

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

YONDR, INC.	§	
	§	
Plaintiff,	§	
	§	
vs.	§	Civil Action No. 1:24-cv-01326
	§	
BE SMARTER, LLC AND	§	
JAMES GUERRA,	§	
	§	
Defendants.	§	

**Defendants’ Answer, Affirmative Defenses, and Counterclaims
in Response to Yondr, Inc.’s Complaint**

Defendants Be Smarter, LLC and James Guerra (“Defendants”) answer plaintiff Yondr, Inc.’s (“Plaintiff” or “Yondr”) Complaint (Dkt. 1) as follows:

Introduction and Parties

1. Defendants admit Plaintiff alleges infringement of U.S. Patent Nos. 9, 819, 788 and 12,133,078 (the “Asserted Patents”). Defendants admit Plaintiff alleges infringement of a U.S. Trademark under Registration Number 6,995,045 (“the ‘045 Mark” or “the Asserted Mark”). Defendants admit Plaintiff alleges unfair competition related to the Asserted Patents and Asserted Mark. Defendants deny infringing the Asserted Patents and the Asserted Mark, deny unfairly competing with respect to the Asserted Patents and the Asserted Mark, and deny all remaining allegations set forth in Paragraph 1 of the Complaint.

2. Defendants lack knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 2 of the Complaint.

3. Defendants lack knowledge or information sufficient to form a belief as to

the truth of the allegations set forth in Paragraph 3 of the Complaint.

4. Defendants lack knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 4 of the Complaint.

5. Defendants lack knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 5 of the Complaint.

6. Defendants lack knowledge or information sufficient to form a belief as to the truth of the allegations set forth in the first sentence of Paragraph 6 of the Complaint.

Defendants deny the allegation of seeking to capitalize on Plaintiff's products.

Defendants admit that Guerra is the Manager of Be Smarter. Defendants admit that Be Smarter first offered its CellockED product for sale in 2024. Defendants admit that Be Smarter markets its CellockED product on its website. Defendants deny that CellockED infringes Plaintiff's patents and trademark. Defendants deny Be Smarter's website contains a video falsely claiming Plaintiff's product does not function properly.

Defendants deny all remaining allegations set forth in Paragraph 6 of the Complaint.

7. Defendants admit that Plaintiff filed the present suit alleging infringement and disparagement but deny that Plaintiff's claims have any merit. Defendants deny all remaining allegations set forth in Paragraph 7 of the Complaint.

8. Defendants lack knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 8 of the Complaint.

9. Defendants deny that Be Smarter is a "limited liability corporation."
Defendants admit the remaining allegations set forth in Paragraph 9 of the Complaint.

10. Defendants admit the allegations set forth in Paragraph 10 of the

Complaint.

Jurisdiction and Venue

11. Defendants admit Plaintiff purports to bring this action under the Patent Laws of the United States, Title 35 of the United States Code, the Trademark and Unfair Competition Laws of the United States, Title 15 of the United States Code, and Texas common law. Defendants deny infringing the Asserted Patents and the Asserted Mark, deny unfairly competing with respect to the Asserted Patents and the Asserted Mark, and deny any remaining allegations set forth in Paragraph 11 of the Complaint.

12. Defendants admit this Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. §§ 1331, 1332, and 1338. Defendants admit this Court also has supplemental jurisdiction over the Texas common law claims in this action pursuant to 28 U.S.C. § 1367(a). Defendants deny all remaining allegations set forth in Paragraph 12 of the Complaint.

13. Defendants admit the allegations set forth in Paragraph 13 of the Complaint.

14. Defendants admit that the Court has personal jurisdiction over Be Smarter in this action. Defendants deny all remaining allegations set forth in Paragraph 14 of the Complaint.

15. Defendants admit the allegations set forth in Paragraph 15 of the Complaint.

16. Defendants admit that the Court has personal jurisdiction over Guerra. Defendants deny all remaining allegations set forth in Paragraph 16 of the Complaint.

17. Defendants admit that venue is proper in this Judicial District. Defendants admit that Be Smarter is registered to do business in and has transacted business in the State of Texas. Defendants deny all remaining allegations set forth in Paragraph 17 of the Complaint.

18. Defendants admit that venue is proper in this Judicial District. Defendants admit that Guerra resides in the State of Texas. Defendants deny all remaining allegations set forth in Paragraph 18 of the Complaint.

Factual Allegations

19. Defendants deny “Dugoni hand sewed the original prototype for the Yondr System.” Defendants lack knowledge or information sufficient to form a belief as to the truth of the remaining allegations set forth in Paragraph 19 of the Complaint.

20. Defendants admit that Plaintiff purports to attach a copy of the '788 Patent to the Complaint as an Exhibit A. Defendants lack knowledge or information sufficient to form a belief as to the truth of the remaining allegations set forth in Paragraph 20 of the Complaint.

21. Defendants admit that Dugoni received a patent. Defendants admit Yondr purports to quote from the Abstract of the '788 Patent, but deny the accuracy of the quotation. Defendants deny the remaining allegations set forth in Paragraph 21 of the Complaint.

22. Defendants lack knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 22 of the Complaint.

23. Defendants admit that a U.S. trademark application was filed on or about

December 13, 2021. Defendants admit that the United States Patent and Trademark Office issued U.S. Trademark Registration No. 6,995,045 on or about March 7, 2023. Defendants admit that Yondr purports to quote from the “Description of the Mark” found in the ‘045 Trademark in Paragraph 23 of the Complaint. Defendants admit that Yondr purports to include an image from the ‘045 Trademark in Paragraph 23 of the Complaint. Defendants deny any and all remaining allegations set forth in Paragraph 23 of the Complaint.

