

No. _____

**In The
Supreme Court of the United States**

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MORRIS REESE,
Petitioner,

v.

**SPRINT NEXTEL CORPORATION,
TRACFONE WIRELESS, INC.,
VERIZON WIRELESS SERVICES LLC,
AT&T MOBILITY II LLC, AND
T-MOBILE USA, INC.,**
Respondents.

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**ON PETITION FOR WRIT OF CERTIORARI TO
THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

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PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

In both *Mayo Collaborative Services v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (2012), and *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014), this Court adopted a two-step framework for determining whether an invention is eligible for patent protection under 35 U.S.C. § 101. Both steps are reserved for the court. First, the court determines “whether the claims at issue are directed to one of [the] patent-ineligible concepts,” excepted from patent eligibility, i.e., laws of nature, natural phenomena, and abstract ideas. *Alice*, 134 S. Ct. at 2355. Neither this Court nor the Federal Circuit has set forth a standard for determining whether an invention is directed toward an abstract idea. *See, e.g., Cellspin Soft, Inc. v. Fitbit, Inc.*, 927 F.3d 1306, 1315 (Fed. Cir. 2019) (stating that the *Alice* inquiry lacks “precise contours” with respect to abstractness). Second, the court determines whether “additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (citing *Mayo*, 132 S. Ct. at 1291).

In this case, the Federal Circuit failed to correctly apply step one. Instead, the Federal Circuit found the asserted claims to be directed to an abstract idea because they consist of generic and conventional elements that fail to convert the abstract idea. Panel Op. at 11a. The Federal Circuit’s judgment conflates the two distinct steps of the *Alice* inquiry and imports the factual analysis underlying the anticipation and obviousness determinations under §§ 102 and 103.

The questions presented, which are of exceptional importance and will have staggering consequences if left unreviewed, are:

Whether this case provides an appropriate vehicle for this Court to state with clarity and certainty the definition of an “abstract idea” under 35 U.S.C. § 101, so courts below can correctly determine at step one of *Alice* whether claims at issue are directed to a patent-ineligible concept, and

Whether the panel’s decision conflicts with this Court’s jurisprudence related to step one of *Alice* by failing to correctly determine whether the claims at issue are directed to a patent-ineligible concept.

PARTIES TO THE PROCEEDING

Petitioner Morris Reese was the plaintiff in the district court and was the appellant in the court of appeals.

Respondents Sprint Nextel Corporation, TracFone Wireless, Inc. (erroneously sued as TracFone Wireless Services, Inc.), Verizon Wireless Services LLC (erroneously sued as Cellco Partnership d/b/a Verizon Wireless), AT&T Mobility II LLC, and T-Mobile USA, Inc. were the defendants in the district court and were the appellees in the court of appeals.

STATEMENT OF RELATED CASES

Petitioner is not aware of any related cases.

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OPINIONS BELOW

In the case below, the Federal Circuit consolidated six appeals arising from patent infringement suits filed by Petitioner in the Central District of California. The Federal Circuit issued its judgment in the consolidated matter on June 10, 2019, which is reported at *Reese v. Sprint Nextel Corp. et al.*, 774 Fed. Appx. 656 (2019) and reproduced at App. 1a-14a. Petitioner sought panel rehearing and rehearing *en banc*. The Federal Circuit's denial of Petitioner's requests for rehearing, issued on August 8, 2019, is unreported and is provided at App. 36a-39a.

The district court order granting Respondents' motion for summary judgment against Petitioner is reported at *Reese v. Sprint Nextel Corp., et al.*, 2018 U.S. Dist. LEXIS 60072, 2018 WL 1737613 (C.D. Cal. April 9, 2018) and is reproduced at App. 15a-31a. The final judgment of the district court is unreported as is reproduced at App. 32a-35a.

STATEMENT OF JURISDICTION

The court of appeals entered judgment in Nos. 2018-1971, 2018-1972, 2018-1973, 2018-1974, and 2018-1975 on June 10, 2019 and entered an order denying rehearing on August 8, 2019. This Court has jurisdiction under 28 U.S.C. § 1254(1).

RELEVANT STATUTORY PROVISIONS

35 U.S.C. § 101 provides:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent

therefor, subject to the conditions and requirements of this title.

35 U.S.C. § 282(a) provides:

A patent shall be presumed valid. Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims; dependent or multiple dependent claims shall be presumed valid even though dependent upon an invalid claim. The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.

PRELIMINARY STATEMENT

Section 101 of the Patent Act provides that a patent may be obtained for an invention that is a “new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” 35 U.S.C. § 101. This Court has long held that Section 101 is subject to implicit exceptions for laws of nature, natural phenomena, and abstract ideas. *See, e.g., Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 216, 134 S. Ct. 2347, 2354 (2014). At the same time, the Court has cautioned that we must “tread carefully in construing this exclusionary principle lest it swallow all of patent law.” *Id.* (citing *Mayo Collaborative Svcs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 71, 132 S. Ct. 1289, 1294 (2012)). And while laws of nature and natural phenomena are amenable to a precise definition, a clear standard for what constitutes an “abstract idea” has remained elusive. In fact, as recently as June 25, 2019, the Federal Circuit

lamented that the standard for identifying an abstract idea lacks any “precise contours.” *Cellspin Soft, Inc. v. Fitbit, Inc.*, 927 F.3d 1306, 1315 (Fed. Cir. 2019). The lower courts are sorely in need of guidance with respect to the application of *Alice* and *Mayo* as they relate to abstract ideas. In the present case, the abstract idea exception to § 101 has been allowed to swallow the entirety of sections 101, the factual inquiries of sections 102 and 103, and the presumption of validity set forth in section 282.

The current *Alice/Mayo* framework, without more, is insufficient for the uniform, predictable determination of patent eligibility. As explained by the Federal Circuit’s Justice Plager, in his partial dissent in *Interval Licensing v. AOL*, the framework we are directed to rely upon in analyzing patentability was provided by the Court in a case that did not turn on whether the asserted invention was an abstract idea. *Interval Licensing, LLC v. AOL, Inc.*, 896 F.3d 1335, 1349 (Fed. Cir. 2018) (citing *Mayo*, 566 U.S. at 72, which addressed a natural law related to drug dosages in the treatment of disease). That framework is thus inapt or imprecise when applied indiscriminately across all three judicially created exceptions to patentability. *Id.* Laws of nature and natural phenomena “have understandable referents, and thus have proven more amenable to workable definitions, or at least a reasonable degree of boundary-setting,” while abstract ideas have not yet been reliably defined. *Id.*

The Federal Circuit found Petitioner’s asserted claims to be directed to an abstract idea because they consist of “generic” and “conventional” elements that fail to convert the abstract idea. 11a. As discussed

herein, whether a claim element is generic or conventional, is a question of fact, but it is also a question better reserved for an anticipation or obviousness analysis, lest the “abstract idea” inquiry swallow all of patent law, as it has done here. *See, Interval Licensing*, 896 F.3d at 1349; *see also, Berkheimer v. HP, Inc.*, 890 F.3d 1369, 1374 (Fed. Cir. 2018) (J. Lourie concurring, suggesting that the fact-finding inquiries underlying §§ 102 and 103 may be a more appropriate vehicle for patentability). A carefully circumscribed formulation of “abstract idea” is necessary to set the appropriate scope of a subject matter eligibility analysis; otherwise, “the ‘abstract ideas’ idea, when used for denying a claimed invention’s patent eligibility either before or after a patent is issued, cannot thus function as a valid rule of law.” *Interval Licensing*, 896 F.3d at 1350 (J. Plager, dissent). The Federal Circuit’s current tactic of stating examples of what prior cases have contained is the sort of “we’ll know it when we see it” standard that fails to set forth the clarity and certainty needed by patentees and courts. “The law needs clarification by higher authority, perhaps by Congress, to work its way out of” the § 101 problems, which “certainly require attention beyond the power of” the lower courts. *Berkheimer*, 890 F.3d at 1374 (J. Lourie concurring).

The present case presents the opportunity for the Court to unambiguously set forth the appropriate standard for applying § 101 to inventions asserted to contain abstract ideas. If left unreviewed, the lower courts will continue to eviscerate the Patent Act through their application of the implicit exceptions to subject matter eligibility. The Federal Circuit’s inconsistent application of 35 U.S.C. § 101 requires that the petition be granted.

