UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

YONDR, INC., Plaintiff, v. BE SMARTER, LLC AND JAMES GUERRA, Defendants.	§ § § § § § § § § § § §	Civil Action No. 1:24-cv-01326-ADA

Defendants' Reply Claim Construction Memorandum

TABLE OF CONTENTS

Table of Authorities ii

Argument 1

I. Person of Ordinary Skill in the Art 1

II. The Parties' Conflicting Positions Reveal a Core Underlying Tension 2

III. Specific Claim Constructions 4

A. The Means-Plus-Function Locking and Unlocking Claim Terms 4

B. Configured 6

C. The Predetermined Condition Claims 8

D. Associated with a Geographic Region 9

IV. 35 U.S.C. § 101 10

Conclusion 11

TABLE OF AUTHORITIES

Case Law **Page(s)**

American Axle & Mfg., Inc. v. Neapco Holdings, LLC,
967 F.3d 1285 (Fed. Cir. 2019) 11

Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.,
672 F.3d 1335 (Fed. Cir. 2012) 7, 8

Centillion Data Systems, LLC v. Quest Comms. Int'l, Inc.,
631 F.3d 1279 (Fed. Cir. 2011). 9

Free Stream Media Corp. v. Alphonso, Inc.,
996 F.3d 1355 (Fed. Cir. 2021) 2, 8

Intamin, Ltd. v. Magnetar Tech.,
483 F.3d 1328 (Fed. Cir. 2007) 7

InterDigital Comms., LLC v. Int'l Trade Comm'n,
690 F.3d 1318 (Fed. Cir. 2012). 8

Irdeto Access, Inc. v. Echostar Satellite Corp.,
383 F.3d 1295 (Fed. Cir. 2004) 6

Mettler-Toledo, Inc. v. B-Tek Scales, LLC,
671 F.3d 1291 (Fed. Cir. 2012) 5

O2 Micro Int'l, Ltd. v. Beyond Innovation Tech. Co.,
521 F.3d 1351 (Fed. Cir. 2008). 6

Phillips v AWH Corp.,
415 F.3d 1303 (Fed. Cir. 2005) 2

SMO Holdings, Inc. v. Hong Kong uCloudlink Network Tech. Ltd.,
983 F.3d 1367 (Fed. Cir. 2021) 7

Teleflex, Inc. v. Ficosa North American Corp.,
299 F.3d 1313 (Fed. Cir. 2002). 2

Telemac Cellular Corp. v. Topp Telecom, Inc.,
247 F.3d 1316 (Fed. Cir. 2001) 7

Williamson v. Citrix Online, LLC
792 F.3d 1339 (Fed. Cir. 2015)..... 4

Rules and Statutes

35 U.S.C. §101 10

35 U.S.C. §112 11

Be Smarter EX-1016-004

Graham Dugoni is clear about what he claims he invented—"a system and apparatus that selectively limits access to and/or disables functions of a mobile electronic device," rendering the cell phone "inaccessible to the user" and "***non-disengageable by the user***" until a "predetermined condition is met." ('788 Patent, Col. 2:25-30, 57-63 (emphasis added).) Yondr further describes the problem Dugoni solved—"highly addictive," "pernicious" cell phone use that "destroys communal activities." (Yondr Resp. Claim Constr. Brief, Dkt. 47 at 6.)[1] Indeed, on the first page of its brief, Yondr agrees, "Dugoni invented a way for users to keep their mobile devices with them, ***while enabling venues to limit user's access***." (*Id*. (emphasis added).)

At the same time, Yondr argues for claim constructions that undermine Dugoni's claimed invention. Yondr argues Be Smarter focuses on a single embodiment, contrary to the rules of claim construction. (*Id*. at 7.) But Yondr ignores the patents' intrinsic record when asking the Court to read the asserted claims on any locking cell phone pouch regardless of whether the device renders the mobile electronic device inaccessible to the user.

