

Declaration of Dr. Gregory D. Buckner in Support of
Petition for *Inter Partes* Review of
U.S. Patent No. 9,819,788

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BE SMARTER, LLC AND JAMES GUERRA

Petitioners

v.

YONDER, INC.
Patent Owner

Case IPR2025-00970
Patent No. 9,819,788 B2
Issue Date: November 14, 2017

DECLARATION OF DR. GREGORY D. BUCKNER

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I. INTRODUCTION

1. I, Dr. Gregory D. Buckner, am a Professor in the Department of Mechanical and Aerospace Engineering at North Carolina State University.

2. I have been retained by the defendant Be Smarter, LLC, to study and provide my expert opinion regarding the validity of U.S. Patent 9,819,788 (“the ’788 patent”).

3. I understand this declaration will be submitted in connection with a Petition for *Inter Partes Review* before the United States Patent and Trademark Office regarding the ’788 patent brought by Defendants Be Smarter LLC and James Guerra (collectively, “Be Smarter”). I am competent to testify under oath regarding the matters addressed in this declaration and will do so if called as a witness.

II. SUMMARY OF OPINIONS

4. Based on my experience, my analysis of prior art references, and the meaning of the patent’s claims per the claim construction proposed by BeSmarter, it is my opinion that claims 1–4 and 6–8 of the ’788 patent are anticipated or obvious in view of the prior art references discussed below. In forming my opinions, I understand from counsel that the effective filing date of the ’788 patent is April 21, 2015. The opinions herein referencing the general knowledge of a person of ordinary skill in the art (“POSA”) refer to the general knowledge of a POSA at the time the

invention claimed in the '788 patent was made, which I have been informed is the timeframe prior to April 21, 2015.

III. PROFESSIONAL BACKGROUND

5. My curriculum vitae is provided as EX-1003.

6. I am being compensated at a rate of \$350 per hour for my analysis and testimony in this matter. I am also being reimbursed for reasonable and customary expenses associated with my work and testimony in this investigation. My compensation is not contingent on the outcome of this matter or the specifics of my testimony.

7. I am a Professor of Mechanical and Aerospace Engineering and an Affiliate Faculty of Electrical and Computer Engineering at North Carolina State University (NCSU) in Raleigh, NC. I am Director of NCSU's Electro-Mechanics Research Laboratory (EMRL), and I have been involved with electromechanics research and development for more than 30 years. My research focuses primarily on design, specifically designing devices that incorporate both electrical components (sensors, actuators, microprocessors, etc.) and mechanical components (mechanisms, linkages, structures, etc.).

8. I received a Ph.D. (1996) in Mechanical Engineering from the University of Texas at Austin, a M.S. (1987) in Mechanical Engineering from Virginia Tech, and a B.S. (1986) in Mechanical Engineering from Louisiana State

University. At the University of Texas at Austin, I specialized in electromechanics research and development, working as a post-doctoral research engineer at the University of Texas Center for Electromechanics.

9. I have over 30 years of design, development and consulting expertise covering a wide range of industries and technologies. During that time, I have maintained a consistent focus on mechanical and electromechanical design. I have directed more than \$7 million of federally and industrially sponsored research. These projects have resulted in numerous peer-reviewed journal and conference publications, multiple patents and corporate license agreements to facilitate technology transfer to industry.

10. I am a named inventor on several U.S. patents:

- U.S. Patent No. 12,184,123—“Three-dimensional airgap electric machines employing winding embedded liquid cooling”
- U.S. Patent No. 9,316,189—“Fuel injection device for an internal combustion engine, and associated method”
- U.S. Patent No. 9,308,350—“Active catheter device and associated system and method”
- U.S. Patent No. 8,579,806—“Force-determining retraction device and associated method”
- U.S. Patent No. 8,295,950—“Intelligent power management system”
- U.S. Patent No. 7,775,974—“Force-determining retraction device and associated method”

11. I am a member of the American Society of Mechanical Engineers (ASME), the Institute of Electrical and Electronics Engineers (IEEE), the American Society for Engineering Education (ASEE), Pi Tau Sigma (Mechanical Engineering Honor Society), Tau Beta Pi (Engineering Honor Society), Phi Kappa Phi (Academic Honor Society), and the National Fire Protection Association (NFPA, which publishes the National Electrical Code). I am Associate Editor of the ASME Journal of Dynamic Systems, Measurement and Control.

12. My education and experience have given me specialized expertise in the design and development of mechanical and electromechanical devices.

IV. INFORMATION CONSIDERED

13. In forming my opinions, I read and considered the '788 patent (EX-1001) and its prosecution history (EX-1004); the proposed construction of the terms of the claims, as set forth in the Petition; the materials listed in Appendix A; and the other materials referenced herein, including:

Exhibit No.	Description of Document
EX-1001	U.S. Patent No. 9,819,788 B2 to Graham Dugoni (filed April 21, 2015, issued November 14, 2017) (“’788 patent”)
EX-1002	Declaration of Dr. Gregory Buckner (“Buckner Decl.”)
EX-1003	Curriculum Vitae of Gregory Buckner
EX-1004	Prosecution History of U.S. Patent No. 9,819,788 B2
EX-1005	U.S. Patent Appl. Pub. No. 2003/0011455 to Samuel et al. (filed February 15, 2001, published January 16, 2003) (“ <i>Samuel</i> ”)

EX-1006	Korean Patent Laid-open No. 10-2007-0041248 to Hyo-jyn Shin (filed October 14, 2005, published April 18, 2007) (“ <i>Shin</i> ”)
EX-1007	U.S. Patent Appl. Pub. No. 2012/0187003 to Stewart et al. (filed January 21, 2011, published July 26, 2012) (“ <i>Stewart</i> ”)
EX-1008	U.S. Patent Appl. Pub. No. 2014/0298492 to Simpson (filed March 14, 2014, published October 2, 2014) (“ <i>Simpson</i> ”)
EX-1009	Dkt. No. 1, Complaint in Case No. 2024-CV-1326 pending in the Western District of Texas, Austin Division (“ <i>Complaint</i> ”)
EX-1010	U.S. Patent No. 6,499,638 to Campbell (filed July 17, 2001, issued December 31, 2002) (“ <i>Campbell</i> ”)
EX-1011	U.S. Patent No. 5,977,876 to Coleman (filed August 13, 1998, issued November 2, 1999) (“ <i>Coleman</i> ”)
EX-1012	U.S. Patent No. 6,218,929 to Furuta et al. (filed June 10, 1998, issued April 17, 2001) (“ <i>Furuta</i> ”)
EX-1013	U.S. Patent No. 6,608,548 to Pellaton et al. (filed May 22, 1998, issued August 19, 2003) (“ <i>Pellaton</i> ”)
EX-1014	U.S. Patent No. 7,277,726 to Ahya et al. (filed May 3, 2004, issued October 2, 2007) (“ <i>Ahya</i> ”)
EX-1015	U.S. Patent No. 7,181,229 to Singh et al. (filed September 23, 2003, issued February 20, 2007) (“ <i>Singh</i> ”)

14. I performed my own analysis of the prior art identified herein and independently came to my own conclusions.

V. LEGAL STANDARDS

15. My understanding of the legal principles applicable to patentability based on 35 U.S.C. §§ 102 and 103 is set forth below.

A. Level of Ordinary Skill in the Art

16. The claims and specification of a patent are to be read and construed through the eyes of a person of ordinary skill in the art (“POSA”) at the time the

invention was made. To determine the appropriate level of one of ordinary skill in the art, the following factors may be considered: (a) the types of problems encountered by those working in the field and prior art solutions thereto; (b) the sophistication of the technology in question, and the rapidity with which innovations occur in the field; and (c) the educational level of active workers in the field.

B. Claim Construction

17. In an invalidity analysis, in order to assess whether a certain claim element is present in the prior art, the claim element must first be construed, and then the prior art must be evaluated to determine whether it satisfies the properly-construed element of the claim. A patent claim is construed from the perspective of a POSA at the time of the invention, taking into account the claim language, the teachings of the patent specification, and the patent's prosecution history.

18. For the sake of my analysis, unless otherwise noted below, I have adopted Be Smarter's proposed constructions. I understand that Patent Owner Yondr, Inc. ("Yondr") has not yet disclosed any of its proposed constructions to Be Smarter.

C. Anticipation

19. A patent claim is invalid as being "anticipated" under 35 U.S.C. § 102 if each limitation of the claim is disclosed explicitly or inherently in a single prior art reference. I further understand that a limitation is disclosed inherently if it is

necessarily present in the prior art reference or is the natural result flowing from the disclosure of the prior art reference.

D. Obviousness

20. A patent claim is invalid as being “obvious” under 35 U.S.C. § 103 if the differences between the claimed subject matter and the prior art are such that the claimed subject matter as a whole would have been obvious to a POSA at the time the invention was made. I also understand that in order to assess whether a claim would have been obvious in light of the prior art, I must step back in time and adopt the viewpoint of the hypothetical POSA when the invention was unknown and just before it was made, which in this case is the timeframe prior to April 21, 2015. I must then make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person.

21. The following factors are considered in determining whether a claimed invention is invalid as obvious over the prior art: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art and (4) any “secondary considerations” that may serve as evidence of nonobviousness, such as commercial success, long-felt but unsolved need, unsuccessful attempts by others in the field, copying of the claimed invention, unexpected and superior results, acceptance and praise by others, independent invention by others, and similar considerations.

22. A POSA is presumed to know all relevant prior art. A reference may be modified or combined with other references or with the POSA's own knowledge if the person would have found the modification or combination obvious. In considering whether a claim is obvious, I understand that I can take account of inferences and creative steps that a POSA would employ, the common knowledge of the art that such a person would possess, and whether there is a teaching, suggestion, or motivation to combine such references.

23. However, there is no rigid rule that a reference or combination of references must contain a "teaching, suggestion, or motivation" to combine references. Nevertheless, the "teaching, suggestion, or motivation" test can be a useful guide in establishing a rationale for combining elements of the prior art. This test asks whether there is an express or implied teaching, suggestion or motivation to combine prior art elements in a way that realizes the claimed invention, and that it seeks to counter impermissible hindsight analysis.

24. The combination of familiar elements disclosed in the prior art according to known methods is likely to be obvious when it does no more than yield predictable results. I understand that if a technique has been used to improve one product, and a POSA would recognize that it would improve similar products in the same way, using the technique is obvious unless its actual application is beyond the skill of a POSA. The proper analysis of obviousness determines whether a POSA

would have a “reasonable expectation of success”—not an “absolute predictability” of success—in achieving the claimed invention by combining prior art references.

25. While there is no requirement that the prior art contain an express suggestion to combine known elements to achieve the claimed invention, a suggestion to combine known elements to achieve the claimed invention may come from the prior art as a whole or individually, as filtered through the knowledge of one skilled in the art. A POSA often will be able to fit the teachings of multiple references together like the pieces of a puzzle. Any need or problem known in the field and addressed by the reference can provide a reason for combining the elements in the manner claimed.

26. If a POSA can implement a predictable variation and would see the benefit of doing so, that variation is likely to be obvious. In many fields, there may be little discussion of obvious combinations, and in these fields market demand—not scientific literature—may drive design trends. When there is a design need or market pressure, and there are a finite number of predictable solutions, a POSA has good reason to pursue those known options.

VI. OVERVIEW OF THE '788 PATENT

A. The '788 Patent

1. Overview of the Specification

27. The '788 patent is titled “System and Apparatus for Selectively

Limiting User Control of an Electronic Device” and lists Graham Dugoni as both the Applicant and Inventor. EX-1001, Title page. The ’788 patent was filed as Application No. 14/692,530 on April 21, 2015, and issued on November 14, 2017. EX-1001, Title page.

28. The Abstract of the ’788 Patent summarizes its disclosures as follows:

A system and apparatus for selectively limiting user control of a mobile electronic device are provided. In an embodiment, the apparatus may be a case sized to receive a mobile electronic device, the case having a locking means to at least partially secure an opening thereof. When engaged, the locking means may be physically impenetrable by the user of the mobile electronic device and may further be configured to engage and disengage in the presence of one or more pre-determined conditions. For example, the lock may engage when the case is detected within a certain geographical region or even during a specified time. It is contemplated that providing disclosed systems and apparatuses may reduce undesirable behavior at communal events by eliminating distractions posed by mobile electronic devices and preventing unauthorized recordings, which together may enhance overall engagement at and enjoyment of such events.

EX-1001, Abstract.

29. In the specification, the ’788 patent has a section entitled “Cross-Reference to Related Applications,” which makes reference to Provisional Patent

Application No. 61/982,789 filed on April 22, 2014. EX-1001, 1:8–11. I understand this is not a proper claim for priority. Regardless, a priority date of April 22, 2014, instead of April 21, 2015, would not change my opinions set forth in this declaration. I also understand from counsel that Yondr has provided its own “infringement contentions” in the pending district court litigation and, in its contentions, Yondr alleges April 21, 2015, is the correct priority date.

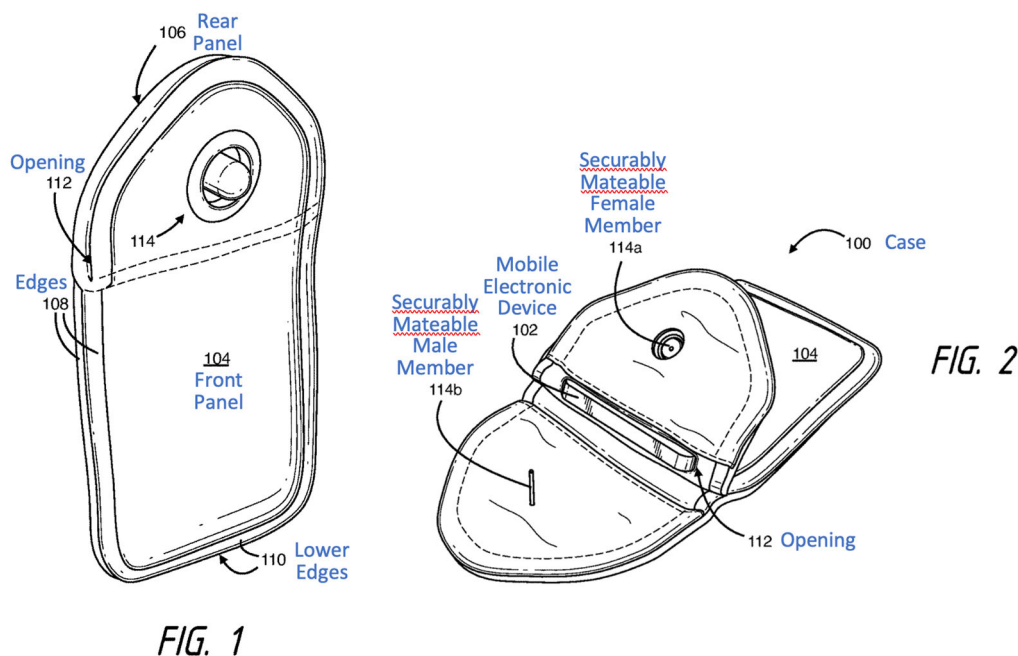
30. The ’788 patent describes its technical field as relating to systems and apparatuses “for limiting functionality of personal electronic devices and, more particularly, to locking cases and other techniques that selectively limit a user’s ability to access and control such electronic devices until predetermined conditions, such as geographic location and passage of time, are met.” EX-1001, 1:37–42.

