**UNITED STATES DISTRICT COURT**
**EASTERN DISTRICT OF WISCONSIN**

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|---|---|
| CHAMPION POWER EQUIPMENT, INC.<br><br>Plaintiff/Counterclaim Defendant, | |
| v. | Case No. 24-cv-1281 |
| GENERAC POWER SYSTEMS, INC.<br><br>Defendant/Counterclaim Plaintiff. | **DEFENDANT/COUNTERCLAIM PLAINTIFF'S SUPPLEMENTAL PRELIMINARY INVALIDITY CONTENTIONS**<br><br>**CONTAINS MATERIAL DESIGNATED HIGHLY CONFIDENTIAL – ATTORNEYS' EYES ONLY** |

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## I. INTRODUCTION

Pursuant to the Amended Scheduling Order (Dkt. 59), Defendant/Counterclaim Plaintiff Generac Power Systems, Inc. ("Generac") hereby discloses its Supplemental Preliminary Invalidity Contentions. Plaintiff/Counterclaim Defendant Champion Power Equipment, Inc. ("Champion") has asserted infringement of U.S. Patent No. 10,221,780 ("the '780 Patent"); U.S. Patent No. 10,598,101 ("the '101 Patent"); U.S. Patent No. 10,697,398 ("the '398 Patent"); U.S. Patent No. 11,143,120 ("the '120 Patent"); U.S. Patent No. 11,143,145 ("the '145 Patent"); U.S. Patent No. 11,306,667 ("the '667 Patent"); U.S. Patent No. 11,492,985 ("the '985 Patent"); U.S. Patent No. 11,530,654 ("the '654 Patent"); U.S. Patent No. 10,840,970 ("the '970 Patent"); U.S. Patent No. 11,905,895 ("the '895 Patent"); and U.S. Patent No. 11,905,896 ("the '896 Patent") (collectively "the Asserted Patents"). Specifically, Champion has asserted infringement of Claims 1, 2, 6, 7, 8, 9, 11, 14, and 15 of the '780 Patent; Claims 1, 2, 8, 9, 18, and 19 of the '101 Patent; Claims 1, 3, 4, 5, 6, 7, 19, 20, 22, 43, 44, 56, 57, and 58 of the '398 Patent; Claim 12 of the '120 Patent; Claims 1, 2, 3, 4, 5, 6, 7, 10, 11, 13, and 14 of the '145 Patent; Claims 1, 2, 3, 4, 5, 6, 7, 8, and 9 of the '667 Patent; Claims 16 and 17 of the '985 Patent; Claims 6, 7, and 9 of the '654 Patent; Claims 1, 2, 4, 5, 11, 20, 21, 22, 23, 26, 27, and 33 of the '970 Patent; Claims 1, 2, 6, 7, 8, 12, 13, 14, 15, and 21 of the '895 Patent; Claims 7, 8, 14, 15, 16, 30, 31, 32, 34, 35, 36, 37, and 38 of the '896 Patent (collectively "the Asserted Claims"). Generac's Supplemental Preliminary Invalidity Contentions, including claim chart Exhibits A-01–A-15; B-01–B-20, D-01–D-15; E-01–E-18; F-01–F-19; G-01–G-20; H-01–H-20; I-01–I-15; J-01–J-25; K-01–K-25; and M-01–M-25, and supporting Exhibits 1-86 (collectively, "Invalidity Contentions") demonstrate that each of the Asserted Claims are invalid under 35 U.S.C. §§ 101, 102, 103, and/or 112.[1] Generac provides its

[1] The Supplemental Preliminary Invalidity Contentions incorporate by reference the exhibits served alongside the Preliminary Invalidity Contentions on August 22, 2025, including claim chart



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Supplemental Preliminary Invalidity Contentions for the Asserted Claims and specifically reserves the right to further supplement revise, and/or amend these Supplemental Preliminary Invalidity Contentions to account for the addition or withdrawal of claims that Champion may be permitted or required to make, any rulings on claim construction, and/or any discovery or evidence uncovered in the case.

## II. GENERAL RESERVATION

Generac's Supplemental Preliminary Invalidity Contentions are subject to the reservations stated herein and to revision, supplementation, and amendment as provided in Rule 26(e) of the Federal Rules of Civil Procedure, the Scheduling Order, the Local Rules, the Court's claim constructions, analyses and opinions of expert witnesses concerning claim construction, infringement, invalidity, and unenforceability issues, and any position that Champion takes concerning any of the foregoing.

