

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

**PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO
STAY REEXAMINATION**

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Exhibit	Description
2001	U.S. Office of Personnel Management, Federal Holidays Overview, <i>available at</i> https://www.opm.gov/policy-data-oversight/pay-leave/federal-holidays/#url=2024 (last visited May 24, 2024)
2002	Unified Patents, Members
2003	<i>Tesla Inc. Annual Income Statement</i> , Wall St. J., https://www.wsj.com/market-data/quotes/TSLA/financials/annual/income-statement (last visited May 21, 2024)
2004	Non-Final Office Action, <i>Ex Parte</i> Reexamination of U.S. Patent No. 8,291,243, Control No. 90/019,303 (Apr. 11, 2024)
2005	Docket Report from May 24, 2024, <i>Graphite Charging Co. LLC v. Tesla, Inc.</i> , Case No. 3:24-cv-02717-VC (N.D. Ca.)
2006	Order Setting Initial Case Management Conference and ADR Deadlines, <i>Graphite Charging Co. LLC v. Tesla, Inc.</i> , Case No. 3:24-cv-02717-VC (N.D. Ca. May 7, 2024)
2007	Affidavit of Ms. Nadiia Loizides in Support of PO's Motion for <i>Pro Hac Vice</i> Admission
2008	Joint Stipulation and Order Regarding Stay Pending Resolution of Petitions for <i>Inter Partes</i> Review and Mandamus as Amended, <i>Graphite Charging Co. LLC v. Tesla, Inc.</i> , Case No. 3:24-cv-02717-VC (N.D. Ca. May 31, 2024)
2009	Request for <i>Ex Parte</i> Reexamination of U.S. Patent No. 8,291,243, Control No. 90/019,303
2010	PO's Response to Non-Final Office Action (July 11, 2024)
2011	References from PO's July 11, 2024 IDS Considered by the Examiner (Aug. 21, 2024)

Petitioner Tesla, Inc.’s (“Petitioner”) Motion to Stay *Ex Parte* Reexamination No. 90/019,303 (Paper 20, “Motion”) should be denied for the following reasons.

I. RELEVANT PROCEDURAL HISTORY

A. *Ex Parte* Reexamination No. 90/019,303

On November 21, 2023, Unified Patents, LLC (“Unified”), of which Petitioner is a member, requested *ex parte* reexamination (“EPR”) of claims 1, 3-6, 9-11, 15, 16, 18, and 19 of U.S. Patent. No. 8,291,243 (“243 patent”) based on Miller, Forth, Yellopeddy, and Gardner. (Ex. 2009.) On December 12, 2023, the Office ordered EPR of those claims. (Ex. 1019.) In response to the Non-Final Office Action (“NFOA”) of April 11, 2024, Patent Owner (“PO”) amended claims 1, 11-15, and 18, and added new claims 21-52. (Ex. 1024 at 19.) In the Final Office Action (“FOA”) of August 21, 2024, claims 1, 3-6, 9-16, 18-19, 25, and 27-52 were allowed, and new claims 21-24 and 26 were rejected. (*Id.* at 19; Ex. 1021 at 12.) On September 11, 2024, PO filed an after-final Response cancelling new claims 21-22 and amending new claims 23-24 and 26. (Ex. 1024 at 19.) Prosecution is now closed.

B. IPR 2024-00388

On February 14, 2024, Petitioner filed an IPR Petition challenging claims 1-20 based on Wang, AESO Report, and Cooley. (Paper 2 at 7.) An Institution Decision (“ID”) issued on August 27, 2024. On August 29, 2024, after most claims

were allowed in the EPR, Petitioner requested leave to file the Motion.¹

II. ALL FACTORS FAVOR DENYING THE MOTION

A. The Respective Timeline and Stage of Each Proceeding Weighs Heavily in Favor of Denial (Factors 6 & 7)

The respective timeline and stage of each proceeding favors denial because the EPR is essentially done while the IPR is just beginning. Prosecution closed in the EPR on August 21, 2024 upon the entry of a FOA allowing all the amended claims and almost all of the new claims. (Ex. 1021 at 12.) PO filed its Response to the FOA on September 11, 2024. (Ex. 1024 at 19.) Since prosecution is closed, and EPRs are statutorily required to be “conducted with special dispatch,” 35 U.S.C. § 305, a decision whether to issue a Notice of Intent to Issue Reexamination Certificate (“NIRC”) is imminent. A stay “at this late stage would mean that the work that had been done was wasted.” *Arctic Cat, Inc. v. Polaris Industries, Inc.*, IPR2015-01781, Paper 78 at 3 (PTAB Sept. 25, 2018).