31. In the Background, the ’788 patent acknowledges prior art attempts made to limit use of mobile electronic devices, including shutting off a cellphone and preventing its user from turning it on within a restricted area. EX-1001, 1:66–2:3 (referencing *Singh* (EX-1015)). The ’788 patent characterized that solution as a geographically limited application that was “also deficient because it fails to block the screen to diminish possible temptation to use the device.” EX-1001, 2:9–11.

32. The ’788 patent further states that other attempts to discourage the use of mobile electronic devices “at communal events and in certain venues” such as providing signs and instructions or requiring people to leave them at home, turn them

off or hand them to event staff have been ineffective and met with resistance. EX-1001, 2:12–24.

33. As a purported solution to the problem of “limiting access to and control of personal mobile electronic devices within certain geographic locations or even during specified periods of time,” the ’788 patent describes “a case sized to accommodate a mobile electronic device.” EX-1001, 2:34–47. Specifically, the ’788 patent describes a case having a front and rear panel secured together along longitudinally opposed side edge and laterally opposed lower edges to form an opening to receive an electronic device, such as shown in Figures 1 and 2 (to which I have added annotations in blue):



EX-1001, Figs. 1–2, 2:46–52, 5:62–6:6; *see also* EX-1001 at Figs. 3–4.

34. The '788 patent further discloses that this case may include a locking means to render the device inaccessible to the user until a predetermined condition, such as geographic location or timing, is met. EX-1001, 2:53–3:8. For example, the '788 patent describes that in one embodiment, the case may render the mobile electronic device inaccessible during an event such as a show or athletic competition within a concert hall, center, arena, or similar venue with the locking means only becoming disengageable if the user leaves the venue or at such a time as the event is over. EX-1001, 3:1–8.

35. The '788 patent alternatively discloses the locking means could be remotely engageable and disengageable via the use of an RFID receiver or a microprocessor equipped to receive Bluetooth or wireless signals. EX-1001, 3:8–36, 6:39–7:53. The '788 patent also teaches that in some embodiments the case could be manually unlocked by “venue staff.” EX-1001, 3:10–13.

36. Referring to Figures 1–4, the '788 patent describes that case 100 may be sized to accommodate a mobile electronic device 102. EX-1001, 5:62–65. The '788 patent describes that the mobile electronic device could be “a cell phone, smart phone, or tablet computer but may also be embodied in any one of a wide variety of wired and/or wireless computing devices.” EX-1001, 8:38–41.

37. The '788 patent further describes that the case includes a front panel 104 and a rear panel 106 that are secured together along longitudinally opposed side

edges 108 and laterally opposed lower edges 110 as shown in Figure 1 above. EX-1001, 5:65–6:1.

38. The '788 patent notes that even though the illustrations show a “soft, flexible case,” other configurations for the case are contemplated such as “a rigid shell or box having a securable, opening to receive a mobile electronic device.” EX-1001, 6:7–15. This is similar to the prior art disclosures I discuss below, which together indicate persons of ordinary skill in the art regularly contemplated the term “case” to have a broad meaning that could refer to a “soft, flexible case” or a more “rigid shell or box” structure similar to a briefcase or small piece of luggage.

39. The '788 patent describes one embodiment of a locking means as “opposing plates disposed on or within the front and rear panels 106, 108 of the case 100” and that for locking, “each opposing plate has one of a securably mateable female 114a and male 114b member.” EX-1001, 6:25–29. However, the '788 patent discloses that other locking means such as “magnetic plates, selectively releasable mesh, lockable zippers” or a “key operated latch” could be used. EX-1001, 6:25–44.

40. The '788 patent further describes that the case may include “means for unlocking the case” that together with the locking means enable the automatic locking and unlocking of the case “within and outside of a defined geographical region” or in response to the existence of a predetermined condition relating to the passage of time. EX-1001, 7:9–63.

2. Claims

41. The '788 patent contains 9 claims. Claims 1–3 are independent claims, and claims 4–9 depend from claim 3. For purposes of my analysis, bold labels have been added to the claims 1–8 below in order to have a shorthand for referring back to parts of each claim.

42. Independent claim 1 of the '788 patent is:

1 (preamble) A case for selectively limiting a user's ability to control such user's own mobile electronic device, comprising,

1(a) a shell defining a cavity sized to accommodate the user's mobile electronic device and having an opening to receive the user's mobile electronic device therein; and

1(b) a locking means for at least partially securing the opening of the shell so that the electronic device is rendered inaccessible to the user, the locking means being further non-disengageable by the user of the mobile electronic device;

1(c) wherein the predetermined condition is physical presence of the case outside of a defined geographical region.

43. I understand the Applicant has applied for a Certificate of Correction to add the words “until a predetermined condition is met” after “mobile electronic device” at the end of element 1(b) but that until that Certificate of Correction is entered, those additional words are not part of the claim. EX-1004–172 (Request for Certificate of Correction).

44. Independent claim 2 of the '788 patent is:

2 (preamble) A case for selectively limiting a user's ability to control such user's own mobile electronic device, comprising,

2(a) a shell defining a cavity sized to accommodate the user's mobile electronic device and having an opening to receive the user's mobile electronic device therein; and

2(b) a locking means for at least partially securing the opening of the shell so that the electronic device is rendered inaccessible to the user, the locking means being further non-disengageable by the user of the mobile electronic device;

2(c) wherein the predetermined condition is the passage of time.

45. I understand the Applicant has applied for a Certificate of Correction to add the words "until a predetermined condition is met" after "mobile electronic device" at the end of element 2(b) but that until that Certificate of Correction is entered, those additional words are not part of the claim. EX-1004-172 (Request for Certificate of Correction).

46. Claims 1 and 2 are nearly identical claims directed at a case. The preambles are the same, 1(a) and 2(a) are the same, and 1(b) and 2(b) are the same. The only distinction between the two claims lies in element (c), which requires in claim 1 that the predetermined condition is "physical presence of the case outside of

a defined geographical region” and in claim 2 that the predetermined condition is “the passage of time.”

47. Independent claim 3 of the ’788 patent is directed at a system:

3 (preamble) A system for selectively limiting a user’s control of such user’s own electronic device, comprising:

3(a) a case sized to receive the user’s mobile electronic device having

3(b) a front and a rear panel each having first and second longitudinally opposed side edges and laterally opposed lower edges,

3(c) the first, second, and lower edges being secured together to define an opening for receiving a mobile electronic device, the case operative to become locked so that the user is unable to access his own mobile electronic device contained therein until a predetermined condition is met;

3(d) a locking means for at least partially securing the opening; and

3(e) means for unlocking the case.

48. Dependent claim 4 of the ’788 patent is:

4. The case of claim 3, wherein the locking means comprises a female and a male plate, the plates respectively disposed on each

of the front and rear panels and configured to securably mate with one another.

49. Dependent claim 5 of the '788 patent is:

5. The case of claim 4, wherein at least one of the female and male plates comprise a radio frequency identification tag operative to receive instructions from a remote transmitter to disengage the locking means when the predetermined condition is met.

50. Dependent claim 6 of the '788 patent is:

6. The case of claim 3, wherein a microprocessor is further disposed in one or both of the female and male plates to receive a wireless data signal from a beacon or transmitter to disengage the locking means when the predetermined condition is met.

51. Dependent claim 7 of the '788 patent is:

7. The case of claim 3, wherein the predetermined condition is physical presence outside of a defined geographical region.

52. Dependent claim 8 of the '788 patent is:

8. The case of claim 3, wherein the predetermined condition for unlocking the case is the passage of time.

3. Claim Terms

53. Although I understand that the phrase “until a predetermined condition is met” is not yet a part of the claims, I have been informed that for purposes of this

declaration, I should interpret claims 1 and 2 to require that the locking means is non-disengageable by the user of the mobile electronic device until a predetermined condition is met in order to provide a proper antecedent basis for “the predetermined condition.”

54. Similarly, I understand that “the passage of time” in claim 2 lacks an antecedent basis and for purposes of this declaration I have been informed to treat “the passage of time” as if it refers to “a passage of time.”

55. Each independent claim of the ’788 patent refers to a “locking means,” which I understand requires construction under the means-plus-function framework to determine its meaning. Claims 1 and 2 require “a locking means *for at least partially securing the opening of the shell so that the electronic device is rendered inaccessible to the user.*” EX-1001, claims 1 and 2 (emphasis added). In claims 1 and 2, the securing is of the opening in the shell which is to “receive the user’s mobile electronic device” according to the initial claim language. Claims 1 and 2 also contain another requirement for the “locking means.” Specifically, the “locking means [is] further non-disengageable by the user of the mobile electronic device [until a predetermined condition is met]¹.” EX-1001, claims 1 and 2.

¹ As previously noted, the language in brackets is what was proposed in the patentee’s Request for Certificate of Correction.

56. The claim context for the “locking means” in system claim 3 of the ’788 patent is similar, but not identical, to that in claims 1 and 2. Claim 3 requires “a locking means *for at least partially securing the opening.*” EX-1001, claim 3 (emphasis added). The opening in claim 3 is first referred to in the context of “the first, second, and lower edges being secured together to define an opening for receiving a mobile electronic device.” EX-1001, claim 3. Claim 3 further requires that the case is “operative to become locked so that the user is unable to access his own mobile electronic device contained therein until a predetermined condition is met.” EX-1001, claim 3.

57. Thus, in each of the independent claims, the “locking means” is required to be controlled by someone other than the user of the mobile electronic device being contained within the case.

58. The ’788 patent specification discusses several different possibilities for the structure of a “locking means.” First, the ’788 patent describes that “the locking means may comprise opposing plates disposed on or within the front and rear panels of the case . . . having securably mateable female and a [*sic*] male members.” EX-1001, 2:53–56.

59. The specification also describes:

In one embodiment, *the locking means 114 comprises opposing plates disposed on or within the front and rear panels* 106, 108

of the case 100, and to effect locking, each opposing plate has one of a *securably mateable female 114a and male 114b member*. Other locking means are, of course contemplated. For example, *magnetic plates, selectively releasable mesh, lockable zippers*, and other means for at least partially securing the opening 112 may be sufficient to practice the invention. In this manner, the locking means 114 may first render the electronic device 102 inaccessible to the user by at least partially securing the opening 112 of the device, and second be non-disengageable by the user of the mobile electronic device until a predetermined condition is met.

EX-1001, 6:25–38 (emphasis added).

60. In another embodiment, the '788 patent describes that the locking means 114 is a “manual, key-operated latch” where the means for unlocking comprises a corresponding key such that the case may be “manually locked or unlocked by venue staff or other members in possession of such a key.” EX-1001, 6:42–51. It is my opinion that a manual, key-operated latch or any “locking means” that requires manual locking by venue staff or similar individuals does not meet the functional requirements of the “locking means” required by claims 1–3.

61. The '788 patent also describes an embodiment where the locking means (114) of the system (500) has electronic receivers such as a radio frequency identification (RFID) tag and means for unlocking the case, comprising an electronic article surveillance (EAS) detacher (502). EX-1001, 6:52–65.

62. I understand that Be Smarter is asserting that the proper claim construction for “locking means” for claims 1 and 2 should be a structure of “opposing plates with securably mateable female and male members, magnetic plates, selectively releasable mesh, or lockable zippers” for the function of “at least partially securing the opening of the shell so that the electronic device is rendered inaccessible to the user and non-disengageable by the user of the mobile electronic device until a predetermined condition is met.” That construction is consistent with my analysis of what the “locking means” requires in light of claims 1 and 2 and the specification of the ’788 patent.

63. Similarly, I understand that Be Smarter is asserting the proper construction of “locking means” in claim 3 should be a structure of “opposing plates with securably mateable female and male members, magnetic plates, selectively releasable mesh, or lockable zippers” for the function of “at least partially securing the opening so that the user is unable to access his own mobile electronic device contained therein until a predetermined condition is met.” That construction is consistent with my analysis of what the “locking means” requires in light of claim 3 and the specification of the ’788 patent.

64. Claim 3 also contains another means phrase, specifically, a “means for unlocking the case.” As with the “locking means,” I understand that the “means for unlocking” claim phrase must be construed in accordance with the means-plus-

function framework to have the function required by the claims and the structure disclosed in the specification for that function.

65. The '788 patent describes an embodiment of the “means for unlocking” that uses an EAS detacher that has strong magnets for disrupting electromagnetic fields to separate the mating portions of the locking means such as is shown in Figures 5 and 6 (to which I have added annotations in blue):

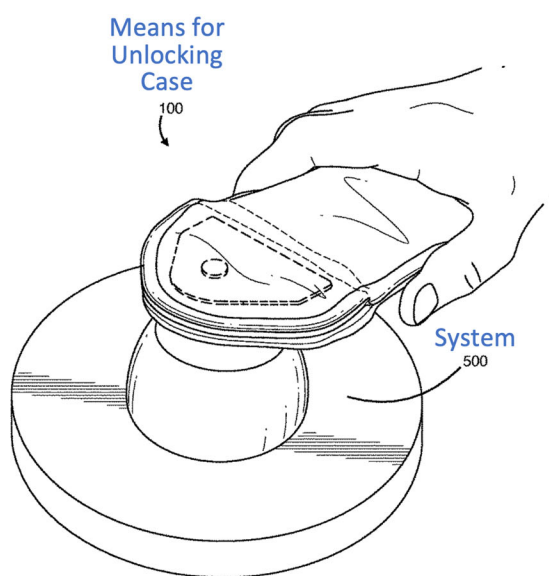


FIG. 5

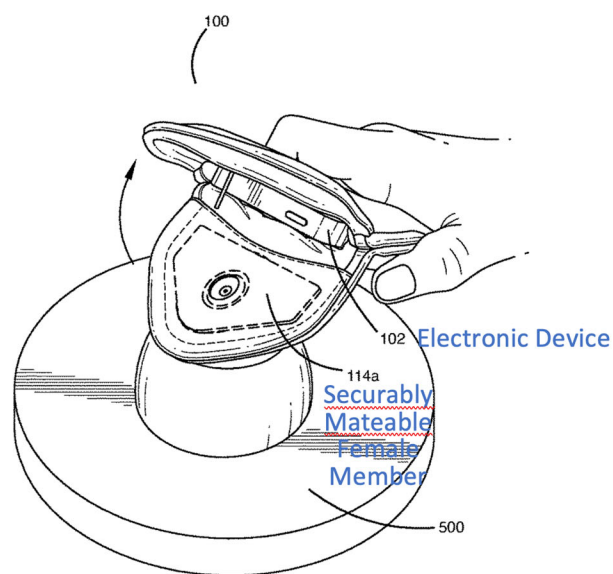


FIG. 6

EX-1001, Figures 5 and 6, 4:13–15 (noting Figures 5 and 6 show “an embodiment of means for unlocking an embodiment of the case for selectively limiting user control of an electronic device”), 6:52–7:8 (noting that for this embodiment, the “predetermined condition involves locating an EAS detacher”). In this embodiment, the user locates an EAS detacher to accomplish unlocking when the means for

unlocking is “placed outside of any audience viewing area or even at venue exit ways.” EX-1001, 6:52–7:8. Because this manual unlocking mechanism is accessible to the user, it is inconsistent with claim 3’s requirement that the case is “operative to become locked so that the user is unable to access his own mobile electronic device contained therein until a predetermined condition is met.” EX-1001, claim 3.

