

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. PGR2025-00070
US Patent No. 12,133,078 B2

PATENT OWNER'S PRELIMINARY RESPONSE

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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

EXHIBIT	DESCRIPTION
2014	U.S. Patent No. 5,977,876 (“Coleman”)
2015	September 23, 2025 Email from Petitioners’ Counsel
2016	Yondr’s Sur-Reply Claim Construction Brief in Case No. 1:24-cv-01326-ADA
2017	Petitioners’ Petition for Inter Partes Review of U.S. Patent No. 9,819,788 in Case No. IPR2025-00970
2018	Declaration of Dr. Gregory D. Buckner in Support of Petitioners’ Petition for Inter Partes Review of U.S. Patent No. 9,819,788 in Case No. IPR2025-00970
2019	Excerpts from Merriam-Webster’s Collegiate Dictionary, Tenth Edition
2020	Screen capture of Yondr webpage (https://www.veryondr.com/phone-locking-pouch)
2021	Screen capture of CellockED webpage (https://cellocked.newschoolhero.org/about/)
2022	LinkedIn post from Petitioner James Guerra
2023	Screen capture of Yondr webpage (https://www.veryondr.com/id-pouch)
2024	Time Magazine’s Best Inventions of 2024 (https://time.com/collection/best-inventions-2024/), “A Way To Disconnect <i>Yondr Pouch</i> ”
2025	Washington Post – “How a Connecticut middle school won the battle against cellphones” (2024)
2026	Houston Chronicle – “Cell phones hinder classroom learning. Texas should tell school districts to lock them up Editorial” (2025)

EXHIBIT	DESCRIPTION
2027	Atlanta Journal-Constitution – “Better behaved, more engaged: School cellphone bans seem successful so far” (2025)
2028	Forbes – “Meet Yondr, The Startup Helping Schools Ban Cell Phones” (2024)
2029	Declaration of David Smith in Support of Yondr’s Responsive Claim Construction Brief in Case No. 1:24-cv-01326-ADA

Pursuant to 35 U.S.C. §323, 37 C.F.R. §42.207 and the Notice of Filing Date Accorded to Petition, dated August 12, 2025 (Paper 3), Patent Owner Yondr, Inc. (“Yondr”) submits this Preliminary Response to the Petition filed by Be Smarter, LLC and James Guerra (“Petitioners”) regarding U.S. Patent No. 12,133,078 (the “’078 Patent”).

I. INTRODUCTION

Over a decade ago, Graham Dugoni, the inventor of the Asserted Patents, realized the pernicious impact of technology on modern life. Personal devices like cell phones engaged their users while shutting users off from the world around them. EX1001, 1:43-49. Instead of paying attention to a conversation or a speaker, users checked their phones for texts, voicemails, or other virtual communications. *Id.*, 1:49-56. Dugoni understood that unrestricted access to mobile devices destroyed communal activities by negatively impacting both other participants, *e.g.*, the audience, and the presenter or performer.

What we now recognize as the highly addictive link between a user and a cell phone frustrated previous attempts at a solution. *Id.*, 1:63-2:27. For example, one approach prevented the user from turning on the cell phone or limited its functionality when inside a car. *Id.*, 1:63-2:8. That approach, however, failed because it did not control the temptation of the user to attempt to use the device. *Id.*

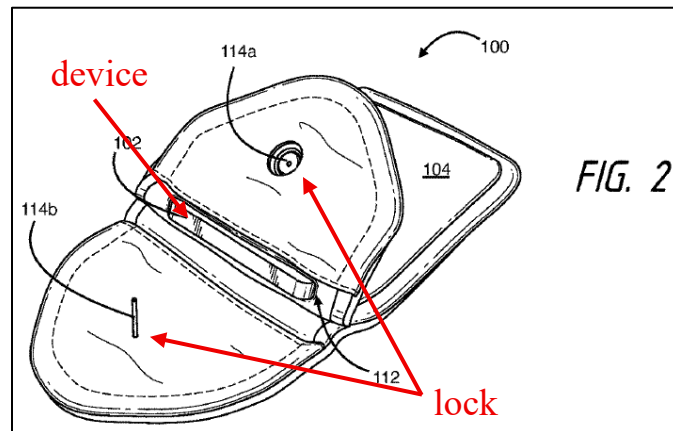
Another approach posted signs asking users not to use cell phones in particular areas or at particular times. *Id.*, 2:9-14. These signs were routinely ignored. *Id.* And requiring users to give cell phones to the venue or leave them at home were unsuccessful and resisted because of users' desire to maintain physical control of their cell phones. *Id.*, 2:14-21.

Dugoni recognized that a different approach was needed to reverse modern technology's intrusion and create distraction-free experiences. Dugoni invented a way for users to keep their mobile devices with them, while enabling venues to limit users' access. The result was the Yondr Pouch, a device-sized case that locked the user's device inside. The user could keep the case, but the venue could choose conditions for unlocking the case and restoring access. Dugoni protected his inventions, in part, with the '078 Patent.

II. BACKGROUND

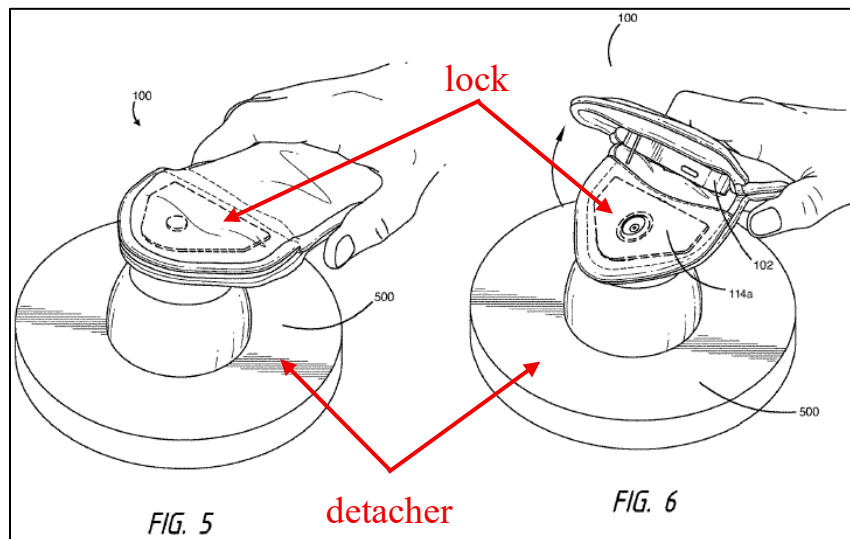
A. The '078 Patent

The '078 Patent discloses a case for a user's mobile device that renders the device inaccessible to the user while the device is in the case. As shown in the figure below, the case includes a lock configured to lock the case once the phone is placed inside.



EX1001, Fig. 2, 6:15-20. The illustrated lock includes opposing plates with one of a securably mateable female and male member. *Id.*, Figs. 1-6, 6:21-29. The lock is configured so that access to the device can be restored after meeting a predetermined condition, for example the user brings the case outside of a venue. *Id.*, 2:51-55, 6:57-7:4; 7:5-51, cls. 1, 3, 9, 15.

Figures 5 and 6 (annotated below) illustrate unlocking using a detacher.



Id., Figs. 5, 6, 6:48-7:4. The detacher can be positioned in a specific location, such as outside of a concert hall, and the user must therefore leave the concert hall and locate a detacher to regain access to their device. *Id.*

B. The Level Of Ordinary Skill In The Art

The '078 Patent involves a primarily mechanical device, specifically “locking cases.” EX1001, 1:33-39. The specification focuses on that case design. *Id.*, 5:58-8:3, Figs. 1-6. *See DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1362-63 (Fed. Cir. 2006) (considering patent’s purpose). Given the patent’s focus on “locking cases,” Petitioners’ definition of a POSA is incorrect. Instead, a POSA would have an undergraduate degree in mechanical engineering, industrial design, or a related field. But the Board need not resolve this issue because the Petition should be denied under either definition.

C. The Petition’s Art

The Petition relies on three references: Samuel (EX1003), Shin (EX1004), and Simpson (EX1005). Pet., 11-12.¹ These references are unlike the '078 Patent.

Samuel is directed to “secure transportation” of valuable objects, such as cash or diamonds, that are transported using “[a]rmored vehicles,” with “physical

¹ Petitioners cite Theobald (EX1006) only for dependent claim 5. Pet., 11.

protection for the personnel concerned.” EX1003, [0001]-[0008]. Samuel attempts to provide an alternative transportation method to armored vehicles while still maintaining security in transit. *Id.* Thus, Samuel’s “invention advantageously replaces” transportation “using strongboxes which must be transported by security guards, who are usually armed.” *Id.*, [0024]. Samuel’s invention may include a way “for destroying” the contents if there is tampering. *Id.*, [0050].

Shin is directed to a “disposable mobile phone storage envelope.” EX1004, 1. Shin uses a modified Ziploc-style “food storage” bag. EX1004, 5. Shin’s “envelope” is a thin plastic bag (microns thick) with a thinner metal coating. EX1004, 6. The bag is closed with a “plastic zipper” made from a male and female “profile strip.” EX1004, 7, 8. The bag, like a Ziploc bag, can be opened at will by “pull[ing] laterally,” which separates the strips. EX1004, 8. The user can block incoming calls by putting their phone inside the bag. EX1004, 5. Shin’s invention thus “allows voluntary participation” by the user. *Id.* The user, or anyone else, can open the bag and access the phone merely by pulling the zipper. EX1004, 8.

Simpson, like Samuel, is related to “secure transportation of valuable objects.” EX1005, [0002]. Simpson provides an alternative to “armed and secure vehicles” to transport “valuable materials such as jewelry” or “intelligence files.” EX1005, [0003]. The “invention involves...a security case for storing and

transporting an item in a secure manner.” EX1005, [0007]. The case “is constructed of materials which are resistant to penetration by means such as drilling, impact, ballistic, thermal, etc.” EX1005, [0035]. The case can “self destruct” upon tampering. EX1005, [0057].

III. CLAIM CONSTRUCTION

All terms should be afforded their plain and ordinary meaning. Petitioners previously raised their proposed constructions to the district court, and the district court rejected each of Petitioners’ positions. EX2010, at 2-3. Petitioners nevertheless attempt to incorporate by reference many of the claim construction arguments they asserted at the district court. Pet., 23 (citing EX1014; EX1016); 25 (citing EX1014; EX1016).² Such incorporation by reference is a plain violation of Board rules. 37 C.F.R. § 42.6(a)(3); *see also Apple Inc. v. Qualcomm Inc.*, IPR2018-01279, Paper No. 45, at 18 (PTAB Jan. 2, 2020) (“Incorporation by reference amounts to a self-help increase in the length of the brief and is a pointless imposition on the court’s time.”) (cleaned up).

² For reference, Yondr identifies the counterarguments successfully made at the district court: EX1015, at 8-20; EX2016, at 5-10.

Regardless, in the parallel district court litigation the Court already considered Petitioners' arguments, held a *Markman* hearing, and issued a claim construction order. EX2010. The Court rejected constructions analogous to those advanced by Petitioners here. *Id.* Because the Court correctly construed the claims, the Board should likewise afford the terms their plain and ordinary meaning without further construction. 37 C.F.R. § 42.200(b). Yondr responds briefly to Petitioners' proposed constructions.

A. “Configured To Unlock To Enable Access To The Mobile Device Based On/In Accordance With A Predetermined Condition”

The '078 Patent claims require a lock with a particular configuration, that at least partially prevents access to a mobile device inside the cavity. '078 Patent, cl. 1; *see also id.*, cls. 9, 15. The claims further require the lock be configured so that it can unlock “to enable access to the mobile device based on a predetermined condition....” *Id.*, cls.1, 9, *see also* cl. 15. The specification uses the same type of language to describe the invention as the claims and provides examples. The specification explains that the lock on a case is “configured to disengage to provide the user with access” to the device “under certain circumstances.” *Id.*, 2:60-64; *see also id.*, 3:7-22 (discussing example configurations).

One example of a lock configured to unlock to enable access to a mobile device based on a predetermined condition involves a detacher placed at a specific

location within the venue, *e.g.*, outside of the “viewing area or even at venue exit ways.” *Id.*, 6:64-7:4. The lock is thus configured “to become unsecured and further exposes the mobile electronic device ... within the case” after the predetermined condition of the user going to that location and touching the case to the detacher. *Id.*, 6:61-7:4; *see also id.*, Figs. 1-6. Another example involves a signal that covers part of the venue; when the user meets the predetermined condition of exiting the geographic region, the lock becomes unsecured and access to the device is restored. *Id.*, 7:23-36; *see also id.*, 7:5-16, Fig. 7. These examples, and the disclosure overall, confirm “configured to unlock” needs no further construction.

