

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA, INC.,

Petitioner,

v.

GRAPHITE CHARGING COMPANY LLC,

Patent Owner

IPR2024-00387

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

PATENT OWNER'S SUR-REPLY

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
Submitted Electronically via PTAB E2E

TABLE OF EXHIBITS

Exhibit	Description
2001	Docket Report from May 9, 2024, <i>Graphite Charging Company LLC v. Tesla, Inc.</i> , Case No. 5:24-cv-2717 (N.D. Ca.)
2002	Order Setting Initial Case Management Conference and ADR Deadlines, <i>Graphite Charging Co. LLC v. Tesla, Inc.</i> , Case No. 3:24-cv-02717-VC (N.D. Ca. May 7, 2024)
2003	Affidavit of Ms. Nadiia Loizides in Support of PO's Motion for <i>Pro Hac Vice</i> Admission
2004	Joint Stipulation and Order Regarding Stay Pending Resolution of Petitions for <i>Inter Partes</i> Review and Mandamus as Amended, <i>Graphite Charging Co. LLC v. Tesla, Inc.</i> , Case No. 3:24-cv-02717-VC (N.D. Ca. May 31, 2024)

TABLE OF CONTENTS

I. The <i>Fintiv</i> Factors Favor Denying Institution.....	1
II. Petitioner Failed to Make Requisite Showings Under <i>Stepan</i>	3

TABLE OF AUTHORITIES

Cases

<i>Adaptics Ltd. v. Perfect Co.</i> , IPR2018-01596, Paper 20 (P.T.A.B. Mar. 6, 2019).....	2
<i>Amazon v. Zentian</i> , IPR2023-01195, Paper 10 (PTAB Jan. 10, 2024).....	2
<i>In re Stepan</i> , 868 F.3d 1342 (Fed. Cir. 2017)	3
<i>In re Van Os</i> , 844 F.3d 1359 (Fed. Cir. 2017)	3
<i>Xerox v. Bytemark</i> , IPR2022-00624, Paper 12 (Feb. 10, 2023).....	3

I. The *Fintiv* Factors Favor Denying Institution

Factors 1 and 3 favor denying institution. **First**, Petitioner admits that one reason the NDCA stayed litigation was PO's filing of a petition for a writ of mandamus challenging transfer from WDTX to NDCA. (Paper 7 at 1; *see also* Ex. 2004 at 1.) If transfer is reversed, the district court case will return to the WDTX and the stay will be lifted. **Second**, Petitioner omits the fact that the stay may be lifted as early as November 2024, almost a year before Petitioner's estimated FWD date of October 2025. (*See* Paper 7 at 1.) The NDCA's Stay Order amended the stipulated language by adding a requirement that a joint status report must be filed every six months. (Ex. 2004 at 5.) Thus, contrary to Petitioner's arguments, the stay in the district court case is far from permanent. As soon as the case returns to the WDTX or the stay is lifted in the NDCA, the court and the parties will resume activity in the parallel proceedings.

Factor 2: As explained in the Factor 1 analysis, the district court case may return to the WDTX. By Petitioner's own calculations, the estimated WDTX trial date is October 2025 (Paper 2 at 103), and the estimated FWD date is October 2025 as well (Paper 7 at 1). Thus, this factor is at best neutral.

Factor 4 favors denying institution. There is significant overlap between the district court and this proceeding because all claims asserted in the parallel litigation are also contested here in the IPR. (Paper 6 at 45.) When the stay is lifted, the risk of conflict between the two proceedings will increase, especially

since Petitioner has not given a *Sotera*-type stipulation. (See Paper 6 at 46.)

