UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT 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

PETITIONER'S REQUEST FOR DIRECTOR REVIEW

TABLE OF CONTENTS

Page

I. Introduction 1

II. Legal Standard 3

III. Argument 4

A. Director Review Is Needed to Clarify Whether a Party Should Be Allowed to Respond to the Rescission of the Vidal Memo When the Party Did Not Receive Adequate Notice of the Retroactive Effect of the Rescission 4

1. Factor 1: Whether the particular case is one of first impression 6

2. Factor 2: Whether the new rule represents an abrupt departure from well-established practice or merely attempts to fill a void in an unsettled area of law 6

3. Factor 3: The extent to which the party against whom the new rule is applied relied on the former rule 7

4. Factors 4/5: (4) the degree of the burden which a retroactive order imposes on a party, and (5) the statutory interest in applying a new rule despite the reliance of a party on the old standard. 7

B. The Board Abused Its Discretion by Arbitrarily Finding That *Fintiv* Factor 2 Weighs Heavily in Favor of Denial 10

C. The Board Abused Its Discretion by Arbitrarily Finding That *Fintiv* Factor 4 Weighs Slightly Against Denial 12

D. The Board Abused Its Discretion by Conducting an Inadequate *Fintiv* Factor 6 Analysis 14

E. Properly Weighed and Balanced *Fintiv* Factors Weigh Against Denial 15

TABLE OF AUTHORITIES

Page(s)

Cases

Apple Inc. v. Fintiv, Inc.,
IPR2020-00019, Paper 15 (PTAB May 13, 2020) .....*passim*

Bentley Motors Ltd. v. Jaguar Land Rover Ltd.,
IPR2019-01539, Paper 9 (PTAB Mar. 10, 2020) 11

Bowen v. Georgetown Univ. Hosp.,
488 U.S. 204 (1988).....5

Cisco Sys., Inc. v. Croga Innovations Ltd.,
IPR2024-01282, Paper 7 (PTAB Feb. 13, 2025).....12, 13, 14

Commscope Techs. LLC v. Dali Wireless, Inc.,
IPR2024-01242, Paper 23 (PTAB Feb. 27, 2023).....14, 15

E-One, Inc. v. Oshkosh Corp.,
IPR2019-00161, Paper 16 (PTAB May 15, 2019) 11

eClinicalWorks, LLC v. Decapolis LLC,
IPR2022-00229, Paper 10 (PTAB Apr. 13, 2022) 10, 11

Ericsson Inc. v. Active Wireless Techs. LLC,
IPR2024-00886, Paper 8 (PTAB Nov. 12, 2024).....12

Immersion Sys. LLC v. Midas Green Techs., LLC,
PGR2021-00104, Paper 15 (PTAB Jan. 31, 2022).....11

Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.,
821 F.3d 1359 (Fed. Cir. 2016) 3

Landgraf v. USI Film Prods.,
511 U.S. 244 (1994).....5, 9

Nokia of Am. Corp. v. Alexander Soto and Walter Soto,
IPR2023-00680, Paper 30 (PTAB Dec. 3, 2024) 10

NXP USA, Inc. v. Impinj, Inc.,
PGR2022-00005, Paper 18 (PTAB May 2, 2022).....10, 11

Retail, Wholesale & Dep't Store Union v. NLRB,
466 F.2d 380 (D.C. Cir. 1972) 6

Samsung Display Co., Ltd. v. Pictiva Displays Int'l Ltd.,
IPR2024-01222, Paper 12 (PTAB Mar. 6, 2025) 12

Samsung Display Co., Ltd. v. Pictiva Displays Int'l Ltd.,
IPR2024-01223, Paper 11 (PTAB Mar. 6, 2025) 12

Samsung Elecs. Co., Ltd. v. Mojo Mobility Inc.,
IPR2023-01092, Paper 11 (PTAB Jan. 8, 2024) 11

Samsung Elecs. Co. Ltd. v. Headwater Rsch. LLC,
IPR2024-01396, Paper 13 (PTAB Apr. 1, 2025) 12

Samsung Elects. Co., Ltd. v. Sionyx, LLC,
IPR2024-01431, Paper 21 (PTAB Apr. 10, 2025) 10

Savant Techs. LLC v. FEIT Elec. Co., Inc.,
IPR2024-01357, Paper 17 (PTAB Mar. 5, 2025) 12

T-Mobile USA, Inc. v. Wireless All., LLC,
IPR2024-00607, Paper 16 (PTAB Sep. 10, 2024) 12

