retired U.S. District Court Judge David Folsom who found a licensing agreement between PMC and Rovi encompassed technology for invoking features from an Interactive Program Guide (IPG), but did not include technology for delivering programming content.

"The arbitration order affirms PMC's right to protect its patented technology from infringement by distributors of programming content and confirms the licensing interpretation we have advanced for over a decade," said Susman Godfrey partner [Arun Subramanian](#), who, with partners [Chanler Langham](#) and [Joseph Grinstein](#), served as counsel to PMC.

"This has been a long time coming for our client, and we are pleased by the result of the arbitration," said Langham.

At issue in the case was the scope of an Exclusive Interactive Program Guide license PMC granted in 2000 to Rovi, which was then operating as Gemstar-TV Guide International.

In 2002-2008, PMC filed patent infringement actions against several defendants, including Scientific Atlanta, DirecTV, Motorola and Dish Network, for technology related to the transmission, encryption and decryption of digital satellite and digital cable signals. Though it was not named in those suits, Rovi intervened, claiming they implicated Rovi's exclusive IPG license. Rovi contended that, under its licensing agreement with PMC, it had the exclusive right to enforce infringement actions for functionality not performed by the program guide, but rather performed by digital set-top-boxes, such as the delivery of digital programming content.

The trial court, the Eastern District of Texas, issued a summary judgment in favor of PMC in 2014, finding that the licensing agreement was "unambiguous" in its scope. Rovi appealed to the Court of Appeals for the Federal Circuit, which reversed the lower court's decision and remanded it back to the Eastern District of Texas. In May of this year, on the eve of a jury trial, both parties agreed to arbitration.

In his November 15 order following arbitration, Judge Folsom rejected Rovi's expansionary view of the license and found "the functionality involved in the delivery or transmission of programming content associated with tuning, pay-per-view, video-on-demand, near video-on-demand, personal video recording or digital recording, are not covered" by Rovi's Exclusive Interactive Program Guide license. Thus, Rovi obtained no right, under the licensing agreement, to bring infringement actions for the delivery and transmission of programming content, even when accessed through an IPG.

The case is *Personalized Media Communications LLC v. Rovi Guides Inc*, Civil Action No. 2:08-CV-0070 (RSP).

PMC was also represented by S. Calvin Capshaw, III and Elizabeth L. DeRieux of Capshaw DeRieux, LLP.

