

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.

IPR2024-01369
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 10–28 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:

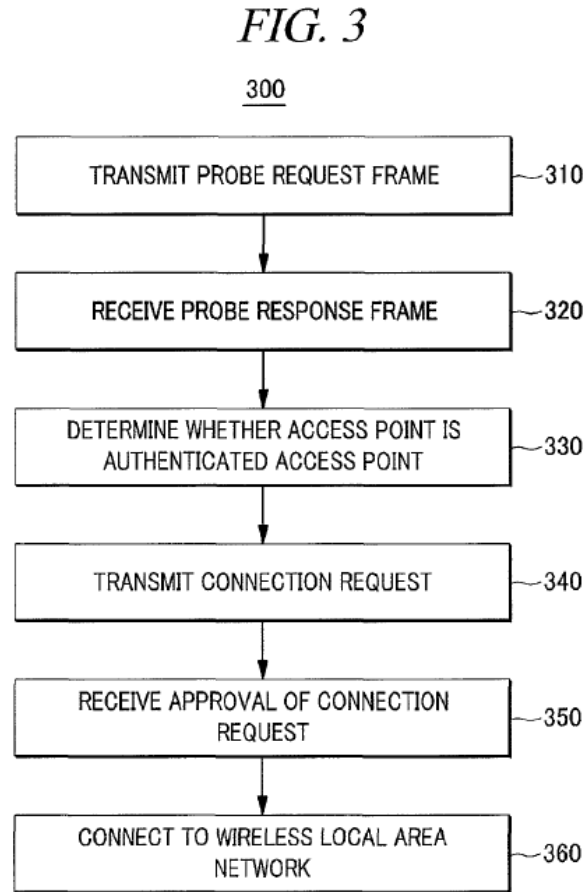


Figure 3 depicts a process by which an end device connects to a WLAN through an access point. Ex. 1001, 2:31–34, 4:66–5:2. At step 310, the end device transmits a probe request frame including a fake end-device identifier to an access point. *Id.* at 5:12–18. At step 320, the end device receives a probe 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 5:38–41. 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 10 is as follows:

10. A method performed by a device, the method comprising:

- [a] receiving, from a server, an authenticated access point list that includes information regarding one or more access points that are controlled by the server;
- [b] receiving, from the server, a fake device identifier for the device, wherein the received 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;
- [c] transmitting, to at least one access point, the probe request frame that includes the received fake device identifier;
- [d] receiving, from the at least one access point in response to the transmitting the probe request frame, a probe response frame that includes information regarding the at least one access point;
- [e] determining, in response to the receiving the probe response frame and based at least, in part, on the information regarding the at least one access point, whether the at least one access point is an authenticated access point, wherein the determining whether the at least one access point is the authenticated access point includes determining whether the information regarding the at least one access point is included in the authenticated access point list that is received from the server; and
- [f] transmitting, to the at least one access point in response to a determination that the at least one access point is the

authenticated access point, a connection request that includes an authentic device identifier for the device.

Ex. 1001, 11:58–12:20 (Petitioner’s limitation labels added).

Petitioner asserts two grounds for *inter partes* review, as summarized in the following table:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
10–28	103(a) ²	Vardi, ³ IEEE802.11, ⁴ Orava, ⁵ Yun ⁶
24–28	103(a)	Vardi, IEEE802.11, Orava, Yun, Kholaf ⁷

Pet. 20.

C. DECLARATORY TESTIMONY

Petitioner submits a declaration by Dr. Harry v. Bims. Ex. 1002.

Patent Owner does not submit expert rebuttal testimony.

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).

⁷ Kholaf et al., US 2012/0257536 A1 (published Oct. 11, 2012) (Ex. 1010).

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*, IPR2024-01368 (PTAB Sept. 4, 2024) as a related PTAB proceeding. Pet. 1; Paper 5, 2.

III. 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. 43–44 (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 6.⁸

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.

⁸ 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 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>.

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 “the District Court likely would stay the case pending the outcome of [this and three other related *inter partes* reviews] in view of potentially substantial judicial efficiencies to be gained” and, “[i]ndeed, Judge Gilstrap (who is presiding over the Texas Litigation) granted a stay in a similar patent infringement case where all claims of the asserted patent, including the non-asserted claims, were subject to [*inter partes* review].” Pet. 95–96 (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. 45. According to Patent Owner, at least one panel of the Board has held that “factor 1 weighs in favor of exercising discretion to deny institution, even where a district court’s order denying a motion to stay permits the movant to renew its motion ‘should the PTAB issue a decision on institution or a final determination as to the validity of the asserted claims.’” *Id.* (quoting *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).

Petitioner replies that “it is not unusual for courts to deny a motion to stay without prejudice before institution,” 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

Ex. 2001, 2; *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.* By contrast, although the order denying the original motion in *Clear Imaging* allowed the petitioner to renew its request for a stay, the order “specifically stated that a stay will unduly prejudice Patent Owner” and that the “late stage of the current case also disfavors a stay.” IPR2020-01401, Paper 12 at 10 (internal quotation omitted).

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. 96 (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. 46–47 (citing PTAB cases). Patent Owner also argues that the median time-to-trial statistics predict an even earlier trial date, which also suggests that the case disposition would be well before our final written decision in this case. *Id.* at 47–48 (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. 96. 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 [claim construction issues], or even conduct expert discovery.” Pet. 96–97.

