

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA INC.,
Petitioner

v.

CHARGE FUSION TECHNOLOGIES, LLC,
Patent Owner

Case No. IPR2025-00153
Patent No. 11,631,987

**PETITIONER’S REPLY TO PATENT OWNER’S PRELIMINARY
RESPONSE FOR DISCRETIONARY DENIAL**

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I. INTRODUCTION

Petitioner submits its Reply to Patent Owner's Preliminary Response for Discretionary Denial (PODD) filed April 15, 2025, setting forth the discretionary considerations for Director review. The Director should not exercise her discretion to deny this proceeding because the *Advanced Bionics* framework for evaluating discretionary denial under 35 U.S.C. § 325(d) is not satisfied. Neither the IPR art nor the arguments are the same or substantially the same as those previously presented to the Office, leaving part one of *Advanced Bionics* unmet. For that reason alone, the Director can end her analysis and elect not to exercise her discretion. Even if the Director moves to part two of *Advanced Bionics*, it is also not met because the Office erred in a manner material to the patentability of the Challenged Claims. Accordingly, the Director should not deny institution under 35 U.S.C. § 325(d).

II. PATENT OWNER HAS NOT SHOWN THAT EITHER CONDITION OF *ADVANCED BIONICS* PART ONE IS SATISFIED

Under *Advanced Bionics*, in considering whether to exercise its discretion to deny review under 35 U.S.C. § 325(d), the Director first must decide “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[.]” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7 (PTAB Feb. 13, 2020) (precedential). *Becton, Dickinson* factors (a), (b), and (d) are the relevant factors that should be considered

in this analysis. *Id.* at 10. “[A]s the party requesting that [the Director] exercise [her] discretion to deny institution under Patent Owner § 325(d),” Patent Owner (PO) bears the burden of proof. *Geotab USA, Inc. v. Omega Patents, LLC*, IPR2023-00504, Paper 11 at 16 (PTAB July 25, 2023) (citing 37 C.F.R. § 42.20(c)).

PO has not met its burden of showing that *Advanced Bionics* part one is satisfied. First, PO ignores Oyobe and Seelig—secondary references applied in Petitioner’s two unpatentability grounds—in its PODD. For that reason alone, PO has not met its burden to show that the same or substantially the same art or arguments were previously presented, and the Director should not exercise her discretion under § 325(d). Second, PO’s arguments regarding Ferro ignore the material difference between Ferro and previously cited Hafner and the fact that this material difference is relied upon in both unpatentability grounds. Accordingly, Ferro is not cumulative to Hafner. Finally, PO’s arguments regarding Letendre and Donnelly are cursory and based on a misunderstanding of the applicable standard. At their core, PO’s arguments contend that because the Office previously examined art describing sliders, the sliders of Letendre and Donnelly are cumulative. But that Letendre and Donnelly each share general teachings for “sliders” with the art previously examined by the Office, without more, is insufficient to find part one of *Advanced Bionics* satisfied. A “slider” is a literal requirement of the Challenged Claims, and it is just one of many claimed requirements. *Advanced Bionics* part one

is not satisfied where the Office previously cited art includes teachings as to one limitation of the pending claims that are merely “similar” to teachings in the IPR art.

Accordingly, PO has failed to meet its burden of showing that *Advanced Bionics* part one is met. The Director, therefore, need not move to *Advanced Bionics* part two, and should not exercise its discretion under § 325(d).

A. Patent Owner’s Failure to Address Secondary References for Each of Petitioner’s Unpatentability Grounds is Fatal to Patent Owner’s Request for Discretionary Denial

PO contends that the IPR art is “utilized in the same manner as art already considered by the Examiner.” *PODD*, 3–12. Yet PO never even addresses Oyobe or Seelig—secondary references combined with Ferro and applied by Petitioner for each of its two grounds for unpatentability—at all. *Id.* As Petitioner explained in its Petition, none of Donnelly, Letendre, Seelig, Knockeart, or Oyobe were cited or considered during prosecution of the ’987 Patent. *Pet.*, 80. Further, Donnelly, Letendre, Seelig, and Oyobe are all combined with Ferro for rendering obvious independent claims 1, 8, 15, and 22. *Pet.*, 4, 15–63, 69–75, 76–78. Thus, “because [Ferro] was not presented in combination with the other references asserted here...the combination of references asserted in the Petition do not qualify as art that was ‘previously presented’ to the Office.” *Samsung Elecs. Co., Ltd. v. Netlist, Inc.*, IPR2022-00063, Paper 13 at 13–14 (PTAB May 5, 2022).

