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

Case No. PGR2025-0070
US Patent No. 12,133,078 B2

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

Mail Stop: PATENT BOARD
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

TABLE OF CONTENTS

Page No.

I. INTRODUCTION 1

II. THE PARALLEL DISTRICT COURT LITIGATION 2

III. INSTITUTION SHOULD BE DENIED 5

A. *Fintiv* Factor 1: The Parallel District Court Litigation Will Not Be Stayed 5

B. *Fintiv* Factor 2: The District Court Trial Will Occur Before A Final Written Decision 7

C. Fintiv Factor 3: The Parties Have Substantially Invested In The District Court Litigation 7

D. Fintiv Factor 4: The Issues Raised In The Petition Overlap With The District Court Issues 9

E. Fintiv Factor 5: Petitioners Are The Defendants In The District Court Litigation 12

F. Fintiv Factor 6: Other Circumstances Favor Denial 12

1. The Director Already Denied Institution Of A Petition For The Related '788 Patent 12

2. Petitioners' Art Is Cumulative Of The Art Before The Examiner 13

3. Petitioners' Invalidity Arguments Are Particularly Weak 17

IV. CONCLUSION 18

TABLE OF AUTHORITIES

Page No(s).

Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH,
IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020).....14

Alice Corp. Pty. Ltd. v. CLS Bank Int'l,
573 U.S. 208 (2014).....18

Apple Inc. v. Fintiv, Inc.,
IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020).....*passim*

BASF Corp. v. Johnson Matthey Inc.,
875 F.3d 1360 (Fed. Cir. 2017).....19

Be Smarter, LLC v. Yondr, Inc.,
IPR2025-00970, Paper 14 (PTAB Sept. 26, 2025).....11, 13

DDR Holdings, LLC v. Hotels.com, L.P.,
773 F.3d 1245 (Fed. Cir. 2014).....19

Immersion Sys. LLC v. Midas Green Techs., LLC,
IPR2021-01176, Paper 16 (PTAB Jan. 6, 2022).....7

Intell. Ventures I LLC v. Hewlett Packard Enter. Co.,
No. 6:21-CV-00596-ADA, 2022 WL 22870184 (W.D. Tex. Dec. 22, 2022).....5

Sonrai Memory Limited v. Micron Tech., Inc.,
No. 1:23-cv-01407-ADA, 2024 WL 5185357 (W.D. Tex. May 29, 2024).....5

OTHER AUTHORITIES

15 U.S.C. §1114.....6

15 U.S.C. §1125.....6

35 U.S.C. §101.....*passim*

TABLE OF AUTHORITIES
(*cont'd*)

Page No(s).

35 U.S.C. §102 ..... 2, 10, 18

35 U.S.C. §103 ..... 2, 10, 18

35 U.S.C. §112 ..... *passim*

35 U.S.C. §321 4

35 U.S.C. §324 1

35 U.S.C. §325 14

TABLE OF EXHIBITS

EXHIBIT	DESCRIPTION
2001	October 31, 2024 Complaint in Case No. 1:24-cv-01326-ADA in the U.S. District Court for the Western District of Texas
2002	December 13, 2024 Answer and Counterclaims in Case No. 1:24-cv-01326-ADA
2003	Docket Report in Case No. 1:24-cv-01326-ADA
2004	January 31, 2024 First Amended Counterclaim in Case No. 1:24-cv-01326-ADA
2005	March 25, 2025 Order Reassigning Case to Judge Alan Albright
2006	Judge Albright's Standing Order Governing Proceedings of Patent Cases ("Judge Albright's OGP")
2007	Petitioners' April 14, 2025 Invalidity Contentions in Case No. 1:24-cv-01326-ADA
2008	August 7, 2025 Scheduling Order in Case No. 1:24-cv-01326-ADA
2009	Transcript of September 22, 2025 Markman Hearing in Case No. 1:24-cv-01326-ADA
2010	September 24, 2025 Claim Construction Order in Case No. 1:24-cv-01326-ADA
2011	September 29, 2025 Email from Petitioners' Counsel to District Court
2012	Petitioners' August 27, 2025 Motion to Stay in Case No. 1:24-cv-01326-ADA
2013	September 16, 2025 Order Denying Petitioners' Motion to Stay in Case No. 1:24-cv-01326-ADA
2014	U.S. Patent No. 5,977,876 ("Coleman")
2015	September 23, 2025 Email from Petitioners' Counsel

