

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA, INC.,

v.

GRAPHITE CHARGING COMPANY LLC,
Patent Owner.

Case No. IPR2024-00387

Patent No. 8,103,391

**PETITIONER'S OPPOSITION TO
PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW**

1. Introduction

Patent Owner (“PO”) presents a scattershot attack on the Final Written Decision (“FWD”) by improperly relitigating issues the Board correctly decided. And even if PO were to prevail on any of its arguments, PO could not receive the reversal it seeks. The Board elected not to address Grounds 4-6 as unnecessary to the resolution of the proceeding. FWD at 55. The most relief PO could receive is reconsideration of Grounds 1-3 and, if necessary, consideration of the unadjudicated grounds. But PO should not receive a second bite at the apple. While PO may disagree with the Board, it identifies no errors requiring correction.

PO starts by relitigating claim construction, inviting the Board and now the Director to commit the “cardinal sin” of claim construction by reading the specification into the claims. *Laitram v. NEC*, 163 F.3d 1342, 1347 (Fed. Cir. 1998). Because the specification lacks any hallmarks of lexicography or disavowal, PO has identified no error in the Board’s handling of claim construction.

PO’s other challenges fare no better, as the Board did not create new invalidity grounds, read out claim limitations, or ignore evidence it was required to credit. The Board properly applied the definition of a skilled artisan it adopted, which PO does not challenge in its Request for Director Review (“Request”), and weighed the relevant evidence. Finally, the Board considered—and rejected—PO’s baseless

expert-bias argument. PO has shown no error in the Board’s handling of that issue. The FWD should be left undisturbed.

2. Argument

2.1 PO Identifies No Error in the Board’s Claim Construction

Although ostensibly framed around two purported arguments, PO raises haphazard complaints loosely related to claim construction. But PO misapprehends the law. PO shows no error in the Board’s handling of claim construction.

2.1.A Claim Construction Is a Question of Law

“The ultimate construction of the claim is a legal question.” *Info-Hold, Inc. v. Applied Media Techs. Corp.*, 783 F.3d 1262, 1265 (Fed. Cir. 2015). As such, neither party bears the burden of proving the correct claim construction, as it is the Board’s job “to ascribe the meaning to claim terms as a person of ordinary skill in the art at the time of invention would have understood them.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–14 (Fed. Cir. 2005) (en banc).

Petitioner suggested “no express constructions are required in this proceeding.” Petition at 6; *see U.S. Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554, 1568 (Fed. Cir. 1997) (court need not construe a term if its plain and ordinary meaning is clear and unambiguous). PO now accuses Petitioner of failing to meet its claim construction “burden” and the Board of “improperly shift[ing] the burden of proof to PO” on claim construction. Request at 2. That is nonsensical. While the

petitioner carries the burden of proving unpatentability, neither party carries the burden of “proving” the correct claim construction for any given term. Indeed, “the Board may adopt a claim construction of a disputed term that neither party proposes.” *Qualcomm Inc. v. Intel Corp.*, 6 F.4th 1256, 1262–63 (Fed. Cir. 2021). Therefore, the Board could not—and did not—“improperly shift the burden of proof to PO” on claim construction. Regardless, as discussed below, PO demonstrated no error in the Board’s claim construction.

2.1.B The Patentees Did Not Act as Lexicographers

PO’s claim construction challenges primarily revolve around lexicography—*i.e.*, according to PO, the plain and ordinary meanings of several claim terms do not apply because the patentees set forth alternative definitions in the specification. To be their own lexicographers, patentees must use a “special definition of the term [that] is **clearly stated** in the patent specification or file history.” *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1580 (Fed. Cir. 1996).¹

PO argues the patentees “defined all the disputed terms in the specification.” Request at 3-4. But there are no such definitions and even the basic hallmarks of lexicography are missing. *Cf. Alnylam Pharm., Inc. v. Moderna, Inc.*, 138 F.4th 1326, 1333 (Fed. Cir. 2025) (having a section of “definitions,” setting terms off in

¹ All emphases added.

quotation marks, characterizing a term as “refer[ing] to” something, and using contrasting non-limiting language elsewhere all indicate lexicography). PO relies only on specification language that describes figures and preferred embodiments, without any definitional intent. Request 3-4.