Argument

I. Person of Ordinary Skill in the Art

Yondr asserts the parties dispute the definition of a person of ordinary skill in the art. To that end, Yondr asserts a POSITA would have a degree in "mechanical engineering, industrial design, or a related field." (*Id*. at 8.) Be Smarter asserts a POSITA would have a degree in "mechanical engineering, electrical engineering, or computer science." (Defs. Claim Constr. Mem., Dkt. 44 at 10.) As applied in this case, these definitions are not materially different. Both parties agree mechanical engineering is an underlying field of art, and Be Smarter's proffered

[1] All citations to Yondr's Resp. Claim Construction Brief are to the ECF system page numbers.

expert has a bachelor's, master's, and doctoral degree in mechanical engineering in addition to his electrical and computer science credentials. (Dkt. 44, Ex. 3, Bucker Decl. at ¶¶ 1, 5, 7-9.)

II. The Parties' Conflicting Positions Reveal a Core Underlying Tension

Yondr argues throughout its brief that "Defendants rewrite" the claims (Dkt. 47 at 7), and, yes, claim construction principles counsel against importing limitations from embodiments into the claims. At the same time, the law requires us to read and interpret the claims in light of context provided by the intrinsic record. *See, e.g., Teleflex, Inc. v. Ficosa North American Corp*., 299 F.3d 1313, 1324-25 (Fed. Cir. 2002) (The intrinsic evidence may provide "context and clarification" about the meaning of claim terms); *Phillips v AWH Corp*., 415 F.3d 1303, 1313-14 (Fed. Cir. 2005) (a POSITA is deemed to read the claim terms in the context of the entire patent, including the specification). Indeed, it is similarly inappropriate to read limitations out of a claim. *See, e.g., Free Stream Media Corp. v. Alphonso, Inc.*, 996 F.3d 1355, 1367 (Fed. Cir. 2021) (while reading limitation into a claim is improper, it is similarly improper to eliminate or ignore a claim limitation in order to extend a patent to unclaimed subject matter); Donald S. Chisum, Chisum on Patents § 18.05(d). Therefore, the Federal Circuit has held "clear statements of scope in the specification and prosecution history determine the correct claim construction." *Teleflex*. at 1327.

In this case, there is a core tension between:

- the inventor's clearly stated, simple goal of limiting user access to cell phones, controlling the "highly addictive" impulse to use a phone no matter how inappropriate the time or location;

  and

- a claim construction that does not control or limit user access, such a mere "locking case," in Yondr's own words. (Dkt. 47 at 7.)

Put simply, a so-called invention that allows the user to unlock his or her own phone or is nothing more than a locking pouch does not solve the problem Dugoni claims to have solved. Such a locking pouch would be nothing more than a centuries-old abstract idea with no inventive concept, as described in Part IV, below. Therefore, in line with Dugoni's self-described problem and solution, the asserted claims must cover more than a mere locking pouch. The claims need to meaningfully limit the user's access to his or her device.

In trying to walk this line between (i) reading the claims broadly by avoiding meaningful limitations and (ii) preserving some sort of invention, Yondr contradicts itself in a fundamental and material way. At the outset, Yondr explains how cell phones are addictive, and prior approaches to limiting cell phone use failed. (Dkt. 47 at 6.) Dugoni makes the same point in his patents. ('788 Patent, Col. 1:65 to 2:30.) Therefore, Dugoni found a way limit cell phone access. (Dkt. 47 at 6.) His purported invention claims "***enabling venues to limit users' access***." (*Id*. (emphasis added).) "[T]he ***venue could choose*** conditions for unlocking and restoring access." (*Id*. (emphasis added).) Later in its brief, Yondr clearly states, "***Users' inability to mentally limit their use of mobile devices is what necessitated Dugoni's physical invention***." (Dkt. 47 at 22 (emphasis added).) Yondr, however, reverses course as it tries to rebut Be Smarter's claim construction arguments. At this point, Yondr asserts the invention "***does not require third-party intervention***" despite all the foregoing context. (Dkt. 47 at 10 (emphasis added).) But again, just two paragraphs later, Yondr concedes that even a pouch with a manual key-operated latch would need to be "manually locked or unlocked by ***venue staff***"—a third party. (*Id*. (emphasis added).)

This contradiction underlies the flaws in Yondr's argument. Dugoni cannot have invented an apparatus for limiting "highly addictive" cell phone access while, at the same, time giving the user control over a simple locking pouch. This is why Dugoni's solution and the asserted claims

tie unlocking the pouch to satisfying a "predetermined condition." And someone other than the user needs to decide if such "predetermined condition" for unlocking has been met; otherwise, the supposed limited cellphone access is illusory and there is no invention. Nonetheless, Yondr tries to read the concept of satisfying a predetermined condition out of the claims.

