

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA, INC.,
Petitioner

v.

GRAPHITE CHARGING COMPANY, LLC,
Patent Owner

U.S. Patent No. 8,291,243
Case No. IPR2024-00388

**Petitioner's Opposition to
Patent Owner's Motion to Strike**

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1. Introduction

Petitioner hereby opposes Patent Owner’s Motion to Strike (filed May 7, 2025), which requests that the Board strike:

- portions of the RSS e-draft (Exhibit 1014);
- portions of the Deposition Transcript of Dr. Cameron (Exhibit 1025);
- Inspiron 1210 Quick Reference Guide (Ex-1027); and
- Portions of the Petitioner’s Reply (Paper 28).

Paper 37 at 2-7.

The Motion to Strike is an attempt to preclude Petitioner from responding to claim construction and other arguments first presented by Patent Owner in its Response. As discussed below, this is inconsistent with Federal regulations and Federal Circuit precedent (not to mention duplicative and untimely). Accordingly, the Board should deny Patent Owner’s motion in its entirety.

2. Legal Standard

In its reply, a petitioner is entitled to respond to “arguments raised in the corresponding ... patent owner response.” 37 C.F.R. § 42.23(b). This is true for newly raised claim constructions, as well. The Federal Circuit has held that, when a patent owner raises new claim constructions in its response, the Board “must give [the] petitioner an opportunity to respond to the new construction[s].” *Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374, 1381 (Fed. Cir. 2023). This includes allowing the petitioner to “present argument and evidence under [patent owner’s] new construction[s].” *Id.*

Moreover, an argument presented in a petitioner’s reply can be considered a permissible explanation of an argument in the petitioner’s petition when the argument is made in response to arguments from the patent owner’s response. *Corephotonics, Ltd. v. Apple Inc.*, 84 F.4th 990, 1008 (Fed. Cir. 2023) (“First, the arguments and evidence in the reply must not be part of a new theory of unpatentability. Second, the arguments and evidence in the reply must be responsive to the patent owner's contentions or the Board's institution decision.”).

3. Argument

3.1 The Disputed Evidence Is Responsive to New Arguments and Therefore Should Not Be Stricken

3.1.1 RSS e-Draft (Exhibit 1014)

Patent Owner alleges that the following two quotes of Exhibit 1014 should be stricken: (i) that “[RSS] has taken the Web by storm”; and (ii) that RSS is “used to provide news to either people or organizations[]” by “serving an ‘RSS feed’ from a website.” Paper 37 at 2-3. Patent Owner alleges that these two portions of the Exhibit should be stricken since Petitioner allegedly “relied on these two quotes to introduce a new invalidity theory/argument that RSS was purportedly notorious at all relevant times.” *Id.* at 3.

As a threshold matter, Petitioner did not raise any *new* arguments related to RSS. The portions of the Reply Brief that PO says are new positions on Exhibit

1014, (*see* Paper 37 at 6), are not new at all. Instead, the discussions of Exhibit 1014 merely present further explanation of the arguments raised in the Petition that “a POSA would have understood an RSS feed was one of a finite number of ***known protocols*** for communication of XML or HTML web server data.” Pet. at 40 (emphasis added); Exhibit 1003 at ¶ 116. Moreover, this further explanation is responsive to the Patent Owner’s argument in the Patent Owner’s Response that “a POSITA would understand that a reference to XML does not imply that an RSS feed is being used because there are many uses of XML that do not require RSS.” Paper 24 (POR) at 21-22. This is precisely the type of explanation that is permissible under *Corephotonics*.

3.1.2 Deposition Transcript of Dr. Cameron (Exhibit 1025)

Patent Owner alleges that the Board should strike the lines of questioning regarding (i) the “delay times” (Ex-1025 at 326:4-327:21), and (ii) “RSS’s notoriety” (Ex-1025 at 414:3-18.), based on Patent Owner’s argument that these lines of questioning relate to new, belated arguments raised by the Petitioner. Paper 37 at 3-4. Patent Owner is wrong.

As to the discussion of “delay times” in Dr. Cameron’s deposition, Petitioner raised those points in the deposition in response to Patent Owner’s new claim constructions the term “current” in the limitation “automatically reducing a

current amount of consumption of electric power from the power grid system.” Paper 24 at 12-13, and 48-52. Therefore, they are permissible.

As to the questioning related to “RSS’s notoriety,” Petitioner’s questioning fits within the *Corephotonics* framework discussed above since it is (a) responsive to arguments raised by Patent Owner in the POR, and (b) serves to *further explain* the arguments that were already made in the Petition. In addition, the specific portions of Exhibit 1014 that were raised in the deposition are further responsive to Dr. Cameron’s assertion that he did not “know whether a POSITA would have known about RSS at the time of the patent.” Exhibit 1025, 413:5-7.

