

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENERAC POWER SYSTEMS, INC.,
HARBOR FREIGHT TOOLS USA INC., and
MWE INVESTMENTS, LLC,
Petitioners

v.

CHAMPION POWER EQUIPMENT, INC.,
Patent Owner

Patent No. 10,598,101
Issue Date: March 24, 2020

Title: DUAL FUEL SELECTOR SWITCH

Inter Partes Review No. IPR2025-00951

**PATENT OWNER CHAMPION POWER EQUIPMENT, INC.'S
BRIEF IN SUPPORT OF REQUEST FOR DISCRETIONARY
DENIAL OF INSTITUTION**

TABLE OF CONTENTS

	Page
TABLE OF CONTENTS.....	i
TABLE OF AUTHORITIES	iv
EXHIBIT LIST	vii
I. FACTUAL BACKGROUND.....	6
A. Champion’s Two Patent Families	6
B. Petitioners—Champion’s Direct Competitors—Asserted the ’101 Patent Was Invalid Years Ago and Did Nothing About It	9
C. The ’101 Patent Is Being Challenged in Four Parallel Cases	11
1. The Firman Case	11
2. The Generac Case.....	14
a. Allegations in the Generac Case	14
b. Progress in the Generac Case Before an Institution Decision	16
The Pleadings	16
Contentions.....	17
Discovery To-Date	17
c. The Status and Timeline of the Generac Case Before a Final Written Decision	20
3. The Harbor Freight Case	20
a. Allegations in the Harbor Freight Case	21
b. Progress in the Harbor Freight Case Before an Institution Decision.....	24
The Pleadings	24
Claim Construction.....	25
Contentions.....	25
Discovery To-Date	26
c. The Status and Timeline of the Harbor Freight Case Before a Final Written Decision	27
4. The MWE Case	28

D.	Petitioners’ Multiple IPR Filings To-Date	28
E.	Petitioners’ Recently Served Stipulations	29
II.	THE BOARD SHOULD EXERCISE ITS DISCRETION UNDER 35 U.S.C. § 314(a) to DENY THE PETITION	31
A.	Factor 1 Weighs in Favor of Discretionary Denial	32
B.	Factor 2 Weighs in Favor of Discretionary Denial	33
C.	Factor 3 Weighs in Favor of Discretionary Denial	37
D.	Factor 4 Weighs in Favor of Discretionary Denial	40
E.	Factor 5 Weighs in Favor of Discretionary Denial	43
F.	Factor 6 Weighs in Favor of Discretionary Denial	44
1.	Strength of the Unpatentability Challenge	44
2.	Settled Expectations	45
3.	Petitioners Rely Extensively on Unfocused Expert Testimony	51
4.	Other Considerations – Petitioners are Burdening Board Resources	53
III.	THE DIRECTOR SHOULD EXERCISE DISCRETION TO DENY INSTITUTION UNDER SECTION 325(D)	54
A.	Petitioners’ Art and Arguments are the Same and/or Substantially Similar to Those Considered by the Examiner	55
1.	The Examiner Considered Substantially Similar Art to That Presented in Grounds 1-2	56
a.	DuroMax is Substantially the Same as the Honda EU20i Video and Deutsch References Considered by the Examiner	56
b.	Secondary Reference De Vries is Substantially Similar to U.S. Publication No. 2014/0202430 (“Monros”) Considered During Examination	58
c.	Secondary Reference Nakafushi Is Substantially Similar to U.S. Patent No. 5,809,979 (“Kubota Patent”)	60
d.	Secondary Reference Olmr is Substantially Similar to U.S. Patent No. 3,384,059 (“Kopa”) and the Kubota Patent	61
2.	Substantially Similar Art to That Presented in Grounds 3-5 Was Considered by the Examiner	61
a.	Fujisawa is Substantially Similar to Monros	61

b. DuroMax, Nakafushi, and Olmr are Substantially Similar to Art Considered by the Examiner.....	62
B. Petitioners Have Failed to Demonstrate Any Material Error by the Examiner.....	63
IV. CONCLUSION.....	63
CERTIFICATE OF WORD COUNT	65
CERTIFICATE OF SERVICE	66

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH</i> , IPR2019-01269, Paper 6 (Feb. 13, 2020) (precedential).....	passim
<i>Advanced Micro Devices, Inc. v. Concurrent Ventures, LLC</i> , IPR2025-00223, Paper 9 (June 12, 2025).....	37
<i>Amgen Inc. v. Bristol-Myers Squibb Co.</i> , IPR2025-00601, Paper 9 (July 24, 2025).....	45, 51
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-0019, Paper 11 (March 20, 2020) (precedential)	passim
<i>Becton, Dickinson & Co. v. B. Braun Melsungen AG</i> , IPR2017-01586, Paper 8 (Dec. 15, 2017).....	55
<i>Cambridge Industries USA, Inc. v. Applied Optoelectronics, Inc.</i> , IPR2025-00433, Paper 12 (June 26, 2025).....	51
<i>Cisco Systems, Inc. v. C-Cation Technologies, LLC</i> , IPR2014-00454, Paper 12 (Aug. 29, 2014) (informative).....	51
<i>Cuozzo Speed Techs., LLC v. Lee</i> , 579 U.S. 261 (2016).....	33
<i>Dabico Airport Solutions Inc. v. AXA Power APS</i> , IPR2025-00408, Paper 21 (June 18, 2025).....	45, 47, 48
<i>Entegris, Inc. v. Inpria Corp.</i> , IPR2025-00267, Paper 12 (July 2, 2025).....	34
<i>FaceTec, Inc. v. iProov, Ltd.</i> , No. 2:21-cv-02252, ECF No. 188 (D. Nev. June 18, 2025)	33
<i>General Plastic Industrial Co., Ltd. v. Kaisha</i> , IPR2016-01357, Paper 19 (Sept. 6, 2017) (precedential).....	54
<i>Google LLC v. Soundclear Technologies LLC</i> , IPR2025-00344, Paper 15 (Aug. 4, 2025)	47
<i>Harmonic Inc. v. Avid Tech., Inc.</i> , 815 F.3d 1356 (Fed. Cir. 2016).....	32

Case No. IPR2025-00951

Patent No. 10,598,101

<i>Hydrite Chem. Co. v. Solenis Techs. LP</i> , No. 2:15-cv-856, ECF No. 9 (E.D. Wis. Aug. 3, 2015)	33
<i>iRhythm Technologies, Inc. v. Welch Allyn, Inc.</i> , IPR-2025-00363, Paper 10 (June 6, 2025).....	50
<i>Kahoot! AS v. Interstellar Inc.</i> , IPR2025-00696, Paper 12 (July 31, 2025).....	50, 51
<i>Linkplay Technology Inc. v. Sonos, Inc.</i> , IPR2025-00509, Paper 10 (July 31, 2025).....	34
<i>Motorola Sols. v. Stellar, LLC</i> , IPR2024-01205, Paper 19 (Mar. 28, 2025).....	42, 43
<i>Murata Manufacturing Co., Ltd. v. Georgia Tech Research Co.</i> , IPR2025-00383, Paper 14 (July 29, 2025).....	40, 49
<i>Nokia of Am. Corp. v. Pegasus Wireless Innovation LLC</i> , IPR2025-00037, Paper 14 (Apr. 25, 2025)	43
<i>Nvidia Corporation v. Neural AI, LLC</i> , IPR2025-00606, Paper 18 (July 31, 2025).....	51
<i>NXP USA, Inc. v. Impinj, Inc.</i> , IPR2021-01556, Paper 13 (Sept. 7, 2022) (precedential).....	41
<i>Parson Xtreme Golf LLC v. Taylor Made Golf Co. Inc.</i> , No. CV-17-03125, ECF No. 187 (D. Az. Nov. 29, 2018).....	33
<i>Pentair Water Pool & Spa Inc. v. Fail-Safe LLC</i> , No. 2:13-cv-01321, ECF No. 8 (E.D. Wis. Dec. 30, 2013).....	33
<i>Pioneer Pet Prods., LLC v. Oil-Dri Corp. of Am.</i> , IPR2022-00691, Paper 31 (Sept. 12, 2023)	52
<i>SAS Inst., Inc. v. Iancu</i> , 584 U.S. 357 (2018).....	32
<i>Shenzhen Tuoshu Tech. Co., Ltd v. Stratasy, Inc.</i> , IPR2025-00354, Paper 11 (June 12, 2025).....	43
<i>Sotera Wireless, Inc. v. Masimo Corp.</i> , IPR2020-01019, Paper 12 (Dec. 1, 2020).....	passim
<i>Syrinx, Inc. v. Blacoh Fluid Control</i> , IPR2018-00415, 2019 WL 2282188 (PTAB May 28, 2019)	53

Statutes

35 U.S.C. § 102	21, 43, 54
35 U.S.C. § 103	41, 43, 54
35 U.S.C. § 112	passim
35 U.S.C. § 122	48
35 U.S.C. § 286	45
35 U.S.C. § 314	passim
35 U.S.C. § 315(a)(2)	33
35 U.S.C. § 315(b)	3, 11
35 U.S.C. § 325(d)	passim

Regulations

37 C.F.R. § 42.22	53
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Other Authorities

Consolidated Trial Practice Guide, 84 Fed. Reg. 64,280 (Nov. 21, 2019)	34, 44, 52
Director’s Memo, March 26, 2025, Memorandum by the Director addressing the “Interim Processes for PTAB Workload Management”	passim
July 29, 2025 Memorandum on Final Written Decision Procedures for AIA Trial Proceedings	5, 53

EXHIBIT LIST

Exhibit #	Description
EX2001	Docket for Champion Power Equipment, Inc. v. Firman Power Equipment Inc., Case No. 2:23-cv-02371 (D. Az.) (“Firman Case”)
EX2002	Firman Case, Case Management Order, ECF No. 33
EX2003	Firman Case, First Amended Complaint, ECF No. 24
EX2004	Firman Case, Firman Answer to First Amended Complaint and Counterclaims, ECF No. 61
EX2005	Firman Case, Firman’s Motion to Amend Invalidity Contentions, ECF No. 115
EX2006	Firman Case, Declaration and Exhibit, ECF No. 116
EX2007	Firman Case, Order Granting Leave to Amend, ECF No. 124
EX2008	Firman Case, ECF No. 149
EX2009	Firman’s Nov. 2024 Subpoena to third-party Generac (Firman Case)
EX2010	Docket for Generac Case (E.D. Wis.)
EX2011	Generac Case, Generac’s First Amended Answer and Counterclaims, ECF No. 30
EX2012	<i>Reserved</i>
EX2013	Defendant Generac’s Feb. 14, 2025 Subpoena to third-party Firman
EX2014	May 22, 2025 Defendant Generac’s Letter to third-party Firman
EX2015	July 23, 2025 Stipulation from Generac
EX2016	Docket for Harbor Freight Case (C.D. Cal.)
EX2017	Harbor Freight Case, Complaint for Declaratory Judgment, ECF No. 1
EX2018	Harbor Freight Case, Champion’s Answer and Counterclaims, ECF No. 47
EX2019	Harbor Freight Case, Harbor Freight’s Answer to Counterclaims, ECF No. 55
EX2020	Harbor Freight Case, Joint R26 Report, ECF No. 38
EX2021	Harbor Freight’s July 14, 2025 Preliminary Claim Constructions
EX2022	Harbor Freight’s July 18, 2025 Objections and Responses to Champion's Second Set of ROGs
EX2023	Harbor Freight’s Mar. 10, 2025 Subpoena on third-party Firman
EX2024	March 24, 2025 Email from third-party Firman to Harbor Freight (Harbor Freight Case)

