

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA, INC.,

Petitioner,

v.

CHARGE FUSION TECHNOLOGIES, LLC,

Patent Owner.

Case IPR2025-00153

Patent 11,631,987

**PATENT OWNER'S PRELIMINARY RESPONSE FOR DISCRETIONARY
DENIAL**

TABLE OF CONTENTS

EXHIBIT LIST	iii
I. INTRODUCTION.....	1
II. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION UNDER 35 U.S.C. § 325(D).	1
A. The Same Prior Art Was Previously Presented to The Office	2
1. The Petitioner’s arguments comparing Ferro to Hafner, regarding the “dynamic nature of Ferro’s planner” is a red herring.....	4
B. Petitioner Has Made No Showing of Material Examiner Error	12

TABLE OF AUTHORITIES

Page(s)

Cases

<i>ABS Global, Inc. v. Cytonome/ST, LLC</i> , IPR2021-00306, Paper 13 (PTAB June 7, 2021)	12
<i>Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH</i> , IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020).....	<i>passim</i>
<i>Becton, Dickinson and Co. v. B. Braun Melsungen AG</i> , IPR2017-01586, Paper 8, 17–18 (PTAB Dec. 15, 2017)	3
<i>Darfon Elecs. Corp. v. Michael Shipman</i> , IPR2022-01008, Paper 11 (PTAB Dec. 2, 2022)	12
<i>Google LLC v. Kewazinga Corp.</i> , IPR2021-00527, Paper 16, 18–19 (PTAB Aug. 24, 2021).....	13
<i>Google</i> , IPR2022- 01197	14
<i>Monolithic Power Systems, Inc. v. Volterra Semiconductor LLC</i> , IPR2020-01348, Paper 19 (PTAB 2021).....	3
<i>Roku, Inc. v. Universal Elecs., Inc.</i> , IPR2019-01619, Paper 11, 11, 19 (PTAB April 2, 2020)	13
<i>Tesla, Inc. v. Charge Fusion Technologies, LLC</i> , IPR2023-00062, Paper 13, 19 (PTAB May 11, 2023)	6
<i>Vital Connect. Inc. v. Bardy Diagnostics, Inc.</i> , IPR2023-00381, Paper 7 (PTAB July 11, 2023)	13
<i>Wolfspeed, Inc. v. The Trustees of Purdue Univ.</i> , IPR2022-00761, Paper 9 (PTAB Nov. 8, 2022).....	12

Statutes

35 U.S.C. § 325(D)	1, 13
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EXHIBIT LIST

Currently Filed – Patent Owner

Ex. No.	Description
2001	Declaration of Steven Goldberg
2002	File History of U.S. Patent No. 10,998,753
2003	U.S. Patent Application Publication No. 2009/0189807A1 to Scalisi et al.
2004	U.S. Patent No. 7,671,567B2 to Eberhard et al.

1. INTRODUCTION

Pursuant to the March 26, 2025, “Interim Processes for PTAB Workload Management” Memorandum (“Memorandum”) Patent Owner hereby submits its discretionary considerations for Director review as to why IPR2025-00153 should not be instituted. The present art submitted by Petitioner is cumulative of the art already considered by the Patent Office. For the reasons set forth below, Patent Owner respectfully requests that the Board exercise its discretion to decline to institute the present petition.

2. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION UNDER 35 U.S.C. § 325(D).

Petitioner asserts that discretionary denial is not appropriate. Pet. at 80-83. To the contrary, discretionary denial under 35 U.S.C. §325(d) is warranted because “the same or substantially the same prior art or arguments previously were presented to the Office[.]” Incredibly, Petitioner did not attempt to show material error by the Patent Office. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7 (PTAB Feb. 13, 2020) (precedential).

When deciding to exercise its Section 325(d) discretion, the Board applies the two-part framework of *Advanced Bionics*: “(1) whether the same or ***substantially the same art*** previously was presented to the Office or whether the same or ***substantially the same*** arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has

demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Id.* at 8 (emphasis added). “If a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute *inter partes* review.” *Id.* at 8–9. “[T]his framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Id.* at 9.

