

## District Court Report and Recommendation Resolves All Infringement Claims Against Nine Media Companies Represented by Rothwell Figg

Magistrate Judge Roy Payne of the Eastern District of Texas issued a Report and Recommendation to grant Defendants' motion to dismiss all infringement claims brought by plaintiff Bartonfalls LLC. Judge Payne agreed with Defendants' position that (1) Bartonfalls had failed to state a claim for patent infringement because it could not identify a plausible claim construction under which it could allege infringement by the Defendants and (2) Bartonfalls' efforts to extend the term of an expired patent beyond the 20 years provided for by statute was not supported by case law, the statute or common sense. This ruling resolved all the claims in favor of RFEM clients Advance Publications, Inc., Allrecipes.com, Inc., Bloomberg, L.P., Discovery Communications, Inc. Forbes Media LLC, NBCUniversal Media, LLC, The New York Times Company, Scripps Networks Interactive, Inc., and Turner Broadcasting System, Inc.

Bartonfalls filed its original complaint asserting infringement of U.S. Patent No. 7,917,922 ("the '922 patent"). It then amended its complaint to add infringement allegations for two additional patents, U.S. Patent No. 8,769,561 ("the '561 patent") and 9,094,694 ("the '694 patent"). The asserted patents describe methods for automatically switching from one television program on one television channel to another television program on a different television channel. Bartonfalls asserted that its patent claims extended to covered websites that automatically play a second video after a website user watches a first video. In support of its infringement theory, Bartonfalls asserted that claimed "TV Channel" should be construed to consider the URLs used to identify specific online videos to each constitute a "TV Channel." Judge Payne found that there was no dispute that Bartonfalls infringement claims turned on "whether URLs fall inside or outside the plain and ordinary meaning of 'TV Channels.'" He then concluded that Bartonfalls "has no plausible basis for alleging that the plain and ordinary meaning of 'TV channel' (or 'TV Channel' properly construed) covers URLs, i.e., a unique address for a web page that makes content addressable on the Internet." Based on the Defendants' showing that there was no plausible basis for Bartonfalls' infringement claims as to the '922 and '561 patents, Judge Payne recommended dismissal of those claims.

### Key Contacts

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### Related Areas of Practice

Media and Constitutional Law  
Patent Litigation

### Technologies

Media

Bartonfalls infringement claims based on the '694 patent were dismissed on separate grounds. The '694 patent claimed priority to an application filed on June 8, 1995, and as a result expired on June 8, 2015. The '694 patent did not issue from the Patent and Trademark office until July 28, 2015—more than a month after its term expired. Bartonfalls argued that it would be unfair for a patent to have no valid term because it expired before expiration and asked the Court to find that it was entitled to some period during which the '694 patent is enforceable. Judge Payne agreed with Defendants that there was no basis under the governing statutes or in the case law that would create an enforceable term for a patent beyond the 20 years provided by 35 U.S.C. § 154(a)(2). Because there was no enforceable term for the '694 patent, Bartonfalls' infringement claims based on that patent were recommended for dismissal as well.

All nine Defendants were represented in this case by Rothwell Figg attorneys Steven Lieberman, Sharon Davis, Brian Rosenbloom, and Jennifer Maisel.