Exhibit #	Description
EX2025	March 24, 2025 Letter from Firman to Harbor Freight (Harbor Freight Case)
EX2026	July 22, 2025 Stipulation from Harbor Freight
EX2027	Docket for Harbor Freight Wisconsin (E.D. Wis.)
EX2028	<i>Reserved</i>
EX2029	Generac Case, Complaint, ECF No. 1
EX2030	Docket for Miscellaneous Case D. Az.
EX2031	Sept. 9, 2019 Letter from Champion to Firman
EX2032	Oct. 8, 2019 Firman Response Letter
EX2033	June 23, 2020 Letter from Champion to MWE
EX2034	July 31, 2020 MWE Response Letter
EX2035	Oct. 17, 2020 MWE Responsive Letter
EX2036	July 7, 2020 Letter from Champion to Generac
EX2037	July 31, 2020 Generac Response Letter
EX2038	March 27, 2024 Letter from Champion to Harbor Freight
EX2039	June 28, 2024 Letter from Champion to Harbor Freight
EX2040	<i>Reserved</i>
EX2041	
EX2042	
EX2043	
EX2044	
EX2045	
EX2046	Champion Manual, #100263
EX2047	Docket Navigator - Time to Milestones for D. Az. (Trial)
EX2048	Docket Navigator - Time to Milestones for E.D. Wis. (Trial)
EX2049	<i>Reserved</i>
EX2050	Generac Case, Order Following Scheduling Conference, ECF No. 29
EX2051	MWE Case, Complaint, ECF No. 1
EX2052	July 29, 2025 Stipulation from MWE
EX2053	<i>Reserved</i>
EX2054	Champion's Patent Statement and Licensing Declaration Form, July 1, 2021
EX2055	Firman's August 30, 2024 Invalidity Contentions
EX2056	Generac Case, Expedited Motion, ECF No. 47

Exhibit #	Description
EX2057	Harbor Freight’s Notice of Subpoenas to be Served on Metalcraft of Mayville, Inc.; Northern Tool & Equipment Company Inc.; Winco, Inc., dated July 1, 2025
EX2058	August 4, 2025 Stipulation from Generac
EX2059	August 4, 2025 Stipulation from Harbor Freight
EX2060	US Pub No. 2002/0134362 (“Deutsch”)
EX2061	US Pub No. 2014/0202430 (“Monros”)
EX2062	US5809979 (“Kubota Patent”)
EX2063	US10393034 (“’034 Patent”)
EX2064	Champion September 26, 2014 Internal Email
EX2065	Firman Case, Champion’s Motion to Amend Counterclaims, ECF No. 198
EX2066	’667 File History Excerpt, Terminal Disclaimer
EX2067	’390 File History Excerpt, Terminal Disclaimer
EX2068	’896 File History Excerpt, Terminal Disclaimer
EX2069	August 15, 2025 Stipulation from MWE
EX2070	Generac Case, Exhibit 3 – webpage, ECF No. 30-03
EX2071	Wayback Machine, http://pgmaonline.com/members.asp , dated July 29, 2013
EX2072	US11306667 (“’667 Patent”)
EX2073	Firman Case, Order, ECF No. 141
EX2074	Generac’s April 23, 2025 Responses to Plaintiff’s First Set of Interrogatories
EX2075	Screenshots from Honda EU20i LPG video, https://www.youtube.com/watch?v=yBpq33aJmR0
EX2076	YouTube Video, <i>HONDA EU20i LPG</i> , https://www.youtube.com/watch?v=yBpq33aJmR0
EX2077	US3384059 (“Kopa”)

Petitioners Generac Power Systems, Inc. (“Generac”), Harbor Freight Tools USA Inc. (“Harbor Freight”), and MWE Investments, LLC (“MWE”) (collectively, “Petitioners”), request *inter partes* review (“IPR”) of all claims of U.S. Patent No. 10,598,101 (“’101 Patent”). *Generac Power Systems, Inc. et al v. Champion Power Equipment, Inc.*, No. IPR2025-00951 (April 29, 2025), Paper 4 (“Pet.”). Pursuant to the March 26, 2025, Memorandum by the Director addressing the “Interim Processes for PTAB Workload Management” (“Director’s Memo”), Patent Owner Champion Power Equipment, Inc. (“Champion” or “Patent Owner”) respectfully requests the Director exercise discretion and deny institution of this IPR. Discretionary denial is warranted under 35 U.S.C. § 314(a), 35 U.S.C. § 325(d), and the *Fintiv* and *Advanced Bionics* factors.¹

This Petition is not a standalone challenge, but rather the latest maneuver in a coordinated, multi-front campaign to invalidate the ’101 Patent, being led by Champion’s long-time industry competitors. Although Petitioners will likely portray themselves as independent actors, the district court cases present a different reality: Petitioners are closely aligned with Firman Power Equipment Inc. (“Firman”)—a statutorily-barred non-petitioner that has been litigating against the validity of the

¹ *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020) (precedential); *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (Feb. 13, 2020) (precedential).

'101 Patent for nearly two years. Petitioners have mirrored and adopted wholesale Firman's litigation strategy, echoing its anticipation and obviousness theories, common arguments, and identical counterclaims, and have relied on Firman's trove of system art contentions, which cannot be adjudicated in this proceeding. Firman's district court case, which is on track to reach trial before a Final Written Decision ("FWD") in this IPR, offers a clear glimpse into Petitioners' current litigation strategies and a preview of what is to come in their respective cases. In essence, Firman's challenge is Petitioners' dress rehearsal.

That Champion developed long-settled expectations based on Petitioners Generac and MWE's half decade of inaction against the '101 Patent further demonstrates allowing this IPR to proceed would not only duplicate substantial efforts already underway in district courts across the country, but reward Petitioners' calculated delay and tactical reserve of this Petition. Instituting in light of this delay would also reward Champion's other competitors, including Petitioner Harbor Freight, whose declaratory judgment action is furthest along, and non-Petitioner Firman, who despite allowing its statutory deadline to lapse, may nevertheless stand to benefit from a Petition for which it laid the groundwork but never pursued. Champion, having reasonably relied on Petitioners' inaction for years, should not now be forced to defend its patent in multiple forums. The Board should decline to

institute under these circumstances, which undermine the efficiency and fairness that IPR proceedings are meant to promote.

All *Fintiv* factors, including applicable factors set forth in the Director's Memo, weigh in favor of denying institution. With respect to the first *Fintiv* factor, there are currently four active U.S. District Court proceedings in which the validity of the '101 Patent is being challenged. (Petitioner MWE has not substantively² responded to the Complaint but threatened petitioning for IPR of the '101 Patent five years ago). None of the Petitioners have moved to stay. The first *Fintiv* factor therefore favors discretionary denial.

The second *Fintiv* factor also weighs in favor of discretionary denial. One of the four active U.S. District Court proceedings in which the validity of the '101 Patent is being challenged has an estimated trial date of November 10, 2026, over a month before the projected December 16, 2026 due date for a FWD. Although the defendant in that parallel district court proceeding, Firman, opted against filing its own petition (and is well past its statutory deadline under 35 U.S.C. § 315(b)), Petitioners have been cooperating with Firman and adopted a significant amount of Firman's arguments and evidence in their own cases, including, for example, copying Firman's invalidity counterclaims, incorporating by reference Firman's

² On August 11, 2025, Petitioner MWE moved to transfer.

invalidity and claim construction arguments and evidence, and exchanging thousands of pages of prior art, contentions, and expert reports with Firman. The second *Fintiv* factor therefore favors discretionary denial.

The third *Fintiv* factor also weighs in favor of discretionary denial. As outlined below, the parties' investment to-date and burden on judicial resources has been considerable. Hundreds of pages of infringement and non-infringement contentions have already been served. Invalidity contentions will have been exchanged, claim construction briefing completed, and at least one claim construction hearing will be held well before the December 16, 2025 deadline for an institution decision. These substantial investments are compounded by extensive discovery to-date, and Petitioners' material involvement in Patent Owner's long-running patent infringement lawsuit against non-Petitioner Firman. Both Petitioners Generac and Harbor Freight subpoenaed Firman for documents (and *vice versa*), sought court intervention in discovery disputes, and filed motions to dismiss that the Generac and Harbor Freight courts have already resolved. Accordingly, the third *Fintiv* factor weighs in favor of discretionary denial.

The fourth and fifth *Fintiv* factors also favor discretionary denial because the parties are the same and the issues overlap. Petitioners offered stipulations regarding invalidity contentions in the parallel district court litigations, but these stipulations are not particularly meaningful given Petitioners are also asserting the '101 Patent's

independent claims are anticipated, rendered obvious, and unenforceable for inequitable conduct in view of system art, none of which can be resolved by the Board. Petitioners' asserted system art is the centerpiece of the defenses and counterclaims in the co-pending litigations and the focus of their discovery to date. That the Board cannot resolve these disputes obviates any efficiency that could otherwise be gained in an IPR. The co-pending cases involve up to thirteen disputed patents and dozens of asserted claims across two patent families. To date, Petitioners have challenged seven of Patent Owner's patents in IPR over the course of four months and promise six more. This Petition requires the Board's analysis of five references asserted across five separate grounds of unpatentability, all of which will need to be fully addressed in the FWD. July 29, 2025 Memorandum on Final Written Decision Procedures for AIA Trial Proceedings ("July 29 Memo). In total, Petitioners raise forty-five grounds involving twenty references across the seven IPR petitions that have been filed to date. The fourth and fifth *Fintiv* factors weigh in favor of discretionary denial.

The sixth *Fintiv* factor also weighs in favor of discretionary denial. The '101 Patent has a November 1, 2013 priority date and is nearly twelve years into its patent term. Having ostensibly been put on notice of the '101 Patent since 2016, knowing of potentially relevant references since 2015, and even warning Champion in 2020 of their intent to challenge the '101 Patent in an IPR, Petitioners waited until 2025

to act. Champion, therefore, has strong settled expectations that the '101 Patent would not be challenged in an IPR by any of these Petitioners, and at least by the same parties that threatened to do so as early as 2020. Petitioners' years-long tactical delay and lack of diligence in seeking IPR demonstrate that this Petition is calculated to do nothing more than open yet another front of attack on the '101 Patent.

Other circumstances tilt the sixth *Fintiv* factor in favor of discretionary denial. As will be fully addressed in Champion's forthcoming Preliminary Response, the Petition itself is substantively deficient, and impermissibly attempts to incorporate by reference a conclusory expert declaration that is nearly twice as long as the Petition itself, and extensively parrots the prior art. Given these circumstances and discretionary considerations, the sixth *Fintiv* factor weighs in favor of discretionary denial.

Finally, discretionary denial is warranted under 35 U.S.C. § 325(d) and the *Advanced Bionics* factors because Petitioners' asserted references are substantially similar to references previously considered by the Examiner. Accordingly, discretionary denial is appropriate under 35 U.S.C. § 314(a), 35 U.S.C. § 325(d), and the *Fintiv* and *Advanced Bionics* factors. See Director's Memo at 1.

I. FACTUAL BACKGROUND

A. Champion's Two Patent Families

Champion is the owner and assignee of two patent families directed to dual-

fuel engines. The '101 Patent belongs to one of these patent families claiming priority to a 2013 application ("2013 Family"). Specifically, on November 11, 2013, Champion filed U.S. Patent Application No. 14/069,747 ("747 Application"), which issued September 6, 2016, as U.S. Patent No. 9,435,273. EX1001, (63). On February 4, 2016, Champion filed a continuation of the '747 Application, U.S. Patent Application No. 15/015,205 ("205 Application"), which published on May 26, 2016, and issued March 24, 2020, as the '101 Patent. *Id.* Three additional continuations were filed claiming priority to the '747 and '205 Applications: U.S. Patent Nos. 11,306,667 ("667 Patent"), 11,761,390 ("390 Patent"), and 11,905,896 ("896 Patent"). The '667 Patent is subject to a terminal disclaimer over the '101 Patent; the '390 Patent is subject to a terminal disclaimer over the '101 and '667 Patents; and the '896 Patent is subject to a terminal disclaimer over the '390, '667, and '101 Patents. EX2066; EX2067; EX2068.

Champion has asserted infringement of the '101, '667, '390, and '896 Patents against Petitioners and Firman and, to date, Petitioners have filed IPR Petitions against the '101, '667, and '896 Patents and has forecasted they also intend to file one against the '390 Patent. EX2058; EX2059.

In the same year the '101 Patent was filed, on October 4, 2016, Champion filed U.S. Patent Application No. 15/285,215, which issued on August 27, 2019, as U.S. Pat. No. 10,393,034 ("034 Patent"). The '034 Patent is from a closely related

multi-fuel engine patent family made up of eleven issued patents (“2015 Family”). Relevant to this proceeding and to several other pending IPR petitions, the patents in the 2015 Family asserted against Petitioners and Firman include: (1) ’034 Patent; (2) U.S. Patent No. 10,221,780 (“’780 Patent”); (3) U.S. Patent No. 10,697,398 (“’398 Patent”); and (4) U.S. Patent 11,143,120 (“’120 Patent”); (5) U.S. Patent 11,492,985 (“’985 Patent”); (6) U.S. Patent 11,530,654 (“’654 Patent”); (7) U.S. Patent 11,840,970 (“’970 Patent”); (8) U.S. Patent 11,905,895 (“’895 Patent”); and (9) U.S. Patent 11,143,145 (“’145 Patent”). *See, e.g.,* EX2003. To date, Petitioners have filed IPR Petitions against the ’034, ’120, ’780, and ’985 Patents and have forecasted filing petitions against the other five patents in the 2015 Family asserted against Petitioners in parallel litigations. EX2058; EX2059; EX2069.

