

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,
Petitioner,

v.

CHAMPION POWER EQUIPMENT, INC.,
Patent Owner.

IPR2025-01271
Patent 10,697,398

**PATENT OWNER CHAMPION POWER EQUIPMENT, INC.'S
PRELIMINARY RESPONSE**

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	OVERVIEW OF THE '398 PATENT	2
A.	The Specification of the '398 Patent	3
B.	The Independent Claims of the '398 Patent.....	4
1.	Claim 1.....	4
2.	Claim 23.....	5
3.	Claim 43.....	5
4.	Claim 57.....	6
III.	LEVEL OF ORDINARY SKILL IN THE ART.....	6
IV.	CLAIM CONSTRUCTION	7
V.	ARGUMENT.....	9
A.	Petitioner's inconsistent claim construction positions support denial.	10
B.	Petitioner's inconsistent indefiniteness arguments support denial. ...	12
VI.	CONCLUSION.....	15

TABLE OF AUTHORITIES

CASES

<i>Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH</i> , IPR2019-01469, Paper 6 (P.T.A.B. Feb. 13, 2020).....	1, 2
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020).....	1
<i>Facebook, Inc. v. Sound View Innovations, LLC</i> , IPR2017-01005, Paper No. 13 (P.T.A.B. Sept. 1, 2017).....	7
<i>Nautilus, Inc. v. Biosig Instruments, Inc.</i> , 572 U.S. 898 (2014).....	14
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005)	7
<i>Revvo Techs., Inc., v. Cerebrum Sensor Techs., Inc.</i> IPR2025-00632, Paper 20 (P.T.A.B. November 3, 2025).....	10, 11, 13, 14
<i>Tesla, Inc. v. Intell. Ventures II LLC</i> , IPR2025-00340, Paper 18 (P.T.A.B. November 5, 2025).....	13, 15
<i>Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.</i> , 200 F.3d 795 (Fed. Cir. 1999)	7

OTHER AUTHORITIES

Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340 (Oct. 11, 2018)	10
John A. Squires, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, Director Institution of AIA Trial Proceedings (October 17, 2025), https://www.uspto.gov/sites/default/files/documents/Director_Institution_of_AI A_Trial_Proceedings.pdf	9

REGULATIONS

37 C.F.R. § 42.107	1
--------------------------	---

STATUTES

35 U.S.C. § 314(a)	1
35 U.S.C. § 325(d)	1

TABLE OF EXHIBITS

Exhibit #	Description
EX2001	Docket for Champion Power Equipment, Inc. v. Firman Power Equipment Inc., Case No. 2:23-cv-02371 (D. Az.) (“Firman Case”)
EX2002	Firman Case, Case Management Order, ECF No. 33
EX2003	Firman Case, First Amended Complaint, ECF No. 24
EX2004	<i>Reserved</i>
EX2005	Firman Case, Firman’s Motion to Amend Invalidity Contentions, ECF No. 115
EX2006	Firman Case, Declaration and Exhibit, ECF No. 116
EX2007	Firman Case, Order Granting Leave to Amend, ECF No. 124
EX2008	<i>Reserved</i>
EX2009	Firman’s Nov. 2024 Subpoena to third-party Generac (Firman Case)
EX2010	<i>Reserved</i>
EX2011	Generac Case, Generac’s First Amended Answer and Counterclaims, ECF No. 30
EX2012	<i>Reserved</i>
EX2013	Defendant Generac’s Feb. 14, 2025 Subpoena to third-party Firman
EX2014	<i>Reserved</i>
EX2015	
EX2016	Docket for Harbor Freight Case (C.D. Cal.)
EX2017	Harbor Freight Case, Complaint for Declaratory Judgment, ECF No. 1
EX2018	Harbor Freight Case, Champion’s Answer and Counterclaims, ECF No. 47
EX2019	Harbor Freight Case, Harbor Freight’s Answer to Counterclaims, ECF No. 55
EX2020	Harbor Freight Case, Joint R26 Report, ECF No. 38
EX2021	<i>Reserved</i>
EX2022	
EX2023	Harbor Freight’s Mar. 10, 2025 Subpoena on third-party Firman
EX2024	<i>Reserved</i>
EX2025	
EX2026	
EX2027	
EX2028	
EX2029	Generac Case, Complaint, ECF No. 1

