

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

CHAMPION POWER EQUIPMENT, INC.,
Patent Owner.

Patent No. 11,905,896

Issued: February 20, 2024

Title: DUAL FUEL SELECTOR SWITCH

Inter Partes Review No. IPR2025-01228

**PETITIONERS' OPPOSITION TO PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL OF INSTITUTION**

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	GIVEN THE NUMBER OF PARALLEL DISTRICT COURT TRIALS ACROSS DIFFERENT JURISDICTIONS, RESOLVING THE DISPUTE AT THE PTAB IS MORE EFFICIENT	2
III.	MATERIAL ERROR BY THE EXAMINER DURING PROSECUTION WEIGHS HEAVILY AGAINST DISCRETIONARY DENIAL.....	4
IV.	SETTLED EXPECTATIONS WEIGH AGAINST DISCRETIONARY DENIAL.....	8
V.	<i>FINTIV</i> FACTORS WEIGH AGAINST DISCRETIONARY DENIAL	10
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	10
1.	The MWE, Generac, and Harbor Freight Cases	10
2.	The Firman Case	11
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	12
1.	The MWE, Generac, and Harbor Freight Cases	12
2.	The Firman Case	13
C.	Factor 3 – Investment in Parallel Proceeding by the Institution Deadline – Weighs Against Discretionary Denial Because the Petitioner-Involved District Court Cases Are at Early Stages	14
D.	Factor 4 – Lack of Overlap in the Parallel Proceeding Weighs Against Discretionary Denial Because the Stipulations Remove Overlap with Parallel Proceedings	15

E.	Factor 5 – Whether the Parties are the Same – Does Not Favor Discretionary Denial Because Petitioners are Not a Party to the Firman Case.....	17
F.	Factor 6 – Other Considerations – Weigh Against Discretionary Denial	17
1.	Strength of Grounds Weighs Against Discretionary Denial	17
2.	No Forum Has Adjudicated Any Claim of the '896 Patent, Which Weighs Against Discretionary Denial	18
VI.	SECTION 325(d) WEIGHS AGAINST DISCRETIONARY DENIAL.....	18
A.	The Prior Art in the Petition is Not the Same nor Substantially the Same as the Art Previously Considered by the Office	18
B.	The Office Materially Erred in Overlooking Deng, As Recognized in the '530 Application.....	20
VII.	CONCLUSION.....	20

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Anthony Inc. v. ControlTec, LLC</i> , IPR2025-00559, Paper 12 (PTAB July 16, 2025)	4
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020)	10
<i>Berkshire Hathaway Energy Co. v. Birchtech Corp.</i> , IPR2025-00274, Paper 23 (PTAB July 2, 2025)	3, 8, 16
<i>Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.</i> , IPR2025-00434, Paper 11 (PTAB June 26, 2025)	8
<i>Ecto World, LLC v. RAI Strategic Holdings, Inc.</i> , IPR2024-01280, Paper 13 (PTAB May 19, 2025)	20
<i>Embody, Inc. v. Lifenet Health</i> , IPR2025-00248, Paper 13 (PTAB June 26, 2025)	9
<i>FaceTec, Inc. v. iProov, Ltd.</i> , No. 21-cv-02252, Dkt. 188 (D. Nev. June 18, 2025)	10
<i>Google LLC v. Withrow Networks Inc.</i> , IPR2025-00775, Paper 10 (PTAB Aug. 14, 2025)	12
<i>iRhythm Techs., Inc. v. Welch Allyn, Inc.</i> , IPR2025-00377, Paper 10 (PTAB June 6, 2025)	10
<i>Padagis US LLC v. Neurelis, Inc.</i> , IPR2025-00464, Paper 12 (PTAB July 26, 2025)	3
<i>Microsoft Corp. v. ParTec Cluster Competence Ctr. GmbH</i> , IPR2025-00318, Paper 9 (PTAB June 12, 2025)	4
<i>Microsoft Corp. v. XI Discovery, Inc.</i> , IPR2025-00253, Paper 13 (PTAB June 25, 2025)	4