The 2013 and 2015 Families are so related that they share many of the same inventors, including, for example, Mark Sarder and Leigh Jenison, who are named co-inventors on both the ’034 and ’101 Patents. EX1001, (72); EX2063, (72). A publication of the ’747 Application—to which the ’101 Patent claims priority—was even cited by the examiner during the ’034 Patent’s prosecution and is listed on the face of the ’034 Patent. *See* EX2063 (56) References Cited, U.S. Publ. No. 2015/0122230 (Sarder). Likewise, the operating manual of at least one Champion dual-fuel model #100263 is marked with patents from both the 2013 and 2015 Families, including the ’101 Patent. *See* EX2046 (“Covered by one or more of the

following U.S. Patent Numbers: 10,598,101, 10,221,780 and other U.S. and foreign patents pending.”). Even Generac claims that a different Champion generator—model #100153—is a commercial embodiment of both the 2013 and 2015 Families. EX2011, ¶82.

B. Petitioners—Champion’s Direct Competitors—Asserted the ’101 Patent was Invalid Years Ago and Did Nothing about It

As an initial matter, Petitioners tacitly admit they actively monitored and would have been aware of Champion’s generator patents *and* applications for years. In fact, as prolific patentees and competitors, Champion and Petitioners regularly place the portable generator industry on notice of their patents. For example, Generac admits that “Champion and Generac are both members of the Portable Generator Manufacturers’ Association (‘PGMA’), an organization that seeks to develop safety standards for portable generators.” EX2011, 70. Generac admits that as members, Generac and Champion release to the industry a Patent Statement and Licensing Declaration Form regarding their patents, and that they “would have come across” each other’s patents “during PGMA’s regular monitoring” process. *Id.*; *see, e.g.*, EX2054. Thus, Generac has been aware that Champion obtains patents generally. In its May 15, 2025 Counterclaims, Generac cited to an August 20, 2018 PGMA webpage showing that Champion and Generac were members of PGMA. EX2070. However, a July 29, 2013 version of that same webpage shows they were

both members back in 2013. EX2071. Accordingly, it is not unreasonable to expect Generac to have been aware of Champion’s publication on May 7, 2015—more than 10 years ago.

It should have therefore come as no surprise when Champion’s enforcement efforts against Petitioners began soon after the ’101 Patent issued. In June and July 2020, Champion sent separate cease-and-desist letters to Petitioners MWE and Generac, respectively, accusing both of infringing the ’101 Patent. EX2033; EX2036; EX2011, pp. 14, 104. On July 31, 2020, both Generac and MWE responded to Champion. EX2034; EX2037. MWE asserted it was “aware of and/or in possession of prior art that will support invalidation” of the asserted claims and that it was “prepared to present this evidence in litigation or in an Inter Partes Review proceeding if it becomes necessary.” EX2034, 1. Likewise, Petitioner Generac claimed that it “analyzed the file history and reviewed the prior art” and asserted that “the claims of the ’101 patent are invalid.” EX2037, 2. Yet, for nearly half a decade, neither MWE nor Generac filed a lawsuit or IPR petition against any patents in the 2013 or 2015 Families.

Champion sent Petitioner Harbor Freight a cease-and-desist letter on March 27, 2024, accusing Harbor Freight of infringing the 2013 and 2015 Families, including the ’101 Patent. EX2038. Harbor Freight and Champion exchanged multiple letters and e-mails over the next several months, culminating in a June 28,

2024 letter in which Champion warned it intended to sue Harbor Freight. EX2039, 2. Instead of filing an IPR petition, on October 9, 2024, Harbor Freight filed a Complaint for Declaratory Judgment of Noninfringement against Champion and then waited to join Generac and MWE in filing the Petition for IPR of the '101 Patent almost seven months later. EX2017.

C. The '101 Patent Is Being Challenged in Four Parallel Cases

There are currently four active litigations in which the validity of the '101 Patent is being challenged, including one against non-petitioner Firman and three against Petitioners Generac, Harbor Freight, and MWE. The four litigations will be discussed in the order in which they were filed.

1. The Firman Case

Champion first sued Firman³ in the District of Arizona on November 10, 2023. *Champion Power Equipment, Inc. v. Firman Power Equipment Inc.*, Case No. 2:23-cv-02371 (“Firman Case”). Champion’s operative complaint alleges that Firman infringes 106 claims across thirteen patents in the 2013 and 2015 Families: the '034, '120, '985, '654, '970, '780, '895, '398, '145, '101, '667, '390, and '896 Patents. *See, e.g.*, EX2003.

The estimated trial date for the Firman Case is November 10, 2026. EX2002;

³ Firman’s statutory deadline to file a petition under 35 U.S.C. § 315(b) lapsed on December 11, 2024. EX2001, 6.

EX2047. Although the remaining case deadlines are tied to the Firman court's issuance of a Markman Order, the estimated median time to trial for patent cases in the District of Arizona is 36.5 months, which would put the projected trial date at November 10, 2026—over one month before the deadline for a FWD. EX2047. The Firman Case is likely to adhere to this estimate given the substantial progress Champion and Firman have made in the last eighteen months.

Discovery commenced seventeen months ago on February 29, 2024, and to date, the complaint, answer, and counterclaims have been amended several times. Champion and Firman have engaged in significant discovery, including multiple rounds of discovery requests and responses, and over 35,000 pages of produced documents. Claim construction proceedings, including exchange of extrinsic evidence, expert discovery (including depositions), and briefing, are complete and the Firman court is poised to issue a Markman Order⁴ any day, which will trigger a ninety-day deadline for the close of all fact discovery and subsequent deadlines for expert discovery and dispositive motions. EX2002 at 9-12. Champion also served its infringement contentions over a year ago, on June 21, 2024. Two months later, on August 30, 2024, Firman served its invalidity contentions. *Id.*, at 4.

Firman's initial invalidity contentions included thirty-nine claim charts

⁴ The Firman court may hold a claim construction hearing if it deems it necessary. EX2002 at 9. It has yet to do so.

comprising 5,000 pages and sixty-nine references. EX2005, p. 7; EX2006, pp. 3, 12-14. Of the sixty-nine asserted references, thirty-three constitute system art that cannot be considered by the Board, including, for example, Champion's own systems. *See* EX2006, pp. 8-9, 40-42; *see* EX2055, pp. 6-8. Firman alleges that the "[u]se of valves and switches for fuel selection was obvious" and that no less than eighteen devices and systems "disclose this functionality" of the 2013 Family, including Firman's own ECO8990E Device, a Kubota Engine, a Winco device, multiple Honda devices, a Northstar device, and a SCAG Turf Tiger device. EX2006, pp. 12-14, 22-23, 40-42; EX2055, pp. 6-8, 16. Firman alleges that the patents of the 2013 Family "failed to describe or enable a fuel valve assembly comprising multiple different fuel valves" and are invalid for "lack of enablement and written description." EX2055, p. 26; EX2006, p. 33.

On February 4, 2025, after subpoenaing Petitioner Generac, Firman moved to amend its contentions on the basis that it had received thousands of pages of allegedly invalidating references from Generac, including evidence of two products allegedly purchased by Generac in 2015. EX2005, p. 6, n.1; EX2007. According to Firman, the trove of allegedly invalidating references in Generac's possession was substantial. EX2005, p. 3 ("[b]etween November 19, 2024, and November 22, 2024, Generac produced 521 documents, spanning over 2,525 pages, and including over

fifty prior art references ... [including] purchases of dual fuel generators Generac made from two separate manufacturers.”).

The court granted Firman’s motion to amend its invalidity contentions on February 28, 2025. EX2007. Subsequently, Firman served amended invalidity contentions, asserting four additional references, including the two Generac generators that Firman referenced in its motion to amend. EX2006; EX2008.

2. The Generac Case

Eight and a half years after the ’101 Patent was filed, on October 9, 2024, Champion sued Petitioner Generac in the Eastern District of Wisconsin. *Champion Power Equip., Inc. v. Generac Power Sys., Inc.*, No. 2:24-cv-01281-LA (E.D. Wisc. Oct. 9, 2024) (“Generac Case”). Generac designs, manufactures, imports, and sells multi-fuel generators that for years directly compete with Champion’s products. EX2029, 2.

a. Allegations in the Generac Case

Champion’s operative complaint alleges Generac infringes dozens of claims across the following eleven patents of the 2013 and 2015 Families: the ’120, ’985, ’654, ’970, ’780, ’895, ’398, ’145, ’101, ’667, and ’896 Patents. *See, e.g.*, EX2029. These patents are all asserted against Firman.

Generac is challenging the validity of the ’101 Patent, as well as every other patent in the 2013 Family. EX2011, pp. 81, 87, 122. Additionally, like Firman,

Generac alleges “all of the claims of the ’101 Patent are invalid for failure to satisfy one or more of the requirements of Section[] ... 112[.]” EX2011, p. 122. Generac is also challenging the validity of several members of the 2015 Family, asserting a generator sold by Firman, “the RD9000E dual fuel generator[,] includes at least one element of at least one claim of *each* patent in the 2015 Patent Family[.]” EX2011, p. 106 (emphasis added).

Notably, Firman’s invalidity contentions and counterclaims, and Champion’s positions in the Firman Case, are fixtures throughout Generac’s counterclaims. For example, like Firman’s invalidity contentions, Generac asserts without limitation that the entire 2013 Family is invalid as obvious in view of U.S. Patent No. 4,492,207 (“Hallberg”). EX2011, pp. 86-87; EX2055, p. 16. Similarly, for the 2015 Family, Generac accuses Champion of “[t]aking infringement positions in [the Generac Case], and in [the Firman Case] that would clearly render the RD9000E generator an anticipatory prior art reference,” and like Firman, Generac alleged inequitable conduct and incorrect inventorship based on the RD9000E. EX2011, pp. 66, 113. In fact, throughout Generac’s Answer and Counterclaims, the RD9000E is referenced no less than forty-seven times, and “Firman” no less than thirty-two times. EX2011. Across 280 paragraphs of counterclaims, Generac alleges the 2013 Family and 2015 Family are anticipated or rendered obvious by most of the same references mapped by Firman in both its initial and amended invalidity contentions. *Id.*

b. Progress in the Generac Case Before an Institution Decision

Significant strides will have been made in the Generac Case before the December 16, 2025 institution decision deadline.

The Pleadings

On October 9, 2024, Champion sued Generac in the Eastern District of Wisconsin. EX2029. On December 4, 2024, Generac filed a Motion to Dismiss Champion's Complaint. EX2010, 5. Champion's Opposition followed and briefing on the Motion fully concluded on January 3, 2025. The Generac court quickly denied Generac's Motion to Dismiss on January 22, 2025. *Id.*, 6.

Two weeks later, on February 5, 2025, Generac filed its Answer and Counterclaims, asserting the 2013 and 2015 Families are invalid. *Id.* Thereafter, on February 26, 2025, Champion filed its Answer, denying Generac's Counterclaims of invalidity. *Id.* On May 15, 2025, Generac filed a First Amended Answer and Counterclaims, adding infringement counterclaims covering a different technological area and asserting that Champion infringes two Generac patents directed to carbon monoxide (CO) detection. EX2011. On May 29, 2025, Champion filed its Answer to Generac's First Amended Counterclaims and, on July 8, 2025, a motion to sever Generac's CO-related claims or, in the alternative, leave to amend to include its own CO-related counterclaims of infringement. EX2010, 7-8.

