

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UIPATH, INC.,

Petitioner,

v.

RULE 14 LLC,

Patent Owner.

Case No. IPR2025-00623
U.S. Patent No. 10,108,679

**BRIEF IN SUPPORT OF PATENT OWNERS' REQUEST FOR
DISCRETIONARY DENIAL OF INSTITUTION
OF *INTER PARTES* REVIEW**

TABLE OF CONTENTS

	<u>Page</u>
I. THE DIRECTOR SHOULD DISCRETIONARILY DENY THE PETITION BECAUSE A DISTRICT COURT HAS ALREADY FOUND THE CHALLENGED PATENT INVALID	1
II. CONCLUSION.....	2

PATENT OWNERS' EXHIBIT LIST

Exhibit	Description
2001	Magistrate Judge Payne's Claim Construction Order in <i>Rule 14 LLC v. UiPath, Inc.</i> No. 2-23-cv-00627 (E.D. Tex. 2023)
2002	Judge Gilstrap's Order Adopting Magistrate's Claim Construction Order in <i>Rule 14 LLC v. UiPath, Inc.</i> No. 2-23-cv-00627 (E.D. Tex. 2023)

Rule 14 LLC (“Rule 14” or “Patent Owner”) respectfully submits this Brief In Support of Its Request for Discretionary Denial of Institution (“Discretionary Denial Brief”) of *Inter Partes* Review (“IPR”) of U.S. Patent No. 10,108,679 (“the ’679 patent”) by UiPath, Inc. (“UI” or Petitioner).

I. THE DIRECTOR SHOULD DISCRETIONARILY DENY THE PETITION BECAUSE A DISTRICT COURT HAS ALREADY FOUND THE CHALLENGED PATENT CLAIMS INVALID

The Director and the Board should exercise discretion under 35 U.S.C. § 314(a), consistent with the Director’s informative decision in *Hulu, LLC v. Pirhana Media Distribution LLC*, IPR2024-01252, Paper 27 (USPTO Director April 17, 2025) (“*Hulu*”), to deny institution for a straightforward reason—the challenged patent has already been found invalid by a district court.

In *Hulu*, the Director addressed a situation in which a district court granted a motion to dismiss under Rule 12(b)(6) that alleged that the claims of the patent challenged in the IPR petition were “invalid as reciting ineligible subject matter under § 101.” *Hulu*, 2. The Director reasoned that “[b]ecause the patent claims already stand invalid, it is unnecessary to institute another proceeding to review them for patentability under other grounds.” *Id.* Notably, the Director acknowledged that the district court decision might be reversed on appeal, but noted that even if that occurred, the Petitioner could raise the invalidity arguments set forth in the Petition “in the district court on remand.” *Id.*, 2-3. Ultimately, the Director held that “where a district court already has found the challenged claims invalid, the efficiency and

integrity of the patent system is best served by denying institution.” *Id.*, 3.

Here, the facts are substantively identical to those in *Hulu* in material respects. Specifically, in *Rule 14 LLC v. UiPath, Inc.* No. 2-23-cv-00627 (E.D. Tex. 2023), Magistrate Judge Payne found that the term “[generating/generate], by an entity,” which is present in every independent claim of the ’679 patent, was invalid as indefinite under 35 U.S.C. § 112(f) on the ground that the term is a means-plus-function term without sufficient structural support in the specification. EX2001, 18. District court Judge Rodney Gilstrap subsequently issued an order stating that “the Court agrees with the conclusions reached within the Order” and expressly adopted Magistrate Judge Payne’s Order. EX2002. While Patent Owner disagrees with the district court’s decision and reserves all rights to challenge it on appeal or otherwise, that is no different from *Hulu*, which recognized the possibility of a reversal on appeal. The fact remains that “a district court already has found the challenged claims invalid”—precisely the factual circumstance that the Director found counseled in favor of discretionary denial in *Hulu*.¹ The result should be no different here.

II. CONCLUSION

For the foregoing reasons, the Director and the Board should exercise its

¹ While no formal judgment of invalidity has issued in the district court case, the Director’s decision in *Hulu* did not hinge on the formality of a judgment—it focused on the inefficiency of diverting PTAB resources to evaluate the patentability of claims that a court has already found invalid.

discretion to deny institution under 35 U.S.C. § 314(a) and *Hulu* based the district court's finding that the claims of the challenged patent are invalid.

Dated: June 16, 2025

By: /s/Michael Matulewicz-Crowley
Michael Matulewicz-Crowley
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CERTIFICATE OF COMPLIANCE

The undersigned hereby certifies that Rule 14's Brief in Support of Their Request for Discretionary Denial of Institution of IPR consists of 542 words, excluding the table of contents, table of authorities, certificate of service, this certificate of compliance, and table of exhibits. This Discretionary Denial Brief complies with the type-volume limitation of 14,000 words as mandated by the Memorandum. In preparing this certificate, counsel has relied on the word count of the word processing system used to prepare this paper (Microsoft Word).

Dated: June 16, 2025

By: /s/Michael Matulewicz-Crowley
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*Counsel for Patent Owner Rule 14
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that pursuant to 37 C.F.R. §42.6(e)(1), a copy of the foregoing **BRIEF IN SUPPORT OF PATENT OWNERS' REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION OF *INTER PARTES* REVIEW** was served on June 16, 2025, by filing this document through the Patent Trial and Appeal Board's P-TACTS System as well as delivering a copy via electronic mail upon the following attorneys of record for Petitioners:

Dated: June 16, 2025

By: /s/Michael Matulewicz-Crowley
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