

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF WISCONSIN**

CHAMPION POWER EQUIPMENT, INC.

Plaintiff / Counter-Defendant,

Case No: 2:24-cv-01281-LA

v.

GENERAC POWER SYSTEMS, INC.

Defendant / Counter-Plaintiff.

**DEFENDANT GENERAC POWER SYSTEMS, INC.'S CIVIL L. R. 7(h)
EXPEDITED NON-DISPOSITIVE MOTION TO AMEND
ORDER FOLLOWING SCHEDULING CONFERENCE (DKT. 29)**

Defendant Generac Power Systems, Inc. (“Generac”) respectfully submits this expedited motion, pursuant to Fed. R. Civ. P. 16 and Civil L. R. 7(h), seeking an amendment of the Scheduling Order issued by the Court on March 12, 2025. (Dkt. 29.) Good cause exists to amend the Scheduling Order for two reasons: (1) each Party has asserted two new patents relating to carbon monoxide (“CO”) detection since the entry of the Scheduling Order and (2) Generac’s preparation of its invalidity/unenforceability contentions for the original patents-in-suit has been hampered by delayed discovery from Plaintiff Champion Power Equipment, Inc. (“Champion”). With respect to the newly asserted CO patents, deadlines need to be added for service of infringement and invalidity/unenforceability contentions for those patents. With respect to contentions for the original patents, Generac diligently pursued prior art and unenforceability discovery from Champion, but that discovery was delayed due to prolonged discussions over the Protective Order, necessitating an extension of the invalidity/unenforceability contention deadline. Generac provides herewith a Proposed Order with the new schedule, which Champion opposes.

Contentions for the Newly-Asserted CO Patents – Generac asserted infringement of U.S. Patent Nos. 10,563,596 and 11,248,540 as counterclaims in this action on May 15, 2025 (Dkt. 30, Counterclaim ¶¶ 15-32), and Champion answered those counterclaims on May 29, 2025 (Dkt. 31, ¶¶ 15-32). Thus, the Generac CO patents are part of the litigation.

Champion moved to sever these CO patents into a separate litigation, and Generac opposed that motion because efficiency dictates that the patent issues relating to this generator technology should be addressed in the same action. (Dkt. 37-38, 43-44.) As an alternative in its motion, Champion seeks leave to amend its Complaint to add two of its own CO patents (U.S. Patent Nos. 10,862,414 and 11,336,214), which Generac does not oppose. (Dkt. 38 at 3, 9-11; Dkt. 43 at 1-2.)

Because Generac’s CO patent claims (and Champion’s requested CO counterclaims) were

asserted after issuance of the Court's current Scheduling Order, there is a need to add deadlines to serve any infringement and invalidity/unenforceability contentions for the newly asserted CO patents. Generac's proposed contention deadlines for Generac's and Champion's new CO patents have less time between them than the contentions for the original patents because the Parties are already up to speed on generator technology, have already begun serving discovery, presumably have begun collecting documents, and are in position to move along in a more expeditious manner.

Invalidity/Unenforceability Contentions on the Original Patents – Separately, Generac seeks to extend the deadline to serve its invalidity and unenforceability contentions for the original patents from August 22, 2025 (*see* Dkt. 29 at 2) to September 26, 2025. Good cause for this short extension arises from Champion's failure to timely produce documents in response to Generac's discovery requests relating to invalidity and/or unenforceability, which Generac served on both February 20, 2025, and April 22, 2025. (*See* Ex. A, Request Nos. 5-9; Ex. B, Request Nos. 14, 19-21, 47-52, and 56-59.) Champion objected to these requests because, among other things, production of documents was improper "without a Protective Order in place in this matter." (*See, e.g.*, Ex. C, Response to Request No. 8; Ex. D, Response to Request Nos. 14, 19-20.) Champion subsequently withheld production of documents relevant to invalidity on the ground that no Protective Order had yet been entered (*see* Ex. E at 1), including, *e.g.*, refusing to produce documents relating to its public disclosure of a dual-fuel generator to Cabela's in October 2014.

The Parties began discussing the Protective Order on April 18, 2025. (Ex. F at 6.) It became apparent as of May 9, 2025, that there was disagreement over the inclusion of a prosecution bar in the Protective Order. (*Id.* at 5.) The Parties had several rounds of good-faith discussions throughout May and June to attempt to resolve that disagreement, but to no avail. (*Id.* at 2-5.) The issue is now before the Court as a contested motion relating to proposed prosecution bar language in the

Protective Order. (*See* Dkts. 34, 41.)

Throughout the Protective Order discussion, Champion refused to produce responsive prior art documents, despite Generac's offer in May to begin production on the basis of the Parties' agreement to the non-prosecution bar terms of the Protective Order. Thus, on June 11, 2025, Generac proposed an amendment to its invalidity/unenforceability contentions deadline to account for Champion's delay. (Ex. F at 1.) Champion waited 19 days before responding, on June 30, 2025, that it would not agree to amend the contentions deadline. (Ex. E at 1-2.) All the while, no prior art documents were produced.

Finally, after Generac repeated its suggestion that the Parties operate under the agreed terms of the Protective Order other than the prosecution bar, Champion at last produced 325 prior art documents on July 18, 2025. Generac is diligently reviewing this initial prior art production, which predominantly includes emails from a custodian named Greg Montgomery relating to the disclosure of the prior art Champion generator to Cabela's. But even that production raises more discovery questions about what was disclosed to Cabela's and when. These questions need to be answered to assess the priority date of certain patents-in-suit, to understand what qualifies as prior art, and to determine what constitutes an invalidating public disclosure. While this likely could have been addressed with an earlier document production, instead, Mr. Montgomery's deposition has been delayed because of Champion's refusal to produce documents until mid-July. (*See* Ex. G at 1.) Now, it is highly unlikely that the Montgomery deposition will occur in time for the deposition testimony, and follow-up discovery, to be incorporated in Generac's invalidity/unenforceability contentions. Generac seeks the extension of the contentions deadline to alleviate the prejudice from Champion's delayed discovery and to allow for the provision of comprehensive contentions.

Date: August 4, 2025

Respectfully submitted,

MERCHANT & GOULD P.C.

/s/ Thomas J. Leach

Thomas J. Leach (MN # 0311844)

Michael Erbele (MN # 0393635)

Joe Dubis (MN # 0398344)

Paige Stradley (MN # 0393432)

MERCHANT & GOULD P.C.

150 South Fifth Street, Suite 2200

Minneapolis, MN 55402

(612) 332-5300

tleach@merchantgould.com

merbele@merchantgould.com

jdubis@merchantgould.com

REINHART BOERNER VAN DEUREN, S.C.

Paul J. Stockhausen

Monica A. Mark

REINHART BOERNER VAN DEUREN, S.C.

22 East Mifflin Street, Suite 700

Madison, WI 53703

Tel.: 608-229-2200

Fax: 608-229-2100

pstockhausen@reinhardtllaw.com

mmark@reinhardtllaw.com

*Attorneys for Defendant and Counterclaim
Plaintiff*