

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

CHAMPION POWER EQUIPMENT, INC.,

Patent Owner.

Patent No. 11,143,120

Issued: October 12, 2021

Title: FUEL SYSTEM FOR A MULTI-FUEL INTERNAL COMBUSTION
ENGINE

Inter Partes Review No. IPR2025-01121

**PETITIONER’S OPPOSITION TO PATENT OWNER’S REQUEST FOR
DISCRETIONARY DENIAL OF INSTITUTION**

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I. INTRODUCTION

Petitioners oppose Patent Owner Champion Power Equipment Inc.’s (“Patent Owner”) request for discretionary denial. Paper 11 (hereinafter “RDD”).

The Office recently referred the grandparent ’034 Patent IPR and the closely-related¹ ’101 Patent IPR to the merits panel. IPR2025-00805, Paper 20 (“’034 Referral Decision”); IPR2025-00951, Paper 18 (“’101 Referral Decision”). Discretionary denial is not appropriate here for the same reasons, including the efficiencies gained from consolidating multiple litigations involving many patents and the existence of material errors during prosecution. *Id.*

“Patent Owner has sued a large number of parties in a multitude of districts.” ’034 Referral Decision, at 2. Petitioners have filed thirteen IPRs challenging the thirteen patents asserted across the three litigations against Petitioners (the “Related IPRs”). As the Director recognized in the ’034 and ’101 Referral Decisions, consolidating invalidity arguments across three litigations into a single set of IPRs is an efficient use of Board resources. *Id.*; *see also* ’101 Referral Decision, at 2.

Additionally, the ’120 Patent was improperly granted due to critical Examiner oversights. **First**, the NOA only addresses claim 1, never mentioning or addressing

¹ *See* IPR2025-00951, Paper 8 (Patent Owner describing its 2015 Patent family—of which the ’034 and ’120 Patents are members as “closely related” to its 2013 Patent family—of which the ’101 Patent is a member).

the unique limitations of independent claims 12 or 18. **Second**, U.S. Patent. No. 5,809,979 to Tsuda (Ex. 2062, (which the RDD refers to as the “Kubota Patent”)) was before the Examiner during the examination of the great-grandparent ’398 Patent, yet was never applied by the Examiner. Patent Owner admits that Tsuda is substantially the same as the Kubota Workshop Manual. RDD, 17-18.

And as detailed in the Petition, the Workshop Manual discloses all limitations of independent claims 12 and 18 (and dependent claims 13-15, 17 and 19). Pet., 50-74. Thus, the same material error as noted in the ’034 IPR—failing to consider the anticipatory teachings of Tsuda/the Workshop Manual during prosecution despite the Examiner being aware of this reference (’034 Referral Decision, at 2-3)—similarly taints the ’120 Patent prosecution. Referring this IPR would allow these errors to be addressed through consideration of claims 12 and 18 and Tsuda/Workshop Manual.

Furthermore, Patent Owner has no settled expectations in the ’120 Patent because it is not even four years old (and over two years younger than the recently referred ’034 Patent). With no trial dates set in any of the litigations involving the ’120 Patent, this *Fintiv* factor favors referral, as do all the other *Fintiv* factors. Accordingly, just as with the ’034 and ’101 IPRs, this Petition should be referred to the Board for assessment on the merits.

II. RESOLVING THE PARTIES’ DISPUTES AT THE PTAB IS MUCH MORE EFFICIENT THAN THREE PARALLEL DISTRICT COURT TRIALS IN THREE DIFFERENT JURISDICTIONS

Patent Owner states that it “should not be forced to defend its patent in multiple forums.” RDD, 2. Petitioners agree, and so does the Office: “Because the litigation between the parties would proceed to several district court trials in different jurisdictions, resolving the dispute between the parties at the Office would be more efficient.” ’034 Referral Decision, at 2; *see also* ’101 Referral Decision, at 2.

