

QUINN EMANUEL URQUHART
& SULLIVAN, LLP
David M. Grable (SBN 237765)
davegrable@quinnemanuel.com
Lauren Lindsay (SBN 280516)
laurenlindsay@quinnemanuel.com
865 South Figueroa Street, 10th Floor
Los Angeles, CA 90017-2543
Telephone: (213) 443 3000
Facsimile: (213) 443 3100

QUINN EMANUEL URQUHART
& SULLIVAN, LLP
Eric Huang (*pro hac vice*)
erichuang@quinnemanuel.com
295 Fifth Avenue
New York, NY 10016-7103
Telephone: (212) 849-7000
Facsimile: (212) 849-7100

Attorneys for Plaintiff Harbor Freight Tools USA, Inc.

**UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA**

HARBOR FREIGHT TOOLS USA,
INC.,

Plaintiff,

vs.

CHAMPION POWER EQUIPMENT,
INC.,

Defendant.

CASE NO.: 2:24-cv-08722-SVW-AS

**HARBOR FREIGHT'S ANSWER
TO CHAMPION'S
COUNTERCLAIMS**

JURY TRIAL DEMANDED

Hon. Stephen V. Wilson

Hon. Alka Sagar

1 Plaintiff Harbor Freight Tools USA, Inc. (“HFT”) hereby answers
2 counterclaims from Defendant Champion Power Equipment, Inc.’s (“Champion”)
3 Answer and Counterclaims (ECF No. 47, “Counterclaims”) as follows:

4 HFT denies each and every allegation in the Counterclaims, except as
5 specifically and expressly admitted or explained herein. HFT’s answer repeats the
6 headings of Champion’s Counterclaims for ease of exposition. To the extent that the
7 headings or any other non-numbered statements in the Counterclaims are found to
8 contain any allegations to which HFT should respond, HFT denies each and every
9 such allegation.

10 **COUNTERCLAIMS**

11 **NATURE OF THE ACTION**

12 1. HFT admits that this action invokes the patent laws of the United States.
13 HFT denies any remaining allegations in Paragraph 1 of the Counterclaims.

14 2. HFT denies the allegations in Paragraph 2 of the Counterclaims, and
15 denies that it has engaged in any acts of infringement of any valid patent.

16 **THE PARTIES**

17 3. On information and belief, HFT admits that Champion is a corporation
18 incorporated in Nevada. HFT denies any remaining allegations in Paragraph 3 of the
19 Counterclaims.

20 4. HFT admits the allegations contained in Paragraph 4 of the
21 Counterclaims.

22 **JURISDICTION AND VENUE**

23 5. HFT admits that the Court has subject matter jurisdiction over
24 Champion’s Counterclaims against HFT. Except as expressly admitted, HFT denies
25 the remaining allegations in Paragraph 5 of the Counterclaims.

1 6. HFT admits that the Court has personal jurisdiction over HFT. Except
2 as expressly admitted, HFT denies the remaining allegations in Paragraph 6 of the
3 Counterclaims.

4 7. HFT admits that venue is proper in this district.

5 **COUNTERCLAIM I**

6 **(Infringement of U.S. Patent No. 10,393,034)**

7 8. HFT incorporates by reference its responses to all preceding paragraphs
8 as if fully set forth herein.

9 9. HFT admits that U.S. Patent No. 10,393,034 (the “’034 patent”) was
10 issued by the U.S. Patent and Trademark Office (“USPTO”), on its face, reflects an
11 issuance date of August 27, 2019, and is entitled “FUEL SYSTEM FOR A MULTI-
12 FUEL INTERNAL COMBUSTION ENGINE.” HFT denies that this patent was duly
13 and legally issued. HFT denies the remaining allegations in Paragraph 9 of the
14 Counterclaims.

15 10. HFT admits that the ’034 patent, on its face, identifies Champion Power
16 Equipment, Inc. as the assignee. HFT does not have sufficient information to admit
17 or deny the remaining allegations in Paragraph 10 of the Counterclaims and on that
18 basis denies them.

19 11. HFT does not have sufficient information to admit or deny the allegation
20 that Champion “has acquired and inspected” any generator model, and on that basis
21 denies that allegation. HFT denies the remaining allegations in Paragraph 11 of the
22 Counterclaims.

23 12. HFT does not have sufficient information to admit or deny the allegation
24 as to any determination made regarding the identified Model, and on that basis denies
25 that allegation. HFT denies the remaining allegations in Paragraph 12 of the
26 Counterclaims, including all allegations of infringement therein including in sub-
27 paragraphs 12(a) through 12(p).

1 13. HFT denies the allegations in Paragraph 13 of the Counterclaims.

2 14. HFT denies the allegations in Paragraph 14 of the Counterclaims.

