

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,
Petitioner,

v.

CHAMPION POWER EQUIPMENT, INC.,
Patent Owner.

IPR2025-00951
Patent 10,598,101

**PATENT OWNER CHAMPION POWER EQUIPMENT, INC.'S
SUR-REPLY IN SUPPORT OF ITS PRELIMINARY RESPONSE**

Petitioner's footnotes are not double-spaced and violate 37 C.F.R. § 42.6(a)(2)(iii), presumably in an attempt to skirt the Board's page requirement. Moreover, Petitioner's arguments regarding indefinite articles and related litigation proceedings are a red herring. Reply, 1. For example, "at least one valve handle" may encompass multiple valve handles, but the one (or more) valve handles must be "mechanically coupled to the first fuel valve *and* the second fuel valve."

Valve Handle: Petitioner's DuroMax-De Vries combination does not disclose a "valve handle ... mechanically coupled to the first fuel valve *and* the second fuel valve." POPR, 26-28; EX1001, Cl. 10. Rather, at most, De Vries discloses a first handle coupled to a first valve, and a second handle coupled to a second valve. Pet., 37-41. Recognizing this deficiency, Petitioner now attempts to blatantly re-write Claim 10 to match the structure disclosed by the prior art. Reply, 4 ("Elements [10.2] and [10.4] should be construed to cover the preferred embodiment and functionally equivalent DuroMax-De Vries combination.").

But, Petitioner's proposed 11th-hour construction is contradicted by Claim 10 itself, which recites: "the at least one valve handle is mechanically coupled to the first fuel valve and the second fuel valve." EX1001, Cl. 10. Claim 10 *does not* recite two valve handles *respectively* coupled to the first and second fuel valves; rather, the Claim is clear that the handle (or handles) must be coupled to both the first and second fuel valves. And yet, Petitioner's proposed construction reads in the term

“respective” despite its clear *absence* in Claim 10. Reply, 3-4 (attempting to construe “Element [10.2] and [10.4]” as “two valve handles located on a generator, mechanically coupled and operatively connected to their *respective* valves”) (emphasis added). Petitioner’s proposed construction is wrong, and its belated attempt to construe the valve handle limitations was not present in the Petition and is waived. *Intelligent Bio-Systems, Inc. v. Illumina Cambridge, Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016).

In support, Petitioner cites *GE Lighting Solutions, LLC v. AgiLight, Inc.* for the proposition that the Federal Circuit “normally do[es] not construe claims in a manner that would exclude the preferred embodiment.” 750 F.3d 1304, 1311 (Fed. Cir. 2014); Reply at 2. But, the *very next* sentence limits the holding to instances “where claims can reasonably be interpreted to include a specific embodiment ... absent probative evidence on the contrary.” *Id.* (citing *Oatey Co. v. IPS Corp.*, 514 F.3d 1271, 1277 (Fed. Cir. 2008)) (cleaned up). In fact, “*Oatey* itself thus recognizes that we should not infer that any particular embodiment is included in a claim when there is probative evidence that sufficiently indicates the contrary.” *SIMO Holdings, Inc. v. H.K. uCloudlink Network Tech., Ltd.*, 983 F.3d 1367, 1378 (Fed. Cir. 2021).

Here, “there is probative evidence that sufficiently indicates” Patent Owner’s application of Claim 10 is proper. Not only is Patent Owner’s interpretation supported by the claim language itself, but the very configuration proposed by

Petitioner is recited by other claims in the same patent. *See, e.g.*, EX1001, Cl. 3 (reciting “a first valve handle coupled to the first fuel valve” and “a second valve handle coupled to the second fuel valve”). Had Patent Owner intended to claim Petitioner’s proposed “respective” configuration, it would have done so. Petitioner cannot now re-write the plain meaning of Claim 10 to suit its own purposes.