STATEMENT OF THE CASE

A. Procedural posture

On May 29, 2013, Plaintiff-Appellant, Morris Reese (“Reese”) filed suit in the United States District Court for the Central District of California against Defendants-Appellees Sprint Nextel Corporation, TracFone Wireless, Inc.; Verizon Wireless Services, LLC; AT&T Mobility II, LLC, and T-Mobile USA, Inc., alleging infringement of U.S. Patent No. 6,868,150 (“the ’150 Patent”). Generally, the ’150 Patent is directed toward methods of providing the combined call waiting/caller ID service through the terminating central office of a telephone service provider. The asserted claims at issue in this case, Claims 23 and 32, are more specifically directed toward the activities occurring at the telephone or cellular company terminating office switching equipment serving a called party who receives a call from a third party whose directory telephone number is marked as “private” by the telephone or cellular company originating office switching equipment serving the third party, indicating that the received directory telephone number is not to be disclosed at the called party’s called station. The telephone or cellular company terminating central office equipment then sends a call waiting tone signal over the same channel as the voice channel to the called party telephone or other receiving and sending equipment indicating an incoming call. Reese’s Complaint alleged that Appellees infringe the ’150 Patent by making, using, selling, or offering to sell cellular telephone services that include the combined Call Waiting/Caller ID feature.

After Reese filed his original Complaint against the Appellees, the district court directed that the case

be severed and refiled by Reese into the five cases that were appealed to the Federal Circuit. The cases were consolidated for pre-trial purposes, with the case against Sprint Nextel Corporation functioning as the lead case. Respondents filed motions for summary judgment on the issue of whether Reese's claims were barred under the theory of laches; the Respondents' motions were granted; and Reese subsequently filed his first appeal to the Federal Circuit. Following this Court's ruling in *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, 137 S. Ct. 954 (2017), holding that laches could not be applied to bar a claim for patent infringement within the six-year statute of limitations, Petitioner's first appeal was remanded back to the Central District of California for further proceedings.

Once the case was back before the district court, Respondents again filed motions for summary judgment, advancing the argument that the asserted claims of the patent-in-suit are invalid for failing to claim patentable subject matter under 35 U.S.C. § 101. Without claim construction or oral argument, the district court granted the Respondents' Motion for Summary Judgment and entered an Order finding Petitioner's '150 Patent invalid in each of the five consolidated cases. Reese timely appealed to the Federal Circuit. On his second appeal, Reese asserted that the district court erred in granting Respondents' Motion for Summary Judgment that the asserted claims of the '150 Patent are invalid because in doing so, the district court failed to meet its obligation to properly construe the scope of the asserted claims, leading the lower court to have an overly simplified view of those claims. Reese also argued that the district court compounded its error by incorrectly

applying the standard for determining whether the claims of the patent-in-suit are directed toward patentable subject matter. Had the district court given meaning to each of the claims' limitations and considered them as an ordered whole, it could not have found the asserted claims invalid. Finally, Reese's appeal asserted that the district court improperly resolved a fact issue against the non-movant when it improperly determined that certain of the claims' functions were already well-known.

The Federal Circuit issued its opinion on June 10, 2019, affirming the district court's grant of summary judgment and concluding that the district court did not err in deciding summary judgment without construing the claims. The Federal Circuit further found that the claims were directed to an abstract idea without an inventive concept to convert the claims to a patent eligible invention. Because the Federal Circuit misapprehended the nature of Reese's asserted claims, overlooked evidence showing the claims contain an inventive concept, determined a material issue of fact against the non-movant, and misapplied step one of *Alice*, Reese sought panel rehearing and rehearing *en banc*. The Federal Circuit denied Petitioner's request on August 8, 2019. Petitioner now timely seeks a Writ of Certiorari to the Federal Circuit based on that court's overly-broad application of § 101 with respect to abstract ideas.

B. Legal Background

Through the Patent Act, Congress—exercising its power “to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective

writings and discoveries,” U.S. Const., Art. I, Section 8, cl. 8—provided that “whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor.” 35 U.S.C. § 101. This Court has long held that § 101 contains implicit exceptions for laws of nature, natural phenomena, and abstract ideas. *See, e.g., Alice*, 573 U.S. at 216. At the same time, the Court has cautioned that we must “tread carefully in construing this exclusionary principle lest it swallow all of patent law.” *Id.* (citing *Mayo*, 566 U.S. at 71).

This Court developed the current law of patent eligibility under § 101 in two seminal cases. First, in *Mayo*, this Court discussed patentability in the context of a natural law: the “relationships between concentrations of certain metabolites in the blood and the likelihood that a dosage of a thiopurine drug will prove ineffective or cause harm.” *Mayo*, 566 U.S. at 77. This Court found that the claims at issue claimed the underlying natural law and “did not add enough to allow the processes they describe to qualify as patent-eligible processes that *apply* natural laws.” *Id.* (emphasis in original).

Then in *Alice*, this Court considered a patent concerning an abstract idea and clarified *Mayo*’s two-step test, directing that first a court must “determine whether the claims at issue are directed to one of those patent-ineligible concepts” and then determine whether the ordered claims as a whole claims contain an “inventive concept.” *Alice*, 573 U.S. at 217. Step two of the analysis is a search for “an element or combination of elements that is sufficient to insure that the patent in practice amounts to significantly

more than a patent upon the ineligible concept itself.” *Id.* at 217-218 (internal quotations omitted).

C. The Patent-in-Suit

Petitioner, Morris Reese, is the sole inventor and owner of U.S. Patent No. 6,868,150 (“the ’150 Patent”), which issued on March 15, 2005.¹ The ’150 Patent claims inventions related to improved methods for routing caller ID information, including specifically the previously unavailable combination of caller ID in the context of an existing call. Generally, the ’150 Patent is directed toward methods of providing the combined call waiting/caller ID service through the terminating central office of a telephone service provider. The asserted claims at issue, Claims 23 and 32, are directed toward the activities occurring at the telephone or cellular company terminating office switching equipment serving a called party who receives a call from a third party whose directory telephone number is marked as “private” by the telephone or cellular company originating office switching equipment serving the third party, indicating that the received directory telephone number is not to be disclosed at the called party’s called station. The telephone or cellular company terminating central office equipment then sends a call waiting tone signal over the same channel as the voice channel to the called party telephone or other receiving and sending equipment indicating an incoming call.

Following this Court’s holding in *Mayo*, setting forth the two-step test for subject matter

¹ A full copy of the ’150 Patent can be found at C.A. Appx. 0125-0136.

patentability, nearly every opinion issued by either the Federal Circuit or this Court in which claims are deemed ineligible under 35 U.S.C. § 101 falls into one of two categories: (a) categorizing, screening or comparing data or (b) business methods such as financial schemes. The claims at issue in this case do not fall into either category. Thus, when properly considered within the context of the '150 Patent's specification and the appropriate construction of the disputed claim terms, the claims at issue in this case do not claim an abstract idea. Even if they could be considered abstract, the specific elements describe an inventive concept that provides information to the called party which allows him to make an informed decision about whether to interrupt his ongoing telephone conversation to answer the incoming caller.

The '150 Patent's claims are patent eligible because: (1) they are not directed to an abstract idea, but rather to an improvement in the functioning of the telephone or cellular company terminating central office switching equipment itself and (2) they recite a specific arrangement of particular structures, operating in a specific way. For example, the telephone or cellular company terminating central office of the called party responds to the receipt of the incoming caller's flagged directory telephone number by sending a call waiting tone signal (an audible notification) to the called party who is already engaged in a call to indicate the existence of an incoming call from the incoming caller.

Considering the claims at issue as a whole, the implementation of the signaling activities (i.e., the sending of the audible notification tone signal (call waiting tone signal) to the called party by the non-

human telephone or cellular company terminating central office of the called party to indicate the existence of the incoming caller) is not an abstract idea. *See, Core Wireless Licensing S.A.R.L. v. LG Elecs., Inc.*, 880 F.3d 1356 (Fed. Cir. 2018); *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299 (Fed. Cir. 2016); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016). Neither of the claims at issue raises any risk of broadly pre-empting the use of a natural law or monopolizing a fundamental human activity. *See, e.g., Mayo*, 566 U.S. at 71.

REASONS FOR GRANTING THE PETITION

A. The decision below conflicts with the precedent of this Court by failing to correctly apply the *Mayo/Alice* two-step inquiry.

