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
U.S. Patent No. 9,819,788 B2
Issue Date: November 14, 2017

PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 9,819,788 B2

TABLE OF CONTENTS

I. Introduction 6

II. Mandatory Notices Under §42.8(A)(1) 6

A. Real-Party-In-Interest under 42.8(b)(1) 6

B. Related Matters under §42.8(b)(2) 7

C. Lead and Back-Up Counsel under §42.8(b)(3) 7

D. Service Information under § 42.8(b)(4) 8

III. Fee Payment 8

IV. Requirements Under §§ 42.104 and 42.108 8

A. Grounds for Standing 8

B. Identification of Challenge and Precise Relief Requested 8

C. *Sotera* Stipulation 9

V. Overview of the '788 patent 10

A. Level of Ordinary Skill in the Art 10

B. Specification Overview 11

C. Claims Overview 13

D. Prosecution History of the '788 Patent 15

VI. Claim Construction 19

A. "the predetermined condition" in Claims 1 and 2 19

B. "the passage of time" in Claim 2 19

C. "locking means" 19

D. "means for unlocking" in Claim 3 22

E. "mobile electronic device" in Claims 1–3 24

VII. The Challenged Claims are Unpatentable 24

A. Overview of Grounds 24

B. Prior Art Status of References 25

C. Ground 1: Claim 1 is unpatentable under 35 U.S.C. §102 over Samuel 26

1. Summary of Samuel 26

2. Independent Claim 1 28

D. Ground 2: Claims 1, 3–4, and 6–7 are unpatentable under 35 U.S.C. § 103 over Samuel in view of Shin 33

1. Summary of Samuel 33

2. Summary of Shin 33

3. Reasons to Combine Samuel and Shin 35

4. Independent Claim 1 36

5. Independent Claim 3 43

6. Dependent Claim 4 52

7. Dependent Claim 6 54

8. Dependent Claim 7 55

E. Ground 3: Claims 2 and 8 are unpatentable under 35 U.S.C. § 103 over Samuel in view of Shin in further view of Simpson 56

1. Summary of Samuel 56

2. Summary of Shin 56

3. Summary of Simpson 56

4. Reasons to Combine Samuel, Shin, and Simpson 59

5. Independent Claim 2 63
6. Dependent Claim 8 65
VIII. Conclusion 66
Certificate of Word Count 68
Certification of Service 69

LIST OF EXHIBITS

Exhibit No.	Description of Document
1001	U.S. Patent No. 9,819,788 B2 to Graham Dugoni (filed April 21, 2015, issued November 14, 2017) ("'788 patent")
1002	Declaration of Dr. Gregory Buckner ("Buckner Decl.")
1003	Curriculum Vitae of Gregory Buckner
1004	Prosecution History of U.S. Patent No. 9,819,788 B2
1005	U.S. Patent Appl. Pub. No. 2003/0011455 to Samuel et al. (filed February 15, 2001, published January 16, 2003) ("Samuel")
1006	Korean Patent Laid-open No. 10-2007-0041248 to Hyo-jyn Shin (filed October 14, 2005, published April 18, 2007) ("Shin")
1007	U.S. Patent Appl. Pub. No. 2012/0187003 to Stewart et al. (filed January 21, 2011, published July 26, 2012) ("Stewart")
1008	U.S. Patent Appl. Pub. No. 2014/0298492 to Simpson (filed March 14, 2014, published October 2, 2014) ("Simpson")
1009	Dkt. No. 1, Complaint in Case No. 2024-CV-1326 pending in the Western District of Texas, Austin Division ("Complaint")
1010	U.S. Patent No. 6,499,638 to Campbell (filed July 17, 2001, issued December 31, 2002) ("Campbell")
1011	U.S. Patent No. 5,977,876 to Coleman (filed August 13, 1998, issued November 2, 1999) ("Coleman")
1012	U.S. Patent No. 6,218,929 to Furuta et al. (filed June 10, 1998, issued April 17, 2001) ("Furuta")
1013	U.S. Patent No. 6,608,548 to Pellaton et al. (filed May 22, 1998, issued August 19, 2003) ("Pellaton")
1014	U.S. Patent No. 7,277,726 to Ahya et al. (filed May 3, 2004, issued October 2, 2007) ("Ahya")
1015	U.S. Patent No. 7,181,229 to Singh et al. (filed September 23, 2003, issued February 20, 2007) ("Singh")

I. INTRODUCTION

U.S. Patent No. 9,819,788 ("the '788 patent") is entitled "System and Apparatus for Selectively Limiting User Control of an Electronic Device." EX-1001 Challenged Claims 1–4 and 6–8 are directed to lockable cases for electronic devices and systems incorporating such cases. Yondr argues these claims cover a locking pouch that can be opened or shut with nothing more than manual effort, no computer chip or network connection required, *i.e.*, not a "smart device." Indeed, by Yondr's logic, its '788 patent would cover everything from a cell phone in a polyester pouch, to a safety deposit box, to a prison cell, to a time capsule. Such a broad invention, however, is not novel under 35 U.S.C. §§ 102, 103. More specifically, as shown in this Petition, the concept of restricting device access was known before the priority date of the '788 patent based on prior art locking cases and pouches alone.

Therefore, Petitioners Be Smarter, LLC and James Guerra (collectively, "Be Smarter"), by way of this Petition and its cited evidence, respectfully request that Challenged Claims 1-4 and 6–8 be held unpatentable and cancelled due to being anticipated under 35 U.S.C. § 102 or obvious under 35 U.S.C. § 103.

II. MANDATORY NOTICES UNDER §42.8(A)(1)

A. Real-Party-In-Interest under 42.8(b)(1)

The real parties-in-interest are Be Smarter, LLC and James Guerra.

B. Related Matters under § 42.8(b)(2)

The '788 patent is the subject of pending litigation involving Petitioners: *Yondr, Inc. v. Be Smarter, LLC and James Guerra*, Case No. 2024-CV-1326 (WDTX) (filed October 31, 2024, "the WDTX Action"). Petitioner Be Smarter, LLC was served on November 4, 2024. Petitioner Mr. Guerra was served November 19, 2024.

The '788 patent was the subject of litigation in *Focally LLC (Yondr, Inc.) and Graham Dugoni v. Win Elements LLC and John Nguyen*, Case No. 5:21-CV-02105 (C.D. Cal.) (filed December 17, 2021), which was terminated on July 21, 2023. Be Smarter is not aware of any prior AIA proceedings against the '788 patent.

C. Lead and Back-Up Counsel under § 42.8(b)(3)

Be Smarter provides the following designation of counsel.

Lead Counsel

Leisa Talbert Peschel (Reg. No. 62,248)
JACKSON WALKER LLP
1401 McKinney, Suite 1900
Houston, TX 77010

Phone: 713-752-4278
Fax: 713-308-4178
lpeschel@jw.com
lpeschelipdocket@jw.com

Back-up Counsel

Arthur Gollwitzer III
JACKSON WALKER LLP
100 Congress Ave. Suite 1100
Austin, TX 78701

Phone: 512-236-2268
Fax: 713-308-4178
agollwitzer@jw.com
Pro Hac Vice[1]

[1] Motion for *pro hac vice* admission to be filed after authorization is granted.

D. Service Information under § 42.8(b)(4)

This Petition is being served by Federal Express next-day delivery to Patent Owner via the attorney of record for the '788 patent, Greenburg Traurig (NY), One Vanderbilt Avenue, New York, NY 10017.

Be Smarter consents to electronic service at the addresses provided above for lead and back-up counsel.

III. FEE PAYMENT

Be Smarter requests review of 7 claims and, therefore, submits a $51,875 payment.

IV. REQUIREMENTS UNDER §§ 42.104 AND 42.108

A. Grounds for Standing

Be Smarter certifies the '788 patent may be challenged via *inter partes* review and that it is not barred or otherwise estopped from filing this Petition.

B. Identification of Challenge and Precise Relief Requested

This Petition, supported by the declaration of Dr. Gregory Buckner ("Buckner Decl.," EX-1002), requests cancellation of the Challenged Claims of the '788 patent on the following grounds:

Ground	Claims	Basis for Challenge
1	1	Anticipated under 35 U.S.C. § 102 by Samuel (EX-1005)
2	1, 3–4, 6–7	Obvious under 35 U.S.C. § 103(a) over Samuel in view of Shin (EX-1006)

3	2, 8	Obvious under 35 U.S.C. § 103(a) over Samuel in view of Simpson (EX-1008) in further view of Shin

The ’788 patent generally relates to locking cases or pouches used to store and preclude use of cellular phones or other electronic devices. The Challenged Claims focus on a pouch or case with a locking mechanism; that is, the technology is not sophisticated, and the prior art manifestly teaches all elements of the Challenged Claims. Accordingly, expert testimony should not be necessary to compare the prior art to the ’788 patent. Nevertheless, Be Smarter includes the accompanying declaration from Dr. Buckner out of an abundance of caution. *See* Buckner Decl., ¶¶ 1–210; *see also* EX-1003 (Dr. Buckner’s curriculum vitae).

C. *Sotera* Stipulation

Pursuant to the latest guidance provided by the Board, Be Smarter does not address discretionary denial in this Petition. *See* United States Patent and Trademark Office Memorandum, dated March 26, 2025 and “FAQs for Interim Processes for PTAB Workload Management.” However, in accordance with the Board’s precedential decision in *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18–19 (PTAB Dec. 1, 2020), Petitioners Be Smarter, LLC and James Guerra stipulate that if the Board institutes post-grant review in this proceeding, then Petitioners will not pursue in the parallel district court proceeding, *Yondr, Inc. v. Be Smarter, LLC and James Guerra*, Case No. 2024-CV-1326 (WDTX), the same

grounds as in the Petition or any grounds that could have reasonably been raised in the Petition.

V. OVERVIEW OF THE '788 PATENT[2]

A. Level of Ordinary Skill in the Art

A person of ordinary skill in the art 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. Buckner Decl., ¶ 91. A person could have qualified with more formal education and less technical experience or *vice versa*. Buckner Decl., ¶ 91.