Petitioners’ proposed construction rewrites the claims and introduces a new requirement: a lock further “programmed to unlock.” Pet., 23. But no intrinsic evidence suggests a clear and unmistakable intent to restrict the claims to just a “programmed” lock. *Thorner v. Sony Comput. Ent. Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012); *Hill-Rom Servs., Inc. v. Stryker Corp.*, 755 F.3d 1367, 1372-73 (Fed. Cir. 2014). Instead, dependent claims 7, 13, and 18 introduce the limitations Petitioners suggest are present in the independent claims. *See* ’078 Patent cls. 6-7, 12-13, 17-18 (requiring wireless signal or RFID). Claim differentiation strongly supports construing the independent claims as broader than Petitioners’ proposed

programmed wireless or RFID locks. *InterDigital Commc'ns, LLC v. Int'l Trade Comm'n*, 690 F.3d 1318, 1324-25 (Fed. Cir. 2012).

Petitioners argue the claims “contemplate that the lock is configured to unlock based on external triggers or signals, such as geographic area or timing.” Pet., 23 (citing EX1001, cls. 1, 6-8, 10, 12-13, 15, 17-19). The claims do not mention “external triggers or signals.” Petitioners further cite the specification’s examples involving automatic unlocking. Pet., 23. But the claims’ plain language is broader than this select embodiment and limiting the claims further is improper. *See Cont’l Circuits LLC v. Intel Corp.*, 915 F.3d 788, 797 (Fed. Cir. 2019) (claims not limited “[e]ven when the specification describes only a single embodiment”); *Thorner*, 669 F.3d at 1365.

Indeed, the specification provides examples of locks configured to unlock to enable access to a mobile device based on a predetermined condition associated with a geographic region that do not require programing, wireless signals, or automatic action. *See, e.g.*, EX1001, 6:64-7:4. In one example, the user must go to a specific predetermined location, for example the exit, where there is “an EAS detacher” to unlock the case. *Id.* This predetermined condition is based on the user being in a specific geographic area with the unlocker, but includes manual unlocking, for example as illustrated in Figures 5-6. *See id.*, 6:59-63. Petitioners improperly

exclude such embodiments. *Cont'l Cirs. LLC v. Intel Corp.*, 915 F.3d 788, 797 (Fed. Cir. 2019); *Thorner*, 669 F.3d at 1365. Petitioners argue that a claim need not cover all disclosed embodiments. Pet., 24. But the claim terms here plainly do include certain embodiments within their scope, *e.g.*, the embodiments shown in Figures 1-6. Petitioners do not allege lexicography or disclaimer, so the Board should “not read limitations from the embodiments in the specification into the claims.” *Hill-Rom Services, Inc. v. Stryker Corp.*, 755 F.3d 1367, 1372-73 (Fed. Cir. 2014).

Accordingly, the Court should reject Petitioners’ request to limit “configured to” to being “programmed to.” The Court should give “configured to” its ordinary meaning, which is not limited to electronic programming. In line with the Court’s construction, to the extent a construction of “configured to” is needed it should be construed as “designed to” or “made to.” EX2010; *Ex parte Matsumura*, Appeal 2019-004113, 2020 Pat. App. LEXIS 7777, at *6 (PTAB May 13, 2020) (construing “configured to” as “designed such that it is able to perform the particular use, purpose or situation recited” in the claim); *Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.*, 672 F.3d 1335, 1349 (Fed. Cir. 2012).

B. “Predetermined Condition”

The claims reference a “predetermined condition,” a term which has a plain meaning that needs no further construction. The specification uses the term

“predetermined condition” repeatedly and consistent with its plain meaning to describe various different embodiments. EX1001, 2:65-3:22 (collecting examples), 6:35-47, 6:61-7:4, Figs. 1-6, 7:23-36, 7:5-16, Fig. 7. Petitioners’ construction replaces two readily understood words with twenty-two, needlessly complicating what was already clear. This is improper and unnecessary. *See O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1362 (Fed. Cir. 2008) (“courts are not (and should not be) required to construe every limitation.”).

Petitioners argue their construction is “consistent with” solving the problem of “limit[ing] access to and/or disabl[ing] functions of a mobile electronic device.” Pet., 25. But, as claimed and disclosed, it is the combination of limitations and not any single one that provides the benefits of the invention. *See Pause Tech., LLC v. TiVo Inc.*, 419 F.3d 1326, 1331 (Fed. Cir. 2005) (claim construction “demands interpretation of the entire claim in context, not a single element in isolation”). Other limitations already address this functionality, such as “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,” and the like. *See, e.g.*, EX1001, cls. 1, 9, 15. Petitioners’ construction of “predetermined condition” would render such language superfluous, “contrary to the well-established rule that ‘claims are interpreted with an eye toward giving effect to all terms in the claim.’” *Digital-*

Vending Servs. Intern., LLC v. Univ. of Phoenix, Inc., 672 F.3d 1270, 1275 (Fed. Cir. 2012).

Petitioners further argue that the claims were allowed during prosecution “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.” Pet., 25 (citing EX1007, at 161-62). Petitioners’ reliance on the prosecution history is limited to the notice of allowance, which states simply that “the art of record does not disclose the subject matter as presented in the claims, as amended.” EX1007, at 161-62. This bare statement provides no support for Petitioners’ sweeping assertion that the prosecution history is “abundantly clear” that the “predetermined condition” must align with Petitioners’ construction. Pet., 25.

Indeed, despite seeking review of claim 3 of the related ’788 Patent, via their since-denied Petition for IPR, EX2017 at 8-9; IPR2025-00970, Paper No. 14, Petitioners did not seek a claim construction of “predetermined condition” before the Board, *id.* at 19-24. Instead, Petitioners and their expert readily applied the term’s plain and ordinary meaning. EX2017 at 47-49, 54-55, 65-66; EX2018 at 38-54, 76-79, 85-87. The Board should likewise apply the plain and ordinary meaning of “predetermined condition.”

C. “A Predetermined Condition Associated With A Geographic Region”

Petitioners argue the term “a predetermined condition associated with a predetermined geographic region” is indefinite under 35 U.S.C. § 112. As described *infra* Part IX, this term is not indefinite. The district court already considered this issue and agreed that this term is not indefinite and should instead be afforded its plain and ordinary meaning. EX2010. The Board should do the same here.

IV. GROUND 1³: SAMUEL DOES NOT ANTICIPATE THE CHALLENGED CLAIMS

Ground 1 alleges anticipation of claims 1, 3, and 9 based on Samuel. Pet., 27-35. “A claim is anticipated if a single prior art reference discloses all the claimed limitations arranged or combined in the same way as in the claim.” *HTC Corp. v. Cellular Commc'ns Equip., LLC*, 877 F.3d 1361, 1368 (Fed. Cir. 2017). The “reference must disclose every limitation of the claimed invention either expressly

³ The Petition does not use consistent numbering for the Grounds. The Petition initially identifies indefiniteness as Ground 1 (Pet., 11-12), but the argument shifts indefiniteness to Ground 5 (Pet., 79) and renumbers other grounds accordingly. This Preliminary Response follows the numbering of grounds used in the argument section.

or inherently.” *Id.* “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.” *Id.* at 1369 (quoting *In re Oelrich*, 666 F.2d 578, 581 (C.C.P.A. 1981)).

Petitioners cannot establish a reasonable likelihood that it would prevail on Ground 1. Samuel does not mention a mobile device anywhere—let alone describe a case that is sized to accommodate a mobile device or a case that locks a mobile device therein. Indeed, Samuel is a large briefcase structure that is plainly not sized for a mobile device.

A. Claim 1

1. Samuel Does Not Disclose Limitation 1(a)

Limitation 1(a) requires that the case have “a shell defining a cavity sized to accommodate a mobile device, the shell having an opening to receive the mobile device.” The Petition’s conclusory analysis of this limitation states that “cash” is “of similar size to a cellphone.” Pet., 29-30 *see also id.*; 53. The Petition likewise states, without analysis, that “the opening of the shell in the Samuel case has an opening to receive a mobile device.” *Id.* at 30. Petitioners’ cursory arguments fail for at least two reasons.

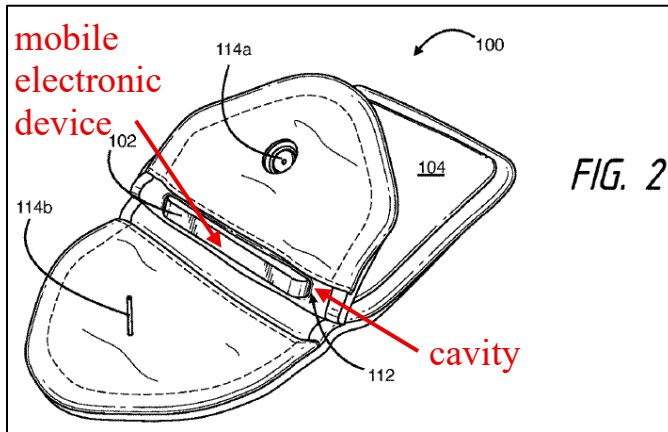
First, Petitioners assert that “the Samuel case includes ‘a shell defining a cavity sized to accommodate’” a mobile device. Pet., 29 (Emphasis omitted). This is incorrect. Samuel does not mention a mobile device and therefore cannot teach that a mobile device that is received into the shell. Samuel’s express disclosures of the contents of the security device are limited to “objects,” “cash,” “banknotes,” “checks,” and “valuable merchandise”—not mobile devices. EX1003, [0001], [0002], [0083], [0084], [0182]. Samuel accordingly does not disclose a mobile device.

Indeed, despite misleadingly asserting that Samuel discusses a mobile device, Petitioners subsequently admit that Samuel does not. Pet., 30. Petitioners argue that Samuel applies to “any object,” and further rely on an illustration of “an object (cash) of similar size to a cellphone.” Pet., 29-30. Petitioners also rely on Samuel allegedly “broadly describing cash, documents, or objects.” Pet., 30. And Petitioners conclude by asserting “it would have been readily apparent that the object transported in Samuel *could* be a mobile electronic device, such as a cellphone.” *Id.* (emphasis added).

Petitioners thus rely on the *possibility* that Samuel *could* be used with a cell phone. *Id.* Petitioners do not even argue that Samuel “necessarily includes” securing a mobile electronic device, just that it “*could* be a mobile electronic device,” since

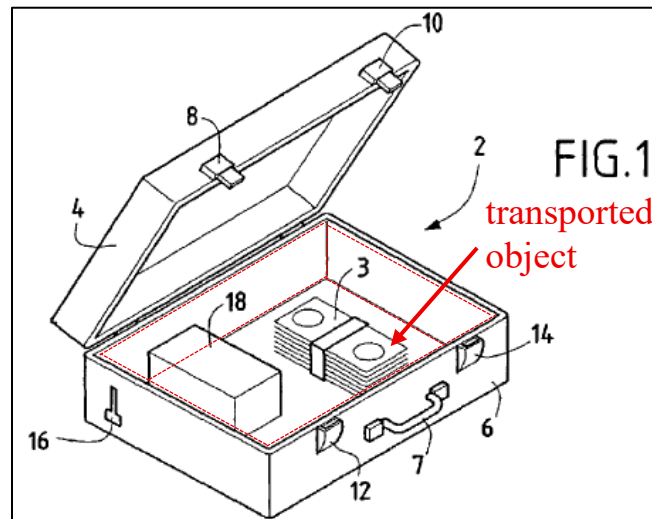
Samuel allegedly discloses objects “of similar size to a cellphone” (*i.e.*, checks and cash). Pet., 29-30 (emphasis added). This is insufficient because inherency “may not be established by probabilities or possibilities.” *HTC*, 877 F.3d at 1369; *see also In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); *In re Montgomery*, 677 F.3d 1375, 1384 (Fed. Cir. 2012) (“Absent inevitability, inherency does not follow...”); *Beckman Coulter, Inc. v. Sirigen II Ltd.*, IPR2022-01207, Paper 66, at 51-56 (PTAB Dec. 21, 2023) (“might have, or even probably have” insufficient); *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1256–57 (Fed. Cir. 1989) (that a reference “could” include the limitation does not make it inherent).

Second, Samuel does not illustrate a “cavity sized to accommodate” a mobile device. Instead, the cavity is much larger than the object inside (money) and includes additional objects, such as the electronic means (18). A cavity “sized to accommodate” the mobile device, however, does not mean merely that a mobile device could be placed inside it. As shown in Figure 2 of the ’078 Patent, a cavity that is “sized to accommodate” a user’s mobile electronic device is approximately the size of the device.



EX1001, Fig. 2. The patent explains that the configuration of “case 100” in Figure 2 is “*sized to accommodate* a mobile electronic device.” *Id.*, 5:58-6:2 (emphasis added). That configuration is also consistent with plain meaning of “sized,” which is: “having a specified size” EX2019, at 5. Thus, a shirt sized to accommodate a child is a shirt approximately the size of a child and not a shirt for an adult, even if the child could also fit (poorly) into that much larger shirt. Likewise, as shown in Figure 2, a case “sized to accommodate a mobile device,” such as a phone, is a case approximately the size of the device, and not some much larger cavity.

A “cavity sized to accommodate a mobile device” is not disclosed by Samuel. Samuel describes a case with, in Petitioners’ words, a “briefcase-type structure[],” Pet. 67, designed for the secure transportation of valuable objects,” as shown in the following figure.