A proper statement of the scope of the asserted claims would have prevented the Federal Circuit's determination that the claims recite only abstract ideas. Claim 23 recites the specific steps of receiving at the telephone or cellular company terminating central office switching equipment of a called party, who subscribes to call waiting and caller ID and who is engaged in an ongoing telephone conversation, a caller's directory telephone number flagged as private from the telephone or cellular company originating central office switching equipment of the caller, indicating that the received caller's directory telephone number is not to be disclosed at the called party's called station (telephone or other receiving and sending equipment) and then, in response to receiving the flagged directory telephone number, the telephone or cellular company terminating central office switching equipment sends only an audible

notification signal (call waiting tone signal) on the same channel as the voice to the called party telephone or other receiving and sending equipment indicating an incoming call. Similarly, Claim 32 recites a method for sending only a call waiting tone signal to a called party already engaged in a call and who subscribes to both call waiting and caller ID in response to receipt, at the telephone or cellular company terminating central office switching equipment serving the called party, of a caller's directory telephone number flagged as private. Considering each claim as a whole, the implementation of the non-human signaling activities at the telephone or cellular company terminating central office switching equipment is not an abstract idea. *See, Core Wireless*, 880 F.3d at 1361-62; *McRO*, 837 F.3d at 1313-14; *Enfish*, 822 F.3d at 1335. Therefore, neither of the asserted claims raises any risk of broadly pre-empting the use of a natural law or monopolizing a fundamental human activity. *Mayo*, 566 U.S. at 71. The Federal Circuit skipped this initial step and made its determination of invalidity on its own combination of Steps 1 and 2 of the *Mayo/Alice* evaluation.

It is axiomatic that the nature and scope of a patent's claims is a question of law to be determined by the court. *Markman v. Westview Instruments*, 517 U.S. 370, 372 (1996). Although both the Federal Circuit and the district court acknowledged that "a full understanding of the basic character of the claimed subject matter" is required, both courts failed to correctly articulate the character of Reese's asserted claims. *See, e.g.*, Appx. 8a (citing *Content Extraction & Transmission, LLC v. Wells Fargo Bank, Nat'l Ass'n*, 776 F.3d 1343, 1349 (Fed. Cir. 2014)). The

lower court's evaluation effectively skipped step one of the *Mayo/Alice* inquiry and stated that the claims contain only generic functions or "conventional activities previously known to the industry." *See*, Appx. at 9a-11a. As a result, the Federal Circuit incorrectly determined the asserted claims failed Step 2. Had the Federal Circuit properly addressed Step 1, it would not have found it necessary to consider whether the asserted claims added elements to an abstract idea sufficient to find an inventive concept. It should have determined that sending a call waiting tone signal from a terminating central office to a party already engaged in a call, in response to receipt of flagged caller identifying information at the terminating central office is not an abstract idea.

Nonetheless, Petitioner provided evidence to the Federal Circuit showing that the claimed combination of call-waiting and caller ID was novel at the time of his invention and that the relevant industry required that any such combination must be designed so that it could be implemented on existing telephone switching equipment. The asserted claims of the '150 Patent met that industry requirement and disclosed the use of existing equipment in a novel manner. At the time the application which became the '150 Patent was filed, the sending to a called party, who subscribes to both call waiting and caller ID and who is engaged in a call, a call waiting tone signal only in response to receipt at telephone or cellular company terminating central office equipment of a calling third party's directory number flagged as private, was not a conventional activity. Instead, it was an inventive concept based on an unconventional method for using existing telecommunications equipment. The Federal Circuit improperly collapsed the two-step inquiry into

a single determination of what is routine and/or conventional and made its own, unsupported determination of that fact issue.

B. The Panel’s determination of a material fact in finding the asserted claims invalid conflicts with the precedent of this Court.

“*Berkheimer* and *Aatrix* stand for the unremarkable proposition that whether a claim element or combination of elements would have been well-understood, routine, and conventional to a skilled artisan in the relevant field at a particular point in time is a question of fact.” *Berkheimer*, 890 F.3d at 1370 (J. Moore concurring). However, the Federal Circuit’s conclusion that “the claims do not contain an inventive concept” is based upon the improper factual determination that the claimed process steps are “generic.” Appx. 11a. That factual determination is not only inappropriate, but it is also incorrect. Petitioner presented evidence to the Federal Circuit showing that the claimed methods were not implemented anywhere at the time of his invention and were thus unconventional. For example, Reese provided an April 1991 Bellcore Request for Information² requiring that any developed combination of the call waiting and caller ID features “work on existing access technology platforms with minimal changes,” clearly showing that Reese’s claimed process was not conventional within the telecommunications industry prior to April of 1991. The Federal Circuit erred by ignoring that evidence and resolving the factual inquiry against the Petitioner, the non-movant on the motion for

² The Bellcore document can be found at C.A. Appx. 0289.

summary judgment. Such “specific factual allegations that aspects of the claims are inventive” cannot be ignored. *See, e.g., Cellspin Soft*, 927 F.3d at 1317. (finding in the context of a motion to dismiss that such factual disputes about whether an element is conventional precluded dismissal under 35 U.S.C. § 101). Material disputes regarding questions of fact prevent a court from granting a motion for summary judgment and should have prevented the Federal Circuit from affirming the district court’s decision. Fed. R. Civ. P. 56(a); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). The Federal Circuit’s determination of invalidity based upon what was known or conventional as of the time Petitioner filed the application which became the ’150 Patent represents a split amongst the Federal Circuit requiring certiorari. *See, e.g., Berkheimer v. HP, Inc.*, 881 F.3d 1360, 1368 (Fed. Cir. 2018) (pending an appeal to this Court in case No. 18-415); *Aatrix Software, Inc. v. Green Shades Software, Inc.*, 890 F.3d 1354, 1365 (Fed. Cir. 2018) (J. Reyna dissent stating that resolution of the divided precedent regarding the factual inquiries under § 101 is of “exceptional importance”).

C. Certiorari is appropriate to set forth a clear standard for determinations of abstractness under 35 U.S.C. § 101, separate and apart from the inquiries under 35 U.S.C. §§ 102 and 103.

Under 35 U.S.C. § 101, a patent may be obtained for an invention that is a “new and useful process, machine, manufacture, or composition of matter,” subject to exceptions for laws of nature, natural phenomena, and abstract ideas. 35 U.S.C. § 101; *see*,

e.g., *Alice*, 573 U.S. at 216. Although this Court has cautioned that the exceptions to § 101 must be construed carefully “lest [they] swallow all of patent law,” to date, a clear definition of an “abstract idea” has been elusive. *Id.* at 217.

As explained by Justice Plager, in his partial dissent in *Interval Licensing*, the framework we are directed to rely upon in analyzing patentability was provided by the Supreme Court in *Mayo*, a case that did not turn on whether the asserted invention was an abstract idea. *Interval Licensing*, 896 F.3d at 1349 (citing *Mayo*, 566 U.S. at 66). That framework is thus inapt or imprecise when applied indiscriminately across all three judicially created exceptions to patentability. *Id.* Laws of nature and natural phenomena “have understandable referents, and thus have proven more amenable to workable definitions, or at least a reasonable degree of boundary-setting,” while abstract ideas have not yet been reliably defined. *Id.*

Both the majority in *Interval Licensing* and the Federal Circuit in this case found the asserted claims to be directed to an abstract idea because they consist of generic and conventional elements that fail to convert the abstract idea. *Id.*; *see also* Appx. at 11a. As discussed above, whether a claim element is generic or conventional, is a question of fact, but it is also a question better reserved for an anticipation or obviousness analysis, lest the “abstract idea” inquiry swallow all of patent law, as it has done here. *See, Id.*; *see also, Berkheimer*, 890 F.3d at 1374 (J. Lourie concurring) (suggesting that the fact-finding inquiries underlying §§ 102 and 103 may be a more appropriate vehicle for patentability). A carefully circumscribed

formulation of “abstract idea” is necessary to set the appropriate scope of a subject matter eligibility analysis; otherwise, “the ‘abstract ideas’ idea, when used for denying a claimed invention’s patent eligibility either before or after a patent is issued, cannot thus function as a valid rule of law.” *Interval Licensing*, 896 F.3d at 1350 (J. Plager dissent). The Federal Circuit’s current tactic of stating examples of what prior cases have contained and then comparing the invention at bar is the sort of “we’ll know it when we see it” standard that fails to set forth the clarity and certainty needed by patentees and courts. “The law needs clarification by higher authority ... to work its way out of” the § 101 problems, which “certainly require attention beyond the power of [the Federal Circuit].” *Berkheimer*, 890 F.3d at 1374 (J. Lourie concurring).

As well as the phrase can currently be defined, the asserted claims in this case are not abstract ideas:

An idea itself by definition is something, such as a thought or conception, that is the product of mental activity. The definitions of abstract include considered apart from concrete existence, difficult to understand; abstruse, and not applied or practical; theoretical. An idea, whether abstract or not, is something that lives in the interstices of someone’s brain, a psychophysiological area not fully understood to this day.