Here, both prongs dictate discretionary denial¹. Petitioner argues that the combination of prior art and arguments are not the same or substantially the same as that considered during prosecution, and thus part one of *Advanced Bionics* is not met. Pet. at 80-82. However, Petitioner’s argument is flawed because the examiner expressly considered cumulative or “substantially the same”. The Petitioner believes the Andrews declaration saves the day in the second prong of *Advanced Bionics*. Pet. 82. This, however, ignores the fact that Ferro was expressly considered during prosecution and, as admitted by the Petitioner, is “listed on the face of the ’987 Patent. *Id.* at 80. Discretionary denial is warranted.

A. The Same Prior Art Was Previously Presented to The Office

¹ Although pursuant to the March 26, 2025, Memorandum, Petitioner is allowed to file an opposition brief, Petitioner should not be afforded the opportunity to create any new arguments including any argument under the second part of the *Advanced Bionics* framework. The Petition was filed prior to the issuance of the memorandum.

In the first part of the *Advanced Bionics* framework, the Board may consider the relevant *Becton, Dickinson* factors: (a) the similarities of the asserted art and the art previously considered; (b) the cumulative nature of the asserted art and the art previously considered; and (d) the extent of overlap between arguments made during examination and the petitioner’s arguments. *Advanced Bionics* at 9-10 (citing *Becton, Dickinson and Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, 17–18 (PTAB Dec. 15, 2017) (informative)). As such, the Board should consider whether the cited art is used in the same manner as previously considered by the Office, in determining whether the prior art is “substantially the same.” *See Monolithic Power Systems, Inc. v. Volterra Semiconductor LLC*, IPR2020-01348, Paper 19, (PTAB 2021). Since the references provided by Petitioner are utilized in the same manner as art already considered by the Examiner, the Board should exercise its discretion to deny the Petition.

The ’987 Patent is a continuation of U.S. Patent of 10,998,753 (hereinafter the ’753 Patent). In the ’753 Patent application, the claims were in a position for allowance after an Examiner’s amendment which added a GUI adapted to display a vehicle charge indicator with three portions – a portion indicating the current charged amount of the electric car battery, a second portion indicating the current uncharged capacity of the electric car battery, and a slider by which an amount of charge can be specified. *See EX2002*, 57-68. Similarly, in the prosecution of the

'987 Patent, the “unitary vehicle charge indicator element”, similar to the examiner amendment in the '753 patent, was filed February 23, 2023, and led to allowance on March 9, 2023. EX1002 at 638-648 and 688-698. Accordingly, the prosecution history of the '753 Patent is telling of the analysis and consideration made by the same examiner during prosecution of the '978 Patent. It is clear that the unitary vehicle charge indicator was the reason for allowance of the '987 Patent, and that the same or similar prior art and combinations thereof that are made in this IPR were already considered by the examiner.

Indeed, all Challenged Claims of the '987 Patent recite a Graphical User Interface adapted to display a unitary vehicle charge indicator comprising: (i) a first portion indicative of an amount of charge residing in a battery of the electric vehicle; (ii) a second portion indicative of an uncharged capacity of the battery of the electric vehicle; and (iii) a third portion comprising a slider by which an amount of charge may be specified.

1. The Petitioner’s arguments comparing Ferro to Hafner, regarding the “dynamic nature of Ferro’s planner” is a red herring.

The Petitioner alleges that the Ferro reference is not cumulative to Hafner because “Hafner is silent to any ‘dynamic’ nature of the planner, and thus Ferro is materially different from Hafner.” Pet. at 81. This allegation, however, is not related to the “unitary vehicle charge indicator element” in which Hafner is entirely cumulative to any portion of Ferro relied on by the Petitioner. The Petitioner admits

that “Ferro has similarities to Hafner applied by Examiner during prosecution.” *Id.*

In analyzing the Slider element in the Petition, the Petitioner relies on Ferro’s paragraphs [0123]. *Id.* at 58. During the motivation to combine section of the Petition addressing the Slider element, the Petition relies on Ferro’s paragraph [0093]. However, these relied-on portions are cumulative to the Hafner reference and thus were already considered by the Examiner. Ferro’s paragraph [0123] is verbatim to Hafner’s paragraph [0098], and Ferro’s [0093] is substantially similar as Hafner’s [0063] as shown in the below table:

