

Petition for Post-Grant Review of
U.S. Patent No. 12,133,078

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BE SMARTER, LLC AND JAMES GUERRA,

Petitioners

v.

YONDR, INC.,

Patent Owner

PGR2025-0070

U.S. Patent No. 12,133,078 B2

Filing Date: March 14, 2024

Issue Date: October 29, 2024

Title: System and Apparatus for Selectively Limiting
User Control of an Electronic Device

**PETITION FOR POST-GRANT REVIEW
OF U.S. PATENT NO. 12,133,078 B2**

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EXHIBITS

Exhibit No.	Description of Document
EX-1001	U.S. Patent No. 12,133,078 B2 to Graham Dugoni (filed March 14, 2024, issued October 29, 2024) (“’078 patent”)
EX-1002	Declaration of Dr. Gregory Buckner (“Buckner Decl.”)
EX-1003	U.S. Patent Appl. Pub. No. 2003/0011466 to Samuel et al. (filed February 15, 2001, published January 16, 2003) (“Samuel”)
EX-1004	Korean Patent Laid-open No. 10-2007-0041248 to Hyo-jyn Shin (filed October 14, 2005, published April 18, 2007) (“Shin”)
EX-1005	U.S. Patent Appl. Pub. No. 2014/0298492 to Simpson (filed March 14, 2014, published October 2, 2014) (“Simpson”)
EX-1006	International Publication No. WO 2014/122001 A1 to Theobald (filed January 20, 2014, published August 14, 2014) (“Theobald”)
EX-1007	Prosecution History of U.S. Patent No. 12,133,078 B2
EX-1008	U.S. Patent Appl. Pub. No. 2012/0187003 to Stewart et al. (filed January 21, 2011, published July 26, 2012) (“Stewart”)
EX-1009	U.S. Patent No. 3,851,506 to Simon et al. (filed December 29, 1972, issued December 3, 1974) (“Simon”)
EX-1010	U.S. Patent No. 5,977,876 to Coleman (filed August 13, 1998, issued November 2, 1999) (“Coleman”)
EX-1011	U.S. Patent No. 5,426,419 to Nguyen, et al. (filed January 14, 1993, issued June 20, 1995) (“Nguyen”)
EX-1012	U.S. Patent No. 6,218,929 to Furuta et al. (filed June 10, 1998, issued April 17, 2001) (“Furuta”)
EX-1013	Prosecution History of U.S. Patent No. 9,819,788 B2
EX-1014	Defendants’ Opening Claim Construction Memorandum filed June 6, 2025 in Civ. A. No. 1:24-cv-01326
EX-1015	Yondr, Inc.’s Responsive Claim Construction Brief filed June 27, 2025 in Civ. A. No. 1:24-cv-01326
EX-1016	Defendants’ Reply Claim Construction Memorandum filed July 11, 2025 in Civ. A. No. 1:24-cv-01326

EX-1017	U.S. Patent No. 9,819,788 B2 to Dugoni (filed April 21, 2015, issued November 14, 2017) (“the ’788 patent”)
EX-1018	U.S. Patent No. 6,499,638 to Campbell (filed July 17, 2001, issued December 31, 2002) (“Campbell”)
EX-1019	U.S. Patent No. 6,608,548 to Pellaton (filed May 22, 1998, issued August 19, 2003) (“Pellaton”)
EX-1020	U.S. Patent No. 7,277,726 to Ahya (filed May 3, 2004, issued October 2, 2007) (“Ahya”)

I. INTRODUCTION

Be Smarter, LLC and James Guerra (“Petitioners” or “Be Smarter”) hereby petition for post-grant review of claims 1-5, 9-11, 15-16, and 19 (“Challenged Claims”) of U.S. Patent No. 12,133,078 (EX-1001, “the ’078 patent”).

II. COMPLIANCE WITH FORMAL REQUIREMENTS

A. Mandatory Notices Under 37 C.F.R. §42.8(b)(1)-(4)

1. Real-Party-In-Interest

The real parties-in-interest are Be Smarter, LLC and James Guerra.

2. Related Matters

The ’078 patent is the subject of pending litigation involving Petitioners: *Yondr, Inc. v. Be Smarter, LLC and James Guerra*, Case No. 2024-CV-1326 (WDTX) (filed October 31, 2024, “the WDTX Action”). Petitioner Be Smarter, LLC was served on November 4, 2024. Petitioner Mr. Guerra was served November 19, 2024.

The ’078 patent is also the subject of pending litigation in *Win Elements LLC v. Yondr, Inc.*, Case No. 2:24-cv-09311 (C.D. Cal.) (filed October 29, 2024).

Be Smarter is not aware of any prior AIA proceedings against the ’078 patent; however, the ’078 patent shares the same specification and is related via a series of continuations and a divisional to U.S. Patent No. 9,819,788, which is the subject of IPR No. 2025-00970 filed by Be Smarter on May 6, 2025.

3. Lead and Back-Up Counsel

Be Smarter provides the following designation of counsel.

Lead Counsel

Leisa Talbert Peschel (Reg. No. 62,248)	Phone: 713-752-4278
JACKSON WALKER LLP	Fax: 713-308-4178
1401 McKinney, Suite 1900	lpeschel@jw.com
Houston, TX 77010	lpeschelipdocket@jw.com

Back-up Counsel

Arthur Gollwitzer III	Phone: 512-236-2268
JACKSON WALKER LLP	Fax: 713-308-4178
100 Congress Ave. Suite 1100	agollwitzer@jw.com
Austin, TX 78701	<i>Pro Hac Vice</i> ¹

Raman N. Dewan (Reg. No. 05791700)	Phone: 512-236-2013
JACKSON WALKER LLP	Fax: 713-308-4178
100 Congress Ave. Suite 1100	rdewanipdocket@jw.com
Austin, TX 78701	

4. Service Information

Service information is provided in the designation of lead and back-up counsel above. Be Smarter consents to electronic service to lead and back-up counsel.

B. Proof of Service on the Patent Owner

This Petition is being served by Federal Express next-day delivery to Patent Owner via the attorney of record for the '078 patent, Sterne, Kessler, Goldstein & Fox P.L.L.C., 1101 K Street, NW, 10th Floor, Washington, DC 20005.

¹ Motion for *pro hac vice* admission to be filed after authorization is granted.

As identified in the attached Certificate of Service, a copy of this Petition and supporting evidence is also being served electronically on counsel of record for Patent Owner in the WDTX Action.

C. Power of Attorney

Powers of attorney are being filed with designation of counsel in accordance with 37 C.F.R. §41.10(b).

D. Standing

Be Smarter certifies the '078 patent may be challenged via post-grant review and that it is not barred or otherwise estopped from requesting a post-grant review on the Challenged Claims on the grounds identified in this Petition.

E. Timing

Pursuant to 37 C.F.R. §42.202, Be Smarter is filing this Petition within nine months of the '078 patent's issue date (October 29, 2024), and this Petition is therefore timely.

F. Fees

The undersigned authorizes the Director to charge the fee specified in 37 C.F.R. § 42.15(b) and any additional fees that may be due in connection with this Petition to Deposit Account No. 40-096.

III. STATEMENT OF PRECISE RELIEF REQUESTED

A. Prior Art

The following references are relevant to the grounds of unpatentability:

- U.S. Pat. App. Pub. No. 2003/0011455 to Samuel *et al.*, published January 16, 2003 (“Samuel,” EX-1003);
- Korean Patent Laid-open No. 10-2007-0041248 to Hyo-jyn Shin, published April 18, 2007 (“Shin,” EX-1004);
- U.S. Patent Appl. Pub. No. 2014/0298492 to Simpson, published October 2, 2014 (“Simpson,” EX-1005); and
- International Publication No. WO 2014/122001 A1 to Theobald, published August 14, 2014 (“Theobald,” EX-1006).

Each reference qualifies as prior art under 35 U.S.C. § 102(a) (AIA).

B. Grounds

This Petition, supported by the declaration of Dr. Gregory Buckner (“Buckner Decl.,” EX-1002), requests cancellation of the Challenged Claims of the ’078 patent on the following grounds:

Ground	Claims	Basis for Challenge
1	1-5, 9-11, 15-16, 19	Invalid under 35 U.S.C. § 112 for indefiniteness
2	1, 3, 9	Anticipated under 35 U.S.C. § 102 by Samuel
3	1, 3, 4, 9, 11, 15-16	Obvious under 35 U.S.C. § 103(a) over Samuel in view of Shin
4	2, 10, 19	Obvious under 35 U.S.C. § 103(a) over Samuel in view of Shin in further view of Simpson
5	5	Obvious under 35 U.S.C. § 103(a) over Samuel in view of Shin in further view of Theobald

6	1-5, 9-11, 15-16, 19	Invalid under 35 U.S.C. § 101 for lack of patent-eligible subject matter
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The '078 patent generally relates to locking cases or pouches used to store and preclude use of cellular phones or other mobile electronic devices. The Challenged Claims focus on a pouch or case with a locking mechanism; that is, the technology is not sophisticated, and the prior art manifestly teaches all elements of the Challenged Claims. Accordingly, expert testimony should not be necessary to compare the prior art to the '078 patent. Nevertheless, Be Smarter includes the accompanying declaration from Dr. Buckner out of an abundance of caution. *See* Buckner Decl., ¶¶ 1-369.

IV. ***SOTERA* STIPULATION**

Pursuant to the guidance provided by the Board, Be Smarter does not address discretionary denial in this Petition. *See* United States Patent and Trademark Office Memorandum, dated March 26, 2025, and “FAQs for Interim Processes for PTAB Workload Management.” However, in accordance with the Board’s precedential decision in *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (PTAB Dec. 1, 2020), Petitioners Be Smarter, LLC and James Guerra stipulate that if the Board institutes post-grant review in this proceeding, then Petitioners will not pursue in the parallel district court proceeding, *Yondr, Inc. v. Be Smarter, LLC and James Guerra*, Case No. 2024-CV-1326 (WDTX), the same grounds as in the

petition or any grounds that could have reasonably been raised in this Petition.

V. OVERVIEW OF THE '078 PATENT²

A. Summary of the '078 Patent

1. '078 Patent Specification

The '078 patent is titled “System and Apparatus for Selectively Limiting User Control of an Electronic Device” and issued on October 29, 2024. EX-1001, Title. The '078 patent describes its technical field as follows:

The disclosed subject matter relates generally to systems and apparatuses for limiting functionality of personal electronic devices and, more particularly, to locking cases and other techniques that selectively limit a user's ability to access and control such electronic devices until predetermined conditions, such as geographic location and passage of time, are met.

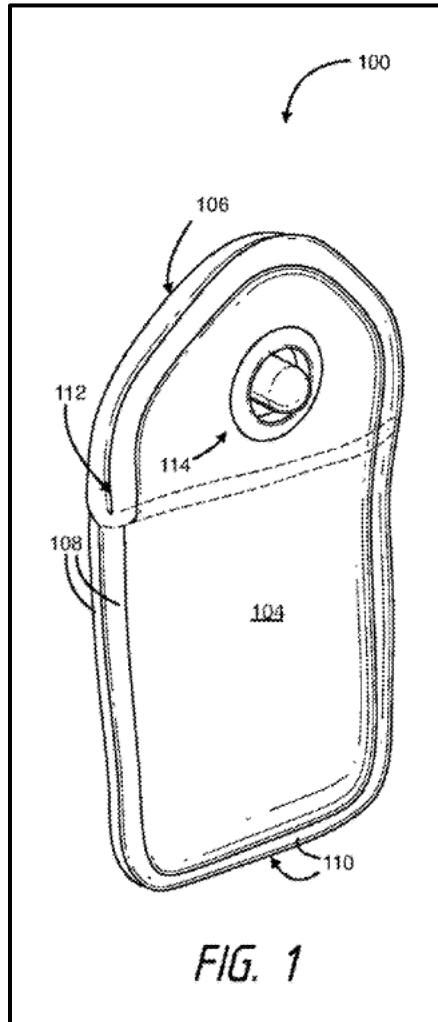
EX-1001, 1:33-39.

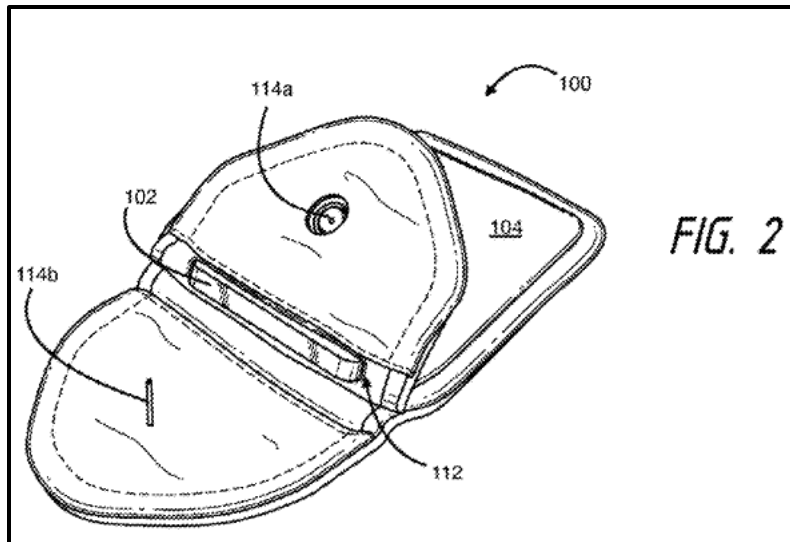
The '078 patent acknowledges prior art attempts were made to limit use of electronic devices, including shutting off a cellphone and preventing its user from turning it on within a restricted area. EX-1001, 1:63-2:3. The '078 patent states this solution was “deficient because it fails to block the screen to diminish possible temptation to use the device.” EX-1001, 2:6-8.

As a purported solution, the '078 patent describes a case sized to

² Unless otherwise specified, all **bold** or *bold italics* emphasis has been added. For example, Petitioners use **bold** emphasis for figure identifiers and claim language.

accommodate or receive a mobile device comprising a front and rear panel secured together along longitudinally opposed side edge and laterally opposed lower edges to form an opening to receive an electronic device, such as shown in Figures 1 and 2:





EX-1001, Figs. 1-2, 2:43-49, 5:58-6:2; *see also* EX-1001 at Figs. 3-4. Such a case may include a locking means to render the device inaccessible to the user until a predetermined condition, such as geographic location, timing, or leaving a venue, is met. EX-1001, 2:50-3:4. The '078 patent teaches the locking mechanism could be remotely engageable and disengageable via the use of an RFID receiver or a microprocessor equipped to receive Bluetooth or wireless signals. EX-1001, 3:10-31, 7:5-51. Alternatively, the '078 patent also teaches that, in some embodiments, the case may be manually unlocked by “venue staff.” EX-1001, 3:7-9, 6:38-6:47.