Interval Licensing, 896 F.3d at 1350 (citing *The American Heritage Dictionary of the English Language* 872 (5th ed. 2011) (internal quotations omitted). Claims 23 and 32 provide a call waiting tone

signal only to a called party, who is already engaged in a call and who subscribes to call waiting and caller ID, in response to receiving a flagged directory telephone number of an incoming caller at the called party's telephone or cellular company terminating central office equipment. That process is not a thought, conception or the product of mental activity, nor is it something that merely lives in the interstices of someone's brain. It is an inventive concept.

The encroachment of the factual inquiries discussed above in the context of a § 101 challenge on the analyses required under §§ 102 and 103 presents opportunities for inconsistent results and threatens to make the clear and convincing evidence requirements for an anticipation or obviousness challenge obsolete. *See*, 35 U.S.C. §§ 102, 103, and 282. While in the present case, the inquiry as to what is “conventional” or “generic” has been decided by the district court and the Federal Circuit under § 101 as a matter of law, a similar inquiry under § 103 would have resulted in a factual dispute precluding a determination on summary judgment. Respondents have thus been allowed to circumvent the clear and convincing evidentiary burden required to invalidate patent claims. *Procter & Gamble Co. v. Teva Pharms. USA, Inc.*, 566 F.3d 989, 994 (Fed. Cir. 2009); *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1361 (Fed. Cir. 2007); *Amgen, Inc. v. F. Hoffmann-La Roche Ltd.*, 580 F.3d 1340, 1362 (Fed. Cir. 2009). This Court has made clear that it “may not find a patent invalid for obviousness on the basis of ‘mere conclusory statements.’” *I/P Engine, Inc. v. AOL Inc.*, 576 Fed. Appx. 982, 998 (Fed. Cir. 2014) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). However, in the instant case, it has done just that, allowing a

finding of invalidity on the basis of conclusory, unsupported statements about what functionality was conventional or generic.

The uncertainty in the Federal Circuit's jurisprudence surrounding § 101 weighs heavily in favor of certiorari. That court's exclusive jurisdiction over patent matters means that no circuit split has developed or will develop; thus, the only mechanism to resolve the division in authority is for this Court to provide its guidance.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be granted.

Respectfully submitted,

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Dated: November 6, 2019

APPENDIX

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[ENTERED: June 10, 2019]

NOTE: This disposition is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

MORRIS REESE
Plaintiff-Appellant

v.

SPRINT NEXTEL CORPORATION
Defendant-Appellee

2018-1971

Appeal from the United States District Court for
the Central District of California in No. 2:13-cv-
03811-ODW-PLA, Judge Otis D. Wright, II.

MORRIS REESE
Plaintiff-Appellant

v.

**TRACFONE WIRELESS, INC.,
ERRONEOUSLY SUED AS TRACFONE
WIRELESS SERVICES INC.,**
Defendant-Appellee

2018-1972

Appeal from the United States District Court for
the Central District of California in No. 2:13-cv-
05196-ODW-PLA, Judge Otis D. Wright, II.

MORRIS REESE
Plaintiff-Appellant

v.

**VERIZON WIRELESS SERVICES LLC,
ERRONEOUSLY SUED AS CELLCO
PARTNERSHIP, DOING BUSINESS AS
VERIZON WIRELESS,**
Defendant-Appellee

2018-1973

Appeal from the United States District Court for
the Central District of California in No. 2:13-cv-
05197-ODW-PLA, Judge Otis D. Wright, II.

MORRIS REESE
Plaintiff-Appellant

v.

AT&T MOBILITY II LLC
Defendant-Appellee

2018-1974

Appeal from the United States District Court for
the Central District of California in No. 2:13-cv-
05198-ODW-PLA, Judge Otis D. Wright, II.

MORRIS REESE

Plaintiff-Appellant

v.

T-MOBILE USA, INC.,

Defendant-Appellee

2018-1975

Appeal from the United States District Court for
the Central District of California in No. 2:13-cv-
05199-ODW-PLA, Judge Otis D. Wright, II.

Decided: June 10, 2019

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Before REYNA, HUGHES, and STOLL, *Circuit Judges*.

REYNA, *Circuit Judge*.

Morris Reese appeals from a grant of summary judgment by the U.S. District Court for the Central District of California determining that certain claims of the asserted patent are ineligible under 35 U.S.C. § 101. The asserted claims are directed to an abstract idea and the claim elements do not transform the nature of the claims into a patent-eligible invention. We affirm.

BACKGROUND

Morris Reese (“Reese”) owns and is the named inventor of U.S. Patent No. 6,868,150 (“the ’150 patent”). The ’150 patent relates to an apparatus and method of providing call waiting and caller ID service through the central office of a telephone service provider. ’150 patent, Abstract. Reese contends that Defendants,¹ who are cellular services providers, infringe claims 23 and 32 of the ’150 patent:

¹ This is a consolidated appeal involving separate cases and five different defendants: Sprint Nextel Corporation, TracFone Wireless, Inc., Verizon Wireless Services, LLC, AT&T Mobility II LLC, and T-Mobile USA Inc. Defendants jointly moved for summary judgment in each case. J.A. 736–41.

23. A method for indicating to a first party who subscribes to a Custom Local Area Signaling System (CLASS) service including Caller Identification (Caller ID) and who is engaged in a telephone call conversation with a second party an incoming call from a third party calling a telephone number of the first party, comprising the steps of:

(a) receiving at a terminating central office (TCO) of the first [sic] party who subscribes to said CLASS service including said Caller ID and who is engaged in the telephone conversation with the second party the third party directory telephone number (DN) flagged as private from an originating central office of the third party, indicating that said DN of the third party is not to be disclosed at the first party called station; and

(b) said TCO then sending a call waiting (CW) tone signal to the first party, said CW tone signal indicates to the first party the incoming call from the third party.

....

32. A method for sending a call waiting (CW) tone signal only to a first party who subscribes to a Custom Local Area Signaling System (CLASS) service including Caller Identification (Caller ID) and who is engaged in a telephone conversation with a second party, comprising the steps of:

(a) receiving at a terminating central office (TCO) of the first party who subscribes to said CLASS service including said Caller ID and who is engaged in the telephone conversation with the second party a calling third party directory telephone number (DN) flagged as private from an originating central office of the calling third party indicating that said received DN of the calling third party is not to be disclosed at the first party called station; and

(b) said TCO then sending said CW tone signal to the first party.

'150 patent col. 10 l. 15–col. 11 l. 26.

The district court found that claims 23 and 32 of the '150 patent are directed to patent-ineligible subject matter and granted summary judgment in favor of Defendants. *Reese v. Sprint Nextel Corp.*, No. 2:13-CV-03811, 2018 WL 1737613, at *6 (C.D. Cal. Apr. 9, 2018). It reasoned that even under Reese's description of the claims' purpose—"to indicate to a subscriber to both call waiting and caller ID, who is already engaged in a call, using an audible tone signal, the existence of an incoming call from a third party whose directory telephone number has been flagged private"—the claims were directed to an abstract idea. *Id.* at *5–6. The district court further reasoned that the claims did not recite "actual processes or necessary equipment" for performing the claimed methods and failed to transform the nature of the claims into something more than the abstract idea. *Id.* at *6.

Reese appeals. We have jurisdiction under 28 U.S.C. § 1295(a)(1).

DISCUSSION

We review a district court’s grant of summary judgment under the law of the regional circuit, here the Ninth Circuit. *See Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1146 (Fed. Cir. 2016) (citations omitted). The Ninth Circuit reviews summary judgment de novo. *Humane Soc’y of the U.S. v. Locke*, 626 F.3d 1040, 1047 (9th Cir. 2010). Patent eligibility under 35 U.S.C. § 101 is reviewed de novo. *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1311 (Fed. Cir. 2016).

The Supreme Court’s two-step framework for patent eligibility requires us to consider (1) whether a claim is directed to a patent-ineligible concept—an abstract idea, law of nature, or natural phenomenon—and (2) if so, whether the claim elements considered individually, or as an ordered combination, “transform the nature of the claim into a patent-eligible application.” *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (citing *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216–18 (2014) (internal quotations omitted)).

I. Claim Construction

We first address Reese’s contention that the district court erred by granting summary judgment without construing the claims. *See* Appellant Br. 14. We disagree.

