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

YONDR, INC. Plaintiff, v. BE SMARTER, LLC and JAMES GUERRA., Defendants.	Case No. 1:24-cv-01326-ADA Judge Alan D. Albright DEMAND FOR JURY TRIAL

BE SMARTER, LLC and JAMES GUERRA., Counterclaim Plaintiffs. v. YONDR, INC. Counterclaim Defendant,

YONDR, INC.'S RESPONSIVE CLAIM CONSTRUCTION BRIEF

TABLE OF CONTENTS

Page No.

TABLE OF AUTHORITIES

Page No(s).

CASE LAW

TABLE OF AUTHORITIES
(*cont'd*)

Page No(s).

TABLE OF AUTHORITIES
(*cont'd*)

Page No(s).

OTHER AUTHORITIES

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. ('788 Patent, 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 with them, but the venue could choose conditions for unlocking the case and restoring access. Dugoni protected his inventions, in part, with the Asserted Patents, U.S. Patent Nos. 9,819,788 ('788 Patent) (Ex. A) and 12,133,078 ('078 Patent) (Ex. B). The Asserted Patents share a specification.

Dugoni started Yondr out of his van and created the phone-free space industry. Yondr is now the leader in helping schools and other venues reduce distractions from cell phones and create phone-free spaces, resulting in better educational outcomes and more-present experiences. Yondr's commercial product (left) is similar to the embodiment illustrated in the Asserted Patents (center). Defendants' CellockED product (right) copies Yondr's design.

Yondr Pouch
Complaint at 8.

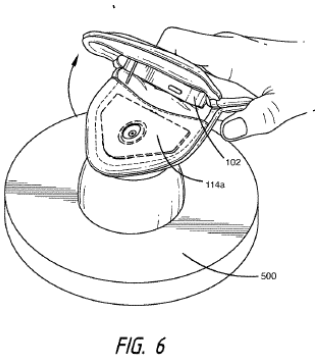

FIG. 6

'788 Patent at Fig. 6.

Defendants' CellockED product
Complaint at 14.

II. ARGUMENT

Defendants' claim constructions all repeat the same error. Instead of applying the claims' plain meanings consistent with the specification, Defendants rewrite the claims to limit them to just one embodiment. Defendants' construction arbitrarily excludes other disclosed embodiments, violates the claim language's plain meaning, and contradicts the specification. Yondr's constructions apply the claims as written, consistent with the specification. The Court should adopt Yondr's constructions.

A. Person of Ordinary Skill in the Art ("POSITA")

The Asserted Patents involve a primarily mechanical device, specifically "locking cases." ('078 Patent, 1:33-38). The specification focuses on that case design, with some embodiments also using, *e.g.*, RFID tags, to further that mechanical design. (*Id.*, 5:58-8:3, Figs. 1-6). Given the patents' 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 when determining level of skill). Indeed, Defendants' expert has degrees in ***mechanical*** engineering. (Ex. 3 at 6-7). Defendants' definition of a POSITA is, thus, incorrect. (*See* Dkt. 44 at 6; Smith Decl. ¶19). Instead, a POSITA would have an undergraduate degree in mechanical engineering, industrial design, or a related field. (Smith Decl. ¶19).

B. Means-Plus-Function Terms

Defendants' Proposed Construction	Yondr's Proposed Construction
"a locking means for at least partially securing the opening"	
Function: at least partially securing the opening so that the user is unable to access his own mobile electronic device contained therein until a predetermined condition is met **Structure**: opposing plates with securably mateable female and male members, magnetic plates, selectively releasable mesh, or lockable zippers	**Function**: at least partially securing the opening **Structure**: securely mateable male and female members, opposing plates with securely mateable male and female members, magnetic plates, selectively releasable mesh, a lockable zipper, or a key-operated latch, and equivalents Thereof
"means for unlocking"	
Function: unlocking the case **Structure**: electronic signal transmitter	**Function**: unlocking the case **Structure**: a key, a magnet, or an electronic article surveillance (EAS) detacher, and equivalents thereof

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 Court determines the claimed function. *Id*. Second, the Court identifies the corresponding structure in the written description that performs that function. *Id*. The Federal Circuit "has repeatedly held that it 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 the Opening" ('788 Patent Claim 3)

The parties agree that the "locking means" term is in means-plus-function format. For step one, identifying the function, Yondr identifies the function exactly as recited in the plain language of the claim: "at least partially securing the opening" ('788 Patent, cl. 3). Defendants agree with that function, but gratuitously add an "additional functional requirement": "so that the user is unable to access his own mobile electronic device contained therein until a predetermined condition is met." (Dkt. 44 at 7). That extra requirement, however, is part of a different limitation and clause, which recites 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." ('788 Patent, cl. 3). Thus, it should not be appended to this limitation. Defendants further assert the function requires "third-party intervention." (Dkt. 44 at 8). The claim, however, only requires "at least partially securing the opening," and does not mention "third-party intervention." Defendants' "function" is thus wrong because it conflicts with the claim's plain language and deviates from the claimed function. *Creo Prods.*, 305 F.3d at 1346.

