

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION**

YONDR, INC.

Plaintiff,

v.

BE SMARTER, LLC and
JAMES GUERRA.,

Defendants.

Case No. 1:24-cv-01326-ADA

Judge Alan D. Albright

DEMAND FOR JURY TRIAL

BE SMARTER, LLC and
JAMES GUERRA.,

Counterclaim Plaintiffs.

v.

YONDR, INC.

Counterclaim Defendant,

**DECLARATION OF DAVID SMITH IN SUPPORT OF YONDR, INC.'S RESPONSIVE
CLAIM CONSTRUCTION BRIEF**

I. INTRODUCTION

1. I have been retained in this matter by Yondr, Inc. (“Yondr”). I have been asked to evaluate and respond to certain issues raised by Be Smarter, LLC and James Guerra (collectively “Be Smarter”) in Be Smarter’s Opening Claim Construction Brief, dated June 6, 2025.

2. If called to testify in this case, the topics on which I may testify include: (1) the inventions described and claimed in Yondr’s U.S. Patent No. 9,819,788 (“the ’788 Patent”) and U.S. Patent No. 12,133,078 (“the ’078 Patent”) (collectively “the Asserted Patents); and (2) that the claims of the Asserted Patents satisfy the definiteness requirements of 35 U.S.C. § 112.

II. QUALIFICATIONS AND PROFESSIONAL EXPERIENCE

3. My qualifications and professional experience are set forth in my curriculum vitae, attached hereto as Appendix A. It includes details of my education, professional, and employment credentials. My further relevant experience is set forth below.

4. I am currently the President of Alpine Engineering & Design, Inc. I am a registered Professional Mechanical Engineer in the States of Utah and Idaho. I am also a Certified Safety Professional in comprehensive practice. I received my Bachelor of Science degree in Mechanical Engineering from Brigham Young University – Idaho, in 2007. I received a Master of Science Degree in Mechanical Engineering and a Master of Business Administration (MBA) from Brigham Young University in 2011. I have approximately 15 years of experience in the fields of mechanical engineering, product development, mechanical design, and much of this work has involved locking mechanisms, safes, lock boxes, locking compartments, electronic enclosures and related components. In my role as a consultant, I have participated in the design and manufacture of numerous products, including equipment for limiting access to certain objects or areas.

5. I am a named inventor on 7 U.S. patents with a number of other patent applications pending. A list of my patents is appended with my CV. I have significant experience in the process of applying for and obtaining patents.

6. I have testified in a number of cases, both at trial and by deposition. Appendix B lists the cases in which I have testified.

7. I am being compensated at the rate of \$500 per hour. The compensation received from this case is not contingent upon my opinions and statements expressed herein. I do not have any interest in the outcome of this matter, and have never been an employee of Yondr or Be Smarter.

8. Appendix C lists the documents and things I have considered in forming my opinions. I have also relied upon my educational professional experience in reaching my opinions.

III. APPLICABLE LEGAL PRINCIPLES

9. Counsel has instructed me on the legal principles relevant to patent claim construction and the standards to be applied when a party attempts to prove a patent claim invalid for indefiniteness.

10. I understand that terms in a patent claim should be construed to be consistent with how those terms and phrases are used in the patent specification. This usually means claim terms are construed according to their plain and ordinary meaning to a person of ordinary skill in the relevant art who is deemed to have read and understood the entire patent. I understand there are two exceptions to this general rule: (1) when a patentee sets out a definition and acts as his or her own lexicographer, or (2) when the patentee disavows the full scope of a claim term either in the specification or during prosecution.

11. I understand that an issued patent is presumed to be valid and that a party challenging the validity of a patent must prove invalidity by clear and convincing evidence. I understand that clear and convincing evidence is evidence that creates an abiding conviction that a factual contention is true. This is a higher standard than the more likely than not standard but it is not so high as the standard used in criminal law, which is evidence beyond a reasonable doubt

12. I understand that Be Smarter contends that certain claims of the Asserted Patents are invalid for failure to satisfy the definiteness requirement of 35 U.S.C. § 112. As such, Be Smarter bears the burden of establishing indefiniteness by the clear and convincing standard of proof.

13. I understand that in order to satisfy the definiteness requirement of 35 U.S.C. § 112, the claim(s) must particularly point out and distinctly claim the subject matter which the applicants regard as their invention. I understand that a patent would be invalid for indefiniteness if its claims, read in light of the patent specification and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention. I understand that a claim is not considered indefinite if the meaning of the claim is discernible, even though the meaning of the claim may be difficult to determine and may be one over which reasonable persons disagree. I further understand that if a person of ordinary skill in the art would understand what is claimed when the claim is read in light of the specification of the patent, then the claim is not considered indefinite.