The application for the '788 patent was filed April 21, 2015. The specification purports to claim priority to U.S. Provisional Patent Application No. 61/982,789 filed on April 22, 2014 (EX-1001, Cover, 1:8–10) but Yondr did not properly claim priority to that 2014 application. *See* EX-1004-149–150 (February 15, 2022 Petition to Accept Unintentionally Delayed Domestic Priority Claim Under 37 CFR 1.78(e)). Therefore, April 21, 2015, is the priority date.[3] However, irrespective of whether the

[2] Unless otherwise specified, all **bold** or ***bold italics*** emphasis has been added. For example, Petitioners use **bold** emphasis for figure identifiers and claim language.

[3] In the WDTX Action, Yondr asserts April 21, 2015 is the priority date.

priority date of the ’788 patent is April 21, 2015, or April 22, 2014, the level of ordinary skill in the art would be the same. Buckner Decl., ¶ 92.

B. Specification Overview

The ’788 patent is titled “System and Apparatus for Selectively Limiting User Control of an Electronic Device” and issued on November 14, 2017. EX-1001, Title. The ’788 patent is in the field “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.

The ’788 patent acknowledges prior art attempts were made to limit use of 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 states this solution was “deficient because it fails to block the screen to diminish possible temptation to use the device.” EX-1001, 2:9–11.

As a purported solution, the ’788 patent describes a case sized to accommodate a mobile electronic device having a case comprising 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:

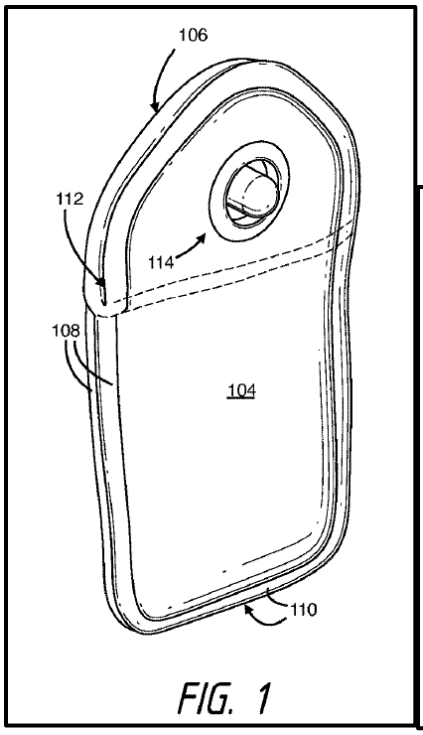


FIG. 1

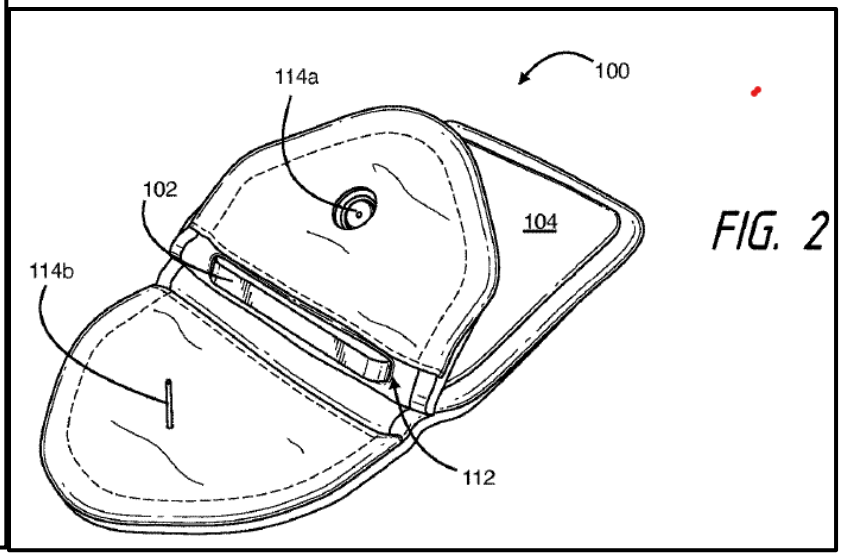


FIG. 2

EX-1001, Figs. 1–2, 2:46–52, 5:62–6:6; *see also* EX-1001 at Figs. 3–4. Such a 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. The ’788 patent teaches the locking mechanism 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, 3:14–26, 7:9–53. Alternatively, the ’788 patent also teaches that, in some embodiments, the case may be unlocked by “venue staff.” EX-1001, 3:10–13, 6:39–6:51.

Although depicted as a “soft, flexible case,” the ’788 patent notes 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.

The ’788 patent describes one physical structure of a locking means as securably mateable opposing plates disposed on the front and rear panels but contemplates that other locking means such as magnetic plates, selectively releasable mesh, lockable zippers, or key operated latches could be used. EX-1001, 6:25–44.

C. Claims Overview

Independent claim 1 of the ’788 patent is representative of claims 1 and 2 (indicators added):

> **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.

EX-1001, cl. 1. Claim 2 only differs from claim 1 in its identification of the predetermined condition, which is “the passage of time” in place of “geographical region” (element **2(c)**). EX-1001, cl. 2.

Independent claim 3 is representative of claims 3–9 (indicators added):

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.

(EX-1001, cl. 3.) Dependent claims 4 and 6 further limit the structure of the case, and claims 7–8 specify the predetermined condition as "physical presence outside of a defined geographical region" (claim 7, same as 1(c)) and "the passage of time" (claim 8, same as 2(c)), respectively.

As discussed in detail below, the cases and systems presented in the '788 patent, namely, lockable cases for electronic devices that require a condition to be

met before unlocking, were well known to persons of ordinary skill in the art before the earliest priority date of the ’788 patent.

D. Prosecution History of the ’788 Patent

U.S. Patent Application No. 14/692,530 (“the ’530 Application”), which ultimately issued as the ’788 patent was filed on April 21, 2015. EX-1001, Cover.

The Examiner erred during prosecution of the ’788 patent. First, the Examiner correctly rejected the Applicant’s claims over Stewart (EX-1007)—and Stewart combined with other references—multiple times. EX-1004-048–058 (October 3, 2016 Non-final Rejection at 4–14), (May 5, 2017 Office Action at 5–16).

Next, the Examiner issued an office action on October 3, 2016, rejecting pending claims under § 102 and § 103 over Stewart (EX-1007) and Stewart in combination with Campbell (EX-1010), Coleman (EX-1011), Furuta (EX-1012), Pellaton (EX-1013), or Ahya (EX-1014). EX-1004-048–060 (October 3, 2016 Office Action at 4–16); Buckner Decl., ¶¶ 71–77 (discussing the first office action). The Examiner specifically relied on Stewart’s teaching of a case for securing a mobile electronic device until a predetermined condition is met including as shown in Figure 1:

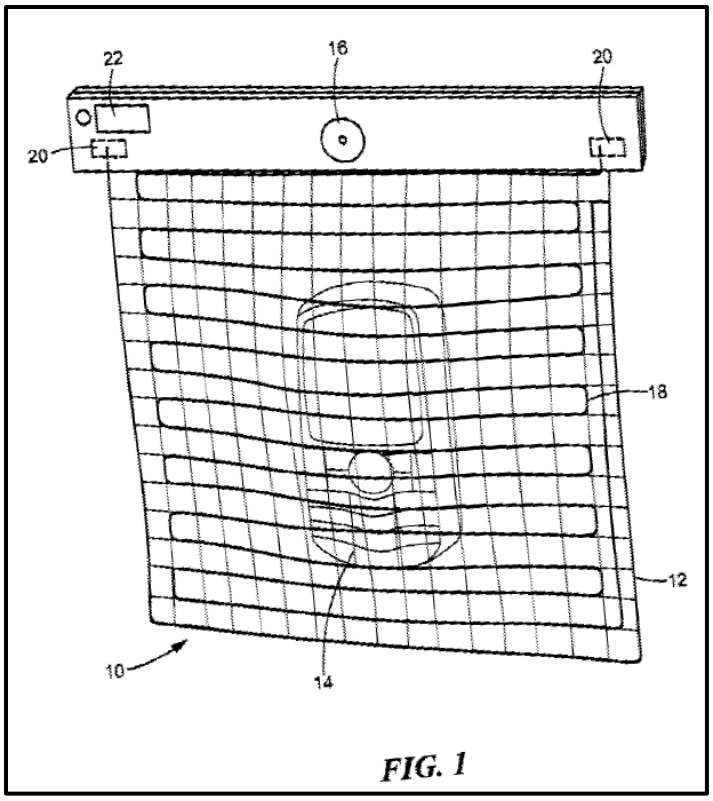


FIG. 1

EX-1004-048–049 (October 3, 2016 Office Action at 4–5); *see also* Buckner Decl., ¶¶ 111–115 (providing an overview of Stewart's teachings).

The Applicant responded on March 3, 2017, by amending the claims and arguing that Stewart did not teach "limiting a user's access to his own property." EX-1004-073 (March 3, 2017 Response at 6); Buckner Decl., ¶ 78. The Applicant also argued the Examiner failed to establish a *prima facie* showing of obviousness regarding the Stewart combinations by failing 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 cited prior art.

In the May 5, 2017 Office Action, the Examiner rejected pending claims 1–7, 10, and 12–17 over Stewart and Stewart combinations, but indicated that pending claims 8, 9, and 11 would be allowable if rewritten as independent claims. EX-1004-100 (May 5, 2017 Office Action at 17). However, pending claims 8, 9, and 11 (which ultimately became issued claims 1–3) contained the same limitations as other claims the Examiner had rejected over Stewart and Stewart combinations and should have been rejected for the same reasons. *See* EX-1004-029–030 (original claims filed April 21, 2015 at 22–23). As correctly summarized by the Examiner with respect to pending claims 1–7, 10, and 12–17, "Applicants are just copying United States Patent Application 2012/0187003 [Stewart] and using it for another intended use." EX-1004-106 (May 5, 2017 Office Action at 23). That rationale should also have been applied to pending claims 8, 9, and 11. *See* Buckner Decl., ¶¶ 79–82 (discussing the application of Stewart to the claims).