Indeed, allowing this IPR (and the Related IPRs) to proceed represents the epitome of efficient and appropriate use of Office resources, given that the alternative is having four different jury trials involving proceed to assess invalidity of the asserted patents in four different district courts. Such piecemeal adjudication creates a very high likelihood of inconsistent outcomes. Compared to presenting broad invalidity cases to four different juries, the Board is much better positioned to grasp and efficiently handle a single set of challenges to so many patents from two different patent families involving complicated aspects of numerous multi-fuel engine/generator designs. The vast efficiencies to be gained by consolidating the three Petitioner district court invalidity proceedings into a single set of proceedings before the PTAB is a highly appropriate use of Office resources, and reason enough by itself to refuse discretionary denial. *Berkshire Hathaway Energy Co. v. Birchtech Corp.*, IPR2025-00274, Paper 23, at 2-3 (PTAB July 2, 2025); *Shenzhen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc.*, IPR2025-00438, Paper 10, at 3 (PTAB July 17, 2025) (referring to the Board where the district court proceeding involved a “large

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number and vast scope” of patents).

The related '034 and '101 IPRs have already been referred to the merits panel for these efficiencies ('034 Referral Decision, at 2-3; '101 Referral Decision, at 2), and this IPR should be referred as well for the same reasons. *Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12, at 3-4 (PTAB July 26, 2025) (referring a second petition on a patent related to another already referred to the merits panel because “it is an efficient use of Board resources to address the related patent”).

Patent Owner has asserted 13 different patents against the three Petitioners in three different district court proceedings in California (Harbor Freight), Wisconsin (Generac), and Nevada (MWE), and has asked a fourth court in Arizona to adjudicate the same patents as to non-petitioner Firman. RDD, 7-10. All 13 patents are the subject of IPR petitions filed collectively by the three Petitioners precisely to streamline the invalidity challenges in a single set of IPR proceedings and ensure consistency on the invalidity determinations. The combined 13 IPRs filed by Petitioners set forth only 27 prior art references in total, applied against approximately 320 challenged claims. This is an average of about two prior art references per patent, and only one reference for every 12 challenged claims on average. The Petitions together thus represent a greatly reduced and streamlined invalidity case as compared to, for example, the sixty-nine prior art references asserted by Firman. RDD, 8.

III. MATERIAL ERROR BY THE EXAMINER DURING PROSECUTION WEIGHS HEAVILY AGAINST DISCRETIONARY DENIAL

Material error during prosecution—such as overlooking features allegedly justifying patentability that are clearly disclosed in the art before the Examiner, or relying on an overgeneralized notice of allowance that fails to address materially different independent claims—weighs heavily against discretionary denial. *Advanced Bionics, LLC v. Med-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, at 7-8 (PTAB Feb. 13, 2020) (precedential); *see, e.g., Eunsung Global Corp. v. Hydrafacial LLC*, IPR2025-00445, Paper 14, at 3 (PTAB July 10, 2025) (referring petition where the NOA alleged the absence of elements actually found in prior before the examiner); *Skullcandy, Inc. v. Earin AB*, IPR2025-00690, Paper 9, at 2 (PTAB July 31, 2025) (referring the petition where the NOA cited elements in the first independent claim, but not in other materially-distinct independent claims). Here, both such errors occurred during prosecution.

The NOA provided the following reason for allowance:

The IDS filed July 1, 2021 did not yield prior art that anticipates the claimed invention. While each of the references cited teach various aspect of the invention, none of the references discloses or teach in combination a multi-fuel engine comprising an engine operable on a liquid fuel and a gaseous fuel; a carburetor attached to an intake of the engine to mix air and fuel and connect a liquid fuel source to the intake, the carburetor comprising a float bowl; a liquid cutoff solenoid coupled to open and close a liquid fuel path to the engine; a gaseous cutoff

solenoid coupled to open and close a gaseous fuel source to the engine; a switch selectively coupling a power source to the liquid cutoff solenoid and the gaseous cutoff solenoid to open and close the liquid fuel path and the gaseous fuel path; and one or more timing circuits electrically coupled to the liquid cutoff solenoid and the gaseous cutoff solenoid that operate to control an actuation time of the liquid cutoff solenoid and the gaseous cutoff solenoid.

Ex. 1002, 249. This NOA manifests multiple material errors that warrant review.