Although depicted as a “soft, flexible case,” the '078 patent notes other configurations for the case are contemplated such as “a rigid shell or box having a securable, opening to receive a mobile electronic device.” EX-1001, 6:3-14.

The '078 patent describes one physical structure of a locking means as securably mateable opposing plates disposed on the front and rear panels but

contemplates other locking means such as magnetic plates, selectively releasable mesh, lockable zippers, or key operated latches could be used. EX-1001, 6:21-40.

2. '078 Patent Claims

Independent claim 1 of the '078 patent is representative of claims 1-5 (indicators added):

1 (preamble) A case comprising:

- (a) a shell defining a cavity sized to accommodate a mobile device, the shell having an opening to receive the mobile device; and
- (b) a lock positioned proximate to the opening of the shell, the lock configured to render the mobile device at least partially inaccessible upon the lock being locked with the mobile device within the cavity of the shell,
- (c) the lock further configured to unlock to enable access to the mobile device based on a predetermined condition associated with a geographic region.

(EX-1001, cl. 1.) Claim 2 further limits the predetermined condition to a time period; claim 3 requires that the geographic region identified in claim 1 corresponds to a physical position of the case “respective to a geographic area of a venue;” claim 4 further limits the structure of the shell; and claim 5 requires that the lock is configured to unlock with a detacher. (EX-1001, cls. 2-5.)

Independent claim 9 of the '078 patent is representative of claims 9-11

(indicators added):

9 (preamble) A case comprising:

- (a) a shell defining a cavity sized to accommodate a mobile device, the shell having an opening to receive the mobile device; and
- (b) a lock positioned proximate to the opening of the shell, the lock configured to at least partially secure the opening of the shell, the lock being further configured to lock the shell and render the mobile device at least partially inaccessible,
- (c) wherein the lock is further configured to unlock to enable access to the mobile device in accordance with a predetermined condition associated with a geographical region.

(EX-1001, cl. 9.) Claim 10 limits the predetermined condition to “associated with a time period” and the geographic region to a “physical position of the case respective to a geographic area of a venue.” (EX-1001, cl. 10.) Claim 11 further limits the structure of the claimed shell. (EX-1001, cl. 11.)

Independent claim 15 of the '078 patent is representative of claims 15, 16, and 19 (indicators added):

15 (preamble) A system comprising: a case sized to receive a user's mobile electronic device, the case including:

- (a) a front panel having a first set of longitudinal edges, a first top edge

and a first bottom edge, and

(b) a rear panel having a second set of longitudinal edges a second top edge and a second bottom edge, wherein the first set of longitudinal edges are respectively secured to the second set of longitudinal edges and the first bottom edge is secured to the second bottom edge to define an opening of the case for receiving a mobile electronic device; and

(c) a lock proximately located to the opening of the case, the lock configured to at least partially secure the opening and render the user unable to access the mobile electronic device until a predetermined condition is met,

(d) the predetermined condition being associated with a physical presence of the case being outside of a defined geographical region.

(EX-1001, cl. 15.) Claim 16 further limits the structure of the lock to require a female and a male plate, and claim 19 limits the predetermined condition to be “associated with a passage of time.” (EX-1001, cls. 16, 19.)

B. Summary of the '078 Patent Prosecution History and the Examiner's Error

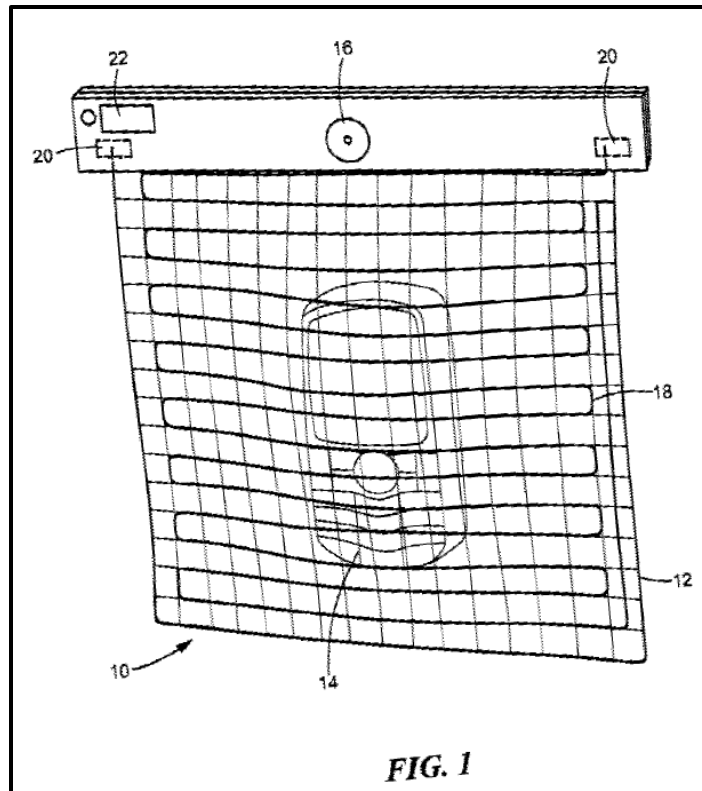
U.S. Patent Application No. 18/604,847 (“the '847 Application”), which ultimately issued as the '078 patent was filed on March 14, 2024. (EX-1001, Cover.)

The '847 Application was filed as a continuation of U.S. Patent Application No. 18/517,675 (filed November 22, 2023), which was a divisional of U.S. Patent

Application No. 16/813,437 (filed March 9, 2020), which was a continuation of Application No. 15/704,425 (filed September 14, 2017), which was a continuation of Application No. 14/692,530 (filed April 21, 2015), now U.S. Patent No. 9,819,788 (“the ’788 patent”). (EX-1001, Cover, 2).

The ’847 Application received prioritized examination under Track I. (EX-1007-076.) In an Office Action on May 23, 2024, the Examiner rejected most of the claims as anticipated by Stewart (EX-1008) and found the rest obvious in light of Stewart combined with Simon (EX-1009, which provided evidence that locks configured to unlock based on a predetermined condition of a time period were well known for at least fifty years), Coleman (EX-1010, which provided evidence that technology incorporating a microprocessor for receiving wireless data signals to unlock a case for a predetermined condition was more than two decades old), or Nguyen (EX-1011, which provided evidence that a lock comprising male and female plates disposed on panels that securably mate was “old” and “commercially available to the general public and well known to one below ordinary skill in the art”). (EX-1007-080, -087, -089, -091, -141; *see also* Buckner Decl., ¶¶ 67-70.)

Notably, Stewart teaches a case for securing a mobile electronic device until a predetermined condition is met including as shown in Figure 1:



(See Buckner Decl., ¶¶ 120-124 (providing an overview of Stewart’s teachings).)

Based on an August 23, 2024, interview, the Examiner subsequently withdrew the rejection of pending claims 20, 28, and 37 because the art of record did not disclose the predetermined condition being both associated with a geographical region and a time period. (EX-1007-145.) The Applicant then filed a response amending the claims so that a predetermined condition associated with a geographic region or with a physical presence of the case being outside of a defined geographic region was required and argued that the claims were now allowable based on the Examiner’s remarks in the interview. (EX-1007-148 to -150, -152; *see also* Buckner Decl., ¶¶ 72-73.) A Notice of Allowance subsequently issued. (EX-1007-160-162.)

The Examiner's allowance of the '847 Application claims over Stewart in combination with the other references was in error. During prosecution of the '788 patent, the Examiner correctly rejected pending claim 5 directed at the same or similar "geographic region" limitations as in '847 Application claims as obvious in light of Stewart and Furuta (EX-1012) but then erred in indicating pending claim 8, which included the same limitation, was allowable if re-written into independent form. (EX-1013-029 (April 21, 2015, Claims at 22); EX-1013-055 (October 3, 2016, Office Action at 11); EX-1013-095, -099 (May 5, 2017, Final Rejection at 12, 16); Buckner Decl., ¶¶ 82-89.) During prosecution of the '847 Application, the Examiner appears to have repeated this mistake to allow similar claims to those at issue during prosecution of the '788 patent. (Buckner Decl., ¶ 95.)

A more detailed analysis of the prosecution history of both the '078 patent and the '788 patent is included in the Declaration of Dr. Gregory Buckner. (EX-1002, ¶¶ 65-95.)

C. Effective Filing Date and PGR Eligibility Under AIA § 3(n)(1)

The '078 patent is eligible for PGR if it, or any of its priority applications, contains or contained at any time a claim with an effective filing date on or after March 16, 2013. *See* AIA § 3(n)(1). The '078 patent issued from Application No. 18/604,847, which was filed March 14, 2024 and claims priority through a series of continuations and a divisional to April 21, 2015. (EX-1001, Cover, 2.) Therefore,

the effective filing date of all claims is after March 16, 2013, and the '078 patent is eligible for PGR.

D. Level of Ordinary Skill in the Art

A person of ordinary skill in the art as of the priority date for the '078 patent would have possessed at least a bachelor's degree in mechanical engineering, electrical engineering, or computer science and two or more years of experience in electromechanical product design.³ (Buckner Decl., ¶ 96.) A person could have qualified with more formal education and less technical experience or *vice versa*. (Buckner Decl., ¶ 96.)

E. Claim Construction⁴

1. “Configured to Unlock to Enable Access to the Mobile Device Based on/in Accordance with a Predetermined Condition”

Independent claims 1 and 9 contain the same “**configured to unlock . . .**”

³ In the WDTX Action, Yondr similarly proposed that a person of ordinary skill in the art “would have an undergraduate degree in mechanical engineering, industrial design, or a related field.” (EX-1015-008.)

⁴ Be Smarter does not anticipate any dispute regarding constructions agreed to by the parties in the WDTX Action (“based on”/ “in accordance with,” “geographic area of

language that links the claimed lock with the concepts of (i) rendering the mobile device inaccessible and (ii) unlocking the case based on or in accordance with a predetermined condition. Be Smarter submits this claim language should mean “programmed to unlock the case upon satisfying a predetermined condition (as defined in Section V.E.2)” in light of the intrinsic evidence. Specifically, the claims contemplate that the lock is configured to unlock based on external triggers or signals, such as geographic area or timing. (EX-1001, claims 1, 6-8, 10, 12–13, 15, 17-19.) The specification likewise supports this construction describing several such embodiments that are programmed to respond to external triggers or signals. (EX-1001, 3:10-31 (lock equipped with electronic receivers such as RFID “configured to instruct the locking means to alternatively engage and disengage when it receives a signal from a proximity transmitter indicating the case has respectively entered and exited defined geographical region”), 4:32-5:3 (contemplating programming may be required to direct functions of the present invention), 7:5-36 (RFID embodiment), 7:52-61 (referring to use of a transmitter to allow unlocking based on timing); *see also* EX-1014-015–017; EX-1016-010–012 (Be Smarter’s arguments in the WDTX Action).)

a venue,” and “proximate”), but submits that if any such dispute arises that the Board should adopt the agreed constructions for each. (*See* EX-1014-008.)

Yondr argued in the WDTX Action that plain and ordinary meaning should apply, and manual unlocking or user-controlled access should not be excluded based on a single example in the specification referring to manual unlocking with a key and latch. (See EX-1015-013-017.) However, not every claim of a patent must cover every embodiment disclosed in the specification. See *SMO Holdings, Inc. v. Hong Kong uCloudlink Network Tech. Ltd.*, 983 F.3d 1367, 1378-79 (Fed. Cir. 2021) (the court must not allow a disclosed embodiment to “outweigh the language of the claim,” especially when the court’s construction is supported by the rest of the intrinsic record). Manual unlocking or user-controlled access are directly counter to the requirement that access to the mobile device is based on a “predetermined condition.” By the plain language in the claims at issue, the lock itself must be configured to enable access to the mobile device based on a “**predetermined condition**.” A lock that opens with a manual key or solely as a result of the user’s actions irrespective of whether the claimed predetermined condition is actually met is not an embodiment of these claims.

2. “Predetermined Condition”

Be Smarter proposes that “**predetermined condition**” should be construed to mean that “a specific pre-established requirement that must be satisfied before a user can regain access to his or her mobile electronic device/mobile device.” The independent claims of the ’078 patent require that the lock be “**configured to unlock**

to enable access to the mobile device based on/in accordance with a *predetermined condition* associated with a geographic region” or “configured to at least partially secure the opening and render the user unable to access the mobile electronic device until a *predetermined condition* is met.” (EX-1001, cls. 1, 9, 15; *see also id.*, cls. 2, 10, 19 (adding further limitations to the predetermined condition). Be Smarter’s proposed construction is consistent with both the context of that claim language and the specification. The ’078 patent describes the problem of electronic device distraction and claims that solving the problem requires “a system and apparatus that selectively limits access to and/or disables functions of a mobile electronic device.” (EX-1001, 2:25-27.) In addition, the claims of the ’078 patent were allowed only after the Patent Owner amended the claims to make clear the case could not be unlocked until a predetermined condition associated with a geographic region had been met. (EX-1007-161-162.) From this intrinsic record, it is abundantly clear that the “**predetermined condition**” must be a specific, pre-existing requirement programmed to trigger unlocking of the lock , rather than a spontaneous decision by the user or a third party that some condition is met. (*See also* EX-1014-017-019; EX-1016-012-013 (Be Smarter’s arguments in the WDTX Action).)

3. “A Predetermined Condition *Associated with a Geographic Region*”

Be Smarter contends that “a **predetermined condition *associated with a***

geographic region” is indefinite under 35 U.S.C. § 112(b) as addressed in Ground 5 below. *See* Section VI.F below.

VI. THE CHALLENGED CLAIMS ARE UNPATENTABLE

A. Overview of Grounds

The Challenged Claims attempt to secure patent rights in lockable cases used to render mobile electronic devices inaccessible until a predetermined condition associated with a geographic region or with a physical presence of the case outside of a defined geographic region is met. These cases and systems, however, were known at the time of the claimed inventions and, therefore, the Challenged Claims are invalid in light of the prior art. *See* Grounds 1-4 below.

Specifically, each of Grounds 1-4 primarily rely on Samuel, which discloses a locked case for securely transporting valuable objects that can only be unlocked when some condition is satisfied, such as arrival at a specific address. (*See* Buckner Decl., ¶¶ 103-108 (providing an overview of Samuel).) Grounds 2 to 4 also rely on Shin which describes an envelope for securing an object such as a cellphone. (*See* Buckner Decl., ¶¶ 97-102 (providing an overview of Shin).) Ground 3 also cites Simpson for using the passage of time as the predetermined condition for unlocking the case. (*See* Buckner Decl., ¶¶ 109-114 (providing an overview of Simpson).) Ground 4 relies on the combination of Samuel with Shin and Theobald, which discloses using magnetic detachers to unlock a case. (*See* Buckner Decl., ¶¶ 115-119

(providing an overview of Theobald).) Thus, the Challenged Claims are anticipated and obvious in view of this prior art.

