UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA, INC.,
Petitioner

v.

CHARGELOGIC LLC,
Patent Owner

Case IPR2026-00378
U.S. Patent 11,258,107

PATENT OWNER'S
REQUEST FOR DISCRETIONARY DENIAL

TABLE OF CONTENTS

TABLE OF CONTENTS i

EXHIBIT LIST ii

I. INTRODUCTION 1

II. LEGAL STANDARDS 2

III. ARGUMENT 3

A. The Considerations Set Forth in the Process Memorandum Weigh In Favor of Discretionary Denial. 3

1. Patent Owner Has Strong Settled Expectations. 3

2. The Invalidity Challenge Is Weak. 6

3. The Petition Relies Heavily on Expert Testimony. 9

4. Discretionary Denial Would Improve the PTAB's Ability to Comply with its Statutory Deadlines. 11

5. Petitioner Size and Manufacturing Do Not Favor Institution. 13

B. The *Fintiv* Factors Weigh In Favor of Discretionary Denial. 14

1. Likelihood of a Stay 15

2. Proximity of District Court Trial Date 16

3. Court and Parties' Investment in Parallel Proceeding 17

4. Overlap with Parallel Proceeding 19

5. Same Parties 20

6. Other Circumstances, Including the Merits 20

IV. CONCLUSION 20

EXHIBIT LIST

No.	Description
2001	March 26, 2025 USPTO Memorandum on Interim Processes for PTAB Workload Management, available at https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf ("Process Memorandum")
2002	March 11, 2026 Squires Memorandum on Additional Discretionary Institution Considerations – U.S. Manufacturing and Small Business Use of AIA Proceedings, available at https://www.uspto.gov/subscription-center/2026/uspto-issues-additional-discretionary-institution-facts ("Small Business Memorandum")
2003	Excerpts from File History of U.S. Patent Application 18/298,152 (issuing as U.S. Patent No. 12,272,189)
2004	USPTO Reexaminations – FY 2026, Quarter ending 6/30/2026, available at https://www.uspto.gov/sites/default/files/documents/reexamination-op-stats.pdf
2005	Tesla, Inc. Form 10-K for the Year Ending December 31, 2025
2006	Complaint for Patent Infringement and Jury Demand, *ChargeLogic LLC v. Tesla, Inc.*, C.A. No. 7:26-cv-00100 (W.D. Tex. March 23, 2026)
2007	Shareholder Deck for Q2 2026 Update, Tesla Investor Relations, July 22, 2026, available at https://assets-ir.tesla.com/tesla-contents/IR/TSLA-Q2-2026-Update.pdf
2008	NHTSA Part 583 American Automobile Labeling Act Report for 2026, available at https://www.nhtsa.gov/part-583-american-automobile-labeling-act-reports
2009	CM/ECF Docket Report, *ChargeLogic LLC v. Tesla, Inc.*, C.A. No. 7:26-cv-00100 (W.D. Tex.) (as of August 23, 2026)

No.	Description
2010	Joint Proposed Scheduling Order, *ChargeLogic LLC v. Tesla, Inc.*, C.A. No. 7:26-cv-00100, Doc. 34-1 (W.D. Tex. Aug. 10, 2026)
2011	U.S. Patent 10,090,567

I. INTRODUCTION

Patent Owner ChargeLogic LLC ("ChargeLogic") requests that the Director exercise discretion to deny institution of *inter partes* review under 35 U.S.C. § 314. Several considerations from the Director's Interim Processes for PTAB Workload Management ("Process Memorandum") weigh heavily in favor of discretionary denial, including Patent Owner's strong settled expectations of patentability (*infra* Section III.A.1), the weakness of the validity challenge (*id.* at A.2), heavy overreliance on expert testimony by Petitioner (*id.* at A.3), and the potential to improve the PTAB's ability to meet its statutory deadlines (*id.* at A.4).