Generac's Supplemental Preliminary Invalidity Contentions are based on information reasonably and presently available to Generac and are based on prior art located after a reasonable search and without discovery from Champion. Generac expressly reserves its right to amend these Supplemental Preliminary Invalidity Contentions should Champion provide any information that it failed to provide in its disclosures, change its positions, or should Champion amend its disclosures in any way. Furthermore, because discovery is ongoing, Generac reserves its right to revise, amend, and/or supplement the information provided herein, including by identifying, charting, and relying on additional references, as information becomes available during discovery.

Prior art not included in these Supplemental Preliminary Invalidity Contentions, whether presently known or not known to Generac, may become relevant. For example, Generac may

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Exhibits A-01–A-09; B-01–B-18, D-01–D-15; E-01–E-18; F-01–F-15; G-01–G-20; H-01–H-15; I-01–I-09; J-01–J-25; K-01–K-25; and M-01–M-25, and supporting Exhibits 1-86.



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receive, either via informal request or pursuant to subpoena, documents from third parties who are believed to have knowledge, documentation, and/or corroborating evidence concerning prior art listed herein and/or additional prior art. These third parties include, as applicable and without limitation, the authors, inventors, assignees, and/or licensees of the prior art references listed in these disclosures. If and to the extent Champion contends any limitations of the Asserted Claims are not disclosed in the prior art identified herein, Generac reserves its right to identify other portions or references that disclose and/or render obvious both any such allegedly missing limitations of any claims and those claims as a whole. Generac reserves all rights to rely on any reference found in the prosecution history of the applications leading to the Asserted Patents, including where Champion takes positions inconsistent with positions taken before the U.S. Patent and Trademark Office ("USPTO").

Generac offers these Supplemental Preliminary Invalidity Contentions without prejudice to any position Generac may ultimately take as to any claim construction issues not yet decided by the Court. Generac's Supplemental Preliminary Invalidity Contentions are based on Generac's present understanding of the Asserted Claims prior to claim construction by the Court and in view of the apparent claim constructions Champion is asserting in view of Champion's Infringement Contentions. Nothing herein should be construed or represented as evidencing any express or implied agreement with any of Champion's claim construction or infringement positions. Generac expressly reserves its right to contest such claim constructions. Generac further makes these Supplemental Preliminary Invalidity Contentions in the alternative and specifically reserves the right to take inconsistent and alternative positions at this early stage of the discovery process and before the claim construction process has completed and before the Court's claim construction order is issued.



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Generac further intends to rely on admissions concerning the scope of the prior art relevant to the Asserted Patents found in, *inter alia*: the patent prosecution history of the Asserted Patents and any related patents and/or patent applications; any deposition testimony of the named inventors of the Asserted Patents and any related patents and/or patent applications; and the papers filed and any evidence submitted by Champion in connection with this action or any other action in which the Asserted Patents have been, are, or will be at issue. Generac's claim charts cite to particular teachings and disclosures of the prior art as applied to features of the Asserted Claims. However, a person having ordinary skill in the art ("POSA") generally may view an item of prior art in the context of other publications, literature, products, and understanding. As such, the cited portions are only examples, and Generac reserves its right to rely on uncited portions of the prior art references and on other publications, expert testimony, and other evidence as aids in understanding and interpreting the cited portions, as providing context thereto, and as additional evidence that the prior art discloses a claim limitation or any of the Asserted Claims as a whole. Generac further reserves its right to rely on uncited portions of the prior art references, other publications, and testimony, including expert testimony, to establish bases for combinations of certain cited references that render the Asserted Claims obvious.

The references discussed in the claim charts may disclose the elements of the Asserted Claims explicitly and/or inherently, and/or they may be relied upon to show the state of the art in the relevant time frame. Any obviousness combinations are provided in addition and in the alternative to Generac's anticipation contentions and are not to be construed as an admission or suggestion that any reference included in the combinations does not by itself anticipate.

Generac reserves its right to challenge any terms of any Asserted Claims under 35 U.S.C. § 112 beyond the grounds outlined herein, especially in view of any of Champion's positions taken



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in claim construction, including by arguing that they are indefinite, not supported by the written description, or not enabled. Nothing stated herein shall be construed as a waiver of any argument available under 35 U.S.C. §§ 101, 102, 103, and/or 112.

## III. IDENTIFICATION OF PRIOR ART

Subject to Generac's reservation of rights herein, Generac identifies the prior art of which it is presently aware, appreciates the significance of given the state of discovery, and that individually or in combination(s) invalidates the Asserted Claims of the Asserted Patents and evidences the state of the art as of the earliest alleged priority date of the Asserted Patents. Generac's identification of prior art is based on Generac's present understanding of the Asserted Claims and any claim constructions expressed or implied in Champion's Infringement Contentions.