In Ground 5, Be Smarter explains why the scope of the Challenged Claims is not readily ascertainable due to the requirement that the predetermined condition be **“associated with”** a **“geographic/geographical region”** or a **“physical presence of the case being outside of a defined geographical region”** without any clarity in the intrinsic record as to the metes and bounds of **“associated with.”** (EX-1001, cls. 1, 9, 15.)

Finally, Ground 6 focuses on the lack of patent eligibility of the Challenged Claims, which are directed to nothing more than the abstract idea of locking up a mobile device to prevent use without any inventive concept.

B. Ground 1: Claims 1, 3, 9 are Unpatentable under 35 U.S.C. § 102 in view of Samuel

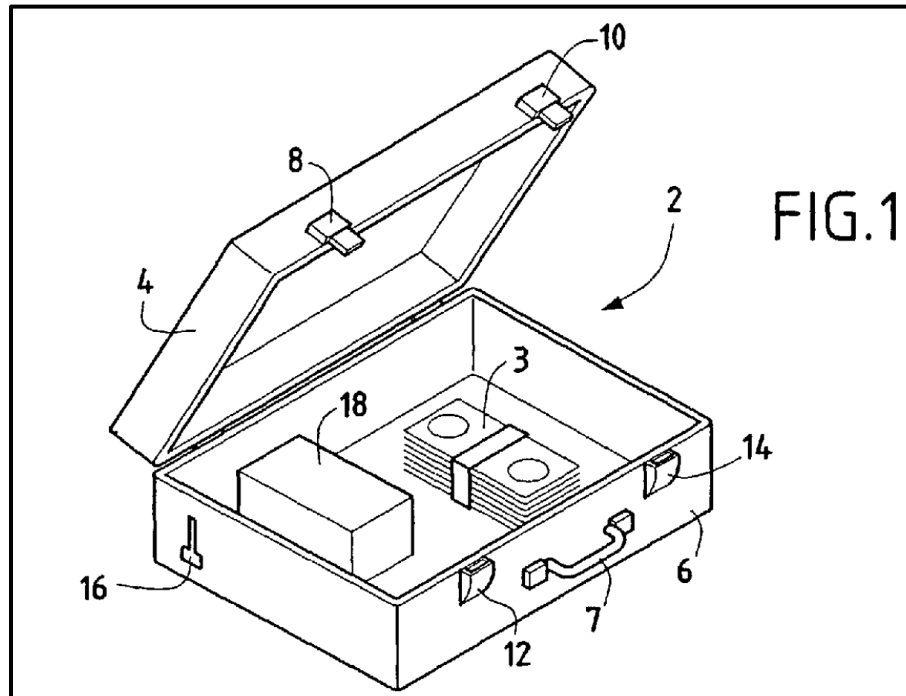
1. Summary of Samuel

U.S. Publication No. 2003/0011466 to Samuel *et al.* (“Samuel”) published on January 16, 2003, from an application filed on February 15, 2001, and is titled “Device and Method for Safe Transport on an Object.” (EX-1003, Title; *see also* Buckner Decl., ¶¶ 103-108 (providing an overview of Samuel).)

Samuel describes devices for the secure transportation of an object, which can be remotely monitored and opened (*i.e.*, unlocked) based on a predetermined condition, including when the container is located at a specific address. (EX-1003,

[0014]-[0020], [0038], [0041], [0069], [0073], [0124], [0182], cls. 1, 18.)

One example of a Samuel device is shown in Figure 1, which depicts a case with two parts **4**, **6** that can be closed by locking means **8**, **10**, **12**, and **14**:



(EX-1003, Fig. 1, [0083].) Means **18** can send signals to a monitoring system and monitor opening and closure of the locking means **8**, **10**, **12**, **14**. (EX-1003, [0088]-[0090], [0105]-[0109].) Although the Samuel device in Figure 1 is shown as a hard case, Samuel specifically teaches the device also could be a parcel type device made of more flexible materials with an “envelope” structure— *i.e.*, a pouch. (EX-1003, [0091].)

Samuel also teaches that GPS location means could be used to track the location of the device, and it may also be equipped with means for sending and receiving RF signals to and from the monitoring system. (EX-1003, [0174]-[0178].)

2. Claim 1

Claim Element	Claim Language
1 (preamble)	A case comprising:

While Be Smarter does not assert that the preamble is limiting, Samuel discloses a “**case.**” Specifically, Samuel discloses “[a] device (2) for the secure transportation of an object (3),” and explicitly describes device 2 as a “**case.**” (EX-1003, Abstract, [0093]; Buckner Decl., ¶¶ 141-142.)

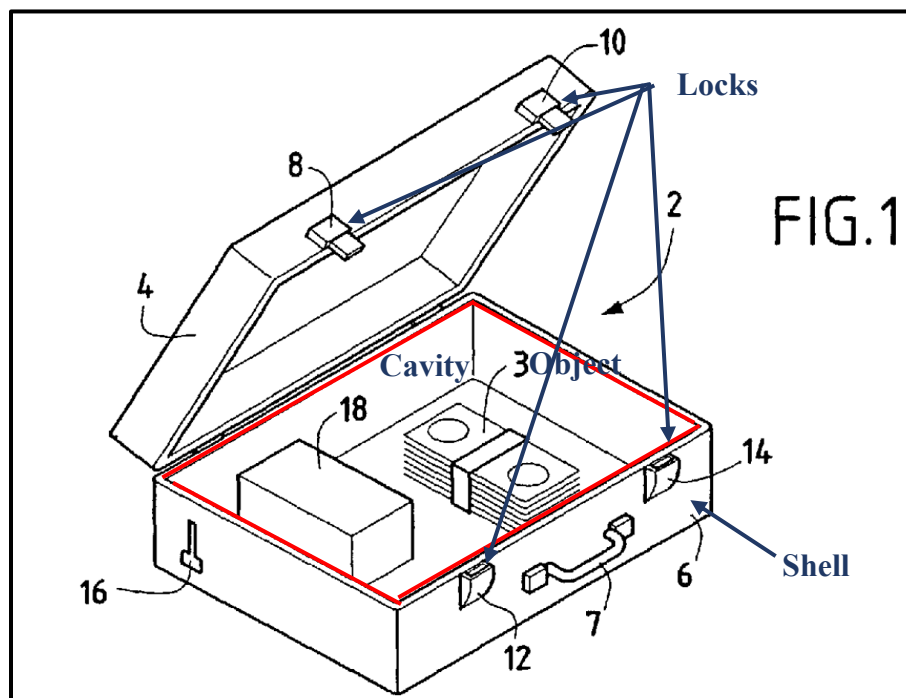
Claim Element	Claim Language
1(a)	a shell defining a cavity sized to accommodate a mobile device, the shell having an opening to receive the mobile device; and

Samuel anticipates the limitations of claim element 1(a). As shown in Figure 1, the Samuel case includes “**a shell defining a cavity sized to accommodate**” an object such as “**a mobile device**”—specifically, lower part 6 of case 2 has a cavity in which cash 3 is depicted as the object being transported. (EX-1003, Fig. 1, [0083]-[0084]; Buckner Decl., ¶ 144-148.)

Samuel is clear that its disclosures are applicable to any size container such that any object may be secured in an appropriately sized case. (EX-1003, [0021]; *see also* EX-1003, Fig. 1 (showing a case transporting an object (cash) of similar size to a cellphone), [0001]-[0002] (noting items similar in size to cellphones may be

securely transported, such as cash or checks and noting the Samuel case may be applied to transport “valuable merchandise”), [0083]-[0084], [0182] (broadly describing cash, documents, or objects to be transported in a Samuel case).) Thus, it would have been readily apparent that the object transported in Samuel could be a mobile electronic device, such as a cellphone. (Buckner Decl., ¶ 146.) The cash and checks described as examples of the “object” transported in the Samuel case are similar in size to mobile electronic devices such as cellphones and thus the cavity shown in the Samuel case is “**sized to accommodate a mobile device.**” (Buckner Decl., ¶ 146.)

Further, when open/unlocked, the opening of the shell in the Samuel case has an opening to receive a mobile device:



(EX-1003, Fig. 1 (red outlining the opening above the cavity, annotations added in

blue); Buckner Decl., ¶¶ 147-148.) Thus, Samuel discloses “**the shell having an opening to receive the mobile device.**”

Claim Element	Claim Language
1(b)	a lock positioned proximate to the opening of the shell, the lock configured to render the mobile device at least partially inaccessible upon the lock being locked with the mobile device within the cavity of the shell,

Samuel also anticipates limitation 1(b). (Buckner Decl., ¶¶ 152-154, 159.) In Samuel, the corresponding “**lock**” is locking means **8**, **10**, **12**, and **14**, which, as shown in annotated Figure 1 above, include opposing plates with securably mateable female members (as shown in **12**, **14**) and male members (as shown in **8**, **10**) that are “**positioned proximate to the opening of the shell.**” (EX-1003, Fig. 1, [0083]; Buckner Decl., ¶ 153.)

The locking means in Samuel is also “**configured to render the mobile device at least partially inaccessible upon the lock being locked with the mobile device within the cavity of the shell.**” When locked, the locking means **8**, **10**, **12**, and **14** in the Samuel case render the object being transported inside the case inaccessible to the user until a certain condition is met. (See EX-1003, Fig. 1 (depicting the object **3** within the cavity of the shell).) For example, Samuel discloses that means **18** inside the case is able to monitor the state of the case (such as its location) and receive and act on closing or opening instructions received by

electronic signals. (EX-1003, [0088]-[0090], [0105]-[0109], [0124]-[0125], [0174]-[0178], cl. 1; Buckner Decl., ¶¶ 153–154, 159.)

Claim Element	Claim Language
1(c)	the lock further configured to unlock to enable access to the mobile device based on a predetermined condition associated with a geographic region.

As set forth in Section V.E.1-2, the “**configured to unlock**” phrase in claim element 1(c) should be construed to mean “programmed to unlock the case upon satisfying a predetermined condition” with “**predetermined condition**” construed to mean “a specific pre-established requirement that must be satisfied before a user can regain access to his or her mobile electronic device/mobile device.”

Due to its programming, the case disclosed by Samuel cannot be unlocked until means **18** receives the appropriate signal to unlock the case, at which point the object being transported would then be accessible again. (EX-1003, [0109], [0124]-[0125]; Buckner Decl., ¶¶ 154, 161.) Thus, the Samuel locking means is “**further configured to unlock to enable access to the mobile device.**” (Buckner Decl., ¶¶ 160-161.)

Samuel also anticipates the requirement in claim element 1(c) that the lock is configured to unlock “**based on a predetermined condition associated with a geographic region.**” Samuel concerns secure transportation of objects and

predefines location of the case at a particular address—which is distinct from the geographic region in which the case began—as a condition for sending the unlock signal. (EX-1003, [0038], [0058], [0123]-[0125]; Buckner Decl., ¶¶ 160-161.)

3. Claim 3

Claim	Claim Language
3	The case of claim 1, wherein the geographic region corresponds to a physical position of the case respective to a geographic area of a venue.

As described in Section VI.B.2, Samuel anticipates **“the case of claim 1.”** Samuel also discloses that **“the geographic region corresponds to a physical position of the case respective to a geographic area of a venue.”** Specifically, Samuel concerns secure transportation of objects and predefines location of the case at a particular address, the terminal to which the transportation device is connected, or destination of the transported object (the **“geographic region corresponds to a physical position of the case respective to a geographic area of a venue”**) as a condition for sending the unlock signal. (EX-1003, [0038], [0058], [0124]-[0125]; Buckner Decl., ¶¶ 180-181.)

4. Claim 9

Claim 9 of the '078 patent is virtually identical to claim 1 and is anticipated by Samuel for the same reasons. *See* Section VI.B.2.

Claim Element	Claim Language
9 (preamble)	A case comprising:

See claim 1 (preamble).

Claim Element	Claim Language
9(a)	a shell defining a cavity sized to accommodate a mobile device, the shell having an opening to receive the mobile device; and

See claim element 1(a).

Claim Element	Claim Language
9(b)	a lock positioned proximate to the opening of the shell, the lock configured to at least partially secure the opening of the shell, the lock being further configured to lock the shell and render the mobile device at least partially inaccessible,

*See claim element 1(b). Claim element 1(b) and claim element 9(b) are nearly identical. The distinctions lie in claim element 9(b)’s requirements for the lock to be configured to “**at least partially secure the opening of the shell**” and “**to lock the shell.**” Samuel also discloses those requirements. Specifically, the locking means in Samuel locks and thereby secures the opening of the shell (as shown in Figures 1 (open) and 2 (closed)). (EX-1003, Figs. 1, 2, [0038], [0083], [0086], [0090], [0105]-[0106]; Buckner Decl., ¶¶ 211-213.) As summarized in Samuel, “the object 3 to be*

transported is placed in the transportation device **2** and the device is closed. The means **8, 10, 12, 14** are locked so that the device **2** cannot be opened without forcing it unless opening is commanded by the monitoring system **22**.” (EX-1003, [0105], cl. 1.)

Claim Element	Claim Language
9(c)	wherein the lock is further configured to unlock to enable access to the mobile device in accordance with a predetermined condition associated with a geographic region.

Claim element 9(c) is identical to claim element 1(c) except for the use of “in accordance with” instead of “based on.” As noted above, the parties in the WDTX Action agreed that there was no change in meaning resulting from that difference. (EX-1014-008.) Samuel anticipates claim element 9(c) for the same reasons discussed in Section VI.B.2 for claim element 1(c). (*See also* Buckner Decl., ¶¶ 220-221.)

C. Ground 2: Claims 1, 3, 4, 9, 11, and 15-16 are Unpatentable under 35 U.S.C. § 103 by Samuel in View of Shin

1. Summary of Samuel

Be Smarter incorporates the summary of Samuel in Section VI.B.1 into Ground 2.