66. The ’788 patent also describes one “unlocking means” as a “corresponding key” to a “manual, key-operated latch.” EX-1001, 6:42–44. As I noted above, the “manual, key-operated latch” embodiment does not meet claim 3’s functional requirements for the required “locking means.” Therefore, the “corresponding key” cannot be a structure for the “unlocking means” required by claim 3.

67. In contrast to the manual unlocking embodiments described above, the ’788 patent illustrates in Figure 7 and describes in the specification an embodiment where the means for unlocking the case *operates remotely* to cause the case to automatically lock and unlock. EX-1001, FIG. 7, 7:9–10. As described in the ’788 patent:

The means for unlocking the case may also operate remotely to cause the case to automatically lock and unlock. For example, in one embodiment, the locking means may automatically lock and unlock when the case is determined to be, respectively, within and outside of a defined geographical region. For

example, with reference to FIG. 7, another embodiment of the system may comprise locking means 114 having electronic receivers such as the aforementioned RFID tag disposed therein and further configured to instruct the locking means to alternatively engage and disengage when it receives a signal from a proximity transmitter 702. Thus, for example, the locking means may receive instructions to lock the device when it is located in 100a the geographical region 704 within reach of the transmitter 702. Then, the locking means 114 may receive instructions to unlock the device when it is located outside 100b of the geographical region 704 within reach of the transmitter 702. In such an embodiment, it is contemplated that the predetermined condition requires a user to exit a geographical region to regain access and control of his or her mobile electronic device.

EX-1001, 7:9–29 (emphasis added); *see also* EX-1001, 7:30–63 (further discussing use of a transmitter to send signals to cause the locking means to lock or unlock).

68. I understand that based on these disclosures and the context of claim 3, Be Smarter proposes that the “means for unlocking the case” term has the function of “unlocking the case” and the structure of “an electronic signal transmitter.” That is consistent with my analysis of the claims and the specification of the ’788 patent.

69. Finally, the claims reference the phrase “mobile electronic device,” and I understand that Be Smarter proposes this phrase should have its plain and ordinary

meaning as viewed in light of the specification, which identifies cellphones, smart phones, and tablet computers as examples.

70. I understand that the prosecution history is sometimes helpful in determining the meaning of a claim term or phrase. I have reviewed the prosecution history and summarize it below, but I have not identified anything in the prosecution history that suggests any meanings different from what I discussed above.

B. The Prosecution History of the '788 Patent

71. In the prosecution history of the application (U.S. Patent Application No. 14/692,530) that led to the '788 patent, the first office action was issued by the Patent Office on October 3, 2016. EX-1004-044 (October 3, 2016 Office Action). Pending claims 1, 7, and 10 were rejected under 35 U.S.C. § 102(a)(1) as being anticipated by United States Patent Application Publication 2012/0187003 ("*Stewart*," EX-1007), which the Examiner noted disclosed "a case (figure 1, #10) for selectively limiting a user's ability to control a mobile electronic device (#11), comprising a front and a rear panel (figure 3) each having first and second longitudinally opposed side edges and laterally opposed lower edges (#16 or 24), the first, second, and lower edges being secured together to define an opening for receiving a mobile electronic device (#14) and a locking means (#16 or 24) for at least partially securing the opening so that the electronic device (#14) is rendered inaccessible to the user, the locking means (#16, or 24) being further non-

one another” from *Campbell* with the disclosed in *Stewart* “for the purpose of securing locking two plates together without much play between the plates.” EX-1004-051–053 (October 3, 2016 Office Action, at 7–9).

74. Pending claims 3, 4, 13, and 14 were rejected under 35 U.S.C. § 103 as unpatentable over *Stewart* in combination with *Campbell* and in further view of U.S. Patent No. 5,977,876 (“*Coleman*,” EX-1011) for its disclosures regarding use of an RFID tag and a radio transmitter to remotely disengage a locking means. EX-1004-054 (October 3, 2016 Office Action, at 10).

75. Pending claims 5 and 15 were rejected under 35 U.S.C. § 103 as obvious over *Stewart* in view of U.S. Patent No. 6,218,929 (“*Furuta*,” EX-1012), which taught the use of a predetermined condition that was physical presence outside of a defined geographical region for the purpose of unlocking. EX-1004-055–056 (October 3, 2016 Office Action, at 11–12).

76. Pending claims 6 and 16 were rejected under 35 U.S.C. § 103 as obvious over *Stewart* in view of U.S. Patent No. 6,608,548 (“*Pellaton*,” EX-1013), which disclosed the use of a predetermined condition that was the passage of time. EX-1004-057 (October 3, 2016 Office Action, at 13).

77. Finally, pending claim 17 was rejected in the first office action as unpatentable under 35 U.S.C. § 103 over *Stewart* in view of U.S. Patent No. 7,277,726 (“*Ahya*,” EX-1014), which disclosed remotely controlling a mobile

electronic device including the ability to send instructions to disable one or more functions. EX-1004-058–059 (October 3, 2016 Office Action, at 14–15).

78. On March 3, 2017, the Applicant responded by amending the claims, adding “user’s” as a modifier to “electronic device” in claims 1, 7, and 10 and arguing that *Stewart* did not teach “limiting a user’s access to his own property.” EX-1004-069–071, 073 (March 3, 2017 Response, at 2–4, 6). The Applicant also argued that the Examiner failed to establish a *prima facie* showing of obviousness regarding the *Stewart* combinations. Specifically, the Applicant argued that the Examiner failed to establish a teaching, motivation, or suggestion to combine the prior art. EX-1004-074–076 (March 3, 2017 Response, at 7–9). The Applicant did not otherwise address *Stewart* or the teachings of the other prior art raised by the Examiner.

79. The Examiner issued a Final Rejection on May 5, 2017. EX-1004-083–106 (May 5, 2017 Final Rejection). The Examiner again rejected pending claims 1–7, 10, and 12–17 under § 102 and § 103 over *Stewart* and the prior cited *Stewart* combinations. EX-1004-087–099 (May 5, 2017 Final Rejection, at 4–16).

80. However, rather than rejecting pending claims 8, 9, and 11, the Examiner instead objected to them because they depended on already-rejected claims and indicated they would be allowable if re-written in independent form. EX-

1004-099 (May 5, 2017 Final Rejection, at 16). Below, I excerpt the Applicant's amendments made to claims 8, 9, and 11 prior to issuance of the Final Rejection:

8. (Currently Amended) The case of claim 7, wherein the predetermined condition is physical presence of the case outside of a defined geographical region.

9. (Original) The case of claim 7, wherein the predetermined condition is the passage of time.

11. (Original) The system of claim 10, wherein the case comprises:
a front and a rear panel each having a first and second longitudinally opposed side edges and laterally opposed lower edges, the first, second, and lower edges being secured together to define an opening for receiving a mobile electronic device; and
a locking means for at least partially securing the opening.

EX-1004-070 (March 3, 2017 Amendment and Response to Office Action, at 3).

81. It is worth noting that in the Final Rejection the Examiner did not withdraw the rejections of pending claims 1, 5, and 6, which I excerpt below for comparison to the "objectionable" then-pending claims 8, 9, and 11:

1. (Currently Amended) A case for selectively limiting a user's ability to control [[a]]such user's own mobile electronic device, comprising:

a front and a rear panel each having first and second longitudinally opposed side edges and laterally opposed lower edges, the first, second, and lower edges being secured together to define an opening for receiving a mobile electronic device; and

a locking means for at least partially securing the opening so that the user's electronic device is rendered inaccessible to the user, the locking means being further non-disengageable by the user of the mobile electronic device until a predetermined condition is met.

5. (Currently Amended) The case of claim 1, wherein the predetermined condition is physical presence of the case outside of a defined geographical region.

6. (Original) The case of claim 1, wherein the predetermined condition is the passage of time.

EX-1004-069–070 (March 3, 2017 Amendment and Response to Office Action, at 2–3).

82. There seems to be no logical reason for the Examiner to have *rejected* then-pending claims 1, 5, and 6, but to have merely *objected to* claims 8, 9, and 10 with the suggestion that they be re-written in independent form, especially considering his rejection of claims 7 and 10 from which these claims depended.

83. In the Final Rejection, the Examiner also rejected Applicant’s argument that adding “user’s” to the pending claims differentiated the claims from the disclosures in *Stewart*. EX-1004-104–106 (May 5, 2017 Final Rejection, at 21–23).

84. In a response, the Applicant amended claims 8, 9, and 11 by re-writing those claims in independent form. EX-1004-119–121 (September 1, 2017 Response After Final Action, at 4–6). The Examiner then issued a Notice of Allowance with an AFCP 2.0 decision that checked box 1 (“All of the rejections in the most recent final Office action are overcome and a Notice of Allowance is issued herewith”). EX-1004-127, 133.

85. When the claims were issued, they were renumbered as follows:

Final Claim Number	Pending Claim Number
1	8
2	9
3	11
4	12
5	13
6	14
7	15
8	16
9	17

EX-1004-137.

86. The '788 patent then issued on November 14, 2017. EX-1004-147.

87. On February 14, 2022, the Applicant filed a “Petition to Accept Unintentionally Delayed Domestic Priority Claim Under 37 CFR 1.78(e)” and said that “Applicant did not set forth specific reference to the priority document in an Application Data Sheet. This oversight was entirely unintentional.” EX-1004-149–150. In addition to filing the petition, the Applicant submitted a Certificate of Correction requesting to correct the “Cross-Reference to Related Applications” to refer to 35 U.S.C. § 120 in the specification. EX-1004-150, 155.

88. The prosecution history of the '788 patent also includes a February 25, 2022 patent assignment from the listed inventor, Graham Dugoni, to Yondr, Inc. EX-1004-158–169. There is also a “Confirmatory Patent Assignment” from Graham

Dugoni to Yondr, Inc. signed on August 23, 2022 in the prosecution history. EX-1004-163–164.

89. On July 12, 2022, the Patent Office requested additional information from the Applicant regarding ongoing litigation in connection with the request to accept the delayed priority date claim. EX-1004-160–161. The Applicant responded to the request for information on August 24, 2022 and indicated that litigation in the Central District of California was ongoing. EX-1004-165–166.

90. Also on August 24, 2022, the Applicant submitted another Certificate of Correction and stated that it “corrects minor errors in Claims 1 and 2” and suggested corrections as shown below:

<p>Col. 10, lines 52-53 [Claim 1] “...electronic device; ...” should read — “...electronic device until a predetermined condition is met; ...”</p> <p>Col. 10, lines 64-65 [Claim 2] “...electronic device; ...” should read — “...electronic device until a predetermined condition is met; ...”</p>

EX-1004-172–174. The Applicant explained that when then-pending claims 8 and 9 (issued claims 1 and 2) were re-written to independent form that “due to a typographical error, the language ‘. . . until a predetermined condition is met . . .’ was excluded from both claims.” EX-1004-172–173.

VII. LEVEL OF ORDINARY SKILL IN THE ART

91. It is my opinion that a person of ordinary skill in the art (“POSA”) as of the priority date for the ’788 patent would have possessed at least a bachelor’s

degree in mechanical engineering, electrical engineering, or computer science and two or more years of experience in electromechanical product design. It is further my opinion that a person could have qualified with more formal education and less technical experience or *vice versa*.

92. My opinion regarding the level of ordinary skill in the art would not change if the priority date for the '788 patent is April 22, 2014, rather than April 21, 2015.

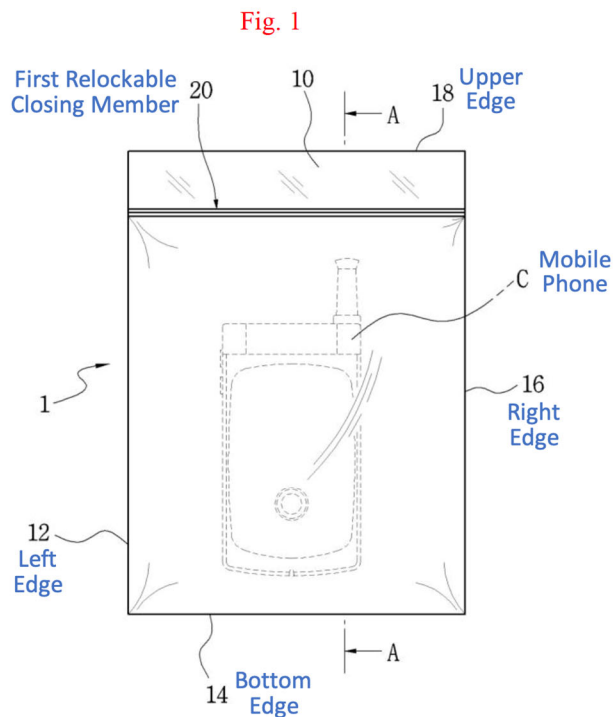
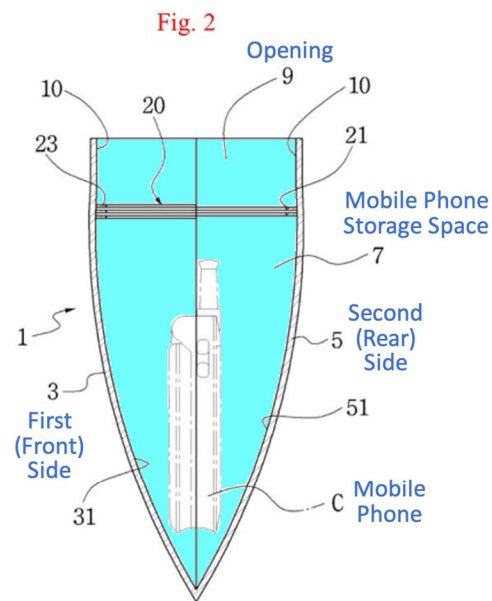
VIII. OVERVIEW OF CERTAIN PRIOR ART

A. *Shin* (EX-1006)

93. I understand that Korean Patent No. 10-2007-0041248 ("*Shin*"), EX-1006, entitled "Radio Wave Blocking Envelope for Storing a Mobile Phone," was published on April 18, 2007. As this date is prior to the effective filing date of the '788 patent (April 21, 2015), I understand *Shin* is prior art to the '788 patent.