### A. Priority Date of the Asserted Patents

The Asserted Patents and associated asserted claims have the following priority dates:

| Champion Patent Nos. | Patent Priority Date |
|---|---|
| 10,221,780 | June 12, 2015 |
| 10,598,101 | November 1, 2013 |
| 10,697,398 | October 28, 2015 |
| 11,143,120 | October 28, 2015 |
| 11,143,145 | October 28, 2015 |
| 11,306,667 | November 1, 2013 |
| 11,492,985 | June 12, 2015 |
| 11,530,654 | June 12, 2015 |
| 11,840,970 | June 12, 2015 |
| 11,905,895 | June 12, 2015 |
| 11,905,896 | November 1, 2013 |

### B. Prior Art

Generac hereby identifies the following prior art with public availability and/or effective filing dates before the Critical Date that Generac relies on in its Supplemental Preliminary Invalidity Contentions.



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These contentions and interrogatories are within the possession, custody, and control of Champion. By reserving the right to rely on such disclosures, Generac makes no admission as to the proffered claim constructions or characterizations of the prior art. To the extent appropriate, Generac relies on these disclosures in addition to the grounds identified in Subsections IV.C and IV.D, *supra.*

## V. INVALIDITY UNDER 35 U.S.C. § 112

Generac hereby identifies the bases for its contention that the Asserted Claims of the Asserted Patents are invalid under 35 U.S.C. § 112. Generac expressly reserves its right to amend these contentions based on any claim constructions decided by the Court. Notwithstanding the foregoing, nothing in these contentions shall be construed so to limit or foreclose any position Generac takes with respect to claim construction.

### A. 35 U.S.C. § 112(a) (Lack of Enablement and Failure to Satisfy Written Description)

35 U.S.C. § 112(a) states that "[t]he specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention." This provides the statutory basis for both the enablement requirement and the written description requirement for a patent.

The **enablement requirement** requires that the patent specification "enable the full scope of the invention as defined by its claims," allowing for "a reasonable amount of experimentation." *Amgen Inc. v. Sanofi*, 598 U.S. 594, 610-612 (2023); *see also Baxalta Inc. v. Genentech, Inc.*, 81 F.4th 1362, 1364-65 (Fed. Cir. 2023). "In other words, 'the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation.'" *Baxalta*, 81 F.4th at 1365 (quoting *MagSil Corp. v. Hitachi Glob. Storage*



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*Techs., Inc.*, 687 F.3d 1377, 1380 (Fed. Cir. 2012)). Factors to be considered when evaluating whether there is undue experimentation include: 1) the quantity of experimentation necessary, 2) the amount of direction or guidance presented, 3) the presence or absence of working examples, 4) the nature of the invention, 5) the state of the prior art, 6) the relative skill of those in the art, 7) the predictability or non-predictability of the art, and 8) the breadth of the claims. *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988).

The **written description** requirement is a separate requirement from enablement under Section 112(a). *See Ariad Pharms., Inc. v. Eli Lilly and Co*., 598 F.3d 1336 (Fed. Cir. 2010) (en banc). The written description requirement requires that the patent specification objectively demonstrate that the applicant actually invented (i.e., was in possession of) the subject matter recited in the claims of the patent. *See id.* at 1349-51. The test for sufficiency of written description is whether the specification reasonably conveys to those of ordinary skill in the art that the inventor had possession of the claimed subject matter as of the filing date of the application for the patent. *Id.* "[T]he level of detail required to satisfy the written description requirement varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology. *Id.* at 1351 (citing *Capon v. Eshhar*, 418 F.3d 1349, 1357-58 (Fed. Cir. 2005)).

There are numerous claim terms or phrases recited in the Asserted Patents that fail to meet either the enablement or written description requirements. This is because the specifications of the Asserted Patents provided limited or no disclosure related to these claim terms or phrases such that they do not (1) teach one of ordinary skill in the art how to make and use the full scope of the claims without undue experimentation or (2) provide a written description that would allow ordinary skill in the art to conclude that the inventors were in possession of the claimed inventions as of the filing date of each patent. As such, the identified claims of the Asserted Patents (and any



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claims depending from them) are invalid as not enabled under 35 U.S.C. § 112(a) for reasons set forth below.

Generac's assertions of lack of enablement or written description are based on its understanding of the claim construction on which Champion relies. Generac expressly reserves the right to amend its contentions in this regard should Champion proffer claim constructions affecting additional claim elements. Further, Generac reserves the right to proffer claim constructions that differ from those which Generac understands Champion to proffer.