24. Defendants deny the allegations set forth in Paragraph 24 of the Complaint.

25. Defendants deny the allegations set forth in Paragraph 25 of the Complaint.

26. Defendants admit that Yondr purports to include images of its product in Paragraph 26 of the Complaint. Defendants deny the remaining allegations set forth in Paragraph 26 of the Complaint.

27. Defendants deny the allegations set forth in Paragraph 27 of the Complaint.

28. Defendants deny the allegations set forth in Paragraph 28 of the Complaint.

29. Defendants deny copying the Yondr’s product and deny all remaining allegations set forth in Paragraph 29 of the Complaint.

30. Defendants deny the Yondr System is used in “countless” spaces or that the Yondr System has gained “widespread popularity and use.” Defendants deny the Yondr System provides a “phone-free experience.” Defendants lack knowledge or information sufficient to form a belief as to the truth of the remaining allegations set forth in Paragraph 30 of the Complaint.

31. Defendants deny the Yondr System has been “recognized for its effectiveness and quality.” Defendants lack knowledge or information sufficient to form a

belief as to the truth of the remaining allegations set forth in Paragraph 31 of the Complaint.

32. Defendants deny the Yondr System has recognition that “has come with increased brand awareness and popularity.” Defendants deny that Yondr has “over 3000 school partners.” Defendants lack knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 32 of the Complaint.

33. Defendants deny the allegations set forth in Paragraph 33 of the Complaint.

34. Defendants admit that Guerra is the Manager of Be Smarter. Defendants deny the remaining allegations set forth in Paragraph 34 of the Complaint.

35. Defendants admit Paragraph 35 of the Complaint includes a LinkedIn post from Guerra in or about June 2024. Defendants deny any remaining allegations set forth in Paragraph 35 of the Complaint.

36. Defendants admit Be Smarter sells a product known as CellockED. Defendants admit that Be Smarter operates a YouTube account. Defendants deny the remaining allegations set forth in Paragraph 36 of the Complaint.

37. Defendants deny the allegations set forth in Paragraph 37 of the Complaint.

38. Defendants admit that Be Smarter operates a YouTube account. Defendants admit Guerra is the manager of Be Smarter. Defendants admit Guerra promotes CellockED on LinkedIn. Defendants deny the remaining allegations set forth in Paragraph 38 of the Complaint.

39. Defendants admit they “were aware of Yondr” when Be Smarter launched CellockED. Defendants admit Be Smarter posted a video relating to a Yondr product.

Defendants deny posting a video to YouTube “making a false claim about the Yondr System.” Defendants admit having “visited the Yondr website.” Defendants deny the allegations set forth in Paragraph 39 of the Complaint.

40. Defendants admit to receiving a letter dated September 30, 2024, from Plaintiff. Defendants admit to responding to Plaintiff’s September 30, 2024, letter on October 29, 2024. Defendants deny the remaining allegations set forth in Paragraph 40 of the Complaint.

41. Defendants admit the YouTube videos “CellockED – Focus on Education” and YouTube Short “CellockED – Focused on Education” describe the CellockED product. Defendants admit Paragraph 41 of the Complaint includes images apparently obtained from the foregoing YouTube video. Defendants deny the remaining allegations set forth in Paragraph 41 of the Complaint.

42. Defendants deny the allegations set forth in Paragraph 42 of the Complaint.

43. Defendants admit Be Smarter offers for sale and sells a product known as CellockED. Defendants deny infringing the ‘788 Patent. Defendants deny the remaining allegations set forth in Paragraph 43 of the Complaint.

44. Defendants admit that Be Smarter promotes the CellockED product. Defendants admit the website <https://cellocked.newschoolhero.org/about/> states “the adoption of a new cell phone pouch with a magnetic locking system, designed to safely secure students’ cell phones during school hours.” Defendants admit that CellockED includes a locking system. Defendants deny the remaining allegations set forth in Paragraph 44 of the Complaint.

45. Defendants admit Be Smarter has had business-related discussions with Tulsa Public Schools, Taylor Independent School District, Taos Municipal Schools, Raymond Ville Independent School District, and Denver Public Schools. Defendants admit the foregoing school districts agreed to purchase or have purchased the accused CellockED product from Be Smarter. Defendants admit Paragraph 45 of the Complaint includes an image of a portion of the CellockED product. Defendants admit the image contained in Paragraph 45 of the Complaint appeared on a LinkedIn page. Defendants deny the remaining allegations set forth in Paragraph 45 of the Complaint.

46. Defendants deny the allegations set forth in Paragraph 46 of the Complaint.

47. Defendants admit Be Smarter has had business-related discussions with Tulsa Public Schools, Taylor Independent School District, Taos Municipal Schools, Raymond Ville Independent School District, and Denver Public Schools. Defendants admit the foregoing school districts agreed to purchase or have purchased the accused CellockED product from Be Smarter. Defendants admit Paragraph 47 of the Complaint includes an image of a portion of the CellockED product. Defendants admit the image contained in Paragraph 47 of the Complaint appeared on a LinkedIn page. Defendants deny the remaining allegations set forth in Paragraph 47 of the Complaint.

48. Defendants deny the allegations set forth in Paragraph 48 of the Complaint.

49. Defendants deny the allegations set forth in Paragraph 49 of the Complaint.

50. Defendants deny the allegations set forth in Paragraph 50 of the Complaint.

51. Defendants deny the allegations set forth in Paragraph 51 of the Complaint.

52. Defendants deny the allegations set forth in Paragraph 52 of the Complaint.

53. Defendants deny the allegations set forth in Paragraph 53 of the Complaint.

54. Defendants deny the allegations set forth in Paragraph 54 of the Complaint.

55. Defendants deny the allegations set forth in Paragraph 55 of the Complaint.

56. Defendants deny the allegations set forth in Paragraph 56 of the Complaint.

57. Defendants deny the allegations set forth in Paragraph 57 of the Complaint.

58. Defendants deny the allegations set forth in Paragraph 58 of the Complaint.

59. Defendants deny the allegations set forth in Paragraph 59 of the Complaint.

60. Defendants deny the allegations set forth in Paragraph 60 of the Complaint.

61. Defendants admit Guerra is the manager of Be Smarter. Defendants deny the remaining allegations set forth in Paragraph 61 of the Complaint.