III. Specific Claim Constructions[2]

A. The Means-Plus-Function Locking and Unlocking Claim Terms

Yondr argues for excluding the phrase, "so that the user is unable to access his own mobile electronic device contained therein until a predetermined condition is met" from the function of the "locking means." Be Smarter's description of the claimed function, however, is a direct quote from claim language, contrary to Yondr's argument that Be Smarter improperly imported this language from an embodiment (Dkt. 47 at 12).[3] (*See*, '788 Patent, Col. 11:11-13.) In fact, Yondr's exclusion of this entire phrase omits the core function of the "locking means." Rendering the cell phone inaccessible to the user is the purpose of the claimed invention.

Next, when ascertaining the structure of a means-plus-function claim, the parties and the Court are required to look at the structures disclosed in the patent's specification. *See Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1351 (Fed. Cir. 2015) (construing means-plus-function claim terms includes: (i) identifying the claimed function, and (ii) determining what structure disclosed in the specification corresponds to the claimed function). To that end, in this case, the

[2] In Exhibit A, Defendants provide a summary of the disputed claim constructions, highlighting the focal point of the parties' disputes.

[3] On ECF page 8, Yondr relies on *Creo Prods., Inc. v. Prestek, Inc*., in which a party impermissibly adopted a function different than recited in the claim, but that case is inapposite in light of Be Smarter's language coming straight from the asserted claim. 305 F.3d 1337 (Fed. Cir. 2002).

required structure needs to be more than a mere "key-operated latch" (as proposed by Yondr (Dkt. 47 at 10, 12)). Here, the claims and specification require that the claimed apparatus prevent user access "until a predetermined condition is met." (Dkt. 47 at 10.) So, while the specification mentions a latch and key, the Court should find that is an insufficient structure because it does not accomplish the expressly claimed function. *See, Mettler-Toledo, Inc. v. B-Tek Scales, LLC*, 671 F.3d 1291, 1296 (Fed. Cir. 2012) (structure disclosed in the specification is "corresponding structure" only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim).

Be Smarter's, however, does not exclude an electronic key contrary to Yondr's argument. (Dkt. 47 at 13.). Rather, Be Smarter explained in its opening brief why a simple, manual key cannot provide the means for unlocking, but an electronic key could accomplish this function. Overall, Yondr would ignore the specification's clear mandate that the structure has to deny the user access until the predetermined condition is met—this is the entire point of the claimed invention. ('788 Patent, Col. 2:59-67, Col. 6:25-38, 52-58 ("render[ing] the electronic device inaccessible to the user," "non-disengageable by the user . . . until a predetermined condition is met," "physically impenetrable by the user," and "selectively limiting user control").)

Finally, Yondr makes a claim differentiation argument that fails upon closer inspection. (Dkt. 47 at 13.) Dependent claims 5 and 6 require more than just a structure that opens the lock upon satisfying a condition. They claim a specific structure for the locking means—female and male plates— that comprises either "a radio frequency identification tag" or "a microprocessor" to receive instructions from "a remote transmitter" or "a wireless data signal from a beacon or transmitter," respectively, to "disengage the locking means when the predetermined condition is met." ('788 Patent at Col. 12:1-11.) Therefore, these claims already require something more than

is needed to satisfy independent claim 3 and do not counsel against including some sort of signal for unlocking when a predetermined condition is met in claim 3.

B. Configured

In the '078 Patent, the term "configured" links the claimed lock with the concepts of (i) rendering the mobile electronic device inaccessible, and (ii) unlocking the pouch based on or in accordance with a predetermined condition. ('078 Patent, Claims 1 and 9.) Yondr argues "configured" has a plain and ordinary meaning, but the dispute underlying this case—*i.e.*, Yondr's effort to disconnect locking the cell phone, iPad, or computer cases from satisfying a condition notwithstanding Dugoni's clear goals—demonstrates the Court should address this construction. *See, O2 Micro Int'l, Ltd. v. Beyond Innovation Tech*. Co., 521 F.3d 1351, 1360 (Fed. Cir. 2008).