IPR2025-01228	
U.S. Patent No. 11,905,896	
<i>Parson Xtreme Golf LLC v. Taylor Made Golf Co. Inc.</i> ,	
No. 17-cv-03125, ECF No. 187 (D. Ariz. Nov. 29, 2018)	12
<i>POSCO Co. v. ArcelorMittal</i> ,	
IPR2025-00370, Paper 10 (PTAB June 25, 2025)	11, 13, 17
<i>Sand Revolution II, LLC v. Cont’l Intermodal Grp. – Trucking LLC</i> ,	
IPR2019-01393, Paper 24 (PTAB June 16, 2020)	14
<i>Shenzhen Tuozhu Tech. Co. v. Stratasy, Inc.</i> ,	
IPR2025-00438, Paper 10 (PTAB July 17, 2025)	3, 16
<i>Sotera Wireless, Inc. v. Masimo Corp.</i> ,	
IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020)	15
<i>TankLogix, LLC v. SitePro, Inc.</i> ,	
IPR2025-00650, Paper 10 (PTAB July 31, 2025)	8
<i>Tesla, Inc. v. Charge Fusion Techs., LLC</i> ,	
IPR2025-00152, Paper 11 (PTAB June 12, 2025)	4
<i>Tesla, Inc. v. Intell. Ventures II LLC</i> ,	
IPR2025-00339, Paper 10 (PTAB June 13, 2025)	16
<i>Tesla, Inc. v. Sec’y of the Navy ex rel. United States</i> ,	
IPR2025-00341, Paper 12 (PTAB June 13, 2025)	16
<i>USAA Fed. Savings Bank v. PACid Techs., LLC</i> ,	
IPR2025-00697, Paper 9 (PTAB Aug. 14, 2025)	12
<i>WebGroup Czech Republic, A.S. v. Dish Techs. LLC.</i> ,	
IPR2025-00467, Paper 14 (PTAB July 16, 2025)	8
<i>Xencor, Inc. v. Merus N.V.</i> ,	
IPR2025-00604, Paper 12 (PTAB July 17, 2025)	4
Statutes	
35 U.S.C. §325(d)	18, 20

UPDATED EXHIBIT LIST

EX1001	U.S. Patent No. 11,905,896 (“the ’896 Patent”)
EX1002	File History for U.S. Patent No. 11,905,896 (“the ’896 File History”)
EX1003	Declaration of Dr. Eric S. Winkel
EX1004	JP2005330867 (Original) (“Fujisawa”)
EX1005	Certified Translation of JP2005330867 (“Fujisawa”)
EX1006	Duro Max XP4400EH Operator’s Manual (“DuroMax”)
EX1007	Declaration of David Raskin (dated May 7, 2025)
EX1008	JPS61283734A (Original) (“Nakafushi”)
EX1009	Certified Translation of JPS61283734A (“Nakafushi”)
EX1010	U.S. Patent No. 5,301,644 (“Olmr”)
EX1011	U.S. Patent No. 7,481,087 (“DeVries”)
EX1012	U.S. Patent No. 1,931,698 (“Holzapfel”)
EX1013	U.S. Patent No. 9,435,273 (“the ’273 Patent”)
EX1014	<i>Switch</i> , MERRIAM-WEBSTER, https://www.merriam-webster.com/dictionary/switch (last updated Mar. 31, 2025)
EX1015	<i>Selector Switch</i> , MERRIAM-WEBSTER, https://www.merriam-webster.com/dictionary/selector%20switch (last visited Apr. 8, 2025)
EX1016	<i>Switch</i> , CAMBRIDGE DICTIONARY, https://dictionary.cambridge.org/us/dictionary/english/switch (last visited Apr. 4, 2025)
EX1017	<i>Switch</i> , THE FREE DICTIONARY, https://www.thefreedictionary.com/switch (last visited Apr. 14, 2025)
EX1018	RUDOLF F. GRAF, MODERN DICTIONARY OF ELECTRONICS (Charlie Buffington & Jack Davis eds., Butterworth-Heinemann 6th ed. 1997) (1984)
EX1019	TONY ATKINS & MARCEL ESCUDIER, OXFORD DICTIONARY OF MECHANICAL ENGINEERING (2013)
EX1020	S.B. CHOPRA, ANMOL’S DICTIONARY OF MECHANICAL ENGINEERING (1989)
EX1021	MCGRAW-HILL DICTIONARY OF MECHANICAL AND DESIGN ENGINEERING (Sybil P. Parker et al. eds., 1984)
EX1022	G.H.F. NAYLER, DICTIONARY OF MECHANICAL ENGINEERING (rev. ed. 2006)
EX1023	Complaint, <i>Champion Power Equipment, Inc. v. Generac Power Systems, Inc.</i> , No. 24-cv-1281, Dkt. 1 (E.D. Wis., filed Oct. 9, 2024)