EX1003, Fig. 1; [0084]. Samuel does not disclose the briefcase’s cavity being approximately the size of *any* object—much less those Petitioners claim are “similar” in size to a mobile device.

Samuel’s sole disclosure pertaining to size relates only to the case generally, not the cavity or its contents. EX1003, [0021] (stating generally that “[i]t is possible to use containers of any size”). This disclosure has no bearing on whether the case’s cavity is structured to house a mobile device, nor even suggests sizing the case to its contents. Samuel, in fact, teaches the opposite because the case must include within its alleged “cavity” other objects such as the electronic means 18. *See* EX1003 Fig. 1, [0088]-[0089] (“means 18 disposed inside”). Samuel does not disclose a case “sized to accommodate” a user’s mobile device.

Third, because the cavity in Samuel is not “sized to accommodate” the user’s device, Samuel does not disclose the claimed “shell having an opening to receive the

mobile device.” As shown in Figures 1-4 of the ’078 Patent, the opening of the cavity sized to accommodate the user’s phone is likewise approximately the same dimensions as the phone. EX1001, Figs. 1-4; 5:58–6:2 (opening “sized to receive” device). Because the cavity in Samuel is unrelated to the object inside, the cavity’s opening is likewise non-specific. Accordingly, the Petition also fails to establish that Samuel has a “shell having an opening to receive the mobile device.”

2. Samuel Does Not Disclose Limitation 1(b) Or Limitation 1(c)

Limitation 1(b) requires that a lock “render the mobile device at least partially inaccessible upon the lock being locked with the mobile device within the cavity of the shell.” Limitation 1(c) further requires that the lock be “further configured to unlock to enable access to the mobile device.” As described *supra* Part IV.A.1, however, Samuel does not disclose a mobile device within the case. Samuel therefore discloses neither limitation 1(b) nor limitation 1(c).

B. Claim 3

Claim 1, requires that the lock be “further configured to unlock to enable access to the mobile device based on a predetermined condition associated with a geographic region.” Claim 3, which depends on claim 1, requires that “the geographic region corresponds to a physical position of the case respective to a geographic area of a venue.” Samuel fails to disclose this limitation.

To illustrate, the '078 Patent teaches that, when operating the case at a venue—such as “a concert hall, center, [or] arena,” EX1001, 3:2-3—the lock may lock when the case is located, for example, “within an audience seating area of a venue,” and may unlock when it is “located outside of the audience seating area” of the same venue, *id.*, 3:11-23. Nothing in Samuel teaches anything similar. Indeed, Samuel only teaches unlocking of the case once it arrives at a particular *address*—not a particular location *within* that address. *See* Pet., 33 (“Samuel concerns secure transportation of objects and predefines location of the case at a particular address...as a condition for sending the unlock signal.”) (citing EX1003, [0038], [0058], [0124]-[0125]; Buckner Decl., ¶¶ 180-181). Therefore, even assuming this address in Samuel is a “venue” as taught in the '078 Patent, Samuel does not teach that the case receives a locking signal once it is located within a particular “geographic area” of that address—such as a lobby or audience seating area. Samuel thus does not disclose claim 3.

C. Claim 9

Claim 9 recites “a shell defining a cavity sized to accommodate a mobile device, the shell having an opening to receive the mobile device.” As described *supra* Part IV.A.1, Samuel does not disclose this limitation. Claim 9 further recites “the lock being further configured to lock the shell and render the mobile device at

least partially inaccessible;” as well as the lock’s being “further configured to unlock to enable access to the mobile device in accordance with a predetermined condition associated with a geographical region.” As described *supra* Parts IV.A.1, IV.A.2, however, since Samuel does not disclose a mobile device, it therefore does not disclose a mobile device’s being rendered “at least partially inaccessible,” nor a lock’s being “configured to unlock to enable access to the mobile device.” Samuel, therefore, does not disclose claim 9.

V. GROUND 2: SAMUEL, IN VIEW OF SHIN, DOES NOT RENDER THE CHALLENGED CLAIMS OBVIOUS

A. Samuel Is Non-Analogous Art

“A reference qualifies as prior art for an obviousness determination only when it is analogous to the claimed invention.” *Airbus S.A.S. v. Firepass Corp.*, 941 F.3d 1374, 1379 (Fed. Cir. 2019).

Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.

In re Bigio, 381 F.3d 1320, 1325 (Fed. Cir. 2004). “A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would

have commended itself to an inventor’s attention in considering his problem.” *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992).

Petitioners have the burden of showing that Samuel is analogous to the claimed invention. *See Sanofi-Aventis Deutschland GmbH v. Mylan Pharms. Inc.*, 66 F.4th 1373, 1379 (Fed. Cir. 2023). Petitioners, however, failed to even *allege*—let alone explain “with particularity,” 35 U.S.C. §322(a)(3)—that Samuel is analogous to the ’078 Patent, *see* Pet., 66-70, 76-77. Nor could Petitioners succeed in showing that Samuel is analogous to the ’078 Patent.

1. Samuel Is Not Within The Same Field Of Endeavor

Petitioners claim that the ’078 Patent is in the “technical field” of “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.” Pet., 13 (quoting EX1001, 1:33-39). The written description and the claims of the ’078 Patent further clarify that the “personal electronic devices” are the users’ *own* electronic devices. *See* EX1001 2:17-21 (noting that prior art failed to provide solution for user’s desire “not to be separated from their valuable personal property”); *id.*, 2:60-64, 3:42-57, 7:65-8:3, 8:10-13 (describing embodiments that limit access to the user’s *own* mobile electronic

device); cl. 1 (preamble); lim. 1(a); cl. 2 (preamble); lim. 2(a); cl. 3 (preamble); lim. 3(a); lim. 3(c); *see also In re Singhal*, 602 F. App'x 826, 830 (non-precedential) (Fed. Cir. 2015) (explaining that one looks to the “written description and claims” of a patent to determine the field of endeavor). The '078 patent further makes clear that the field is specifically directed to eliminating distractions at communal events; preventing access to mobile electronic devices “within certain locations” or “during certain periods of time”; and preventing unauthorized recording of proprietary content and individuals' conduct. EX1001, 3:39-57.

Samuel does not pertain to limiting a users' access to **their own** mobile device. Instead, Samuel concerns ensuring secure transportation of objects, a field that includes armored vehicles and armed guards, and not a personal case that reduces distractions by preventing access to a user's own mobile device. *See, e.g.*, EX1003, [0001]–[0008], [0024], [0038], [0057], [0058], [0106]–[0110], [0123]–[0125], [0195], [0196]. Samuel never **mentions** mobile electronic devices, much less discloses locking a mobile device in the security case in order to prevent access by the device's owner.

Accordingly, Samuel is not from the same field of endeavor as the '078 Patent.

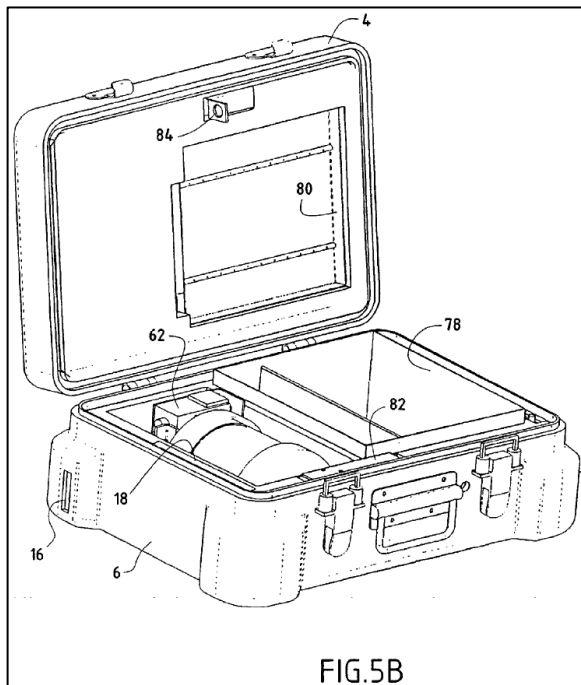
2. Samuel Is Not Reasonably Pertinent

Samuel would not “have logically commended” itself to the attention of the inventor of the claimed invention, for at least two reasons.

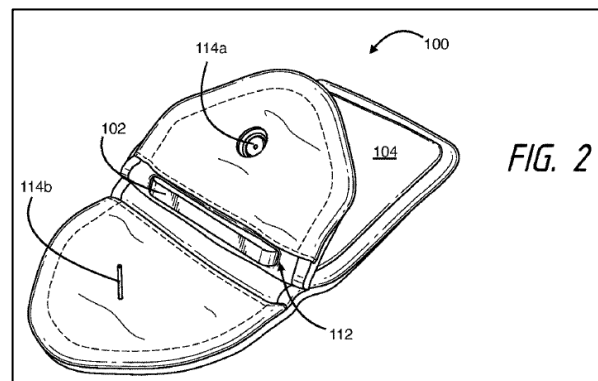
First, Samuel does not “relate to a similar problem or purpose” as the claimed invention. *Donner Tech., LLC v. Pro Stage Gear, LLC*, 979 F.3d 1353, 1359 (Fed. Cir. 2020) (noting that the “reasonably pertinent” test “ultimately rests on the extent to which the reference of interest and the claimed invention relate to a similar problem or purpose”). The purposes underlying the ’078 Patent include eliminating distractions at communal events; preventing access to mobile electronic devices “within certain locations” or “during certain periods of time”; and preventing unauthorized recording of proprietary content and individuals’ conduct. EX1001, 3:39-57.

The purpose of the case in Samuel, by contrast, is to provide a way of securely transporting objects through cheaper and/or smaller means than armored vehicles. EX1003, [0008]. This purpose plainly does not align with any of those taught in the ’078 Patent. *In re Nat. Alternatives, LLC*, 659 F. App’x 608, 613–14 (Fed. Cir. 2016) (non-precedential) (finding reference directed to solving a “substantially different problem[]” as the claimed invention was not analogous).

Second, the inventions in Samuel bear minimal similarity to the structure and function of the invention claimed in the '078 Patent. *See Clay*, 966 F.3d at 660 (finding a reference was not reasonably pertinent when the reference lacked similarity in structure and function to the claimed invention). For example, as described, *supra* Part IV.A.1, the case of the '078 Patent is designed specifically for mobile electronic devices, such that a user may keep the secured device with them at, *e.g.*, a concert venue. EX1001, 2:9-21. Samuel, by contrast, describes a case with, in Petitioners' words, a "rigid" and "briefcase-type structure[], designed for the secure transportation of valuable objects," as shown in the comparison below.



Samuel



'078 Patent

Pet., 38, 67; EX1003, Fig. 5B; EX1001, Fig. 2. The reference in Samuel to a “rubber” envelope that includes a “circuit card” and “connecting jack” likewise does not suggest a structure like that claimed in the ’078 Patent. EX1003, [0091].

Accordingly, Simpson is not analogous to the claimed invention.

B. A POSA Would Not Have Been Motivated to Combine Samuel and Shin

To show a combination of prior art references would have been obvious to a POSA, there must be some “explanation or reasoning for concluding that one of skill in the art would have combined these particular references to produce the claimed invention.” *Metalcraft of Mayville, Inc. v. The Toro Co.*, 848 F.3d 1358, 1367 (Fed. Cir. 2017). Accordingly, Petitioners “must demonstrate that a skilled artisan would have had reason to combine the teaching of the prior art references to achieve the claimed invention, and...a reasonable expectation of success from doing so.” *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 449 (Fed. Cir. 2015) (cleaned up).

Petitioners provide a cursory analysis of motivation to combine that is completely inadequate. Pet., 38–39. The Petition relies on (1) the idea that Samuel “could be replaced by a more flexible envelope design, such as the envelope shown in Shin,” and (2) the idea that both “Samuel and Shin teach ways of preventing unauthorized access to objects.” *Id.* Neither of these motivations has adequate

support, and both are contrary to the references. As explained below, there is no motivation to combine Samuel and Shin.

1. Shin Does Not Teach Preventing Unauthorized Access

The Petition alleges a motivation to combine because it incorrectly states both Samuel and Shin teach “preventing unauthorized access to objects.” Pet., 38-39. Shin does *not* prevent access to the cellphone. Shin’s bag, just like a Ziploc bag, can be opened by anyone merely by pulling. EX1004, 8. Shin’s “invention” expressly uses “voluntary participation by mobile phone owners.” EX1004, 5. Samuel, in contrast, is directed to “secure transportation,” EX1003 (Abstract), without any mention of a mobile phone. The references provide no indication why someone would use Samuel’s high-security system to transport a mobile phone. Indeed, as the ’078 Patent recognizes, a user typically keeps their mobile phone with them. EX1001, 2:14-21.

Accordingly, the Petition’s motivation to combine is based on a non-existent disclosure. There is no commonality between Shin and Samuel that would have motivated the Petition’s obviousness combination.