Page in Petition relying on Ferro	Ferro paragraph relied on in Petition	Corresponding disclosure in Hafner:
Pet. at 61	[0093] A principal may create preferences for managing parameters of the electric vehicle's charging transactions using a user input/output device associated with the computing device hosting the energy preference service. In this embodiment, the principal may use an input/output device located on-board the electric vehicle to create the preferences. In other words, in this embodiment, the principal uses an on-board system for maintaining, inputting, storing, and retrieving preferences that are used to manage the charging, de-charging, and/or storing of	[0063] A principal may select preferences for managing aspects of the electric vehicle's charging transactions using a user input/output device located on-board the electric vehicle. In other words, the principal uses an on-board system for maintaining, inputting, storing, and retrieving preferences that are used to manage the charging, de-charging, and/or storing of electric power associated with the electric vehicle.

	electric power associated with the electric vehicle.	
Pet. at 58, 61.	[0123] Amount of charge 514 preferences may specify minimum level 536 of charge in the electric vehicle's storage device, a maximum level of charge 538, or specify different levels of charge depending on power source 540 of the electricity used to charge the electric vehicle. If the power source is a “green” source, such as solar power, the user may specify a higher charge level than if the power source is a more environmentally harmful, or “brown” power source, such as coal or oil.	[0098] Amount of charge 514 preferences may specify minimum level 536 of charge in the electric vehicle's storage device, a maximum level of charge 538, or specify different levels of charge depending on power source 540 of the electricity used to charge the electric vehicle. If the power source is a “green” source, such as solar power, the user may specify a higher charge level than if the power source is a more environmentally harmful, or “brown” power source, such as coal or oil.

Therefore, the below statement in the Petition is wrong.

The Board previously confirmed Ferro’s “dynamic” planner portions being “materially different” from an essentially identical Hafner in IPR2023-00062. *Tesla, Inc. v. Charge Fusion Technologies, LLC*, IPR2023-00062, Paper 13, 19 (PTAB May 11, 2023). Because Petitioner discusses the “dynamic” nature of the planner throughout our arguments, there is little overlap with any arguments made during prosecution.

Pet. at 81. For the Slider and “unitary vehicle charge indicator element” limitations of all Challenged Claims, which were the express reason for allowance, the Ferro reference relied on by the Petitioner is entirely cumulative and directly overlaps with the prosecution.

In addition, other “sliders” were considered that are cumulative to the prior art relied on the Petition. The Notice of Allowance of the ’753 Patent, and thus the similar allowance in the ’987 Patent, illustrates substantially the same arguments which Petitioner has presented for this unitary vehicle charge indicator that is the basis for allowability for the ’987 Patent. EX1002 at 688-698. As illustrated below, in allowing the ’753 Patent, and thus similarly for the ’987 Patent, the Examiner already considered similar “sliders,” as shown below.