T-Mobile USA, Inc. v. Wireless All., LLC,
IPR2024-00608, Paper 16 (PTAB Sep. 3, 2024) 12, 13

TCL Elecs. Holdings Ltd. v. Univ. of Rochester,
IPR2024-01245, Paper 10 (PTAB Feb. 13, 2025) 12

Vector Flow, Inc. v. HID Glob. Corp.,
IPR2023-00353, Paper 11 (PTAB Aug. 10, 2023) 9

Vector Flow, Inc. v. HID Glob. Corp.,
IPR2023-00353, Paper 15 (PTAB Oct. 17, 2023) 15

Statutes

5 U.S.C. §551(4) 5

I. INTRODUCTION

Under the discretionary denial regime guided by Director Vidal's Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation dated June 21, 2022 ("Vidal memo"), Petitioner filed the current Petition on September 4, 2024. Due to the co-pending district court litigation (*see* Paper 1 at 1), Petitioner addressed the six *Fintiv* factors. *See id*. at 65-67. Patent Owner, in its Preliminary Response, asserted that discretionary denial was justified. Paper 7 at 44-55. Based on the issues and the applicable legal regime defined by the Vidal memo, the parties further exchanged Petitioner's Reply (Paper 8, filed January 30, 2025) and Patent Owner's Sur-Reply (Paper 9, filed February 5, 2025).

Only after pre-institution briefing had been completed, the USPTO rescinded the Vidal memo on February 28, 2025—less than a month before the March 26, 2025, deadline for an Institution Decision. The USPTO's terse statement announcing the rescission provided no indication that the rescission applied retroactively to all pending petitions. This was only clarified on March 24, 2025, by Chief Administrative Patent Judge Boalick's memorandum ("Boalick memo") outlining, among other things, that the recission applied retroactively to all pending post-issuance proceedings. On the very same day that the Boalick memo was released, the Board issued its Institution Decision ("ID") in this matter,

discretionarily denying institution under 35 U.S.C. § 314(a) based on an analysis of the *Fintiv* factors without the application of the guidance set forth in the Vidal memo. *See* Paper 10 at 9-10, n7.

Because the Boalick memo was issued on the same day as the ID, Petitioner did not have notice of the retroactivity of the rescission and did not have a fair opportunity to respond to that retroactivity. That lack of notice resulted in a violation of Petitioner's due process rights and runs counter to basic fairness. To remedy this injustice, Petitioner should be allowed to appropriately respond to the Boalick memo by being allowed to submit a *Sotera* stipulation.

Moreover, the Board abused its discretion with respect to the decisions it made regarding the *Fintiv* factors. First, the Board abused its discretion by arbitrarily finding that *Fintiv* factor 2 weighs heavily in favor of denial. *Inter alia*, the Board improperly allowed its view on *Fintiv* factor 4 to skew its view of factor 2.

Second, the Board abused its discretion by arbitrarily finding that *Fintiv* factor 4 weighs slightly against denial. Petitioner submitted a *Sand* stipulation, which even the Board acknowledges "is not without any meaning or weight." And *Sand* stipulations by themselves commonly lead to Board decisions that *Fintiv* factor 4 weighs marginally against denial. Here, there is no overlap between the challenged claims in this petition and the asserted claims in the parallel EDTX

action. This combination of a *Sand* stipulation and no overlap should have resulted in factor 4 weighing heavily against denial.

Third, the Board abused its discretion by conducting an inadequate *Fintiv* factor 6 analysis. Relevant legal authority mandates that the Board must provide, in support of its *Fintiv* factor 6 finding, reasoning sufficient enough to allow the parties to challenge that finding and sufficient to allow for review of the Board's decision. The Board here did not meet that standard.

II. LEGAL STANDARD

Director Review is appropriate when the FWD "present[s] (a) an abuse of discretion, (b) important issues of law or policy, (c) erroneous findings of material fact, or (d) erroneous conclusions of law." USPTO, Director Review process, §§ 2.B, 5.A. Abuse of discretion exists if the decision is 1) clearly unreasonable, arbitrary, or fanciful; 2) based on an erroneous conclusion of law; 3) rests on clearly erroneous fact finding; or 4) involves a record that contains no evidence on which the Board could rationally base its decision. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016). Petitioner's request satisfies at least criteria (a) and (b). We first address the issues of law and policy and then move on to the Board's abuse of discretion.