In contrast, the IPR is in its early stages, with the ID issued on August 27, 2024—*after* the FOA. (Paper 15.) While the IPR is subject to a statutory deadline that requires a FWD within one year of institution, the deadline is not until August 27, 2025. Any motions for reconsideration, appeals, and remands would extend the

¹ Petitioner knew of the EPR when it filed the Petition. (Paper 2 at 1.) Therefore, the Motion should be denied as untimely. *See Toshiba Corp. v. Intellectual Ventures II LLC*, IPR2014-00317, Paper 10 at 3 (PTAB May 6, 2014).

duration of this proceeding further. The almost-completed EPR should thus be allowed to proceed. *Arctic Cat*, IPR2015-01781, Paper 78 (denying a stay because, among other things, the FOA had been entered); *Mastercard Int’l Inc. v. D’Agostino*, IPR2014-00543, Paper 14 (PTAB October 2, 2014).

Petitioner’s *first* counterargument—that “the timing of the EPR is unknown and uncertain”—fails because it is based on Petitioner’s fundamental misunderstanding of the EPR procedure and ignores the fact that prosecution in the EPR is closed. *See, e.g.*, M.P.E.P. § 2272. *Quest* and *Google*, on which Petitioner relies, are distinguishable. In both cases, the Board expressly found that “[b]oth proceedings [were] at an early stage.” *Quest Diagnostics Inc. v. Ravgen, Inc.*, IPR2021-00791, Paper 25 at 8 (PTAB Dec. 15, 2021); *Google LLC v. Ecofactor, Inc.*, IPR2021-00054, Paper 12 at 4 (PTAB Jun. 28, 2021). Petitioner’s *second* counterargument—that the EPR has not yet considered the ID—is irrelevant because the ID did not address the limitations added by amendment in the EPR.

B. A Reexam Decision Will Simplify Issues in the IPR (Factor 8)

Since all of the original claims have been amended and deemed patentable in the EPR, a NIRC would render any IPR “decision as to the patentability of original claims . . . at issue in this proceeding . . . moot and purely advisory.” *M & P Golf, LLC v. Max Out Golf, LLC*, IPR2016-00784, Paper 43 at 4 (PTAB Aug. 30, 2017). At the same time, the IPR would not resolve patentability of new claims in the EPR

reciting the “multiple thresholds” limitation that is not at issue in the IPR, including new claims 23, 24, 26, 33, 40, and 47. (Ex. 1024 at 10-14, 16.) Thus, Factor 8 weighs in favor of denial.

C. The Claims at Issue in the IPR and EPR are Different (Factor 1)

The fact that the claims challenged in the IPR are different than those at issue in the EPR weighs in favor of denial. As noted, original claims 1-20 are challenged in the IPR. In the EPR, original claims 1-20 were amended (via amendment of independent claims 1, 11, 15 and 18) and new claims 21-52 were added. (Ex. 1020 at 20-23.) New claims 23, 24, 26, 33, 40, and 47 recite a new “multiple thresholds” limitation not found in the original claims. (*Id.*) Even if, as alleged by Petitioner, there is overlap between one claim in the IPR and some claims in the EPR, the overlap is not complete. *See Arctic Cat*, IPR2015-01781, Paper 78 at 4 (declining to stay where the overlap was not “complete” and the IPR would not address all the same issues).

Petitioner’s counterarguments are of no avail. **First**, it is false that “the same claims [are] at issue” (Paper 20 at 4) because PO amended all original claims and added new claims with limitations not found in the original claims. **Second**, Petitioner’s argument that some overlap remains between the original claims and the claims in the EPR (*id.* at 4-5) is unsubstantiated. Specifically, Petitioner asserts that amended claim 1 incorporates the “applying a **weighing function**” limitation from

original claim 8. (*Id.* at 4-5 (emphasis original).) Amended claim 1 actually recites, in relevant part, “wherein analyzing the operating environment feed data to determine an indication of a high demand for electric power from the power grid system comprises inputting the operating environmental condition data into a weighting function.” (Ex. 1024 at 3.) Thus, amended claim 1 is different in scope than original claim 8 reciting at 8[i] “applying a weighted function comprising a linear combination of values obtained from a plurality of different feeds, each of the different feeds having a weight.”² (*Id.* at 5.) These and the other differences between the claims in the IPR and EPR weigh in favor of denial.