Laryngeal Mask Co. Ltd. v. Ambu, 618 F.3d 1367, 1372 (Fed. Cir. 2010), is instructive. In that case the parties disputed whether the claimed backplate must contain a tube joint. The specification explained: “The backplate 52 has a . . . tube-joint 92 oriented proximally relative to the bowl, as shown in FIGS. 5 and 6.” *Id.* The Federal Circuit declined to find lexicography, explaining “[t]his sentence, . . . is not enough to require every backplate to include a tube joint. . . . The specification does not clearly contain such a special definition.” *Id.* (citations omitted). The specification passages on which PO relies here are similar to those analyzed in *Laryngeal*, with references to specific figures, numbers, and preferred embodiments. As in *Laryngeal*, there is no lexicography.

PO also relies on discredited (and rebutted) testimony from its expert Dr. Cameron on how a skilled artisan would understand the terms. *Compare* Request at 5 *with* FWD at 21, 26. But the Board need not rely on the extrinsic evidence to resolve the claim construction dispute because “[i]n most situations, an analysis of the intrinsic evidence alone will resolve any ambiguity in a disputed claim term. In such circumstances, it is **improper to rely on extrinsic evidence.**” FWD at 21

(citing *Vitronics*, 90 F.3d at 1580). PO shows no error in the Board’s reliance on solely intrinsic evidence.

Finally, the Board did not err in considering the specification as a whole. FWD at 14. While the Federal Circuit has instructed that “boilerplate language, without more, is not sufficient to overcome the **explicit** description of the present invention,” *SandBox Logistics LLC v. Proppant Express Invs.*, 813 F. App’x 548, 553 n.8 (Fed. Cir. 2020), there is no such **explicit** description of **the present invention** here. And, in any event, the Board only “note[d]” the specification’s language at the beginning of its analysis; the Board did not indicate any purported boilerplate language controlled the outcome. FWD at 14.

2.1.C The Specification Lacks Any Claim Scope Disavowal

PO alternatively argues that the patentees disavowed all but PO’s proposed narrow constructions of “request” and “response” as messages including headers and bodies. Request at 5. But as a preliminary matter, PO never made this argument in its PO Response. PO never referenced disavowal when addressing the construction of “request” or “response.” *See Finjan, Inc. v. Cisco Sys., Inc.*, 837 F. App’x 799, 809 n.10 (Fed. Cir. 2020) (any argument not raised in PO Response is forfeited).

Regardless, the argument fails on the merits. The specification only vaguely discusses improving on “rudimentary energy transactions” by providing “flexibl[ity]” and “interoperabl[ity].” Ex. 1001 at 6:65-7:2, 7:12-16. It is silent

about a header and a body in a request or a response. PO relies solely on its expert Dr. Cameron’s testimony for those additional requirements. Request at 5-6.

Similarly, PO points to Dr. Cameron’s testimony to argue that the Board’s constructions exclude an embodiment from the specification because—according to Dr. Cameron—the term “data services interruption” excludes intra-system communications abnormalities. Request at 6. But an expert’s testimony “cannot overcome the plain language of the claims,” especially where—as is the case here—the expert suggests “read[ing] such a limitation into them.” *Kara Tech. Inc. v. Stamps.com Inc.*, 582 F.3d 1341, 1348 (Fed. Cir. 2009). The Board did not err in declining to credit Dr. Cameron’s *ipse dixit* testimony. *See Apple Inc. v. MPH Techs. Oy*, 28 F.4th 254, 262 (Fed. Cir. 2022) (Board is “free to reject” an “expert’s testimony based on a lack of factual support”).

2.1.D The Board Was Not Required to Specify the Plain and Ordinary Meaning

PO next cites to *O2 Micro International Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1360 (Fed. Cir. 2008), to argue the Board was required to “specify the plain and ordinary meanings” of its claim constructions. Request at 7. But in *O2 Micro*, the Federal Circuit held it is improper to leave the **jury** to consider claim construction arguments. 521 F.3d at 1360. There is no jury in a Board proceeding. *O2 Micro* does not apply.

