

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 REPLY IN SUPPORT OF
ITS 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. THE MOTION SHOULD BE GRANTED IN ITS ENTIRETY 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.....3

 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 5

 F. The Board Should Exclude Certain Portions of the Petition (Paper 2)
 and Reply (Paper 26) 5

TABLE OF AUTHORITIES

Cases	Page(s)
<i>Google v. IPA Techs.</i> , IPR2019-00730, Paper 72 (PTAB Sept. 16, 2020).	4
<i>Parus Holds. v. Google LLC</i> , 70 F.4th 1365 (Fed. Cir. 2023).	5
<i>RTI Surgical v. LifeNet Health</i> , IPR2019-00571, Paper 75 (PTAB Aug. 14, 2020).	4
Rules	
Fed. R. Evid. 703.	4
Fed. R. Evid. 803(17).....	2
Fed. R. Evid. 901(8).....	1

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. THE MOTION SHOULD BE GRANTED IN ITS ENTIRETY¹

A. The Board Should Exclude Ex-1011

Ex-1011 remains unauthenticated. *First*, Petitioner argues that it is “authentic” (Paper 33 at 3), but it provided no supplemental evidence proving it. Notably, Petitioner did not even refer to Dr. MacCarley’s Supplemental Declaration (Ex-1015) for support because it did not cure Ex-1011’s identified defects. *Second*, Petitioner submits that Dr. MacCarley’s testimony (Ex-1009, ¶¶ 19, 56, 68, 146, 154, 269, 270) authenticates it. Those paragraphs discuss the purported teachings of J1772, and cannot prove that Ex-1011 is an authentic, unaltered copy of J1772.

Third, Petitioner argues that Ex-1011 is an ancient document under Fed. R. Evid. 901(8), and that it was in a place where it would likely be because footers on each page of Ex-1011 indicate where it is available for download. (Paper 33 at 3.) However, all footers in Ex-1011 state that this document was “[l]icensed to Morgan Lewis & Bockius LLP user[,]” along with the order number and prohibition on copying and networking. Thus, Ex-1011’s footers contradict testimony from Dr. MacCarley’s Supplemental Declaration that “[he] obtained the Standard [J1772] and provided it to Petitioner’s Counsel.” (Ex-1015, ¶ 2.)

Ex-1011 is hearsay. *First*, Petitioner is wrong that Ex-1011 is not hearsay

¹ Capitalized terms should be given the same meaning as in the Motion.

because it does not rely on it for anything other than a POSITA's general knowledge of chargers for electric vehicles. (Paper 33 at 4.) While the Petition only generally cited to Ex-1011 (Paper 2 at 6, 36), Dr. MacCarley extensively discussed the contents of J1772 (purportedly attached as Ex-1011) and offered the teachings of J1772 as proof of the truth of what it asserts (*see, e.g.*, Ex-1009, ¶ 56).

Second, Petitioner is wrong that Ex-1011 is admissible under Fed. R. Evid. 803(17) even if hearsay because it is relied on people in the automotive industry. There is a dispute regarding whether a POSITA would be familiar with J1772. (Paper 24 at 17-19.) Also, Fed. R. Evid. 803(17) concerns "Market Reports and Similar Commercial Publications," and J1772 is neither, as Petitioner admits. (Paper 33 at 4 (J1772 is an industry standard).)

Ex-1011 is irrelevant. ***First***, contrary to Petitioner's intimation, Dr. Cameron never admitted that J1772 is relevant—his position is diametrically opposite. (Ex-2005, ¶¶39-42.) ***Second***, the intrinsic evidence at best shows that J1772 is relevant for examples of suitable receptacles and cables. (Ex-1025, ¶44.)

Third, Ex-1011 is irrelevant to the issue of motivation to combine Keith and Nor (Paper 33 at 6) because the discussion of data and communication pathways in J1772 appear only in Dr. MacCarley's Declaration and not in the Petition and is therefore impermissible incorporation by reference. (*Compare* Ex-1009, ¶¶269-270, *with* Paper 2 at 101.)

B. The Board Should Exclude Ex-1020

First, Dr. Cameron did not authenticate Ex-1020. Rather, he explained that he relied on Petitioner: “I assume you got it off of a reputable source” (Ex-1021 at 129:15-16.) *Second*, Ex-1020 is hearsay. The “truth of matter asserted” in Ex-1020 on which Petitioner relies is that Dr. Cameron and his co-inventors chose to include the definition section, complete with the word “definitions” there. (Ex-1020 at 129:25–132:13.) *Third*, Ex-1020 is irrelevant because nothing requires that a patentee include or not to include a definition section in the specification. *Fourth*, it is untimely/unauthorized as will be explained in PO’s motion to strike.