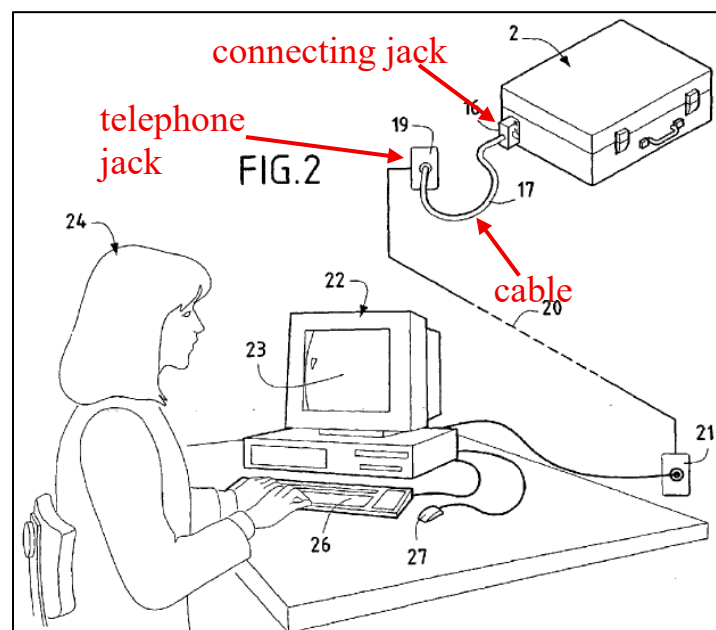
2. The Plastic Envelope In Shin Could Not Support The Connecting Jack Taught In Samuel

Petitioners further assert that a POSA would have recognized that “the rigid case depicted in [Samuel’s] figures could be replaced by a more flexible envelope

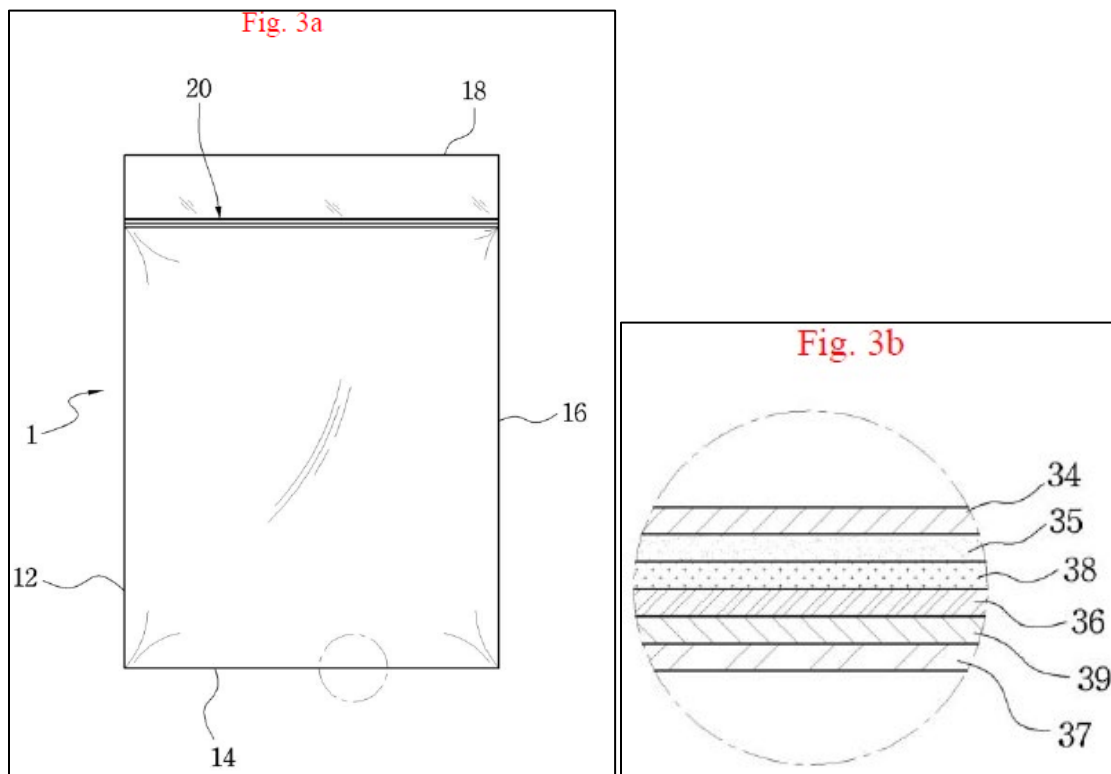
design, such as the envelope shown in Shin.” Pet., 38. In support, Petitioners rely on the following quotation from Samuel:

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....*

Id. (quoting EX1003, [0091]). Petitioners omit the remainder of the quotation, which requires that “[t]hese types of materials” permit “a *connecting jack* 16 on one of the outside surfaces or walls.” EX1003, [0091] (emphasis added). The “outside surfaces or walls” of Samuel must accordingly be durable enough to not only hold the weight of the connecting jack (16), but also withstand the additional weight and push/pull force of the cable (17), which connects the connecting jack (16) to a phone jack (19).



EX1003, Fig. 2; *see also, e.g., id.*, [0032], [0033], [0089], [0093], [0166], [0167] (describing connection of case to a network via the connecting jack). As illustrated below, the disposable envelope in Shin—made from thin coated plastic, microns thick—is far too flimsy to house this type of connecting jack and cable. *See* EX1004, Fig. 3a, Fig. 3b, 5, 6, 7. Shin expressly describes its bag as a “disposable mobile phone storage envelope,” EX1004, 1 (Abstract), indicating it is not the type of heavy-duty structure required by Samuel to support attached features or withstand transportation.



Id., Fig. 3a, Fig. 3b, 7.

A POSA would understand that these thin layers of plastic and aluminum foil would be nowhere near durable enough to support the structure needed to employ a connecting jack, or to withstand the force of both the connecting jack and the insertion/withdrawal of the cable connection to the phone jack. Samuel would accordingly be left “void of the mechanism it relies on” to receive the unlocking signals (*i.e.*, the connecting jack and cable) if it were to adopt the envelope of Shin. *See In re Schweickert*, 676 F. App’x 988, 994 (Fed. Cir. 2017) (non-precedential) (vacating obviousness rejection when combination of references would leave the primary reference “void of the mechanism it relies on” to perform critical functionality); *Cook Grp. Inc. v. Bos. Sci. Scimed, Inc.*, 809 F. App’x 990, 1001 (Fed. Cir. 2020) (non-precedential) (“[T]he Board may consider whether the modification renders the reference inoperable for its intended function in deciding whether a POSA would have a motivation to combine the references, even if that function is not a feature of the claimed device at issue.”). A POSA would therefore not have been motivated to modify the “rigid case” in Samuel with the flimsy, plastic envelope in Shin.

3. It Is Inaccurate And Inadequate To Rely On The References’ Addressing The Same Subject Matter

Petitioners argue that a POSA would have been motivated to combine Samuel and Shin, since both “teach ways of preventing unauthorized access to objects in...a

case or envelope” and thus “address the same subject matter.” Pet., 38-39. This assertion is doubly flawed. First, Petitioners are incorrect that both references “teach ways of preventing unauthorized access to objects” in their respective case or envelope. *Id.* On the contrary, the envelope in Shin is not lockable and remains, by design, freely accessible to the user. *See supra* Part V.B.1.

Second, even if Samuel and Shin both “address[ed] the same subject matter,” the mere fact that two references are “directed to the same art or same techniques” does not “show persuasively that a relevant skilled artisan would have been motivated to combine the references.” *Microsoft Corp. v. Enfish, LLC*, 662 F. App’x 981, 990 (Fed. Cir. 2016) (non-precedential); *see also Securus Techs., Inc. v. Glob. Tel*Link Corp.*, 701 F. App’x 971, 976 (Fed. Cir. 2017) (non-precedential) (finding allegation of motivation to combine was “simply too conclusory” when petitioner merely asserted that the two references “were drawn from the same general field of art”).

4. Petitioners’ Assertion That Both Samuel And Shin Disclose A Lock Is Incorrect And Irrelevant

Petitioners further assert that a POSA would have been motivated to combine Samuel and Shin since both disclose “securably mateable male and female members that function to secure the opening.” Pet., 44. This assertion is baseless. As described below, neither reference discloses securably mateable male and female

members, let alone those that “function to secure the opening.” *Infra* Parts V.C.1, V.C.5.A, . Moreover, even if these references did disclose securably mateable male and female members, the structural differences between the two remain stark enough to render this alleged similarity irrelevant. Indeed, Shin is a disposable “food storage”-type bag, while Samuel is a “rigid” and “briefcase-type” structure designed to replace armored vehicles. *See supra* Parts V.A.2, V.B.2.

5. Shin Teaches Against Limiting A User’s Access To Her Own Mobile Device

Petitioners further claim that a POSA, based on Shin’s stated goal of blocking phone calls while the cellphone is in the envelope, would have been motivated “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.” Pet., 59-60; *see also id.* at 61 (asserting that Shin “discusses the need to prevent access to phones in certain venues” and therefore “provides a motivation to combine” with Samuel). Shin does not “limit the user’s access” to their own objects stored in the case, *supra* Part V.B.1, and actually teaches ***against*** limiting the user’s access to their own mobile device, *see* EX1004, 5 (listing “***voluntary*** participation by mobile phone owners” as an object of the invention) (emphasis added); *id.* 5, 7, 8 (describing use of a resealable plastic zipper on the envelope); *see also AstraZeneca AB v. Mylan Pharm. Inc.*, 19

F.4th 1325, 1337 (Fed. Cir. 2021) (“[A] reference that properly teaches away can preclude a determination that the reference renders a claim obvious.”) (cleaned up).

Accordingly, Petitioners have failed to demonstrated motivation to combine or a reasonable likelihood of success.

C. The Combination Of Shin And Samuel Does Not Disclose Or Render Obvious The Challenged Claims

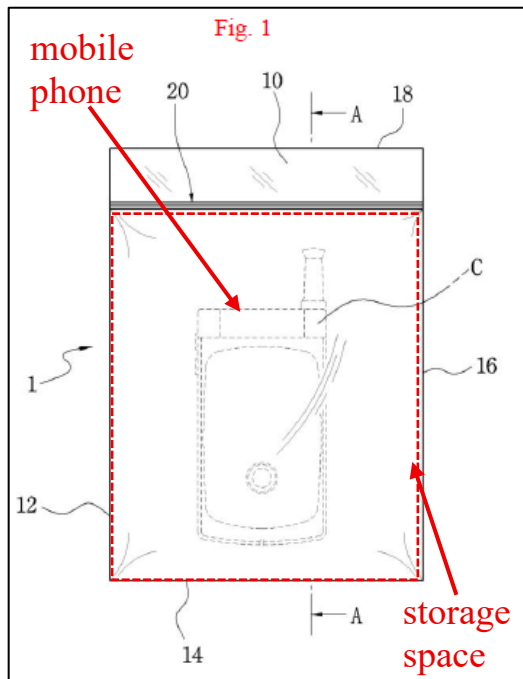
1. Claim 1

Petitioners present the same arguments that Samuel discloses the limitations in claim 1 as they did in their anticipation analysis. *See* Pet., 29-33, 39-46. As described *supra* Part V.A.1, however, Samuel does not disclose a mobile device, nor a “cavity sized to accommodate a mobile device,” nor a “shell having an opening to receive the mobile device.”

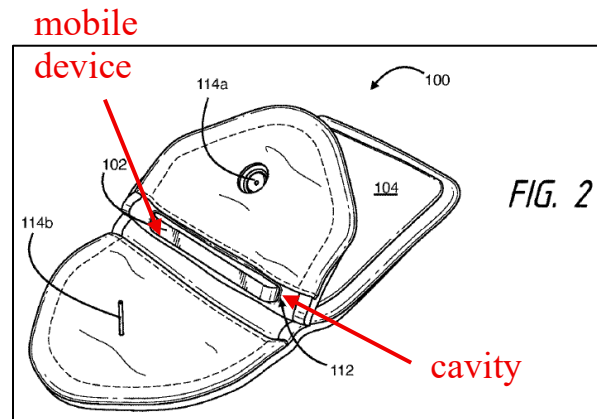
Shin does not fix Samuel’s deficiencies. Petitioners assert that Shin’s profile strips qualify as a “lock” as recited in claim 1. Pet., 44. This is incorrect. The profile strips in Shin form the “closing member 20,” which is nothing more than a “plastic zipper.” EX1004, 7, 8. This zipper does not lock at all, at least not in a way that prevents access as required by the ’078 Patent. Instead, Shin teaches that its bag is sealed by pressing with a thumb and index finger, and opened “when the first closing member 20 is pulled laterally” and “the protrusion portion and the recessed portion are separated”—exactly like a Ziploc-style food storage bag. EX1004, 8. Shin does

not deny the user access to the phone and expressly lists “**voluntary** participation by mobile phone owners” as an object of its invention. *Id.*, 5 (emphasis added). The ’078 patent, in contrast, discloses and claims **preventing** user access to their own device. *See, e.g.*, EX1001, 1:33-39, 2:31-34, 2:55-60, 6:15-47; claims 1, 9, 15. The plastic zipper in Shin, like a zipper on a Ziploc-style bag, plainly does not secure the opening in a way that renders the device inside “inaccessible” or a “user unable to access the mobile device” inside (EX1001 cls. 1, 9, 15), is openable at any time by the user, and cannot prevent user access. EX1004, 5 (describing invention as an improvement upon a food storage bag); 8 (bag opened when “pulled laterally”). Shin’s Ziplock-style bag accordingly does not disclose a “lock.”