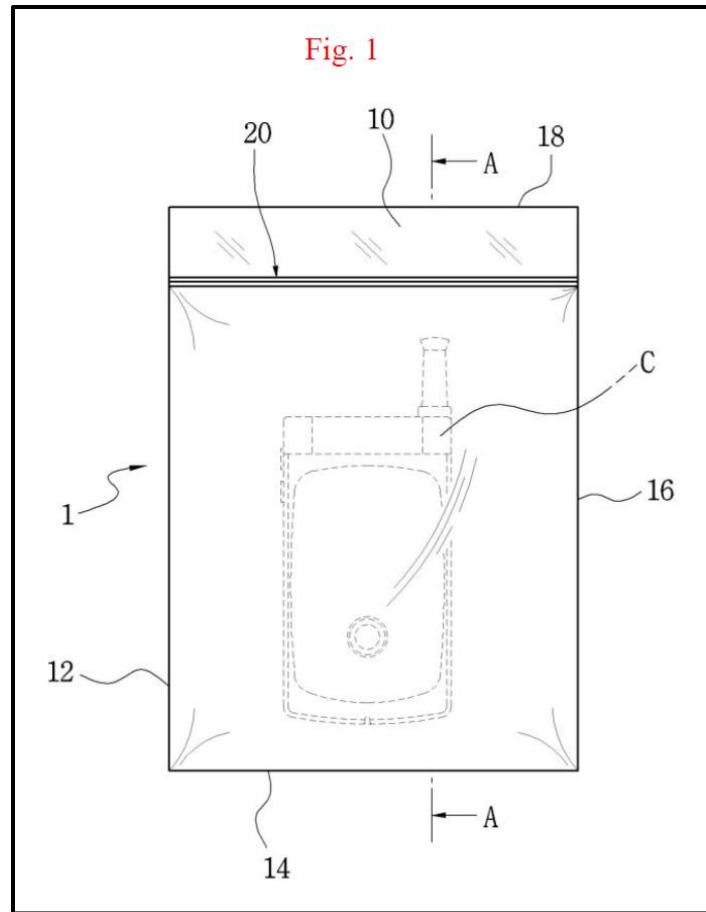
2. Summary of Shin

K.R. Patent Laid-open No. 10-2007-0041248 to Hyo-kyun Shin (“Shin”)

published on April 18, 2007, and is titled “Radio Wave Blocking Envelope for Storing a Mobile Phone.” (EX-1004,⁵ Title; *see also* Buckner Decl., ¶¶ 97-102 (providing an overview of Shin).)

As set forth in the Abstract, Shin describes “a radio wave blocking envelope for storing a mobile phone that prevents the mobile phone stored inside the envelope from receiving high-frequency radio waves” in order to prevent “phone rings or vibration sounds in public places where silence is required.” (EX-1004, Abstract, 5-6, 9.) Figure 1 illustrates an embodiment that depicts a cellphone stored within the mobile phone storage envelope:

⁵ All references to Shin in this Petition are to the certified English translation included in EX-1004.



(EX-1004, Fig. 1; *see also* EX-1004, Figs. 2, 6, 8, and 11-14 (illustrating various embodiments of the envelope with a cellphone).)

Shin also discloses that in some embodiments, “a portion of the envelope automatically opens after a predetermined time, for example, after a performance ends, allowing calls from outside to be received.” (EX-1004, 6, 9-10 (“timer means that automatically opens a portion of the envelope after a predetermined time, for example, after the performance ends, allowing incoming calls from outside to be received”).) In preferred embodiments of the Shin envelope, there is a closing member (*e.g.*, first closing member **20**) that “includes a male profile strip **21** and a

female profile strip **23** that are formed to be suitably engaged with engage with each other to lock the opening **9** of the envelope.” (EX-1004, 7.) In one embodiment, the closing member is a zipper, but Shin also makes clear that various coupling means could be used. (EX-1004, 8.)

3. Reasons to Combine Samuel and Shin

Samuel provides an explicit motivation to combine the flexible security device structure described in Shin (*i.e.*, a mobile phone storage envelope) with the locking and unlocking mechanisms described in Samuel. Specifically, Samuel notes:

The walls that define the transportation device of the invention can be made of *flexible plastics materials*, especially in the case of parcel type devices, or of a material such as rubber for devices *with an “envelope” format*. . . .

(EX-1003, [0091]; *see also* EX-1003, [0021] (envelopes or parcels).) As explained by Dr. Buckner, one of ordinary skill would have recognized Samuel acknowledging the rigid case depicted in its figures could be replaced by a more flexible envelope design, such as the envelope shown in Shin.⁶ (Buckner Decl., ¶ 125; *see also* EX-1004, Figs. 1-14.)

In addition, both Samuel and Shin teach ways of preventing unauthorized

⁶ References to the “Samuel envelope” herein refer to the Samuel case as a person of ordinary skill has modified using the disclosures in Shin to adopt an envelope structure sized to contain a cellphone.

access to objects in such a case or envelope (at least temporarily). (EX-1003, [0009]-[0020]; EX-1004, Abstract, 6-7.) Thus, a person of ordinary skill would understand these references address the same subject matter and would look to both to evaluate potential options for solving the problem of how to secure an object such as a cellphone or other valuables. (Buckner Decl., ¶¶ 126-127.) Additional motivations to combine may be discussed below.

4. Claim 1

Claim Element	Claim Language
1 (preamble)	A case comprising:

While Be Smarter does not assert that the preamble is limiting, Samuel in combination with Shin, discloses and renders obvious a “**case**.” (Buckner Decl., ¶¶ 141-143.) Specifically, Samuel discloses “[a] device (**2**) for the secure transportation of an object (**3**),” and explicitly describes device **2** as a “**case**.” (EX-1003, Abstract, [0093]; Buckner Decl., ¶ 142.)

Shin also discloses a “**case**.” Specifically, the mobile phone storage envelope (depicted in figures as **1**, **101**, **201**, and **301**) is a “**case**.” (Buckner Decl., ¶ 143.) As noted above, Samuel suggests that its case could adopt an envelope structure, such as that disclosed by Shin. (EX-1003, [0091].)

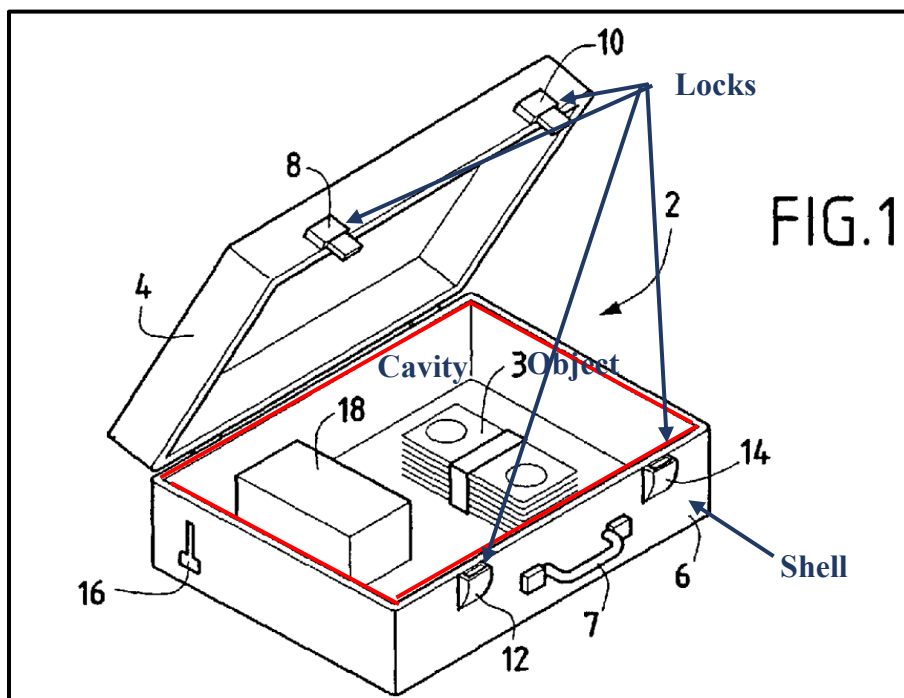
Claim Element	Claim Language
1(a)	a shell defining a cavity sized to accommodate a mobile device, the shell having an opening to receive the mobile device; and

Samuel in combination with Shin discloses and renders obvious the limitations of claim element 1(a). (See Buckner Decl., ¶¶ 144-151.) As shown in Figure 1, the Samuel case includes **“a shell defining a cavity sized to accommodate”** an object such as **“a mobile device”**—specifically, lower part 6 of case 2 has a cavity in which cash 3 is depicted as the object being transported. (EX-1003, Fig. 1, [0083]-[0084]; Buckner Decl., ¶¶ 144-147.)

Samuel is clear that its disclosures are applicable to any size container such that any object may be secured in an appropriately sized case. (EX-1003, [0021]; *see also* EX-1003, Fig. 1 (showing a case transporting an object (cash) of similar size to a cellphone), [0001]-[0002] (noting items similar in size to cellphones may be securely transported, such as cash or checks and noting the Samuel case may be applied to transport “valuable merchandise”), [0083]-[0084], [0182] (broadly describing cash, documents, or objects to be transported in a Samuel case).) Thus, it would have been apparent that the object transported in Samuel could be a mobile device, such as a cellphone. (Buckner Decl., ¶¶ 145-146.) The cash and checks described as examples of the “object” transported in the Samuel case are similar in size to mobile devices such as cellphones and, thus, the cavity shown in the Samuel

case is “**sized to accommodate a mobile device.**” (Buckner Decl., ¶ 146.)

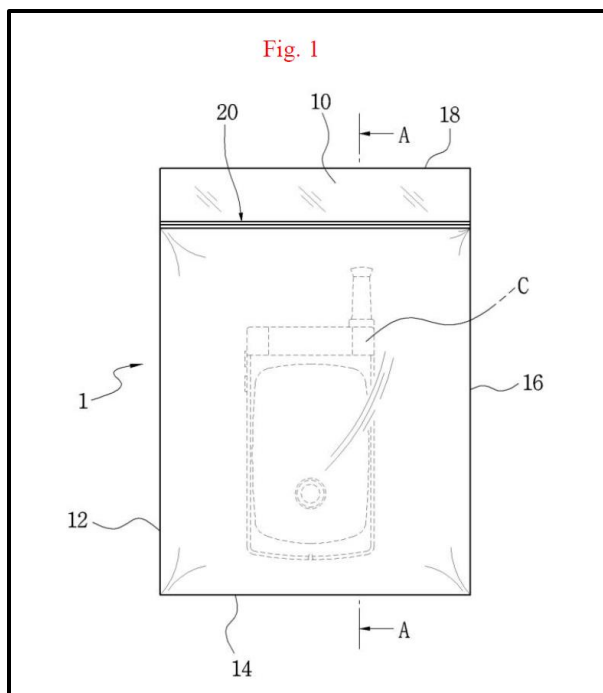
Further, when open/unlocked, the opening of the shell in the Samuel case has an opening to receive a mobile device:



(EX-1003, Fig. 1 (red outlining the opening above the cavity, annotations added in blue); Buckner Decl., ¶ 147-148.) Thus, Samuel discloses “**the shell having an opening to receive the mobile device.**”

As in Section VI.C.3, one of ordinary skill in the art would have been motivated to take the Samuel case and modify it to use more flexible materials in accordance with its own disclosures and those in Shin to form the Samuel envelope. (Buckner Decl., ¶ 125.)

Shin describes its envelope structure and depicts its use to store a cellphone (mobile phone C) in Figure 1:



(EX-1004, Fig. 1, Abstract, 1 (“having sufficient size to form a mobile phone storage space”), 6 (describing Fig. 1), cl. 1 (“sufficient size to form a mobile phone storage space”); *see also* EX-1006, Figs. 2, 6, 8, 11-14.) As shown and described in Shin, the mobile phone storage envelope (depicted in the figures as **1**, **101**, **201**, and **301**) has **“a shell defining a cavity sized to accommodate a mobile device, the shell having an opening to receive the mobile device”** that is made by integrally joining edges **12**, **14**, and **16** of the first side **3** and second side **5** while leaving opening **9** that can be closed via closing member **20**. (EX-1004, 6; Buckner Decl., ¶¶ 149-150.)

And, as explained above, a person of ordinary skill would find it obvious for the object locked in the Samuel envelope—thus rendered inaccessible to the user—to be a mobile electronic device in view of the Shin disclosures. (EX-1003, Fig. 1,

[0083]-[0084]; EX-1004, Figs. 1-2, Abstract; Buckner Decl., ¶¶ 125, 149-151.)

Claim Element	Claim Language
1(b)	a lock positioned proximate to the opening of the shell, the lock configured to render the mobile device at least partially inaccessible upon the lock being locked with the mobile device within the cavity of the shell,

Samuel in combination with Shin also discloses limitation 1(b), and the Samuel envelope meets this limitation. (Buckner Decl., ¶ 152.)

In Samuel, the corresponding “**lock**” is locking means **8, 10, 12, and 14**, which, as shown in annotated Figure 1 above, include opposing plates with securably mateable female members (as shown in **12, 14**) and male members (as shown in **8, 10**) that are “**positioned proximate to the opening of the shell.**” (EX-1003, Fig. 1, [0083]; Buckner Decl., ¶ 153.)

The locking means in Samuel is also “**configured to render the mobile device at least partially inaccessible upon the lock being locked with the mobile device within the cavity of the shell.**” When locked, the locking means **8, 10, 12, and 14** in the Samuel case render the object being transported inside the case inaccessible to the user until a certain condition is met. (See EX-1003, Fig. 1 (depicting the object **3** within the cavity of the shell), Fig. 2 (showing the closed case).) For example, Samuel discloses that means **18** inside the case is able to monitor the state of the case (such as its location) and receive and act on closing or

opening instructions received by electronic signals. (EX-1003, [0088]-[0090], [0105]-[0109], [0124]-[0125], [0174]-[0178], cl. 1; Buckner Decl., ¶ 154.) Thus, the opening of the Samuel envelope is secured until such time as the opening signal is sent by the monitoring system. (EX-1003, [0105]-[0106], [0109], [0123]-[0125]; Buckner Decl., ¶¶ 157-159.)

In addition to the disclosures in Samuel, Shin describes that the first closing member **20**/second closing member **120**/third closing member **220** (which secure the envelope) may be comprised of a female profile strip **23/123/223** and a male profile strip **21/121/221** that are “formed to be suitably engaged with each other to lock the opening **9** of the envelope.” (EX-1004, Figs. 2, 5-7, pp. 7 (describing the male and female profile strips **21** and **23** as “formed of a combination of one protrusion and a recessed portion”), **8** (male profile strip **121** and female profile strip **123** “are formed to suitably lock the envelope by engaging with each other” and that male profile strip **221** and female profile strip **223** are used to lock the opening); Buckner Decl., ¶ 156.) Thus, like Samuel, Shin discloses securably mateable female and male members that function to secure the opening and thus discloses the “**lock**” required by claim element 1(b)—these similarities provide a further motivation to combine Samuel and Shin. (Buckner Decl., ¶¶ 126, 156.)

Claim Element	Claim Language
1(c)	the lock further configured to unlock to enable access to the mobile device based on a predetermined condition associated with a geographic region.

Samuel in combination with Shin discloses this limitation. As set forth in Sections V.E.1-2, the “configured to unlock” phrase in claim element 1(c) should be construed to mean “programmed to unlock the case upon satisfying a predetermined condition” with “predetermined condition” construed to mean “a specific pre-established requirement that must be satisfied before a user can regain access to his or her mobile electronic device/mobile device.”