Pending claim 8 depended from rejected claim 7 and added the limitation "wherein the predetermined condition is physical presence outside of a defined geographic region." EX-1004-029 (April 21, 2015 Claims at 22). That limitation also appeared in claim 5, which had been rejected over Stewart and Furuta (EX-1012). EX-1004-029 (April 21, 2015 Claims at 22); EX-1004-055 (October 3, 2016 Office Action at 11); EX-1004-095 (May 5, 2017 Final Rejection at 12). Pending claim 9 also depended from rejected claim 7 and added the limitation "wherein the

predetermined condition is the passage of time," which was the same limitation rejected in pending claim 6 over Stewart and Pellaton (EX-1013). EX-1004-029 (April 21, 2015 Claims at 22); EX-1004-057 (October 3, 2016 Office Action at 13); EX1004-097 (May 5, 2017 Final Rejection at 14). Similarly, pending claim 11 depended from rejected claim 10, and added limitations regarding the front and rear panels and a locking means that also were described in pending claim 1, which was rejected over Stewart. EX-1004-028, -030 (April 21, 2015 Claims at 21, 23); EX-1004-048–049 (October 3, 2016 Office Action at 4–5); EX-1004-088–089 (May 5, 2017 Final Rejection at 5–6). Rather than reject those claims, which would have been consistent with the Examiner's application of Stewart and the Stewart combinations to the other claims, the Examiner erroneously indicated claims 8, 9, and 11 were allowable if re-written to independent form. EX-1004–099 (May 5, 2017 Final Rejection at 16).

In response to this error, the Applicant then rewrote the claims, which ultimately issued as the independent claims of the '788 patent (claims 1–3) following a Notice of Allowance that provided no reasoning. EX-1004-117–119 (September 1, 2017 Am. And Resp. to Final Office Action at 2–4); Buckner Decl., ¶ 83; EX-1004-127 (Notice of Allowability).

A more detailed analysis of the prosecution history of the '788 patent is included in the Declaration of Dr. Gregory Buckner. EX-1002, ¶¶ 71–90.

VI. CLAIM CONSTRUCTION

A. "the predetermined condition" in Claims 1 and 2

Claims 1 and 2 refer to "the predetermined condition" without any antecedent basis and are thus indefinite. Be Smarter, however, notes the patentee has requested a certificate of correction to add "until ***a*** predetermined condition is met" at the end of the locking means element in claims 1 and 2 but that the Office has not yet issued any correction. *See* EX-1004–172 (Request for Certificate of Correction). Solely for purposes of analyzing the '788 patent in this Petition, Petitioners 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 the proper antecedent basis for "the predetermined condition." *See also* Buckner Decl., ¶¶ 43, 45, 53.

B. "the passage of time" in Claim 2

Claim 2 refers to "the passage of time" without an antecedent basis. Solely for purposes of this proceeding, Petitioners interpret that phrase to refer to "a passage of time." *See also* Buckner Decl., ¶ 54.

C. "locking means"

Each of the "locking means" phrases in claims 1–3 should be interpreted under 35 U.S.C. § 112(f) as a means-plus-function element with the function as specified in the claim language, including that following the proposition "for." 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." Claims 1 and 2 also require that the locking means is further non-disengageable by the user of the mobile electronic device [until a predetermined condition is met] (*e.g.*, relating to geography or time).[4] EX-1001, claims 1 and 2; Buckner Decl., ¶ 55. Claim 3 requires "a locking means for at least partially securing the opening." *See* Buckner Decl., ¶ 56 (explaining claim differences). In claim 3, the case is also "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]." The claim context for "locking means" in each of the independent claims therefore demonstrates that such means is required to be controlled by someone other than user of the mobile electronic device being contained with the case. Buckner Decl., ¶¶ 56–57.

The potential structures disclosed in the '788 patent specification for a locking means include opposing plates that include securably mateable female **114*a*** and male members **114*b*** as shown in Figure 4 as locking means **114**. Ex. 1001, FIG. 4, 2:53–56, 6:25–29, 6:52–58. The '788 patent further discloses the following are alternative locking means: magnetic plates, selectively releasable mesh, lockable

[4] Bracketed language is only included if the Applicant's certificate of correction is entered but both claims 1 and 2 also include specific requirements for "the predetermined condition."

zippers, or a manual, key-operated latch. EX-1001, 6:30–31, 6:42–44, 6:61–65; *see also* Buckner Decl., ¶¶ 58–63 (comparing structures disclosed in the specification to the functional requirements of the independent claims of the '788 patent).

A manual, key-operated latch would not meet all the functional requirements for the "locking means" and therefore should not be a structure included in the construction for claims 1–3 because a manual, key-operated latch cannot be programmed to be "non-disengageable by the user of the mobile electronic device [until a predetermined condition is met]" (claims 1–2) or be "locked so that the user is unable to access his own mobile electronic device contained therein until a predetermined condition is met" (claim 3). EX-1001, claims 1–3; Bucker Decl., ¶ 60.

For these reasons, "locking means" should be construed as follows:

Claims	Structure	Function
Claims 1 and 2	opposing plates with securably mateable female and male members, magnetic plates, selectively releasable mesh, or lockable zippers	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
Claim 3	opposing plates with securably mateable female and male members, magnetic plates, selectively	at least partially securing the opening so that the user is unable to access his own mobile electronic device contained therein

Claims	Structure	Function
Claims 1 and 2	opposing plates with securably mateable female and male members, magnetic plates, selectively releasable mesh, or lockable zippers	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
	releasable mesh, or lockable zippers	until a predetermined condition is met

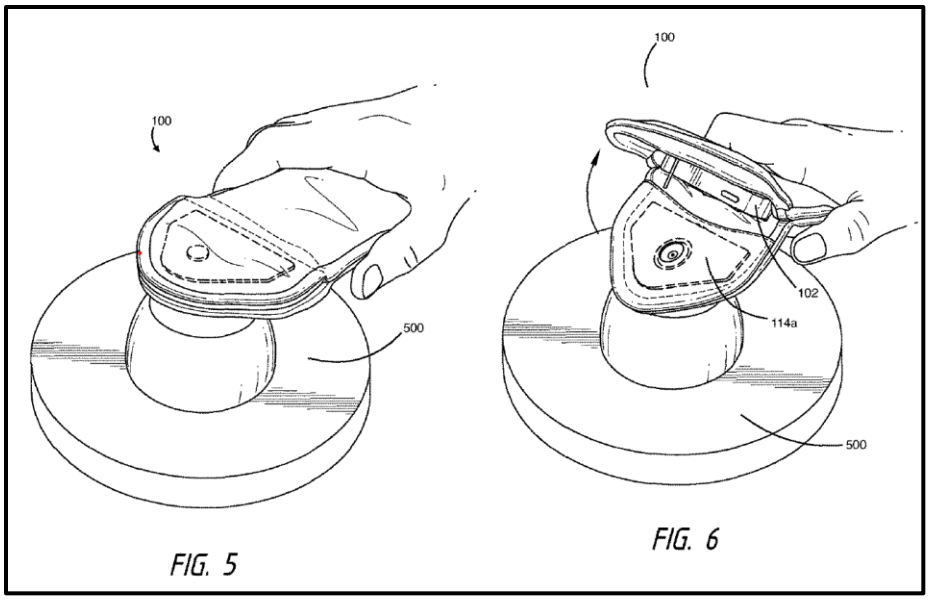
See Buckner Decl., ¶¶ 62–63 (noting constructions are consistent with the claims and specification).

D. "means for unlocking" in Claim 3

Claim 3 includes the phrase "means for unlocking the case," which also should be interpreted under 35 U.S.C. § 112(f). The function of this means phrase is therefore "unlocking the case."

The '788 patent depicts one potential "embodiment of means for unlocking an embodiment of the case" in Figures 5 and 6, which is an electronic article surveillance (EAS) detacher **502**[5] that has strong magnets for disrupting electromagnetic fields to separate the mating portions of the locking means **114**:

[5] Although the text of the '788 patent refers to an EAS detacher labeled 502, in Figures 5 and 6 there is no such label.



EX-1001, 4:13–15, 6:52–61; *see also* Buckner Decl., ¶¶ 64–65. The "predetermined condition" discussed for this embodiment involves the user "locating an EAS detacher" to unlock the locking means and is therefore 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, 6:52–7:8; Buckner Decl., ¶ 65. Therefore, this is not a structure that should be included in the construction of "unlocking means" for claim 3.

The '788 patent also discloses an unlocking means could be the "corresponding key" if the locking means is a "manual, key-operated latch." EX-1001, 6:42–44; *see also* Buckner Decl., ¶ 66. However, as explained above, the manual, key-operated latch embodiment does not meet all of the requirements for

the locking means in claim 3. Therefore, this embodiment also is inapplicable to the construction for the unlocking means in claim 3.

The '788 patent also discusses an embodiment where the means for unlocking the case constitutes a transmitter **702** that sends a signal to unlock the case to RFID tags disposed in the locking means as shown in Figure 7. EX-1001, FIG. 7, 7:9–29; *see also* Buckner Decl., ¶ 67.

Be Smarter therefore proposes that "means for unlocking the case" be construed to have the function of unlocking the case and the structure of an electronic signal transmitter. *See* Buckner Decl., ¶ 68 (noting consistency of this construction with the claims and specification).

E. "mobile electronic device" in Claims 1–3

Each of the independent claims refers to a "mobile electronic device." This term should have its plain and ordinary meaning as viewed in light of the specification, which identifies cellphones, smart phones, and tablet computers as examples of mobile electronic devices. EX-1001, 1:52, 8:38–41; *see also* Buckner Decl., ¶ 69.

VII. THE CHALLENGED CLAIMS ARE UNPATENTABLE

A. Overview of Grounds

The Challenged Claims attempt to secure patent rights in lockable cases used to render mobile electronic devices inaccessible until a predetermined condition is

met. These cases and systems were known and the Challenged Claims are invalid in light of the prior art.