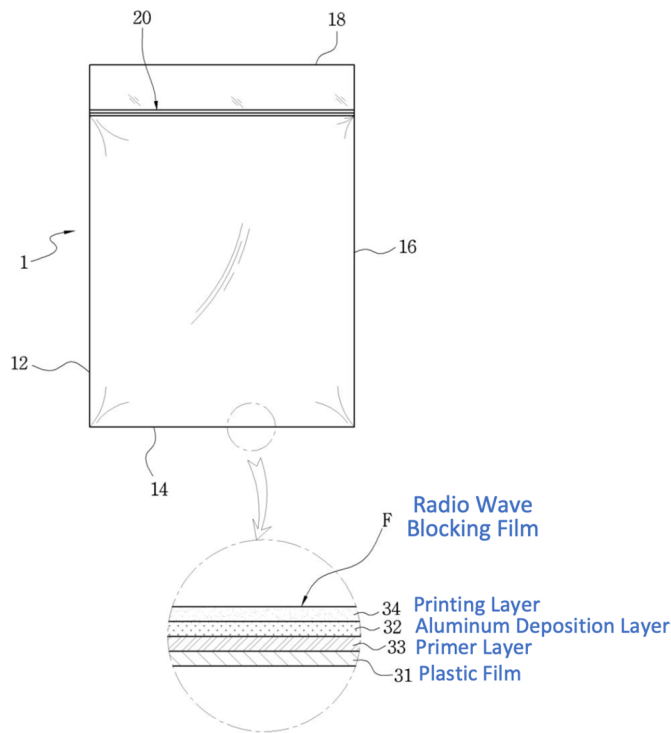
94. *Shin* discloses a system for selectively limiting a user's ability to control such user's own mobile electronic device, a "radio wave blocking envelope for storing a mobile phone that prevents the mobile phone stored inside the envelope from receiving high frequency radio waves." EX-1006, Abstract. *Shin*'s system can "temporarily store a mobile phone and prevent incoming calls from being received during storage, thereby preventing phone rings or vibration sounds in public places where silence is required." EX-1006, Abstract.

95. The case, or “envelope” of *Shin*’s system, is dimensioned appropriately to receive the user’s mobile device, and has “sufficient size to form a mobile phone storage space.” EX-1006, Abstract. As shown in *Shin*’s Fig. 1 (“Front view of a mobile phone storage envelope in a locked state”) and Fig. 2 (“Cross-sectional view of the mobile phone storage envelope in an open state”) below (to which I have added annotations in blue), this case has a front (3) and rear panel (5) each having first (12) and second (16) longitudinally opposed side edges and laterally opposed lower edges (14). The first, second, and lower edges of *Shin*’s case are secured together to define an opening (9, highlighted in light blue) providing access to a mobile phone storage space (7, highlighted in light blue) for receiving a mobile electronic device (C), the case operative to become locked (Fig. 1) so that the user is unable to access his own mobile electronic device contained therein until a predetermined condition is met. *Shin*’s case features a locking means (20) for at least partially securing the opening, the locking means being further non-disengageable by the user of the mobile electronic device, and a means for unlocking the case (Fig. 2).



96. The first and second sides of *Shin*'s case are made of a "radio wave blocking film including at least one or more conductive metal layers." EX-1006, Specification, at 6. In one embodiment, shown in *Shin*'s Fig. 3a below, this blocking film "comprises a plastic film layer 31 having a predetermined thickness (10–100 μm), an aluminum deposition layer 32 having a predetermined thickness (5–30 μm) vacuum-deposited thereon, and a primer layer 33 coated between the plastic film layer 31 and the aluminum deposition layer 32 to improve adhesion." EX-1006, Specification, at 7.

Fig. 3a



97. The locking means (20) of *Shin's* case comprises a male plate (or “profile strip” 21) and a female plate (or “profile strip” 23) that are respectively disposed on each of the front and rear panels and configured to securely mate with one another “to lock the opening 9 of the envelope.” EX-1006, Specification, at 7.

98. *Shin* discloses a predetermined condition that must be met before the user is able to access his own mobile electronic device contained within the case: the passage of time. *Shin's* case comprises a “timer means that automatically opens a portion of the envelope after a predetermined time, for example, after the

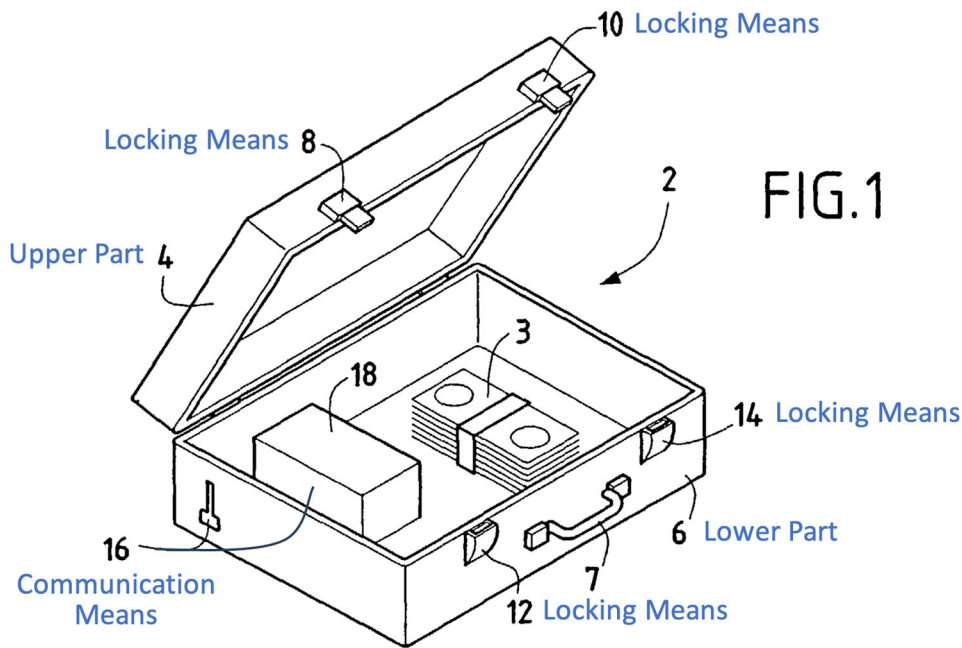
performance ends, allowing incoming calls from outside to be received.” EX-1006, Specification, at 10.

B. *Samuel* (EX-1005)

99. I understand that U.S. Publication No. 2003/0011466 (“*Samuel*”), EX-1005, entitled “Device and Method for Safe Transport of an Object,” was published on January 16, 2003, from an application filed on February 15, 2001. As both dates are prior to the effective filing date of the ’788 patent (April 21, 2015), I understand *Samuel* is prior art to the ’788 patent.

100. *Samuel* discloses devices for the securely transporting objects which can be remotely monitored, unlocked, and opened based on a predetermined condition, such as when the container reaches a specific location. EX-1005, [0014]–[0020], [0038], [0041], [0069], [0073], [0124], [0182], cls. 1, 18.

101. In one example, *Samuel* teaches using a case with two parts (4, 6) that can be closed by locking means (8, 10, 12, and 14 as shown in *Samuel*’s Figure 1, to which I have added annotations in blue):



102. In this example, communication means (16, 18) can send signals to a “monitoring system” (22) to track and control the opening and closing of the locking means (8, 10, 12, 14). EX-1005, Fig. 1, [0083], [0088]–[0090], [0105]–[0109].

103. Note that while the *Samuel* device shown in Figure 1 is a hard case, *Samuel* provides other exemplary devices. Specifically, *Samuel* expressly teaches the device could be a parcel type device made of a “flexible material” with an “envelope format”—*i.e.*, a pouch. EX-1005, [0091].

104. Finally, *Samuel* teaches that “GPS location means” could be used to track the location of the *Samuel* device. EX-1005, [0174]–[0178]. *Samuel* also teaches that the device may be equipped with means for sending and receiving RF signals to and from the monitoring system. *Id.*

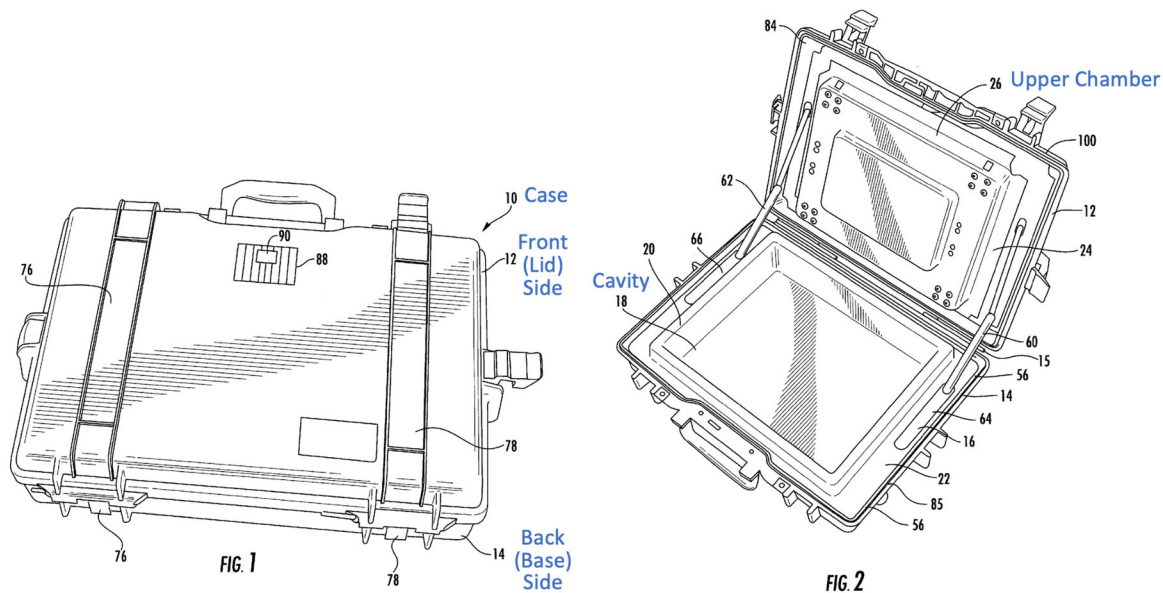
C. *Simpson* (EX-1008)

105. I understand that U.S. Patent 2014/0298492 to Simpson (“*Simpson*”), EX-1008, entitled “Security Case,” was published on October 2, 2014 from an application filed on March 14, 2014. As both dates are prior to the effective filing date of the ’788 patent (April 21, 2015), I understand that *Simpson* is prior art to the ’788 patent.

106. Simpson discloses a system for selectively limiting a user’s access to and ability to control such user’s own “valuable objects”, including mobile electronic devices, via a “a portable container which restricts access to the contents within the container to authorized individuals and enables the container to be tracked.” EX-1008, [0002]. The case, or “container” of Simpson’s system “is secure in its locked condition by locks which are preferably operated by an electronic key. The electronic key can be programmed to open the case or container dependent upon various different conditions, for example, location, time, ...” EX-1008, Abstract.

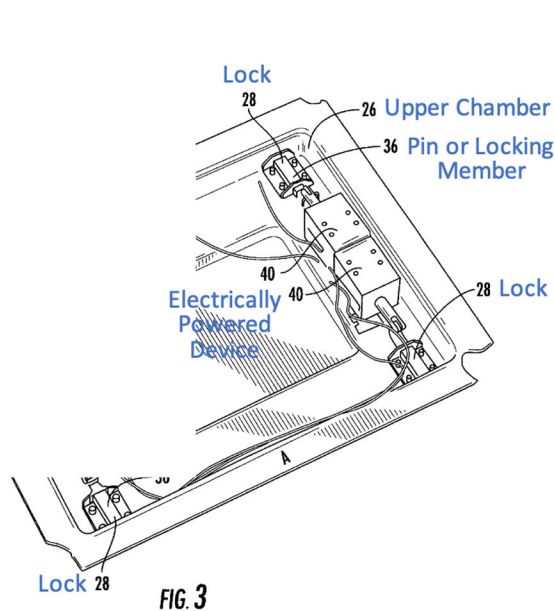
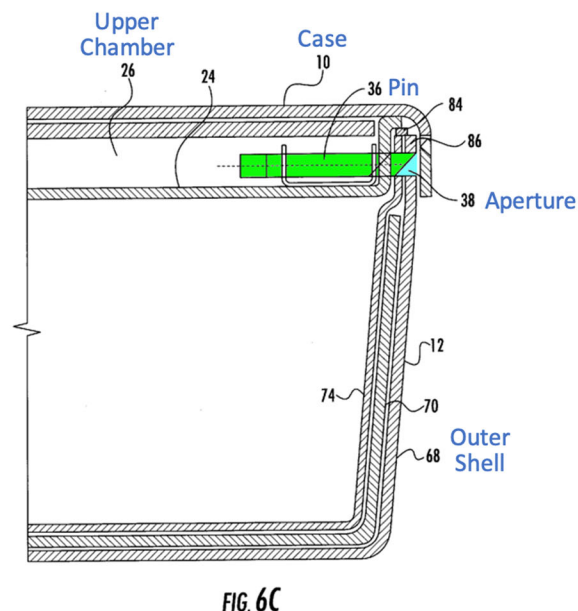
107. The case of Simpson’s system is dimensioned appropriately to receive the user’s mobile device (mobile phone, tablet computer, laptop computer, etc.), enabling the “storing and transporting” of the device “in a secure manner, the case comprising: a lid coupled to a base and cooperating therewith to define a closable storage chamber.” EX-1008, Claim 1. As shown in Simpson’s Fig. 1 (“a top

perspective view of the present invention”) and Fig. 2 (“a perspective view of the interior of the present invention”) below (to which I have added annotations in blue), this case (10) has a front (“lid” 12) and rear panel (“base” 14), each having first and second longitudinally opposed side edges and laterally opposed lower edges. The first, second, and lower edges of Simpson’s case define an opening (“cavity” 18) for receiving a mobile electronic device, the case operative to become locked (Fig. 1) so that the user is unable to access his own mobile electronic device contained therein until a predetermined condition is met.



108. As shown in Simpson’s Fig. 3 (“a view of the locking mechanism of the present invention”) and Fig. 6c (“a cross sectional view of a lower portion of the case”) below (to which I have added annotations in blue and highlighting), Simpson’s case features a locking means (28) housed within the upper chamber (26)

for at least partially securing the opening, the locking means being further non-disengageable by the user of the mobile electronic device, and a means for unlocking the case (Fig. 2). *Simpson's* locking means comprises opposing plates with securably mateable male (“pin” 36, highlighted in green) and female (“aperture” 38, highlighted in light blue) members, actuated by an “electronically powered device” (40), for the function of at least partially securing the opening of the case so that the electronic device is rendered inaccessible to the user and non-disengageable by the user of the secured device until a predetermined condition is met. “In the retracted or open position, the pin 36 does not extend into an aperture in the side of the lower portion 14 of the case. In the locked position, the pin 36 extends into the aperture 38 in the side of the lower portion.” EX-1008, Abstract, [0037].



109. The locking means of *Simpson's* case includes a “GPS type of location device,” which enables the location of the case to be “tracked from remote locations.” EX-1008, [0006]. The locks (28) are “preferably operated by an electronic key” which can be “programmed to open the case or container dependent upon various conditions, for example location, time, identification of operator, etc.” EX-1008, Abstract. This electronic key “can be disabled or enabled from a signal transmitted by a satellite, a cellphone or a radio frequency transmission.” EX-1008, [0039].