Defendants' unsupported functional requirements also conflict with the specification, which explains that a user ***may*** participate in meeting a predetermined condition. One "predetermined condition[]," involving a "manual, key-operated latch" that is "locked or unlocked by venue staff," is "requiring the user … to locate venue staff …." ('788 Patent, 6:39-51). Another "predetermined condition," involving a magnetic detacher placed at a specific location such as a "venue exit," is that the user must go to a specific location (*e.g.*, the exit) before they can unlock the case. (*Id.*, 7:1-8). Yet another example of a "predetermined condition," involving a signal that covers part of the venue, is requiring a user to exit the area covered by the signal to unlock the case. (*Id.*, 7:26-39). The specification thus confirms that even Defendants' "function," which

incorporates a "predetermined condition," does not require third-party intervention. (*Id.*, 7:1-8, 7:26-39).

For the second step, the parties agree 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." (Dkt. 44 at 7; '788 Patent, 6:25-33, Figs. 1-6, cls. 4-5). Yondr's construction also includes a "key-operated latch." ('788 Patent, 6:25-29, 6:42-44). The specification explains "a key-operated latch" is a structure "for selectively limiting user control of an electronic device." (*Id.*, 6:42-51). It prevents user access until a predetermined condition is met, for example where the "predetermined condition" is "requiring the user of the electronic device 102 to locate venue staff … in possession of the key." (*Id.*). Accordingly, a key-operated latch is disclosed as a structure that performs the function.

Defendants argue that the key-operated latch "structure does not satisfy the functional requirements" of securing "without third-party intervention because it would allow the user to unlock the case at will." (Dkt. 44 at 8). But this argument relies on Defendants' erroneous function. Moreover, a user cannot simply "unlock the case at will" with the key-operated latch structure. Instead, in one embodiment, the key-operated latch structure prevents user access because the case is "manually locked or unlocked by venue staff" and can only be opened after a predetermined condition is met. ('788 Patent, 6:45-50; *see also* Dkt. 44 at 12 (acknowledging manual unlocking that "requires third-party assistance"), 16). Defendants' attorney argument and expert declaration are litigation inspired positions that contradict the claim and specification, and thus have little probative value. *Phillips*, 415 F.3d at 1318-19 (evidence "generated at the time of and for the purpose of litigation … can suffer from bias that is not present in intrinsic evidence").

The specification also discloses "opposing plates" with "one of a securably mateable female … and male … member," with the female/male members used "to effect locking." ('788 Patent, 6:25-29, 2:54-58, 6:25-29, Fig. 4, cl. 4; *see also id.*, 6:56-58 ("mating portions of the locking means")). Accordingly, a POSITA would have also understood that the female/male member structure, including as part of opposing plates, at least partially secures the opening.

Defendants cite statements in the specification discussing making the device "inaccessible" or "non-disengageable by the user." (Dkt. 44 at 7-8 (citing '788 Patent, 2:58-67, 6:25-38, 6:52-58)). But importing a function from the specification into the claims is improper. *In re Teles AG Informationstechnologien*, 747 F.3d 1357, 1367 (Fed. Cir. 2014) (claimed function need not "match" every "function disclosed in the specification"). Regardless, as discussed, the specification discloses structures, including "a key-operated latch," that prevent user access until a predetermined condition is met. Defendants' omissions of such structures are incorrect.

2. "Means for Unlocking the Case" ('788 Patent Claim 3)

The parties agree that "means for unlocking the case" is in means-plus-function format. For the first step of identifying the function, Yondr applies the claim's plain language, which identifies the function "unlocking the case." That function is all the claim requires. Defendants agree that the function includes "unlocking the case." (Dkt. 44 at 9). But Defendants then depart from their proposed function and argue the function also "requires that unlocking is not within the user's control until a predetermined condition is met." (*Id.* (citing '788 Patent, 7:9-29)). Defendants' new functional requirements are not recited in this limitation ("means for unlocking the case") and "predetermined condition" is a requirement for the case (*Supra* §II.B.1). Accordingly, the function set out by the claim's plain language is "unlocking the case."

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.*, '788 Patent, 6:39-7:3, Figs. 5-6). Yondr includes "a key" within its construction because the specification expressly discloses "a key" to perform the corresponding function of unlocking the case. (*Id.*, 6:39-51 (case is "unlocked by venue staff … in possession of such a key")). 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.*).