Each of Grounds 1 to 3 primarily rely on Samuel (EX-1005), which discloses a locked case for securely transporting valuable objects that can only be unlocked when some condition is satisfied, such as arrival at a specific address. *See* Buckner Decl., ¶¶ 99–104 (providing an overview of Samuel). Grounds 2 to 3 also rely on Shin which describes an envelope for securing an object such as a cellphone. *See* Buckner Decl., ¶¶ 93–98 (providing an overview of Shin). Finally, Ground 3 cites Simpson for using the passage of time as the predetermined condition for unlocking the case. *See* Buckner Decl., ¶¶ 105–110 (providing an overview of Simpson). The Challenged Claims are anticipated and obvious in view of this prior art.

B. Prior Art Status of References

Each reference cited in the grounds listed in Section IV.B qualifies as prior art. Samuel and Shin qualify as prior art under 35 U.S.C. § 102(a)(1) because they are printed publications that published before the effective filing date of the '788 patent. EX-1005, Cover (filed February 15, 2001, published January 16, 2003); EX-1006, Cover (filed October 14, 2005, published April 18, 2007). Buckner Decl., ¶¶ 93, 99. Simpson is prior art under 35 § U.S.C. 102(a)(1) (or prior art under 35 U.S.C. § 102(a)(2) if the priority date becomes April 22, 2014). Buckner Decl., ¶ 105.

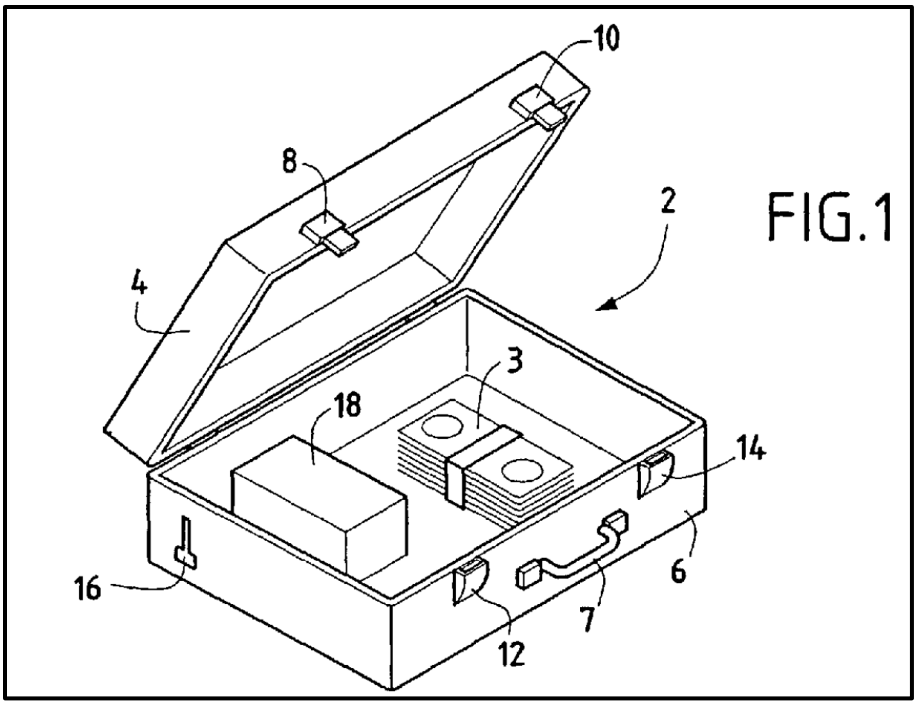
C. Ground 1: Claim 1 is unpatentable under 35 U.S.C. § 102 over Samuel

1. Summary of Samuel

U.S. Publication No. 2003/0011466 to Samuel *et al.* ("Samuel") published on January 16, 2003, from an application filed on February 15, 2001, and is titled "Device and Method for Safe Transport on an Object." EX-1005, Title; *see also* Buckner Decl., ¶¶ 99–104 (providing an overview of Samuel).

Samuel describes devices for the secure transportation of an object, which can be remotely monitored and opened (*i.e.*, unlocked) based on a predetermined condition, including when the container is located at a specific address. EX-1005, [0014]–[0020], [0038], [0041], [0069], [0073], [0124], [0182], cls. 1, 18.

One example of a Samuel device is shown in Figure 1, which depicts a case with two parts **4**, **6** that can be closed by locking means **8**, **10**, **12**, and **14**:



EX-1005 Fig. 1, [0083]. Means **18** can send signals to a monitoring system and monitor opening and closure of the locking means **8**, **10**, **12**, **14**. EX-1005, [0088]–[0090], [0105]–[0109]. ***Although the Samuel device in Figure 1 is shown as a hard case, Samuel specifically teaches the device also could be a parcel type device made of more flexible materials with an "envelope" structure— i.e., a pouch.*** EX-1005, [0091].

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

2. Independent Claim 1

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

While Be Smarter does not assert that the preamble is limiting, Samuel discloses a "**case**" that fulfills the purpose set forth in the preamble. It would have been apparent the case disclosed in Samuel could be used "**for selectively limiting a user's ability to control such user's own mobile electronic device**." Buckner Decl., ¶¶ 125–126. Specifically, Samuel discloses "[a] device (**2**) for the secure transportation of an object (**3**)," which corresponds to the claimed "**case**." EX-1005, Abstract. Samuel explicitly describes device **2** as a case. EX-1005, [0093].

Samuel further teaches the case may be locked without the ability to unlock the case until a specific state (*i.e.*, condition) is met. EX-1005, [0009]–[0018], [0038] (determining whether the address 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"). In this way, the object being transported in a Samuel case is inaccessible during such transport, including to the user of the object. Buckner Decl., ¶ 127. Put simply, Samuel teaches that the mobile phone is locked in the case and thereby inaccessible to the user.

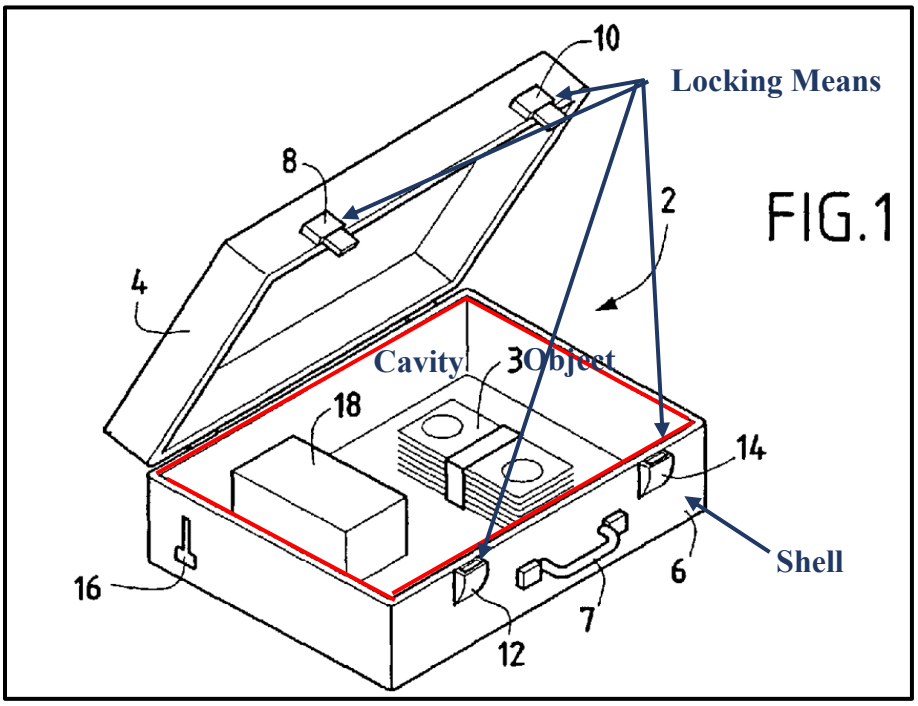
Samuel also is clear that its disclosures are applicable to any size container such that any object may be secured in an appropriately sized case. EX-1005, [0021]; *see also* EX-1005, Fig. 1 (showing a case transporting an object (cash) of similar size to a cellphone), [0001]–[0002] (noting items similar in size to cellphones may be securely transported, such as cash or checks and noting the Samuel case may be applied to transport "valuable merchandise"), [0083]–[0084], [0182] (broadly describing cash, documents, or objects to be transported in a Samuel case). Thus, it would have been readily apparent that the object transported in Samuel could be a mobile electronic device, such as a cellphone. Buckner Decl., ¶ 128.

Claim Element	Claim Language
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**

Samuel anticipates the limitations of claim element 1(a). As shown in Figure 1, the Samuel case includes "**a shell defining a cavity sized to accommodate**" an object such as "**the user's mobile electronic device**"—specifically, lower part **6** of case **2** has a cavity in which cash **3** is depicted as the object being transported. EX-1005, Fig. 1, [0083]–[0084]; Buckner Decl., ¶ 130. As noted above, cash and mobile electronic devices such as cellphones are similar in size and thus the cavity shown

in the Samuel case is "**sized to accommodate the user's mobile electronic device**." Buckner Decl., ¶ 130.

Further, when open/unlocked, the opening of the shell in the Samuel case has an opening to receive the user's mobile electronic device:



EX-1005, Fig. 1 (red outlining the opening above the cavity, annotations added in blue); Buckner Decl., ¶ 130–131.

Claim Element	Claim Language
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]**;**

Samuel also anticipates this limitation. Buckner Decl., ¶ 135. As noted above, the "**locking means**" in claim element 1(b) should be construed to have 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 and the structure of opposing plates with securably mateable female and male members, magnetic plates, selectively releasable mesh, or lockable zippers. In Samuel, the corresponding "**locking means**" is locking means **8**, **10**, **12**, and **14**, which, as shown in annotated Figure 1 above, include 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]; Buckner Decl., ¶¶ 135–136. Thus, Samuel discloses the structure of the "**locking means**." And, as noted above, the locking means **8**, **10**, **12**, and **14** in the Samuel case perform the required function of rendering the object being transported inside the case inaccessible to the user until a certain condition is 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; Buckner Decl., ¶ 136.

The locking means in Samuel (**8**, **10**, **12**, **14**) are also "**non-disengageable by the user of the mobile electronic device**" (or whatever object is transported 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]; Buckner Decl., ¶ 139.

