

IPR2025-00951

U.S. Patent No. 10,598,101

IN THE 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

Issued: March 24, 2020

Title: DUAL FUEL SELECTOR SWITCH

Inter Partes Review No. IPR2025-00951

**PETITIONERS' PRELIMINARY REPLY TO THE PATENT OWNER
PRELIMINARY RESPONSE**

UPDATED EXHIBIT LIST

EX1001	U.S. Patent No. 10,598,101 (“the ’101 Patent”)
EX1002	File History for U.S. Patent No. 10,598,101 (“the ’101 File History”)
EX1003	Declaration of Dr. Eric S. Winkel
EX1004	JP2005330867 (Original) (“Fujisawa”)
EX1005	Certified Translation of JP2005330867 (“Fujisawa”)
EX1006	DuroMax XP4400EH Operator’s Manual (“DuroMax”)
EX1007	Declaration of David Raskin (dated May 7, 2025)
EX1008	JPS61283734A (Original) (“Nakafushi”)
EX1009	Certified Translation of JPS61283734A (“Nakafushi”)
EX1010	U.S. Patent No. 5,301,644 (“Olmr”)
EX1011	U.S. Patent No. 7,481,087 (“De Vries”)
EX1012	U.S. Patent No. 1,931,698 (“Holzapfel”)
EX1013	U.S. Patent No. 9,435,273 (“the ’273 Patent”)
EX1014	<i>Switch</i> , Merriam-Webster, https://www.merriam-webster.com/dictionary/switch (last updated Mar. 31, 2025)
EX1015	<i>Selector Switch</i> , Merriam-Webster, https://www.merriam-webster.com/dictionary/selector%20switch (last visited Apr. 8, 2025)
EX1016	<i>Switch</i> , Cambridge Dictionary, https://dictionary.cambridge.org/us/dictionary/english/switch (last visited Apr. 4, 2025)
EX1017	<i>Switch</i> , The Free Dictionary, https://www.thefreedictionary.com/switch (last visited Apr. 14, 2025)
EX1018	Rudolf F. Graf, Modern Dictionary of Electronics (Charlie Buffington & Jack Davis eds., Butterworth-Heinemann 6th ed. 1997) (1984)
EX1019	Tony Atkins & Marcel Escudier, Oxford Dictionary of Mechanical Engineering (2013)
EX1020	S.B. Chopra, Anmol’s Dictionary of Mechanical Engineering (1989)
EX1021	McGraw-Hill Dictionary of Mechanical and Design Engineering (Sybil P. Parker et al. eds., 1984)
EX1022	G.H.F. Naylor, Dictionary of Mechanical Engineering (rev. ed. 2006)
EX1023	Complaint, <i>Champion Power Equipment, Inc. v. Generac Power Systems, Inc.</i> , No. 24-cv-1281, Dkt. 1 (E.D. Wis., filed Oct. 9, 2024)