IV. THE LEVEL OF ORDINARY SKILL IN THE ART

14. I am informed that claims are to be interpreted from the perspective of a hypothetical person of ordinary skill in the art at the time of the invention, in view of the specification and prosecution history.

15. I am informed that definiteness under 35 U.S.C. § 112 is also analyzed from the perspective of a hypothetical person of ordinary skill in the art at the time of the invention.

16. I understand that determining the level of ordinary skill in the art involves an analysis of the following factors: (1) the types of problems encountered in the art; (2) the prior art solutions to those problems; (3) the rapidity with which innovations are made; (4) the sophistication of the technology; (5) the educational level of active workers in the field; and (6) the educational level of the inventors. I also understand that these factors are not exhaustive, and are merely a useful guide to determining the level of ordinary skill in the art. I am informed that the effective filing date of the Asserted Patents is April 21, 2015, and I have considered that to be the date of invention for purposes of my opinions herein.

17. The Asserted Patents relate to the field of “system[s] and apparatus[es] for selectively limiting user control of a mobile electronic device.” ’078 Patent, Abstract. Thus, a person of ordinary skill in the art would need to be familiar with such systems and apparatuses.

18. The Asserted Patents state:

[T]he apparatus for selectively limiting user control of an electronic device may be embodied as a case 100 sized to accommodate a mobile electronic device 102. More particularly, the case may comprise a front 104 and a rear panel 106 secured together along longitudinally opposed side edges 108 and laterally opposed lower edges 110. The lower edges 110 may be secured by permanently stitching or gluing together, while the side edges 108 may be stitched or glued upward from the lower toward an opening 112 that is defined by the front and rear panels 104, 106 and permanently secured edges 108, 110 and further sized to receive the mobile electronic device 102.

As illustrated, one embodiment of the apparatus may be a soft, flexible case. It may comprise various rugged materials such as neoprene, lycra, silicone rubber, spandex, vinyl, canvas, and any other material or combinations of materials sufficient to temporarily house a mobile electronic device. Additionally, various other configurations are contemplated for the shape of the apparatus as well. For example, the invention may comprise a rigid shell or box having a securable opening to receive a mobile electronic device. As such, one skilled in the art will

recognize that the illustrated figures are offered by way of example and ease of understanding only, not of limitation.

The apparatus for selectively limiting user control of an electronic device further comprises a locking means 114 for at least partially securing the opening 112 so the mobile electronic device 102 is may be rendered inaccessible to and further uncontrollable by the user of the device although it may still remain in his possession.

Id. at 5:58-6:20.

19. Based on the disclosure of the Asserted Patents, in my opinion, a person of ordinary skill in the art would have had an undergraduate degree in mechanical engineering, industrial design, or a related field.

20. My opinions below concerning the Asserted Patents are from the perspective of a person of ordinary skill in the art at the time of the invention.

21. I understand that Be Smarter identified a different level of skill in the art. Specifically, Be Smarter stated:

A person having ordinary skill in the art relating to the subject matter of the Asserted Patents at the time of invention 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. (*See*, Ex. 3, Buckner Decl. at ¶ 91.) A person of ordinary skill in the art could have more formal education and less technical experience or *vice versa*. (*Id.*).

Be Smarter's Opening Claim Construction Brief at 6. My analysis would not change under that level of skill.

22. Further, I believe that I was at least a person of ordinary skill in the art at the time of the Asserted Patents' priority date (April 21, 2015), because at that time I had received my Bachelor of Science degree in Mechanical Engineering from Brigham Young University – Idaho. Although, my education and experience in this field now exceed that of a person of ordinary skill in the art, I offer my opinions below consistent with the understandings above.

V. SUMMARY OF OPINIONS

23. In its Opening Claim Construction Brief, Be Smarter asserts that the phrase “a predetermined condition associated with a geographic region” renders indefinite Asserted Claims 1, 9, 15 (and their dependents) of the '078 Patent. I disagree.

24. Based on my experience, my review of the Asserted Patents and their file histories, my review of Be Smarter's Opening Claim Construction Brief, and my review of documents and things discussed herein and/or listed in Appendix C, it is my opinion that the phrase “a predetermined condition associated with a geographic region” does not render any Asserted Claim indefinite because the claims convey, with at least reasonable certainty, the scope of the invention to a POSITA.

