Federal Court Cour fédérale

Date: 20251114

Docket: T-841-21

Citation: 2025 FC 1725

Ottawa, Ontario, November 14, 2025

PRESENT: Madam Justice Gagné

BETWEEN:

ADEIA GUIDES INC.

Plaintiff

and

VIDEOTRON LTD.

Defendant

Contents

PUBLIC JUDGMENT AND REASONS
(Confidential Judgment and Reasons was issued on October 24, 2025)

I. Overview

[1] The Court is seized with what could be identified as the second round of litigation between these parties.

[2] In *Rovi Guides, Inc v Videotron Ltd*, 2022 FC 874 [*Rovi FC*], Adeia Guides, Inc [Adeia], formerly known as Rovi Guides, Inc, brought a first action against Videotron Ltd, alleging infringement of four of its patents related to "interactive television program guide" [IPG] technology, originating from filings made in the late 1990s. An IPG is a system comprised of software and data that runs on a set-top box (STB) or a similar type of device that allows user to navigate television listings and program data, along with associated functionalities.

[3] Videotron denied these allegations of infringement and counterclaimed that the claims of the four patents were invalid on various grounds.

[4] This Court found the claims of the four patents to be invalid and, although it did not have to deal with the remedies were the claims valid and infringed, it did so. In *Rovi Guides, Inc v Videotron Ltd*, 2024 FCA 125 [*Rovi FCA*], the Federal Court of Appeal dismissed the appeal, although it identified several errors regarding remedies.

[5] Before the decision was issued in *Rovi FC*, Adeia brought the within action against Videotron, alleging infringement of four different patents (same portfolio license) owned by Adeia:

- Canadian Patent No 2,967,187 [187 Patent], entitled *Systems and Methods for Episode Tracking in an Interactive Media Environment*, filed in Canada on December 8, 2006 (issued on July 9, 2019) and claiming

priority to US patent applications filed on **December 29, 2005**.

- Canadian Patent No 2,775,674 [674 Patent], entitled *Interactive Media System and Method for Selectively Preventing Access to Trick Play Functions*, filed in Canada on March 30, 2001 (issued on January 24, 2017) and claiming priority to US patent application filed **March 31, 2000**.

- Canadian Patent No 2,553,922 [922 Patent], entitled *Interactive Television System with Automatic Switching from Broadcast Media to Streaming Media*, filed in Canada on January 13, 2005 (issued on June 23, 2015) and claiming priority to US patent application filed on **January 21, 2004**.

- Canadian Patent No 2,635,571 [571 Patent], entitled *An Interactive Media Guidance System Having Multiple Devices*, filed in Canada on December 7, 2006 (issued on January 31, 2017) and claiming priority to US patent applications filed on **December 29, 2005**.

[collectively, the Asserted Patents]

[6] Again, Videotron brought a counterclaim alleging the Asserted Patents were invalid on the grounds of anticipation and obviousness and, in the case of the 571 Patent, Videotron alleges it is also invalid for "double patenting". Even if valid, argues Videotron, its services do not infringe the Asserted Patents.

II. The Parties

A. *Adeia and its Business*

[7] Adeia is a Delaware corporation operating out of San Jose, California. Along with its current and former affiliates, Adeia has a long history of developing innovative technologies in

the field of digital entertainment, including key advances in the way viewers interact with television and other media content.

[8] From 1996 onward, Adeia entered a series of acquisitions of competitors and mergers with entities such as United Video, StarSight Telecast, Inc., TV Guide on Screen, Gemstar and others.

[9] As a result, Adeia owns globally thousands of patents covering a multitude of digital entertainment technologies, including the Asserted Patents. It is in the business of licensing its technology in portfolio to several leading companies, including companies offering subscription-based television broadcasting. Leading multi-system operators and telecommunications companies, including Canadian companies such as Bell, Rogers, Shaw, Cogeco and Videotron, currently license or in the past have licensed the Adeia patent portfolio.

B. *Videotron and its Services*

[10] Videotron is a company incorporated under the laws of the Province of Quebec and is a company active in a variety of industries, including the provision of cable equipment and services, as well as interactive multimedia content. At all relevant times, Videotron has carried out an active business of providing cable television equipment and related services to customers in Canada.

[11] Videotron and its predecessors have been offering interactive cable television services, including video on demand, re-transmission of broadcast programming, consumer programs and content, search functionality, and electronic content guides since the 1990s.

[12] There are four Videotron services that Adeia claims are infringing:

> (a) **illico TV,** Videotron's legacy cable television system, providing linear channels, video-on demand [VOD] content, and personal video recorder [PVR] recording, accessible from STBs and, until August 2022, web and mobile. It was launched in 2011.
>
> (b) **Helix TV,** Videotron's internet-based television system with linear channels, VOD and DVR recording, accessible from STBs and web or mobile applications. It was launched in August 2019.
>
> (c) **Club illico** and (d) **VRAI,** both "over-the-top" or "OTT" platforms for French language scripted and unscripted content, respectively, accessible through a web or mobile application with a standalone subscription. The Club illico and VRAI OTT platforms were launched in February 2021 and August 2021, respectively. Club illico and VRAI content was also available as part of illico TV and Helix TV. In October 2024, Club illico was rebranded as **illico+** and VRAI content was merged into it, with VRAI being discontinued.

[13] Helix TV is operated by Comcast, a third-party to whom Videotron provides the content source, content description and updates, while managing its own subscribers accounts.

[14] The VRAI OTT platform [redacted], and was paid for its services. [redacted] and, from end users' perspective, they were dealing with Videotron. However, the delivery of VRAI OTT content to end users was subcontracted by [redacted] to a third-party, Brightcove. [redacted]

[redacted]

C. *The Parties' Business Relationship*

[15] Videotron did obtain a licence from Adeia for Adeia's patent portfolio from about 2010 to 2016 (original agreement and two extensions), allegedly to avoid the costs of entering a dispute with Adeia (I say allegedly here because there was no direct evidence of that fact). None of the Asserted Patents were granted at the time the licence was entered into by Videotron.

[16] Since Videotron first obtained a licence from Adeia, the composition of the Adeia patent portfolio has changed. For example, over 30 of Adeia's first generation Canadian patents, which are not at issue in this case, expired prior to the end of 2016, when the Videotron license agreement expired.

[17] In November 2016, Adeia was interested in renewing its licence agreement with Videotron and presented what they called their "soft offer" based on the average rates that would be acceptable for Adeia, e.g. those being paid by other licensed Canadian pay-TV providers that Adeia perceived to be comparable to Videotron, on a per-subscriber per-month basis [redacted].

[18] Since what was offered to Videotron was a license renewal for a patent portfolio that was not static — in the sense that during the life of the licence some patents would expire, and others

would be added – Videotron asked to obtain a list of the patents included in the licence at the time.

[19] On December 16, 2016, after a review of the portfolio, Videotron informed Adeia that it was not interested in renewing the licence, although it left opened the opportunity to discuss further should Adeia have more information to share. Discussions continued for a while but ultimately, Videotron ended them without renewing.

III. The Law of Patents

A. *The Skilled Person and the Common General Knowledge*

[20] Patents must be read through the eyes of the skilled person to whom they are directed. The skilled person is "ordinary": "ordinarily skilled in the art to which the invention relates and possessing the ordinary amount of knowledge incidental to that particular trade." The bar is thus not high. Rather, the skilled person need only be "acquainted with" the surrounding circumstances and technical meanings to "appreciate" the nature and description of the invention (*Whirlpool v Camco*, 2000 SCC 67 [*Whirlpool*] at paras 53 and 70).

[21] A further critical feature of the skilled person is that they do not possess a "scintilla of inventiveness or imagination"; they are "wholly devoid of intuition" (*Rovi FCA* at paras 59-60).

[22] The skilled person is equipped with their common general knowledge [CGK]. The CGK is the knowledge generally known by the skilled person at the relevant date. It does not include

all information in the public domain but includes information that is "generally known and accepted without question by the bulk of those who are engaged in the particular art" (*Bell Helicopter Textron Canada Limitée v Eurocopter, société par actions simplifiée*, 2013 FCA 219 [*Bell Helicopter*] at paras 64-65; *Eli Lilly and Company v Apotex Inc*, 2009 FC 991 [*Eli Lilly*] at para 97, aff'd 2010 FCA 240 [*Eli Lilly FCA*]).

B. *Claim Construction*

[23] The first step in a patent action is to construe the claims at issue, which are given the same interpretation for both the infringement and validity analysis (*Whirlpool* at paras 43 and 49(b)). A patent must be construed independent of considerations of infringement or validity. This reduces the risk that claims be impermissibly given a results-oriented interpretation.

[24] Patents are read through the eyes of the skilled person at the publication date, considering the CGK. The skilled person must have a mind willing to understand, not a mind desirous of misunderstanding. Claim construction is purposive – it must pay close attention to the inventor's purpose and intent based on the words used in the claims, interpreted in the context of the entire patent (*Whirlpool* at paras 43 and 49(c); *Takeda v Apotex*, 2024 FC 106 [*Takeda*] at paras 71-74).

[25] Patents must be interpreted in a manner that is fair to both the patentee and the public (*Seedlings Life Science Ventures, LLC v Pfizer Canada ULC*, 2020 FC 1 at para 56). What is not claimed is disclaimed. Allowing the patentee to expand the scope of a claim to encompass more than what is claimed is unfair (*Canamould Extrusions Ltd v Driangle Inc*, 2004 FCA 63 at para 19).

[26] The patent may be divided into two discrete sections: the claims and the remainder, known as the description or disclosure. Claims must be construed with reference to the entire specification, and not in isolation (*Biogen Canada Inc v Pharmascience Inc*, 2022 FCA 143 at paras 72-73; *Tetra Tech EBA Inc v Georgetown Rail Equipment Company*, 2019 FCA 203 at para 86).

[27] However, this does not mean that the claims are to be reinterpreted by reference to examples or descriptions in the patent specification. Reference to the disclosure should not be used "in a manner that would enlarge or contract the scope of the claim as written and … understood" (*Whirlpool* at paras 52; *Takeda* at paras 72). Figures in a patent are to be taken as illustrative only, and a claim should generally not be confined to the specific form indicated in the figures (*Tearlab v I-MED*, 2019 FCA 179 at para 47).

[28] Although there are concerns with adopting a strict dictionary or grammarian approach to claims construction, the purposive approach does not dispense with ordinary rules of syntax and grammar.

[29] Words have the same meaning as used throughout the claims (presumption of claim consistency), and claim elements are not redundant but have distinct meanings (presumption of claim differentiation) (*Whirlpool* at para 79, *Ratiopharm v Canada (Health)*, 2007 FCA 83 at para 33, *Tekna Plasma Systems Inc v AP&C Advanced Powders & Coatings Inc*, 2024 FC 871 at para 54(h)).

C. *Validity*

[30] Issued patents are presumed valid, and those who allege otherwise bear the burden of proving invalidity on a balance of probabilities (*Patent Act*, RSC, 1985, c P-4 [*Patent Act*], s 43(2); *Bell Helicopter*, at para 105).

(1) Anticipation

[31] Section 28.2 of the *Patent Act* provides the requirement of novelty. The subject matter defined by a claim must not have been disclosed in, and enabled by, a single prior art document before the claim date.

[32] In other words, the test for anticipation consists of two parts: first, the prior art must disclose the subject matter claimed; and second, the prior art must enable the skilled person to practice that subject matter (*Apotex Inc v Sanofi-Synthelabo Canada Inc.*, 2008 SCC 61 [*Apotex-methyl alpha-5*] at paras 24-29).

[33] At the disclosure stage, the single prior publication must contain a clear direction that a skilled person following it would "in every case and without possibility of error", be led to the claimed invention (*Free World v Électro Santé*, 2000 SCC 66 [*Free World*] at para 26; *Agracity v Upl*, 2024 FCA 133 at para 12). Thus, a mere "signpost upon the road to the invention", however clear, will not suffice; the prior art must be clearly shown to have "planted its flag" at the precise destination before the patentee did so (*Free World*, at para 26). Whenever subject

matter described in the prior disclosure is capable of being performed and is such that, if performed, it must result in the patent being infringed, the disclosure condition is satisfied.

[34] As recently stated by Justice Furlanetto in *Alexion Pharmaceuticals, Inc v Amgen Canada Inc*, 2025 FC 754:

> [62] As noted in *Takeda* at paragraph 153, disclosure may be made without any recognition of what is present or what is happening: see *Abbott Laboratories v Canada (Minister of Health)*, 2008 FC 1359 at para 75 [*Abbott*]; aff'd 2009 FCA 94. If in performing the teachings of the prior art reference, the invention is necessarily made, the absence of knowledge of the subject-matter of the invention is legally irrelevant: *Abbott v Canada (Minister of Health)*, 2007 FCA 153 at paras 18-22. However, if there are choices left for the PSA, leading to other ways to perform the prior art which do not result in infringement, there will be no anticipation: *BMS* at para 232; *Apotex v Shire*, 2021 FCA 52 [*Shire*] at para 50.

[35] Prior art is not anticipatory if it only contains "some elements" of the claimed invention, "could be modified, adapted, or reconfigured to resemble the claimed invention", or would have to be "completely reworked" to arrive at the claimed invention (*Western Oilfield Equipment Rentals Ltd. v M-I LLC*, 2019 FC 1606 at para 147).

[36] The prior art must be read by the skilled person with an open mind, trying to understand what the prior art meant (*Eli Lilly* at para 394).

[37] At the enablement stage, trial and error, and the use of the skilled person's common general knowledge is permitted (*Apotex-methyl alpha-5* at paras 27).

(2) Obviousness

[38] Section 28.3 of the *Patent Act* provides that the subject matter defined by a claim must not have been obvious on the claim date to a skilled person having regard to the state of the art.

[39] Obviousness assesses the difference between the state of the art and the inventive concept of the patent (*Bristol-Myers Squibb Canada Co v Teva Canada Limited*, 2017 FCA 76 [*BMS*] at para 65). The question is whether the skilled person, considering the state of the art and common general knowledge as at the claim date, have come directly and without difficulty to the solution taught by the patent (*Bridgeview Manufacturing v 931409 Alberta*, 2010 FCA 188 at para 40, quoting *Beloit Canada Ltd. v Valmet Oy*, 1986 FCA 7621, at page 294).

[40] The obviousness analysis must not be performed in a rigid way; rather, it must proceed as part of a flexible, contextual, and fact driven inquiry (*Apotex-methyl alpha-5* at para 67). After identifying the skilled person and their CGK (step one of the *Apotex-methyl alpha-5*test), and the inventive concept of the claim (step two of *Apotex-methyl alpha-5*), the obviousness inquiry compares the prior art as viewed by the skilled person through the lens of their common general knowledge, with the claims at issue (step three of *Apotex-methyl alpha-5*). If this comparison yields any differences, the inquiry seeks to ascertain whether those differences would have been obvious to the skilled person (step four of *Apotex-methyl alpha-5*). If the differences were obvious as of the claim date, the claim is invalid (*Apotex-methyl alpha-5* at para 67).

[41] The CGK of the skilled person must be assessed as of the claim date (*Patent Act*, s. 28.3).

[42] The inventive concept has been described as "not materially different from 'the solution taught by the patent'" (*BMS* at para 75). Its purpose is to help determine what, if anything, makes the claim, as constructed, inventive. While a single inventive concept must flow through a patent, each claim's specific inventive concept may be different (*Apotex Inc v Shire LLC*, 2021 FCA 52 [*Apotex-LDX*] at paras 75-77).

[43] Prior art relevant for the obviousness analysis includes any document the skilled person would locate after conducting a reasonably diligent search (*E Mishan & Sons, Inc v Supertek Canada Inc*, 2015 FCA 163 at para 22). However, obviousness is not determined by reference to the prior art at large, the Court is limited to considering the prior art relied upon by the parties, which is limited only by the requirements of section 28.3 of the *Patent Act* (*Ciba Specialty Chemicals Water Treatments Limited v SNF Inc*, 2017 FCA 225 [*Ciba*] at paras 56-60). Unlike anticipation, the party asserting validity based on obviousness may rely on a combination of pieces of prior art under the "mosaic" theory of obviousness (*Ciba* at para 60).

[44] The mosaic theory allows for the combination of prior art references in so far as it would be uninventive to do so (*Camso Inc v Soucy International Inc*, 2019 FC 255 [*Camso*] at para 125, aff'd 2020 FCA 183). The question of whether it is obvious to combine references is to be considered in light of the particular circumstances of a case, but a relevant factor includes whether both references would have been found in the diligent search "of the kind the skilled person would routinely carry out before attempting to find a solution to the problem the patent addresses" (*Eli Lilly* at para 419, citing *Scinopharm Taiwan Ltd v Eli Lilly & Co*, [2009] EWHC 631 (Pat)).

[45] Prior art that "teaches away" from the claimed invention is a relevant consideration for obviousness as it illustrates that the conventional wisdom at the time discouraged the skilled person from exploring a particular solution (*Merck v Pharmascience*, 2022 FC 417 [*Merck-Januvia*] at para 209).

[46] Finally, in assessing obviousness, the Court must avoid hindsight biases:

> Every invention is obvious after it has been made, and to no one more so than an expert in the field. Where the expert has been hired for the purpose of testifying, his infallible hindsight is even more suspect. It is so easy, once the teaching of a patent is known, to say, 'I could have done that'; before the assertion can be given any weight, one must have a satisfactory answer to the question, 'Why didn't you?
>
> (*Bridgeview* at para 50, citing *Beloit Canada Ltd. v. Valmet Oy (1986)*, 1986 CanLII 7621 (FCA), 8 C.P.R. (3d) 289 at p 295)

(3) Double Patenting

[47] There may only be one patent covering an invention. The analysis as to whether there is double patenting involves a comparison of the claims (*Whirlpool* at para 63).

[48] For "obviousness-type double patenting" (the type asserted by Videotron), the claims of the second patent must be an obvious and uninventive extension of the claims of the first patent.

[49] While the analysis for obviousness-type double patenting is "similar" to obviousness, it has fundamental differences: only the claims of the earlier patent and the CGK may be considered; any other prior art must be disregarded (*Boehringer v JAMP*, 2024 FC 1198 at paras 163, 168; *Mylan v Eli Lilly*, 2016 FCA 119 at para 29).

D. *Infringement*

[50] A patented invention is used if "the defendant's activity deprived the inventor in whole or in part, directly or indirectly, of full enjoyment of the monopoly conferred by law."

[51] It is no answer to an infringement allegation to point to instances of non-infringement where there are other instances of infringement. An infringer is liable even where, "acts of infringement may be few and far between" (*Janssen v Teva*, 2020 FC 593 at para 272, aff'd 2023 FCA 68 at paras 48, 49 and 115).

[52] The party asserting infringement must establish, on a balance of probabilities, the infringement of its patent(s) (*Monsanto v Schmeiser*, 2004 SCC 34 at para 29 [*Monsanto*]). Infringement will only occur if the alleged product includes all the essential elements of a particular patent claim. There is no infringement if an essential element of a claim is different or omitted in the impugned product (*Free World* at paras 31 and 68). Whether a defendant's activities fall within the scope of the monopoly is a question of fact (*Whirlpool* at para 76), and the mere possibility of infringement is insufficient (*Novopharm Ltd v Pfizer Canada Inc*, 2005 FCA 270 [*Novopharm*] at para 4).

IV. The Expert Witnesses

A. *Adeia's Witnesses*

[53] Dr. Samuel Russ testified in respect of the 187 and 674 Patents. He is a professor of electrical engineering. During the relevant period (2000 to 2007), he led a team of engineers at Scientific-Atlanta, a world-leading STB manufacturer. His work at Scientific-Atlanta included developing a digital video recorder ("DVR") that operated across multiple rooms, for which he won an Emmy award. In 2005, he filed a patent application for blocking "trick play" on an STB under certain circumstances.

[54] At trial, Dr. Russ was qualified as an expert in electric and computer engineering, including computer programming, video display, transmission and distribution, network communication and optimization, including home networking and local internet systems, embedded system design, STB design and architecture, digital media, streaming media, media severs and broadcasting facilities, interactive television features and user interactivity, interactive program guides and program servers, including for use in pay television systems, including televisions and STB, interactive program guides, program guide servers, VOD, digital and personal video recorders, mobile and personal computer platforms and data visualization.

[55] While Videotron did not object to Dr. Russ' qualification, it points to the fact that up until 2000, his experience did not relate to STBs or IPGs for the TV industry, but it primarily focussed on hardware design. And as of May 2000, Dr. Russ's work at Scientific Atlanta focussed on designing and developing hardware for STBs, rather than software implementation. Since

Dr. Russ provided his evidence from the perspective of the STB hardware developer in a commercial setting, he discounted views which were broader than those strictly of a pay-TV STB engineer and, at times, brought an impermissible focus on commercial viability. His testimony was often rooted in his own experience designing STBs, which is not the perspective of the skilled person.

[56] The Court has given due consideration to those caveats when came the time to weigh Dr. Russ's testimony on issues he opined on.

[57] Dr. W. Charles Easttom II testified in respect of the 922 and 571 Patents.

[58] Dr. Easttom holds eight post-secondary degrees, including Ph.Ds in Computer Science, Nanotechnology, and Cybersecurity. He is an adjunct professor at both Vanderbilt and Georgetown Universities in graduate computer science programs. He has authored or co-authored 44 books and over 100 papers used at universities around the world, including relating to computer science, networking, video protocols and television forensics. He also has extensive experience researching video conferencing and video forensics and reverse-engineering STBs.

[59] At trial, he was qualified as an expert in computer science and systems engineering, including computer programming, network communication, system architecture and design, video transmission and distribution, digital media, streaming media, media servers and broadcasting facilities, multi-media presentation, video graphics and interactive human/computer

interfaces, including for use in televisions and television STBs, IPGs, program guide servers, VOD, digital or personal video recorders, mobile and personal computer platforms, and data visualization.

[60] Videotron did not object to Dr. Easttom being so qualified but rather suggest that his lack of experience with respect to broadcast television, IPGs, video processing, or VOD, should go to the weight to be given to his testimony. In addition to the lack of relevant experience, Videotron asserts that Dr. Easttom provided opinions with a bias towards finding infringement.

[61] Again, the Court will take into consideration the "weaknesses" identified during Dr. Easttom's cross-examination when weighing his opinion on the issues he testified on.

B. *Videotron's Witnesses*

[62] Videotron has filed the reports of two experts, Dr. Edward A. Fox (on the 187 Patent) and Dr. Martin G. Kienzle (on the three other patents).

[63] Unfortunately, a few months before the trial was scheduled to start, it became obvious to Videotron that, for medical reasons, Dr. Kienzle would not be able to testify at trial.

[64] Consequently, the start of the trial was pushed back by two weeks to provide Dr. Fox sufficient time to familiarize himself with the subject matters of the three patents covered by the Kienzle Report. Dr. Fox did so and filed a report whereby he confirms that despite having

different experience and qualification from Dr. Kienzle, he adopts the conclusions of the following reports [Adoption Report]:

- Dr. Kienzle Report of June 14, 2024;
- Dr. Kienzle Report of October 2, 2024;
- Dr. Kienzle Report of November 11, 2024.

[65] Dr. Fox studied electrical engineering (computer science option) at Massachusetts Institute of Technology and then Cornell University. After obtaining his Ph.D. at Cornell, he became a professor at Virginia Tech and was on the faculty there for over 40 years. His resume includes accolades and lists hundreds of scholarly works (books, articles, tutorials, keynotes, and the like). From at least the late 1980s, Dr. Fox has edited and been on the editorial boards for publications relating to video and multimedia, including television content. From a relatively early point in his career, Dr. Fox became interested in digital video and built one of the first digital video systems for computers. He has been involved in litigation as an expert witness and worked with, for example, Google, Facebook, LinkedIn and Oracle.

[66] At trial, Videotron asked that Dr. Fox be qualified as an expert in the area of human-computer interaction, digital libraries and information retrieval, including a particular focus on multimedia and hypermedia content, such as interactive television content.

[67] Adeia objected to the part that is underlined in the previous paragraph and the Court took the objection under reserve. Dr. Fox was cross-examined on his credentials and the tone was set.

[68] The first issue that was put to Dr. Fox was not having updated his qualifications in the Adoption Report to reflect what experience in his 150-page resume was relevant for the 674, 922 and 571 Patents.

[69] Adeia also pointed to the fact that Dr. Fox's studies and experiences focussed on information retrieval and processing of information. Dr. Fox agrees subject to i) his broad interpretation of information that covers images, different languages of text, digital libraries, etc., and ii) his broad interpretation of "searching and retrieving" that have to do with finding things, presenting them, visualizing them, helping people understand them, under the general concept of human-computer interaction. Although his report does not indicate Dr. Fox has expertise with television systems, IPGs or STBs, he considers them to be computer-based systems. Even if when giving expert testimony in prior cases he did not refer to having specific experience in television, STBs and IPGs, Dr. Fox did refer to video transmission, hypermedia, multimedia, optical disk technology, electronic publishing, all being what television is.

[70] The same was said about Dr. Fox's department page at Virginia Tech, whereby his actual research interests are identified as being in the field of digital libraries, information retrieval, text analysis, natural language processing, machine learning, AI, human-computer interaction, and computer education. Dr. Fox explained that what is indicated on the department page is basically what is relevant to the topics that the students interested in Virginia Tech would be looking for advisors. The information had to be relevant to the courses that are taught at the department. In fact, Dr. Fox confirmed that accuracy is important, but completeness is not.

[71] Finally, Dr. Fox confirmed not having made or designed commercial IPG systems, but he did research and analyse them.

[72] Having considered all the arguments, I am dismissing Adeia's objection. In my view and despite a grilling cross-examination on his qualification, Dr. Fox remained adamant that through his career, he "acquired special or peculiar knowledge through study or experience in respect of the matters on which he […] undert[ook] to testify" (*R v Mohan*, 1994 CanLII 80 (SCC), [1994] 2 SCR 9 at section III (1)(d)).

[73] Adeia argues that "Dr. Fox stands alone amongst the technical witnesses in lacking credibility, as he disregarded his duty to assist the Court". I disagree. Dr. Fox testified over three full days and was subjected to a thorough cross-examination that covered all four Asserted Patents and included 13 reports. Questions posed to him were at time very long, involving complex scenarios. Here is an example of the type of questions that were put to Dr. Fox:

> "QUESTION: [...] using the times that match the figure, if it helps you to remember. Ten minutes of 'Sex and the City' on channel 10, switch to channel 11 to watch the full episode of '60 minutes', switch to channel 12 to watch '24'. They pause in the middle of '24', they go out for dinner, they come back, they don't want to watch the end of '24', they know the local news comes on immediately after. Can they skip in their buffer to the start of the local news? Yes or no?
>
> "ANSWER: I think you said three different things were being recorded, 'Sex and the City' –
>
> "QUESTION: I'll do it a third time for you.
>
> "ANSWER: I'm sorry, I don't have a paper to write this down [...]."