III. ARGUMENT

A. Director Review Is Needed to Clarify Whether a Party Should Be Allowed to Respond to the Rescission of the Vidal Memo When the Party Did Not Receive Adequate Notice of the Retroactive Effect of the Rescission

The ID presents an important issue of law or policy. That is, should a Petitioner be allowed to fully address the rescission of the Vidal memo, when the Petitioner did not receive notice that the rescission would be retroactive prior to the Institution Decision? The answer is a resounding yes.[1]

The February 28, 2025, notice rescinding the Vidal memo was a three-sentence USPTO website post that did not indicate for which cases the rescission would apply.[2] It was not until Chief APJ Boalick issued the Boalick memo on March 24, 2025, that the public was informed that the rescission would not only apply to petitions filed after February 28, 2025, but also would also apply retroactively to "any case in which the Board has not issued an institution decision, or where a request for rehearing or Director Review of an institution decision was filed and remains pending." Boalick memo at 2. The retroactive application was

[1] Patent Owner acknowledges that the Director denied Patent Owner's request to present new argument to address the Boalick memo. *See* EX3101. Nevertheless, Patent Owner respectfully proffers the argument to avoid waiver.
[2] Contrast that omission with the Vidal memo, which explicitly indicated that "[t]his interim guidance applies to all proceedings pending before the Office." Vidal memo at 9.

confirmed in the ID. Paper 10 at 9-10, n7. Because the Boalick memo was issued on the same day as the ID, Petitioner did not have notice of the retroactivity of the rescission and did not have a fair opportunity to respond to that retroactivity.[3]

As a general matter, "[r]etroactivity is not favored in the law." *Bowen v. Georgetown Univ. Hosp.*, 488 U.S. 204, 208 (1988). Motivated by the principles of due process and basic fairness, the Supreme Court has held that the Constitution requires that individuals "have an opportunity to know what the law is and to conform their conduct accordingly." *Landgraf v. USI Film Prods.*, 511 U.S. 244, 265 (1994). The D.C. Circuit, for example, applies a multi-factor test for determining whether retroactivity is appropriate when an agency changes the law:[4]

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[3] Indeed, the Acting Director herself suggests a much more reasonable position in the March 26, 2025, memo she issued entitled Interim Processes for PTAB Workload Management ("Stewart memo"). The Stewart memo, which is a memo detailing new processes for deciding discretionary denials, appears to recognize the importance of notice and gives parties time to adjust strategy by indicating that "[t]he processes described herein will be implemented in IPR and PGR proceedings where the deadline for the patent owner to file a preliminary response has not yet passed." Stewart memo at 3.

[4] Agency policy statements fall within the category of agency actions that are "rules" within the Administrative Procedure Act's definition, because they constitute "the whole or a part of an agency statement of general or particular applicability and future effect designed to implement, interpret, or describe law or policy." 5 U.S.C. §551(4); Agency Policy Statements | Administrative Conference of the United States (https://www.acus.gov/document/agency-policy-statements) ("Administrative Conference"). When an agency policy statement is treated by the agency as binding, it operates effectively as a legislative rule. Administrative Conference.

"(1) whether the particular case is one of first impression, (2) whether the new rule represents an abrupt departure from well established practice or merely attempts to fill a void in an unsettled area of law, (3) the extent to which the party against whom the new rule is applied relied on the former rule, (4) the degree of the burden which a retroactive order imposes on a party, and (5) the statutory interest in applying a new rule despite the reliance of a party on the old standard." *Retail, Wholesale & Dep't Store Union v. NLRB*, 466 F.2d 380, 390 (D.C. Cir. 1972).

Here, the factors weigh in favor of retroactivity not being appropriate.

1. Factor 1: Whether the particular case is one of first impression

This IPR was discretionarily denied institution the same day (March 24, 2025) the Chief APJ issued his memo indicating that the rescission of the Vidal memo would have retroactive effect. That is, this IPR, along with any other IPRs discretionarily denied institution on March 24, 2025, are the first possible cases with this issue. Accordingly, this particular case is one of first impression.

2. Factor 2: Whether the new rule represents an abrupt departure from well-established practice or merely attempts to fill a void in an unsettled area of law

The rescission of the Vidal memo "represents an abrupt departure from well established practice." The rescission materially alters how the PTAB analyzes the *Fintiv* factors, as compared to the well-settled and applied policy of the Vidal

memo. For example, for the two plus years the Vidal memo was in effect, the merits of a challenge alone were enough to avoid discretionary denial. That abruptly changed when the memo was rescinded on February 28, 2025, and when that rescission was subsequently applied retroactively on March 24, 2025.

