

UNITED STATES PATENT AND TRADEMARK OFFICE

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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BE SMARTER, LLC AND JAMES GUERRA,  
Petitioners,

v.

YONDR, INC.,  
Patent Owner

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Case No. IPR2025-00970  
US Patent No. 9,819,788 B2

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**PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR  
*INTER PARTES* REVIEW OF U.S. PATENT NO. 9,819,788 B2**

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### LIST OF EXHIBITS

Exhibit	Description
2001	October 31, 2024 Complaint in Case No. 1:24-cv-01326-ADA in the U.S. District Court for the Western District of Texas
2002	December 13, 2024 Answer and Counterclaims in Case No. 1:24-cv-01326-ADA
2003	Docket Report in Case No. 1:24-cv-01326-ADA
2004	January 31, 2024 First Amended Counterclaim in Case No. 1:24-cv-01326-ADA
2005	March 25, 2025 Order Reassigning Case to Judge Alan Albright
2006	Judge Albright's Standing Order Governing Proceedings of Patent Cases ("Judge Albright's OGP")
2007	Petitioners' April 14, 2025 Invalidity Contentions in Case No. 1:24-cv-01326-ADA
2008	August 7, 2025 Scheduling Order in Case No. 1:24-cv-01326-ADA
2009	July 29, 2025 Joint Claim Construction Statement in Case No. 1:24-cv-01326-ADA
2010	U.S. Patent No. 5,977,876 ("Coleman")
2011	Excerpts from Merriam-Webster's Collegiate Dictionary, Tenth Edition
2012	Screen capture of Yondr webpage ( <a href="https://www.veryondr.com/phone-locking-pouch">https://www.veryondr.com/phone-locking-pouch</a> )
2013	Screen capture of CellockED webpage ( <a href="https://cellocked.newschoolhero.org/about/">https://cellocked.newschoolhero.org/about/</a> )
2014	LinkedIn post from Petitioner James Guerra
2015	Screen capture of Yondr webpage ( <a href="https://www.veryondr.com/id-pouch">https://www.veryondr.com/id-pouch</a> )
2016	Time Magazine's Best Inventions of 2024 ( <a href="https://time.com/collection/best-inventions-2024/">https://time.com/collection/best-inventions-2024/</a> ), "A Way To Disconnect <i>Yondr Pouch</i> "

2017	Washington Post – “How a Connecticut middle school won the battle against cellphones” (2024)
2018	Houston Chronicle – “Cell phones hinder classroom learning. Texas should tell school districts to lock them up   Editorial” (2025)
2019	Atlanta Journal-Constitution – “Better behaved, more engaged: School cellphone bans seem successful so far” (2025)
2020	Forbes– “Meet Yondr, The Startup Helping Schools Ban Cell Phones” (2024)

Pursuant to 35 U.S.C. §313, 37 C.F.R. §42.107 and the Notice of Filing Date Accorded to Petition, dated June 10, 2025 (Paper 5), Patent Owner Yondr, Inc. (“Yondr”) submits this Preliminary Response to the Petition filed by Be Smarter, LLC and James Guerra (“Petitioners”) regarding U.S. Patent No. 9,819,788 (the “788 Patent”).

## **I. INTRODUCTION**

Over a decade ago, Graham Dugoni, the inventor of the Asserted Patents, realized the pernicious impact of technology on modern life. Personal devices like cell phones engaged their users while shutting users off from the world around them. EX1001, 1:46-52. Instead of paying attention to a conversation or a speaker, users checked their phones for texts, voicemails, or other virtual communications. *Id.*, 1:52-59. Dugoni understood that unrestricted access to mobile devices destroyed communal activities by negatively impacting both other participants, e.g., the audience, and the presenter or performer.

What we now recognize as the highly addictive link between a user and a cell phone frustrated previous attempts at a solution. *Id.*, 1:66-2:30. For example, one approach prevented the user from turning on the cell phone or limited its functionality when inside a car. *Id.*, 1:66-2:12. That approach, however, failed because it did not control the temptation of the user to attempt to use the device. *Id.* Another approach posted signs asking users not to use cell phones in particular areas

or at particular times. *Id.*, 2:12–17. These signs were routinely ignored. *Id.* And requiring users to give cell phones to the venue or leave them at home were unsuccessful and resisted because of users’ desire to maintain physical control of their cell phones. *Id.*, 2:17–24.

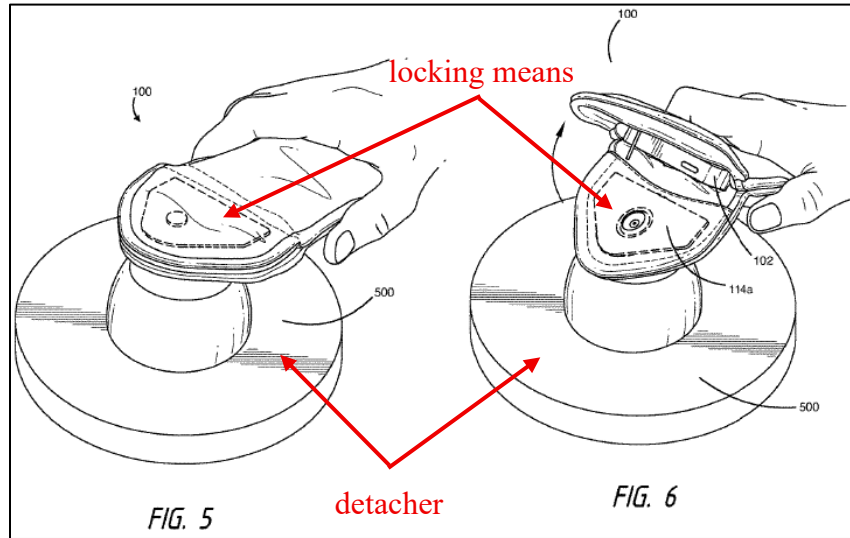
Dugoni recognized that a different approach was needed to reverse modern technology’s intrusion and create distraction-free experiences. Dugoni invented a way for users to keep their mobile devices with them, while enabling venues to limit users’ access. The result was the Yondr Pouch, a device-sized case that locked the user’s device inside. The user could keep the case, but the venue could choose conditions for unlocking the case and restoring access. Dugoni protected his inventions, in part, with U.S. Patent No. 9,819,788 (the “’788 Patent”).

## **II. BACKGROUND**

### **A. The ’788 Patent**

The ’788 Patent discloses a case for a user’s mobile electronic device that renders the device inaccessible to the user while the device is in the case. As shown in the figure below, the case comprises a “locking means” configured to lock the case once the phone is placed inside.





*Id.*, Figs. 5, 6, 6:52–61. The detacher can be positioned in a specific location, such as outside of a concert hall, and the user must therefore leave the concert hall and locate a detacher to regain access to their device. *Id.*, 6:61–7:8.

**B. The Level Of Ordinary Skill In The Art**

The '788 Patent involves a primarily mechanical device, specifically “locking cases.” EX1001, 1:35–42. The specification focuses on that case design, with some embodiments also using, e.g., RFID tags, to further that mechanical design. *Id.*, 5:54–8:5, Figs. 1–6. Given the patent’s focus on “locking cases,” those components do not transform the claimed cases into inventions in the field of electrical engineering or computer science. *See DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1362-63 (Fed. Cir. 2006) (considering patent’s purpose). Petitioners’ definition of a POSA is incorrect. Instead, a POSA would have an undergraduate degree in mechanical engineering,

industrial design, or a related field. But the Board need not resolve this issue because the Petition should be denied under either definition.

**C. Prosecution History**

Petitioners argue that, during prosecution, the Examiner treated certain prior art references inconsistently. Pet., 15–18 (citing, *inter alia*, EX1007 (Stewart); EX1012 (Furuta); EX1013 (Pellaton)). Petitioners, however, do not rely on these references in their grounds, nor do they explain how these references purportedly render the challenged claims invalid. *See* Pet., 24–65; *see also* 35 U.S.C. §312(a)(3). The Petition’s characterization of the prosecution history merely distracts from its flawed arguments, and does not bear on the institution decision.

**D. The Petition’s Art**

The Petition proposes three grounds using three references: Samuel (EX1005), Shin (EX1006), and Simpson (EX1008). Pet., 8-9. These references are unlike the ’788 Patent.

**Samuel** is directed to “secure transportation” of valuable objects, such as cash or diamonds, that are transported using “[a]rmored vehicles,” with “physical protection for the personnel concerned.” EX1005, [0001]-[0008]. Samuel attempts to provide an alternative transportation method to armored vehicles while still maintaining security in transit. *Id.* Thus, Samuel’s “invention advantageously replaces” transportation “using strongboxes which must be transported by security

guards, who are usually armed.” *Id.*, [0024]. Samuel’s invention may include a way “for destroying” the contents if there is tampering. *Id.*, [0050].

**Shin** is directed to a “disposable mobile phone storage envelope.” EX1006, 1. Shin uses a modified Ziploc-style “food storage” bag. EX1006, 5. Shin’s “envelope” is a thin plastic bag (microns thick) with a thinner metal coating. EX1006, 6. The bag is closed with a “plastic zipper” made from a male and female “profile strip.” EX1006, 7, 8. The bag, like a Ziploc bag, can be opened at will by “pull[ing] laterally,” which separates the strips. EX1006, 8. When the user puts their phone inside the bag, the metal layer blocks incoming calls. EX1006, 5. Shin’s invention thus “allows voluntary participation” by the user. *Id.* The user, or anyone else, can open the bag and access the phone merely by pulling the zipper. EX1006, 8.

**Simpson**, like Samuel, is related to “secure transportation of valuable objects.” EX1008, [0002]. Simpson provides an alternative to “armed and secure vehicles” to transport “valuable materials such as jewelry” or “intelligence files.” EX1008, [0003]. The “invention involves...a security case for storing and transporting an item in a secure manner.” EX1008, [0007]. The case “is constructed of materials which are resistant to penetration by means such as drilling, impact, ballistic thermal, etc.” EX1008, [0035]. The case can be constructed with features to “self destruct” upon tampering. EX1008, [0057].

### **III. CLAIM CONSTRUCTION**

The terms “locking means” and “means for unlocking” should be construed, to the extent necessary, under 35 U.S.C. §112(f). All other terms should be afforded their plain and ordinary meaning.

#### **A. Means-Plus-Function Terms**

Construing a means-plus-function limitation has two steps. *Applied Med. Res. Corp. v. U.S. Surgical Corp.*, 448 F.3d 1324, 1332 (Fed. Cir. 2006). First, the Board determines the claimed function. *Id.* Second, the Board identifies the corresponding structure in the written description that performs that function. *Id.* “[I]t is improper to restrict a means-plus-function limitation by adopting a function different from that explicitly recited in the claim.” *Creo Prods., Inc. v. Presstek, Inc.*, 305 F.3d 1337, 1346 (Fed. Cir. 2002).

#### **1. “locking means for at least partially securing”**

##### **a) Function**

The parties agree that the “locking means for at least partially securing” terms are means-plus-function limitations subject to 35 U.S.C. §112(f). For step one, Yondr identifies the function exactly as recited in the plain language of each independent claim—claims 1 and 2: “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”; and claim 3: “at least partially securing the opening.”

Petitioners assert the locking means must “be controlled by someone other than [the] user of the mobile electronic device being contained with the case.” Pet., 20. Petitioners’ “function” is wrong because it conflicts with and deviates from the function recited in the claims, which do not mention third-party intervention. *Creo Prods.*, 305 F.3d at 1346.

Petitioners add an extra functional requirement to Claim 3’s “locking means”: that the user be “unable to access his own mobile electronic device contained therein until a predetermined condition is met.” Pet., 20–22. That requirement is not recited in the “means” element. Instead, a different limitation and clause recite the *case* must be “operative” so “the user is unable to access his own mobile electronic device contained therein until a predetermined condition is met.” EX1001, lim. 3(c). The Board should not entertain Petitioners’ attempt to redraft the claims to add unrecited functions to the “locking means” terms.

**b) Structure**

Petitioners assert that the specification discloses structures for locking means that include “opposing plates with securably mateable female and male members, magnetic plates, selectively releasable mesh, [and] lockable zippers.” Pet., 21; EX1001, 6:25–33, Figs. 1–6, cls. 4, 5. Yondr agrees that these structures are

disclosed in the specification as locking means that can perform the claimed function.