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 Petitioner’s invalidity position, Patent Owner’s infringement allegations, and claim construction. Prelim. Resp. 49–51; *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 stipulates that, “if [*inter partes* review] is instituted, Petitioners will not pursue in the Texas Litigation the same grounds asserted in this Petition.” Pet. 97. 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)). Petitioner also contends that this Petition challenges more claims than are asserted in the parallel district court litigation. *Id.*

Patent Owner responds that the claims challenged in this proceeding substantially overlap with Petitioner’s invalidity contentions in the parallel district court proceeding,⁹ 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 51–52. 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 52–53. Thus, Patent Owner argues that the fourth *Fintiv* factor “weighs strongly in favor of denial of institution.” *Id.* at 54.

“[I]f the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.” *Fintiv* 12. Although Petitioner correctly points out that the claims challenged in the parallel district court litigation (claims 10, 11, 13–18, 20–22, 24, 25, and 28 (*see* Ex. 2003, 1)) are a subset of the claims challenged in the Petition (claims 10–28), Petitioner does not meaningfully dispute there is substantial overlap between the claims, arguments, and evidence raised in the two proceedings. For example, there is

⁹ This argument appears to include 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. 51 (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 challenging claims 10, 11, 13–18, 20–22, 24, 25, and 28 of the ’552 patent).

no independent claim challenged in the Petition that is not challenged in the parallel district court litigation.

Thus, the only remaining issue for the fourth *Fintiv* factor is to what degree Petitioner's stipulation mitigates the existing concerns against potentially duplicative efforts. In the record before us, we have (1) Petitioner's two asserted grounds (Pet. 20); (2) Petitioner's general assertions in its invalidity contentions from the parallel district court litigation that "the prior art references [in a list of ten including Vardi, IEEE802.11, Orava, and Yun but not Kholaiif] anticipate and/or render obvious, alone or in combination, one or more of the Asserted Claims of the '552 Patent" (Ex. 2003, 27); and (3) a few general statements regarding what Petitioner contends would have been known or obvious regarding the '552 patent's claimed subject matter in light of these ten references (*id.* at 27–28).

From this information, and without any guidance from Petitioner, we have no way to fully evaluate how much meaningful mitigation, if any, Petitioner's stipulation actually provides. Although Petitioner's stipulation would presumably prevent it from asserting "the same grounds" in the parallel district court litigation as it has in the Petition, it is not clear that the stipulation would avoid duplicate efforts to resolve key issues, such as the construction of "authenticated access point list" or whether Vardi and IEEE802.11 disclose authentication of access points. *See infra* Section III.F.

These particular issues would still be key to Petitioner's argument if, for example, Petitioner, swapped the Orava or Yun references for another reference asserted in the parallel district court litigation. *See, e.g.*, IPR2024-01367, Paper 1, 17 (alternatively asserting Yun or Jalfon in combination with Vardi and IEEE802.11 in another petition by Petitioner challenging a

patent with similar “authenticated access point” language). Such a swap would not be the “same grounds asserted in the Petition” but would result in the same central disputed issues needing to be decided in light of Vardi and IEEE802.11.

Thus, although we acknowledge Petitioner’s stipulation is not without any meaning or weight, it does not substantially mitigate the prospect of duplicative efforts between the two proceedings under these circumstances, in light of the substantial overlap of the claims, prior art, and evidence in the two proceedings. Accordingly, we find that Factor 4 weighs in favor of discretionary denial.

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. 97–98.

Patent Owner argues that “the Petition presents no compelling case,” including “to substantively address the meaning of ‘authenticated’ or describe why or how the proposed combination would have rendered obvious this claim requirement,” so we need not consider the sixth *Fintiv* factor. Prelim. Resp. 54–55 (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. 25–27; Prelim. Resp. 19–29; 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 10 recites a step of “receiving, from a server, an authenticated access point list that includes information regarding one or more access points.” Ex. 1001, 11:60–62. Independent claims 15, 21, and 24 include similar limitations. *See id.* at 12:44–46, 13:37–39, 14:29–31. 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. 27.

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.* at 21–22 (citing Exs. 2006–2009 (dictionary definitions)). But according to Patent Owner, Vardi “fails to disclose any authentication of an access point” because Vardi’s radio resource database includes unauthenticated third-party information. *Id.* at 22, 26; *see also id.* at 23–28 (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. Patent Owner also contends that it agreed in the parallel district court proceeding, as it does here, that the term has its plain meaning. *Id.* at 2 (citing Ex. 1017, 8).

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 4 weighs in favor of discretionary denial, as does Factor 5 at least to some degree. Factors 1 and 6 are neutral. Factor 3 weighs against discretionary denial, but this factor does not outweigh the other factors under the circumstances of this case. Thus, the evidence of record favors exercising our discretion to deny institution of an *inter partes* review.

IV. DISCRETIONARY DENIAL: MULTIPLE PETITIONS

Petitioner filed two contemporaneous petitions challenging the '552 patent. *See* Pet. 1; PO Resp. 43; Pet. Reply 4–5; Pet. Sur-reply 3–4. 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. 43 (citing Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), <https://www.uspto.gov/TrialPracticeGuideConsolidated> (“Trial Practice Guide”)).

Because Petitioner has subsequently ranked this Petition as the first among the two (Pet. Reply 4–5), and because we deny institution based on the *Fintiv* factors as discussed above, we need not decide whether it was appropriate for Petitioner to file two petitions challenging the ’552 patent.

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.

IPR2024-01369
Patent 9,961,552 B2

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