Contentions

Champion served its infringement contentions on April 15, 2025. On June 20, 2025, Generac served its responses to Champion's infringement contentions. The deadline for Generac to serve its invalidity contentions is August 22, 2025, and Champion must respond on October 22, 2025. Although Generac has been in possession of allegedly invalidating prior art for at least half a decade, on August 4, 2025, Generac filed an expedited motion seeking to amend the scheduling order to push back the deadline for its invalidity contentions to September 26, 2025 (EX2056), which is notably after Champion's Patent Owner Discretionary Denial briefs are due in three other IPRs filed by Petitioners (IPR2025-01099, IPR2025-001121, IPR2025-01228). Yet, even under Generac's self-serving amended schedule, all infringement and invalidity contentions and responses will have been served prior to the institution decision deadline.

Discovery To-Date

The Generac court issued a Scheduling Order months ago, and Generac and Champion spent months negotiating a proposed Protective Order and Protocol for the discovery of Electronically Stored Information, both of which were submitted for the Generac court's consideration on June 26, 2025. EX2010, p. 7. Notwithstanding the current absence of a Protective Order and ESI Order, the parties have been actively engaged in discovery since February 2025. In total, Champion

has propounded, and Generac has responded to, two sets of discovery requests, including seven interrogatories and twenty-three requests for production; and Generac has propounded, and Champion has responded to, three sets of discovery requests, including twenty-one interrogatories, 105 requests for production, and three requests for admission. To date, Champion has produced 17,539 pages of documents, and Generac has produced 6,927 pages.

Despite failing to produce a single responsive document for six months based on a dragged-out dispute over the Protective Order, Generac instead focused on obtaining third party discovery from Firman. Mirroring Firman's subpoena to Generac in the Firman Case, Generac served Firman with a subpoena on February 14, 2025, requesting Firman produce documents covering four topics, including "[a]ll documents exchanged, served, or filed by the parties in the [Firman Case] relating to [claim] construction ... including but not limited to correspondence, infringement contentions, invalidity contentions, proposed terms, proposed constructions, joint statements, exhibits, extrinsic evidence, declarations, deposition transcripts, discovery requests and responses, briefs, and court orders or opinions." EX2009; EX2013, p. 7.

Generac also requested Firman produce several categories of documents relating to its invalidity and unenforceability defenses and counterclaims: (1) "[a]ll Prior Art to the Patents-in-Suit, including but not limited to any art identified or

produced in the [Firman Case] or otherwise known to [Firman];” (2) “[a]ll Documents relating to or evidencing prior art or prior art activity, such as public disclosures, public uses, offers for sale, or sales to the Patents-in-Suit;” and (3) “[a]ll documents exchanged, served, or filed by the parties in the [Firman Case] relating to invalidity or unenforceability of any claim of the Patents-in-Suit, including but not limited to correspondence, invalidity contentions, exhibits, declarations, deposition transcripts, discovery requests and responses, briefs, and court orders or opinions.” *Id.* On February 26, 2025, Firman produced thousands of pages of documents in response to Generac’s subpoena, and on May 22, 2025, Generac sent Firman a letter requesting Firman supplement its response and produced even more documents. EX2014.

On April 2, 2025, Champion served a Notice of Subpoena for a deposition of Gregory Montgomery, Firman’s Chief Executive Officer, who is also former VP of Sales of Champion (2005-2014) and former VP and General Manager of Generac’s Powermate Brand (2014-2015). Mr. Montgomery was privy to Champion’s research and development efforts during his time at Champion. Highlighting Mr. Montgomery’s importance to both the Firman and Generac Cases, and the extensive coordination between Firman and the Petitioners, Firman and Generac responded to the subpoena by seeking court intervention to limit the scope of Mr. Montgomery’s

testimony.⁵ EX2030.

c. The Status and Timeline of the Generac Case Before a Final Written Decision

The following major milestones in the Generac Case schedule will also have occurred before December 16, 2026, deadline for a FWD:

1. On December 19, 2025, Generac and Champion must exchange their list of claim terms, phrases, and claims for construction.
2. On January 20, 2026, both parties must serve their proposed claim constructions and extrinsic evidence.
3. The parties must file a Joint Claim Construction Statement on March 13, 2026 and complete all claim construction discovery two weeks later, on April 1, 2026.
4. Generac and Champion must serve opening Markman briefs on April 13, 2026, and responsive Markman briefs on May 13, 2026.

EX2050. The remaining case deadlines are tied to the Generac court's issuance of a Markman Order. *Id.* However, the estimated median time to trial for patent cases in Eastern District of Wisconsin is 33.6 months—or, in this case, July 9, 2027. EX2048.

3. The Harbor Freight Case

Eight years after the '101 Patent was filed, on October 9, 2024, Petitioner

⁵ Although the Firman court resolved this dispute, Firman and Generac continue to delay Mr. Montgomery's deposition.

Harbor Freight filed a declaratory judgement action against Patent Owner Champion in the Central District of California. *Harbor Freight Tools USA Inc., v. Champion Power Equip., Inc.*, No. 2:24-cv-08722-SVW (C.D. Cal. Oct. 9, 2024) (“Harbor Freight Case”). EX2017.

a. Allegations in the Harbor Freight Case

Harbor Freight’s Complaint seeks declaratory judgment that it does not infringe the following patents: the ’034, ’120, ’985, ’654, ’970, ’780, ’895, ’398, ’145, ’101, ’667, ’390, and ’896 Patents. EX2017, p. 2. These are the same thirteen patents from the 2013 and 2015 Families asserted against Firman, eleven of which are also asserted against Generac.

Champion answered and counterclaimed, alleging two Harbor Freight multi-fuel generators infringe each of Champion’s patents, including the ’101 Patent. EX2018, p. 28. Harbor Freight responded to Champion’s Counterclaims, asserting each patent is invalid and unenforceable, including under §§ 102, 103, and 112. EX2019, p. 19.

Like Generac and Firman, Harbor Freight gives relatively short shrift in its invalidity counterclaims to the 2013 Family, including the ’101 Patent, as compared to its claims against the 2015 Family. Firman largely raised its invalidity arguments against the ’101 Patent in its invalidity contentions—contentions which, as discussed below, Generac will soon serve and which, to date, Harbor Freight refuses to serve.

Harbor Freight’s multiple third-party subpoenas reveal that system art raised by Firman in its invalidity contentions is the focus of Harbor Freight’s own invalidity allegations against the ‘2013 Family, including the ’101 Patent. For instance, Harbor Freight subpoenaed three third parties—each of which is associated with a specific system, engine, or device that Firman asserted against the ’101 Patent. EX2057. On July 1, 2025, Harbor Freight notified Champion “it will serve subpoenas on: (1) Metalcraft of Mayville, Inc.; (2) Northern Tool & Equipment Company Inc.; and (3) Winco, Inc.” *Id.*, 2. Specifically, Harbor Freight subpoenaed Metalcraft regarding its SCAG device, Northern Tool regarding its Northstar device, and Winco regarding seven Winco devices. *Id.* Harbor Freight requested documents showing “the design, structure, and operation of the System Art Product” and “the first sale, first offer for sale, or first public use of the System Art Product,” “[a] sample of each of the System Art Product,” and “[a]ll Communications between [the third party] and Champion concerning this Action, the Asserted Patents, and the System Art Product.” *Id.*, 11, 28, 45. Harbor Freight also subpoenaed all three third parties for a deposition on the same topics, demonstrating these system references will be the focus of Harbor Freight’s challenge against the ’101 Patent.

Likewise, Harbor Freight’s adoption of Firman’s claims against the 2015 Family make it even more likely that it will mirror Firman’s invalidity contentions against the 2013 Family, including the ’101 Patent. For example, just as Generac

copied many of Firman’s invalidity counterclaims from the Firman Case, so too did Harbor Freight in its own affirmative defenses against the 2015 Family. In fact, Harbor Freight’s invalidity defenses include word-for-word copies of Generac’s

Answer and Counterclaims:

“To the extent that the claims of the ’780 patent are construed to cover the Firman models that Champion has accused of infringement in *Champion Power Equipment, Inc. v. Firman Power Equipment, Inc.*, Case No. 2:23-cv-02371-DWL (D. Ariz.), on information and belief, the RD9000E dual fuel generator discloses every element of at least the following claims of the ’780 patent”

EX2019, pp. 27-28, ¶219.

“To the extent that the claims of the ’780 Patent are construed to cover the Firman models that Champion has accused of infringement in *Champion Power Equipment, Inc. v. Firman Power Equipment, Inc.*, Case No. 2:23-cv-02371-DWL (D. Ariz.), the RD9000E dual fuel generator discloses every element of at least the following claims of the ’780 Patent”

EX2011, pp. 106-107, ¶139.

Harbor Freight repeats this paragraph against seven other Champion patents, and references the RD9000E no less than forty-three times, and “Firman” no less than thirty-one times. *See, e.g.*, EX2019, p. 27, ¶218 (“[T]he RD9000E dual fuel generator includes at least one element of at least one claim of each patent in the 2015 Patent Family[.]”). Tellingly, Harbor Freight asserts Champion is “[t]aking infringement positions in [the Harbor Freight Case], [the Generac Case], and in [the

Firman Case], that would clearly render the RD9000E generator an anticipatory prior art reference.” *Id.*, pp. 35-36, ¶228. In other words, Firman, Generac, and Harbor Freight raise the same uniform claims against the 2015 Family, foreshadowing allegations against the ’101 Patent and the 2013 Family.

b. Progress in the Harbor Freight Case Before an Institution Decision

Significant progress will have been made in the Harbor Freight Case before the institution decision deadline.

The Pleadings

On October 9, 2024, Harbor Freight filed a declaratory judgment action against Champion in the Central District of California. On October 14, 2024, Champion sued Harbor Freight for patent infringement in the Eastern District of Wisconsin, *Champion Power Equip. Inc. v. Harbor Freight Tools USA Inc.*, No. 2:24-cv-01302-PP (E.D. Wis. Oct. 14, 2024) (“HFT Wisconsin Case”). EX2027. On November 4, 2024, the parties filed and briefed competing motions to dismiss in each case. EX2027, p. 3; EX2016, p. 6. Ultimately, the HFT Wisconsin Case was dismissed on April 28, 2025, and Harbor Freight’s declaratory judgment action proceeded. EX2016, p. 9; EX2027, p. 4. On February 27, 2025, Champion filed its Answer and infringement Counterclaims. EX2018. Harbor Freight answered on March 20, 2025, raising various affirmative defenses, including invalidity defenses

against the '101 Patent and the other twelve asserted patents from the 2013 and 2015 Families. EX2019. And, like Firman and Generac, Harbor Freight asserts the 2015 Family is unenforceable based on an alleged failure to disclose the RD9000E generator during prosecution. EX2019, p. 27, ¶218.

Claim Construction

The parties have commenced claim construction proceedings, exchanging their proposed terms for construction on June 30, 2025. For the '101 Patent, Harbor Freight proposed two terms and phrases for construction. On July 14, 2025, the parties exchanged preliminary claim constructions and extrinsic evidence. For its disclosure of extrinsic evidence, Harbor Freight listed and incorporated by reference the present Petition, its IPR petitions against the '667 and '896 Patents, expert declarations filed in support of the three petitions, and the declaration of Firman's expert in the Firman Case. EX2021, pp. 4-6. Harbor Freight and Champion met and conferred regarding their proposed constructions on August 1, 2025. Claim construction discovery will conclude on September 2, 2025. The parties will file opening claim construction briefs on September 9, 2025, and reply briefs on September 16, 2025. The Markman hearing is scheduled for September 30, 2025, well before the December 16 institution decision deadline. EX2016, p. 10.

Contentions

Champion proposed specific deadlines for serving infringement and invalidity

contentions, but Harbor Freight contends such contentions are “[u]nnecessary” and that “contention discovery can be handled” with routine discovery requests. EX2020, pp. 13-14. The Harbor Freight court left it to the parties to handle contentions through discovery requests. Champion agreed to Harbor Freight’s request to produce infringement contentions, which were served on April 24, 2025. On the other hand, despite its earlier insistence that contention deadlines were unnecessary and could instead be handled through routine discovery, Harbor Freight has refused to provide responses to Champion’s standard requests for non-infringement contentions and invalidity contentions, such as “charts that describe in detail the complete factual and legal bases supporting any contention that the Asserted Patents are invalid and unenforceable[.]” EX2022.

