

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 STRIKE

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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TABLE OF EXHIBITS

Exhibit	Description
2001	N.D. Cal Graphite District Court Litigation
2002	Graphite v. Tesla, Dkt. No. 64
2003	Loizides PHV Affidavit
2004	Stay Order NDCA
2005	Cameron Declaration
2006	Kirk Cameron CV
2007	Transcript- CArthurMacCarley

I. INTRODUCTION

Pursuant to the Board’s email authorization from April 25, 2025, Patent Owner Graphite Charging Co. LLC (“PO” or “Graphite”) respectfully requests that the Board strike the following exhibits, as well as corresponding portions of Petitioner Tesla, Inc.’s (“Petitioner”) briefing.

II. RELEVANT LEGAL STANDARDS

A. New Arguments and Evidence

“A reply may only respond to arguments raised in the corresponding opposition, patent owner preliminary response, patent owner response, or decision on institution.” 37 § C.F.R. 42.23(b). “Once the Board identifies new issues presented for the first time in reply, neither this court nor the Board must parse the reply brief to determine which, if any, parts of that brief are responsive, and which are improper.” *Intelligent Bio-Systems, Inc. v. Illumina Cambridge, Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (affirming the Board’s refusal to consider the petitioner’s reply brief and accompanying declaration). “Petitioner may not submit new evidence or argument in reply that it could have presented earlier, *e.g.* to make out a prima facie case of unpatentability.” *Lenovo Hold. Co. v. DoDots Licensing Solutions LLC*, IPR2019-01278, Paper 25 at 5 (PTAB Sept. 9, 2020) (quoting Consol. Tr. Practice Guide (“CTPG”)); *see also MOM Enter. v. Vieth*, IPR2023-00726, Paper 89 at 8 (PTAB May 9, 2024) (granting-in-part the patent owner’s

motion to strike where the petitioner, among other things, used previously asserted arguments to support a new theory in the reply); *Laboratoire Francais Du Fractionnement et des Biotechnologies S.A. v. Novo Nordisk HealthCare AG*, Paper 109 at 15-21 (PTAB Apr. 13, 2022).

B. Belated Submission Without Authorization

A party seeking to introduce evidence beyond that expressly permitted by the PTAB's rules must contact the Board to seek authorization before filing the new evidence, as counseled by the CTPG. 37 C.F.R. § 42.123; 37 C.F.R. § 42.223; *Cradlepoint, Inc. v. 3G Licensing S.A.*, IPR2021-01141, Paper 18 at 2 (PTAB Dec. 7, 2021) (granting the patent owner's motion to strike the petitioner's declaration filed with its reply without seeking authorization); *Lenovo*, IPR2019-01278, Paper 25 at 6-7 (granting the patent owner's motion to strike the petitioner's belated reply argument and related new exhibit and affidavit); *Colgate-Palmolive Co. v. Noble Innovations NC L.L.C.*, IPR2023-01254, Paper 35 at 5 (PTAB Nov. 12, 2024); CTPG at 75-76.

III. ARGUMENT

A. Ex-1020 (U.S. Patent No. 8,918,657 to Cameron *et al.*) in Its Entirety

Ex-1020 should be stricken in its entirety because it was belatedly filed as an exhibit to Petitioner's Reply without authorization in violation of the Board's

procedure.¹ *See, e.g., Cradlepoint*, IPR2021-01141, Paper 18 at 2.

Petitioner relied on Ex-1020 in its Reply to erroneously suggest that a patent's specification must contain a definitions section to indicate that it contains definitions. (See Paper 26 at 3 n.2.) Petitioner also relied on Ex-1020 in an impermissible line of questioning based on this belatedly submitted evidence. (Ex-1021 at 83:5-86:11; *id.* at 132:10-11; *id.* at 128:3-132:13.)

B. Ex-1022 (Excerpt from Wiley Electrical and Electronics Engineering Dictionary) in Its Entirety

Ex-1022 should be stricken in its entirety because it was belatedly filed as an exhibit to Petitioner's Reply without the Board's authorization. Petitioner relied on Ex-1022 in its Reply to belatedly construe the term "request" (Paper 26 at 13), despite previously asserting that no construction was necessary because all terms should be given their plain and ordinary meaning (Paper 2 at 6). Thus, this is a

¹ Ex-2020 is also subject to PO's motion to exclude on different, evidentiary grounds, including as irrelevant, unauthenticated, and hearsay. (Paper 32 at 3-4.) While PO's counsel mentioned in its motion to exclude that it objected to Ex-2020 during Dr. Cameron's deposition because, among other things, Ex-2020 was belatedly introduced without authorization ((Ex-1021 at 128:11-17; *see also id.* 83:21-84:4), PO did not develop this argument either in that motion (Paper 32), or its reply in support of that motion.

new argument that could have been submitted in the Petition and in fact contradicts the Petition (*id.* at 6), and Dr. MacCarley’s testimony (Ex-1009, ¶ 34). PO will be prejudiced if Ex-1022 is not stricken because it was first presented after PO deposed Petitioner’s expert, thereby depriving PO of the opportunity to question Petitioner’s expert about the exhibit.