Due to its programming, the case disclosed by Samuel cannot be unlocked until means **18** receives the appropriate signal to unlock the case, at which point the object being transported would then be accessible again. (EX-1003, [0109], [0124]-[0125]; Buckner Decl., ¶ 161.) Specifically, Samuel discloses that locking means **8**, **10**, **12**, and **14** may be unlocked in response to electronic signals sent by monitoring system **22** to the case, specifically, signals sent to means **18**—“electronic means for sending or receiving signals”—through means **16**, which provides a connection between the case and a communication network. (EX-1003, [0088], [0090], [0105]-[0109], [0123]-[0125]; *see also* EX-1003, [0096]-[0103] (describing components of monitoring system **22**); Buckner Decl., ¶ 161.) Thus, the Samuel locking means is

“further configured to unlock to enable access to the mobile device.” (Buckner Decl., ¶ 161.)

Samuel also discloses the requirement in claim element 1(c) that the lock is configured to unlock **“based on a predetermined condition associated with a geographic region.”** Samuel concerns secure transportation of objects and predefines location of the case at a particular address—which is distinct from the geographic region in which the case began—as a condition for sending the unlock signal. (EX-1003, [0038], [0058], [0123]-[0125]; Buckner Decl., ¶ 161.)

5. Claim 3

Claim	Claim Language
3	The case of claim 1, wherein the geographic region corresponds to a physical position of the case respective to a geographic area of a venue.

As described above, Samuel in combination with Shin discloses and renders obvious **“the case of claim 1.”** *See supra* claim 1 analysis. Samuel also discloses that **“the geographic region corresponds to a physical position of the case respective to a geographic area of a venue.”** Specifically, Samuel concerns secure transportation of objects and predefines location of the case at a particular address, the terminal to which the transportation device is connected, or destination of the transported object (the **“geographic region corresponds to a physical position of the case respective to a geographic area of a venue”**) as a condition for sending

the unlock signal. (EX-1003, [0038], [0058], [0124]-[0125]; Buckner Decl., ¶¶ 180-181.) Further, Shin discusses the need to prevent access to phones in certain venues, such as “concert halls, churches, courtrooms, lecture rooms, and libraries,” which provides another motivation to combine the disclosures of Samuel and Shin to arrive at the invention in claim 3. (EX-1004, 5; Buckner Decl., ¶ 182.)

6. Claim 4

Claim Element	Claim Language
4(a)	The case of claim 1, wherein the shell comprises: a front panel; and

As described above, Samuel in combination with Shin discloses and renders obvious “**the case of claim 1.**” *See supra* claim 1 analysis. The Samuel envelope also discloses and renders obvious the requirements of claim element 4(a). (Buckner Decl., ¶¶ 185-187.)

Specifically, Samuel suggests the envelope structure, and Shin very explicitly discloses an envelope structure with a shell with a front panel, namely first side **3**. (EX-1003, [0091]; EX-1004, Figs. 1-2; Buckner Decl., ¶¶ 186-187.) Shin describes “an envelope formed by integrally joining left and right edges and bottom edge of a first side and a second side.” (EX-1004, Abstract, cl. 1 (“left and right edges and bottom edges of first and second sides are integrally combined to form the envelope”), **6** (“wherein the first side **3** and the second side **5** are joined at their left

edge **12**, bottom edge **14**, and right edge **16** to form a mobile phone storage space **7**”).) The “first side **3**” in Shin is “**a front panel**” as required by claim element 4(a). (See EX-1004, Figs. 2, 5, 7, 9, 10 (showing the profile view of various Shin envelope embodiments); Buckner Decl., ¶ 187.)

And, as noted above in Section VI.C.3, a person of ordinary skill in the art had motivation to combine the case functionality described in Samuel, specifically the conditional locking/unlocking mechanisms, with the more flexible envelope structure suggested in Samuel and disclosed in greater detail by Shin. (Buckner Decl., ¶¶ 125-127, 186.)

Claim Element	Claim Language
4(b)	a rear panel, the rear panel being connected to the front panel on each longitudinal edge and on a lateral edge distally opposed to the opening.

Samuel in combination with Shin also discloses and renders obvious claim element 4(b). (Buckner Decl., ¶¶ 188-192.) Shin discloses a case structure that includes front and rear panels—specifically, Shin describes “an envelope formed by integrally joining left and right edges and bottom edge of a first side and a second side.” (EX-1004, Abstract, cl. 1 (“left and right edges and bottom edges of first and second sides are integrally combined to form the envelope”), **6** (“wherein the first side **3** and the second side **5** are joined at their left edge **12**, bottom edge **14**, and

right edge **16** to form a mobile phone storage space **7**”).) The “second side **5**” in Shin is “**a rear panel**” as required by claim element 4(b). (*See* EX-1004, Figs. 2, 5, 7, 9, 10 (showing the profile view of various Shin envelope embodiments); Buckner Decl., ¶¶ 190-191.) Second side **5** has a left edge **12** and right edge **16**, which are each a “**longitudinal edge**” and bottom edge **14**, which is the “**lateral edge distally opposed to the opening.**” (*See, e.g.,* EX-1004, Figs. 1, 3a, 4, 6; Buckner Decl., ¶¶ 190-191.)

7. Claim 9

Claim 9 of the '078 patent is virtually identical to claim 1 and is disclosed and rendered obvious by the combination of Samuel and Shin for the same reasons. *See* Section VI.C.4.

Claim Element	Claim Language
9 (preamble)	A case comprising:

See claim 1 (preamble).

Claim Element	Claim Language
9(a)	a shell defining a cavity sized to accommodate a mobile device, the shell having an opening to receive the mobile device; and

See claim element 1(a).

Claim Element	Claim Language
9(b)	a lock positioned proximate to the opening of the shell, the lock configured to at least partially secure the opening of the shell, the lock being further configured to lock the shell and render the mobile device at least partially inaccessible,

See claim element 1(b). Claim element 1(b) and claim element 9(b) are nearly identical. The distinctions lie in claim element 9(b)’s requirements for the lock to be configured to “**at least partially secure the opening of the shell**” and “**to lock the shell.**” Samuel also discloses those requirements. Specifically, the locking means in Samuel locks and thereby secures the opening of the shell (as shown in Figures 1 (open) and 2 (closed)). (EX-1003, Figs. 1, 2, [0038], [0083], [0086], [0090], [0105]-[0106]; Buckner Decl., ¶¶ 212-213, 218.) As summarized in Samuel, “the object **3** to be transported is placed in the transportation device **2** and the device is closed. The means **8, 10, 12, 14** are locked so that the device **2** cannot be opened without forcing it unless opening is commanded by the monitoring system **22.**” (EX-1003, [0105], claim 1.)

In addition to the disclosures in Samuel, Shin describes that the first closing member **20**/second closing member **120**/third closing member **220** (which secure the envelope) may be comprised of a female profile strip **23/123/223** and a male profile strip **21/121/221** that are “formed to be suitably engaged with each other to lock the opening **9** of the envelope.” (EX-1004, Fig. 2, 5-7, pp. 7 (describing the male and

female profile strips **21** and **23** as “formed of a combination of one protrusion and a recessed portion”), 8 (male profile strip **121** and female profile strip **123** “are formed to suitably lock the envelope by engaging with each other” and that male profile strip **221** and female profile strip **223** are used to lock the opening); Buckner Decl., ¶¶ 214-215.) Thus, like Samuel, Shin discloses securably mateable female and male members that function to secure the opening and thus discloses the “**lock**” required by claim element 9(b)—these similarities provide a further motivation to combine Samuel and Shin. (Buckner Decl., ¶¶ 216, 219.)

Claim Element	Claim Language
9(c)	wherein the lock is further configured to unlock to enable access to the mobile device in accordance with a predetermined condition associated with a geographic region.

See claim element 1(c). Claim element 9(c) is identical to claim element 1(c) except for the use of “in accordance with” instead of “based on.” As noted above, the parties in the WDTX Action agreed that there was no change in meaning resulting from that difference. EX-1014-008. Samuel in combination with Shin discloses and renders obvious claim element 9(c) for the same reasons discussed above for claim element 1(c). (Buckner Decl., ¶ 220-222.)

8. Claim 11

Claim Element	Claim Language
11(a)	The case of claim 9, wherein the shell comprises: a front panel; and

See claim 9 and claim element 4(a).

Claim Element	Claim Language
11(b)	a rear panel, the rear panel being connected to the front panel on each longitudinal edge and on a lateral edge distally opposed to the opening.

See claim element 4(b).

9. Claim 15

Claim Element	Claim Language
15 (preamble)	A system comprising:

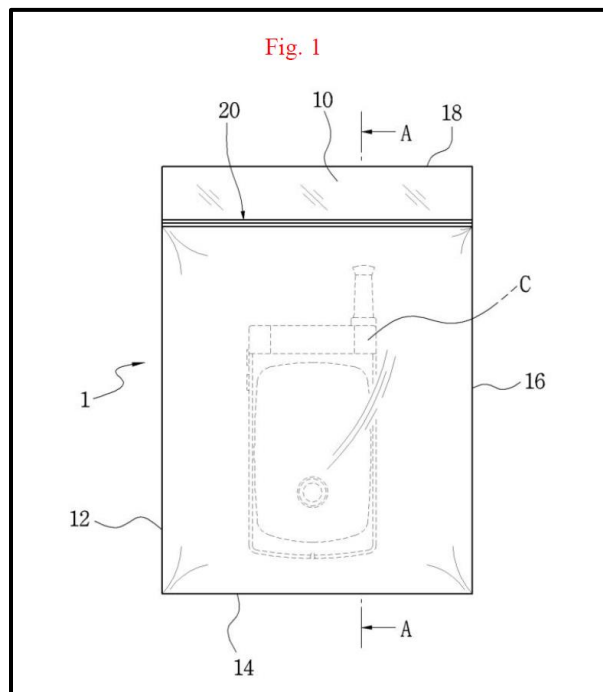
While Be Smarter does not assert that the preamble is limiting, Samuel in combination with Shin, discloses and renders obvious a system as set forth in claim 15. (Buckner Decl., ¶ 251.) Specifically, the combination of the Samuel case **2** and monitoring system **22** is designed to selectively limit a user's control over the cash, documents, or valuable merchandise transported in the case until a predetermined state of the case is met, such as reaching a desired location. (EX-1003, [0001]-[0002])

[0083]-[0084], [0124]-[0125], [0182] (broadly describing cash, documents or objects to be transported in a Samuel case); Buckner Decl., ¶ 253.) And, as described above, a person of ordinary skill would have been motivated to combine the case disclosed in Samuel with the disclosures in Shin to use an envelope design for the case structure. *See* Section VI.C.3. (Buckner Decl., ¶ 254.) Shin discloses that electronic devices, such as a cellphone, may be securely contained within its mobile phone storage envelope. (*See, e.g.*, EX-1004, Figs. 1-2, 6, 8, 11-14, Abstract; Buckner Decl., ¶ 254.) A person of ordinary skill in the art would thus have been motivated to combine the system disclosed in Samuel to include the case structure disclosed in Shin to arrive at the system of claim 15. (Buckner Decl., ¶ 254.)

Claim Element	Claim Language
15(a)	a case sized to receive a user’s mobile electronic device, the case including:

Samuel in combination with Shin discloses and renders obvious “**a case sized to receive the user’s mobile electronic device.**” (Buckner Decl., ¶¶ 255-258.) Samuel discloses that its case is sized to receive valuable objects, for example, Figure 1 depicts a case in which cash 3 is the object depicted as being transported. (EX-1003, Fig. 1, [0083]-[0084].) Cash and mobile electronic devices such as cellphones are similar in size and thus the case shown in Samuel Figure 1 is “**sized to accommodate the user’s mobile electronic device.**” (Buckner Decl., ¶ 256.)

Further, Samuel specifically contemplates the transport of smaller objects, in cases made with more flexible materials, such as flexible plastics materials or rubber. (EX-1003, [0091]-[0092].) As discussed in Section VI.C.3, one of ordinary skill in the art would have been motivated to take the Samuel case and modify it to use more flexible materials in accordance with its own disclosures and those in Shin to form the Samuel envelope. (Buckner Decl., ¶¶ 125, 257.)



is a “case is sized to receive the user’s mobile electronic device.” (Buckner Decl., ¶ 258.)

Claim Element	Claim Language
15(b)	a front panel having a first set of longitudinal edges, a first top edge and a first bottom edge, and

Samuel in combination with Shin also discloses and renders obvious this limitation. (Buckner Decl., ¶¶ 259-262.) Shin discloses a case structure that includes front and rear panels—specifically, Shin describes “an envelope formed by integrally joining left and right edges and bottom edge of a first side and a second side.” (EX-1004, Abstract, cl. 1 (“left and right edges and bottom edges of first and second sides are integrally combined to form the envelope”), 6 (“wherein the first side **3** and the second side **5** are joined at their left edge **12**, bottom edge **14**, and right edge **16** to form a mobile phone storage space **7**”).) The “first side **3**” in Shin is “**a front panel having a first set of longitudinal edges, a first top edge and a first bottom edge**” as required by claim element 15(b). (See EX-1004, Figs. 2, 5, 7, 9, 10 (showing the profile view of various Shin envelope embodiments), p. 6; Buckner Decl., ¶¶ 261-262.) Left edge **12** and right edge **16** are the “**first set of longitudinal edges**,” upper edge **18** is “**a first top edge**” and bottom edge **14** is “**a first bottom edge**” as required by 15(b). (See, e.g., EX-1004, Figs. 1, 3a, 4, 6; Buckner Decl., ¶¶ 261-262.)

Claim Element	Claim Language
15(c)	a rear panel having a second set of longitudinal edges, a second top edge and a second bottom edge, wherein the first set of longitudinal edges are respectively secured to the second set of longitudinal edges and the first bottom edge is secured to the second bottom edge to define an opening of the case for receiving a mobile electronic device; and

Samuel in combination with Shin also discloses and renders obvious this limitation. (Buckner Decl., ¶¶ 263-270.) As discussed above, Shin discloses a case structure that includes front and rear panels—specifically, Shin describes “an envelope formed by integrally joining left and right edges and bottom edge of a first side and a second side.” (EX-1004, Abstract, cl. 1 (“left and right edges and bottom edges of first and second sides are integrally combined to form the envelope”), 6 (“wherein the first side **3** and the second side **5** are joined at their left edge **12**, bottom edge **14**, and right edge **16** to form a mobile phone storage space **7**”).) The “second side **5**” in Shin is “**a rear panel having a second set of longitudinal edges a second top edge and a second bottom edge**” as required by claim element 15(c). (See EX-1004, Figs. 2, 5, 7, 9, 10 (showing the profile view of various Shin envelope embodiments); Buckner Decl., ¶265.) Left edge **12** and right edge **16** are the “**second set of longitudinal edges**,” upper edge **18** is “**a second top edge**” and bottom edge **14** is “**a second bottom edge**” as required by 15(c). (EX-1004, Figs. 1, 3a, 4, 6; Buckner Decl., ¶¶ 265-266.)