EX1024	<i>Powermate DF3500E – 3500 Watt Electric Start Dual Fuel Portable</i> , ELECTRIC GENERATORS DIRECT, https://www.electricgeneratorsdirect.com/Powermate-6957-Portable-Generator/p72548.html (last visited Apr. 4, 2025)
EX1025	U.S. Patent No. 4,492,207 (“Hallberg”)
EX1026	[intentionally omitted]
EX1027	U.S. Patent No. 10,598,101 (“the ’101 Patent”)
EX1028	File History for U.S. Patent No. 10,598,101 (“the ’101 File History”)
EX1029	Castell Safety Int’l Ltd., <i>Castell Interlocks: How They Work</i> , YOUTUBE (Apr. 14, 2009), https://www.youtube.com/watch?v=CpNy6u5GssA
EX1030	Screenshots and Video Transcript of Castell Safety Int’l Ltd., <i>Castell Interlocks: How They Work</i> , YOUTUBE (Apr. 14, 2009), https://www.youtube.com/watch?v=CpNy6u5GssA
EX1031	U.S. Patent No. 9,175,601 (“Markoski”)
EX1032	FORD MOTOR CO., 2004 SERVICE MANUAL: POWERTRAIN CONTROL/EMISSIONS DIAGNOSIS: ON BOARD DIAGNOSTICS BI-FUEL LPG TRUCK (Aug. 2003)
EX1033	U.S. Patent No. 1,827,214 (“Sturm”)
EX1034	U.S. Patent No. 4,641,625 (“Smith”)
EX1035	U.S. Patent No. 6,276,345 (“Nelson”)
EX1036	U.S. Patent No. 2,645,570 (“Anderson”)
EX1037	U.S. Patent No. 2,945,111 (“McCormick”)
EX1038	[Intentionally Omitted]
EX1039	U.S. Patent No. 8,040,663 (“Czarnecki”)
EX1040	WILLIAM A. SCHUSTER, SMALL ENGINE TECHNOLOGY (2d ed. 1999)
EX1041	Neil B. Hampson & Jennette L. Zmaeff, <i>Carbon Monoxide Poisoning from Portable Electric Generators</i> , 28 AM. J. PREVENTIVE MED. 123 (2005)
EX1042	H. Windawi, <i>Controlling the Exhaust Emissions from Alternative Fuel Vehicles: New Opportunity for Platinum Metals Catalysts</i> , 36 PLATINUM METALS REV. 185 (1992)
EX1043	MARTY AHRENS, NAT’L FIRE PROT. ASS’N, U.S. VEHICLE FIRE TRENDS AND PATTERNS (2010)
EX1044	<i>Selector Switch</i> , THE FREE DICTIONARY https://www.thefreedictionary.com/selector+switch (last visited Apr. 14, 2025)

EX1045	Engineering Explained, <i>Why Cars Backfire - Afterfire - Explained</i> , YOUTUBE (Feb. 13, 2013), https://www.youtube.com/watch?v=bgS3PA5r0vY
EX1046	Screenshots and Video Transcript of Engineering Explained, <i>Why Cars Backfire - Afterfire - Explained</i> , YOUTUBE (Feb. 13, 2013), https://www.youtube.com/watch?v=bgS3PA5r0vY
EX1047	Shivansh Sabhadiya, <i>What Causes Backfire in an Engine?</i> , ENGINEERING CHOICE, https://www.theengineeringchoice.com/what-causes-car-backfire/ (last visited Apr. 15, 2025)
EX1048	U.S. Patent No. 4,489,699 (“Poehlman”)
EX1049	U.S. Patent Application Publication No. 2007/0137591 (“Sugimoto”)
EX1050	Declaration on Mina Ching (dated Apr. 22, 2025)
EX1051	Champion’s Infringement Contentions for U.S. Patent No. 11,905,896 as Asserted Against General Model DF3500E et al. (served Apr. 15, 2025)
EX1052	File History for U.S. Patent No. 11,306,667 (“the ’667 File History”)
EX1053	File History for U.S. Patent No. 11,761,390 (“the ’390 File History”)
EX1054	Answer and Counterclaims, <i>Harbor Freight Tools USA Inc. v. Champion Power Equipment, Inc.</i> , No. 24-cv-8722, Dkt. 47 (C.D. Cal., answer filed Feb. 27, 2025)
EX1055	Order on Defendant/Counter-Claimant's Motion for Partial Stay, <i>FaceTec, Inc. v. iProov, Ltd.</i> , No. 21-cv-2252, Dkt. 188 (D. Nev., order dated June 18, 2025)
EX1056	Docket Navigator Statistics Regarding Judge Adelman's Grant Rate for Motions to Stay
EX1057	Docket Navigator Statistics Regarding Grant Rate for Motions to Stay in Eastern District of Wisconsin
EX1058	Docket Navigator Statistics Regarding Motions to Stay in District of Nevada
EX1059	Declaration of Eric Huang (dated Sept. 12, 2025)
EX1060	Order, <i>Parsons Xtreme Golf LLC v. Taylor Made Golf Co.</i> , No. 17-cv-3125, Dkt. 187 (D. Ariz., order dated Nov. 29, 2018)
EX1061	Email from Taylor R. Stemler to Jennifer Hoekel et al. (Aug. 13, 2025)
EX1062	Docket Navigator Statistics Regarding Grant Rate for Uncontested Motions to Stay in Eastern District of Wisconsin
EX1063	Docket Navigator Statistics Regarding Grant Rate for Uncontested Motions to Stay in District of Nevada
EX1064	Docket Navigator Time to Trial Statistics for District of Nevada