First, the NOA speaks only to the alleged lack of **anticipation** by the cited prior art, with no assessment whatsoever of **obviousness**. Second, while the stated reasons for allowance track the limitations of claim 1, they fail to acknowledge or address independent claims 12 and 18—which contain no limitations directed to “timing circuits,” and instead focus on features such as a “fuel regulator system” and an “idle fuel circuit,” respectively. Accordingly, the stated reasons for allowance fail to address materially-distinct claims 12 and 18. *See also* Ex. 1002, 107 (likewise addressing only claim 1, stating “the further optimization of timing the fuel cutoff valves as claimed for a carburetor assisted fuel injection is considered a novel approach for such engine types”).

Third, as Patent Owner admits (RDD, 17-18), Tsuda (i.e., the “Kubota Patent”) was before the Examiner during prosecution of earlier family members of the ’120 Patent. Patent Owner further contends that Tsuda is substantially the same as the Workshop Manual. *Id.* Yet, as detailed in the Petition, the Workshop Manual

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expressly discloses **all limitations** of independent claims 12 and 18 (Pet., 51-58, 64-74) and many dependent claims. Thus, similar to the '034 IPR ('034 Referral Decision, at 2-3), the Office erred during prosecution of the '120 Patent in a manner material to the patentability of the challenged claims by overlooking the teachings of Tsuda, in addition to failing to assess obviousness in general or the materially distinct limitations of independent claims 12 and 18. These errors are in addition to failing to locate and apply the teachings of, *inter alia*, Imamura, which itself anticipates at least claims 1-2, 4-6, and 9-10. Pet., 23-37. Accordingly, a merits review to address these errors is warranted. *Xencor, Inc. v. Merus N.V.*, IPR2025-00604, Paper 12, at 2-3 (PTAB July 17, 2025); *Microsoft Corp. v. Partec Cluster Competence Ctr. GmbH*, IPR2025-00318, Paper 9, at 3 (PTAB June 12, 2025).

IV. SETTLED EXPECTATIONS WEIGH AGAINST DISCRETIONARY DENIAL

The '120 Patent issued in 2021 and has been in force for less than four years. Challenges to patents that have been in force for many years longer have still been consistently characterized as “early” and “favor[ing] robust predictable patent rights and weigh[ing] against discretionary denial.” *See, e.g., Tanklogix v. Sitepro*, IPR2025-00650, Paper 10, at 2 (PTAB July 31, 2025); *Cambridge Industries USA, Inc. v. Applied Optoelectronic, Inc.*, IPR2025-00434, -00436, Paper 11, at 2-3 (PTAB June 26, 2025); *Berkshire Hathaway*, IPR2025-00274, Paper 23, at 3; *Webgroup Czech Republic, A.S. et al., v. Dish Technologies LLC.*, IPR2025-00467, Paper 14, at

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2 (PTAB July 16, 2025).

Patent Owner appears to believe that it already had settled expectations in the '120 Patent upon issuance because of its parent '780 Patent. RDD, 2, 4-7. Yet, Patent Owner does not even have settled expectations in the parent patent, let alone the '120 Patent that was issued much more recently. Patent Owner sent “cease-and-desist” letters to MWE and Generac in 2020, alleging infringement of the '101 Patent (Ex. 2033; Ex. 2036)—which is not even in the same family as the '780 or '120 Patents. In response to the 2020 letters, both MWE and Generac informed Patent Owner that its claims were invalid. Ex. 2034, Ex. 2035, Ex. 2037. MWE even told Patent Owner that it **would file an IPR** if Patent Owner further pursued its dubious infringement claims (Ex. 2034). Tellingly, prior to embarking on its current litigation campaign (initiated four years after its last communications on the matter), Patent Owner never again raised the infringement issues with either MWE or Generac. Moreover, Patent Owner did not raise the '101 Patent with Harbor Freight until a March 27, 2024 letter, which never even accused Harbor Freight of infringing the '101, '780, or '120 Patents. Ex. 2038, 2.

Under these circumstances, it would be illogical and contrary to the evidence of record to find that Patent Owner had any “reasonable expectation” that the validity of the '101 Patent (or the '120 Patent later-issued in a different family) would not be challenged. Indeed, the only “reasonable expectation” to be taken from their prior

correspondence exchanges is that Patent Owner understood that its patents **would be challenged in IPR proceedings** in the event that Patent Owner sought to enforce them. And that is exactly what has transpired.