Shin also discloses “**wherein the first set of longitudinal edges are respectively secured to the second set of longitudinal edges and the first bottom edge is secured to the second bottom edge to define an opening of the case for receiving a mobile electronic device.**” As shown in the Shin figures, “**the first, second, and lower edges**” (*i.e.*, the left edge **12**, right edge **16**, and bottom edge **14**) of the front and rear panels (*i.e.*, first side **3** and second side **5**) are “**secured together**” in the Shin envelope (*i.e.*, one of embodiments **1**, **101**, **201**, or **301**) “**to define an opening for receiving a mobile electronic device,**” specifically opening portion **9** to house mobile phone **C**. (EX-1004, Fig. 2, 5, 7, 9 (showing opening portion **9**), Figs. 1, 6 (showing the secured edges and mobile phone **C**), Abstract (“envelope formed by integrally joining left and right edges and bottom edge of a first and a second side”), cl. 1, p. 6 (“the edges **12**, **14**, **16** of the first side **3** and the second side **5** are integrally joined by methods such as thermal compression, adhesive bonding, or folding” and “[a]n opening **9** through which a mobile phone can be inserted and removed is formed at an upper edge **18** of the first side **3** and the second side **5**. Therefore, the mobile phone **C** is stored through the opening portion **9**.”); Buckner Decl., ¶¶ 266-270.) Shin also specifically discloses the use of one or more closing members **20/120/220**, which may be locked to secure the mobile phone in the envelope. (EX-1004, 6-8 (discussing various embodiments of the closing member designed to lock the opening of the envelope); Buckner Decl., ¶ 274.)

And, as explained above, a person of ordinary skill would find it obvious for the object locked in the Samuel envelope—thus rendered inaccessible to the user—to be a mobile electronic device in view of the Shin disclosures. (EX-1003, Fig. 1, [0083]-[0084]; EX-1004, Figs. 1-2, Abstract; Buckner Decl., ¶¶ 268-270.)

Claim Element	Claim Language
15(d)	a lock proximately located to the opening of the case, the lock configured to at least partially secure the opening and render the user unable to access the mobile electronic device until a predetermined condition is met,

This limitation is disclosed by Samuel in combination with Shin. (Buckner Decl., ¶¶ 271-279.) In Samuel, the corresponding “**lock**” includes locking means **8**, **10**, **12**, and **14**, which, as shown in annotated Figure 1 above, include opposing plates with securably mateable female members (as shown in **12**, **14**) and male members (as shown in **8**, **10**). (EX-1003, Fig. 1, [0083]; Buckner Decl., ¶ 272.) And, as noted above, the locking means **8**, **10**, **12**, and **14** in the Samuel “**render the user unable to access**” the object “**until a predetermined condition is met.**” For example, Samuel discloses that means **18** inside the case is able to monitor the state of the case (such as its location) and receive and act on closing or opening instructions received by electronic signals. (EX-1003, [0088]-[0090], [0105]-[0109], [0124]-[0125], [0174]-[0178], claim 1; Buckner Decl., ¶ 272.)

Like Samuel, Shin also discloses that the closing member **20/120/220** may

include a male profile strip **21/121/221** and a female profile strip **23/123/223** that engage with each other to lock opening **9**. (EX-1004, Figs. 2, 5-7, 9-10, and pp. 7-8 (describing those figures); Buckner Decl., ¶ 274.) In addition, Shin teaches that the male and female strips of the closing member (*i.e.*, one plate with a female member and an opposing plate with a male member that are securably mateable) may be a zipper that locks the envelope such that **“the user unable to access the mobile electronic device.”** (EX-1004, 8.)

The locking means in Samuel (**8, 10, 12, 14**), as would be used in the combination of Samuel and Shin, prevent the user from accessing the mobile electronic device (or whatever object is transported in a Samuel case) because the locks cannot be unlocked until an appropriate signal to unlock the case is received by means **18**. (EX-1003, [0109], [0124]-[0125]; *see also* Buckner Decl., ¶¶ 275-277 (discussing how Shin’s use of a timer means and its objective of blocking cellphone signals further suggests combining the teachings of Samuel and Shin).)

Samuel also discloses that a condition for delivering the signal to open the locking means may be whether it is in a predetermined state such as arriving at a predetermined location. (EX-1003, [0038], [0069], [0073], [0125]; Buckner Decl., ¶ 278.) In addition, a person of ordinary skill would have viewed Shin’s objective to block cellphone signals for a pre-set period of time through radio penetration hole **62** and timer means **80** to prevent use in public places as a motivation to combine

Shin’s envelope structure with Samuel’s locking means to further limit the user’s access to the cellphone stored in the Shin envelope during a pre-set period of time or in a specific geographic location (*e.g.*, in a concert hall, church, or school). (EX-1004, 5, 9; Buckner Decl., ¶ 277.)

Thus, a person of ordinary skill would have found it to be a natural modification of the locking means described in Shin to use the enhanced security of the locking means described in Samuel with the Shin envelope, which would result in **“a lock proximately located to the opening of the case, the lock configured to at least partially secure the opening and render the user unable to access the mobile electronic device until a predetermined condition is met.”** (Buckner Decl., ¶¶ 275, 279.)

Claim Element	Claim Language
15(e)	the predetermined condition being associated with a physical presence of the case being outside of a defined geographic region.

Samuel in combination with Shin discloses and renders obvious this limitation. (Buckner Decl., ¶¶ 280-282.) Specifically, Samuel discloses the requirement in claim element 15(e) for **“the predetermined condition being associated with a physical presence of the case being outside of a defined geographic region.”** Samuel concerns secure transportation of objects and

predefines location of the case at a particular address, which is distinct from the geographic region in which the case began, as a condition for sending the unlock signal. (EX-1003, [0038], [0058], [0124]-[0125]; Buckner Decl., ¶ 281.) Shin also discusses the need to prevent access to phones in certain venues, which provides a motivation to combine the disclosures of Samuel and Shin to arrive at the invention claimed in the '078 patent. (EX-1004, 5; Buckner Decl., ¶ 282.)

10. Claim 16

Claim Element	Claim Language
16(a)	The system of claim 15, wherein the lock comprises a female plate; and

As described above, Samuel in combination with Shin renders obvious “**the system of claim 15.**” *See supra* claim 15 analysis. (Buckner Decl., ¶¶ 285-289.) Samuel illustrates that its locking means (**8, 10, 12, 14**) include securably mateable female members (as shown in **12, 14**) and male members (as shown in **8, 10**) of opposing plates. (EX-1003, Fig. 1, [0083], [0086], [0105]; Buckner Decl., ¶¶ 286.) A person of ordinary skill would have considered using the same locking means described in Samuel as an obvious design choice to secure the front and rear panels of the envelope structure similar to the locking means **8, 10, 12, and 14** secured upper portion **4** to upper portion **6** in the Samuel case embodiment shown in Figures 1 and 2 to arrive at the Samuel envelope. (EX-1003, Figs. 1-2; Buckner Decl., ¶ 287.)

Specifically, the male and female profile strips used to lock the envelope in Shin could be easily designed as female and male plates configured to securably mate with one another based on the disclosures in Shin and Samuel. (See EX-1004, Fig. 2, 5-7, pp. 7-8 (describing use of male and female profile strips to lock the envelope); Buckner Decl., ¶¶ 288-289.) The Samuel envelope implemented with a female and a male plate on the top of each panel as the locking mechanism would thus meet the requirement in claim 16(a) “**wherein the lock comprises a female plate.**” (Buckner Decl., ¶ 289.)

Claim Element	Claim Language
16(b)	a male plate, wherein the female plate and the male plate are respectively disposed on the front panel and the rear panel, wherein the female plate and the male plate are configured to securely mate.

Samuel in combination with Shin further renders obvious claim element 16(b). (Buckner Decl., ¶¶ 290-293.) As described above, Samuel illustrates that its locking means (**8, 10, 12, 14**) include securably mateable female members (as shown in **12, 14**) and male members (as shown in **8, 10**) of opposing plates. (EX-1003, Fig. 1, [0083], [0086], [0105]; Buckner Decl., ¶ 290.) A person of ordinary skill would have considered using the same locking means described in Samuel as an obvious design choice to secure the front and rear panels of the envelope structure similar to the locking means **8, 10, 12**, and **14** secured upper portion **4** to upper portion **6** in the

Samuel case embodiment shown in Figures 1 and 2 to arrive at the Samuel envelope. (EX-1003, Figs. 1-2; Buckner Decl., ¶¶ 291-292.) Specifically, the male and female profile strips used to lock the envelope in Shin could be easily designed as female and male plates configured to securably mate with one another based on the disclosures in Shin and Samuel. (*See, e.g.*, EX-1004, Fig. 2, 5-7, pp. 7-8 (describing use of male and female profile strips to lock the envelope); Buckner Decl., ¶ 293.) The Samuel envelope implemented with a female and a male plate on the top of each panel as the locking mechanism would thus meet the requirements in claim 16(b) of **“a male plate, wherein the female plate and the male plate are respectively disposed on the front panel and the rear panel, wherein the female plate and the male plate are configured to securely mate.”** (Buckner Decl., ¶¶ 290-293.)

D. Ground 3: Claims 2, 10, and 19 are Unpatentable under 35 U.S.C. § 103 by Samuel in View of Shin in further View of Simpson

1. Summary of Samuel

Be Smarter incorporates the summary of Samuel provided in Section VI.C.1 into Ground 3.

2. Summary of Shin

Be Smarter incorporates the summary of Shin provided in Section VI.C.2 into Ground 3.

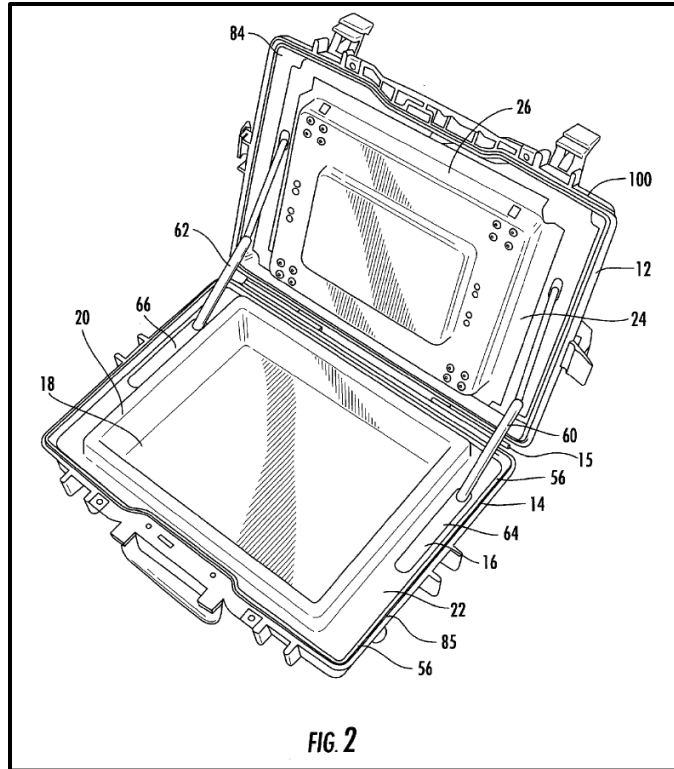
3. Summary of Simpson

U.S. Publication No. 2014/0298492 (“Simpson”) is entitled “Security Case,”

was filed March 14, 2014, claimed priority to Provisional Application No. 61/800,958 filed on March 15, 2013, and was published on October 2, 2014. (EX-1005, Cover; *see also* Buckner Decl., ¶¶ 109-114 (providing an overview of Simpson).)

Simpson describes security cases with locks preferably operated by an electronic key that “can be programmed to open the case . . . dependent on various different conditions, for example, location, time, identification of operator, etc.” (EX-1005, Abstract.) The Simpson case is a “portable container which restricts access to the contents within the container to authorized individuals and enables the container to be tracked.” (EX-1005, [0002]; *see also* EX-1005, cl. 1.) The Simpson case includes a controller that determines whether a condition is met and authorizes the lock device to move to an unlocked condition. (EX-1005, [0007]-[0008], cl. 1.)

Figure 2 illustrates an embodiment of the Simpson case including a case **10**, cover or lid **12**, base/lower portion **14**, hinge **15**, insert **16**, cavity/lower chamber **18** (where “valuable articles” are securely transported), upstanding wall/perimeter portion **20**, and spacer area **22**:



(EX-1005, Fig. 2, [0036]-[0037].) Figure 3 further shows upper chamber **26**, which contains locks **28** to secure the case closed. (EX-1005, Fig. 3, [0037].) The Simpson case also may contain a GPS location device **30** or an electronic memory device **32**. (EX-1005, Fig. 4, [0037], [0040]-[0041].)

An exemplary locking mechanism to secure lid **12** to lower portion **14** of the Simpson case is illustrated in Figure 6C of Simpson, which shows a pin or locking member **36** for each lock that is operated by an electrically powered device such as a solenoid **40**. (EX-1005, Figs. 6C, 8, [0037]-[0038].) Simpson teaches the use of an electronic key **42**, which can physically turn and open lock **44** if it receives a proper signal. (EX-1005, [0039].) Simpson specifically notes the electronic key may be programmed to open the case at a certain time or within a certain time frame and can

be enabled or disabled from a signal “transmitted by a satellite, a cellphone, or a radio frequency transmission.” (EX-1005, [0039].)

Simpson also teaches that the controller **54** can be programmed to authorize opening of the case within a certain time range or at a specific predetermined location. (EX-1005, [0045], [0048], [0056].)

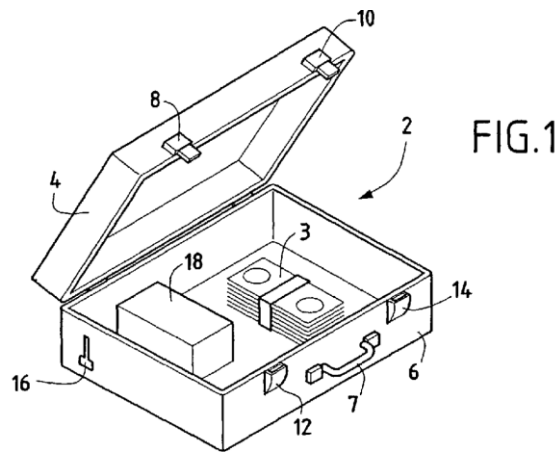
Finally, Simpson notes that while a certain form of the invention was illustrated (*e.g.*, the hard case embodiment shown in Figure 2), it should not be limited to that specific form or arrangement. (EX-1005, [0060].)

4. Reasons to Combine Samuel, Shin, and Simpson

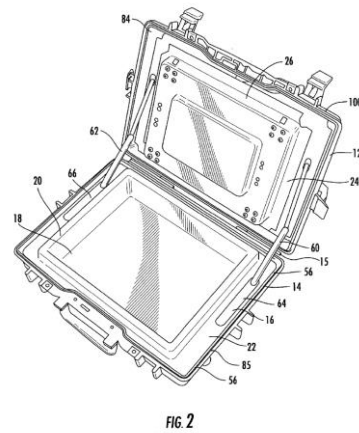
Be Smarter incorporates the reasons to combine Samuel and Shin provided in Section VI.C.3. In summary, a person of ordinary skill would have been motivated to look to Shin to replace the hard case preferred embodiment of Samuel with the more flexible structure disclosed in Shin based on the explicit disclosure in Samuel that a more flexible parcel or envelope structure could be used in place of the hard case embodiment. (EX-1003, [0091]; Buckner Decl., ¶ 128.)