EX1065	Docket Navigator Time to Milestone Statistics for Judge Adelman
EX1066	Docket Navigator Time to Milestone Statistics for Eastern District of Wisconsin
EX1067	Docket Navigator Time to Milestone Statistics for Central District of California
EX1068- EX1069	[intentionally omitted]
EX1070	Memorandum in Support of Plaintiff's Motion to Sever Defendant's Counterclaims for Infringement or in the Alternative for Leave to File an Amended Answer and Counter-Counterclaim, <i>Champion Power Equipment, Inc. v. Generac Power Systems, Inc.</i> , No. 24-cv-1281, Dkt. 38 (E.D. Wis. July 3, 2025)
EX1071- EX1080	[intentionally omitted]
EX1081	U.S Patent No. 8,757,139 (“Deng”)
EX1082	Excerpts from File History for U.S. Patent Application No. 18/443,530 (“the ’530 Application File History”)
EX1083	Amended Scheduling Order, <i>Champion Power Equipment, Inc. v. Generac Power Systems, Inc.</i> , No. 24-cv-01281, Dkt. 59 (E.D. Wis. Sept. 17, 2025)

I. INTRODUCTION

Petitioners oppose Patent Owner Champion Power Equipment Inc.’s (“Patent Owner”) request for discretionary denial. (Paper 14 (hereinafter “RDD”)).

The Director recently referred the “closely related”¹ ’034 Patent IPR and the great grandparent ’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 from consolidating multiple litigations involving many patents and the Examiner’s material error during prosecution. ’034 Referral Decision at 2-3.

“Patent Owner has sued a large number of parties in a multitude of districts.” ’034 Referral Decision at 2. Petitioners filed thirteen IPRs challenging all 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 resources, especially since none of the three litigations have trial dates and any trials are expected to occur after a FWD here. *Id.*; *see also* ’101 Referral Decision at 2.

Additionally, the ’896 Patent was improperly granted due to a critical

¹ *See* IPR2025-00951, Paper 8 (Patent Owner describing its 2015 Patent family—of which the ’034 Patent is a member as “closely related” to its 2013 Patent family—of which the ’101 and ’896 Patents are members).

Examiner oversight. The Examiner did not perform a particularized analysis for the claims of the '896 Patent. As a result, the Examiner failed to consider the Honda EU20i Video (EX2076), which anticipates at least Claim 15-17. The Examiner also failed to consider U.S. Patent No. 8,757,139 ("Deng," EX1081), which anticipates at least Claim 30. Instituting this IPR would correct these material errors through consideration of De Vries and Fujisawa, which teach valve assemblies with valve handle(s) and two inputs and outputs controlled by a selector switch.

Furthermore, Patent Owner has no settled expectations in the '896 Patent. It is only 17 months old, four years younger than the referred '034 and '101 Patents. Petitioners' forceful rebuke of Patent Owner's enforcement attempts for the parent '101 Patent eliminates Patent Owner's expectations in the '896 Patent.

Finally, none of the *Fintiv* factors favor discretionary denial, and in fact, a majority of the *Fintiv* factors weigh strongly against discretionary denial.

In sum, when holistically assessing the facts, evidence, circumstances, and other considerations, discretionary denial is not appropriate. This Petition should be referred to the Board for assessment on the merits.