The *Fintiv* factors also favor discretionary denial. *Infra* Section III.B. Before the institution decision deadline, the parties will have served preliminary infringement and invalidity contentions, exchanged and narrowed the claim terms in dispute, and disclosed extrinsic evidence; and before any final written decision, *Markman* briefing and the hearing, fact and expert discovery, the dispositive motions deadline, and extensive pretrial disclosures will all be complete. Because there is no indication that the district court will stay the lawsuit, both the parties and the district court will necessarily expend substantial and duplicative resources before any final written decision issues. In addition, Petitioner is not pursuing this IPR as a true alternative to its district court invalidity case; it has reserved the right to present §§ 102/103 challenges in the lawsuit, including based on publications and patents.

Moreover, there are a total of six IPR petitions pending against the challenged patent—U.S. Patent No. 11,258,107 ("the '107 Patent")—and five related patents. The merits of all six are *very* weak. *Infra* Section III.A.2. But even if Petitioner could carry its institution-burden in some of its petitions, such institution would not simplify or reduce the burden of parallel litigation. The Board's finite resources would be consumed adjudicating validity questions that the district court is already positioned to resolve—and will resolve—on a schedule unaffected by the Board's action and with a trial date within a month of the projected final written decisions.

II. LEGAL STANDARDS

Under 35 U.S.C. § 314, the Director has broad discretion regarding whether to institute an IPR proceeding. *See, e.g., In re Motorola Sols., Inc.*, 159 F.4th 30, 36 (Fed. Cir. 2025); *SAS Inst. Inc. v. Iancu*, 584 U.S. 357, 366 (2018). The precedential *NHK Spring* and *Fintiv* decisions established the "*Fintiv* factors" governing that discretion where parallel proceedings are pending. *Motorola*, 159 F.4th at 34. The Director has further explained that the discretion should focus on the public interest, unlike the "broad adjudication of private disputes in district court litigation." *Magnolia Med. Techs., Inc. v. Kurin, Inc.*, IPR2026-00097, Paper 17 at 7 (PTAB May 14, 2026) (precedential).

The Process Memorandum further detailed the Director's consideration of additional relevant factors including but not limited to the merits, the extent of the

petitioner's reliance on expert testimony, the settled expectations of the parties, compelling economic interests, and the ability of the PTAB to comply with its statutory deadlines. Ex. 2001 at 2-3. The subsequent Small Business Memorandum also identifies additional considerations related to U.S. manufacturing and small business use of AIA proceedings. Ex. 2002.

III. ARGUMENT

Discretionary denial is warranted pursuant to *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (designated precedential) ("*Fintiv*") and other relevant considerations set forth in the Director's subsequent guidance memorandums and decisions, as detailed below.

A. The Considerations Set Forth in the Process Memorandum Weigh In Favor of Discretionary Denial.

1. Patent Owner Has Strong Settled Expectations.

Although "there is no bright-line rule on when expectations become settled, in general, the longer the patent has been in force, the more settled expectations should be." *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21, at 3 (Dir. June 18, 2025) (informative). Strong settled expectations for patent owners exist for patents that have been in force for at least six years. *See, e.g.*, *id.* at 2; *Kahoot! AS v. Interstellar Inc.*, IPR2025-00696, Paper 12 at 2 (Dir. July 31, 2025).

Here, the first patent in the family (U.S. Patent 10,090,567) issued October 2, 2018, nearly eight years ago and more than seven years before the Petition was filed.

Ex. 1001 at 2 ("Related Application Data"); Ex. 2011. Thus, ChargeLogic has strong settled expectations that the '567 Patent is valid. The '107 Patent shares the same specification as the '567 Patent, covers very similar subject matter, and issued more than four and a half years ago. Although a patent issued within the past six years has been cited as a factor that "might favor referral to the Board," *Phison Elec. Corp. v. Vervain, LLC*, IPR2025-00213, Paper 14 at 3 (Dir. July 10, 2025), that factor is outweighed here by the other factors discussed herein. *See, e.g.*, *Samsung Elecs. Co. Ltd. v. GenghisComm Holdings LLC*, IPR2025-00788, Paper 11, at 2 (Dir. Aug. 22, 2025) ("Although the patents challenged in these proceedings have not been in force for as long as those in [parallel IPRs], this fact alone does not tip the balance against discretionary denial."); *Tesla, Inc. v. Granite Vehicle Ventures, LLC*, IPR2025-00943, Paper 17 at 2 (Dir. Sept. 26, 2025) ("Even though the challenged patents have not been in force for a significant period of time (issued in 2023), this fact alone does not tip the balance against discretionary denial.").