VI. A POSITA WOULD UNDERSTAND THE SCOPE OF THE CLAIMED “PREDETERMINED CONDITION ASSOCIATED WITH A GEOGRAPHIC REGION”

25. Asserted Claims 1, 9, and 15 of the '078 Patent recite a case comprising, among other elements, the following limitations:

- “a lock ... configured to unlock to enable access to the mobile device based on a predetermined condition associated with a geographic region” ('078 Patent, Claim 1)
- “a lock ... configured to unlock to enable access to the mobile device in accordance with a predetermined condition associated with a geographical region” ('078 Patent, Claim 9)
- “a lock ... configured to at least partially secure the opening and render the user unable to access the mobile electronic device until a predetermined condition is met, the predetermined condition being associated with a physical presence of the case being outside of a defined geographical region” ('078 Patent, Claim 15)

26. I understand that Be Smarter states that “[t]he '078 Patent is a continuation of the '788 Patent and, therefore, both Asserted Patents share a common specification and overlapping file history.” Be Smarter's Opening Claim Construction Brief at 18. Be Smarter also states that

the claims of the '788 patent recite, among other things, that “the predetermined condition is physical presence outside of a defined geographical region.” *Id.* at 18 (quoting '788 Patent, Claim 7). I understand that Be Smarter then asserts:

[I]f in '788 Patent Claim 7 the predetermined condition is physical presence outside of a defined geographical area, then the '078 Patent requirement that the predetermined condition is just associated with a geographic region must mean something different. But neither the specification nor the file history provide any such definition or explanation. As a result, these terms are indefinite under 35 U.S.C. § 112(b).

Id. at 19. I disagree. In my opinion, the claims, read in view of the specification, inform with reasonable certainty one of ordinary skill in the art about the scope of the invention.

A. The Specification Gives Numerous Examples of “Predetermined Condition[s] Associated With a Geographic Region.”

27. The specification discloses multiple examples of a lock configured to unlock based on a “predetermined condition associated with a geographic region.” For example, the specification discloses a lock configured to unlock when touched to a detacher near an exit. '078 Patent, 6:57-7:4. This predetermined condition is associated with a geographic region because it requires a user to go to a specific location such as an exit.

28. Additionally, the figures of the '078 Patent further support a case comprising a lock configured to unlock based on “a predetermined condition associated with a geographic region.” Figures 5 and 6, reproduced below, depict a case with a lock configured so that the detacher unlocks the case.

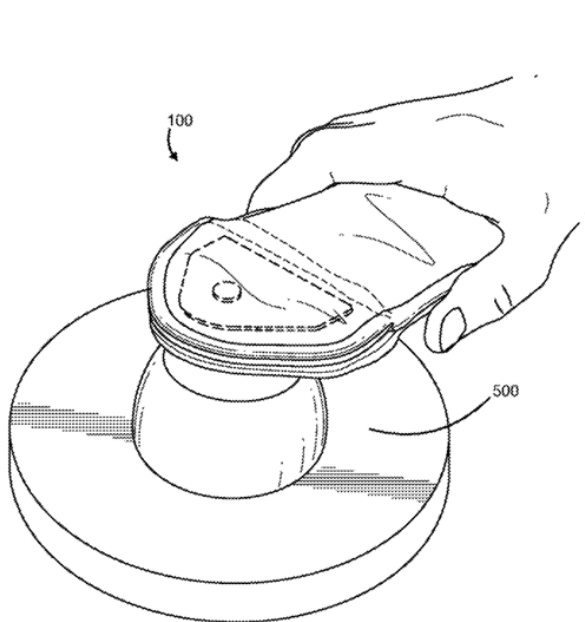


FIG. 5

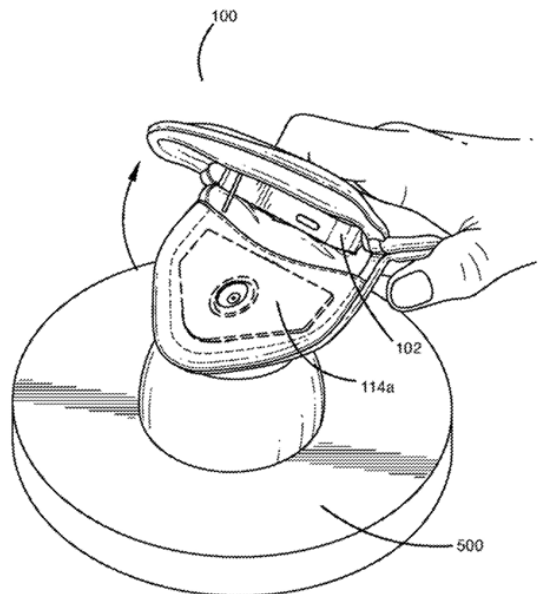


FIG. 6

Id. at Figs. 5-6. The specification explains that the system shown in Figures 5 and 6 may be placed at a location, such as “at venue exit ways” “to reduce distractions at a communal event.” *Id.* at 6:48-7:4. A person of ordinary skill in the art would therefore understand the system shown in Figures 5 and 6, and described in the specification, to comprise a lock configured to unlock based on “a predetermined condition associated with a geographic region” (e.g., the user can unlock the phone by meeting the predetermined condition of going to the geographic region of a venue exit way).