II. GIVEN THE NUMBER OF PARALLEL DISTRICT COURT TRIALS ACROSS DIFFERENT JURISDICTIONS, RESOLVING THE DISPUTE AT THE PTAB IS MORE EFFICIENT

"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. 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 proceed to assess invalidity of the asserted patents in four different district courts. Such piecemeal adjudication creates a 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 families involving complicated aspects of multi-fuel engine/generator designs. The vast efficiencies 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. 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 number and vast scope” of patents). Both the ’101 Patent IPR from the same patent family and the related ’034 Patent IPR have already been referred to the merits panel for these efficiencies. ’101 Referral Decision at 2; ’034 Referral Decision at 2-3. This IPR should be referred as well to realize those efficiency gains. *Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12, at 3-4 (PTAB July 26, 2025).

Patent Owner asserted 13 patents against the three Petitioners in three different district courts 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, 8-10. Petitioners filed IPR petitions against all 13 patents to streamline the invalidity challenges in a single set of IPRs and ensure consistent invalidity determinations. The combined 13 IPRs 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. The Petitions thus represent a greatly streamlined invalidity case as compared to, for example, the 69 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 also weighs heavily against discretionary denial, often overcoming facts that would otherwise have resulted in a *Fintiv* denial. *See 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); *see also Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025-00152, Paper 11, at 2-3 (PTAB June 12, 2025); *Anthony Inc. v. ControlTec, LLC*, IPR2025-00559, Paper 12, at 2 (PTAB July 16, 2025); *Microsoft Corp. v. XI Discovery, Inc.*, IPR2025-00253, Paper 13, at 2 (PTAB June 25, 2025).

In a first-action allowance, the Examiner stated that “[t]he reasons for allowance[] are given in the previous parent patents listed above” without acknowledging that the ’896 Patent claims are broader than those of its parents or performing any analysis particularized to the claims of the ’896 Patent. EX1002, 19. As a result, the same material errors from the ’101 and ’667 Patents apply here.

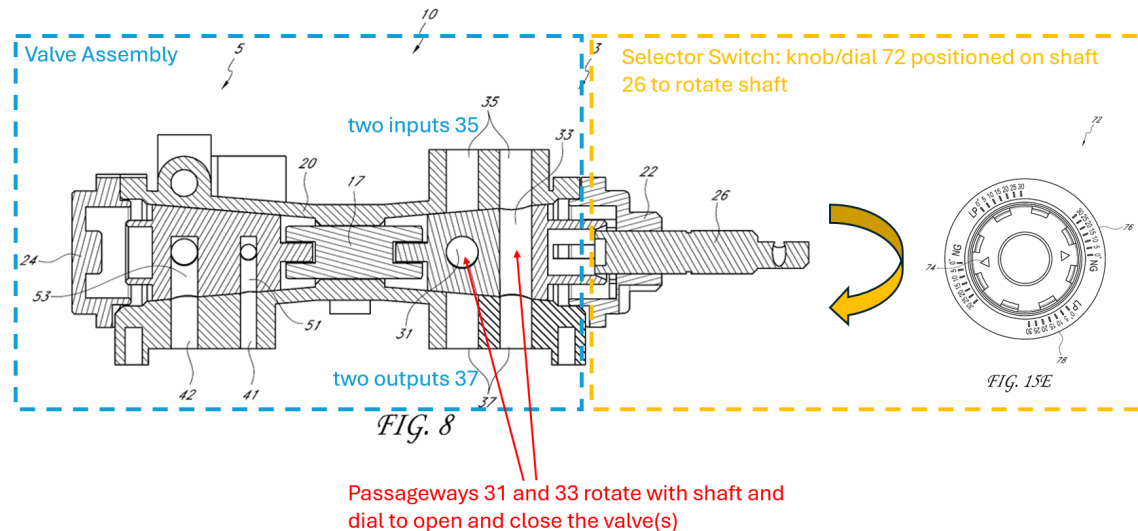
Specifically, the Examiner failed to consider the EU20i Video, cited in the great-grandparent ’101 Patent. The EU20i Video anticipates at least Claims 10-12 of the ’101 Patent. Claims 15-17 of the ’896 Patent are broader versions of these same claims and are therefore anticipated by the EU20i Video for the same reasons, as shown below. Allowance of these claims over the EU20i Video was material error.



IPR2025-00951, Paper 8, 57 (further annotated); EX2076, [1:13] (annotated).