The parties dispute whether additional structures also fall within the scope of the claimed “locking means” terms. For example, Petitioners argue that a key-operated latch “should not be a structure.” Pet., 21. Petitioners argue claims 1 and 2 exclude such structure because a “key-operated latch cannot be *programmed* to be ‘non-disengageable by the user of the mobile electronic device until a predetermined condition is met’”; and for claim 3, it cannot “be ‘locked so that the user is unable to access his own mobile electronic device contained therein until a predetermined condition is met.’” *Id.* (emphasis added).

Yondr disagrees because neither the specification nor claims 1-3 *require* that the locking means be “programmed.” Instead, the specification discloses a “key-operated latch” as a structure “for selectively limiting user control of an electronic device.” EX1001, 6:42–51. That structure prevents user access until a “predetermined condition” is met, such as “requiring the user of the electronic device 102 to locate venue staff...in possession of the key.” *Id.* Petitioners assume that a key for a manual, key-operated latch is somehow easily accessible by the phone-owner, but the specification indicates the venue can “selectively limit[] user control” with a key for “a manual, key-operated latch.” *Id.*

The Board should construe “only those terms” “that are in controversy, and only to the extent necessary to resolve the controversy.” *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (2000); *see also* Consolidated Trial Practice Guide (Nov. 2019), 49. The Board need not resolve the Parties’ additional disputes because the Petition alleges *only* that the prior art discloses “opposing plates with securably mateable female and male members” or a “lockable zipper[],” Pet., 30-32, 40-42, 49-51, 53, 64-65. The parties *agree* that these are corresponding structures (though Petitioners are wrong that they are disclosed in the cited art). Thus, there is currently *no claim construction dispute* that the Board need resolve at institution.

**2. “means for unlocking the case” (claim 3)**

**a) Function**

The parties agree that claim 3’s “means for unlocking the case” is in means-plus-function format. For step one, Yondr applies the claim’s plain language, which identifies the function “unlocking the case.” Petitioners agree that the function includes “unlocking the case.” Pet., 22. But Petitioners then redraft the claim to their liking and argue the function also includes that the user is “unable to access his own mobile electronic device contained therein until a predetermined condition is met.” *Id.*, 23 (citing EX1001, 6:52–7:8, cl. 3). This functional requirement is not recited in the “means” element at all (“means for unlocking the case”), and the “predetermined condition” is expressly recited in a different element of the claim as

a requirement for the case, *not* the “means for unlocking” the case. *Supra* §III.A.1.a. The only function recited by the claim is “unlocking the case.”

**b) Structure**

For the second step, identifying the corresponding structure, the specification identifies a key, a magnet, and an electronic article surveillance (EAS) detacher as structures for unlocking the case and restoring user access. *See, e.g.*, EX1001, 6:39–7:3, Figs. 5–6. Yondr includes “a key” because the specification discloses “a key” that performs the corresponding function, e.g., the case is “*unlocked* by venue staff...in possession of such a *key*.” *Id.*, 6:39–51. Separating the key and lock creates a “system for selectively limiting user control of an electronic device” that includes a “predetermined condition” of “requiring the user...to locate venue staff” and “unlock the case.” *Id.* The specification directly contradicts Petitioners’ unsupported assumption that the user could access a “key” controlled by the venue, or only available at an exit, without meeting the predetermined condition.

Petitioners concede the specification discloses that “an unlocking means could be the ‘corresponding key’ if the locking means is a ‘manual, key-operated latch.’” Pet., 23 (citing EX1001, 6:42–44). Petitioners argue, however, that a “key-operated latch embodiment does not meet all of the requirements for the locking means in claim 3.” Pet., 23-24. But that argument is based on the faulty premise of impermissibly redrafting the “locking means” element to establish that a key-

operated latch cannot “be ‘locked so that the user is unable to access his own mobile electronic device contained therein until a predetermined condition is met.’” Pet., 21. As described above, this requirement applies to the *case*, not to the unlocking means. *Supra* §§III.A.1.a, III.A.2.a. In addition, Petitioners ignore that a mechanical unlocker (key or magnet or EAS) can easily be controlled by the venue, as the patent describes. EX1001, 6:39-7:8, Figs. 5-6. Petitioners’ argument is meritless.

The specification also expressly discloses other non-programmed detachers, such as a magnet, as a “means for unlocking the case.” EX1001, 6:52–7:3, Figs. 5-6. The specification similarly discloses “an electronic article surveillance (EAS) detacher” to perform the corresponding function. *Id.* Petitioners try to exclude these expressly disclosed “means” for unlocking, Pet., 23, and again rely on improperly redrafting the “means” element with additional functional requirements not recited in the element or specification. *In re Teles AG Informationstechnologien*, 747 F.3d 1357, 1367 (Fed. Cir. 2014). Neither the claim nor the specification prohibits the user from personally accessing the detacher upon leaving the venue; instead the specification expressly contemplates that the user can unlock the case with, e.g., a detacher after the user meets a predetermined condition such as going to the venue’s exit. EX1001, 7:1–8. A magnet or detacher are, therefore, structures described in the specification corresponding to the “means for unlocking.”

After systematically excluding the unlocking structures disclosed in the specification, Petitioners argue the corresponding structure should be “an electronic signal transmitter.” Pet., 24. Petitioners cite a single embodiment that uses an RFID tag. Pet., 24 (citing EX1001, Fig.7, 7:9-29). An RFID tag could “instruct the locking means to...disengage,” but dependent claim 5 adds an “RFID” in a male/female plate, suggesting that claim 3 is not so limited. EX1001, 7:9–29, cl. 5; *InterDigital Comms., LLC v. ITC*, 690 F.3d 1318, 1324–25 (Fed. Cir. 2012). At most the disclosure on which the Petition relies supports an RFID tag that *receives* a wireless signal and “disengage[s]” the lock as the corresponding structure for the “means for unlocking.” EX1001, 7:14-20. Petitioners’ proposed structure (a generic “electronic signal transmitter”) is not mentioned.

Accordingly, Yondr correctly identifies the corresponding structure of “means for unlocking,” including, “a key, a magnet, and an electronic article surveillance (EAS) detacher,” all of which are expressly disclosed in the specification as structures that unlock the pouch.

**B. “the passage of time”**

Petitioners assert that “the passage of time” in Claim 2 is without an antecedent basis and apply the construction: “*a* passage of time.” Pet., 19. That term has a meaning that is “reasonably ascertainable by those skilled in the art.” *See, e.g., Energizer Holdings, Inc. v. Int’l Trade Comm’n*, 435 F.3d 1366 (Fed. Cir. 2006)

(“said anode” had a “reasonably ascertainable meaning” without antecedent basis); *In re Downing*, 754 F. App’x 988, 996 (Fed. Cir. 2018) (non-precedential) (“the end user” not indefinite). An alternate construction is therefore unnecessary. Regardless, the plain and ordinary meanings of “*the* passage of time” versus “*a* passage of time” are the same because there is no prior definition of “passage of time” in the claim to change from the ordinary meaning.

#### **IV. CLAIMS 1 AND 2 ARE NOT SUITABLE FOR INTER PARTES REVIEW**

The Petition admits that it seeks what amounts to an advisory opinion on claims 1 and 2. Yondr petitioned for a Certificate of Correction to add claim language to claims 1 and 2. EX1004, 172. The Patent Office has not acted on that petition. Nevertheless, the Petition analyzes the claims as if they included that extra language “until a predetermined condition is met.” Pet., 19. Petitioners claim they do this “to provide the proper antecedent basis” for a later limitation. *Id.*

Even assuming Petitioners could succeed on its arguments for claims 1 and 2 (as discussed below, they cannot), the result would be the Board rendering a patentability determination for a claim *that does not exist*. A petitioner, however, may only request review of an existing claim, not a hypothetical one. *See* 35 U.S.C. §311(b) (“claims of a patent”), §312(a)(3) (petition identifies “each claim challenged”). The Board’s Final Written Decision may only address “the patentability of any patent claim challenged by the petitioner and any new claim

added under section 316(d).” 35 U.S.C. §318(a). The statute does not authorize rendering an advisory opinion on patentability for a claim that does not exist, the pending petition for a Certificate of Correction notwithstanding.

Petitioners assert that the lack of antecedent basis for the term “the predetermined condition,” found in claims 1 and 2, means the claims are not amenable to interpretation (i.e., indefinite). Pet., 19. In similar situations, the Board has denied institution because whether the claims are indefinite cannot be addressed during IPR. 35 U.S.C. §311(b); *see, e.g., Nikon Corp. v. ASML Netherlands B.V.*, IPR2018-00220, Paper No. 8, at 18–19 (PTAB June 4, 2018) (denying institution when “indefiniteness likely would be a significant issue”); *Space Exploration Techs. Corp. v. Blue Origin LLC*, IPR2014-01378, Paper No. 6, at 8–9 (PTAB Mar. 3, 2015); *Facebook, Inc. v. TLI Comms. LLC*, IPR2014-00566, Paper No. 14, at 12–13 (PTAB Sept. 15, 2014).

Petitioners’ challenge to claims 1 and 2 cannot be a proper basis for institution. Regardless, as discussed below, those challenges also fail on the merits.

**V. GROUND 1: SAMUEL DOES NOT ANTICIPATE THE CHALLENGED CLAIM**

Ground 1 alleges anticipation of claim 1 based on Samuel. Pet., 26–32. As discussed, amended claim 1 is not properly challenged in the Petition. In addition, Ground 1 fails on the merits.

“A claim is anticipated if a single prior art reference discloses all the claimed limitations arranged or combined in the same way as in the claim.” *HTC Corp. v. Cellular Communications Equipment, LLC*, 877 F.3d 1361, 1368 (Fed. Cir. 2017). The “reference must disclose every limitation of the claimed invention either expressly or inherently.” *Id.* “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.” *Id.* at 1369 (quoting *In re Oelrich*, 666 F.2d 578, 581 (C.C.P.A. 1981)).

Petitioners cannot establish a reasonable likelihood that it would prevail on Ground 1. Samuel does not mention a mobile electronic device anywhere, let alone discuss controlling access to a user’s own mobile device. Instead, Samuel is directed to shipping containers for “secure transportation” that can replace an armored car. EX1005, Abstract, [0001]-[0008]. Anticipation fails for multiple reasons.

First, the preamble (to the extent it is limiting) recites a “case for selectively limiting a user’s ability to control such user’s own mobile electronic device.” Samuel, however, does not disclose a mobile electronic device, and certainly does not disclose limiting a user’s ability to control their own mobile electronic device.

Second, claim 1 recites both “a cavity sized to accommodate the user’s mobile electronic device” and an “opening to receive the user’s mobile electronic device

therein.” The Petition, however, points to a large briefcase structure that is not sized for a mobile device. Samuel does not disclose this limitation either.

Third, claim 1 requires 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 Petition states, without analysis, that Samuel discloses opposing plates with securably mateable female and male members (a corresponding structure from the specification). Samuel does not disclose any opposing locking plate structure, let alone one with female and male members.

Finally, claim 1 recites “the locking means being further non-disengageable by the user of the mobile electronic device.” Samuel does not disclose this limitation either. In short, the Petition relies on a structure for anticipation that is completely different from the claim.

**A. Samuel Does Not Disclose The Preamble**

Samuel is directed to a lockable, briefcase-like device designed for transporting objects “from one point to another, or from one person to another, with a particular degree of security.” EX1005, [0003]. Petitioners cite no portion of Samuel indicating that the case is configured in any way to limit a mobile-device owner’s ability to control their own mobile device. Instead, Petitioners assert that Samuel “teaches the case may be locked without the ability to unlock the case until a specific state (i.e., condition) is met” and “the object being transported in a Samuel

case is inaccessible during such transport, including to the user of the object.” Pet., 28. This argument fails for at least two reasons.

**First**, Petitioners assert, without citation, that “Samuel teaches that the mobile phone is locked in the case and thereby inaccessible to the user.” Pet., 28. This is incorrect. Samuel does not mention a mobile phone and therefore cannot teach that a mobile phone “is locked in the case” as Petitioners allege. Samuel’s express disclosures of the contents of the security device are limited to “objects,” “cash,” “banknotes,” “checks,” and “valuable merchandise”—not mobile electronic devices. EX1005, [0001], [0002], [0083], [0084], [0182]. Samuel accordingly does not disclose a mobile electronic device.