3 15. HFT denies the allegations in Paragraph 15 of the Counterclaims.

4 16. HFT admits that it received correspondence from Champion on March
5 27, 2024, May 17, 2024, and June 28, 2024, but denies the remaining allegations in
6 Paragraph 16 of the Counterclaims.

7 17. HFT denies the allegations in Paragraph 17 of the Counterclaims.

8 **COUNTERCLAIM II**

9 **(Infringement of U.S. Patent No. 11,143,120)**

10 18. HFT incorporates by reference its responses to all preceding paragraphs
11 as if fully set forth herein.

12 19. HFT admits that U.S. Patent No. 11,143,120 (the “’120 patent”) was
13 issued by the USPTO, on its face, reflects an issue date of October 12, 2021, and is
14 entitled “FUEL SYSTEM FOR A MULTI-FUEL INTERNAL COMBUSTION
15 ENGINE.” HFT denies that this patent was duly and legally issued. HFT denies the
16 remaining allegations in Paragraph 19 of the Counterclaims.

17 20. HFT admits that the ’120 patent, on its face, identifies Champion Power
18 Equipment, Inc. as the assignee. HFT does not have sufficient information to admit
19 or deny the remaining allegations in Paragraph 20 of the Counterclaims and on that
20 basis denies them.

21 21. HFT does not have sufficient information to admit or deny the allegation
22 that Champion “has acquired and inspected” any generator model, and on that basis
23 denies that allegation. HFT denies the remaining allegations in Paragraph 21 of the
24 Counterclaims, including all allegations of infringement therein including in sub-
25 paragraphs 21(a) through 21(b).

26 22. HFT does not have sufficient information to admit or deny the allegation
27 as to any determination made regarding the identified Model, and on that basis denies
28

1 that allegation. HFT denies the remaining allegations in Paragraph 22 of the
2 Counterclaims, including all allegations of infringement therein including in sub-
3 paragraphs 22(a) through 22(f).

4 23. HFT denies the allegations in Paragraph 23 of the Counterclaims.

5 24. HFT denies the allegations in Paragraph 24 of the Counterclaims,
6 including all allegations in sub-paragraph 24(a).

7 25. HFT denies the allegations in Paragraph 25 of the Counterclaims.

8 26. HFT denies the allegations in Paragraph 26 of the Counterclaims.

9 27. HFT denies the allegations in Paragraph 27 of the Counterclaims.

10 28. HFT admits that it received correspondence from Champion on March
11 27, 2024, May 17, 2024, and June 28, 2024, but denies the remaining allegations in
12 Paragraph 28 of the Counterclaims.

13 29. HFT denies the allegations in Paragraph 29 of the Counterclaims.

14 **COUNTERCLAIM III**

15 **(Infringement of U.S. Patent No. 11,492,985)**

16 30. HFT incorporates by reference its responses to all preceding paragraphs
17 as if fully set forth herein.

18 31. HFT admits that U.S. Patent No. 11,492,985 (the “’985 patent”) was
19 issued by the USPTO, on its face, reflects an issuance date of November 8, 2022, and
20 is entitled “OFF-BOARD FUEL REGULATOR FOR GENERATOR ENGINE.”
21 HFT denies that this patent was duly and legally issued. HFT denies the remaining
22 allegations in Paragraph 31 of the Counterclaims.

23 32. HFT admits that the ’985 patent, on its face, identifies Champion Power
24 Equipment, Inc. as the assignee. HFT does not have sufficient information to admit
25 or deny the remaining allegations in Paragraph 32 of the Counterclaims and on that
26 basis denies them.

1 denies that this patent was duly and legally issued. HFT denies the remaining
2 allegations in Paragraph 43 of the Counterclaims.

3 44. HFT admits that the '654 patent, on its face, identifies Champion Power
4 Equipment, Inc. as the assignee. HFT does not have sufficient information to admit
5 or deny the remaining allegations in Paragraph 44 of the Counterclaims and on that
6 basis denies them.

7 45. HFT does not have sufficient information to admit or deny the allegation
8 that Champion "has acquired and inspected" any generator model, and on that basis
9 denies that allegation. HFT denies the remaining allegations in Paragraph 45 of the
10 Counterclaims, including all allegations of infringement therein including in sub-
11 paragraphs 45(a) through 45(b).

12 46. HFT does not have sufficient information to admit or deny the allegation
13 as to any determination made regarding the identified Model, and on that basis denies
14 that allegation. HFT denies the remaining allegations in Paragraph 46 of the
15 Counterclaims, including all allegations of infringement therein including in sub-
16 paragraphs 46(a) through 46(b).

17 47. HFT denies the allegations in Paragraph 47 of the Counterclaims.

