

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

SECURE WI-FI LLC,
Patent Owner.

IPR2024-01368
Patent 9,961,552 B2

Before CHRISTOPHER L. OGDEN, FREDERICK C. LANEY, and
MARY C. HOFFMAN, *Administrative Patent Judges*.

OGDEN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, “Petitioner”) filed a Petition (Paper 1, “Pet.”) under 35 U.S.C. §§ 311–319 requesting *inter partes* review of claims 1–9 of U.S. Patent No. 9,961,552 B2 (Ex. 1001, “the ’552 patent”). Secure Wi-Fi LLC (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”).¹ With our authorization, Petitioner also filed a Preliminary Reply (Paper 8, “Prelim. Reply”) and Patent Owner filed a Preliminary Sur-reply (Paper 9, “Prelim. Sur-reply”).

Under the authority delegated to us by the Director of the U.S. Patent and Trademark Office under 37 C.F.R. § 42.4(a), we may only institute an *inter partes* review when “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a); *see also* 37 C.F.R. § 42.108(c). However, institution of *inter partes* review is discretionary. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”). For the reasons below, we exercise our discretion not to institute an *inter partes* review.

¹ The parties identify themselves as the real parties in interest. Pet. 1; Paper 5, 2.

II. BACKGROUND

A. THE '552 PATENT (EX. 1001)

The '552 patent describes schemes for connecting to a wireless network, and specifically “security for Wi-Fi wireless access technologies.” Ex. 1001, code (54), 1:27–28.

As was previously known in the art, when an end device, such as a cell phone, tries to locate wireless access points in a wireless local area network (“WLAN”), it would broadcast “probe request” signals to wireless access points near the end device. Ex. 1001, 3:4–12. These probe requests would include a device identifier and the end device’s media access control (MAC) address. *Id.* According to the '552 patent, this presented the drawback that “present location information of the end device may be exposed to some access points with which a user of the end device does not want to be connected and/or other devices to which the end device does not want to disclose the present location information.” *Id.* at 3:12–18.

As a proposed solution to this, the '552 patent discloses that probe requests may contain a fake device identifier for the end device, such as a fake MAC address. Ex. 1001, 3:19–22, 3:65–67. In response to these faked probe requests, each access points transmits a probe response that includes information about the access point such as its MAC address or service set identifier (SSID). *Id.* at 3:22–28. If the access point is an “authenticated access point,” the end point “may transmit a connection request including an authentic device identifier for the end device, such as an original MAC address, to the authenticated access point,” thus avoiding leakage of the end point’s present location information to undesirable access points. *Id.* at 3:32–39.

This connection process is shown in more detail in the flowchart of Figure 3, reproduced below:

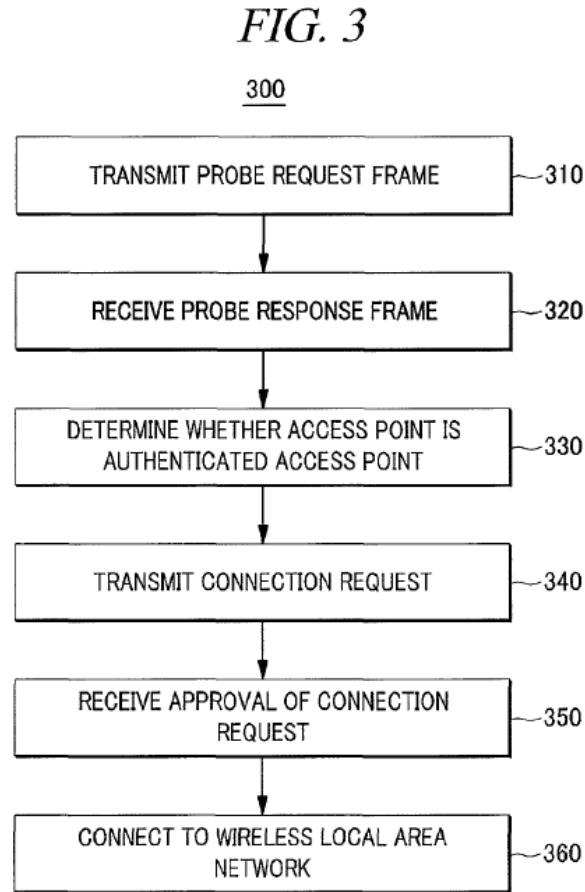


Figure 3 depicts a process by which an end device connects to a WLAN through an access point. Ex. 1001, 2:31–34, 4:66–5:2. At step 310, the end device transmits a probe request frame including a fake end-device identifier to an access point. *Id.* at 5:12–18. At step 320, the end device receives a probe response frame from the access point including information regarding the access point (e.g., a MAC address or SSID). *Id.* at 5:19–26. At step 330, the end device determines whether the access point is an authenticated access point “based at least in part on the information regarding [the] access point . . . included in the probe response frame.” *Id.* at 5:27–37. It may do so by “check[ing] whether the information regarding [the] access point . . . is

included in [the] authenticated access point list.” *Id.* at 5:38–45. At remaining steps 340, 350, and 360, the end device transmits a connection request, receives approval, and connects to the WLAN. *Id.* at 5:38–55.

B. CHALLENGED CLAIMS AND GROUNDS

Representative claim 1 is as follows:

1. A method performed by a server, the method comprising:
 - [a] transmitting, by the server to a device, an authenticated access point list that includes at least one of a media access control (MAC) address or a service set identifier (SSID) of each of one or more authenticated access points, wherein the one or more authenticated access points are controlled by the server; and
 - [b] transmitting, by the server to the device, a fake device identifier, wherein the fake device identifier includes at least one of one or more random numbers or one or more random characters to falsely identify the device in a probe request frame in a search for at least one of the one or more authenticated access points around the device.

Ex. 1001, 10:60–11:7 (Petitioner’s limitation labels added). Claim 4, the other challenged independent claim, is as follows:

4. A method performed by an access point, the method comprising:
 - [a] receiving, by the access point from a device, a probe request frame that includes a fake device identifier for the device, wherein the fake device identifier is received at the device from a server, and wherein the fake device identifier includes at least one of one or more random numbers or one or more random characters;
 - [b] transmitting, by the access point to the device, a probe response frame that includes information regarding the access point;

- [c] receiving, by the access point from the device in response to the transmitting the probe response frame, a connection request that includes an authentic device identifier for the device, wherein the receiving the connection request includes receiving the connection request in response to an authentication of the access point based on an authenticated point list received at the device from the server, and wherein the authenticated point list includes information that indicates that the access point is an authenticated access point; and
- [d] transmitting, by the access point to the device in response to the receiving the connection request, an approval of the connection request, wherein the access point is controlled by the server.

Ex. 1001, 11:13–38 (Petitioner’s limitation labels added).

Petitioner asserts a single ground for *inter partes* review, as summarized in the following table:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–9	103(a) ²	Vardi, ³ IEEE802.11, ⁴ Orava, ⁵ Yun ⁶

Pet. 16.

² 35 U.S.C. §§ 103 (2006), *amended by* Leahy–Smith America Invents Act (“AIA”), Pub. L. No. 112-29 §§ 102, 103, sec. (n)(1), 125 Stat. 284, 287, 293 (2011) (effective Mar. 16, 2013). Petitioner relies on the pre-AIA statutes, and Patent Owner does not contest this. *See* Pet. 5; Prelim. Resp.

³ Vardi et al., US 8,126,476 B2 (issued Feb. 28, 2012) (Ex. 1007).

⁴ IEEE Computer Society, *Part 11: Wireless LAN Medium Access Control (MAC) and Physical Layer (PHY) Specifications*, IEEE Std 802.11 (Mar. 29, 2012) (Ex. 1009).

⁵ Orava et al., US 2003/0177267 A1 (published Sept. 18, 2003) (Ex. 1005).