EX1024	<i>Powermate DF3500E – 3500 Watt Electric Start Dual Fuel Portable, Electric Generators Direct</i> , https://www.electricgeneratorsdirect.com/Powermate-6957-Portable-Generator/p72548.html (last visited Apr. 4, 2025)
EX1025	U.S. Patent No. 4,492,207 (“Hallberg”)
EX1026- EX1028	[intentionally omitted]
EX1029	Castell Safety Int’l Ltd., <i>Castell Interlocks: How They Work</i> , YouTube (Apr. 14, 2009), https://www.youtube.com/watch?v=CpNy6u5GssA
EX1030	Screenshots and Video Transcript of Castell Safety Int’l Ltd., <i>Castell Interlocks: How They Work</i> , YouTube (Apr. 14, 2009), https://www.youtube.com/watch?v=CpNy6u5GssA
EX1031	U.S. Patent No. 9,175,601 (“Markoski”)
EX1032	Ford Motor Co., 2004 Service Manual: Powertrain Control/Emissions Diagnosis: On Board Diagnostics Bi-Fuel LPG Truck (Aug. 2003)
EX1033	U.S. Patent No. 1,827,214 (“Sturm”)
EX1034	U.S. Patent No. 4,641,625 (“Smith”)
EX1035	U.S. Patent No. 6,276,345 (“Nelson”)
EX1036	U.S. Patent No. 2,645,570 (“Anderson”)
EX1037	U.S. Patent No. 2,945,111 (“McCormick”)
EX1038	Champion’s Infringement Contentions for U.S. Patent No. 10,598,101 as Asserted Against General Model DF3500E et al. (served Apr. 15, 2025)
EX1039	U.S. Patent No. 8,040,663 (“Czarnecki”)
EX1040	William A. Schuster, <i>Small Engine Technology</i> (2d ed. 1999)
EX1041	Neil B. Hampson & Jennette L. Zmaeff, <i>Carbon Monoxide Poisoning from Portable Electric Generators</i> , 28 Am. J. Preventive Med. 123 (2005)
EX1042	H. Windawi, <i>Controlling the Exhaust Emissions from Alternative Fuel Vehicles: New Opportunity for Platinum Metals Catalysts</i> , 36 Platinum Metals Rev. 185 (1992)
EX1043	Marty Ahrens, Nat’l Fire Prot. Ass’n, U.S. Vehicle Fire Trends and Patterns (2010)
EX1044	<i>Selector Switch</i> , The Free Dictionary https://www.thefreedictionary.com/selector+switch (last visited Apr. 14, 2025)

EX1045	Engineering Explained, <i>Why Cars Backfire - Afterfire - Explained</i> , YouTube (Feb. 13, 2013), https://www.youtube.com/watch?v=bgS3PA5r0vY
EX1046	Screenshots and Video Transcript of Engineering Explained, <i>Why Cars Backfire - Afterfire - Explained</i> , YouTube (Feb. 13, 2013), https://www.youtube.com/watch?v=bgS3PA5r0vY
EX1047	Shivansh Sabhadiya, <i>What Causes Backfire in an Engine?</i> , Engineering Choice, https://www.theengineeringchoice.com/what-causes-car-backfire/ (last visited Apr. 15, 2025)
EX1048	U.S. Patent No. 4,489,699 (“Poehlman”)
EX1049	U.S. Patent Application Publication No. 2007/0137591 (“Sugimoto”)
EX1050	Declaration on Mina Ching (dated Apr. 22, 2025)
EX1051	Champion’s Infringement Contentions for U.S. Patent No. 11,905,896 as Asserted Against General Model DF3500E et al. (served Apr. 15, 2025)
EX1052- EX1054	[intentionally omitted]
EX1055	Order on Defendant/Counter-Claimant’s Motion for Partial Stay, <i>FaceTec, Inc. v. iProov, Ltd.</i> , No. 21-cv-2252, Dkt. 188 (D. Nev., order dated June 18, 2025)
EX1056	Docket Navigator Statistics Regarding Judge Adelman’s Grant Rate for Motions to Stay
EX1057	Docket Navigator Statistics Regarding Grant Rate for Motions to Stay in Eastern District of Wisconsin
EX1058	Docket Navigator Statistics Regarding Motions to Stay in District of Nevada
EX1059	Declaration of Eric Huang (dated Sept. 12, 2025)
EX1060	Order, <i>Parsons Xtreme Golf LLC v. Taylor Made Golf Co.</i> , No. 17-cv-3125, Dkt. 187 (D. Ariz., order dated Nov. 29, 2018)
EX1061	Email from Taylor R. Stemler to Jennifer Hoekel et al. (Aug. 13, 2025)
EX1062	Docket Navigator Statistics Regarding Grant Rate for Uncontested Motions to Stay in Eastern District of Wisconsin
EX1063	Docket Navigator Statistics Regarding Grant Rate for Uncontested Motions to Stay in District of Nevada
EX1064	Docket Navigator Time to Trial Statistics for District of Nevada
EX1065	Docket Navigator Time to Milestone Statistics for Judge Adelman
EX1066	Docket Navigator Time to Milestone Statistics for Eastern District of Wisconsin