A person of ordinary skill also would have been motivated to modify the Samuel case or envelope with disclosures from Simpson because Simpson describes a very similar security case that accounts for advancements in wireless signal processing and locking/unlocking mechanisms since the publication of Samuel. (Buckner Decl., ¶¶ 128-133.)

First, the security cases disclosed in Samuel and Simpson are very similar:



Samuel



Simpson

(EX-1003, Fig. 1; EX-1005, Fig. 2; Buckner Decl., ¶ 129.) That is, Samuel and Simpson both describe cases, as depicted in the figures above, briefcase-type structures, designed for the secure transportation of valuable objects. (EX-1003, Fig. 1, [0001]-[0002],[0084], [0182]; EX-1005, Fig. 2, Abstract, [0002]-[0003].) Both also teach locking mechanisms (locks **8**, **10**, **12**, **14** in Samuel and locks **28** in Simpson) that may be unlocked using electronic means. (EX-1003, Abstract, [0012]-[0013], [0083], [0089]-[0090], [0105]-[0109], cl. 1; EX-1005, [0037]-[0039].) Thus, not only are Samuel and Simpson references in the same field, but they describe nearly identical security cases. (Buckner Decl., ¶ 129.) For these reasons, a person of ordinary skill would have been motivated to combine the disclosures of Samuel with those of Simpson in designing a secure case to store or transport valuables. (Buckner Decl., ¶¶ 129.)

Second, a person of ordinary skill looking to develop a secure case for electronic devices would consider variations on the predetermined conditions for unlocking the case, including by review of similar references. (Buckner Decl., ¶¶ 129-132.) Both Samuel and Simpson teach that unlocking may be dependent on certain conditions. (EX-1003, [0073], [0109], [0124]-[0125], [0137]-[0141]; EX-1005, Abstract, [0039], [0045], [0056].) For example, Samuel teaches the case's status may be monitored, including by GPS, and a person of ordinary skill in the art would understand Samuel to teach location may be a condition used to determine whether to send the unlock signal to the electronic means for unlocking. (EX-1003, [0012]-[0013], [0038], [0067]-[0069], [0073], [0124]-[0125], [0174]-[0178]; Buckner Decl., ¶ 130.) Specifically, Samuel discloses the predetermined condition could be that the destination of the case has been reached. (EX-1003, [0123]-[0125], [0173]-[0176]; *see also* Section VI.C.4.) Simpson similarly teaches its electronic key may be programmed to open the case depending on location, including through the use of GPS location. (EX-1005, Abstract, [0008], [0039]-[0040], [0043], [0053], [0045], [0056]; Buckner Decl., ¶ 130.)

In addition, each of Samuel, Shin, and Simpson teach using timing as a condition. Shin discloses the use of a timing means to block radio waves from entering the envelope until a set time has expired. (EX-1004, 9; Buckner Decl., ¶ 131.) Simpson teaches an electronic key may be programmed to open the case

conditioned on time. (EX-1005, Abstract, [0008], [0039]; Buckner Decl., ¶ 130.) Samuel also contemplates timing as an aspect of programming a security case. Specifically, Samuel discloses that once the signal authorizing opening the case is received, the contents must be removed within a “particular time interval” or the case will lock again. (EX-1003, [0137]-[0141].) Samuel thus acknowledges timing is a consideration for lock and unlock signals, and it would be a natural extension of Samuel for a person of ordinary skill to condition opening of the case on the passage of time as described in Simpson. (Buckner Decl., ¶¶ 130-131.) Thus, a person of ordinary skill would have been motivated to start with Samuel, which pre-dates Simpson, and modify the Samuel case (or the Samuel envelope) to account for alternative conditions for triggering the electronic key to unlock the case, including using the passage of time as the (or part of the) condition. (Buckner Decl., ¶¶ 130-133.)

Further, each of Samuel, Simpson, and Shin disclose ways to secure valuables, and a person of ordinary skill looking to secure electronic devices would have been motivated to look to references attempting to solve the same problem. (Buckner Decl., ¶¶ 132.)

For these reasons, a person of ordinary skill would have been motivated to combine the disclosures of Samuel, Shin, and Simpson to design a case that met the limitations of claims 2, 10, and 19 of the '078 patent. (Buckner Decl., ¶¶ 128-133.)

5. Claim 2

Claim	Claim Language
2	The case of claim 1, wherein the predetermined condition is further associated with a time period.

Samuel in combination with Shin and Simpson discloses and renders obvious claim 2. (Buckner Decl., ¶¶ 163-176.) For the reasons discussed in Ground 2 at Section VI.C.4, which is incorporated by reference, Samuel in combination with Shin discloses the limitations of and renders obvious claim 1. *See* claim 1 analysis.

Simpson also teaches disclosures that read on elements required by claim 1, which provide a motivation to combine Simpson’s disclosures with those of Samuel and Shin. (Buckner Decl., ¶¶ 165-176.) Specifically, Simpson discloses that its “Security Case” restricts access to the valuable objects securely transported within the container, thus “selectively limiting a user’s ability to control” the “valuable” stored within the case. (EX-1005, Title, [0002]; Buckner Decl., ¶¶ 165-166.) Simpson provides examples including jewelry, financial files, financial documents, credit cards, and intelligence files. (EX-1005, [0003].) Although the specific examples of “valuables” given in Simpson do not include mobile devices, one of ordinary skill in the art would understand the briefcase depicted in Figure 2 would accommodate a “valuable” such as a user’s mobile device and thus, to one of ordinary skill in the art, Simpson teaches a security case that would meet the limitations of the preamble of claim 1 and 1(a). (Buckner Decl., ¶¶ 165-172.)

Specifically, the “**shell defining a cavity sized to accommodate a mobile device, the shell having an opening to receive the mobile device**” required in element 1(a) is met by “the insert **16** [that] includes a cavity or lower chamber **18**” as depicted in Figure 2 of Simpson. (EX-1005, Fig. 2, [0036]; Buckner Decl., ¶¶ 167-172.) That “**shell**” of Simpson has “**an opening to receive**” a valuable, which, as noted above, a person of ordinary skill in the art would understand to include a mobile device, particularly in combination with Shin’s disclosure of a cellphone as the valuable being contained. (EX-1005, Fig. 2; Buckner Decl., ¶¶ 169-171.)

Simpson also discloses the required “**lock**” of element 1(b) of the ’078 patent. (Buckner Decl., ¶ 173-176.) Simpson discloses that shell **16** is part of the lower portion **14** of the case, which is secured to the lid **12** using locks **28**, each of which is “**positioned proximate to the opening of the shell**” such that the valuable, for example the user’s mobile device, within the cavity of the shell is rendered inaccessible to the user. (EX-1005, Figs. 2, 3, 6A-6C, [0002], [0036]-[0039]; Buckner Decl., ¶¶ 173, 176.) As shown in Figure 6C, that locking means includes securably mateable female and male members on opposing plates to secure lid **12** to the lower portion **14** as part of the locking mechanism that includes an aperture in the side of the lower portion **14** through which pin **36** may be extended to lock the case **10**. (EX-1005, Fig. 6C, [0037]; Buckner Decl., ¶ 174.) In the locked position, the contents inside the case are inaccessible to the user, and Simpson further teaches

that the locking means will remain locked at least until an electronic key **42** is used to open the lock. (EX-1005, [0037]-[0039]; Buckner Decl., ¶ 175.) For these reasons, Simpson, like Samuel, discloses the limitations required by element 1(b). (Buckner Decl., ¶¶ 173-176.)

Simpson also discloses the final element of claim 2, which requires the “**the predetermined condition is further associated with a time period.**” Specifically, Simpson notes the electronic key **42** used to unlock the case **10** may be programmed to “only open the case at a certain time or within a certain time frame or window as preprogrammed.” (EX-1005, [0039], [0045].) To a person of ordinary skill, that is a disclosure that the predetermined condition is a time period (and thus “associated” with a time period). (Buckner Decl., ¶ 177.)

6. Claim 10

Claim	Claim Language
10	The case of claim 9, wherein the predetermined condition is further associated with a time period, wherein the geographic region corresponds to a physical position of the case respective to a geographic area of a venue.

Samuel in combination with Shin and Simpson discloses and renders obvious claim 10 of the '078 patent. (Buckner Decl., ¶¶ 223-236.) For the reasons discussed in Ground 2 at Section VI.C.7, which are incorporated by reference, Samuel in combination with Shin discloses all the limitations of and renders obvious claim 9. *See* claim 9 analysis.

The remaining elements of claim 10 combine a limitation from claim 2—**“wherein the predetermined condition is further associated with a time period”**—and a limitation from claim 3—**“wherein the geographic region corresponds to a physical position of the case respective to a geographic area of a venue.”** These additional limitations are disclosed and rendered obvious by the combination of references for the same reasons set forth regarding claims 2 and 3 above, which are hereby incorporated by reference. *See* claim 2 analysis, Section VI.D.5; claim 3 analysis, Section VI.C.5.

As discussed above with respect to claim 2, Simpson discloses that **“the predetermined condition is further associated with a time period.”** (*See* Section VI.D.5 (incorporated by reference); Buckner Decl., ¶¶ 235, 237-240.) Specifically, Simpson teaches that “a travel plan by time of day and location can be stored in the memory” and thereby used to determine whether the security case should remain locked or be unlocked and that the case may be programmed to “only open the case at a certain time or within a certain time frame or window as preprogrammed.” (EX-1005, [0039]-[0040], [0043]; *see also* Buckner Decl., ¶¶ 235, 238.) The fact that the time of day is stored in the memory and used to evaluate whether to keep the case locked discloses the time period limitation in claim 10—in other words, the evaluation of the time of day or time frame determines whether or not the “time period” condition has been met. (Buckner Decl., ¶¶ 235, 238.)

7. Claim 19

Claim	Claim Language
19	The system of claim 15, wherein the predetermined condition is further associated with: a passage of time.

Samuel in combination with Shin and Simpson discloses and renders obvious claim 19. (Buckner Decl., ¶¶ 294-307.) For the reasons discussed in Ground 2 at Section VI.C.9, which are incorporated by reference, Samuel in combination with Shin discloses all the limitations of and renders obvious claim 15. *See* claim 15 analysis. Claim 19 adds the limitation that “**the predetermined condition is further associated with: a passage of time.**” Simpson discloses that the predetermined condition is the passage of time and thus “**associated with: a passage of time.**” (Buckner Decl., ¶ 308.) Specifically, Simpson teaches that “a travel plan by time of day and location can be stored in the memory” and thereby used to determine whether the security case should remain locked or be unlocked and that the case may be programmed to “only open the case at a certain time or within a certain time frame or window as preprogrammed.” (EX-1005, [0039]-[0040], [0043]; Buckner Decl., ¶ 308.) The fact that the time of day is stored in the memory and used to evaluate whether to keep the case locked discloses to a person of ordinary skill the limitation in claim 19—in other words, the evaluation of the time of day or time frame determines whether or not the “passage of time” condition has been met. (Buckner Decl., ¶¶ 308.)

E. Ground 4: Claim 5 is Unpatentable under 35 U.S.C. § 103 by Samuel in View of Shin and Theobald

1. Summary of Samuel

Be Smarter incorporates the summary of Samuel provided in Section VI.B.1 into Ground 4.

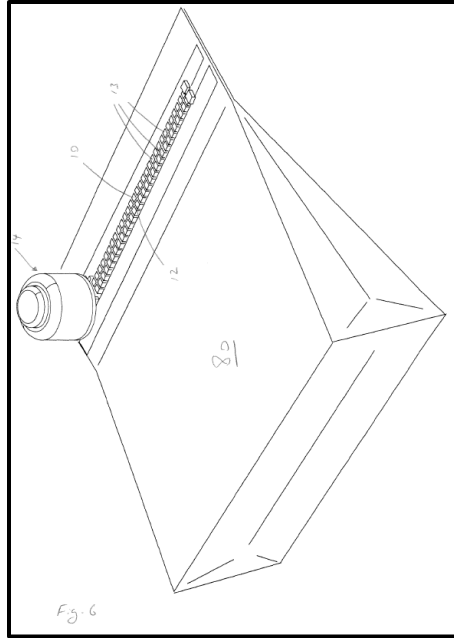
2. Summary of Shin

Be Smarter incorporates the summary of Shin provided in Section VI.C.2 into Ground 4.

3. Summary of Theobald

WO 2014/122001 A1 to Theobald (“Theobald”) published on August 14, 2014, from PCT/EP2014/051000, which claims priority to February 7, 2013, and is titled “Magnetically Operated Locking Slider for Zipper.” (EX-1006, Cover; *see also* Buckner Decl., ¶¶ 115-119 (providing an overview of Theobald).)

Theobald concerns a lockable zipper, which can move from a locking position to an unlocking position when a magnetic force is applied, and discloses and depicts its use with a security bag:



(EX-1006, pp. 1, 4, 9, Fig. 6.) Theobald describes:

In use, a product is placed within the bag and the zipper is closed by sliding the slider **14** in the closing direction. As the slider **14** is in the locking configuration shown in Figure 3, the slider cannot be slide in the opposite opening direction to open the bag. When it is desired to remove the article from the bag, a shop worker can use the detaching magnet **78** to unlock the slider **14**, as discussed above, so as to allow the slider **14** to be slid in the opening direction.

(EX-1006, p. 9; *see also* EX-1006, Fig. 5 (depicting detaching magnet **78**).)

4. Reasons to Combine Samuel, Shin, and Theobald

Be Smarter incorporates the reasons to combine Samuel and Shin provided in Section VI.C.3. In summary, a person of ordinary skill would have been motivated to look to Shin to replace the hard case preferred embodiment of Samuel with the more flexible structure disclosed in Shin based on the explicit disclosure in Samuel that a more flexible parcel or envelope structure could be used in place of the hard

case embodiment. (EX-1003, [0091]; Buckner Decl., ¶¶ 125-127.)

A person of ordinary skill also would have been motivated to modify the Samuel envelope with disclosures from Theobald because Theobald describes a very similar envelope or “bag” structure to that mentioned in Samuel and depicted in Shin with security improvements to the locking mechanism. (Buckner Decl., ¶ 135; EX-1006, Fig. 6; EX-1003, [0021], [0091]; EX-1004, Figs. 1-2.)

Further, each of Samuel, Shin, and Theobald disclose ways to secure valuables, and a person of ordinary skill looking to secure electronic devices would have been motivated to look to references attempting to solve the same problem. (Buckner Decl., ¶ 137.)