Exhibit #	Description
EX2030	<i>Reserved</i>
EX2031	Sept. 9, 2019 Letter from Champion to Firman
EX2032	<i>Reserved</i>
EX2033	June 23, 2020 Letter from Champion to MWE
EX2034	July 31, 2020 MWE Response Letter
EX2035	Oct. 17, 2020 MWE Responsive Letter
EX2036	July 7, 2020 Letter from Champion to Generac
EX2037	July 31, 2020 Generac Response Letter
EX2038	March 27, 2024 Letter from Champion to Harbor Freight
EX2039	June 28, 2024 Letter from Champion to Harbor Freight
EX2040	<i>Reserved</i>
EX2041	
EX2042	
EX2043	
EX2044	Kubota DF-972 Information Sheet
EX2045	<i>Reserved</i>
EX2046	
EX2047	Docket Navigator - Time to Milestones for D. Az. (Trial)
EX2048	Docket Navigator - Time to Milestones for E.D. Wis. (Trial)
EX2049	<i>Reserved</i>
EX2050	
EX2051	MWE Case, Complaint, ECF No. 1
EX2052	<i>Reserved</i>
EX2053	
EX2054	Champion's Patent Statement and Licensing Declaration Form, July 1, 2021
EX2055	Firman's August 30, 2024 Invalidity Contentions
EX2056	<i>Reserved</i>
EX2057	
EX2058	
EX2059	
EX2060	
EX2061	
EX2062	US5809979 ("Kubota Patent")
EX2063	<i>Reserved</i>
EX2064	Champion September 26, 2014 Internal Email

Exhibit #	Description
EX2065	Firman Case, Champion's Motion to Amend Infringement Contentions, ECF No. 198
EX2066	<i>Reserved</i>
EX2067	
EX2068	
EX2069	
EX2070	Generac Case, Exhibit 3 – webpage, ECF No. 30-03
EX2071	Wayback Machine, http://pgmaonline.com/members.asp , dated July 29, 2013
EX2072	<i>Reserved</i>
EX2073	Firman Case, Order, ECF No. 141
EX2074	Generac's April 23, 2025 Responses to Plaintiff's First Set of Interrogatories
EX2075	Screenshots from Honda EU20i LPG video, https://www.youtube.com/watch?v=yBpq33aJmR0
EX2076	YouTube Video, HONDA EU20i LPG, https://www.youtube.com/watch?v=yBpq33aJmR0
EX2077	US3384059 ("Kopa")
EX2078	<i>Reserved</i>
EX2079	
EX2080	
EX2081	
EX2082	File History of U.S. Patent App. No. 14/925,441
EX2083	August 29, 2025 Stipulation from MWE
EX2084	August 29, 2025 Stipulation from Harbor Freight
EX2085	September 2, 2025 Stipulation from Generac
EX2086	US10221780 ("the '780 Patent")
EX2087	Declaration of Scott P. Amy in Support of Patent Owner's Notice of Intent to Designate a Provisionally Recognized PTAB Attorney as Backup Counsel
EX2088	US9435273 ("the '273 Patent")
EX2089	<i>Reserved</i>
EX2090	
EX2091	
EX2092	
EX2093	
EX2094	Generac Case, Affidavit of Service, ECF No. 4

Exhibit #	Description
EX2095	<i>Reserved</i>
EX2096	
EX2097	<i>Reserved</i>
EX2098	Excerpts from File History of U.S. Patent No. 11,143,120
EX2099	Generac Case, Amended Scheduling Order, ECF No. 59
EX2100	<i>Reserved</i>
EX2101	
EX2102	
EX2103	
EX2104	
EX2105	
EX2106	
EX2107	
EX2108	
EX2109	
EX2110	Harbor Freight Case, HFT's Opening Claim Construction Brief
EX2111	<i>Reserved</i>
EX2112	US5419291 ("Kimata")
EX2113	Generac Case, Generac's Supplemental Preliminary Invalidity Contentions, dated 2025-09-25 (redacted)
EX2114	<i>Reserved</i>
EX2115	
EX2116	
EX2117	
EX2118	
EX2119	
EX2120	
EX2121	
EX2122	
EX2123	
EX2124	Harbor Freight Case, HFT's Supplemental Claim Construction Brief, ECF 101