The '107 Patent is a continuation of parent applications in which the first issued family member—the '567 Patent—has been in force since at least 2018. Even where the challenged patent itself has not been in force for more than six years, its membership in a portfolio that has been in force or was known to Petitioner nonetheless creates settled expectations for ChargeLogic. *See, e.g.*, *iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 at 3 (Dir. June 6, 2025)

(discretionarily denying institution where petitioner was aware of one patent in portfolio after it was cited in petitioner's own patent application); *Datadome S.A. v. Arkose Labs Holdings, Inc.*, IPR2025-00693, Paper 13 at 2 (Dir. Aug. 14, 2025) (denying institution based, in part, on awareness of Patent Owner's portfolio in general). The challenged subject matter is fully supported by the specification of that parent application, and settled expectations regarding the portfolio favor denial here.

Further, because published patent applications and issued patents are publicly available, "actual notice of a patent or of possible infringement is not necessary to create settled expectations." *Dabico Airport*, IPR2025-00408, Paper 21 at 3. Here, Petitioner *did* have personal knowledge of the published application of the '567 Patent more than two years ago: during examination of Petitioner's own patent application on August 15, 2024 the published application was **explicitly applied by the Examiner** to reject Petitioner's pending claims. Ex. 2003 at 28 (citing U.S. Patent Application Publication No. 2011/0175569 A1); *see* Ex. 2011 at 1. With that knowledge of the family, Petitioner should also have been aware of the '107 Patent, and the Office has found such actual knowledge relevant to the settled expectations analysis. *See, e.g.*, *Google LLC v. SoundClear Techs., LLC*, IPR2025-00344, Paper 15 at 2-3 (Dir. Aug. 4, 2025); *iRhythm Techs.*, IPR2025-00363, Paper 10 at 3 (discretionarily denying for settled expectations where petitioner was aware of a challenged patent's application because it was cited during examination of

petitioner's patent application); *Murata Mfg. Co. v. Georgia Tech. Research Corp.*, IPR2025-00383, Paper 14 at 2-3 (Dir. July 29, 2025) (Petitioner's knowledge of challenged patent created settled expectations favoring denial, because "failure to seek early review of the patent favors denial and outweighs the above-discussed considerations.").

2. The Invalidity Challenge Is Weak.

Patent Owner is permitted to "direct attention to an anticipated POPR and evidence for a discussion of the merits," but "should not repeat its merits arguments verbatim but should briefly explain why the merits are relevant."[1] The Petition is weak for many reasons. Four are briefly addressed below.

First, the Petition's threshold defect is one of claim construction. Every ground is premised exclusively on an express construction of "threshold level of charge"—a term recited in all independent claims—that Petitioner never explains or substantiates, and that Petitioner's own expert declines to endorse, applying it only because he was "instructed by counsel" to do so. POPR at Section III (citing Ex. 1003 ¶ 28). Because Petitioner maps the prior art to the claims under that construction and no other, the construction's failure is the Petition's failure, and

[1] https://www.uspto.gov/patents/ptab/interim-director-discretionary-process ("Interim Director Discretionary Process") at § II.c.i. (accessed Aug. 22, 2026).

Petitioner cannot carry its burden. *Id.* (citing supporting authority). Compounding the problem, Petitioner advances inconsistent claim construction positions across these related IPR proceedings and offers no explanation for the inconsistency—precisely the gamesmanship the Director has refused to countenance. *Id.* (citing *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 at 3–5 (Dir. Nov. 3, 2025) (precedential) (vacating institution because petitioner failed to adequately explain why it took an inconsistent claim construction position between the IPR and district court litigation)). Tesla certainly knows better. *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18 (Dir. Nov. 5, 2025) (informative) (denying institution where Tesla took inconsistent claim construction positions).