Defendants concede that the specification "expressly identifies" a key but argue that "embodiment does not satisfy the functional requirements of the claims as it allows user-controlled unlocking." (Dkt. 44 at 10). Defendants similarly argue that "a construction that allows the user to unlock his or her own device" conflicts with the specification. (*Id.*). That argument improperly imports functional requirements from the specification into the claims. *Teles*, 747 F.3d at 1367. Regardless, a key can meet the separate requirement that the case be "locked so that the user is unable to access his own mobile electronic device contained therein until a predetermined condition is met." ('788 Patent, cl. 3). A key should be included as a corresponding structure.

The specification also discloses a detacher, and specifically a magnet, is a "means for unlocking the case." (*Id.*, 6:52-7:3, Figs. 5-6). Thus, a magnet is a structure disclosed to perform the claimed function of "unlocking the case." (*Id.*) The specification similarly discloses "an electronic article surveillance (EAS) detacher" to perform the corresponding function. (*Id.*). Thus, an electronic article surveillance (EAS) detacher, including a magnet, is sufficient structure to perform the corresponding function of unlocking the case. Defendants argue a detacher or magnet fails "to meet the claim's requirement that unlocking is contingent on a predetermined condition, not unilateral user action." (Dkt. 44 at 10). Defendants again (*supra* §II.B.1) rely on improperly importing additional functional requirements from the specification. *Teles*, 747 F.3d at 1367.

Nowhere does the claim limit itself to prohibiting the user from personally accessing the detacher upon leaving the venue or the like. Regardless, the specification makes clear that a "detacher or magnet" can unlock the case after a predetermined condition is met, *e.g.*, requiring a user exit the venue. ('788 Patent, 7:1-8). A magnet or detacher are corresponding structure.

Much of Defendants' error comes from focusing on a single embodiment that uses an electronic signal transmitter. (Dkt. 44 at 10). Defendants assert that an electronic signal transmitter is the only structure where unlocking is completely outside of the user's control until a predetermined condition is met. (*Id.* at 9 (citing '788 Patent, 7:9-29)). That structure could play a role in unlocking the case ('788 Patent, 7:9-29), but independent claim 3 is not limited to an "electronic signal transmitter." Instead, dependent claims 5 and 6 require "remote" or "wireless" control, suggesting that claim 3 is not so limited. (*Id.*, cls. 5-6); *InterDigital Comms., LLC v. ITC*, 690 F.3d 1318, 1324-25 (Fed. Cir. 2012). A transmitter could be ***an example*** of corresponding structure, but it is ***not the only*** sufficient corresponding structure.

Accordingly, Yondr correctly identifies the corresponding structure, including, "a key, a magnet, and an electronic article surveillance (EAS) detacher."

C. "Configured to Unlock to Enable Access to the Mobile Device [Based on/in Accordance with] a Predetermined Condition" ('078 Patent Claims 1, 9)

Defendants' Proposed Construction	Yondr's Proposed Construction
Programmed to unlock the case remotely, such as via RFID or other wireless instructions, upon satisfying a predetermined condition (as defined)	Plain and ordinary meaning

The "configured to unlock" limitation appears in the '078 Patent, the second patent at issue. The '078 Patent claims require a lock with a particular configuration, that at least partially prevents access to a mobile device inside the cavity. ('078 Patent, cl. 1; *see also id.*, cls. 9, 15). The claims further require the lock be configured so that it can unlock "to enable access to the mobile device based on a predetermined condition." (*Id.*). For example, claim 1 recites:

> a lock positioned proximate to the opening of the shell, the lock configured to render the mobile device at least partially inaccessible upon the lock being locked with the mobile device within the cavity of the shell, the ***lock further configured to unlock to enable access to the mobile device based on a predetermined condition*** associated with a geographic region.

The claims' plain language is easily understandable and needs no further construction. Indeed, the specification uses the same type of language to describe the invention as the claims and provides examples. The specification explains that the lock on a case is "configured to disengage to provide the user with access" to the device "under certain circumstances." (*Id.*, 2:60-64; *see also id.*, 3:7-22 (discussing example configurations)). One example of a lock configured to unlock to enable access to a mobile device based on a predetermined condition involves a detacher placed at a specific location within the venue, *e.g.*, outside of the "viewing area or even at venue exit ways." (*Id.*, 6:64-7:4). The lock is thus configured "to become unsecured and further exposes the mobile electronic device … within the case" after the predetermined condition of the user going to that location and touching the case to the detacher. (*Id.*, 6:61-7:4; *see also id.*, Figs. 1-6). Another example involves a signal that covers part of the venue; when the user meets the predetermined condition of exiting the geographic region, the lock becomes unsecured and access to the device is restored. (*Id.*, 7:23-36; *see also id.*, 7:5-16, Fig. 7). These examples, and the disclosure overall, confirm "configured to unlock" needs no further construction.