62. Defendants deny the allegations set forth in Paragraph 62 of the Complaint.

63. Defendants deny the allegations set forth in Paragraph 63 of the Complaint.

64. Defendants deny the allegations set forth in Paragraph 64 of the Complaint.

65. Defendants admit that Paragraph 65 of the Complaint includes images of LinkedIn posts relating to the CellockED product. Defendants deny the remaining allegations set forth in Paragraph 65 of the Complaint.

66. Defendants admit Guerra is the manager of Be Smarter. Defendants deny the remaining allegations set forth in Paragraph 66 of the Complaint.

67. Defendants deny the allegations set forth in Paragraph 67 of the Complaint.

68. Defendants admit Guerra is a Manager of Be Smarter. Defendants admit Guerra has a financial interest in Be Smarter. Defendants deny the remaining allegations set forth in Paragraph 68 of the Complaint.

69. Defendants admit Guerra is a Manager of Be Smarter. Defendants deny the remaining allegations set forth in Paragraph 69 of the Complaint.

70. Defendants deny the allegations set forth in Paragraph 70 of the Complaint.

71. Defendants deny the allegations set forth in Paragraph 71 of the Complaint.

72. Defendants deny the allegations set forth in Paragraph 72 of the Complaint.

73. Defendants deny the allegations set forth in Paragraph 73 of the Complaint.

74. Defendants deny the allegations set forth in Paragraph 74 of the Complaint.

75. Defendants deny the allegations set forth in Paragraph 75 of the Complaint.

76. Defendants deny the allegations set forth in Paragraph 76 of the Complaint.

77. Defendants deny the allegations set forth in Paragraph 77 of the Complaint.

78. Defendants deny the allegations set forth in Paragraph 78 of the Complaint.

Count I
Infringement of U.S. Patent No. 9,819,788

79. Defendants restate and incorporate by reference each of their responses to the allegations set forth in Paragraphs 1 through 78 of the Complaint as if fully set forth herein.

80. Defendants deny the allegations set forth in Paragraph 80 of the Complaint.

81. Defendants deny the allegations set forth in Paragraph 81 of the Complaint.

82. Defendants lack knowledge or information sufficient to form a belief as to whether or not Plaintiff owns all rights, title, and interest in the '788 Patent. Defendants deny any remaining allegations set forth in Paragraph 82 of the Complaint.

83. Defendants admit that Plaintiff purports to attach a copy of the '788 Patent to the Complaint as Exhibit A. Defendants deny any remaining allegations set forth in

Paragraph 83 of the Complaint.

84. Defendants admit that U.S. Patent No. 9,819,788 (“the ‘788 Patent”) is entitled “System and Apparatus for Selectively Limiting User Control of an Electronic Device,” was filed on or about April 21, 2015, and was issued on or about November 14, 2017. Defendants admit that Graham Dugoni claims to be the inventor of the inventions claimed in the ‘788 Patent. Defendants deny any remaining allegations set forth in Paragraph 84 of the Complaint.

85. Defendants admit that Plaintiff purports to quote Claims 3, 7, 8, and 9 of the ‘788 Patent in Paragraph 85 of the Complaint. Defendants deny the remaining allegations set forth in Paragraph 85 of the Complaint.

86. Defendants admit that Plaintiff included a “claim chart” as an exhibit to the Complaint. Defendants deny infringing the ‘788 Patent and deny all remaining allegations set forth in Paragraph 86 of the Complaint.

87. Defendants admit the website <https://cellocked.newschoolhero.org/about/> states “a new cell phone pouch with a magnetic locking system, designed to safely secure students’ cell phones during school hours.” Defendants deny all remaining allegations set forth in Paragraph 87 of the Complaint.

88. Defendants admit the website <https://www.prnewswire.com/news-releases/cellocked-launches-signal-blocking-cell-phone-device-for-improving-focus-and-productivity-in-schools-302193646.html> states “CellockED features a unique cell phone pouch equipped with a retractable locking pin that unlocks only with a specialized

magnetic detacher.” Defendants deny all remaining allegations set forth in Paragraph 88 of the Complaint.

89. Defendants deny infringing the ‘788 Patent and deny all remaining allegations set forth in Paragraph 89 of the Complaint.

90. Defendants deny the allegations set forth in Paragraph 90 of the Complaint.

91. Defendants deny the allegations set forth in Paragraph 91 of the Complaint.

92. Defendants deny the allegations set forth in Paragraph 92 of the Complaint.

93. Defendants admit to having knowledge of the ‘788 Patent by virtue of Plaintiff’s allegations in this case. Defendants deny any remaining allegations set forth in Paragraph 93 of the Complaint.

94. Defendants deny the allegations set forth in Paragraph 94 of the Complaint.

95. Defendants deny the allegations set forth in Paragraph 95 of the Complaint.

96. Defendants deny the allegations set forth in Paragraph 96 of the Complaint.

COUNT II
Infringement of U.S. Patent No. 12,133,078

97. Defendants restate and incorporate by reference each of their responses to the allegations set forth in Paragraphs 1 through 96 of the Complaint as if fully set forth herein.

98. Defendants deny the allegations set forth in Paragraph 98 of the Complaint.

99. Defendants deny the allegations set forth in Paragraph 99 of the Complaint.

100. Defendants lack knowledge or information sufficient to form a belief as to whether Plaintiff owns all rights, title, and interest in the ‘078 Patent. Defendants deny any remaining allegations set forth in Paragraph 100 of the Complaint.