3. Factor 3: The extent to which the party against whom the new rule is applied relied on the former rule

Petitioner reasonably relied on the standard set forth by the Vidal memo in its overall strategy. As one example in the IPR, *Sand* stipulations were routinely viewed as weighing marginally against discretionary denial while the Vidal memo was in place. *See* Section III.C. *infra*. Under the Vidal memo, given the amplified importance of the merits, which by themselves could prevent discretionary denial, *Sotera* stipulations were often not submitted. Had Petitioner known that the rescission retroactively applied to its case, Petitioner would have filed a *Sotera* stipulation to improve the odds of avoiding discretionary denial.

The reliance further extended to the district court litigation. In formulating its district court strategy, Petitioner relied on this standard in its decision to expend substantial resources in preparing and filing the present petition for IPR. These resources involved both a significant financial investment and the opportunity cost in time and effort to not pursue an alternative overall invalidity strategy.

4. Factors 4/5: (4) the degree of the burden which a retroactive order imposes on a party, and (5) the statutory interest in

applying a new rule despite the reliance of a party on the old standard.

The retroactive order here puts a significant burden on Petitioner. Knowing that the merits of the challenges by themselves are no longer enough would have been highly relevant and changed Petitioner's strategy and positions. *See, e.g.*, *supra* §III.A.3. By the time the USPTO publicly acknowledged the retroactivity of the Vidal memo with the issuance of the Boalick memo, it was already too late.

The Boalick memo recognized this burden by providing an opportunity to request additional briefing. Specifically, the Boalick memo provides that "[t]he Board will consider timely requests for additional briefing on the application of the Interim Procedure's recission on a case-by-case basis." Boalick memo at 2. As such, the harm to Petitioner of retroactive application is great.

Conversely, if the rescission of the Vidal memo is not applied retroactively, the impact of the Acting Director's rescission will not be felt until this fall. Certainly, that might frustrate the Acting Director's presumed goal that the effect of her policy be quickly felt. But the policy itself would not be significantly affected. IPR and PGR proceedings going forward would still no longer be subject to the Vidal memo, removing the memo's obstacles to discretionary denial.

That said, weighing the two interests is not even necessary, because there is a simple solution that protects Petitioner's interests while protecting the Acting

Director's new scheme: allow Petitioner to do what it would have done if it had proper notice of retroactivity. That is, accept Petitioner's now-submitted *Sotera* stipulation.[5] This type of remedial action was contemplated by the Boalick memo, which indicated that the Board "will consider timely requests for additional briefing on the application of the Interim Procedure's rescission on a case-by-case basis." Boalick memo at 2. Because Petitioner's *Sotera* stipulation would be before "the time for seeking Director Review or rehearing has passed," Petitioner's request would be timely under the timing set forth in the Boalick memo. *Id*. Indeed, the Director has in the past authorized a Petitioner to file a *Sotera* stipulation when Petitioner could not have addressed certain events, because they occurred after the Petition was filed. *Vector Flow, Inc. v. HID Glob. Corp.*, IPR2023-00353, Paper 11 at 7-8 (PTAB Aug. 10, 2023).

Not allowing Petitioner to submit a *Sotera* stipulation violates Petitioner's due process rights and runs counter to basic fairness by preventing Petitioner from having "an opportunity to know what the law is and to conform [its] conduct accordingly." *Landgraf*, 511 U.S. at 265. Petitioner respectfully requests allowance to respond to the Boalick memo by submitting a *Sotera* stipulation.

[5] If the Institution Decision is vacated and institution is subsequently granted, Petitioner stipulates that it will not raise in the parallel EDTX action any grounds that it raised in the IPR petition or that it reasonably could have raised.

B. The Board Abused Its Discretion by Arbitrarily Finding That *Fintiv* Factor 2 Weighs Heavily in Favor of Denial

The Board found that factor 2 weighs *heavily* in favor of denial, because the parallel litigation is likely to address the same validity issues relating to the '552 patent addressed in this proceeding about 5 months before a FWD. Paper 10 at 12. But similar time frames (e.g., FWD issued few months after trial) have often been found to weigh *marginally*, not heavily, in favor of denial. *See*, *e.g.*, *Samsung Elects. Co., Ltd. v. Sionyx, LLC*, IPR2024-01431, Paper 21 at 13-14 (PTAB Apr. 10, 2025) (finding an imminent ITC trial with an investigation completion date three months before the final written decision deadline only slightly favored discretionary denial); *see also Nokia of Am. Corp. v. Soto*, IPR2023-00680, Paper 30 at 11-12 (PTAB Dec. 3, 2024); *NXP USA, Inc. v. Impinj, Inc.*, PGR2022-00005, Paper 18 at 8-9 (PTAB May 2, 2022); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12-13 (PTAB May 13, 2020); *eClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper 10 at 9 (PTAB Apr. 13, 2022).[6] Such a big swing to "heavily" in favor is arbitrary.

