

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA, INC.,
Petitioner,

v.

GRAPHITE CHARGING COMPANY LLC,
Patent Owner.

Case No. IPR2024-00387

U.S. Patent No. 8,103,391

**PETITIONER'S REPLY TO PATENT
OWNER'S PRELIMINARY RESPONSE**

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PETITIONER’S EXHIBIT LIST

<u>Exhibit</u>	<u>Description</u>
Ex-1001	U.S. Patent No. 8,103,391 to Ferro <i>et al.</i> (“’391 Patent”)
Ex-1002	U.S. Patent No. 5,596,258 to Kimura <i>et al.</i> (“Kimura”)
Ex-1003	U.S. Patent No. 5,650,710 to Hotta (“Hotta”)
Ex-1004	U.S. Patent No. 5,659,240 to King (“King”)
Ex-1005	U.S. Patent No. 5,696,367 to Keith (“Keith”)
Ex-1006	U.S. Patent No. 5,548,200 to Nor <i>et al.</i> (“Nor”)
Ex-1007	Prosecution History of the ’391 Patent
Ex-1008	U.S. Patent No. 6,614,204 to Pellegrino <i>et al.</i> (“Pellegrino”)
Ex-1009	Declaration of Expert C. Arthur MacCarley, Ph.D., P.E.
Ex-1010	Curriculum Vitae of Expert C. Arthur MacCarley
Ex-1011	SAE Standard J1772 (Revised Nov. 2001)
Ex-1012	Federal Court Management Statistics—Profiles (Sept. 30, 2023)
Ex-1013	Motion for Extensions of Time (Jan. 26, 2024)
Ex-1014	District Court Complaint (Aug. 4, 2023)

As authorized by the Board on June 10, 2024, Petitioner hereby replies to Patent Owner's Preliminary Response (Paper 6, POPR).

1. THE *FINTIV* FACTORS FAVOR INSTITUTION

Factor 1. The POPR states “there is currently no stay in effect ..., nor is one pending.” Paper 6 at 42. But the district court case is now stayed. *Graphite Charging Co. LLC v. Tesla, Inc.*, No. 3-24-cv-02717, Dkt. No. 77 at 2-3 (N.D. Cal. May 31, 2024) (hereinafter “Stay Order”). Following a transfer to NDCA, the parties stipulated to—and the court granted—a stay “pending resolution, including any appeal(s), of Tesla’s IPR proceedings on the Asserted Patents and Graphite’s forthcoming petition for writ of mandamus [regarding the transfer motion], whichever is resolved later.” *Id.* This factor favors institution.

Factor 2. With the NDCA case stayed and, in any event, the expected time-to-trial in NDCA (36.7 months) being nearly a year longer than in WDTX (25.8 months), Ex-1012, 37 and 66, any trial would occur well after the projected Final Written Decision (October 2025). Paper 2 at 103. Factor 2 thus favors institution.

Factors 3-4. Patent Owner’s arguments about investment in the parallel proceeding (Paper 6 at 45) are incorrect given the stay. Although “the motion to transfer has been resolved,” the parties will *not* be required “to comply with several discovery deadlines in June and July 2024.” *Id.* No *Markman* hearing or substantive discovery will occur. There will be no overlapping invalidity issues during the stay.

The parties agree that the case “is [still] in its infancy” and has yet to make any meaningful progress. Stay Order at 2. Thus, Factors 3-4 favor institution.

Factor 5. *Amazon* remains persuasive. Factor 5 is—at worst—neutral if time exists between the trial date and latest FWD date, even if the parties are the same. *See, e.g., Protect Animals v. Onpoint Sys.*, IPR2021-01483, Paper 11 at 17.

Factor 6. The POPR’s position on the single-reference obviousness grounds misunderstands the caselaw and, regardless, provides no substantive response to the Keith anticipation ground, thereby confirming the compelling merits. PO also appears to believe that compelling merits are undermined if an expert elaborates on technical support for arguments raised in the Petition. Not true. PO’s apparent position (i.e., requiring an identical expert declaration and Petition) would render the Board’s precedential *Xerox* case meaningless. Even if Factors 1-5 favored denial (they do not), the Board need not discretionarily deny given the compelling merits.

2. THE POPR MISUNDERSTANDS STEPAN

The POPR contends that because Grounds 1 and 5 rely on single-reference obviousness, “a motivation to combine elements and reasonable expectation of success” is required under *In re Stepan Co.*, 868 F.3d 1342 (Fed. Cir. 2017). Paper 6 at 25, 38-39. However, *Stepan* does not dictate that *all* single-reference obviousness combinations must have this. *Id.* at 25. Instead, *Stepan* addresses only “[i] combining *multiple embodiments* from a single reference, or [ii] selecting from *large*

lists of elements in a single reference.” 868 F.3d at 1346 & n.1 (emphasis added).

Grounds 1 and 5 do neither. For Ground 1, the Petition relies on a *single* embodiment in Kimura showing controllers 14 and 24 of Figure 1 executing the processes of Figures 10A, 10B, and 12-15. Paper 2 at 7-51; Ex-1002, 6:9-15, 8:66-9:19. And for Ground 5, the Petition relies on a single embodiment from Keith showing the charge station computer 34, the vehicle charge computer 72, and the charging processes performed by the computers 34 and 72. Paper 2 at 95-99; Ex-1005, 9:6-9 and 9:53-56; *see also id.* Figures 2-16 (indicating performance of the respective processes by the “STATION” computer or the “VEHICLE” computer).

Further, no motivation is needed when the combination is expressly taught. *Philip Morris v. RAI*, IPR2020-00921, Paper 32 at 34 (identifying argument that distinguishes *Stepan*). Kimura (Ground 1) and Keith (Ground 5) expressly teach combining the relied-upon elements. Ex-1002, 6:9-15 and 8:66-9:19; Ex-1005, 9:6-9 and 9:53-56; Paper 2 at 7-51 and 95-99. Each teaches executing their various processes by the controllers and computers recited therein. Ex-1002, 6:9-15 and 8:66-9:19; Ex-1005, 9:6-9 and 9:53-56.

Grounds 1 and 5 each rely on a single embodiment or expressly teach the combinations. No further “motivation to combine and reasonable expectation of success analysis” was required.

Dated: June 17, 2024 Respectfully, /Alexander B. Stein / (Reg. No. 71,397)

CERTIFICATE OF SERVICE

I certify that on June 17, 2024, I caused a true and correct copy of the foregoing reply to be served via electronic mail to Patent Owner's designated counsel, listed below:

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Respectfully Submitted,

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