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

Petitioners thus rely on the *possibility* that Samuel *could* be used with a cell phone. *Id.* Petitioners do not even argue that Samuel “necessarily includes” securing

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

**Second**, Samuel does not teach “selectively limiting a user’s ability to control such user’s *own* mobile electronic device.” Samuel makes no mention at all of whether a sender, recipient, or third-party “own” the contents being transported in the case. Nor do Petitioners argue otherwise. Instead, Petitioners observe that “the object being transported in a Samuel case is inaccessible during such transport, including to the user of the object.” Pet., 28. But that is no different than a letter being inaccessible when it is mailed and has nothing to do with the case; indeed, physically removing a device is the very approach the ’788 Patent taught was unsuccessful. *See* EX1001, 2:17-20 (requiring users to “physically turn [devices] over to venue staff...is often met with resistance”).

Nor could such teaching be inherent in Samuel's disclosure. Samuel was designed to replace transportation of objects by armored vehicles and strongboxes (which are usually accompanied by armed guards). EX1005, [0001]–[0008], [0024]. These means of secure transportation do not inherently limit an owner's access to their own objects. On the contrary, they *ensure* that the transported objects arrive with their intended recipient. *See, e.g.*, EX1005, [0020], [0038], [0058], [0106], [0123], [0184].

Accordingly, to the extent the preamble is limiting, Petitioners fail to establish that Samuel discloses a “case for selectively limiting a user's ability to control such user's own mobile electronic device.”<sup>1</sup>

**B. Samuel Does Not Disclose Limitation 1(a)**

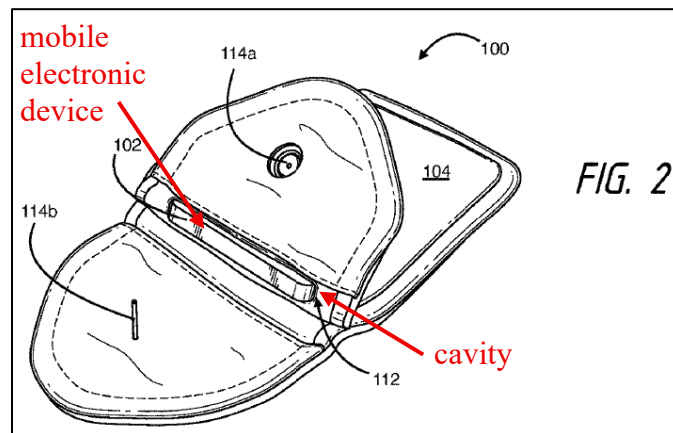
Limitation 1(a) requires that the case have “a shell defining a cavity sized to accommodate the user's mobile electronic device and having an opening to receive the user's mobile electronic device therein.” The Petition's conclusory analysis of this limitation states that “cash and mobile electronic devices such as cellphones are similar in size” and assumes “the cavity shown in the Samuel case is ‘sized to accommodate the user's mobile electronic device.’” Pet., 29–30. The Petition

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<sup>1</sup> As limitations 1(a) and 1(b) similarly recite a “mobile electronic device” / “the user's mobile electronic device,” Samuel therefore also fails to disclose these limitations.

likewise states, without analysis, that “the opening of the shell in the Samuel case has an opening to receive the user’s mobile electronic device.” *Id.* at 30. Petitioners’ cursory arguments fail for at least two reasons.

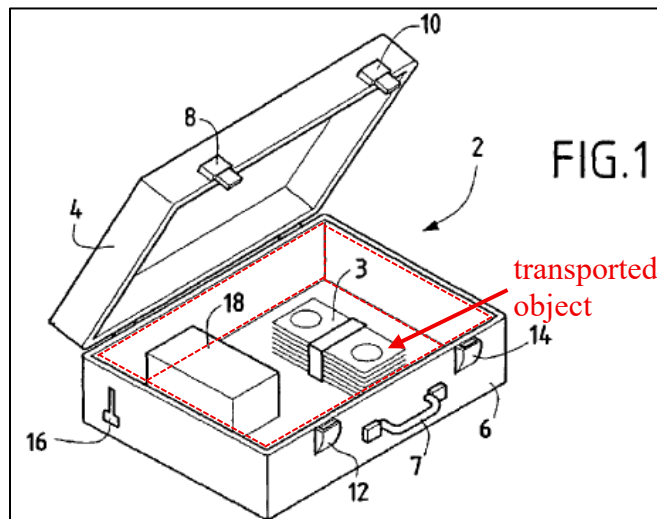
**First**, Samuel does not illustrate a “cavity sized to accommodate” a mobile device. Instead, the cavity is much larger than the object inside (money) and includes additional objects, such as the electronic means (18). A cavity “sized to accommodate” the mobile device, however, does not mean merely that a mobile device could be placed inside it. As shown in Figure 2 of the ’788 Patent, a cavity that is “sized to accommodate” a user’s mobile electronic device is one that is approximately the size as the device.



EX1001, Fig. 2. The patent explains that the configuration of “case 100” in Figure 2 is “*sized to accommodate* a mobile electronic device.” *Id.*, 5:62–6:6 (emphasis added). That configuration is also consistent with plain meaning of “sized,” which is: “having a specified size ....” EX2011, at 5. Thus, a shirt sized to accommodate

a child is a shirt approximately the size of a child and not a shirt for an adult, even if the child could also fit (poorly) into that much larger shirt. Likewise, as shown in Figure 2, a case “sized to accommodate a mobile electronic device,” such as a phone, is a case approximately the size of the device, and not some much larger cavity.

A “cavity sized to accommodate the user’s mobile electronic device” is not disclosed by Samuel. Samuel describes a case with, in Petitioners’ words, a “briefcase-type structure[], Pet. 60, designed for the secure transportation of valuable objects,” as shown in the following figure.



EX1005, Fig. 1; [0084]. Samuel does not disclose the briefcase’s cavity being approximately the size of *any* object—much less those Petitioners claim are “similar” in size to a mobile electronic device.

Samuel’s sole disclosure pertaining to size relates only to the case generally, not the cavity or its contents. EX1005, [0021] (stating generally that “[i]t is possible

to use containers of any size”). This disclosure has no bearing on whether the case’s cavity is structured to house a mobile electronic device, nor even suggest sizing the case to its contents. Samuel, in fact, teaches the opposite because the case must include within its alleged “cavity” other objects such as the electronic means 18. *See* EX1005 Fig. 1, [0088]–[0089] (“means 18 disposed inside”). Samuel does not disclose a case “sized to accommodate” a user’s mobile electronic device.

**Second**, because the cavity in Samuel is not “sized to accommodate” the user’s device, Samuel does not disclose the claimed “cavity...having an opening to receive the user’s mobile electronic device therein.” As shown in Figures 1–4 of the ’788 Patent, the opening of the cavity sized to accommodate the user’s phone is likewise approximately the same dimensions as the phone. EX1001, Figs. 1-4; 5:62-6:6 (opening “sized to receive” device). Because the cavity in Samuel is unrelated to the object inside, the cavity’s opening is likewise non-specific. Accordingly, the Petition also fails to establish that Samuel has a “cavity...having an opening to receive the user’s mobile electronic device therein.”

**C. Samuel Does Not Disclose Limitation 1(b)**

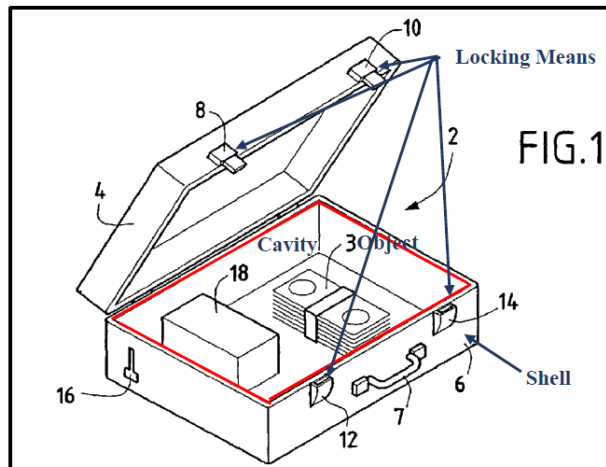
Limitation 1(b) requires a “locking means” that accomplishes the function of “at least partially securing the opening of the shell so that the electronic device is rendered inaccessible to the user, the locking means being further non-disengageable by the user of the mobile electronic device.” The Petition does not establish that

Samuel discloses either the structure for the claimed locking means or the corresponding function.

**1. Samuel Does Not Disclose The “locking means”**

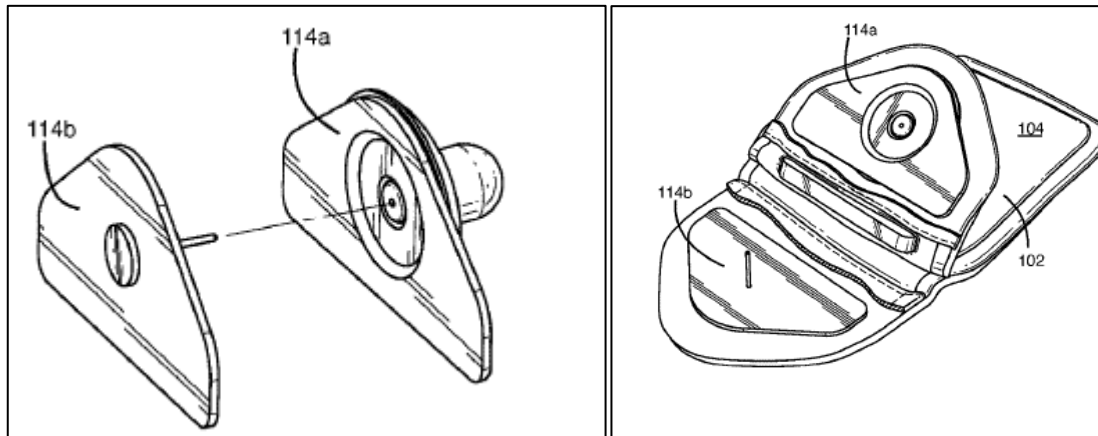
Petitioners argue that the “closure” or “locking means” disclosed in Samuel “include opposing plates with securably mateable female members (as shown in **12**, **14**) and male members (as shown in **8**, **10**.” Pet., 31 (citing EX1005 Fig. 1, [0083]). Opposing plates with respective securably mateable female and male members is a structure taught in the ’788 Patent, *supra* §III.A.1, but Samuel does not disclose this structure.

Samuel provides no description whatsoever of the types of “locking means” that may be used with the case, opposing plates or otherwise. *See* EX1005, [0083], [0090], [0105], [0106], [0109], [0110], [0163]. The closest Samuel comes is explaining the locking means can be a “miniature solenoid” or “a selectively operable mechanical device,” neither of which are opposing plates with securely mateable male and female members. EX1005, [0086]. Petitioners accordingly rely on an annotated version of Samuel’s Figure 1 (below) identifying locking means 8, 10, 12, 14.



Pet., 30, 31 (citing EX1005, Fig. 1). This figure, however, is generic and does not disclose a locking means with a structure of male/female “opposing plates” as Petitioners allege. *See Hologic, Inc. v. SenoRx, Inc.*, 639 F.3d 1329, 1338–39 (Fed. Cir. 2011) (finding a figure in a prior art patent did not disclose a claim limitation because the limitation was not “clearly show[n]” in the figure).

Indeed, the Petition does not identify any alleged “opposing plates” in Samuel’s structure, and none are evident in features 8/10 and 12/14. The ’788 Patent illustrates the Petition’s deficiency. Figure 4 (below, left) shows example opposing plates with securably mateable male and female members. Figure 3 (below right) illustrates that the plates are positioned so that they block the opening of the case when secured with the male and female members. EX1001, Figs. 3-4; 6:19-29.



The Petition does not identify any such plate in Samuel and therefore cannot establish Samuel discloses opposing plates with securably mateable female and male members, the only structure alleged to correspond to the '788 Patent's means.

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

**2. “rendered inaccessible to the user”**

Petitioners argue that the locking means in Samuel “render[s]” the mobile electronic device “inaccessible to the user,”<sup>2</sup> since Samuel teaches that the case may be programmed to only open once it arrives at its intended destination. *See* Pet., 31. But that does not mean that the contents of the case are “rendered”—i.e., *caused* to be—inaccessible to the user. *See* EX2011, at 4 (“render” as “to cause to be or become”). Indeed, an object in transit is *already* inaccessible to, *e.g.*, the recipient, irrespective of any locked case.