EX1067	Docket Navigator Time to Milestone Statistics for Central District of California
EX1068	First Amended Complaint, <i>Champion Power Equipment, Inc. v. Firman Power Equipment, Inc.</i> , No. 23-cv-2371, Dkt. 24 (D. Ariz. Mar. 29, 2024)
EX1069	Champion Power Equipment, Inc.’s Preliminary Infringement Contentions, <i>Harbor Freight Tools USA, Inc. v. Champion Power Equipment, Inc.</i> , No. 24-cv-8722 (C.D. Cal., served Apr. 24, 2025)
EX1070	Memorandum in Support of Plaintiff’s Motion to Sever Defendant’s Counterclaims for Infringement or in the Alternative for Leave to File an Amended Answer and Counter-Counterclaim, <i>Champion Power Equipment, Inc. v. Generac Power Systems, Inc.</i> , No. 24-cv-1281, Dkt. 38 (E.D. Wis. July 3, 2025)
EX1071	Answer and Counterclaim, <i>Champion Power Equipment, Inc. v. Firman Power Equipment, Inc.</i> , No. 23-cv-2371, Dkt. 13 (D. Ariz., answer filed Jan. 31, 2024)
EX1072	U.S. Patent No. 10,319,207 (“Janscha”)
EX1073	U.S. Patent No. 10,563,596 (“Wischadt”)
EX1074	U.S. Patent No. 10,862,414 (“Sarder”)
EX1075	Plaintiff’s Answer to Defendant Generac Power Systems, Inc.’s Amended Counterclaim, <i>Champion Power Equipment, Inc. v. Generac Power Systems, Inc.</i> , No. 24-cv-01281, Dkt. 31 (E.D. Wis. May 29, 2025)
EX1076	PatDocs Champion Patent Portfolio Overview
EX1077	Defendant Champion Power Equipment, Inc.’s Opening Markman Brief, <i>Harbor Freight Tools USA, Inc. v. Champion Power Equipment, Inc.</i> , No. 24-cv-8722, Dkt. 83 (C.D. Cal., Sept. 9, 2025)
EX1078	File History for U.S. Patent No. 10,221,780 (“the ’780 File History”)
EX1079	Excerpts from Champion Power Equipment, Inc.’s Objections and Answers to Generac Power Systems, Inc.’s Second Set of Interrogatories (served May 22, 2025)
EX1080	Champion Dual Fuel Generator Model 100153 Operator’s Manual

As authorized by the Board (EX3002), Petitioners file this Preliminary Reply to the Patent Owner Preliminary Response (“POPR”; Paper 13).

The DuroMax-De Vries combination is structurally and functionally equivalent to the preferred embodiment, presenting a strong case for invalidity. Patent Owner argues that the DuroMax-De Vries combination does not teach the claimed “at least one valve handle” nor “a selector switch,” but instead teaches multiple valve handles and multiple switches. But Patent Owner concedes in the parallel Harbor Freight litigation that “[t]he Federal Circuit has repeatedly determined, that within patent claims, the indefinite articles ‘a’ or ‘an’ are typically construed to signify ‘one or more.’” EX1077, 18 (citing *Baldwin Graphic Sys., Inc. v. Siebert, Inc.*, 512 F.3d 1338, 1342–43 (Fed. Cir. 2008)).¹ The ’101 Patent does not demonstrate any intent to deviate from the plain and ordinary meaning of “a” or “at least one.” Furthermore, “at least one valve handle” should not be construed to exclude the only embodiment disclosed in the specification.

¹ Unlike Patent Owner’s contradictory litigation position regarding the construction of other terms in its 2015 Patent Family, Petitioner Harbor Freight’s positions are consistent, as its construction of those terms is based on prosecution history estoppel rather than the plain and ordinary meaning of “a.”

A. The specification does not support Patent Owner’s construction of “at least one valve handle . . . mechanically coupled to the first fuel valve and the second fuel valve.”