Second, the prior art is very weak. Petitioner does not advance a single anticipation ground, relying instead on ***six*** obviousness grounds. Pet. at 2. Four of those grounds require at least ***four*** prior art references to reach the independent claims alone, and the remaining two require ***three***. *Id.* In several key grounds, Petitioner *first* argues that a POSITA would have combined two distinct embodiments of Sutardja, and only *then* stacks three or more further references on top of that internal combination. *Id.* at 29. When a petitioner's strongest challenge cannot reach the independent claims without three—and usually four—separate references, that is *de facto* evidence of the weakness of the challenge.

Third, this reference-stacking is not merely inelegant; it introduces numerous substantive errors. Because Petitioner assembles so many disparate references—a hindsight-driven mosaic reverse-engineered from the claims—its analysis depends on groupings that defy the art. For example, Petitioner repeatedly resorts to illogical "box drawing" by roping together multiple disparate prior art elements in ways that make no sense, including for the "battery charger" limitation recited in all claims. *See e.g.*, Pet. at 7-8, 10-11.

Four of the six grounds likewise depend on importing Hobbs's "***current*** threshold" into Sutardja's battery charger system, which Petitioner contends already teaches a predetermined threshold ***level of battery*** charge. Pet. at 11-16. But Hobbs's separate, hardware-derived ***current*** threshold is structurally and functionally incompatible with Sutardja's user-input ***charge-percentage*** parameter. Even if a POSITA would have combined Hobbs with Sutardja, the combination would *still* not satisfy every claim element. Moreover, Petitioner does not show that a POSITA would have found it obvious to modify Sutardja to rely on the complex current-based threshold system of Hobbs or had a reasonable expectation of success. That Petitioner chose to rely on Hobbs—which discloses a fundamentally different and more complex ***current***-threshold charging system—evidences the weakness of the Petition and "impermissible hindsight reconstruction." *LG Energy Solution, Ltd. v. Molecular Rebar Design, LLC*, IPR2024-01006, Paper 37 at 21 (PTAB Dec. 15,

2025).

Fourth, the Petition's unnecessarily complex and confusing presentation compounds its substantive weakness. For example, it contains ***eighteen* (18)** separate "motivation to combine" sections sporadically placed throughout, each with its own "reasonable expectation of success" argument, which Petitioner compresses into the acronyms "MTC" and "REOS"—apparently to skirt the word-count limit. *See* Pet. at ii-vi; *id.* at 4 n.1. Indeed, the table of contents alone spans five pages. Pet. at ii-vi. This complexity needlessly burdens both the Board and Patent Owner in attempting to analyze the Petition and is prejudicial to Patent Owner's ability to reasonably respond to the voluminous obviousness theories raised. Worse, these "MTC" sections repeat the same vague and generalized assertions from ground to ground. *Compare, e.g.*, Pet. at 16, 19, 24, 36, 41, 48, 59, 61, 78, 86 (alleging various combinations involved use of a "known technique" "to improve" a "similar device" "in the same way"). A Petition that requires 18 discrete "MTCs," often in repeated conclusory terms, is not strong. The Board's limited resources are better devoted to petitions grounded in the references themselves.

3. The Petition Relies Heavily on Expert Testimony.

The Office has previously explained that:

> [E]xtensive reliance on expert testimony and/or reasonable disputes between experts on dispositive issues may suggest that the questions are better resolved in an Article III court. The statute and our reviewing

> court require that petitions be based on prior art patents and printed publications. As the judges have technical and legal expertise, it is not necessary for an expert to explain every aspect of the prior art. It is most helpful if an expert is providing focused testimony, for example to provide helpful context or to explain terms of art. The failure to provide focused expert testimony may weigh against institution.[2]

This factor is still reflected in the Office's current guidance. *See* Interim Director Discretionary Process § I.B. This consideration favors discretionary denial because the Petition relies heavily on the unfocused declaration testimony of Petitioner's proposed expert, Scott Andrews. Indeed, Mr. Andrews' declaration consists of 303 paragraphs of testimony spanning 216 pages. *See generally* Ex. 1003. The Petition extensively cites to and relies upon his testimony, including attempting to plug holes by arguing that certain features not disclosed in the relied-on references would have been obvious. *See, e.g.*, Pet. at 16-17, 19, 23, 29, 33, 46, 47, 53 (examples of the many "MTC" sections). Indeed, the acronym "POSITA" appears 85 times.