18 48. HFT denies the allegations in Paragraph 48 of the Counterclaims,
19 including all allegations in sub-paragraphs 48(a) through 48(b).

20 49. HFT denies the allegations in Paragraph 49 of the Counterclaims.

21 50. HFT denies the allegations in Paragraph 50 of the Counterclaims.

22 51. HFT denies the allegations in Paragraph 51 of the Counterclaims.

23 52. HFT admits that it received correspondence from Champion on March
24 27, 2024, May 17, 2024, and June 28, 2024, but denies the remaining allegations in
25 Paragraph 52 of the Counterclaims.

26 53. HFT denies the allegations in Paragraph 53 of the Counterclaims.
27
28

COUNTERCLAIM V

(Infringement of U.S. Patent No. 11,840,970)

54. HFT incorporates by reference its responses to all preceding paragraphs as if fully set forth herein.

55. U.S. Patent No. 11,840,970 (“the ’970 patent”) was issued by the USPTO, on its face, reflects an issue date of December 12, 2023, and is entitled “DUAL FUEL GENERATOR WITH REMOTE REGULATOR.” HFT denies that this patent was duly and legally issued. HFT denies the remaining allegations in Paragraph 55 of the Counterclaims.

56. HFT admits that the ’970 patent, on its face, identifies Champion Power Equipment, Inc. as the assignee. HFT does not have sufficient information to admit or deny the remaining allegations in Paragraph 56 of the Counterclaims and on that basis denies them.

57. HFT does not have sufficient information to admit or deny the allegation that Champion “has acquired and inspected” any generator model, and on that basis denies that allegation. HFT denies the remaining allegations in Paragraph 57 of the Counterclaims, including all allegations of infringement therein including in sub-paragraphs 57(a) through 57(b).

58. HFT does not have sufficient information to admit or deny the allegation as to any determination made regarding the identified Model, and on that basis denies that allegation. HFT denies the remaining allegations in Paragraph 58 of the Counterclaims, including all allegations of infringement therein including in sub-paragraphs 58(a) through 58(d).

59. HFT denies the allegations in Paragraph 59 of the Counterclaims.

60. HFT denies the allegations in Paragraph 60 of the Counterclaims, including all allegations in sub-paragraphs 60(a) through 60(k).

61. HFT denies the allegations in Paragraph 61 of the Counterclaims.

62. HFT denies the allegations in Paragraph 62 of the Counterclaims.

63. HFT denies the allegations in Paragraph 63 of the Counterclaims.

64. HFT admits that it received correspondence from Champion on March 27, 2024, May 17, 2024, and June 28, 2024, but denies the remaining allegations in Paragraph 64 of the Counterclaims.

65. HFT denies the allegations in Paragraph 65 of the Counterclaims.

COUNTERCLAIM VI

(Infringement of U.S. Patent No. 10,221,780)

66. HFT incorporates by reference its responses to all preceding paragraphs as if fully set forth herein.

67. HFT admits that U.S. Patent No. 10,221,780 (“the ’780 patent”) was issued by the USPTO, on its face, reflects an issue date of March 5, 2019, and is entitled “DUEL FUEL LOCKOUT SWITCH FOR GENERATOR ENGINE.” HFT denies that this patent was duly and legally issued. HFT denies the remaining allegations in Paragraph 67 of the Counterclaims.

68. HFT admits that the ’780 patent, on its face, identifies Champion Power Equipment, Inc. as the assignee. HFT does not have sufficient information to admit or deny the remaining allegations in Paragraph 68 of the Counterclaims and on that basis denies them.

69. HFT does not have sufficient information to admit or deny the allegation that Champion “has acquired and inspected” any generator model, and on that basis denies that allegation. HFT denies the remaining allegations in Paragraph 69 of the Counterclaims.

70. HFT does not have sufficient information to admit or deny the allegation as to any determination made regarding the identified Model, and on that basis denies that allegation. HFT denies the remaining allegations in Paragraph 70 of the

1 Counterclaims, including all allegations of infringement therein including in sub-
2 paragraphs 70(a) through 70(d).

3 71. HFT denies the allegations in Paragraph 71 of the Counterclaims.

4 72. HFT denies the allegations in Paragraph 72 of the Counterclaims.

5 73. HFT denies the allegations in Paragraph 73 of the Counterclaims.

6 74. HFT admits that it received correspondence from Champion on March
7 27, 2024, May 17, 2024, and June 28, 2024, but denies the remaining allegations in
8 Paragraph 74 of the Counterclaims.

9 75. HFT denies the allegations in Paragraph 75 of the Counterclaims.