As noted in Section VI.A, the patentee requested a certificate of correction to add the language noted in brackets to claim element 1(b) in the table above. Samuel further discloses the locking means is non-disengageable by the user of the mobile electronic device ***until a 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 is in a predetermined state such as arriving at a predetermined location. EX-1005, [0038], [0069], [0073], [0125]; Buckner Decl., ¶ 141.

Claim Element	Claim Language
1(c)	**wherein the predetermined condition is physical presence of the case outside of a defined geographic region.**

Samuel also anticipates the requirement in claim element 1(c) that "**the predetermined condition is physical presence of the case outside of a defined geographic region**." Samuel concerns secure transportation of objects and predefines location of the case at a particular address—which is distinct from the geographic region in which the case began—as a condition for sending the unlock signal. *See, e.g.*, EX-1005, [0038], [0058], [0123]–[0125]; Buckner Decl., ¶ 142.

D. Ground 2: Claims 1, 3‑4, and 6–7 are unpatentable under 35 U.S.C. § 103 over Samuel in view of Shin

1. Summary of Samuel

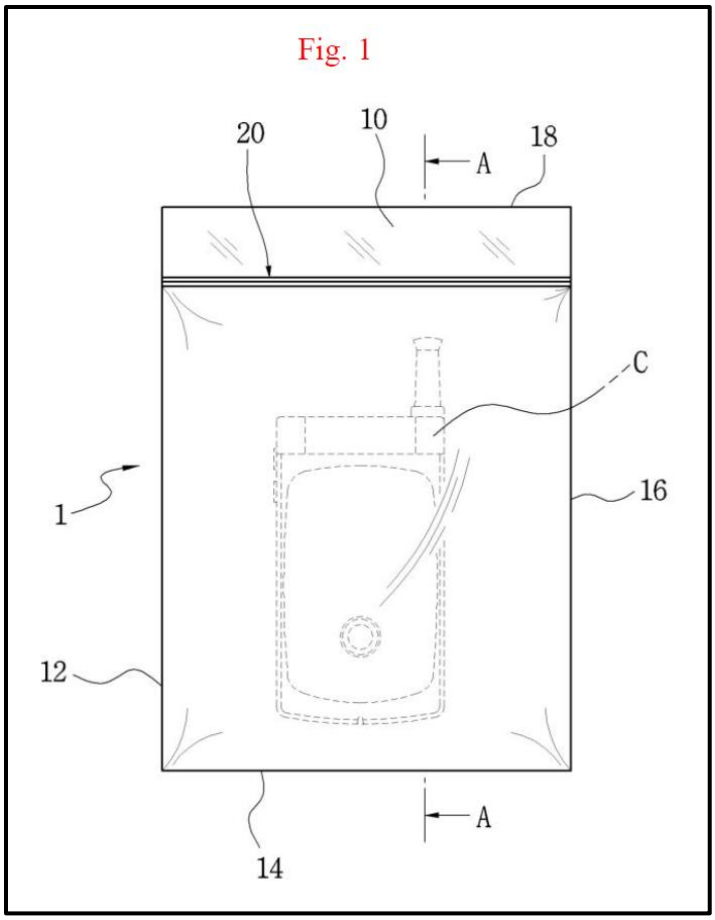
Be Smarter incorporates the summary of Samuel in Section VII.C.1 into Ground 2.

2. Summary of Shin

K.R. Patent Laid-open No. 10-2007-0041248 to Hyo-kyun Shin ("Shin") published on April 18, 2007, and is titled "Radio Wave Blocking Envelope for Storing a Mobile Phone." EX-1006,[6] Title; *see also* Buckner Decl., ¶¶ 93–98 (providing an overview of Shin).

As set forth in the Abstract, Shin describes "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" in order to prevent "phone rings or vibration sounds in public places where silence is required." EX-1006, Abstract, 5–6, 9. Figure 1 illustrates an embodiment that depicts a cellphone stored within the mobile phone storage envelope:

[6] All references to Shin in this Petition are to the certified English translation included in EX-1006.



EX-1006, Fig. 1; *see also* EX-1006, Figs. 2, 6, 8, and 11–14 (illustrating various embodiments of the envelope with a cellphone).

Shin also discloses that in some embodiments, "a portion of the envelope automatically opens after a predetermined time, for example, after a performance ends, allowing calls from outside to be received." EX-1006, at 6, 9–10 ("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"). In preferred embodiments of the Shin envelope, there is a closing member (*e.g.,* first closing member **20**) that "includes a male profile strip **21** and a

female profile strip **23** that are formed to be suitably engaged with engage with each other to lock the opening **9** of the envelope." EX-1006, at 7. In one embodiment, the closing member is a zipper, but Shin makes clear that various coupling means could be used. EX-1006, at 8.

3. Reasons to Combine Samuel and Shin

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 notes:

> 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). As discussed by Dr. Buckner, one of ordinary skill 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.[7] Buckner Decl., ¶ 116; *see also* EX-1006, Figs. 1–14.

[7] References to the "Samuel envelope" herein refer to the Samuel case as a person of ordinary skill has modified using the disclosures in Shin to adopt an envelope structure sized to contain a cellphone.

In addition, both Samuel and Shin teach ways of preventing unauthorized access to objects in such a case or envelope (at least temporarily). EX-1005, [0009]–[0020]; EX-1006, Abstract, 6–7. Thus, a person of ordinary skill 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 an object such as a cellphone or other valuables. Buckner Decl., ¶ 117. Additional motivations to combine may be discussed below.

4. Independent Claim 1

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

While Be Smarter does not assert that the preamble is limiting, Samuel discloses a case that fulfills the purpose set forth in the preamble. A person of ordinary skill would understand that the case disclosed in Samuel could be used to selectively limit a user's ability to control his or her own mobile electronic device. Buckner Decl., ¶¶ 125–126. Specifically, Samuel discloses "[a] device (**2**) for the secure transportation of an object (**3**)." EX-1005, Abstract. Samuel teaches the case may be locked without the ability to unlock the case until a specific state (*i.e.*, condition) is met. EX-1005, [0009]–[0018], [0038] (determining whether the address 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"). In this way, the object being transported in a Samuel case is inaccessible during such transport, including to the user of the object. Buckner Decl., ¶ 127. Put simply Samuel teaches that the mobile phone is locked in the case and thereby inaccessible to the user.

Samuel's disclosures also are applicable to any size container such that any object may be secured in an appropriately sized case. EX-1005, [0021]; *see also* EX-1005, Fig. 1 (showing a case transporting an object (cash) of similar size to a cellphone), [0001]–[0002] (noting items similar in size to cellphones may be securely transported, such as cash or checks and noting the Samuel case may be applied to transport "valuable merchandise"), [0083]–[0084], [0182] (broadly describing cash, documents or objects to be transported in a Samuel case). Thus, a person of ordinary skill would have understood that the object transported in a Samuel case could be a mobile electronic device, such as a cellphone. Buckner Decl., ¶ 128.

In addition, for the reasons discussed in Section VII.D.3, a person of ordinary skill would have been motivated to look to Shin to modify the Samuel case. As illustrated in its figures, Shin depicts a mobile phone **C** as the valuable object contained within the case. EX-1006, Figs. 1–2, 6, 8, 11–14. A mobile phone is an

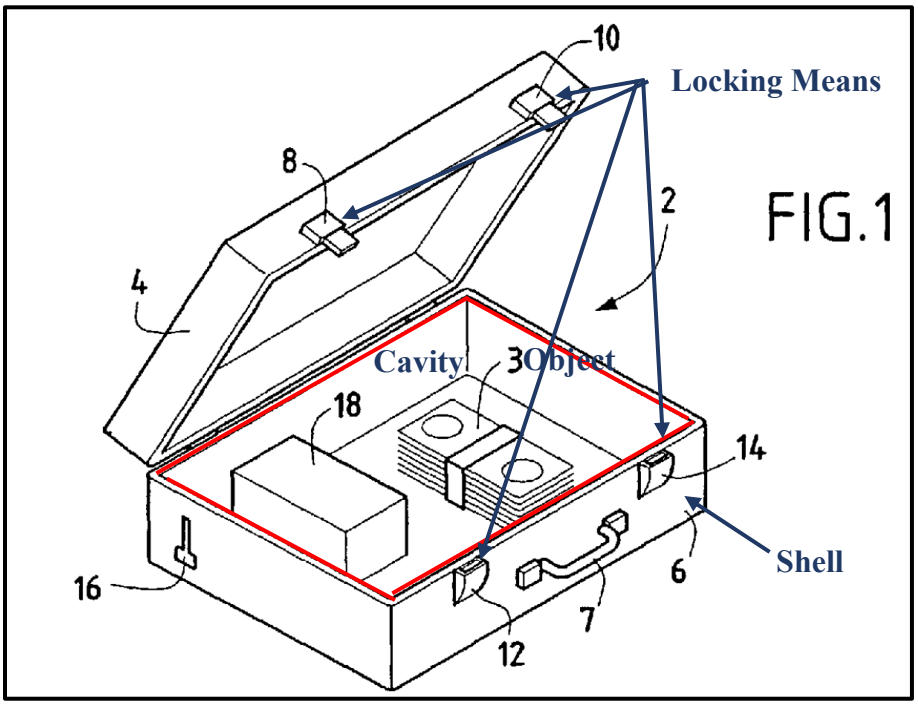
example of a "mobile electronic device" as required by the claims of the '788 patent. EX-1001, 1:50–56. A person of ordinary skill would have considered the mobile phone of Shin to easily substitute for the cash depicted in the Samuel case as the object being transported because they are of a similar size. Buckner Decl., ¶ 129. Thus, the combination of Samuel and Shin renders obvious the preamble of claim 1.

Claim Element	Claim Language
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**

Samuel in combination with Shin also discloses and renders obvious the limitations of claim element 1(a). As shown in Figure 1, the Samuel case includes "**a shell defining a cavity sized to accommodate the user's mobile electronic device**"—the lower part **6** has a cavity in which cash **3** is depicted as the object being transported. EX-1005, Fig. 1, [0083]–[0084]. As noted above, cash and mobile electronic devices such as cellphones are similar in size and thus the cavity shown in the Samuel case is "**sized to accommodate the user's mobile electronic device**." Buckner Decl., ¶ 130. Shin also explicitly discloses a mobile phone (*i.e.*, the mobile electronic device) as the valuable object contained within a case. EX-1006, Figs. 1–2, 6, 8, and 11–14; Buckner Decl., ¶¶ 132–134. Therefore, a person of ordinary skill

would have been motivated to use the Samuel case to transport a mobile phone (*i.e.*, a mobile electronic device). Buckner Decl., ¶¶ 116–118.