Further, Mr. Andrews' declaration contains much of the same language as the Petition, even including the same annotations and color-coding used in the Petition.

---

[2] FAQs for Interim Processes for PTAB Workload Management ("Interim FAQs"), at #22, https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management (last accessed on Aug. 22, 2026) (superseded).

Compare, e.g., Pet. at 4-41 *with* Ex. 1003 ¶¶ 92-169 (Ground 1 analysis); Pet. at 50-60 *with* Ex. 1003 ¶¶ 194-221 (Ground 3 analysis); Pet. at 62-87 *with* Ex. 1003 ¶¶ 228-294 (Ground 5 analysis). The Board has been skeptical where arguments from the petition are repeated verbatim by a witness purporting to give expert testimony. *Kinetic Techs., Inc. v. Skyworks Sols., Inc.*, IPR2014-00529, Paper 8 at 14-15 (PTAB Sept. 23, 2014) (denying institution). Such skepticism is warranted in reviewing the Petition considering Mr. Andrews' extensive repetition of the Petition, as well as the nature of the technology at issue. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, at 15, 19 (PTAB Aug. 24, 2022) (precedential) (denying institution).

Moreover, there are at minimum "reasonable disputes between experts on dispositive issues" that are "better resolved in an Article III court." Interim FAQs at #22. The preliminary response will identify several such disputes as to whether the limitations of the independent claims are obvious in view of the asserted prior art. While ChargeLogic submits that the prior art plainly fails to teach those limitations, the existence of these disputes independently favors denial, and the Board's resources are better allocated to petitions grounded in the references themselves.

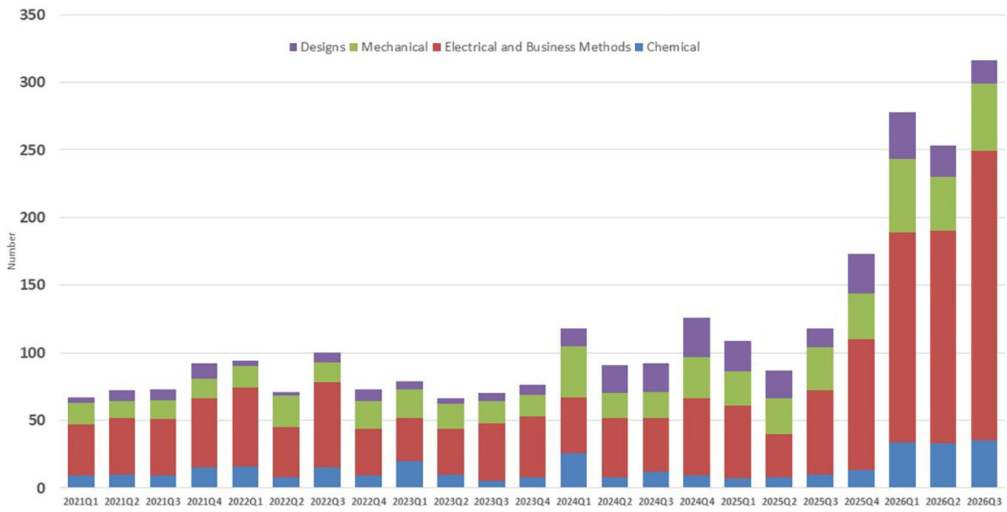
4. Discretionary Denial Would Improve the PTAB's Ability to Comply with its Statutory Deadlines.

This consideration relates to "the ability of the PTAB to comply with pendency goals for *ex parte* appeals, its statutory deadlines for AIA proceedings, and other workload needs." Process Memorandum at 3. The above-captioned