In addition, both Samuel and Theobald discuss using magnetic locking closures. (EX-1003, [0086]; EX-1006, p. 1; Buckner Decl., ¶ 136.)

For these reasons, a person of ordinary skill would have been motivated to combine the disclosures of Samuel, Shin, and Theobald to design a case that met the limitations of claim 5 of the '078 patent. (Buckner Decl., ¶ 138.)

5. Claim 5

Claim	Claim Language
5	The case of claim 1, wherein the lock is configured to unlock the case based on interaction with a detacher.

Samuel in combination with Shin and Theobald discloses and renders obvious claim 5. (Buckner Decl., ¶¶ 193-196.) For the reasons discussed in Ground 2 at

Section VI.C.4, which is incorporated by reference, Samuel in combination with Shin discloses the limitations of and renders obvious claim 1. *See* claim 1 analysis.

Theobald also teaches disclosures that read on elements required by claim 1, which provide a motivation to combine Theobald's disclosures with those of Samuel and Shin. Specifically, Theobald discloses a “**case**,” as required by the preamble, in the form of a security bag and also has a “**shell defining a cavity sized to accommodate a mobile device, the shell having an opening to receive the mobile device**,” as required by claim element 1(a). (Buckner Decl., ¶ 195; EX-1006, 9, Fig. 6.) Although Theobald only refers to a “product” being placed within the bag through the opening, a person of ordinary skill in the art would have understood from the description and figures in Theobald that the security bag was sized to accommodate a product such as a mobile device. (Buckner Decl., ¶ 195; EX-1006, 9.)

Theobald also discloses claim element 1(b). Specifically, Theobald discloses a lockable zipper at the top of the security bag (“**positioned proximate to the opening of the shell**”) that is configured to remain in a locked position and prevent the product from being removed (“**the lock configured to render the mobile device at least partially inaccessible upon the lock being locked with the mobile device within the cavity of the shell**”). (Buckner Decl., ¶ 196; EX-1006, Fig. 6, 3-4, 6, 7, 9.)

Finally, Theobald discloses that **“the lock is configured to unlock the case based on interaction with a detacher”** as required by claim 5. (Buckner Decl., ¶¶ 197-198.) Specifically, Theobald discloses a zipper lock with control member **58** that can be moved from a locking position to an unlocking position by the application of a magnetic force to the control member **58**, such as through the use of detaching magnet **78** (**“a detacher”**). (EX-1006, Fig. 5, Abstract, pp. 2, 8-9.)

F. Ground 5: The Challenged Claims Are Invalid for Indefiniteness under 35 U.S.C. § 112

All Challenged Claims require the predetermined condition be **“associated with”** a **“geographic/geographical region”** or **“a physical presence of the case being outside of a defined geographical region.”** (EX-1001, cls. 1, 9, 15.) This contrasts with similar claims in the ’788 patent, which require that the **“predetermined condition *is* physical presence of the case outside of a defined geographical region.”** (EX-1017, claims 1, 7; *see also* Buckner Decl., ¶¶ 312, 327-328 (explaining the different claim language).) There is nothing in the ’078 patent that explains what merely being **“associated with”** means—the phrase **“associated with”** as it relates to predetermined condition or a geographic region does not appear

anywhere in the specification.⁷ (Buckner Decl., ¶¶ 309-311.) Nor does the '078 patent explain how “**associated with**” is different from “is” as used in the '788 patent. *See, e.g., Karlin Tech. Inc. v. Surgical Dynamics, Inc.* 177 F.3d 968, 971-72 (Fed. Cir. 1999) (explaining the “common sense notion” that different words or phrases used in separate claims are presumed to have separate meanings). Nor does the prosecution history of the '078 patent provide reasonable certainty to a person of skill in the art as to what it means that the predetermined condition is “**associated with**” a geographic region or physical presence outside such a region. (Buckner Decl., ¶¶ 313-314.)

For these reasons, the Challenged Claims are indefinite under 35 U.S.C. § 112(b). *See Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 910 (2014) (patent is invalid under § 112(b) “if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention”). (Buckner Decl., ¶¶ 309-330.)

Yondr may argue that certain examples in the specification provide guidance

⁷ Other than in the claims, “associated with” appears in the '078 patent only in a discussion of the “processors associated with the mobile electronic device.” (EX-1001, 8:55-56.)

as to “examples of the ‘predetermined condition[s] associated with a geographic region.” (See EX-1015-022-023.) However, those examples do not (i) refer to the predetermined condition being “**associated with**” a geographic region or (ii) provide reasonable certainty as to the scope of what it means that the predetermined condition is merely “**associated with**” a geographic region as opposed to the predetermined condition itself being “physical presence of the case outside of a defined geographical region” as set forth in certain ’788 patent claims. (EX-1017, cls. 1, 7; *see also* Buckner Decl., ¶¶ 315-326 (discussing examples).)

G. Ground 6: Claims 1-5, 9-11, 15-16, and 19 Are Invalid for Lack of Patent-Eligible Subject Matter under 35 U.S.C. § 101

Yondr argued for claim constructions in the WDTX Action that, if adopted, would leave the asserted claims requiring nothing more than the abstract idea of unlocking a case sized to accommodate a “mobile electronic device/mobile device.”

Under Yondr’s constructions, the claimed inventions do not provide any technological solution to the challenges posed by “highly addictive” cellphone use in inappropriate situations. (See EX-1015-006 (characterizing part of the problem as the highly addictive link between a user and a cell phone).) Likewise, even after applying Be Smarter’s proposed constructions, the claimed inventions offer nothing more than the abstract idea of the conditional unlocking of a case implemented by generic, conventional components. Thus, none of the Challenged Claims meets the

requirements for patent eligibility. (*See also* Buckner Decl., ¶¶ 331-365 (analyzing the patent eligibility of each Challenged Claim).)

Patent Act Section 101 implicitly excludes “abstract ideas” from the scope of patent eligible subject matter. 35 U.S.C. § 101. To that end, the Supreme Court has held that patent eligibility under 35 U.S.C. § 101 is determined by applying a two-step test. A claim is not eligible for patent protection if (i) it is directed to an abstract idea, and (ii) its particular limitations, considered both individually or as an ordered combination, lack an inventive concept sufficient to transform the abstract claim into a patent-eligible application. *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 217-18 (2014). Put another way, is there “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.* at 217-18 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 72, 77-79 (2012)).

1. *Alice* Step One—The Claims Are Directed to an Abstract Idea.

The Federal Circuit has explained that step one requires the Board to review the “focus of the claimed advance” to determine whether the focus of the claims “as a whole” is directed to excluded subject matter. *See American Axle & Mfg., Inc. v. Neapco Holdings, LLC*, 967 F.3d 1285, 1292 (Fed. Cir. 2020).

Here, inventor Graham Dugoni expressly stated the problem he sought to solve: making “pernicious,” highly addictive” cellphones and other mobile

electronic devices unavailable to users at inappropriate times and places. (See EX-1015-006 (describing the problem inventor Dugoni was attempting to solve); EX-1001, Abstract, 1:43-2:27.) But that is just an abstract idea in the same way that society prefers people not to bring a cowbell to the opera or handheld video games to church. Indeed, Dugoni does not claim to have discovered some previously unknown idea. Locking storage containers, cases, luggage, purses have been well-known for centuries. (See Buckner Decl., ¶ 341 (citing prior art examples of lockable cases).) Similar locking containers that open only upon satisfying predetermined conditions such as a bank safety-deposit box or a time capsule also have been around for 100+ years. At the core, Yondr’s claims are directed to the centuries-old practice of controlling another person’s access to personal property—just an unpatentable form of “organizing human activity.”

Moreover, the claims cite functional results rather than concrete technological solutions further demonstrating this is just an abstract idea. Rendering the device inaccessible and unlocking only upon satisfaction of a condition are just desired outcomes without specifying how those outcomes are technologically achieved. This type of results-oriented claiming is not eligible for patenting. *American Axle*, 967 F.3d at 1295-97. Indeed, claims that purport to encompass all solutions for achieving a particular result, claims drafted in a way that encompasses the principle in the abstract no matter how implemented, are patent-ineligible abstract ideas. *Id.* at 1296.

During prosecution of the application leading to the '078 Patent (the '847 Application), the Examiner initially agreed. Yondr requested prioritized examination of the '847 Application under Track 1. (EX-1007-076.) In an Office Action dated May 23, 2024, the Examiner rejected most of the claims as anticipated by Stewart (EX-1008) and found all remaining claims obvious in light of Stewart combined with Simon (EX-1009), Coleman (EX-1010), and Nguyen (EX-1011). (EX-1007-080, 087-092.) Specifically, Simon taught that locks configured to unlock based on a temporal predetermined condition were well known for at least “fifty years.” (EX-1007 at 088 (“The Examiner takes Official Notice that a case which has a lock is configured to unlock the case based on a predetermined condition, the predetermined condition being at least a time period is well known and at lease [sic] fifty years old”).) Coleman taught that incorporating a microprocessor for receiving wireless data signals to unlock a case was “more than two decade old technology.” (EX-1007-090.) And Nguyen taught that a lock comprising male and female plates disposed on panels that securely mate was “old, commercially available to the general public, and well known to one below ordinary skill in the art.” (EX-1007-091.)

All these rejections demonstrate both that the Asserted Claims are invalid under 35 U.S.C. §§ 102 and 103 as set already forth in this Petition, and provide further evidence the claimed inventions are nothing more than patent ineligible

abstract ideas under Section 101. (See Buckner Decl., ¶¶ 339, 354, 360 (concluding that, under an analysis of the first step in the test for patent eligibility that each of the Challenged Claims is directed to the abstract idea of the conditional unlocking of a case).)

2. *Alice* Step Two—The Claims Do Not Include Any Inventive Concept.

Next, the Board examines the claim elements to determine whether, individually or in an ordered combination, they contain an inventive concept sufficient to transform the abstract idea into patent-eligible subject matter. *Id.* at 1293. To meet this requirement, the claims must do more than recite “well-understood, routine, conventional activity.” *Mayo Collaborative Servs. V. Prometheus Labs, Inc.*, 566 U.S. 66, 79-80 (2012). And generic hardware cannot provide the inventive concept. *Alice*, 573 U.S. at 223.

Here, the asserted independent claims 1, 9, and 15, do not recite any technological improvement or add any inventive concept, especially in light of Yondr’s proposed claim constructions. These three claims include roughly the same elements:

- A case comprising;
- A shell defining a cavity sized to accommodate a mobile device, the shell having an opening to receive the mobile device; and
- A lock positioned proximate to the opening of the shell, the lock configured to render the mobile device at least partially

inaccessible upon the lock being locked with the mobile device within the cavity of the shell, the lock further configured to unlock to enable access to the mobile device on a predetermined condition associated with a geographic region.

(EX-1001, cl. 1 (emphasis added); *see also* EX-1001, cls. 9, 15 (containing the same or similar basic requirements emphasized in claim 1 above); Buckner Decl., ¶¶ 337, 350, 356.)

There is no inventive concept in that claim or among those elements. (Buckner Decl., ¶¶ 340-349, 351-353, 355, 357-359, 361-364 (addressing each of the Challenged Claims).) A real, patentable solution to the problem here potentially could include elements of a system or steps in a method that actually prevent a user from accessing his or her cell phone until a condition is satisfied whether that is by a radio frequency communication, wireless computer signal, or some other means of unlocking the device only upon satisfying a condition that do more than simply apply conventional components. Yondr, however, argued *against* any such limitations in the WDTX Action. (EX-1015, 8-12.)

Specifically, Yondr argued “configured to . . .” and “based on/in accordance with a predetermined condition” need nothing more than “plain and ordinary” meaning. (EX-1015, 12, 17.) Yondr further rejected including any meaningful limitations in the definitions of these terms and repeatedly argued that the claims should be broader than “just a ‘programmed’ lock.” (EX-1015, 8–17.) Therefore,

Yondr concedes that there is no inventive concept here.

In the end, under Yondr’s claim interpretation, the ’078 patent claims are directed to nothing more than the unlocking of a case (sized to accommodate a mobile electronic device/ mobile device). Any asserted novelty lies in applying the abstract idea as to cellphones (or other mobile devices), but applying an abstract idea in a new area does not amount to the required inventive concept. In *Alice*, the Supreme Court said that limiting application of this concept to a particular environment—here, cellphone use—does not make the abstract idea patentable. *Alice*, 573 U.S. at 225. Confining the restriction to mobile devices rather than all personal property is “simply a drafting effort designed to monopolize the [idea] itself.” *Id.* at 222-23.

Even if the Board applies more meaningful constructions to “configured to render the mobile device at least partially inaccessible” and “configured to unlock to enable access to the mobile electronic device based on a predetermined condition,” as proposed by Be Smarter, there still is no inventive concept. These terms do nothing more than transform the locking case into a case that only unlocks when a predetermined condition is satisfied. (See Buckner Decl., ¶¶ 339–340 (addressing claims 1-5), 354-355 (addressing claims 9-11), 360-361 (addressing claims 15, 16, and 19).) As described above, even the Examiner cited multiple prior art references—Stewart, Simon, Coleman, and Nguyen—all evidencing that the

claimed inventions lack any inventive concept. (EX-1007 at 80-91; Buckner Decl., ¶¶ 67-70.)

In the end, there is nothing inventive here without adding some additional technology to implement this well-known idea.

VII. CONCLUSION

For the reasons set forth above, Be Smarter has established a reasonable likelihood that the Challenged Claims of the '078 patent are unpatentable. Petitioners therefore request institution of post-grant review and cancellation of the Challenged Claims.

Dated: July 29, 2025

Respectfully submitted,

/s/ Leisa Talbert Peschel
Leisa Talbert Peschel
Lead Counsel for Petitioners
Registration No. 62,248

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(a)(1)(ii), the undersigned attorney for Petitioners declares that the argument section of this Petition (Sections I and III–VII) has 16,201 words, according to the word count tool in Microsoft Word with the addition of annotations not otherwise counted in figures.

Dated: July 29, 2025

Respectfully submitted,

/s/ Leisa Talbert Peschel
Leisa Talbert Peschel
Lead Counsel for Petitioners
Registration No. 62,248

CERTIFICATION OF SERVICE

The undersigned certifies that, in accordance with 37 C.F.R. § 42.6(e) and 37 C.F.R. § 42.105, service of this Post-Grant Review Petition (including Exhibit List; Exhibits EX-1001 to EX-1020) was made on Patent Owner by Federal Express next-day delivery to the Patent Owner for the '078 patent via its attorney of record, Sterne, Kessler, Goldstein & Fox, P.L.L.C., 1101 K Street, NW, 10th Floor, Washington, DC 20005, with a courtesy copy sent via email to counsel of record for Yondr, Inc. in the WDTX Action.

/s/ Leisa Talbert Peschel
Leisa Talbert Peschel
Lead Counsel for Petitioners
Registration No. 62,248