Patent Owner argues that DuroMax is substantially the same as the dual fuel generator of the EU20i Video. RDD, 18. The DuroMax grounds similarly invalidate the ’896 Patent claims, and instituting the Petition will allow the Board to correct this material error. *See* Petition, Grounds 1-2.

Furthermore, the Examiner never considered Deng, cited with the grandparent '667 Patent, which discloses a fuel selector including all of the elements recited in Claim 30 of the '896 Patent, as shown below. This was also material error.



EX1081, 8:56-64, 10:10-40, 14:61-15:11, FIGS 8, 15E (annotated).

The Examiner recognized this error in U.S. Patent Application No. 18/443,530 (“the ’530 Application”), a pending continuation of the ’896 Patent. There, considering a claim that is even narrower than Claim 30 of the ’896 Patent (shown below), the Examiner found the Sportsman Video (which teaches an analogous selector switch and dual fuel valve arrangement to Deng) teaches a manually actuated selector switch on a valve assembly with two inputs and outputs, making the Sportsman Video “read as a 102(a)(1) reference for claim 10” of the ’530 Application EX1082, 67. These same findings apply equally to the ’896 Patent and have never been traversed or contested by Patent Owner.

'896 Patent, Claim 30 (Broader)	'530 Application, Claim 10
[30.0] A fuel selector for use with a dual fuel generator, the fuel selector comprising:	[10.0] A fuel selector for use with a dual fuel generator, the fuel selector comprising:
[1.1] a valve assembly fluidly couplable to each of a first fuel source and a second fuel source and operable to selectively control a first fuel flow and a second fuel flow from the first fuel source and the second fuel source, respectively, to an engine of the dual fuel generator, the valve assembly comprising:	[10.1] a valve assembly fluidly couplable to each of a first fuel source and a second fuel source and operable to selectively control a first fuel flow and a second fuel flow from the first fuel source and the second fuel source, respectively, to an engine of the dual fuel generator, the valve assembly comprising:
[30.2] two fuel inputs comprising: a first fuel input couplable to the first fuel source; and a second fuel input couplable to the second fuel source; and two fuel outputs configured to selectively supply fuel to the engine from the first fuel source or the second fuel source; and	[10.2] at least one fuel valve comprising open and closed positions to selectively control the first fuel flow or the second fuel flow to the engine; a first fuel input fluidly couplable to the first fuel source; a second fuel input fluidly couplable to the second fuel source; a first fuel output fluidly coupled to the engine to supply the first fuel flow to the engine; and a second fuel output fluidly coupled to the engine to supply the second fuel flow to the engine; and
[30.3] a selector switch positioned on the valve assembly to allow a user to manually select the first fuel flow or the second fuel flow.	[10.3] a selector switch positioned on or adjacent the valve assembly and movable between a first position and a second position to allow a user to manually select only the first fuel flow in the first position or only the second fuel flow in the second position.

EX1001, Claim 30; EX1082, 133 (Claim 10).

Instituting this IPR would permit correction of these material errors, because

Fujisawa and De Vries also supply examples of selector switches positioned on valve assemblies with two inputs and outputs. *See* Petition, Grounds 1 and 3.

IV. SETTLED EXPECTATIONS WEIGH AGAINST DISCRETIONARY DENIAL

Petitioner argues its expectations in the '896 Patent “have been settled for years.” RDD, 4. But the '896 Patent has not even been in force for years—the '896 Patent issued on February 20, 2024, only 17 months before this IPR was filed. Challenges to patents in force four times that duration are consistently characterized as “early” and “favor[ing] robust predictable patent rights and weigh[ing] against discretionary denial.” *See, e.g., TankLogix, LLC v. SitePro, Inc.*, IPR2025-00650, Paper 10, at 2 (PTAB July 31, 2025); *Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00434, Paper 11, at 2-3 (PTAB June 26, 2025); *Berkshire Hathaway*, IPR2025-00274, Paper 23, at 3; *WebGroup Czech Republic, A.S. v. Dish Techs. LLC.*, IPR2025-00467, Paper 14, at 2 (PTAB July 16, 2025).

