

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

PATENT OWNER'S MOTION TO EXCLUDE

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 CONTENTS

I.	INTRODUCTION.....	1
II.	LEGAL STANDARD	1
III.	ARGUMENT.....	1
	A. The Board Should Exclude Ex-1011	1
	B. The Board Should Exclude Ex-1020.....	3
	C. The Board Should Exclude Certain Portions of Ex-1009, Dr. MacCarley’s Declaration in This IPR.....	4
	D. The Board Should Exclude Certain Portions of Ex-1021, Transcript of Dr. Kirk Cameron’s Deposition in This IPR	5
	E. The Board Should Exclude Certain Portions of Ex-1026, Errata Sheet of Dr. Kirk Cameron’s Deposition.....	6
	F. The Board Should Exclude Certain Portions of the Petition (Paper 2).....	6
	G. The Board Should Exclude Certain Portions of Petitioner’s Reply (Paper 26) 7	
IV.	CONCLUSION.....	8

TABLE OF AUTHORITIES

Statutes

37 C.F.R. § 42.20	1
37 C.F.R. § 42.6	5
37 C.F.R. § 42.62	1
37 C.F.R. § 42.64	1, 3
Fed. R. Evid. 402	5
Fed. R. Evid. 801	2
Fed. R. Evid. 802	3
Fed. R. Evid. 901	2

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.64(c), Patent Owner Graphite Charing Company, LLC (“PO”) moves the Board to exclude from the record (“Motion”) inadmissible exhibits submitted by Petitioner Tesla, Inc. (“Petitioner”), specifically, Ex-1011 and Ex-1020, as well as corresponding portions of the Declaration of Petitioner’s expert Dr. C. Arthur MacCarley (Ex-1009), Petitioner’s briefing (Papers 2 and 26) and Petitioner’s line of questioning eliciting testimony of PO’s expert Dr. Kirk Cameron regarding inadmissible evidence (Ex-1021 and Ex-1026).

It is not enough for the Board to find that this Motion is moot if the Board does not rely on the inadmissible exhibits and portions of the briefing in reaching its Final Written Decision. If these exhibits and portions of Petitioner’s briefing remain in the record, Petitioner may seek to rely on them on appeal to the U.S. Court of Appeals for the Federal Circuit, and PO could be unfairly prejudiced.

II. LEGAL STANDARD

The party moving to exclude evidence bears the burden of proof to establish that it is entitled to the relief requested—namely, that the material sought to be excluded is inadmissible under the Federal Rules of Evidence. *See* 37 C.F.R. §§ 42.20(c), 42.62(a).

III. ARGUMENT

A. The Board Should Exclude Ex-1011

The Board should exclude Ex-1011 (purporting to be a copy of SAE Standard J1772 (“J1772”)) in its entirety. Petitioner relied on Ex-1011 in its Reply (Paper 26 at 17-18), the Declaration of its expert Dr. MacCarley (Ex-1009, ¶¶ 19, 56, 68, 146, 154, 269, 270), and during the deposition of PO’s expert Dr. Cameron (Ex-1021 at 51:11-53:6; *id.* at 53:22-55:6). Moreover, Petitioner did **not** rely on Ex-1011 in its Petition beyond a general statement that a POSITA would have familiarity with J1772 (Paper 2 at 6), and a broad citation to fifty-five paragraphs of Dr. MacCarley’s declaration purportedly discussing J1772 (*id.* at 36 (citing Ex-1009 ¶¶ 44-95 as “also discussing confirmation from J1772”)).

PO timely objected to Ex-1011 as inadmissible. (Paper 17 at 3.) Among other things, Ex-1011 is unauthenticated because Petitioner has failed to produce “sufficient evidence to support a finding that the item is what the proponent claims it is.” Fed. R. Evid. 901(a). For example, Petitioner alleged a publication date but has not provided sufficient evidence pursuant to Fed. R. Evid. 901(b) or otherwise satisfying the requirement of Fed. R. Evid. 901(a).

PO also timely objected to Ex-1011 as hearsay under Fed. R. Evid. 801(c) and therefore inadmissible under Fed. R. Evid. 802. (Paper 17 at 3.) For example, Petitioner and its expert relied on Ex-1011 for the truth of the matter asserted therein. (*See, e.g.*, Ex-1009 at 26-27, 33, 76, and 123.) Yet Petitioner has not offered sufficient evidence that Ex-1011 falls within any exception of the rule

against hearsay under Fed. R. Evid. 802.