Shin’s bag is also not “sized to accommodate” a mobile device, because it is not approximately the size of, *e.g.*, a mobile phone. Shin only describes a bag with sides of “predetermined sizes...to form a mobile phone storage space.” EX1004, 6. As shown below, that space is significantly larger than a mobile phone.



Shin



'078 Patent

EX1004, Fig. 1; EX1001, Fig. 2.

Even if Shin did disclose a bag sized for a mobile phone, however, there would be no motivation to apply that teaching to Samuel. Samuel's case cannot be sized for a mobile device because its cavity must include additional structures, for example a circuit card and means for sending signals. EX1003, Fig. 1; [0088]; [0091]. Samuel's high-security cases must also be reused for many different objects. *See, e.g.,* EX1003, [0001]-[0008], [0024]; [0206]-[0210] (transport different objects to different locations). Sizing Samuel's case to one particular object would undermine that ability, and the Petition identifies no benefit to sizing Samuel's case to a mobile electronic device.

Petitioners further refer to a “Samuel envelope,” which is, apparently, the imaginary results of “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.” Pet., 38, n.6. That disclosure is not in the art and is nonsensical. Samuel mentions, briefly, an envelope but states that it is made of rubber and must be “compatible” with inserting a “management system” and “a connecting jack.” EX1003, [0091]. Unlike Samuel’s high-security rubber “envelope,” Shin’s invention is a “disposable” bag made from thin plastic, similar to a food storage bag. EX1004, 1, 6; 6-7 (bag microns thick). As discussed *supra* Part V.A.2, Shin’s structure is not compatible with Samuel’s requirements, further confusing the issue of what, exactly, Petitioners assert is the combination.

Nor does Shin suggest a cell phone should be kept in a high-security case; instead Shin teaches its invention is “voluntary” use of a bag opened by merely “pull[ing] laterally” on the flaps. EX1004, 5, 8. Thus, Shin teaches the user (or anyone else) can always access the phone inside the bag, making it completely *unsecured*, the opposite of Samuel’s high-security armored car substitute. EX1003, [0001]-[0008]. Neither Shin’s use of a timer, nor its purpose of blocking signals, suggests “combining the teachings of Samuel and Shin.” Pet., 59-60 (citing EX1002 ¶¶275-77). Indeed, contrary to Dr. Buckner’s assertion that Shin “teaches that the

locking means is non-disengageable,” EX1002 ¶217, Shin’s bag is *expressly the opposite*: disengageable by mere pulling, EX1004, 8. Shin provides no suggestion, nor does any other reference, that denying the user access to their own cell phone would be desirable; Shin *teaches the opposite* because its invention is “voluntary” and the phone always available by pulling the zipper. EX1004, 5, 8.

Neither Petitioner nor its expert provide any additional detail of how the “Samuel envelope” would be configured in view of Shin, nor how it would be locked. Accordingly, the Petition does not explain the alleged “Samuel envelope” theory, let alone establish the combination with Shin.

2. Claims 3 and 4

Claims 3 and 4 depend from claim 1, which, as shown *supra* Part V.C.1, the combination of Samuel and Shin fails to disclose. Petitioners further rely solely on their argument that Samuel anticipates claim 3 in order to show that the combination of Samuel and Shin renders claim 3 obvious. As shown *supra* Part IV.B, however, Samuel does not disclose claim 3. The combination of Samuel and Shin, therefore, discloses neither claim 3 nor claim 4.

3. Claims 9 and 11

Petitioners present essentially the same argument as they did for claim 1 in order to show that the combination of Samuel and Shin discloses claim 9. As

demonstrated above, however, Samuel does not disclose a mobile device, Shin does not disclose a lock, and neither Samuel nor Shin disclose a cavity/shell that is sized to accommodate/receive a mobile device. *Supra* Parts IV.A.1, V.C.1. In addition to having no valid motivation to combine the references, the combination of Samuel and Shin fails to disclose each and every limitation of claim 9.

Claim 11 depends from claim 9 but is otherwise identical to claim 4. Petitioners therefore rely exclusively on their obviousness arguments for claims 4 and 9 to argue claim 11 is obvious. Pet., 52. As shown above, the combination of Samuel and Shin discloses neither claim 9 nor claim 4. *Supra* Parts V.C.2, V.C.3. The combination therefore also fails to disclose claim 11.

4. Claim 15

Claim 15 requires that the case be “sized to receive a user’s mobile electronic device.” As described *supra* Parts IV.A.1, V.C.1, however, neither the Samuel case nor the Shin case is “sized to receive” a mobile electronic device.

Claim 15 further requires that the case comprise a “lock” that is “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,” where the predetermined condition is “associated with a physical presence of the case being outside of a

defined geographical region.” The combination of Samuel and Shin does not disclose this limitation.

For one, Shin does not disclose a “lock.” *See supra* Part V.C.1. Further, Samuel does not disclose the claimed front/rear panel structure that defines an opening for the case for receiving a mobile electronic device (limitation 15(c)) and does not disclose a lock proximately located to the opening of that case (limitation 15(d)). Thus, the two references in combination do not teach or suggest the claimed case structure using front/rear panels with a lock proximately located to the opening of that case.

Moreover, Petitioners rely only on Samuel to argue that the unlocking of the case be “associated with a physical presence of the case being outside of a defined geographical region.” *See* Pet., 60-61 (emphasis omitted). But Samuel does not disclose this limitation; it teaches the exact opposite. Petitioners assert Samuel involves the “location of the case at a particular address.” Pet., 60-61. But a “particular address” requires the case be *inside*—not outside—of a defined geographical location. The ’078 Patent explains that one approach (used in claim 15) relies on the case being *outside* of a defined area to restore access, which prevents disruption of an event. The patent identifies an “audience seating area” as an example of a “defined geographical region.” *See, e.g.*, EX1001, 3:11-23. Because

a user cannot access their cellphone until they leave that defined area, it accomplishes the patent's goal of, *e.g.*, preventing distracting cell phone use during a performance. *See id.*, 1:34-39; *id.*, 3:11-23; 3:39-44. This understanding likewise comports with the otherwise plain and ordinary meaning of the word "defined." EX2019, at 3 ("to fix or mark the limits of"). The combination of Samuel and Shin therefore does not disclose limitation 15(e).

5. Claim 16

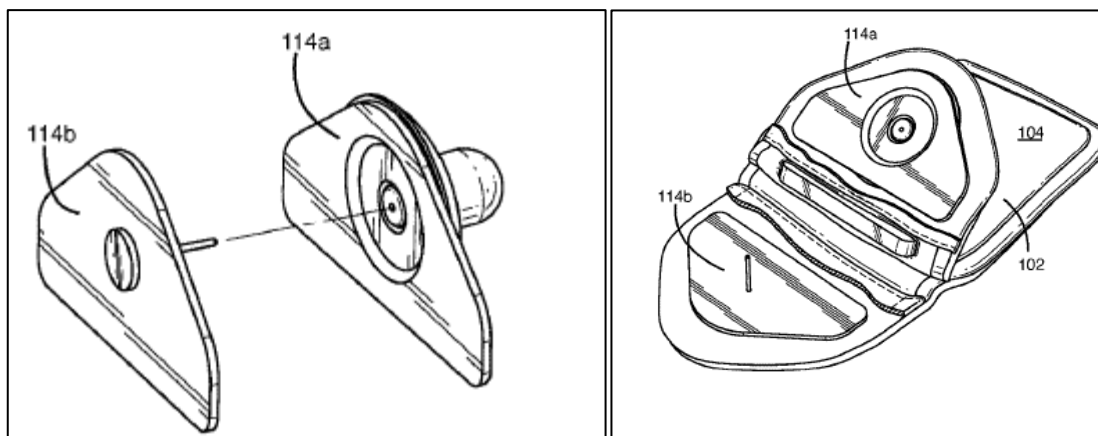
Claim 16 depends from claim 15, which, as shown *supra* Part V.C.4, the combination of Samuel and Shin fails to disclose. Further, claim 16 requires that the lock comprise "a female plate" and "a male plate," which are "respectively disposed on the front panel and the rear panel" and are "configured to securely mate." Neither Samuel nor Shin, however, disclose such a lock.

a) Samuel Does Not Disclose Opposing Plates

Petitioners argue that the "closure" or "locking means" disclosed in Samuel "include opposing plates with securably mateable female members (as shown in **12**, **14**) and male members (as shown in **8**, **10**)." Pet., 58 (citing EX1003 Fig. 1, [0083]). This is wrong. Samuel, in fact, provides no description whatsoever of the types of "locking means" that may be used with the case, opposing plates or otherwise. *See* EX1003, [0083], [0090], [0105], [0106], [0109], [0110], [0163]. The closest Samuel

comes is explaining the locking means can be a “miniature solenoid” or “a selectively operable mechanical device,” neither of which are opposing plates with securely mateable male and female members. EX1003, [0086]. Samuel’s figures are generic and accordingly do not disclose a lock with male/female “opposing plates” as Petitioners allege. *See Hologic, Inc. v. SenoRx, Inc.*, 639 F.3d 1329, 1338–39 (Fed. Cir. 2011) (finding a figure in a prior art patent did not disclose a claim limitation because the limitation was not “clearly show[n]” in the figure).

Indeed, the Petition does not identify any alleged “opposing plates” in Samuel’s structure, and none are evident in features 8/10 and 12/14. The ’078 Patent illustrates the Petition’s deficiency. Figure 4 (below, left) shows example opposing plates with securably mateable male and female members. Figure 3 (below right) illustrates that the plates are positioned so that they block the opening of the case when secured with the male and female members. EX1001, Figs. 3-4; 6:15-25.



The Petition does not identify any such plate in Samuel and therefore cannot establish Samuel discloses opposing plates with securably mateable female and male members.

While Samuel's disclosure is not clear, it appears the alleged male/female members (8/10 and 12/14 of Figure 1) are actually a buckle-type structure. As shown above, the patent illustrates plates with male/female members as a pin that inserts into a member that includes a mechanism that locks the pin in place. EX1001, Figs. 1–4. That example helps explain a male/female member arrangement, which is not illustrated in Samuel. Indeed, there is no discussion in Samuel of securely mateable male and female members. Moreover, as discussed above, Samuel does not disclose a structure with a front/rear panel, and therefore the specific lock structure of claim 16 is not on a front and rear panel. Accordingly, the Petition does not identify either the plate or the mateable male/female member, or its positioning on front/rear panels.

**b) It Would Not Have Been Obvious To Combine
Samuel's Lock With The Shin Bag**

Petitioners further assert it would have been “an obvious design choice to secure the front and rear panels” of the bag in Shin with the lock in Samuel, Pet., 61-62, and that the profile strips 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,” Pet., 62-63. This nonsensical position apparently imagines,

without any relevant support in Shin or Samuel, that Shin’s disposable Ziploc-style bag *could* be modified so that its profile strips could be locked, and subsequently unlocked, when the bag arrives at a specific location. Pet., 61-63. Petitioners’ sole support is its expert’s declaration, which is entitled to no weight because it “merely repeats...the conclusory assertion for which it is offered to support.” *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, at 15 (Aug. 24, 2022) (precedential).

Left unexplained is how the type of extreme, high-security measures for transporting valuable objects discussed in Samuel could even work with Shin’s modified “food storage” bag. EX1004, 5. Shin’s “invention” is “disposable,” not high-security. EX1004, 1, 5. The invention in Shin uses “voluntary participation” and a freely-openable bag. EX1004, 5, 8. A POSA would not have seen fit to take Shin’s Ziploc-style bag and add a locking mechanism used to secure valuables like jewelry and cash during transit. Moreover, Samuel’s locking mechanism is sizeable and sturdy enough to secure a “rigid” briefcase, Pet., 38, and could not be housed in the slightly upgraded sandwich bag disclosed in Shin, *see* EX1004, 7 (showing Shin’s bag plastic and aluminum foil, a fraction of a millimeter thick).

Petitioners accordingly failed to show that modifying Shin to include the generic locking mechanism in Samuel, much less securely mateable male and female plates, would be a “natural modification” to the POSA. *Plantronics, Inc. v. Aliph*,

Inc., 724 F.3d 1343, 1354 (Fed. Cir. 2013) (“[T]he mere recitation of the words ‘common sense’ without any support adds nothing to the obviousness equation.”) (cleaned up). The Petition provides no evidence that Shin’s thin, disposable, plastic bag is compatible with Samuel’s locking mechanism, does not suggest modifying Samuel’s lock, and does not explain why there would be an expectation that these disparate features could be successfully combined to obtain the claimed invention. *See Surgalign Spine Techs., Inc. v. LifeNet Health*, No. 2021-1117, 2022 WL 1073606, at *7–8 (Fed. Cir. Apr. 11, 2022) (non-precedential) (affirming finding that replacing a “metal screw with a bone pin” was nonobvious, since it was “doubtful that a bone pin could withstand the force needed” to use the claimed invention). The declaration likewise provides no explanation. EX1002 ¶¶285-93.