proceeding is one of six *inter partes* review petitions filed by Petitioner concerning the same six patents asserted in the underlying Texas litigation. Pet. at 92. The full list of proceedings includes IPR2026-00377 (USP 10,090,567), IPR2026-00378 (USP 11,258,107), IPR2026-00379 (USP 11,508,996), IPR2026-00380 (USP 11,721,844), IPR2026-00381 (USP 11,909,010), and IPR2026-00382 (USP 11,909,011). *Id.* However, the reasons for discretionary denial herein largely apply with equal force to the five other pending petitions. Thus, discretionary denial would not only free up Board resources associated with this proceeding, but also the five other proceedings. Further, the Director has explained that in similar situations involving several IPR petitions challenging patents asserted in a single district court proceeding, "addressing all of the challenged patents in the district court proceeding would be the fastest and most efficient resolution" of the parties' disputes. *Samsung Elecs. Co. v. VB Assets, LLC*, IPR2025-00870, Paper 11 at 3 (Chief APJ Oct. 10, 2025). Given the focus "on the ability of the PTAB to comply with pendency goals for *ex parte* appeals, its statutory deadlines for AIA proceedings, and other workload needs," denial is favored here as it would free significant Board resources, including for appeals relating to ordinary prosecution and EPRs. Process Memorandum at 3.

The availability of PTAB resources is of particular importance given the recent surge in *ex parte* reexamination ("EPR") filings. Specifically, the PTO's

statistics[3] show a substantial 2x-3x increase in EPR filings beginning Q4 2025:



Recent Office statistics show that 297 EPRs were filed in the third fiscal quarter of 2026 (April–June 2026) alone. *See* Ex. 2004 at 1. Thus, the surge beginning in late 2025 is not an anomaly—it is part of a clear upward trajectory that *continues* to increase, reaching its highest number to date in the last quarter. Discretionary denial will further the goal of ensuring the PTAB can efficiently meet its statutory deadlines in IPRs and PGRs, as well as the goal of efficiently deciding EPR appeals.

5. Petitioner Size and Manufacturing Do Not Favor Institution.

Petitioner is not a small business. It has a current market capitalization of over $1 trillion and reported fiscal 2025 revenues of $94.8 billion, Ex. 2005 at 31, and so qualifies as a large, "market dominant company" like those the Director has found

[3] https://www.uspto.gov/learning-and-resources/statistics/reexamination-information (last accessed Aug. 22, 2026).

to dominate IPR filings. *Magnolia Med. Techs.*, IPR2026-00097, Paper 17 at 5. Although Petitioner maintains extensive manufacturing and assembly operations in the United States, its own disclosures show that it also depends substantially on foreign production: its installed annual U.S. automotive capacity for the accused products[4] is approximately 1,050,000 units per year, against approximately 1,325,000 units per year outside the United States. Ex. 2007 at 6. And as of June 2026, 25-40% of the parts in the accused products (by value) were made outside the U.S. and Canada, with some portion of the remaining 60-75% made in Canada rather than the United States. *See* Ex. 2008 at 8-9. Given Petitioner's size and its considerable reliance on foreign parts and labor, this consideration is at most neutral.

B. The *Fintiv* Factors Weigh In Favor of Discretionary Denial.

The Director should also exercise discretion to deny institution pursuant to the *Fintiv* factors. The patent challenged in this Petition, and the patents challenged in related proceedings, are concurrently asserted against Petitioner in parallel litigation in the Western District of Texas before Judge Counts, with Magistrate Judge Gilliland being assigned to handle all pre-trial matters. *See ChargeLogic LLC v. Tesla, Inc.*, Case No. 7:26-cv-00100-DC-DTG (filed Mar. 23, 2026) ("the Litigation"). Because substantial efforts by the parties (and the district court) will

[4] Ex. 2006 ¶¶ 38-39 (identifying Model 3, Y, S, X, Cybertruck, and Semi).

occur before institution and any final written decision due to the low likelihood of a stay, the *Fintiv* factors strongly favor exercising discretion not to institute.

1. Likelihood of a Stay

There is no stay of proceedings in the parallel litigation, no motion to stay has been filed, and there is no evidence that a stay is likely should such a motion be filed. *See, e.g.*, *Samsung Elecs. Co. v. GenghisComm Holdings, LLC*, IPR2025-00899, Paper 10 at 2 (Chief APJ Sept. 26, 2025) (denying institution based on *Fintiv* where the time of trial was close to the projected issuance date of the FWD and the co-pending litigation had insufficient evidence of stay). Any assertion that a stay will be granted is entirely speculative and discretionary denial is appropriate under this factor. *See Samsung Elecs. Co., Ltd. v. Telcom Ventures LLC*, IPR2025-00957, Paper 12 at 2 (Chief APJ Oct. 10, 2025). Patent Owner is aware of no instance in which Judge Counts has granted a contested motion to stay pending IPR, and the practice of most district courts is to deny a stay where the Board has not yet acted on the petition. *Arbor Global Strategies v. Samsung Elecs. Co.*, No. 2:19-cv-333-JRG-RSP, 2021 U.S. Dist. LEXIS 2434, at *7 (E.D. Tex. Jan. 7, 2021) (explaining the practice of most district courts).