In addition, Patent Owner cannot develop settled expectations in the '120 Patent based solely on an earlier-issued patent in the same family. That is especially true where, as here, the '780 Patent claims all focused on limitations directed to a “fuel lockout” switch—a feature appearing nowhere in the claims of the '120 Patent. *Compare* Ex. 1001, Claims 1-19, *with* Ex. 2086, Claims 1, 8, and 15.

Moreover, to the extent parent-child relationships are considered, the parent's fate is tied to the child's, not the other way around. For example, in *Embodry, Inc. v. Lifenet Health*, both a parent patent and its child were challenged via IPR. IPR2025-00248, -00249, Paper 13 (PTAB June 26, 2025). The child patent was deemed to not trigger settled expectations and was referred to the merits panel. The parent patent was also referred to the merits panel because “it is an efficient use of Board resources to address the related patent.” *Id.*, 3.

Here, not only does the '120 Patent lack settled expectations when considered in a vacuum, the '120 Patent has even younger children of its own: the child '985 Patent was challenged less than three years after issuance (IPR2025-01272) and the grandchild '970 Patent was challenged less than two years after issuance (IPR2025-01463). Efficiency gains are particularly pronounced here, given identical

specifications of the directly related patents, and the referral of the IPR on the '034 Patent from the same family (*see* '034 Referral Decision).

V. *FINTIV* FACTORS WEIGH AGAINST DISCRETIONARY DENIAL

This is the quintessential case for institution. None of the *Fintiv* factors favor discretionary denial, and in fact, a majority of the *Fintiv* factors weigh strongly against discretionary denial. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 5-6 (PTAB Mar. 20, 2020). The weight of the *Fintiv* factors and related considerations against discretionary denial are further detailed below.

A. Factor 1 – the Likelihood of a Stay – Weighs Against Discretionary Denial Because the District Courts Have a Record of Granting Stay Motions on Similar Facts

Factor 1 weighs against discretionary denial. Patent Owner focuses on whether the parallel proceedings have *already* been stayed (RDD, 10), but this factor considers how the district courts will *likely* rule on a motion to stay. *See iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00377, Paper 10, at 2-3 (PTAB June 6, 2025). The data shows that stays will likely be granted.

1. The MWE, Generac, and Harbor Freight Cases

The MWE case is pending in the District of Nevada before Judge Traum. Judge Traum has granted a contested motion to stay on similar facts. *See FaceTec, Inc. v. iProov, Ltd.*, No. 2:21-cv-02252, Dkt. 188 (D. Nev. June 18, 2025) (attached as EX1055). And this district has granted stays 67% of the time. Ex. 1058.

The Generac case is pending in the Eastern District of Wisconsin before Judge

Adelman. Judge Adelman has granted contested motions to stay 70% of the time (EX1056), which is comparable to the district's average grant rate of 73% (Ex. 1057). The Harbor Freight case is pending in the Central District of California. This district has granted stays at a 66% rate (Ex. 1059, ¶5, Ex. B, 12).

Furthermore, both Generac and Harbor Freight have had meet-and-confers with Patent Owner regarding their intention to seek stays of their litigations.² In both cases, Patent Owner instead indicated an openness to stays should the IPRs not be discretionarily denied (Ex. 1059, ¶4; Ex. 1061, 1), creating a high likelihood the MWE, Generac, and Harbor Freight cases will be stayed. *See, e.g.*, Ex. 1062 (showing that all uncontested stays have been granted in EDWI); Ex. 1063 (showing that all uncontested stays have been granted in Nevada).

2. The Firman Case

Firman is not a petitioner, privy, or real-party-in-interest, which alone weighs against discretionary denial. *POSCO Co. v. ArcelorMittal*, IPR2025-00370, Paper 10, at 2-3 (PTAB June 25, 2025). To the extent Firman's case is considered, it weighs against discretionary denial because the presiding judge has granted a motion to stay on similar facts. *See Parson Xtreme Golf LLC v. Taylor Made Golf Co. Inc.*, No. 17-

² A motion to transfer venue is pending in the MWE case. *Champion Power Equip., Inc. v. Westinghouse Elec. Corp.*, No. 25-cv-00239, Dkt. 35 (D. Nev. Aug. 11, 2025). MWE intends to seek a stay once venue has been settled.