I. INTRODUCTION

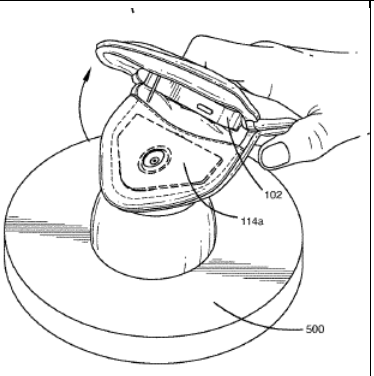
Pursuant to the Patent Office's March 26, 2025 "Interim Processes for PTAB Workload Management," Yondr ("PO") respectfully requests that the Board exercise its discretion to deny this Petition under 35 U.S.C. §324(a). Patent Office policy and precedent counsel against wasteful, duplicative litigation. Yet that is precisely what Petitioners request. The Petition raises the exact same arguments that the same Petitioners raise in a parallel district court litigation, where trial is expected to occur many months before the deadline for a final written decision.

That case has reached an advanced stage. The district court has either already resolved, or will soon address, several of the Petition's patentability arguments. Claim Construction is already complete, discovery is proceeding, and Defendants have already indicated they will move for summary judgment of invalidity on October 10, 2025.

Discretionary denial is particularly appropriate in this instance because the Director already denied institution of a petition for a related patent in the same litigation, involving similar or identical prior art combinations. And Defendants delayed filing this PGR to the last day available under the statute. Instituting this Petition would only create the opportunity for inconsistent fact-finding long after resolution of the district court proceeding. Accordingly, the *Fintiv* factors, and additional considerations, strongly favor denial.

II. THE PARALLEL DISTRICT COURT LITIGATION

On October 31, 2024, PO sued Petitioners for infringing two of PO's patents—U.S. Patent Nos. 9,819,788 ("the '788 Patent") and 12,133,078 ("the '078 Patent"). EX2001. These patents cover systems and devices for limiting the use of cell phones, particularly at communal events, to create phone-free spaces. Shown below are '078 Patent Figure 6, PO's patent-practicing product, and Petitioners' accused product, which by any observation copies Yondr's patented product.

'078 Patent (EX1001) FIG. 6	PO's Patent-Practicing Product (EX2001 at 8)	Petitioners' Accused Product (EX2001 at 14)
 FIG. 6		

On December 13, 2024, Petitioners filed an Answer and Counterclaims. EX2002. Petitioners asserted, among other things, invalidity under 35 U.S.C. §§ 101, 102, 103, and 112 (indefiniteness). EX2002 at 20-21; 28-29. On January 17, 2025, PO filed a Motion to Dismiss Petitioners' Counterclaims. EX2003. On January 31, 2025, Petitioners filed a First Amended Counterclaim. EX2004.

Petitioners' First Amended Counterclaim again asserted that the '078 Patent is invalid under 35 U.S.C. §§ 101, 102, 103, and 112. *Id.* at 8-9.

On March 25, 2025, the district court case was reassigned to Judge Alan Albright. EX2005. The parties were instructed to comply with Judge Albright's Standing Order Governing Proceedings of Patent Cases ("Judge Albright's OGP," EX2006). Petitioners served Invalidity Contentions in the litigation many months ago, on April 14, 2025. The Invalidity Contentions relied on Samuel, Shin, Simpson, and Theobald—the same references that Petitioners rely on in this PGR Petition. EX2007 at 7. Petitioners raised substantially the same obviousness arguments for both the '078 Patent at issue in the Petition, and the related '788 patent. *Id.* at 11-14. Petitioners' contentions also incorporated arguments from the later-filed PGR. *Id.* at 14.