In *Homeland Housewares, LLC v. Whirlpool Corp.*, 865 F.3d 1372, 1375 (Fed. Cir. 2017), the Federal Circuit explained that the Board must only resolve claim construction disputes that affect the outcome. Here, the Board rejected PO's proposed unduly narrow claim constructions and held the challenged claims unpatentable in view of Kimura alone or in combination with Hotta under the plain and ordinary meanings of the terms. As even PO acknowledges, the Board explicitly stated its interpretation of "request" and "response" as not excluding "the use of [] signals." FWD at 22. The Board's analysis is more than sufficient to resolve the parties' dispute and allow for future review—which is all that is required. *See Gechter v. Davidson*, 116 F.3d 1454, 1459 (Fed. Cir. 1997) (Board must only provide an appropriate level of specificity necessary for review).

2.1.E PO's Remaining Complaints Are Unavailing

Finally, PO characterizes its expert's testimony on claim construction as "unrebutted" and criticizes the Board for not considering other extrinsic evidence when the Board was not required to do so. *Vitronics Corp.*, 90 F.3d at 1583; *see also Granite Constr. Co. v. United States*, 962 F.2d 998, 1006 (Fed. Cir. 1992) (recognizing the Board "may reject even uncontroverted expert testimony when it is intrinsically unpersuasive"). Further, Dr. Cameron's views were **rebutted** by at least his own cross examination, the prosecution history, and dictionary definitions. *E.g.*, FWD at 21. That the Board did not rely on any of the extrinsic evidence does

not make Dr. Cameron’s views unchallenged, nor would it force the Board to accept these opinions. In fact, the Board separately made it clear that even if it had considered Dr. Cameron’s testimony on claim construction, it would not have credited it. FWD at 21-22.

PO also accuses the Board of “*sua sponte* introduc[ing] evidence of instructions in Hotta when the Petition did not as much as mention the word ‘instruction.’” Request at 8. This argument is meritless for at least four reasons. *First*, the Petition mentions the word “instruction” 36 times. *Second*, the Board rejected PO’s argument that the “manual override interruption” should be construed as “an instruction.” FWD at 45-46. Therefore, any analysis the Board performed as to whether Hotta disclosed instructions is irrelevant to the outcome. *Third*, the Board made it clear it addressed “instructions” while responding to an argument **PO raised**. *Id.* There is nothing improper in the Board explaining both why it credited Petitioner’s arguments and evidence and rejected PO’s arguments based on the record. *Fourth*, the Board credited Dr. MacCarley’s interpretation of Hotta’s Figure 1 at ¶¶ 150-152 of his declaration. FWD at 47. Those paragraphs included annotations showing that Hotta’s switch 52 provides an input (*i.e.*, instructions) to the controller 21. *Id.* The Board therefore did not raise any evidence *sua sponte*. PO has shown no error.

2.2 The Board Did Not Create a New Invalidity Theory

PO accuses the Board of creating a new invalidity theory that is an amalgamation of arguments made under Ground 1 and Ground 2. Request at 10. But PO is again mistaken.

Claim 5 requires “wherein the one or more interruptions is the preference interruption, and the preference interruption is detected from a violation of a preference selected by a participant to the charging process.” In invalidating claim 5 under Ground 1, the Board adopted both of Petitioners theories: (1) Kimura’s disclosure of the use of a factory preset EEPROM discloses claim 5’s limitation, and (2) Kimura’s disclosure of a DIP switch discloses claim 5’s limitation. FWD at 38. Both were discussed in the Petition in Ground 1. *See* Petition at 38-40 (EEPROM); *id.* at 27 (DIP switch); *id.* at 38 (cross reference to earlier DIP switch discussion). Therefore, PO’s representation that it was not on notice of Petitioner’s arguments related to the DIP switch is false. Regardless, either theory is enough for unpatentability. Again, PO has shown no error that could change the outcome.

While the Board did cite to Petitioner’s expert Dr. MacCarley’s declaration at ¶¶ 157-158, which relates to Ground 2, that is not improper either, as “the Board must consider the entirety of the record before it.” *Aqua Products, Inc. v. Matal*, 872 F.3d 1290, 1296 (Fed. Cir. 2017) (en banc). Regardless, the Board could have cited to Dr. MacCarley’s declaration at ¶ 84, which relates to Ground 1 and provides a comparable opinion. To the extent there was any citation error, it was harmless

and does not change the analysis or the result. Further, the Board held claim 5 unpatentable under Ground 2, so even if the Director agreed with PO as to the Board's treatment of claim 5 in Ground 1, claim 5 stands unpatentable in Ground 2.