Further, to the extent appropriate, Generac relies on any enablement or written description arguments raised in the Invalidity Contentions served by Firman Power Equipment, Inc. ("Firman") in *Champion Power Equipment, Inc. v. Firman Power Equipment, Inc.*, No. 2:23-cv-02371-DWL (D. Ariz). In addition, to the extent appropriate, Generac relies on any enablement or written description arguments raised in the Invalidity Contentions served by Harbor Freight Tools USA, Inc. ("Harbor Freight") in either *Harbor Freight Tools USA, Inc. v. Champion Power Equipment, Inc.*, No. 2:24-cv-8722 (C.D. Cal.) or *Champion Power Equipment, Inc. v. Harbor Freight Tools USA, Inc.*, No. 2:24-cv-1302 (E.D. Wis.). Moreover, to the extent appropriate, Generac relies on any enablement or written description arguments raised in any Invalidity Contentions served by Westinghouse Electric Corp. ("Westinghouse") in *Champion Power Equipment, Inc. v. Westinghouse Elec. Corp. et al.*, No. 2:25-cv-00844 (D. Nev.), *Champion Power Equipment, Inc. v. Westinghouse Elec. Corp. et al.* No. 3:25-cv-00239 (D. Nev.), or any other lawsuit by Champion asserting the Asserted Patents against one or of the same defendants for example as a result of the pending motion to transfer or change venue. By reserving the right to rely on such disclosures, Generac makes no admission as to the proffered claim constructions by any of the third parties.



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The claims that contain the following limitations, and any claims that depend from them, are invalid for failing to meet the enablement or written description requirements:

1. "Valve assembly fluidly connected to each of a first fuel source and a second fuel source" ('101 Patent, Claims 1 and 18; '667 Patent, Claim 1)

   or

   "Valve assembly fluidly couplable to each of a first fuel source and second fuel source" ('896 Patent, Claims 7, 15 and 30)

The patents fail to enable one of ordinary skill in the art to make and use the claimed valve assembly without undue experimentation. The specification of the patents does not describe or enable a single valve assembly fluidly connected to both a first fuel source and a second fuel source. Instead, the specification discloses two separate valve assemblies, each fluidly connected to a single fuel source.

For the same reason, the patents do not provide an adequate written description of this claim element, and consequently, one of ordinary skill in the art would conclude that the inventors did not have possession of the claimed invention as of the filing date.

2. "Wherein the valve assembly comprises: a first fuel valve having open and closed positions to selectively control the first fuel flow to the engine; and a second fuel valve having open and closed positions to selectively control the second fuel flow to the engine" ('101 Patent, Claims 1 and 18; '667 Patent, Claim 3; '896 Patent, Claim 32)

   or



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"The valve assembly comprising: a first mechanical fuel valve having open and closed positions to selectively control the first fuel flow to the engine; and a second mechanical fuel valve having open and closed positions to selectively control the second fuel flow to the engine" ('896 Patent, Claim 7)

The patents fail to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. The specification of the patents does not describe or enable a single valve assembly comprising both a first fuel valve (mechanical or otherwise) and a second fuel valve (mechanical or otherwise). Instead, the specification discloses two separate valve assemblies, each comprising a single fuel valve.

For the same reason, the patents do not provide an adequate written description of this claim element, and consequently, one of ordinary skill in the art would conclude that the inventors did not have possession of the claimed invention as of the filing date.

3. "Wherein the valve assembly comprises: two fuel inputs…; and two fuel outputs…" ('101 Patent, Claim 18; '667 Patent, Claim 1)

   or

   "The valve assembly comprising: two fuel inputs…; and two fuel outputs" ('896 Patent, Claim 30)

The patents fail to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. The specification of the patents does not describe or enable a single valve assembly comprising two fuel inputs and two fuel outputs. Instead, the specification discloses two separate valves, each comprising one fuel input and one fuel output.



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For the same reason, the patents do not provide an adequate written description of this claim element, and consequently, one of ordinary skill in the art would conclude that the inventors did not have possession of the claimed invention as of the filing date.

4. "At least one valve handle mechanically coupled to the first fuel valve and the second fuel valve to selectively open and close the first fuel valve and the second fuel valve responsive to actuation thereof so as to enable the first fuel flow to the engine or the second fuel flow to the engine" ('896 Patent, Claim 15)

The '896 Patent fails to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. The specification does not describe a single valve handle mechanically coupled to both fuel valves such that a single valve handle can open and close both fuel valves. Instead, the specification describes two separate valve handles, each mechanically coupled to a single fuel valve. Each fuel valve opens and closes responsive to actuation only of its respective valve handle.

For the same reason, the patent does not provide an adequate written description of this claim element, and consequently, one of ordinary skill in the art would conclude that the inventors did not have possession of the claimed invention as of the filing date.