The Court entered a Scheduling Order on August 7, 2025. EX2008. The Scheduling Order set Trial to start on September 21, 2026. Pursuant to the Court's Standing Order, "After the trial date is set, the Court will not move the trial date except in extreme situations." EX2006 at 9. Consistent with this rapidly-approaching trial date, the parties completed claim construction briefing, the Court held a *Markman* hearing on September 22, 2025, the parties exchanged initial disclosures, and the Parties immediately initiated fact discovery. EX2008; EX2015.

Petitioners' claim construction briefing in the district court litigation raised patentability and indefiniteness, pursuant to section 101 and 112, respectively. EX1014 at 17-20; EX1016 at 9-10. The Court issued its claim construction order on September 24, 2025, adopted its preliminary constructions, and rejected Petitioner's indefiniteness arguments. EX2010. Petitioners now indicate they will file a summary judgment motion to address the section 101 issues, with briefing due to be completed months before the PGR institution date. EX2011.

After filing this Petition, Petitioners moved the district court for a stay. EX2012. On September 16, 2025, the Court denied Petitioners' motion to stay the litigation. EX2013. Petitioners again asked for a stay to file their summary judgment on Section 101, which was also denied by the District Court. EX2009, 30:20-31:22. Accordingly, the litigation will continue according to the Scheduling Order, with Fact Discovery complete by April 2026, Expert Discovery complete by June 2026, the Final Pretrial Conference scheduled for August 31, 2026, and the Trial scheduled to start on September 21, 2026. EX2008.

Petitioners filed the present PGR Petition on July 29, 2025, the last possible day before the 9 month statutory deadline. 35 U.S.C. § 321(c). On August 12, 2025, the Patent Office accorded the Petition a filing date. A decision on whether to institute is thus expected by February 12, 2026. If instituted, a final written decision

would be expected by February 12, 2027, approximately ***five months after the district court trial*** addressing the same issues raised by the Petition.

III. INSTITUTION SHOULD BE DENIED

A. *Fintiv* Factor 1: The Parallel District Court Litigation Will Not Be Stayed

Where the parallel district court litigation is unlikely to be stayed, this factor favors denial. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6-9 (PTAB Mar. 20, 2020). Here, Petitioners moved the district court to stay the litigation on August 27, 2025, based on, among other things, its pending PGR petition involving the '078 Patent. EX2012. On September 16, 2025, the Court denied Petitioners' motion. EX2013. Accordingly, the case is not stayed and will continue to trial.

Moreover, if Petitioners were to move again for a stay, Judge Albright routinely denies such motions to stay after institution when doing so would not obviate the need for jury trial. For example, in *Sonrai Memory Limited v. Micron Tech., Inc.*, No. 1:23-cv-01407-ADA, 2024 WL 5185357 (W.D. Tex. May 29, 2024), Judge Albright denied the Petitioners' motion to stay pending *inter partes* review where trial was scheduled to occur two months before a final written decision. Judge Albright explained that the district court "[a]ction is slated to resolve all the patent disputes separating the parties—either at the summary judgment stage or trial—before the PTAB adjudicates only invalidity based only on prior-art publications." *Id.* at *2. He thus found there is "little sense in putting off trial in favor of a lagging,

limited adjudication that may not ultimately obviate the need for a jury trial." *Id.* Likewise, in another case, Judge Albright denied a motion to stay because "[p]ushing back trial for a limited [PTAB] proceeding (that may not eliminate the need for a jury trial) makes little sense." *Intell. Ventures I LLC v. Hewlett Packard Enter. Co.*, No. 6:21-CV-00596-ADA, 2022 WL 22870184, at *2 (W.D. Tex. Dec. 22, 2022).