Ordinarily, it is improper to “construe claims in a manner that would exclude the preferred embodiment, especially where it is the only disclosed embodiment.” *GE Lighting Sols., LLC v. AgiLight, Inc.*, 750 F.3d 1304, 1311 (Fed. Cir. 2014). By arguing that Claim 10 requires a single valve handle “‘mechanically coupled’ to *both* ‘the first fuel valve and the second fuel valve’” (POPR, 28), Patent Owner’s construction excludes its only embodiment. The specification discloses a first valve handle 34 mechanically coupled to only valve 36 and a second valve handle 38 mechanically coupled to only valve 40. Neither valve handle is mechanically coupled to the opposite valve. EX1001, 4:17–45, FIGS. 3, 5-6 (annotated below).

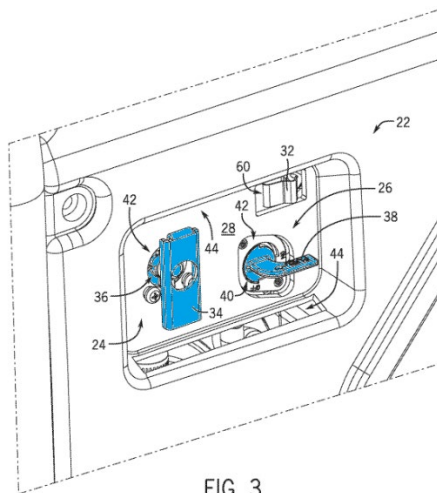


FIG. 3

While the valve handles 34, 38 are selectively covered by the described selector switch 30, Patent Owner already admitted that the valve handles in its corresponding commercial embodiment are not mechanically *coupled to* selector

switch 30. EX1078, 195–97; *see also* EX1079, 3, 29; EX1080, 6. Thus, any position that the selector switch somehow mechanically couples the valve handles to the opposite valves flies in the face of Patent Owner’s earlier arguments to the USPTO.

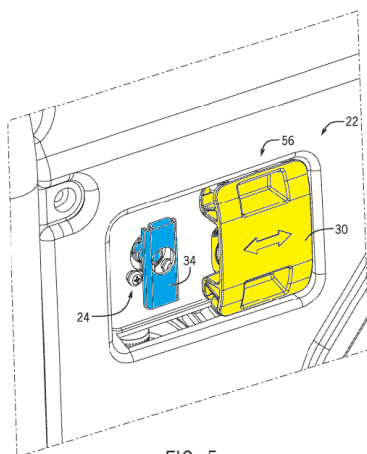


FIG. 5

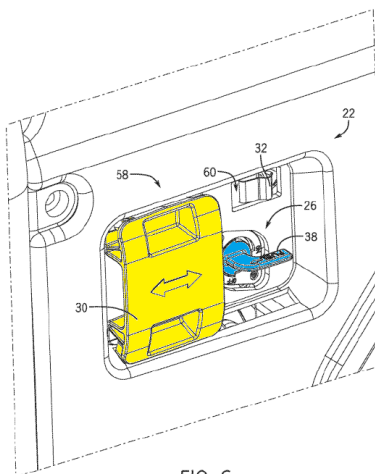


FIG. 6

Patent Owner’s arguments are further undercut by the rest of Element [10.4] (requiring the “at least one valve handle” to also “selectively open and close the first fuel valve and the second fuel valve”). During prosecution of the “closely related” U.S. Patent No. 10,221,780 (Paper 8, 8), Patent Owner admitted that actuation of either valve handle in the ’101 Patent embodiment does not open or close the opposite valve to control fuel flow in the opposite fuel line. EX1078, 195–97. Thus, the “at least one valve handle” of claim 10 should be interpreted as “one or more valve handles.” EX1001, Element [10.4].

The DuroMax-De Vries combination teaches the same structural and functional features as the preferred embodiment: two valve handles located on a generator, mechanically coupled and operatively connected to their respective

valves, and mechanically interlocked such that they cannot be simultaneously actuated. This is the exact configuration described in dependent Claims 12–15. Elements [10.2] and [10.4] should be construed to cover the preferred embodiment and functionally equivalent DuroMax-De Vries combination.