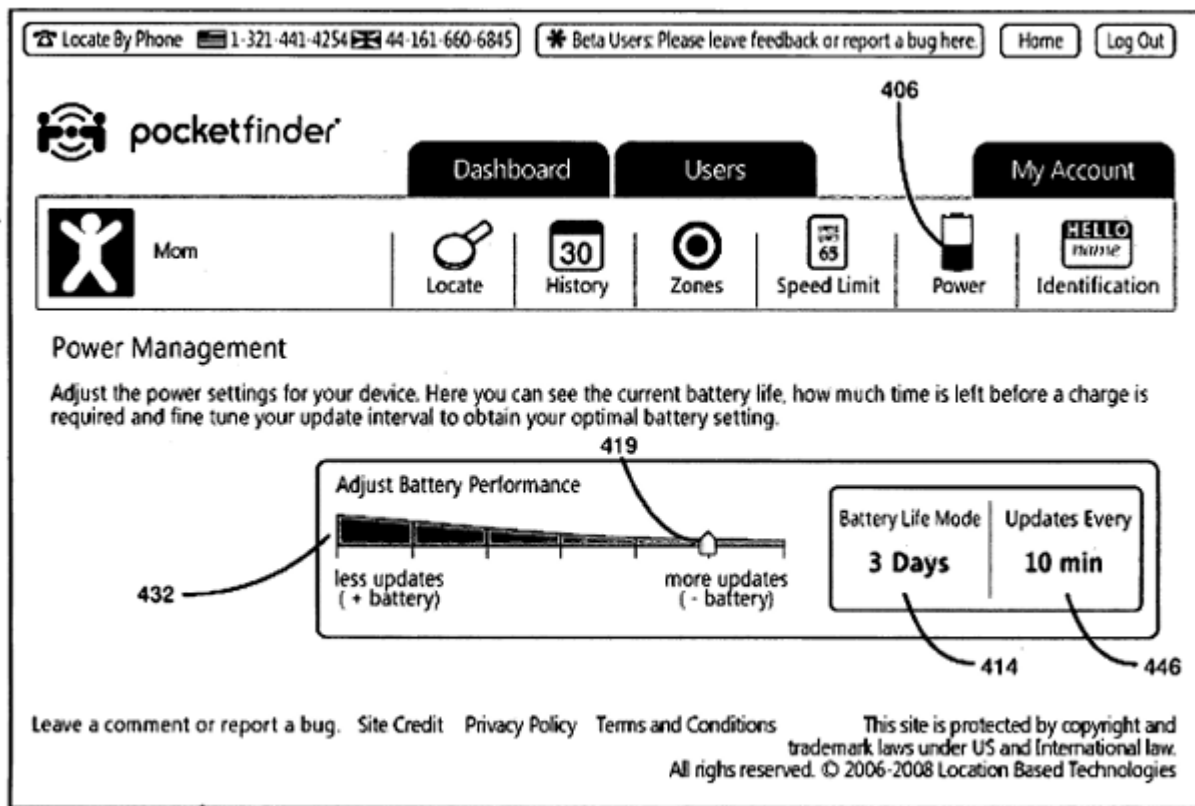


Figure 4

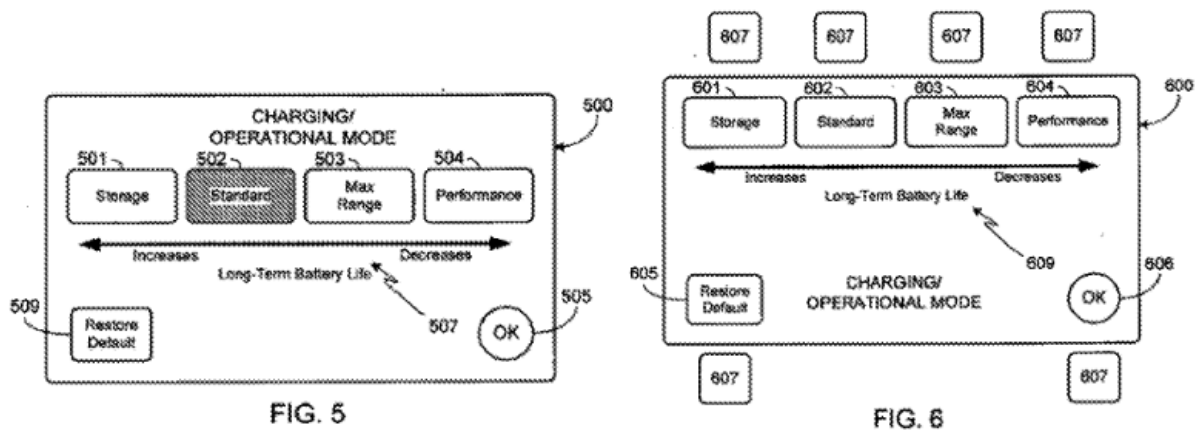
EX2003 at FIG. 7. The above figure is Figure 7 of U.S. Patent Application No 2009/0189807A1 to “Scalisi”. This reference was expressly considered in the Notice

of Allowance of the '753 Patent, which stated “The following is an examiner’s statement of reasons for allowance: As per independent claims 17 and 23, the bets prior art of record, *Hafner et al.*, *Straubel*, and *Scalisi et al.* (*US 2009/0189807A1*)(*See: IDS of 09/22/2020, #11*) neither anticipates, nor , alone or combined, renders obvious as a whole, ***the specific combination of the inventive features*** as currently recited in the Examiner’s Amendment.” EX2002 at 67; emphasis added. The Scalisi reference was also cited in the Prosecution of the ‘987 Patent, in an IDS dated July 8, 2021 (EX1002 at 77) and expressly considered by the Examiner on July 27, 2021 (EX1002 at 176-180).