“Although the determination of patent eligibility requires a full understanding of the basic character of

the claimed subject matter, claim construction is not an inviolable prerequisite to a validity determination under § 101.” *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1349 (Fed. Cir. 2014). In some cases, there is no claim construction dispute relevant to the eligibility issue. *Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369, 1374 (Fed. Cir. 2016). In such cases, the court can evaluate subject matter eligibility under § 101 without formal claim construction. *Id.*

Citing *Aatrix Software, Inc. v. Green Shades Software, Inc.*, 882 F.3d 1121, 1125 (Fed. Cir. 2018), Reese argues that we should adopt his—the non-movant’s—proposed claim constructions in evaluating subject matter eligibility. Appellant Br. 14–15. Yet Reese proceeds to argue that Defendants’ proposed constructions are more specific, requiring “a wired (rather than wireless or cellular) connection and a specific subset of analog signaling” that transform “any alleged abstract idea” in the claims into an inventive concept. *Id.* at 18–19. Reese also argues that if the court adopted his admittedly broader constructions, the claims nevertheless contain an inventive concept. *Id.* at 20.

As such, Reese contends that the claims recite patent-eligible subject matter under either of the parties’ proposed constructions and fails to provide any reasoning why any claim construction dispute is relevant to the eligibility issue. The mere fact that Defendants’ proposed constructions might be more specific and therefore limited to a particular technological environment does not transform an otherwise abstract idea into a patent-eligible application. *See Affinity Labs of Texas, LLC v.*

DIRECTV, LLC, 838 F.3d 1253, 1259 (Fed. Cir. 2016). Nor does Reese argue that any limitations, either alone or in combination, in any of the parties' constructions were anything but "well-understood, routine, [and] conventional activities previously known to the industry." *Content Extraction*, 776 F.3d at 1347–48. Accordingly, we determine that there is no claim construction dispute relevant to eligibility and that we can fully understand the basic character of the claims without claim construction. The district court did not err in deciding summary judgment without construing the claims.

II. *Alice* Step One

Under step one, we consider whether the character of the claims in their entirety is directed to a patent-ineligible concept. *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015). Claims 23 and 32 recite a method for indicating to a first party engaged in a call with a second party, an incoming call from a third party with a private number, comprising the steps of receiving at a TCO a third party DN flagged as private, and the TCO then sending the CW tone signal to the first party. *See* '150 patent col. 10 l. 15–col. 11 l. 26. According to Reese, the purpose of these claims "is to indicate to a subscriber to both call waiting and caller ID, who is already engaged in a call, using an audible tone signal, the existence of an incoming call from a third party whose directory telephone number has been flagged as private." Appellant Br. 26–27. By Reese's own terms, this identified purpose of the claims is abstract.

The claims are directed to the abstract idea of receiving information (a calling phone number

flagged as private) and sending an indication (an audible tone) to a party already engaged in a call. The claims do not recite any particular method of receiving the information and sending the indicating tone in response. *See Interval Licensing LLC v. AOL, Inc.*, 896 F.3d 1335, 1342 (Fed. Cir. 2018). The claims here are akin to concepts of receiving and displaying (indicating) information (an incoming call from a private number) that fall into a familiar class of claims directed to abstract ideas. *See Elec. Power Grp.*, 830 F.3d at 1353. Although Reese argues that the claims require specific telephone features, merely limiting claims to a particular technological environment does not render the claims any less abstract. *Affinity Labs*, 838 F.3d at 1259. Accordingly, claims 23 and 32 are directed to a patent-ineligible abstract idea.

III. *Alice* Step Two

For the claims to be salvaged under step two, we search for an inventive concept sufficient to transform the claims into significantly more than the abstract idea itself. *Content Extraction*, 776 F.3d at 1347. Merely reciting the use of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. *Alice*, 573 U.S. at 223. Similarly, steps that generically recite the use of a telephone network cannot confer patent eligibility. *In re TLI Commc'ns LLC Patent Litig.*, 823 F.3d 607, 615 (Fed. Cir. 2016).

Reese does not point to any non-generic telephone network components and instead, asserts that “no successful combination of caller ID and call waiting yet existed” and that his “combination of known

switching equipment with the steps set forth” in the claims removes them from abstractness. Appellant Br. 34–35. Yet despite Reese’s assertion, the claims at issue only recite steps that the ’150 patent itself describes as prior art: sending a call waiting signal when a phone number is flagged as private. *See* ’150 patent col. 2 ll. 6–8 (“If the directory telephone number is flagged ‘private’, the terminating central office equipment connects to the called party telephone line with ringing only.”). And by the ’150 patent’s own terms, the claims do not recite any non-conventional equipment. *See, e.g., id.* at col. 1 l. 16–col. 2 l. 12 (describing conventional telephony equipment and services). Further, the claims recite functional language lacking “any requirements for *how* the desired result is achieved.” *Elec. Power Grp.*, 830 F.3d at 1355 (emphasis in original). Nothing in the claims requires anything other than conventional telephone network equipment to perform the generic functions of receiving and sending information. Reciting an abstract idea and applying it on telephone network equipment is not enough for patent eligibility. *See Alice*, 573 U.S. at 223. Accordingly, the claims do not contain an inventive concept.

CONCLUSION

We have considered Reese’s other arguments and find them unpersuasive. The district court correctly determined that claims 23 and 32 of the ’150 patent are directed to patent-ineligible subject matter.

AFFIRMED

COSTS

No costs.

[ENTERED: June 10, 2019]

**United States Court of Appeals
for the Federal Circuit**

MORRIS REESE
Plaintiff-Appellant

v.

SPRINT NEXTEL CORPORATION
Defendant-Appellee

2018-1971

Appeal from the United States District Court for
the Central District of California in No. 2:13-cv-
03811-ODW-PLA, Judge Otis D. Wright, II.

MORRIS REESE
Plaintiff-Appellant

v.

**TRACFONE WIRELESS, INC.,
ERRONEOUSLY SUED AS TRACFONE
WIRELESS SERVICES INC.,**
Defendant-Appellee

2018-1972

Appeal from the United States District Court for
the Central District of California in No. 2:13-cv-
05196-ODW-PLA, Judge Otis D. Wright, II.

MORRIS REESE
Plaintiff-Appellant

v.

**VERIZON WIRELESS SERVICES LLC,
ERRONEOUSLY SUED AS CELLCO
PARTNERSHIP, DOING BUSINESS AS
VERIZON WIRELESS,**
Defendant-Appellee

2018-1973

Appeal from the United States District Court for
the Central District of California in No. 2:13-cv-
05197-ODW-PLA, Judge Otis D. Wright, II.

MORRIS REESE
Plaintiff-Appellant

v.

AT&T MOBILITY II LLC
Defendant-Appellee

2018-1974

Appeal from the United States District Court for
the Central District of California in No. 2:13-cv-
05198-ODW-PLA, Judge Otis D. Wright, II.

MORRIS REESE
Plaintiff-Appellant

v.

T-MOBILE USA, INC.,
Defendant-Appellee

2018-1975

Appeal from the United States District Court for
the Central District of California in No. 2:13-cv-
05199-ODW-PLA, Judge Otis D. Wright, II.

JUDGMENT

THIS CAUSE having been considered, it is

ORDERED AND ADJUDGED:

AFFIRMED

ENTERED BY ORDER OF THE COURT

June 10, 2019

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

[ENTERED: April 9, 2018]

**United States District Court
Central District of California**

MORRIS REESE, Plaintiff, v. SPRINT NEXTEL CORP., Defendant.	Case No. CV13-03811-ODW (PLAx) ORDER GRANTING DEFENDANTS' MOTION FOR SUMMARY JUDGMENT [131] ALL CASES Judge: Hon. Otis D. Wright II
<hr/> MORRIS REESE, Plaintiff and Counter-defendant, v. TRACFONE WIRELESS, INC., Defendant and Counterclaimant.	Case No. CV13-05196-ODW (PLAx) ALL CASES Judge: Hon. Otis D. Wright II
<hr/> MORRIS REESE, Plaintiff and Counter- defendant, v.	Case No. CV13-05197-ODW (PLAx) ALL CASES

<p>VERIZON WIRELESS SERVS LLC, Defendant and Counterclaimant.</p>	<p>Judge: Hon. Otis D. Wright II</p>
<p>MORRIS REESE, Plaintiff and Counter-defendant, v. AT&T MOBILITY II LLC, Defendant and Counterclaimant.</p>	<p>Case No. CV13-05198-ODW (PLAx) ALL CASES Judge: Hon. Otis D. Wright II</p>
<p>MORRIS REESE, Plaintiff, v. T-MOBILE USA, Defendant.</p>	<p>Case No. CV13-05199-ODW (PLAx) ALL CASES Judge: Hon. Otis D. Wright II</p>