Discovery To-Date

The Harbor Freight court issued a schedule months ago, and Harbor Freight and Champion spent months negotiating a proposed Protective Order and Protocol for the discovery of Electronically Stored Information. Like the Generac case, the parties are actively disputing the scope of the Protective Order and have been actively engaged in discovery since November 2024. In total, Champion has propounded, and Harbor Freight has responded to, two sets of discovery requests, including fifteen interrogatories and twenty-nine requests for production; and Harbor Freight has propounded, and Champion has responded to, one set of

discovery requests, including four interrogatories and twenty-one requests for production. To date, Champion has produced 7,858 pages of documents and Harbor Freight has produced 1,668 pages.

Mirroring Firman's subpoena to Generac in the Firman Case and Generac's subpoena to Firman in the Generac Case, Harbor Freight served Firman with a subpoena on March 10, 2025, requesting Firman produce documents covering four topics. EX2023. These subpoena topics were *identical* to those in Generac's subpoena to Firman, with Harbor Freight requesting claim construction documents, contentions, prior art, extrinsic evidence, opinions, and declarations. *Id.*, 9. Firman responded to this subpoena on March 24, 2025, producing contentions and claim construction exchanges from the Firman Case, as well as Champion's expert reports and the declarations of Firman's claim construction expert. EX2024; EX2025.

c. The Status and Timeline of the Harbor Freight Case Before a Final Written Decision

The Harbor Freight court has not issued a post-Markman case schedule. However, Harbor Freight and Champion jointly filed a proposed schedule where fact discovery, expert discovery and disclosures, and dispositive motion briefing would conclude no later than August 21, 2026. EX2020, p. 11. In fact, the parties agreed that the Final Pretrial Conference occur December 10, 2026—6 days *before* the

December 16, 2026, FWD deadline—and that trial could begin as early as January 19, 2027. *Id.*

4. The MWE Case

On May 14, 2025, Champion filed a Complaint against Petitioner MWE in the District of Nevada. *Champion Power Equip., Inc v. Westinghouse Electric Corporation et. al.*, No. 3:25-cv-00239 (D. NV. May 14, 2025) (“MWE Case”). EX2051. Champion’s Complaint accuses MWE of infringing the following ten patents from the 2013 and 2015 Families: the ’034, ’120, ’985, ’780, ’895, ’398, ’145, ’101, ’667, and ’896 Patents. *See, e.g.*, EX2051. These patents are all asserted against Firman, Generac, and Harbor Freight. MWE was on notice of the ’101 Patent at least as of June 19, 2020, even threatening to file an IPR petition at that time. *Id.*, 12. The MWE case is in its early stages. On August 11, 2025, MWE filed a motion to transfer.

D. Petitioners’ Multiple IPR Filings To-Date

Of the thirteen patents asserted Champion across the four co-pending cases, to date Petitioners have challenged seven of them in IPR over the course of four months:

- i. *Harbor Freight Tools USA, Inc. et al. v. Champion Power Equipment, Inc.*, IPR2025-00805 (April 29, 2025), challenging the ’034 Patent;
- ii. *Generac Power Systems, Inc. et al. v. Champion Power Equipment, Inc.*,

IPR2025-00951 (May 16, 2025), challenging the '101 Patent;

- iii. *Generac Power Systems, Inc. et al. v. Champion Power Equipment, Inc.*, IPR2025-01099 (June 17, 2025), challenging the '667 Patent;
- iv. *Harbor Freight Tools USA, Inc. et al. v. Champion Power Equipment, Inc.*, IPR2025-001121 (June 23, 2025), challenging the '120 Patent;
- v. *Generac Power Systems, Inc. et al. v. Champion Power Equipment, Inc.*, IPR2025-01228 (July 11, 2025), challenging the '896 Patent;
- vi. *MWE Investments, LLC et al. v. Champion Power Equipment, Inc.*, IPR2025-01185 (July 22, 2025), challenging the '780 Patent; and
- vii. *Harbor Freight Tools USA, Inc. et al. v. Champion Power Equipment, Inc.*, IPR2025-01272 (July 30, 2025), challenging the '985 Patent.

Petitioners have promised to file IPR petitions against the six remaining asserted Champion patents, and assuming they do so on similar timelines as the first seven, this will amount to thirteen IPRs filed over 6-7 months.

E. Petitioners' Recently Served Stipulations

On October 9, 2024, Harbor Freight filed its declaratory judgment complaint against Champion, and Champion filed its infringement complaint against Generac. Over seven months later, on May 16, 2025, Petitioners filed the Petition. Yet, Harbor Freight and Generac delayed serving their stipulations regarding invalidity contentions for three members of the 2013 Family—the '101, '667, and '896

Patents—until August 4, just two weeks before the August 18, 2025 deadline for the instant brief. EX2058; EX2059. MWE served its stipulation one business day before the filing deadline. EX2069. The stipulations are generally *Sotera* stipulations with the extra caveat that Petitioners will not assert in their parallel litigations “system prior art” “that directly corresponds to a printed publication reference asserted as part of a ground raised in IPR2025-00805.” EX2058, p. 4, EX2059, p. 4. However, the stipulations go on to clarify:

To be clear, this stipulation does not cover other system prior art. For example, because a manual for the DuroMax XP4400EH generator is relied upon as part of a ground in IPR2025-00951, the XP4400EH generator is covered by this stipulation. However, other systems/engines are not covered, even if similar to the XP4400EH generator.

EX2058, p. 4; EX2059, p. 5.

These stipulations are similar to stipulations served in late July regarding invalidity contentions against the '034 Patent from the 2015 Family. EX2026, p. 2; EX2015, p. 2; EX2052, p. 2. Those stipulations also carve out system prior art that does not directly correspond to a publication asserted in IPR:

To be clear, this stipulation does not cover other system prior art. For example, because a manual for the Kubota DF-972 engine is relied upon as part of a ground in IPR2025-00805, the DF-972 engine is covered by this stipulation. However, other systems/engines are not covered, even if similar to the DF-972 engine.

Id.

In other words, the stipulations do not apply to the litany of system art references asserted by Firman that, in view of Petitioners' pattern of adopting Firman's arguments and evidence in their respective litigations, will likely be asserted against the '101 Patent in Petitioners' invalidity contentions in the parallel proceedings. EX2006; EX2008. For example, it does not apply to Firman's own ECO8990E Device, the Kubota DF-972 Engine, the Winco device, multiple Honda devices, the Northstar device, or the SCAG Turf Tiger device (which incorporates the Kubota DF-972 engine). *See* Section I.C.1. *supra*; EX2006, pp. 40-42; EX2009. Notably, although Petitioners stipulate not to assert the Kubota DF-972 engine against the '034 Patent, it does not so stipulate with respect to the '101 Patent. On the other hand, while Petitioners stipulate to not assert the DuroMax XP4400EH generator against the '101 Patent, it does not so stipulate with respect to the '034 Patent.

II. THE BOARD SHOULD EXERCISE ITS DISCRETION UNDER 35 U.S.C. § 314(a) TO DENY THE PETITION

The Board may not institute IPR unless the information presented in the petition "shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314. Institution of IPR, however, is within the Director's discretion. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) ("[T]he PTO is permitted,

but never compelled, to institute an IPR proceeding.”); *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 366 (2018); *see also Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016) (“the agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion”). The Director applies *Fintiv*’s six-factor balancing test to determine whether discretionary denial is appropriate. *Fintiv*, IPR2020-00019, Paper 11 at 6 (*Fintiv* Factors). In addition to these factors, the Director evaluates the PTAB’s “ability ... to comply with pendency goals for *ex parte* appeals, its statutory deadlines for AIA proceedings, and other workload needs.” Director’s Memo at 3. Here, each of these factors, including those set forth in the Director’s Memo, weighs in favor of denying institution.

A. Factor 1 Weighs in Favor of Discretionary Denial

Factor 1 weighs substantially in favor of discretionary denial. None of the four parallel district court proceedings in which the ’101 Patent is being challenged have been stayed. In fact, Petitioners have not moved to stay any of their respective cases. Even if any Petitioner eventually seeks a stay, there is insufficient evidence that any of the Generac, Harbor Freight, MWE, or Firman courts would issue a stay. Only two of these four courts have resolved contested motions to stay pending IPR—the MWE and Firman courts—and in each of those cases IPR had already been instituted. *FaceTec, Inc. v. iProov, Ltd.*, No. 2:21-cv-02252, ECF No. 188 (D. Nev. June 18, 2025); *Parson Xtreme Golf LLC v. Taylor Made Golf Co. Inc.*, No. CV-17-

03125, ECF No. 187 (D. Az. Nov. 29, 2018). It is also unlikely the Firman court would grant a stay because Firman is not a Petitioner and its statutory deadline to file a petition has long passed, the parties and court have invested a significant amount of time and resources in that case over the course of almost two years, and it is likely to proceed to trial before a FWD.

Regarding the two other courts, the Generac court granted two stipulations for automatic stay pursuant to 35 U.S.C. § 315(a)(2), *Hydrite Chem. Co. v. Solenis Techs. LP*, No. 2:15-cv-856, ECF No. 9 (E.D. Wis. Aug. 3, 2015) and *Pentair Water Pool & Spa Inc. v. Fail-Safe LLC*, No. 2:13-cv-01321, ECF No. 8 (E.D. Wis. Dec. 30, 2013), and the Harbor Freight court has never considered a stay motion pending IPR. Accordingly, Factor 1 weighs in favor of discretionary denial.

B. Factor 2 Weighs in Favor of Discretionary Denial

Factor 2 weighs in favor of discretionary denial. As an initial matter, although no trial date has been set in any of the Harbor Freight, Generac, and MWE cases, Petitioner Harbor Freight proposed and agreed to a schedule where fact discovery, expert discovery and disclosures, and dispositive motion briefing would conclude nearly four months before a FWD. EX2020, p. 11 (proposing a deadline of August 21, 2026). In fact, Harbor Freight agreed that the Final Pretrial Conference occur December 10, 2026—six days *before* the December 16, 2026, FWD deadline—and that trial could begin as early as January 19, 2027. *Id.*; *see Linkplay Technology Inc.*

v. Sonos, Inc., IPR2025-00509, Paper 10 at 2 (July 31, 2025) (“Although time-to-trial statistics suggest trial would begin in November 2026, the parties have agreed to the August trial date.”).

The validity of the ’101 Patent will likely be adjudicated in the Firman Case, with an estimated trial date of November 10, 2026 (EX2047), over a month before FWD if trial is instituted. The presence of “events in other proceedings related to the same patent” may weigh against granting a petition. Consolidated Trial Practice Guide (84 Fed. Reg. 64,280 (Nov. 21, 2019)) at 58. The Director may consider whether “the validity of the challenged patent is already being adjudicated in another forum that will issue” a decision before the FWD, even if none of the Petitioners are “a named defendant in the parallel district court proceeding.” *See Entegris, Inc. v. Inpria Corp.*, IPR2025-00267, Paper 12 at 2 (July 2, 2025). In particular, the Director may find that discretionary denial is warranted under such circumstances when “arguments, evidence, and statements” are being “incorporated by reference,” “and the issues presented in the Petition are ‘the same as, or substantially similar to, those already or about to be litigated’[.]” *Id.* (quoting *Fintiv*, IPR2020-00019, Paper 11 at 14).

Harbor Freight focuses on third-party discovery related to the exact same system references cited by Firman against the ’101 Patent, subpoenaing third parties for documents and depositions related to SCAG, Northstar, and Winco devices.

Petitioners Generac and Harbor Freight assert other counterclaims and defenses that are carbon copies of each other, and near identical copies of Firman's own invalidity allegations. *Compare* Firman's counterclaims (EX2004, ¶80) *with* Generac counterclaims (EX2011, ¶¶139-40) *and* Harbor Freight's counterclaims EX2019, ¶139); *see also* Section I.C.3.a. All three parties rely extensively on Firman's RD9000E generator as allegedly anticipatory system art to the entire 2015 Family and the basis for inequitable conduct defenses and counterclaims. *Id.* Generac's and Harbor Freight's counterclaims are riddled with references to Firman's RD9000E generator and the Firman case. *Id.* This pattern of adopting Firman's invalidity positions in its pleadings foreshadows Petitioners' own forthcoming invalidity contentions against the '101 Patent.