GLOSSARY

Abbreviation	Term
2015 Family	U.S. Patent Nos.: 10,393,034; 11,143,120; 10,221,780; 11,492,985; 10,697,398; 11,530,654; 11,840,970; 11,905,895; and 11,143,145 (collectively)
'398 Patent	U.S. Patent No. 10,697,398
Board	Patent Trial and Appeal Board
Challenged Claims	Claims 1-17, 19-26, 32-46, 53-54, and 56-58 of the '398 Patent
Firman	Firman Power Equipment, Inc.
Generac	Generac Power Systems, Inc.
HFT	Harbor Freight Tools USA, Inc.
MWE	MWE Investments, LLC
Patent Owner	Champion Power Equipment, Inc.
Petition	Petition for Inter Partes Review of U.S. Patent No. 10,697,398 (Paper 4)
Petitioner	HFT, Generac, and MWE, collectively
POSITA	Person of Ordinary Skill in the Art
USPTO	United States Patent & Trademark Office

Pursuant to 37 C.F.R. § 42.107, Patent Owner Champion Power Equipment, Inc. hereby submits its Preliminary Response to the Petition filed by Harbor Freight Tools USA, Inc., Generac Power Systems, Inc., and MWE Investments, LLC (collectively, “Petitioner”), challenging Claims 1-17, 19-26, 32-46, 53-54, and 56-58 of U.S. Patent No. 10,697,398

I. INTRODUCTION

Petitioner’s proposed grounds are identified below:

Ground	Claims	Basis	Primary Reference	Secondary Reference(s)
1	1, 3, 22, 57	102	Workshop Manual	-
2	2, 4-14, 19-21, 23, 32-42, 58	103	Workshop Manual	Matsushima, Yamamoto, and Olmr
3	1, 3, 22, 57	102	Nakafushi	-
4	2, 4-14, 19-21, 23, 32-42, 58	103	Nakafushi	Matsushima, Yamamoto, and Olmr
5	1, 15-16, 43-44	102	Holzapfel	-
6	43-46, 56	102	Neal	-
7	43-46, 53-54, 56	102	Winberg	-
8	17, 23-26	103	Holzapfel	Neal, Yamamoto
9	17, 23-26	103	Holzapfel	Winberg, Yamamoto

Discretionary denial pursuant to 35 U.S.C. § 314(a), 35 U.S.C. § 325(d), and the *Fintiv* and *Advanced Bionics* factors¹ is warranted for the reasons set forth in

¹ *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020)