110. Note that while the Simpson device shown in Figure 1 is a hard case, Simpson teaches that the case or container can be “made from different materials which are impermeable and resistant to heat, drilling and ballistic impact.” EX-1008, [0006].

D. *Stewart* (EX-1007)

111. I understand that U.S. Patent 2012/0187003 to Stewart et al. (“*Stewart*”), EX-1007, entitled “Soft Alarming Safer,” was published on July 26, 2012 from an application filed on January 21, 2011. As both dates are prior to the effective filing date of the ’788 patent (April 21, 2015), I understand that *Stewart* is prior art to the ’788 patent.

112. Stewart discloses a system for selectively limiting a user’s access to and ability to control “electronic and other high-priced items” or “products” via a

“security device having a flexible material into which a product may be sealed and unauthorized removal of the product triggers a security alarm.” EX-1007, Abstract. The case (“container” or “pouch”) of Stewart’s system “can operate in a locked or sealed orientation where product 14 is not accessible to customers” and “thereby prevent unwanted entry into pouch” EX-1007, [0022].

113. The “container” or “pouch” of Stewart’s system is dimensioned appropriately to receive “electronic and other high-priced items” (such as the mobile phone depicted in *Stewart’s* Figure 1 below, to which I have added annotations in blue), and comprises “a flexible material into which a product may be sealed and unauthorized removal of the product triggers a security alarm.” EX-1007, Abstract, [0004]. *Stewart’s* pouch (12) has a front (shown in Fig. 1) and rear panel, each having first and second longitudinally opposed side edges and laterally opposed lower edges. The first, second, and lower edges of *Stewart’s* case are secured together to define a “flexible housing” comprising “conductive material and an alarming device.” EX-1007, [0007]. When the seal (4) of the flexible housing is opened (as shown in Fig. 3, to which I have added annotations in blue) an opening provides access to a cavity (highlighted in light blue) for receiving a mobile electronic device. If opened “without deactivation of the alarming device [22]”, an electrical circuit initiates “activation of the alarming device.” EX-1007, [0007].

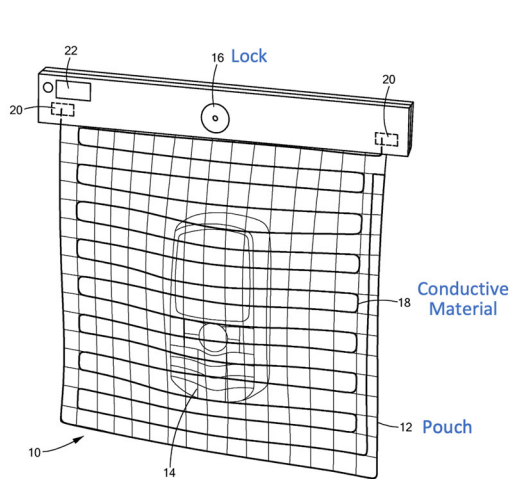


FIG. 1

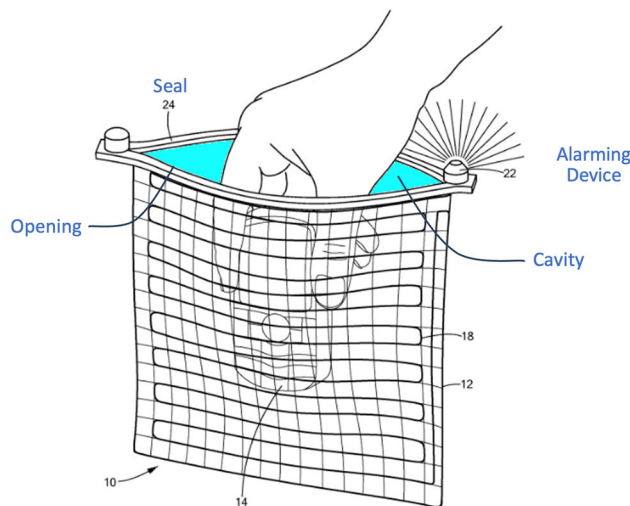


FIG. 3

114. As shown in Figs. 1 and 3 above, *Stewart's* “pouch 12 can operate in a locked or sealed orientation where product 14 is not accessible to customers. Lock 16 can secure a fold-down tab 16 to pouch 12 and thereby prevent unwanted entry into pouch 12. Lock 16 can be a magnetic lock similar to the type used in hard tags.” EX-1007, [0022]. *Stewart's* device further comprises “an unlocking mechanism to allow the product to be removed from within the flexible material without triggering the alarming device”, one embodiment being “existing detachers.” EX-1007, claim 5, [0022].

115. *Stewart's* security device can be configured to include “an electronic article surveillance (EAS) label affixed thereto, wherein the alarming device is triggered upon receipt by the EAS label of an EAS interrogation signal.” EX-1007, claim 6. Another embodiment further comprises “a radio frequency identification (RFID) element”. EX-1007, claim 7.

IX. MOTIVATIONS TO COMBINE

A. *Samuel* and *Shin*

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

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

EX-1005, [0091]; *see also* EX-1005, [0021] (envelopes or parcels). Therefore, a POSA would have recognized *Samuel* acknowledging the rigid case depicted in its figures could be replaced by a more flexible envelope design, such as the envelope shown in *Shin*. *See also*, EX-1006, Figs. 1-14.

117. In addition, both *Samuel* and *Shin* teach ways to at least temporarily prevent unauthorized access to objects in such a case or envelope. EX-1005, [0009]–[0020]; EX-1006, Abstract, 6–7. Thus, a POSA would understand these references address the same subject matter and would look to both to evaluate potential options for solving the problem of how to secure and prevent unauthorized access to an object such as a mobile electronic device or other valuables. For example, like *Samuel*, *Shin* discloses securably mateable female and male members that function to secure the opening providing further motivation to combine *Samuel* and *Shin*.

118. Finally, a POSA would have viewed *Shin's* objective to block cellphone signals for a pre-set period of time (via a “timer means”) to prevent use in public places and other venues as a motivation to combine *Shin's* envelope structure with *Samuel's* locking means to further limit the user's access to the cellphone stored in the *Shin* envelope for a pre-set period of time or in a specific geographic location (*e.g.*, in a concert hall, church, or school). EX-1006, 5, 9.

B. *Samuel, Shin, and Simpson*

119. In addition to combining *Samuel* and *Shin* for the reasons described above (*e.g.*, *Samuel* teaching the rigid case depicted in its figures could be replaced by a more flexible envelope design, such as the envelope shown in *Shin*, which results in the *Samuel* envelope), a POSA also would have been motivated to modify the *Samuel* envelope with disclosures from *Simpson* because *Simpson* describes a security case very similar to *Samuel* that accounts for advancements in wireless signal processing and locking/unlocking mechanisms since the publication of *Samuel*.

120. The security cases disclosed in *Samuel* and *Simpson* are very similar:

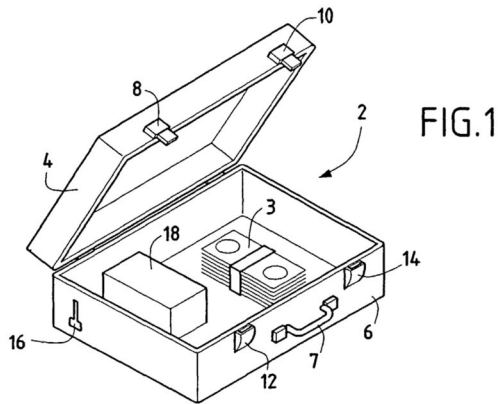


FIG. 1

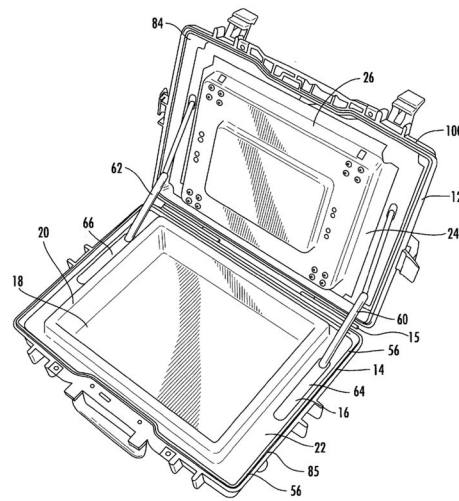


FIG. 2

Samuel

Simpson

EX-1005, Fig. 1; EX-1008, Fig. 2. That is, *Samuel* and *Simpson* both describe cases, as depicted in the figures above, briefcase-type structures, designed for the secure storage and transportation of valuable objects. EX-1005, Fig. 1, [0001]–[0002],[0084], [0182]; EX-1008, Fig. 2, Abstract, [0002]–[0003]. Both also teach locking mechanisms (locks 8, 10, 12, 14 in *Samuel* and locks 28 in *Simpson*) that may be unlocked using electronic means. EX-1005, Abstract, [0012]–[0013][0083], [0089]–[0090], [0105]–[0109], cl. 1; EX-1008, [0037]–[0039]. Furthermore, both *Samuel* and *Simpson* teach that such unlocking may be dependent on certain conditions. EX-1005, [0073], [0109], [0124]–[0125], [0137]–[0141]; EX-1008, Abstract, [0039], [0045], [0056]. Thus, not only are *Samuel* and *Simpson* references in the same field, but they describe similar security cases that require a predetermined condition to be met before the case can be unlocked. For these

reasons, a POSA would have been motivated to combine the disclosures of *Samuel* with those of *Simpson* in designing a secure case to store and prevent unauthorized access to valuables.

121. *Samuel* also teaches the case's status and **location** may be monitored, including by GPS, and a POSA would understand *Samuel's* monitoring of **location** may be a condition used to determine whether to send the unlock signal to the electronic means for unlocking. EX-1005, [0012]–[0013], [0038], [0067]–[0069], [0073], [0124]–[0125], [0174]–[0178]. *Simpson* similarly teaches its electronic key may be programmed to open the case depending on a location condition. EX-1008, Abstract, [0039]–[0040], [0045], [0056]. In addition, *Simpson* teaches the electronic key may be programmed to open the case depending on other conditions such as time or the identification of the operator. EX-1008, Abstract, [0039]. Thus, a POSA would have been motivated to start with *Samuel*, which pre-dates *Simpson*, and modify the *Samuel* case to account for alternative conditions for triggering the electronic key to unlock the case.

122. Next, *Samuel* contemplates **timing** as an aspect of programming a security case. Specifically, *Samuel* discloses that once the signal authorizing opening the case is received, its contents must be removed within a “particular time interval” or the case will lock again. EX-1005, [0137]–[0141]. *Samuel* thus acknowledges timing is a consideration for locking and unlocking signals, and it would be a natural

extension of *Samuel* for a POSA to condition opening of the case on the passage of time as described in *Simpson*. Similarly, *Shin* discloses the use of a “timer means” to block radio waves from entering the envelope until a set time has expired. EX-1006, 9.

123. Each of *Samuel*, *Simpson*, and *Shin* references also discloses ways to secure valuables, and a POSA looking to secure mobile electronic devices as one type of valuables would have been motivated to look to references attempting to solve the same problem.

124. A POSA looking to develop a secure case for mobile electronic devices would also consider variations on the predetermined conditions for unlocking the case, including by review of similar references. *Samuel* discloses the predetermined condition could be that the destination has been reached. EX-1005, [0123]–[0125], [0173]–[0176]. *Simpson*, like *Samuel*, describes the use of GPS location as a condition to determine whether to unlock the case. EX-1008, [0008], [0040], [0043], [0053]. In addition to GPS, *Simpson* teaches that other conditions could be used to initiate an unlock command, such as timing or the identification of an operator with biometric information. EX-1008, [0008], [0053]. Thus, a POSA would have been motivated to consider and combine the disclosures of *Samuel*, *Shin*, and *Simpson*.

X. APPLICATION OF PRIOR ART TO CLAIMS 1–4 AND 6–8 OF THE '788 PATENT

A. Claim 1 is Invalid in Light of *Samuel* or the Combination of *Samuel* and *Shin*

125. Claim 1 begins with a preamble reciting “[a] case for selectively limiting a user’s ability to control such user’s own mobile electronic device, comprising:” Even assuming that this preamble was found to be limiting, it is disclosed by *Samuel*.

126. *Samuel* teaches a “case” that fulfils the purpose recited in the preamble. Specifically, *Samuel* discloses “[a] device (2) for the secure transportation of an object (3),” which corresponds to the claimed “case.” EX-1005, Abstract. Indeed, *Samuel* explicitly describes device (2) as a “case”. EX-1005, [0093]. A POSA would have understood that the “object (3)” could be any number of valuable items, including a mobile electronic device such as a laptop computer or cellular telephone. Accordingly, A POSA would have understood the *Samuel* case could be used “for selectively limiting a user’s ability to control such user’s own mobile electronic device.”

127. *Samuel* further teaches its case may be locked without the ability to unlock the case until a specific state or condition is met. EX-1005, [009]-[0018], [0038]. *Samuel* specifically describes determining whether the location of the case corresponds to a predetermined location before sending an opening signal. EX-1005,

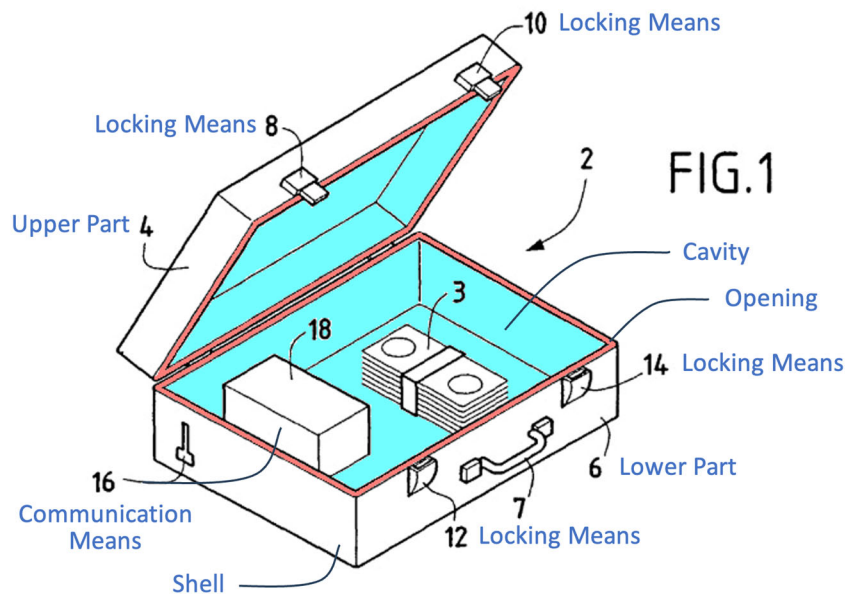
[0058], [0069], [0073], [0105]-[0109], [0124]–[0125]. In other words, *Samuel* teaches the object transported in the *Samuel* case is inaccessible to anyone, including the user, during transportation until the case reaches a predetermined location.