I. INTRODUCTION

Before the Court is Defendants Sprint Nextel Corporation, TracFone Wireless, Inc., Verizon Wireless Services, LLC, AT&T Mobility II LLC, and T-Mobile USA, Inc.'s Motion for Summary Judgment,

filed December 18, 2017. (Mot., ECF No. 131.) Plaintiff Morris Reese timely opposed the Motion on January 8, 2018 (Opp'n ECF No. 134), and Defendants replied on January 22, 2018. (Reply, ECF No. 136.) For the following reasons, the Court **GRANTS** Defendants' Motion.¹

II. BACKGROUND

A. Patent Claims at Issue

Plaintiff filed this action on May 29, 2013, alleging that various cellular wireless companies infringed on his patent, U.S. Patent No. 6,868,150 (“the ’150 Patent”), by providing call-waiting and caller-ID services. (Compl., ECF No. 1.) On December 18, 2017, Defendants moved for summary judgment, arguing that Claims 23 and 32 of the ’150 Patent are invalid under 35 U.S.C. § 101. The parties agree that there are no disputed issues of material fact at issue in the pending Motion. (Pl.’s Statement of Genuine Disputes of Material Facts and Conclusions of Law, ECF No. 135-1 (“Plaintiff . . . confirms there are no disputed issues of material fact relevant to Defendants’ Motion for Summary Judgment under 35 U.S.C. § 101.”)) Rather, the Motion turns on whether Claims 23 and 32 are patent eligible as a matter of law.

The ’150 Patent is titled, “Method for Use with Caller ID System.” (Defs.’ Statement of Uncontroverted Facts, Ex. A (“the Patent”), ECF No. 132-1.) According to Plaintiff, the ’150 Patent

¹ After considering the papers filed in connection with the Motion, the Court deemed the matter appropriate for decision without oral argument. Fed. R. Civ. P. 78(b); C.D. Cal. L.R. 7-15.

teaches improved methods for using conventional telephone and cellular equipment both for controlling the disclosure of a calling party directory telephone number (or name and number) and for transmitting that information from the switching office serving a party who is making a call to the switching office of a party receiving a call before transmitting or withholding that caller ID information to or from the called party.

(Opp'n 1.) Plaintiff claims that Defendants infringe Claims 23 and 32 of the '150 Patent.

Claim 23 provides:

A method for indicating to a first party who subscribes to a Custom Local Area Signaling System (CLASS) service including Caller Identification (Caller ID) and who is engaged in a telephone conversation with a second party an incoming call from a third party calling a telephone number of the first party comprising the steps of:

(a) receiving at a terminating central office (TCO) of the fi[r]st party who subscribes to said CLASS service including said Caller ID and who is engaged in the telephone conversation with the second party the third party directory telephone number (DN) flagged as private from an originating central office of the third party, indicating that said DN of the third party is not to be disclosed at the first party called station; and

(b) said TCO then sending a call waiting (CW) tone signal to the first party, said CW tone signal indicates to the first party the incoming call from the third party.

(The Patent col. 10:15–31.)

Claim 32 provides:

A method for sending a call waiting (CW) tone signal only to a first party who subscribes to a Custom Local Area Signaling System (CLASS) service including Caller Identification (Caller ID) and who is engaged in a telephone conversation with a second party, comprising the steps of:

(a) receiving at a terminating central office (TCO) of the first party who subscribes to said CLASS service including said Caller ID and who is engaged in the telephone conversation with the second party a calling third party directly telephone number (DN) flagged as private from an originating central office of the calling third party indicating that said received DN of the calling third party is not to be disclosed at the first party called station; and

(b) said TCO then sending said CW tone to the first party.

(*Id.* col. 11:11–26.)

Defendants argue that the two Claims are not materially different for the § 101 analysis. (*See* Mot. 2.) Each claim is directed to a method comprising two steps: (a) receiving a private-flagged directory telephone number of a calling party at a “terminating

central office”²; and (b) the terminating central office then sending a call waiting tone to the called party to notify them of the incoming call from the calling party. The “notification” takes the form of the well-known call waiting tone signal.

B. Parties’ Arguments

Defendants argue that Claims 23 and 32 are not patent-eligible under § 101 because they concern the abstract idea of notifying a person engaged in a conversation that a third party would like to speak with them. (Mot. 1.) Defendants contend that the Claims fail both steps of the test outlined in *Alice Corp. Pty Ltd. v. CLS Bank International*, 134 S. Ct. 2347 (2014) (“*Alice*”), i.e., the Claims are directed to an unpatentable abstract idea and contain no additional inventive elements in computer or communications technology to make them patent eligible.

Plaintiff argues that his inventions do not simply automate the “basic human activity” of interrupting a conversation to notify one of its participants that a third party would like to speak to one of the call participants; rather, the purpose of Claims 23 and 32 “is to indicate to a subscriber to both call waiting and caller ID, who is already engaged in a call, using an audible tone signal, the existence of an incoming call from a third party whose directory telephone number has been flagged private.” (Opp’n 6.) Plaintiff also argues that Defendants improperly interpret the

² The patent defines a “terminating central office” as generic “telephone switching office” equipment used by Regional Bell operating Companies to deliver telephone services. (The Patent, col. 1:48–2:12.)

Claims and asserts that the Court should construe the disputed claims before adjudicating the pending Motion. (*Id.* at 11.)

III. LEGAL STANDARD

A. Motion for Summary Judgment

Federal Rule of Civil Procedure 56 states that a “court shall grant summary judgment” when the movant “shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a). A fact is “material” for purposes of summary judgment if it might affect the outcome of the suit, and a “genuine issue” exists if the evidence is such that a reasonable factfinder could return a verdict for the non-moving party. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). The evidence, and any inferences based on underlying facts, must be viewed in the light most favorable to the opposing party. *Twentieth Century–Fox Film Corp. v. MCA, Inc.*, 715 F.2d 1327, 1329 (9th Cir. 1983). In ruling on a motion for summary judgment, the court’s function is not to weigh the evidence, but only to determine if a genuine issue of material fact exists. *Anderson*, 477 U.S. at 255.

Under Rule 56, the party moving for summary judgment has the initial burden to show “no genuine dispute as to any material fact.” Fed. R. Civ. P. 56(a); *see Nissan Fire & Marine Ins. Co. v. Fritz Cos.*, 210 F.3d 1099, 1102–03 (9th Cir. 2000). The burden then shifts to the non-moving party to produce admissible evidence showing a triable issue of fact. *Nissan Fire & Marine Ins.*, 210 F.3d at 1102–03; *see* Fed. R. Civ. P. 56(a). Summary judgment “is appropriate when the plaintiff fails to make a showing sufficient to establish

the existence of an element essential to [their] case, and on which [they] will bear the burden of proof at trial.” *Cleveland v. Policy Mgmt. Sys. Corp.*, 526 U.S. 795, 805–06 (1999); *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986). The standard “provides that the mere existence of some alleged factual dispute between the parties will not defeat an otherwise properly supported motion for summary judgment; the requirement is that there be no genuine issues of material fact.” *Anderson*, 477 U.S. at 247–48.

B. Test for Patent Eligibility

Section 101 “specifies four independent categories of inventions or discoveries that are eligible for patent protection: processes, machines, manufactures, and compositions of matter.” *Bilski v. Kappos*, 561 U.S. 593, 601 (2010). “In choosing such expansive terms . . . Congress plainly contemplated that the patent laws would be given wide scope.” *Id.* (quoting *Diamond v. Chakrabarty*, 447 U.S. 303, 308–09 (1980)). Even so, the Supreme Court has carved out three exceptions to Section 101’s “broad patent-eligibility principles: ‘laws of nature, physical phenomena, and abstract ideas.’” *Id.* (quoting *Chakrabarty*, 447 U.S. at 309). These exceptions seek to protect concepts that “are part of the storehouse of knowledge of all men” and are “free to all men and reserved exclusively to none.” *Id.* (quoting *Funk Bros. Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127, 130 (1948)).

The Supreme Court has also recognized that “[a]t some level, ‘all inventions . . . embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.’” *Alice*, 134 S. Ct. at

2354 (quoting *Mayo Collaborative Servs. v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289, 1293 (2012) (“*Mayo*”)) (ellipses in original). “Thus, an invention is not rendered ineligible for patent simply because it involves an abstract concept. Applications of such concepts to a new and useful end . . . remain eligible for patent protection.” *Id.* (citations and quotations omitted).