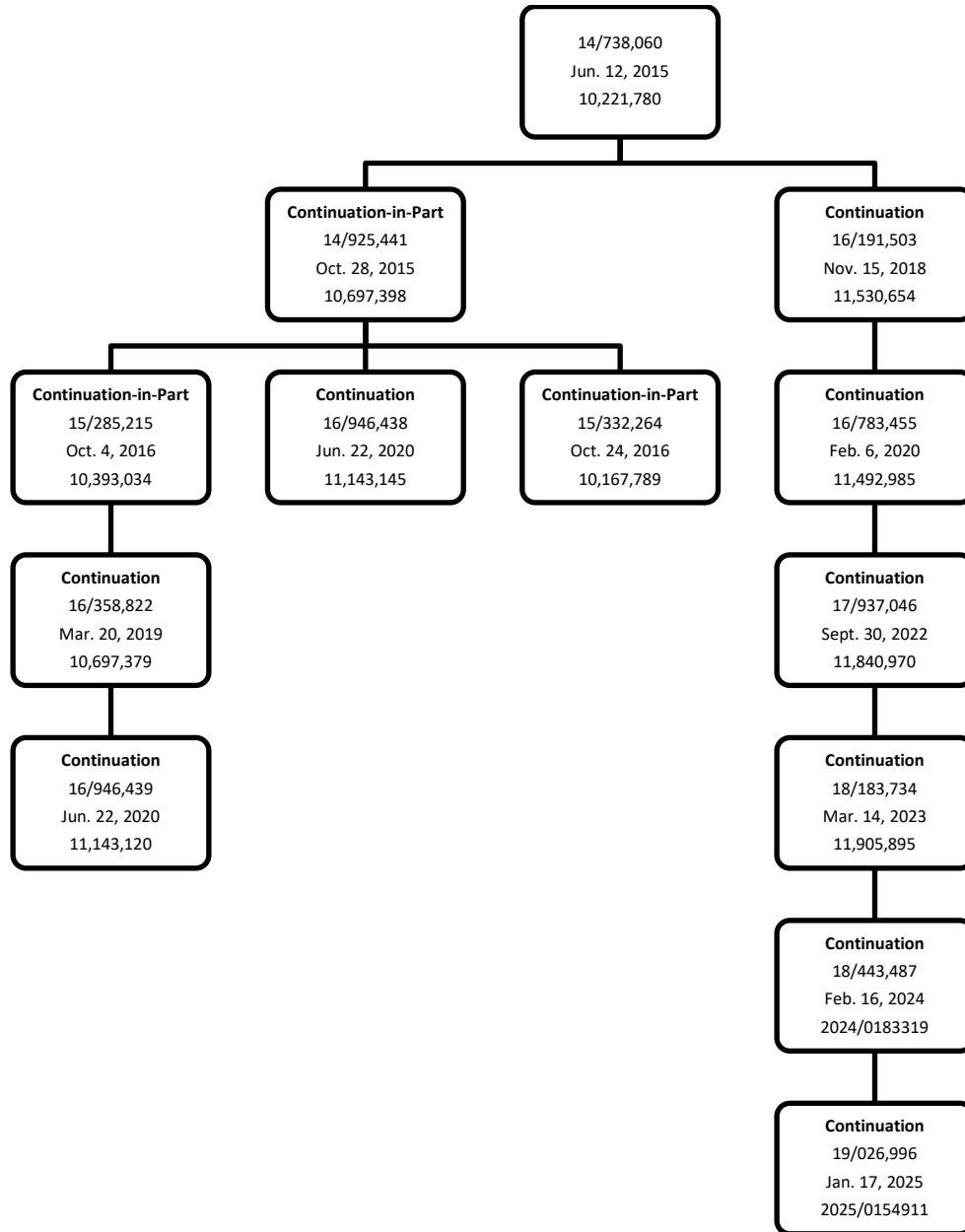
Patent Owner's Brief in Support of its Request for Discretionary Denial of Institution
(Paper 9).

Moreover, denial is appropriate because of inconsistencies between Petitioner's claim construction positions before the Board and in multiple district court proceedings. For example, the Petition improperly relies on the plain and ordinary meaning of terms which Petitioner construed in parallel district court litigation, and Petitioner's district court indefiniteness arguments inherently contradict the Petition. Each argument is discussed in turn, below, and presents an independent basis for denial.

II. OVERVIEW OF THE '398 PATENT

The '398 Patent was filed as U.S. Patent Application No. 14/925,441 on October 28, 2015. EX1001, (21), (22). The '398 Patent is one of thirteen members of a patent family directed to multi-fuel engine technology, which are collectively referred to as the "2015 Family." The 2015 Family is depicted below:

(precedential); *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (P.T.A.B. Feb. 13, 2020) (precedential).



A. The Specification of the '398 Patent

The '398 Patent, titled “Batteryless Dual Fuel Engine with Liquid Fuel Cut-Off,” is directed to a liquid fuel cut-off attached to a carburetor to interrupt liquid fuel upon actuation of the switch from liquid fuel to gaseous fuel. *Id.*, Abstract. The '398 Patent explains that:

In order to provide the liquid and gaseous fuel to the engine, the dual fuel engine may have a first fuel line for liquid fuel and a second fuel line for gaseous fuel. A liquid fuel source and a gaseous fuel source may be coupled to the respective lines to provide fuel to the engine. However, a common problem with such configurations that couple two fuel sources to a single engine is the engine can experience overly rich air-fuel ratio when both fuels are simultaneously engaged during cross-over switching between the fuel sources. Such simultaneous delivery of fuel from the first fuel line and the second fuel line may make the engine hard to start or lead to unstable operating conditions. Further, a float bowl in the carburetor that must first fill or empty prior to changeover causes delay in cross-over switching between the fuel sources.