In this case, there is even less "sense in putting off trial" than in *Sonrai* or *Intellectual Ventures* because a post-grant review decision would occur five months after trial and ***undisputedly*** would not obviate the need for a jury trial. In the district court litigation, PO asserts infringement of the '788 Patent (Count 1) and infringement of the '078 Patent (Count 2), along with trademark infringement under 15 U.S.C. §1114 (Count 3), unfair competition under 15 U.S.C. §1125 (Count 4), trademark infringement under Texas common law (Count 5), trade libel under Texas common law (Count 6), and unfair competition under Texas common law (Count 7). Thus, the litigation will proceed on myriad remaining issues, including infringement and validity of the related '788 Patent.

Because the Court has already denied a stay, the Court's practice of continuing litigation when the trial is scheduled before the Board's anticipated decision, and the wide range of issues involved in the litigation, a stay of the district court litigation is highly unlikely for the '078 Patent, even if the PGR was instituted. Thus, Factor 1 favors discretionary denial of the Petition.

B. *Fintiv* Factor 2: The District Court Trial Will Occur Before A Final Written Decision

"If the court's trial date is earlier than the projected statutory deadline [for a final written decision], the Board generally has weighed this fact in favor of exercising authority to deny institution[.]" *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 9 (PTAB Mar. 20, 2020). As explained above, trial in this case is scheduled for September 2026. EX2008. Because the trial is expected to occur **five months** before the February 2027 statutory deadline for a final written decision, this factor favors denial. *See Immersion Sys. LLC v. Midas Green Techs., LLC*, IPR2021-01176, Paper 16 at 12-13 (PTAB Jan. 6, 2022) ("a jury trial … scheduled to occur in the related district court litigation approximately three months prior to when a final written decision would be statutorily due" in the IPR weighs in favor of exercising discretion to deny). Under the Court's standing order, "After the trial date is set, the Court will not move the trial date except in extreme situations." EX2006 at 9. Petitioners identify no such "extreme situations" in this case that would justify moving the already-scheduled trial date, nor is the case particularly complicated in view of Petitioners' clear copying.

C. Fintiv Factor 3: The Parties Have Substantially Invested In The District Court Litigation

"[M]ore work completed by the parties and court in the parallel proceeding tends to support" a finding that "instituting would lead to duplicative costs." *Apple*

Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 10 (PTAB Mar. 20, 2020). Here, this factor favors denial.

As described above, PO filed its Complaint, Petitioners filed an Answer and Counterclaims, PO filed a Motion to Dismiss Petitioners' Counterclaims, and Petitioners filed a First Amended Answer and Counterclaims. EX2003. After the pleading stage, PO and Petitioners exchanged contentions. Petitioners served invalidity contentions, which included 35 different claim charts corresponding to 18 different references. EX2007.

The parties have finished claim construction. The claim construction briefing extended from May 12, 2025, when the parties exchanged proposed claim constructions, until PO's July 25 sur-reply claim construction brief. Ex. 2003.

On September 22, 2025 the Court held the *Markman* hearing, requiring further investment by the parties and the Court. The Court issued its *Markman* order on September 24, 2025 and rejected Petitioners' indefiniteness arguments. EX2010. Petitioners indicated to the Court that they will move for summary judgment on patent eligibility, with briefing completed in the next month. EX2011 (September 29, 2025 Email from Petitioners' Counsel to District Court). Thus, before institution the Court will have already addressed the indefiniteness and patent eligibility arguments raised by the Petition. As described above, Petitioners also filed a motion for a stay, which PO opposed and the Court denied. EX2013.

Moreover, the parties will incur substantial additional costs even before the institution decision date for the Petition. As set out in the Scheduling Order, fact discovery is now open, and the parties must serve Final Infringement and Invalidity Contentions on November 14, 2025. EX2008 at 4. Petitioners served written discovery immediately upon the opening of fact discovery that will require responses months before any institution decision. EX2015. Thus, the parties have additional deadlines that require a substantial investment of time to complete, even before the institution decision date. And the parties will substantially invest in litigating other causes of action irrespective of the review of the '078 Patent that Petitioners seek.