Even if Petitioner moves to stay, there is "insufficient evidence that the district court is likely to stay its proceeding even if the Board were to institute trial." *See, e.g., Cerence Op. Co. v. Samsung Elecs. Co.*, IPR2025-00458, Paper 14 at 2 (Chief

APJ June 25, 2025); *Cisco Systems, Inc. v. WSOU Investments LLC*, IPR2025-00429, Paper 15 at 2 (Dir. June 25, 2025). Board resources should be reserved for situations where litigation will not proceed in parallel. Thus, this factor favors denial. *See*, *e.g., GenghisComm*, IPR2025-00899, Paper 10 (institution denied under *Fintiv* where trial date was close to projected FWD issuance and there was insufficient evidence a stay would be granted); *Telcom Ventures*, IPR2025-00957, Paper 12 (same).

2. Proximity of District Court Trial Date

Although trial in the Litigation has not been set, the parties recently jointly submitted a proposed scheduling order that sets trial for January 18, 2028,[5] which is less than a month after the projected statutory deadline for a final written decision (December 23, 2027).[6] It is also possible that the statutory deadline for the final written decision could be extended up to six months, putting the latest possible deadline for the final written decision on June 23, 2028, roughly five months after

[5] Ex. 2009, Doc. 34-1; Ex. 2010.

[6] This date was determined based on the June 23, 2026 Notice of Filing Date Accorded (Paper 3), the 3-month deadline to file a preliminary response (Sept. 23, 2026), the 3-month deadline to issue a decision on institution, and the 1-year deadline to issue a final written decision. *See* 35 U.S.C. §§ 314(b), 316(a)(11).

the trial. 35 U.S.C. § 316(a)(11). Even assuming institution, by the time a final written decision issues the parties will be at the cusp of a jury trial after having expended significant resources addressing validity, infringement, and damages. Further, given that the trial is scheduled within the relevant deadlines for rehearing and appeal of the final written decision, institution here creates no efficiencies for the parties or the court below whatsoever. Because trial is scheduled to occur within a month of the projected deadline for the final written decision, this factor is at best neutral, or at worst slightly favors not exercising discretion to deny. *Protect Animals with Satellites v. OnPoint Sys.*, IPR2021-01483, Paper 11 at 12-13 (PTAB Mar. 4, 2022) (finding proximity factor neutral where the FWD was due approximately one month after the trial deadline); *see also iRhythm Techs.*, IPR2025-00363, Paper 10 at 3 (discretionarily denying institution even though trial date was seven months after projected FWD deadline due to other factors).

3. Court and Parties' Investment in Parallel Proceeding

This factor is related to the trial date factor and whether institution would lead to duplicative costs. *Fintiv*, IPR2020-00019, Paper 11 at 10. Here, the parties have already invested in the litigation. Petitioner filed a motion to dismiss under Rule 12(b)(6), which the parties resolved by entering a joint stipulation. Ex. 2009, Doc. 26. Petitioner also filed a motion to transfer venue, which is pending. *Id.*, Doc. 32. Further, before the projected institution decision deadline (December 23, 2026), the

parties will have taken venue discovery and fully briefed the motion to transfer, prepared and served preliminary infringement and invalidity contentions, exchanged proposed claim terms and met and conferred to narrow the terms in dispute, disclosed extrinsic evidence, and claim construction briefing (except for Plaintiff's sur-reply) will be completed. *See* Ex. 2010. Before the deadline for a final written decision, the Court will have held the *Markman* hearing, fact and expert discovery will be closed, the deadline for dispositive motions will have passed, and the parties will have served pretrial disclosures (jury instructions, exhibit lists, witness lists, and discovery and deposition designations). *Id.* A final written decision will issue only approximately three weeks before the trial date and would prevent none of the foregoing efforts by the parties or the district court.