Defendants' proposed construction is a transparent attempt to change the claim's plain requirement for a lock further "***configured*** to unlock" into a lock further "***programmed*** to unlock." (Dkt. 44 at 11 & n.1). Defendants argue that unlocking must be done "remotely, such as via RFID or other wireless instructions." (*Id.* at 11). But no intrinsic evidence suggests a clear and unmistakable intent to restrict the claims to just a "programmed" lock. *Thorner v. Sony Comput. Ent. Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012); *Hill-Rom Servs., Inc. v. Stryker Corp.*, 755 F.3d 1367, 1372-73 (Fed. Cir. 2014).

Indeed, the independent claims mention neither programming nor wireless unlocking. Instead, dependent claims 7, 13, and 18 further limit the claims to a microprocessor for receiving wireless signals to "unlock"/"disengage" and dependent claims 6, 12, and 17 further limit the claims to an "RFID tag" that enables unlocking/disengages the locking. ('078 Patent, cls. 6-7, 12-13, 17-18). Claim differentiation strongly supports construing the independent claims as broader than such programmed wireless or RFID locks. *InterDigital Comms.*, 690 F.3d at 1324-25. "[C]laim differentiation is at its strongest" where, as here, "'the limitation that is sought to be 'read into' an independent claim already appears in a dependent claim.'" *Id*.

Defendants argue the claim language "contemplates unlocking the pouch based on external triggers or signals … not mere manual intervention." (Dkt. 44 at 11 (citing '078 Patent, cls. 1, 6-7, 8, 10, 12-13, 17-19)). The claims do not mention "external triggers" or "manual intervention." Defendants cite the specification's examples involving automatic unlocking, but concede that they rely on only "[c]ertain disclosed embodiments," while discarding others. (*See id.*, at 11-12). Because the claims' plain language is broader, it is improper to limit the claims to just the embodiment from the specification that automatically unlocks. *Cont'l Circuits LLC v. Intel Corp.*, 915 F.3d 788, 797 (Fed. Cir. 2019) (claims not limited "[e]ven when the specification describes only a single embodiment"); *Thorner*, 669 F.3d at 1365.

The specification provides multiple other examples of locks configured to unlock to enable access to a mobile device based on a predetermined condition associated with a geographic region that do not require programing, wireless signals, or automatic action. ('078 Patent, 2:65-3:10, 6:40-47, 6:64-7:4, 6:59-63). The specification discloses a lock configured so when the user leaves the geographic region of the venue, a staff member may manually unlock the case and restore access. (*Id.*, 2:65-3:10, 6:35-47). The specification also discloses a predetermined condition not

requiring staff intervention, with a user "locating an EAS detacher" at a specific location, such as outside the "audience viewing area or even at venue exit ways." (*Id.*, 6:64-7:4). This predetermined condition is based on the user being in a specific geographic area with the unlocker, but includes manual unlocking by the user, for example as illustrated in Figures 5-6. (*See id.*, 6:59-63 (case "touched to" detacher to "become unsecured")). Defendants improperly exclude such embodiments, in contravention to the claims' plain language. *Cont'l Circuits*, 915 F.3d at 797; *Thorner*, 669 F.3d at 1365.

Defendants' cited authority provides no support for their claim reimagination. Defendants suggest *Aspex Eyewear* held that "configured to" means "making something for a particular purpose." (Dkt. 44 at 13). But *Aspex* involved a different term, "adapted to." *Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.*, 672 F.3d 1335, 1349-50 (Fed. Cir. 2012). *Aspex* discussed "configured to" "in context" of other patents and claim language. *Id.* at 1349. Defendants also cite *Wanker v. United States*, 152 Fed. Cl. 219 (2021). In *Wanker*, the Court gave "configured to" its plain and ordinary meaning, which the court noted was "made to" or "designed to." *Id.* at 253-54. Because the patent in *Wanker* was related to "computer implemented technology," "configured to" could mean "programmed to." *See Wanker*, 152 Fed. Cl. at 253. In the context of ***this*** claim and ***this*** disclosure, involving a primarily mechanical invention, with specification examples of mechanical locks and unlockers, "configured to" does not require electronic programming.

Finally, Defendants suggest that Yondr's construction attempts "to broaden this claim language … to support its theory of infringement …." (Dkt. 44 at 12-13). But Yondr seeks only the claims' plain meaning, consistent with the specification, which is not limited to electronically programmed locks. ('078 Patent, 2:65-3:10, 6:40-47, 6:64-7:4, 6:59-63). Nor is broadening needed. As shown above, Defendants' product copies the Yondr design illustrated in Figures 1-6.

