

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. IPR2024-00388

U.S. Patent No. 8,291,243

**PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

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PETITIONER’S EXHIBIT LIST

<u>Exhibit</u>	<u>Description</u>
Ex-1001	U.S. Patent No. 8,291,243 (“’243 Patent”)
Ex-1002	Prosecution History of the ’243 Patent
Ex-1003	Declaration of Expert, Dr. C. Arthur MacCarley, Ph.D., P.E.
Ex-1004	Curriculum Vitae of Dr. C. Arthur MacCarley, Ph.D., P.E.
Ex-1005	PCT Patent App. Pub. No. 2006/096854 to Wang <i>et al.</i> (“Wang”)
Ex-1006	Archived Copies of Published Data from the Alberta Electric Supply Operator (“AESO Report”)
Ex-1007	U.S. Patent No. 9,052,904 to Cooley <i>et al.</i> (“Cooley”)
Ex-1008	Order on Reexamination for Control No. 90/019,303
Ex-1009	Federal Court Management Statistics – Profiles (Sept. 30, 2023)
Ex-1010	District Court Complaint (Aug. 4, 2023)
Ex-1011	Motion for Extensions of Time (Jan. 26, 2024)
Ex-1012	Alberta Electrical Supply System Study (Oct. 2004)
Ex-1013	Alberta Electric Supply Operator – Help Page (Mar. 2007)
Ex-1014	RSS Article (Sept. 13, 2006)
Ex-1015	History of Power Article (Oct. 1, 2022)
Ex-1016	U.S. Patent No. 5,673,497 to St. Louis (“St. Louis”)

Ex-1017	Alliance Laundry Systems – Home Laundry Dryers Service Manual (Apr. 2002) (“Service Manual”)
Ex-1018	Internet Archive Affidavit (Feb. 7, 2024)

As authorized by the Board on June 10, 2024, Petitioner hereby replies to Patent Owner's Preliminary Response (Paper 6, POPR).

I. DISCRETIONARY DENIAL IS NOT WARRANTED.

A. The *Fintiv* Factors Favor Institution.

Factor 1. The POPR says that “there is currently no stay in effect..., nor is one pending.” Paper 6 at 51. But the district court case is now stayed. *See Graphite Charging Co. LLC v. Tesla, Inc.*, No. 3-24-cv-02717, Dkt. No. 77 at 2-3 (N.D. Cal. May 31, 2024) (hereinafter “Stay Order”). After transfer to the Northern District of California (“NDCA”), a stay was entered “pending resolution, including any appeal(s), of Tesla’s IPR proceedings on the Asserted Patents and Graphite’s forthcoming petition for writ of mandamus [regarding the transfer motion], whichever is resolved later.” *Id.* Accordingly, Factor 1 strongly supports institution.

Factor 2. With the case stayed and the expected time-to-trial in NDCA (36.7 months) increasing by nearly a year versus WDTX (25.8 months), Ex-1009, 37 and 66, any trial would be well after the projected Final Written Decision (Aug. 2025).

Factors 3-4. Patent Owner’s arguments about investment in the parallel proceeding (Paper 6 at 53-54) are incorrect given the stay. Although “the motion to transfer has been resolved,” the parties will *not* be required “to comply with several discovery deadlines in June and July 2024.” *Id.* No *Markman* hearing or substantive discovery will occur. There will also be no overlapping invalidity issues during the

stay. The parties agree that the case “is [still] in its infancy” and has made no meaningful progress. Stay Order at 2. Thus, Factors 3-4 favor institution.

Factor 5. *Amazon* remains persuasive. Other PTAB panels have confirmed Factor 5 is—at worst—neutral under similar circumstances. *See, e.g., Protect Animals v. Onpoint Sys., LLC*, IPR2021-01483, Paper 11 at 17 (PTAB Mar. 4, 2022).

Factor 6. The Petition advances compelling merits, and the POPR does not undermine this showing. Instead, the POPR raises unsubstantiated contentions based on ignoring relevant portions of the prior art, including portions of Wang that explicitly discuss combining the embodiments and related data cited in the Petition. *See* Pet. at 77-78. PO also appears to believe that compelling merits are undermined if an expert elaborates on technical support for arguments raised in the Petition. That is not the case. PO’s apparent position (i.e., that the expert declaration and Petition must be identical) would render the Board’s precedential *Xerox* case meaningless. Thus, even if Factors 1-5 favored denial (they do not), the Board need not discretionarily deny given the compelling merits presented here.