Moreover, PO “does not assert or explain sufficiently that [Oyobe or Seelig are] cumulative of any reference cited during prosecution of the [’987] patent.” *Id.* at 13–14; *PODD*, 3–12. For that reason alone, PO cannot meet its burden of showing that part one of *Advanced Bionics* is satisfied. *See, e.g., Ceva Santé Animale S.A. v. Targan, Inc.*, IPR2024-00595, Paper 9 at 13 (PTAB Aug. 5, 2024) (Board finding part 1 of *Advanced Bionics* not satisfied when “Petitioner presents new prior art combinations and arguments...that were not previously considered by the Office”); *Profac Holding Corp. v. Halliburton Energy Servs., Inc.*, IPR2023-01318, Paper 7 at 23 (PTAB Apr. 15, 2024) (*Advanced Bionics* Part 1 not satisfied, even though primary reference considered by Examiner, where petition sets forth new combination of references); *Netlist*, IPR2022-00063, Paper 13 at 14 (“[T]he first condition of the first part of the *Advanced Bionics* framework is not satisfied, and we need not consider whether Petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.”).

B. Patent Owner Ignores the Material Difference Between Ferro and Hafner That is Relied Upon in the Two Unpatentability Grounds

PO does not dispute that Ferro is not cumulative of Hafner because Hafner is silent to any “dynamic” nature of the planner, making Ferro materially different from Hafner. *PODD*, 4 (citing *Pet.*, 81). Rather, Patent Owner requires Ferro, the primary reference, to be materially different from Hafner when “related to the ‘unitary

vehicle charge indicator element’ in which Hafner is entirely cumulative to any portion of Ferro relied on by the Petitioner.” *PODD*, 4–6. However, the material differences are not limited to certain limitations of the claims; any “material differences between the asserted art and the prior art involved during examination” are relevant. *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, 17–18 (PTAB Dec. 15, 2017) (precedential) (describing factor (a)). Petitioner relies upon Ferro’s dynamic nature of the transaction planner for teaching the claimed “dynamic attribute.” *Pet.*, 39–40 (citing Ferro, [0115]), 69, 71–75, 78. Unlike Hafner, Ferro discloses dynamically changing the transaction plan based on an updated price of electricity. Ex. 1004, [0115]. As such, Ferro “present[s] information that is neither substantively similar nor cumulative of that disclosed or suggested by [Hafner],” and the Director should, therefore, “decline to exercise discretion to deny institution pursuant to 35 U.S.C. § 325(d).” *Yealink (USA) Network Tech. Co. LTD., v. Barco N.V.*, IPR2024-01439, Paper 12 at 8 (PTAB Apr. 8, 2025). Additionally, as mentioned in the Petition, the Board previously confirmed Ferro’s dynamic planner to be “materially different” from an essentially identical Hafner. *Pet.*, 81 (citing *Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2023-00062, Paper 13, at 19 (PTAB May 11, 2023)). And while PO describes the Petition’s assertion as “wrong,” that *was* the Board’s prior finding. *Tesla*, IPR2023-00062, Paper 13, at 19. Because Ferro is materially different from Hafner and the material

difference is relied upon throughout both unpatentability grounds, “there is little overlap with any arguments made during prosecution,” weighing factors (a) and (d) against denying institution under § 325(d). *Pet.*, 81.

C. Patent Owner Has Not Shown that Letendre and Donnelly, Alone or in Combination with Ferro, Are Substantially the Same as or Cumulative of the Art Cited During Examination

Regarding Letendre and Donnelly, PO does not dispute Petitioner’s contention that neither reference was cited during examination. *PODD*, 6–12; *Pet.*, 80. Instead, PO argues that because Letendre and Donnelly disclose “similar” technologies (a slider in Letendre, a GUI in Donnelly) to the art cited during examination, Letendre and Donnelly are substantially the same as the art cited during examination. *PODD*, 6–12. But “common technology—standing alone—[does not] satisfy the ‘substantially the same art’ test” of *Advanced Bionics. Geotab*, IPR2023-00504, Paper 11 at 16. The substantially the same art test demands “**a *detailed analysis*** of the similarities between the disclosures” of Letendre/Donnelly and the art cited during prosecution. *Id.* (emphasis added).