The slider shown in Figure 7 of the Scalisi reference is described as: “In one variant, local battery adjustment mechanism 416 includes user adjustable screen icon 432 to graphically display in substantially real-time trade-off relationships between remaining battery charge level 414 and update rate 446 (e.g., refresh rate) of location coordinate packets 422. Advantageously as compared to conventional tracking devices, user input request 430 adjusts value 419 to select an appropriate update set of network communication signaling protocols to achieve a desired user defined battery operating environment, e.g., obtain optimal battery life, obtain optimal update rate, tradeoffs between them.” EX2003 at 14, paragraph [0054].

Further, the examiner considered US 7,671,567 (“Eberhard”), which was cited in an IDS filed on September 1, 2022, during prosecution of the ‘987 Patent

(EX1002 at 316-322), which was considered by the Examiner on September 26, 2022. *Id.* at 469-475. Eberhard discloses for a method and apparatus that allows a user to select a mode of operation for the charging system of an electric vehicle using slide switches and displays as shown in Figures 5 and 6 of Eberhard, reproduced below.

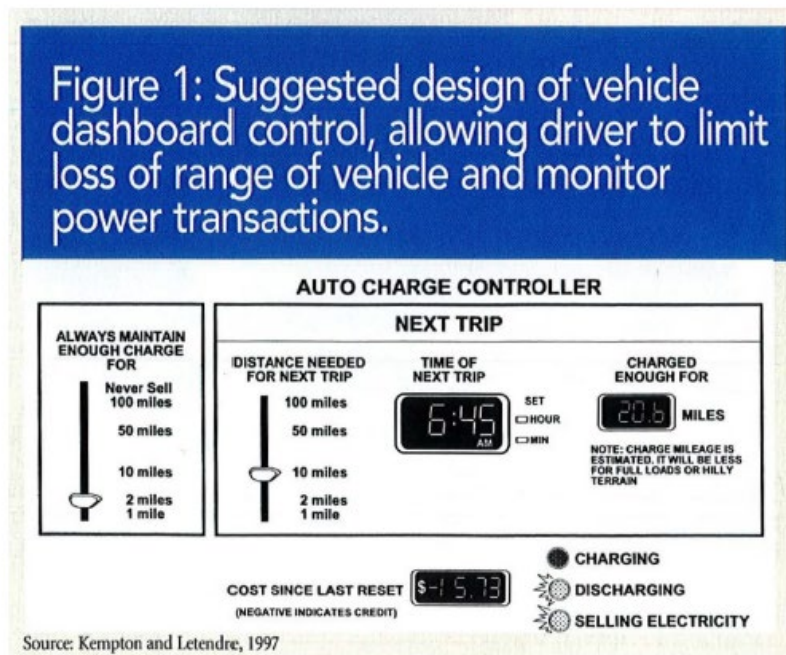


EX2004 at 4, Figs. 5-6.

Not only were sliders related to battery levels discussed and considered in the '987 Patent and its parent '753 Patent, but selecting distance traveled was also expressly considered. In the '753 Patent, a Pre-Interview First Office Action was issued on December 2, 2020, noting “Nakai (US6,618,650) discloses indicating a desired distance of travel and a desired travel destination Fig. 7.” EX2002 at 188. Furthermore, the Final Rejection of February 12, 2021, indicated that Hafner taught to “receive ... information indicative of one or more charging preferences corresponding to a desired charging of a vehicle and defining a desired distance of