Defendants seem to be projecting their own attempt to artificially narrow the claim to just the Figure 7 embodiment to manufacture a non-infringement argument. (*Id.*, Fig. 7, 7:10-42). Indeed, Defendants devote much of their brief to thinly veiled invalidity arguments, none of which support their narrowing construction. (Dkt. 44 at 1, 3-4, 8, 17-18). *See Warner Mfg. Co. v. Armstrong*, 504 F. Supp. 2d 589, 591 (D. Minn. 2007) ("Markman hearings are for claim construction alone. Noninfringement is never relevant to claim construction. Invalidity is sometimes relevant, but only when two constructions are equally plausible."). Surely, if Defendants genuinely believed the ordinary meaning led to the claim being invalid, Defendants would not be so desperately trying to narrow the claim to one specific figure.

Accordingly, these terms should be given their plain and ordinary meaning. The Court should reject Defendants' request to limit "configured to" to being "programmed to." The Court should give "configured to" its ordinary meaning, which is not limited to electronic programming. If the court wishes to provide alternative words, the common interpretation is "designed to" or "made to." *See, e.g.*, *Rex Med. v. Intuitive Surgical, Inc.*, 2020 WL2128795, at *5 (D. Del. May 5, 2020) (designed, constructed or set up to); *see also Aspex Eyewear*, 672 F.3d at 1349.

D. "Predetermined Condition" Terms

Defendants' Proposed Construction	Yondr's Proposed Construction
"Predetermined condition"	
A specific pre-established requirement that must be satisfied before a user can regain access to his or her mobile electronic device/mobile device	Plain and ordinary meaning
"Until a predetermined condition is met" "[Based on/In accordance with] a predetermined condition"	
The lock is programmed to unlock if a predetermined condition (as defined above) is met	Plain and ordinary meaning

1. "Predetermined Condition" ('788 Patent Claims 3, 7-8; '078 Patent Claims 1-2, 9-10, 15, 19)

The claims reference a "predetermined condition," a term which has a plain meaning that needs no further construction. The specification uses the term "predetermined condition" repeatedly and consistent with its plain meaning to describe various different embodiments. ('078 Patent, 2:65-3:22 (collecting examples), 6:35-47, 6:61-7:4, Figs. 1-6, 7:23-36, 7:5-16, Fig. 7). Defendants' construction replaces two readily understood words with twenty-two, needlessly complicating what was already clear. This is improper and unnecessary. *O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1362 (Fed. Cir. 2008) ("[D]istrict courts are not (and should not be) required to construe every limitation"); *see also Astute Tech., LLC v. Learners Digest Int'l LLC*, 2014 WL 1385191, at *17 (E.D. Tex. Apr. 2, 2014) ("the Court is not convinced that Plaintiff's construction is more helpful to the jury as opposed to the plain meaning").

Defendants argue their construction "is consistent with Dugoni's goals" because "the user only regains control over his or her phone upon satisfying a preestablished requirement." (Dkt. 44 at 14). But, as claimed and disclosed, it is the combination of limitations and not any single one that provides the benefits of the invention. *See Pause Tech., LLC v. TiVo Inc.*, 419 F.3d 1326, 1331 (Fed. Cir. 2005) (claim construction "demands interpretation of the entire claim in context, not a single element in isolation"). Other limitations already address this functionality, such as "the case operative to become locked so that the user is unable to access his own mobile electronic device contained therein," "a locking means for at least partially securing the opening," and the like. (*See, e.g.*, '788 Patent, cl. 3; '078 Patent, cls. 1, 9, 15). Defendants' construction of "predetermined condition" would render these or parts of these other limitations superfluous, "contrary to the well-established rule that 'claims are interpreted with an eye toward giving effect

to all terms in the claim.'" *Digital-Vending Servs. v. Univ. of Phoenix, Inc.*, 672 F.3d 1270, 1275 (Fed. Cir. 2012).

Defendants argue "'predetermined condition' was essential to the Patent Office allowing the '078 Patent" (Dkt. 44 at 14 (citing Ex. 5 at 78, 80-82, 84, 87-88)), and conclude "'predetermined condition' must mean something more than was claimed in [the prior art]." (*Id.* at 15 (citing Ex. 5 at 152)). Defendants' own citations, however, show that the Examiner cited the prior art as allegedly disclosing a "lock … configured to unlock to enable access to the mobile device in accordance with a predetermined condition." (Ex. 5 at 84 (cited by Dkt. 44 at 14)). It was, at least, the relation of the predetermined condition to a time period or geographic region that distinguished the pending claims. (*Id.* at 87, 148-151). But there was no clear and unequivocal disclaimer to change the claims' plain meaning. *Thorner*, 669 F.3d at 1365; *Symantec Corp. v. Comput. Assocs., Int'l, Inc.*, 522 F.3d 1279, 1289 (Fed. Cir. 2008). Thus, the claimed combination led to patentability, and not any alleged disclaimer of scope for a "predetermined condition."