B. Factor 2 – Parallel Trial Date – Weighs Against Discretionary Denial Because the Board is Likely to Issue a Final Written Decision Before the District Court Proceedings Reach Trial

Factor 2, focused on the timing of parallel proceeding trial dates, weighs against discretionary denial. None of the three parallel litigations involving Petitioners have scheduled trial dates, and a FWD will almost certainly issue well before these cases reach trial. Even the case involving non-Petitioner Firman is running far behind schedule, suggesting a trial date falling well after the FWD.

1. The MWE, Generac, and Harbor Freight Cases

No trial dates have been scheduled in any of the three parallel litigations involving Petitioners, and any such trials will almost certainly occur after a FWD. The lack of trial dates weighs against discretionary denial, especially where a FWD will reduce the chances of inconsistent outcomes among numerous tribunals. *USAA Federal Savings Bank v. PACid Techs., LLC*, IPR2025-00697, Paper 9, at 2 (PTAB Aug. 14, 2025); *Google LLC v. Withrow Networks Inc.*, IPR2025-00775, Paper 10, at 2 (PTAB Aug. 14, 2025).

Regarding the MWE case, the average time to trial in Nevada is 53 months, with a median of 42 months. Ex. 1064. Even using the shorter median, the data suggests a trial date at the end of 2028, two years after the FWD.

Regarding the Generac case, Judge Adelman has presided over one patent case

since 2008, which took 43 months to reach trial. Ex. 1065. A similar timeline here would place trial around April 2028 – nearly two years after the FWD. Even if the district’s overall median time-to-trial of 34 months is considered (Ex. 1066), trial would not be expected to occur until August 2027, eight months after the FWD. The court also recently extended the case schedule, further delaying the case. Ex. 1083.

Regarding the Harbor Freight case, Patent Owner references a prior proposed schedule (RDD, 9), but fails to mention that this proposal was filed with a different judge and never adopted. With a median time to trial of 35 months, trial is projected to occur in September 2027, nine months after the FWD. Ex. 1067, 1.

2. The Firman Case

Patent Owner alleges that the Firman trial will occur before the FWD date. RDD, 11. While time-to-trial statistics in a vacuum may suggest a trial date around the same time as the FWD, the Firman case is already running significantly behind schedule. Specifically, statistics indicate a median time to claim construction of 15.7 months (Ex. 2047, 1-2), suggesting that a *Markman* ruling should have occurred in February 2025. Yet now, as of mid-October 2025, a *Markman* hearing has yet to occur or even be scheduled. Thus, the Firman case is already running at least **seven months** behind schedule compared to Patent Owner’s relied-upon statistics. As a result, any trial in the Firman case will likely occur well after the FWD. In addition, discretionary denial is unsupported because Petitioners are not a party to the Firman

case (thus, no *res judicata* will flow from that case), and Firman is not a privy or real-party-in-interest in this IPR. *POSCO*, IPR2025-00370, Paper 10, at 2-3.

C. Factor 3 – Investment in Parallel Proceeding at the DI Deadline – Weighs Against Discretionary Denial Because the District Court Cases Are at Early Stages for the Petitioner Involved Cases

Factor 3 weighs against discretionary denial because the district court cases involving the Petitioners are all at very early stages. For example, even Patent Owner admits that the MWE case is still in its infancy. RDD, 12.

Similarly, in its filings to the district court, Patent Owner recently described the Generac case as being in its “infancy.” Ex. 1070, 13-15. Patent Owner should not be allowed to take a contradictory position before the Board simply to suit its needs here.

Substantial work remains in the Harbor Freight case, as the court has not yet issued a protective order, document discovery has yet to begin in earnest, no schedule dates other than those for the *Markman* hearing have been entered, and the parties have not conducted any fact depositions or any substantive discovery, let alone prepare for trial. Under similar circumstances, the Board has found this factor to “weigh only marginally, if at all” toward discretionary denial. *See, e.g., Sand Revolution II, LLC v. Cont’l Intermodal Grp. – Trucking LLC*, IPR2019-01393, Paper 24, at 10-11 (PTAB June 16, 2020). While the Harbor Freight court held a *Markman* hearing on September 30, 2025, there is no deadline by which the court

will issue a claim construction ruling.