Petitioners appear to argue that a user locks their own belongings in the case, such that they cannot be accessed until they are shipped to the intended destination. Pet., 31-32. But this peculiar scenario in which a user’s belongings, that were otherwise accessible, are made *in*accessible to the user solely by the locking of the case, is not taught in Samuel. “[A]n equally plausible, if not more plausible,” use of the Samuel case is one in which a third party sends an object back to its rightful owner using the Samuel case, with the case being already inaccessible during transit. *PersonalWeb Techs., LLC v. Apple, Inc.*, 917 F.3d 1376, 1382 (Fed. Cir. 2019) (finding a reference did not inherently disclose a limitation when the patent owner

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<sup>2</sup> As explained *supra* §V.A, Samuel does not disclose a mobile electronic device. Samuel’s failure to teach a mobile electronic device is alone sufficient to show that Samuel does not anticipate this limitation.

was able to propose “an equally plausible, if not more plausible understanding of” the reference).

**D. Samuel Does Not Disclose Limitation 1(c)**

Petitioners finally argue that Samuel discloses “physical presence of the case outside of a defined geographical region.” Pet., 32; *see also* 56. Samuel does not disclose this limitation; it teaches the exact opposite. Petitioners assert Samuel involves the “location of the case at a particular address.” Pet., 32. But a “particular address” requires the case be *inside*—not outside—of a defined geographical location. The ’788 Patent explains that one approach (used in claim 1) relies on the case being *outside* of a defined area to restore access, which prevents disruption of an event. The patent identifies an “audience seating area” as an example of a “defined geographical region.” *See, e.g.*, EX1001, 3:14–27. Because a user cannot access their cellphone until they leave that defined area, it accomplishes the patent’s goal of, e.g., preventing distracting cell phone use during a performance. *See id.*, 1:37–42; *id.*, 3:14–27; 3:44–49. This understanding likewise comports with the otherwise plain and ordinary meaning of the word “defined.” EX2011, at 3 (“to fix or mark the limits of”). Samuel therefore does not disclose limitation 1(c).

Based on the foregoing, Petitioners failed to demonstrate a reasonable likelihood of success proving Samuel anticipates claim 1 of the ’788 Patent.

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

Ground 2 alleges claims 1, 3–4, and 6–7 would have been obvious based on the combination of Samuel and Shin. Petitioners’ obviousness arguments recycle the same incorrect positions regarding Samuel’s disclosure that it proposed for Ground 1. As discussed above, and further below, these incorrect positions likewise undermine obviousness. Shin does not fix Samuel’s deficiencies. Instead, the combination plucks features from disparate structures and combines them in a nonsensical way, is missing elements, and does not establish a motivation to combine Samuel and Shin. Accordingly, Petitioners cannot establish a reasonable likelihood that it would prevail on any claim for Ground 2.

**A. The Combination Of Shin And Samuel Does Not Disclose A “locking means for at least partially securing...” (Limitations 1(b); 2(b); 3(d))**

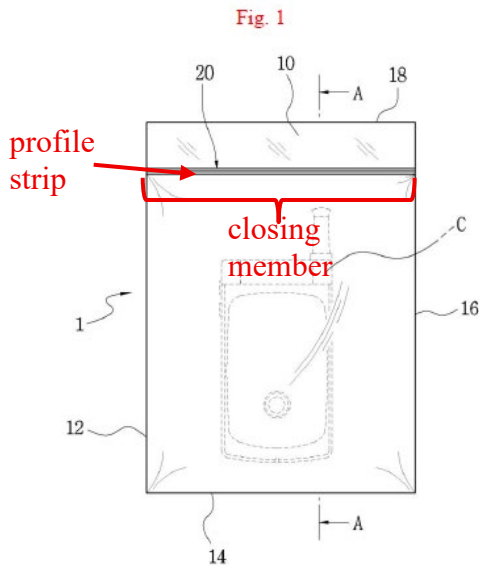
**1. Neither Shin Nor Samuel Disclose The Alleged Locking Means**

The Petition alleges that Samuel discloses “opposing plates with securably mateable female members.” Pet., 40–41, 50, 63. The only support is Figure 1 and ¶[0083] of Samuel, and conclusory statements from Petitioner’s expert. Pet., 40, 50, 63. As discussed above, Samuel discloses no plates, nor does it disclose securably mateable female/male members (as opposed to a buckle or some other structure more typically used in a briefcase). *Supra* §V.C. The Petition does not even attempt to identify what piece of Samuel’s case it contends is a plate, or the securably mateable

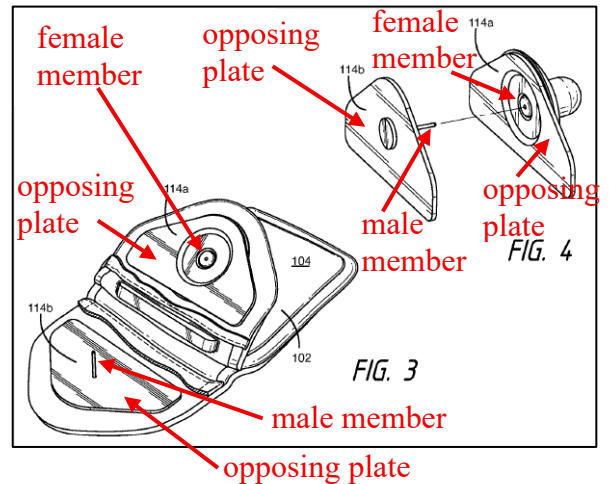
male and female members for that matter; instead the Petition generically identifies “locking means” without explanation. Pet., 39-40. The declaration likewise is just a conclusory statement that “Samuel’s locking means includes opposing plates” and “securably mateable” male and female members without analysis and does not identify the plates or male/female members. EX1002 ¶135. That silence is unsurprising because Samuel does not disclose *any* plate and includes no disclosure regarding securably mateable male and female members.

Shin does not fix Samuel’s deficiency. Petitioners assert that Shin discloses a “locking means,” arguing that the female profile strip and male profile strip are, respectively, “one plate with a female member and an opposing plate with a male member that are securably mateable.” Pet., 41; *see also supra* §III.A.1. Petitioners are wrong for multiple reasons.

**First**, the profile strips Petitioners cite are a zipper, *not* “securably mateable male and female members.” Shin explains the “closing member 20” is “commonly known as a plastic *zipper*,” and that “plastic *zipper* consist[s] of a male profile strip and a female profile strip.” EX1006, 7, 8 (emphases added). The ’788 Patent expressly differentiates zippers as *different* structures from male/female members; as illustrated below they plainly are. *See* EX1001, 6:26–33 (listing “lockable zippers” and mateable male and female members as different locking means).



Shin



'788 Patent

EX1006, Fig. 1 (left); EX1001, Figs. 3-4 (right).

Thus Petitioners are wrong that Shin discloses a structure corresponding to the mateable male/female members of the '788 Patent. Shin expressly discloses its strips are a zipper.

**Second**, Shin's profile strips are not "securably mateable" male and female members. *See, e.g., Pet.*, 41, 51. Securely mateable male and female members are members that secure—i.e., lock—the case. The '788 patent explains the locking means makes the device both "inaccessible to the user by at least partially securing the opening" and further "non-disengageable by the user." EX1001, 6:33-38. This is reflected in the claim language as well. *See* cls. 1, 2 ("partially securing the opening," "rendered inaccessible," and "non-disengageable by the user"); cl. 3 ("partially securing the opening"; and further requiring the case is "operative to

become locked so that the user is unable to access his own mobile electronic device”).

Shin explains that its structure does not lock at all, at least not in a way that prevents access as required by the ’788 Patent and claims. Instead, Shin teaches that its bag is sealed by pressing with a thumb and index finger, and opened “when the first closing member 20 is pulled laterally” and “the protrusion portion and the recessed portion are separated,” exactly like a Ziploc-style food storage bag. EX1006, 8. Shin does not deny the user access to the phone and expressly lists “*voluntary* participation by mobile phone owners” as an object of its invention. *Id.*, 5 (emphasis added). The ’788 patent, in contrast, discloses and claims *preventing* user access to their own device. *See, e.g.*, EX1001, 1:35-42, 2:34-37, 2:58-63, 6:19-51; claims 1-3. The plastic zipper in Shin, like a zipper on a Ziploc-style bag, plainly does not secure the opening, is openable at any time by the user, and cannot prevent user access. EX1006, 5 (describing invention as an improvement upon a food storage bag); 8 (bag opened when “pulled laterally”).

Petitioners argue that the profile strips are “a zipper that locks the envelope” in Shin and asserts that meets the “lockable zipper” structure corresponding to “locking means.” Pet., 41 (citing EX1006, 8); *see also supra* §III.A.1. That is wrong. A “lockable zipper” is a zipper that must, itself, be lockable via, *e.g.*, a locking feature that prevents unzipping. *See* EX1001, 6:30-38 (“secure[] the

opening” and “be non-disengageable”). Shin explains that the profile strips “lock the envelope” in a way that the members “engage with each other to *close* the opening,” EX1006, 8 (emphasis added), not lock it to prevent access.<sup>3</sup> Indeed, Shin’s zipper has no lock and is not lockable; instead it freely opens when “pulled laterally.” *Id.*; *see also id.*, 5 (“voluntary” use of bag). The ’788 patent explains the lockable zipper structure must “at least partially secure[] the opening” and “be non-disengageable.” EX1001, 6:30-38. Shin’s zipper, opened by merely pulling, does not secure the opening and is freely disengageable. Shin does not disclose a lockable zipper.

**Third**, Shin’s members have no “plate.” As illustrated above, a plate is a generally flat structure. *See* EX1001, 6:25–30, Fig. 1, Figyls. 3-4. The plain meaning of “plate” likewise requires that a plate be generally flat. *See, e.g., Ex parte Graham*, Appeal 2018-002792, 2019 Pat. App. LEXIS 1459, at \*8 (PTAB Mar. 4, 2019) (“plate” is a flat surface); *Ex parte Perez-Cruet*, Appeal 2015-001910, 2016 Pat. App. LEXIS 11248, at \*5–6 (PTAB Nov. 21, 2016) (same). While the opposing plates in the ’788 patent may include some variation from flat (e.g., slightly curved structures that fit together), the Petition relies on the male/female profile strips in

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<sup>3</sup> The Petition mentions, in passing, Shin’s other “coupling means.” Pet., 35. Those other means, such as tape or “snap buttons,” likewise are not lockable and emphasize Shin’s closing member is not securably mated. EX1006, 8.

Shin, and those profile strips do not fall within any reasonable understanding of “plate.” Indeed, Shin describes those strips as a zipper. EX1006, 7, 8.

Petitioners accordingly fail to show that Shin discloses a “locking means.”

**2. A POSA Would Not Have Modified Shin to Include Samuel’s Locking Structure**

Petitioners finally claim that a POSA “would have found it to be a natural modification” of Shin’s Ziploc-style bag “to use the enhanced security of the locking means described in Samuel,” which substitutes for armored cars. Pet., 41. This nonsensical position apparently imagines, without any relevant support in Shin or Samuel, that Shin’s Ziploc-style bag *could* be modified so that its profile strips could be locked, and subsequently unlocked, when the bag arrives at a specific location. Pet., 41–42. Petitioners’ sole support is its expert’s declaration, which is entitled to no weight because it “merely repeats...the conclusory assertion for which it is offered to support.” *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, at 15 (Aug. 24, 2022) (precedential).

Left unexplained is how the type of extreme, high-security measures for transporting valuable objects discussed in Samuel could even work with Shin’s modified “food storage” bag. EX1006, 5. Shin’s “invention” is “disposable,” not high-security. EX1006, 1, 5. The invention in Shin uses “voluntary participation” and a freely-openable bag. EX1006, 5, 8. A POSA would not have seen fit to take Shin’s Ziploc-style bag and add a locking mechanism used to secure valuables like

jewelry and cash during transit. Moreover, Samuel’s locking mechanism is sizeable and sturdy enough to secure a “rigid” briefcase, Pet., 35, and could not be housed in the slightly upgraded sandwich bag disclosed in Shin, *see* EX1006, 7 (showing Shin’s bag plastic and aluminum foil, a fraction of a millimeter thick).