PO’s analysis does not meet the *Advanced Bionics* demand for a detailed analysis. The majority of PO’s analysis is spent describing the sliders and/or GUIs disclosed in the Scalisi and Eberhard references considered by the Examiner and the travel distance disclosed in Hafner and Nakai. *PODD*, 6–10. However, PO provides little in the way of a comparison between the cited art’s sliders and Letendre’s slider,

the cited art's GUI's and Donnelly's GUI, or the cited art's distance selection and Letendre's entered desired distance that indicates a desired charge amount. Instead, PO states that "Petitioner relies on Letendre's physical slider" and "combine[s] the slider of Letendre with the GUI bar graph in 'Donnelly.'" *PODD*, 10–11. PO provides just one sentence purporting to compare the teachings of Letendre and Donnelly with the teachings of the art cited by the Examiner: "[T]he art cited by the examiner...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[.]" *PODD*, 11. This lone assertion shows nothing more than Letendre, Donnelly, and the art cited during prosecution relate to common technology. Missing from PO's argument is *any* analysis of the similarities between the references' disclosures—let alone the *detailed* analysis *Advanced Bionics* requires—or any analysis as to suggest that the teachings of Ferro, Letendre, Donnelly, Oyobe, Seelig, or the combinations thereof, that Petitioner relies on for the many remaining limitations of the Challenged Claims are substantially the same as the art cited during examination. *Geotab*, IPR2023-00504, Paper 11 at 16.

Even if PO had established that Letendre and Donnelly are substantially the same as the art cited during prosecution, PO still fails to satisfy *Advanced Bionics* part one because PO does not address whether *the combination* of Letendre or

Donnelly with Ferro (as otherwise modified by Oyobe and Seelig) is substantially the same as *the combination* of art cited during prosecution. *PODD*, 3–12. Accordingly, “the combination of references asserted in the Petition [does] not qualify as art that was ‘previously presented’ to the Office[,]” and PO fails to show that the first part of the *Advanced Bionics* framework is satisfied per *Netlist*, IPR2022-00063, Paper 13 at 13.

While PO’s analyses are insufficient on their face to satisfy *Advanced Bionics* part one, they also fail because PO does not address the material differences between Donnelly/Letendre and the art cited during prosecution.

Starting with Letendre, Letendre teaches a user interface comprising a slider by which a user specifies parameters managing the charging of the electric vehicle’s battery. *Pet.*, 12. The user interface of Letendre’s auto charge controller includes a slider that the driver may move to set a desired level of charge based on the miles needed for travel. *Pet.*, 59. Contrastingly, Scalisi uses a slider to dictate the amount of updates allowed to occur on a tracking device. *Compare Letendre*, FIG. 1 with *Ex. 2007*, FIG. 4. Scalisi is not even related to electric vehicle charging but rather to updating coordinates on a tracking device. *Ex. 2007*, (54), Abstract. Similarly, Eberhard is directed to allowing a user to select a charging *mode* (e.g., “performance,” “standard,” “max range,” “storage,”) via *buttons*. *Ex. 2004*, FIGs. 5–6. Thus, unlike Scalisi and Eberhard, Letendre discloses a slider “that is at least

related to” specifying the amount of charge for an electric vehicle and, therefore, “is neither substantively similar nor cumulative of that disclosed or suggested by” Scalisi and Eberhard. *Yealink Network Tech. Co. LTD. v. Barco N.V.*, IPR2024-01439, Paper 12 at 8 (PTAB Apr. 8, 2025).

Additionally, Nakai, via Fig. 7, calculates an expected travel distance based on a user-entered destination. *Nakai* (Ex. 1094), FIG. 7. Because Nakai calculates the travel distance, Nakai does not even disclose what PO contends it discloses: “*selecting* distance traveled[.]” (emphasis added). *PODD*, 9. Hafner receives information relating to a desired travel distance *between charging locations* and does not use this desired distance to indicate a user-desired charge amount. Ex. 2002, 115. Thus, unlike Nakai and Hafner, Letendre discloses a slider “that is at least related to” specifying the amount of charge for an electric vehicle by entering miles needed for travel, and, therefore, “is neither substantively similar nor cumulative of that disclosed or suggested by” Nakai and Hafner. *Yealink*, IPR2024-01439, Paper 12 at 8.