The claimed invention and solution to Dugoni's self-defined problem requires linking unlocking to meeting a predetermined condition. Thus, understanding "configured" as "programmed," or even "designed to" or "made to," ties unlocking and meeting a condition together. In response, Yondr argues "programmed" is too limiting, but Yondr does not otherwise explain how the claimed apparatus is "configured" to open.

To that end, the specification teaches this term means "programmed to unlock, . . ., upon satisfying a predetermined condition." Specifically, the specification confirms "[t]he present disclosure is directed to techniques for limiting access to and control of personal mobile electronic devices within certain geographic locations or even during specified periods of time." ('078 Patent, Col. 2:31-34.) The lock needs to be "configured to unlock to enable access to the mobile device based on/in accordance with a predetermined condition" and involve a lock programmed to unlock the case upon determining a condition has been met. (*See*, e.g., '078

Patent, Col. 2:65 to 3:7 (lock is only disengageable if user leaves the venue or at a time when the communal event is completed), 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 that the case has respectively entered and exited defined geographical region")). The specification also expressly contemplates computer programming may be required "to direct the functions of the present invention." ('078 Patent, Col. 4:32-5:3.) Indeed, the Federal Circuit has treated terms like "configured to," "made to," and "designed to" as synonymous. *See, e.g., Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.*, 672 F.3d 1335, 1349 (Fed. Cir. 2012).

Finally, Yondr argues this definition is not proper because it excludes certain embodiments, again referring to a manual key. (Dkt. 47 at 9.) Not every claim of a patent has to 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); *Intamin, Ltd. v. Magnetar Tech*., 483 F.3d 1328, 1336-37 (Fed. Cir. 2007) (a claim need not cover all embodiments), citing *Telemac Cellular Corp. v. Topp Telecom, Inc*., 247 F.3d 1316, 1326 (Fed.Cir.2001) ("[w]e conclude that only those embodiments involving communications established by the host processor meet the functional elements of the claim"). Therefore, the law does not require the Court to include a manual key in the structure for this claim.

And Yondr's claim differentiation argument again fails. Claims 7, 13, and 18 include additional limitations making them different from the independent claims even if "configured" includes the concept of "programming." For example, claims 7, 13, and 18 also require "a

Be Smarter EX-1016-011

microprocessor for receiving wireless data signals" in the claimed apparatus not required by the word "configured." As case law cited by Yondr provides, claim differentiation arguments are strongest when the limitation in dispute is the only meaningful difference between an independent and dependent claim. *InterDigital Comms., LLC v. Int'l Trade Comm'n*, 690 F.3d 1318, 1324-25 (Fed. Cir. 2012). Here, however, the independent claims contain additional differentiating limitations.

C. The Predetermined Condition Claims

"Predetermined condition" underlies the core dispute here and, therefore, should not be left to "plain and ordinary" meaning. Dugoni and Yondr state the goal of this claimed invention, limiting user access to "addictive" cellphones, but then try to avoid the resulting limitations in claim construction briefing. The predetermined condition is the final link in the combination of "locking means" and "configured" and, thus, is the key to resolving the underlying tension. Indeed, as in other areas of its brief, Yondr appears to agree with or concede the role of the predetermined condition. For example, on page 13, Yondr admits how this trio of claim limitations solve the problem of unlimited cell phone use, stating "it is the combination of limitations and not any single one that provides the benefits of the invention." (Dkt. 47 at 18.)

Yondr, however, tries to strip away that solution in its claim terms arguments, admitting they work together, but defining each term in a way that vitiates the core concept of the invention. *See, e.g., Free Stream Media Corp.*, 996 F.3d at 1367; *Aspex Eyewear*, 672 F.3d at 1359 (reading the claim language in context showed the district court improperly read a limitation out of the claim). Yondr points to the invention as a whole to accomplish the inventor's goal while simultaneously vitiating any meaningful limitations on an element-by-element basis.

The "predetermined condition" is the event that unlocks the pouch. The user cannot unilaterally decide when the condition is met as that would undermine or belie the entire concept of defeating the addictive temptation to use a cellphone, tablet, or laptop at an improper time or location. Once again, Yondr contradicts itself. First, Yondr admits the locking pouch is "inaccessible only until the predetermined condition is met." (Dkt. 47 at 21.) But in the next paragraph, Yondr asserts "the specification discloses that a user can unilaterally decide to meet a predetermined condition…" (*Id*.) Unless the locking mechanism is controlled by someone else, configured to open when the condition is met, such a user-based unilateral decision to open the case undermines the goal of limiting access to "highly addictive" electronic devices.