Because the parties have substantially invested in the district court litigation—including through multiple pleadings, infringement and invalidity contentions, extensive claim construction briefing, a *Markman* hearing and order, a summary judgment motion, and fact discovery—this factor favors denial.

D. Fintiv Factor 4: The Issues Raised In The Petition Overlap With The District Court Issues

"[I]f the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial." *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 12 (PTAB Mar. 20, 2020). In this case, the Petition raises exactly the same claims, grounds, arguments, and evidence as presented in the parallel proceeding. The Petition asserts the following grounds.

- Ground 1: Claims 1, 3, 9 are Unpatentable under 35 U.S.C. §102 in view of Samuel
- 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
- 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
- Ground 4: Claim 5 is Unpatentable under 35 U.S.C. § 103 by Samuel in View of Shin and Theobald
- Ground 5: The Challenged Claims Are Invalid for Indefiniteness under 35 U.S.C. § 112
- Ground 6: The Challenged Claims Are Invalid for Lack of Patent-Eligible Subject Matter under 35 U.S.C. § 101

Petition at 11-12. Petitioners raise those same arguments in the parallel district court litigation. Petitioners' invalidity contentions at the district court contain substantively the same arguments for invalidity under § 101 as their PGR petition. *Compare* EX2007 at 23-24 *with* Petition at 81-88. The same is true for their § 112 arguments. *Compare* EX2007 at 22-23 *with* Petition at 79-81. Moreover, Petitioners' invalidity contentions rely on Samuel, Shin, Simpson, and Theobald—with Samuel, Shin, and Simpson listed as the first three references. EX2007 at 7. Petitioners' invalidity contentions refer to Samuel as an "anticipatory prior art

reference" that "alone or in combination with other prior art [including Shin and Simpson] renders the Asserted Claims invalid as obvious." *Id.* at 8-12.

Accordingly, the Petition raises entirely duplicative issues to those raised in the parallel district court proceeding. This factor weighs even more heavily in favor of denial because Petitioners have raised substantially the same invalidity arguments, and combination of references, for the other patent involved in the district court litigation—the '788 Patent. The Director already denied institution of a petition for review of the '788 Patent. *Be Smarter, LLC v. Yondr, Inc.*, IPR2025-00970, Paper 14 (PTAB Sept. 26, 2025). The overlap in Petitioners' validity positions between the '788 Patent and the '078 Patent at the district court ensures that, if the Petition were instituted, there would be duplicative and wasteful litigation involving analogous issues with the clear potential for inconsistent factual findings between the different venues.

Indeed, before the institution decision in this Petition, the Petitioners will have ***already*** substantially litigated their § 101 and § 112 positions before the district court. The Court addressed, and rejected, the indefiniteness argument during *Markman*. EX2010. Petitioners will have moved for summary judgment on patent eligibility, and briefing on that issue will be finished months before any institution decision, and a Court decision will likely follow soon thereafter. EX2011. Opening these issues up for review before the Board after the district court already resolved

the dispute would accordingly complicate, rather than simplify, proceedings. Petitioners could have filed an IPR, rather than a PGR, against the '078 Patent, thereby not opening the door to litigating duplicative § 101 and § 112 issues before the district court and the PTAB. Instead, they waited until the ***last day possible*** to file their PGR petition—with the § 101 and § 112 positions it had already raised at the district court.

Because there has been, and will continue to be, substantial overlap between the issues presented in the Petition and at the district court, this factor favors denial.

E. Fintiv Factor 5: Petitioners Are The Defendants In The District Court Litigation

If a petitioner is unrelated to a defendant in a parallel proceeding, the Board may weigh this fact against exercising discretion to deny institution. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 9 (PTAB Mar. 20, 2020). Here, however, Petitioners Be Smarter, LLC and James Guerra are the named defendants in the district court litigation. EX2001. This factor thus favors denial.