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

First, Petitioner is wrong that PO had failed to raise objections to Dr. MacCarley’s Declaration “regarding citations to Ex-1011” before the Motion. (Paper 33 at 8 n.1.) PO timely alerted Petitioner of its position that certain portions of Ex-1009 were improperly incorporated by reference. (Paper 6 at 8, 18, 19, 21-22; Paper 24 at 41; Paper 27 at 16-17.)

Second, Petitioner argues that the at-issue portions of MacCarley’s Declaration should not be excluded even if Ex-1011 is inadmissible because Ex-1011’s probative value outweighs its prejudicial effect. (Paper 33 at 9.) However, Petitioner fails to explain how Ex-1011’s probative value “substantially outweighs” its prejudicial effect, as required by Fed. R. Evid. 703. Also, there is a

dispute whether a POSITA “would reasonably rely on” it “in forming an opinion . . .” Fed. R. Evid. 703. (*See* Motion at 2; *supra* Part I.A; Paper 24 at 17-19.)

RTI is distinguishable because there the patent owner showed a connection between sales data and secondary considerations (instead of conclusory statements as here) and the documents were part of a prior litigation over the same patent.

RTI Surgical v. LifeNet Health, IPR2019-00571, Paper 75 at 7-9 (PTAB Aug. 14, 2020).

Google is inapposite because there the Board, *inter alia*, (i) denied as moot the patent owner’s motion to exclude five exhibits they were not relied on, and (ii) afforded limited value to three exhibits due to their prejudicial effect. *Google v. IPA Techs.*, IPR2019-00730, Paper 72 at 19-20, 27-29 (PTAB Sept. 16, 2020).

Regarding other exhibits, the Board found that they did not exceed the proper scope, were used by the patent owner or authenticated. *Id.* at 27-30.

Third, Petitioner is wrong that paragraphs 44-95 of Dr. MacCarley’s Declaration were not improperly incorporated by reference because they were “cited” in the Petition and because this is “consistent with common Board practice.” (Paper 33 at 10.) Petitioner’s conclusory argument that J1772 purportedly confirms claim 1’s invalidity is based solely on a cite to fifty-two paragraphs (¶¶44-95) of Dr. MacCarley’s Declaration. (Paper 2 at 36.) Such incorporation by reference is expressly prohibited. 37 C.F.R. § 42.65(a)(3). And

nothing “mandates that the Board review evidence and issues introduced by a party in violation of its rules” *Parus Holds. v. Google LLC*, 70 F.4th 1365, 1372 (Fed. Cir. 2023).

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

First, Petitioner argues that PO is wrong that Ex-1011 and Ex-1020 are inadmissible. This argument fails for the same reasons as explained in the Motion (Paper 32 at 1-3, 5-6) and *supra* Part I.A-B. *Second*, Petitioner submits that PO conducted redirect examination and therefore already “exercised” “the opportunity to clarify the record.” (Paper 33 at 10 n.2.) However, it was always PO’s position that Ex-1011 and Ex-1020 were not properly part of the record, and indeed PO objected to the introduction of Ex-1020 during Dr. Cameron’s deposition. (Ex-1021 at 128:11-17; *id.* at 83:21-84:4.) No further “clarify[ication]” is necessary.

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

Contrary to Petitioner’s argument, there is nothing “strange” in PO’s motion to exclude Ex-1026. If the Board excludes J1772 and references to it from Ex-1020, nothing justifies leaving references to J1772 in the related errata sheet.

F. The Board Should Exclude Certain Portions of the Petition (Paper 2) and Reply (Paper 26)

Petitioner provides no separate arguments, and thus the Motion should be granted for the reasons detailed in Paper 32 at 6-8 and *supra* Part I.A-D.

Respectfully submitted,

Dated: April 30, 2025

/Jason M. Shapiro/

Jason M. Shapiro

Reg. No. 35,354

Nadiia Loizides (*pro hac vice*)

DEVLIN LAW FIRM LLC

1526 Gilpin Ave.

Wilmington, DE 19806

Tel: (302) 449-9010

jshapiro@devlinlawfirm.com

nloizides@devlinlawfirm.com

Counsel for Patent Owner

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(c)(2), the undersigned certifies that this reply brief does not exceed 5 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/

Jason M. Shapiro

Reg. No. 35,354

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:

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