29. The specification also discloses a lock configured to unlock upon exceeding the range of a transmitter. *Id.* at 3:11-22, 7:10-20, Fig. 7. This predetermined condition is associated with a geographic region because it requires a user to go beyond the operational range of a transmitter.

30. The specification further discloses a lock configured to unlock upon entering certain unblocked rooms within a venue. *Id.* at 7:26-36. This predetermined condition is associated with a geographic region because it requires a user to go into specific rooms within a location.

31. The specification also discloses a lock configured to unlock when outside of a given location. *See, e.g., id.* at 7:5-9. This predetermined condition is associated with a geographic region because it requires a user to leave the location.

32. The specification thus provides several different examples of, *e.g.*, a lock configured to unlock to enable access to the mobile device based on a predetermined condition associated with a geographical region. A person of ordinary skill in the art would have understood the plain meaning of the claim language and, additionally, the examples from the specification of a lock configured to unlock based on “a predetermined condition associated with a geographic region” (*e.g.*, when touched to a detacher near an exit, upon exceeding the range of a transmitter, upon entering certain unblocked rooms within a venue, when outside of a given location) would provide further confirmation of the claims’ plain meaning and scope.

B. The Claims of the ’078 Patent and ’788 Patent Do Not Change My Opinion

33. I understand that Be Smarter raised the following argument related to the scope of claim 7 in the ’788 Patent and the scope of claims in the ’078 Patent:

[I]n this case, if in ’788 Patent Claim 7 the predetermined condition is physical presence outside of a defined geographical area, then the ’078 Patent requirement that the predetermined condition is just associated with a geographic region must mean something different. But neither the specification nor the file history provide any such definition or explanation. As a result, these terms are indefinite under 35 U.S.C. § 112(b).

Be Smarter Opening Brief at 19. I understand that Be Smarter further states:

And if Yondr argues that ‘associated with’ is the same as ‘is’ located outside of a geographic region notwithstanding the doctrine of claim differentiation, then Yondr’s ‘078 Patent adds nothing to its parent ‘788 Patent. Put another way, the ‘078 Patent would not be patentably distinct from and rendered invalid by its own parent patent.

Id. at 20.

34. I disagree that the difference in claim language between the two patents makes the scope of the ‘078 Patent claims indefinite. As I discussed above, a person of ordinary skill in the art would have understood the plain meaning, as further confirmed by the examples in the specification, which demonstrate different lock configurations that unlock to enable access to the mobile device in accordance with a predetermined condition associated with a geographical region. The ‘788 Patent, claim 7 adds the following limitation to ‘788 Patent, claim 3: “the predetermined condition is physical presence outside of a defined geographical region.” Thus, unlike the ‘078 Patent claims, ‘788 Patent claim 7 requires (1) a defined geographical region; and (2) that the case be physically present outside of that defined geographical region.

35. One example of the type of defined geographical region in the shared specification is that the case “receives a signal from a proximity transmitter indicating that the case has respectively entered and exited defined geographical region. Thus, for example, the locking means may receive instructions to lock the device when it is located within an audience seating area of a venue or concert hall. Then, the locking device may receive instructions to unlock the device when it is located outside of the audience area of a venue or concert hall.” ‘788 Patent, 3:14-27. In contrast, as discussed, the ‘078 Patent claims’ predetermined condition does not require leaving a defined geographical region.

36. Thus, to the extent Be Smarter states that claim differentiation means the Asserted Claims of the ‘078 Patent are indefinite, I disagree. A person of ordinary skill in the art would

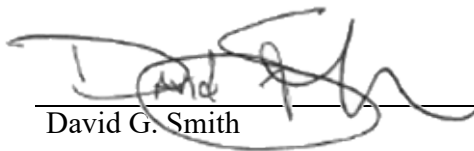
have understood the difference between the claim scope of '788 Patent claim 7 and the claims of the '078 Patent, and would further have understood, with reasonable certainty, the scope of the claim term "predetermined condition associated with a geographic region" in the '078 Patent.

37. I reviewed the file histories of the Asserted Patents and read nothing inconsistent with my opinions above.

38. Accordingly, based on my review of the Asserted Patents' claim language, specification, figures, and file histories, a person of ordinary skill would understand, with reasonable certainty, the scope of the Asserted Claims reciting the phrase "a predetermined condition associated with a geographic region."

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Dated: 6/26/2025



David G. Smith