B. The *General Plastic* Factors Favor Institution.

General Plastic Factor 1 favors institution because Petitioner has not previously filed a petition directed to the same claims of the same patent. *General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 15-16. Nevertheless, Patent Owner says Factor 1 weighs against institution due to Unified’s

reexamination and Petitioner “is a paying member of Unified.” Paper 6 at 43. That is wrong. “Board decisions have routinely determined Factor 1 does not weigh in favor of exercising discretion to deny institution when Unified was the earlier challenger and the Petitioner in the second Petition was a member of Unified.” *Tesla v. Charge Fusion*, IPR2023-00062, Paper 13 at 9 (PTAB May 11, 2023).

Although Factor 1 “is not limited solely to instances when multiple petitions are filed by the same petitioner” and “different petitioners” *may* still warrant weighing Factor 1 in favor of denial, there must be a “significant relationship” between the parties “with respect to the challenged patent.” *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11 at 9-10 (PTAB Apr. 2, 2019).

There is no “significant relationship” here. Unified and Petitioner are not co-defendants in the parallel proceeding, and there is no common or related product that Patent Owner has accused of infringement. *Cf. id.* at 10. There is “no business relationship involving the accused products or technology between Unified and Petitioner.” *Netflix Inc. v. DIVX, LLC*, IPR2020-00052, Paper 42 at 11 (PTAB May 10, 2020). There is no evidence of any interactions or agreements about the accused products. *Ford Motor Co. v. Neo Wireless LLC*, IPR2023-00763, Paper 28 at 10-11 (PTAB Mar. 22, 2024). And there is no “road mapping” based on the prior filing. *Box, Inc. v. Topia Tech., Inc.*, IPR2023-00427, Paper 17 at 22 (PTAB Aug. 4, 2023).

Patent Owner’s citation to *Toyota Motor Corp. v. Intellectual Ventures II*

LLC, IPR2022-00708, Paper 12 (PTAB Oct. 10, 2022), does not change the result. Paper 6 at 44. Although the Board in *Toyota* stated that “Unified’s subscription fees provide an incentive to challenge patents asserted against its members,” the Board found “that alone **does not create the type of ‘significant relationship’ that was found in *Valve* to favor denying institution.**” *Id.* at 10 (emphasis added).

Notably, where “the first and second petitioners are neither the same party, nor possess a significant relationship under *Valve*,” factor one “necessarily outweighs the other *General Plastic* factors.” *Videndum Prod. Sol’ns, Inc. v. Rotolight Ltd.*, IPR2023-01218, Paper 12 (PTAB Apr. 19, 2024). PO’s analysis of Factors 2-6 depends almost entirely on its theory that the Petition is a follow-on to the Unified reexam, which is incorrect for the reasons explained above.

General Plastic factors—as a whole (Pet. at 8-9)—pose no bar to institution.

II. GROUND 1 HAS A REASONABLE EXPECTATION OF SUCCESS.

The POPR contends that the Petition fails to articulate a reasonable expectation of success for Ground 1. That is incorrect. Petitioner showed a reasonable expectation of success supported by expert testimony, *e.g.*: “Given the interchangeable nature taught for various features of Wang’s embodiments,” and the “common components ... confirming combinability of aspects of the disclosed embodiments,” a person of ordinary skill in the art (POSA) “would have had a reasonable expectation of success in combining features of the embodiments.” Pet.

at 77-78. The POPR describes the Petition’s reasoning as “[u]nsupported attorney argument,” but the positions in the Petition are adequately support by expert testimony. Pet. at 12, 23, 55-57, 63, 68, 77-78 (citing Ex-1003 ¶¶ 60, 177, 201-203).

Critically, if a POSA can implement a “predictable variation [between two separate embodiments], § 103 likely bars patentability.” *Boston Sci. Scimed, Inc. v. Cordis Corp.*, 554 F.3d 982, 991 (Fed. Cir. 2009) (“Combining two embodiments disclosed adjacent to each other in a prior art patent does not require a leap of inventiveness”). Indeed, the Board has found a reasonable expectation of success where an obviousness argument relies on “the core function” of the claims, “which cuts across all embodiments.” *Intel Corp. v. Pact XPP Schweiz AG*, IPR2020-00539, Paper 35 at 32-33 (PTAB Sept. 8, 2021). That is the case here, as the Petition showed. Pet. 4-5, 12-77 (focusing on Wang’s power consumption management techniques across the publication’s disclosures). By ignoring the *Boston Scientific* case, PO’s arguments miss the mark. PO presents no credible argument that combining Wang’s closely linked embodiments would have been outside of a POSA’s skillset. The Petition’s reasonable expectation of success position is sufficient and adequately supported by expert testimony. Nothing further is required.

Dated: June 17, 2024

Respectfully Submitted,

/ Alexander B. Stein /
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CERTIFICATE OF SERVICE

I certify that on June 17, 2024, I caused a true and correct copy of the foregoing reply to be served via electronic mail to Patent Owner's designated counsel, listed below:

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