5. "Selector switch" ('101 Patent, Claims 1 and 18; '667 Patent, Claim 1; '896 Patent, Claims 7 and 30)

The patents fail to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. The claims and specification of the patents does not describe or enable a plain-and-ordinary meaning of "selector switch," under Champion's apparent



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construction (a switch that effectuates a selection). Instead, the specification discloses only a selector switch that enables a user to take a subsequent action that itself effectuates a selection.

For the same reason, the patents do not provide an adequate written description of this claim element, and consequently, one of ordinary skill in the art would conclude that the inventors did not have possession of the claimed invention as of the filing date.

6. "Carburetor Solenoid" ('667 Patent, Claim 6; '896 Patent, Claim 36)

The patents do not provide an adequate written description of this claim element, and consequently, one of ordinary skill in the art would conclude that the inventors did not have possession of the claimed invention as of the filing date. The specification of the patents states that a solenoid "shuts off fuel flow to the carburetor" when activated. (*See* '667 Patent, Col. 6:61-64; '896 Patent, Col. 6:62-65.) Thus, the solenoid described in the specification shuts off fuel flow before it reaches the carburetor and is not a solenoid integrated into the carburetor to shut off fuel flow within the carburetor by, for example, blocking the fuel passage between the float bowl and throat. Further, the Figures do not provide written description support because they do not depict the carburetor solenoid.

7. "A mechanical fuel valve actuatable between a first position and a second position to selectively control fuel flow to the dual fuel engine from a first fuel source through a first fuel line and a second fuel source through a second fuel line" ('970 Patent, Claim 1; '780 Patent, Claims 1 and 15; '895 Patent, Claims 1 and 8)

or



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"Wherein the mechanical fuel valve is configured to: provide liquid fuel from a liquid fuel tank of the first fuel source to the dual fuel engine while in the first position, and provide gaseous fuel from a pressurized fuel container of the second fuel source to the dual fuel engine while in the second position" ('895 Patent, Claims 7 and 13)

or

"A mechanical fuel valve actuatable between a first position and a second position to selectively control fuel flow to the dual fuel generator from the liquid fuel source through the liquid fuel line and the pressurized fuel source through the gaseous fuel line" ('970 Patent, Claim 20; '654 Patent, Claim 6; '895 Patent, Claim 14)

or

"Coupling a mechanical fuel valve to the internal combustion engine actuatable between a first position and a second position to selectively control fuel flow to the internal combustion engine from the first fuel source through a first fuel line and the second fuel source through a second fuel line" ('780 Patent, Claim 8)

The patents fail to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. The specification of the patents does not disclose or enable a single mechanical fuel valve that selectively controls fuel flow from both the first and second fuel sources along distinct fuel lines. Instead, the specification discloses mechanical fuel valve(s) that control fuel flow from only one fuel source along only one fuel line.

For the same reason, the patents do not provide an adequate written description of this claim element, and consequently, one of ordinary skill in the art would conclude that the inventors did not have possession of the claimed invention as of the filing date.



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8. "A mechanical fuel valve actuatable between a first position and a second position to selectively control fuel flow to the dual fuel generator from the liquid fuel source through the liquid fuel line and the pressurized fuel source through the gaseous fuel line" ('970 Patent, Claim 20; '654 Patent, Claim 6)

or

"Wherein mechanical fuel valve opens and closes the liquid fuel line to selectively control fuel flow from the liquid fuel source to the dual fuel generator" ('970 Patent, Claims 4 and 26; '654 Patent, Claim 6)

The patents fail to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. The specification of the patents describes a liquid fuel source located "onboard" the generator. (*See* '970 Patent, Col. 4:57-60; '654 Patent, Col. 4:9-12). As such, the liquid fuel does not flow from a liquid fuel source through a liquid fuel line to the generator. Thus, the specification does not describe or enable a mechanical fuel valve that selectively controls fuel flow from the liquid fuel source through the liquid fuel line to the generator.

For the same reason, the patents do not provide an adequate written description of this claim element, and consequently, one of ordinary skill in the art would conclude that the inventors did not have possession of the claimed invention as of the filing date.

9. "The dual fuel generator and fuel delivery system of claim 20 wherein the pressurized fuel source is independent and disconnected from the dual fuel generator." ('970 Patent, Claim 21)



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or

"The dual fuel generator and fuel delivery system of claim 21 wherein the fuel regulator system is disconnected from the dual fuel generator." ('970 Patent, Claim 22)

or

"The dual fuel generator and fuel delivery system of claim 21 wherein the primary pressure regulator is disconnected from the pressurized fuel source." ('970 Patent, Claim 23)

The patents fail to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. The specification of the patents does not describe or enable a mechanical fuel valve that selectively controls fuel flow from the pressurized fuel source through the gaseous fuel line when the pressurized fuel source, fuel regulator system, and/or generator are disconnected.