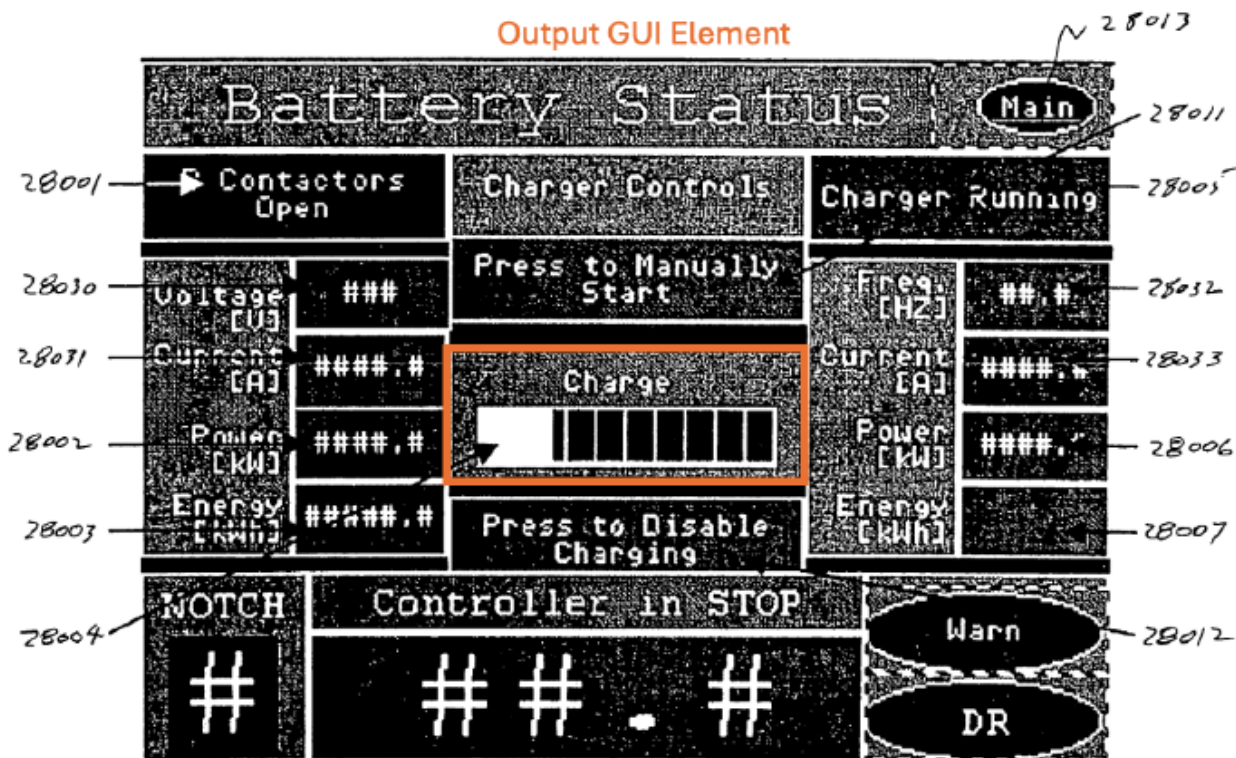
travel between a first charging location and a second charging location.” *Id.* at 115. Thus, the new Letendre reference adds nothing and is cumulative to the prior art that was considered by the Examiner, and which led to an allowance because of “the unitary vehicle charge indicator” element that was expressly deemed as a “*specific combination of the inventive features*” that was allowable. EX2002 at 67; emphasis added.

All of the grounds within the Petition rely upon Letendre. Petitioner states that Letendre “teaches a user interface comprising a slider by which a user specifies parameters managing the charging of an electric vehicle’s battery”. Pet. at 13. Petitioner relies on Letendre’s physical slider:



EX1007, 18-20; Pet. at 12.

Petitioner's proposed grounds combine the slider of Letendre with the GUI bar graph in "Donnelly." Pet. at 48-63. As shown below, Donnelly presents nothing more than a figure of battery charge amount that has no interaction with a slider:



Despite the fact that the art cited by the examiner purportedly presented a slider related to charging ("Scalisi"), and art indicating to input desired distance of travel ("Hafner" and "Nakai"), and art directed at a user's ability to select a desired mode of charge with slider switches ("Eberhard") during prosecution, Petitioner provides *no analysis* as to why its proposed Grounds, that require no less than three pieces of art combined, are not cumulative to these prior art references cited by the Examiner during prosecution of the '987 Patent.