Petitioners accordingly failed to show that modifying Shin to include the generic locking mechanism in Samuel, much less the claimed locking means, would be a “natural modification” to the POSA. *Plantronics, Inc. v. Aliph, Inc.*, 724 F.3d 1343, 1354 (Fed. Cir. 2013) (“[T]he mere recitation of the words ‘common sense’ without any support adds nothing to the obviousness equation.”) (cleaned up). The Petition provides no evidence that Shin’s thin, disposable, plastic bag is compatible with Samuel’s locking mechanism, does not suggest modifying Samuel’s lock, and does not explain why there would be an expectation that these disparate features could be successfully combined to obtain the claimed invention. Pet., 41; *see Surgalign Spine Techs., Inc. v. LifeNet Health*, No. 2021-1117, 2022 WL 1073606, at \*7–8 (Fed. Cir. Apr. 11, 2022) (non-precedential) (affirming finding that replacing a “metal screw with a bone pin” was nonobvious, since it was “doubtful that a bone pin could withstand the force needed” to use the claimed invention). The declaration likewise provides no explanation. EX1002 ¶¶138-39.

Petitioners also refer in passing to a “Samuel envelope” in their argument, but without any explanation. Pet., 42. The Petition refers to the “Samuel

case...modified using the disclosures in Shin to adopt an envelope structure sized to contain a cellphone.” Pet., 35 n.7. The Petition, however, argues for starting with Shin and modifying it to “use the enhanced security of the locking means described in Samuel with the Shin envelope.” Pet., 41.

To the extent that the Petition is suggesting modifying the “envelope” in Samuel based on Shin, that is likewise nonsensical. Samuel provides no details about its envelope, other than it is made of rubber, and must be “compatible” with inserting a “management system” and “a connecting jack.” EX1005, [0091]. Unlike Samuel’s high-security rubber “envelope,” Shin’s invention is a “disposable” bag made from thin plastic, similar to a food storage bag. EX1006, 1, 6; 6-7 (bag microns thick). Nor does Shin suggest a cell phone should be kept in a high-security case; instead Shin teaches its invention is “voluntary” use of a bag opened by merely “pull[ing] laterally” on the flaps. EX1006, 5, 8. Thus, Shin teaches the user (or anyone else) can always access the phone inside the bag, making it completely *unsecured*, the opposite of Samuel’s high-security armored car substitute. EX1005, [0001]-[0008].

Neither Shin’s use of a timer, or its purpose of blocking signals, suggests “combining the teachings of Samuel and Shin.” Pet., 41-42 (citing EX1002 ¶¶139-40). That assertion relies on the clearly erroneous understanding that Shin “teaches that the locking means is non-disengageable,” EX1002 ¶140, when Shin’s bag is

*expressly the opposite*: disengageable by mere pulling, EX1006, 8. Shin provides no suggestion, nor does any other reference, that denying the user access to their own cell phone would be desirable; Shin *teaches the opposite* because its invention is “voluntary” and the phone always available by pulling the zipper. EX1006, 5, 8.

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

Finally, even if the references provided the motivation to modify Shin with Samuel’s “locking means,” the lock in Samuel does not meet the claim language, as explained previously and below.

**B. The Combination Of Shin And Samuel Does Not Disclose “locking means further non-disengageable by the user” (claims 1, 2) Or “so that the user is unable to access his own mobile electronic device” (claim 3)**

The Petition relies on the same arguments regarding Samuel to argue that Samuel discloses a locking means that is “non-disengageable by the user of the mobile electronic device” (claims 1 and 2) and is “operative to become locked so that the user is unable to access his own mobile electronic device” (claim 3). Pet., 41-42, 48-49. As discussed above, Samuel does not disclose a mobile electronic device or that the locking means is non-disengageable by the user of that device. *Supra* §V. Shin does not fix this problem, because Shin discloses “voluntary

participation” and a mobile electronic device available for user access via an openable Ziploc-style zipper. EX1006, 5, 7, 8; *supra* §VI.A.1.

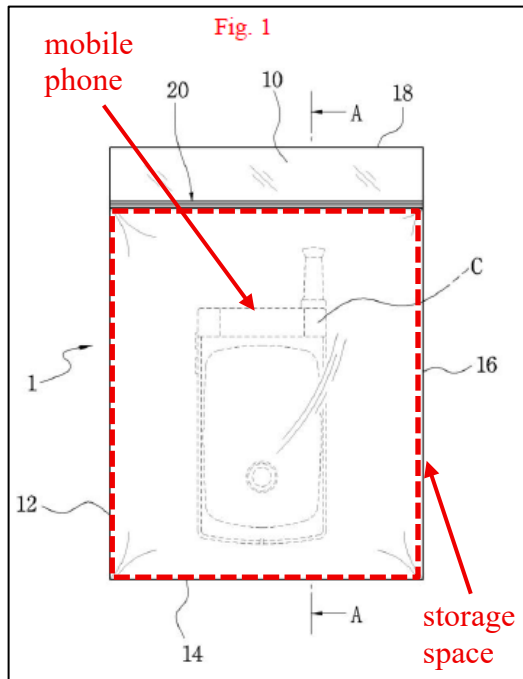
With respect to claim 3, the Petition recycles the limitation 1(b) argument, that Samuel locks the contents of the case until the case arrives at its intended destination. *See* Pet., 31–32, 48–49. Limitation 3(c), however, requires that the case become locked to prevent the user from accessing “his own mobile device.” Neither Samuel nor Shin discloses this type of locking. Samuel’s transportation device—like the armored vehicles and armed guards it was designed to replace—prevent thieves (and other unintended recipients) from accessing the transported objects, not the user/owner of the objects. EX1005, [0001]-[0008]. Samuel does not “become locked *so that* the user is unable to access his own mobile electronic device.” Nor have Petitioners alleged that such use would be within the general knowledge of a POSA. *See Google v. Parus Holdings, Inc.*, IPR2022-00279, Paper 40, at 31 (PTAB Aug. 1, 2024) (arguments not in petition “are forfeited”).

As discussed, Shin does not fill in this gap because it discloses a resealable bag that a user can open at will by merely pulling. EX1006, 8. Shin thus does not teach “the electronic device is rendered inaccessible to the user” (claims 1, 2) or “the case operative to become locked so that the user is unable to access his own mobile electronic device” (claim 3). Likewise, Simpson (cited in Ground 3, with respect to claim 2) admittedly does not teach a mobile electronic device. Pet., 63. No cited

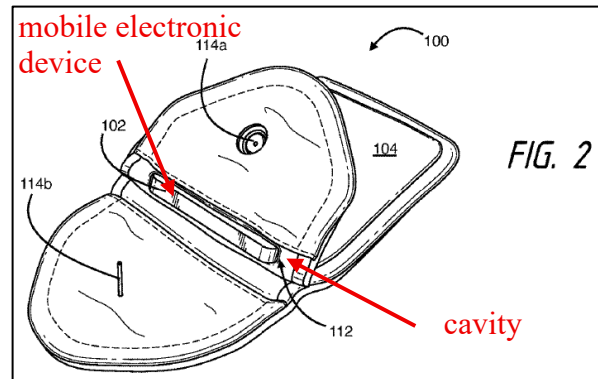
references teaches making a mobile electronic device inaccessible to its user, or the user unable to access their own mobile electronic device.

**C. The Combination Of Shin And Samuel Does Not Disclose Limitations 1(a) Or 2(a)**

Petitioner relies on the same analysis as Ground 1 for limitations 1(a) and 2(a). Pet., 38-39; 63-64; *see also infra* §VII.A.1 (discussing Simpson). As described *supra* §V.B, Samuel does not disclose a cavity sized to accommodate the user’s mobile electronic device. Shin likewise does not disclose its bag being approximately the size of, e.g., a mobile phone. Shin only describes a bag with sides of “predetermined sizes...to form a mobile phone storage space.” EX1006, 6. As shown below, that space is significantly larger than a mobile phone.



Shin



'788 Patent

EX1006, Fig. 1; EX1001, Fig. 2.

Even if Shin did disclose a bag sized for a mobile phone, however, there would be no motivation to apply that teaching to Samuel. Samuel's case cannot be sized for a mobile device because its cavity must include additional structures, for example a circuit card and means for sending signals. EX1005, Fig. 1; [0088]; [0091]. Samuel's high-security cases must also be reused for many different objects. *See, e.g.,* EX1005, [0001]-[0008], [0024]; [0206]-[0210] (transport different objects to different locations). Sizing Samuel's case to one particular object would undermine that ability, and the Petition identifies no benefit to sizing Samuel's case to a mobile electronic device.

**D. Claim 3 And Dependent Claims**

The combination of Samuel and Shin does not disclose the limitations of Claim 3, including “a mobile electronic device,” “a locking means,” or “the case operative to become locked so that a user is unable to access his own mobile electronic device contained therein,” as explained above in §§V.A-C; VI.A-C. Petitioners fail to establish additional limitations from claim 3, as described below.

**1. The Combination Of Shin And Samuel Does Not Disclose A “means for unlocking the case”**

Claim 3 requires a “means for unlocking the case,” which is limited to the corresponding structures disclosed in the specification. *Supra* §III.A.2. The Petition does not identify in Shin or Samuel a means for unlocking the case that falls within the scope of the claim. The Petition relies solely on a “programmed microprocessor and a network card (or line interface means)” from Samuel. Pet., 51–52 (citing EX1005, [0103]–[0104]). Consistent with Samuel’s high-security considerations, this approach uses a wired connection. *See* EX1005, Figs. 1, 2 (showing wired connection).

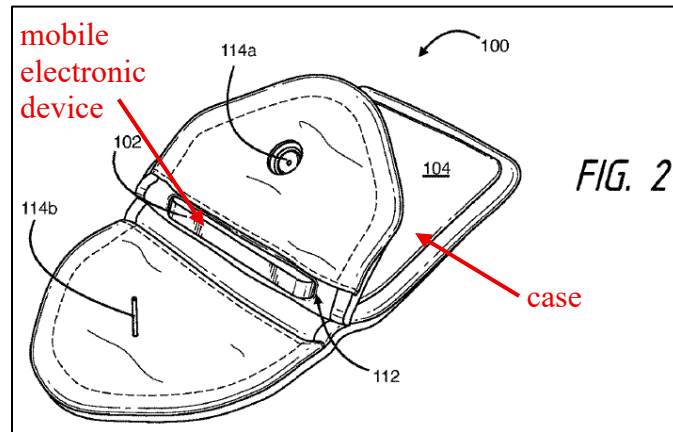
The structure disclosed in Samuel, however, does not correspond to any structure for unlocking disclosed in the ’788 Patent. The Petition refers back to its claim construction argument for support. Pet., 51 (citing §VI.D). That argument only underscores the problem with Samuel’s disclosure. Petitioners exclusively cited the ’788 Patent’s discussion (and associated Figure 7) of an “RFID tag

disposed” in the locking means that instructs the “locking means to...disengage,” *see* Pet., 24 (citing EX1001, Fig. 7, 7:9–29). But the Petition does not allege that Samuel discloses an RFID tag (or other wireless *receiver*); Shin discloses any unlocking means; it would have been obvious to alter Samuel to incorporate an RFID tag or another unlocking structure from the ’788 Patent; or cite evidence showing RFID tags were routinely used in this fashion. Pet., 51–52. The ’788 Patent does not disclose a wired structure like that in Samuel; and the Petition points to nothing in Samuel that discloses any unlocking structure discussed in the ’788 Patent, including a RFID tag/wireless beacon,. EX1001, Fig. 7, 6:39-7:53.

Accordingly, the combination of Shin and Samuel does not disclose the “unlocking means” required by the ’788 Patent.

**2. The Combination Of Shin And Samuel Does Not Disclose “a case sized to receive the user’s mobile electronic device”**

Petitioners argue that Samuel discloses “a case sized to receive the user’s mobile electronic device.” Pet., 44–45. To support its argument, Petitioners again assert that Samuel discloses transporting cash, which is purportedly “similar in size” to a cell phone. Pet., 45; *see also supra* §V.A. But as described, *supra* §§V.B, VI.C, a case that is “sized to receive” a user’s mobile electronic device is one that is approximately the same size as the device, with a correspondingly sized opening.



EX1001, Fig. 2; *see also id.*, 5:62–6:6.

As discussed, *supra* §§V.B, VI.C, Samuel does not disclose its structure being specifically designed for *any* object and, indeed, requires additional elements within its cavity. Likewise, as discussed, *supra* §VI.C, Shin does not teach a bag sized to receive the user’s mobile electronic device. And, as discussed, even if Shin did disclose its bag was sized to receive the user’s device, there would be no motivation to apply that to Samuel because Samuel’s case (1) must include additional elements inside it and (2) must be reused to transport many different objects.