For the same reason, the patents do not provide an adequate written description of this claim element, and consequently, one of ordinary skill in the art would conclude that the inventors did not have possession of the claimed invention as of the filing date.

10. "A liquid fuel valve positioned along a liquid fuel line coupling the liquid fuel source to the carburetor; a gaseous fuel valve positioned along a gaseous fuel line coupling the gaseous fuel source to the carburetor" ('398 Patent, Claim 1)

Or



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"A liquid fuel valve along a liquid fuel line coupling the liquid fuel source to the carburetor; and a gaseous fuel valve along a gaseous fuel line coupling the gaseous fuel source to the carburetor." ('145 Patent, Claim 2)

The patents fail to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. First, the specification of the patents does not describe or enable both a liquid fuel valve coupling the liquid fuel source to the carburetor and a gaseous fuel valve coupling the gaseous fuel source to the carburetor at the same time. To the extent "coupling" refers to fluid coupling, only one fuel source is coupled to the carburetor at a time. To the extent "coupling" refers to physical coupling, the fuel sources are not simultaneously coupled to the carburetor if the gaseous fuel source is disconnected. Moreover, if the gaseous fuel source is connected, the switch cannot change operation between gaseous fuel and liquid fuel, which means the carburetor is not connected to the liquid fuel source.

Second, the specification does not describe or enable a gaseous fuel valve positioned along the gaseous fuel line. Rather, the specification describes a quick-connect hose coupling located in front of the fuel line. To the extent the quick-connect hose coupling described in the specification is covered by the claim, the specification does not enable the full scope of the claim, which includes a gaseous fuel valve located anywhere along the fuel line.

11. "Fuel lockout apparatus" ('780 Patent, Claims 1, 8 and 15; '654 Patent, Claim 6; '970 Patent, Claims 4 and 26; '895 Patent, Claim 1)

The patents fail to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. "Fuel lockout apparatus" is a means-plus-function term, and it should be limited to the structure (58) disclosed in the specification of the patents. Further,



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the specification does not disclose a structure that performs all of the claimed functions. To the extent "fuel lockout apparatus" is not a means-plus-function term, and to the extent Champion construes the claimed "fuel lockout apparatus" to cover embodiments other than structure (58), then the specification does not describe or enable the full scope of this claim.

12. "Wherein the mechanical fuel lockout switch communicates the first fuel source to the dual fuel engine and prevents communication between the second fuel source and the dual fuel engine when the mechanical fuel valve is in the first position, and communicates the second fuel source to the dual fuel engine and interrupts the first fuel source communication with the dual fuel engine when in the second position" ('780 Patent, Claims 1 and 15)

    or

    "Wherein when the mechanical fuel valve is in the first position, the fuel lockout apparatus communicates the first fuel source to the internal combustion engine and prevents the second fuel source from coupling to the internal combustion engine" ('780 Patent, Claim 8)

The patents fail to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. The "fuel lockout switch" disclosed in the specification of the patents does not "communicate" either the first fuel source or the second fuel source to the dual fuel engine. Likewise, the "fuel lockout apparatus" disclosed in the specification of the patents does not "communicate" either the first fuel source or the second fuel source to the dual fuel engine. The "communication" of fuel from a fuel source to the dual fuel engine is accomplished by a fuel line. For example, the specification describes a fuel lockout switch that uncovers the inlet



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of the second fuel line when the mechanical fuel valve is in the second position so that a user may couple the second fuel source to the second fuel line. It is the second fuel line that communicates the second fuel source to the dual fuel engine while the mechanical fuel valve is in the second position. The fuel lockout switch does not communicate the second fuel source to the engine even though the mechanical fuel valve is in the second position.

For the same reason, the patents do not provide an adequate written description of this claim element, and consequently, one of ordinary skill in the art would conclude that the inventors did not have possession of the claimed invention as of the filing date.

13. "A switch to change operation of the engine between gaseous fuel and liquid fuel" ('398 Patent, Claim 1; '145 Patent, Claim 1)

or

"Coupling a switch to the engine to change operation of the engine between gaseous fuel and liquid fuel" ('398 Patent, Claim 57)

The patents fail to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. The specification of the patents does not describe or enable a "switch to change operation of the engine between gaseous fuel and liquid fuel." For example, the electro-mechanical switch 86 disclosed in the specification only "connects one fuel source to the carburetor" (*see* '398 Patent, Col. 9:48-54; '145 Patent, Col. 9:52-56), and it does not change operation of the engine between gaseous fuel and liquid fuel. A person of ordinary skill in the art would not understand that electro-mechanical switch (disclosed as the mechanical fuel lockout switch) to change operation of the engine between gaseous fuel and liquid fuel, at least because actuation of that switch is not sufficient to enable the engine to operate on gaseous fuel.