C. Ex-1023 (Excerpt from The Authoritative Dictionary of IEEE) in Its Entirety

Ex-1023 should be stricken in its entirety because it was belatedly filed as an exhibit to Petitioner’s Reply without the Board’s authorization. Petitioner relied on Ex-1023 in its Reply to belatedly construe the term “response” (Paper 26 at 13), despite previously asserting that no construction was necessary because all terms should be given their plain and ordinary meaning (Paper 2 at 6). Thus, this is a new argument that could have been submitted in the Petition and in fact contradicts the Petition (*id.* at 6), and Dr. MacCarley’s testimony (Ex-1009, ¶ 34). PO will be prejudiced if Ex-1023 is not stricken because it was first presented after PO deposed Petitioner’s expert, thereby depriving PO of the opportunity to question Petitioner’s expert about this exhibit.

D. Ex-1024 (Exhibit 14 as cited in Patent Owner’s Complaint in District Court Case No. DCA-3-24-cv-02717) in Its Entirety

Ex-1024 should be stricken in its entirety because it was belatedly filed as an exhibit to Petitioner’s Reply without the Board’s authorization. Petitioner relied

on Ex-1024 in its Reply to belatedly argue that

dynamic load management configurations are not user specified; instead, “dynamic Power Management continuously monitors the available power in your panel and adjusts your Wall Connector charge rate based on *electrical usage in your home*,”

(Paper 26 at 11 (emphasis added).) However, as PO explained in its sur-reply, Ex-1024 concerns Tesla’s Superchargers used during long-distance travel and not electrical usage at home. (Paper 27 at 10-11 (citing Ex-1024, 3).) Accordingly, this is a new argument/theory based on misrepresentation of Ex-1024.

Additionally, Petitioner had an opportunity to present Ex-1024 earlier because Petitioner admits that Ex-1024 was “cited in Patent Owner’s Complaint in District Court Case No. DCA-3-24-cv-02717.” (Paper 26 at ii.) Petitioner cannot argue that it was unaware of the complaint or Ex-1024 when it filed its Petition. (See Ex-1014; Paper 2 at 104.) PO will be prejudiced if Ex-1024 is not stricken because it was first presented after PO deposed Petitioner’s expert, thereby depriving PO of the opportunity to question Petitioner’s expert about this exhibit.

E. Ex-1025 (U.S. Published Patent Application No. 2009/017780 to Lowenthal “Lowenthal”) in Its Entirety

Ex-1025 should be stricken in its entirety because it was belatedly filed without the Board’s authorization. Petitioner relied on Ex-1025 in its Reply, in support of its argument that “the intrinsic record includes a reference to J1772 (Ex-1025 ¶0036)[.]” (Paper 26 at 18.) Petitioner also alluded to Ex-1025 during the

deposition of Dr. Cameron. (Ex-1021 at 52:8–53:6.)

The IDS listing Ex-1025 was included in the prosecution history that Petitioner filed alongside the Petition (Ex-1007 at 75; Paper 2 at 6). Thus, Petitioner cannot show that it could not have introduced this evidence earlier. PO will be prejudiced if Ex-1025 is not stricken because it was first presented after PO deposed Petitioner’s expert, thereby depriving PO of the opportunity to question Petitioner’s expert about this exhibit.

F. Certain Portions of the Reply (Paper 26)

The first full paragraph on page 11 of Petitioner’s Reply (starting with the word “**Third**” and ending with “invalidity.”) is based on Petitioner’s mischaracterization of belatedly introduced and unauthorized Ex-1024. (See Paper 26 at 11.) This paragraph should be stricken in its entirety for the same reasons as explained *supra* Part III.D and in PO’s Sur-Reply (Paper 27 at 10-11).

The first two full paragraphs on page 13 of Petitioner’s Reply (starting with the word “Extrinsic” and ending with “it.”) are based on Petitioner’s belated construction of the terms “request” and “response” based on belatedly introduced and unauthorized Ex-1022 and Ex-1023. (See Paper 26 at 13.) These two paragraphs should be stricken in their entirety for the same reasons as explained *supra* Part III.B-C.

IV. CONCLUSION

For these reasons, PO respectfully requests that this Motion be granted.

Dated: April 30, 2025

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(c)(2), the undersigned certifies that this reply brief does not exceed 7 pages, excluding any table of contents, table of authorities, mandatory notices under 37 C.F.R. § 42.8, certificate of word count, certificate of service, or appendix of exhibits. This certification relies on the word count of the word-processing system used to prepare this paper.

/Jason M. Shapiro/

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CERTIFICATE OF SERVICE

The undersigned certifies that on April 30, 2025, pursuant to 37 C.F.R. § 42.6(e), a copy of **PATENT OWNER’S REQUEST FOR ORAL ARGUMENT** was served via email (as consented to by counsel) to counsel of record for Petitioner as follows:

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