Therefore, it would be desirable to design a dual fuel generator having a liquid fuel and gaseous fuel delivery system that overcomes the aforementioned detriments without substantially increasing the overall cost of the system.

Id., 1:53-2:4.

B. The Independent Claims of the '398 Patent

Claims 1, 23, 43, and 57 are reproduced below:

1. Claim 1.

1. A dual fuel engine comprising:

an engine operable on a gaseous fuel and a liquid fuel;

a switch to change operation of the engine between gaseous fuel and liquid fuel;

- a carburetor attached to an intake of the engine to mix air and fuel and connect to a gaseous fuel source and a liquid fuel source;
- 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; and
- a liquid fuel cut-off incorporated into the carburetor to interrupt liquid fuel upon actuation of the switch from liquid fuel to gaseous fuel.

2. Claim 23.

23. A batteryless dual fuel generator comprising:

- a housing containing a pull start engine coupled to drive an alternator, the engine operable on a gaseous fuel and a liquid fuel;
- a carburetor attached to an intake of the engine comprising:
 - a throat to mix fuel with air,
 - a float bowl, and
 - a fuel passage extending from the float bowl to the throat to provide liquid fuel; and
- a fuel shutoff attached to the carburetor to close the fuel passage upon selection of engine operation to gaseous fuel.

3. Claim 43.

43. A carburetor having a fuel shutoff comprising:

- a carburetor comprising:
 - a float bowl,
 - a throat, and
 - a fuel passage extending from the float bowl to the throat; and

a fuel shutoff coupled to the carburetor having a first end in the carburetor that actuates to close the fuel passage and a second end external to the carburetor to actuate the first end; and wherein the fuel shutoff actuates free from linear motion.

4. Claim 57.

57. A method of assembling a dual fuel engine comprising:
providing an engine operable on a gaseous fuel and a liquid fuel;
attaching a carburetor to an intake of the engine, the carburetor comprising:
a throat to mix gaseous fuel with air and liquid fuel with air,
a float bowl, and
a fuel passage extending from the float bowl to the throat to provide liquid fuel;
coupling a switch to the engine to change operation of the engine between gaseous fuel and liquid fuel; and
attaching a liquid fuel cut-off to the carburetor to close the fuel passage upon actuation of the switch from liquid fuel to gaseous fuel.

III. LEVEL OF ORDINARY SKILL IN THE ART

A POSITA pertinent to the Challenged Claims would have a four-year degree in mechanical engineering or a closely related field and at least one year of experience designing, developing, servicing, or operating fuel-powered machinery. Additional education could substitute for professional experience and significant

work experience—such as working with, servicing, or operating such machinery in the field—could substitute for formal education.

Petitioner alleged that a POSITA:

[W]ould have a degree in mechanical engineering, physics, materials science, or related fields, and three years of work experience in combustion engines. Additional higher graduate education could substitute for work experience, and additional work experience/training could substitute for formal education.

Petition, 9 (citing EX. 1003, ¶32). Petitioner’s proposed definition is deficient. Specifically, Petitioner has failed to support its contention that an undergraduate physics degree is pertinent to the Challenged Claims, or that three years of work experience in combustion engines is necessary. Regardless, the arguments advanced herein are not impacted based on which definition is applied.

IV. CLAIM CONSTRUCTION

Claim terms are to be construed in accordance with the standard set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (*en banc*). But “[o]nly terms which are in controversy need to be construed, and then only to the extent necessary to resolve the controversy and material to the decision.” *Facebook, Inc. v. Sound View Innovations, LLC*, IPR2017-01005, Paper 13 at 6 (P.T.A.B. Sept. 1, 2017) (citing *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)). Unless otherwise noted, for purposes of the arguments set forth in this

Preliminary Response, Patent Owner applies the plain and ordinary meaning of each claim limitation which is addressed.