Further, at least Petitioners Generac and Harbor Freight have been actively collaborating with Firman throughout discovery in the district court cases. Firman subpoenaed Generac and both Generac and Harbor Freight subpoenaed Firman, and the parties have exchanged extensive documents and evidence relating to their respective litigations, including prior art, claim construction, infringement and invalidity contentions, correspondence, exhibits, extrinsic evidence, declarations, deposition transcripts, discovery materials, briefs, and court rulings or opinions. EX2013; EX2009; EX2023. Generac's and Harbor Freight's discovery requests to Champion have also been Firman-focused. For example, Generac's first three

requests for production sought documents relating to written discovery, contentions, and claim construction in the Firman Case. Likewise, Harbor Freight requested all documents “in any litigation involving any Patent-in-Suit” relating to the scope of any claims, including infringement or invalidity contentions and claim construction proceedings, which include documents from the Firman, Generac, and MWE cases.

In essence, Petitioners have co-opted the Firman Case entirely, adopting Firman’s invalidity counterclaims as their own and actively collaborating with Firman throughout discovery. They have incorporated Firman’s arguments, evidence, and statements regarding invalidity and claim construction, and have exchanged thousands of pages of references, contentions, and expert reports with Firman. While Petitioners may attempt to minimize the influence of the Firman Case on this Petition and their own parallel litigations, that self-serving argument would be at odds with Petitioners’ Firman-focused litigation strategy to date. That the trial against statutorily-barred Firman is likely to precede a FWD is notable given the Board’s vested interest in preserving resources and avoiding inconsistent outcomes with respect to the meaning, validity, and enforceability of the ’101 Patent.

Given the extent of Petitioners’ reliance on the Firman Case, and the fact that the Firman Case is likely to go to trial before a FWD, Factor 2 weighs strongly in favor discretionary denial.

C. Factor 3 Weighs in Favor of Discretionary Denial

Factor 3 weighs in favor of discretionary denial because there has been meaningful investment in the co-pending cases. Discretionary denial may be warranted where the parties “have made meaningful investment in the district court proceeding,” such as, for example, when “the parties have exchanged infringement and invalidity contentions, have already conducted over seven months of fact discovery, and a Markman hearing is scheduled to occur before the due date for an institution decision.” *Advanced Micro Devices, Inc. v. Concurrent Ventures, LLC*, IPR2025-00223, Paper 9 at 2 (June 12, 2025) (denying institution).

First, since February 29, 2024, substantial discovery has already taken place in the Firman Case—discovery on which Petitioners rely. *See* Sections I.C.2.b-3.b. Claim construction briefing is complete, and the court is expected to issue a Markman Order any day. Once issued, the Order will trigger a ninety-day deadline to complete all fact discovery, including final contentions, which would be closely followed by expert discovery and dispositive motion deadlines. Champion served Firman infringement contentions over a year ago, and Firman served invalidity contentions on August 30, 2024. Firman’s invalidity contentions, which it produced to Generac and Harbor Freight, included over 5,000 pages of claim charts. Firman amended those contentions after receiving a voluminous document production from Generac. *See, e.g.*, EX2005; EX2007. Despite already identifying over 100 prior art

references in its original contentions, Firman emphasized the importance of Generac's production, noting it included information regarding decade-old sales of allegedly invalidating products. EX2005, n.1.

Second, by the institution decision deadline, substantial investments will have been made in the Generac Case. The parties have already completed multiple rounds of pleadings. The parties have exchanged infringement and non-infringement contentions, and Generac's invalidity contentions are due on August 22, 2025. Discovery in the Generac Case has also been active since early 2025, with the parties exchanging multiple sets of discovery requests and responses. Generac also relied on the significant time and investment that Firman has made to date, seeking extensive discovery from Firman and adopting many of its defenses and arguments wholesale. Champion and Generac are in the process of negotiating a time and place for the deposition of Firman's CEO, underscoring his relevance to both the Firman and Generac Cases. Overall, the volume and pace of activity in the Generac Case has been substantial.

Third, the Harbor Freight Case will have also advanced significantly by the institution decision deadline. After Harbor Freight sued Champion for declaratory judgment of non-infringement, the parties engaged in dueling pleadings and substantial motion practice between October 2024 and February 2025, ultimately resulting in consolidation of the cases in the Central District of California. Both

parties have since filed answers and counterclaims, with Harbor Freight asserting non-infringement, Champion responding with infringement claims, and Harbor Freight raising an affirmative defense of invalidity of the '101 Patent.

Claim construction in the Harbor Freight Case is well underway, and the parties' opening claims construction briefs are due in three weeks. The parties exchanged proposed terms and preliminary constructions in June and July 2025, with Harbor Freight disclosing a substantial amount of extrinsic evidence, such as multiple expert declarations and IPR petitions. EX2021. The Markman Hearing is September 30, 2025. Discovery has also been active since November 2024, with both parties exchanging multiple sets of interrogatories and requests for production. And, while Champion served infringement contentions in April 2025, Harbor Freight has refused to produce non-infringement or invalidity contentions in an apparent effort to delay the case.

Admittedly, unlike the Generac and Harbor Freight Cases, the MWE Case is in its infancy, and a scheduling order has yet to issue. This, however, should be given little weight because like Harbor Freight and Generac, MWE is Champion's long-time competitor, has been in the same "technology space involving the challenged patent" for years, and indeed, has long known about Champion's multi-fuel generator patent families "before filing its Petition challenging Patent Owner's patent," even threatening to file an IPR against the '101 Patent five years ago.

Murata Manufacturing Co., Ltd. v. Georgia Tech Research Co., IPR2025-00383, Paper 14 (July 29, 2025). MWE instead chose inaction until Champion had no other choice but to file suit to enforce its patent rights.

In short, thousands of pages of infringement, non-infringement, and invalidity contentions, in addition to significant written discovery and document productions, have already been exchanged or will have been exchanged in the Firman, Generac, and Harbor Freight Cases before the institution decision deadline. Additionally, a claim construction order may issue any day in the Firman Case and claim construction proceedings will be complete in the Harbor Freight Case by September 30. Accordingly, the third *Fintiv* factor weighs in favor of discretionary denial, or at minimum, is a neutral factor.

D. Factor 4 Weighs in Favor of Discretionary Denial

The fourth *Fintiv* factor supports discretionary denial because the belated stipulations offered by Petitioners cannot moot their expansive invalidity theories in the co-pending cases, including anticipation and obviousness based on system art, as well as 35 U.S.C. § 112 arguments that, as alleged by Firman, the '101 Patent is invalid for lack of written description and enablement. None of these issues can be resolved by the Board.

Whether a Petitioner timely files a stipulation that it will not raise any ground raised or that could have reasonably been raised in an IPR is “highly relevant, but

will not be dispositive by itself.” Director’s Memo at 2-3, citing *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (Dec. 1, 2020) (“Sotera”). While a stipulation can only be offered before an Institution Decision, the Office’s Process provides a petitioner should file a *Sotera* stipulation “as soon as practicable, so that a patent owner may address the impact of the stipulation in its discretionary denial brief.” Interim Director Discretionary Process (“Process”), Section I(D); see *NXP USA, Inc. v. Impinj, Inc.*, IPR2021-01556, Paper 13 (Sept. 7, 2022) (precedential).

As an initial matter, Harbor Freight and Generac served their stipulations with respect to the ’101 Patent on August 4, 2025, while MWE served its stipulation on August 15, 2025, one business day before the deadline. Petitioners failed to provide any explanation as to why they waited to serve their stipulations nearly three months after filing the Petition and nearly two months after the Notice of Filing Date Accorded issued. Paper 7.

In any event, the stipulations do little to narrow the issues before the district courts. “Where the petitioner is relying on corresponding system art in a co-pending proceeding and/or several other invalidity theories, a stipulation may not be particularly meaningful[.]” Process, Section I(D). The circumstances of this Petition are unique in that the ’101 Patent invalidity theories asserted across the four co-pending cases are not only developed by Firman but also involve numerous combinations of system art that the stipulations do not moot. See *Motorola Sols. v.*

Stellar, LLC, IPR2024-01205, Paper 19 at 3–4 (Mar. 28, 2025) (Director Review)

(“Petitioner’s invalidity arguments in the district court are more expansive and include combinations of the prior art asserted in these proceedings with unpublished system prior art, which Petitioner’s stipulation is not likely to moot”). Tellingly, although Petitioners Harbor Freight and Generac have repeatedly sought to delay serving their ’101 Patent invalidity contentions to Champion, depriving Champion the opportunity to fully address those contentions in this and multiple other discretionary denial briefs, Harbor Freight has actively sought third-party discovery related to the exact same system references cited by Firman against the ’101 Patent. At every turn, Petitioners have made a habit of parroting Firman’s entire case against Champion, and have focused their discovery efforts on the exact same systems that Firman asserts against both patent families.⁶

Because the Board cannot evaluate these system-based invalidity theories in IPR, the district courts will still have to grapple with several §§ 102 and 103 invalidity grounds, in addition to § 112 grounds. *See Motorola Sols.*, IPR2024-01205, Paper 19 at 3–4 (denying institution despite Petitioner’s *Sotera* stipulation, in part, because “Petitioner’s stipulation does not ensure that the[] IPR proceedings

⁶ For example, the allegations against the 2015 Family based on the RD9000E system art are central to the defenses and counterclaims in the Firman, Generac, and Harbor Freight Cases. *See* Section I.C.2.b.

would be a ‘true alternative’ to the district court proceeding”); *see also Shenzhen Tuoshu Tech. Co., Ltd v. Stratasy, Inc.*, IPR2025-00354, Paper 11 at 2–3 (June 12, 2025) (same); *see also Nokia of Am. Corp. v. Pegasus Wireless Innovation LLC*, IPR2025-00037, Paper 14 at 13 (Apr. 25, 2025) (noting that a stipulation would not be dispositive given “that some issues will remain—the district court will still have to resolve various § 112 issues raised by the Petitioner”).

While the stipulations provide that Petitioners will not assert in *their* litigations “system prior art...that directly corresponds to a printed publication” raised in the Petition, nothing prevents *Firman* from pursuing its invalidity grounds based on those systems in its far more advanced litigation. In fact, *Firman* provided hundreds of pages of claim charts on these systems in its invalidity contentions. The stipulations do not prevent Petitioners from relying on corresponding system prior art, e.g., the Kubota engine or the DuroMax XP4400EH generator, against other asserted patents where the corresponding user manuals are not asserted in IPRs against those particular patents, meaning that corresponding prior art will likely still be at issue in the parallel district court cases.

Accordingly, Factor 4 weighs in favor of discretionary denial.

E. Factor 5 Weighs in Favor of Discretionary Denial

The parties to the Petition are the same as those in the Generac, Harbor Freight, and MWE Cases. Accordingly, Factor 5 weighs in favor of discretionarily

denying the Petition. *See Sotera*, IPR2020-01019, Paper 12 at 19 (precedential as to Section II.A).

F. Factor 6 Weighs in Favor of Discretionary Denial

Factor 6 weighs in favor of discretionary denial for several reasons. “[C]onsistent with the discretionary considerations enumerated in existing Board precedent ... and the Consolidated Trial Practice Guide (Nov. 2019), the parties are permitted to address all relevant considerations, which may include: ...

- The strength of the unpatentability challenge;
- The extent of the petition’s reliance on expert testimony;
- Settled expectations of the parties, such as the length of time the claims have been in force; ... and
- Any other consideration bearing on the Director’s discretion.”

Director’s Memo at 2-3.

1. Strength of the Unpatentability Challenge

The sixth factor of the *Fintiv* analysis favors denial because the Petition's merits are weak, as Champion will establish more fully in its forthcoming Preliminary Response. *See* Process, Section II(C)(i) (“[W]hen filing a brief for discretionary denial, a patent owner may direct attention to an anticipated POPR and evidence for a discussion of the merits.”).

2. Settled Expectations

The sixth *Fintiv* factor also supports discretionary denial because Champion has long settled expectations that the '101 Patent would not be challenged in an IPR. “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 Solutions Inc. v. AXA Power APS*, IPR2025-00408, Paper 21 at 3 (June 18, 2025). “This approach aligns with other approaches to settled expectations and incentives, for example, for filing infringement lawsuits.” *Id.* (citing 35 U.S.C. § 286 (“Except as otherwise provided by law, no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action.”))).

Here, the application that issued as the '101 Patent was filed almost ten years ago on February 4, 2016, and issued nearly six years ago on March 24, 2020. Claiming a priority date of November 1, 2013, the '101 Patent is already twelve years into its enforceable term. *See Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00601, Paper 9 at 3 (July 24, 2025) (“the challenged patents have been in force for seven and six years, respectively, creating strong settled expectations for Patent Owner ...”). Until this Petition, no IPR petition had ever been filed against any of the issued patents in the 2013 Family.

