From: Trials
To: Michael F. Snyder; Daniel H. Golub; Ryan O"Donnell; "mmatulewicz-crowley@reichmanjorgensen.com"; "clehman@reichmanjorgensen.com"; "ppark@reichmanjorgensen.com"
Cc: Trials
Subject: RE: IPR2024-01306 | Patent 11,048,712 | Petitioner's Request for Pre-Institution Reply | UiPath, Inc. v. Rule 14 LLC
Date: Tuesday, February 4, 2025 12:41:45 PM
Attachments: image001.png
image002.png
image003.png
image004.png
image005.png

Counsel,

After considering the parties' positions, the panel determines that additional briefing is not warranted and denies Petitioner's request for authorization to file a reply to the Preliminary Response.

Regards,

Franchesca I. Alicea Villanueva
Supervisory Paralegal
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Michael F. Snyder <MSnyder@vklaw.com>
Sent: Thursday, January 30, 2025 3:30 PM
To: Trials <Trials@USPTO.GOV>
Cc: Daniel H. Golub <DGolub@vklaw.com>; Ryan O'Donnell <RODonnell@vklaw.com>; 'mmatulewicz-crowley@reichmanjorgensen.com' <mmatulewicz-crowley@reichmanjorgensen.com>; 'clehman@reichmanjorgensen.com' <clehman@reichmanjorgensen.com>; 'ppark@reichmanjorgensen.com' <ppark@reichmanjorgensen.com>
Subject: IPR2024-01306 | Patent 11,048,712 | Petitioner's Request for Pre-Institution Reply | UiPath, Inc. v. Rule 14 LLC

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Re: IPR2024-01306
Patent 11,048,712

Dear Honorable Board,

Petitioner requests authorization from the Board to file a Pre-Institution Reply limited to five (5) pages directed to (i) Patent Owner's mischaracterization of the standard for establishing a motivation to combine references, and (ii) Patent Owner's argument that the challenged claims are supported by the '313 Application. Petitioner could not have reasonably anticipated either of these issues. Patent Owner objects to Petitioner's request. Petitioner does not object to the filing by Patent Owner of a Sur-Reply also limited to five (5) pages.

The below quoted material from Patent Owner's counsel has been included verbatim with this message at their request:

> "IPR2024-01306
>
> Patent Owner opposes Petitioner's request for authorization to file a Pre-Institution Reply in IPR2024-01306. As an initial matter, Patent Owner requested that Petitioner share its intended email to the Board; Petitioner refused to do so. Thus, Patent Owner has not had an opportunity to review or respond to Petitioner's request and any arguments to the Board.
>
> In any event, there is not "good cause" for Petitioner's requested Pre-Institution Reply. *See* 37 C.F.R. § 42.108. In email correspondence, Petitioner stated that a Pre-Institution Reply is warranted in IPR2024-01306 to address "(i) Patent Owner's mischaracterization of the standard for establishing a motivation to combine references, and (ii) Patent Owner's arguments that the challenged claims are supported by the '313 Application."
>
> Neither basis provides good cause for Petitioner's request. "[I]dentifying and evaluating statements or misstatements of the facts and law are well within the purview of the Panel of Judges assigned to these proceedings. It may always be the case that a Petitioner is unhappy with how Patent Owner characterizes the facts and law presented in the Petition. Our rules, however, provide for a Petitioner Reply only when good cause exists." *Xactware Sols., Inc. v. Pictometry Int'l Corp.*, IPR2016-00593, Paper 11 at 3 (PTAB Jul. 1, 2016); *see also Mylan Pharmaceuticals Inc. v. Janssen Oncology, Inc.*, IPR2016-01332, Paper 16 (PTAB Oct. 26, 2016). Just so here. Moreover, Petitioner could have addressed—and in fact did address—each of these issues in the Petition, further demonstrating the lack of good cause for a Pre-Institution Reply. *See ARM, Ltd. v. Godo Kaisha IP Bridge 1*, IPR2016-00825, Paper 11 at 2-4 (PTAB Sep. 29, 2016) ("Petitioner's arguments do not persuade us that there is good cause for why this issue could not have been raised earlier."); *Twilio Inc. v. Telesign Corp.*, IPR2016-00450, Paper 14 at 2-3 (PTAB June 3, 2016) ("We determine that we are capable of applying the indicated facts to the indicated statutes, rules, and case law and are not persuaded that the Board would benefit from additional briefing or supplementation.").
>
> Patent Owner thus respectfully requests the Board deny Petitioner leave to file a Pre-Institution Reply. In the alternative, if the Board is entertaining granting Petitioner's request, Patent Owner requests a conference call with the Board to discuss the issues more fulsomely."

Parties' Availability for a Conference Call with the Board

Counsel for Petitioner and Patent Owner are both available for a conference call with the Board on January 31, 2025 between 2:30pm and 4:00pm ET, on February 4, 2025 between 10:00am and 1:00pm ET, and February 7, 2025 between 2:00pm and 4:00pm ET.

Respectfully submitted,

Michael F. Snyder, Counsel for Petitioner

Michael F. Snyder

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