[74] I must confess, I was as lost as Dr. Fox!

[75] It was indeed an arduous cross-examination, but mostly because like many expert witnesses, Dr. Fox was very defensive and feared to be faulted. In my view, his credibility and his duty to the Court are unaffected by his demeanor on cross-examination.

[76] However, that is not to say that on certain topics, cross-examination has shown that more weight should be given to the testimony of Adeia's experts.

V. The Fact Witnesses

A. *For Adeia: The Inventors Walker, Cordray and Knee*

[77] Todd Walker, Robert Knee and Charles Cordray each testified as to their involvement in the inventions that led to the 187 Patent (Walker and Cordray), 571 Patent (Walker and Knee) and 922 Patent (Walker).

[78] At the relevant time, Messrs. Walker and Knee were senior leaders at Gemstar-TV Guide, the world's leading developer of IPGs, supplying IPGs to most North American pay-TV providers. They testified that the inventions underlying the patents at issue arose due to a desire to develop innovative and unique features for their companies' market-leading IPG products to benefit customers (pay-TV providers) and end-users (television users).

[79] Videotron submits that the inventor's evidence is only potentially relevant with respect to obviousness and emphasizes that none of the experts testified to a long arduous path or technical hurdles faced in developing the ideas that led to the patents. Additionally, Videotron submits that

the fact witnesses had very little memory of the single group meeting held 20 years ago during which these ideas were discussed.

[80] In addition, no context was provided for the conception of the 922 Patent, and no inventors testified as to the 674 Patent.

B. *For Videotron: Said, Peladeau and Couture*

(1) Michael Said

[81] Mr. Michael Said provided fact evidence on the functionality of the illico, Helix, Vrai, and Club illico systems, including the deployment of Helix and the relationship with Comcast – all of which he worked on personally since 2009.

[82] At trial, Adeia raised a hearsay objection to the portions of Mr. Said's testimony (both in his affidavit and his examination-in-chief) purporting to address how the Helix system functions from Comcast's end. In his affidavit, Mr. Said admitted that, because Videotron's Helix system is managed by the third-party Comcast, his knowledge of how the system functions is "limited." According to Adeia, Videotron could have and should have called a witness from Comcast to explain how the system functions. In addition, or in the alternative, Adeia submits an adverse inference should be drawn that the testimony of a Comcast witness would have been harmful to Videotron.

[83] Videotron, on the other hand, states that having led the integration of the Helix system and continued to work on Helix, Mr. Said had gained firsthand knowledge of the workings of the Comcast aspects of the system. His involvement included Helix technical implementation details with respect to new functionalities and bug fixes for the systems; as such he learned of certain system operation directly.

[84] Adeia's general objection is dismissed. However, I will only consider those parts of Mr. Said's testimony (in chief and in cross-examination) about which he has clear firsthand knowledge. Considering Mr. Said's general knowledge of the Helix system and the experience acquired during its implementation, I am not willing to infer from the absence of a Comcast witness that his or her testimony would have been detrimental to Videotron.

(2) Jean Peladeau

[85] Jean Peladeau is a Senior Vice-President Marketing at Videotron. He worked at Videotron from 2017 to 2019 and returned to the role in 2024. Appended to his affidavit, Mr. Peladeau purports to file the results of some 75 surveys conducted by the third-party external research firm Léger, some dating back to 2011.

[86] Adeia submits the surveys are hearsay (or double hearsay) evidence and objects to them being used for the truth of their content, being the actual views or perceptions of Videotron's customers. Given Mr. Peladeau's evidence is entirely based on what those surveys say, along with his impressions of those surveys, there is no factual foundation for his affidavit evidence.

[87] In addition to its hearsay objection, Adeia asks the Court to strike paragraph 20 of Mr. Peladeau's affidavit, based on Rule 248 of the *Federal Courts Rules*, SOR/ 98-106, on the ground that the information was refused to Adeia during examination for discovery.

[88] Dealing first with the hearsay objection, I agree with Adeia that Mr. Peladeau is unable to speak to the surveys as he did not conduct them, and as he was not even at Videotron when most of them were conducted. Hearsay evidence is presumptively inadmissible unless it falls under one of the recognized exceptions to the hearsay rule or meets the criteria of necessity and reliability (*R v Khelawon*, 2006 SCC 57 at paras 2, 34, and 42; *Pfizer Canada Inc v Teva Canada Limited*¸ 2016 FCA 161 at paras 86-87; *Takeda*, at para 60).

[89] As Videotron did not provide any evidence that the individuals who conducted the surveys were unable or unavailable to testify before the Court, the necessity branch of the test is not met. The same can be said regarding reliability; the surveys are not inherently reliable, and no evidence was provided as to the methodology followed, the questions posed, and the customers targeted.

[90] That said, the surveys can be used to explain, for example, why a business decision was made or not made or how it influenced the development of a new service, but not for the truth of their content.

[91] However, Mr. Peladeau states that "these surveys provide crucial insights into consumer responses to our service offering" and "these surveys have consistently demonstrated several key

findings regarding consumer preferences." This implies that these are the consumer's responses to Videotron's service offering, and that they demonstrate Videotron's key findings regarding consumers preferences or, put differently, these findings are true. That is improper. In the absence of someone from Léger or an expert witness, the surveys will not be considered for the truth of how consumers react to Videotron's service offering or how they would react in any hypothetical circumstances.

[92] Turning now to the Rule 248 objection, Adeia's key argument is grounded in Videotron's refusal to provide the following information, required during Mr. Said's examination for discovery:

> For each of those surveys, and for each of those production documents I've identified, to the extent there is raw underlying survey response data that underlies the tables and the figures […] can that be provided to me?

[93] Adeia argues that these would have been necessary to conduct a cross-examination or to obtain the opinion of its own experts on the results of the surveys. For Adeia, this argument stands whether Videotron intends to use the survey's result, or the Court accepts to take them for the truth of their content. What if Videotron was working from a misapprehension?

[94] The answer to that question is simple: if the surveys are not accepted for the truth of their content, the evidence that Videotron worked or acted based on accurate information was not provided.

[95] Also, no evidence has been tendered as to how the market would have reacted to changes in Videotron's systems, how would customers have behaved or what would Videotron have done.

[96] However, this finding does not prevent Mr. Peladeau to testify on his own understanding of the market based on his experience, or on the views and experience of Videotron's marketing team (see for example paragraph 11 of Mr. Peladeau's affidavit), or even on customers' direct feedback or past behaviour. What he cannot say is "Videotron's understanding was confirmed by the surveys."

[97] Finally, Mr. Peladeau can testify that Videotron made business decisions or would have made business decisions (either well informed or not), based on the results of the surveys.

(3) Guillaume Couture

[98] At the relevant time, Mr. Couture was the Director, Strategic Contracts and Strategic Sourcing at Videotron. Mr. Couture was heavily involved with the negotiations around the renewal of the Rovi/Videotron licence in 2015-2016. Although he is a member of the Québec Bar, he was not part of Videotron's (or its parent company Quebecor Media Inc) legal team.

[99] At trial, Adeia objected to portions of Mr. Couture's evidence based on hearsay, "a little bit of opinion evidence", and most importantly, based on Rule 248. Adeia argued that its Rule 248 objection dovetailed into a real concern about Videotron's waiver of solicitor client privilege.

[100] I dealt with the hearsay and opinion objections at trial and reserved the issue of waiver of privilege.

[101] At paragraph 15 of his affidavit, Mr. Couture says the following:

[102] At paragraph 17, Mr. Couture adds:

[103] Yet, during discovery, the following questions were asked and objected to, on the basis of relevance, and litigation and solicitor-client privilege:

> … specifically did Ms. Beaudoin ask in-house or outside counsel to assess the listed patents [for] validity or infringement by Videotron services?
>
> … did Videotron ever use the list of patents to conduct an assessment of infringement by the Illico or Helix services?
>
> … to the extent the list of patents was ever used by Videotron to conduct an assessment of validity or infringement, confirm the date the request was made for such an assessment.
>
> To the extent a contemporaneous analysis – and contemporaneous, I mean in the 2015, 2016, early 2017 time period – was conducted by Videotron as to the relative cost of entering into a dispute as opposed to entering into a licence, can you please let me know if that analysis was conducted – that's my first question – and if it

> was conducted, can you let me know or can you provide me a copy of that analysis?
>
> Etc.

[104] If the Court exercises its discretion and allows Mr. Couture's testimony on the engineering and legal assessment of the list of patents, Adeia asserts that based on this Court's decision in *Apotex Inc v Canada (Minister of Health)*, 2003 FC 1480 [*Apotex FC*], affirmed by the Federal Court of Appeal in *Canada (Minister of Health) v Apotex Inc*, 2004 FCA 280 [*Apotex FCA*], the Court has to find that Videotron has waived its litigation and solicitor-client privilege.

[105] In *Apotex FC*, the issue was whether Canada should disclose the contents of certain communications between its officials and their legal advisors, in respect of which solicitor-client privilege was asserted, if they intended to rely on the fact of having sought legal advice to justify the delay in issuing an NOC for Apotex's medicine. Canada argued that they were only relying on the fact of having sought legal advice and not on what the legal advisors had told Canada's officials.

[106] The essence of Canada's defence was that its actions were reasonable, and it relied on the fact of having received legal advice to explain the delay in issuing the NOC to Apotex. The Court found that the mere fact of asserting they obtained legal advice as an explanation for their reasonable behaviour, gave rise to an obligation to disclose the legal advice. In other words, Canada had implicitly waived solicitor-client privilege.

[107] Adeia is of the view that *Apotex FC* applies *mutadis mutandis* to the situation before me. I disagree.

[108] Videotron's defence is not that it was justified not to take a licence in 2016; its defence is rather that the Asserted Patents are invalid and, if valid, not infringed. The issue before the Court is not whether Videotron acted in bad faith in its negotiations or if it was wrong not to renew the licence, but rather whether the Asserted Patents are valid and infringed. They might have been confident that their systems did not infringe, that a design around was available, or that no injunction could be issued.

[109] This does not mean that they provided the Court with evidence that their systems did not in fact infringe, that a design-around was available, or that this is not a case where and injunction should issue.

[110] The only evidence put forward by Videotron is that they decided not to renew the licence because they were of the view that it was not needed, whether right or wrong. In other words, Mr. Couture's testimony will only be considered to provide evidence of the process he went through in 2015-2016 that led to Videotron's decision not to renew the licence; not to demonstrate in any way that Videotron was right in doing so.

[111] The other side of that coin however is that Videotron won't be able to rely on Mr. Couture's testimony to support the fact that Videotron had good reasons to believe it was not infringing the Asserted Patents, that it acted in good faith, and that there was no brazen

infringement in the real world. Without the content of the legal opinion, no one knows whether the legal team identified concerns or raised some flags, just as without the technical assessment by the engineering team, no one knows what work around was identified, if any.

VI. The Person of Ordinary Skill in the Art of the Patents

[112] There are significant commonalities among the skilled persons of the four patents. Dr. Russ opined that the skilled persons of the 187 and 674 Patents each had the same characteristics, and Dr. Easttom gave a similar opinion as to the skilled persons of the 922 and 571 Patents. Likewise, Dr. Kienzle (now Dr. Fox) opined that the skilled person was the same for each of the 674, 922 and 571 Patents. The difference, if any, lies in the level of the field experience attributed to the skilled person.

A. *187 Patent*

[113] Dr. Russ and Dr. Fox present a similar skilled person in the art for the 187 Patent; they agree that such a person would have at least an undergraduate degree in computer science or computer engineering and relevant experience or familiarity working with television interactive programming and related systems.

[114] Dr. Russ asserts that the skilled person to whom the 187 Patent is directed is a person with an undergraduate degree in computer science, computer engineering, electrical engineering or equivalent degree with at least 2 or 3 years of work experience in pay television systems, especially IPGs and program guide servers.

[115] Dr. Fox is of the view that the skilled person to whom the 187 Patent is directed is a person or group of people with a university degree (either a bachelor's or advanced degree) in computer science or engineering in the software/computing space. This person or team would understand, and have experience with, the technology and employment of user facing interactive multimedia applications in the mid 2000's, as well as familiarity with VOD and DVR systems. This person or team would also be familiar with digital library interfaces. Alternatively, the skilled person or team could have gained equivalent knowledge through "on the job" experience with interactive multimedia applications and the use of digital library interfaces, digital databases, and related technical systems.

[116] For Dr. Fox, it is unclear why the skilled person's experience should be with pay television specially, as pay television is only a potential application of the 187 Patent, which generally related to an "interactive media monitoring application". The 187 Patent is not related solely to "television" media, or even more narrowly to "pay television".

[117] Dr. Russ disagrees. He is of the view that the 187 Patent is drawn to the television arts and, more specifically, to the arena of pay television (where subscribers pay service providers for content, such as cable television or satellite television).

[118] In cross-examination, Dr. Fox confirmed that in his view, the notional skilled person could be a high school student who enrolls in university in 2001, majors in computer science, takes courses in multimedia and in digital library during his four-year degree, and graduates with a bachelor's degree in 2005.

[119] Dr. Russ disagrees with Dr. Fox that the skilled person could have no practical experience. Since undergraduate study in computer science or computer software engineering in the mid-2000s likely did not address television systems, the fresh out-of-school student could not have developed the relevant skills.

[120] In my view, Dr. Russ' skilled person is more accurately described in the context of understanding the 187 Patent in the early to mid-2000s.

[121] First, Dr. Fox's skilled person significantly contrasts with that of Dr. Kienzle who, as will be seen below, requires that person or team of persons to have a higher degree of experience, being a senior executive in media distribution. This person would, by definition, have years of relevant hands-on experience. In fact, the very definition of a skill, as per the Cambridge Dictionary, is "an ability to do an activity or a job, especially because you have practised it." Although school prepares you to acquire skills in a field, it often does not provide students with marketable skills.

[122] Second, the 187 Patent might not be specific to television equipment, but it is tied to serial programming, which is normally television content. One of ordinary skill would recognize a close connection between the patent and the television art. Read as a whole in the mid 2000s, the 187 Patent does focus on television media, which was at the time pay cable television. Internet based broadcasting and streaming or watching serial programs on a computer or portable device, was not what came to mind in the early 2000s.

B. *674 Patent*

[123] Dr. Russ asserts that the skilled person to whom the 674 Patent is directed is the same as the skilled person to whom the 187 patent is directed. The skilled person is a person with an undergraduate degree in computer science, computer engineering, electrical engineering or equivalent degree with at least 2 or 3 years of work experience in pay television systems.

[124] Dr. Kienzle (now Dr. Fox) asserts that the skilled person to whom the 674 Patent is directed is a person with an engineering background in the field of communications, electrical, or software engineering, and have hands-on managerial experience in the field of media distribution. Likely, such a person would rely on a team of individuals to implement the patent's teachings as the patent bridges different technological aspects of television distribution, the nuances of which would likely not be in the job description of a single person. He explains that the broad terms of the 674 Patent with regards to its implementation by using "any suitable" technology requires a team of people to practically select which "suitable technology" should be used to implement the specific elements of the 674 Patent at the direction of the skilled person. He adds that the skilled person would also know how to run pilots and build prototypes and have the team run trials before deployment of a system.

[125] Again, considering that Dr. Kienzle's skilled person stands in stark contrast to Dr. Fox's neophyte skilled person of the 187 Patent — contrast that Dr. Fox was unable to explain, I again prefer Dr. Russ' description of the person of skilled in the art of the 674 Patent.

C. *922 and 571 Patents*

[126] Dr. Easttom and Dr. Kienzle (now Dr. Fox) generally agree on the person of skill in the art relating to the 922 and 571 Patents.

[127] Dr. Easttom asserts that the skilled person to whom the 922 Patent and 571 Patent are directed to is the same person. In his opinion, the skilled person is a person with an undergraduate degree in computer science, electrical engineering or systems engineering, with a focus on computer networks. This skilled person would have at least two years of experience with video transmission or distribution and playback, such as cable, satellite or streaming, and including television devices such as STBs. However, a person with a relevant graduate degree but only one year of experience would also be skilled in the art, as would a person without a degree but five or more years of experience.

[128] Dr. Kienzle (now Dr. Fox) asserts that the skilled person for all four Asserted Patents is the same. In his opinion, the Skilled Person would likely have an engineering background in one of communications, electrical or software engineering and have hands-on managerial experience in the field of media distribution. Likely, such a person would rely on a team of individuals to implement the patent's teachings as the patent bridges different technological aspects of television distribution, the nuances of which would likely not be in the job description of a single person.

[129] In my view and considering the absence of contradiction, I find that the person of skill in the art relating to the 922 and 571 Patents is a combination/addition of these two descriptions.

VII. Common General knowledge

[130] Adeia generally agrees with Videotron's characterization of the CGK, subject to minor disagreements, some of which are addressed below. Adeia and Videotron both agree that the expert's opinions largely turn on their analysis of the patents and prior art.

A. *187 Patent*

[131] Dr. Fox explains that the CGK of the skilled person would include familiarity with STBs, electronic program guides/IPGs, distribution of television content, digital databases/digital libraries, hypermedia/hypertext, user profiles, and information storage in the field of multimedia applications. Dr. Russ generally agreed with Dr. Fox's characterization of the CGK, with some minor clarifications and disagreement.

[132] The main issue Dr. Russ and Adeia took with Dr. Fox's CGK section was his listing of 14 textbooks that he states the skilled person "would likely have reviewed or have possession of." Dr. Russ rather asserts that the skilled person would not necessarily be familiar with the content of those textbooks, even if in their possession. As set out above, the CGK does not include pieces of art that are widely circulated or read, CGK includes information that is "generally known and accepted without question" (*Eli Lilly* at para 97). During

cross-examination, it became clear that the information contained with the books was what Dr. Fox asserted to be CGK, not the books themselves.

[133] Since Dr. Fox and Dr. Russ generally agreed on the subject matters identified above and detailed in their reports, I have considered that information to be the relevant CGK.

B. *674 Patent*

[134] Again, Dr. Russ generally agrees with Dr. Kienzle's (now Dr. Fox's) description of the CGK as of the 674 Publication Date, October 11, 2001, but notes that some aspects of the CGK as of the priority date, which was March 31, 2000, would be different.

[135] Dr. Kienzle (now Dr. Fox) asserts that the skilled person would have been well aware of media distribution systems, interactive television, media streaming, compression and media formats, user equipment devices, video storage and servers, and interactive program guides.

[136] He adds that the CGK would have developed after October 2001. From October 2001 to August 2005, it would have included familiarity with distribution technology, home networks, and media players and services. From August 2005 to July 2007, the decrease in the cost of equipment related to television and streaming services increased consumer access and acceptance of features of television and streaming technology, such as VOD. Notably, the popularity of YouTube and other online video streaming services increased user awareness of streaming capabilities and features.

C. *922 and 571 Patents*

[137] The experts also generally agree on the CGK applicable to the 922 and 571 Patents.

[138] Dr. Kienzle (now Dr. Fox) asserts the following topics would be part of the skilled person's common general knowledge as of 2001: Media Distribution Systems, Interactive Television, Media Streaming, Compression and Media Formats, User Equipment Devices, Video Storage and Interactive Program Guides. From October 2001 to August 2005, the CGK would have also included Distribution Technology, Home Networks, and Media Players and Services. From August 2005 to July 2007, an important development in the field was the launch of YouTube, and similar video offerings including Vimeo, Dailymotion, Amazon Prime Video and Netflix.

[139] Dr. Easttom acknowledges that the skilled person would be familiar with STBs and agrees with Dr. Fox's descriptions of certain technologies such as Macromedia Shockwave player, RealNetworks RealVideo player and Real Time Streaming Protocol, and DOCSIS. However, he disagrees with Dr. Fox's description of various handheld devices as being directed to watching lengthy, broadcast-quality videos in the same way the modern handheld devices are. Dr. Easttom also took issue with Dr. Kienzle's reliance on Wikipedia, which he cites 70 times in his in-chief report, and his inclusion of certain technical publications and promotional materials in the CGK.

VIII. The 187 Patent

[140] The 187 Patent is entitled “Systems and Methods for Episode Tracking in an Interactive Media Environment”. It claims priority to December 29, 2005, and was published on July 12, 2007. The 187 Patent expires in December 2026. At a high level, it discloses (among other things) an IPG that tracks a user’s progress as they view television series in DVR and VOD services.

[141] Messrs. Walker and Cordray explained that they wanted to counter the success of Digital Video Discs [DVDs], but they needed a way for viewers to navigate those products.

[142] Adeia is seeking a declaration that all the defendant’s services at issue (illico TV, Helix TV, Club illico and VRAI) have infringed and continue to infringe Claims 1, 2, 3, 5, 6, 7, 8, 9, 11, 12, 13, 14, 15, 16, 17, 18, 19, and 22 of the 187 Patent [the 187 Asserted Claims] .

[143] The 187 Asserted Claims are divided into 2 groups:

> Group A Claims: 1-3, 5-9 and 11-14; and
>
> Group B Claims: 15-19 and 22.

[144] The Group A claims are exemplified by independent Claim 1, with key claim terms bolded:

> A method for presenting media content based on **a user’s** viewing progress within serial programs on user equipment, the method comprising:

> creating **a media profile** comprising **a first viewing progress** within **a first serial program** and a second viewing progress within a second serial program;
>
> storing the media profile in a storage device;
>
> determining a **first progress** point in the first serial program based on the first viewing progress and a second progress point in the second serial program based on the second viewing progress; and
>
> generating for display **a first link corresponding to the first progress point** in the first serial program **adjacent to** a second link corresponding to the second progress point in the second serial program.

[145] Independent Claim 13 also comprises a method for "presenting media content based on a user's viewing progress within serial programs" but implicates a "user profile" associated with the "media profile".

[146] The Group B claims are exemplified by independent Claim 15, with key claim terms bolded:

> A method for presenting media content to **users**, the method comprising:
>
> retrieving **a viewing progress** of a user in serial programming from **a user profile**;
>
> determining a current episode in the serial programming that corresponds to the viewing progress; and
>
> presenting a viewing option to the user, wherein **selection of the viewing option causes the current episode to be skipped, a subsequent episode to be presented, and the viewing progress in the user profile to be updated based on the current episode being skipped**, and wherein the viewing option is presented before the subsequent episode is played back.

A. *Claim Construction*

[147] Most elements of the claims to all four patents are not subject to meaningful dispute. For each Claim Construction section, the focus will therefore be on those claim elements for which the experts have advanced differing constructions, and which are most pertinent to the infringement or validity issues raised by the parties.

(1) "User" or "user profile" and "media profile"

[148] The term "user profile" is found in Claims 13 and 14 of the Group A Claims, and in the Group B Claims (independent claim 15). There is no dispute that a "user profile" is a collection of information about a given user, identified by a unique identifier. The skilled person would understand the claimed "user profile" to include one or more media profiles, which comprise information associated with a user and particular piece of media.

[149] The dispute with respect to these claim terms arises with respect to whether a "user", and its associated "user profile", is specific to an individual person (Dr. Fox) or to a subscriber or household (Dr. Russ).

[150] For Dr. Russ, "user profile" would be understood by the skilled person as referring to the household or subscriber account receiving the service, while "media profile" refers to an individual using the service. He asserts that the skilled person would understand from the claim that one or more media profiles can be associated with the user profile.

[151] Dr. Fox is of the opinion that “user” or “user profile” and “media profile” would be understood by the skilled person as referring to an identifiable individual.

[152] Dr. Russ generally agrees with Dr. Fox that computers have long had accounts for each user, which accounts typically recorded the user’s name and/or identifier and other information. However, he criticizes Dr. Fox’s opinion as being informed by technology applicable to personal computers, lacking connection to pay television.

[153] Adeia submits that since the word “user” only appears in the preamble to the 187 Patent (Group A and B Claims), it is not considered a patentable limitation in the claim. That might be so, but “user” cannot have a different meaning when used alone and when used in the term “user profile”, which is a claimed term. In addition, the word “user” must be given the same interpretation throughout the patent.

[154] In cross-examination and in its closing arguments, Adeia focussed on paragraph 119 of the 187 Patent in support of its position that “user profile” means a household, not an individual’s profile. Part of paragraph 119 reads as follows:

> [0119] … In some embodiments, users may always be required to log-in using log-in screen 1000. In other embodiments, users may be required to log-in only if the interactive media monitoring application is in multi-user mode. If the interactive media monitoring application is setup for single-user mode, log-in screen 1000 may be bypassed (or authentication credentials of the user may be automatically supplied) …

[155] For Adeia, the generic term “user” in the claims is thus intended to be broader and unqualified by either a “single” or “multiple” limitation.

[156] With respect, I fail to see the logic behind Adeia's argument. It rather seems obvious to me that in both "single user mode" and "multi-user mode", the word "user" refers to an individual, not a household. If "user" (and "user profile") referred to a household, the embodiments discussed in paragraph 119 of the 187 Patent would distinguish between a "single-household mode" and a "multi-household mode".

[157] In my view, the context of the 187 Patent points to the construction of "user" to mean an individual. The description in the patent shows, for example, that media profiles are defined to be able to be specific to individuals (see "John's Media Profile" of Figure 12). Further, the purpose of the patent – to prevent "spoilers" and to avoid confusion due to missing plot developments by unwittingly skipping ahead in a series – are based on the knowledge and memory of individual viewers, not on a collective viewing pattern at a household.

(2) "Viewing progress" and "Progress point"

(a) *Viewing Progress*

[158] The experts disagree as to the construction of the term "viewing progress", and more particularly, as to whether it captures the most recently watched episode of a serial program (Dr. Russ), or the furthest episode reached in a serial program (Dr. Fox).

[159] In an ordinary viewing pattern, the most recently watched episode will also be the furthest episode reached in the series. For example, where a viewer watches episodes 1, 2 and then 3 of a given program, the viewing progress will be episode 4 on either expert's construction.

[160] Adeia submits that in cases where a viewer chooses to watch episodes out of order or re-watch a serial program they have already watched in the past, only Dr. Russ' construction is consistent with one of the focuses of the patent, namely, ensuring users understand recent plot sequences.