128. The case and object being transported described in *Samuel* are not limited to any particular size, as *Samuel* discloses it is “possible to use containers of any size”. EX-1005, [0021]. In other words, *Samuel* could be applied to any object secured in an appropriately sized case. For example, Figure 1 depicts a case transporting a quantity of cash that is similar in size to a cellphone. *Samuel*’s paragraphs 1 and 2 also provide examples of the object to be transported, including cash, checks, documents, valuable merchandise, industrial diamonds, or “rare materials.” EX-1005, [0001]–[0002], [0083]–[0084], [0182]. Therefore, the *Samuel* case could be a container for a mobile electronic device, such as a cellphone.

129. In addition, *Shin* clearly depicts a mobile phone stored in a container. EX-1006, Figs. 1–2, 6, 8, 11–14. Such a mobile phone is similar in size to the cash shown in *Samuel* Figure 1. Therefore, a POSA would appreciate that the mobile phone shown in *Shin* could be (i) a substitute for the cash, or (ii) the other “valuable object” described in *Samuel*.

1(a): “a shell defining a cavity sized to accommodate the user’s mobile electronic device and having an opening to receive the user’s mobile electronic device therein.”

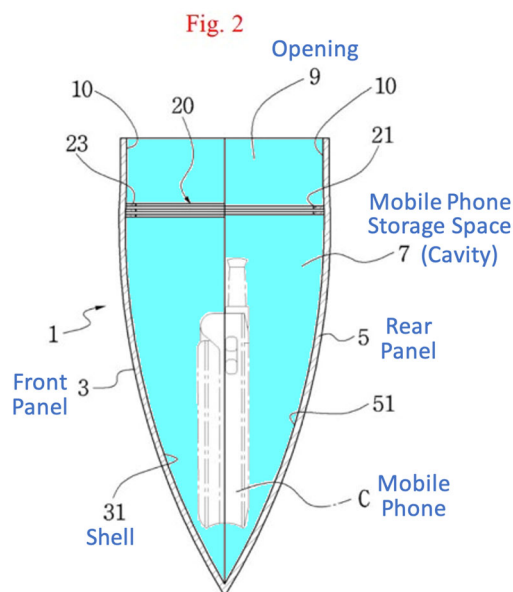
130. *Samuel* and *Shin* also teach the limitations of claim element 1(a). For example, *Samuel*’s Figure 1 depicts a lower part (6) of the case (2) having a cavity in which cash (3) is the object being securely transported. EX-1005, Fig. 1, [0083]–[0084]. And as I explained above, cash and mobile electronic devices, such as cellphones, are similar in size. Therefore, the cavity shown in *Samuel*’s case is “sized to accommodate the user’s mobile electronic device.” The opening of *Samuel*’s case is outlined in red, and the cavity is highlighted in light blue in the following diagram:



131. Furthermore, the *Samuel* case can be opened in order to insert the object being transported. Therefore, the *Samuel* case has an opening to receive a mobile electronic device.

132. *Shin* is similarly instructive. As explained above, *Shin* explicitly teaches that a mobile phone (which is a mobile electronic device) can be the valuable object contained within a shell. EX-1006, Figs. 1–2, 6, 8, and 11–14.

133. *Shin* also depicts and discusses opening portion (9), which receives the mobile phone into the envelope, as highlighted in light blue in the figure below. EX-1006, Figs. 2, 5, 7, 9 and 6–8 (discussing opening portion 9).



134. That is, *Shin*, like *Samuel*, discloses “having an opening to receive the user’s mobile electronic device.”

1(b): “a locking means for at least partially securing the opening of the shell so that the electronic device is rendered inaccessible to the user, the locking means being further non-disengageable by the user of the mobile electronic device [until a predetermined condition is met].”

135. *Samuel* depicts a “locking means” in its Figure 1 at 8, 10, 12, and 14.

EX-1005, Fig. 1. Samuel's locking means includes opposing plates with securably mateable female members (as shown in 12, 14) and male members (as shown in 8, 10). EX-1005, Fig. 1, [0083].

136. This structure performs the required function of rendering the object being stored inside the case inaccessible to the user until a certain condition has been met. For example, *Samuel* discloses that means (18) inside the case is able to monitor the state of the case (such as its location) and receive and act on closing or opening instructions received by electronic signals. EX-1005, [0088]–[0090], [0105]–[0109], [0124]–[0125], [0174]–[0178], cl. 1.

137. *Shin* also teaches use of a “locking means.” Specifically, *Shin* describes a closing member (20/120/220) that may include a male profile strip (21/121/221) and a female profile strip (23/123/223) that engage with each other to lock opening 9. EX-1006, Figs. 2, 5–7, 9–10, and pp. 7–8. In addition, *Shin* teaches that the male and female strips (*i.e.*, opposing plates with securably mateable female and male members) that make up the closing member may be a zipper that locks the envelope. EX-1006, 8. Thus, *Shin* discloses a closing member that meets the function and structure required by the “locking means,” particularly in view of the '788 patent's disclosure that locking means such as “magnetic plates, selectively releasable mesh, lockable zippers” could be used. EX-1001, 6:25–44.

138. A POSA also would have found using the *Shin* envelope with the

enhanced security of the locking means described in *Samuel* to be a natural modification of the locking means described in *Shin*.

139. Moreover, the *Samuel* locking means is “non-disengageable by the user of the mobile device” (or whatever object is stored in a *Samuel* case) because the locks cannot be unlocked until means (18) receives the appropriate signal to unlock the case. *See, e.g.*, EX-1005, [0109], [0124]–[0125].

140. Like *Samuel*, *Shin* teaches that the locking means is non-disengageable by the user in light of its objective to block cellphone signals for a pre-set period of time through a “timer means” (80) to prevent use in public places. Indeed, *Shin*’s objective to block cellphone signals further suggests combining *Shin*’s envelope structure with *Samuel*’s locking means to further limit the user’s access to the cellphone stored in the *Shin* envelope during a pre-set period of time or in a specific geographic location (*e.g.*, in a concert hall or church). EX-1006, 5, 9.

141. Finally, even if the patentee’s proposed correction “until a predetermined condition is met” is added to claim element 1(b), *Samuel* teaches the locking means is not disengageable by the user of the mobile electronic device until some predetermined condition is met. Specifically, *Samuel* discloses that a condition for deliverance of the signal to open the locking means may be whether the case has met a predetermined condition such as arriving at a predetermined location. EX-1005, [0038], [0069], [0073], [0125].

1(c): “wherein the predetermined condition is physical presence of the case outside of a defined geographic region.”

142. *Samuel* addresses the secure transportation of an object and uses its predetermined location (i.e., the case’s arrival at a destination address)—which is outside of a defined geographic region enclosing the case’s departure address—as a condition for sending a signal to unlock the case. *See, e.g.*, EX-1005, [0038], [0058], [0123]–[0125]. Therefore, *Samuel* anticipates the requirement in claim element 1(c) that “the predetermined condition is physical presence of the case outside of a defined geographic region.”

143. Likewise, *Shin* addresses the need to prevent access to phones in certain venues requiring silence (e.g., “concert halls, churches, courtrooms, lecture rooms, and libraries”). Limiting access by venue is a form of setting a geographic predetermined condition for cellphone access as required by claim element 1(c). Moreover, *Shin*’s explicit description of preventing cellphone access in certain locations provides another motivation to combine the disclosures of *Samuel* and *Shin* to arrive at the invention in claim 1 of the ’788 patent EX-1006, at 5.

B. Claim 2 is Obvious in Light of the Combination of *Samuel*, *Shin*, and *Simpson*

144. Claim 2 begins with the preamble reciting “[a] case for selectively limiting a user’s ability to control such user’s own mobile electronic device, comprising.” I understand that a claim preamble generally does not limit a claim but

in some circumstances it may. With respect to claim 2 of the '788 patent, whether or not the preamble is a limitation, it is disclosed by the combination of *Samuel*, *Shin*, and *Simpson*.

145. The preamble of claim 2 is identical to the preamble of claim 1. I therefore incorporate my analysis of the preamble of claim 1 into my discussion here regarding the preamble of claim 2 and repeat some of that analysis below for context.

146. *Samuel* teaches a “case” that fulfils the purpose recited in the preamble. Specifically, *Samuel* discloses “[a] device (2) for the secure transportation of an object (3),” which corresponds to the claimed “case.” EX-1005, Abstract. Indeed, *Samuel* explicitly describes device (2) as a “case”. EX-1005, [0093]. A POSA would have understood that the “object (3)” could be any number of valuable items, including a mobile electronic device such as a laptop computer or cellular telephone. Accordingly, a POSA would have understood the *Samuel* case could be used “for selectively limiting a user’s ability to control such user’s own mobile electronic device.”

147. *Samuel* further teaches its case may be locked without the ability to unlock the case until a specific state or condition is met. EX-1005, [009]–[0018], [0038]. *Samuel* specifically describes determining whether the location of the case is the same as a predetermined location before sending a signal to unlock. EX-1005, [0058], [0069], [0073], [0105]–[0109], [0124]–[0125]. In other words, *Samuel*

teaches the object transported in the *Samuel* case is inaccessible to anyone, including the user, during transportation until the case reaches a predetermined location.

148. The case and object being transported described in *Samuel* are not limited to any particular size, as *Samuel* discloses it is “possible to use containers of any size”. EX-1005, [0021]. In other words, *Samuel* could be applied to any object secured in an appropriately sized case. For example, Figure 1 depicts a case transporting a quantity of cash that is similar in size to a cellphone. *Samuel*’s paragraphs 1 and 2 also provide examples of the object to be transported, including cash, checks, documents, valuable merchandise, industrial diamonds, or “rare materials.” EX-1005, [0001]–[0002], [0083]–[0084], [0182]. Therefore, the *Samuel* case could be a container for a mobile electronic device, such as a cellphone.

149. In addition, *Shin* clearly depicts a mobile phone stored in a case. EX-1006, Figs. 1–2, 6, 8, 11–14. Such a mobile phone is similar in size to the cash shown in *Samuel* Figure 1. Therefore, a POSA would appreciate that the mobile phone shown in *Shin* could be (i) a substitute for the cash, or (ii) the other “valuable object” described in *Samuel*.

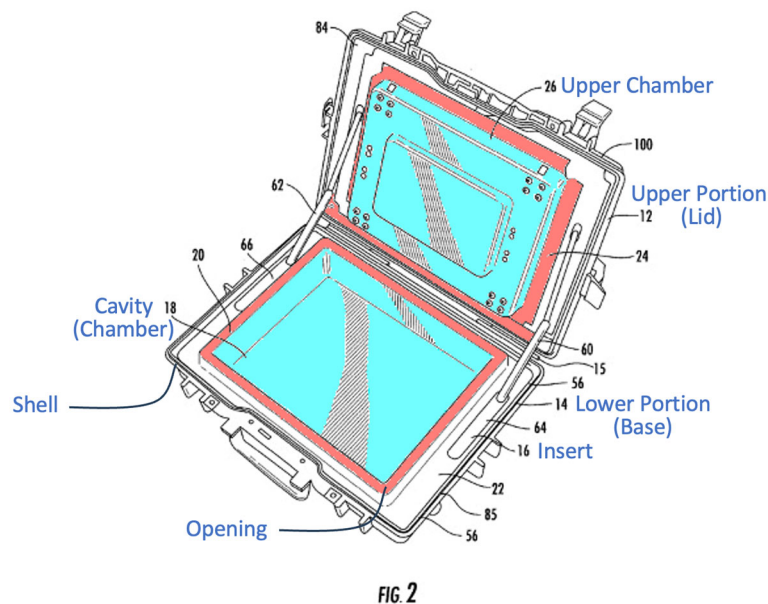
150. *Simpson* is also directed at a “Security Case.” EX-1008, Title, Figs. 1–2. *Simpson* discloses that its invention:

relates to the secure transportation of valuable objects; in particular, it relates to a portable container which restricts access

to the contents within the container to authorized individuals and enables the container to be tracked.

EX-1008, [0002]; *see also* EX-1008, [0009]–[0013] (objects of the invention including the use of restricted entry mechanisms and/or electronic keys). Thus, *Simpson* also teaches a case that restricts access to the “valuable object” being stored within the case in a way that selectively limits the user’s ability to control that object.

151. *Simpson* discloses examples of valuable objects that could be securely transported within its case as “jewelry, financial files, financial documents, credit cards, intelligence files, etc.” EX-1008, [0003]. One embodiment of the *Simpson* case is shown in Figure 2 below, where the opening of *Simpson*’s case is outlined in red, and the cavity (18) highlighted in light blue:



A POSA would understand from this illustration, as well as the other figures and descriptions in the text, that a mobile electronic device, such as a cellphone or tablet computer, could be a valuable object secured inside the *Simpson* case.

2(a): “a shell defining a cavity sized to accommodate the user’s mobile electronic device and having an opening to receive the user’s mobile electronic device therein”

152. Claim element 2(a) of the ’788 patent is identical to claim element 1(a).

I therefore incorporate here my discussion above of *Samuel* and *Shin* applied to claim element 1(a).

153. *Simpson* is also relevant to this claim element. In summarizing his invention, *Simpson* explains:

The present invention involves the provision of a security case for storing and transporting an item in a secure manner. The case includes a lid coupled to a base and cooperating therewith to define *a closable storage chamber*. At least one lock device is located inside the case and operable to selectively maintain the lid locked in a closed condition to the base, selectively resisting access to the storage chamber.

EX-1008, [0007] (emphasis added).

154. Additional detail is provided in Figure 2 and its accompanying description in *Simpson*, which discusses that case (10) has a lower portion (14) that includes “insert 16 [that] includes a cavity or lower chamber 18.” EX-1008, Fig. 2,

[0036]; *see also* EX-1008, Fig. 6A (showing insert 16 with a cavity to hold one or more valuables). To a POSA, these are descriptions of a “shell defining a cavity.”

155. *Simpson* further teaches that the “valuable articles to be securely transported are housed within the cavity or chamber 18.” EX-1008, [0036]. As I discussed with respect to the preamble, a POSA would understand that the valuable articles to be transported in a *Simpson* case could include a user’s mobile electronic device.

156. Further, a POSA would understand that the *Simpson* case is “sized to accommodate the user’s mobile electronic device.” First, the valuables discussed in *Simpson* are of a similar size to mobile electronic devices such as cellphones or tablet computers, and a POSA thus would have considered mobile electronic devices as other examples of valuables that could be stored in the *Simpson* case. EX-1008, [0003] (discussing “jewelry, financial files, financial documents, credit cards, intelligence files”).

157. Second, a POSA would understand that the portable security case as described and illustrated was sized to accommodate a mobile electronic device. EX-1008, Fig. 2; *see also* EX-1008, [0007] (“[t]he case includes a lid coupled to a base and cooperating therewith to define a closeable storage chamber”), [0008] (“self contained, portable security case or container”), [0035] (“portable case or container 10 which is constructed and arranged to securely transport valuable articles”), [0036]

(“valuable articles to be securely transported are housed within the cavity or chamber 18”). For example, Figure 2 illustrates what I refer to as a briefcase embodiment, and, as is commonly known, a typical briefcase is sized to accommodate mobile electronic devices such as a tablet computer. EX-1008, Fig. 2.

