

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA, INC.,
Petitioner,

v.

GRAPHITE CHARGING COMPANY LLC,
Patent Owner.

IPR2024-00388
Patent 8,291,243 B2

Before KEN B. BARRETT, MATTHEW S. MEYERS, and
JOHN R. KENNY, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

ORDER
Granting Petitioner's Motion to Stay *Ex Parte* Reexamination
of U.S. Patent No. 8,291,243 B2
37 C.F.R. § 42.5

I. INTRODUCTION

Tesla, Inc. (“Petitioner”) filed, on February 14, 2024, a Petition requesting *inter partes* review of U.S. Patent No. 8,291,243 B2 (“the ’243 patent,” Ex. 1001). Paper 2 (“Pet.”). The Petition challenges the patentability of claims 1–20 of the ’243 patent. Graphite Charging Company, LLC (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 6. Petitioner also filed a Preliminary Reply (Paper 7, “Prelim. Reply”) and Patent Owner filed a Preliminary Sur-reply (Paper 13). On August 27, 2024, we instituted *inter partes* review as to all challenged claims of the ’243 patent.

The parties informed us that the ’243 patent currently is the subject of Reexamination Control No. 90/019,303 (“the ’303 Reexamination Proceeding” or “the reexamination”), discussed further below. *See* Pet. 1, Paper 4, 2; Paper 8, 2. On July 19, 2024, Petitioner sent an email to the Board requesting authorization to file a motion to stay the reexamination. *See* Ex. 3001. We denied, without prejudice, the request as premature because the Board had not decided at that point whether to institute an *inter partes* review. *See id.* (citing Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding, 84 Fed. Reg. 16654, 16657 (Apr. 22, 2019) (“Notice”) (“The Board typically will consider motions to stay a concurrent Office proceeding (or may impose a stay sua sponte) any time after institution of an AIA trial proceeding”)).¹ After institution, Petitioner renewed its

¹ In light of the Notice’s guidance and our denial of Petitioner’s initial request, we do not deny the Motion as untimely as Patent Owner urges. *See* Opp. 2 n.1.

request for authorization, and, with our authorization filed, on September 11, 2024, a motion to stay the reexamination. Paper 20 (“Motion” or “Mot.”). Patent Owner filed an Opposition. Paper 21, (“Opposition” or “Opp.”).

The Board has authority to stay a reexamination involving a patent challenged in an *inter partes* review. 37 C.F.R. § 42.122(a); *see also* 35 U.S.C. § 315(d). For the reasons discussed below, we determine that there is good cause to stay the ’303 Reexamination Proceeding.

II. THE REEXAMINATION PROCEEDING

On November 21, 2023, and prior to the filing of the Petition, a third-party Requester filed a Request for *Ex Parte* Reexamination of claims 1, 3–6, 9–11, 15, 16, 18, and 19 of the ’243 patent. Ex. 2023. On December 12, 2023, the request was granted in the ’303 Reexamination Proceeding. Ex. 1019. During the reexamination, Patent Owner amended all of the original independent claims along with original dependent claims 12–14, and added new claims 21–52. *See, e.g.*, Ex. 1020, 3–18. A final rejection was entered on August 21, 2024. Ex. 1021. The original, as-amended claims challenged in the reexamination and some of the new claims have been deemed patentable, and some new claims have been rejected. Ex. 1021, 6–11. Patent Owner filed a response to that final rejection, canceling rejected new claims 21 and 22, and further amending rejected new claims 23, 24, and 26. *See, e.g.*, Ex. 1024, 19.

III. ANALYSIS

The Board may enter an order staying a reexamination proceeding where good cause exists. 37 C.F.R. § 42.122(a); *see also* 35 U.S.C. § 315(d); 37 C.F.R. § 42.3(a). “[T]he Board ordinarily will stay a [reexamination] where good cause exists.” Notice, 84 Fed. Reg. at 16,656.

The Notice identifies factors the Board may consider in deciding whether to stay a parallel reexamination involving the same patent. *Id.* at 16,657. We discuss each of those factors below.