Accordingly, the combination of Samuel and Shin does not disclose a case sized to receive the user’s mobile electronic device.

### 3. Claims 4, 6, 7

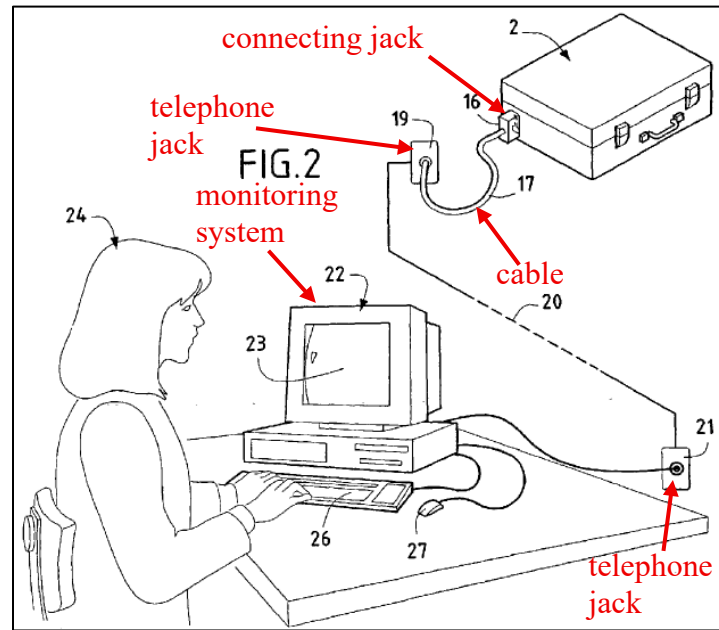
Claim 4, 6, and 7 depend from claim 3. As described *supra* §§VI.A–B, VI.D.1-2, Shin and Samuel do not render claim 3 obvious. Accordingly, these narrower dependent claims are likewise not rendered obvious. Petitioners have failed to show these claims are obvious for at least the additional reasons below.

Claim 4 adds the limitation: “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.” Petitioners allege Samuel “illustrates...securably mateable female members...and male members...of opposing plates.” Pet., 53 (citing EX1005, Fig. 1; [0083], [0086], [0105], EX1002, ¶191). As explained *supra* §§V.C.1; VI.A, there are no male and female opposed “plates” in Samuel’s Figure 1, nor does Samuel describe plates configured to securably mate, or even locking means on “each of the front and rear panels.”

Petitioners assert the “locking means” from Figure 1 could be incorporated into Samuel’s rubber envelope embodiment. Pet., 53. That does not fix the problem that Samuel does not disclose the male/female plates on front and rear panels configured to securably mate. Petitioners also argue, with no explanation, that the profile strips making up Shin’s zipper “could be easily designed as female and male plates.” Pet., 53. But that changes Shin’s zipper into a completely different structure not disclosed in any cited reference. *Supra* §§V.C.1; VI.A-B. That modification also contradicts Shin’s teaching that its invention “allows voluntary participation” and its bag is opened by merely pulling. EX1006, 5, 8; *supra* §VI.A-B. Nor is there any reason to install a high-security lock on a thin sandwich bag, or any expectation that would be successful. *Supra* §VI.A-B, *infra* §§VI.E.

Claim 6 depends from claim 3 and additionally requires: “a microprocessor...disposed in one or both of the female and male plates.” Petitioner incorrectly asserts that Samuel “implicitly discloses” a microprocessor in the locking means. Pet., 55. Samuel, however, receives a signal at the case’s jack, a completely different structure from the locking means, and does not suggest a microprocessor in a (non-existent) plate. *See* EX1005, Fig. 1, [0088]-[0091] (element 16 is jack for connecting to network; distinct from “locking means”). The Petition’s motivation to modify Samuel to put a microprocessor in the locking means to allegedly “unlock as quickly as possible,” Pet., 55, likewise makes no sense given an electrical signal is, effectively, instantaneous and nothing indicates quick unlocking would be desirable.

In addition, Petitioners insist the “opening or unlocking signal [in Samuel] is a ‘wireless data signal.’” Pet., 54 (citing EX1005, [0036], [0038]; EX1002 ¶197). But the cited disclosure refers to a “LAN,” “ETHERNET,” and other wired networks. EX1005, [0036], [0038]. Samuel exclusively teaches *wired* transmission of unlocking signals, as shown below.



EX1005, Fig. 2.

This wired approach is consistent with the high-security fundamental to Samuel. EX1005, [0001]-[0008]. Samuel does not disclose or suggest a microprocessor that receives wireless data signals.

Accordingly, Petitioners have failed to demonstrate that Samuel and Shin disclose each limitation of the challenged claims.

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

Even if the proposed combinations had disclosed every limitation of the challenged claims, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). Instead, there must be some “explanation or reasoning for concluding that one of skill in the art

would have combined these particular references to produce the claimed invention.” *Metalcraft of Mayville, Inc. v. Toro Co.*, 848 F.3d 1358, 1367 (Fed. Cir. 2017). Accordingly, Petitioners “must demonstrate that a skilled artisan would have had reason to combine the teaching of the prior art references to achieve the claimed invention, and...a reasonable expectation of success from doing so.” *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 449 (Fed. Cir. 2015) (cleaned up).

Petitioners provide a cursory analysis of motivation to combine that is completely inadequate. Pet., 35–36. The Petition relies on (1) the idea that Samuel “could be replaced by a more flexible envelope design, such as the envelope shown in Shin,” and (2) the idea that both “Samuel and Shin teach ways of preventing unauthorized access to objects.” *Id.* Neither of these motivations has adequate support, and both are contrary to the references. As discussed above, *supra* VI.A.2, VI.C, VI.D.2, and further below, there is no motivation to combine Samuel and Shin.

**1. Shin Does Not Teach Preventing Unauthorized Access Or That A Mobile Phone Is A Valuable Object Contained Within The Case**

Petitioners repeatedly assert that “Shin depicts a mobile phone C as the valuable object contained within the case.” Pet., 37, 38, 64. Shin, however, does not describe a mobile phone as a “valuable object,” nor would such a description make any sense because Shin’s thin plastic bag includes a zipper that can be opened and closed at will. EX1006, 5, 7, 8. This fundamentally undermines the Petition,

which relies on the idea that both Shin and Samuel view a mobile phone as a “valuable object” to establish a motivation to combine their teachings. *See, e.g.*, Pet., 37–38. But neither Shin nor Samuel identify a mobile phone as a “valuable object,” which means Petitioners’ alleged “explicit[]” motivation to combine, *id.*, 38, is based on a non-existent disclosure, *id.*, 37–39.

The Petition also alleges a motivation to combine because it incorrectly states both Samuel and Shin teach “preventing unauthorized access to objects.” Pet., 36. Shin does *not* prevent access to the cell phone. Shin’s bag, just like a Ziploc bag, can be opened by anyone merely by pulling. EX1006, 8. Shin’s “invention” expressly uses “voluntary participation by mobile phone owners.” EX1006, 5. Samuel, in contrast, is directed to “secure transportation,” EX1005 (Abstract), without any mention of a mobile phone. The references provide no indication why someone would use Samuel’s high-security system to transport a mobile phone. Indeed, as the ’788 Patent recognizes, a user typically keeps their mobile phone with them. EX1001, 2:17–24.

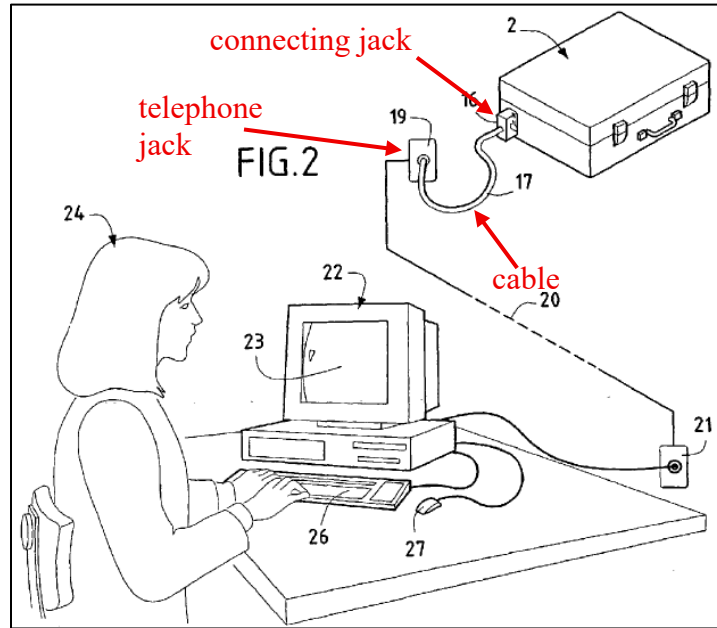
Accordingly, the Petition’s motivation to combine is based on a non-existent disclosure. There is no commonality between Shin and Samuel that would have motivated the Petition’s obviousness combination.

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

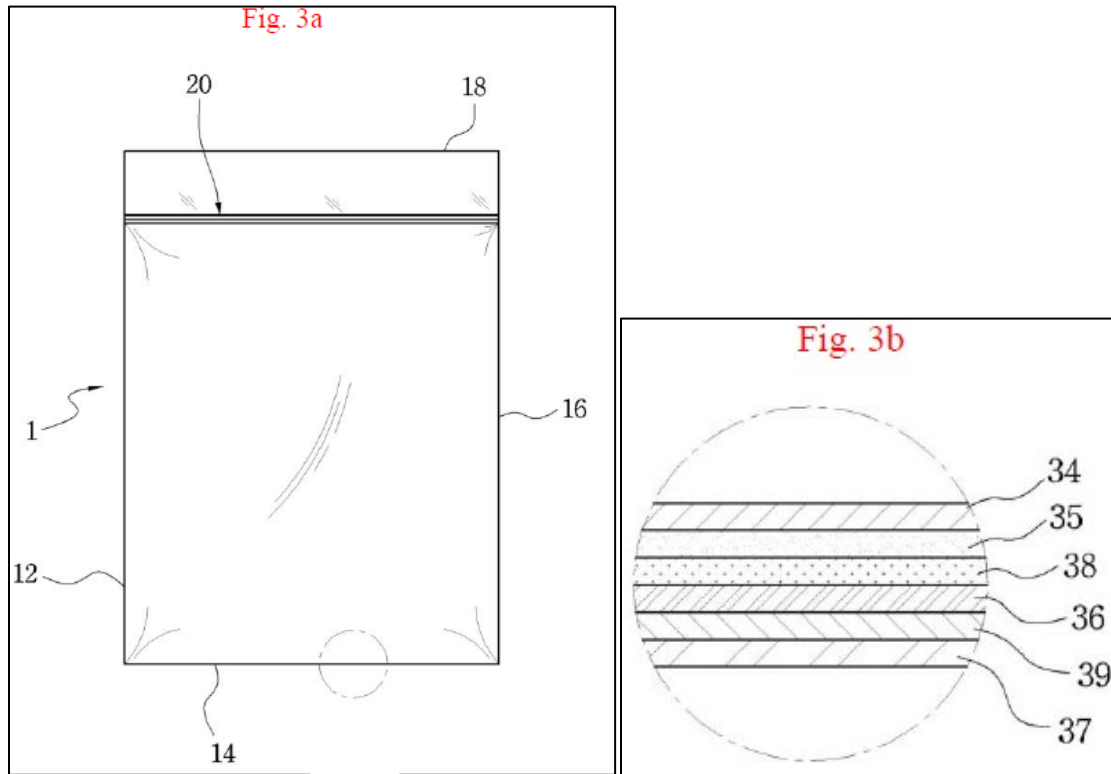
Petitioners further assert that a POSA would have recognized that “the rigid case depicted in [Samuel’s] figures could be replaced by a more flexible envelope design, such as the envelope shown in Shin.” Pet., 35. In support, Petitioners rely on the following quotation from Samuel:

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

*Id.* (quoting EX1005, [0091]). Petitioners omit the remainder of the quotation, which requires that “[t]hese types of materials” permit “a *connecting jack* 16 on one of the outside surfaces or walls.” EX1005, [0091] (emphasis added). The “outside surfaces or walls” of Samuel must accordingly be durable enough to not only hold the weight of the connecting jack (16), but also withstand the additional weight and push/pull force of the cable (17), which connects the connecting jack (16) to a phone jack (19).



