

**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

**PETITIONER'S BRIEF IN OPPOSITION TO PATENT OWNER'S
REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION
OF INTER PARTES REVIEW**

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I. INTRODUCTION

Petitioner UIPATH, INC., (“Petitioner”), respectfully submits this Brief in Opposition to Patent Owner’s Request for Discretionary Denial of Institution of Inter Partes Review (Paper No. 6).

Patent Owner’s sole basis for seeking discretionary denial is that the Court in the related litigation¹ issued an interlocutory decision finding that a term included in each of the independent claims of U.S. Patent No. 10,108,679 (‘679 Patent) indefinite. In support of Patent Owner’s request, Patent Owner cites to a single prior decision, *Hulu, LLC v. Piranha Media Distribution LLC*, IPR2024-01252, Paper 27 (USPTO Director April 17, 2025) (“*Hulu*”). As explained herein, *Hulu* was in a much different posture than the present IPR.

Notably, Patent Owner has not requested discretionary denial under any of the factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020), or any recent Director decisions or guidance, or Patent Trial and Appeal Board (Board) decisions or guidance, relating to the *Fintiv* factors.

For the reasons set forth herein, Petitioner submits that the Patent Owner’s request should be denied. As explained in greater detail below, the present situation is highly distinguishable from the posture of the *Hulu* proceeding and related

¹ *Rule 14 LLC v. UiPath, Inc.*, No. 2-23-cv-00627 (E.D. Tex. 2023) (the “Related Litigation”).

litigation. Patent Owner has not presented any reasonable basis for discretionary denial.

II. EFFICIENCY FAVORS PROCEEDING WITH THIS IPR

In *Hulu*, a final judgment was issued on patent ineligible subject matter under 35 U.S.C. § 101, and the Patent Owner had appealed that final judgment to the United States Court of Appeals for the Federal Circuit. *Hulu*, at 2.

In the Related Litigation, the parties are far from a final judgment on any issue, let alone whether the '679 Patent is invalid for indefiniteness. Even after the Related Litigation reaches a Final Judgment, Petitioner will still have an opportunity to seek reconsideration of the indefiniteness before the district court under Fed. R. Civ. P. 59(e) or 60(b). In the Eastern District of Texas where the Related Litigation is pending, after a final judgment is entered, a party can seek reconsideration of a prior ruling (such as a summary judgment ruling finding claims indefinite) under either Fed. R. Civ. P. 59(e) or 60(b)). *Mid-Am. Supply Corp. v. Truist Bank*, 2023 U.S. Dist. LEXIS 98424, 2023 WL 3852683 (E.D. Texas 2023) (reconsidering prior summary judgment after final judgment) ("A motion asking the Court to reconsider a prior ruling is therefore evaluated either as a motion to alter or amend judgment under Federal Rule of Civil Procedure 59(e) or as a motion for relief from a final judgment, order, or proceeding under Federal Rule of Civil Procedure 60(b). ... The

applicable rule depends on when the motion was filed—if the motion was filed within twenty-eight days after the entry of judgment, it is analyzed under Rule 59, and, if it was filed outside of that time, it is analyzed under Rule 60").

This matter is clearly distinguishable from *Hulu* because, in that case, the district court had entered a final judgment of patent ineligible subject matter and invalidity under 35 U.S.C. § 101, which was already on appeal to the Federal Circuit. *Hulu, LLC v. Piranha Media Distribution, LLC*, IPR2024-01252, Exs. 2010 [final judgment of invalidity] and 2011 [Docketing Statement At Court of Appeals for the Federal Circuit]. In contrast to *Hulu* where the district court had entered a final judgment of invalidity, the Board has held that it has authority to institute an IPR proceeding, where, as here, the district court has rendered only a non-final invalidity determination with respect to the subject claims, and the Board should conduct a *Fintiv* analysis, if necessary. *Volvo Penta of the Americas, LLC v. Brunswick Corporation*, IPR2022-01366, Paper #15, 8 (PTAB 2023) ("*AviaGames* recognizes that a *Fintiv* analysis should be conducted in scenarios like this, where a district court has rendered a non-final invalidity determination that some or all of the claims challenged in an IPR petition are invalid, even on grounds that cannot be raised in that IPR") (citations omitted). Here, Patent Owner has not requested discretionary

denial or made a showing under any of the *Fintiv* factors, and thus there is no basis for discretionary denial under a *Fintiv* analysis.

Moreover, any concerns regarding efficiency relied upon in the *Hulu* case are not present in this proceeding. Rather, the opposite is true here: moving forward with this IPR could remove the ‘679 Patent as an issue for appeal. Any consideration of the ‘679 Patent is effectively “stayed” pending the conduct and completion of the Related Litigation. Should the ‘679 Patent be found to be unpatentable for the reasons set forth in the IPR Petition, that would resolve the matter as to the ‘679 Patent, well before any appeal of the district court's ruling is decided, thus saving the parties and the Court time and expense on the appellate issues surrounding the ‘679 Patent.

Accordingly, the Board’s prior decisions favoring the most efficient disposition of patent invalidity issues should control here, and this proceeding should be permitted to move forward. Otherwise, Petitioner will be blocked from this forum, and will not have another opportunity to challenge the claims of the ‘679 Patent in this forum should Patent Owner obtain reconsideration or reversal of the district court's indefiniteness ruling.

III. CONCLUSION

Patent Owner seeks to benefit from an interlocutory decision of the District Court in the Related Litigation, knowing full well that Patent Owner will also ultimately seek to overturn the indefiniteness decision. Should the Patent Owner prevail on reconsideration or appeal, Petitioner will be unfairly prejudiced as it will be barred from again seeking an IPR.

For the foregoing reasons, Petitioner respectfully submits that Patent Owner's request should be denied.

Respectfully,

Date: July 16, 2025

By: /Michael F. Snyder/
Counsel for Petitioner
UiPath, Inc.

CERTIFICATE OF COMPLIANCE

The undersigned hereby certifies that Petitioner's Brief in Opposition to Patent Owner's Request for Discretionary Denial of Institution of IPR consists of 959 words, excluding the table of contents, table of authorities, certificate of service, this certificate of compliance, and table of exhibits. This Brief complies with the type-volume limitation of 5,600 words as mandated by the March 26, 2025 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: July 16, 2025

By: /Michael F. Snyder/
Michael F. Snyder
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UiPath, Inc.

CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing **BRIEF IN OPPOSITION TO PATENT OWNER’S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION OF INTER PARTES REVIEW** was served on July 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 Patent Owner:

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