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For the same reason, the patents do not provide an adequate written description of this claim element, and consequently, one of ordinary skill in the art would conclude that the inventors did not have possession of the claimed invention as of the filing date.

### B. 35 U.S.C. § 112(b) (Indefiniteness)

35 U.S.C. § 112(b) states that "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." Under this **definiteness requirement**, "a patent [claim] is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention." *Nautilus, Inc. v. Biosig Instruments, Inc*., 572 U.S. 898, 901 (2014); *see also Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1371 (Fed. Cir. 2014) ("The claims, when read in light of the specification and the prosecution history, must provide objective boundaries for those of skill in the art."). The proper test for determining whether a claim satisfies the definiteness requirement is whether the claim provides "reasonable certainty" as to its scope and bounds to a person of ordinary skill in the art at the time of filing. *Nautilus*, 572 U.S. at 901.

There are numerous claim terms or phrases recited in the Asserted Patents that fail to meet the definiteness requirement. This is because the claim language, read in light of the specification and prosecution history of the relevant patent(s), fails to provide a person of ordinary skill in the art reasonable certainty as to the scope of the claim language. As such, the identified claims of the Asserted Patents (and any claims depending from them) are invalid as indefinite under 35 U.S.C. § 112(b) for reasons set forth below.

Generac's assertions of indefiniteness are based on its understanding of the claim construction on which Champion relies. Generac expressly reserves the right to amend its contentions in this regard should Champion proffer claim constructions affecting additional claim

elements. Further, Generac reserves the right to proffer claim constructions that differ from those which Generac understands Champion to proffer.

Further, to the extent appropriate, Generac incorporates by reference any indefiniteness arguments raised in the Invalidity Contentions served by Firman Power Equipment, Inc. ("Firman") in *Champion Power Equipment, Inc. v. Firman Power Equipment, Inc.*, No. 2:23-cv-02371-DWL (D. Ariz). In addition, to the extent appropriate, Generac incorporates by reference any indefiniteness arguments raised in the Invalidity Contentions served by Harbor Freight Tools USA, Inc. ("Harbor Freight") in either *Harbor Freight Tools USA, Inc. v. Champion Power Equipment, Inc.*, No. 2:24-cv-8722 (C.D. Cal.) or *Champion Power Equipment, Inc. v. Harbor Freight Tools USA, Inc.*, No. 2:24-cv-1302 (E.D. Wis.). Moreover, to the extent appropriate, Generac incorporates by reference any indefiniteness arguments raised in any Invalidity Contentions served by Westinghouse Electric Corp. ("Westinghouse") in *Champion Power Equipment, Inc. v. Westinghouse Elec. Corp. et al.*, No. 2:25-cv-00844 (D. Nev.), *Champion Power Equipment, Inc. v. Westinghouse Elec. Corp. et al.* No. 3:25-cv-00239 (D. Nev.), or any other lawsuit by Champion asserting the Asserted Patents against one or of the same defendants for example as a result of the pending motion to transfer or change venue.

The claims identified below are invalid for failing to meet the definiteness requirement for at least the following reasons:

1. "Selector switch" ('101 Patent, Claims 1 and 18; '667 Patent, Claim 1; '896 Patent, Claims 7 and 30)

This claim term is indefinite because it fails to inform a person of ordinary skill in the art of the scope of the invention with reasonable certainty. The claims and specification of the patents



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does not describe or enable a plain-and-ordinary meaning of "selector switch," such as a switch that effectuates a selection. Instead, the specification discloses only a selector switch that enables a user to take a subsequent action that itself effectuates a selection. But that is not how a person of ordinary skill in the art would understand a selector switch. Moreover, the specification discloses only one particular embodiment of the purported selector switch. Thus, it is unclear where the bounds lie of what constitutes a selector switch.

2. "A selector switch positioned on the valve assembly to allow a user to manually select one of the first fuel flow and the second fuel flow" ('101 Patent, Claims 1 and 18; '667 Patent, Claim 1; '896 Patent, Claim 30)

This claim term is indefinite because it fails to inform a person of ordinary skill in the art of the scope of the invention with reasonable certainty. The claimed "valve assembly" does not have a well-defined boundary from which a person of ordinary skill in the art could determine with reasonable certainty whether the claimed selector switch is "positioned on the valve assembly." For example, Champion's allegation that the carburetor solenoid is a component of the valve assembly, which is contrary to the specification and claims, demonstrates that a person of ordinary skill in the art would not be able to determine with reasonable certainty which components of the generator comprise the valve assembly. Thus, a person of ordinary skill in the art also would not be able to determine with reasonable certainty what constitutes a selector switch "positioned on the valve assembly."