Simply put, “*Oatey* is not a panacea, requiring all claims to cover all embodiments. Instead, courts must recognize that disclosed embodiments may be within the scope of other allowed but unasserted claims.” *PSN Illinois, LLC v. Ivoclar Vivadent, Inc.*, 525 F.3d 1159, 1166 (Fed. Cir. 2008). Claim 10 is clear on its face, and De Vries *does not* disclose the claimed valve handle. The Board “must not allow the disclosed embodiment to ‘outweigh the language of the claim.’” *Rolls-Royce, PLC v. United Technologies Corp.*, 603 F.3d 1325, 1334 (Fed. Cir. 2010).

Selector Switch: Independent Claims 1, 17, and 18 each recite “a selector switch” with a variety of features. Petitioner explicitly construed “selector switch” as “a movable component whose positioning enables subsequent user selection of only one fuel source.” Pet., 22. In offering this construction, Petitioner intentionally chose to define the claimed “selector switch” as “a movable component,” *not* as “one or more movable components.” *Id.* Patent Owner explained that the DuroMax-De Vries combination does not disclose the claimed “selector switch” under Petitioner’s proposed construction because “safety systems 13 and 14 and key 17” are not “a

movable component” or a “switch.” Pet., 23-26. In Reply, “[r]ather than explaining how its original petition was correct,” Petitioner advances two “subsequent arguments [which] amount to ... entirely new theor[ies] of prima facie obviousness absent from the petition. Shifting arguments in this fashion is foreclosed by statute, our precedent, and Board guidelines.” *Wasica Fin. GmbH v. Cont’l Auto. Sys.*, 853 F.3d 1272, 1286 (Fed. Cir. 2017) (citing 35 U.S.C. § 312(a)(3)).¹

First, Petitioner proposes broadening its construction to also encompass “discrete subcomponents functioning together,” even where those “discrete subcomponents” are distinct structures (a key and two lock mechanisms) which *are not* mechanically coupled to each other at all. Reply, 4-5. But, Petitioner provides no authority to support (1) its attempt to *broaden* its original construction on Reply, or (2) its proposed construction of “selector switch” as including multiple, unconnected locks and keys. To be clear, Patent Owner *does not dispute* that the term “a selector switch” reasonably encompasses “one or more” selector switches, or that a “selector switch” may include subcomponents. Reply, 5 n.2. But, the ’101 Patent envisions and claims a “selector switch” with multiple features, *not* a variety of disparate locks

¹ Neither new theory, however, resolves Petitioner’s failure to explain why a POSITA would have been motivated to combine the petrochemical pipeline valves disclosed by De Vries with the DuroMax generator. POPR, 21-23.

and keys, which each (allegedly) disclose *some* of the claimed features. Petitioner attempted (unsuccessfully) to construe “selector switch” to embody De Vries’ various locks and keys. But, even under Petitioner’s construction, De Vries’ teaching of disparate locks and keys *does not disclose* one (or more) selector switches.

Second, Petitioner revises its invalidity theory to separately identify each of “safety systems 13 and 14 and key 17” as the claimed “selector switch.” Reply, 5. In addition to being untimely, neither safety system 13 or 14 (nor key 17) alone “enable[] subsequent user selection of only one fuel source” based on their positioning, and therefore cannot be a “selector switch.” For example, safety system 13 has no impact on actuation of valve 6, and safety system 14 does not impact valve 5. Key 17 is just a key—without a corresponding lock it does not do anything.

To resolve this, Petitioner incorrectly conflates the claimed “selector switch” with the mechanical structure “switch” to argue that Patent Owner “admits that each ‘single component’ itself constitutes a ‘selector switch.’” Reply, 4-5. Not so. POPR, 25-26 (“De Vries discloses two *separate switches*, which ... are not a ‘*selector switch*.’”). In fact, Patent Owner explicitly challenged whether “a key/lock mechanism constitutes a ‘switch’ under the plain and ordinary meaning of the term.” POPR, 26 n.6. Under Petitioner’s proposed construction, the “selector switch” must still “enable[] subsequent user selection of only one fuel source.” Safety systems 13, 14, and key 17 (individually) do not do so, and are therefore not “selector switches.”

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