⁶ Yun et al., WO 2007/086705 A1 (published Aug. 2, 2007) (Ex. 1004).

C. DECLARATORY TESTIMONY

Petitioner submits a declaration by Dr. Harry v. Bims. Ex. 1002.
Patent Owner does not submit expert rebuttal testimony.

D. RELATED PROCEEDINGS

As related matters, the parties identify the following district court proceeding: *Secure Wi-Fi LLC v. Samsung Elecs. Co.*, No. 2:24-cv-00047 (E.D. Tex. filed Oct. 19, 2023). Pet. 1; Paper 5, 2. We refer to this case as the “parallel district court proceeding.”

The parties also identify *Samsung Elecs. Co. v. Secure Wi-Fi LLC*, IPR2024-01369 (PTAB Sept. 4, 2024) as a related PTAB proceeding. Pet. 1; Paper 5, 2.

III. DISCRETIONARY DENIAL: MULTIPLE PETITIONS

Petitioner filed two contemporaneous petitions challenging the ’552 patent, the other one being IPR2024-01369 which challenges claims 10–28. *See* Pet. 67.

Patent Owner argues that Petitioner failed to justify the filing of two petitions challenging the same patent, and has not provided a ranking of the petitions or explained the differences between the two petitions. Prelim. Resp. 42 (citing Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), <https://www.uspto.gov/TrialPracticeGuideConsolidated> (“Trial Practice Guide”)).

Petitioner responds that its “ranking and explanation was at least implicitly included in the Petition.” Prelim. Reply 4. According to Petitioner, the IPR2024-01369 petition “covers all of the claims identified in Patent

Owner’s Infringement Contentions” in the parallel district court proceeding. *Id.* at 4–5. Thus, the present Petition “ranks second, because it covers claims that have not been asserted against Petitioner in the [parallel district court proceeding].” *Id.* at 5. Petitioner also notes that the claims asserted in this proceeding “focus on the perspective of a server or access point,” whereas the claims in IPR2024-01369 are from the perspective of an end device. *Id.*

Patent Owner responds that it has not demonstrated that this is one of the “rare” circumstances in which we would institute on two petitions challenging the same patent. Prelim. Sur-reply 3–4 (citing Trial Practice Guide 59). Patent Owner also argues that Petitioner asserts the same prior art in both cases, and the claims do not represent distinct inventions because during examination the Examiner did not issue a restriction requirement. *Id.* at 4.

As we discuss below, we deny institution based on the *Fintiv* factors. Thus, we need not decide whether it was appropriate for Petitioner to file the present Petition in addition to its first-ranked petition in IPR2024-01369.

IV. DISCRETIONARY DENIAL: *FINTIV*

In light of the parallel district court proceedings, Patent Owner argues that the Board should deny institution under 35 U.S.C. § 314(a). Prelim. Resp. 42–44 (citing *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential)).

Institution of an *inter partes* review is discretionary. *See Harmonic v. Avid Tech.*, 815 F.3d at 1367; *see also* 35 U.S.C. § 314(a). The Board has held that the advanced state of a parallel district court action is a factor weighing in favor of denying a petition under § 314(a). *See NHK Spring Co.*,

Ltd. v. Intri-Plex Techs. Inc., IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (precedential); Trial Practice Guide 58 & n.2.

In *Fintiv*, the Board explained that “cases addressing earlier trial dates as a basis for denial under *NHK* have sought to balance considerations such as system efficiency, fairness, and patent quality.” *Fintiv*, Paper 11 at 5.

Fintiv sets forth six non-exclusive factors for determining “whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Id.* at 6.

These factors consider the following:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

Id. at 5–6. In evaluating these factors, we “take[] a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.* at 6.⁷

⁷ We note that the “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” (June 21, 2022) issued by former Director Kathi Vidal of the U.S. Patent and Trademark

We address each of the above *Fintiv* factors below, and as we explain, we agree with Patent Owner that these factors do not favor institution of *inter partes* review.