Petitioner, meanwhile, contends that it “has not identified any claim terms that need construction in order to address the issues raised by this petition.” Pet., 9-10. As such, Petitioner alleges that it applies the “plain and ordinary meaning as understood by a person of ordinary skill in the art and the prosecution history.” *Id.*

However, despite asserting that the plain and ordinary meaning applies here, Harbor Freight proposed and argued for narrow constructions of the term “switch ... to change operation of the engine between gaseous fuel and liquid fuel” in co-pending district court litigation. Specifically, Harbor Freight argued that the term should be construed as “a device for making, breaking, or changing the connections in an electrical circuit that causes a change in operation.” EX2110, 21-22. In supplemental briefing, Petitioner modified its proposed construction, as follows:

a device for making, breaking, or changing the connections in an electrical circuit that controls mechanical movement and causes a change in operation of the engine between gaseous and liquid fuel.

EX2124, 5. Harbor Freight asserts that the '398 Patent “clearly requires an electrical switch, not a purely mechanical one. *Id.* Petitioner has repeatedly stated that “Generac and MWE expect to take the same claim construction positions at the time such disclosures are due.” IPR2025-01185, Paper 20 at 1; *see also* IPR2025-01099,

Paper 20 at 1; IPR2025-01228, Paper 23 at 1. Generac, meanwhile, argues in its parallel litigation that the same “switch” term construed by Harbor Freight is actually indefinite. EX2113, 54.

Finally, Harbor Freight also argues in parallel district court litigation that “claims that use the term ‘coupled to’ followed by a verb but not by any other structure should be held indefinite.” EX2110, 28-30; *see also* EX1001, Cl. 23 (“a housing containing a pull start engine *coupled to drive* an alternator.”) (emphasis added).

V. ARGUMENT

The USPTO’s institution process considers both “the merits, [and] other non-discretionary considerations” and is designed “[t]o improve efficiency, consistency, and adherence to the statutory requirements for institution.” *See, e.g.*, October 17, 2025 Memorandum from J. Squires at 1-2. Here, the Petition engages in rampant gamesmanship. Denial is appropriate without the need to reach the merits.

First, the Petition relies on broad claim constructions (plain and ordinary meaning) and prior art that is contradicted by Petitioner’s litigation positions. Second, the Petition is inherently at odds with Petitioner’s district court indefiniteness arguments. Each deficiency independently supports denial and is addressed below.

A. Petitioner’s inconsistent claim construction positions support denial.

Despite arguing for construction of the term “switch ... to change operation of the engine between gaseous fuel and liquid fuel” in the Harbor Freight district court proceeding, Petitioner applies the plain and ordinary meaning of the term here. Notably, Petitioner does not provide *any basis* for its inconsistent positions.

On November 3, 2025, the Director’s Order in *Revvo Techs., Inc., v. Cerebrum Sensor Techs., Inc.*, was designated precedential. IPR2025-00632, Paper 20 (P.T.A.B. November 3, 2025) (precedential). There, the Director explicitly stated that “[t]he Board’s claim construction rules are designed to ensure that the Board correctly construes claim terms and to minimize inconsistency in claim construction between forums. To that end, the rules *discourage petitioners from seeking broader constructions at the Board to support a patentability challenge while seeking narrower constructions in litigation to avoid infringement liability.*” *Id.* at 4 (citing Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340 at 51,349-51,350 (Oct. 11, 2018)) (emphasis added). Nevertheless, that is precisely Petitioner’s approach here.

As explained in *Revvo Technologies*, “[a]llowing petitioners to continue this practice [i.e., proposing different claim constructions in the two forums] does not

further the Office’s goal of ‘providing greater predictability and certainty in the patent system.’” *Id.* at 4. Here, Petitioner provided no explanation whatsoever for its inconsistent position, which alone merits denial. *Id.* at 5 (“Ordinarily, that would mean a denial of institution.”).

Moreover, Petitioner’s gamesmanship here is particularly egregious in light of the construction in question. In related district court proceedings, Harbor Freight proposed and argued for a narrow construction of the term “switch ... to change operation of the engine between gaseous fuel and liquid fuel.” Specifically, Harbor Freight argued that the term should be construed as:

a device for making, breaking, or changing the connections in an electrical circuit that controls mechanical movement and causes a change in operation of the engine between gaseous and liquid fuel.