158. *Simpson* also teaches that its case has “an opening to receive the user’s mobile electronic device.” Specifically, in the unlocked and open state, there is an opening that allows the mobile electronic device to be placed in the storage chamber, which defines the cavity (18) in the Fig. 2 embodiment. EX-1008, Fig. 2 (perspective view of the interior of the *Simpson* case); *see also* EX-1008, Fig. 6B (cross-sectional view of a lower portion of the case with insert 16), Fig. 11B (cross-sectional view of the 11A embodiment in an open position), [0017], [0022], [0029].

2(b): “a locking means for at least partially securing the opening of the shell so that the electronic device is rendered inaccessible to the user, the locking means being further non-disengageable by the user of the mobile electronic device [until a predetermined condition is met]”

159. Claim element 2(b) of the ’788 patent is identical to claim element 1(b). I therefore incorporate here my discussion above of *Samuel* and *Shin* applied to claim element 1(b).

160. *Simpson* also discloses claim element 2(b). As the Abstract discloses, the *Simpson* case is a “self contained portable security case or container . . . [that is] secure in its locked condition by locks which are preferably operated by an electronic

key . . . [that] can be programmed to open the case or container dependent upon various different conditions, for example, location, time, identification of operator, etc.” EX-1008, Abstract. Specifically, in the illustrated embodiment of Figure 2, the *Simpson* case includes shell (16) that is part of the lower portion of the case (14), which is secured to the lid (12) through locks (28). EX-1008, Fig. 2; *see also* EX-1008, Figs. 3, 6A–6C, 7–8 (locks 44), [0002] (“relates to a portable container which restricts access to the contents within the container”), [0036]–[0039] (describing how locking mechanism secures the case closed). *Simpson* describes its locking mechanism and how it can be unlocked using an “electronic key”:

The manner in which the locks 28 secure the lid 12 to the lower portion 14 is illustrated in FIG. 6C. A pin or locking member 36 is an element of each of the four locks 28. The pin 36 moves in a longitudinal direction between an extended or locked position, as illustrated in FIGS. 2 and 6C, and a retracted or open position. In the retracted or open position, the pin 36 does not extend into an aperture in the side of the lower portion 14 of the case. In the locked position, the pin 36 extends into the aperture 38 in the side of the lower portion (FIG. 6C).

Each of the pins 36 is operated by an electrically powered device such as a solenoid 40. The solenoids 40 are preferably operated according to the schematic of FIG. 8. In place of solenoids 40, stepper motors can also be employed. The stepper motors would preferably drive a worm which is drivingly coupled to a worm

gear (not shown), which in turn operates the pins 36. An advantage of such a stepper motor drive system is that the locks 28 cannot be driven backward, thereby preventing access to the interior of said case. An electronic key 42 is utilized to open lock 44 (FIGS. 7 and 8). When lock 44 is open, an electrical circuit is completed. The electrical circuit includes lock 44, a battery 46, a fuse 48, and solenoids 40.

...

The electronic key 42 can be programmed to only open specific locks 44. The electronic key 42 includes a plurality of contacts 43 which electrically connect with respective contacts (not shown) on the lock 44. Preferably, an electronic key locks the case 10 at a point of departure and a separate electronic key at the final destination opens the case 10. The electronic keys can also be programmed to only open the case at a certain time or within a certain time frame or window as preprogrammed. Another feature of the electronic key is that it can be disabled or enabled from a signal transmitted by a satellite, a cell phone, or a radio frequency transmission.

EX-1008, [0037]–[0039].

161. As shown in Figure 6C, to which I have added annotations and highlights, the *Simpson* locking mechanism includes opposing plates with securably mateable female and male members to secure lid (12) to the lower portion (14) as part of the locking mechanism that includes an aperture (38, highlighted in light

blue) in the side of the lower portion (14) through which pin (36, highlighted in green) may be extended to lock the case (10). EX-1008, Fig. 6C, [0037]. The *Simpson* locking mechanism thus meets the structure required for the “locking means” in claim element 2(b).

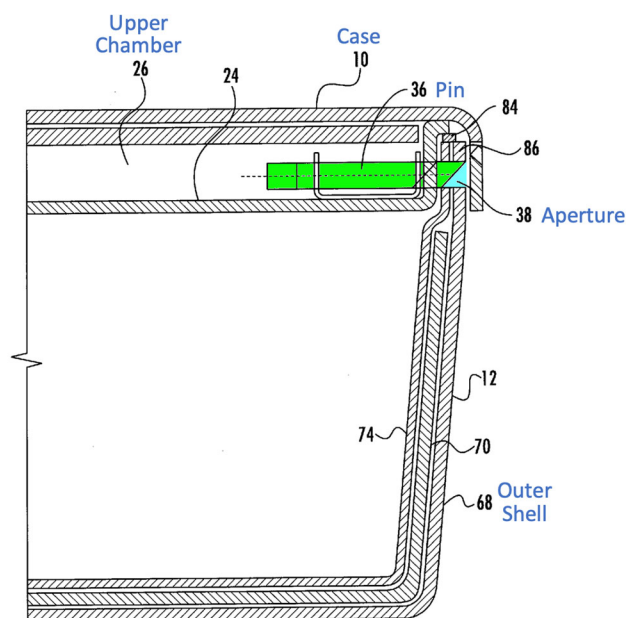


FIG. 6C

162. Further, in the locked position, the contents inside the case are inaccessible to the user, and *Simpson* further teaches that the locking means may be “non-disengageable by the user of the mobile electronic device” at least until the electronic key (42) is used to open the lock. EX-1008, [0037]–[0039]. Furthermore, *Simpson* teaches that the ability to unlock with the electronic key may be conditioned on time or geography and the user cannot disengage the *Simpson* locking mechanism

“until a predetermined condition is met” (e.g., “within a certain time range” or “at a specific predetermined location”). EX-1008, [0039]–[0040], [0045].

163. Considering these disclosures, a POSA would understand that the Simpson locking mechanism is therefore “at least partially securing the opening of the shell” so that the valuable stored inside (including a user's mobile electronic device per my discussion above) is “rendered inaccessible to the user.”

2(c): “wherein the predetermined condition is the passage of time”

164. *Simpson* also discloses element 2(c) of the '788 patent. Specifically, as I indicated above, the electronic key (42) used to unlock case (10) may be programmed to “only open the case at a certain time or within a certain time frame or window as preprogrammed.” EX-1008, [0039]. In addition, *Simpson* discloses that its “controller 54 can be programmed to recognize authorized opening of the case within a certain time range.” EX-1008, [0045]. A POSA would understand these disclosures to mean that a “predetermined condition” for opening the *Simpson* case is the passage of time.

C. Claim 3 is Obvious in Light of the Combination of *Samuel* and *Shin*

165. Claim 3 begins with the preamble reciting “[a] system for selectively limiting a user’s control of such user’s own electronic device, comprising:” As I have stated previously, I understand that a claim preamble generally does not limit

a claim but in some circumstances it may. With respect to claim 3 of the '788 patent, whether or not the preamble is a limitation, it is disclosed by the combination of *Samuel* and *Shin*.

166. *Samuel* discloses “[a] device (2) for the secure transportation of an object (3),” which is later referred to as a “case”. EX-1005, Abstract, [0093]. A POSA would have understood that the “object (3)” could be any number of valuable items, including a mobile electronic device such as a laptop computer or cellular telephone. Accordingly, a POSA would have understood that the *Samuel* case could be used “for selectively limiting a user’s ability to control such user’s own mobile electronic device.”

167. Furthermore, *Samuel* discloses a system that includes the *Samuel* case (2) and monitoring system (22) that renders the contents of the case inaccessible by preventing the case from being unlocked/opened until a predetermined state of the case is met, such as reaching a desired location. EX-1005, [0001]–[0002] [0083]–[0084], [0124]–[0125], [0182] (broadly describing cash, documents or objects to be transported in a *Samuel* case). In this way, the *Samuel* system selectively limits a user’s ability to control any cash, documents or other valuable merchandise being stored in the case. As noted above, a POSA would have understood that a user’s electronic device, such as a cellphone, could be the “object” stored in the *Samuel* case.

168. Furthermore, as I described above, a POSA would have been motivated by *Samuel*'s express discussion of an alternative "envelope" structure for its case to look to other references that focus on that type of structure, including, for example *Shin*. EX-1005, [0021], [0091]. *Shin* teaches a mobile phone storage envelope. EX-1006, Figs. 1–2, 6, 8, 11–14, Abstract. Thus, a POSA looking to both references to design a secure case and system might choose to combine the envelope structure of *Shin*, which was specifically sized to contain a cellphone, with the locking and unlocking mechanisms discussed in *Samuel* in order to arrive at "a system for selectively limiting a user's control of such user's own electronic device." A POSA would not have expected any significant technical obstacles to combining the disclosures in *Shin* and *Samuel* to end up with a case as I described above and in my discussion of claim 3 below.

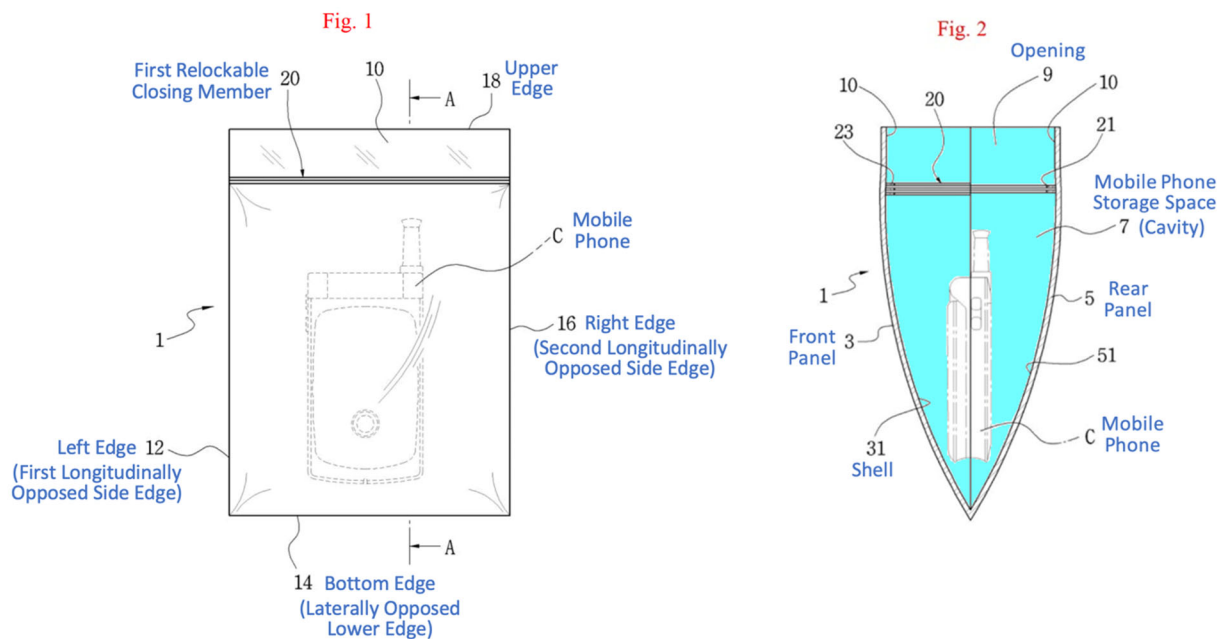
3(a): "a case sized to receive the user's mobile electronic device having"

169. Claim element 3(a) is disclosed by the combination of *Samuel* and *Shin*. *Samuel* discloses that its "case" is sized to receive valuable objects, for example, Figure 1 depicts a case in which cash (3) is the object depicted as being stored. EX-1005, Fig. 1, [0083]–[0084]. A POSA would have understood that *Samuel*'s general references to an "object" being stored could also include a "user's mobile electronic device." And, a POSA would have understood that a cellphone can be approximately

the same size as the cash depicted in Figure 1 of *Samuel* and therefore the *Samuel* case was “sized to receive the user’s mobile electronic device.”

170. *Samuel* also discusses the use of flexible materials, such as “flexible plastics or rubber”, to make the case, including in an “envelope” structure to transport smaller objects. EX-1005, [0091]–[0092]. The alternative suggested in *Samuel* is found in *Stewart* and *Shin*, which a POSA would have looked to if deciding to design a case according to the disclosures in *Samuel* with the suggested envelope structure. *Shin* explicitly refers to its case structure as “an envelope for storing a mobile phone.” EX-1006, Title, 1.

171. *Shin* also describes the envelope structure in detail and depicts its use to store a cellphone in Figures 1 and 2 (to which I have added annotations in blue):



EX-1006, Figs. 1, 2, Abstract, 1 (“having sufficient size to form a mobile phone storage space”), 6 (describing Fig. 1), cl. 1 (“sufficient size to form a mobile phone storage space”); *see also* EX-1006, Figs. 2, 6, 8, 11–14. As shown and described in *Shin*, the mobile phone storage envelope (depicted in the figures as 1, 101, 201, and 301) is a “case sized to receive the user’s mobile electronic device.”

3(b): “a front and a rear panel each having first and second longitudinally opposed side edges and laterally opposed lower edges”

172. Claim element 3(b) is also disclosed by *Samuel* and *Shin*.

173. As discussed above, *Samuel* expressly suggests that its case could be implemented with an envelope structure. A POSA would find the elements of claim element 3(b) met by an envelope structure. However, I acknowledge that *Samuel* does not detail the features of the contemplated envelope structure.

174. However, *Shin* does provide detail regarding its envelope structure. *Shin* discloses “an envelope formed by integrally joining left and right edges and bottom edge of a first side and a second side.” EX-1006, Abstract, cl. 1 (“left and right edges and bottom edges of first and second sides are integrally combined to form the envelope”), 6 (“wherein the first side 3 and the second side 5 are joined at their left edge 12, bottom edge 14, and right edge 16 to form a mobile phone storage space 7”). The “first side 3” and “second side 5” in *Shin* are “a front and a rear panel” as required by claim element 3(b). *See* EX-1006, Figs. 2, 5, 7, 9, 10 (showing the

profile view of various *Shin* envelope embodiments). Each of the first side (3) and second side (5) has a left edge 12 and right edge 16, which are the “longitudinally opposed side edges” and bottom edge (14) of each side comprises the “laterally opposed lower edges” required by 3(b). *See, e.g.*, EX-1006, Figs. 1, 3a, 4, 6.

175. Above I have annotated *Shin*’s Figure 1 (which is a view of the front panel) and Figure 2 (which is a side view showing front and rear panels) to show how the *Shin* envelope structure meets the requirements of claim element 3(b). I note that each panel in the *Shin* structure has a laterally opposed lower edge but because Figure 1 is viewing the front panel only, I have only annotated the laterally opposed lower edge for the front panel. *See also* EX-1006, claim 1 (specifying that there are “bottom edges” that are “integrally combined” with the left and right edges of the first and second sides to form the envelope).

3(c): “the first, second, and lower edges being secured together to define an opening for receiving a mobile electronic device, the case operative to become locked so that the user is unable to access his own mobile electronic device contained therein until a predetermined condition is met”

176. *Samuel* and *Shin* disclose the requirements of claim element 3(c) of the ’788 patent.