Factor 5 weighs significantly in favor of denying institution because the parties in both matters are identical. (Paper 6 at 47.) See *Fintiv*, at 13-14. Petitioner's reliance on the non-precedential institution decision in *Amazon v. Zentian*, IPR2023-01195, Paper 10 at 3 (PTAB Jan. 10, 2024) is misplaced because the facts there were different: Amazon sought to join Apple's petition that had already been granted, and *Fintiv*'s Factor 2 outweighed all other factors because the trial date was significantly later than the FWD due date. *Id.* at 9-11. Further, the Board should disregard Petitioner's argument tying Factors 2 and 5 under *Amazon* and *Protect Animals*, because Petitioner could have but failed to raise it in the Petition. (Compare Paper 2 at 104, with Paper 7 at 2.)

Factor 6 favors denying institution because the Petition failed to establish compelling merits. Contrary to Petitioner's argument, the POPR's position on the single-reference obviousness grounds is correct as a matter of law (*see II infra*), and the POPR established that Petitioner failed to show anticipation by Keith (Ground 4) because at a minimum the Petition does not explain what structure in Keith is allegedly equivalent to claim element 1[A]. (Paper 6 at 34-35.) Also, the Petition's bare boned, conclusory statements violate the particularity requirement, regardless of what may or may not be disclosed in their expert's declaration. *E.g.*, *Adaptics Ltd. v. Perfect Co.*, IPR2018-01596, Paper 20 at 17 (P.T.A.B. Mar. 6, 2019). *Xerox* favors PO's position because there the PTAB Director held that the

Board correctly gave little weight to the expert’s conclusory declaration in support of the petition, and that the petition itself was conclusory and did not warrant institution. *Xerox v. Bytemark*, IPR2022-00624, Paper 12 at 2-5 (Feb. 10, 2023).

II. Petitioner Failed to Make Requisite Showings Under *Stepan*

To begin, Petitioner only focuses on a POSITA’s motivation to combine and does not deny that it failed to show a reasonable expectation of success. (*See* Paper 7 at 2-3.) Its motivation to combine arguments are unavailing for at least three reasons. **First**, *Stepan* does not exempt specific classes of cases from the requisite showings. Rather, it teaches that whether the petitioner is combining disclosures from multiple references, or multiple embodiments/multiple elements from a single reference, “there must be a motivation to make the combination and a reasonable expectation that such a combination would be successful[.]” *Stepan*, 868 F.3d at 1346 n.1. **Second**, Petitioner does not rely on a *single* embodiment in Keith (Ground 5). For example, Petitioner admits that “Keith does not appear to disclose [*i.e.*, there is no single embodiment] using these two parameters at the vehicle charge computer 72 for interruption detection.” (Paper 2 at 102.) **Third**, assertions of Petitioner’s expert regarding “[POSITA’s] common knowledge” (Ex. 1009, ¶¶ 133, 257) are insufficient to establish a motivation to combine and reasonable expectation of success. *In re Van Os*, 844 F.3d 1359, 1361 (Fed. Cir. 2017) (such statements are “no different than merely stating the combination ‘would have been obvious’”).

Dated: June 28, 2024

/Jason Shapiro/
Jason Shapiro
Registration No. 35,354
Michael A. Siem
Registration No. 47,316
Cedric C.Y. Tan
Registration No. 56,082
Lynn Lehnert
Registration No. 54,678
Devlin Law Firm LLC
Nadiia Loizides (*pro hac vice* to be
filed)
1526 Gilpin Ave.
Wilmington, DE 19806
Telephone: (302) 449-9010

*Counsel for Patent Owner Graphite
Charging Company, LLC*

**CERTIFICATE OF SERVICE
UNDER 37 C.F.R. § 42.6(e)(4)**

The undersigned hereby certifies that a copy of the foregoing Patent Owner's Sur-Reply was served on June 28, 2024, by filing this document through the Patent Trial and Appeal Board End to End System as well as delivering a copy via electronic mail upon the following email addresses for the attorneys of record for the Petitioner: Tesla-Graphite243-IPR@morganlewis.com and pmargulies@tesla.com.

Dated: June 28, 2024

/Jason Shapiro/

Jason Shapiro
Registration No. 35,354
Devlin Law Firm LLC
1526 Gilpin Ave.
Wilmington, DE 19806

*Counsel for Patent Owner Graphite
Charging Company, LLC*