[161] Videotron, on the other hand, submits that the patent consistently describes the farthest point of advancement through a series as being tracked, simple "recency" not being mentioned in the patent. For that proposition, Videotron specifically points to the following excerpts of paragraphs 5, 6, 58, 123, 127 and 128 of the 187 Patent:

> [0005] …An example of serial programming includes episodes of the television series "24". A user who watches an episode of the television series "24" out of sequence may not recognize or understand certain characters, themes, or plot elements that were introduced in previous, unwatched episodes …
>
> [0006] … For example, a user, who is watching a particular episode of a certain television series, may not wish to see spoilers or other irrelevant media content related to unwatched shows in a series of related programs.
>
> [0058] …The media monitoring application may also filter media content and other information (e.g., web or Internet data) that is inconsistent with the user's viewing progress. For example, a spoiler advertisement relating to an unwatched program may be replaced with an advertisement relating to an already watched program…
>
> [0123] Several options may be presented to a user for watching a program or series of programs of a time-shifted basis depending on such factors as, for example, the type of program (e.g. whether the program is more of a serial program or more of an episodic program), how far the user's viewing progress is behind, etc.
>
> [0127] For example, in the illustrative display screen of FIG. 12, the current user has watched through season 3, episode 3 of the series "24" on FOX® network. In some embodiment, this indicates that the user has watched episodes 1 through 3 of season 3 only. In other embodiments, this viewing progress indicates that the user

> has watched episodes 1 through 3 of season 3 and all the episodes in any previous season or seasons (e.g., season 1 and 2)…
>
> [0128] The interactive media monitoring application may use information stored in the user's media profile to remove or replace any media content that is inconsistent with the user's current viewing progress. For example, an advertisement promoting season 3, episode 7 of the series "24" may be replaced with an advertisement promoting season 3, episode 4, which may be the user's next unwatched episode as indicated by the user's media profile…

[162] I agree that the concept of "spoilers" refers to future events in a series. However, all examples put forward assume that the user adopts an ordinary viewing pattern, that is a sequential pattern. In my respectful view, these examples do not support (nor contradict) Videotron's position.

[163] I also do not agree with Adeia that the only interpretation that is consistent with the patent objective of ensuring users understand plot points is that of Dr. Russ.

[164] Neither interpretation offers a proper solution if an episode is skipped (and therefore a plot point is missed) or if the user decides to rewatch a previously viewed episode.

[165] If a user watches episodes 1 to 6 of a series comprising 12 episodes and decides to rewatch episode 1 for a refresher regarding certain earlier events before moving on, Dr. Fox's solution is preferable because the user's viewing progress would then be episode 7, whereas Dr. Russ' solution would be episode 2.

[166] In another scenario, a user has watched an entire old series and years later, decides to rewatch it. During the rewatch, the viewing progress would always be the last episode of the series. This scenario clearly favours Dr. Russ' interpretation that the viewing progress should bring the user to the most recently watched episode.

[167] Now a third scenario to which neither interpretation provides a solution. The user watches episodes 1, 2 and 3 of a season and then jumps to the last episode out of burning curiosity. The viewing progress will inevitably be the end of the series, whether we use the further point reached or the most recently watched, and the real tracking will be lost.

[168] Although the ordinary meaning of the word "progress" (in the sense of advancement) leads toward the further point reached in the series, in the context of television watching it seems the most recently watched episode makes more sense.

[169] All that to say, this construction issue is, in my view, a false debate, one put forward solely to give the claims a result-oriented interpretation, which is not permitted in patent law (*Whirlpool* at para 49(a); *Takeda* at para 69). That debate is only put forward for the purpose of arguing infringement or the absence of infringement.

[170] I believe the viewing progress is both, the furthest point reached in a series and the most recently watched episode, because the very purpose of the 187 Patent is to track a viewer's viewing progress in a series that is meant to be watched in a sequential fashion. When the series

is so watched, the viewing progress is both the further point reached and the most recently watched.

(b) *Progress point*

[171] A second construction issue relating to “viewing progress” is how it differs from “progress point”.

[172] Dr. Russ explained that, while “viewing progress” refers to the episode of the series the user last watched, “progress point” refers to “a more granular position within the program, e.g. a specific time point or frame number”. Adeia submits that this construction is consistent with the structure of Claim 1, which involves “determining a first progress point in the first serial program based on the first viewing progress”. Dr. Russ pointed out that a skilled person would understand that if you are using two different words, they should be used to describe two different things.

[173] In his responding report, Dr. Fox states the following: “based on my claim construction of both “progress point” and “viewing progress”, which I construe to being the same…” (at para 42). In cross-examination, Dr. Fox denied having given both terms the same meaning. He explained that these terms rather go hand-in-hand and have in common the word “progress”. The label of the “progress” in Figure 7B, contrasts with the label “position”. In his view, the skilled person would understand that “viewing progress” and “progress point” go together because the “progress point” is to be determined relative to the “viewing progress”, which the skilled person

understands as being a reference to the season/episode of a series. In other words, the value is the same but not their exact meaning.

[174] Portions of Figure 7B and 12 of the 187 Patent, respectively, are excerpted below:

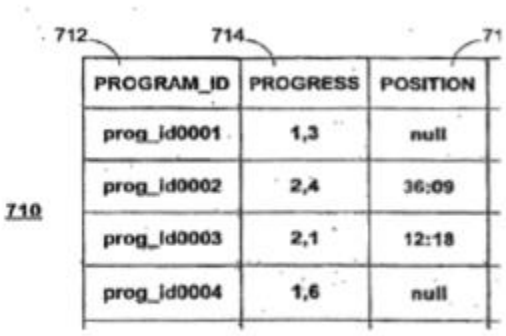


FIGURE 7B

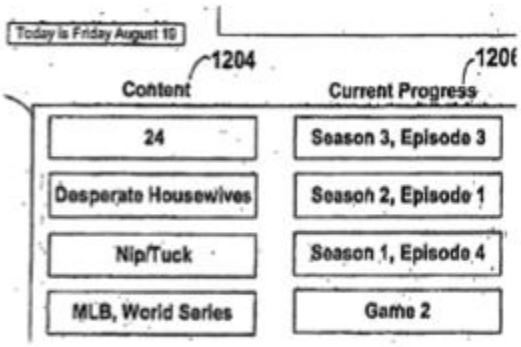


FIGURE 12

[175] Figure 7B is a media profile record and Figure 12 is an example user screen, showing the user's media profile. The data of Figure 7B is related to, but not the same as, what is displayed in Figure 12. "Progress" data in the media profile of Figure 7B consists of two numerals, separated by a comma (in the second row of the media profile in the Figure 7B example, "1,3"). In contrast, in the display to the user example of Figure 12, there is more information provided in the "Current Progress" column such as "Season 3, Episode 3" or "Game 2". "Determining" a "progress point" based on "viewing progress" (Claim 1 of the 187 Patent) refers to extracting from the media profile a value (e.g. number for episode and identifier for serial), which later will be included in the data of the link that will be generated for the "progress point".

[176] The way I see this is the "viewing progress" is a line (which includes the past viewing up to the current viewing) and the "progress point" is the last point on that line (exactly where you

are at in the current viewing). These terms do not have the same meaning, but the latter is defined relative to the former. Both are needed to track exactly where the viewer is at in a serial program.

(3) "A first link corresponding to the first progress point" and "adjacent to a second link"

[177] The experts generally agree on the meaning of a "link" as a means of selecting the viewing or progress point. They disagree on the steps required to select the link that will allow a user to resume viewing an episode within the method disclosed in the claim.

[178] Dr. Russ asserts that the terms "corresponding to" in the claim means that the link displayed does not need to lead directly to resuming content from the progress point, such that a secondary display before resuming an episode would not deviate from the patent disclosure. In cross-examination, he provided the following clarification (transcripts, p. 368, ln 9 to 16):

> It is a link that corresponds to the progress point, and so selecting the link leads the user down a path that results in resuming at the progress point.
>
> And the patent claim says "link", and it's a link to a chain of events that leads to the episode being played back at the progress point.

[179] In Dr. Fox's opinion, the link selected when the user is choosing media content to watch from the viewing progress displayed must be the link that leads directly to the episode which the user wishes to continue viewing. An intermediary step, which, in Videotron's case, is a new display showing details of the selected episode only before the user can then select and continue viewing the serial program, would not be consistent with the disclosure of the patent. Such a link

selected from a secondary display would no longer be adjacent to a first or second link, and therefore not contemplated by the patent.

[180] I partially agree with Dr. Russ. The claim language does not require directly engaging playback, it just says “a link corresponding to”. If once the link is activated, you are brought at a specific time, in a specific episode of a specific season, and the only thing the user is requested to do is push “resume watching”, the link is corresponding to a progress point.

[181] However, I disagree that it would be sufficient for the link to simply lead to a chain of different steps that eventually brings the user to the progress point.

B. *Infringement*

[182] Adeia is seeking a declaration that all the defendant’s services at issue (illico TV, Helix TV, Club illico and VRAI) have infringed and continue to infringe the 187 Asserted Claims. However, the infringement arguments (as the invalidity arguments) largely turn on the independent Claims 1, 13 (Group A Claims) and 15 (Group B Claim).

[183] To establish that there is infringement, the Court must be satisfied that the impugned product has all the essential elements of the Asserted Claims (*Takeda,* at para 116, citing *Free World Trust* at para 31(f)). Infringement can be found even if acts of infringement are few and far between (*Janssen* at para 272, aff’d on this point 2023 FCA 68 at paras 48-49, 115).

(1) Group A Claims

[184] Videotron argues its systems and functions are not infringing the Group A Claims because they lack the features corresponding to one or more of the essential elements of the asserted claims:

> (a) Lack of tracking or of presenting "viewing progress". Instead, in the Videotron systems information is tracked or presented based on other characteristics such as recently recorded, last watched, or partially watched.
>
> (b) Lack of information being maintained on a "user" basis. Rather, information is tracked based on subscriber accounts.
>
> (c) Lack of links to series content being displayed adjacent to each other. Instead, systems list content information without regard to it being related to a series or not. Even if, by chance, series information is displayed adjacent to each other, that displayed information is not a link to serial content.
>
> (d) Lack of updating of viewing progress in a user profile when a next episode option is selected by a user. Instead, the system merely records partial viewing of an episode when the next episode option is selected.

[185] Adeia submits that Videotron focuses its evidence and argument on specific instances of non-infringement, or where infringement is not inevitable or intentional. It asserts that the fact that Videotron may in some cases not infringe is irrelevant given that in many cases it does infringe, intentionally or otherwise.

[186] Infringement can be established even if non-infringing circumstances exist (*Takeda* at para 134). However, the patentee still has the burden of establishing infringement on a balance of probabilities, with "sufficiently clear, convincing and cogent" evidence (*Takeda* at para 116).

Evidence that estimates or speculates as to there being a possibility of infringement, however strong, is not enough (*Novopharm* at para 22).

[187] In *Janssen* at paras 268-272, aff'd on this point 2023 FCA 68 at paras 76-79, the patented claims at issue concerned a dosing regimen for medication used to treat schizophrenia. In his analysis on whether the defendant induced infringement of the patent, Justice Michael Manson found that expert evidence from prescribing physicians was sufficient to determine that some patients will receive the defendant's medication according to the claimed dosing regimen, as both products would "likely be interchangeable" (para 270). He adds:

> [271] While the IMS data and the evidence of Dr. Allain indicate that a large number of patients on INVEGA SUSTENNA receive 100 mg-eq or 150 mg-eq as their maintenance dose, Dr. Agid opined that many of his patients receive maintenance doses of 75 mg-eq. Dr. Simm acknowledged on cross-examination that he has treated at least some patients with INVEGA SUSTENNA using the claimed regimen of 150 mg-eq on day 1 in the deltoid, 100 mg-eq on day 8 in the deltoid, and 75 mg-eq as an ongoing maintenance dose. Dr. Simm stated that it is very likely that at least some patients will receive the Teva paliperidone product in accordance with the claimed dosing regimens in the 335 Patent for both renally impaired and non-renally impaired patients.
>
> [272] Therefore, while acts of infringement may be few and far between, at least some physicians will prescribe and administer paliperidone palmitate injections that fall within the scope of the claimed dosing regimens in the 335 Patent.

[188] That said, whether a defendant's activities fall within the scope of the monopoly is a question of fact (*Whirlpool* at para 76).

(a) *Helix TV "Resume Viewing" and "recently Watched" interfaces*

[189] For the "Resume Viewing" interface (Figure E of the Russ Report), the system creates a media profile comprising a first viewing progress (FBI, season 5, episode 21) and a second viewing progress (*Liste noire*, season 10, episode 21); the media profile is not visually depicted but is created, as shown in the drop-down menu activated when selecting the link; the listed items act as links that correspond to the progress point in each of FBI and *Liste noire*; the system determines the specific time point at which the user left off in viewing each of FBI and *Liste noire* and depicts it visually using the progress bar.

[190] For the "Recently Watched" interface (p. 40 of the Said Affidavit), the system creates a media profile comprising a first viewing progress (*Sorcières*, season 1, episode 24) and a second viewing progress (*L'Enquète McSween*); The listed items act as links that correspond to the progress point in each of *Sorcières* and *L'Enquète McSween*; upon activating one of the tile links, the option to "Resume" appears. The system determines the specific time point at which the user left off in viewing each of these two programs and depicts it visually using the progress bar.

[191] The same analysis can be made with regards to the Web (Figure F of the Russ Report) and mobile (Figure H of the Russ Report) "Recently Watched" interfaces, and with regards to the STB "Recordings" interface (Figure S of the Russ Report).

[192] Dr. Fox's responses to Dr. Russ's analysis point out that (i) the "Resume Viewing" interface displays the viewing progress of a subscriber household (rather than individuals within the household), (ii) it tracks the most recently watched episode rather than the furthest episode reached in a series, (iii) it is not limited to serial programs (as opposed to other types of video programming, like movies), and (iv) it would not capture programs viewed on linear broadcast television (as opposed to VOD/DVR).

[193] According to Adeia, if the Court agrees with Dr. Russ's construction of "user" and "viewing progress" (respectively "the subscriber/household" and "the most recently watched"), then the Helix TV "Resume Viewing" interface infringes the 187 Asserted Claims.

[194] But even if the Court disagrees with Dr. Russ's constructions on both points, adds Adeia, the Helix TV "Resume Viewing" menu does and will infringe in the scenario of a single-person household watching a serial program in its intended viewing order.

[195] I agree. As acknowledged by Dr. Fox, "any individual in a single-person household would be a single user", and when the latest episode reached in a series is the same as the episode most recently watched, such episode is the "viewing progress". In my view, this is likely to be most of the time as the interest in watching a series is to watch it in the proper order.

[196] As to the fact that the Helix system is not limited to serial programs, I also agree with Adeia that the fact that it is possible for Helix TV to not infringe by not being limited to serial programs is irrelevant. The same could be said to the fact that it would not capture programs

viewed on linear broadcast television (as opposed to VOD/DVR). The relevant fact is that when a user has several serial programs in his or her media profile, he or she has access to adjacent links to their respective viewing progress and progress point. In that specific case, I am of the view that there is infringement.

[197] With respect to the Helix TV "Recently Watched" interface, Dr. Fox advanced two additional non-infringement arguments. Again, both result in some cases of non-infringement on an STB but continue to result in infringement in other cases on an STB and on the web and mobile applications. He first noted that the "Recently Watched" interface on an STB will display all video programs that have recently been watched, including potentially multiple episodes of the same serial program. However, if a user watches two different serial programs, then they would be side-by-side. Therefore, the system can carry out the essential claim elements.

[198] Dr. Fox also noted that the link to "resume" viewing a particular episode at the progress point on the "Recently Watched" interface on the STB only appears once the user has pressed the "ok" button on the remote, and thus the link does not occur directly in a single selection. But as stated above, nowhere in the Group A Claims is there a requirement that the claimed link take the user directly and with a single selection to the corresponding progress point. The link must only "correspond to" the progress point. Pressing "ok" brings the user exactly to the corresponding progress point.

[199] Finally, and as Dr. Fox conceded, no argument can be made against the "Recently Watched" interface on the web or mobile applications, which show only the most recently

watched episode of each distinct serial program (or other video programming). Each involves a link that brings a user directly from selection of the episode tile into the episode at the progress point, with no intervening selection.

[200] I am therefore of the view that Helix TV "Resume Viewing" and "Recently Watched" interfaces infringe the Group A claims of the 187 Patent, and that it has done so since it was launched in August 2019.

(b) *illico TV "My Resume Viewing" and "Recordings"*

[201] The "My Resume Viewing" interface allows a user to resume viewing programs at the specific point they left off for up to two days after pausing. The episodes listed on this interface can be sorted alphabetically or by "time left". Mr. Said confirmed that, when sorted by "time left", this interface lists the video programming in order of most recently watched.

[202] As explained by Dr. Russ, the illico TV "Recordings" menu will take the essential elements of the Group A Claims where there is sequential recording and watching of programs:

> [I]n a case where a user is sequentially recording and watching episodes, this screen will reflect the viewing progress. There are situations, like Big Bang Theory with the (4) after it, where it's not pointing to a specific episode, in which case it would not carry out the essential elements. But in the case of … a series that's being recorded sequentially and watched sequentially, this screen would carry out the essential claim elements (Russ Cross-examination, p. 343, l. 21 to p. 344, l.7).

[203] With reference to Figure A from the first Russ Report, Dr. Russ observed instances where the "Recordings" menu reads on the claim elements. Since both FBI International and Heartland

1 were recorded, the menu displays the viewing progress for both programs. The two entries correspond to the episode that were most recently watched in both serial programs.

[204] As a result, I find the illico TV "My Resume Viewing" and "Recordings" have presented instances of infringement of the Group A claims of the 187 Patents, since August 2019.

(c) *Club illico/VRAI/illico+*

[205] Club illico/illico+ web (Figure I of Russ Report) and mobile (Schedule D of Russ Report) applications include a "Resume Viewing" menu that creates a media profile comprising a first viewing progress and a second viewing progress. The cover tiles act as links to the progress points within each program, and the system determines progress points in each serial program and depicts them visually by the progress bars.

[206] The VRAI Web interface (Schedule D of Russ Report) creates a media profile comprising a first viewing progress (*L'incroyable famille Kardashian*, episode *"La loyauté à Chicago"*) and a second viewing progress (Below Deck, episode named "Regrets"). The listed items act as links that correspond to the progress point in each of *L'incroyable famille Kardashian* and Below Deck; the system determines the specific time point at which the user left off in viewing each of these programs.

[207] I therefore find that Club illico, VRAI and illico+ have infringed the Group A claims of the 187 Patent, respectively since February 2021, August 2021 and October 2024, while illico+ continues to infringe.

(2) Group B Claims

[208] Adeia asserts that all four of the Videotron Services employ methods that comprise the essential elements of the Group B Claims. As described above, each of the Videotron Services determines the viewing progress and therefore a current episode that corresponds to it.

[209] Each of the Videotron Services offers a viewing option for the user, which allows the user to skip to a subsequent episode, and for the viewing progress to be updated in the user profile:

> (a) For illico TV, when a user is watching a current episode on VOD or from the "My Resume Viewing" menu, upon pressing "Exit", they are presented with a viewing option that includes an option to "View next episode" in the series.
>
> (b) For Helix TV on an STB, when a user is watching a current episode on VOD, at any point they can select an icon displayed in the bottom right that says "Next" and be presented with a viewing option that allows them to "Watch the next episode" in the series. On the web and mobile applications, a user can select an icon displayed in the bottom right corner labelled "Next episode" (*Prochain episode*).
>
> (c) For Club illico / illico+ OTT, when a user is watching a current episode, they are presented with an icon to the right of the play/pause icon labelled "Next" (*Suiv* for *Suivant*).
>
> (d) For VRAI, when a user is watching a current episode, a 'pop-up' viewing option is presented before the episode concludes labelled "Next Video" (*Vidéo suivante*).

[210] Upon selection of these viewing options, the user is brought to the subsequent episode in the series and the viewing progress is updated in the user profile, as visually indicated in each of the various interfaces available on the Videotron Services.

[211] Videotron raises basically the same argument regarding the Group B Claims as they did with the Group A Claims, namely that the Videotron Services do not track “viewing progress”. For the same reasons as provided above, I am respectfully of the view that this argument has no merit.

[212] Videotron also suggests that the requirement for “user profiles” is not met, on the basis that the Videotron Services maintain information at a subscriber level, rather than an individual level. Again, for the same reasons as for the Group A Claims, this position is rejected.

[213] Videotron takes issue with the fact that, in some but not all Videotron Services, after an episode is “skipped”, both the skipped from and skipped to episodes may still be presented as having been partially watched. Videotron reads into the claim element a requirement that the user profile be updated to delete the current episode being skipped. However, all that the claim requires is that the “viewing progress in the user profile [is] updated based on the current episode being skipped”. The key words of this claim element are “based on”. There is no requirement that the prior episode be marked as “skipped” or never presented again. The claim element is met given the user profile is updated to reflect that the skipped-to episode has been watched (in full or partially) and now represents the user’s viewing progress based on the current episode having been skipped.

[214] Finally, Videotron argues that there is no mechanism that permits a user to skip to a next episode in a series without already watching an episode, nor is there evidence of a reliance on

viewing progress in displaying the option to skip forward. Yet, neither of these functionalities fall within the claimed elements of the Group B Claims.

[215] I therefore find, on the balance of probabilities, that all Videotron services infringe, or have infringed, the Group B Claims of the 187 Patent, for the same periods as for the Group A Claims.

C. *Validity – Group A Claims*

(1) Anticipation

[216] Videotron alleges that the Drazin US 2004/237108A1 patent application entitled "Gemstar Development Limited" is anticipatory of Claims 1-3, 5, 7-9 and 11 of the 187 Patent, as of December 29, 2005. In other words, Videotron must convince the Court that if one functions through Drazin, they will inevitably infringe the 187 Patent.

[217] The Drazin prior art reference describes a system for the handling and storing of video content which is controllable by an Electronic Program Guide (EPG) – which has interactive functionality. The Drazin user interface provides information about whether the video content has been viewed by the user. Drazin also discloses displaying, in a grid-like format, lists of stored programs, including series episodes and corresponding viewing progress.

[218] The Abstract section of Drazin describes the invention as:

> A system and method for providing an electronic program guide for television or radio programs includes presenting listings of

> present or future programs on-screen, presenting listings of past programs on-screen and indicating whether the past program is available again at a future time. Also, a system and method for handling information controllable from an electronic program guide for television and radio programs comprises receiving information in a user's system, storing the received information in the user's system, displaying access to the stored information by means of a user interface and enabling the user to select one of a plurality of management options for controlling the operation of the stored information through the user interface.

[219] Paragraph 180 of the Drazin disclosures states the following:

> A viewer's progress into playing a partially viewed program may be shown graphically by rendering the played segment of the program cell bar 420 in a different colour, shade or style compared to the un-played segment. Or, Alternatively, the boundaries between played and un-played segments may be marked with a line, thick or other symbols (not shown).

[220] Drazin presents an EPG mode called "My TV". Different shows can be depicted on this EPG with block cells, with the name corresponding to the show. The viewing progress into a partially played show may be graphically shown. However, there is no indication of what point one has reached in a serial program. For example, in Figure 14a, there are two references to both programs Heidi and Big. No indication that the system is tracking the progress point.

[221] Drazin also discloses "means for displaying information", "relevant to the status of stored information"; the "stored information" being information that has been received, as opposed to having been generated (Drazin at paras 70-75).

[222] Finally, Drazin discloses a history feature for displaying future airings of reruns of episodes a user may have missed. It basically informs a user when a rerun is coming on.

[223] Drazin does not disclose a “viewing progress”, a “progress point”, or a “first link corresponding to the first progress point…adjacent to a second link corresponding to the second progress point.”

[224] Dr. Fox states that Drazin expressly discloses a system that comprises the means of informing the user whether stored information has been viewed by the user and the progress of viewed information. He adds that there is disclosure of an ability to track and display the progress point using the history function, through the rerun function. In its closing arguments, Videotron refers the Court to paragraph 280 of Fox Report in Chief, and paragraph 180 of Drazin. Yet, in his paragraph 280, Dr. Fox rather refers to paragraph 75 of Drazin in support of his opinion.

[225] The relevant excerpt of Drazin reads as follows:

> [0070] According to a ninth aspect of the invention there is provided a method for handling information controllable from an EPG for television or radio programs, the method comprising:
>
> > [0071] receiving information in a user’s system;
> >
> > [0072] storing the received information in the user’s system;
> >
> > [0073] displaying access to the stored information by means of a user interface; and
> >
> > [0074] controlling the selection of one of a plurality of management options for controlling the operation of the stored information through the user interface
>
> [0075] Preferably, system further comprises means for displaying information, preferably visual, relevant to the status of the stored information, such as whether or not the information has been viewed by the user, and/or whether or not the user has elected to

> keep or delete stored information, and/or viewing duration of stored information, and/or the progress of stored information.

[226] There is no mention of a user's viewing progress or progress point in a serial program. It explicitly references the information received by the system but does not inform the user of their progress in viewing a given serial program, which information would be generated, not received.

[227] That said, a reference to paragraph 180 of Drazin might seem a little more helpful to Videotron:

> [0180] A viewer's progress into playing a partially viewed program may be shown graphically by rendering the played segment of the program cell bar 420 in a different colour, shade or style compared to the un-played segment. Or, alternatively, the boundaries between played and un-played segments may be marked with a line, tick or some other symbol (not shown).

[228] However, in cross-examination, Dr. Fox acknowledged that the viewing progress Drazin is speaking to is within an episode, not within the entire series.

[229] Videotron also relies on the "history" function of Drazin as disclosing an ability to track or display the "progress point". Paragraph 146 of Drazin discusses the interactive "history" or "missed" button:

> [0146] The EPG can be generated in such a manner as to allow user to scroll seamlessly between past and future programs, as shown in FIG. 6. Alternatively, the EPG may be adapted to present and future listing as a default setting and include an interactive "history" or "missed" button, which when selected causes the CPU to generate and cause the display of a dedicated past program EPG….

[230] Again, Dr. Fox acknowledged in cross-examination that this “history” function is related to identifying when a rerun would be available in the future.

[231] Dr. Fox also opines that Drazin discloses a user interface display where programs are represented as “cells” which are adjacent to each other, and which act as links to content. Simply put, given that Drazin does not disclose a “progress point”, it cannot disclose an “adjacent links to a progress point”.