Turning to Donnelly, Donnelly’s bar graph displays a state of charge of the battery, including an uncharged/charged indicator. *Pet.*, 53–56. Neither Scalisi, Eberhard, Nakai, nor Hafner shows the battery’s available charged/uncharged capacity. *PODD*, 7–9. Scalisi’s adjustable screen icon indicates less/more updates to a tracking device, while Eberhard shows various buttons a user may press to change

the charging mode. Ex. 2007, FIG. 4; Ex. 2003, 7–9. Neither Nakai nor Hafner even show what a GUI would look like in the system, let alone the GUI having a bar graph displayed. *See, generally, Nakai, Hafner* (Exs. 1094, 1095). Thus, unlike Scalisi, Eberhard, Nakai, and Hafner, Donnelly discloses a GUI bar graph “that is at least related to” displaying the state of charge of an electric vehicle and, therefore, “is neither substantively similar nor cumulative of that disclosed or suggested by” the prosecution cited art. *Yealink*, IPR2024-01439, Paper 12 at 8.

Finally, as PO admits, neither Scalisi nor Eberhard was substantively examined during prosecution. *PODD*, 7–9. Additionally, Hafner and Nakai were applied to claims that are markedly different from the now-allowed ’987 claims. *PODD*, 9–10 (citing Ex. 2002, 188, 115). For example, the ’987 claims do not include “defining a desired distance of travel between” two charging locations or “indicating a desired” travel destination. Ex. 2002, 115, 188. Thus, there is no overlap between Petitioner’s detailed analysis supporting the combination of Ferro (otherwise modified by Oyobe and Seelig), Letendre, and Donnelly (*Pet.*, 48–63) and the arguments made during examination.

Taken together, the proper analysis of factors (a), (b), and (d) of *Becton, Dickinson* demonstrates that PO has not met its burden of showing that part one of the *Advanced Bionics* framework is satisfied. Accordingly, the Director can end her analysis here and decide not to exercise her discretion under § 325(d).

III. THE OFFICE MATERIALLY ERRED DURING PROSECUTION OF THE ASSERTED PATENT

Should the Director consider *Advanced Bionics* part two, as Petitioner establishes below, the Office did err “in a manner material to the patentability of the challenged claims[,]” so the Director should not exercise her discretion under § 325(d) for this reason as well. *Becton, Dickinson* factors (c), (e), and (f) are the relevant factors that should be considered at part two. *Advanced Bionics*, IPR2019-01469, Paper 6 at 10.

At the outset, PO suggests that it is “[i]ncredibl[e]” that “Petitioner did not attempt to show material error by the Patent Office.” *PODD*, 1. Petitioner further claims that Petitioner “completely failed to address the second prong of *Advanced Bionics*, much less show that the Examiner erred in a manner material to patentability.” *PODD*, 12–13. But Petitioner directly addressed “Part Two of *Advanced Bionics*” in the Petition and showed how the Examiner materially erred; namely, because the “examiner did not have the benefit of the teachings of” the new, additional references (i.e., Oyobe, Seelig, Letendre, Donnelly, Ferro). *Pet.*, 82 (citing *Hamilton Techs. LLC v. Fleur Tehrani*, IPR2020-01199, Paper 6 at 21 (PTAB Jan. 6, 2021)).

Regardless, the Examiner did not “expressly consider” Ferro in combination with Oyobe, Seelig, Donnelly, and Letendre during prosecution, so “[i]t is difficult

to see how Petitioner could” show material error. *Pet.*, 82; *BowTech Inc., v. MCP IP, LLC*, IPR2019-00379, Paper 14 at 19–20 (PTAB July 3, 2019). And, consequently, “it is therefore difficult, if not impossible, to discern exactly why the Examiner allowed the claims of the [’987 patent], or how the Examiner might have considered the arguments presented in the Petition, had they been presented to the Examiner.” *Id.* Moreover, as explained in the preceding section, the IPR art was never considered by the Examiner during prosecution. *See supra*, Section II. Thus, because the IPR art was “not before the examiner, the examiner could not have considered the combination...during prosecution.” *Hamilton*, IPR2020-01199, Paper 6 at 21. Consequently, “the examiner did not have the benefit of [the IPR arts’] teachings” and committed material error by overlooking them during prosecution. *Id.* (finding “that the examiner materially erred in allowing the claims over Taube because the examiner did not have the benefit of the teachings of” the IPR art); *Advanced Bionics*, IPR2019-01469, Paper 6 at 8–9; *see also*, *Pet.*, 82.