Similarly, for claims 7, 14, and 19, the Board relied on both the EEPROM and the DIP switch. FWD at 43-44. And, in any event, the Board only addressed the EEPROM and DIP switch when discussing "additional[]" issues with PO's patentability arguments had the Board adopted PO's proposed claim construction for claim 7. *Id.* at 43. The Board had already "decline[d] to limit the claim scope" as PO requests, mooted this issue. *Id.*

2.3 The Board Did Not Read Out Claim Language, Nor Did It Ignore Relevant Evidence under Ground 1

PO makes three additional arguments related to claims 7, 14, and 19 and the Board's analysis in Ground 1.

First, PO accuses the Board of ignoring its argument that Petitioner failed to prove that Ground 1 discloses "an operational parameter from the set of operational parameters that conform to the set of predefined interrupt conditions." Request at 10. But the Board considered the argument and "determine[d] that Kimura's battery voltage is an **operational parameter that is identified from a set of operational parameters** from a set of predefined interrupt conditions, including the voltage threshold." FWD at 43; *see also id.* at 40 ("in Kimura, after the voltage exceeds the

voltage threshold, the charger controller 14 outputs a charge inhibit signal and terminates the charging process”).

Second, PO argues that the claimed operational parameter must be identified during a pre-charge stage and not at another time. Request at 11. While PO acknowledges the Board considered (and rejected) this argument, PO asserts the Board’s conclusion is unsupported. *Id.* PO is again mistaken and seeks to re-argue its case. Like its claim construction arguments, PO asks the Director to read limitations from preferred embodiments into the claims. But PO takes it one step further, asking the Director to transform the specification’s disclosure of a preferred embodiment where “all parties of the transaction are presented with the conditions governing the charging transaction . . . **relevant to their role in the transaction**” during the precharge phase into a claim requirement that an **operational parameter cannot be identified outside the precharge phase**. Request at 11. As the Board properly found, “Patent Owner does not explain adequately, for example, how a disclosure of presenting conditions to parties during a pre-charge phase precludes identifying operational parameters at another time.” FWD at 42. The Board did not err in making that finding.

Third, PO rehashes its argument in the previous section that the DIP switches were not addressed in the Petition’s Ground 1. For the reasons explained in Section 2.2, *supra*, PO’s argument is misguided.

2.4 The Board Did Not Otherwise Abuse Its Discretion

2.4.1 The Board Did Not Misapply Its Own POSITA Definition

PO next accuses the Board of misapplying its POSITA definition. Request at 12. According to PO, since the Board declined to find that a POSITA must have experience with electric-vehicle charging, it was error to credit Petitioner's expert Dr. MacCarley's opinions due to his experience with electric-vehicle charging.

But PO again misunderstands the law. The POSITA's skill and the weight to be given to expert testimony are two separate issues. To be admissible, PO's expert Dr. Cameron needed to testify from the perspective of a POSITA, which the Board found he could despite lacking electric-vehicle charging experience. That Dr. Cameron's testimony was admissible does not mean the Board was required to give Dr. Cameron's testimony weight equal to the contrary testimony from Dr. MacCarley, an expert with more relevant experience. *See In re Zyprexa Products Liab. Litig.*, 489 F. Supp. 2d 230, 282 (E.D.N.Y. 2007) ("Assertions that the witness lacks particular educational or other experiential background go to the weight, not the admissibility, of the testimony.") (citing *McCulloch v. H.B. Fuller Co.*, 61 F.3d 1038, 1044 (2d Cir. 1995)); *Am. Express Co. v. Harvey Lunenfeld*, CBM2014-00050, 2015 WL 3397147, at *8 (PTAB May 22, 2015) (the Board is "capable of discerning from the testimony, and the evidence presented, whether the witness's

testimony is entitled to any weight, and taking into consideration the areas of expertise of each witness in weighing that testimony accordingly”).