[232] In light of the forgoing, it seems clear that Drazin is no “bullseye” and that its focus is almost opposite to that of the 187 Patent. While the 187 Patent is forward-looking, intended to monitor a user’s progress as they make their way through serial programs, Drazin is backward-looking, generally directed towards facilitating watching reruns of past television episodes that a viewer might have missed.

[233] Drazin’s “My TV” mode lists the titles of programs (serial programs or otherwise) that a user has recorded, in seemingly no order, without any season or episode information. It does not monitor and determine a user’s viewing progress through serial programs, and it does not disclose any way for a user to know which episode of a series represents his or her viewing progress.

[234] Accordingly, Drazin does not disclose the essential element of a user’s “viewing progress”. It follows that it does not either disclose determining a user’s “progress point” or “adjacent links corresponding to a user’s progress point” since, on either expert’s construction,

the progress point is based on the viewing progress. Drazin is not anticipatory of the Group A Claims of the 187 Patent.

(2) Obviousness

[235] Videotron alleges obviousness of the Group A Claims by four pieces of prior art (including Drazin).

[236] Videotron did not allege that the skilled person would "mosaic" any two (or more) of these pieces of prior art. Mosaicking is the concept of combining separate prior art references that are not part of the CGK. The party alleging obviousness has the burden of demonstrating that it would be uninventive to link the pieces of prior art (*Camso*, at para 125; *Pharmascience Inc v Teva Canada Innovation*, 2022 FCA 2 at para 33). That is, the party alleging obviousness must show that the skilled person, looking at a particular piece of prior art, would turn to another piece of prior art to supplement the first (*Camso* at para 125; *Biovail Corporation v Canada (Health)*, 2010 FC 46 at para 84).

[237] Videotron had the burden of arguing the mosaic, and of providing expert evidence to show that it would be uninventive to link two or more pieces of prior art. Since it did not, each piece of prior art will be addressed individually.

(a) *Drazin*

[238] Videotron asserts that if the Court finds there are gaps between Drazin's disclosure and the essential elements of the Group A Claims, these gaps would have been directly and without difficulty bridged by the Skilled Person and that, as a result, Claims 1-3, 5-9, 11-14 on the 187 Patent are invalid for obviousness.

[239] Adeia notes that Dr. Fox gave no evidence that a skilled person could overcome any of the gaps without inventive ingenuity. Instead, he simply repeated his anticipation analysis verbatim, in a separate obviousness section. However, there is a distinction between both these concepts. Anticipation is backward-looking and "directed at the very invention in suit" and "assumes that there has been an invention but asserts that it has been disclosed to the public prior to the application for the patent". Obviousness is forward-looking, forbids hindsight and is based upon the state of the art and the CGK, devoid of any knowledge of the invention in suit.

[240] I pause here to observe that most of counsel for Adeia's observations on obviousness bring the Court back to the perspective of this fourth-year student "kid fresh out of university" proposed by Dr. Fox. Yet, this is not the skilled person as described by Dr. Russ, nor the definition retained by the Court. The skilled person of the 187 Patent has at least a few years of experience in the field of pay TV.

[241] That said, Dr. Russ opined that the concept of Claim 1 is inventive. This is because, in part, Drazin effectively teaches away from the inventive concept by simply displaying all

recorded programs, agnostic to a user's viewing progress, for a completely different purpose. The focus of Drazin is on improving access to reruns a user may have missed.

[242] Both Drs. Fox and Russ agreed that there is a gap between Drazin and Claims 6 and 12 (which are not alleged to be anticipated), because they add the essential element of a "summary region" that "indicates a predefined viewing order" for the serial program. Dr. Russ opined that it would have been a "huge leap" and "an enormous amount of work" for the skilled person to arrive at this "important new capability" based on Drazin, since it would require an entire reconfiguration of My TV mode, with the benefit of hindsight. Dr. Russ held in cross-examination: "I don't think that would have been obvious in 2004 [*sic*]. That's why it's not in [Drazin] … it was more commonly the case in 2004 [*sic*] that that information is irrelevant."

[243] Drs. Fox and Russ also agreed that there is a gap between Drazin and Claims 13 and 14 (also not alleged to be anticipated), namely, the requirement for a "user profile".

[244] Dr. Russ explained that the reason why Drazin does not disclose a user profile is because Drazin's content is stored locally and is limited to the content for a single household, there is only ever one "user". In contrast, in a system where content from multiple households is stored remotely (like the Videotron Services), user profiles are needed to differentiate between the multiple users. Thus, not only would it not have been obvious to add a user profile to Drazin, but the skilled person would also not need, or even want, to do so. In other words, Drazin teaches away from Claims 13 and 14.

[245] As for the claims Videotron argues are obvious, they do not provide specific evidence as to what would have been the direct and easy path that would have gone from Drazin to the 187 Patent. It cannot be left to the Court to fill in the blanks.

(b) *Roth*

[246] US Patent Application US 2003/167471A1, published in September 2003 (Roth), describes a system to manage content in a VOD system. Viewer's progress is used by the system to automatically recommend "the next episode in the series based upon the consumer's prior viewings." Roth describes the management of serial video on demand content (SVOD) such as the series Sex in the City – which type of series includes the concept of a "next episode" (i.e. an ordering of the episodes). The Roth reference describes customization by individual users (e.g. family members) which would be understood to utilize a media profile. The system presents the user with their viewing progress within a series. Links for multiple serial programs are displayed in a grid-like manner, which leads to a display for the episodes of the series, which then permits access to the content:

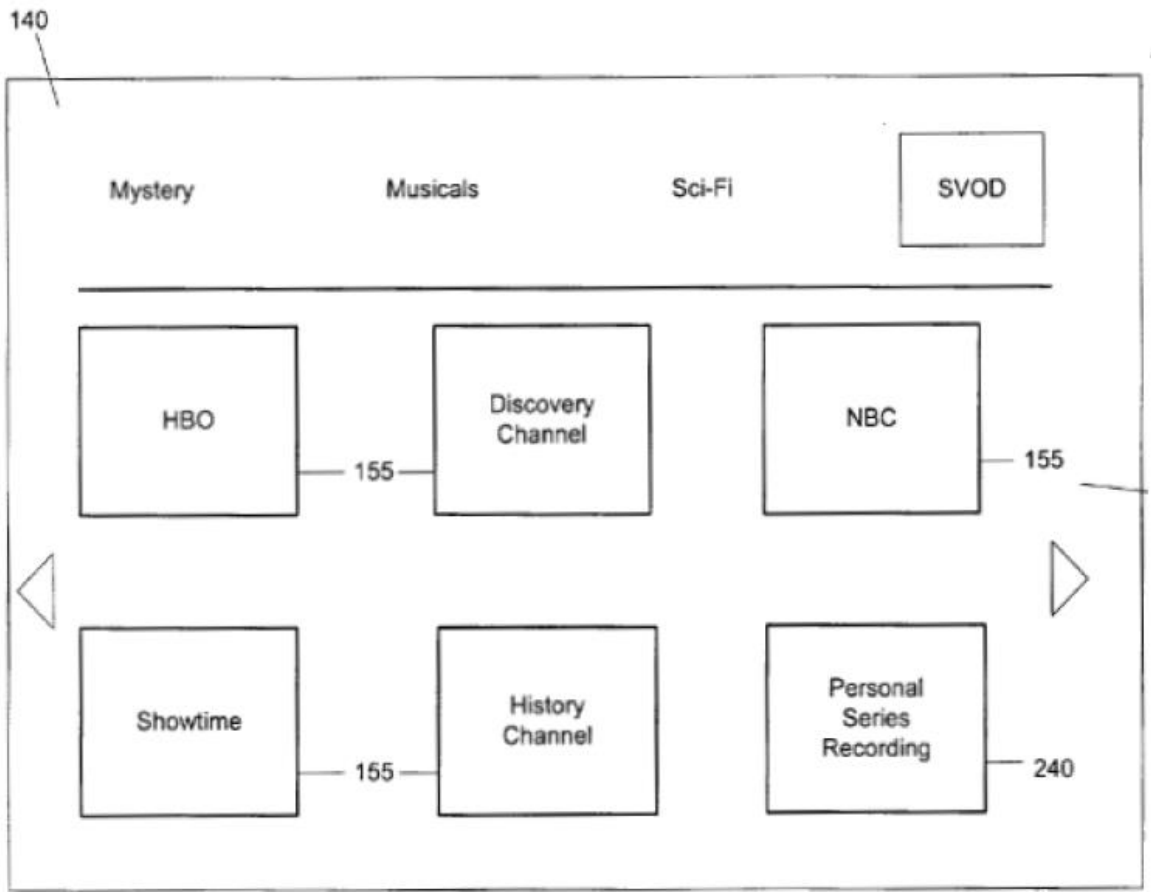


FIGURE 4

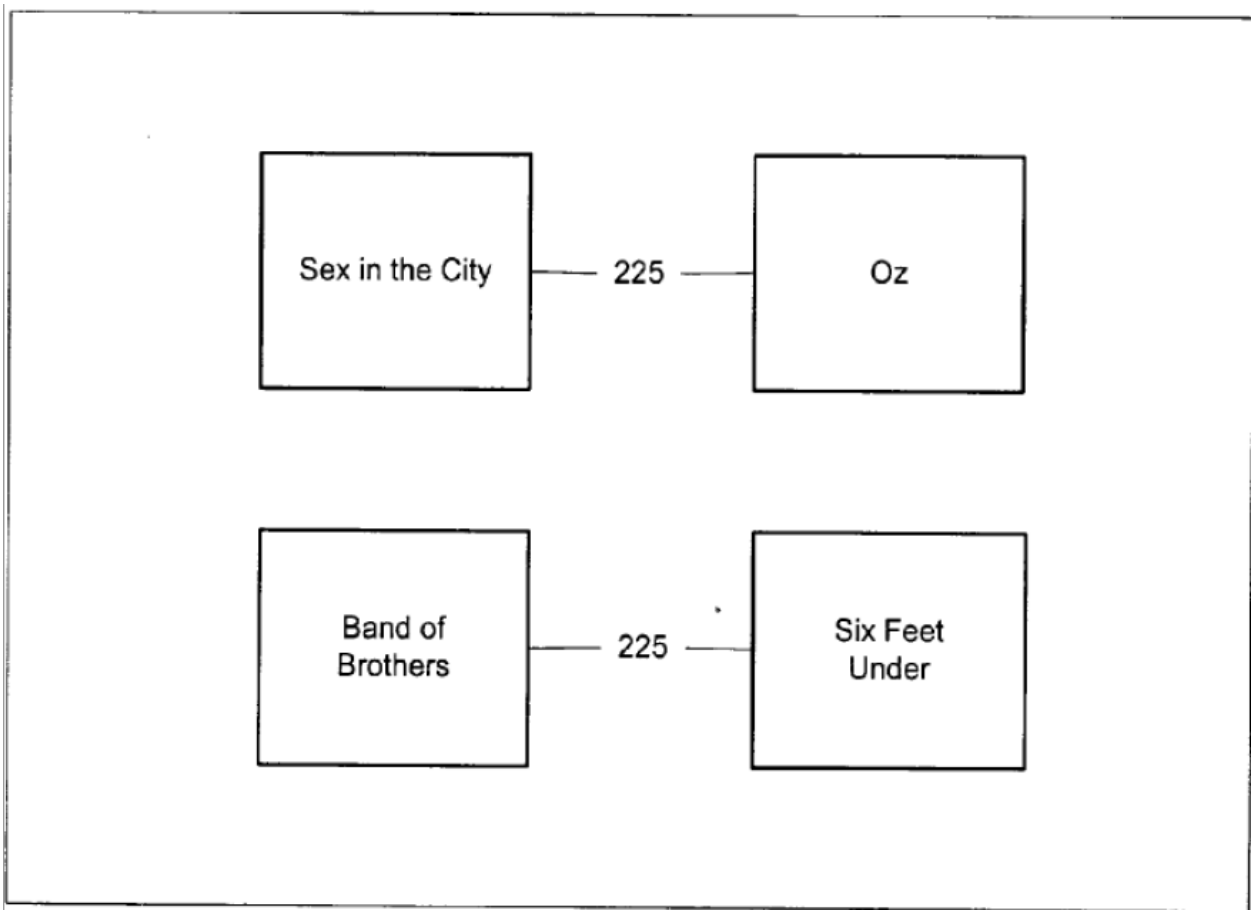


FIGURE 5

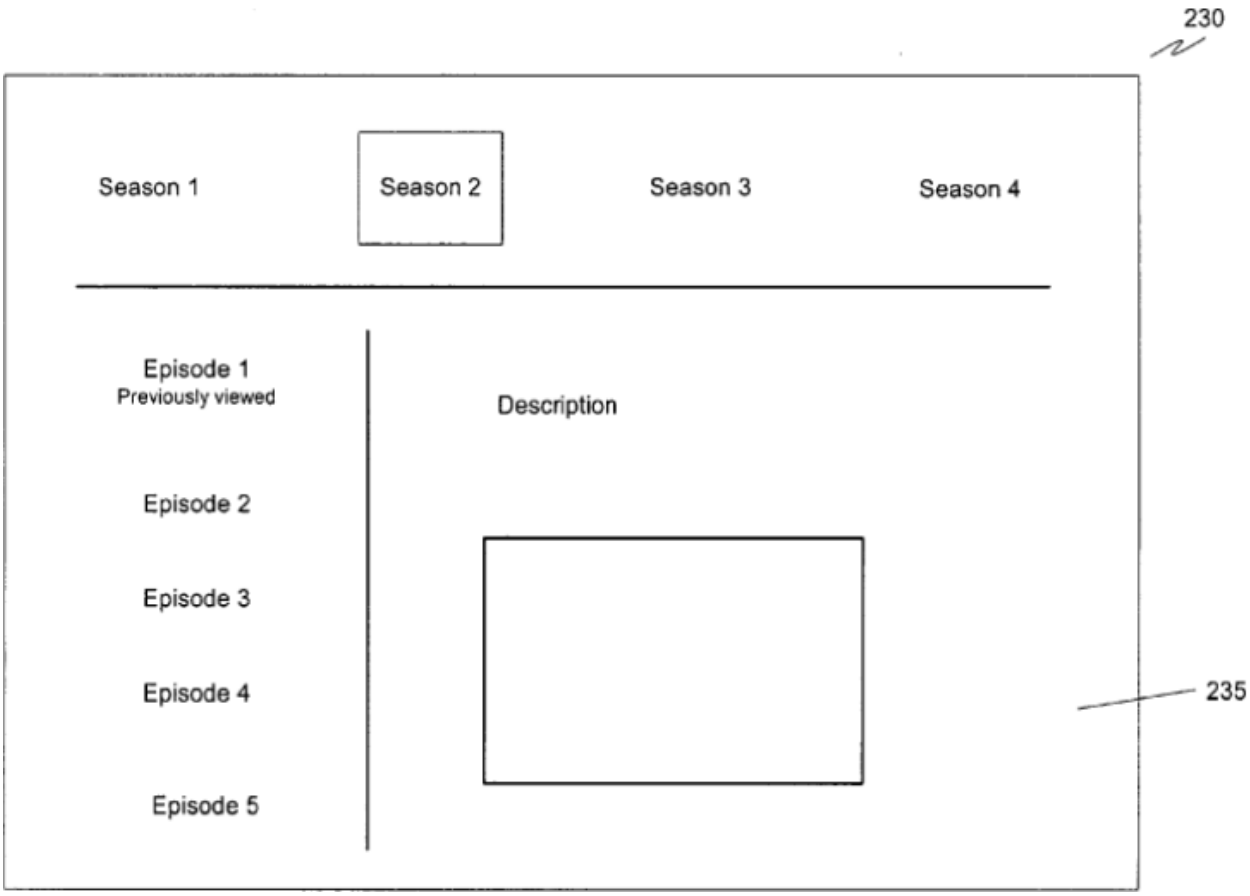


FIGURE 6

[247] Videotron asserts that the person of ordinary skill would have easily, and in a natural and straightforward manner as a clear design choice, included the recommended episode (the "next episode") in the display of Figure 5, particularly in view of the teaching "the VOD guide 135 automatically recommends the next episode in the series." Consequently, Videotron argues that Claims 1-3, 5-9, 11-14 of the 187 Patent are invalid for obviousness.

[248] Adeia responds that Roth is directed towards solving the problem of offering an efficient and convenient way to allow users to find VOD offerings, not to solving the problem of ensuring that viewers watch series episodes in the preferred order, as in the 187 Patent. It's not about

placing adjacent links of two episodes in an interface so one can click and be taken to their episode. This is a management tool that filters one down to a particular level.

[249] Roth discloses an EPG that allows a user to select a particular television channel (Fig. 4), then a particular program from that channel (Fig. 5), and then a particular episode of that program (Fig. 6). The episode page of Figure 6 indicates if a particular episode of a season has been “previously viewed”.

[250] Both experts agreed that Roth has a “gap” with the Group A Claims, namely, it does not disclose displaying adjacent links to multiple serial programs. Rather, as set out in Fig. 6, the only disclosure in Roth is of adjacent links to the same serial program. Dr. Russ identified several additional gaps between Roth and the Group A Claims, primarily the concepts of “viewing progress” and “progress points” (on either expert’s construction).

[251] With respect to the first, agreed-upon, gap, Dr. Russ is of the view that allowing for adjacent links to progress points for multiple serial programs would require an entire reconfiguration of Roth.

[252] Dr. Fox suggests that the skilled person could accomplish this reconfiguration by turning the icons of Fig. 5 into links to the episode representing the user’s viewing progress in each series, instead of links to the episodes page of Fig. 6. Dr. Fox never explained why a skilled person would think to do this without exercising inventive ingenuity, other than by asserting that it would be “a clear design choice”.

[253] If this were true, then Roth would have included such links in Fig. 5. It is unclear what would happen to the episodes page of Fig. 6 in Dr. Fox's reconfiguration of Roth, since it would no longer be linked to from Fig. 5, or why a skilled person would eliminate one of Roth's key elements and frustrate the ability of users to efficiently and conveniently find VOD offerings (which Roth was directed toward addressing). I agree with Adeia that the skilled person "would not see a problem" with Roth: "There is nothing that needs to be fixed".

[254] As stated by this Court in *Janssen-Ortho Inc v Novapharm Ltd*, 2006 FC 1234, aff'd 2007 FCA 217:

> [113] A determination of obviousness on a principled and objective basis requires that the Court take into consideration a number of factors…
>
> > (5) What motivation existed at the time the alleged invention was made to solve a recognized problem? There may have been a general motivation such that anybody in a particular area was looking for a solution. The more unique and personal the motivation was, apart from any general motivation, the more one might be expected to be inventive. If motivation came from an outside source, and common place thought and techniques can come up with a solution, the less one is expected to have exercised inventive ingenuity…

[255] A similar approach was taken in *Allergan v Sandoz Canada Inc.*, 2020 FC 1189:

> [220] Dr. Felton opined that the Skilled Person would not have had any motivation to improve upon the dissolution rate of the formulation disclosed in JP998, because that prior art did not provide any basis for the Skilled Person to believe that any improvement was necessary. In my view, this is confirmed by a reading of JP998.
>
> [221] This is further confirmed by the testimony of both Dr. Felton and Dr. Fassihi, on cross-examination, that the formulation

> disclosed in JP998 would be understood to be an immediate release formulation: Public Transcript, at 113, 446-448. Dr. Fassihi conceded that the Skilled Person would understand from this that "there should not be [a] bioavailability issue" and that the Skilled Person would have no motivation to try to improve the dissolution rate of the JP998 formulation: Public Transcript, at 446 and 448-449.
>
> […]
>
> [225] Based on all of the foregoing, I consider that the Skilled Person would not have had any motivation to pursue the invention claimed in the '002 Patent. The Skilled Person would have had no basis to believe that any improvement in the formulation disclosed in JP998 was necessary or desirable….

[256] Roth's main feature is to bring the user to, for example, HBO. Once the user has clicked on the link, the HBO library opens to disclose its entire offering. So, Roth would have to be reconfigured at the Figure 5 stage to add links that do not exist, simply to achieve a purpose that is not contemplated by Roth. Dr. Fox has not convinced me that this is what would have come to the mind of the skilled person, or that it "would have been a clear design choice", without the benefit of hindsight.

[257] With respect to the second gap, the failure to track a user's viewing progress or progress points, Roth discloses only whether a given episode has been "previously viewed". However, unlike the 187 Patent, Roth does not account for partially viewed episodes. If a user of Roth watches half an episode, that episode will either be marked "Previously Viewed" or not. If it is marked "Previously Viewed", the viewing progress and progress point would erroneously become the subsequent episode. If it were left unmarked, the viewing progress and progress point would be the beginning of that current episode, despite the user having watched half of it.

[258] Videotron has provided no convincing evidence to explain why there would have been a motivation to fix this problem, what the fix would be, how it is that one reading Roth would have tuned into the issue of viewing progress at all when viewing a useful invention for an altogether different purpose.

[259] There is no reason to believe that a skilled person would have even realized that partially watched episodes were not accounted for, let alone devised a solution to the problem. Roth, who, as an inventor, possessed inventive ingenuity, did not. As explained below, Schaffer, who was also an inventor applying inventive ingenuity, did not. Dr. Fox, who had the benefit of hindsight yet did not avert to this gap in his report, did not.

[260] In my view, the skilled person could not have directly and without difficulty bridged either gap by completely reconfiguring a good VOD system disclosed by the inventors of Roth.

[261] I therefore find the Group A Claims not to be obvious based on Roth alone.

(c) *Schaffer*

[262] International Patent Application WO/0207433A1, published in January 2002 (Schaffer), allows a user to keep a view history (raw data) and a user profile which may include processed data. The user profile/view history tracks viewed content by episode IDs which therefore provide information about episodes in a serial program that have been watched. The Schaffer reference describes display of information about shows in a grid, with recommended shows “presented as a

list". Similarly, listing of recommended shows on a grid, without showing already viewed shows, is disclosed.

[263] Videotron notes that it is expressly set out in Schaffer that previously viewed shows are not proposed for "recommendation". Given the ordered nature of serial programming, a user profile which causes the recommendations to include episodes from a series will, by default, recommend the next unwatched episode as manifestly the most obvious choice for recommendations in a series.

[264] Schaffer does not, in the view of Dr. Fox, expressly disclose either the use of links to directly display content or the feature of skipping an episode. However, both gaps would have been straightforward and obvious to bridge: Interactive EPGs were known and the use of a link to take a user from a list of programs to the programs themselves were commonly used. Similarly, the Schaffer reference discloses manual entry of data and the system prompting a user to indicate whether a show has been watched. Using a "mark watched" (i.e. "skip") option would have been obvious as the Schaffer reference describes updating the profile after receiving manual input from the user.

[265] As a result, Videotron asserts that Claims 1-3, 5-9, 11-14 of the 187 Patent are invalid for obviousness.

[266] Adeia agrees that Schaffer discloses a method for recommending television programs, including by determining if the program has already been viewed. However, it highlights the fact

that Schaffer will recommend shows based on desirability and the user's profile and that it specifically states that a previously viewed program may still be recommended since "[s]ome users desire to experience the same content more than once". Dr. Russ opined that the skilled person would understand that this is essentially the opposite philosophy of the 187 Patent, which is focussed on ensuring that users proceed forward in their viewing progress.

[267] Schaffer does not disclose displaying adjacent links to multiple serial programs, nor does it disclose the concepts of "viewing progress" and "progress points" (on either expert's construction). Schaffer is directed at recommending programs that will be airing in the future. It is therefore not possible for a program guide to provide links – let alone adjacent links to progress points of multiple serial programs – to programs that have not yet aired. Dr. Fox even stretched the logic by stating that a link could be inactive until the show is recorded, and when it has been recorded, that link would become active. This is not convincing.

[268] With respect to viewing progress and progress points, Dr. Fox relied on the fact that Schaffer contains information on which episodes have been watched. True, but the purpose of tracking which episodes have been watched, and which have not, is quite specific. If a show is watched, it enters one category. If it is not, it enters another and then those that are watched are identified as areas of interest and that leads to recommendations. The purpose is not about tracking episodes to make sure a person does not get lost in the context of a series.

[269] That does not get us close to the viewing point that is based on the viewing progress. There is no reason for Schaffer to track viewing progress, since it is intended as a

recommendation engine for television programs generally, including previously viewed episodes, but not necessarily the next episode in each series.

[270] Unlike Roth, the inventor of Schaffer did consider the issue of partial viewing. Schaffer applies some sort of threshold as to length of time the show was viewed, at which point an episode would be considered previously viewed. Yet, this still raises all the same problems as in Roth – if that threshold is applied mid-episode, the viewer may be recommended the next episode, only to literally lose the plot.

[271] Shaffer is a good invention, one that is still part of TV watchers experience today, and Dr. Fox did not convince me that the skilled person would have had the motivation to modify it to arrive at the 187 Patent.

[272] I agree with Adeia that it is only with hindsight, about 20 years later, that it could appear obvious to modify Schaffer to account for all the above missing elements to arrive at viewing progress and progress points. The 187 Patent is not rendered obvious by Shaffer.

(d) *Hyper G*

[273] Hyper-G: A Large Universal Hypermedia System and Some Spin-Offs, published in the Journal of Computer Science in April 1995 (vol 1 no 4 (1995), 2006-220) (Hyper-G), provides for video content to be stored and accessed using links. Fundamental to the system is the concept of “location feedback” which provides the user with information about how the information being accessed using the link related to the structural framework which included the information.

A profile was provided to maintain the history and location feedback for content accessed (viewed) by the user.

[274] Dr. Fox states that Hyper-G does not expressly disclose content being serial programs or episodes of TV programs, and they do not disclose tracking of a first and second progress point with corresponding display of adjacent links. However, the opinion of Dr. Fox was that the Group A Claims of the 187 Patent were obvious in view of Hyper-G as the system was designed for the navigation and display of multimedia content, and the documents referenced show Hyper-G being used for content organized in a series. The system is based on links accessing content and the session manager display of content is dependent on the organization of that content.

[275] For this reason, display of content “organized next to each other” would result in adjacent links, and Claims 1-3, 5-9, and 11-14 of the 187 Patent would be invalid for obviousness.

[276] Adeia points to the fact that Hyper-G was a distributed hypermedia system that was designed for large institutions like universities to share information. It adds that it would have essentially been impossible to use Hyper-G to watch television programs, since it was just a primitive form of the internet. So much so that by the claim date, it had disappeared into irrelevance. Even Dr. Fox acknowledged that it was a bit odd for Hyper-G to be brought into the present debate.

[277] I do not believe that more needs to be said about this piece of prior art.

[278] The Group A Claims of the 187 Patent are not invalid for obviousness.