Indeed, despite seeking review of '788 Patent claim 3 in their Petition for IPR (Ex. 4 at 8-9), Defendants did not seek a claim construction of "predetermined condition" in that forum. (*Id.* at 19-24). Instead, Defendants and their expert readily applied the term's plain and ordinary meaning. (Ex. 3 at 38-54, 76-79, 85-87; Ex. 4 at 47-49, 54-55, 65-66). Applying different constructions in different forums is unfair to the patentee. *Music Choice v. Stringray Digital Grp.*, 2019 WL 8110069, at *4 (E.D. Tex. Nov. 19, 2019) (explaining, "allowing [Defendant] to argue under one position during PTAB proceedings … and then argue a contradictory position in this Court … would be unfair to [Plaintiff]").

Thus, "predetermined condition" should be given its plain meaning.

2. "Until a Predetermined Condition Is Met"/"Based on a Predetermined Condition"/"In Accordance with a Predetermined Condition" ('788 Patent Claims 3; '078 Patent Claims 1, 9, 15)

In addition to "predetermined condition" alone, Defendants also seek a construction of that term within some of the surrounding claim language. The plain meaning of these limitations, read in context, is that the case is operative to become locked until a predetermined condition is met ('788 claim 1), the lock is configured to unlock to enable access "based on" or "in accordance with" a predetermined condition, ('078 Patent claims 1, 9) or the lock is configured to secure the opening "until a predetermined condition is met" ('078 Patent claim 15). The claims of the '078 Patent further specify the predetermined condition is "associated with a geographic[al] region" (claims 1, 9) or "associated with a physical presence of the case being outside of a defined geographical region" (claim 15). As discussed, the specification uses that plain meaning when providing different example lock and case configurations that unlock based on specific predetermined conditions. ('078 Patent, 2:65-3:22 (collecting examples), 6:35-47, 6:61-7:4, Figs. 1-6, 7:23-36, 7:5-16, Fig. 7). An example of this is simply the phone user being at the exit of the phone free space (such as a classroom or other phone free space venues). Accordingly, no further construction is needed.

Defendants, however, bootstrap their erroneous "configured to" (*supra* §II.C) construction to argue that these claims require a programable lock (Dkt. 44 at 15). Defendants assert the specification "supports" their construction, and suggest "Dugoni describes how the lock is programmed to unlock only when such condition is met." (*Id*. at 16). Defendants also argue their proposed construction should be read with their "predetermined condition" construction (*id.* at 13) replacing the easily understood claim language with another unwieldy and unhelpful twenty-two word definition. *O2 Micro*, 521 F.3d at 1362; *Astute Tech.*, 2014 WL 1385191, at *17. Defendants further assert that "the case is not merely configured to unlock, it is configured to unlock only

when the condition is met." (Dkt. 44 at 15). But the claim language stands on its own and recites locking/rendering inaccessible only until the predetermined condition is met, or based on/in accordance when the predetermined condition is met. (*See, e.g.*, '788 Patent, cl. 3; '078 Patent, cl. 1). That language requires no further construction and does not limit the inventions to just automated, computer-based implementations, as Defendants argue. (Dkt. 44 at 15-16).

As explained above, the specification confirms the plain language and includes multiple examples of predetermined conditions that must be met before unlocking, some of which are manual mechanical unlockers. (*Supra* §II.B.1). Defendants also argue that the claims do not allow a user to "unilaterally open" the cellphone case. (Dkt. 44 at 16). But as discussed above, the specification discloses that a user can unilaterally decide to meet a predetermined condition by, *e.g.*, moving to a different position or moving to the venue's exit to use a detacher. ('078 Patent, 2:65-3:10, 6:35-47 (locating staff member), 6:61-7:4, Figs. 1-6, (touching detacher), 3:10-22, 7:23-36, 7:5-16, Fig. 7 (passing transmitter range)). These disclosed embodiments are entirely consistent with one of the goals of the invention, *e.g.*, reducing distractions at the event. ('788 Patent, 1:47-62). Defendants are wrong that the only "solution is a phone case that is ***programmed*** to open." (Dkt. 44 at 16-17) (emphasis added).

Defendants raise the specter of subject matter eligibility to defend their construction. Defendants' misplaced belief that these claims are computer-based explains their confusing attempt to apply § 101 to the claimed mechanical invention. Defendants' argument that the "patents are directed to nothing more than the abstract idea of a locking container" (Dkt. 44 at 17) shows the absurdity of their argument. A container is not abstract. The claims set out structural requirements of a physical object, such as an appropriately configured lock, case, shell, panels, edges, and cavity. (*See, e.g.*, '788 Patent, cl. 3; '078 Patent, cl. 1, Figs. 1-6). Nor could the claims

be carried out in a user's mind through mental steps. Users' ***inability*** to ***mentally*** limit their use of mobile devices is what necessitated Dugoni's ***physical*** invention. (*Supra* §I). The claims, embodied in physical pouches, are the antithesis of the type of computer-implemented processes held abstract under § 101. *Cf. Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208, 218 (2014) (computer-implemented intermediated settlement, *e.g.*, escrow). And even assuming that the claims were directed to an abstract idea (they are not), there is an added inventive concept, as demonstrated by the extensive use of Yondr's physical product in the marketplace and Defendants' copying. Section 101 does not support Defendants' construction that transmutes these structural claims into computer-based ones by adding the requirement the case be "programmed."