3.1.3 Inspiron 1210 Quick Reference Guide (Exhibit 1027)

Patent Owner alleges that the Board should strike the Inspiron 1210 Quick Reference Guide (Exhibit 1027) based on the alleged belatedness of arguments raised by the Petitioner. Paper 37 at 3-4. However, similarly to the portion of the Cameron Deposition above related to the “delay times,” the cited portions of Exhibit 1027 and the related arguments in the Reply Brief are responsive to the new claim construction for “current” that Patent Owner raised in the POR. *See* Paper 24 at 12-13, and 48-52.

3.1.4 Portions of the Reply Brief (Paper 28)

Patent Owner raises various requests to strike portions of the Reply Brief, many of which are duplicative to those discussed in connection with the evidence discussed above with in sections 3.1.A – 3.1.C. *See, e.g.*, Paper 37 at 5 (requesting to strike the portion of the Reply Brief discussing Dr. Cameron’s “delay time” testimony).

The Patent Owner also requests to strike several other arguments in the Reply Brief.

First, the Petitioner’s assertion that Wang’s processor 416 performs independent power-reducing actions, *id.* at 5-6, which, again, are not new arguments. In contrast, they are responsive to Patent Owner’s arguments from the Patent Owner Response regarding Wang and serve to further explain arguments already made in the Petition. *See, e.g.*, Paper 28 at 16 (citing Pet. at 24 in conjunction with Dr. Cameron’s deposition testimony that an “analytic decision engine” could be an “application-specific processor” or a “microprocessor”).

Second, Patent Owner’s positions on claims 13 and 14 are incorrect too — the Reply Brief merely explained the use of “respectively” to address those claims, no new argument was made. Petition at 68-69; Paper 28 at 31-32.

Patent Owner’s remaining positions related to other portions of the Reply Brief fail for similar reasons as discussed above, since they (a) further explain

arguments already made in the Petition, (*see* Pet. at 41-42, 56, and 81; Ex-1003, ¶ 147), and (b) are responsive to new arguments raised in the Patent Owner Response. But Patent Owner fails to satisfy the burden of showing how this argument meets the Board’s standard for “newness.” *Corephotonics*, 84 F.4th 990 at 1008 (“The ‘newness’ restriction prohibits the petitioner from raising, in reply, ‘an entirely new theory of prima facie obviousness absent from the petition’”).

3.2 The Motion to Strike Is Duplicative

In addition to the aforementioned legal issues, Patent Owner’s Motion to Strike is also partially duplicative and entirely dismissive of explicit Board instructions. In authorizing the Motion, the Board indicated that Patent Owner’s motion “is only to address matters *not the subject of any forthcoming motion to exclude*.” E-mail from Tina Williams, Supervisory Paralegal Specialist, PTAB (May 2, 2025 at 6:43 AM PT) (emphasis added).

Yet Patent Owner now moves to strike portions of Exhibit 1014, Exhibit 1025, and the Reply Brief, as well as Exhibit 1027 in its entirety, which it already included in its Motion to Exclude. Paper 35 at 5-6 and 11-12. Such repetition is wasteful of limited Board resources, not to mention neglectful of unambiguous Board instructions.

3.3 The Motion to Strike Is Untimely

Lastly, Petitioner's request to file its Motion to Strike is months overdue. The Trial Practice Guide indicates that, "[g]enerally, authorization to file a motion to strike should be requested *within one week* of the allegedly improper submission[s]." Trial Practice Guide at 81 (emphasis added).

Here, Petitioner introduced the evidence at issue on February 26th. Accordingly, Patent Owner should have requested authorization to file a motion to strike the evidence by March 5th. Instead, Patent Owner waited more than eight weeks to request authorization—contacting the Board on April 25th and requiring Petitioner to prepare this Opposition just prior to oral argument.

4. Conclusion

The Motion to Strike seeks to deny Petitioner the opportunity to rightfully raise arguments related to Patent Owner's new arguments, including claim construction arguments—which Patent Owner raised for the first time in its Response. Not only does Patent Owner's Motion misunderstand regulation and past precedent, but it is duplicative and untimely and should be rejected accordingly.

For these reasons, Petitioner respectfully requests that the Board deny Patent Owner's Motion to Strike in its entirety.

Dated: May 13, 2025

Respectfully Submitted,

/ Alexander B. Stein /

Alexander B. Stein, Reg. No. 71,397

Certificate of Service

Pursuant to 37 C.F.R. §42.6(e), the undersigned hereby certifies that on May 13, 2025, copies of this Opposition was provided via email to Patent Owner at the following addresses:

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