EX2124, 5. Harbor Freight asserted that the ’398 Patent “clearly requires an electrical switch, not a purely mechanical one.” *Id.*

Conversely, the Petition alleges that a mechanical structure is the claimed “switch.” *See e.g.*, Pet., 94-95 (alleging that Holzapfel’s “rod or wire 47 ... simultaneously controls valves 14 and 39 by control of operating levers 45 and 46.”). But, “rod or wire 47” is not an electrical switch, as would be required by Petitioner’s proposed district court construction. Rather, Holzapfel merely discloses a mechanical structure which can be used to actuate two valves simultaneously.

EX1009, 2:100-107 (“operating levers 45 and 46 for the valves 14 and 39, respectively, are connected to a rod or wire 47 which extends to a point of convenient access to the operator of the vehicle such as, for example, the dashboard 48 so that the rod or wire 47 may be manipulated to simultaneously control both valves 14 and 39.”); *see also id.*, 2:108-123 (“Operating the rod or wire 47 will reverse the valves 14 and 39 so that the gaseous fuel supply is cut off and the liquid fuel supply connected to feed the carburetor.”).

Simply put, the Petition ostensibly relies on the plain and ordinary meaning of the claimed “switch” to hand-wave over additional requirements it proposed in district court; namely, that the switch is *electrical* in nature. Petitioner’s gamesmanship attempts to mask substantial deficiencies in the prior art.

B. Petitioner’s inconsistent indefiniteness arguments support denial.

Despite advancing different constructions of the term “switch ... to change operation of the engine between gaseous fuel and liquid fuel” in the parallel Harbor Freight litigation and before the Board (§V.A, *supra*), Petitioner also argues in the Generac litigation that the same “switch” term is actually indefinite, due to “the specification’s attempt to define ‘switch’ to include an electro-mechanical switch.” EX2113, 54. It is unclear how the same term can be (1) limited to electrical switches, as alleged in the Harbor Freight litigation, (2) broad enough to also encompass mechanical switches, as alleged before the Board, and (3) indefinite for failing to

inform the scope of the “electro-mechanical switch” as alleged in the Generac litigation. Notably, Petitioner does not provide *any basis* for its inconsistent positions.

The Director’s informative Order in *Tesla, Inc. v. Intell. Ventures II LLC* held that “when a petitioner advances different positions before the Board and a district court, that petitioner is *required* to explain why those different positions are warranted.” IPR2025-00340, Paper 18 at 3 (P.T.A.B. November 5, 2025) (citing *Cambridge Mobile*, IPR2024-00942, Paper 12 at 8-9; *Revvo Techs.*, IPR2025-00632, Paper 20 at 3-5) (emphasis in original). In *Tesla*, the petitioner had “argued indefiniteness in the district court and then adopted Patent Owner’s plain and ordinary meaning construction from the district court litigation in its Petition.” *Id.* at 4. Specifically, the Director explained that “[a]llowing a petitioner to advance a claim construction before the Board when that petitioner has made inconsistent indefiniteness arguments in district court fails to further, but instead detracts from, the Office’s goal of ‘providing greater predictability and certainty in the patent system.’” *Id.* (citing *Revvo Techs.*, IPR2025-00632, Paper 20 at 3–5).

However, the Petition does not address Petitioner’s inconsistent indefiniteness arguments (which contradict both Harbor Freight’s litigation construction, and Petitioner’s application of the plain and ordinary meaning before the Board). Pet., 9-10. Specifically, Petitioner failed to explain how the disputed term is both (1)

sufficiently definite so as to inform Petitioner’s invalidity challenges raised in the Petition, and (2) “fail[s] 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). The Petition should be denied on this basis alone.

Allowing the instant Petition to proceed highlights the very policy issues *Revvo Techs.* and *Tesla* were designed to prevent. Petitioner has raised three contradictory theories regarding the scope of the claimed switch among and between the Harbor Freight and Generac district court litigations, and the instant IPR proceedings. If instituted, Patent Owner will be forced to defend against invalidity challenges relying on constructions directly counter to those advanced in two different parallel proceedings. There can be no reasonable explanation (other than rampant gamesmanship) for Petitioner’s inconsistent arguments. Thus, like in *Revvo Techs.*, Petitioner’s reliance on inconsistent claim construction positions “[sh]ould mean a denial of institution.” *Revvo Techs.*, Paper 20 at 5.