A. *FINTIV* FACTOR 1: WHETHER THE COURT GRANTED A STAY OR EVIDENCE EXISTS THAT ONE MAY BE GRANTED IF A PROCEEDING IS INSTITUTED

Petitioner argues that the first *Fintiv* factor is neutral or weighs slightly in favor of institution because none of the claims in this proceeding are at issue in the parallel district court proceeding, and the presiding judge in that forum has previously granted a stay under similar circumstances. Pet. 65 (citing *Commc 'ns Techs., Inc. v. Samsung Elecs. Am., Inc.*, No. 2:21-cv-00444, 2023 WL 1478447 (E.D. Tex. Feb. 2, 2023)).

Patent Owner argues that the first factor weighs against institution because Petitioner's request for a stay has already been denied without prejudice. Prelim. Resp. 44–45. According to Patent Owner, at least one panel of the Board has held that such a denial weighs against institution even if the motion to stay can be renewed, and in any event, a motion to stay would be unlikely given the progress thus far in the case and the proximity of the scheduled trial date. *Id.* (citing *Samsung Elecs. Co. v. Clear Imaging Research*, IPR2020-01401, Paper 12 at 11 (PTAB Feb. 17, 2001)); see also Prelim. Sur-reply 4–5 (reiterating the arguments).

Office (“Vidal Memo”) has been rescinded and is no longer in force. See *USPTO Rescinds Memorandum Addressing Discretionary Denial Procedures* (Feb. 28, 2025), <https://www.uspto.gov/about-us/news-updates/uspto-rescinds-memorandum-addressing-discretionary-denial-procedures>.

Petitioner replies that it is not unusual for courts to deny motions to stay without prejudice, and this district court “invites parties to file early motions to stay because the [district court] awards weight to the timing of the moving party’s initial motion to stay making the renewed post-institution stay more likely to be granted.” Prelim. Reply 5–6 (citing *Solas OLED Ltd. v. Samsung Display Co.*, No. 2:19-cv-00152, 2020 WL 4040716, at *2 (E.D. Tex. Mar. 17, 2020)).

In the parallel district court litigation, the presiding judge simply denied without prejudice Petitioner’s motion to stay and indicated that Petitioner may refile the motion following PTAB’s institution decision. Ex. 2001, 2. The district court offered no indication of whether a subsequent request for a stay is likely to be granted or denied. *See id.* This order is unlike the order denying the original motion in *Clear Imaging* where, although the court allowed the petitioner to renew its request for a stay, the order “specifically stated [the court’s view] that a stay will unduly prejudice Patent Owner, and [that t]he late stage of the current case also disfavors a stay.” IPR2020-01401, Paper 12 at 10 (internal quotation omitted).

Thus, we decline to speculate on whether the district court might rule on a renewed motion to stay that has not been filed. On this record, we agree with Petitioner that the first factor is neutral. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12 (PTAB May 13, 2020) (informative) (“We decline to infer . . . how the District Court would rule should a stay be requested by the parties in the parallel case here.”).

B. *FINTIV* FACTOR 2: PROXIMITY OF THE COURT’S TRIAL DATE TO THE BOARD’S PROJECTED STATUTORY DEADLINE FOR A FINAL WRITTEN DECISION

Petitioner argues that the second factor “weighs slightly in favor of denial” because, although trial in the parallel district court litigation is scheduled for November 3, 2025, “scheduled trial dates are unreliable and often change,” and therefore the trial date “is not by itself a good indicator of whether the district court will occur before the statutory deadline for a final written decision.” Pet. 65–66 (quoting Vidal Memo 8 (rescinded Feb. 28, 2025)).

Patent Owner agrees that the trial timeline favors discretionary denial, and notes that the scheduled trial date is “nearly five months before the Board’s final decision would be due,” a circumstance that has led many Board panels to deny institution. Prelim. Resp. 45–46 (citing PTAB cases). Patent Owner also argues that the median time-to-trial statistics also suggests that the case disposition would be well before our final written decision in this case. *Id.* at 46–47 (citing Vidal Memo 8–9 (rescinded)).