D. *Validity - Group B Claims*

[279] As a reminder that the Group B Claims of the 187 Patent discloses a method for tracking a user's viewing progress in a serial program, retrieving that viewing progress from the user profile and, once the user goes back to the series, he or she is offered the option to skip to the next episode. Should the user choose that option, the user profile is updated for the viewing progress to now be the skipped-to episode viewing point.

(1) Anticipation

[280] According to Videotron, Canadian Patent 2 438 947 (Ellis), published in September 2002, sets out a system for displaying recorded programs and discloses the use of storage of information such as profiles, preferences, viewing history and recording history, for users. The Ellis system maintains a log of all programs viewed by a particular user, it describes a "skip-forward" functionality, and the inclusion of trick play functions. The updating of the log of all programs viewed would be understood to be updated, given the function of the log (to manage which programs should be recorded – i.e. all unviewed programs). As such, Videotron asserts that Ellis plants the flag at the Group B Claims of the 187 Patent as it discloses all the elements of Claims 15-18 and 22.

[281] Ellis is a lengthy patent that discloses many different inventions, including: (i) the ability to set up ongoing "series recordings" of episodes of a television series using an IPG; and (ii)

presenting users with the option to “skip-forward” while watching television by using a recording “buffer”.

[282] For example, if a user is watching an episode of 24, Ellis will simultaneously record the episode in a buffer. If the user presses “pause”, Ellis will continue to record the episode in a buffer. Once the episode ends, Ellis will continue to record the next program, say Desperate Housewives, in a buffer. Ellis’ “skip forward” feature allows the user to skip forward past the remainder of 24 and begin watching the start of Desperate Housewives from the buffer.

[283] First, Ellis lacks disclosure of the essential element of skipping the current episode in a serial program to the subsequent episode in the same serial program. This is because, when a user selects to “skip forward” in Ellis, the subsequent episode to be presented would be whatever program happens to be stored in the next buffer, without relation to the user’s viewing progress in each serial program. The Group B Claims are directed to skipping from one episode of 24 to the next episode of 24, whereas Ellis is directed to skipping from one episode of 24 to whatever comes next on broadcast TV (Desperate Housewives in the above example).

[284] Second, the disclosure of displaying recorded series programs and maintaining a “log” is not to be equated with tracking a user’s viewing progress through a serial program. Ellis discloses a system that allows a user to record a program at 7:30 on weeknights and create a series of recordings that are kept in a “log”.

[285] Third, the "log" is part of an entirely different invention from, and thus completely unrelated to, the disclosure of skipping forward. The skip forward function is specific to the buffer, not the series recordings. As stated by Dr. Russ, "there is nothing in Ellis to bridge these two concepts. One is about managing the process of future recordings, on a PVR. That menu has nothing to do with what you're actually watching. The latter is based on watching live television and switching between live television programs. They don't take into account viewing progress."

[286] Consequently, the remaining elements of the Group B Claims – retrieving a viewing progress, determining the current episode in the serial program, and updating the user profile based on the current episode being skipped – are also not met by the "skip-forward" feature of Ellis.

[287] The law of anticipation requires the prior art to disclose the subject-matter of the claimed invention without the need for "modification, adaptation, or reconfiguration" (*Western Oilfield v M-I LLC*, 2019 FC 1606 at para 147, aff'd 2021 FCA 24).

[288] I am of the opinion that Ellis would never infringe the Group B Claims as it does not have their essential elements. As such, it cannot be said to have anticipated the 187 Patent.

(2) Obviousness

(a) *Ellis*

[289] Videotron also alleges that Claims 15-19 and 22 of the 187 Patent are invalid for obviousness considering Ellis. However, they do not say much on how that would be the case.

[290] Dr. Fox largely repeated his anticipation analysis to conclude that there is no gap between Ellis and the Group B Claims. In fact, considering the above, essentially every aspect of the inventive concept is a gap. Ellis lacks: (i) tracking of viewing progress; (ii) retrieving of viewing progress; (iii) determining a current episode based on viewing progress; (iv) an option to skip to the next episode; and (v) updating of a user profile based on skipping to the next episode.

[291] In the absence of evidence on Videotron's part on the lack of inventiveness required to fill those gaps, I have to rely on the evidence of Dr. Russ. As he explained, the structure of the buffer skip-forward invention of Ellis is incompatible with the structure of the Group B Claims. Unlike the buffer of Ellis, the Group B Claims are based on a PVR or VOD system where the subsequent episodes of the serial programs are available to be skipped to. To redesign Ellis to arrive at the Group B Claims, the skilled person would essentially have to start from scratch.

[292] Dr. Fox's opinion rests on stitching together the series recording and skip-forward aspects of Ellis. However, the skilled person would not read Ellis in this way, nor would they be able to cherry-pick and combine aspects of these two distinct concepts, disclosed 100 pages and several inventions apart in Ellis, without inventive ingenuity. Even if the skilled person wanted

or thought of combining these two distinct inventions in practice, they would not have been able to: "[T]here's not a coherent way that those two are combined", because "DVRs have two completely different file systems, one for live buffers and one for scheduled recordings" (Cross-Examination of Dr. Easttom, February 5, 2025, at 465:4).

(b) *Schaffer*

[293] As for Ellis, Videotron provides very little details as to what in Schaffer would render the Group B Claims obvious. But as stated above, Schaffer does not disclose the concept of tracking a user's viewing progress. Since it does not allow the user to know what the current episode is, the current episode cannot be skipped to the next. Since I already found that the skilled person would not, without inventiveness and difficulty, bridge the gap for the system to determine the viewing progress, Schaffer cannot render the Group B Claims obvious. In fact, Schaffer does not even introduce the concept of skipping forward, the key component of the Group B Claims.

[294] Dr. Fox did not suggest that there were skip functions in Schaffer. Rather, he asserted that it would have been obvious for the skilled person to create a skip option since Schaffer is already disclosing to include a step of 'manually' entering data or inquiring of the user on whether a show should be marked as watched. But even following this theory, the skip function would occur when updating a user profile, not while watching a current episode, and thus would also not present a subsequent episode, both of which are required by the Group B Claims.

[295] In my view, Schaffer does not render the Group B Claims of the 187 Patent invalid for obviousness.

E. *Conclusion of the 187 Patent*

[296] For all the above reasons, I find Adeia's 187 Patent valid and infringed by all four Videotron Services.

IX. The 674 Patent

[297] Like the 922 Patent that will be discussed later, the 674 Patent is one that deals with trick play. It is entitled "Interactive Media System and Method for Selectively Preventing Access to Trick Play Functions." The technology disclosed in the patent can prevent a user from fast-forwarding through designated media of recorded content, like advertisements. The 674 Patent states that advertisers, who paid for commercial timeslots, would prefer that their content not be skipped by users through fast-forwarding.

[298] Just like the 922 Patent, the 674 Patent refers to an existing technology known as TiVo or Restart TV that allows users to press pause during live broadcast and start recording from that point on the live broadcast on the users PVR hard drive. Once the users press the restart button, they resume watching at the point where they had left but what is on is the recorded delayed version of the program not the live broadcast (hence the "trick play" terminology).

[299] The 674 Patent was published in October 2001 and claims a priority date of March 31, 2000. It expired in 2021.

[300] Adeia is seeking a declaration that Videotron's Helix service infringes Claims 35-38, 43-48, 50 and 53-54 of the 674 Patent [the 674 Asserted Claims].

[301] The 674 Asserted Claims are exemplified by independent Claim 35, with key claim terms bolded:

> A method comprising:
>
> playing **broadcast media** with user equipment;
>
> in response to **user input received while the broadcast media is playing, retrieving, from a server, a stored version of the broadcast media and media data** that indicates that the user equipment should be prevented from fast-forwarding through the stored version of the broadcast media;
>
> receiving user input to fast-forward through the stored version of the broadcast media;
>
> in response to receiving the user input to fast forward through the media, **determining, local to the user, whether the user equipment should be prevented from fast-forwarding** through the stored version of the broadcast media based on the retrieved media data; and
>
> in response to determining that the user equipment should be prevented from fast forwarding through the media, preventing the user equipment from fast-forwarding through the stored version of the broadcast media.

[302] The 674 Patent method involves the following: User input (i.e. a trick play request) is received while broadcast media is playing. The system retrieves, from a server, a stored version of the broadcast media (to facilitate trick play). Media data is also retrieved with the broadcast media and indicates there should be prevention of fast-forwarding through the stored version. If the user seeks to fast forward through the stored media, there is a determination, local to the user

(i.e. on the STB), whether the user equipment should be prevented from fast-forwarding and consequently preventing the requested fast-forwarding if so.

A. *Claim Construction*

(1) "Broadcast Media"

[303] Dr. Russ and Dr. Fox generally agree on the meaning of the term "broadcast media." They both assert that "broadcast media" refers to non-interactive media that is transmitted to all users who are simultaneously tuned in to a specific channel at a specific time.

[304] Adeia notes that it is only when discussing infringement that Dr Fox's construction changed. Videotron asserts that Helix uses an Internet Protocol (IP) stream called unicast, not broadcast. Dr. Kienzle (now Dr. Fox) explained that the transmission is not achieved the same way as broadcast, as it is transmission one on one through the internet, although simultaneous to all users tuned in the to same channel at the same time. Videotron adds that it is technically not the same as broadcast and that when one watches a program that is broadcast using the IP technology, there might be a slight delay in transmission (a few seconds).

[305] Dr. Eastman, who was cross-examined on the subject in the context of the 922 Patent, is of the view that the individual streamed transmission called unicast is still broadcast; it is not interactive, and it is delivered to all viewers at the same time. He adds that it might have a different meaning in certain computer networks but in the television world, if the stream is sent to all viewers with the right STB, at the same time, it is broadcast. This is confirmed at paragraph

59 of the Fox Responding Report (speaking to the 187 Patent): “The Helix TV platform provides access to live broadcast content like traditional TV…”

[306] In addition, there is no direct evidence that Helix TV uses unicast. All that Mr. Said confirmed is that it is transmitted via Internet Protocol Television (IPTV). Yet, Dr. Fox acknowledged during cross-examination that there were other ways than unicast to transmit a television signal over the internet.

[307] Considering that both experts agree that broadcast media refers to non-interactive media that is transmitted to all users who are simultaneously tuned in to a specific channel at a specific time, even if individually sent simultaneously to all IP addresses with the right STB, I am of the view that it encompasses those using IPTV or unicast.

(2) “User input received while the broadcast media is playing”

[308] Dr. Russ and Dr. Fox agree that “user input” is unlimited by any particular means of triggering it. However, they disagree on whether “user input” should be construed to mean a single input, i.e., the press of a single button, or if the user input can constitute of multiple actions to trigger the method disclosed in the claim.

[309] Dr. Russ asserts that there is “no limitation in the claim on the means of user input” and that multiple user inputs, i.e., pressing multiple buttons on the remote, is a means of providing input which fits within the method disclosed in the claim.

[310] Dr. Fox is rather of the opinion that the user input is "a first action from the user that the method is responsive to," meaning that a single input, i.e. a single click of a button, is the more accurate construction of the claim. In the table found at paragraph 108 of the Kienzle Report, he states:

> **In response to user input received** […retrieving, from a server, a stored version of the broadcast media and media data…] would be understood as a first action from the user that the method is responsive to, which is initiated by the user while the broadcast media is being played.
>
> […]
>
> **Receiving user input to fast-forward** would be understood as a second action from the user, specific now to fast-forward.

[311] Videotron asserts that "a first action" means a single user input, whereas Adeia states it is simply to contrast it from the "second action".

[312] In my view, Claim 35 requires two steps. A first step is necessarily performed while the broadcast is playing. It is the input that retrieves from a server the stored version of the broadcast media and media data. The second step is the choice of trick play (rewind or fast forward). If the user choses the fast forward, he or she is prevented locally to do so by the retrieved media data.

[313] In other words, the user input that retrieves the stored version of the broadcast media and media data is a single input performed while the broadcast is playing.

(3) "Retrieving, from a server, a stored version of the broadcast media and media data that indicates that the user equipment should be prevented from fast-forwarding"

[314] Dr. Russ and Dr. Fox disagree on whether the claim should be construed to mean that the stored version of the "broadcast media" and "media data" be stored on and retrieved from the same server or different servers.

[315] Dr. Russ asserts that the plain reading of the claim means that the broadcast media is retrieved from "a" server and the media data is retrieved from "a" server, but there is nothing in the claim imposing that it be the same server. Adeia is of the view that Videotron is adding to the claim language when it argues that the media and media data must be stored on "the same server".

[316] It might be true, but Adeia too is adding to the claim language when it suggests that it means "a server or servers".

[317] Figure 1 of the 674 Patent, described as a schematic diagram of an illustrative interactive media system in accordance with the invention, seams to give Videotron's position some support; it depicts the media and media data as being stored on the same server. The user equipment is shown as connecting to a single server even though there are two servers being shown on the slide:

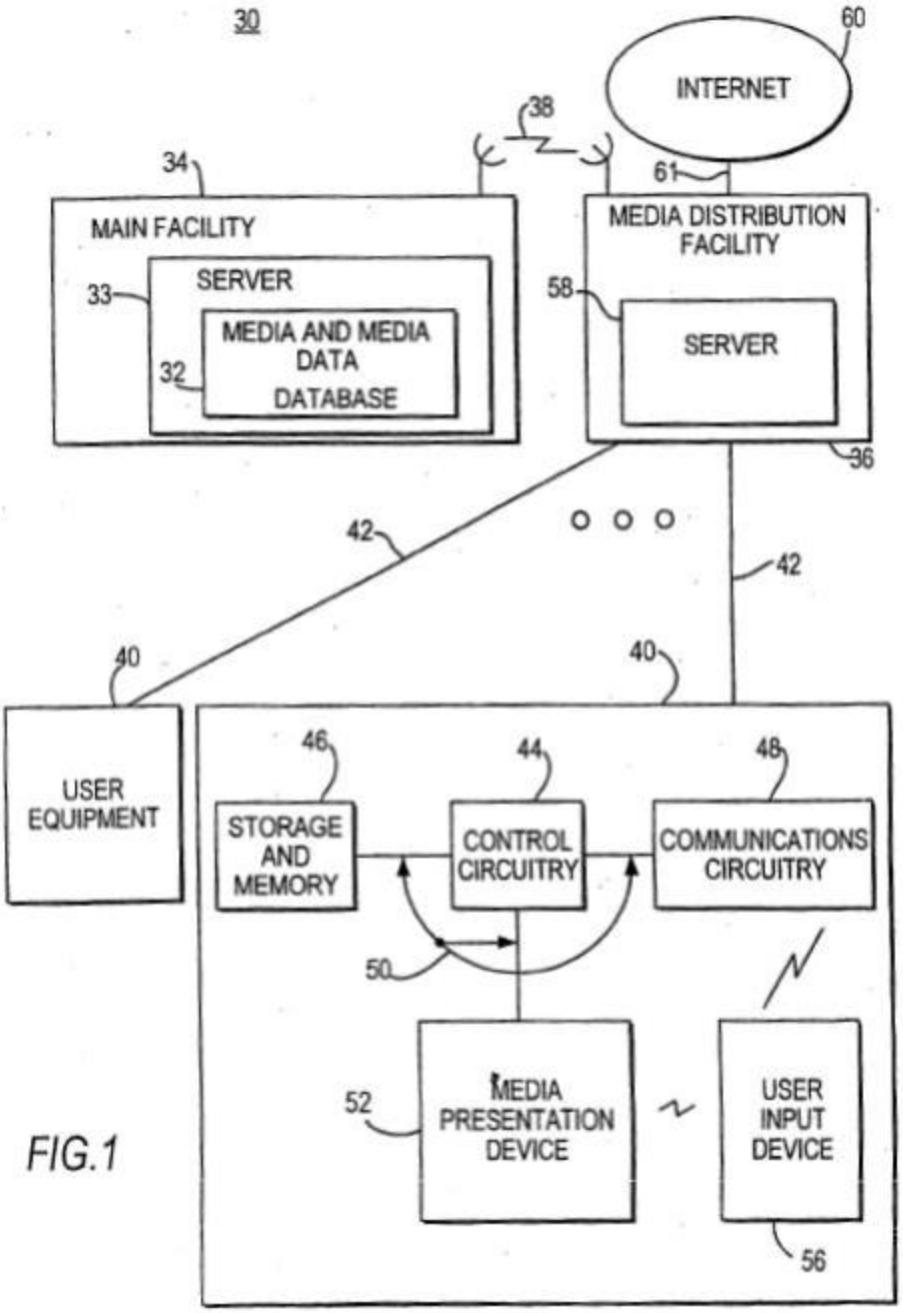


FIG.1

[318] Adeia disagrees and points to paragraphs 37 to 39 of Dr. Russ Reply Report where he states:

> 37. Dr. Kienzle concludes that Figure 1 of the 674 Patent "clearly illustrates media and media data stored *together*" [emphasis in original]. I disagree.

> 38. The 674 Patent disclosure states: “Illustrative interactive media system 30 may include multiple main facilities, but only one main facility 34 is illustrated in FIG. 1 to avoid over complicating the drawing” [emphasis added]. The disclosure of the 674 Patent then goes on to confirm: “Main facility 34 may distribute the media and media data to multiple media distribution facilities 36 via communications paths such as communications path 38” [emphasis added].
>
> 39. Thus, the skilled person would understand that there could be multiple main facilities 34, and thus multiple servers 33, distributing media and media data to multiple media distribution facilities 36 and multiple servers 58, which in turn distribute the media and media data to multiple user input devices 56 (not depicted above)…

[319] Adeia adds that the disclosure expressly addresses the possibility of media data being provided to media distribution facilities from sources other than the main facility, and it expressly discloses the possibility of a broadcast media and media data being received separately by the user equipment, inferring that they come from separate places (674 Patent, 8:6-15, 7:23-28, 8:5-12,:

> Detailed Description of the Preferred Embodiments
>
> […]
>
> …Illustrative interactive media system 30 may include multiple main facilities, but only one main facility 34 is illustrated in FIG. 1 to avoid over complicating the drawing. For clarity the invention will be primarily discussed in connection with the use of one such main facility. Main facility 34 may include server 33 for storing and distributing media and media data from media and media data database 32, which may be used for storing media and media data…
>
> …Server 58 may include a database for storing media, media data, pause-time content or any other suitable content…Server 58 may be based on one or more computers.
>
> […]

> Media distribution facility 36 may receive the media data from main facility 34 via communication path 38. If desired, some or all of the media data may be provided using data source at facilities other than main facility 34. For example, media distribution facility 34 may receive the media data from Internet 60 via communication path 61…

[320] If the media data can only partially be provided from a different source, this implies the possibility of more than one source or more than one server.

[321] In addition, claim terms are to be read in a way informed by the skilled person's understanding of the CGK. Only Adeia discusses the perspective of the skilled person.

[322] Dr. Russ explains that the skilled person would know the advantages of using multiple servers from the CGK of the relevant time frame, such that a claim construction favouring the use of multiple servers would be more likely.

[323] This is because a skilled person would have known, in October of 2001, there's advantages to using separate servers. Dr. Russ offered several reasons for this knowledge, including: the comparatively large file size required for broadcast media compared to media data ("a million-to-one type ratio"); the frequency of access broadcast media compared to media data ("while media data may need to be frequently accessed and edited, video likely would not", and by separating them, "the broadcast media playback would not be impacted by queries related to the media data"); difference in access patterns ("high sustained bandwidth" but with a "very sequential access pattern" for media, compared with "occasional access" that "can be far slower" and "much more random" for media data); the ability to balance user requests workload ("the

broadcast media server is likely to experience much higher traffic" than the media data server); the difference in transmission paths of the two file types (broadcast media "is sent over broadcast, downstream channels" while media data is sent either over a downstream "carousel" or a dedicated "'out-of-band' non-broadcast channel"); and the difference in origination source (studios and networks for broadcast media and third-party providers like Tribune Media for media data) (Russ Reply Report, paras 30-34; Russ Chief, 244:17-23, 246:7-13).

[324] I am therefore of the view that properly construed, Claim 35 does not require the stored version of the "broadcast media" and "media data" to be stored on and retrieved from the same server.

B. *Infringement*

(1) Additional Testing of Videotron's Services

[325] Dr. Fox had to step in quite late in this instance to review the Kienzle reports to testify at the trial and provide expert evidence on all four patents.

[326] Adeia submits that Dr. Fox's infringement evidence in respect of the 674 Patent, and the 922 and 571 Patents, should be given reduced, if any, weight, for failure to comply with the Federal Court's requirements for invited testing.

[327] Counsel from both parties were invited to, and did, watch the opposite party's original infringement testing, in-person in Montreal. Videos and photos were taken and disclosed.

[328] After Dr. Fox was chosen to replace Dr. Kienzle, Videotron arranged for further infringement testing of the Videotron Services in December 2024, in respect of the three patents addressed by Dr. Kienzle. That testing was conducted by Mr. Said and witnessed virtually by Dr. Fox (consistent with Videotron's original testing, which was conducted by counsel and witnessed by Drs. Fox and Kienzle). Videotron did not invite counsel to Adeia to attend that testing, virtually or otherwise, and disclosed no photos or videos of it.

[329] Adeia relies on Section 13 of the Federal Court's "Case and Trial Management Guidelines for Complex Proceedings" that states the following:

> 13. **Experimental Testing (patent infringement/Validity only)**. In an action for infringement or invalidity of a patent, where a party intends to establish any fact in issue by experimental testing conducted for the purpose of litigation, it shall, no later than two (2) months before the scheduled service of its expert report(s) to which the testing relates, provide reasonable notice to the other parties as to:
>
> […]
>
> c) when and where the adverse parties' counsel and representative(s) can attend to watch the experiment(s)…
>
> […]
>
> Unless a party intending to rely on such experiments has so advised the other parties, the party shall not, without leave of the Court, lead evidence at the trial or hearing as to any experiments conducted by or for it for the purpose of the litigation.

[330] Again, those were quite unusual circumstances where the Court was faced with the possibility of a major delay for this trial to commence, strongly opposed by Adeia. The compromise was to grant Videotron a few additional weeks delay before the commencement of

the trial to have Dr. Fox prepared to provide expert evidence on the 674, 922 and 571 Patents. Both parties were satisfied with and benefited from that compromise.

[331] If pursuant to this additional testing, Dr. Fox had requested to make some changes to the Kienzle Reports, I would agree with Adeia. However, Dr. Fox adopted the opinions of Dr. Kienzle without alteration and consequently, there was no change in the expert opinions tendered to the Court due to the testing being repeated for Dr. Fox.

[332] In these circumstances, I do grant Videotron leave to rely on Dr. Fox's evidence as to the additional testing, and I disagree that it should be given reduced weight for that sole reason.

(2) "Broadcast Media"

[333] As stated above, there is a consensus amongst experts that "broadcast media" is non-interactive live media, delivered to all users tuned to a specific channel at a specific time. Therefore, Helix TV is broadcast media as it is exactly what it does.

(3) Helix TV iVOD function (user input)

[334] First, Adeia asserts that the use of the iVOD (instant Video on Demand) "Restart" feature by the Helix system retrieves a stored version in response to user input received while the broadcast media is playing. Figures CC and DD of the Russ Report show that the program "*Quand rien ne va plus*" on History Channel has the iVOD function (it has a blue arrow in a circle right next to the name of the program). Once the user starts watching the program it is live,

but it gives the user two options: press the i button on the remote control and be presented with the option to restart or use the voice remote to restart directly.

[335] In both cases the user is presented with a stored version of the program. If one tries to fast forward the stored version, it is blocked.

[336] Videotron responds that since the iVOD "Restart" feature is triggered by pressing "Info" first, and then "Restart", on the remote control, the "Restart" (user input) is not pressed while the broadcast media is playing, and two steps or inputs are required.

[337] Adeia replies that properly construed, the claim is not limited to a single input and that in any event, "Restart" can equally be done in a single input, by saying "Restart" into the voice remote.

[338] As stated above, I am of the view that the first action (user input) needs to be the one that is performed while the live broadcast is playing, and it needs to be the one that retrieves the stored version of the broadcast media and media data from a server. As such, only the voice remote option includes the "user input" claimed in the 674 Patent.

(4) Retrieving the Stored Version of the Broadcast Media and Media Data from "a Server"

[339] Adeia asserts that the Helix iVOD feature retrieves a stored version of the broadcast media and media data from a server, an essential element of the 674 Asserted Claims.

[340] Dr. Fox opined that the 674 Asserted Claims are not infringed by the Helix TV service because Videotron has chosen [redacted]

[341] As stated above, as long as broadcast media is retrieved from “a server” and media data is retrieved from “a server” – and there is no dispute that they are – then Helix TV would take the essential elements of the asserted claims.

(5) “Local Determination” Suppressing Fast Forward

[342] Videotron brings an additional non-infringement argument related to the requirement that there is a local determination which is responsible for suppressing fast forward. The [redacted] When a user selects fast forward on the remote, the STB verifies the metadata to determine if that operation is allowed.

[343] Videotron refers the Court to Adeia’s prior representation made to the Patent Office during prosecution of the application that led to the grant of the 674 Patent. The Patent Officer took the position that the 674 Patent claims were anticipated by DeLang. As a result, the claims were amended to include the limitation that determining that fast forward should be blocked is perform “local to the user”. Adeia then argued that the amendment rendered the 674 Patent different from DeLang.

[344] DeLang’s server sets out whether the user interface on the STB is allowed to display a fast-forward icon. In other words, the server in DeLang effectively transmits the metadata that sets out the available trick plays and edits the user interface with the STB (Russ Cross, p. 504-505.

[345] Testing carried out and reflected in the Kienzle Responding Report show that there is no basis to conclude that the Helix system operates any differently from DeLang.

[346] Videotron argues that in both DeLang and Helix, metadata is sent from a server to the STB to determine whether fast-forward commands are permitted. Thus, if the Helix system operates in the same way as described in DeLang, then the arguments advanced to suggest DeLang does not disclose the claimed subject matter (i.e. arguments that DeLang does not infringe) must equally apply to suggest Helix does not infringe.

[347] Adeia responds that this argument should be disregarded. Not only does Videotron not plead that Adeia took an inconsistent position before the Patent Office, but such an argument is only permissible in the context of claim construction, not to support a non-infringement argument.

[348] In addition, and as opined by Dr. Russ, the instantaneous appearance of a message indicating fast-forwarding was blocked is clear evidence the determination is being made by the local STB. Helix is thus different from DeLang.