F. Fintiv Factor 6: Other Circumstances Favor Denial

1. The Director Already Denied Institution Of A Petition For The Related '788 Patent

As discussed above, PO asserts two patents against Petitioners in the parallel district court proceeding—the '078 Patent (challenged here) and the related '788 Patent (challenged in an earlier IPR Petition). On September 26, 2025, the Director

discretionarily denied Petitioners' '788 IPR Petition. *Be Smarter, LLC v. Yondr, Inc.*, IPR2025-00970, Paper 14 (PTAB Sept. 26, 2025). The Director found that, even at that earlier date, the parties "have made meaningful investments in the district court proceeding" because "the parties have exchanged infringement and invalidity contentions, and a *Markman* hearing is scheduled to occur before the due date for an institution decision." *Id.* at 2.

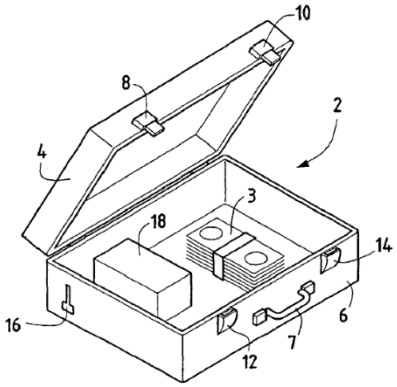
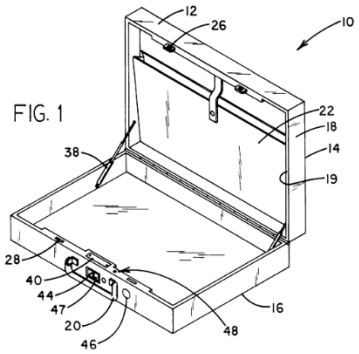
Since then, the Court held the Markman hearing on September 22, 2025, with a resulting order. EX2010. Fact discovery opened on September 23, 2025. EX2008 (Scheduling Order). Both parties have already served discovery requests and are investing in responding to such requests. EX2015. The parties will also serve final infringement and invalidity contentions before the deadline for an institution decision. EX2008. And the parties will invest in Petitioners' expected motion for summary judgment, with all briefing to be completed by October 31, 2025. EX2011. Accordingly, the parties' investment in the district court proceeding applies with even greater force here than in the denial of the '788 IPR.

2. Petitioners' Art Is Cumulative Of The Art Before The Examiner

The art Petitioners assert in this Petition is cumulative of, and in fact ***less relevant*** than, the art already considered by the Examiner. Such issues are sometimes addressed under § 325(d). *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7–9 (PTAB Feb. 13,

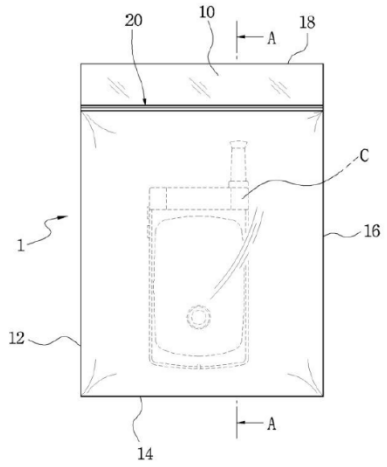
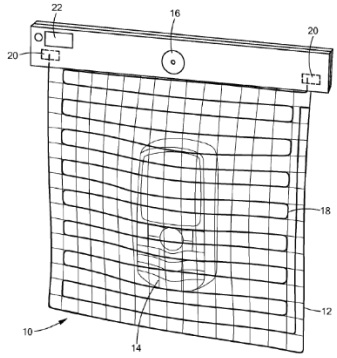
2020). But even outside of the § 325(d) framework, rehashing similar arguments already considered by the Examiner would be a waste of Office resources and unfair to the Patent Owner.

For example, Petitioners rely on "Samuel" for all asserted grounds. Petition at 26-27. Samuel discusses a "case" wherein "non-deformable materials can be used for the walls" (e.g., a briefcase). EX1003 at ¶¶0083-0092. But Samuel is, at best, cumulative of art that the Examiner already considered, as illustrated in the figure below comparing Samuel to U.S. Patent No. 5,977,876 ("Coleman"). Indeed, "Samuel," which is directed to cases that are intended to replace armored cars and guards, EX1003, Abstract, [0001]-[0008], never mentions mobile electronic devices, and is not even relevant to the '078 Patent's invention of a case that limits a user's access to their own mobile electronic device.