Further, when open/unlocked, the opening of the shell in the Samuel case has an opening to receive the valuable object, such as the user's mobile electronic device:



EX-1005, Fig. 1 (red outlining the opening above the cavity, annotations added in blue); Buckner Decl., ¶¶ 130–131. Likewise, Shin depicts and discusses opening portion **9**, which receives the mobile phone into the envelope. EX-1006, Figs. 2, 5, 7, 9 and 6–8 (discussing opening portion **9**). Samuel and Shin therefore disclose and render obvious the requirement in claim 1 that the shell includes "**having an opening to receive the user's mobile electronic device therein**." Buckner Decl., ¶¶ 130–131, 133–134.

Claim Element	Claim Language
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]**;**

This limitation is disclosed by Samuel in combination with Shin. As noted above, the "**locking means**" in claim element 1(b) should be construed to have 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 and the structure of opposing plates with securably mateable female and male members, magnetic plates, selectively releasable mesh, or lockable zippers. In Samuel, the corresponding "**locking means**" is locking means **8**, **10**, **12**, and **14**, which, as shown in annotated Figure 1 above, include 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]; Buckner Decl., ¶ 135. Thus, Samuel clearly discloses the structure of the "**locking means**." And, as noted above, the locking means **8**, **10**, **12**, and **14** in the Samuel case perform the required function of "**rendering**" the object being transported inside the case "**inaccessible to the user**" until a certain condition is 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; Buckner Decl., ¶ 136.

Like Samuel, Shin also discloses that the closing member **20**/**120**/**220** 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 (describing those figures); Buckner Decl., ¶ 137. In addition, Shin teaches that the male and female strips of the closing member (*i.e.,* one plate with a female member and an opposing plate with a male member that are securably mateable) 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**," and a person of ordinary skill would have found it to be a natural modification of the locking means described in Shin to use the enhanced security of the locking means described in Samuel with the Shin envelope. Buckner Decl., ¶¶ 137–138.

Further, the locking means in Samuel (**8**, **10**, **12**, **14**) are "**non-disengageable by the user of the mobile electronic device**" (or whatever object is transported in a Samuel case) because the locks cannot be unlocked until an appropriate signal to unlock the case is received by means **18**. *See, e.g.*, EX-1005, [0109], [0124]–[0125]; *see also* Buckner Decl., ¶¶ 139–140 (discussing how Shin's use of a timer means

and its objective of blocking cellphone signals further suggests combining the teachings of Samuel and Shin).

The requirement specifying that the locking means is non-disengageable by the "**user of the mobile electronic device**" is met with the combination of Samuel and Shin in the Samuel envelope for the reasons described above with respect to the preamble and claim element 1(a). Buckner Decl., ¶¶ 128–134.

Further, as noted in Section VI.A, the patentee requested a certificate of correction to add the language noted in brackets to claim element 1(b). Samuel further discloses that the locking means is "**non-disengageable by the user of the mobile electronic device**" until a predetermined condition is met. Specifically, Samuel discloses that a condition for delivering the signal to open the locking means may be whether it is in a predetermined state such as arriving at a predetermined location. EX-1005, [0038], [0069], [0073], [0125]; Buckner Decl., ¶ 141. In addition, a person of ordinary skill would have viewed Shin's objective to block cellphone signals for a pre-set period of time through radio penetration hole **62** and timer means **80** to prevent use in public places 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 during 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; Buckner Decl., ¶ 140.

Claim Element	Claim Language
1(c)	**wherein the predetermined condition is physical presence of the case outside of a defined geographic region.**

Samuel also discloses the requirement in claim element 1(c) that "**the predetermined condition is physical presence of the case outside of a defined geographic region**." Samuel concerns secure transportation of objects and predefines location of the case at a particular address, which is distinct from the geographic region in which the case began, as a condition for sending the unlock signal. *See, e.g.*, EX-1005, [0038], [0058], [0124]–[0125]; Buckner Decl., ¶ 142. Shin also discusses the need to prevent access to phones in certain venues, which provides a motivation to combine the disclosures of Samuel and Shin to arrive at the invention claimed in the '788 patent. EX-1006, at 5; Buckner Decl., ¶ 143.

5. Independent Claim 3

Claim Element	Claim Language
3 (preamble)	**A system for selectively limiting a user's control of such user's own electronic device, comprising:**

While Be Smarter does not assert that the preamble is limiting, Samuel in combination with Shin, discloses and renders obvious a system that fulfills the purpose set forth in the preamble of claim 3. Buckner Decl., ¶ 165. Specifically, the combination of the Samuel case **2** and monitoring system **22** is designed to

selectively limit a user's control over the cash, documents, or valuable merchandise transported in the case 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); Buckner Decl., ¶ 166. And, as described above, a person of ordinary skill would have been motivated to combine the case disclosed in Samuel with the disclosures in Shin to use an envelope design for the case structure. *See* Section VII.D.3. Shin discloses that electronic devices, such as a cellphone, may be securely contained within its mobile phone storage envelope. *See, e.g.*, EX-1006, Figs. 1–2, 6, 8, 11–14, Abstract; Buckner Decl., ¶ 168. Considering the disclosures in both Samuel and Shin, a person of ordinary skill would naturally have considered "**a user's own electronic device**," such as a cellphone, as an object that could be contained within a case in a "**system for selectively limit a user's control of such user's own electronic device**." Buckner Decl., ¶¶ 165–168.

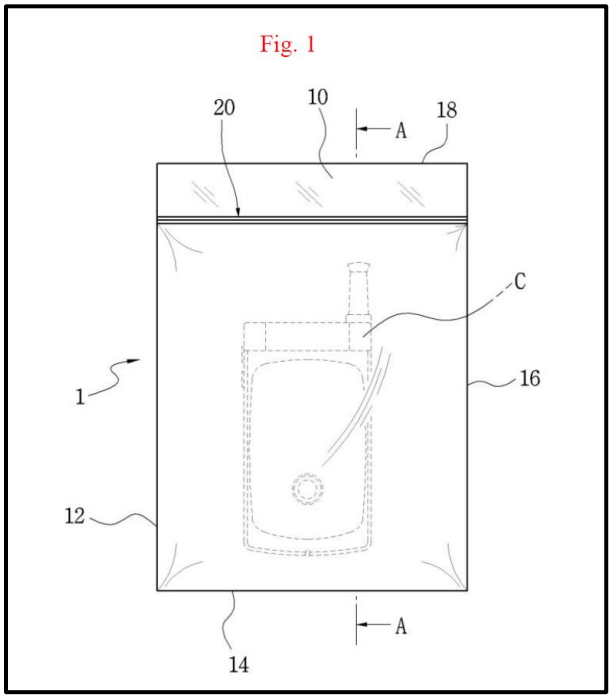
Claim Element	Claim Language
3(a)	**a case sized to receive the user's mobile electronic device having**

Samuel in combination with Shin discloses and renders obvious "**a case sized to receive the user's mobile electronic device**." 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 transported. EX-1005, Fig. 1, [0083]–[0084]. Cash and mobile electronic devices such as cellphones are similar in size and thus the case shown in Samuel Figure 1 is "**sized to accommodate the user's mobile electronic device**." Buckner Decl., ¶ 169.

Further, Samuel specifically contemplates the transport of smaller objects, in cases made with more flexible materials, such as flexible plastics materials or rubber. EX-1005, [0091]–[0092]. As discussed above, one of ordinary skill in the art would have been motivated to take the Samuel case and modify it to use more flexible materials in accordance with its own disclosures and those in Shin to form the Samuel envelope. *See* Section VII.D.3; Buckner Decl., ¶ 170.

Shin also describes the envelope structure and depicts its use to store a cellphone in Figure 1:



EX-1006, Fig. 1, 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 is sized to receive the user's mobile electronic device**." Buckner Decl., ¶ 171.

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

Shin discloses this limitation. Buckner Decl., ¶¶ 172–175. Shin discloses a case structure that includes front and rear panels—specifically, Shin describes "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); Buckner Decl., ¶ 174. 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; Buckner Decl., ¶¶ 174–175.

Claim Element	Claim Language
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;**

Samuel and Shin in combination render obvious this limitation. Buckner Decl., ¶¶ 176–184. As shown in the Shin figures, "**the first, second, and lower edges**" (*i.e.*, the left edge **12**, right edge **16**, and bottom edge **14**) of the front and rear panels (*i.e.*, first side **3** and second side **5**) are "**secured together**" in the Shin envelope (*i.e.*, one of embodiments **1**, **101**, **201**, or **301**) "**to define an opening for receiving a mobile electronic device**," specifically opening portion **9** to house mobile phone **C**. *See, e.g.*, EX-1006, Fig. 2, 5, 7, 9 (showing opening portion **9**), Figs. 1, 6 (showing the secured edges and mobile phone **C**), Abstract ("envelope formed by integrally joining left and right edges and bottom edge of a first and a second side"), cl. 1, p. 6 ("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**."); Buckner Decl., ¶¶ 177–180. Shin also specifically discloses the use of one or more closing members **20**/**120**/**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); Buckner Decl., ¶ 181.

And, as noted above in Section VII.D.3, a person of ordinary skill in the art had motivation 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. Buckner Decl., ¶ 182.

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**"—in other words, "**the case [is] operative to become locked so that the user is unable to access his own mobile electronic device**" until that predetermined condition is met. EX-1005, [0009]–[0018], [0038] (determining whether the address 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* claim 1 (preamble) discussion. Specifically, in Samuel, the 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]; Buckner Decl., ¶ 183. For example, 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; Buckner Decl., ¶ 183. The locking means 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]; Buckner Decl., ¶ 183.