Petitioners have not been diligent in challenging the '101 Patent, and Patent

Owner's expectations have therefore been settled for years. Notably, Champion began enforcing the '101 Patent against Petitioners just weeks after it issued in 2020. Champion sent cease-and-desist letters to Petitioners Generac and MWE, both of whom were, at the time, represented by the same attorneys and law firms that are of record on the Petition. EX2033; EX2036. On July 31, 2020, both Petitioners responded. MWE stated it was "aware of and/or in possession of prior art that will support invalidation" and was "prepared to present this evidence in litigation or in an Inter Partes Review proceeding if it becomes necessary." EX2034. MWE went even further, claiming that references in its possession would prove to "be fatal to" Champion's rights in dual-fuel generators. EX2035. Generac likewise asserted that it had "analyzed the file history and reviewed the prior art" and concluded that "the claims of the '101 patent are invalid." EX2037. Despite these early threats, neither MWE nor Generac filed suit or initiated an IPR against the '101 Patent—or any other patent in the 2013 or 2015 Families—for five years.

Meanwhile, Champion submitted IDSs in 2020 in all pending cases with all the art cited by the Petitioners, resulting in some claims issued broader than the claims herein. For example, compare Claim 1 of the '101 Patent to Claim 1 of the '667 Patent. *Compare*, EX1001, Claim 1 *with* EX2072, Claim 1.

Although Petitioners are sophisticated long-time competitors of Champion in the same technology space, an industry in which they actively monitored

Champion's generator patents, were members of the same generator manufacturers' groups, and should have been aware of Champion's commercialized and marked products, Petitioners did not challenge the '101 Patent until faced with litigation. Even if Champion was not selling a commercialized and marked product, Champion would still have strong settled expectations. *See Google LLC v. Soundclear Technologies LLC*, IPR2025-00344, Paper 15 at 2-3 (Aug. 4, 2025) ("Petitioner's argument that Patent Owner does not have strong settled expectations because the patent was not 'commercialized, asserted, marked, licensed, or otherwise applied in a petitioner's particular technology space,' without more, does not defeat Patent Owner's strong settled expectations.").

In fact, before it issued as the '101 Patent, the '205 Application published as U.S. Pat. Publ. No. 2016/0146122A1 on May 26, 2016, just *three months* after it was first filed. *See Dabico*, IPR2025-00408, Paper 21 at 3 ("[P]atent applications (after 18 months) and issued patents are almost always publicly available to provide notice to the public, other inventors, competitors, and commercial interests") (citing 35 U.S.C. § 122). That the application was published nearly ten years ago is enough, on its own, to create strong settled expectations. *See Google*, IPR2025-00344, Paper 15 at 2-3 ("This is particularly true considering that Petitioner had knowledge of the challenged patents as early as 2019."). Having ostensibly been put on notice of the '101 Patent since 2016, knowing of potentially relevant references since 2015 (i.e.,

the Generac system art Firman added to its Amended Invalidity Contentions), and even warning Champion in 2020 of their intent to challenge the '101 Patent, Petitioners nevertheless waited until 2025 to act.

As early as 2015, Generac and Firman should have been aware of Champion's research and development efforts and that Champion was actively seeking corresponding patents by virtue of their employment of Mr. Greg Montgomery, Champion's former VP, for nearly a decade. Mr. Montgomery joined Generac in early 2015 as a high-level executive (VP and General Manager of Generac's subsidiary, Powermate, and later joining Firman as CEO in mid-2015). Any of Champion's pending patent applications would have either already been published or would have been published soon after Mr. Montgomery joined Generac and Firman in 2015. *See Dabico*, IPR2025-00408, Paper 21 at 3 ("Interested parties may find published patents and patent applications using the Office's automated search systems as well as publicly available resources on the Internet ... As such, actual notice of a patent or of possible infringement is not necessary to create settled expectations."). Mr. Montgomery knew Champion filed the parent to the '101 Patent and knew Champion was actively working on another application when he left Champion in December 2014. EX2064. Upon starting at Generac in January 2015, Mr. Montgomery immediately led a team in developing dual fuel generators based on Champion's designs. EX2065 at 14; EX2073 at 3; EX2074 at 12-13. While

Generac had actual knowledge of Champion's patent applications in early 2015 by virtue of its executive, it also is deemed to have constructive notice upon the publication date of May 7, 2015, especially due to their PGMA membership dating back to at least 2013.

Likewise, in its analysis of the 2013 Family, Generac should have been aware of any commercial embodiments that it believed were covered by the 2013 Family, including embodiments which it now contends are also "prior art to the 2015 Patent Family[.]" EX2011, ¶¶79, 82 ("Champion dual fuel generator model 100153 is a commercial embodiment of the 2013 Patent Family and 2015 Patent Family."). Notably, another Champion engine model was marked with both patent families, including the '101 Patent, as early as September 2020. EX2046; *Murata*, IPR2025-00383, Paper 14 at 2–3 ("Petitioner was aware that Patent Owner was involved in the same technology space for a significant amount of time before filing its Petition challenging Patent Owner's patent").

Instead of challenging the Patent Families, MWE and Generac bided their time, and waited until they were either sued or warned of a complaint that was about to be filed. The pattern continued with Harbor Freight. Like Generac and MWE, Harbor Freight chose not to file an IPR petition in response to Champion's cease-and-desist letter accusing it of infringing patents in both the 2013 and 2015 Families, including the '101 Patent. Instead, it filed a declaratory judgment action in district

court, further underscoring the strategic delay and reluctance of Petitioners to use the IPR process until faced with litigation. That the infringement actions at issue were filed in 2024 is irrelevant to Petitioners' delay in seeking clarity on the validity of the '101 Patent. *See Kahoot! AS v. Interstellar Inc.*, IPR2025-00696, Paper 12 at 2 (July 31, 2025) ("Petitioner's argument that Patent Owner does not have settled expectations because Patent Owner did not previously assert the challenged patent against Petitioner does not defeat Patent Owner's settled expectations.").

Petitioners' delay suggests a tactical decision to hedge litigation risk rather than a genuine interest in timely resolving patentability concerns. This prolonged inaction gave Champion settled expectations that the '101 Patent would not be challenged in an IPR. These settled expectations are dispositive and on its own, far "outweighs the [other] considerations" that would collectively "weigh against discretionary denial." *iRhythm Technologies, Inc. v. Welch Allyn, Inc.*, IPR-2025-00363, Paper 10 (June 6, 2025) (discretionarily denying institution). Allowing a late-stage IPR now would destabilize long-standing patent rights and reward Petitioners' delay at Champion's expense. *Kahoot!*, IPR2025-00696, Paper 12 at 2 ("[T]he challenged patent has been in force for over six years, creating strong settled expectations"); *Cambridge Industries USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00433, Paper 12 at 3 (June 26, 2025) (discretionarily denying institution challenging seven and nine year old patents); *Amgen*, IPR2025-00601, Paper 9 at 3.

Ultimately, a “Petitioner’s failure to seek early review of the patents favors denial.”

Nvidia Corporation v. Neural AI, LLC, IPR2025-00606, Paper 18 at 3 (July 31, 2025).

Champion’s settled expectations favor discretionary denial.

3. Petitioners Rely Extensively on Unfocused Expert Testimony

Petitioners’ expert declaration is 174 pages—nearly twice as long as the Petition itself—and includes 285 numbered paragraphs. *See* EX1003. Yet the Petition only cites fifty-two of these paragraphs. For example, in his discussion of Ground 3, Dr. Winkel dwells on JP2005330867 (“Fujisawa”) as an anticipatory reference for 25 paragraphs spread out over 15 and a half pages. EX1003, pp. 127-143 (¶¶218-244). The Petition cites *none* of this testimony. It is unclear why Dr. Winkel would have drafted an additional 233 superfluous paragraphs, requiring the Board to determine the paragraphs that are properly of record. *Cisco Systems, Inc. v. C-Cation Technologies, LLC*, IPR2014-00454, Paper 12 (Aug. 29, 2014) (informative) (“A brief must make all arguments accessible to the judges, rather than ask them to play archeologist with the record.”).

On the other hand, to the extent Petitioners are improperly holding these paragraphs in reserve for a future reply, it would be improper for Petitioners to later argue that Dr. Winkel provided testimony in support of certain grounds of

unpatentability when Petitioners never cited much less discussed the testimony in the Petition itself. *Pioneer Pet Prods., LLC v. Oil-Dri Corp. of Am.*, IPR2022-00691, Paper 31 at 29 (Sept. 12, 2023) (rejecting new arguments and evidence made in reply); Consolidated Trial Practice Guide at 74 (“It is also improper for a reply to present new evidence (including new expert testimony) that could have been presented in a prior filing ...”).

The few paragraphs that are cited in the Petition are far more expansive and specific than the arguments and generalizations in the Petition. For example, when discussing the reasonable expectation of success in combining the DuroMax XP4400EH Operator’s Manual (“DuroMax”), U.S. Patent No. 7,481,087 (“De Vries”), JPS61283734A (“Nakafushi”), and U.S. Patent No. 5,301,644 (“Olmr”) (Ground 2), the Petition states that “[g]iven the axial insertion of the key of De Vries into the safety systems 13, 14, a depressible switch would be a logical mechanism for coupling of the carburetor shutoff solenoid Nakafushi and Olmr to the selection mechanism of the first and second fuel sources.” Pet. at 52 (citing EX1003, ¶¶202-203). Nothing more. Yet in support of this single sentence, Petitioners cite two “paragraphs” that, together, cover *two full pages* of Dr. Winkel’s declaration. EX1003, pp. 110-111.

Tellingly, Dr. Winkel’s testimony in these two pages is far more specific than the Petition’s broad generalization. *Id.* Indeed, “each petition ... must include ... [a]

full statement of the reasons for the relief requested, including *a detailed explanation of the significance of the evidence.*” 37 C.F.R. § 42.22 (emphasis added). These declarative statements—which largely lack their own citations to the prior art references—are not found in the Petition and should not be used to circumvent page limits or to introduce new arguments not found in the Petition. *Syrinix, Inc. v. Blacoh Fluid Control*, IPR2018-00415, 2019 WL 2282188, at *21 (PTAB May 28, 2019) (“Allowing Petitioner to incorporate by reference the numerous additional arguments regarding motivation to combine from Dr. Lander’s Declaration would serve to circumvent the page limits imposed on petitions for *inter partes* review, while imposing on our time by asking us to sift through and address arguments the Petitioner did not believe were significant enough to include in the Petition. This is improper”).

4. Other Considerations – Petitioners are Burdening Board Resources

Petitioners are thwarting a principal goal of IPR: to serve as an efficient and alternative forum for the promotion of robust and predictable patent rights. *General Plastic Industrial Co., Ltd. v. Kaisha*, IPR2016-01357, Paper 19 at 15–16 (Sept. 6, 2017) (precedential). Here, the district court proceedings involve up to thirteen disputed patents across two related patent families. On May 16, Petitioners filed the present challenge against the ’101 Patent based on eight unpatentability grounds

requiring analysis of at least five references, all of which will need to be fully addressed in the FWD. July 29 Memo. Over the course of three months, and as of the date of the instant brief, Petitioners have filed six other IPR petitions implicating forty additional grounds.

Assuming Petitioners follow through with their promise to file IPR petitions against the six remaining asserted Champion patents on similar timelines as the first seven, this will amount to thirteen IPRs filed over 6–7 months, resulting in numerous different IPR schedules and a significant drain on the Board’s limited resources. This burden on the Board is especially unwarranted when four district courts are already tasked with resolving Firman’s and the Petitioners’ myriad system art-based §§102 and 103 grounds and §112 enablement and written description grounds.

Given a holistic view of the *Fintiv* factors and consistent with the Director’s mandate to ensure the PTAB complies “with pendency goals for *ex parte* appeals, its statutory deadlines for AIA proceedings, and other workload needs,” the Director should exercise discretion and deny institution.