EX1005, Fig. 2; *see also, e.g., id.*, [0032], [0033], [0089], [0093], [0166], [0167] (describing connection of case to a network via the connecting jack). As illustrated below, the disposable envelope in Shin—made from thin coated plastic, microns thick—is far too flimsy to house this type of connecting jack and cable. *See* EX1006, Fig. 3a, Fig. 3b, 5, 6, 7. Shin expressly describes its bag as a “disposable mobile phone storage envelope,” EX1006, 1 (Abstract), indicating it is not the type of heavy-duty structure needed in Samuel to support attached features or withstand transportation.



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

A POSA would understand that these thin layers of plastic and aluminum foil would be nowhere near durable enough to support the structure needed to employ a connecting jack, or to withstand the force of both the connecting jack and the insertion/withdrawal of the cable connection to the phone jack. Samuel would accordingly be left “void of the mechanism it relies on” to receive the unlocking signals (i.e., the connecting jack and cable) if it were to adopt the envelope of Shin. *See In re Schweickert*, 676 F. App’x 988, 994 (Fed. Cir. 2017) (non-precedential) (vacating obviousness rejection when combination of references would leave the primary reference “void of the mechanism it relies on” to perform critical

functionality); *Cook Grp. Inc. v. Bos. Sci. Scimed, Inc.*, 809 F. App'x 990, 1001 (Fed. Cir. 2020) (non-precedential) (“[T]he Board may consider whether the modification renders the reference inoperable for its intended function in deciding whether a POSA would have a motivation to combine the references, even if that function is not a feature of the claimed device at issue.”). A POSA would therefore not have been motivated to modify the “rigid case” in Samuel with the flimsy, plastic envelope in Shin.

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

Petitioners argue that a POSA would have been motivated to combine Samuel and Shin, since both “teach ways of preventing unauthorized access to objects in...a case or envelope” and thus “address the same subject matter.” Pet., 36; *see also id.*, 38 (asserting that both Shin and Samuel disclose a mobile electronic device “contained within a case”). This assertion is doubly flawed. First, Petitioners are incorrect that both references “teach ways of preventing unauthorized access to objects” in their respective case or envelope. *Id.* On the contrary, the envelope in Shin is not lockable and remains, by design, freely accessible to the user. *See supra* §§VI.A-B.

Second, even if Samuel and Shin both “address[ed] the same subject matter,” the mere fact that two references are “directed to the same art or same techniques” does not “show persuasively that a relevant skilled artisan would have been

motivated to combine the references.” *Microsoft Corp. v. Enfish, LLC*, 662 F. App’x 981, 990 (Fed. Cir. 2016) (non-precedential); *see also Securus Techs., Inc. v. Glob. Tel\*Link Corp.*, 701 F. App’x 971, 976 (Fed. Cir. 2017) (non-precedential) (finding allegation of motivation to combine was “simply too conclusory” when petitioner merely asserted that the two references “were drawn from the same general field of art”).

4. **Shin Teaches Against Limiting A User’s Access To Her Own Mobile Electronic Device**

Petitioners further claim that a POSA, based on Shin’s stated goal of blocking phone calls while the cellphone is in the envelope, would have been motivated “to combine Shin’s envelope structure with Samuel’s locking means to further limit the user’s access to the cellphone stored in the Shin envelope.” Pet., 42; *see also id.* at 43 (asserting that Shin “discusses the need to prevent access to phones in certain venues” and therefore “provides a motivation to combine” with Samuel). Samuel does not “limit the user’s access” to their own objects stored in the case, *supra* §V.A, and actually teaches *against* limiting the user’s access to their own mobile device, *see* EX1006, 5 (listing “*voluntary* participation by mobile phone owners” as an object of the invention) (emphasis added); *id.* 5, 7, 8 (describing use of a resealable plastic zipper on the envelope); *see also AstraZeneca AB v. Mylan Pharm. Inc.*, 19 F.4th 1325, 1337 (Fed. Cir. 2021) (“[A] reference that properly teaches away can preclude a determination that the reference renders a claim obvious.”) (cleaned up).

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

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

**A. The Combination Of Simpson, Samuel, And Shin Fails To Disclose The Claimed Invention**

**1. Claim 2**

As discussed above, amended claim 2 is not properly challenged in the Petition. In addition, Petitioners’ arguments fail on the merits.

The preamble of claim 2, limitation 2(a), and limitation 2(b) are identical to the preamble of claim 1, limitation 1(a), and limitation 1(b), respectively. Petitioners accordingly recycle their same arguments that Samuel, in view of Shin, renders claim 2, limitation 2(a), and limitation 2(b) obvious. *See* Pet., 36–43, 63–65. As explained *supra* §§V, VI.A–C, these arguments are baseless. Petitioners also argue that the pin illustrated in Simpson’s Figure 6C demonstrates “securably mateable female and male members on opposing plates.” Pet., 64. But, again there are no opposing plates identified. And even if the pin could be considered a male member, there is no corresponding female member in Simpson that interacts and “securably mate[s]” with the male member. Indeed, Petitioners’ expert identified only an “aperture,” not a female member, and does not identify corresponding plates. EX1002 ¶ 161. Accordingly, Simpson does not fix Samuel or Shin’s deficiencies.

Moreover, as Petitioners acknowledge, “the security cases disclosed in Samuel and Simpson are very similar.” Pet., 60. In fact, as demonstrated below, Simpson fails to disclose virtually all of the same limitations as Samuel. Simpson, therefore, adds nothing to Petitioners’ argument that the claimed invention is obvious.

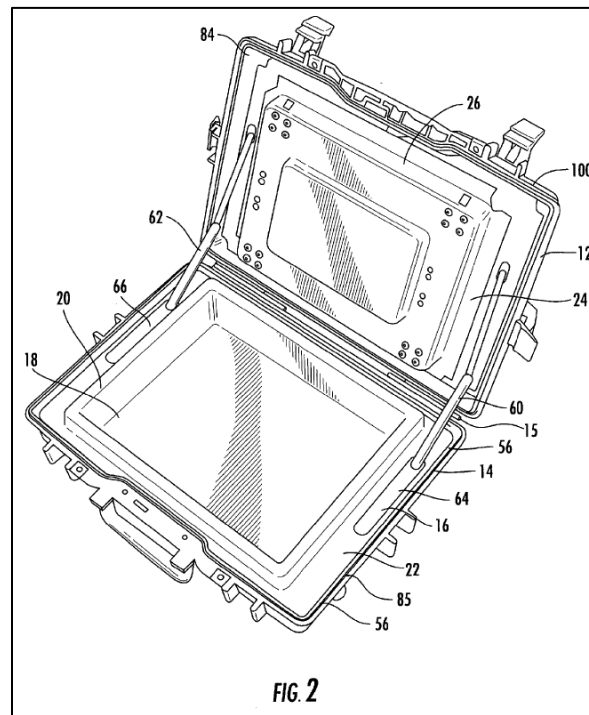
a) **“a cavity sized to accommodate the user’s mobile electronic device”**

Petitioners concede that, like Samuel, “the specific examples of ‘valuables’ given in Simpson do not include mobile electronic devices.” Pet., 63. Like Samuel, Simpson makes no mention of a party using the case to control their own access to the contents inside. *See* EX1008, [0003], [0035], [0036]. Petitioners accordingly are forced to argue that a POSA “would understand the briefcase depicted in Figure 2 [of Simpson] would accommodate a ‘valuable’ such as a user’s mobile electronic device.” Pet., 63.

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

V.B, VI.C, a cavity that is “sized to accommodate” a mobile electronic device is one that is approximately the size of the device. EX1001, Fig. 2; *see also id.*, 5:62–6:6.

Simpson, like Samuel, however, describes a case with, in Petitioners’ words, a “briefcase-type structure[], designed for the secure transportation of valuable objects,” Pet., 60, as shown in the following figure.



EX1008, Fig. 2. Simpson does not disclose the briefcase being designed for *any* object—much less those Petitioners claim are “similar” in size to a mobile electronic device. Indeed, Simpson’s sole disclosure pertaining to size at all relates only to the case generally, not the cavity specifically. EX1008, [0051] (stating that the embodiment of the case shown in Figure 12 is larger than that shown in Figure 1). The “briefcase-type structure” of Simpson is accordingly not “sized to

accommodate” a user’s mobile electronic device as contemplated by the ’788 Patent, nor would that have been obvious in view of Samuel and Shin, as discussed for Ground 2.

b) **“rendered inaccessible to the user”**

Petitioners further argue that the locking mechanism in Simpson “render[s] [the valuables] inaccessible to the user,” based solely on the fact that the case in Simpson may remain locked until certain conditions are met. Pet., 64–65. But Petitioners again ignore, as they did with Samuel, that objects in transit are *already* inaccessible prior to their arrival at the intended destination, regardless of whether they are transported in a locked case. *See supra* §§V.C.2, VI.B. The locking mechanism in Simpson therefore does not necessarily “render”—i.e., *cause*—the transported objects to be inaccessible to the intended recipient. Nor have Petitioners alleged that such a scenario would be within the general knowledge of the POSA. *See Google v. Parus Holdings, Inc.*, IPR2022-00279, Paper 40, at 31 (PTAB Aug. 1, 2024) (arguments not presented in the petition “are forfeited and will not be considered”). Accordingly, for the reasons set out above as well as those discussed for the corresponding limitations in Grounds 1 and 2, the Petition fails to establish obviousness.

**2. Claim 8**

Petitioners finally argue that Samuel, in view of Shin and Simpson, teaches claim 8. Petitioners, however, rely solely on the combination of Samuel and Shin to argue that the limitations of claim 3—from which claim 8 depends—are met. Pet., 65–66 (incorporating arguments). As explained *supra* §§VI.A-B, VI.D.1–2, VI.E, this argument is baseless.

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

Petitioners assert that a POSA would have been motivated to combine Samuel and Simpson given the similarity of the two references. Pet., 60–62. Even if a POSA would have been motivated to combine Samuel with Simpson, however, Petitioners do not show that a POSA would have also been motivated to combine Samuel/Simpson with Shin. *Supra* §§VI.A-C, VI.D.1–2, VI.E ; *see also* Pet., 59–62 (relying on Petitioners’ previous arguments for combining Samuel with Shin). Petitioners also argue that each of the three references involve “timing.” Pet., 61–62. That does not explain why Shin’s timer that allows signals to reach the phone inside its modified sandwich bag has any relevance to Samuel or Simpson’s high-security cases. In addition, the Petition reiterates the incorrect assertion that Shin discloses “ways to secure valuables.” Pet., 62. As discussed, Shin teaches that its thin, disposable, bag can be opened at any point by merely pulling, which is the

opposite of securing valuables. EX1006, 8. Petitioners accordingly fail to show a motivation to combine Shin with Samuel and Simpson.

### **VIII. NEITHER SAMUEL NOR SIMPSON ARE ANALOGOUS TO THE CLAIMED INVENTION**

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

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

*In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). “A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992).

Petitioners have the burden of showing that Samuel and Simpson are analogous to the claimed invention. *See Sanofi-Aventis Deutschland GmbH v. Mylan Pharms. Inc.*, 66 F.4th 1373, 1379 (Fed. Cir. 2023). Petitioners, however, failed to even *allege*—let alone explain “with particularity,” 35 U.S.C. §312(a)(3)—

that Samuel or Simpson are analogous to the '788 Patent, *see* Pet., 33–36, 56-62. Nor could Petitioners succeed in showing that Samuel and Simpson are analogous to the '788 Patent, as demonstrated below.