[349] In my view, there is no clear evidence from Videotron that the determination to prevent fast-forward is made remotely with its Helix service. Considering Videotron could have presented that evidence had they wanted to, I prefer Adeia’s position and Dr. Russ’ technical explanation that the instantaneity of the response is a sign of local determination.

C. *Validity*

[350] Videotron alleges anticipation of certain of the 674 Asserted Claims, and obviousness for all of the 674 Asserted Claims, largely on the basis of a single piece of prior art: International Patent Application WO 00/01149, entitled Advanced Television System, published in January 2000 [Wachtfogel].

(1) Anticipation

[351] Wachtfogel is a combination of a STB and a DVR; it allows for the STB to record television programs. The Wachtfogel apparatus may operate as a home server for recording, displaying and deleting programs generated at various terminals in a home network.

[352] Wachtfogel also includes a function allowing to freeze the broadcast television program. When the program is frozen, the apparatus starts recording it. If or when the user resumes watching, the apparatus may resume playing the program from internal memory at the point where the program was frozen rather than the current live program (circular buffer). The circular buffer may be controlled by a smart card that may be operative to disable fast-forward/fast-backward operations on the program stored in the circular buffer so that the user is unable to skip through commercials.

[353] First, Wachtfogel is concerned with trick play, and it does disclose a way of suppressing fast-forward. This part is admitted by Adeia. But Adeia adds that the 674 Patent provides a specific and “elegant” way of doing that, Wachtfogel does it differently.

[354] Videotron notes that Wachtfogel is identified as being from a well-known equipment manufacturer now known as Synamedia. It adds that at a high level, Wachtfogel discloses:

> (a) how one can prevent a user from fast-forwarding through media content, and specifically commercials, including for recorded content and for broadcast content.
>
> (b) that a user may "switch from broadcast television to the stored program in a simple way," and employ a "freeze" command to store broadcast programs while they are being viewed. Wachtfogel also teaches that its apparatus may act as a server.

[355] Specifically, Wachtfogel discloses a "broadcaster set of parameters" which includes a parameter disabling fast-forward (p.6). As explained by Dr. Fox: "Wachtfogel gives a very clear description of exactly how to prevent a user from fast-forwarding through media content, such as commercials." The Kienzle Report discloses a table showing how the Wachtfogel reference discloses the essential elements of Claim 35 of the 674 Patent:

Claim 35 – a method comprising	
playing **broadcast media** with user equipment;	Wachtfogel teaches a user apparatus that may receive broadcast programs and display them on a display.[177]
in **response to user input received** while the broadcast media is playing, **retrieving, from a server, a stored version of the broadcast media and media data** that indicates that the user equipment should be prevented from fast-forwarding through the stored version of the broadcast media;	Wachtfogel teaches that a user may "switch from broadcast television to the stored program in a simple way, "[178] and employ a "freeze" command to store broadcast programs while they are being viewed. Wachtfogel also teaches that its apparatus may act as a server. [179] In response to a user input, media may be retrieved from the memory of Wachtfogel's apparatus when it is acting as a server for another user.
receiving user input to fast-forward through the stored version of the broadcast media;	Wachtfogel teaches that a user may request that the system attempt to fast-forward through the media pulled from the home server.

in response to receiving the user input to fast forward through the media, **determining, local to the user,** whether the user equipment should be prevented from fast-forwarding through the stored version of the broadcast media **based on the retrieved media data**; and,	Wachtfogel teaches a set of parameters that are transmitted to the end user that are then used to determine, local to the user, whether the user's equipment is prevented from fast forwarding through a program.
in response to determining that the user equipment should be prevented from fast forwarding through the media, **preventing the user equipment from fast-forwarding through the stored version of the broadcast media.**	Wachtfogel teaches that the apparatus is prevented from fast-forwarding based on the parameters associated with a program.[180]

[356] Dr. Russ disputes the accuracy of this correlation on two main grounds: i) the "freeze" function described in Watchfogel differs from what is described in the 674 Patent, and ii) the server function which Wachtfogel describes does not allow for local determination of the fast-forward prevention.

[357] Adeia further argues that Wachtfogel does not disclose "retrieving, from a server, a stored version of the broadcast media and media data".

[358] Videotron responds that the alleged distinction concerning the "freeze" function is contradicted by the description in the 674 Patent which relies heavily and repeatedly on the ability to pause a broadcast. Pause can hardly be distinguished from freeze in the context of trick play functions; this is not based on the viewpoint of a skilled person having a mind willing to understand – these are the same operations. In addition, Dr. Russ agreed that Wachtfogel also discloses the use of 'rewind' which would involve a switch to the stored version while watching

the broadcast, and then the blocking of fast-forward on the stored version (Russ Cross, Transcript vol. 3, p. 514, line 3 to p. 515, line 12).

[359] However, I agree with Adeia: the use of the "rewind" function does not allow the "retrieving from a server". That is because although the Wachtfogel apparatus may be used as a server for recording, displaying and deleting material, it does not have the ability to freeze and unfreeze (or rewind) while being used as a home server. As explained by Dr. Russ, the apparatus cannot, at the same time, continue to record the TV program and transmit the program to a different home equipment. Dr. Russ is adamant that in the early 2000s, this would have been very complicated, if not impossible. After all, Dr. Russ developed, in 2003, the first STB capable of functioning as a home network device.

[360] As for the issue relating to the function of the Wachtfogel server, Videotron argues that the evidence at trial was that such a server function was not inconsistent with the requirement that the determination be made locally. While Dr. Russ agrees that the claims of the 674 Patent do not specify where the server need be located, Dr. Fox's position is that Wachtfogel's apparatus could act as a remote or local server for other devices, such as STBs, televisions, or other Wachtfogel apparatus. A local smart card would then control playback from the server.

[361] The local smart card, installed on the user equipment, determines whether that particular user has the ability to fast forward or not. But Dr. Russ explained that while Wachtfogel discloses that the apparatus can act as a home server, it is limited to playing in your bedroom (for example), TV programs you pre-recorded in your living room. Adeia adds that when a smart

card is on the Wachtfogel device, it is the card that precludes the fast-forwarding, so when one is in their bedroom, accessing the server of Wachtfogel elsewhere, the fast-forwarding does not occur local to the user.

[362] There is also a difference in the way Wachtfogel accesses or generates the stored version of the program. When the user selects freeze, the system starts recording in the system's memory the live television what would otherwise be missed. In other words, there is not a pre-recorded version that is stored on a server. When the user unfreezes, the system may resume playing the program from the memory rather than from the current broadcast. As the user is watching the recorded broadcast, stored locally on memory, through the circular buffer, the system continues to record as the program goes forward. There is no server on which the pre-recorded version is stored.

[363] I see those points as being the gaps between Wachtfogel and the 674 Patent that prevents me from a finding of invalidity for anticipation.

(2) Obviousness

[364] Videotron does not provide any specific evidence as to how the skilled person would bridge the gaps between Wachtfogel and the 674 Asserted Claims.

[365] In addition, and as will be further discussed in the context of the 922 Patent, the notion of getting content from a remote server or going to a remote server to get the recorded copy of a

program is expressly disclosed in US Patent Application 2003/0208763 A1 [McElhatten]. However, McElhatten postdates the 674 Patent and is no help in bridging the gap.

D. *Conclusion of the 674 Patent*

[366] For the above reasons, I find that the 674 Asserted Claims are valid and have been infringed by the Helix TV iVOD "Restart" function on voice remote only, from August 2019 to March 2021.

X. The 922 Patent

[367] The 922 Patent is entitled "Interactive Television System with Automatic Switching from Broadcast Media to Streaming Media". It was filed on January 13, 2005, published August 4, 2005. The 922 Patent claims priority to US Patent Application US10/763007, filed January 27, 2004. The 922 Patent expired on January 13, 2025.

[368] In brief, the 922 Patent discloses methods and systems for providing a television user with playback options on a broadcast program by switching between broadcast and streaming versions of a given television program.

[369] The 922 Patent provides that streaming content has several advantages over broadcast content [922 Patent at para 158]:

> A streamed program allows the viewer to control playback;
>
> A streamed program may not require a significant amount of memory or storage because it is received substantially in real time, and thus only a portion may be provided at a time;

> A television distribution facility may provide separate and individualized streams to a plurality of users simultaneously, without being over-burdened by providing network-based control functions to all; and
>
> Playback control by one user need not affect the streams received by other users.

[370] The Background to the 922 Patent explains that television programming that is broadcast to a user and displayed on the user equipment is generally non-interactive. The viewer is unable to control the playback of the program, such as pausing, rewinding, fast-forwarding, or other such features traditionally available for recorded programs or streaming media programs (e.g. VOD). Although playback control features are available to a user if the broadcast program is being concurrently cashed (e.g. by storage on a network-based or local PVR), the cache is generally limited to the portion of the program that has been broadcast and thus, cannot be "fast-forwarded" or skipped beyond the current time. The Background provides that it would be desirable to provide a user with on-demand play control functions while viewing a broadcast television program.

[371] The Summary of the Invention sets out certain embodiments of the invention. The Summary explains that the invention provides for interactive television systems that allow a user to request playback control functions while viewing broadcast television programs on the user equipment. While viewing the broadcast program, the system may be directed to switch from displaying the broadcast television program on the user equipment to displaying the streaming version of the program. This switch appears substantially seamless from the perspective of the user viewing the program. When such a function is initiated by the viewer, an interactive application on the user equipment may identify which program or channel is being viewed and

may provide this information to equipment at the television distribution facility. The user may direct the interactive television application to resume displaying the broadcast television program or the broadcast may automatically resume once the program being viewed reaches its end.

[372] The improvement of the trick play function is therefore the fact that a recorded version of the entire program exists on a remote server, at the distribution facility.

A. *Claims Construction*

[373] The 922 Patent has 30 claims. Claims 1, 6, 7, 13, 15, 20, 21, 27, 29, 30 are at issue [Asserted 922 Claims]. Claims 1 and 15 are the independent claims, with Claim 15 being the "system" version of the "method" of Claim 1.

[374] Claim 1 reads (emphasis added):

> A method for providing a user with playback options while viewing a broadcast television program on user equipment, the method comprising:
>
> providing, from **a remote server**, the broadcast television program that is currently being broadcast to the user equipment;
>
> receiving, with **the remote server**, a request from the user to perform a playback option while viewing the broadcast television program that is currently being broadcast; and
>
> providing a streaming version of a portion of the currently broadcast television program from **the remote server** to the user equipment for use by the user equipment instead of the currently broadcast television program in response to the received request, wherein the streaming version of the currently broadcast television program is generated before the broadcast of the television program.

[375] The primary construction dispute centers on the term, “server” when used in “providing, from a remote server, the broadcast television program”, “receiving, with the remote server a request from the user”, and “providing a streaming version… from the remote server”.

[376] Both experts generally agree that the “remote server” would be understood as equipment or a device that provides a service or functionality, and that the server would not be local to the user requesting the service. The dispute is as to whether the same server needs to perform each of those functions.

[377] Adeia’s position is that “the remote server” need not refer to the same single server for each claim element. Dr. Easttom states that it is common in the television and computer industries to refer to “a server” even though multiple servers may be involved. The skilled person would know as part of their CGK that it would be unusual for a single server to necessarily be responsible for providing both broadcast and streaming versions of a program. The skilled person would therefore turn to the disclosure for clarification. The disclosure makes it clear that the invention is not limited to a single remote server but could involve multiple servers. It states that broadcast television programming can be delivered by “standard non-interactive analog” or digital signals. Conversely, a streaming television is to be delivered by “digital data stream”. Dr. Easttom says that a broadcast server delivered by analog signals would most likely be delivered by a different server than the server delivering digital streaming version.

[378] Videotron’s position is that same single “remote server” must perform each of the distinct steps in the claim. Dr. Kienzle (now Dr. Fox) states that a single server could comprise multiple

computers, but the language used in the claims and the 922 Patent's disclosure makes it clear that the invention relates to a single server. Additionally, Dr. Kienzle opines that, contrary to Dr. Easttom's opinion, the 922 Patent teaches that both the broadcast and streaming content could originate from the same single server. Paragraph 0159 of the 922 Patent states as follows:

> Interactive television system 10 may include television distribution facility 14 that is capable of providing both broadcast programming content and streaming programming content to a plurality of user equipment devices 18. [...] Television distribution facilities may use server 56 (or a remote server 36 may be used) to deliver interactive media streams to users.

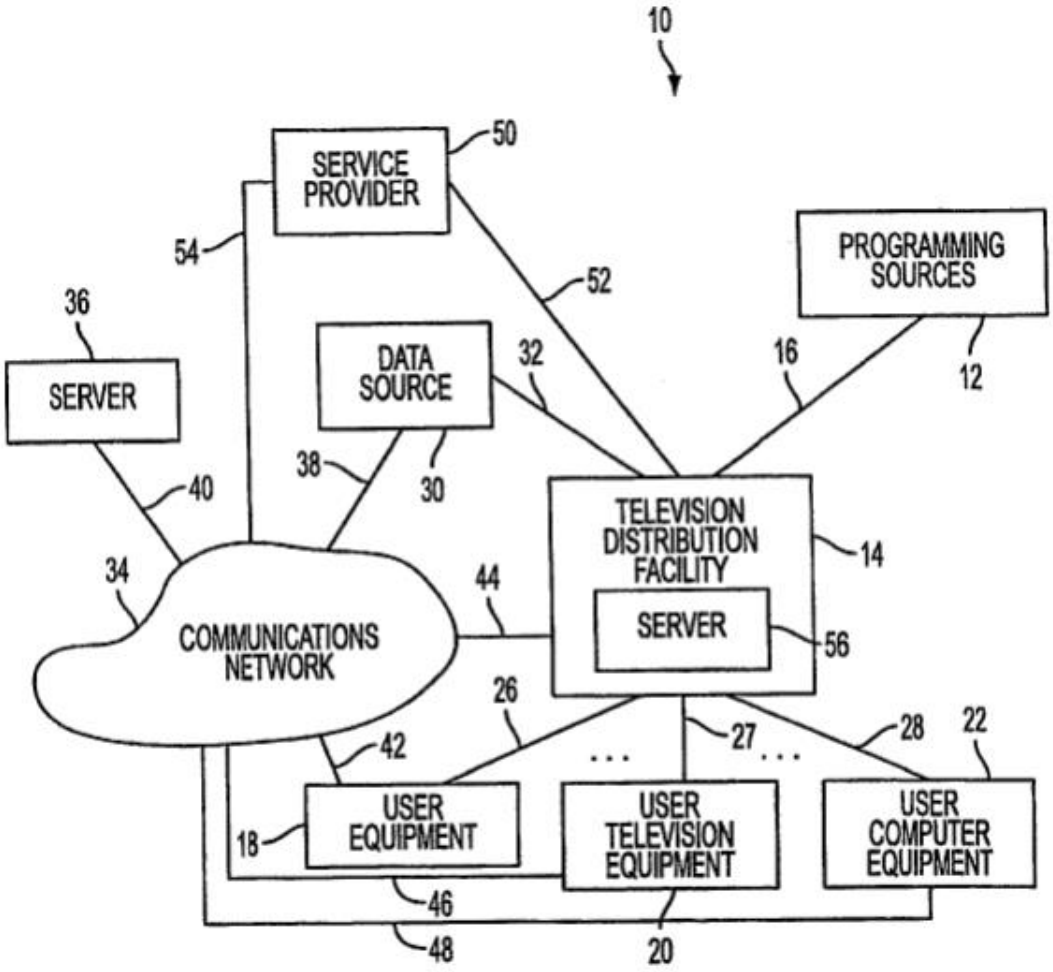


FIG. 1

[379] Videotron acknowledges that Figure 1 does not help the Court understand that the 922 Patent is clustering these servers (36 and 56) together.

[380] Nevertheless, Dr. Fox is of the view that the claims of the 922 Patent are directed to “a” single server embodiment. They refer to a server and then things occur with “the” remote server. According to him, this is depicted in Figure 27:

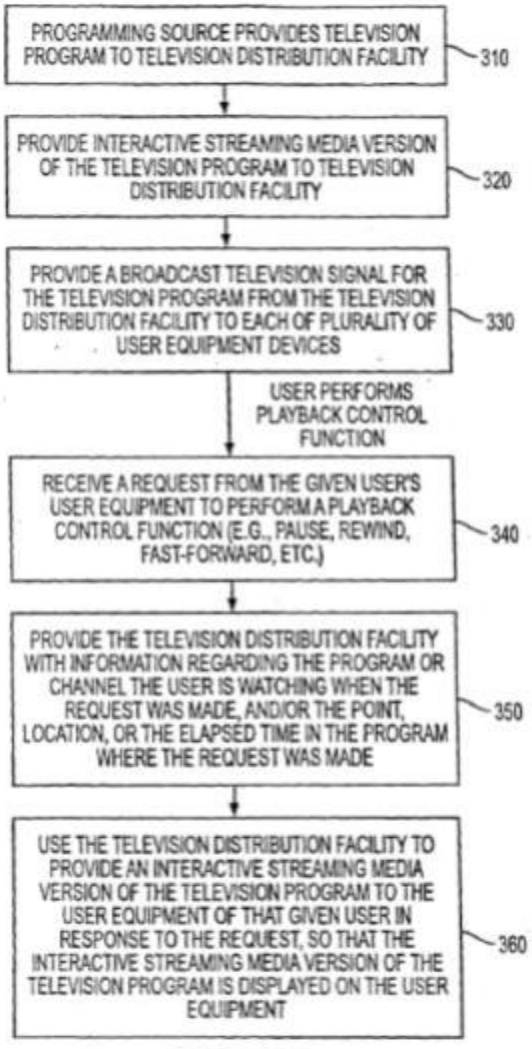


FIG. 27

[381] This figure refers to the television distribution facility throughout which is, in Figure 1, server 56. The flow is coming in an out of a single server, the one located at the television distribution facility. Claim 1 of the 922 Patent simply does not refer to server 36 of Figure 1.

[382] In my view, Dr. Fox's position is more compatible with the terms used in claim 1 of the 922 Patent. The rationale here is similar to the one used for the construction of the 674 Patent, although it leads me to a different outcome.

[383] In the 674 Patent, the claim only refers to "a" server (generically for both the broadcast media and media data), without any reference to "the" server. There were also other reasons to find that the skilled person would foresee the possibility for the broadcast media and media data to come from different servers.

[384] In the case of the 922 Patent, no such evidence was presented and the claim terms lead to a different finding.

B. *Infringement*

[385] Adeia's infringement position relates to the iVOD "Restart" feature on Helix TV. When the viewer presses restart while watching live TV on Helix, and what is currently being watched is already in the VOD library maintained by the Helix system, the viewer will automatically switch to the recorded version of the program and have access to the trick play (rewind, fast-forward).

[386] Videotron first repeats its non-infringing argument that IPTV is unicast and not broadcast, but this was previously disposed under IX.A.(1). Broadcast media or broadcast television program is non interactive television that is viewed by anyone tuned in on the same channel at the same time.

[387] Videotron then turns to the remote server issue or the requirement that the remote server both receives content to store and provide the broadcast programming. [redacted] Neither are responsible for, nor takes any role in, the delivery of the broadcast media.

[388] Considering my previous finding that Claim 1 of the 922 Patent requires the broadcast television program and the streaming version of that program to come from the same server, I am of the view that Videotron's Helix system does not infringe the 922 Patent.

C. *Validity*

(1) Anticipation

[389] Videotron asserts that all of the 922 Asserted Claims, other than Claims 5, 17, and 19, are anticipated by McElhatten published on November 6, 2003.

[390] McElhatten teaches a communication system and method for accessing and reserving programs stored in a network. McElhattan discusses disadvantages associated with the use of the PVRs, including that a PVR only records the last X minutes of program material played on the channel to which the user actually tunes in or records a program from the start if it has been identified in advance of its broadcast (i.e. a scheduled recording). McElhatten claims to overcome the prior art limitations by providing network-based interactive programming and services.

[391] In its second embodiment, McElhatten teaches that "when a user at a set-top box performs a PVR-like function on an in-progress TV broadcast program, the real-time transport stream being received by the terminal is immediately replaced by a second transport stream containing a recorded copy of the TV program."

[392] McElhatten is effectively removing the program recording function from a local device to the network.

[393] Claim 1 of McElhatten claims a method consisting of: (1) receiving content of a program from a content provider before a broadcast thereof; (2) recording the content of the program at a location remote from the user location; (3) broadcasting the content of the program; (4) listing an identifier of the program for a period including a duration before broadcast of the content of the program; (5) receiving a selection by a user of the identifier; and (6) allowing access by the user to the recorded content of the program in response to the received selection.

[394] The Kienzle Report provides a chart which maps the claim elements of the 922 Asserted Claims with where they are disclosed in McElhatten. Dr. Fox opines that McElhatten not only discloses the elements but that its disclosure would also enable the skilled person to put its teachings into practice.

[395] Dr. Easttom asserts that the following elements of the 922 Asserted Claims are not disclosed or enabled by McElhatten: (1) viewing a "broadcast television program"; (2) when the user requests to perform a playback option, "providing a streaming version of a portion of the currently broadcast television program … instead of the currently broadcast television program"; and (3) the streaming version provided being "generated before the broadcast of the television program".

(a) *"a broadcast program"*

[396] Dr. Easttom asserts that the skilled person would recognize that McElhatten does not involve the viewing of a broadcast television program, but a stream. A broadcast program is "non-interactive", it is a television program transmitted to all user equipment tuned to that program simultaneously. In contrast, what is being sent to the STB is an interactive reformatted transport stream, which contains a modified and interactive version of the broadcast television program. Dr. Easttom recognizes that McElhatten uses the terms "broadcast" and "streaming" loosely, and sometimes interchangeably, but he ultimately concludes that because the user may pause, resume, rewind etc., this supports the finding that the reformatted transport stream is interactive and thus a stream, not a broadcast.

[397] I disagree. McElhatten reference expressly describes the real-time transport stream (i.e. the MPEG-2 transport stream used in digital broadcasts) being "immediately replaced by a second transport stream containing a recorded copy." Although Dr. Easttom attempted to suggest that there was only one set of content involved, this is simply not what the McElhatten reference describes in the second embodiment.

[398] In addition, both pre-staged and restart programs are described in the McElhatten reference as being stored programs in the system. Therefore, the replacement of the broadcast "by a second transport stream containing a recorded copy" includes these recorded copies which are identified as being made prior to broadcast. Those are clearly identified as being different, one version being non-interactive, the other one being interactive.

(b) *"Providing a streaming version of a portion of the currently broadcast television program... instead of the currently broadcast television program"*

[399] Dr. Fox opines that this claim element is met as McElhatten teaches that the media processor may receive a request from a user terminal to rewind a broadcast program, the media processor will then retrieve from the head-end storage the rewind trick play file associated with the broadcast program, which will then be streamed to the user that requested it. The skilled person would understand that the trick play file could be a "streaming version" as it is streamed and allows for interactivity. McElhatten also teaches that the same function can allow a user to access a video on demand asset, which could be a "streaming version" as it is streamed and allows for interactivity.

[400] I agree. McElhatten discloses two ways of recording and having available the full program: one is a "pre-staged" asset or prearranging to have the full program; the other is accessing the full program through the "restart" mechanism or "lookback" in the McElhatten reference (although the "lookback" function allows the viewer to watch what was previously broadcast, up to a predetermined period). In one embodiment, the lookback feature enables a user to restart a program that is currently being watched. This is exactly what Adeia says the Helix system does and what is alleged to be infringing.

(c) *"generated before the broadcast of the television program"*

[401] As stated, there is another way to get the full program through what McElhatten calls "pre-staging", that is receiving content of a program from a content provider before a broadcast.

[402] Dr. Fox opines this claim element is met as:

> Claim 1 of McElhatten specifically states that program content can be provided before a broadcast thereof, can then be recorded at a remote location, and only then can be broadcast or accessed otherwise within a "lookback" period.

[403] Dr. Easttom argues that this claim relates to the "Program Reservation" feature of McElhatten which enables a user to reserve past, current and future programs. However, for in-progress programs, the user is limited to the portions of the broadcast that have already been broadcast. Thus, he opines that the streaming version of the television program is created in real-time, as the processor receives the broadcast, reformats it, and either transmits it directly, or via the cache manager, in a transport stream to the user equipment. He says it is generated after the broadcast, not before.

[404] Dr. Easttom is ignoring the second embodiment of McElhatten:

> [0080] …in this second embodiment, when a user at a set-top terminal performs a PVR-like function on an in-progress TV broadcast program, say, rewinding, the real-time transport stream being received by the terminal is immediately replaced by a second transport stream containing a recorded copy of the TV program, e.g., from cache manager 111…

[405] In my view, McElhatten, in its second embodiment, discloses the essential elements of the 922 Asserted Claims, other than Claims 5, 17, and 19, and renders them invalid for anticipation.

(2) Obviousness

[406] Claims 5, 17 and 19 of the 922 Patent deal with means for the user to return to the broadcast of the broadcast television program, may it be at the user request (Claim 17), automatically after a predetermined amount of time (Claim 5) or automatically after the end of the streaming version (Claim 19).

[407] Dr. Kienzle (now Dr. Fox) acknowledges that McElhatten does not explicitly mention returning from the streaming version to the broadcast media either automatically or at the user request. He adds that the return to broadcast is only explicitly described to occur if a user presses the fast forward command on a stored program and catches up to the in-progress version of that program.

[408] However, Dr. Kienzle opines that once it was known to switch from a broadcast program to a recorded version of that program, and that a return to the broadcast version could occur, it

would have been obvious to the skilled person to add a user request to return to broadcast, a return following a predetermined amount of time, or other means of returning to the broadcast program. The change would merely switch the system back to its original state as the ability to switch back was expressly taught in McElhatten.

[409] I accept this evidence and find that Claims 5, 17, and 19 are invalid for obviousness.

D. *Conclusion of the 922 Patent*

[410] For the above reasons, I am of the view that the 922 Asserted Claims, other than Claims 5, 17, and 19, are invalid for anticipation, whereas Claims 5, 17, and 19 of the 922 Patent are invalid for obviousness. In addition, I find that have the 922 Asserted Claims been valid, they have not been infringed by the iVOD "Restart" feature on Helix TV.

XI. The 571 Patent

[411] The 571 Patent is entitled "An Interactive Media Guidance System having multiple Devices". It was published on July 12, 2007, and claims priority to US Patents filed on December 29, 2005. The 571 Patent will expire on December 7, 2026.

[412] The Background to the 571 Patent explains how there may be multiple equipment devices with different abilities and capabilities (e.g., abilities to run interactive applications, high-definition capabilities, and storage bandwidth capabilities) within a home network.