101. Defendants admit that Plaintiff purports to attach a copy of the '078 Patent to the Complaint as Exhibit B. Defendants deny any remaining allegations set forth in Paragraph 101 of the Complaint.

102. Defendants admit that U.S. Patent No. 12,133,078 ("the '078 Patent") is entitled "System and Apparatus for Selectively Limiting User Control of an Electronic Device," was filed on or about March 14, 2024, and was issued on or about October 29, 2024. Defendants admit that Graham Dugoni claims to be the inventor of the inventions claimed in the '078 Patent. Defendants deny any remaining allegations set forth in Paragraph 102 of the Complaint.

103. Defendants admit that Plaintiff purports to quote Claim 1 of the '078 Patent in Paragraph 103 of the Complaint. Defendants deny the remaining allegations set forth in Paragraph 103 of the Complaint.

104. Defendants admit that Plaintiff included a "claim chart" as an exhibit to the Complaint. Defendants deny infringing the '078 Patent and deny all remaining allegations set forth in Paragraph 104 of the Complaint.

105. Defendants admit the website <https://cellocked.newschoolhero.org/about/> states "a new cell phone pouch with a magnetic locking system, designed to safely secure students' cell phones during school hours." Defendants deny all remaining allegations set forth in Paragraph 105 of the Complaint.

106. Defendants admit the website <https://www.prnewswire.com/news-releases/cellocked-launches-signal-blocking-cell-phone-device-for-improving-focus-and->

[productivity-in-schools-302193646.html](https://www.fda.gov/oc/foia/productivity-in-schools-302193646.html) states “CellockED features a unique cell phone pouch equipped with a retractable locking pin that unlocks only with a specialized magnetic detacher.” Defendants deny all remaining allegations set forth in Paragraph 106 of the Complaint.

107. Defendants deny infringing the ‘078 Patent and deny all remaining allegations set forth in Paragraph 107 of the Complaint.

108. Defendants deny the allegations set forth in Paragraph 108 of the Complaint.

109. Defendants deny the allegations set forth in Paragraph 109 of the Complaint.

110. Defendants deny the allegations set forth in Paragraph 110 of the Complaint.

111. Defendants admit to having knowledge of the ‘078 Patent by virtue of Plaintiff’s allegations in this case. Defendants deny any remaining allegations set forth Paragraph 111 of the Complaint.

112. Defendants deny the allegations set forth in Paragraph 112 of the Complaint.

113. Defendants deny the allegations set forth in Paragraph 113 of the Complaint.

114. Defendants deny the allegations set forth in Paragraph 114 of the Complaint.

COUNT III
Infringement of Federally Registered Trademark No. 6,995,045

115. Defendants restate and incorporate by reference each of their responses to the allegations set forth in Paragraphs 1 through 114 of the Complaint as if fully set forth herein.

116. Defendant admits that Plaintiff purports to attach the '045 Trademark as Exhibit E to its Complaint. Defendants lack knowledge or information sufficient to form a belief as to ownership of the '045 Mark. Defendants deny the remaining allegations set forth in Paragraph 116 of the Complaint.

117. Defendants deny infringing the '045 Mark and deny all remaining allegations set forth in Paragraph 117 of the Complaint.

118. Defendants deny the allegations set forth in Paragraph 118 of the Complaint.

119. Defendants deny the allegations set forth in Paragraph 119 of the Complaint.

120. Defendants deny the allegations set forth in Paragraph 120 of the Complaint.

121. Defendants deny the allegations set forth in Paragraph 121 of the Complaint.

122. Defendants deny the allegations set forth in Paragraph 122 of the Complaint.

123. Defendants deny the allegations set forth in Paragraph 123 of the Complaint.

124. Defendants deny the allegations set forth in Paragraph 124 of the Complaint.

125. Defendants deny the allegations set forth in Paragraph 125 of the Complaint.

COUNT IV
Unfair Competition, 15 U.S.C. § 1125

126. Defendants restate and incorporate by reference each of their responses to the allegations set forth in Paragraphs 1 through 125 of the Complaint as if fully set forth herein.

127. Defendants deny engaging in acts of unfair competition and deny all remaining allegations set forth in Paragraph 127 of the Complaint.

128. Defendants deny the allegations set forth in Paragraph 128 of the Complaint.

129. Defendants deny the allegations set forth in Paragraph 129 of the Complaint.

130. Defendants deny the allegations set forth in Paragraph 130 of the Complaint.

131. Defendants deny the allegations set forth in Paragraph 131 of the Complaint.

132. Defendants admit that Yondr seeks a judgment in its favor and various forms of relief. Defendants deny Yondr is entitled to such judgment or relief and deny the remaining allegations set forth in Paragraph 132 of the Complaint.

COUNT V
Trademark Infringement Under Texas Common Law

133. Defendants restate and incorporate by reference each of their responses to the allegations set forth in Paragraphs 1 through 132 of the Complaint as if fully set forth herein.

134. Defendant admits that Plaintiff purports to attach the '045 Trademark as Exhibit E to its Complaint. Defendants lack knowledge or information sufficient to form a belief as to ownership of the '045 Mark. Defendants deny the remaining allegations set forth in Paragraph 134 of the Complaint.

135. Defendants deny infringing the '045 Mark and deny all remaining allegations set forth in Paragraph 135 of the Complaint.