Expanding on its decision in *Mayo*, the Supreme Court in *Alice* established a two-step process for resolving patent eligibility under Section 101. “First, a court must ‘determine whether the claims at issue are directed to one of those patent-ineligible concepts.’” *Timeplay, Inc v. Audience Entm’t*, No. CV–15–05202–SJO–JCx, 2015 WL 9695321, at *3 (C.D. Cal. Nov. 10, 2015) (quoting *Alice*, 134 S. Ct. at 2355). “If so, then the court must ask ‘[w]hat else is there in the claims,’ which requires consideration of ‘the elements of each claim both individually and as an ordered combination to determine whether the additional elements transform the nature of the claim into a patent-eligible application.’” *Id.* (quotations omitted). “In this second step, the court must ‘search for an inventive concept—i.e., an element or combination of elements that is sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the ineligible concept itself.’” *Id.* (brackets and quotations omitted).

IV. DISCUSSION

A. Timing of Patent Eligibility Inquiry

As a threshold matter, the Court must first determine whether it may consider the question of patent eligibility without a claim construction

hearing. “Patent eligibility under [Section] 101 is a question of law that may, in appropriate cases, be decided on the pleadings without the benefit of a claim construction hearing.” *Modern Telecom Sys. LLC v. Earthlink, Inc.*, No. SA–CV–14–0347–DOC, 2015 WL 1239992, at *6 (C.D. Cal. Mar. 17, 2015) (citing *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat. Ass’n*, 776 F.3d 1343, 1349 (Fed. Cir. 2014) (affirming district court’s decision to grant motion to dismiss based on patent-ineligible subject matter under Section 101 without having a claim construction hearing)). Even so, it may be “desirable—and often necessary—to resolve claim construction disputes prior to a [Section] 101 analysis, for the determination of patent eligibility requires a full understanding of the basic character of the claimed subject matter.” *Bancorp Servs., L.L.C. v. Sun Life Assurance Co. Can. (U.S.)*, 687 F.3d 1266, 1273–74 (Fed. Cir. 2012); *but see Content Extraction*, 776 F.3d at 1349 (“Although the determination of patent eligibility requires a full understanding of the basic character of the claimed subject matter, claim construction is not an inviolable prerequisite to a validity determination under [Section] 101.”).

Plaintiff argues that the Court should first reject Defendants’ proposed interpretation of the claims at issue and construe the disputed claim terms consistently with Reese’s proposed constructions. (Opp’n 11.) Plaintiff also acknowledges, however, that a claim construction is not an “inviolable prerequisite to a validity determination.” (*Id.* (citing *Content Extraction*, 776 F.3d at 1349).) As described above, Claims 23 and 32 concern relatively nontechnical concepts of telephone services. These concepts are not so “opaque such that claim construction would be

necessary to flush out [their] contours” before determining whether the claims are patent eligible. *EveryMD.com LLC v. Facebook Inc.*, No. CV 16-06473-AB-JEM, 2017 WL 3453294, at *4 (C.D. Cal. May 10, 2017) (quoting *Lumen View Tech. v. Findthebest.com, Inc.*, 984 F. Supp. 2d 189, 205 (S.D.N.Y. 2013)). Therefore, the Court finds that a full claim construction is unnecessary to adjudicate the pending Motion.

B. Claims 23 and 32 of the '150 Patent Are Abstract and Fail Under Step One of the *Alice/Mayo* Inquiry

The first step in the *Alice/Mayo* test is to determine whether the patent claims are “directed to an abstract idea.” In evaluating this prong, courts in this district have adopted the approach in *Diamond v. Diehr*, 450 U.S. 175, 185 (1981), and held that the Court should first “identify the purpose of the claim—in other words, what the claimed invention is trying to achieve—and ask whether that purpose is abstract.” *Cal. Inst. of Tech. v. Hughes Commc’ns Inc.*, 59 F. Supp. 3d 974, 991 (C.D. Cal. 2014). “The *Diehr* majority took the correct approach of asking what the claim was trying to achieve, instead of examining the point of novelty.” *Id.* at 991–92. Thus, “courts should recite a claim’s purpose at a reasonably high level of generality,” using step one of the *Alice/Mayo* test as a “sort of ‘quick look’ test, the object of which is to identify a risk of preemption and ineligibility.” *Id.* Then, “[i]f a claim’s purpose is abstract, the court looks with more care at specific claim elements at step two.” *Id.*

At step one, “it is often useful to determine the breadth of the claims in order to determine whether the claims extend to cover a ‘fundamental . . . practice long prevalent in our system’” *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1369 (Fed. Cir. 2015) (quoting *Alice*, 134 S. Ct. at 2356). In determining whether the claims are directed to an abstract idea, courts “must be careful to avoid simplifying the claims because ‘at some level, all inventions . . . embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.’” *In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016) (quoting *Alice*, 134 S. Ct. at 2354). “However, not every claim that recites concrete, tangible components escapes the reach of the abstract-idea inquiry.” *Id.*

Defendants argue that Claims 23 and 32 are directed to the unpatentable, abstract idea of notifying a person engaged in a call that someone who wants to keep their telephone number private would like to speak with them. (Mot. 9.) They contend that the claims do nothing more than describe an automated version of the following human functions: Bruce calls an operator and asks to speak to Alex. Alex is already engaged in a call with Nate. Bruce instructs the operator to interrupt the call between Alex and Nate to tell Alex that he has a call, but not to disclose Bruce’s identity. The operator interrupts the call and informs Alex that an unidentified caller is attempting to call him on his telephone number. (*Id.* at 10–11.) Defendants also argue that the recitation in the Claims to general telecommunications equipment does not convert the abstract idea into something tangible. (*Id.* at 11 (citing *TLI*, 823 F.3d at 612).)

Plaintiff disputes that the purpose of the Claims is abstract. According to Plaintiff, the purpose is “to indicate to a subscriber to both call waiting and caller ID, who is already engaged in a call, using an audible tone signal, the existence of an incoming call from a third party whose directory telephone number has been flagged private.”

Even accepting this purpose as stated by Plaintiff, the Court finds it to be directed to an abstract idea. That the claims involve functionality of known telecommunications equipment does not detract from this finding. As the Federal Circuit has clarified, “a relevant inquiry at step one is ‘to ask whether the claims are directed to an improvement to computer functionality versus being directed to an abstract idea.’” *TLI Comm’ns*, 823 F.3d at 611. Claims involving the latter include those that “simply add conventional computer components to well-known business practices or consist only of generalized steps to be performed on a computer using conventional computer activity.” *Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1260 (Fed. Cir. 2016) (citing *TLI*, 823 F.3d at 612). For example, in *TLI* the Federal Circuit held patents claiming a method of uploading, classifying, and storing digital images were patent-ineligible even though the claims involved tangible components like “a telephone unit” and a “server” because these physical components “merely provided a generic environment in which to carry out the abstract idea of classifying and storing digital images in an organized manner.” 823 F.3d at 611. The specification described these components as “having ‘the standard features of a telephone unit,’ with the addition of a ‘digital image pick up unit for recording images,’ that ‘operates as a digital photo

camera of the type which is known.” *Id.* at 612 (citations to the patent specification omitted). “Likewise, the server [was] described simply in terms of performing generic computer functions such as storing, receiving, and extracting data.” *Id.* Thus, the components’ functions were “described in vague terms without any meaningful limitations,” indicating “the focus of the patentee and of the claims was not on an improved telephone unit or improved server.” *Id.* at 613. The Federal Circuit therefore concluded the claims were “not directed to a solution to a ‘technological problem’” or to solving “a challenge particular to the Internet,” but were instead directed to an abstract idea. *Id.* The Court finds that Claims 23 and 32 simply add conventional telecommunications components to the well-known telephone practice of interrupting a call to let one of the parties know that another person is trying to call them, and are directed to an abstract idea. *See Affinity Labs*, 838 F.3d at 1260.

Plaintiff responds that Defendants’ position ignores the limitations of the claims related to “flagging a directory telephone number as private, transmitting that flagged number from an originating office to a terminating office, and sending only an audible call waiting tone signal to the called party in response to receiving the flagged directory telephone number at the terminating central office.” (Opp’n 3.) The only part of this “limitation,” however, that actually appears on the face of the Claims is the action of sending an audible call waiting tone. Nowhere do the Claims describe the actual methods for flagging a number as private or transmitting the flagged number from one office to another. (*See The Patent* col. 10:15–34, col. 11:11–26.) Instead, the

Claims refer to a third-party call that has already been flagged as private and a terminating central office that “receiv[es]” the notice of the third-party call. (*Id.*) These passive descriptions do not describe the methods for “flagging” or the “receiving.”