Patent Owner again makes much of the parties' purported "investment" in the Firman case but cites no authority for why that case – in which Petitioners have no involvement whatsoever and there is no invalidity argument based on the prior art combinations presented in this IPR – has any bearing on *Fintiv* Factor 3 here.

D. Factor 4 – Lack of Overlap in the Parallel Proceeding Weighs Against Discretionary Denial Because the Stipulations Remove Overlap with Parallel Proceedings

This factor weighs heavily against discretionary denial because Petitioners have committed to broad *Sotera*-plus stipulations that will eliminate overlap between the district court proceedings and this IPR (as well as the Related IPRs). Specifically, Petitioners have stipulated that they will forego invalidity challenges involving:

- (i) the specific grounds raised in the Petition;
- (ii) any other grounds that could have reasonably been raised in the IPR proceeding (i.e., any ground that could have reasonably been raised under §§102 or 103 on the basis of prior art patents or printed publications); and
- (iii) any ground based on system prior art (either alone or in combination with other references) that directly corresponds to a printed publication reference asserted as part of a ground raised in said instituted (and not vacated) petition.

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Ex. 2089; Ex. 2090; Ex. 2069.

These stipulations extend far beyond the more typical *Sotera*-type stipulation³ to ensure that there will be no overlap with any arguments raised in the litigations, including for system prior art reflected in the relied-upon printed publications, making this IPR (and the related IPRs) a true alternative to district court for determining invalidity. These broad stipulations weigh heavily against discretionary denial. *See Shenzhen Tuozhu Tech.*, IPR2025-00438, Paper 10, at 3 (rejecting discretionary denial request where petitioner has “filed a broad stipulation”); *Tesla, Inc. v. Sec’y of the Navy ex rel. United States*, IPR2025-00341, Paper 12, at 2 (PTAB June 13, 2025) (same); *Tesla, Inc. v. Intell. Ventures II*, IPR2025-00339, Paper 10, at 2 (PTAB June 13, 2025) (same).

Patent Owner inexplicably claims that “the stipulations do little to narrow the issues before the district courts.” RDD, 13. This absurd claim is refuted simply by considering the alternative—if the Board refuses to institute these IPRs, then **four separate district courts** will each have to separately adjudicate **all** the invalidity issues raised by the individual defendants in each case. On the other hand, if instituted, all invalidity grounds based on printed publications that were raised or that could have been raised in the IPRs, as well as system art corresponding to the

³ *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, at 18-19 (PTAB Dec. 1, 2020) (precedential as to §II.A) (“*Sotera*”).

printed publications that were raised as part of a challenge, will be consolidated into a single set of proceedings before the PTAB. As the Director already found in the '034 Patent IPR ('034 Referral Decision, at 2), this factor clearly weighs strongly against discretionary denial. *Berkshire Hathaway*, IPR2025-00274, Paper 23, at 2-3.

E. Factor 5 – Whether the Parties are the Same – Does Not Favor Discretionary Denial Because Petitioners are Not a Party to the Firman Case

Patent Owner's discretionary denial brief mentions Firman over 40 times. Yet Firman is conspicuously absent from Patent Owner's discussion of this factor. RDD, 15. Patent Owner cannot have it both ways—relying on the Firman case when it suits its needs for other factors, while ignoring Firman for its discussion of *Fintiv* Factor 5. The parties before the Board and their three respective district court cases are the same, as in almost all IPRs. However, the opposite is true with respect to the Firman case, where Petitioners are not a party. Given Patent Owner's extensive attempted reliance on the Firman case in its arguments, this fact weighs *Fintiv* Factor 5 against discretionary denial. *Cf. POSCO*, IPR2025-00370, Paper 10, at 2.

F. Factor 6 – Other Considerations – Weigh Against Discretionary Denial

As discussed in §§II-IV above, efficiency, material error, and the lack of settled expectations weigh strongly against discretionary denial. Additional considerations under Factor 6 also weigh against denial, as discussed below.