Based on the preliminary record, it is highly likely that issues bearing on the patentability of the challenged claims will be considered and resolved before we would issue a final written decision. Thus, we determine that the second factor weighs heavily in favor of discretionary denial of the Petition.

C. *FINTIV* FACTOR 3: INVESTMENT IN THE PARALLEL PROCEEDING BY THE COURT AND THE PARTIES

Petitioner argues that the third *Fintiv* factor weighs in favor of institution because the parallel district court proceeding “is in its early stages.” Pet. 66. According to Petitioner, “[t]he parties have only exchanged preliminary infringement and invalidity contentions and associated

document productions. Discovery is just beginning, and the parties are yet to file any dispositive motions, exchange terms or brief Markman, or even conduct expert discovery.” *Id.*

Patent Owner argues that the third factor weighs in favor of denial because, by the time we decide whether to institute trial, the parties in the parallel district court proceeding will have expended considerable resources, including on matters relating to the merits of Samsung’s invalidity position and claim construction. Prelim. Resp. 48–50; *see also* Prelim. Sur-reply 5.

Petitioner replies that opening claim construction briefs will not be due until after we decide whether to institute trial, and much work will remain to be done on the case at that time. Prelim. Reply 6.

Although there has been significant investment by the parties in the parallel district court proceeding, the parties still have much work to do and the district court has not yet issued any substantive orders. *See Fintiv*, IPR2020-00019, Paper 11 at 10 (“If, at the time of the institution decision, the district court has not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution . . .”). Thus, Factor 3 weighs against discretionary denial of the Petition.

D. FINTIV FACTOR 4: OVERLAP BETWEEN ISSUES RAISED IN THE PETITION AND IN THE PARALLEL PROCEEDING

Petitioner argues that there is no overlap between the claims challenged in this proceeding and the claims at issue in the parallel district court proceeding. Pet. 66. Petitioner also stipulates in its Petition that, “if [*inter partes* review] is instituted, Petitioners will not pursue in the Texas Litigation the same grounds asserted in this Petition.” *Id.* According to

Petitioner, this “mitigates to some degree the concerns of duplicative efforts,” and we should conclude that the fourth *Fintiv* factor weighs in favor of institution. *Id.* (citing *Sand Revolution II, LLC v. Continental Intermodal Group—Trucking LLC*, IPR2019-01393, Paper 24 at 12 (PTAB June 16, 2020) (informative)).

Patent Owner responds that the claims challenged in this proceeding overlap with Petitioner’s invalidity contentions in the parallel district court proceeding,⁸ and that Petitioner asserts the same prior-art references. Prelim. Resp. 50. Patent Owner also argues that Petitioner’s stipulation is narrow and “does not fully resolve concerns about overlap, duplicative efforts, and conflicting decisions.” *Id.* at 50–51. According to Patent Owner, that Petitioner might assert *additional* art in the parallel district court proceeding “does nothing to alter the degree of overlap between the Petition and [Petitioner’s] invalidity contentions.” *Id.* at 51–52. Thus, Patent Owner argues that the fourth *Fintiv* factor “weighs strongly in favor of denial of institution.” *Id.* at 52.

Although there appears to be no overlap between the claims challenged in this proceeding and those challenged in the parallel district court litigation, there will likely be at least some overlap in the issues, as Petitioner relies on a list of prior art that includes each of the references

⁸ This argument appears to be a clerical error. In making this argument, Patent Owner refers to the asserted claims in U.S. Patent No. 10,694,384, which is not the subject of this proceeding. *Compare* Prelim. Resp. 50 (alleging that Petitioner asserts “claims 1–4, 6–15, 17–20, and 22–24” in the parallel district court proceeding), *with* Ex. 2003, 1 (challenging the validity of claims 1–4, 6–15, 17–20, and 22–24 of U.S. Patent No. 10,694,384, but omitting any argument for claims 1–9 of the ’552 patent).

asserted in this proceeding. *See* Ex. 2003, 8–13. Also, although a stipulation such as Petitioner’s might “mitigate[] to some degree the concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions,” *Sand Revolution*, IPR2019-01393, Paper 24 at 12, it is not clear on the present record that Petitioner’s stipulation will meaningfully reduce the potential for overlap between the issues addressed in the two proceedings.