Based on the language of the Claims themselves and Plaintiff’s description of the purpose of the Claims, the Court finds that they are directed to an abstract idea and fail step one of the *Alice/Mayo* inquiry.

C. Claims 23 and 32 of the ’150 Patent Fail to Add an Inventive Concept and Fail Step Two of the *Alice/Mayo* Inquiry

When a claim is directed to an abstract idea, the Court “consider[s] the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent eligible application.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1334–35 (Fed. Cir. 2016) (quoting *Mayo*, 132 S. Ct. at 1297–98). This inquiry requires a determination whether the patent includes “additional features to ensure that the claim[s] [are] more than a drafting effort designed to monopolize the abstract idea.” *Alice*, 134 S. Ct. at 2357. “Those ‘additional features’ must be more than ‘well-understood, routine, conventional activity.’” *Ultramercial, Inc. and Ultramercial, LLC v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014) (quoting *Mayo*, 132 S. Ct. at 1298).

Plaintiff argues that Claims 23 and 32 contain an inventive concept because they “describe a specific method for providing flagged caller identification

information from an originating central office to a terminating central office and, when appropriate, withholding that information from a party already engaged in a call but only if that called party subscribes to specific telephone features.” (Opp’n 10–11.)

Considering the language of the Claims themselves, the Court finds that neither claim includes an inventive concept that transforms the nature of the Claims into patentable inventions. As Defendants point out, the Claims do not describe the use of any particular equipment or describe how the tone is transmitted. (Reply 15.) Additionally, the use of telephone units in the Claims is not sufficient to establish an inventive concept. *TLI*, 823 F.3d at 614 (explaining that “the telephone unit is not an inventive concept sufficient to confer patent eligibility”). And as discussed above, the Claims do not describe the actual processes or necessary equipment for (1) subscribing to call waiting or caller ID, (2) flagging the number as private, (3) transmitting the flagged caller’s information to the terminating central office, or (4) transmitting the call waiting tone to the party engaged in the call. Therefore, the Court finds that the Claims simply “monopolize the abstract idea” and are not patent eligible. *See Alice*, 134 S. Ct. at 2357.

Thus, Claims 23 and 32 fail step two of the *Alice/Mayo* inquiry to be patent-eligible subject matter under § 101. Therefore, the Court **GRANTS** Defendants’ Motion for Summary Judgment.

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V. CONCLUSION

For the foregoing reasons, the Court **GRANTS** Defendants' Motion for Summary Judgment. (ECF No. 131.) The Court **ORDERS** the parties to file a joint status report no later than **April 23, 2018**, detailing what claims, if any, remain for the Court to resolve, including whether adjudication of Defendants AT&T and T-Mobile's pending motions to amend is necessary given the outcome of the Motion for Summary Judgment. If there are no further claims remaining, the parties shall submit a proposed final judgment for the Court's review.

IT IS SO ORDERED.

April 9, 2018

/s/

OTIS D. WRIGHT, II
UNITED STATES DISTRICT JUDGE

[ENTERED: April 24, 2018]

JS-6

IN THE UNITED STATES DISTRICT COURT
FOR THE CENTRAL DISTRICT OF
CALIFORNIA
WESTERN DIVISION—LOS ANGELES

MORRIS REESE, Plaintiff, v. SPRINT NEXTEL CORP., Defendant.	Case No. CV13-03811-ODW (PLAx) JUDGMENT ALL CASES Judge: Hon. Otis D. Wright II Courtroom: 11
MORRIS REESE, Plaintiff and Counter-defendant, v. TRACFONE WIRELESS, INC., Defendant and Counterclaimant.	Case No. CV13-05196-ODW (PLAx) JUDGMENT ALL CASES Judge: Hon. Otis D. Wright II Courtroom: 11

MORRIS REESE, Plaintiff and Counter-defendant, v. VERIZON WIRELESS SERVS LLC, Defendant and Counterclaimant.	Case No. CV13-05197-ODW (PLAx) JUDGMENT ALL CASES Judge: Hon. Otis D. Wright II Courtroom: 11
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MORRIS REESE, Plaintiff and Counter-defendant, v. AT&T MOBILITY II LLC, Defendant and Counterclaimant.	Case No. CV13-05198-ODW (PLAx) JUDGMENT ALL CASES Judge: Hon. Otis D. Wright II Courtroom: 11
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MORRIS REESE, Plaintiff, v. T-MOBILE USA, Defendant.	Case No. CV13-05199-ODW (PLAx) JUDGMENT ALL CASES Judge: Hon. Otis D. Wright II Courtroom: 11
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FINAL JUDGMENT

On April 9, 2018, the Court granted Defendants' Motion for Summary Judgment under 35 U.S.C. § 101 (Sprint Dkt. #140). Because the Court's April 9, 2018 Order invalidated all claims that have been asserted in this action, the Court hereby enters judgment in favor of Defendants.

IT IS HEREBY ORDERED:

1. Plaintiff Morris Reese shall take nothing;
2. Judgment is entered on behalf of all of the Defendants in this, the lead case (Sprint Nextel Corp. (2:13-cv-3811-ODW(PLAx))), as well as in the following related cases:
 - a. TracFone Wireless, Inc. (2:13-cv-5196-ODW(PLAx));
 - b. Verizon Wireless Services LLC (2:13-cv-5197-ODW(PLAx));
 - c. AT&T Mobility II LLC (2:13-cv-5198-ODW(PLAx)); and
 - d. T-Mobile USA (2:13-cv-5199-ODW(PLAx));
3. Defendant AT&T Mobility II LLC's and T-Mobile USA's pending Motions to Amend are dismissed without prejudice (2:13-cv-5198-ODW-PLA, ECF No. 49; 2:13-cv-5199-ODW-PLA, ECF No. 60);
4. The Defendants' counterclaims are dismissed without prejudice;
5. All dates and deadlines are **VACATED**; and

[ENTERED: August 8, 2019]

NOTE: This order is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

MORRIS REESE
Plaintiff-Appellant

v.

SPRINT NEXTEL CORPORATION
Defendant-Appellee

2018-1971

Appeal from the United States District Court for
the Central District of California in No. 2:13-cv-
03811-ODW-PLA, Judge Otis D. Wright, II.

MORRIS REESE
Plaintiff-Appellant

v.

**TRACFONE WIRELESS, INC.,
ERRONEOUSLY SUED AS TRACFONE
WIRELESS SERVICES INC.,**
Defendant-Appellee

2018-1972

Appeal from the United States District Court for
the Central District of California in No. 2:13-cv-
05196-ODW-PLA, Judge Otis D. Wright, II.

MORRIS REESE
Plaintiff-Appellant

v.

**VERIZON WIRELESS SERVICES LLC,
ERRONEOUSLY SUED AS CELLCO
PARTNERSHIP, DOING BUSINESS AS
VERIZON WIRELESS,**
Defendant-Appellee

2018-1973

Appeal from the United States District Court for
the Central District of California in No. 2:13-cv-
05197-ODW-PLA, Judge Otis D. Wright, II.

MORRIS REESE
Plaintiff-Appellant

v.

AT&T MOBILITY II LLC
Defendant-Appellee

2018-1974

Appeal from the United States District Court for
the Central District of California in No. 2:13-cv-
05198-ODW-PLA, Judge Otis D. Wright, II.

MORRIS REESE
Plaintiff-Appellant

v.

T-MOBILE USA, INC.,
Defendant-Appellee

2018-1975

Appeal from the United States District Court for
the Central District of California in No. 2:13-cv-
05199-ODW-PLA, Judge Otis D. Wright, II.

ON MOTION

Before PROST, *Chief Judge*, NEWMAN, LOURIE, DYK,
MOORE, O'MALLEY, REYNA, WALLACH, TARANTO,
CHEN, HUGHES, and STOLL, *Circuit Judges*.

PER CURIAM.

O R D E R

Appellant Morris Reese filed a combined petition
for panel rehearing and rehearing en banc. The
petition was referred to the panel that heard the
appeal, and thereafter the petition for rehearing en

banc was referred to the circuit judges who are in regular active service.

Upon consideration thereof,

IT IS ORDERED THAT:

The petition for panel rehearing is denied.

The petition for rehearing en banc is denied.

The mandate of the court will issue on August 15, 2019.

FOR THE COURT

August 8, 2019

Date

/s/ Peter R. Marksteiner

Peter R. Marksteiner

Clerk of Court