Petitioner further fails to state how its proposed art for the unitary indicator element is different than the previously considered art that presents similar combinations of sliders and GUI entries. The Petitioner’s statement that “Donnelly and Letendre are non-cumulative and materially different from *any art evaluated during examination*, given Letendre discloses a web page charging control panel with sliders for indicating user charge preferences and Donnelly teaches a GUI showing a battery stat-of-charge via a bar graph” is wrong and expressly contradicted by Scalisi, Hafner, Nakai, and Eberhard

B. Petitioner Has Made No Showing of Material Examiner Error

Further, Petitioner’s completely failed to address the second prong of *Advanced Bionics*, much less show that the Examiner erred in a manner material to patentability. *See* Pet. at 82. The Board may exercise its discretion to deny institution in circumstances where a petitioner does not address whether the Office materially erred. *See Wolfspeed, Inc. v. The Trustees of Purdue Univ.*, IPR2022-00761, Paper 9 at 14-15 (PTAB Nov. 8, 2022) (denying institution when petitioner did not address whether the Office materially erred); *see also Darfon Elecs. Corp. v. Michael Shipman*, IPR2022-01008, Paper 11 at 14 (PTAB Dec. 2, 2022) (same).

In addressing the first prong of *Advanced Bionics*, Petitioner notes merely that the Petition’s references were not applied against the claims during prosecution. Pet. at 80-82. But that alone cannot satisfy Petitioner’s burden to show material error.

See, e.g., ABS Global, Inc. v. Cytonome/ST, LLC, IPR2021-00306, Paper 13 at 13-14 (PTAB June 7, 2021) (Argument that “the Examiner did not apply [a] reference” was insufficient because petitioner did “not point[] out any specific disclosure from [the reference] that was overlooked by the Office.”); *Vital Connect, Inc. v. Bardy Diagnostics, Inc.*, IPR2023-00381, Paper 7 at 19 (PTAB July 11, 2023) (Argument that grounds were “not previously considered and/or applied by the Examiner..., without any further analysis, cannot persuade us of material error.”).

Further, Board panels have declined to independently review and assess the merits of a petition’s grounds to conclude whether and how any material error occurred when a petitioner makes no attempt to identify or explain the alleged material error. *See, e.g., Roku, Inc. v. Universal Elecs., Inc.*, IPR2019-01619, Paper 11, 11, 19 (PTAB April 2, 2020) (noting that a reference “was previously presented to the Office . . . in an [IDS],” and not considering the merits of the challenge when petitioner did not “explain adequately how the Examiner erred in a manner material to the patentability . . . by allegedly not considering [the reference]”); *Google LLC v. Kewazinga Corp.*, IPR2021-00527, Paper 16, 18–19 (PTAB Aug. 24, 2021) (same).

Thus, to the extent Petitioner wants the Board to consider the merits of its grounds to determine whether Mr. Borissov, the patent examiner who has been examining the ’987 patent family since 2009, materially erred, the Board should reject that approach. “That approach not only places Petitioner[s’] burden

improperly on the shoulders of the Board, it cuts against the express language of our § 325(d) precedent requiring that Petitioner[s] make a ‘showing of material error’ and ‘point[] out sufficiently how’ the Examiner erred.” *Google*, IPR2022- 01197, Paper 18 at 22-23 (citing *Advanced Bionics* at 8-9). In fact, “the express language of *Advanced Bionics* suggests that a petitioner should explain with specificity what it believes the previous error is and also show why that error is material to the patentability of the challenged claims.” *Id.* (citing *Advanced Bionics* at 8-9).

Because Petitioner has failed to point out sufficiently how the Examiner allegedly erred in his evaluation of the asserted prior art, this factor weighs in favor of exercising discretion to deny institution.

Dated: April 15, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on April 15, 2025, a true and correct copy of the foregoing
PATENT OWNER'S PRELIMINARY RESPONSE FOR DISCRETIONARY
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