D. The Grounds and Prior Art in the IPR and EPR Differ (Factor 2)

As an initial matter, Petitioner admits that the “EPR uses different prior art than the IPR.” (Paper 20 at 5.) This alone is enough to conclude that this factor favors denial of the Motion. Indeed, the Board’s prior decisions are clear—at least a partial overlap is required for a finding that this factor favors a stay. *See, e.g., Samsung Electronics v. Power2B Inc.*, IPR2022-00334 and IPR2022-01378, Paper 11 (Feb. 21, 2023); *Fox Factory, Inc. v. SRAM, LLC*, IPR2017-01440, Paper 32

² It should also be noted that original claim 8 was not challenged in the EPR (Ex. 2004 at 4), as Petitioner admits (Paper 20 at 4), and neither Petitioner nor its expert cited any prior art that discloses the “weighing function” limitation of original claim 8 (*see* Paper 2 at 55-56; Ex. 1003 ¶¶ 145-146). The Board did not separately analyze claim 8 in the ID (Paper 15 at 36), while the EPR reviewed the Petition and accompanying exhibits and found amended claim 1 patentable (Ex. 2010 at 2; Ex. 2011 at 1).

(PTAB June 4, 2018). Here, there is no overlap because Petitioner relied on Wang, AESO Report, and Cooley in the IPR. (Paper 2 at 7.) Entirely different references—Forth, Miller, Yellepedy, and Gardner—were asserted in the EPR. (Ex. 2004 at 5.)

Petitioner’s counterarguments fail to overcome the lack of overlap in the grounds and art. **First**, Petitioner mischaracterizes the record by arguing PO did not provide the reexamination panel with notice of the IPR until September 6, 2024, and that “[t]here is no indication that the U.S. Patent Examiner has considered the Board’s opinions concerning the different prior art” (Paper 20 at 5-6.) In fact, PO provided the Examiner with copies of the Petition and IPR exhibits concurrently with its July 11, 2024 Response to the NFOA, *i.e.*, **over two months ago**. (Ex. 2010 at 2.) Moreover, the Examiner confirmed in writing that she considered the Petition and IPR exhibits. (Ex. 2011.)

Second, Petitioner argues that “staying the EPR will ensure that the grounds presented here . . . are fully considered.” (Paper 20 at 6.) But “fully” considering the original claims, after the Examiner has already considered them during the EPR, is the quintessence of wasting time and resources, complication of issues, and duplication of efforts. *See M & P Golf*, IPR2016-00784, Paper 43 at 3-4.

Third, relying on *Google*, Petitioner submits that the Board should consider an alleged overlap between the original claims and certain **unspecified** elements of amended claims under Factor 2. (Paper 20 at 5.) However, each Notice factor is

evaluated independently and *Google* supports PO because there the Board declined to consider the purported overlap in the claims under Factor 2 and concluded that Factor 2 weighed against a stay due to lack of overlap between the prior art. *Google*, IPR2021-00054, Paper 12 at 3-4.

E. Allowing the EPR to Proceed Will Not Duplicate Efforts or Create Inconsistent Results (Factors 3 & 4)

Allowing the EPR to continue will not duplicate efforts or create inconsistent results because all the original claims have been amended rendering the IPR issues moot. Further, the two proceedings involve different art. A stay would save little work because prosecution is closed in the EPR. In fact, the work that has been done would be wasted. *Arctic Cat*, IPR2015-01781, Paper 78 at 3; *c.f. Valeo North America, Inc. v. Schaeffler Techs. AG & Co. KG*, IPR2016-00502, Paper 44 at 7 (PTAB July 20, 2017). Therefore, Factor 3 favors denial.

Petitioner's counterarguments fail to show that allowing the EPR to proceed will duplicate efforts or create inconsistent results. **First**, Petitioner laments that different branches of the Office need to review "overlapping" claims. (Paper 20 at 6.) But the Examiner has already indicated that the amended original claims are allowable, and therefore the Board does not need to look at the original claims post-NIRC. Only if the stay is granted will the Board have to review them again duplicating the efforts. *Quest v. Ravgen* and *Google* are distinguishable because in those cases, little work had been done in either proceeding. *Quest*, IPR2021-00791,

Paper 25 at 8; *Google*, IPR2021-00054, Paper 12 at 4.