Moreover, the IPR art includes specific teachings that, as the Petition shows, impact the patentability of the Challenged Claims. And, the Petition’s arguments are specific, detailed, and supported by expert testimony as to how the combination of the IPR art teaches the limitations—including the slider limitation 1(i)—and as to why a POSITA would have been motivated to combine the IPR art as proposed. *See, e.g., Pet.*, 48–63 (citing Ex. 1003). Specifically, the slider limitation is rendered

obvious by the combination of Ferro (inputting an amount of charge), Donnelly (displaying charged/uncharged capacity), and Letendre (using the slider to input the amount of charge). *Pet.*, 48–63. Thus, the Petition provides extensive additional evidence and facts supporting the obviousness of the Challenged Claims that were not considered during prosecution and that confirm the Examiner would have committed a material error by allowing the claims over the IPR art, had it been before him.

On this record, *Becton, Dickinson* factors (c), (e), and (f) all weigh against denying institution under § 325(d). *Solaredge Tech. Ltd., v. SMA Solar Tech. AG*, IPR2020-00021, Paper 8 at 11–12 (PTAB Apr. 10, 2020); *Hamilton*, IPR2020-01199, Paper 6 at 21; *Safran Cabin Inc., v. B/E Aerospace, Inc.*, IPR2022-00749, Paper 10 at 12 (PTAB Oct. 21, 2022); *see also, Pet.*, 82.

Finally, PO contends (in a footnote) that Petitioner “should not be afforded the opportunity to create any new arguments...under the second part of the *Advanced Bionics* framework.” *PODD*, 2 n.1. The Director can summarily dismiss this argument. First, as PO recognizes, the Director’s March 26, 2025, Memorandum empowers Petitioner to file an opposition to the *PODD*. *Id.* Second, it is of no moment that “[t]he Petition was filed prior to the issuance of the Memorandum.” *Id.* PO elected to present its arguments under the Memorandum’s new guidance rather than in its *POPR*. Moreover, it is well-established that Petitioner may respond to

PO's *Advanced Bionics* part two arguments because the Office did not address the IPR art or their differences from the prosecution art during examination. *See, e.g., Dexcom, Inc. v. Abbott Diabetes Care Inc.*, IPR2022-00605, Paper 10 at 2 (PTAB July 27, 2022) (noting "Petitioner could not have anticipated when it filed the Petitions the Section 325d arguments raised in the POPRs"); *Unified Patents, LLC v. Memoryweb, LLC*, IPR2021-01413, Paper 2 at Ex. 1020 (PTAB Sept. 3, 2021).

IV. PATENT OWNER DOES NOT CONTEND THAT DISCRETIONARY DENIAL IS WARRANTED OTHER THAN UNDER § 325(d)

Patent Owner contends that discretionary denial is appropriate only under § 325(d). *See generally, PODD*. Thus, the other factors identified in the Board's March 26, 2025, Memorandum are not applicable here. Nonetheless, Petitioner explained in its Petition prior to the Memorandum why discretionary denial is also not warranted under § 314(a) because there is no pending litigation involving the '987 Patent, which PO does not dispute. *Pet.*, 83. Accordingly, the Director should not exercise her discretion to deny institution of this proceeding.

Dated: May 15, 2025

Respectfully submitted,

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COUNSEL FOR PETITIONER

CERTIFICATE OF SERVICE ON PATENT OWNER
UNDER 37 C.F.R. § 42.6

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on May 15, 2025, the foregoing *Petitioner's Reply To Patent Owner's Preliminary Response for Discretionary Denial* was served via electronic filing with the Board and via Electronic Mail on the following practitioners of record for Patent Owner:

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