Patent Owner appears to believe that it had settled expectations in the '896 Patent upon issuance because of its parent patents. RDD, 4. But Patent Owner does not have settled expectations in the parent patents—the great grandparent '101 Patent IPR was referred. '101 Referral Decision at 2. Patent Owner sent “cease-and-desist” letters to MWE and Generac in 2020, alleging infringement of the '101 Patent. EX2033; EX2036. Patent Owner did not raise the '101 Patent with Harbor Freight until a March 27, 2024 letter, which did not even accuse Harbor Freight of

infringing the '101 Patent. EX2038, 2. In response, both MWE and Generac informed Patent Owner that its claims were invalid. EX2034, EX2035, EX2037. MWE even told Patent Owner that it **would file an IPR** if Patent Owner further pursued its infringement claims. EX2034. Tellingly, prior to embarking on its current litigation campaign, Patent Owner never again raised the infringement issues with MWE or Generac. Under these circumstances, the only “reasonable expectation” to be taken from the prior correspondence 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.

Regardless, Patent Owner cannot develop expectations in the '896 Patent based on its ancestors. Continuations often broaden their claims relative to their parents, such that the child may be subject to invalidity attacks that are not applicable to their parents. Here, Patent Owner admits that the '667 Patent claims are broader than the '101 Patent claims. *See* IPR2025-00951, Paper 8, at 46. The '896 Patent claims are even broader. *Compare* EX1001, Claims 7, 15, 21, and 30, *with* EX1027, Claims 1, 10, 17, and 18, *respectively*.

To the extent parent-child relationships are considered, the '101 Patent IPR was already referred, making it efficient to refer the '896 Patent. For example, in *Embodiment, Inc. v. Lifenet Health*, both a parent patent and its child were challenged via IPR. IPR2025-00248, Paper 13 (PTAB June 26, 2025). The child was deemed to not

trigger settled expectations and was referred to the merits panel. The parent was also referred to the merits panel because “it is an efficient use of Board resources to address the related patent.” *Id.*, 3. Efficiency gains in the present case are particularly pronounced, given identical specifications of the directly related patents, the overlap in limitations of the child patents’ claims and those of the parent patents, and the referral of the “closely related” ’034 and ’101 Patent IPRs.

V. *FINTIV* FACTORS WEIGH AGAINST DISCRETIONARY DENIAL

This is the quintessential case for institution. All *Fintiv* factors weigh 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. 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. 21-cv-02252, Dkt. 188 (D. Nev. June 18, 2025) (attached as

EX1055). And this district has granted stays 67% of the time. EX1058.

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% (EX1057).

The Harbor Freight case is pending in the Central District of California. This district has granted stays at a 66% rate (EX1059, ¶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 indicated an openness to stays if the IPRs are referred to the Board (EX1059, ¶4; EX1061, 1), creating a high likelihood the MWE, Generac, and Harbor Freight cases will be stayed. *See, e.g.*, EX1062 (showing that all uncontested stays have been granted in EDWI); EX1063 (same 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

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.

on similar facts. *See Parson Xtreme Golf LLC v. Taylor Made Golf Co. Inc.*, No. 17-cv-03125, ECF No. 187 (D. Ariz. Nov. 29, 2018) (attached as EX1060).

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. The lack of trial dates weighs against discretionary denial, especially where a FWD will reduce the chances of inconsistent outcomes among numerous tribunals. *USAA Fed. 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. EX1064. Even using the shorter median, the data suggests a trial date at the end of 2028, nearly 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. EX1065. A similar timeline here would place trial around April 2028 – over a year after the FWD. Even if the district’s overall median time-to-trial of 34 months is considered (EX1066), trial would not be expected to occur until August 2027, seven months after the FWD. The Generac court also recently extended its case schedule, further delaying this parallel proceeding. EX1083.

Regarding the Harbor Freight case, Patent Owner references a prior proposed schedule (RDD, 9-10), 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, eight months after the FWD. EX1067, 1.

2. The Firman Case

The Firman case does not support discretionary denial because Petitioners are not a party to the Firman case, and Firman is not a privy or real-party-in-interest in this IPR. *POSCO*, IPR2025-00370, Paper 10, at 2-3. Nonetheless, Patent Owner alleges the Firman trial will occur before the FWD date. RDD, 11. However, the Firman case is already running significantly behind schedule. Specifically, Patent Owner’s own exhibit indicates a median time to claim construction of 15.7 months (EX2047, 1-2), suggesting a claim construction ruling should have occurred in February 2025. Yet now, as of October 2025, no *Markman* hearing has even been scheduled. Thus, the Firman case is already running at least **eight months** behind

schedule compared to the statistics Patent Owner relies upon for its prediction. As a result, any trial in the Firman case will likely occur well after the FWD.

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

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, 13.

Similarly, Patent Owner recently described the Generac case as being in its “infancy.” EX1070, 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. 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).

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.

EX2058; EX2059; EX2069.