136. Defendants deny the allegations set forth in Paragraph 136 of the Complaint.

137. Defendants deny the allegations set forth in Paragraph 137 of the Complaint.

138. Defendants deny the allegations set forth in Paragraph 138 of the Complaint.

139. Defendants deny the allegations set forth in Paragraph 139 of the Complaint.

140. Defendants deny the allegations set forth in Paragraph 140 of the Complaint.

141. Defendants deny the allegations set forth in Paragraph 141 of the Complaint.

142. Defendants deny the allegations set forth in Paragraph 142 of the Complaint.

143. Defendants admit that Yondr seeks a judgment in its favor and various forms of relief. Defendants deny Yondr is entitled to such judgment or relief and deny the remaining allegations set forth in Paragraph 143 of the Complaint.

COUNT VI
Trade Libel Under Texas Common Law

144. Defendants restate and incorporate by reference each of their responses to the allegations set forth in Paragraphs 1 through 143 of the Complaint as if fully set forth herein.

145. Defendants deny the allegations set forth in Paragraph 145 of the Complaint.

146. Defendants deny the allegations set forth in Paragraph 146 of the Complaint.

147. Defendants deny the allegations set forth in Paragraph 147 of the Complaint.

148. Defendants deny the allegations set forth in Paragraph 148 of the Complaint.

149. Defendants admit that Yondr seeks a judgment in its favor and various forms of relief. Defendants deny Yondr is entitled to such judgment or relief and deny the remaining allegations set forth in Paragraph 149 of the Complaint.

COUNT VII
Common Law Unfair Competition Under Texas Law

150. Defendants restate and incorporate by reference each of their responses to the allegations set forth in Paragraphs 1 through 149 of the Complaint as if fully set forth herein.

151. Defendants deny the allegations set forth in Paragraph 151 of the Complaint.

152. Defendants admit Plaintiff sells products in the State of Texas. Defendants deny the remaining allegations set forth in Paragraph 152 of the Complaint.

153. Defendants deny the allegations set forth in Paragraph 153 of the Complaint.

154. Defendants deny the allegations set forth in Paragraph 154 of the Complaint.

155. Defendants deny the allegations set forth in Paragraph 155 of the Complaint.

156. Defendants admit that Yondr seeks a judgment in its favor and various forms of relief. Defendants deny Yondr is entitled to such judgment or relief and deny the remaining allegations set forth in Paragraph 132 of the Complaint.

Prayer for Relief

Defendants deny that Plaintiff is entitled to judgment or any of the relief sought in its Complaint.

Affirmative Defenses

Defendants assert the following affirmative defenses without assuming the burden of proof when such burden would otherwise be on Plaintiff.

First Affirmative Defense - Invalidity of the Asserted Patents

Plaintiff is barred from the relief it seeks for alleged infringement of the Asserted Patents because the claims of the Asserted Patents are invalid and unenforceable due to failing to meet one or more conditions for patentability set forth in 35 U.S.C. §§ 101 *et seq.*, including without limitation 35 U.S.C. §§ 101, 102, 103, and 112.

Contrary to 35 U.S.C. § 101, the claims of the '788 Patent and '078 Patent do not claim patentable subject matter. *See Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208 (2014). For example, the Patent Office issued the '788, at least in part, based on the claimed novelty of not being able to access a mobile electronic device until a predetermined condition is satisfied. Such an abstract idea lacks any inventive concept and, thus, is not patentable under 35 U.S.C. § 101.

Also, the claims of the '788 Patent and '078 Patent are anticipated or rendered obvious under 35 U.S.C. §§ 102 and 103 by prior art references such as U.S. Patent App. No. 13/011,356 to Stewart and U.S. Patent No. 9,928,387 to Simpson, among others.

In addition, the '788 Patent and '078 Patent fail to inform with reasonable certainty those skilled in the art of the scope of the invention contrary to 35 U.S.C. § 112. For example, claims 1 and 2 of the '788 Patent refer to unlocking the case when "the predetermined condition" is satisfied. ('788 Patent, Col. 10, lines 54-55 and 66-67.) There, however, is no antecedent basis for "the predetermined condition," rendering these

claims indefinite under 35 U.S.C. § 112.

For at least the foregoing reasons, the Asserted Patents are invalid and unenforceable.

Second Affirmative Defense - Patent Marking

To the extent Plaintiff or any of its licensees have failed to comply with the marking requirement of 35 U.S.C. § 287, Plaintiff cannot recover any damages for Defendants' alleged infringement prior to the date the Complaint was filed.

Third Affirmative Defense - Inequitable Conduct

On information and belief, the '045 Mark is unenforceable due to Plaintiff's inequitable conduct before the United States Patent and Trademark Office in the preparation and prosecution of the federal trademark application for the '045 Mark. To wit, Plaintiff, its attorneys, assigns, and others involved in the preparation and prosecution of the federal trademark application for the '045 Mark (referred to as "Yondr Applicants") failed to disclose to the examining attorney specific uses of the trademark in violation of 15 U.S.C. § 1064, or other applicable statutes, regulations, rules, or procedures.

Specifically, the Yondr Applicants failed to inform the examining attorney who was examining the application that led to registration of the '045 Mark that their design was the subject of a patent or patent application in response to a specific question posed by the examining attorney despite knowing Yondr's U.S. Patent No. 9,819,788 had issued, and U.S. Patent Application No. 16,813,437 was pending.

These facts establish, at least by inference, that the Yondr Applicants had specific intent to deceive the Trademark Office and cause the Trademark Office to wrongfully

register the '045 Mark.

Therefore, the Yondr Applicants engaged in a pattern of deceptive and otherwise improper conduct in connection with the prosecution of the '045 Mark which renders the '045 Mark unenforceable.

Fourth Affirmative Defense – Limitation on Damages

Plaintiff's claims for damages are statutorily limited or barred by 35 U.S.C. § 286. That is, Plaintiff cannot seek to recover damages for any infringement allegedly occurring more than six years before the date the Complaint was filed.

Fifth Affirmative Defense – No Damages

Plaintiff's claims are barred in whole or in part because it has suffered no damages under the claims asserted in the Complaint. As of the date of this Answer, Defendants' CellockED – Focus on Education YouTube video has only approximately 38 views, and including non-unique visitors and visits made by Plaintiff or its attorneys.