PO timely objected to Ex-1011 as being irrelevant under Fed. R. Evid. 401 and thus inadmissible under Fed. R. Evid. 402, or as being confusing or a waste of time under Fed. R. Evid. 403 because Ex-1011 is inadmissible as explained above. (Paper 17 at 3.) The fact that Petitioner does not rely on Ex-1011 for any substantive proposition in the Petition shows that Ex-1011 cannot make any fact of consequence in this IPR more or less probative, which particularly underscores the irrelevance of this exhibit.

Notably, Dr. MacCarley's Supplemental Declaration served on PO on or around September 5, 2024, did not cure the identified deficiencies. Among other things, Dr. MacCarley failed to establish where he obtained Ex-1011, whether the copy submitted in this IPR was altered, and whether it was even published. (*See* Ex-1015, ¶ 2.)

B. The Board Should Exclude Ex-1020

The Board should exclude Ex-1020 (U.S. Patent No. 8,918,657 to Cameron *et al.*) in its entirety. Petitioner belatedly—and without the Board's authorization—introduced Ex-1020 during the deposition of Dr. Cameron in this IPR, and thereafter relied on Ex-1020 in the same deposition (Ex-1021 at 83:5-86:11; *id.* at 132:10-11; *id.* at 128:3-132:13) and in its Reply (Paper 26 at 3 n.2).

Pursuant to 37 C.F.R. § 42.64(a), counsel for PO timely objected to

admissibility of Ex-1020 “as being belatedly presented without proper authorization by the [B]oard, not authenticated, irrelevant, potentially hearsay depending on what you’re relying on it for, confusing, and a waste of time.” (Ex-1021 at 128:11-17; *see also* 83:21-84:4.)

Notably, Petitioner failed to cure PO’s objection during that deposition, nor did it seek to stipulate on the deposition record to cure the identified deficiencies at a later time. *See* 37 C.F.R. § 42.64(a).

C. The Board Should Exclude Certain Portions of Ex-1009, Dr. MacCarley’s Declaration in This IPR

The Board should exclude the following portions of Ex-1009, Dr. MacCarley’s Declaration in this IPR (Ex-1009):

- Ex-1009, ¶¶ 19, 56, 68, 146, 154, 269, 270 (references to Ex-1011 (J1772), which is not properly part of the record).
- *Id.* ¶ 44-95 (portions that were impermissibly incorporated by reference into the Petition). Petitioner relied on these portions of Ex-1009 in the Petition (Paper 2 at 36) and Reply (Paper 26 at 18).

As noted above, PO timely objected to the admissibility of Ex-1011 and Petitioner did not cure PO’s objections. (Paper 17 at 3; *supra* Part III.A.) Therefore, the portions of Ex-1009 (Dr. MacCarley’s Declaration) referencing Ex-1011 should be excluded from the record.

PO likewise timely objected to Ex-1009 as containing arguments that are

incorporated by reference into the Petition in violation of at least 37 C.F.R. § 42.6(a)(3); irrelevant under Fed. R. Evid. 401 and inadmissible under Fed. R. Evid. 402, or as being confusing or a waste of time under Fed. R. Evid. 403. (Paper 17 at 2; Paper 24 at 41, Paper 27 at 16-17.) Such arguments in Ex-1009 should be excluded from the record.

D. The Board Should Exclude Certain Portions of Ex-1021, Transcript of Dr. Kirk Cameron's Deposition in This IPR

The Board should exclude at least the following portions of Ex-1021, Transcript of Dr. Cameron's deposition in this IPR:

- Ex-1021 at 51:11-53:6; and
- *id.* at 53:22-55:6.

These portions are inadmissible because they reflect the line of Petitioner's questions seeking to elicit Dr. Cameron's testimony regarding J1772, which is not properly part of the record, as explained *supra* Part III.A and in PO's objections (Paper 17 at 3).

Additionally, the Board should exclude the following portions of Ex-1021:

- Ex-1021 at 83:5-86:11;
- *id.* at 132:10-11; and
- *id.* at 128:3-132:13.

