IceMiller
LEGAL COUNSEL

One American Square | Suite 2900 | Indianapolis, IN 46282-0200

July 31, 2020

WRITER'S DIRECT NUMBER: (317) 236-5946
DIRECT FAX: (317) 592-4844
INTERNET: Tom.Walsh@icemiller.com

Settlement Communication Subject to Federal Rule of Evidence 408

VIA EMAIL (SSUMITANI@STETINALAW.COM)

Mr. Sam Sumitani
Stetina Brunda Garred & Brucker
75 Enterprise Street, Suite 250
Aliso Viejo, CA 92656

RE: Correspondence to MWE Investments, LLC dated June 23, 2020 regarding U.S. Patent No. 10,598,101

Dear Mr. Sumitani:

As I noted in my letter dated June 10, 2020, MWE Investments, LLC asked me to look at the disclosure, claims, and prosecution history of U.S. Patent No. 10,598,101 (the "'101 Patent") in light of the allegations of infringement contained in your June 23, 2020 letter.

As I am certain you are aware, dual fuel internal combustion engines have been used to propel vehicles and for electric power generation for decades. Dual fuel internal combustion engine technology is well known, as is the technology for selecting the fuel that is being supplied to the internal combustion engine. As such, there is a substantial body of public knowledge about the evolution of dual fuel internal combustion engines and the technology for selecting the fuel that is being supplied to the internal combustion engine, including patents, published patent applications, and other publications that all are prior art to the '101 Patent. Accordingly, there are significant questions of validity with respect to the '101 Patent. Claims 1, 17, and 18 of the '101 Patent claim well known structures for selecting the fuel that is supplied to a dual fuel internal combustion engine. We are aware of and/or in possession of prior art that will support invalidation of Claims 1, 17, and 18 of the '101 Patent. We are prepared to present this evidence in litigation or in an Inter Partes Review proceeding if it becomes necessary.

Turning now to your allegations of infringement, an infringement analysis requires two separate steps. First, the scope of the claims must be construed to determine their meaning and scope. Second, the claims as construed are compared to the allegedly infringing product.

Claims 1, 17, and 18 of the '101 Patent employ certain facially broad terms, such as, but not limited to, "selector switch" and "valve assembly." There is no doubt these terms were

chosen intentionally, as they convey an amorphous scope that is useful when threatening parties with patent infringement. However, after applying claim construction principles as would be done in litigation or in an Inter Partes Review proceeding before the Patent Trial and Appeal Board, these terms take on more specific meanings.

The selector switch disclosure of the '101 Patent is limited to a "linearly translatable" selector switch. There is no disclosure in the '101 Patent of any other type of selector switch. In particular, there is no disclosure in the '101 Patent of a rotating selector switch, such as the rotating selector switch used in the Westinghouse® generators.

Two distinct and separate valve assemblies are disclosed in '101 Patent: a "first valve assembly" that controls the flow of a first fuel, and a "second valve assembly" that controls the flow of a second fuel. There is no disclosure in the '101 Patent of a single valve assembly that controls the flow of two fuels. The linearly translatable selector switch disclosed in the '101 Patent slides linearly to cover one or the other of the first valve assembly or the second valve assembly. The function of the linearly translatable selector switch is to mechanically prevent both the first valve assembly and the second valve assembly from being open at the same time. To change between the first fuel and the second fuel, the first valve assembly must be manually closed, and then the linearly translatable selector switch must be moved to cover the closed first valve assembly, and then the second valve assembly must be manually opened. To change back to the first fuel, the second valve assembly must be manually closed, and then the linearly translatable selector switch must be moved to cover the closed second valve assembly, and then the first valve assembly must be manually opened.

The function of the linearly translatable selector switch disclosed in the '101 Patent is essentially the same as a lockout switch, the use of which well known in the electrical distribution field. For example, it is well known to equip an electrical breaker panel with a lockout switch that mechanically prevents both utility-supplied electric service and electric service supplied by a backup generator from being active at the same time. It is highly likely that the inventors of the '101 Patent had this structure in mind when designing the selector switch that is disclosed in the '101 Patent.