[6] Note that each of PGR2022-00005, IPR2020-00019, and IPR2022-00229 were cited by Patent Owner as supporting Patent Owner's position that factor 2 weighs in favor of denial. The Board in these cases, however, only found factor 2 to weigh *slightly* in favor of denial. Moreover, IPR2023-00680 is a case in which Director Vidal was the one who weighed factor 2 as marginally in favor of denial.

Indeed, in the 7 cases cited by Patent Owner as purportedly supporting a finding of "heavily" in favor, the Board never found factor 2 to weigh *heavily* in favor of denial, and in 3 of those 7 the Board only found factor 2 to weigh *somewhat* in favor of denial. *See*, *e.g.*, *Samsung Elecs. Co., Ltd. v. Mojo Mobility Inc.*, IPR2023-01092, Paper 11 at 11-12 (PTAB Jan. 8, 2024); *Bentley Motors Ltd. v. Jaguar Land Rover Ltd.*, IPR2019-01539, Paper 9 at 14 (PTAB Mar. 10, 2020); *Immersion Sys. LLC v. Midas Green Techs., LLC*, PGR2021-00104, Paper 15 at 11 (PTAB Jan. 31, 2022); *NXP*, PGR2022-00005, Paper 18 at 8-9; *E-One, Inc. v. Oshkosh Corp.*, IPR2019-00161, Paper 16 at 6-9 (PTAB May 15, 2019); *Fintiv*, IPR2020-00019, Paper 15 at 12-13; *eClinicalWorks*, IPR2022-00229, Paper 10 at 9. None of these cases supports the Board's finding of "heavily" in favor of denial.

A critical reason for the Board finding that factor 2 weighs "heavily" is its belief that "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." Paper 10 at 12. Put another way, the Board pushes its weighing to "heavily" due to the overlap of issues raised in the petition and the parallel EDTX action. But that is not what needs to be weighed for factor 2. Rather, the degree of overlap is already accounted for in factor 4. It is inappropriate to account for that same overlap here to make factor 2 weigh "heavily" in favor. Even if it were appropriate to do so, Petitioner has submitted a *Sand* stipulation,

which the Board agrees is not without meaning or weight. Such a stipulation reduces the risk that the same issues bearing on patentability will be addressed.

Accordingly, factor 2 should weigh slightly in favor of denial, not heavily.

C. The Board Abused Its Discretion by Arbitrarily Finding That *Fintiv* Factor 4 Weighs Slightly Against Denial

The Board weighed factor 4 only slightly against denial, despite the fact that Petitioner submitted a *Sand* stipulation **and** there is no overlap whatsoever between the challenged claims and the claims asserted in the parallel EDTX action. Petitions with a *Sand* stipulation routinely result in factor 4 being weighed as marginally against denial. *See, e.g., Samsung Elecs. Co. Ltd. v. Headwater Rsch. LLC*, IPR2024-01396, Paper 13 at 7-8 (PTAB Apr. 1, 2025); *Cisco Sys., Inc. v. Croga Innovations Ltd.*, IPR2024-01282, Paper 7 at 39-40 (PTAB Feb. 13, 2025); *Samsung Display Co., Ltd. v. Pictiva Displays Int'l Ltd.*, IPR2024-01223, Paper 11 at 7 (PTAB Mar. 6, 2025); *Samsung Display Co., Ltd. v. Pictiva Displays Int'l Ltd.*, IPR2024-01222, Paper 12 at 7-8 (PTAB Mar. 6, 2025); *Savant Techs. LLC v. FEIT Elec. Co., Inc.*, IPR2024-01357, Paper 17 at 13-14 (PTAB Mar. 5, 2025); *TCL Elecs. Holdings Ltd. v. Univ. of Rochester*, IPR2024-01245, Paper 10 at 13-14 (PTAB Feb. 13, 2025); *Ericsson Inc. v. Active Wireless Techs. LLC*, IPR2024-00886, Paper 8 at 11-13 (PTAB Nov. 12, 2024); *T-Mobile USA, Inc. v. Wireless All., LLC*, IPR2024-00607, Paper 16 at 12-15 (PTAB Sep. 10, 2024); *T-Mobile*

USA, Inc. v. Wireless All., LLC, IPR2024-00608, Paper 16 at 12-15 (PTAB Sep. 3, 2024).