"Samuel" (EX1003) FIG. 1 (relied upon by Petitioners)	**"Coleman" (EX2014) FIG. 1 (considered by Examiner)**
	

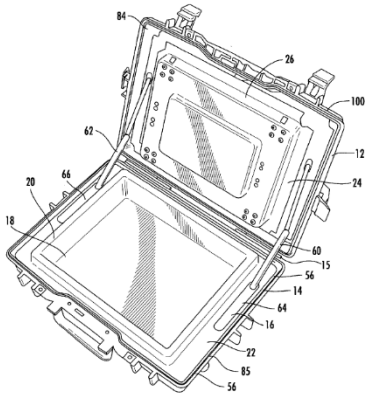
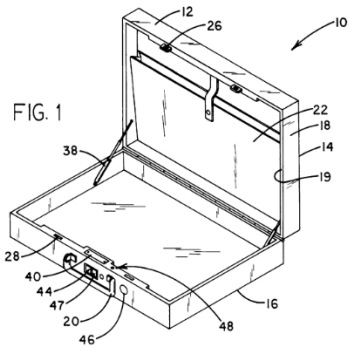
Petitioners also rely on "Shin" (EX1004)—which Petitioners describe as a "mobile phone storage envelope"—as a secondary reference. Petition at 35-38.

Again, however, Shin is, at best, cumulative of the art already considered by the Examiner, as illustrated in the figure below comparing Shin to U.S. Patent Publication No. 2012/0187003 ("Stewart"). Shin is even less relevant than Stewart because Shin's "envelope" is a modified thin plastic food storage bag (e.g., a Ziploc bag) that has no lock, and allows a user to open the bag at any time by merely pulling. EX1004 at 5–8. This is in direct contrast to the '078 Patent's invention of a case that locks to prevent a user from accessing their own mobile electronic device until a predetermined condition is met.

"Shin" (EX1004) FIG. 1 (relied upon by Petitioners)	**"Stewart" (EX1008) FIG. 1 (considered by Examiner)**
	

Petitioners further rely on "Simpson" (EX1005)—which Petitioners describe as a "security case"—as a secondary reference. Petition at 63-66. But Simpson is, again, cumulative of the already-considered reference, Coleman, as illustrated in the figure below. Indeed, Simpson, which like Stewart is directed to cases that are intended to replace armored cars and guards and also never mentions mobile

electronic devices, EX1005 at [0003], is not even relevant to the '078 Patent's invention of a case that limits a user's access to their own mobile electronic device.

"Simpson" (EX1005) FIG. 2 (relied upon by Petitioners)	**"Coleman" (EX2014) FIG. 1 (considered by Examiner)**
	

Petitioners do not explain why their proposed art is more relevant than the art already considered by the Patent Office, nor provide any indication why the Patent Office's original judgment to issue the patent was in error.

Petitioners' conclusory assertion that "[t]he Examiner's allowance of the '847 Application claims over Stewart in combination with the other references was in error" (Petition at 21) fails to establish any actual error in the Examiner's analysis. Indeed, Petitioners failed to identify any instance where the Examiner allegedly misapprehended or overlooked specific teachings of the relevant prior art or otherwise erred in examining the '078 Patent. Instead, Petitioners simply assert that the Examiner ruled inconsistently in his examination of the ***'788 Patent***—not the '078 Patent—and that "the Examiner appears to have repeated this mistake to allow

similar claims to those at issue during prosecution of the ’788 patent.” Petition at 21. Neither Petitioners nor their expert, however, explain how the Examiner made the same alleged mistake in examining the ’078 Patent. The Petition accordingly asks the Office to reconsider the Examiner’s analysis without identifying any error.

