

From: [Trials](#)
To: [Michael Matulewicz-Crowley](#); [Trials](#)
Cc: [Daniel H. Golub](#); [Ryan O'Donnell](#); [msnyder@vklaw.com](#); [Christine E. Lehman](#); [Peter Park](#)
Subject: RE: IPR2024-01306 | Patent 11,048,712 | Patent Owner's Request for Supplemental Pre-Institution Response | UiPath, Inc. v. Rule 14 LLC
Date: Wednesday, March 5, 2025 11:40:03 AM

Counsel,

After considering the parties' positions, the panel determines that additional briefing is not warranted and denies Patent Owner's request for authorization to file supplemental briefing and evidence.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
USPTO
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From: Michael Matulewicz-Crowley <mmatulewicz-crowley@reichmanjorgensen.com>
Sent: Tuesday, March 4, 2025 2:22 PM
To: Trials <Trials@USPTO.GOV>
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Subject: IPR2024-01306 | Patent 11,048,712 | Patent Owner's Request for Supplemental Pre-Institution Response | UiPath, Inc. v. Rule 14 LLC

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Re: IPR2024-01306
Patent 11,048,712

Dear Honorable Board,

Patent Owner respectfully requests authorization from the Board to file (1) a Supplemental Pre-Institution Response limited to three (3) pages showing that the Petition should be denied under 35 U.S.C. § 314(a) and the Board's Precedential decision in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) and (2) new evidence in support of that *Fintiv* argument limited to the Docket Control Order from the parallel district court litigation and time-to-trial statistics from the Eastern District of Texas, where the parallel district court litigation is proceeding.

Patent Owner contends that there is good cause for the requested relief. On February 28, 2025,

the USPTO rescinded former Director Vidal's 2022 "Interim Procedure for Discretionary Denials in AIA Post Grant Proceedings with Parallel District Court Litigation" Memorandum (the "2022 Memorandum"). *See* <https://content.govdelivery.com/accounts/USPTO/bulletins/3d4a99f>. Patent Owner's *Fintiv* argument was not available before the rescission of the 2022 Memorandum, as the 2022 Memorandum precluded *Fintiv* denial where the Petitioner had submitted a so-called *Sotera* stipulation (as Petitioner did here). After the rescission of the 2022 Memorandum, Patent Owner's requested *Fintiv* argument is particularly strong. As but one example, trial in the parallel district court litigation is scheduled for approximately six months before the statutory deadline for the Final Written Decision in this proceeding.

Patent Owner contends that it could not have reasonably anticipated rescission of the 2022 Memorandum. Moreover, Patent Owner has requested its relief two business days after the USPTO's rescission of the 2022 Memorandum and has thus been diligent in seeking relief. Petitioner argues the Board does not have authority to grant Patent Owner's requested relief, but the Board has plenary authority to grant additional briefing, including Patent Owner's requested relief. *See* 37 C.F.R. § 42.5(a) ("The Board may determine a proper course of conduct in a proceeding for any situation not specifically covered by this part and may enter non-final orders to administer the proceeding."). Finally, there are sixteen days before the Board's deadline to render its Institution Decision, and there is thus sufficient time for the parties to brief the newly-possible *Fintiv* arguments—particularly if the parties engage in simultaneous briefing, as Patent Owner suggests.

Patent Owner conferred with Petitioner's counsel and did not reach an agreement on this request. Patent Owner does not object to the filing by Petitioner of a Reply also limited to three (3) pages to address *Fintiv* denial.

Petitioner's Position on Patent Owner's Request:

Petitioner opposes Patent Owner's request to supplement the discretionary denial arguments that Patent Owner previously set forth in its Preliminary Responses and to submit new evidence. *See*, IPR2024-01304, POPR (Paper 7), at 43-46 and IPR2024-01306, POPR (Paper 7), at 58-61.

Patent Owner's proposed do-over is not permitted under the statute or the rules. The arguments and new evidence that Patent Owner is now proposing could have been submitted in its Preliminary Response. *Fintiv* was precedent that Patent Owner could have previously addressed. In addition, the requested supplemental filing is neither a "reply" to a patent owner preliminary response (which could only be filed by Petitioner), nor a "sur-reply" (which could only be filed by Patent Owner if Petitioner had filed a reply, which is not the case), and is not provided for in any manner under the statute or the rules. For example, while 37 C.F.R. 1.108(c) states that "a Petitioner may seek leave to file a reply to the preliminary response," neither the statute nor the rules provide for what Patent Owner now requests -- which is neither a "reply" nor a "sur-reply" -- but rather a reworking of Patent Owner's previous discretionary denial arguments in each IPR. Similarly, while 37 C.F.R. 42.20(d) provides the Board with authority to order briefing on any issue, such authority is limited to issues "involved in a trial." Here, no trial has yet been instituted. Finally, while 37 C.F.R. 42.23(a) speaks to "oppositions, replies and sur-replies," the Rule makes no mention of the type of filing now proposed by Patent Owner, which does not fall into any of the categories of

filings enumerated in the rule.

There is also insufficient time for the further briefing and additional exhibits that Patent Owner is now proposing. Patent Owner filed its POPR's in IPR2024-01304 and IPR2024-01306 on December 20, 2024. Under 35 U.S.C. §314(b), the Board has 3 months from that date (or until March 20, 2025) to render the institution decisions in these cases. The Board cannot be expected to turn on a dime. By the time additional filings are completed, the Board would have practically no time to digest the filings and prepare the two institution decisions due by March 20, 2025.

Petitioner's requests on the timing of briefing, if permitted by the Board, are inconsistent. Petitioner's March 3, 2025 correspondence stated, "if Patent Owner is afforded this response, Patent Owner does not object to Petitioner's filing of a reply limited to three pages to respond to Patent Owner's response." Petitioner's March 4, 2025 correspondence stated "we think it makes the most sense for the parties to file their respective briefing simultaneously" and does not provide page limitations.

To the extent that the Board permits Patent Owner's request, then it is Petitioner's position that Patent Owner should submit its additional paper first followed by Petitioner's responsive paper (in accordance with Patent Owner's March 3, 2025 proposal) having the same number of pages afforded to Patent Owner. Simultaneous briefing (in accordance with Patent Owner's March 4, 2025 proposal) would be prejudicial to Petitioner as Patent Owner already submitted discretionary denial arguments in its POPRs and Petitioner needs to be afforded the opportunity to review Patent Owner's supplemental position before submitting additional briefing.

Parties' Availability for Conference Call with the Board

Thursday (3/6): 2:30-5:00 pm (ET)

Friday (3/7): 10:00 am-2:00 pm (ET)

Respectfully submitted,
Michael Matulewicz-Crowley, Counsel for Patent Owner
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