Similarly, PO accuses the Board of taking an inconsistent position on the Society of Automotive Engineers J1772 standard, which Petitioner cited as evidence of what was known to skilled artisans. Request at 13. But the Board was entirely consistent. At page 10 of the FWD the Board acknowledged the Petition addressed the J1772 standard under the heading “Level of Ordinary Skill.” The Board declined to reach the issue of whether a POSITA would have been familiar with the J1772 standard “as part of this determination of the general description of the level of ordinary skill in the art.” *Id.* But the Board noted the issue is later “address[ed] below, in the context of Petitioner’s grounds” on page 49. *Id.* There was no internal inconsistency in the Board’s treatment of J1772. PO misreads the Board’s opinion.

PO also argues that the Board improperly credited Dr. MacCarley’s testimony based on the J1772 standard, but that too is a misreading. The Board explained it “need not rely on the substance of the J1772 standard because, even without it, we find to be credible the unrebutted testimony of Dr. MacCarley that a person of ordinary skill in the art would have known that a manual stop was required.” FWD at 49. The Board again based this determination in part on Dr. MacCarley’s relevant experience working with electric vehicles, including charging. Since Dr. Cameron lacked such experience, he could not rebut that opinion. PO cannot show error in

that determination. *See SEB S.A. v. Montgomery Ward & Co.*, 594 F.3d 1360, 1373 (Fed. Cir. 2010) (expert testimony admissible where testimony established an “adequate relationship” between witness’s experience and the claimed invention).

For claim 2 in Ground 2, PO also accuses the Board of citing to testimony in Dr. MacCarley’s declaration at ¶ 154 related to purported common knowledge. Request at 2. But PO argues an argument depending on ¶ 154 was missing from the Petition. *Id.* But that too is nonsensical, as even PO acknowledges Petitioner cited directly to ¶ 154 in Ground 2 of the Petition. *Id.* Thus, PO was on notice and had an opportunity to be heard on the issue. *See Hamilton Beach Brands, Inc. v. f’real Foods, LLC*, 908 F.3d 1328, 1339 (Fed. Cir. 2018) (no APA violation where party had notice of the contested issues and an opportunity to be heard).

2.4.2 The Board Properly Addressed PO’s Bias Argument

Finally, PO argues that Petitioner’s expert Dr. MacCarley was biased in favor of Petitioner and accuses the Board of “summarily dismissing” its concerns. Request at 15. But PO is wrong on the facts and on the law.

On the facts, PO contends the evidence of bias is un rebutted. But Dr. MacCarley swore a financial disinterest and testified that Tesla never offered to or gave him or his students any money. Ex. 2007, 81:19-23; Ex. 1009, ¶¶ 3-14.

On the law, PO cites nothing to support entitlement to any relief. To the contrary, even if Dr. MacCarley had a financial interest in Tesla—and the record

shows he does not—“a witness’s pecuniary interest in the outcome of a case goes to the probative weight of testimony, not its admissibility.” *Ethicon, Inc. v. U.S. Surgical Corp.*, 135 F.3d 1456, 1465 (Fed. Cir. 1998) (no abuse of discretion in admitting witness testimony into evidence, subject to cross-examination that might expose bias). PO deposed Dr. MacCarley about his alleged bias, and the Board considered the argument and the testimony. PO may disagree with the Board’s conclusion, but it cannot show the Board abused its discretion in considering Dr. MacCarley’s opinions.

3. Conclusion

PO seeks to relitigate issues properly resolved by the Board and invites the Director to introduce—rather than correct—error based on a misrepresentation of the law, the facts, and the FWD. Indeed, PO repeatedly asks the Director to commit the “cardinal sin” of claim construction and read descriptions of preferred embodiments from the specification into the claims.

Director Review is not appropriate for every case, and PO has shown no entitlement to the extraordinary relief it seeks. For the foregoing reasons, Petitioner respectfully requests that the Board deny PO’s Request for Director Review.

Dated: September 9, 2025

Respectfully Submitted,

/ Alexander B. Stein /
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), lead counsel for Petitioner hereby certifies that a copy of this Opposition was served on September 9th via email to Patent Owner's counsel of record:

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