Finally, Harbor Freight also argues in parallel district court litigation that “claims that use the term ‘coupled to’ followed by a verb but not by any other structure should be held indefinite.” EX2110, 28-30; *see also* EX1001, Cl. 23 (“a housing containing a pull start engine *coupled to drive* an alternator.”) (emphasis added). Once again, Petitioner *did not* explain the basis for inconsistent indefiniteness arguments. Petitioner’s failure to do so supports denial. *Tesla*,

IPR2025-00340, Paper 18 at 3 (“when a petitioner advances different positions before the Board and a district court, that petitioner is *required* to explain why those different positions are warranted.”).

VI. CONCLUSION

For at least the reasons discussed above, the Petition fails to establish that the Challenged Claims are invalid.

Dated: December 16, 2025

Respectfully submitted,

By: /Joseph W. Staley/

Joseph W. Staley, Reg. No. 60,732

Scott P. Amy (Admitted *pro hac vice*)

Thomas F. Finch, Reg. No. 82,341

PERILLA KNOX & HILDEBRANDT LLP

5871 Glenridge Dr.

Suite 350

Atlanta, Georgia 30328

Tel: (770) 927-7802

Fax: (877) 389-6779

Email:

j.staley@pkhip.com

s.amy@pkhip.com

t.finch@pkhip.com

Timothy J. Ziolkowski, Reg. No. 38,368

Jacob M. Fritz, Reg. No. 71,459

**ZIOLKOWSKI PATENT SOLUTIONS
GROUP, SC**

136 South Wisconsin Street

Port Washington, WI 53074

(262) 268-8100 Tel

(262) 268-8185 Fax

Email:

tjz@zpatents.com

jmf@zpatents.com

Counsel for Patent Owner

CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. § 42.6(e), the undersigned certifies that on December 16, 2025, a complete and entire copy of the foregoing Patent Owner's Preliminary Response, including the exhibits relied upon, was served on counsel of record for Petitioner, as follows:

Kimberly K. Dodd, Reg. No. 54,646
Jeffrey S. Gundersen, Reg. No. 47,619
FOLEY & LARDNER LLP
777 E Wisconsin Ave
Milwaukee, WI 53202-5306
Tel: 414-271-2400
kdodd@foley.com
jgundersen@foley.com
HarborFreight-Champion-
IPRs@foley.com

Michael Houston, Reg. No. 58,486
FOLEY & LARDNER LLP
321 N. Clark St., Suite 3000
Chicago, Illinois 60654
Tel: 312-832-4500
mhouston@foley.com

Thomas J. Leach, Reg. No. 53,188
Taylor R. Stemler, Reg. No. 79,777
MERCHANT & GOULD P.C.
150 South Fifth Street, Suite 2200
Minneapolis, MN 55402
Tel: 612-336-4665
Tel: 612-371-5215
TLeach@merchantgould.com
TStemler@MerchantGould.com

Thomas A. Walsh, Reg. No. 45,196
ICE MILLER LLP
One American Square, Suite 2900
Indianapolis, IN 46282
Tel: 317-236-5946
thomas.walsh@icemiller.com

Thomas A. Rammer, Reg. No. 62,591
Alexas D. Siliunas, Reg. No. 79,826
ICE MILLER LLP
200 W. Madison Street, Suite 3500
Chicago, IL 60606
Tel: 312-705-6016
Tel: 312-726-8174
tom.rammer@icemiller.com
alek.siliunas@icemiller.com

Case No. IPR2025-01271
U.S. Patent No. 10,697,398

Dated: December 16, 2025

Respectfully submitted,

By: /Joseph W. Staley/
Joseph W. Staley, Reg. No. 60,732
Counsel for Patent Owner

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that the foregoing Patent Owner's Preliminary Response, excluding the portions exempted under 37 C.F.R. § 42.24(b), contains 2,870 words according to Microsoft Word's word count feature.

Dated: December 16, 2025

Respectfully submitted,

By: /Joseph W. Staley/

Joseph W. Staley, Reg. No. 60,732

Counsel for Patent Owner