Sixth Affirmative Defense – Failure to State a Claim against Defendant Guerra

Plaintiff's claims against defendant Guerra are barred and should be dismissed pursuant to Federal Rule of Civil Procedure 12(b)(6) or 12(c) because Plaintiff has failed to state a claim upon which relief can be granted against Guerra. Guerra does not personally import, manufacture, offer for sale, or sell the accused CellockED product. Defendant Be Smarter offers for sale and sells the CellockED product. Be Smarter is a limited liability company organized and existing under Texas law. Plaintiff has not pleaded facts plausibly sufficient to "pierce the corporate veil," treat Guerra as the "alter ego" of Be Smarter, or otherwise hold Guerra personally liable for Be Smarter's alleged

infringement. Moreover, Plaintiff has not pleaded facts plausibly sufficient to hold Guerra vicariously liable for any infringement by defendant Be Smarter.

Jury Demand

Defendants request a trial by jury on all matters and issues properly tried to a jury pursuant to Federal Rules of Civil Procedure 38 and 39 and other applicable federal and state law.

Be Smarter's Counterclaims for Declaratory Judgment of Invalidity and Non-Infringement

Defendant/Counterclaim-Plaintiff Be Smarter, LLC ("Be Smarter") alleges the following counterclaims against Plaintiff/Counterclaim-Defendant Yondr, Inc. ("Yondr") pursuant to Federal Rule of Civil Procedure 13.

Nature of the Action

1. Be Smarter seeks declaratory judgment of non-infringement and invalidity of U.S. Patent Nos. 9, 819, 788 ("the '788 Patent") and 12,133,078 ("the '078 Patent") (collectively the "Asserted Patents") pursuant to the Patent Laws of the United States, 35 U.S.C. § 1, *et seq.*, damages, and such other relief as the Court deems just and proper.

2. Be Smarter also seeks declaratory judgment of non-infringement and invalidity of Federal Trademark Registration Number 6,995,045 ("the '045 Mark") pursuant to the Trademark Laws of the United States, 15 U.S.C. § 1064 and 15 U.S.C. § 1119. Accordingly, Be Smarter requests the Court enter an order cancelling the '045 Mark and award Be Smarter damages, and such other relief as the Court deems just and proper.

3. Be Smarter seeks this relief because Yondr has accused Be Smarter of infringing the Asserted Patents and the '045 Mark, which has placed a cloud over Be Smarter and its cell-phone pouch, CellockED, business. Be Smarter believe Yondr's allegations lack merit and thus ask this Court to declare the legal rights of Be Smarter so that Be Smarter is afforded relief from the uncertainty and delay regarding its rights caused by Yondr's allegations against Be Smarter.

Parties

4. Be Smarter is a limited liability company organized and existing under the laws of Texas with its principal place of business at 605 E. University Ave. Ste. 101, Georgetown, Texas.

5. Yondr, Inc. is a corporation organized and existing under the laws of the state of Delaware, with its principal place of business at 12503 Venice Boulevard, Los Angeles, California.

Jurisdiction and Venue

6. This action arises under the Patent Laws of the United States, Title 35 of the United States Code (35 U.S.C. § 1 *et seq.*), the Trademark Laws of the United States, Title 15 of the United States Code (15 U.S.C. §§ 1064, 1119, and 1121(a)), the Federal Declaratory Judgment act (28 U.S.C. §§ 2201 and 2202), and Texas common law.

7. This Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. § 1331 (federal question), 28 U.S.C. § 1338(a) (actions arising under an Act of Congress relating to patents or trademarks), 15 U.S.C. § 1121(a) (action arising under an Act of Congress related to trademarks), and 28 U.S.C. § 1367(a) (supplemental

jurisdiction over other claims so related to claims in the action within the Court's original jurisdiction that they form part of the same case or controversy).

8. This Court has personal jurisdiction over Yondr because it submitted itself to the jurisdiction of this Court by filing its Complaint (Dkt. 1).

9. Venue is proper over Yondr because it has conceded to venue in this District by way of its Complaint (Dkt. 1).

The Asserted Patents

10. The '788 Patent lists Graham Dugoni as inventor, is entitled "System and Apparatus for Selectively Limiting User Control of an Electronic Device," and issued on or about November 14, 2017. The application for the '788 Patent was filed on or about April 21, 2015.

11. On information and belief, the '788 Patent is assigned to Yondr.

12. The '078 Patent lists Graham Dugoni as inventor, is entitled "System and Apparatus for Selectively Limiting User Control of an Electronic Device," and issued on or about October 29, 2024. The application for the '078 Patent was filed on or about March 14, 2024.

13. On information and belief, the '788 Patent is assigned to Yondr.

The '045 Mark

14. The '045 Mark lists Yondr as the owner, is of the international class 009, and has a registration date of March 7, 2023. The application for the '045 Mark was filed on or about December 13, 2021.

15. On information and belief, the '045 Mark is owned by Yondr.

Presence of an Actual Controversy

16. The presence of an actual controversy between the parties is at least in part shown by the filing of the Complaint by Yondr.

17. In its Complaint, Yondr alleges that Be Smarter's CellockED product infringes the Asserted Patents and the '045 Mark. (Dkt. 1.)

18. Thus, there is a substantial controversy of sufficient immediacy and relativity between Be Smarter and Yondr to warrant issuance of a declaratory judgment.