[413] The Summary of the Invention describes various embodiments related to configuring the delivery of data associated with the video programming and configuring the delivery of the interactive media guidance applications to user equipment devices on a home network.

[414] The Summary describes the invention as permitting a user to select video programming (e.g. a television program) for recording using a user equipment device located in a home network, and subsequent retrieval of that programming. The invention provides a server which may determine the available formats of a television program and compare the requirements of available formats of that show with the capabilities of the user equipment devices in a home network to determine the most suitable formats of the television program to record.

[415] In some embodiments, the user may select the format of the content to record. In other embodiments, a server or user equipment device associated with the home network may determine the most suitable formats of the program to record. And in another embodiment, the highest-quality format of the program may be recorded and later translated into the formats that have been identified as suitable for display by the user equipment devices in the home network.

A. *Claim Construction*

[416] The 571 Patent has 47 claims. Claims 1-5, 7, 11, 12, 16, 21-29, 35, 36, 40, 45-47 are at issue [Asserted 571 Claims]. The independent Claims are 1 and 25, where independent Claim 25 is the “system” version of the “method” of Claim 1. Claim 1 reads:

> A method for delivering video programming to user equipment devices in a home network comprising:
>
> storing video programming in a plurality of formats;

> receiving a request from a first user equipment device in the home network to play back the video programming;
>
> identifying a first format of the video programming that is appropriate for the first user equipment device;
>
> accessing the video programming in the first format from the stored video programming in the plurality of formats; and
>
> delivering the video programming in the first format to the first user equipment device.

[417] The parties' primary construction dispute centres on the claim term "home network". Adeia's position is that "home network" connotes a relatively stable and permanent connection of at least two devices. It is not enough for it to be capable of connecting multiple user equipment devices, it must comprise multiple interconnected user equipment devices. The home network must be able to communicate with the head-end and vice-versa, since the method is for delivering (from a head-end) video programming to the networked devices.

[418] Dr. Fox in the Kienzle Report characterizes "home network" as a capability of connecting multiple user equipment devices within a user's home in any suitable configuration. Figure 7 of the 571 Patent show a "home network" in which a plurality of user equipment and a server are implemented in a client-server configuration in accordance with the present invention [571 Patent at para 23]:

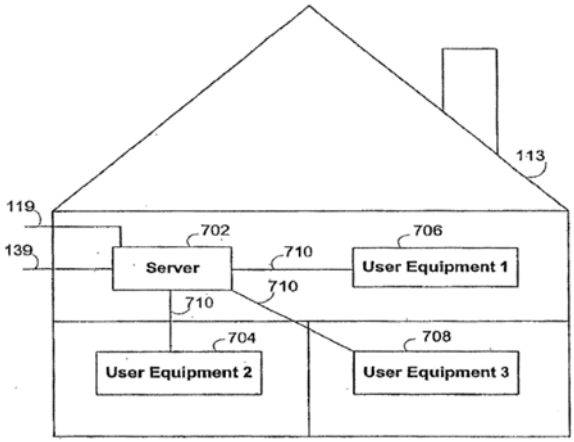


FIG. 7

[419] Dr. Easttom in his in-chief report said that "'home network' carries its plain and ordinary meaning, namely, a collection of electronic devices that are interconnected via communication paths (e.g. by wires or the same local internet connection). The home network could communicate with the head-end" (para 192). In his Responding Report, Dr. Easttom states that a home network "must actually comprise multiple interconnected user equipment devices", "must be relatively stable and permanent" and "must be able to communicate with the head-end, and vice versa" (para 182-184). If fact, Dr. Easttom narrowed his definition to say that a temporary or transient connection would not be considered a home network. Yet, this ignores the fact that the 571 Patent talks about a car (parked in the driveway) or a mobile device being part of the network.

[420] At the hearing, Dr. Easttom agreed that a mobile phone, which can join and leave the home network, is a user equipment device that can form part of the home network, agreeing that

when the mobile phone comes into the Local Area Network (LAN) there is a connection, and it joins the home network.

[421] I agree with Videotron that the patent is concerned with a more fluid arrangement where pieces of equipment can come and go. It doesn't have to have any kind of permanence; it just has to arrange for the interconnection of the different pieces of equipment that join the home network.

[422] The other issue of construction concerns the identification of "a first format of the video programming that is appropriate for the first user equipment device". The parties do not fully agree on what it means but there is important overlap. Dr. Easttom opines that the identification of a first format that is "appropriate" for the first user equipment device is based on one or more of a number of factors, including device capability, network bandwidth and user preference.

[423] Dr. Fox raised no meaningful disagreement and similarly pointed to dependent claims and examples in the patent disclosure to support his finding.

[424] However, Videotron contends that according to Adeia, Dr. Easttom interprets the "identification of a first format" as a step that must depend on several factors. Videotron also accuses Dr. Easttom of maintaining inconsistent constructions of this claim element in chief and response.

[425] I agree with Adeia that Dr. Easttom's evidence is consistent: the claimed method must have the ability to consider several factors and apply one or more of them in a particular circumstance.

B. *Infringement*

(1) Helix TV STB

[426] Adeia contends that all the 571 Asserted Claims are infringed by two features of the Helix TV STB: one that "upgrades" users from high definition (HD) to 4K if they have 4K capability, and one that "downgrades" users from 4K to HD if they do not.

[427] Adeia states that Helix TV can be accessed (and was accessed during testing) on multiple devices that are connected on the same network with communication pathways over the same local Internet connection and are therefore in a home network. Helix TV identifies, accesses, and delivers a first and second format of the video programming based on the capabilities of the device and/or user preference settings. Helix offers a setting whereby a user can "Prefer Best Available Resolution", which is described as defaulting to the best resolution available for video playback. When that setting is on, and an HD channel is requested from a 4K STB and television, the Helix system identifies that a 4K version is appropriate by returning a message and a link to watch the program in 4K. When the user selects the link, the system accesses the 4K format and delivers it to the STB.

[428] Videotron asserts that what rather happens when a user is watching an HD channel on a 4K equipment is the user is informed that a 4K channel exists and the user has the option to press OK and be transferred to this 4K channel. In the reverse, if the user tries to access a 4K channel on a HD piece of equipment, the user is invited to move to the HD channel.

[429] As such, Videotron's first non-infringement argument concerns the lack of evidence that the multiple formats are stored — and not simply transcoded at delivery, and that a request from a user device is sent to the storage device. For example, if History channel has a 4K and an HD version of a documentary, the request would have to come from the user equipment to History channel to meet the essential element of the claim. This does not happen with the Helix system. History channel is unaware that the user has pressed OK to access a different format of the broadcast program. Mr. Said testified to the following:

> The 'linear' content [...] is sent by Videotron to this equipment for [redacted]
>
> (Said affidavit, para 60)

[430] In other words, the linear content goes from History channel to Videotron and [redacted]

All the Helix system does is receiving the live stream, passing it on and provide the user with the option to change the channel to accommodate the user equipment.

[431] Despite this factual evidence, Adeia states that they provide sufficient evidence that the program was not transcoded “on the fly” through Dr. Easttom’s testimony. Dr. Easttom testified that although possible, it would be technically hard to do, and that one would have a hard time going from 4K down, and the STB could not do the down coding.

[432] Although they have the burden to prove infringement, Adeia states that not only was Videotron uniquely situated to prove or disprove that fact, but Videotron have the burden because they are asserting it is possible that instead of the programs being stored in a plurality of formats, there may be no storage and the program may be transcoded upon being delivered to the user’s STB; he who asserts a fact must prove it. Adeia is thus relying on the common law presumption of adverse inference (*Gray v Canada (Attorney General)*, 2019 FC 301 at para 142. See also *Ottawa Athletics Club Inc. (Ottawa Athletic Club v Athletic Club Group Inc*, 2014 FC 672, at para 119, *Apotex v Canada (Health)* 2018 FCA 147, at para 68).

[433] I disagree with Adeia. Considering Mr. Said’s testimony, I am of the view that Adeia has not satisfied its burden to prove that the Helix system allowed for a connection between a stored version of a program in multiple formats and the user’s request to view that program.

[434] Videotron’s evidence is therefore that the live stream [redacted] so that the user is invited to change the channel for one more adapted to his or her equipment.

(2) Club illico, VRAI and illico +

[435] For the web applications of Club illico and illico +, Dr. Easttom explained that there are options to indicate a user preference for a particular format (Quality of reading: low, medium or high resolution) or to allow the system to automatically select the format (by leaving the default "Auto" format selection).

[436] Videotron rather argues that selection of a stream quality between standard definition (SD) and HD is a "feature" of adaptive bit rate technology (ABR), which is a streaming or transport protocol in which bit rate is dynamically adjusted to account for factors such as network bandwidth.

[437] The Kienzle report states that the way ABR works is to allow for an adjustment in how the mechanism works to provide a given resolution. ABR is not taught in the 571 Patent and contrasts with what is disclosed in the patent, that video content is "stored in various stand-alone and separate formats". This evidence was not challenged in the cross-examination of Dr. Fox and Dr. Easttom agreed that ABR did not infringe.

[438] As for the VRAI platform, the plurality of formats is delivered by Videotron's partner Brightcove. Instead of the low, medium and high options, it gives the options of the actual resolution (in terms of pixels).

[439] The same non-infringement argument discussed in respect of the Helix TV, illico TV, Club illico and illico+ web applications apply to VRAI.

[440] I am therefore of the view that none of the Videotron's services infringe the 571 Asserted Claims.

C. *Validity*

(1) Anticipation

[441] Videotron asserts that all Claims 1-5, 7, 11, 16, 21-23 (method) and 25-29, 35, 40, 45-47 (system) of the 571 Patent are anticipated by the U.S. Patent Application US 2004/0237104 [Cooper], published on November 25, 2004. Cooper is entitled "System and Method for Recording and Displaying Video programs and Mobile Handheld Devices".

[442] Cooper is focussed on making PVR-recorded programs available on mobile devices, which previously were not available for various reasons, including the large size of videos for storage and playback. Cooper identifies two needs: first, an ability for a user to operate a mobile device to control various functions of the PVR, such as selecting programs to be recorded; and second, an ability to record in a manner that facilitates transfers and playback on the mobile device.

[443] Cooper discloses an improved PVR that allows the user to select a television program for recording in a conventional (large) display format, a mobile display format, or in both a

conventional and mobile display format. After the selection, the PVR stores the selected television program in one or more encoding formats in a storage device. A remote controller or the mobile device can be used to control the PVR using a graphical user interface, to record a program which is scheduled to be broadcast, and to select the format(s) in which the program will be recorded. Once saved, the program can be played in several ways (television set, computer monitor, mobile handheld device). For a mobile display format, the stored program must be exported to a mobile handheld device, via a wireless transmission or via wired connection to the device. Following viewing of the selected program on either the large display or the mobile display device, the program may delete based on the user-selected deletion criteria.

[444] At paragraph 210 of the Kienzle Report, Dr. Kienzle provides a chart demonstrating how Cooper discloses each of the elements of the 571 Asserted Claims. He then states that Cooper not only discloses the elements, but the elements are also enabled as Cooper provides sufficient instructions to allow the skilled reader to put its teachings into practice.

[445] Adeia asserts that Cooper fails to disclose three elements of Claim 1: (1) a home network; (2) storing video programming in a plurality of formats; and (3) identifying a first format of the video programming that is appropriate or the first user equipment device.

(a) *"Home Network"*

[446] Dr. Fox opines that based on the above description from Cooper, the mobile device, PVR, and large display devices would be understood as being interconnected on what is understood as a local or home network. The PVR and television are connected by wire while the mobile device

may be wired or wirelessly connected. USB and Bluetooth could each have been used to establish a network connection between devices inside a home. At the hearing, Dr. Fox opines that in Cooper, the devices are connected either by wireless or wired connections, which form a network inside a home.

[447] Dr. Easttom disagrees with Dr. Fox, asserting that Cooper describes a direct temporary connection for a single video (either by USB or Bluetooth), which is not a network connection. A home network, as described in the 571 Patent, is multiple pieces of user equipment connected to a server. Thus, he asserts that the skilled person would understand that all the connections of Cooper are not intended to form a home network given that Cooper treats temporary wired connections interchangeably with wireless connections. Dr. Easttom compares this to Figure 7 of the 571 Patent, shown above, which illustrates a home network as multiple pieces of user equipment connected to a server.

[448] At trial, Dr. Easttom states that “home network” means a collection of electronic devices that are interconnected via communication paths, perhaps wires or the same local Internet connection. On cross-examination, Dr. Easttom agreed that “802.11b”, which is mentioned in Cooper, is Wi-Fi, but said that it doesn’t mean it would be used for a home network, but could be used for a one-to-one connection, like Bluetooth as also mentioned in Cooper. In addition, Dr. Easttom admits that Cooper discloses the possibility of more than one Personal Digital Assistant (PDA) at the time connecting to the PVR.

[449] Therefore, looking at Cooper with a mind willing to understand means seeing the reference to 802.11b as a teaching that the disclosure provides for a Wi-Fi connection. This is one of the factors that the Kienzle Report references in concluding that a home network is disclosed.

[450] Paragraph 27 of the disclosures also refers to a mobile device connecting to a LAN:

> [0027] …While in STANBY mode, when the mobile device 25 receives a communication request from the PVR 26, or the mobile device 25 detects that it has entered the range of a wireless LAN connection, the mobile device 25 switches into TRANSFER mod, which consumes more power than STANBY mode. In the TRANSFER mode, data is transferred between the PVR 26 and the mobile device 25…

[451] As stated above, I am of the view that Cooper discloses a home network, as it discloses exporting a video to a mobile device from a PVR via wireless transmission. This description satisfies the definition of home network in the Kienzle Report: a capability of connecting multiple user equipment devices within a user's home in any suitable configuration. It also meets the definition from Dr. Easttom's first report: a collection of electronic devices that are interconnected via communication paths.

(b) *"storing video programming in a plurality of formats"*

[452] Dr. Fox opines that this claim element is met because Cooper provides three recording options to a user: (i) large display/normal format, (ii) mobile/handheld format, or (iii) both. He further states that the large display/normal format may be encoded as MPEG-2 and may include

SD or HD content, while the handheld formats may include MPEG-4, H.26L, JVT, H.263A formats.

[453] Dr. Easttom agrees that if a user selects “both” (“normal” format and “handheld” format) then the claim element is met, but if only one of the first two options is chosen, only a single format of the video is stored, and there is no “plurality of formats” being stored. Thus, when the skilled person employs the method in Cooper, in two out of three instances, the skilled person is not led to this element of claim 1 of the 571 Patent.

[454] However, as the Federal Court of Appeal reminded us in *Steelhead LNG (ASLNG) Ltd v ARC Resources Ltd*, 2024 FCA 212 at paragraph 5, the disclosure of different options does not detract from the fact that one option discloses the essential elements of the claim in question.

[455] On cross-examination, Dr. Easttom was also taken to paragraph 18 of Cooper that talks about having two formats stored on a hard drive, which allows the desired format to be easily retrieved for display and/or retrieved and exported to a mobile device. Dr. Easttom agrees that the 571 Patent and Cooper have this in common but says that Cooper has a different view of formats than the 571 Patent since Cooper is limited to large and mobile formats. Dr. Easttom agreed that there is “some overlap” between “transcoding” in Cooper at para 22 and “translating” in the 571 Patent.

[456] I prefer Dr. Fox’s position on this, and I am of the view that Cooper discloses storing video programming in a plurality of formats.

(c) *"identifying a first format of the video programming that is appropriate for the first user equipment device"*

[457] Dr. Fox opines that Cooper teaches identifying a format appropriate for the request user equipment device as Cooper teaches that the PVR automatically selects the stored large display format or the mobile device format depending on what system (i.e., television or mobile device) the playback request is for viewing on.

[458] Dr. Easttom says that Cooper does not involve any "identification" of a video format that is "appropriate" for the first user equipment device. Rather, Cooper involves a preset and predetermined delivery of the video format based on the nature of the particular device that is connected to the PVR. More simply, the PVR of Cooper does not determine or assess the size of the screen, the available resolution, the network bandwidth, and so on, of the requesting device, it merely determines if it is a mobile device or a television/ computer monitor, irrespective of its capabilities.

[459] I disagree. Just like the 571 Patent, the Cooper system automatically selects the format that needs to be delivered. In finding that Cooper is limited to mobile devices or television/ computer monitors, Dr. Easttom dismisses the relevance of paragraph 41 of Cooper which states:

> [N]umerous modifications to and alternative embodiments of the present invention will be apparent to those skilled in the art in view of the foregoing description. For example, although the present embodiments describe recording the formats for a conventional display and a mobile device display, it is to be understood that other formats for other platforms may be included for recording as such formats and platforms become available.

[460] I am therefore of the view that Cooper discloses “identifying a first format of the video programming that is appropriate for the first user equipment device”.

D. *Obviousness and Double Patenting*

[461] Considering my findings regarding anticipation (and infringement), I do not need to address Videotron’s other invalidity arguments.

E. *Conclusion of the 571 Patent*

[462] For the above reasons, I am of the view that the 571 Asserted Claims are invalid for anticipation. I am also of the view that had the 571 Asserted Claims been valid, they would not have been infringed by the Videotron services.

XII. Comcast and Brightcove

A. *The Parties’ Positions*

[463] Adeia asserts that Videotron’s liability is not excused by what it calls in an inflammatory way “Videotron’s orchestration of infringement”, referring to its decision to sub-contract aspects of its system architecture to third parties. Any cause of action for infringement is grounded in section 42 of the *Patent Act*, which provides that a patentee has the exclusive right of making, constructing, selling and using the invention in Canada. As such, any act that interferes with the full enjoyment of the monopoly granted to the patentee is infringement, and the list of types of infringement that may flow from this statutory provision is not closed. The fact that some of

those steps may be carried out by Comcast (Helix TV) or Brightcove (VRAI OTT), in the United States, is irrelevant.

[464] Acts which take place outside Canada – and which would infringe if carried out within Canada – may also result in liability, under the so-called "Saccharin doctrine", which holds that it is an act of infringement to import a product into Canada where an infringing process or device was used to make it (Stratton, *Annotated Patent Act*, December 2024, at para 16:7, *Monsanto* at paras 35 and 44, *Eli Lilly FCA* at para 18). What is relevant is the fact that Videotron is selling to its customers the use of the patented methods and systems in Canada, without the consent of the Adeia.

[465] As far as Comcast's role in this "orchestration of infringement", these arguments would apply to the findings that the 187 and 674 Patents are infringed by some functionalities of Helix TV. Adeia points to the following facts:

- [redacted]
- All of Videotron's programming and its associated features are available only within Canada, for paying Canadian subscribers, in response to actions taken by those subscribers in Canada;
- [redacted]
- [redacted]
- Videotron pays Comcast for these services.

[466] As for Brightcove, this argument would apply to the finding that Videotron's VRAI service has infringed the 187 Patent. Again, Adeia points to Brightcove's activity led from the United States.

[467] Videotron responds that in fact, Adeia's claims that Videotron is liable are based either on a theory of (1) direct infringement whereby activities of a third party are "attributed" to Videotron; or (2) indirect infringement whereby Videotron is liable due to inducing, having others act as its agent, or alternatively due to acting collectively in "common design" with a third party.

[468] Videotron first asserts there is no authority in Canada that has found infringement under the theory of attribution or common design. Videotron cites the decision of this Court in *Molo Design, Ltd v Chanel Canada ULC et al*, 2024 FC 1260 [*Molo Design*]. However, in that case, Justice Nicolas McHaffie did not rule on whether the theory of common design was applicable to the facts before him, as he ultimately finds that he does not have to deal with the issue considering his finding on direct infringement (*Molo Design* at para 160).

[469] As for the "Saccharin doctrine", Videotron argues it applies to imported products but has not been extended to cases where the essential steps of a patented method are undertaken outside Canada. In the present case, what we have is activities carried out by arms-length, third parties who are not named defendants.

B. *Infringement by Common Design of Two Parties Acting in Concert*

[470] I turn first to the common design doctrine, whereby two parties agree on a common action and, in carrying out that action together, infringe on the rights of the plaintiff. Common design has been accepted in Canada in the context of large torts (see for example *I.C.B.C. v Stanley Cup Rioters*, 2016 BCSC 1108) and occasionally referenced in the context of patent infringement cases (*Molo Design*), although no case of patent infringement has in fact turned on that issue.

[471] The doctrine originates from the United Kingdom. In *Fish & Fish v Sea Shepherd*, [2015] UKSC 10, the Supreme Court of the United Kingdom stated that for a respondent to be jointly liable with the principal tortfeasor, the two must combine to do acts which constituted a tort. That required proof of two elements, the respondent i) must have acted in a way which furthered the commission of the tort by the principal tortfeasor; and ii) must have done so in pursuance of a common design to commit the tort.

[472] In *Bauer Hockey Corp. v Easton Sports Canada Inc*., 2010 FC 361, the Court notes that infringement "by common design" exists in Canada but had not been applied in the context of a patent infringement action at the time of the decision. If it had been, knowledge of the specific patent that was allegedly infringed could form part of the reasoning but would not be a prerequisite for an infringement finding (para 206).

[473] Despite the passing mention of common design in *Bauer Hockey*, the Courts in Canada have since increasingly acknowledged the possibility of patent infringement on the theory of common design, and have cited *Sea Shepherd* as the leading case for the related tort (see for example: *Molo Design* at para 157, *Rovi Guides Inc v BCE Inc*, 2022 FC 979, at para 59; *Adeia Guides Inc v BCE Inc*, 2025 FC 560, at para 7).

[474] In non-patent cases that turned on the notion of common design, the precise content of what the actual common design ought to be is highly fact specific and is tailored to the precise action that occurred.

[475] In *Genentech Inc. v Celltrion Healthcare*, 2019 FC 293, the plaintiff alleged that several pharmaceutical companies were working together to bring a specific drug to the Canadian market, thereby infringing on its patent. In that case, Prothonotary Mandy Aylen (as she then was) accepted the argument for common design in relation to patent infringement, as the evidence led – which included clear delineation of roles that the primary and additional defendants were engaged in – supported the pleading (para 43). She found that "acting in concert" in the context of parties working together to commit a tortious act fell within the scope of infringement by common design, as the two were one in the same (para 41).

(1) Comcast

[476] Given the facts of this case, together with this Courts' increasing recognition of the theory of common design and overarching policy concerns, I find Videotron liable for infringement of the 187 and 674 Patents, on the theory of common design. The concept stems

from the principle of holding someone accountable for their actions towards another if they are working with a third party to further those actions. Put simply, one cannot escape liability for patent infringement by virtue of subcontracting out a portion of the infringing act, or by being but one party to an overall harm towards another.

[477] From 2010 until 2015, Videotron and Adeia (then known as Rovi) had established a licensing agreement, whereby Videotron would license Adeia's patent portfolio, so Videotron could offer services such as its illico TV STB system and the Club illico and VRAI platforms for delivering services to its subscribers. In the fall of 2015, [redacted] while also discussing the renewal of the license with Adeia. This [redacted] included, under the "Detailed Project Description" heading, the following:

[478] The [redacted] Amongst other functionality, it included the "Resume Viewing" function.

[479] Following the end of the [redacted] on December 17, 2015, Adeia and Videotron agreed to formally extend their contract into 2016, and at the end of the year, Videotron elected not to renew the license agreement. Some months later, on August 29, 2017, Videotron announced a partnership with Comcast to deliver an IPTV service using Comcast's XFINITY X1 platform.

This agreement between the two parties is understood [redacted] fulfilled Videotron's requirements.

[480] In cross-examination, Michael Said [redacted]

[481] Not only were Comcast services designed to answer Videotron's specific needs/requirements, but the evidence also shows that for its Helix TV system, Videotron and Comcast were actively engaged in providing the Helix TV system to Videotron's customers. Throughout the Videotron/Comcast relationship, [redacted] Videotron was not a docile party – it was engaged in the acts of infringement. Comcast not being included in this litigation does not bar the finding of common design, as both parties do not need to be named defendants to find infringement by common design (*Sea Shepherd*, at para 55).

[482] I thus find that Videotron infringed both the 187 Patent and the 674 Patent through their contractual agreement with Comcast. In this case, the specific common design, was to launch Videotron's Helix TV offerings with the "Resume Viewing" function, through sub-contracting part of their patent infringement to Comcast.

(2) Brightcove

[483] The situation is somewhat different when it comes to Videotron's liability for infringement of the 187 Patent by common design of the VRAI "Resume Viewing" function. In my view, there is not sufficient evidence of the contractual relationship between Videotron and [redacted] and Brightcove, on the other hand, to find that Adeia has met its burden to prove that Videotron would have participated in the design of the VRAI "Resume Viewing" menu.

C. *The Saccharin Doctrine*

[484] The Saccharin Doctrine acknowledges it may be possible to infringe on an existing patent by importing an invention into Canada and is often used when conducting the purposive step of a statutory interpretation of the *Patent Act*.

[485] The *Saccharin Corp. v Anglo-Continental Chemical Works, Ld.* (1900), 17 R.P.C. 307 (H.C.J.) [*Saccharin*] case confirms a key question that flows from a purposive interpretation of the *Patent Act*: Did the defendant, by their acts or conduct, deprive the inventor, in whole or in part, directly or indirectly, of the advantage of the patented invention? The Saccharin doctrine has been referred to by the Supreme Court of Canada in the decision of *Monsanto* at paras 43-44:

> Infringement through use is thus possible even where the patented invention is part of, or composes, a broader unpatented structure or process. This is, as Professor Vaver states, an expansive rule. It is, however, firmly rooted in the principle that the main purpose of patent protection is to prevent others from depriving the inventor, even in part and even indirectly, of the monopoly that the law intends to be theirs: only the inventor is entitled, by virtue of the

> patent and as a matter of law, to the full enjoyment of the monopoly conferred.
>
> Thus, in *Saccharin Corp. v. Anglo-Continental Chemical Works, Ld. (1900)*, 17 R.P.C. 307 (H.C.J.), the court stated, at p. 319:
>
> > By the sale of saccharin, in the course of the production of which the patented process is used, the Patentee is deprived of some part of the whole profit and advantage of the invention, and the importer is indirectly making use of the invention.

[486] The governing principle is whether the defendant, by his actions, appropriated the patented invention, thus depriving the inventor of the enjoyment of the monopoly.