Given how early it is in the parallel EDTX case, "it would be speculation as to whether the same or substantially the same claims, grounds, arguments, and evidence will be presented in the district court as in this proceeding." *Cisco Sys., Inc. v. Croga Innovations Ltd.*, IPR2024-01282, Paper 7 at 40. "Without speculating, all we can determine is that the same grounds will not be raised in the parallel proceeding and that the same or substantially the same claims, arguments, and evidence may be presented in both proceedings." *Id*. (finding *Fintiv* factor 4 to weigh slightly against denial when a *Sand* stipulation has been submitted).

As noted above, a *Sand* stipulation by itself is enough to cause factor 4 to weigh against denial. But here, in addition to there being a *Sand* stipulation, there is no overlap of claims whatsoever. That is, no challenged claims are also being asserted in the parallel EDTX action. Despite the Board's acknowledgment of this lack of overlap, the Board only found factor 4 to weigh slightly against denial, noting that "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." Paper 10 at 15. Out of hundreds, if not thousands, of possible prior art combinations, the Board allowed the *possibility* that a small fraction of

those combinations could cause duplicative efforts to infect its decision. This is pure speculation, and it is improper. *Cisco Sys.*, IPR2024-01282, Paper 7 at 40.

Accordingly, given the *Sand* stipulation and lack of claim overlap, factor 4 should be weighed heavily against denial. [7]

D. The Board Abused Its Discretion by Conducting an Inadequate *Fintiv* Factor 6 Analysis

In assessing the merits in a *Fintiv* analysis with respect to factor 6, the Board must provide reasoning sufficient enough to allow the parties to challenge that finding and sufficient to allow for review of the Board's decision. *Commscope Techs. LLC v. Dali Wireless, Inc.*, IPR2024-01242, Paper 23 at 5 (PTAB Feb. 27, 2023). The Board here does not meet that standard.

While the Board attempts to perform some level of analysis, it does not provide enough. The Board found that the 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.'" Paper 10 at 18. But the Board does not specify what it believes to be the ordinary and customary meaning of "authenticated access point." Nor is there any explanation as to how Petitioner's

[7] Moreover, should Petitioner's now-submitted *Sotera* stipulation be accepted, yet another reason exists for factor 4 weighing heavily against discretionary denial.

interpretation does not meet the ordinary and customary meaning of the term. Accordingly, the Board has not provided reasoning sufficient enough to allow the parties to challenge that finding and sufficient to allow for review of the Board's decision. *Commscope Techs.*, IPR2024-01242, Paper 23 at 5.

As a result, the Institution Decision should be vacated and the merits of the Petition should be properly analyzed and weighed.[8]

E. Properly Weighed and Balanced *Fintiv* Factors Weigh Against Denial

Factor 1 was correctly found to be neutral. Factor 2 should have been weighed slightly, not heavily, in favor of denial. Factor 3 was correctly found to weigh against denial. Factor 4 should have been found to weigh heavily against denial.[9] Factor 5 was correctly found to weigh slightly in favor of denial. Factor 6 should have been found to weigh against denial. On balance, given these corrected weights, the Board should have found the *Fintiv* factors weigh against denial. Even if factor 6 is ultimately found to be merely neutral (which the Board already acknowledged), a correct balancing of the factors weighs against denial.

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[8] Moreover, once the Institution Decision is vacated, it is appropriate to consider Petitioner's *Sotera* stipulation. *Vector Flow, Inc. v. HID Glob. Corp.*, IPR2023-00353, Paper 15 at 8-9 (PTAB Oct. 17, 2023).

[9] Moreover, should Petitioner's now-submitted *Sotera* stipulation be accepted, factor 4 should weigh heavily against discretionary denial.

Respectfully submitted,

Dated: April 23, 2025

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CERTIFICATE OF SERVICE

I hereby certify that on April 23, 2025, a true and correct copy of the foregoing PETITIONER'S REQUEST FOR DIRECTOR REVIEW was filed with the Patent Trial and Appeal Board Case Tracking System (P-TACTS), with a copy served via electronic mail to the following email addresses, as authorized in Patent Owner's Mandatory Notice (Paper 5):

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