A final written decision in this case will therefore not be received in time to create any efficiency in the co-pending litigation. *See Samsung*, IPR2025-00870, Paper 11 at 2 (explaining that even where the FWD will issue before trial, it does not outweigh the efficiencies gained by avoiding parallel proceedings); *Shenzhen Tuozhu Tech. Co. v. Stratasys, Inc.*, IPR2025-00354, Paper 11 at 2 (Dir. June 12, 2025) (denying institution where "[e]xercising discretion to deny the petition in this case reduces the inefficiencies and burdens on the parties to maintain two parallel proceedings").

4. Overlap with Parallel Proceeding

Petitioner submitted a stipulation pursuant to *Sotera Wireless, Inc. v. Masimo Corporation*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020):

> [I]f IPR is instituted in any of the IPRs ("the instituted IPR"), then in … ("the Parallel Litigation"), Tesla will not advance against the claims challenged in any instituted IPR: (i) the specific grounds asserted in the instituted IPR(s); (ii) any ground that reasonably could have been raised in the instituted IPR(s) (i.e., any ground that reasonably could have been raised under §§ 102 or 103 on the basis of prior art patents or printed publications); or (iii) any other ground based on a combination of system art with any prior art reference asserted as the basis of a ground in the instituted IPR(s).

Ex. 1042. Element (iii) is carefully crafted such that Petitioner reserves its ability to pursue invalidity theories in the district court based on system art alone, or in combination with *any* patents or publications, except for the few references relied on in the asserted grounds of the Petition. *See id*. Thus, Petitioner is not offering a true alternative to litigating validity in the district court, causing this factor to weigh in favor of exercising discretion to deny institution. *Magnolia*, IPR2026-00097, Paper 17 at 3 ("[A]ll too often the co-pending litigation involves either the same arguments as the AIA review, or a petitioner asserts system art in the litigation that overlaps with the patents or printed publications asserted in the AIA review—a tell-tale sign that the AIA review is not functioning as a litigation alternative."); *see also*

Motorola Sols., Inc. v. Stellar, LLC, IPR2024-01205, Paper 19 at 3-4 (Dir. March 28, 2025) (vacating institution and finding this factor favors denying institution despite *Sotera* stipulation because the "stipulation does not ensure that these IPR proceedings would be a true alternative to the district court proceeding").

5. Same Parties

The parties are the same as those in the Litigation, favoring denial. Ex. 2006.

6. Other Circumstances, Including the Merits

The considerations set forth in Section III.A also strongly favor exercising discretion to deny institution, including but not limited to strong settled expectations (Section III.A.1) and the weakness of the invalidity challenge (Section III.A.2). As the Office has repeatedly recognized (including in *Fintiv*), no single factor or consideration is dispositive, and the Director "takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review." *Fintiv*, Paper 11 at 6. A holistic view heavily favors discretionary denial.

IV. CONCLUSION

For the reasons above, ChargeLogic respectfully requests that the Director exercise discretion and deny institution of *inter partes* review.

Dated: August 23, 2026

Respectfully submitted,

/Stephen D. Zinda/
Stephen D. Zinda
Reg. No. 67,272
Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that on August 23, 2026, the foregoing document and all exhibits were served via electronic mail at the following e-mail addresses, where Petitioner has previously consented to electronic service:

Jennifer C. Bailey (Reg. No. 52,583)
jennifer.bailey@eriseip.com
PTAB@eriseip.com

Robin A. Snader (Reg. No. 66,085)
Robin.Snader@eriseip.com

Adam M. Sandwell (Reg. No. 72,484)
Adam.Sandwell@eriseip.com

Graeme I. Gillespie (Reg. No. 800,141)
Graeme.Gillespie@eriseip.com

ERISE IP, P.A.

Ashraf Fawzy (Reg. No. 67,914)
afawzy@tesla.com

TESLA, INC.

/Stephen D. Zinda/
Stephen D. Zinda