And, as explained above, a person of ordinary skill would find it obvious for the object locked in the Samuel envelope—thus rendered inaccessible to the user—to be a mobile electronic device in view of the Shin disclosures. EX-1005, Fig. 1, [0083]–[0084]; EX-1006, Figs. 1–2, Abstract; Buckner Decl., ¶ 184.

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

Samuel in combination with Shin also discloses this limitation. As noted above in Section VI.C, the "**locking means**" has 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 and the structure of opposing plates with securably mateable female and male members, magnetic plates, selectively releasable mesh, or lockable zippers. The Samuel envelope meets this limitation. Buckner Decl., ¶¶ 185–188. In Samuel, the corresponding "**locking means**" is locking means **8**, **10**, **12**, and **14**, which, as shown in Figure 1, include 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]; Buckner Decl., ¶ 186. Thus, Samuel clearly discloses the structure required by the "**locking means**."

Moreover, the locking means described in Samuel fulfills the function of "**at least partially securing the opening**." As shown in Figure 2, 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 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 envelope is secured until such time as the opening signal is sent by the

monitoring system. EX-1005, [0105]–[0106], [0109], [0123]–[0125]; Buckner Decl., ¶ 187.

In addition to the disclosures in Samuel, Shin describes that the first closing member **20**/second closing member **120**/third closing member **220** (which secure the envelope) may be comprised 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, pp. 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); Buckner Decl., ¶ 188. 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)—these similarities provide a further motivation to combine Samuel and Shin. Buckner Decl., ¶ 188.

Claim Element	Claim Language
3(e)	**means for unlocking the case.**

Samuel in combination with Shin discloses and renders obvious claim element 3(e). As noted in Section VI.D, the "**means for unlocking the case**" has the structure

of an electronic signal transmitter that has the function of unlocking the case (here, the Samuel envelope). Samuel 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 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**). Particularly relevant is Samuel's disclosure that monitoring system **22** could 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 to send signals 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). Buckner Decl., ¶ 189.

6. Dependent Claim 4

Claim	Claim Language
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.

As described above, Samuel in combination with Shin renders obvious "**the case of claim 3**." *See supra* claim 3 analysis. Samuel illustrates that its locking means (**8**, **10**, **12**, **14**) include securably mateable female members (as shown in **12**, **14**) and male members (as shown in **8**, **10**) of opposing plates, which meets the structure required by the "**locking means**" element of claim 3. EX-1005, Fig. 1, [0083], [0086], [0105]; Buckner Decl., ¶ 191. A person of ordinary skill 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** secured upper portion **4** to upper portion **6** in the Samuel case embodiment shown in Figures 1 and 2 to arrive at the Samuel envelope. EX-1005, Figs. 1–2; Buckner Decl., ¶ 192. Specifically, the male and female profile strips used to lock the envelope in Shin could be easily designed as female and male plates configured to securably mate with one another based on the disclosures in Shin and Samuel. *See, e.g.*, EX-1006, Fig. 2, 5–7, pp. 7–8 (describing use of male and female profile strips to lock the envelope); Buckner Decl., ¶ 193–194. 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." Buckner Decl., ¶¶ 193–194.

7. Dependent Claim 6

Claim	Claim Language
6	**The case of claim 3, wherein a microprocessor is further disposed in one or both of the female and male plates[8] to receive a wireless data signal from a beacon or transmitter to disengage the locking means when the predetermined condition is met.**

Samuel and Shin render obvious claim 3 and further render obvious claim 6. *See supra* claim 3 analysis; Buckner Decl., ¶¶ 195–199. Samuel discloses that locking means **8**, **10**, **12**, and **14** are unlocked in response to electronic signals sent by monitoring system **22** to the case, specifically, signals 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]; Buckner Decl., ¶ 196. The opening or 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]; Buckner Decl., ¶ 197. As described with respect to claim element 3(e), which is herein incorporated by reference, that

[8] There is no antecedent basis for "**the female and male plates**" of claim 6.

opening signal is sent "**from a . . . transmitter**." EX-1005, [0103]–[0104]; Buckner Decl., ¶ 197.

Samuel further 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]; Buckner Decl., ¶ 198. It also would have been obvious to a person of ordinary skill to place the microprocessor **100** in one or both of the plates so as to cause the mechanism to unlock as quickly as possible following transmission of the signal from the monitoring system and reduce the need for multiple microprocessors within the same case. Buckner Decl., ¶ 199. Thus, Samuel renders obvious the requirements in claim 6 of "**a microprocessor [that] is further disposed in one or both of the female or male plates to receive a wireless data signal from a beacon or transmitter to disengage the locking means when the predetermined condition is met**." Buckner Decl., ¶ 199.

8. Dependent Claim 7

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

As described above, Samuel and Shin render obvious claim 3. *See supra* claim 3 analysis. Samuel further teaches that "**the predetermined condition is physical presence outside of a defined geographical region**" as required by claim 7. Samuel concerns secure transportation of objects and predefines the arrival of the case at a particular address, which is distinct from the geographic region in which the case began, as a condition for sending the unlock signal. *See, e.g.*, EX-1005, [0038], [0058], [0123]–[0125], [0173]–[0176] (describing use of GPS location to determine case location); Buckner Decl., ¶ 201; *see also* claim element 1(c) analysis (same limitation). Therefore, Samuel renders obvious the requirement in claim 7. Buckner Decl., ¶ 202.

E. Ground 3: Claims 2 and 8 are unpatentable under 35 U.S.C. § 103 over Samuel in view of Shin in further view of Simpson

1. Summary of Samuel

Be Smarter incorporates the summary of Samuel provided in Section VII.C.1 into Ground 3.

2. Summary of Shin

Be Smarter incorporates the summary of Shin provided in Section VII.D.2 into Ground 3.

3. Summary of Simpson

U.S. Publication No. 2014/0298492 ("Simpson") is entitled "Security Case," was filed March 14, 2014, claimed priority to Provisional Application No.

61/800,958 filed on March 15, 2013, and was published on October 2, 2014. EX-1008, Cover; *see also* Buckner Decl., ¶¶ 105–110 (providing an overview of Simpson).

Simpson describes security cases with locks preferably operated by an electronic key that "can be programmed to open the case . . . dependent on various different conditions, for example, location, time, identification of operator, etc." EX-1008, Abstract. The Simpson case is 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, cl. 1. The Simpson case includes a controller that determines whether a condition is met and authorizes the lock device to move to an unlocked condition. EX-1008, [0007]–[0008], cl. 1.

Figure 2 illustrates an embodiment of the Simpson case including a case **10**, cover or lid **12**, base/lower portion **14**, hinge **15**, insert **16**, cavity/lower chamber **18** (where "valuable articles" are securely transported), upstanding wall/perimeter portion **20**, and spacer area **22**:

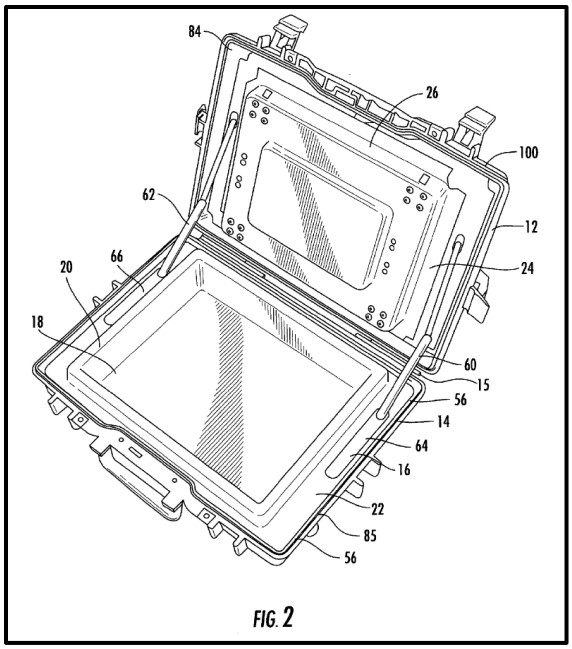


FIG. 2

EX-1008, Fig. 2, [0036]–[0037]. Figure 3 further shows upper chamber **26**, which contains locks **28** to secure the case closed. EX-1008, Fig. 3, [0037]. The Simpson case also may contain a GPS location device **30** or an electronic memory device **32.** EX-1008, Fig. 4, [0037], [0040]–[0041].

An exemplary locking mechanism to secure lid **12** to lower portion **14** of the Simpson case is illustrated in Figure 6C of Simpson, which shows a pin or locking member **36** for each lock that is operated by an electrically powered device such as a solenoid **40**. EX-1008, Figs. 6C, 8, [0037]–[0038]. Simpson teaches the use of an electronic key **42**, which can physically turn and open lock **44** if it receives a proper signal. EX-1008, [0039]. Simpson specifically notes the electronic key may be programmed to open the case at a certain time or within a certain time frame and can

be enabled or disabled from a signal "transmitted by a satellite, a cellphone, or a radio frequency transmission." EX-1008, [0039].

Simpson also teaches that the controller **54** can be programmed to authorize opening of the case within a certain time range or at a specific predetermined location. EX-1008, [0045], [0048], [0056].

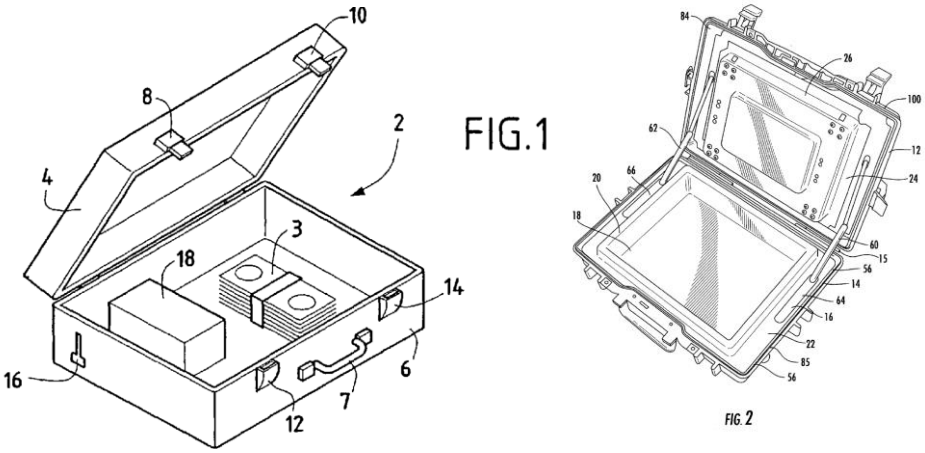
Finally, Simpson notes that while a certain form of the invention was illustrated (*e.g.*, the hard case embodiment shown in Figure 2), it should not be limited to that specific form or arrangement. EX-1008, [0060].