3. Petitioners’ Invalidity Arguments Are Particularly Weak

The USPTO has further announced that the Board may weigh “the strength of the unpatentability challenge” in determining whether to grant a motion for discretionary denial. *See Interim Processes for PTAB Workload Management*, USPTO (Mar. 26, 2025). Because Petitioners present art that is, as described above, cumulative of and less relevant than the art the Examiner considered when allowing the challenged claims of the ’078 Patent, Petitioners’ arguments under § 102 and § 103 are unlikely to prevail.

Moreover, Petitioners’ arguments regarding § 101 and § 112 are particularly weak. For § 101, the ’078 Patent recites claims that set out structural requirements of a ***physical*** pouch, such as an appropriately configured lock, case, shell, panels, edges, and cavity. *See, e.g.*, EX1001 Patent, claims 1, 9, 15, Figs. 1-6. Such claims are the antithesis of the type of computer-implemented processes held abstract under § 101. *Cf. Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 218 (2014) (computer-implemented intermediated settlement, *e.g.*, escrow). The ’078 Patent

claims are not directed to an abstract idea, and fall directly within the scope of patentable subject matter.

For § 112, the District Court has already rejected the indefiniteness argument presented in the PGR. EX2010. The Court's holding is consistent with the specification, which provides guidance on the meaning of the terms "associated with" a "geographic/geographical region." *See, e.g.*, EX1001, 6:57-7:4; 2:66-3:5, 2:65-3:22, 6:35-47, 7:5-36. Petitioners do not identify any genuine ambiguity in the claims, nor do they address the specification's many examples. "[S]pecific and unequivocal examples," such as the ones provided in the specification, can "provide a skilled artisan with clear notice of what is claimed." *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1261 (Fed. Cir. 2014); *see also BASF Corp. v. Johnson Matthey Inc.*, 875 F.3d 1360, 1367-68 (Fed. Cir. 2017) (reversing indefiniteness because a "skilled artisan would be informed by the specification's numerous examples").

Accordingly, the Petition—in addition to relying on largely irrelevant prior art that is, at best, no more than cumulative of what was before the Examiner—also presents arguments under § 101 and § 112 that are baseless.

IV. CONCLUSION

PO respectfully requests that the Patent Office exercise its discretion to deny institution of post grant review of the '078 Patent.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: October 8, 2025

/ Rhett Ramsey /
Rhett D. Ramsey (Reg. No. 78,415)
Customer No. 64,735

Attorney for Patent Owner
Yondr, Inc.

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. §§ 42.24(d), the undersigned certifies that this **PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION** contains 3875 words after excluding the parts exempted according to the word count feature of Microsoft Word.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: October 8, 2025

/ Rhett Ramsey /
Rhett D. Ramsey (Reg. No. 78,415)
Customer No. 64,735

Attorney for Patent Owner
Yondr, Inc.

CERTIFICATE OF SERVICE

I hereby certify that, pursuant to 37 C.F.R. § 42.6(e) and with the agreement of counsel for Petitioner, a true and correct copy of **PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION** is being served electronically on October 8, 2025, to the e-mail addresses shown below:

Leisa Talbert Peschel JACKSON WALKER LLP 1401 McKinney, Suite 1900 Houston, TX 77010 Phone: 713-752-4278 Fax: 713-308-4178 Email: lpeschel@jw.com Email: lpeschelipdocket@jw.com	Arthur Gollwitzer III (*Pro Hac Vice*) JACKSON WALKER LLP 100 Congress Ave. Suite 1100 Austin, TX 78701 Phone: 512-236-2268 Fax: 713-308-4178 Email: agollwitzer@jw.com
Raman N. Dewan JACKSON WALKER LLP 100 Congress Ave. Suite 1100 Austin, TX 78701 Phone: 512-236- 2013 Fax: 713-308-4178 Email: rdewanipdocket@jw.com Email: rdewan@jw.com	

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: October 8, 2025

/ Rhett Ramsey /
Rhett D. Ramsey (Reg. No. 78,415)
Customer No. 64,735

Attorney for Patent Owner
Yondr, Inc.