A. Factor 1— Whether the claims challenged in the AIA proceeding are the same as or depend directly or indirectly from claims at issue in the concurrent parallel Office proceeding

As Petitioner notes (Mot. 3–4), all of the claims of the ’243 patent (claims 1–20) are being challenged in this *inter partes* review, and claims 1, 3–6, 9–11, 15, 16, 18, and 19 are involved in the reexamination. Mot. 3–4; see Prelim. Sur-reply (Paper 13) at 1 (Patent Owner stating that “it is undisputed that Petitioner challenged all of the claims challenged in *Ex Parte* Reexamination Control No. 90/019,303.”). All of the original independent claims are involved in the reexamination and, therefore, the remaining claims, i.e., the non-overlapping claims challenged in this *inter partes* review, depend from a claim at issue in the reexamination.

Patent Owner argues that the same claims are not at issue in both proceedings because, in the reexamination, the original claims have been amended and new claims have been added. Opp. 4. We do not agree. Although certain amendments have been entered, the claims, at this time, remain as originally issued in the patent. See 37 CFR § 1.530(k) (“Amendments not effective until certificate. Although the Office actions will treat proposed amendments as though they have been entered, the proposed amendments will not be effective until the reexamination certificate is issued and published.”).

In this case, the claims challenged in the AIA proceeding are the same as or depend directly or indirectly from claims at issue in the concurrent parallel Office proceeding. “Good cause for staying a case may exist if, for

example, an ongoing AIA proceeding, which is subject to statutory deadlines, is addressing the same or overlapping claims of a patent at issue in a parallel Office proceeding.” Notice at 16,656.

This factor favors a stay.

B. Factor 2 – Whether the same grounds of unpatentability or the same prior art are at issue in both proceedings

There is no dispute that the Requester’s and Petitioner’s challenges involve different prior art references. See Mot. 5 (“The EPR [*Ex Parte* Reexamination] uses different prior art than the IPR.”); Opp. 5–6. However, Patent Owner states that:

[Patent Owner] 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.)

Opp. at 6. Patent Owner also argues that “the EPR reviewed the Petition and accompanying exhibits,” *id.* at 5, and that “the EPR considered Petitioner’s arguments,” *id.* at 10. Patent Owner is referring to an Information Disclosure Statement (“IDS”) that lists Petitioner’s prior art references. See Ex. 2011, 2 (listing, as items 5–7, Wang, the AESO Report, and Cooley). Thus, according to Patent Owner, Petitioner’s prior art references are at issue in both proceedings.

This factor favors a stay.

C. Factor 3 – Whether the concurrent parallel Office proceeding will duplicate efforts within the Office

Factor 4 – Whether the concurrent parallel Office proceeding could result in inconsistent results between proceedings (e.g., whether

substantially similar issues are presented in the concurrent parallel Office proceeding)

Petitioner argues that:

the IPR and EPR include overlapping claims, which necessitates a duplication of efforts by different branches of the Office. As to the new and amended claims in the EPR, even if those are considered, the Office will be reviewing overlapping subject matter claims in parallel proceedings—a necessarily duplicative undertaking.

Mot. 6. Petitioner also argues that “[p]ermitting the EPR to proceed . . . while this IPR also proceeds is highly likely to lead to inconsistent results,” and, “[w]ith the two proceedings advancing in parallel, the Board may reach contrasting positions at different stages of the proceedings in connection with interpretation of claim scope, the prior art, or other issues.” *Id.* at 7; *see also id.* (“And, if the Office considered the prior art at issue in this [*inter partes* review] proceeding in the EPR . . . , the risk of inconsistent results would increase.”).

Patent Owner argues that “[a]llowing 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.” Opp. 7. We disagree because, as mentioned above, the amendments are not effective until a reexamination certificate issues. *See* 37 CFR § 1.530(k). The issues are not moot.

Patent Owner disputes Petitioner’s argument about different branches of the Office reviewing the same claims. *See* Opp. 7. According to Patent Owner, “a decision whether to issue a Notice of Intent to Issue Reexamination Certificate (‘NIRC’) is imminent,” Opp. 2, that the NIRC is “expected,” *id.* at 8, and that “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,” *id.* at 7. *See also id.* at 9 (Patent Owner referring to the “forthcoming allowance of claims in the EPR”). Patent Owner’s assertion that issuance of the NIRC is expected and imminent is speculative. Currently, the application is subject to a final rejection, and not all of the claims involved in the reexamination have been determined to be allowable. Ex. 1021. We decline to speculate as to whether the Examiner (the Reexamination Specialist) will find that Patent Owner’s after-final amendment overcomes all remaining rejections.

Patent Owner also reiterates its argument that “the two proceedings involve different art.” Opp. 7; *see also id.* at 8 (“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.”). But, as mentioned above, Patent Owner also argues that the Examiner has considered Petitioner’s arguments and the same art that is before us in this *inter partes* review. *See id.* at 5–6, 10. That suggests duplicative efforts that could lead to inconsistent results.