Thus, these terms should be given their plain and ordinary meaning.

E. "A Predetermined Condition Associated with a Geographic Region" ('078 Patent Claims 1, 9, 15)

Defendants' Proposed Construction	Yondr's Proposed Construction
Indefinite	Plain and ordinary meaning

The '078 Patent claim 1 includes the limitation that the "lock is further configured to unlock to enable access to the mobile device based on a predetermined condition associated with a geographic region." ('078 Patent cls. 1, 9). Claim 15 has a similar limitation: "the predetermined condition being associated with a physical presence of the case being outside of a defined geographical region." (*Id.*, cl. 15). The claims' plain meaning is that the predetermined condition is associated with a location, or for claim 15 the presence of the case outside of a defined location. This is not confusing or ambiguous. The specification explains various examples implementing predetermined conditions, which are associated with a geographic region, such as a detacher at an exit or a transmitter that covers a certain area in a venue. ('078 Patent, 6:57-7:4; 2:66-3:5, 2:65-3:10, 6:38-47; *see also id.*, 3:11-22, 7:10-20, 7:26-36, cls. 2, 10, 19). These examples all confirm

the claims and specification use that plain meaning. (Smith Decl. ¶¶27-32). And a geographic position is just that – a location. (*See* Dkt. 44 at 4 (parties agreeing on meaning of "geographic area of a venue"). Either term is equally plain. Accordingly, no further construction is required.

Defendants argue that "associated with" is indefinite. (*Id.* at 18-20). But Defendants ignore the specification's guidance, including examples of the "predetermined condition[s] associated with a geographic region," including: (1) a case that must be touched to a detacher or unlocked by venue staff ***at an exit*** ('078 Patent, 6:57-7:4; 2:66-3:5, 2:65-3:10, 6:35-47; Smith Decl. ¶¶27-28); (2) a case that must exceed the range of a transmitter ('078 Patent, 3:11-22, 7:10-20; Smith Decl. ¶29); (3) a case that unlocks ***in a certain room within a venue*** ('078 Patent, 7:26-36; Smith Decl. ¶30); and (4) a case that unlocks ***outside of a given location*** ('078 Patent, 7:5-9; Smith Decl. ¶31); as well as (5)-(8) the combination of all of these with the passage of time (*id.*, cls. 2, 10, 19). Each of these examples of predetermined conditions for unlocking the case is "associated with" a geographic region, for example, a detacher or person placed ***at*** a geographic region or ***at*** a ***particular place*** within a geographic region, ***exceeding*** the ***range*** of a transmitter located at a geographic region, or a particular ***room***, or ***outside*** of a geographic region. (Smith Decl. ¶¶27-32).

Defendants do not identify any real ambiguity in the claims, nor do they address the specification's many examples. "[S]pecific and unequivocal examples," such as the ones provided in the specification, can "provide a skilled artisan with clear notice of what is claimed." *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1261 (Fed. Cir. 2014). This is because a skilled artisan would be informed by the specification's examples and use them to resolve any alleged ambiguity in the claim language. *See BASF Corp. v. Johnson Matthey Inc.*, 875 F.3d 1360, 1367-68 (Fed. Cir. 2017) (reversing indefiniteness because a "skilled artisan would be informed by the

specification's numerous examples of qualifying compositions"); *see also Kinetic Concepts, Inc. v. Blue Sky Med. Grp., Inc.*, 554 F.3d 1010, 1022 (Fed. Cir. 2009). Defendants are incorrect that the patents do not explain "what 'associated with' means" (Dkt. 44 at 18) and "the … intrinsic record shed[s] no light on how 'associated with' is different from simply being outside of a geographic location" (*id.* at 19; Smith Decl. ¶32).

Defendants argue that "the phrase 'associated with a geographic [geographical] region' does not appear anywhere in the specification." (*Id.* at 19). But *in haec verba* support is not the indefiniteness standard. *Presidio Components, Inc. v. Am. Tech. Ceramics Corp.*, 875 F.3d 1369, 1376 (Fed. Cir. 2017) (quoting *Dow Chem. Co. v. Nova Chem. Corp.*, 809 F.3d 1223, 1225 (Fed. Cir. 2015) (concurrence)) ("[I]f a skilled person would choose an established method of measurement, that may be sufficient to defeat a claim of indefiniteness, even if that method is not set forth *in haec verba* in the patent itself."); *Williamson v. Google*, 2017 WL, at *12 (N.D. Cal. July 27, 2017) ("[T]here is no authority, and [Defendant] has provided none, requiring that the recited word or phrase must appear in the specification as a condition for definiteness.").