**A. Neither Samuel Nor Simpson Are Within The Same Field Of Endeavor As The Claimed Invention**

Petitioners claim that “[t]he '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.’” Pet., 11 (quoting EX1001, 1:37–42). Even if that were correct, the written description and the claims of the '788 Patent further clarify that the “personal electronic devices” are the users’ *own* electronic devices. *See* EX1001 2:20–24 (noting that prior art failed to provide solution for user’s desire “not be separated from their valuable personal property”); *id.*, 2:63–67, 3:47–62, 7:67–8:5, 8:12–15 (describing embodiments that limit access to the user’s *own* mobile electronic device); cl. 1 (preamble); lim. 1(a); cl. 2 (preamble); lim. 2(a); cl. 3 (preamble); lim. 3(a); lim. 3(c); *see also In re Singhal*, 602 F. App’x 826, 830 (non-precedential) (Fed. Cir. 2015) (explaining that one looks to the “written description and claims” of a patent to determine the field of endeavor). Moreover, the '788 patent makes clear that the field is specifically directed to eliminating distractions at communal events; preventing access to mobile electronic devices “within certain

locations” or “during certain periods of time”; and preventing unauthorized recording of proprietary content and individuals’ conduct. EX1001, 3:44–62

Neither Samuel nor Simpson pertain to limiting a users’ access to ***their own*** mobile device. Instead, Samuel concerns ensuring secure transportation of objects by transporting them in a locked case that only opens once the case reaches its intended destination or recipient. *See, e.g.*, EX1005, [0001]–[0008], [0038], [0057], [0058], [0106]–[0110], [0123]–[0125], [0195], [0196]. Simpson, like Samuel, concerns ensuring secure transportation of objects by transporting them in a locked case that only opens once the case reaches its intended destination or recipient. EX1008, [0008], [0039]–[0046], [0049], [0050], [0052]–[0057]. Neither Samuel nor Simpson even ***mentions*** mobile electronic devices, much less discloses locking a mobile electronic device in the security case in order to prevent access by the device’s owner.

Accordingly, neither Samuel nor Simpson are from the same field of endeavor as the ’788 Patent.

**B. Neither Samuel Nor Simpson Are Reasonably Pertinent To The Problems Addressed By The Claimed Invention**

Neither Samuel nor Simpson “would have logically commended” themselves to the attention of the inventor of the claimed invention, for at least two reasons.

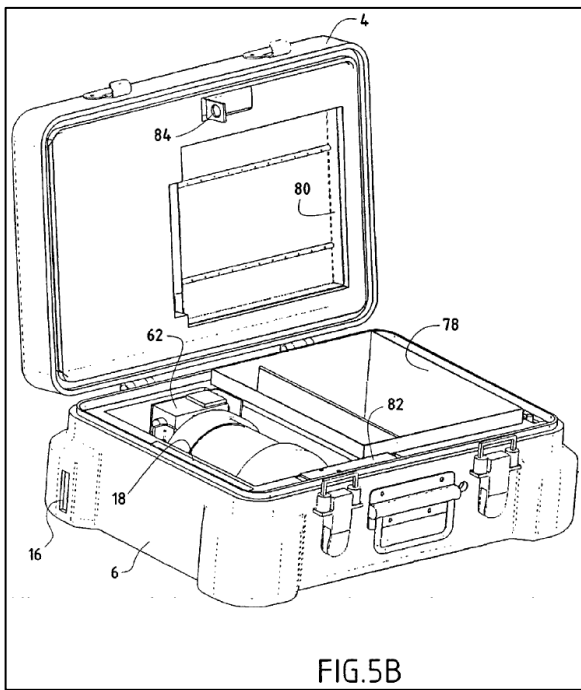
First, neither reference “relate[s] to a similar problem or purpose” as the claimed invention. *Donner Tech., LLC v. Pro Stage Gear, LLC*, 979 F.3d 1353,

1359 (Fed. Cir. 2020) (noting that the “reasonably pertinent” test “ultimately rests on the extent to which the reference of interest and the claimed invention relate to a similar problem or purpose”). The purposes underlying the ’788 Patent consist of eliminating distractions at communal events without blocking phone notifications; preventing access to mobile electronic devices “within certain locations” or “during certain periods of time”; and preventing unauthorized recording of proprietary content and individuals’ conduct. EX1001, 3:44–62.

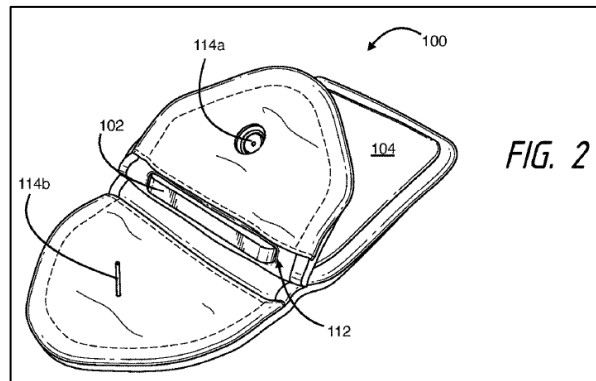
The purpose of the case in Samuel, by contrast, is to provide a way of securely transporting objects through cheaper and/or smaller means than armored vehicles. EX1005, [0008]. The purpose of the case in Simpson, like Samuel, is to enable individuals to securely transport valuables, “[s]ince the transportation of these objects cannot always be restricted to armed and secure vehicles.” EX1008, [0003]. This purpose plainly does not align with any of those taught in the ’788 Patent. *In re Nat. Alternatives, LLC*, 659 F. App’x 608, 613–14 (Fed. Cir. 2016) (non-precedential) (finding reference directed to solving a “substantially different problem[]” as the claimed invention was not analogous).

Second, the inventions in Samuel and Simpson bear minimal similarity to the structure and function of the invention claimed in the ’788 Patent. *See Clay*, 966 F.3d at 660 (finding a reference was not reasonably pertinent when the reference lacked similarity in structure and function to the claimed invention). For example,

as described, *supra* §§II.A, V.B, VI.C, VI.D.2, the case of the '788 Patent is designed specifically for mobile electronic devices, such that a user may keep the secured device with them at, e.g., a concert venue. Samuel, by contrast, describes a case with, in Petitioners' words, a "rigid" and "briefcase-type structure[], designed for the secure transportation of valuable objects," as shown in the comparison below.



Samuel



'788 Patent

Pet., 35, 60; EX1005, Fig. 5B; EX1001, Fig. 2. The reference in Samuel to a "rubber" envelope that includes a "circuit card" and "connecting jack" likewise does not suggest a structure like that claimed in the '788 Patent. EX1005, [0091]. Simpson similarly involves a rigid structure akin to the briefcase shown in Samuel. *See, e.g.*, EX1008, Figs. 1, 2. A POSA would not have relied on references with

such manifestly different structures and functions to solve the problems facing the inventor of the '788 Patent. *See Clay*, 966 F.3d at 660; *Donner Tech., LLC v. Pro Stage Gear, LLC*, IPR2018-00708, Paper No. 47, at 25 (PTAB Aug. 26, 2019).

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

#### **IX. OBJECTIVE INDICIA REINFORCE PATENTABILITY OF THE CHALLENGED CLAIMS**

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

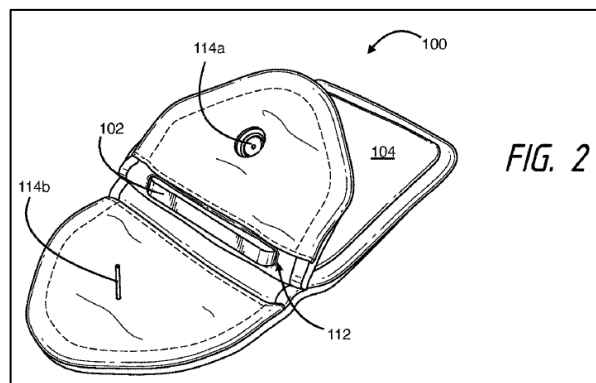
Objective indicia "are not just a cumulative or confirmatory part of the obviousness calculus but constitute[] independent evidence of nonobviousness." *Leo Pharm. Prods., Ltd. v. Rea*, 726 F.3d 1346, 1358 (Fed. Cir. 2013) (internal quotation marks omitted). "[T]he objective indicia of nonobviousness are crucial in avoiding the trap of hindsight." *Id.* Indeed, such evidence "may often be the most probative and cogent evidence in the record" and "may often establish that an invention appearing to have been obvious in light of the prior art was not." *Transocean Offshore Deepwater Drilling, Inc. v. Maersk Drilling USA, Inc.*, 699 F.3d 1340, 1349 (Fed. Cir. 2012) (internal quotation marks omitted). Though each objective

indicium provides substantial weight to nonobviousness, “it stands to reason that these individual weights would sum to a greater weight” to firmly establish the challenged claims are patentable. *Volvo Penta of the Ams., LLC v. Brunswick Corp.*, 81 F.4th 1202, 1215 (Fed. Cir. 2023).

As shown below, the Yondr Pouch is similar to '788 Patent Figure 2.



Yondr Pouch



'788 Patent

EX2012; EX1001, Fig. 2. The objective indicia discussed below result directly from the Yondr Pouch’s unique and claimed ability to selectively limit a user’s access to their own mobile electronic device while allowing the user to maintain possession of the device, as highlighted by Yondr’s website. *See* EX2012.

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

Competitors’ copying of the Yondr Pouch is strong evidence the claims of the '788 patent would not have been obvious. *Volvo Penta*, 81 F.4th at 1213 (noting the Federal Circuit has “usually considered a determination of copying to be strong

evidence of nonobviousness”) (internal quotation marks omitted). A party’s copying may be established by showing that the party “had access to the [copied product] while it was developing [its own product] and the products have substantially similar designs.” *Medtronic, Inc. v. Teleflex Innovations S.A.R.L.*, 70 F.4th 1331, 1339 (Fed. Cir. 2023).

Here, Petitioners have copied the Yondr Pouch. Petitioners sell a product called CellockED, which, like the Yondr Pouch, is directed to limiting a user’s access to their own mobile electronic device. *See* EX2013. Petitioners did not launch CellockED until 2024, long after the Yondr Pouch became publicly available and years after the ’788 Patent issued. *See* EX2014. The design of CellockED strikingly matches the Yondr Pouch, as the following images show.

CellockED	Yondr Pouch
<p data-bbox="370 256 620 289">Product Dimensions</p>  <p data-bbox="435 865 565 907">EX2013</p>	 <p data-bbox="1058 865 1188 907">EX2015</p>
 <p data-bbox="435 1579 565 1621">EX2013</p>	 <p data-bbox="1058 1579 1188 1621">EX2012</p>

Be Smarter could have selected a different design for its product. For example, Be Smarter could have selected a briefcase like Samuel or a food storage

bag like Shin. But Be Smarter did not select anything like those devices, because the design disclosed in the '788 Patent, and embodied in Yondr's Pouch, provides substantial benefits. Be Smarter's copying of the Yondr Pouch accordingly reinforces the fact that the claimed invention of the '788 Patent would not have been obvious to a POSA.

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

Yondr has also received significant industry praise for its Yondr Pouch, which “provides probative and cogent evidence that one of ordinary skill in the art would not have reasonably expected the claimed invention.” *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1334 (Fed. Cir. 2016) (cleaned up). For example, the Yondr Pouch was included among TIME Magazine's “Best Inventions of 2024.” EX2016. Publications like the Washington Post, the Houston Chronicle, and the Atlanta Journal-Constitution have further highlighted the Yondr Pouch as an effective tool for instituting phone-free schools. *See* EX2017 (noting Yondr's effectiveness in schools); EX2018 (same); EX2019 (same). Connecticut Governor Ned Lamont, according to Forbes, even “specifically recommended Yondr pouches as a solution” to implementing statewide restrictions on cellphones in schools. EX2020, at 5. This “evidence of industry praise by business publications” is “compelling” evidence that may “rebut[] even a strong showing” of obviousness. *Apple Inc. v. Int'l Trade Comm'n*, 725 F.3d 1356, 1366 (Fed. Cir. 2013).

**X. CONCLUSION**

For the foregoing reasons, Yondr respectfully requests the Board deny institution.

Respectfully submitted,

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**CERTIFICATE OF COMPLIANCE**

Pursuant to 37 C.F.R. §42.24(d), Counsel for Patent Owner Yondr, Inc. hereby certifies that this document complies with the type-volume limitation of 37 C.F.R. §42.24(b). This document contains approximately 13,821 words, including any statement of material facts to be admitted or denied in support, and excluding the table of contents, table of authorities, mandatory notices under §42.8, exhibit list, certificate of service or word count, or appendix of exhibits or claim listing.

KNOBBE, MARTENS, OLSON & BEAR, LLP

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**CERTIFICATE OF SERVICE**

I hereby certify that, pursuant to 37 C.F.R. §42.6(e) and with the agreement of counsel for Petitioners, a true and correct copy of **PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR INTER PARTES REVIEW OF U.S. PATENT NO. 9,819,788 B2 AND EXHIBITS** are being served electronically on September 10, 2025, to the e-mail addresses shown below:

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