Because there is no overlap between the claims challenged in the two proceedings, we determine that the fourth *Fintiv* factor weighs against, but, for the reasons above, only slightly against, discretionary denial of the Petition.

E. *FINTIV* FACTOR 5: WHETHER THE PETITIONER AND THE
DEFENDANT IN THE PARALLEL PROCEEDING ARE THE SAME PARTY

It is uncontested that the parties in this proceeding are the same. Pet. 67; Prelim. Resp. 53. Petitioner argues that the fifth *Fintiv* factor “weighs slightly in favor of denial.” Pet. 67.

Based on the parties’ agreement on this issue, we weigh the factor as at least slightly in favor of discretionary denial. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020) (precedential as to Section II.A) (holding, in a case where the parties were the same in the two proceedings, that the fifth *Fintiv* factor “supports denying institution”). Our decision not to institute does not depend on the degree of weight we give this factor.

F. *FINTIV* FACTOR 6: OTHER CIRCUMSTANCES THAT IMPACT THE BOARD’S EXERCISE OF DISCRETION, INCLUDING THE MERITS

As explained in *Fintiv*, “if the merits of a ground raised in the petition seem particularly strong on the preliminary record, this fact has favored institution,” but “if the merits of the grounds raised in the petition are a closer call, then that fact has favored denying institution when other factors favoring denial are present.” *Fintiv*, IPR2020-00019, Paper 11 at 14–15. We do not, however, typically need to perform a full merits analysis to evaluate this factor. *Id.* at 15.

Petitioner argues that the sixth *Fintiv* factor “heavily weighs against denial because the merits [of its Petition] are so clear” in that “the key references disclose the sole alleged distinction between the admitted prior art and the claimed invention (fake identifier during probing).” Pet. 67.

Patent Owner argues that “the Petition presents no compelling case,” so we need not consider the sixth *Fintiv* factor. Prelim. Resp. 53–54 (citing *Fintiv*, IPR2020-00019, Paper 11 at 15).

Having considered the evidence and arguments presented by both parties, we do not find the merits to be particularly strong on the preliminary record.

A central disputed issue in this case is whether Vardi discloses or suggests limitations relating to an “authenticated access point list” as recited in independent claims 1 and 4. *See* Pet. 21–26; Prelim. Resp. 16–28; Prelim. Reply 1–4; Prelim. Sur-reply 1–3. Vardi describes “a server that includes a database storing data about various radio access points,” and clients who “receive updates about relevant access points from the server and use the information to connect to the preferred access point.” Ex. 1007, code (57).

The access-point database can include MAC and SSID information for each access point. *Id.* at 11:41–42.

Claim 1 recites a step of “transmitting, by [a] server . . . , an authenticated access point list that includes at least one of a media access control (MAC) address or a service set identifier (SSID) of each of one or more authenticated access points.” Ex. 1001, 10:62–66. Claim 4 recites “receiving . . . [a] connection request in response to an authentication of [an] access point based on an authenticated point list received at the device from the server, and wherein the authenticated point list includes information that indicates that the access point is an authenticated access point.” *Id.* at 11:25–34. According to Petitioner, Vardi’s access-point database from the server is an “authenticated access point list” because Vardi’s mobile client device compares its own stored list of information (i.e., the radio resource database) about access points with the information obtained about access points in its vicinity, based on a Wi-Fi scan. Pet. 25.