Even Yondr's example on page 16 undermines its argument and proves Be Smarter's reading is correct: "*e.g*., moving to a different position or moving to the venue's exit to use the detacher." (*Id*.) In that example, a third party must determine if the user has moved to an acceptable location, that is, if the condition has been met.[4] Otherwise, the user can give in to temptation and unlock his or her cellphone whenever he or she desires.

In summary, each claim contemplates unlocking the device and allowing the user to access his or her cellphone "until," "based on," or "in accordance with" the "predetermined condition." Thus, the locking pouch, and the way to unlock it, must be tied to this requirement.

D. Associated with a Geographic Region

This final disputed phrase is indefinite. "***Associated*** with a geographic region" is used in all asserted claims of the '078 Patent but not in the '788 Patent. Instead, the '788 Patent refers a

[4] Yondr likely is trying to argue no third party is necessary even though that undermines the claimed invention because it wants to avoid the problems associated with proving divided infringement. *See Centillion Data Systems, LLC v. Quest Comms. Int'l, Inc*., 631 F.3d 1279 (Fed. Cir. 2011).

predetermined condition being tied to whether or not the user ***is*** outside of the defined geographic region. ('788 Patent at Claim 7.) Moreover, Yondr argues that the Patent Office withdrew its double-patenting objection, obviating the need for a terminal disclaimer. (Dkt. 47 at 25). Therefore, when Dugoni used a different word in his continuation patent application that lead to the '078 Patent, the Court should presume the new word has a different meaning.

The intrinsic record, however, does not teach a POSITA what "associated" instead of "is" means. Yondr tries to address this problem by providing examples of what "associated" could mean, but its examples further demonstrate how this term is indefinite. On page 18, Yondr recites: "at an exit," exceeding the "range of a transmitter," "in a certain room within a venue," and "outside of a given location." (Dkt. 47 at 23.) Each of those examples is different—do "at an exit," out of range, and in certain rooms all infringe? Neither Yondr nor the intrinsic evidence provide the answer. Therefore, contrary to Section 112, a POSITA cannot ascertain whether or not a given location is infringing, rendering these patent claims invalid.

IV. 35 U.S.C. § 101

Finally, Yondr insinuates Be Smarter is making a misplaced *Alice* argument. (Dkt. 47 at 21.) An *Alice* argument would be appropriate and dispositive as Yondr's proposed constructions would leave the asserted claims requiring nothing more than a locking pouch that could be opened by the user—without any third party determining if the predetermined condition has been met. Put simply, the claimed invention would cover a simple locking container sized to accommodate a "mobile electronic device." Yondr claims there is an inventive concept based on marketplace use of the device (*Id*. at 22), but Yondr never tells us what it is.[5]

[5] Yondr appears to argue that 35 U.S.C. § 101 only limits "computer-based" claims (Dkt. 47 at 21), but the statute and case law contain no such limitation. The Federal Circuit has applied Section 101 and the Supreme Court's *Alice* framework to numerous other types of inventions.

Conclusion

For the foregoing reasons, Defendants respectfully request the Court (i) adopt their proposed claim constructions, and (ii) find that "a predetermined condition associated with a geographic region" is indefinite under 35 U.S.C. § 112; or (iii) if the claimed invention is nothing more than a locking pouch that does not even require a third party to determine if a predetermined condition has been met, find that the remaining locking pouch is nothing more than an abstract idea not eligible for patenting under 35 U.S. C. § 101.

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Respectfully submitted,

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See, e.g., American Axle & Mfg., Inc. v. Neapco Holdings, LLC, 967 F.3d 1285 (Fed. Cir. 2019) (analyzing whether patent claims relating to manufacturing propeller shafts were patent ineligible abstract ideas in light of Section 101 and *Alice*).

Certificate of Service

I, Arthur Gollwitzer III, an attorney of record in this matter, hereby certify that on July 11, 2025, I electronically filed the following document:

Defendants' Reply Claim Construction Memorandum

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