4. Reasons to Combine Samuel, Shin, and Simpson

Be Smarter incorporates the reasons to combine Samuel and Shin provided in Section VII.D.3. In summary, a person of ordinary skill would have been motivated to look to Shin to replace the hard case preferred embodiment of Samuel with the more flexible structure disclosed in Shin based on the explicit disclosure in Samuel that a more flexible parcel or envelope structure could be used in place of the hard case embodiment. EX-1005, [0091]; Buckner Decl., ¶¶ 116–118.

A person of ordinary skill also would have been motivated to modify the Samuel case with disclosures from Simpson because Simpson describes a very similar security case that accounts for advancements in wireless signal processing and locking/unlocking mechanisms since the publication of Samuel. Buckner Decl., ¶¶ 119–122.

First, the security cases disclosed in Samuel and Simpson are very similar:



Samuel **Simpson**

EX-1005, Fig. 1; EX-1008, Fig. 2; Buckner Decl., ¶ 120. That is, Samuel and Simpson both describe cases, as depicted in the figures above, briefcase-type structures, designed for the secure 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]. Thus, not only are Samuel and Simpson references in the same field, but they describe nearly identical security cases. Buckner Decl., ¶ 120. For these reasons, a person of ordinary skill would have been motivated to combine the disclosures of Samuel with those of Simpson in designing a secure case to store or transport valuables. Buckner Decl., ¶¶ 119–120.

Second, a person of ordinary skill looking to develop a secure case for electronic devices would consider variations on the predetermined conditions for unlocking the case, including by review of similar references. Buckner Decl., ¶ 124. Both Samuel and Simpson teach that unlocking may be dependent on certain conditions. EX-1005, [0073], [0109], [0124]–[0125], [0137]–[0141]; EX-1008, Abstract, [0039], [0045], [0056]. For example, Samuel teaches the case's status may be monitored, including by GPS, and a person of ordinary skill in the art would understand Samuel to teach 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]; Buckner Decl., ¶ 121. Specifically, Samuel discloses the predetermined condition could be that the destination of the case has been reached. EX-1005, [0123]–[0125], [0173]–[0176]; *see also* Section VII.D.8. Simpson similarly teaches its electronic key may be programmed to open the case depending on location, including through the use of GPS location. EX-1008, Abstract, [0008], [0039]–[0040], [0043], [0053], [0045], [0056]; Buckner Decl., ¶ 124.

In addition, each of Samuel, Shin, and Simpson teach using timing as a condition. Shin discloses the use of a timing means to block radio waves from entering the envelope until a set time has expired. EX-1006, 9; Buckner Decl., ¶ 122. Simpson teaches an electronic key may be programmed to open the case conditioned

on time. EX-1008, Abstract, [0008], [0039]; Buckner Decl., ¶ 124. Samuel also contemplates timing as an aspect of programming a security case. Specifically, Samuel discloses that once the signal authorizing opening the case is received, the 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 lock and unlock signals, and it would be a natural extension of Samuel for a person of ordinary skill to condition opening of the case on the passage of time as described in Simpson. Buckner Decl., ¶ 122. Thus, a person of ordinary skill would have been motivated to start with Samuel, which pre-dates Simpson, and modify the Samuel case (or the Samuel envelope) to account for alternative conditions for triggering the electronic key to unlock the case, including using the passage of time as the condition. Buckner Decl., ¶ 121.

Further, each of Samuel, Simpson, and Shin disclose ways to secure valuables, and a person of ordinary skill looking to secure electronic devices would have been motivated to look to references attempting to solve the same problem. Buckner Decl., ¶¶ 123–124.

For these reasons, a person of ordinary skill would have been motivated to combine the disclosures of Samuel, Shin, and Simpson to design a case that met the limitations of claims 2 and 8. Buckner Decl., ¶¶ 119–124.

5. Independent Claim 2

The preamble and first two elements of claim 2 of the '788 patent are identical to the preamble, 1(a), and 1(b) of claim 1. Those elements are therefore disclosed by Samuel (and Samuel modified in view of Shin) for the same reasons as set forth above with respect to claim 1, which are incorporated by reference. *See* claim 1 (preamble), 1(a), and 1(b) analysis in Sections VII.C.2 and VII.D.4 above.

Like Samuel, Simpson also contains disclosures that read on elements in the preamble, 1(a)/2(a), and 1(b)/2(b). Specifically, Simpson discloses that its "Security Case" restricts access to the valuable objects securely transported within the container, thus "selectively limiting a user's ability to control" the "valuable" stored within the case. EX-1008, Title, [0002]; Buckner Decl., ¶¶ 150–151. Simpson provides examples including jewelry, financial files, financial documents, credit cards, and intelligence files. EX-1008, [0003]. Although the specific examples of "valuables" given in Simpson do not include mobile electronic devices, one of ordinary skill in the art would understand the briefcase depicted in Figure 2 would accommodate a "valuable" such as a user's mobile electronic device (*e.g.* a cellphone or tablet computer) and thus, to one of ordinary skill in the art, Simpson teaches a security case that would meet the limitations of the preamble of claim 2 and 2(a). Buckner Decl., ¶¶ 150–158. Specifically, the "**shell defining a cavity sized to accommodate the user's mobile electronic device**" required in element 2(a) is

met by "the insert **16** [that] includes a cavity or lower chamber **18**" as depicted in Figure 2 of Simpson. EX-1008, Fig. 2, [0036]; Buckner Decl., ¶¶ 154–157. That "**shell**" of Simpson has "**an opening to receive**" a valuable, which, as noted above, a person of ordinary skill in the art would understand to include a mobile electronic device, particularly in combination with Shin's disclosure of a cellphone as the valuable being contained. EX-1008, Fig. 2; Buckner Decl., ¶¶ 155, 157–158.

Simpson also discloses the required "**locking means**" of element 2(b) of the '788 patent. As noted in Section VI.C, "**locking means**" may include opposing plates with securably mateable female and male members for at least partially securing the opening of the shell so that the electronic device is rendered inaccessible to the user. Simpson discloses that shell **16** is part of the lower portion **14** of the case, which is secured to the lid **12** using locks **28**, thus "**securing the opening of the shell**" such that the valuable, for example the user's electronic device, is "**rendered inaccessible to the user**." EX-1008, Figs. 2, 3, 6A–6C, [0002], [0036]–[0039]; Buckner Decl., ¶¶ 160, 163. As shown in Figure 6C, that locking means includes securably mateable female and male members on opposing plates to secure lid **12** to the lower portion **14** as part of the locking mechanism that includes an aperture in the side of the lower portion **14** through which pin **36** may be extended to lock the case **10**. EX-1008, Fig. 6C, [0037]; Buckner Decl., ¶ 161. 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 an electronic key **42** is used to open the lock. EX-1008, [0037]–[0039]; Buckner Decl., ¶ 162. For these reasons, Simpson, like Samuel, discloses the limitations required by element 2(b) of claim 2. Buckner Decl., ¶¶ 159–163.

Claim Element	Claim Language
2(c)	**wherein the predetermined condition is passage of time.**

Simpson also discloses the final element of claim 2, which requires the predetermined condition be the passage of time. Specifically, Simpson notes the electronic key **42** used to unlock the 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], [0045]. To a person of ordinary skill, that is a disclosure that "**the predetermined condition is passage of time**." Buckner Decl., ¶ 164.

6. Dependent Claim 8

Claim	Claim Language
8	**The case of claim 3, wherein the predetermined condition is the passage of time.**

Claim 8 of the '788 patent depends from claim 3. For the reasons discussed above in Ground 2 at Section VII.D.5, which is incorporated by reference, the combination of Samuel and Shin discloses all the limitations of and therefore renders

obvious claim 3. Claim 8 further specifies that "**the predetermined condition is the passage of time**" in reference to the limitation in claim 3 regarding the ending point of the user not being able to access his own mobile electronic device. As discussed above with respect to claim 2, Simpson discloses that "**the predetermined condition is the passage of time**." *See* Section VII.E.5 (incorporated by reference); Buckner Decl., ¶¶ 204–206. Specifically, Simpson 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]; Buckner Decl., ¶ 204. 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 person of ordinary skill 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. Buckner Decl., ¶¶ 205–206.

VIII. CONCLUSION

For the reasons set forth above, Be Smarter has established a reasonable likelihood that the Challenged Claims of the '788 patent are unpatentable. Petitioners therefore request institution of *inter partes* review and cancellation of the Challenged Claims.

Dated: May 6, 2025

Respectfully submitted,

/s/ Leisa Talbert Peschel
Leisa Talbert Peschel
Lead Counsel for Petitioners
Registration No. 62,248

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24, the undersigned attorney for Petitioners declares that the argument section of this Petition (Sections I and III–VIII) has 12,545 words, according to the word count tool in Microsoft Word with the addition of annotations not otherwise counted in figures.

Dated: May 6, 2025

Respectfully submitted,

/s/ Leisa Talbert Peschel
Leisa Talbert Peschel
Lead Counsel for Petitioners
Registration No. 62,248

CERTIFICATION OF SERVICE

The undersigned certifies that, in accordance with 37 C.F.R. § 42.6(e) and 37 C.F.R. § 42.105, service of this *Inter Partes* Review Petition (including Exhibit List; Exhibits EX-1001 to EX-1015) was made on Patent Owner by Federal Express next-day delivery to the Patent Owner for the '788 patent via its attorney of record, Greenburg Traurig (NY), One Vanderbilt Avenue, New York, NY 10017, with a courtesy copy sent via email to counsel of record for Yondr, Inc. in the WDTX Action.

/s/ Leisa Talbert Peschel
Leisa Talbert Peschel
Lead Counsel for Petitioners
Registration No. 62,248