In response, Patent Owner argues that Petitioner failed to meet its burden in the Petition to explain “what it means for an access point to be ‘authenticated’ and whether that is disclosed within the proposed combination” including Vardi. Prelim. Resp. 21. Patent Owner contends that the term “authenticated” refers to “the process of verifying the identity of an entity, using known, trusted, and verifiable information, before granting access to a resource.” *Id.* (citing Exs. 2006–2009 (dictionary definitions)). But according to Patent Owner, Petitioner has not shown that Vardi discloses any process for verifying the identity of an access point because Vardi’s radio resource database includes unauthenticated third-party information. *Id.* at 22, 26; *see also id.* at 22–28 (arguing that Vardi’s system never

authenticates access points, but instead relies on a list of access points provided by unverified, untrusted users).

In its Preliminary Reply, Petitioner contends that in the parallel district court litigation, Patent Owner did not specify any action that an end device needs to do to authenticate an access point other than to “check[] its memory using the received SSID and other information to see whether the access point previously provided connectivity to the end device.” Prelim. Reply 2. According to Petitioner, Vardi’s end device performs this check and, “[i]n that sense, applying Patent Owner’s infringement-motivated interpretation, *Vardi* authenticates the access point before using it to provide connectivity to the user terminal.” *Id.* at 3–4.

In response, Patent Owner contends that Petitioner “do[es] not address the plain meaning of the limitation, do[es] not address how *Vardi* (or any other reference) satisfies the plain meaning of the limitation, and do[es] not point to any explanation in the Petition demonstrating the plain meaning limitation is satisfied by the cited reference.” Prelim. Sur-reply 1–2.

Based on the preliminary evidence, Petitioner has not shown that Vardi’s radio resource database from the server, which includes unauthenticated third-party information, teaches the claimed “authenticated access point list” transmitted by or received from the server. Petitioner has not cited to any evidence that a list including previously connected access points and unauthenticated third-party data constitutes the ordinary and customary meaning of the term “authenticated access point list.” To the extent that Petitioner is arguing that the term should be construed in a way that departs from its ordinary and customary meaning, Petitioner has not

pointed to evidence for such a departure in the intrinsic record, and we are aware of no such evidence.

We note that the '522 patent states, “[b]y way of example, but not limitation,” that an “authenticated access point may include . . . an access point previously connected with [the] end device.” Ex. 1001, 4:33–36. But this does not appear to suggest that a prior connection is sufficient to authenticate the access point in the context of the '552 patent.

Because we do not find the merits of the Petition particularly strong on the preliminary record, we find that the sixth *Fintiv* factor is neutral.

G. BALANCING THE *FINTIV* FACTORS

A holistic balancing of the *Fintiv* factors weighs in favor of discretionary denial of the Petition. As discussed above, factor 2 weighs heavily in favor of discretionary denial because the district court is likely to address patentability issues at trial before we would issue a final written decision. Factor 5 also weighs, at least to some degree, in favor of discretionary denial. Factors 1 and 6 are neutral. Factors 3 and 4 weigh against discretionary denial (factor 4 only slightly so), but these factors combined do not outweigh factor 2 under the circumstances of this case. Thus, the evidence of record favors exercising our discretion to deny institution of an *inter partes* review.

V. CONCLUSION

For the above reasons, we exercise our discretion under 35 U.S.C. § 314(a) to deny institution of an *inter partes* review challenging claims 1–9 of the '552 patent.

VI. ORDER

It is

ORDERED that the Petition is *denied*, and no trial is instituted.

IPR2024-01368
Patent 9,961,552 B2

For PETITIONER:

Walter Davis
Dipu Doshi
Jonathan England
Ameya Paradkar
BLANK ROME LLP
walter.davis@blankrome.com
dipu.doshi@blankrome.com
jwengland@blankrome.com
aparadkar@blankrome.com

For PATENT OWNER:

Jerry Tice
BUNSOW DE MORY LLP
jtice@bdiplaw.com