Patent Owner argues that “[a] stay would save little work because prosecution is closed in the EPR,” and that “the work that has been done would be wasted.” Opp. 7. Patent Owner does not explain adequately why a stay that may be lifted later results in wasted effort. Also, although prosecution technically may be closed, the reexamination has not concluded as Patent Owner implies. Patent Owner filed an after-final amendment in an attempt to gain allowance of rejected claims, thus prompting further action by the Examiner. And Patent Owner argued, *inter alia*, that those “amendments should be entered because they . . . present rejected claims 23, 24, and 26 in better form for consideration on appeal.” Ex. 1024, 19. Patent

Owner's suggestion that it may appeal the Examiner's final rejection is contrary to the assertion that the reexamination proceedings are nearly concluded.

We acknowledge that much of the potentially duplicative effort that may result in inconsistent results already has been completed in the reexamination. However, the same claims and the same prior art references relied on by Petitioner are involved in both proceedings and there remains action to be taken by the Examiner and there is the possibility of appeal. Therefore, there has been and continues to be opportunities for potentially duplicative efforts and inconsistent results.

These factors 3 and 4—pertaining to duplicate efforts and potentially inconsistent results—slightly favor a stay.

D. Factor 5 – Whether amending the claim scope in one proceeding would affect the claim scope in another proceeding

Patent Owner has amended, *inter alia*, all the independent claims, and, therefore, the scope of those claims and the respective dependent claims—namely, all the claims in the *inter partes* review—will be affected if and when a reexamination certificate issues. *But see* Opp. 8 (Patent Owner arguing that “all original claims have been amended” and “if the EPR is allowed to continue, there will remain no original claims at issue, and thus no original claim scope will be affected”). Additionally, Patent Owner currently has the opportunity to file a motion to amend the claims in this *inter partes* review, and there is the risk of concurrent differing amendments in the two proceedings, particularly if there is extended after-final amendment practice in the reexamination and/or Patent Owner appeals the Examiner's final rejection. *See* Mot 8 (Petitioner arguing that there is “[a] risk of variable claim amendments between the proceedings.”); *see also*

Ex. 1024, 19 (Patent Owner arguing to the Examiner that the after-final amendments should be entered, in part, to place the rejected claims in better form for appeal); Paper 16 (Scheduling Order setting the due date of November 19, 2024, for a motion to amend).

Patent Owner argues that “PO would be prejudiced by a stay because [Patent Owner] would (unnecessarily) lose at least a year of the ’243 patent’s remaining ~6.5 years of life,” but does not explain why any patent term would be lost. Opp. 9–10.

This factor favors a stay.

E. Factor 6 – The respective timeline and stage of each proceeding
Factor 7 – The statutory deadlines of the respective proceedings

Petitioner notes that this *inter partes* review has a statutory deadline and argues that, “[i]n contrast, the timing of the EPR is unknown and uncertain.” Mot. 9. Patent Owner argues that “[t]he respective timeline and stage of each proceeding favors denial because the EPR is essentially done while the IPR is just beginning.” Opp. 2.

This proceeding is subject to a statutory deadline that requires a final decision within one year of institution, absent a good cause extension. 35 U.S.C. § 316(a)(11). The deadline is August 27, 2025. This *inter partes* review is at a relatively early stage of the trial portion, but there has been two rounds of pre-institution briefing and a decision on institution by the Board.

The ’303 Reexamination Proceeding is required to be “conducted with special dispatch,” but is not subject to a specific deadline. 35 U.S.C. § 305.

Patent Owner asserts that prosecution is closed in the reexamination “upon the entry of a [Final Office Action] allowing all the amended claims