19. Be Smarter believes the infringement allegations as to the Asserted Patents lack merit and the Asserted Patents are invalid. Similarly, Be Smarter believes the infringement allegations as to the '045 Mark lack merit and that the '045 Mark is invalid or unenforceable. Therefore, Be Smarter seeks relief declaring the legal rights of Be Smarter - namely, that Be Smarter does not infringe any valid and enforceable claim of the Asserted Patents, that each asserted claim of the Asserted Patents is invalid, that Be Smarter does not infringe the '045 Mark, and that the '045 Mark is invalid or unenforceable. Without such declaration, Yondr's infringement allegations will continue to negatively impact Be Smarter's business at least with respect to its CellockED product. In general, Be Smarter's CellockED product is a significant component of Be Smarter's overall business, success, and market reputation. Accordingly, there is a substantial controversy of sufficient immediacy and reality between Be Smarter and Yondr to warrant issue of a declaratory judgment.

20. Be Smarter denies that it infringes any valid and enforceable claim of the Asserted Patents and further denies that any claim of the Asserted Patents is valid.

Additionally, Be Smarter denies that it infringes the '045 Mark and further denies that the '045 Mark is valid is enforceable.

Count I
Declaratory Judgment of Invalidity of U.S. Patent No. 9,819,788

21. The allegations set forth in Paragraphs 1 through 20 of Be Smarter's Counterclaims are incorporated by reference as if fully set forth herein.

22. As a result of the acts described in the foregoing Paragraphs, there exists an actual and justiciable controversy between Be Smarter and Yondr regarding the validity of the '788 Patent.

23. The claims of the '788 Patent are invalid for failure to meet the conditions for patentability or otherwise comply with the requirements of 35 U.S.C. § 101 *et seq.*, including but not limited to §§ 101, 102, 103, and 112.

24. For example, the asserted claims of the '788 Patent are invalid as anticipated or obvious in view of the prior art, including but not limited to U.S. Patent Application No. 13/011,356 to Stewart and U.S. Patent No. 9,928,387 to Simpson.

25. Contrary to 35 U.S.C. § 101, the claims of the '788 Patent do not claim patentable subject matter. *See Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208 (2014). For example, the Patent Office issued the '788, at least in part, based on the claimed novelty of not being able to access a mobile electronic device until a predetermined condition is satisfied. Such an abstract idea lacks any inventive concept and, thus, is not patentable under 35 U.S.C. § 101.

26. The '788 Patent fails to inform with reasonable certainty those skilled in the art of the scope of the invention contrary to 35 U.S.C. § 112. For example, claims 1 and 2

of the '788 Patent refer to unlocking the case when "the predetermined condition" is satisfied. ('788 Patent, Col. 10, lines 54-55 and 66-67.) There, however, is no antecedent basis for "the predetermined condition," rendering these claims indefinite under 35 U.S.C. § 112.

27. Therefore, a judicial declaration of invalidity is necessary and appropriate to resolve this controversy and prevent Yondr from continuing to allege validity of the '788 Patent.

Count II
Declaratory Judgment of Invalidity of U.S. Patent No. 12,133,078

28. The allegations set forth in Paragraphs 1 through 20 of Be Smarter's Counterclaims are incorporated by reference as if fully set forth herein.

29. As a result of the acts described in the foregoing Paragraphs, there exists an actual and justiciable controversy between Be Smarter and Yondr regarding the validity of the '078 Patent.

30. The claims of the '078 Patent are invalid for failure to meet the conditions for patentability or otherwise comply with the requirements of 35 U.S.C. § 101 *et seq.*, including but not limited to §§ 101, 102, 103, and 112.

31. For example, the asserted claims of the '078 Patent are invalid as anticipated or obvious in view of the prior art, including but not limited to U.S. Patent Application No. 13/011356 to Stewart and U.S. Patent No. 9,928,387 to Simpson.

32. Contrary to 35 U.S.C. § 101, the claims of the '078 Patent do not claim patentable subject matter. *See Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208 (2014). For example, the Patent Office issued the '078, at least in part, based on the claimed novelty

of not being able to access a mobile electronic device until a predetermined condition is satisfied. Such an abstract idea lacks any inventive concept and, thus, is not patentable under 35 U.S.C. § 101.

33. Therefore, a judicial declaration of invalidity is necessary and appropriate to resolve this controversy and prevent Yondr from continuing to allege validity of the '078 Patent.

Count III
Declaratory Judgment of Invalidity or Unenforceability
of Registered Trademark No. 6,995,045

34. The allegations set forth in Paragraphs 1 through 20 of Be Smarter's Counterclaims are incorporated by reference as if fully set forth herein.

35. As a result of the acts described in the foregoing Paragraphs, there exists an actual and justiciable controversy between Be Smarter and Yondr regarding the validity of the '045 Mark.

36. The '045 Mark is invalid or unenforceable due to inequitable conduct before the United States Trademark Office in the preparation and prosecution of the '045 Mark. To wit, Plaintiff, its attorneys, assigns, and others involved in the preparation and prosecution of the Asserted Patents and the '045 Mark (referred to as the "Yondr Applicants") failed to disclose to the examining attorney specific uses of the trademark in violation of 15 U.S.C. § 1064, and other applicable statutes, regulations, rules, or procedures.

37. The Yondr Applicants filed the application leading to registration of the '045 Mark on or about December 13, 2021.

38. At some point after December 13, 2021, and before registration of the '045 Mark, a trademark examining attorney required the Yondr Applicants to disclose whether their claimed design was the subject of a patent application.

39. U.S. Patent No. 9,819,788 issued on or about November 14, 2017. Yondr claims its "Yondr System" (as defined in Paragraph 2 of the Complaint (Dkt. 1)) embodies at least one claim of the '788 Patent.

40. The Yondr Applicants filed U.S. Patent Application No. 16,813,437 on or about March 9, 2020. On or about October 29, 2024, United States Patent No. 12, 133,074 issued from U.S. Patent Application No. 16,813,437. Yondr claims its "Yondr System" (as defined in Paragraph 2 of the Complaint (Dkt. 1)) embodies at least one claim of the '074 Patent.