These portions of Ex-1021 are inadmissible because they reflect the line of Petitioner's questions seeking to elicit Dr. Cameron's testimony regarding Ex-1020

(U.S. Patent No. 8,918,657 to Cameron *et al.*), which is not properly part of the record, as explained *supra* Part III.B. Petitioner relied on these portions of Ex-1021 in its Reply. (Paper 26 at 3 n.2.)

PO timely and repeatedly objected to the line of Petitioner's questioning seeking to elicit testimony regarding Ex-1020 during the deposition of Dr. Cameron in this IPR "as being belatedly presented without proper authorization by the [B]oard, not authenticated, irrelevant, potentially hearsay depending on what you're relying on it for, confusing, and a waste of time." (Ex-1021 at 128:11-17; *see also* 83:21-84:4.)

E. The Board Should Exclude Certain Portions of Ex-1026, Errata Sheet of Dr. Kirk Cameron's Deposition

For the same reasons as in *supra* Parts III.A, C & D, the Board should exclude references to J1772 in Ex-1026, the errata sheet for Dr. Cameron's deposition transcript in this IPR (Ex-1021). Specifically, Ex-1026 refers to J1772 to correct typographical errors in the name of that standard on pages 47-48 of Ex-1021. (Ex-1026 at 1.) PO was compelled to make these corrections to preserve the integrity of the record. However, because J1772 was never properly part of the record, as PO explained in its Objections (Paper 17 at 3), these portions of Ex-1026 should be excluded.

F. The Board Should Exclude Certain Portions of the Petition (Paper 2)

The Board should exclude the following Portions of the Petition:

- Paper 2 at 6 (a general statement that a POSITA would have familiarity with Ex-1011 (J1772));
- *id.* at 36 (citing Ex-1009 ¶¶ 44-95 as “also discussing confirmation from J1772”));
- *id.* at 18, 53, 57, 101 (citing to portions of Dr. MacCarley’s declaration that referenced J1772).

PO timely objected to these portions of the Petition as inadmissible because they refer to inadmissible Ex-1011 and impermissibly incorporate arguments from Dr. MacCarley’s Declaration in violation of 37 C.F.R. § 42.6(a)(3). (Paper 17 at 2; Paper 24 at 41, Paper 27 at 16-17.) PO timely objected to admissibility of Ex-1009 and Ex-1011 as well. (Paper 17 at 2-3.)

G. The Board Should Exclude Certain Portions of Petitioner’s Reply (Paper 26)

The Board should exclude at least the following portions of Petitioner’s Reply:

- Paper 26 at 17-18 (the last full paragraph in Part IV.A of the Reply discussing Ex-1011 (the J1772 standard) and what it purportedly discloses); and
- *id.* at 3 n.2 (discussing Ex-1020 that is not properly part of the record and counsel for Petitioner’s line of questioning regarding Ex-1020

during the deposition of Dr. Cameron in Ex-1021).

These portions of the Reply are inadmissible for the same reasons as Ex-1011, Ex-1020, and certain portions of Petition, Ex-1009, and Ex-1021, as explained *supra* Parts III.A-D & F.

IV. CONCLUSION

For the foregoing reasons, PO respectfully requests that this Motion be granted in its entirety.

Dated: April 16, 2025

/Jason M. Shapiro/
Jason M. Shapiro
Reg. No. 35,354
DEVLIN LAW FIRM LLC
1526 Gilpin Ave.
Wilmington, DE 19806
Tel: (302) 449-9010
jshapiro@devlinlawfirm.com
Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned certifies that on April 16, 2025, pursuant to 37 C.F.R. § 42.6(e), a copy of **PATENT OWNER’S MOTION TO EXCLUDE** was served via email (as consented to by counsel) to counsel of record for Petitioner as follows:

LEAD COUNSEL	BACKUP COUNSEL
Alexander B. Stein, Reg. No. 71,397 Alexander.stein@morganlewis.com	Paul Margulies, Reg. No. 59,580 pmargulies@tesla.com
Additional email for service: Tesla-Graphite391-IPR@morganlewis.com	

/Jason M. Shapiro/

Jason M. Shapiro
Reg. No. 35,354