[487] As stated by Justice Judith Snider in *Pfizer Canada Inc. v Canada (Health)*, 2007 FC 898:

> [90] …when faced with a situation where the question must be addressed, a Court must have regard to such factors as:
>
> - The importance of the product or process to the final product sold into Canada. Where the use is incidental, non-essential or could readily be substituted (such as the Italian scissors example), a Court might be less inclined to find infringement.
>
> - Whether the final product actually contains all or part of the patented product. Where the patented product can actually be identified in the product sold into Canada, there may be a strong case for a finding of infringement.
>
> - The stage at which the patented product or process is used. For example, use of a process as a preliminary step of a lengthy production process may lead to a

> conclusion that the patentee has suffered little deprivation.
>
> - The number of instances of use made of the patented product or process. Where the same patented product is used repetitively through the production of the non-patented end product, there may be clearer evidence that the advantage of the patentee has been impaired.
>
> - The strength of the evidence demonstrating that, if carried out or used in Canada, the product or process would constitute infringement. On this point, my opinion would be that, where there is ambiguity in the evidence, the benefit of the doubt should go to the party using the product or process. This is, perhaps, simply another way of expressing the established principle that the patentee bears the burden of proving infringement.

[488] In the present case, Adeia, who bears the burden to prove infringement, has led very little evidence, if any, purporting to those factors. And beside asserting that the doctrine applied in Canada, which is conceded, and citing opposing counsel's textbook on the issue, Adeia's counsel did not engage in a specific application of the doctrine to the facts of this case.

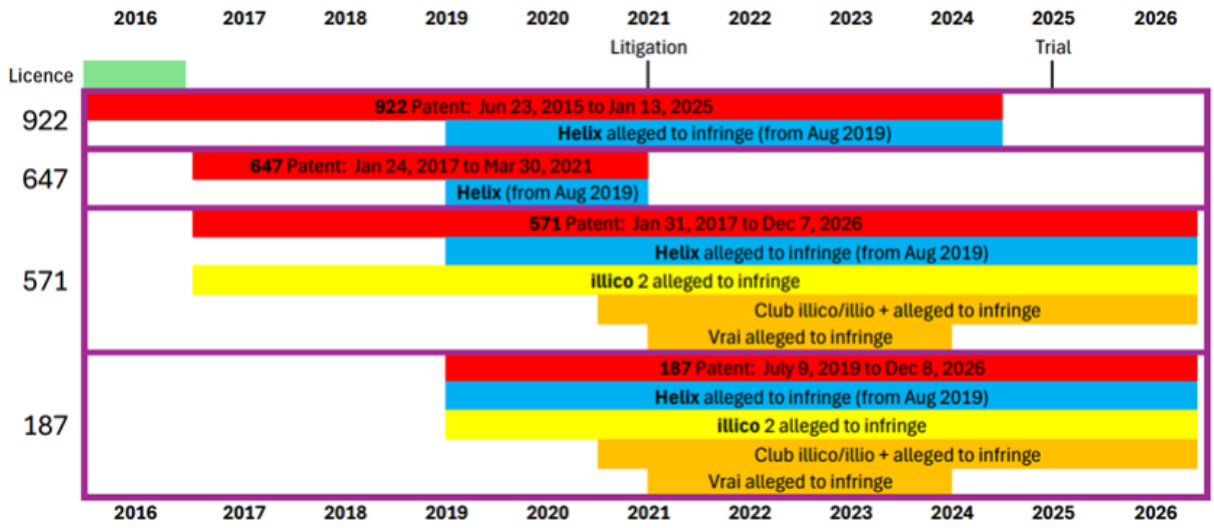
[489] The Court will therefore not assess whether the *Pfizer* factors are met in respect of the infringement of the 187 and 674 Patents. As a result, Videotron will not be found liable for the infringement of the 187 Patent by the VRAI "Resume Viewing" menu.

XIII. Remedies

[490] Adeia seeks two remedies provided by statute: (a) damages, in the form of lost licensing income; and (b) an injunction precluding further infringement.

A. *Assessment of Damages*

[491] I will start this section by reproducing a table that highlights the status of all four patents from the end of 2016 (when the Licence Agreement between the parties expired) to 2026 (when the last two patents will expire). The table contains a typo: 647 should read 674. Otherwise, this table provides a good roadmap for the assessment of damages resulting from the infringement of the 187 and 674 Patents.



[492] Damages focus on the loss suffered by the plaintiff by reason of the defendant's infringement and are aimed at compensating the plaintiff for that loss. Damages may take different forms depending on the business of the plaintiff: "damages may take the form of

compensation for lost profits associated with sales lost or price suppression suffered by the plaintiff by reason of the infringement or compensation for income lost by the plaintiff where it has a practice of entering into licencing arrangements" (*Rovi FCA* at para 93).

[493] Adeia thus asserts that given the nature of its business, which relates to licensing its IPG patent portfolio, damages should be awarded in the form of lost licensing income. Adeia states this should not be confused with damages awarded where a plaintiff cannot establish a loss that requires compensation (because it cannot establish lost sales or a practice of licensing), and damages are nevertheless awarded in the form of a hypothetical "reasonable royalty". The latter requires the Court to determine the terms that the parties would have agreed to had they negotiated a royalty for those specific patents, within the portfolio, that are found to be infringed.

[494] In other words, Adeia is seeking damages equal to the royalty Videotron would have paid had they renewed the licence for the entire portfolio in 2017 (totaling 222 patents under the expired license), either based on the "expired license" [redacted] or based on Adeia's 2017 "soft offer" [redacted] – [redacted], through August 2023, assuming infringement is found as of January 2017.

[495] Adeia adds that damages for lost licensing income are rooted in basic principles of causation and the "perfect compensation" required by subsection 55(1) of the *Patent Act*. The legal test for establishing causation is the "but for" test: conduct in the real world informs and is very important to what would have happened in the "but for" world (*Rovi FCA* at para 132; *Apotex v Merck*, 2015 FCA 171 [*Apotex-Lovastatin*], at paras 41-45, 90). To escape this

straightforward construction of the “but for” world, and to instead apply a “reasonable royalty” analysis, Adeia asserts that Videotron must meet the heavy burden to prove its affirmative defence that, “but for” its infringement, rather than entering into a licence agreement with Adeia (as it had previously), it could have and would have deployed non-infringing alternatives (NIAs). It is only if Videotron meets this heavy burden that the Court need consider an award of a “reasonable royalty”.

[496] Videotron takes issue with the fact that Adeia — who does not itself commercialize its own patent rights — relies on the fact of its own refusal to licence individual patents to seek damages that are not commensurate with the alleged acts of infringement. Adeia seeks purported ‘lost profits’ due to a ‘lost’ patent portfolio licence with Videotron. This effectively treats the four patents in suit as being a proxy for over 200 unasserted patents and applications for which validity and infringement (or usefulness for Videotron) have not been determined. In fact, of those eight patents that have been litigated so far, only two were found valid and infringed whereas six were found invalid (including those four found invalid and non-infringed in *Rovi FC*). Such an overcompensation for any infringement found by the Court, argues Videotron, is directly contrary to the principles of compensatory damages established in Canadian jurisprudence. The Supreme Court of Canada recently confirmed the fundamental principle that damages for patent infringement must be “casually attributable to infringement” (*Nova Chemicals Corp v Dow Chemical Co*, 2022 SCC 43 [*Nova Chemicals Corp*] at para 7). As such, damages in the form of loss license royalty should only be granted for those patents that are found valid and infringed.

[497] I agree with Videotron.

[498] NIAs are useful to assess the real market value of the patent owner's exclusive right, and therefore his expected profit or reward (*Apotex-Lovastatin*, at para 56). This way, only damages causally attributable to the infringement are awarded to the patentee. In my view, this exercise can only be made by looking at patents individually. Section 55(1) of the *Patent Act* states that an infringer is liable for "all damage sustained … by reason of the infringement". The objective is to ascertain the real value of inventions for which a patentee was granted a monopoly (*Apotex Inc v Eli Lilly and Company*, 2018 FCA 217 [*Apotex-Cefaclor*], at para 49).

[499] In fact, Mr. Josh Graham from Adeia admitted he didn't know how many Canadian patents Adeia owned, nor what features Videotron's systems actually had when negotiating a potential licence renewal.

[500] I do not agree with Adeia that for the Court to grant a "reasonable royalty" for those patents that are found to be valid and infringed, Videotron had to prove they had valid NIAs.

[501] Adeia is relying on the NIA factors that are employed in the "lost profits on lost sales" analysis. In such cases, the hypothetical NIA sales are effectively deducted from the actual infringing sales when establishing the lost sales of the patentee. This isolates the lost sales attributable to the infringement. The NIA must therefore be a substitutable product, or a true substitute for consumers, to displace the patentee's sales. This rationale does not apply to the case before me. Applying the but-for world in the way Adeia does would lead us to an undesired

outcome. The damages would not be causally attributable to the infringement of specific features of specific patents.

[502] That said, I do not agree either with Videotron that the evidence clearly establishes it had NIAs available and both would have, and could have, pursued an alternative to infringement. As stated above, the testimonies of both Messrs. Peladeau and Couture were truncated by well founded objections raised on this issue. In any event, Videotron did not even attempt to argue that they meet the *Apotex-Lovastatin* four-part test: (i) whether the NIA is a true substitute, ii) whether the NIA is economically viable, iii) whether the infringer could have sold the NIA, and iv) whether the infringer would have actually sold the NIA.

[503] Adeia highlights the fact that Videotron relies on outdated authorities for the proposition that only a reasonable royalty for the patents that are found valid and infringed should be granted. Adeia adds that Videotron ignores post 2010 jurisprudence, when "our damage law exploded", or post 2015 jurisprudence, when the *Apotex-Lovastatin* decision marked "a sea of change in the law". The reality is that besides the Federal Court of Appeal comments made in *Rovi FCA*, there is no Canadian case law where a Court was asked to grant the loss of the entire license royalty on a patent portfolio as important as Adeia's (over 200), for the infringement of a few patents (two found valid and infringed out of the eight assessed by this Court). This "explosion" of post 2010 jurisprudence relied upon by Adeia all deal with only one or a very few patents.

[504] Adeia's claim for damages is based entirely on the business model of the plaintiff and ignores the causal connection that must be shown between the actual infringement and the remedy to be awarded. As stated by the Federal Court of Appeal in *Apotex-Lovastatin,* "[t]he concept of compensation rejects both under-compensation and over-compensation" (at para 41). For this reason, courts consider closely how the value of a product which incorporates the invention is related to the value of a product that does not make use of the invention. This is one way to ensure that there is an appropriate causal connection between the infringement and the remedy.

[505] In my respectful view, Adeia's position as to what the "but for" test is in this case might be over-simplified; it seams to me that it ignores the ordinary and robust common sense (*Apotex-Lovastatin,* at para 44). It is true that causation is established by the but-for test and that the but-for test is purely factual; Adeia must show on a balance of probability that but for Videotron's infringement of the 187 and 674 Patents, Adeia would not have suffered a loss (*Apotex-Lovastatin,* at para 45). The real question is therefore, but for the infringement of two of Adeia's patents, would Videotron have entered into a license agreement for a portfolio of over 200 different patents. Although Messrs. Couture and Peladeau's testimonies were not taken for the truth of the feasibility of the design around and whether an NIA was a real substitute for the infringing features, they were taken for the fact that Videotron believed it was not infringing, it was not seriously facing an interlocutory injunction, it could easily design around any feature found to be infringed, and as a result, it would not have signed a licence agreement for the entire portfolio.

[506] And that is consistent with Adeia's suggestion that if the Court does not find the 571 Patent valid and infringed (which is the case), it does not claim the loss royalty for the portfolio as of January 2017. So as the Court only finds the 187 Patent and the 674 Patent to be or have been infringed, in Adeia's but for world, the portfolio license would only have been entered into in July or August of 2019, and for the 674 Patent, it would only have covered the period from August 2019 to March 2021. In that context, when exactly did the real world and the hypothetical world diverge. Not in January 2017. There is something in this but-for scenario that goes against a robust common-sense analysis.

[507] In fact, if the Court was to grant Adeia the royalty loss on the entire portfolio, wouldn't that be theoretically akin to revisiting the Federal Court of Appeal's decision in *Rovi FCA*, at least for the four patents that were in suit in that case?

[508] The task for the Court is rather to create the most realistic but-for world (*Apotex-Cefaclor*, at paras 112-113). Causation requires the Court to assess the damages suffered by Adeia as a result of the infringement, hence the need to create the legal fiction of the but-for world. If we isolate only the damages caused by the infringement, Adeia is entitled to royalty in respect of each unauthorized use if its property, nothing more (*Electric Chain v Art Metal Works*, [1933 SCR 581] at 590).

[509] However, Videotron cannot take issue with the fact that Adeia is seeking royalties to the date of the judgment in this action. If damages are assessed on the basis of a "reasonable royalty" for those patents that are found to be valid and infringed, and not of a hypothetical renewal of the

portfolio license, the duration of that license agreement is irrelevant, and damages cannot be limited to a period of 2 or 5 years (until 2019 or 2022). Damages should be calculated by considering the time the Videotron services found to be infringing were available, as well as the validity of the infringed patent (i.e. by referring to the above table).

[510] In round one on the litigation between the parties, Rovi (now Adeia) was seeking an accounting of Videotron's profits as remedy for the alleged infringement of four patents. As stated above, the Federal Court of Appeal was critical of the way this Court applied the test to determine whether this equitable remedy was appropriate. In reviewing the way with which this Court assessed the complexity of the calculations for an accounting of profit, Justice Mary J. L. Gleason found no error in the analysis. She stated the following (*Rovi FCA*, at para 127):

> This finding [that the complexity of the required calculations was a basis for denying the requested accounting of profits] was open to the Federal Court in light of the nature of the calculations put forward by Rovi's expert. These were based on a market reconstruction premised on Rovi's entire patent portfolio, and not just the claims in suit, and included the profits earned by Videotron relating to cable TV content subscriptions as well as its non-TV lines of business, which did not involve technologies similar to those claimed in the Patents. There was ample basis for the Federal Court to conclude that the methods proposed by Rovi's experts would not allow the Court to arrive at a reliable and appropriate amount for profits earned by reason of any infringement, had it found the claims valid. There is thus no error in the Federal Court's treatment of this issue.

[511] Just as in the present case, the Federal Court of Appeal agreed that a calculation of the appropriate remedy based on the entire portfolio did not follow a realistic approach.

[512] Justice Gleason saw no error either in the Federal Court's adoption of a reasonable royalty analysis given the way the case was argued before it (*Rovi FCA* at para 132), considering Rovi sought a reasonable royalty as opposed to damages for lost royalty income premised on its previous licence with Videotron. Adeia argues this means the only remedy that can be granted is the total royalty charged for the entire portfolio. I disagree. In my view, a royalty can be premised on the previous licence and yet be apportioned to only compensate for the damages caused by the infringement of two patents (out of over 200).

[513] When discussing more generally the principles applicable to the assessment of damages under subsection 55(1) of the *Patent Act*, Justice Gleason states the following:

> [94] However, there may be circumstances where a plaintiff cannot establish that it has lost sales and has no relevant practice of licencing **the invention** that the court accepts as the basis for measuring damages. In such circumstances, a court may award damages calculated via a hypothetical "reasonable royalty" on the sales made by the infringer: *Nova Chemicals* at para. 7, citing *AlliedSignal Inc. v. Du Pont Canada Inc.* (1998), 78 C.P.R. (3d) 129 (F.C. (T.D.)), at para. 199 [*AlliedSignal*]; *Unilever PLC et al. v. Proctor & Gamble Inc.* [1993] F.C.J. No. 117, 47 C.P.R. (3d) 479 (FC), aff'd [1995] F.C.J. No. 1005, 61 C.P.R. (3d) 499 (F.C.A.) at 571 [*Unilever*]. Setting the hypothetical reasonable royalty rate in this fashion requires the court to determine the terms that the parties would have agreed to had they negotiated a royalty. As noted in *AlliedSignal*, "[t]he test is what rate would result from negotiations between a willing licensor and a willing licensee": at para. 199. (My emphasis)

[514] Adeia is not in the practice of licencing **an invention**, it is in the practice of licencing an important portfolio of patents. The proper royalty/remedy, in this case, could be the same as a royalty income premised on the previous licence or on the 2017 "soft offer". Since the parties did not previously enter into licence agreements for the 187 and 674 Patents, the Court is tasked with

assessing what rate would result from negotiations between a theoretical willing licensor (not Adeia, as we know Mr. Graham was not a willing licensor for individual patents) and a theoretical willing licensee for those two patents (*Nova Chemicals Corp.* at para 7, citing *AlliedSignal Inc. v Du Pont Canada Inc*. 1998 CanLII 7464 [*AlliedSignal*], at para 199). And that assessment can be premised on the previous licence or on the 2017 "soft offer", with the necessary adaptation, as these are the only indicia the Court has.

[515] The challenge is that it is practically impossible to analyze each patent in the portfolio to assign a value for that patent to Videotron (and to Adeia), or even comparative value between all the patents in the portfolio. In fact, [redacted] What we know is that it generally increases and decreases over time, as new patents are granted, and old ones expire. The portfolio includes every patent owned by Rovi/Adeia that it believed related to IPG or to products ostensibly using IPGs but does not provide a specific list of patents.

[516] In January 2015, Adeia provided Videotron a gross list of its approximately 286 pending and issued Canadian patents. It is unclear however whether they are all IPG related or not.

[517] Adeia has offered no evidence on royalty rates or value for the Asserted Patents. In fact, Adeia's technical experts admitted in cross-examination that they had no idea as to what IPG features were of greater interest for Videotron subscribers or in the market more generally.

[518] However, the parties had a prior history, and it was found on the facts that there was a new proposed license that Adeia had presented on December 7. Mr. Graham testified that this new proposal [redacted], which is useful evidence in determining the starting point for the calculation of the royalty to be paid for the two infringed patents. Thus, the royalty analysis will focus on the royalty rate that Videotron would have paid to Adeia if Videotron had come to license the 187 and 674 Patents during the infringing period. The basis for the calculation will therefore be by the proposed license rate put forth by Adeia's expert, Mr. Harington, minus [redacted]; the entire portfolio license fee would therefore have been [redacted].

[519] Videotron's expert, Mr. Martinez, has put his mind to the issue of apportionment and applied to his analysis the fifteen or so factors that the courts in Canada and the US respectively, have identified as being potentially helpful to adjust or identify an appropriate royalty rate (*AlliedSignal*; *Georgia-Pacific v United-States Plywood Corp.*, 318 F. Supp. 1116, 1120-1121 (SDNY 1970), modified and aff'd, 446 F. 2d Cir)).

[520] Mr. Martinez identified the following data points and considerations that would have been found relevant to the hypothetical negotiations between the parties for license rights for the Asserted Patents:

- The 2010 license for the full portfolio of Rovi IPG patents for monthly per subscriber license fees ranged from [redacted] (*Georgia-Pacific* Factor 1);
- No evidence that Videotron generates incremental revenues or earns incremental profits due to the inclusion of the functionality allegedly claimed by the Asserted Patents (*AlliedSignal* Factors 8-9, 12);

- The relatively minor benefits of the Asserted Patents compared to prior art methods (*AlliedSignal* Factor 10);
- The existence of *potential* non-infringing alternatives to the Asserted Patents that could have been implemented by Videotron between January 2017 and August 2019 (*AlliedSignal* Factor 6);
- The relatively minor contribution, if any, of the Asserted Patents compared to the value of Videotron's technical and commercial contributions and Pay-TV content (*AlliedSignal* Factor 8-9, 12); and
- The assumption of validity and infringement of the Asserted Patents.

[521] I am of the view that the evidence supports a conclusion that the appropriate royalty for the 187 and 674 Patents, is as calculated by Mr. Martinez, namely a scaled rate based on the Adeia's January 2017 proposition, minus [redacted].

[522] Using the same formula used in his report, Mr. Martinez is therefore directed to isolate the royalty rates, or license fees, attributable to the 187 and 674 Patents apart from the total number of other Adeia IPG Patents included in the 2017 proposition, with the understanding that the "R" variable in Table 25 (below) is determined for each of the cable, mobile and online services based on the 2017 offer, [redacted] rather then on the 2010 Rovi/Videotron licence:

Variable	Equation	Description
Full Patent Portfolio Rate	R	The rate for a given full patent portfolio
Relevant Patents	P_A	The number of relevant patents being considered within a given patent portfolio
Full Patent Portfolio	P_{IPG}	The total number of patents in the given portfolio
Relevant Patents Share	$S = \frac{P_A}{P_{IPG}}$	The share of the relevant patents relative to the full portfolio
Apportioned Portfolio Rate	$\boldsymbol{L = R \times S}$	The portion of the portfolio rate attributable to the relevant patents

[523] The parties' experts on remedy will be directed to confer and validate Mr. Martinez's resulting data.

B. *Is an Injunction Warranted*

[524] Considering the above finding, an injunction can only issue with respect to the 187 Patent, the only patent that is found valid and infringed, on one hand, and not expired, on the other hand.

[525] A permanent injunction is rarely denied to a successful patentee. As such, the Court should only refuse to grant a permanent injunction to a successful patentee in very rare circumstances (*Rovi v Telus*, 2024 FCA 126 [*Telus FCA*], at paras 119, 125).

[526] Contrary to Videotron's argument, a permanent injunction should not be denied merely because a patentee chooses to commercialize its patent by licencing it (*Telus FCA*, at para 128).

[527] Videotron did not convince me that the circumstances of this case are such that I should depart from the norm which is to refrain the infringer to continue infringing on a valid patent. Videotron has asked that the enforcement of any injunction be delayed by three months to allow Videotron to design around the features of the 187 Patent that are found valid and infringed; I will grant them 30 days from the date of this judgment.

[528] Finally, I am of the view that in the context of this file, where the features alleged to infringe are a very minor part of the whole TV offering to Videotron's customers, the delivery up remedy sought by Adeia should not be granted.

XIV. Conclusions

[529] For the above reasons, Adeia's claim is granted in part, so is Videotron's counterclaim.

[530] Adeia's claim is granted with respect to the 187 and 674 Patents.

[531] I find the 187 Patent valid and infringed by the following Videotron services:

> Helix TV "Resume Viewing" and Recently Watched" interfaces have been infringing the 187 Patent since August 29, 2019;
>
> illico TV "My Resume Viewing" and "Recording" interfaces have been infringing the 187 Patent since July 9, 2019.
>
> Club illico OTT and illico+ OTT "Resume Viewing" interface has been infringing the 187 Patent since July 9, 2019.

[532] I find the 674 Patent valid and infringed by Helix TV "iVOD Restart Voice Remote Function" from August 29, 2019 to March 30, 2021;

[533] With respect to Helix TV, Videotron's infringement of the 187 and 674 Patents is grounded in the theory of common design, through its engagement with Comcast. However, and although the essential elements of the 187 Patent were found in the VRAI interface, I do not find Videotron liable for infringement due to the lack of evidence regarding the contractual relation between Videotron and [redacted] and Brightcove, on the other hand, that would have led to a finding of common design.

[534] Videotron's counterclaim is granted with respect to the 922 and 571 Patents, which are declared invalid for anticipation/obviousness.

[535] Adeia has not convinced me that the proper remedy for Videotron's infringement of the 187 and 674 Patents is the total royalty that would have been paid to Adeia, had the parties renewed the licence for the entire Adeia patents portfolio. In my view, Videotron's expert has provided the Court with the proper formula for the assessment of damages for the infringement of two patents out of more than 200, and the parties' experts are directed to provide the Court with their calculation in accordance with these reasons.

[536] The Court grants Adeia a permanent injunction to refrain Videotron from infringing the 187 Patent, which will be in force the 31st day of the date of these reasons until December 8, 2026.

[537] The parties have jointly proposed that the question of costs, if not resolved as between them after judgment is issued, be reserved and subject to short submissions to the Court. If the

parties are unable to agree on costs, they are to provide the Court with written submissions, not exceeding 10 pages, within 15 days from the date of this judgement.

JUDGMENT in T-841-21

THIS COURT'S JUDGMENT is that:

1. Both the Plaintiff's action and the Defendant's counterclaim are granted in part;
2. Canadian Patent No 2,553,922 is invalid;
3. Canadian Patent No 2,635,571 is invalid;
4. The Defendant's Helix TV "Recordings", "Resume Viewing" and Recently Watched" interfaces have been infringing Canadian Patent No 2,967,187 [187 Patent] since August 29, 2019;
5. The Defendant's illico TV "My Resume Viewing" and "Recording" interfaces have been infringing the 187 Patent since July 9, 2019;
6. The Defendant's Club illico OTT (between when it was launched in February 2021 and when it was discontinued) and illico+ OTT (since it was launched in October 2024) "Resume Viewing" interface have been infringing the 187 Patent;
7. The Defendant's Helix TV "iVOD Restart Voice Remote Function" has infringed Canadian Patent No 2,775,674 [674 Patent] from August 29, 2019 to March 30, 2021;
8. The Defendant, its directors, officers, employees, agents, and all of those over whom it exercises control are enjoined, from the 31st day of the date of this judgment until December 8, 2026, from:

    a) manufacturing, distributing, offering for sale, selling, supplying or otherwise making available, or using any of the systems and/or methods of the 187 Patent Asserted Claims, or having said things done, in Canada;

    b) inducing or procuring others to manufacture, distribute, offer for sale, sell, supply, make available, or use in Canada

any of the systems and/or methods of the 187 Patent Asserted Claims; and

c) otherwise infringing any of the systems and/or methods of the 187 Patent Asserted Claims;

9. The Plaintiff is awarded damages at a per subscriber/per month set of rates to be calculated by Mr. Christofer Martinez, and validated by Mr. Andrew C. Harington, in accordance with these reasons;

10. The Plaintiff is awarded pre-judgment interest, computed using the rate and methodology of Mr. Andrew C. Harington, and validated by Mr. Daniel Ross, on the amounts contemplated by paragraph 9 above, to the date of Judgment.

11. The Plaintiff is awarded post-judgment interest at the prime rate (as it changes over time), computed on a simple basis, on the amounts contemplated by paragraph 9 above, from the date of Judgment to the date of payment by the Defendant to Adeia of those amounts; and

12. Should the parties be unable to agree on costs, they are required to serve the other party and file with the Court, within 15 days from [the Confidential Judgment and Reasons], their written submissions on costs, not exceeding 10 pages.

"Jocelyne Gagné"
Judge

FEDERAL COURT

SOLICITORS OF RECORD

DOCKET:	T-841-21
STYLE OF CAUSE:	ADEIA GUIDES, INC. v VIDEOTRON LTD.
PLACE OF HEARING:	TORONTO, ONTARIO
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