1. Strength of Grounds Weighs Against Discretionary Denial

Patent Owner puts forth no true argument as to the merits of the Petition, citing only to its forthcoming Preliminary Response. RDD, 15. In fact, the merits of the Petition are strong and include well-grounded theories of invalidity based on the proffered prior art. *See supra*, §III.

2. No Forum Has Adjudicated Any Claim of the '120 Patent, Which Weighs Against Discretionary Denial

The '120 Patent has not been reexamined, reissued, or otherwise adjudicated in any other forum to Petitioners' knowledge. Nor is it expected to be adjudicated in any other forum before a FWD is expected to issue in this proceeding, if instituted. *See supra*, §V.B.

VI. SECTION 325(d) WEIGHS AGAINST DISCRETIONARY DENIAL

Patent Owner fails to establish that the Petition should be denied institution pursuant to 35 U.S.C. §325(d), as discussed below.

A. The Prior Art in the Petition is Not the Same Nor Substantially the Same as the Art Previously Considered by the Office

Patent Owner argues that the Workshop Manual is “substantially the same” as the Tsuda patent that was before the Examiner. RDD, 17-18. However, Patent Owner bases this conclusion only on both references being directed to Kubota’s duel-fuel engines (*id.*); Patent Owner nowhere shows that both references actually contain the same relevant disclosure. And indeed, whereas claim 18 contains a limitation directed to an idle fuel circuit that the Workshop Manual discloses via its “Slow

System” relying on a pilot fuel jet (*see* Pet., 68-70), Tsuda nowhere mentions this same “Slow System” or a pilot fuel jet. Thus, for at least this reason, the Workshop Manual is not merely cumulative of Tsuda.

Patent Owner also argues that Imamura is cumulative to Thome. RDD, 16-17. However, Thome nowhere describes its system as including a timing “circuit,” which is one of the features relied on by the Examiner in the NOA. Ex. 1002, 249. In contrast, Imamura expressly discloses the claimed circuits (*see* Pet., 28-32), along with the other limitations of claim 1 and the limitations of six of its dependent claims (*see id.*, 23-37). Thus, Imamura is not merely cumulative of Thome, and does not merit discretionary denial under §325(d).

Patent Owner’s remaining arguments are directed towards references that were applied in the Petition in obviousness grounds. Yet, the Examiner’s stated reasons for allowance only addresses anticipation, claiming that the prior art teaches various aspects of claim 1 but that no prior art “anticipates the claimed invention.” Ex. 1002, 249. This statement is plainly wrong when considering the anticipatory teachings of the Workshop Manual and Imamura, and further fails to address the obviousness of the claims in view of the prior art cited in the Petition (*see* Pet., Grounds 2-4, 6-8). Since the Examiner did not have Imamura, Nakafushi, French, Frantz, Olmr, Jungmann, Parlatore, or Kirk, nor the support of an expert declaration explaining a POSA’s understanding of these references, the Examiner was not able

to consider the arguments raised under these grounds presented in the Petition.

B. The Office Erred in Overlooking Tsuda/the Workshop Manual

The NOA fails to acknowledge or address the materially different limitations of independent claims 12 and 18 (*see* Ex. 1002, 107, 249), which in and of itself constitutes error sufficient to decline discretionary denial. *Skullcandy, Inc.*, IPR2025-00690, Paper 9, at 2.

In addition, as noted above (*supra*, §III), the Workshop Manual expressly discloses the limitations of independent claims 12 and 18, which contain materially different limitations than claim 1. Accordingly, to the extent the Workshop Manual and Tsuda are deemed to be “substantially the same” as argued by Patent Owner (RDD, 17), the Examiner materially erred in failing to apply these teachings to the claims, further making discretionary denial inappropriate just as was determined in the ’034 IPR. ’034 Referral Decision, 2-3.

VII. CONCLUSION

For the foregoing reasons, the Director should reject Patent Owner’s request for discretionary denial, and Petitioners respectfully request that the Petition be submitted to the panel for review on the merits.

Date: October 10, 2025

Respectfully submitted,

By: /Kimberly K. Dodd/

IPR2025-01121
U.S. Patent No. 11,143,120

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on October 10, 2025, a true and correct copy of the foregoing **PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION** was filed through the P-TACTS system along with service to the email addresses listed below:

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