and almost all of the new claims.” Opp. 2. However, that Final Office Action is a rejection. Ex. 1021. In response to the final rejection, Patent Owner did not, for example, cancel the rejected claims, which might have resulted in the issuance of NIRC. Rather, Patent Owner filed an after-final amendment that further amended some of those rejected claims (and canceled others). See Ex. 1024, 19. Patent Owner, summarizing an interview, states that “[t]he Examiners indicated that the proposed claim amendments overcome the outstanding Section 112 rejections, but did not offer an opinion on whether the amendments overcome the Section 102/103 rejections.” Ex. 1024, 18. Thus, it is not clear that the Examiner will withdraw all remaining rejections and issue a NIRC soon, as Patent Owner implies. See Opp. 2 (“[A] decision whether to issue a Notice of Intent to Issue Reexamination Certificate (‘NIRC’) is imminent.”). Additionally, Patent Owner argued to the Examiner that “[t]hese amendments should be entered because they . . . present rejected claims 23, 24, and 26 in better form for consideration on appeal,” further indicating that the finalization of the reexamination is not necessarily imminent. *Id.* at Ex. 1024, 19 (“better form for . . . appeal” listed as one of three enumerated reasons why the after-final amendment purportedly should be entered). We acknowledge Patent Owner’s argument that “[a]ny motions for reconsideration, appeals, and remands would extend the duration of this [*inter partes* review] proceeding further.” Opp. 2–3. However, those events would occur after and not affect the meeting of the statutory one-year deadline.

These factors 6 and 7—pertaining to timelines and deadlines—favor a stay.

F. Factor 8 – Whether a decision in one proceeding would likely simplify issues in the concurrent parallel Office proceeding or render it moot

Petitioner argues that “[a] decision in the instant IPR would simplify the EPR, particularly as to disputes concerning scope of the original claims, overlapping new claims, proposed amendments with overlapping subject matter, and estoppel implications.” Mot. 10.

Patent Owner argues that the issuance of a NIRC (leading to the amendments becoming legally effective) would render a decision on the original, unamended claims in the IPR “moot and purely advisory.” Opp. 3. Patent Owner further argues that “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.” *Id.* at 3–4 (citing Ex. 1024, 10–14, 16).

It is not clear that allowing the reexamination to proceed would moot the *inter partes* review, even if, as Patent Owner speculates, a NIRC is imminent. As Petitioner argues, the amendments in the reexamination of the original claims incorporates at least some of the “weighted function” subject matter of dependent claim 8. Mot. 4; *see* Ex. 1020, 3 (amended claim 1 reciting, in part, “inputting the operating environmental condition data into a weighting function”). That dependent claim is not challenged in the reexamination but is being challenged in the *inter partes* review, and Petitioner presents argument and evidence directed to the purported obviousness of using a weighted function. *See* Pet. 51–59; *but see* Opp. 5 (Patent Owner arguing that “amended claim 1 is different in scope than original claim 8”). As to the new claims, it similarly is not clear that the *inter partes* review will not simplify proceedings in the reexamination, as Patent Owner implies. Although the new claims recite “multiple

thresholds,” claim 8 is challenged in the Petition and contains a limitation pertaining to “a certain threshold.” *See, e.g.*, Ex. 1024, 10–11; Pet. 56–59 (addressing the “above a certain threshold” recitation of claim 8). The *inter partes* review may touch on issues such as claim construction, the prior art reference’s teachings regarding thresholds, and opinion testimony regarding the person of ordinary skill in the art which could simplify issues in the reexamination. Thus, it is not clear that the amendments (if finalized by a reexamination certificate) would moot the Petition. Rather, allowing the reexamination to proceed could complicate greatly the *inter partes* review proceeding. And, if Patent Owner moves to amend the claims in the *inter partes* review, that likely would simplify the reexamination of claims directed to overlapping or similar subject matter.

In light of the uncertainty as to whether a decision in one proceeding will simplify issues in the other proceeding, this factor slightly favors a stay.

IV. CONCLUSION

After considering all the factors, we, for the foregoing reasons, find that Petitioner has shown good cause for staying the ’303 Reexamination Proceeding pending resolution of this *inter partes* review. *See* Notice at 16,656 (“Good cause for staying a case may exist if, for example, an ongoing AIA proceeding, which is subject to statutory deadlines, is addressing the same or overlapping claims of a patent at issue in a parallel Office proceeding.”).

V. ORDER

For the foregoing reasons, it is

ORDERED that Petitioner’s Motion to Stay *Ex Parte* Reexamination of U.S. Patent No. 8,291,243 B2 is granted;

FURTHER ORDERED that Reexamination Control No. 90/019,303 is stayed pending the termination or completion of IPR2024-00388;

FURTHER ORDERED that all time periods for filing further papers in Reexamination Control No. 90/019,303 are tolled for the duration of the stay, and no further papers shall be filed in the reexamination while this stay remains in place, without authorization; and

FURTHER ORDERED that, when the stay is lifted, a paper will be sent resetting the time periods for responding to any outstanding papers in Reexamination Control No. 90/019,303.

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