3. "A mechanical fuel valve actuatable between a first position and a second position to selectively control fuel flow to the dual fuel engine from a first fuel source



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through a first fuel line and a second fuel source through a second fuel line" ('780 Patent, Claims 1 and 15; '970 Patent, Claim 1; '895 Patent, Claims 1 and 8)

or

"A mechanical fuel valve actuatable between a first position and a second position to selectively control fuel flow to the dual fuel generator from the liquid fuel source through the liquid fuel line and the pressurized fuel source through the gaseous fuel line" ('654 Patent, Claim 6; '970 Patent, Claim 20; '895 Patent, Claim 14)

or

"Coupling a mechanical fuel valve to the internal combustion engine actuatable between a first position and a second position to selectively control fuel flow to the internal combustion engine from the first fuel source through a first fuel line and the second fuel source through a second fuel line" ('780 Patent, Claim 8)

These claim phrases contain terms that are indefinite because they fail to inform a person of ordinary skill in the art of the scope of the invention with reasonable certainty. The claims, specification, and prosecution history of the patent fail to inform a person of ordinary skill in the art with reasonable certainty about the scope of the definitions of either "actuatable" or "selectively control fuel flow."

4. "A gaseous fuel valve coupled to an inlet of the gaseous fuel line and connectable to the pressurized fuel source" ('970 Patent, Claim 20)

This claim term is indefinite because it fails to inform a person of ordinary skill in the art of the scope of the invention with reasonable certainty. The scope of claim 20 must encompass the scope of its dependent claim 29, which requires the gaseous fuel valve to comprise the two ends



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of a quick-connect hose coupling (i.e., ends 50a and 50b of hose coupling 50 in the specification). A quick-connect hose coupling, as described in the specification, is not a "valve" under the plain and ordinary meaning of the term. Further, even if the quick-connect hose couplings are "valves," they are not "gaseous fuel valves" because they do not open and close in order to regulate the flow of gaseous fuel. Because the '970 Patent does not define "gaseous fuel valve," a person of ordinary skill in the art would not be able to determine with reasonable certainty the scope of the term "gaseous fuel valve" such that claim 20 encompasses the scope of claim 29.

5. "Desired pressure" ('654 Patent, Claim 6; '970 Patent, Claims 1 and 20; '120 Patent, Claim 12; '895 Patent, Claim 14)

This claim term is indefinite because it fails to inform a person of ordinary skill in the art of the scope of the invention with reasonable certainty. The claims, specification, and prosecution histories of the patents fail to inform a POSA with reasonable certainty about the scope of the subjective term "desired pressure."

6. "Switch" ('398 Patent, Claims 1 and 57; '345, Claim 1)

This claim term is indefinite because it fails to inform a person of ordinary skill in the art of the scope of the invention with reasonable certainty. In view of the specification's attempt to define "switch" to include an electro-mechanical switch comprising the disclosed "fuel lockout switch," a POSA would not be able to determine with reasonable certainty the scope of the term "switch."



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7. "Wherein the two fuel outputs selectively supply fuel to the engine from only one of the first fuel source or the second fuel source" ('667 Patent, Claim 2)

or

"Wherein the two fuel outputs are configured to selectively supply fuel to the engine from only one of the first and second fuel sources" ('896 Patent, Claim 31)

These claim phrases are indefinite because they fail to inform a person of ordinary skill in the art of the scope of the invention with reasonable certainty. The claims, specification, and prosecution history of the patents fail to inform a person of ordinary skill in the art with reasonable certainty about the scope of the definition of "selectively supply," and thus a POSA would not be able to determine with reasonable certainty the scope of the phrase "selectively supply."

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## VII. CONCLUSION

For all the foregoing reasons, Champion's Asserted Patents are invalid under 35 U.S.C. §§ 101, 102, 103, and/or 112 and/or unenforceable.

Date: September 25, 2025

Respectfully submitted,

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## CERTIFICATE OF SERVICE

I, Monique Kreutz, hereby certify that on September 25, 2025, I served upon the following counsel for Plaintiff via electronic mail a true and correct copy of the foregoing document, including Exhibits and Charts A-10–A-15, B-05_Amended, B-13_Amended, B-19, B-20, F-16–F-19, H-16–H-20, I-10–I-15:

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