41. The Yondr Applicants failed to inform the trademark examining attorney who was examining the application that led to registration of the '045 Mark that their purported trade dress was the subject of a patent or patent application in response to the specific question posed by the examining attorney despite knowing Yondr's U.S. Patent No. 9,819,788 had issued and U.S. Patent Application No. 16,813,437 was pending at that time.

42. These facts establish the Yondr Applicants had specific intent to deceive the Trademark Office and cause the Trademark Office to wrongfully register the '045 Mark.

43. Therefore, the Yondr Applicants purposely engaged in a pattern and practice of deception and otherwise improper conduct in connection with their prosecution of the '045 Mark which renders the '045 Mark unenforceable.

44. A judicial declaration of invalidity is necessary and appropriate to resolve this controversy and prevent Yondr from continuing to allege validity of the '045 Mark.

Count IV
Tortious Interference with Business Relations

45. The allegations set forth in Paragraphs 1 through 20 of Be Smarter's Counterclaims are incorporated by reference as if fully set forth herein.

46. As of September 2024, Be Smarter had reached agreements to sell its accused CellockED to a number of customers including the Denver Public Schools and the Taylor, Texas Independent School District ("Be Smarter's Customers"). Be Smarter reasonably expected to make considerable sales of its CellockED products to the Denver Public Schools and the Taylor, Texas Independent School District.

47. As of September 2024, Yondr was aware of Be Smarter's contract with Denver Public Schools. Yondr was aware of Be Smarter's business relationship with Denver Public Schools. As of September 2024, Yondr was aware of Be Smarter's contract with Taylor, Texas Independent School District. Yondr was aware of Be Smarter's business relationship with Taylor, Texas Independent School District.

48. Yondr alleges in its Complaint in this case that Be Smarter has "partnered" with its customers. (Dkt. 1 at ¶ 45.) Yonder alleges in its Complaint in this case that Be Smarter is profiting from its "partnerships" with its customers. (*Id.*) Therefore, Yondr cannot deny being aware of at least some of Be Smarter's customers for its accused CellockED product.

49. On Information and belief, on or about September 30, 2024, Yondr sent letters to Be Smarter's Customers accusing Be Smarter and its customers of infringing the

'788 Patent and threatening Be Smarter's customers with patent infringement litigation if they did not terminate their arrangements with Be Smarter.

50. A true and correct copy of Yondr's letter to the Taylor, Texas Independent School District dated September 30, 2024, is attached to these Counterclaims as Exhibit A.

51. A true and correct copy of Yondr's letter to the Denver Public Schools dated September 30, 2024, is attached to these Counterclaims as Exhibit B.

52. On or about October 29, 2024, Be Smarter wrote to Yondr explaining that its '788 Patent is invalid as anticipated or obvious in view of the prior art, including but not limited to U.S. Patent Application No. 13/011356 to Stewart and U.S. Patent No. 9,928,387 to Simpson. Yondr did not respond to or otherwise rebut that letter.

53. After receiving Be Smarter's October 29, 2024, letter, Yondr continued to correspond with Be Smarter's Customers, accusing such customers and Be Smarter of patent infringement. For example, on or about December 5, 2024, counsel for Yondr wrote to the Taylor, Texas Independent School District continuing to assert that Be Smarter's sales of its CellockED product infringes Yondr's patents. Yondr knowingly and intentionally continues to threaten Be Smarter's Customers with full knowledge that its patent are invalid for at least the reasons described in Be Smarter's letter dated October 29, 2024.

54. A true and correct copy of Yondr's email to Taylor, Texas Independent School District dated December 5, 2024, is attached to these Counterclaims as Exhibit C.

55. Yondr is knowingly and intentionally trying to interfere with Be Smarter's customer relationships.

56. As a direct result of Yondr's knowing and intentional tortious interference with Be Smarter's customer relationships, Denver Public Schools terminated its contract with Be Smarter.

57. Be Smarter has lost actual sales and suffered actual damage as the proximate result of Yondr's tortious interference with the foregoing business relationships.

Prayer for Relief

WHEREFORE, Be Smarter prays that the Court enter judgment in favor of Be Smarter against Plaintiff on these Counterclaims, granting the following relief pursuant to 28 U.S.C. 2201 and 2202, 35 U.S.C. 285, and any other applicable law, rule, or inherent power of the Court:

- a. dismissal of all of Yondr's claims against Be Smarter in this action with prejudice;
- b. a declaration that all asserted claims of the '788 Patent are invalid;
- c. a declaration that all asserted claims of the '078 Patent are invalid;
- d. a declaration that the '045 Mark is invalid or unenforceable;
- e. cancellation of the '045 Mark;
- f. all lost profits and other damages resulting from Yondr's tortious interference with Be Smarter's business relationships;
- g. exemplary or punitive damages for Yondr's intentional tortious actions;
- h. reasonable attorneys' fees;

- i. court costs; and
- j. all other relief the Court deems fair and equitable.

Jury Demand

Counterclaim-Plaintiff Be Smarter requests a trial by jury on all matters and issues properly tried to a jury pursuant to Federal Rules of Civil Procedure 38 and 39 and other applicable federal and state law.

Dated: December 13, 2024

Respectfully submitted,

/s/ Arthur Gollwitzer III

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Certificate of Service

I, Arthur Gollwitzer III, an attorney of record in this matter, hereby certify that on December 13, 2024, I electronically filed the following document:

**Defendants' Answer and Affirmative Defenses, and Counterclaims
in Response to Yondr, Inc.'s Complaint**

with the Clerk of the United States District Court for the Western District of Texas, Austin Division, using the CM/ECF system, which will send notification and a copy of this filing to the following counsel of record:

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By: /s/ Arthur Gollwitzer III
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