B. Patent Owner improperly imports a “single structure” requirement into Petitioners’ construction of “selector switch.”

Continuing the theme of its arguments relating to “valve handle,” Patent Owner unilaterally limits Petitioners’ proposed construction of “selector switch” to “a single component.” POPR, 25. This artificially imposed limitation has no support in the specification or the language of Petitioners’ construction. Regardless, Patent Owner admits that each “single component” itself constitutes a “selector switch.”

A single limitation “may be satisfied by multiple discrete components functioning together.” *Chamberlain Grp., Inc. v. Int’l Trade Comm’n*, No. 2020-1965, 2023 U.S. App. LEXIS 10273, at *14 (Fed. Cir. Apr. 27, 2023) (citing *Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1309 (Fed. Cir. 2005)). Thus, “a selector switch” means “a movable component” which may comprise multiple discrete subcomponents functioning together.

In the DuroMax-De Vries combination, safety systems 13 and 14 and key 17 are discrete subcomponents functioning together to form “a movable component whose positioning enables subsequent user selection of only one fuel source.” *See* EX1011, FIGS. 1A–1C. Patent Owner provides no justification for unilaterally

limiting Petitioners' construction to a single monolithic component.²

Furthermore, the use of the indefinite article “a” means “one or more” in the claim term “a selector switch” and Petitioners' construction “a movable component.” *Baldwin*, 512 F.3d at 1342–43. Patent Owner admits that safety systems 13 and 14 individually constitute selector switches even under Patent Owner's artificially constrained interpretation of Petitioners' construction. POPR, 25–26 (“De Vries discloses two separate switches”). Either such safety system 13/14 is a component movable between locked and unlocked positions “which separately enable[s] subsequent user actuation of valve 5 and valve 6.” *Id.* Similarly, key 17 on its own is a movable component whose positioning enables subsequent user actuation of only one fuel source. Patent Owner's attempt to differentiate the DuroMax-De Vries combination does not save the '101 Patent from invalidity. Either the safety systems 13 and 14 and key 17 are subcomponents that combine to form a single “selector switch,” or safety systems 13 and 14 and key 17 each constitute a “selector switch” and invalidate the claims of the '101 Patent.

² In attempting to argue that safety systems 13 and 14 and key 17 are not “a movable component” Patent Owner misapplies its own narrow interpretation of Petitioners' construction. Patent Owner admits that safety systems 13 and 14 constitute “two separate switches” (POPR, 26), but safety *systems* 13 and 14 themselves are components having many associated subcomponents. *See* EX1011, FIG. 4.

IPR2025-00951
U.S. Patent No. 10,598,101
Date: October 3, 2025

Respectfully submitted,

By: /Thomas J. Leach/

Thomas J. Leach
Registration No. 53,188
MERCHANT & GOULD P.C.
150 South Fifth Street, Suite 2200
Minneapolis, MN 55402
Counsel for Petitioner Generac
Lead Counsel for Co-Petitioners

By: /Michael R. Houston/

Michael R. Houston
Reg. No. 58,486
FOLEY & LARDNER LLP
321 N Clark Street, Suite 3000
Chicago, IL 60654
Counsel for Petitioner Harbor Freight

By: /Thomas A. Walsh/

Thomas A. Walsh
Registration No. 45,196
ICE MILLER LLP
One American Square, Suite 2900
Indianapolis, IN 46282-0200
Counsel for Petitioner MWE

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on October 3, 2025, a true and correct copy of the foregoing **PETITIONERS' PRELIMINARY REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE** was filed through the PTACTs system along with service to the email addresses listed below:

Joseph W. Staley
Email: j.staley@pkhip.com

Timothy J. Ziolkowski
Email: tjz@zpatents.com

Jacob M. Fritz
Email: jmf@zpatents.com

Scott P. Amy
Email: s.amy@pkhip.com

Thomas F. Finch
Email: t.finch@pkhip.com
Email: championlit@pkhip.com

Robyn Templin
Email: rlt@zpatents.com

Date: October 3, 2025

By: /Thomas J. Leach/

Thomas J. Leach
Registration No. 53,188
MERCHANT & GOULD P.C.
150 South Fifth Street, Suite 2200
Minneapolis, MN 55402
Counsel for Petitioner Generac
Lead Counsel for Co-Petitioners