Defendants argue that two district court cases support their positions. Both are easily distinguished. (Dkt. 44 at 19). *Checkpoint Sys., Inc. v. Hangshou Century Co., Ltd.*, 2014 WL 4930686 (N.D. Ohio Oct. 1, 2014) involved patent claims to an otherwise unlimited and undefined "first structure." *Id.* at *4. Because that structure was not defined in the specification, and conflicting disclosures made "first structure" "not amenable to construction," it was held indefinite. *Id*. at *5-6. Likewise, *Kaavo Inc. v. Amazon.com Inc*., 2018 WL 3025040 (D. Del. June 18, 2018) involved a claim requiring the use of a "needs analysis algorithm," which had no plain meaning. *Id*. at *3. The specification in *Kaavo* disclosed no corresponding algorithm, and, instead, identified potentially conflicting functional results. *Id*. Accordingly, the Court concluded

the term was indefinite. *Id.* Unlike *Checkpoint* and *Kaavo*, "associated with a geographic region" read in context has a plain meaning, which is confirmed by the specification's multiple examples. The attempt to complicate the simple concept about the location of the pouch reveals Defendants' desperate stretch.

Finally, Defendants present a convoluted claim differentiation argument, asserting "associated with a geographic region must mean something different" than "physical presence outside of a defined geographical area." (Dkt. 44 at 18-19). For this position, Defendants seem to abandon indefiniteness in favor of obviousness type double patenting. (*Id.*). Defendants insinuate that Yondr promised to, but did not, submit a terminal disclaimer during prosecution. (*Id.* at 20 n.2). This argument misreads the prosecution history: Yondr ***traversed*** the double patenting rejection, and the Examiner ***withdrew*** it. (Ex. 5 at 152, 162). As discussed above, if anything, claim differentiation cuts against Defendants. (*Supra* §II.D.1; Smith Decl. ¶¶33-36).

Defendants' indefiniteness position is based on attorney argument and unsupported by the intrinsic record and expert testimony. Based on several specific examples in the specification, a POSITA would understand the plain meaning of the terms and be reasonably certain of their scope.

III. CONCLUSION

Yondr's constructions apply the claims' plain language and reflect the patents' disclosure and examples. Defendants' claim constructions deviate from the claims' plain language and instead attempt to limit the claims to a single embodiment. Because Defendants sell a product that copies the embodiment in Figures 1-6, they improperly try to narrow the claims to just the embodiment in Figure 7. But nothing in the intrinsic record demonstrates a clear intent, via lexicography or disclaimer, to deviate from the claims' plain meaning, much less in the way Defendants propose. Accordingly, the Court should adopt Yondr's constructions for all terms.

June 27, 2025

Respectfully submitted,

By: */s/ Jeremiah S. Helm*

Jeremiah S. Helm (*Pro Hac Vice*)
CA Bar No. 254395
Stephen C. Jensen (*Pro Hac Vice*)
CA Bar No. 149894
Rhett D. Ramsey (*Pro Hac Vice*)
CA Bar No. 348077
KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 Main St., 14th Floor
Irvine, CA 92614
949-760-0404
Fax:949-760-9502
jererniah.helm@knobbe.com
2scj@knobbe.com
rhett.ramsey@knobbe.com

Ben K. Shiroma (*Pro Hac Vice*)
CA Bar No. 329415
KNOBBE, MARTENS, OLSON & BEAR, LLP
1925 Century Park E #400
Los Angeles, CA 90067
310-551-3450
Fax:310-601-1263
ben.shiroma@knobbe.com

Robert Pierce Earle
TX Bar No. 24124566
Stephen Burbank
TX Bar No. 24109672
SCOTT DOUGLASS & MCCONNICO LLP
303 Colorado Street, Suite 2400
Austin, TX 78701
(512) 495-6300
Fax: (512) 474-0731
rearle@scottdoug.com
sburbank@scottdoug.com

Counsel for Plaintiff and Counterclaim Defendant Yondr, Inc.

CERTIFICATE OF SERVICE

Pursuant to the Federal Rules of Civil Procedure and Local Rule CV-5, I hereby certify that on June 27, 2025, I caused the foregoing document to be electronically transmitted to the Clerk of the Court using the CM/ECF system for filing and transmittal of a Notice of Electronic Filing to participants and law firms who are registered CM/ECF users, whom will be served by the CM/ECF system.

/s/ *Jeremiah S. Helm*
Jeremiah S. Helm (*Pro Hac Vice*)