These stipulations extend far beyond the more typical *Sotera*-type stipulation³

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

IPR2025-01228

U.S. Patent No. 11,905,896

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 LLC*, 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, 14. 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** of 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 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, this factor clearly weighs strongly against discretionary denial. ’034 Referral Decision at 2; *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, 16. 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

Multiple considerations under Factor 6 weigh strongly against discretionary denial. Patent Owner’s arguments for Factor 6 (RDD, 16-17) overlook or sidestep the most important considerations, as discussed below and in §§II–IV above.

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, 16. 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 '896 Patent,
Which Weighs Against Discretionary Denial**

The '896 Patent's claims have not been reexamined, reissued, or otherwise adjudicated in any other forum to Petitioners' knowledge. Nor are they 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 further discussed below.

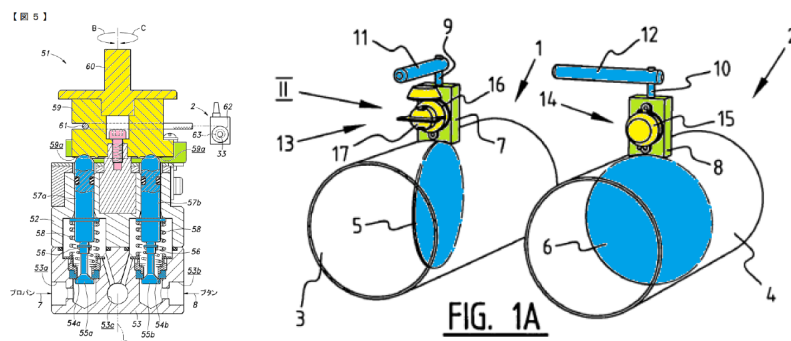
A. The Prior Art in the Petition is Not the Same nor Substantially the Same as the Art Previously Considered by the Office

Patent Owner argues that Fujisawa and De Vries are substantially similar to Monros or Deutsch. RDD, 18-19. But this is contradicted by the arguments Patent Owner made during prosecution that (1) the prior art failed to teach a dual-valve valve assembly with mechanical valves, and (2) it would not be obvious to position an electronic “selector switch” on a valve assembly. During prosecution, Patent Owner distinguished Poehlman for teaching electrical valves and “fail[ing] to teach or suggest ... a valve assembly comprising first and second valves that are mechanical valves.” EX1028, 126. Patent Owner distinguished Sugimoto for teaching a single fuel valve rather than “separate first and second fuel valves each having open and closed positions.” *Id.*, 129. Patent Owner further argued that a POSA would be motivated to position Poehlman's electronic “selector switch” away

from its valve assembly “to shield the switch contacts from the fuel that flows through” the valve assembly. *Id.*, 181-182.

Monros teaches a single-valve configuration with an electronic switch and suffers from the same deficiencies as Poehlman. EX2061. Specifically, Monros discloses an electronic microcontroller switch positioned “on the dashboard inside the car” rather than on the valve assembly. *Id.*, ¶[0025]. Deutsch also teaches a similar electronic switch. EX2060, ¶[0040]. Champion’s arguments regarding the type of valve, number of valves, and the positioning of the electronic switch relative to the valves with respect to Poehlman and Sugimoto apply equally to Monros’ and Deutsch’s electronic switches.

Unlike Poehlman, Sugimoto, Monros, and Deutsch—Fujisawa and De Vries both teach a selector switch (yellow) positioned on a pair of mechanical valves (blue). Thus, Fujisawa and De Vries are materially different from Monros and Deutsch because they teach the specific claim elements present in the independent claims of the ’896 Patent that Patent Owner argued were missing from the prior art.



EX1004, FIG. 5 (annotated); EX1011, FIG. 1A (annotated).

Patent Owner's remaining arguments are directed towards prior art that was not substantively addressed or applied in the same way as the references in the Petition. DuroMax, Nakafushi, and Olmr become centrally relevant after they are combined with Fujisawa or De Vries. Since the Examiner did not have Fujisawa and De Vries, the Examiner did not have the opportunity to consider the arguments raised under the grounds presented in the petition.

B. The Office Materially Erred in Overlooking the EU20i Video and Deng, As Recognized in the '530 Application

The Office materially erred in overlooking the EU20i Video and Deng. *Supra* §III. Discretionary denial is therefore unwarranted under §325(d). *See Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 at 5 (PTAB May 19, 2025).

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.

IPR2025-01228
U.S. Patent No. 11,905,896
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on October 20, 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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