VI. GROUND 3: SAMUEL, IN VIEW OF SHIN AND SIMPSON, DOES NOT RENDER THE CHALLENGED CLAIMS OBVIOUS

A. A POSA Would Not Have Been Motivated To Combine Samuel With Shin And Simpson

Petitioners assert that a POSA would have been motivated to combine Samuel and Simpson given the similarity of the two references. Pet., 66-70. Even if a POSA would have been motivated to combine Samuel with Simpson, however, Petitioners do not show that a POSA would have also been motivated to combine Samuel/Simpson with Shin. *Supra* Part V.B; *see also* Pet., 66 (relying on

Petitioners’ previous arguments for combining Samuel with Shin). Petitioners also argue that each of the three references involve “timing.” Pet., 68-69. That does not explain why Shin’s timer that allows signals to reach the phone inside its modified sandwich bag has any relevance to Samuel or Simpson’s high-security cases. In addition, the Petition reiterates the incorrect assertion that Shin discloses “ways to secure valuables.” Pet., 69. As discussed, Shin teaches that its thin, disposable, bag can be opened at any point by merely pulling, which is the opposite of securing valuables. EX1004, 8. Petitioners accordingly fail to show a motivation to combine Shin with Samuel and Simpson.

B. Neither Samuel Nor Simpson Are Analogous To The Claimed Invention

As discussed above, the Petitioners have the burden of demonstrating Samuel and Simpson are analogous art to the claimed invention. *Supra* Part V. Petitioners, however, failed to even *allege*—let alone explain “with particularity,” 35 U.S.C. §322(a)(3)—that Samuel or Simpson are analogous to the ’078 Patent, *see* Pet., 66-70, 76-77. Samuel is not analogous to the ’078 Patent, as discussed above. And Simpson is likewise not analogous for the reasons set forth below.

1. Simpson Is Not Within The Same Field Of Endeavor

As discussed, the field of endeavor for the ’078 patent is specifically directed to eliminating distractions at communal events; preventing access to mobile

electronic devices “within certain locations” or “during certain periods of time”; and preventing unauthorized recording of proprietary content and individuals’ conduct. EX1001, 3:39-57. *Supra* V.A.1. Simpson does not pertain to limiting a users’ access to *their own* mobile device. Instead, Simpson, like Samuel, concerns ensuring secure transportation of objects by transporting them in a locked case that only opens once the case reaches its intended destination or recipient. EX1005, [0008], [0039]–[0046], [0049], [0050], [0052]–[0057]. Simpson never *mentions* mobile electronic devices, much less discloses locking a mobile electronic device in the security case in order to prevent access by the device’s owner.

Accordingly, Simpson is not from the same field of endeavor as the ’078 Patent.

2. Simpson Is Not Reasonably Pertinent

Simpson would not “have logically commended” itself to the attention of the inventor of the claimed invention, for at least two reasons.

First, Simpson does not “relate to a similar problem or purpose” as the claimed invention. *Donner*, 979 F.3d at 1359. The purposes underlying the ’078 Patent include eliminating distractions at communal events; preventing access to mobile electronic devices “within certain locations” or “during certain periods of time”; and preventing unauthorized recording of proprietary content and individuals’ conduct.

EX1001, 3:39-57. The purpose of the case in Simpson, like Samuel, is to enable individuals to securely transport valuables, “[s]ince the transportation of these objects cannot always be restricted to armed and secure vehicles.” EX1005, [0003]. This purpose plainly does not align with any of those taught in the ’078 Patent.

Second, the inventions in Simpson bear minimal similarity to the structure and function of the invention claimed in the ’078 Patent. For example, as described, *supra* Part V.A.2, the case of the ’078 Patent is designed specifically for mobile electronic devices, such that a user may keep the secured device with them at, *e.g.*, a concert venue. Simpson, by contrast, describes a rigid, heavy-duty and high-security structure akin to a briefcase. *See, e.g.*, EX1005, Figs. 1, 2. A POSA would not have relied on references with such manifestly different structures and functions to solve the problems facing the inventor of the ’078 Patent. *See Clay*, 966 F.3d at 660; *Donner Tech., LLC v. Pro Stage Gear, LLC*, IPR2018-00708, Paper No. 47, at 25 (PTAB Aug. 26, 2019).

Accordingly, neither Samuel nor Simpson is analogous to the claimed invention.

C. Claim 2

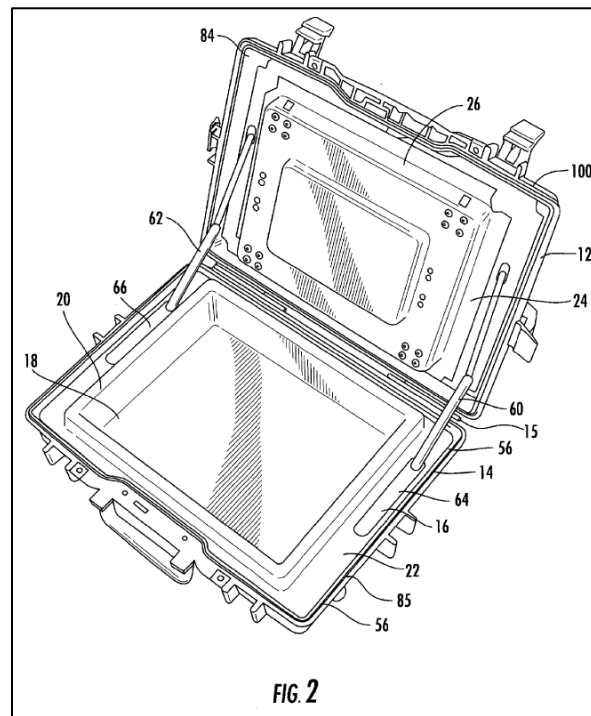
Claim 2 depends from claim 1, which, as described above, the combination of Samuel and Shin fails to disclose. *See supra* Part V.C.1. Moreover, as Petitioners

concede, “the security cases disclosed in Samuel and Simpson are very similar.” Pet., 67. Simpson, therefore, fails to disclose the limitations in claim 1 in much as the same way as Samuel.

In particular, Simpson does not disclose a “cavity sized to accommodate a mobile device” or “a shell having an opening to receive the mobile device.” Indeed, Petitioners concede that, like Samuel, “the specific examples of ‘valuables’ given in Simpson do not include mobile devices.” Pet., 70. Petitioners accordingly are forced to argue that a POSA “would understand the briefcase depicted in Figure 2 [of Simpson] would accommodate a ‘valuable’ such as a user’s mobile device.” Pet., 70.

Neither Petitioners nor their expert provide evidence to support this assertion. *Klas Telecom, Inc. v. Arnouse Digital Devices Corp.*, IPR2020-01057, Paper 9, at 14 (PTAB Nov. 23, 2020) (rejecting “conclusory” expert testimony as risking “improper hindsight analysis”) (quoting *TQ Delta, LLC v. Cisco Sys., Inc.*, 942 F.3d 1352, 1362 (Fed. Cir. 2019)). Nothing in Simpson indicates that the case’s cavity is “sized to accommodate” a user’s mobile device. As discussed, *supra* Part IV.A.1, a cavity that is “sized to accommodate” a mobile device is one that is approximately the size of the device. EX1001, Fig. 2, 5:58-6:2.

Simpson, like Samuel, however, describes a case with, in Petitioners’ words, a “briefcase-type structure[], designed for the secure transportation of valuable objects,” Pet., 67, as shown in the following figure.



EX1005, Fig. 2. Simpson does not disclose the briefcase being designed for *any* object—much less those Petitioners claim are “similar” in size to a mobile device. Indeed, Simpson’s sole disclosure pertaining to size at all relates only to the case generally, not the cavity specifically. EX1005, [0051] (stating that the embodiment of the case shown in Figure 12 is larger than that shown in Figure 1). The “briefcase-type structure” of Simpson has neither “a cavity sized to accommodate a mobile device” nor “a shell having an opening to receive the mobile device.” Nor would

such a structure have been obvious in view of Samuel and Shin, as discussed for Ground 2. The combination thus fails to disclose both claim 1 and claim 2.

D. Claim 10

Claim 10 depends from claim 9, which, as described above, the combination of Samuel and Shin fails to disclose. *See supra* Part V.C.3. Moreover, as Petitioners concede, “the security cases disclosed in Samuel and Simpson are very similar.” Pet., 67. Simpson, therefore, fails to disclose the limitations in claim 9 in much as the same way as Samuel. In particular, Simpson does not disclose a “cavity sized to accommodate a mobile device” or “a shell having an opening to receive the mobile device.” *See supra* Part VI.C. Neither do Samuel nor Shin. *See supra* Parts IV.A.1, V.C.1. Therefore, the combination of Samuel, Shin, and Simpson fails to disclose both claim 9 and claim 10.

E. Claim 19

Claim 19 depends from claim 15. Petitioners rely solely on Samuel and Shin to argue that the limitations of claim 15 are disclosed in the prior art. Pet., 74. As described *supra* Part V.C.4, however, the combination of Samuel and Shin does not disclose the limitations of claim 15. Petitioners therefore fail to show that the combination of Samuel, Shin, and Simpson discloses the limitations of claim 19.

VII. GROUND 4: SAMUEL, IN VIEW OF SHIN AND THEOBALD, DOES NOT RENDER THE CHALLENGED CLAIMS OBVIOUS

A. A POSA Would Not Have Been Motivated To Combine Samuel With Shin And Theobald

Petitioners assert there were three motivations to combine Samuel with Shin and Theobald. None have merit. The first motivation is that “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.” Pet., 77. But as described *supra* Part V.C.1, Samuel provides only a minimal description of the so-called “envelope,” which is entirely insufficient demonstrate that it is “similar” to the Theobald bag. Moreover, the thin “food storage” bag disclosed in Shin is also unlike Theobald’s disclosure that prevents shoplifting. EX1006, at 10. Theobald is therefore not “similar” to either Samuel or Shin.

The second motivation is that each reference “disclose[s] ways to secure valuables.” This is incorrect; Shin is not lockable and remains, by design, freely accessible to the user. *See supra* Part V.B.1. Moreover, the mere fact that references might be “directed to the same art or same techniques” does not “show persuasively that a relevant skilled artisan would have been motivated to combine the references.” *Supra* Part V.B.3 (citing *Microsoft*, 662 F. App’x at 990; *Securus Techs.*, 701 F. App’x at 976).

The third motivation is that “both Samuel and Theobald discuss using magnetic locking closures.” Pet., 77 (citing EX1003, [0086]; EX1006, at 1). Petitioner concedes that Shin’s closing mechanism is not magnetic, and thus presumably concedes that the magnetic closures in Samuel and Theobald would not create a motivation to combine with Shin. But even the “magnetic locking closures” in Samuel and Theobald bear minimal similarity to one another. Indeed, the individual closing mechanism in Samuel is a “miniature solenoid,” whose magnetic engagement is purely electrically generated. EX1003, [0086]. The magnetic closure in Theobald, by contrast, involves manually applying a “strong permanent magnet” that results in a completely different structure. EX1006, at 10. Petitioners advance no evidence that Theobald would be compatible with Samuel’s case, particularly because Theobald apparently contemplates a manual opening that is the opposite of Samuel’s disclosure, which for security purposes requires a remote unlocking. *See, e.g.*, EX1003, Fig. 2, [0032]-[0038], [0106]-[0113]. Moreover, Theobald and Samuel are otherwise largely structurally different; Theobald is a bag composed of plastic designed for retail use, and Samuel is a “rigid” security briefcase designed to be repeatedly used in transit. The concept of magnetism—which is applied in completely different ways reflecting the references’ divergent purposes—does not fix the structural and design differences between the two references.

Petitioners have accordingly failed to show any motivation to combine Samuel, Shin, and Theobald.

B. Samuel Is Not Analogous To The Claimed Invention

As discussed *supra* Part V.A, Samuel is not analogous to the claimed invention. The further combination with Theobald fails for this additional reason.

C. The Combination Of Samuel, Shin, And Theobald Does Not Disclose The Challenged Claims

Petitioners argue that Samuel, in view of Shin and Theobald, renders claim 5 obvious. Claim 5 depends from claim 1, which, as described above, the combination of Samuel and Shin fails to disclose. *Supra* Parts V.C.1. Petitioners further assert that Theobald discloses a “shell defining a cavity sized to accommodate a mobile device, the shell having an opening to receive the mobile device.” Pet., 77-78. But, as with Samuel, Theobald does not so much as mention a mobile device and therefore cannot teach that a mobile device is received into the shell. Indeed, Petitioners concede Theobald discloses nothing more than a non-descript “product” that is placed within the bag. Pet., 78; *see* EX1006, at 10.