III. THE DIRECTOR SHOULD EXERCISE DISCRETION TO DENY INSTITUTION UNDER SECTION 325(D)

The Board should deny institution under 35 U.S.C. § 325(d) because Petitioner relies solely on art and arguments that are the same or substantially the same as those considered by the Examiner during prosecution, and Petitioner has not

and cannot meet its burden to demonstrate material error by the Examiner. Under the two-part framework from *Advanced Bionics*, the PTAB must first determine whether the art or arguments were previously presented (step one), and, if so, whether the Office materially erred in allowing the claims (step two). *See, e.g., Advanced Bionics*, IPR2019-01469, Paper 6 at 10. The step two inquiry is guided by the non-exclusive factors articulated in *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (Dec. 15, 2017), which address how the Examiner evaluated the art, how the Petitioners' arguments differ from those made during prosecution, and whether other facts warrant reconsideration.

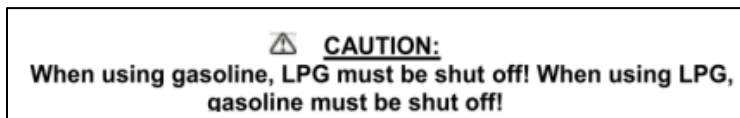
A. Petitioners' Art and Arguments are the Same and/or Substantially Similar to Those Considered by the Examiner

The Petition can be grouped into two sets of grounds: Grounds 1-2 asserting obviousness of all claims based on DuroMax as the primary reference; and Grounds 3-5 asserting anticipation and obviousness in view of Fujisawa. Pet. at 3. De Vries, Nakafushi, Olmr, and DuroMax are used as secondary references in Grounds 1-2 and 4-5. *Id.* Because each of these references is cumulative of prior art already considered by the Examiner, the first *Advanced Bionics* prong warrants denial of institution.

1. The Examiner Considered Substantially Similar Art to That Presented in Grounds 1-2

a. DuroMax is Substantially the Same as the Honda EU20i Video and Deutsch References Considered by the Examiner

The Petition relies on DuroMax as a primary obviousness reference for Grounds 1 and 2 and as a secondary obviousness reference in Grounds 4 and 5. Pet. at 3. Specifically, the Petition asserts DuroMax teaches a generator configured to run on gasoline or LPG that includes a manual gasoline shutoff valve. *Id.*, 5. LPG fuel is delivered via a hose and two pressure regulators—one on the hose and another mounted on-board the generator. EX1006 at 12. The gasoline tank is on-board the generator. *Id.*, 7. Petitioners also heavily rely on DuroMax for its disclosure that it is undesirable to use both fuel sources at the same time, arguing that “Duromax stresses the importance of shutting off each of the fuel sources before switching fuels” based on the following warning:



Pet. at 6. The Petition does not rely on DuroMax for any additional features or functions apart from those known and considered during examination of the '101 Patent.

Every feature relied on by Petitioners or otherwise taught by DuroMax is similarly taught by the YouTube Video of the Honda EU20i generator (“EU20i

Video”) that was cited in a November 22, 2019 IDS during examination of the ’101 Patent. EX1002, p. 63; EX2075; EX2076. The EU20i Video shows a gasoline and LPG fueled generator that utilizes two pressure regulators on the LPG hose. EX2075 at 4-8. It further includes an on-board gasoline tank with a manual gasoline shutoff. *Id.*, 1-2. In fact, in the EU20i Video, the operator manually turns off the gasoline before turning on the LPG fuel:



Id., 2-3 (annotation added)

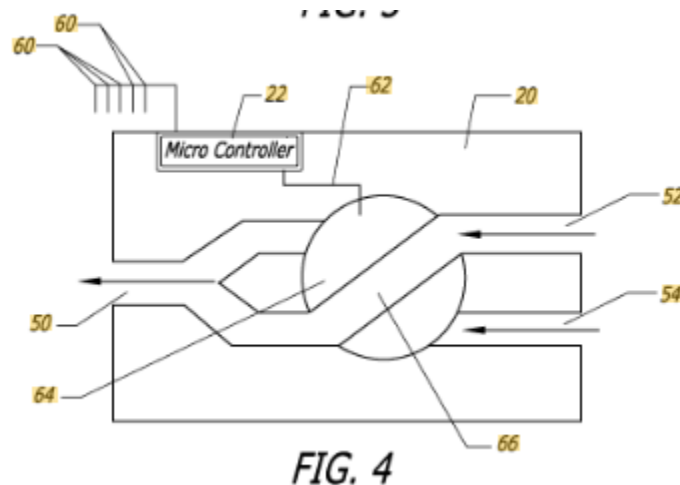
Like DuroMax, another reference cited in the November 22, 2019 IDS—U.S. Publication No. 2002/0134362 (“Deutsch”)—explains that having both fuels “on” is undesirable and can cause poor operating conditions such as flooding and stalling of the engine. *See* EX2060, [0010]. In sum, DuroMax fails to introduce any functionality or features that were not considered by the Examiner during prosecution.

b. Secondary Reference De Vries is Substantially Similar to U.S. Publication No. 2014/0202430 (“Monros”) Considered During Examination

The Petition relies on De Vries as a secondary reference in Grounds 1 and 2, and specifically for teaching a “safety interlock system” to prevent ‘undesired or even dangerous situations’ by ensuring correct order of operations.” Pet. at 37; *see also id.*, 36-42, 44-47, 49-53, 56, and 57. De Vries discloses a pipeline interlock system used in the petrochemical industry. EX1011, 5:25-27, FIGs. 1A-1C. A key unlocks or opens a first butterfly valve in a first pipeline and a second butterfly valve in a second pipeline. *Id.*, 5:31-53, FIGs. 1A-1C. De Vries attempts to prevent both butterfly valves from opening at the same time, with the same key. *Id.*, 5:53-62. This is accomplished by only allowing the key to be removed from a valve when the valve is in the closed position. *Id.*, 5:63-66. Thus, to use the key to open the second valve, the first valve must be closed. *Id.*, 5:63-6:4.

Such a device and functionality, however, was taught by Monros, cited in the November 22, 2019 IDS. EX1002, p. 62. Monros discloses a gasoline and propane fuel supply for an internal combustion engine. EX2061, Abstract. Fuel delivery is controlled by a rotating switch that selectively allows only one of gasoline or propane to flow at a time. EX2061, [0028]. Monros specifically discloses that “[r]egardless of mechanism used, the switch box 20 in any embodiment of the present invention will allow only one type of fuel to pass through at a time.” *Id.*

While Monros discloses using a microcontroller to control the rotating switch 64, it is also possible to manually control the switch: “The dual fuel system 10 may also be manually controlled.” *Id.*, [0030]. Monros further teaches “[t]he selector switch 78 enables the driver to override the automatic programming of the microcontroller 22 (see FIG. 4) and switch fuel sources on the fly.” *Id.* Since “the rotating switch 64 is configured to allow only one type of fuel through to the fuel supply line 50 at a time,” fuel will only flow through one of the gasoline supply line 52 or the propane supply line 54 to the engine’s fuel supply line 50, as illustrated in FIG. 4 reproduced below:



Id., [0027], Fig. 4. Both Monros and De Vries, therefore, are substantially similar because both teach a safety interlock device having two positions and prevents two fuel paths from being open at the same time.

c. Secondary Reference Nakafushi Is Substantially Similar to U.S. Patent No. 5,809,979 (“Kubota Patent”)

Nakafushi, a secondary reference asserted in Ground 2, is substantially similar to the Kubota Patent, also cited in the November 22, 2019 IDS. EX1002, p. 61. The Petition relies on Nakafushi as disclosing an engine configured to run selectively on gasoline or LPG, as well as a control valve downstream of the carburetor float chamber which prevents the float chamber from being emptied of gasoline when switching to LPG operation. Pet. at 12. Nakafushi explains the control valve operation prevents a rich air/fuel ratio by preventing both fuels from being delivered to the engine at the same time. EX1009, [0016].

The Kubota Patent discloses every element the Petition argues is taught by Nakafushi. *Compare* EX2062, FIG. 3 *with* EX1008, FIG. 1. Both references disclose an engine configured to run on either LPG or gasoline and that utilizes a fuel selector switch to electronically control an LPG valve and a gasoline valve on the carburetor downstream of the float bowl. *Compare* EX2062, 2:39-3:40 *with* EX1008, 4:23-6:20. Further, both references require the use of an LPG vaporizer—which the ’101 Patent does not—demonstrating these two references are closer to each other than to the ’101 Patent. *Id.* Nakafushi is thus substantially similar to the Kubota Patent.

d. Secondary Reference Olmr is Substantially Similar to U.S. Patent No. 3,384,059 (“Kopa”) and the Kubota Patent

The Petition relies on Olmr as a secondary reference in Ground 2, but Olmr is substantially similar to the Kubota Patent and Kopa, both of which were cited in the November 22, 2019 IDS. EX1002, pp. 60-62. Specifically, the Petition relies on Olmr for its disclosure of a solenoid valve within a carburetor float bowl of a as a mechanism for cutting off the fuel supply to the engine. Pet. at 13, 47, 49, 51-57, 72-81. Similarly, the Kubota Patent discloses a solenoid valve attached to a float bowl to cut off the supply of fuel when gasoline is not selected. EX2062, 3:14-27. Similarly, Kopa discloses an electrically-controlled, gasoline solenoid valve connected in the fuel line between the float chamber and the carburetor. EX2077, 12:58-74. Accordingly, neither Olmr nor a combination of Olmr with any other reference introduces anything new.

2. Substantially Similar Art to That Presented in Grounds 3-5 Was Considered by the Examiner

a. Fujisawa is Substantially Similar to Monros

The Petition asserts Fujisawa as an anticipatory reference in Ground 3 and as the primary reference in Grounds 4 and 5. Pet. at 3. Fujisawa discloses a fuel supplying device with a rotary knob that is adjusted with a wire by a pulley. EX1005, [0034]-[0036], FIG. 5. Rotating the rotary knob manipulates cams and followers to selectively open and close a propane valve and a butane valve to fuel

an internal combustion engine. *Id.*, [0037]-[0038]. Only one of the valves may open at a time. *Id.*

Similarly, Monros' rotating switch 64 only allows one of gasoline or propane to flow at a time, specifically disclosing, "Regardless of mechanism used, the switch box 20 in any embodiment of the present invention will allow only one type of fuel to pass through at a time." EX2061, [0028]. Monros' rotating switch 64 can be manually controlled with a selector switch 78 that "enables the driver to override the automatic programming of the microcontroller 22 (*see* FIG. 4) and switch fuel sources on the fly." *Id.*, [0030]. Since "the rotating switch 64 is configured to allow only one type of fuel through to the fuel supply line 50 at a time," fuel only flows through the gasoline supply line 52 or the propane supply line 54 to the engine's fuel supply line 50. *Id.*, [0027]. Fujisawa is substantially similar to Monros, and Fujisawa fails to introduce anything new that the Examiner failed to consider.

b. DuroMax, Nakafushi, and Olmr are Substantially Similar to Art Considered by the Examiner.

DuroMax, Nakafushi, and Olmr are asserted as secondary references in Grounds 4-5. Pet. at 3. As discussed above in Sections III.1.a, c-d, DuroMax, Nakafushi, and Olmr are substantially similar to the prior considered during examination.

In view of the above, the Office has already considered the same or essentially the same art and arguments as now presented in the Petition. Prong 1 of the *Advanced Bionics* framework thus weighs in favor of discretionary denial.

B. Petitioners Have Failed to Demonstrate Any Material Error by the Examiner

Upon satisfaction of Prong 1, the Board requires “a showing that the Office erred in evaluating the art...” *Advanced Bionics*, IPR2019-01469, Paper 6 at 8. Petitioners have not alleged any material defect or error of any kind that occurred during examination. While the Petition briefly discussed the prosecution history of the ’101 Patent (Pet. at 18-20), it does not raise any failure by the Office to consider any disclosure of the references cited during examination. Nor does the Petition attempt to show any of the references cited in the Petition disclose any new material that was not considered during examination. Accordingly, Prong 2 weighs heavily in favor of discretionary denial.

IV. CONCLUSION

Patent Owner respectfully requests the Director exercise discretion under Sections 314(a) and 325(d) to deny institution.

Case No. IPR2025-00951
Patent No. 10,598,101

Dated: August 18, 2025

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Case No. IPR2025-00951

Patent No. 10,598,101

CERTIFICATE OF WORD COUNT

The undersigned hereby certifies pursuant to 37 C.F.R. § 42.24(d) that the foregoing document includes, as indicated by the word count of the word-processing system used to prepare the document contains 13,997 words.

Date: August 18, 2025

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