Second, Petitioner argues that it has a stake in the final outcome as to the original claims. (Paper 20 at 6.) If so, Petitioner should welcome the expected NIRC and not hinder its issuance. And Petitioner is not estopped from challenging the validity of reexamined claims in the future. **Third**, Petitioner argues that PO can pursue amendments in the IPR. (*Id.* at 6.) But that would be duplication and a waste of the Office and PO's efforts, as explained directly above and *supra* Part II.A-B.

Fourth, there is no risk of inconsistent results from the parallel advancement of the EPR and IRP (Paper 20 at 7) because of differences in claims, art, and timelines. Indeed, the timelines here and in *Cannon*, on which Petitioner relies, are reversed. There, the PGR was nearing the FWD when stay was granted, while the reissue claims had not yet been examined and no Office Action entered. *Canon, Inc. v. Hidehiko Nakajima*, PGR2018-00090, Paper 16 at 4-5 (PTAB Nov. 6, 2019), *FWD issued*, Paper 17 (PTAB Mar. 5, 2020).

Fifth, Petitioner's estoppel effect argument (Paper 20 at 8) repackages its lack of patent distinctiveness argument under Factor 1, and is refuted *supra* Part II.C.

F. All Original Claims Have Been Amended in the EPR (Factor 5)

As indicated above, all original claims have been amended and indicated as allowable in the EPR. Thus, if the EPR is allowed to continue, there will remain no original claims at issue, and thus no original claim scope will be affected. Therefore,

this factor weighs in favor of denial.

Petitioner's counterarguments are unconvincing. **First**, Petitioner argues that, absent a stay, PO "will continue to propose amendments in the EPR" (Paper 20 at 8.) As explained above, Petitioner misunderstands the EPR procedure. Prosecution is closed in the EPR. *Supra* Parts I.A, II.A & II.C. PO is procedurally restricted from submitting additional amendments after a FOA. *See* 37 C.F.R. § 1.116; M.P.E.P. §§ 2254, 2271. Accordingly, there is no real risk of continuous claim amendments. In fact, the only amendments still at issue in the EPR are to new claims 23-24 and 26, which are irrelevant to the IPR because they are not part of the IPR and recite limitations absent from the original claims.

CBS, on which Petitioner relies, supports PO because there prosecution in the co-pending IPR was ongoing, and the Board stayed the reexam largely to protect the PO against multiple attacks by the same petitioners. *See CBS Interactive v. Helferich Pat. Licensing*, IPR2013-00033, Paper 19 at 1-2 (PTAB Dec. 20, 2012). Here, Tesla and its allies launched serial attacks on PO, starting with the Reexam Request by Unified for Tesla's benefit. With forthcoming allowance of claims in the EPR, Tesla and its allies are seeking to have the EPR stayed. PO, who did not initiate the EPR, needs protection from their gamesmanship.

Petitioner's **second** argument that a stay would not prejudice PO because PO may pursue amendments in this IPR is false. (Paper 20 at 8, 9.) PO would be

prejudiced by a stay because PO would (unnecessarily) lose at least a year of the '243 patent's remaining ~6.5 years of life. Also, PO has extended significant time and effort to amend the original claims and add new claims in the EPR. *See Idle Free Sys. v. Bergstrom, Inc.*, IPR2012-00027, Paper 26 at 6 (PTAB June 11, 2013) (PO may choose an EPR as a vehicle to amend). Prosecution in the EPR is over. Forcing PO to seek amendments anew in the IPR would be unfair to PO and the Office.

Third, Petitioner argues that PO potentially could obtain claims in the EPR that may not be permitted otherwise. (Paper 20 at 9 (quoting *Ossia, Inc. v. Energous Corp.*, PGR2016-00023, Paper 18 at 4 (PTAB Sept. 27, 2016))). In *Ossia*, the concern was that allowing the reexamination to proceed would enable the PO to circumvent Petitioner's Section 112 arguments. *Ossia*, PGR2016-00023, Paper 18 at 4. Here, the EPR considered Petitioner's arguments, so there is no issue of possible circumvention.

III. CONCLUSION

For all of the foregoing reasons, Petitioner's Motion should be denied.

Dated: September 20, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE
UNDER 37 C.F.R. § 42.6(e)(4)

The undersigned hereby certifies that a copy of the foregoing Patent Owner's Motion to Accept Filings was served on September 20, 2024, by filing this document through the Patent Trial and Appeal Board End to End System as well as delivering a copy via electronic mail upon the following email addresses for the attorneys of record for the Petitioner: Tesla-Graphite391-IPR@morganlewis.com and pmargulies@tesla.com.

Dated: September 20, 2024

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