Petitioners accordingly resort to arguing that a POSA “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.” Pet., 78 (citing Buckner Decl., ¶195; EX1006, at 9). But neither Petitioners nor their expert provide evidence to

support this assertion. *Klas Telecom, Inc. v. Arnouse Digital Devices Corp.*, IPR2020-01057, Paper 9, at 14 (PTAB Nov. 23, 2020) (rejecting “conclusory” expert testimony as risking “improper hindsight analysis”) (quoting *TQ Delta, LLC v. Cisco Sys., Inc.*, 942 F.3d 1352, 1362 (Fed. Cir. 2019)). Nothing in Theobald indicates that the case’s cavity is “sized to accommodate” a user’s mobile electronic device. As discussed *supra* Part IV.A.1, a cavity that is “sized to accommodate” a mobile device is one that is approximately the size of the device. EX1001, Fig. 2; *see also id.*, 5:58-6:2. Theobald, however, contains no disclosure whatsoever regarding the size of the bag. Theobald accordingly does not disclose “a shell defining a cavity sized to accommodate a mobile device, the shell having an opening to receive the mobile device.”

Similarly, since Theobald contains no disclosure whatsoever regarding a mobile device, it also does not disclose a “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,” nor a lock “configured to unlock to enable access to the mobile device.” Therefore, the combination of Samuel, Shin, and Theobald does not render claim 5 obvious.

VIII. OBJECTIVE INDICIA REINFORCE PATENTABILITY OF THE CHALLENGED CLAIMS

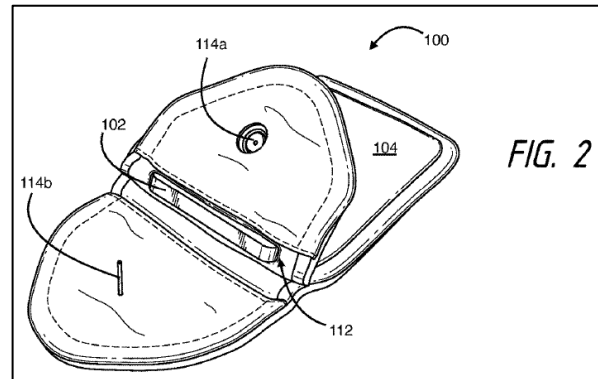
As set out above, the Petition’s obviousness combinations do not include all of the claim elements and there would have been no motivation to combine the disparate references. In addition, objective indicia of nonobviousness demonstrate that the claims are non-obvious and institution should be denied accordingly.

Objective indicia “are not just a cumulative or confirmatory part of the obviousness calculus but constitute[] independent evidence of nonobviousness.” *Leo Pharm. Prods., Ltd. v. Rea*, 726 F.3d 1346, 1358 (Fed. Cir. 2013) (internal quotation marks omitted). “[T]he objective indicia of nonobviousness are crucial in avoiding the trap of hindsight.” *Id.* Indeed, such evidence “may often be the most probative and cogent evidence in the record” and “may often establish that an invention appearing to have been obvious in light of the prior art was not.” *Transocean Offshore Deepwater Drilling, Inc. v. Maersk Drilling USA, Inc.*, 699 F.3d 1340, 1349 (Fed. Cir. 2012) (internal quotation marks omitted). Though each objective indicium provides substantial weight to nonobviousness, “it stands to reason that these individual weights would sum to a greater weight” to firmly establish the challenged claims are patentable. *Volvo Penta of the Ams., LLC v. Brunswick Corp.*, 81 F.4th 1202, 1215 (Fed. Cir. 2023).

As shown below, the Yondr Pouch is similar to ’078 Patent Figure 2.



Yondr Pouch



'078 Patent

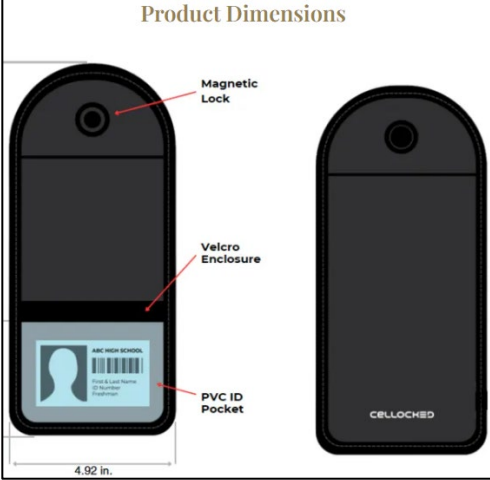
EX2020; EX1001, Fig. 2. The objective indicia discussed below result directly from the Yondr Pouch's unique and claimed ability to selectively limit a user's access to their own mobile device while allowing the user to maintain possession of the device, as highlighted by Yondr's website. *See* EX2020.

A. Copying Of The Yondr Pouch Provides Strong Evidence Of Non-Obviousness

Competitors' copying of the Yondr Pouch is strong evidence the claims of the '078 patent would not have been obvious. *Volvo Penta*, 81 F.4th at 1213 (noting the Federal Circuit has "usually considered a determination of copying to be strong evidence of nonobviousness") (internal quotation marks omitted). A party's copying may be established by showing that the party "had access to the [copied product] while it was developing [its own product] and the products have substantially similar

designs.” *Medtronic, Inc. v. Teleflex Innovations S.A.R.L.*, 70 F.4th 1331, 1339 (Fed. Cir. 2023).

Here, Petitioners have copied the Yondr Pouch. Petitioners sell a product called CellockED, which, like the Yondr Pouch, is directed to limiting a user’s access to their own mobile device. *See* EX2021. Petitioners did not launch CellockED until 2024, the same year the ’078 Patent issued and long after the Yondr Pouch became publicly available. *See* EX2022. The design of CellockED strikingly matches the Yondr Pouch, as the following images show.

CellockED	Yondr Pouch
Product Dimensions  EX2021	 EX2023
 EX2021	 EX2020

Be Smarter could have selected a different design for its product. For example, Be Smarter could have selected a briefcase like Samuel or a food storage bag like Shin. But Be Smarter did not select anything like those devices, because the design disclosed in the '078 Patent, and embodied in Yondr's Pouch, provides

substantial benefits. Be Smarter’s copying of the Yondr Pouch accordingly reinforces the fact that the claimed invention of the ’078 Patent would not have been obvious to a POSA.

B. Industry Praise Of The Yondr Pouch Provides Objective Evidence The Claims Are Not Obvious

Yondr has also received significant industry praise for its Yondr Pouch, which “provides probative and cogent evidence that one of ordinary skill in the art would not have reasonably expected the claimed invention.” *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1334 (Fed. Cir. 2016) (cleaned up). For example, the Yondr Pouch was included among TIME Magazine’s “Best Inventions of 2024.” EX2024. Publications like the Washington Post, the Houston Chronicle, and the Atlanta Journal-Constitution have further highlighted the Yondr Pouch as an effective tool for instituting phone-free schools. See EX2025 (noting Yondr’s effectiveness in schools); EX2026 (same); EX2027 (same). Connecticut Governor Ned Lamont, according to Forbes, even “specifically recommended Yondr pouches as a solution” to implementing statewide restrictions on cellphones in schools. EX2028, at 5. This “evidence of industry praise by business publications” is “compelling” evidence that may “rebut[] even a strong showing” of obviousness. *Apple Inc. v. Int’l Trade Comm’n*, 725 F.3d 1356, 1366 (Fed. Cir. 2013).

IX. GROUND 5: THE CHALLENGED CLAIMS ARE NOT INDEFINITE

Petitioners assert that the term “associated with” as used in claims 1, 9, and 15 is indefinite. Pet., 79-81. According to Petitioners, “[t]here is nothing in the ’078 Patent that explains what merely being ‘**associated with**’ means.” Pet., 79. Petitioners are incorrect. Indeed, the district court already considered, and rejected, analogous indefiniteness arguments. EX2010.

For one, the specification is replete with examples of the “predetermined condition[s] associated with a geographic region,” including: (1) a case that must be touched to a detacher or unlocked by venue staff *at an exit* (EX1001, 6:57-7:4; 2:66-3:5, 2:65-3:10, 6:35-47; EX2030 ¶¶27-28); (2) a case that must exceed the range of a transmitter (EX1001, 3:11-22, 7:10-20; EX2030 ¶29); (3) a case that unlocks *in a certain room within a venue* (EX1001, 7:26-36; Smith Decl. ¶30); and (4) a case that unlocks *outside of a given location* (EX1001, 7:5-9; EX2030 ¶31). Each of these examples of predetermined conditions for unlocking the case is “associated with” a geographic region, for example, a detacher or person placed *at* a geographic region or *at a particular place* within a geographic region, *exceeding* the *range* of a transmitter located at a geographic region, or a particular *room*, or *outside* of a geographic region. (EX2030 ¶¶27-32).

Petitioners complain, however, that such examples do not expressly use the term “associated with” in reference to the geographic region. Pet., 81. But *in haec verba* support is not the indefiniteness standard. *Presidio Components, Inc. v. Am. Tech. Ceramics Corp.*, 875 F.3d 1369, 1376 (Fed. Cir. 2017) (quoting *Dow Chem. Co. v. Nova Chem. Corp.*, 809 F.3d 1223, 1225 (Fed. Cir. 2015) (concurrency)) (“[I]f a skilled person would choose an established method of measurement, that may be sufficient to defeat a claim of indefiniteness, even if that method is not set forth *in haec verba* in the patent itself.”). Indeed, “specific 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). This is because a skilled artisan would be informed by the specification’s examples and use them to resolve any alleged ambiguity in the claim language. See *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 of qualifying compositions”); *Kinetic Concepts, Inc. v. Blue Sky Med. Grp., Inc.*, 554 F.3d 1010, 1022 (Fed. Cir. 2009).

Petitioners further assert the ’078 Patent fails to “explain how ‘associated with’ is different from ‘is’ as used in the ’788 Patent.” Pet., 80; *see also id.* at 81 (arguing the ’078 Patent does not describe how the term “associated with a

geographic region” differs from the term “physical presence of the case outside of a defined geographical region” as claimed in the ’788 Patent) (citing EX1017, cls. 1, 7). This argument is baseless. As described above, the specification provides a host of examples of a predetermined condition “associated with” a geographic region. The ’078 Patent accordingly provides the POSA with reasonable certainty as to the scope of the “associated with” limitations. The extent to which these limitations are similar to other limitations in the ’788 Patent has no bearing on this analysis.⁴

The challenged claims, therefore, are not indefinite.

X. GROUND 6: THE CHALLENGED CLAIMS ARE PATENT ELIGIBLE SUBJECT MATTER

Petitioners further assert that independent claims 1, 9, and 15 are patent-ineligible under 35 U.S.C. § 101. Though the Petition identifies claim 1-5, 9-11, 15-16, and 19 as relevant to the section 101 analysis, Pet., 12, the Petition’s section 101 analysis addresses only claims 1, 9, and 15 and presents no evidence or argument

⁴ To the extent Petitioners intend to argue the ’078 Patent is invalid for obviousness-type double patenting in view of the ’788 Patent, this is a non-statutory ground for invalidity and is accordingly not appropriate for post-grant review. *LKQ Corp. v. GM Glob. Tech. Ops. LLC*, PGR2020-00021, Paper No. 8, at 29 (PTAB Sept 1, 2020).

related to any dependent claims. *See* Pet., 85-88 (providing argument solely for claims 1, 9, and 15 at step two). Accordingly, the Petition is facially deficient for all dependent claims. And, regardless, the section 101 arguments that were raised fail on the merits.

“Patent eligibility under § 101 is a question of law that may contain underlying issues of fact.” *CardioNet, LLC v. InfoBionic, Inc.*, 955 F.3d 1358, 1367 (Fed. Cir. 2020). Inventions are broadly eligible for patenting under 35 U.S.C. § 101, with only laws of nature, natural phenomena, and abstract ideas excluded. *Diamond v. Diehr*, 450 U.S. 175, 185 (1981). But the exclusion is not categorical, because “[a]pplications of abstract concepts to a new and useful end are eligible for patent protection.” *PowerBlock Holdings, Inc. v. iFit, Inc.*, 146 F.4th 1366, 1371 (Fed. Cir. 2025).

There is a two-step test to determine whether an otherwise eligible discovery must remain unpatented to preserve others’ access to the “building blocks of human ingenuity.” *Alice Corp. Pty. v. CLS Bank Int’l*, 573 U.S. 208, 217 (2014). At step one, courts consider the “claims in their entirety,” determining whether “their character as a whole” is directed to a judicial exception. *PowerBlock*, 146 F.4th at 1371; *see also* *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016). If the claims, ***considered as a whole***, are not directed to a judicial

exception, the inquiry stops, and the invention is deemed patent eligible. *PowerBlock*, 146 F.4th at 1371. Otherwise, the analysis proceeds to step two, which “consider[s] the elements of each claim both individually and as an ordered combination to determine whether the additional elements transform the nature of the claim into a patent-eligible application.” *Id.* (quoting *CardioNet, LLC v. InfoBionic, Inc.*, 955 F.3d 1358, 1368 (Fed. Cir. 2020)).

