
From: Taylor R. Stemler <TStemler@MerchantGould.com>
Sent: Monday, August 4, 2025 4:45 PM
To: Hoekel, Jennifer; HB - Champion; jmf@zpatents.com; rlt@zpatents.com; tjz@zpatents.com
Cc: GeneracChampMGTEAM; Monique L. Kreutz; Paul J. Stockhausen; Monica A. Mark; {F6332953}.Active@ef.merchantgould.com
Subject: RE: Champion v. Generac - Stipulation of Invalidity Contentions [IMAN-DB1.FID6332953]
Attachments: 2025 08 04 Defendant Generac Stipulation of Invalidity Contentions(117630582.2).pdf

Counsel,

As you are aware, Generac has filed a petition for *inter partes* review (“IPR”) challenging certain claims of U.S. Patent Nos. 10,598,101; 11,306,667; and 11,905,896. With regard to the prior art grounds in those petitions and in this litigation, Generac stipulates to the following, as provided in the attached stipulation:

WHEREAS, Generac has filed petitions for inter partes review (“IPR”) challenging certain claims (including all asserted claims here) of the ’101 patent, the ’667 patent, and the ’896 patent in IPR Nos. IPR2025-00951, IPR2025-01099, and IPR2025-01228, respectively (“Subject Petitions”).

Generac hereby stipulates, broader than the stipulation made by the Petitioner in Sotera that, if the PTAB institutes an IPR (and does not subsequently vacate institution) in response to a Subject Petition, Generac will not pursue in this litigation invalidity of the claims for the specific patent challenged in the instituted IPR for said Subject Petition based on: (i) the specific grounds raised in the petition, (ii) any other grounds that could have reasonably been raised before the PTAB in that instituted 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), or (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 Subject Petition for the instituted (and not vacated) IPR.

As you are also aware, Generac has also filed IPR petitions on U.S. Patent Nos. 10,393,034; 11,143,120; 10,221,780; and 11,492,985, which are all pending institution decisions, and Generac intends to petition for IPRs on the remaining patents-in-suit in short order: U.S. Patent Nos. 10,697,398; 11,143,145; 11,530,654; 11,840,970; 11,905,895; and 11,761,390. I confirm that Generac intends to stipulate to the same scope for each of the pending IPR petitions as well as subsequent IPR petitions on patents-in-suit in the above captioned case.

We look forward to meeting and conferring regarding the request to stay this litigation pending outcome of all IPRs on all patents-in-suit, which would include the proceedings from petitions on the 3 patents that are the subject of this stipulation and from other IPR petitions on the patents-in-suit.

Best regards,

Taylor

Taylor R. Stemler

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Operating as Merchant & Gould, LLP, in California.

Please consider the environment before printing this email. Thank you

From: Taylor R. Stemler

Sent: Monday, August 4, 2025 3:43 PM

To: Hoekel, Jennifer <Jennifer.Hoekel@huschblackwell.com>; HB - Champion <HB-Champion@huschblackwell.com>; jmf@zpatents.com; rlt@zpatents.com; tjz@zpatents.com

Cc: GeneracChampMGTEAM <GeneracChampMGTEAM@MerchantGould.com>; Monique L. Kreutz <mkreutz@merchantgould.com>; Paul J. Stockhausen <pstockhausen@reinhardtllaw.com>; Monica A. Mark <mmark@reinhardtllaw.com>; {F6332953}.Active@ef.merchantgould.com

Subject: RE: Champion v. Generac - Stipulation of Invalidity Contentions [IMAN-DB1.FID6332953]

Hi Jennifer,

Thanks for getting back to me on this. We are available to confer at the below times (central time). Please let us know what works for you, and we can circulate a meeting invite.

8/8, between 9am and 12:30pm;

8/11, between 9:30am and 1pm;

8/13, before 10:30am.

Best regards,

Taylor

Taylor R. Stemler

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USA

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

CHAMPION POWER EQUIPMENT,
INC.

Plaintiff / Counter-Defendant

Case No. 24-cv-1281

v.

JURY TRIAL DEMANDED

GENERAC POWER SYSTEMS, INC.

Defendant / Counter-Plaintiff.

DEFENDANT’S STIPULATION REGARDING INVALIDITY CONTENTIONS

WHEREAS, Champion has asserted U.S. Patent Nos. 10,598,101 (“the ’101 patent”), 11,306,667 (“the ’667 patent”), and 11,905,896 (“the ’896 patent”) against Generac;

WHEREAS, Generac has alleged that the asserted claims of the ’101 patent, the ’667 patent, and the ’896 patent are invalid based on prior art;

WHEREAS, Generac has filed petitions for *inter partes* review (“IPR”) challenging certain claims (including all asserted claims here) of the ’101 patent, the ’667 patent, and the ’896 patent in IPR Nos. IPR2025-00951, IPR2025-01099, and IPR2025-01228, respectively (“Subject Petitions”).

Generac hereby stipulates, broader than the stipulation made by the Petitioner in *Sotera* that, if the PTAB institutes an IPR (and does not subsequently vacate

institution) in response to a Subject Petition, Generac will not pursue in this litigation invalidity of the claims for the specific patent challenged in the instituted IPR for said Subject Petition based on: (i) the specific grounds raised in the petition, (ii) any other grounds that could have reasonably been raised before the PTAB in that instituted 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), or (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 Subject Petition for the instituted (and not vacated) IPR.

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

Respectfully submitted,

Dated: August 4, 2025

By: /s/ Thomas J. Leach

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Attorneys for Defendant

CERTIFICATE OF SERVICE

I, Taylor Stemler, hereby certify that on August 4, 2025 I caused a true and correct copy of the foregoing document to be served upon the following counsel for Plaintiff via email service:

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/s/ Taylor R. Stemler

Taylor R. Stemler