177. As shown in the annotated *Shin* Figures 1 and 2 above, the first (left edge 12), second (right edge 16), and lower edges (bottom edge 14) of the front and rear panels (first side 3 and second side 5) are secured together in the *Shin* envelope.

EX-1006, Figs. 1–2. The *Shin* envelope is labeled “1” in Figures 1–3a but referenced in illustrations of embodiments with additional features as “101,” “201,” or “301.” EX-1006, Figures.

178. *Shin* discloses that opening portion (9) of its mobile phone storage envelope allows the user to put mobile phone (C) into the envelope. EX-1006, Figs. 2, 5, 7, 9 (each showing opening portion 9). Figures 1 and 6 show that the opening is formed at the top of the envelope by securing the right, left, and lower edges together while leaving opening portion (9) unsecured (when open). EX-1006, Figs. 1, 6. *Shin* specifically discloses that the “envelope [is] formed by integrally joining left and right edges and bottom edge of a first and a second side.” EX-1006, Abstract; *see also* EX-1006, claim 1 (“left and right edges and bottom edges of first and second sides are integrally combined to form the envelope”).

179. *Shin* further details that “the edges (12, 14, 16) of the first side (3) and the second side (5) are integrally joined by methods such as thermal compression, adhesive bonding, or folding” and “[a]n opening 9 through which a mobile phone can be inserted and removed is formed at an upper edge 18 of the first side 3 and the second side 5. Therefore the mobile phone C is stored through the opening portion 9.” EX-1006, 6.

180. A POSA would understand these disclosures in *Shin* to teach that the secured edges of the *Shin* envelope “define an opening for receiving a mobile

electronic device.”

181. *Shin* also specifically discloses the use of one or more closing members (referred to in the illustrations and text by indicators 20, 120, or 220), which may be locked to secure the mobile phone in the envelope. EX-1006, 6–8 (discussing various embodiments of the closing member designed to lock the opening of the envelope).

182. And, as noted above, a POSA would have been motivated to combine the case functionality described in *Samuel*, specifically the conditional locking/unlocking mechanisms, with the more flexible envelope structure suggested in *Samuel* and disclosed in greater detail by *Shin*.

183. *Samuel* discloses a case that may be locked with an object inside such that the user of the object cannot access it “until a predetermined condition is met.” EX-1005, [0009]–[0018], [0038] (determining whether the location of the case is the same as the predetermined address before sending an opening signal), [0058], [0069], [0073], [0105]–[0109], [0124]–[0125] (opening conditioned on determination that “the container is that which is for the recipient or the destination originally intended”); *see also* my discussion above of the claim 1 (preamble). Specifically, the *Samuel* case is locked using locking means (8, 10, 12, and 14), which perform the required function of rendering the object being transported inside the case inaccessible to the user until a certain predetermined condition is met. EX-1005, Fig. 1, [0083], [0086]. *Samuel* discloses that means (18) inside the case

monitors the state of the case (such as its location) and receives and acts on closing or opening instructions received by electronic signals. EX-1005, [0088]–[0091], [0105]–[0109], [0124]–[0125], [0174]–[0178], cl. 1. The locking means described in *Samuel* (8, 10, 12, 14) cannot be unlocked until means (18) receives the appropriate signal to unlock the case, thus ensuring that the “user is unable to access” the object “contained therein until a predetermined condition is met.” *See, e.g.*, EX-1005, [0018], [0109], [0123]–[0125].

184. And, as explained above, a POSA would find it obvious for the object locked in a *Samuel* case with the *Shin* envelope structure (the “*Samuel* envelope”) to be a mobile electronic device in view of the *Shin* disclosures. EX-1005, Fig. 1, [0083]–[0084]; EX-1006, Figs. 1–2, Abstract.

3(d): “a locking means for at least partially securing the opening; and”

185. *Samuel* in combination with *Shin* also discloses claim element 3(d) of the ’788 patent.

186. *Samuel* discloses its own locking means (8, 10, 12, and 14). As shown in Figure 1, these components include opposing plates with securably mateable female members (12, 14) and male members (8,10). EX-1005, Fig. 1, [0083]. Thus, the locking means in *Samuel* corresponds to the structure required for the locking means in claim 3 of the ’788 patent.

187. Moreover, the locking means described in *Samuel* fulfills the function of “at least partially securing the opening.” *Samuel* Figure 2 shows that when the case is closed, the locking means secure the opening such that the object inside is not accessible. EX-1005, Fig. 2, [0010]. *Samuel* further discloses that means (18) inside the case monitors the state of the case (such as its location) and receives and acts on closing or opening instructions received by electronic signals. EX-1005, [0018], [0088]–[0090], [0105]–[0109], [0124]–[0125], [0174]–[0178], cl. 1. Thus, the opening of the *Samuel* case (including as modified to adopt the *Shin* envelope structure) is secured until such time as the opening signal is sent by the monitoring system (22). EX-1005, [0105]–[0106], [0109], [0123]–[0125].

188. In addition to the disclosures in *Samuel*, *Shin* describes that its closing members (*i.e.*, the first closing member 20/second closing member 120/third closing member 220) are made up of a female profile strip (23/123/223) and a male profile strip (21/121/221) that are “formed to be suitably engaged with each other to lock the opening 9 of the envelope.” EX-1006, Fig. 2, 5–7, pgs. 7 (describing the male and female profile strips 21 and 23 as “formed of a combination of one protrusion and a recessed portion”), 8 (male profile strip 121 and female profile strip 123 “are formed to suitably lock the envelope by engaging with each other” and that male profile strip 221 and female profile strip 223 are used to lock the opening). Thus, like *Samuel*, *Shin* discloses securably mateable female and male members that

function to secure the opening and thus discloses the “locking means” required by claim element 3(d). The similarities between *Samuel* and *Shin* in this respect provide a further motivation for a POSA to combine these references to arrive at a modified *Samuel* case with the *Shin* envelope structure (*i.e.*, the *Samuel* envelope) with a locking means for at least partially securing the opening.

3(e): “means for unlocking the case”

189. *Samuel* and *Shin* further disclose claim element 3(e). *Samuel* in combination with *Shin* discloses and renders obvious claim element 3(e). *Samuel* discloses that its locking means (8, 10, 12, and 14) are unlocked in response to electronic signals sent by monitoring system (22) to the case. Specifically, electronic signals are sent to means (18)—“electronic means for sending or receiving signals”—through means (16), which provides a connection between the case and a communication network. EX-1005, [0088], [0090], [0105]–[0109], [0123]–[0125]; *see also* EX-1005, [0096]–[0103] (describing components of monitoring system 22). Monitoring system (22) in *Samuel* is able to use the Internet as the communication network via a “PC fitted with a communication card” that communicates with electronic means (18), which comprises a “programmed microprocessor and a network card (or line interface means).” EX-1005, [0103]–[0104]; *see also* EX-1005, [0036] (noting that the communication network over which signals are sent between the device and monitoring system could be the Internet), [0038] (noting the

monitoring system sends an opening signal). The communication card in monitoring system (22) is an electronic signal transmitter that meets the structure required for the unlocking means in claim element 3(e) and fulfills the function of unlocking the case.

D. Claim 4 is Obvious in Light of the Combination of *Samuel* and *Shin*

190. Claim 4 requires a locking means comprised of “a female and a male plate, the plates respectively disposed on each of the front and rear panels and configured to securably mate with one another.”

191. This locking means is taught in *Samuel*. Specifically, *Samuel* illustrates that its locking means (8, 10, 12, 14) include opposing plates with securably mateable female members (12, 14) and male members (8, 10), which would meet the structure required by the “locking means” element of claim 3. EX-1005, Fig. 1, [0083], [0086], [0105].

192. *Samuel* also teaches using a flexible envelope structure rather than the hard case shown in the figures. In the *Samuel* envelope, a POSA would have considered using the same locking means described in *Samuel* as an obvious design choice to secure the front and rear panels of the envelope structure, similar to the locking means (8, 10, 12, and 14) securing upper portion (4) to lower portion (6) in the *Samuel* case embodiment shown in Figures 1 and 2. EX-1005, Figs. 1–2.

193. Put simply, the *Samuel* envelope implemented with a female and a male plate on the top of each panel as the locking mechanism would thus meet the requirements in claim 4 that “the locking means comprises a female and a male plate, the plates respectively disposed on each of the front and rear panels and configured to securably mate with one another.”

194. Likewise, *Shin* describes an envelope with “male and female profile strips 21 and 23” used to lock the envelope. Like the profile strips described in *Shin*, which comprise a locking “zipper”, the ’788 patent describes the use of “lockable zippers” as one embodiment of the “locking means.” ’788 patent, 6:29–33. Further, the profile strips in *Shin* could be easily designed as female and male plates configured to securably mate with one another as described in the ’788 patent. *See, e.g.*, EX-1006, Fig. 2, 5–7, pp. 7–8. A POSA would have been motivated to combine these disclosures in *Samuel* and *Shin* to make the case of claim 4 for the reasons I discussed here and in Section IX.A. *See also* my analysis of claim 3 on which claim 4 depends.

E. Claim 6 is Obvious in Light of the Combination of *Samuel* and *Shin*

195. Claim 6 requires a microprocessor further “disposed in one or both of the female and male plates to receive a wireless data signal from a beacon or

transmitter to disengage the locking means when the predetermined condition is met.”

196. The *Samuel* reference discloses that locking means (8, 10, 12, and 14) may be unlocked in response to electronic signals sent by monitoring system (22) to the case. Specifically, signals are sent to means (18)—“electronic means for sending or receiving signals”—through means (16), which provides a connection between the case and a communication network such as the Internet. EX-1005, [0036], [0038], [0054], [0088], [0090], [0105]–[0109], [0123]–[0125].

197. The unlocking signal is “a wireless data signal” to “disengage the locking means,” and *Samuel* teaches it is used when, for example, the case is at a predetermined address (*i.e.*, “when the predetermined condition is met”). EX-1005, [0036], [0038]. Furthermore, the unlocking signal is sent “from a . . . transmitter.” EX-1005, [0103]–[0104].

198. *Samuel* also teaches that electronic means (18) includes a “microprocessor 100”, which triggers opening of locking means (8–14) by sending a signal, which implicitly discloses that there is a transmitter in electronic means (18) that sends the signal to be received by a microprocessor in one or both of the plates in locking means (8–14). EX-1005, Fig. 7, [0104], [0153]–[0154], [0162]–[0163].

199. It also would have been obvious to a POSA to dispose the

microprocessor (100) in one or both of the female and male plates so as to effectuate the unlocking mechanism as quickly as possible following transmission of the signal from the monitoring system and to reduce the need for excess electrical wiring and/or additional microprocessors within the same case. A POSA would have been motivated to combine these disclosures from *Samuel* regarding the use of locking and unlocking signals and the use of electronic means (18) with a microprocessor (100) with the other disclosures in *Samuel* and *Shin* to make the case of claim 6 for the reasons I discussed in Section IX.A. *See also* my analysis of claim 3 on which claim 6 depends.

F. Claim 7 is Obvious in Light of the Combination of *Samuel* and *Shin*

200. Claim 7 requires the predetermined condition be physical presence outside of a defined geographical region.

201. The *Samuel* reference addresses the secure transportation of an object and uses its predetermined location (i.e., the case’s arrival at a destination address)—which is outside of a defined geographic region enclosing the case’s departure address—as a condition for sending a signal to unlock the case. *See, e.g.*, EX-1005, [0038], [0058], [0123]–[0125], [0173]–[0176].

202. Therefore, the *Samuel* reference teaches that “the predetermined condition is physical presence outside of a defined geographical region” as required

by claim 7. A POSA would have been motivated to use this example of a predetermined condition from *Samuel* with the other disclosures in *Samuel* and *Shin* to make the case of claim 7 for the reasons I discussed in Section IX.A. *See also* my analysis of claim 3 on which claim 7 depends.

G. Claim 8 is Obvious in Light of the Combination of *Samuel*, *Shin*, and *Simpson*

203. Claim 8 requires the predetermined condition be the passage of time.

204. The *Simpson* reference teaches that “a travel plan by time of day and location can be stored in the memory” and thereby used to determine whether the security case should remain locked or be unlocked. EX-1008, [0039]–[0040], [0043].

205. The fact that the time of day is stored in the memory and used to evaluate whether to keep the case locked discloses to a POSA the limitation in claim 8—in other words, the evaluation of the time of day determines whether or not the “passage of time” condition has been met.

206. Therefore, *Simpson* discloses that “the predetermined condition is the passage of time.” A POSA would have been motivated to use this example of a predetermined condition from *Simpson* with the other disclosures in *Samuel* and *Shin* to make the case of claim 8 for the reasons I discussed in IX.B. *See also* my analysis of claim 3 on which claim 8 depends. For example, *Shin* discusses the use of a “timer

means” and references a condition for allowing radio waves to pass after a “predetermined time has elapsed.” EX-1006, Abstract, 6, 9–10.

XI. NO SECONDARY CONSIDERATION OF NONOBVIOUSNESS

207. As discussed above, I understand that “secondary considerations” may be used to demonstrate nonobviousness if they are present and proven to have a nexus to the claimed invention. I understand that Yondr has not identified any evidence related to secondary considerations. I am not aware of any other evidence related to secondary considerations, such as commercial success, unexplained results, long felt but unsolved need, industry acclaim, simultaneous invention, copying by others, skepticism by experts in the field, or failure of others, that suggests the claims of the ’788 patent are not obvious. If any such evidence is put forth by Yondr during the course of this proceeding or the district court litigation, I reserve the right to supplement my analysis and opinions to address that evidence.

XII. CONCLUSION

208. I understand this declaration will be submitted in a contested proceeding before the Patent and Trial Appeal Board of the United States Patent and Trademark Office and I may be subject to a deposition in that proceeding. I am prepared to testify regarding my opinions relating to the invalidity of the claims of the ’788 patent.

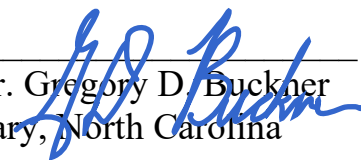
209. In summary, I hold the following opinions:

- Claim 1 of the '788 patent is anticipated by or is obvious in light of the disclosures in *Samuel*;
- Claim 1 of the '788 patent is obvious in light of the disclosures in *Samuel* and *Shin*;
- Claim 2 of the '788 patent is obvious in light of the disclosures in *Samuel*, *Simpson*, and *Shin*;
- Claim 3 of the '788 patent is obvious in light of the disclosures in *Samuel* and *Shin*;
- Claim 4 of the '788 patent is obvious in light of the disclosures in *Samuel* and *Shin*;
- Claim 6 of the '788 patent is obvious in light of the disclosures in *Samuel* and *Shin*;
- Claim 7 of the '788 patent is obvious in light of the disclosures in *Samuel* and *Shin*; and
- Claim 8 of the '788 patent is obvious in light of the disclosures in *Samuel*, *Shin*, and *Simpson*.

210. I hereby declare that all statements made in this declaration of my own knowledge are true and all statements are made with the knowledge that willful false statements are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001.

Dated: April 9.

Respectfully submitted,



Dr. Gregory D. Buckner
Cary, North Carolina