A. The Challenged Claims Are Not Directed To A Patent Ineligible Subject Matter

1. Petitioners Cannot Articulate The Purported Abstract Idea

Petitioners argue that the challenged claims are directed to an “abstract idea.” Pet., 83. Petitioners, however, are not even sure what this purported abstract idea is. When Petitioners first presented this argument at the district court, they argued that the purported abstract idea was “a locking container.” EX1014 at 17. Confronted with the absurdity of this argument—a locking container is plainly not an “abstract idea,” *see* EX1015, at 16-17—Petitioners have since changed course. But even now, Petitioners are inconsistent as to what they believe is the purported “abstract idea.” Specifically, at step one, Petitioners claim the “abstract idea” is “controlling another person’s access to personal property.” Pet., 83. But then, at step two, Petitioners claim it is “the unlocking of a case (sized to accommodate a mobile electronic device / mobile device).” Pet., 87. That Petitioners have now presented multiple different

characterizations of the purported abstract idea—and have still yet to clarify which they assert here—shows that the challenged claims are not, in fact, directed to an abstract idea.

2. Petitioners Fail To Consider The Claim Language

At step one, Petitioners argue the claims are directed to nothing more than “an unpatentable form of ‘organizing human activity,’” *i.e.*, “controlling another person’s access to personal property.” Pet., 83; *see also id.* (arguing that the claims “cite functional results rather than concrete technological solutions”). Petitioners’ analysis here focuses exclusively on the written description. This is legal error because the “*Alice* step one inquiry involves consideration of the claims ‘*in their entirety*’ to ascertain whether their character *as a whole* is directed to excluded subject matter.” *PowerBlock*, 146 F.4th at 1373 (emphasis in original) (quoting *CardioNet*, 955 F.3d at 1367). In *McRO*, the Federal Circuit likewise rejected the limitation-stripping approach used in the Petition. *McRO*, 837 F.3d at 1313. The Court explained “that courts ‘must be careful to avoid oversimplifying the claims’ by looking at them generally and failing to account for the specific requirements of the claims.” *Id.* Petitioners engage in this forbidden generalization and ignore the detailed language of the claims, which are directed to structural limitations on a mechanical device.

The claims-at-issue are made up entirely of structural limitations and physical features. The claimed case has a particular size (a physical feature), *e.g.*, “a cavity sized to accommodate a mobile device” (EX1001, cls. 1, 9, *see also* claim 15). Certain claims limit how the case is put together (another physical feature), with “a front panel” and “rear panel” that are “connected” in a way that creates the “opening.” (EX1001, cl. 15; *see also id.* cls. 4, 11). That claimed combination of features yields a top-loading case with specific sides, edges, and other physical requirements sized to a mobile device like the one shown in Figures 1-6. Other limitations add more physical structure, including a lock on the case that is “proximate to the opening,” (EX1001, cls. 1, 9, 15) not an external lock, or a lock set apart from the opening. Some claims are limited to specific types of locks (EX1001, cl. 5), while others are limited to a specific type of lock with “a female plate” and “a male plate” “respectively disposed on the front panel and rear panel” and “configured to securely mate,” exemplified in Figures 1-6. EX1001, cl. 16.

The lock is further configured in a way such that, once locked, the user cannot access their own mobile device, with the lock opening the case when meeting a predetermined condition “based on” or “in accordance with” “a predetermined condition associated with a geographic region.” EX1001, cls. 1, 9; *see also id.*, cl. 15. Some claims narrow the predetermined condition to the “physical presence” or

“physical position” of the case outside of or relative to a defined geographical region. EX1001, cls. 3, 10, 15. Such configurations and predetermined conditions are fundamentally physical, for example the lock is released with a strong magnet, and the corresponding strong magnet is placed at the “venue exit ways,” so the case (a mechanical object) must be physically moved to the exit (a physical location) as a predetermined condition for the lock to release (using another tangible object) and restore access. EX1001, 6:54-7:4. Other examples involve physically moving the case to a different location to restore access. EX1001, 7:5-42 (unlocking if case leaves area).

The claims are thus directed to an eligible physical invention, namely “a concrete thing, consisting of parts, or of certain devices and combination of devices.” *PowerBlock*, 146 F.4th at 1372 (quoting *SiRF Tech., Inc. v. Int’l Trade Comm’n*, 601 F.3d 1319, 1332 (Fed. Cir. 2010)). This type of physical, mechanical object with specific physical features is routinely deemed patent eligible at step one. *See, e.g., PowerBlock*, 146 F.4th at 1372-73 (dumbbell); *PM Holdings, LLC v. Heart of Texas Surgery Ctr., PLLC*, No. 6:21-CV-00644-ADA, 2022 WL 1004644, at *4 (W.D. Tex. Apr. 4, 2022) (operating room), *No Spill, LLC v. Scepter Canada, Inc.*, No. 2:18-CV-02681-HLT, 2023 WL 12004664, at *4 (D. Kan. Feb. 2, 2023) (fuel containers); *Cap Exp., LLC v. Zinus, Inc.*, No. 2:16-CV-00371-SVW-MRW, 2019

WL 982883, at *5 (C.D. Cal. Jan. 24, 2019) (bed frames); *Quality Innovative Prods., LLC v. Brand 44, LLC*, No. 18-CV-00369-NYW, 2018 WL 4829647, at *7 (D. Colo. Oct. 4, 2018) (children’s swings); *Nike, Inc. v. Puma N. Am., Inc.*, No. CV 18-10876-LTS, 2018 WL 4922353, at *4 (D. Mass. Oct. 10, 2018) (shoes). The same outcome is appropriate here because a case is not an abstract idea.

Petitioners also assert the section 101 analysis can ignore claim limitations that are found in the prior art. Pet., 83-85. Again, that is legal error: “[i]t is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis.” *Diamond*, 450 U.S. at 188. Nor can Petitioners use section 101 to argue anticipation or obviousness. Indeed, the Federal Circuit recently “caution[ed] parties and tribunals not to conflate the separate novelty and obviousness inquiries under 35 U.S.C. §§ 102 and 103, respectively, with the step one inquiry under § 101.” *PowerBlock*, 146 F.4th at 1373 n.3. Rejecting arguments analogous to those Petitioners now rely on, the Court held that step one determines only what “is sought to be patented,” not whether it is novel or obvious. *Id.* (quoting *Parker v. Flook*, 437 U.S. 584, 593 (1978)).

As discussed above, the Petition’s art does not disclose or render obvious the claimed inventions. Instead, the claims-at-issue are “focused on a specific asserted improvement,” *McRO*, 837 F.3d at 1314, that was not previously used: a case and

system using a case with a specific size, configuration, lock position, lock structure, and further configured to require a predetermined condition be physically met (*e.g.*, the physical presence of the case in specific location) to unlock the case. It is that combination of features—and not any one in isolation—that provides an advance over prior art techniques that sought to control cell phone use through, *e.g.*, signs or directions. EX1001, 1:63-2:21. Nor is there any issue of preemption: there is no evidence that the claimed cases, with their various physical features, are the *only* case structures that could be used to lock or control access to a phone. *See McRO*, 837 F.3d at 1315 (preemption requires “there exists only one set of rules” that could be used).

3. Petitioners Confuse Patent Eligibility With Novelty And Nonobviousness

Petitioners nevertheless argue that “[l]ocking storage containers”—such as “cases, luggage, purses,” “bank safety deposit box[es],” and “time capsule[s]”—have existed “for 100+ years.” Pet., 83. This is entirely irrelevant to the § 101 analysis. For one, the challenged claims are not directed these types of “locking storage containers.” They are instead limited to a mobile device case with the precise structural limitations described *supra* Part X.A.2.

More fundamentally, however, Petitioners err by introducing obviousness and anticipate arguments into section 101. It is improper “to conflate the separate

novelty and obviousness inquiries under 35 U.S.C. §§ 102 and 103, respectively, with the step one inquiry under § 101.” *PowerBlock*, 146 F.4th at 1373 n.3. In *PowerBlock*, the Federal Circuit rejected arguments analogous to those made by Petitioners. *Id.*; *see also CardioNet*, 955 F.3d at 1372 (“the novelty or nonobviousness of the invention has little to no bearing on the question of what the claims are ‘directed to’” at step one); *Data Engine Techs. LLC v. Google LLC*, 906 F.3d 999, 1011 (Fed. Cir. 2018) (“The eligibility question is not whether anyone has ever used tabs to organize information. That question is reserved for §§ 102 and 103. The question of abstraction is whether the claim is ‘directed to’ the abstract idea itself.”). Accordingly, Petitioners’ discussion of prior art in its section 101 arguments are largely irrelevant, and Petitioners’ citation to a non-final Office Action (Pet., 84-85) is irrelevant for the same reason.

4. Petitioners’ Sole Supporting Case Is Inapposite

The sole case Petitioners cite in support of their argument that the ’078 Patent is directed an abstract idea is *American Axle & Manufacturing v. Neapco Holdings LLC*, 939 F.3d 1355 (Fed. Cir. 2019). But that case concerned method claims that simply directed the user to use their “knowledge of Hooke’s law”—an undisputedly natural law governing vibrational frequencies—“to engage in an ad hoc trial-and-error process of changing the characteristics of a liner until a desired result is

achieved.” *Am. Axle*, 939 F.3d at 1364. The claims were also devoid of “any physical structure or steps for achieving the claimed result of damping two different types of vibrations.” *Id.* at 1366-67. Here, by contrast, the challenged claims are apparatus claims, which do not recite any law of nature and are plainly limited to a specific structure for preventing access to a mobile device. Courts routinely hold mechanical devices with specific physical features, like the ones claimed here, patent eligible at step one. *See, e.g., PowerBlock*, 146 F.4th at 1372 (dumbbell); *PM Holdings*, 2022 WL 1004644, at *4 (operating room), *No Spill*, 2023 WL 12004664, at *4 (fuel containers); *Cap Exp.*, 2019 WL 982883, at *5 (bed frames); *Quality Innovative*, 2018 WL 4829647, at *7 (children’s swings); *Nike*, 2018 WL 4922353, at *4 (shoes).

B. The Challenged Claims Contain An Inventive Concept

Because the Petition’s analysis fails at step one, the claims are patent eligible and the Board need not consider step two. *PowerBlock*, 146 F.4th at 1371. But even if the Petition could demonstrate an abstract idea at step one (and it cannot), the Petition fails to establish the absence of an inventive concept.

Petitioners first appear to argue that the structural limitations in the challenged claims are “generic hardware,” which, according to Petitioners, “cannot provide the inventive concept.” Pet., 85 (citing *Alice*, 573 U.S. at 223). The portion of *Alice*

Petitioners cite *simply* holds that the “recitation of a ***generic computer*** cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” 573 U.S. at 223 (emphasis added). But the challenged claims here, embodied in physical pouches, are the antithesis of the type of computer-implemented processes held abstract under § 101.

Petitioners then argue, again citing *Alice*, that the claim scope simply “limit[s] application of [the abstract idea] to a particular environment—here, cellphone use.” Pet., 86-87 (citing *Alice*, 573 U.S. at 223). Again, however, the portion of *Alice* Petitioners cite holds that “[s]tating an abstract idea while adding the words ‘apply it with a ***computer***’ simply combines the two steps.” 573 U.S. at 223 (emphasis added). The ’078 Patent, by contrast, does not recite a computer program that prevents a user from accessing their mobile device; it instead recites a series of structural limitations that physically prevent access to the mobile device.

Petitioners conclude by referencing the same non-final Office Action they did in step one as “evidence[e] that the claimed inventions lack any inventive concept.” Pet., 87-88 (noting that the non-final Office Action “cited multiple prior art references”). As in step one, however, “[w]hether a particular technology is well-understood, routine, and conventional [under § 101] goes beyond what was simply known in the prior art. The mere fact that something is disclosed in a piece of prior

art, for example, does not mean it was well-understood, routine, and conventional.” *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1369 (Fed. Cir. 2018). Petitioners’ reliance on this non-final Office Action is accordingly meritless.

A court may identify an inventive concept in one or more of the claim limitations, or in their ordered combination. *Bascom Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1349 (Fed. Cir. 2016). “The inventive concept inquiry requires more than recognizing that each claim element, by itself, was known in the art.” *Id.* at 1350. Instead, “an inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces.” *Id.*

As discussed above, the particular ordered combination of elements is not found in the prior art, nor would it have been obvious. *Supra* Parts IV-VII. There is copious evidence that the ordered combination of elements provides an inventive concept, including the industry praise for the Yondr invention and Petitioners’ copying of the specific structural features disclosed in the patent and present in the claims. *Supra* Part VIII.

The Petition therefore cannot establish the challenged claims are patent ineligible under section 101.

XI. CONCLUSION

For the foregoing reasons, the Patent Owner respectfully requests that the Board deny institution.

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that this **PATENT OWNER'S PRELIMINARY RESPONSE** complies with the 18,700-word type-volume limitation because it contains 14,884 words after excluding the parts exempted according to the word count feature of Microsoft Word.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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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 YONDR, INC.’s PRELIMINARY RESPONSE** is being served electronically on November 12, 2025, to the e-mail addresses shown below:

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