It is evident from your June 23, 2020 letter that you have a working knowledge of the Westinghouse® generators that are alleged to infringe Claims 1, 17, and 18 of the '101 Patent. As you know, the Westinghouse® generators employ two separate valves to control the flow of two separate fuels to the generator engine. This two-valve arrangement is universally used in dual fuel internal combustion engines. In the Westinghouse® generators, the two valves are part of a single valve assembly, and a rotatable selector switch enables a user to change between a first fuel and a second fuel. To change between the first fuel and the second fuel, the rotatable selector switch simply must be rotated in a first direction. To change back to the first fuel, the rotatable selector switch must be rotated in the opposite direction. Rotation of the selector switch in the Westinghouse® generators opens and closes the valves controlling the flow of the two fuels.

EX2034 (IPR2025-00951)
Patent Owner Champion

Regarding Claim 1 of the '101 Patent, you alleged that the rotating selector switch in Westinghouse® generators that opens and closes the valves controlling the flow of the two fuels fits within the scope of the "selector switch" and "valve assembly" limitations of Claim 1. This allegation cannot survive scrutiny. While it is true that claim language should be construed according to its ordinary and accustomed meaning in most cases, it also is true that claim language cannot be construed to recapture the prior art. In this case, the prior art is replete with disclosures of multi-port fluid valves where the flow of multiple fluids is controlled by a single rotating control mechanism. Of course, this prior art would not have been considered during prosecution of the '101 Patent, because there is not the slightest hint in the written description or drawings of the '101 Patent that the inventors had this type of selector switch and valve assembly structure in mind.

Therefore, it appears that Claim 1 can remain valid only if the "selector switch" and "valve assembly" limitations are narrowly construed to be limited to structure disclosed in the '101 Patent. Pursuing the broader claim construction that you assert in your June 23, 2020 letter will inevitably render Claim 1 invalid. Accordingly, if the "selector switch" and "valve assembly" limitations of Claim 1 are narrowly construed so as to preserve the validity of Claim 1, the Westinghouse® generators cannot infringe Claim 1. If the "selector switch" and "valve assembly" limitations of Claim 1 are construed to cover the selector switch and valve assembly used in the Westinghouse® generators, Claim 1 is invalid.

Claim 17 of the '101 Patent includes limitations pertaining to a "solenoid switch" and a "fuel solenoid," with a "selector switch" that triggers the solenoid switch when the selector switch is "changed from the second fuel mode to the first fuel mode." The use of solenoids to control the flow of fluids, including fuels, is well known. The "selector switch" limitation must be construed consistently across all claims of the '101 Patent. Therefore, as with Claim 1, the "selector switch" must be narrowly construed to have the meaning disclosed in the '101 Patent in order to preserve the validity of Claim 17. Accordingly, if the "selector switch" limitation of Claim 17 is narrowly construed so as to preserve the validity of Claim 17, the Westinghouse® generators cannot infringe Claim 17. If the "selector switch" limitation of Claim 17 is construed to cover the selector switch used in the Westinghouse® generators, Claim 17 is invalid.

Claim 18 of the '101 Patent is substantially the same as Claim 1, and suffers from the same defects as Claim 1. The only material difference between Claim 1 and Claim 18 are certain additional limitations pertaining to the "valve assembly." As with Claim 1, Claim 18 can remain valid only if the "selector switch" and "valve assembly" limitations are narrowly construed. The broader claim construction you asserted in your June 23, 2020 letter will inevitably render Claim 18 invalid. Accordingly, if the "selector switch" and "valve assembly" limitations of Claim 18 are narrowly construed so as to preserve the validity of Claim 18, the Westinghouse® generators cannot infringe Claim 18. If the "selector switch" and "valve assembly" limitations of Claim 18 are construed to cover the selector switch and valve assembly used in the Westinghouse® generators, Claim 18 is invalid.

EX2034 (IPR2025-00951)
Patent Owner Champion

We trust this information resolves your concerns. If you have any remaining questions, please do not hesitate to contact me.

Very truly yours,

ICE MILLER LLP

Thomas A. Walsh

TAW/klb

cc: James Cline
Tom Pampush