10 **COUNTERCLAIM VII**

11 **(Infringement of U.S. Patent No. 11,905,895)**

12 76. HFT incorporates by reference its responses to all preceding paragraphs
13 as if fully set forth herein.

14 77. HFT admits that U.S. Patent No. 11,905,895 (the “’895 patent”) was
15 issued by the USPTO, on its face, reflects an issue date of February 20, 2024, and is
16 entitled “DUAL FUEL LOCKOUT SWITCH FOR GENERATOR ENGINE.” HFT
17 denies that this patent was duly and legally issued. HFT denies the remaining
18 allegations in Paragraph 77 of the Counterclaims.

19 78. HFT admits that the ’895 patent, on its face, identifies Champion Power
20 Equipment, Inc. as the assignee. HFT does not have sufficient information to admit
21 or deny the remaining allegations in Paragraph 78 of the Counterclaims and on that
22 basis denies them.

23 79. HFT does not have sufficient information to admit or deny the allegation
24 that Champion “has acquired and inspected” any generator model, and on that basis
25 denies that allegation. HFT denies the remaining allegations in Paragraph 79 of the
26 Counterclaims, including all allegations of infringement therein including in sub-
27 paragraphs 79(a) through 79(b).

1 80. HFT does not have sufficient information to admit or deny the allegation
2 as to any determination made regarding the identified Model, and on that basis denies
3 that allegation. HFT denies the remaining allegations in Paragraph 80 of the
4 Counterclaims, including all allegations of infringement therein including in sub-
5 paragraphs 80(a) through 80(f).

6 81. HFT denies the allegations in Paragraph 81 of the Counterclaims.

7 82. HFT denies the allegations in Paragraph 82 of the Counterclaims.

8 83. HFT denies the allegations in Paragraph 83 of the Counterclaims.

9 84. HFT admits that it received correspondence from Champion on March
10 27, 2024, May 17, 2024, and June 28, 2024, but denies the remaining allegations in
11 Paragraph 84 of the Counterclaims.

12 85. HFT denies the allegations in Paragraph 85 of the Counterclaims.

13 **COUNTERCLAIM VIII**

14 **(Infringement of U.S. Patent No. 10,697,398)**

15 86. HFT incorporates by reference its responses to all preceding paragraphs
16 as if fully set forth herein.

17 87. HFT admits that U.S. Patent No. 10,697,398 (the “’398 patent”) was
18 issued by the USPTO, on its face, reflects an issue date of June 30, 2020, and is
19 entitled “BATTERYLESS DUAL FUEL ENGINE WITH LIQUID FUEL CUT-
20 OFF.” HFT denies that this patent was duly and legally issued. HFT denies the
21 remaining allegations in Paragraph 87 of the Counterclaims.

22 88. HFT admits that the ’398 patent, on its face, identifies Champion Power
23 Equipment, Inc. as the assignee. HFT does not have sufficient information to admit
24 or deny the remaining allegations in Paragraph 88 of the Counterclaims and on that
25 basis denies them.

26 89. HFT does not have sufficient information to admit or deny the allegation
27 that Champion “has acquired and inspected” any generator model, and on that basis
28

denies that allegation. HFT denies the remaining allegations in Paragraph 89 of the Counterclaims, including all allegations of infringement therein including in sub-paragraphs 89(a) through 89(b).

90. HFT does not have sufficient information to admit or deny the allegation as to any determination made regarding the identified Model, and on that basis denies that allegation. HFT denies the remaining allegations in Paragraph 90 of the Counterclaims, including all allegations of infringement therein including in sub-paragraphs 90(a) through 90(j).

91. HFT denies the allegations in Paragraph 91 of the Counterclaims.

92. HFT denies the allegations in Paragraph 92 of the Counterclaims, including all allegations in sub-paragraphs 92(a) through 92(f).

93. HFT denies the allegations in Paragraph 93 of the Counterclaims.

94. HFT denies the allegations in Paragraph 94 of the Counterclaims.

95. HFT denies the allegations in Paragraph 95 of the Counterclaims.

96. HFT admits that it received correspondence from Champion on March 27, 2024, May 17, 2024, and June 28, 2024, but denies the remaining allegations in Paragraph 96 of the Counterclaims.

97. HFT denies the allegations in Paragraph 97 of the Counterclaims.

COUNTERCLAIM IX

(Infringement of U.S. Patent No. 11,143,145)

98. HFT incorporates by reference its responses to all preceding paragraphs as if fully set forth herein.

99. HFT admits that U.S. Patent No. 11,143,145 (the “145 patent”) was issued by the USPTO, on its face, reflects an issue date of October 12, 2021, and is entitled “BATTERYLESS DUAL FUEL ENGINE WITH LIQUID FUEL CUT-OFF.” HFT denies that this patent was duly and legally issued. HFT denies the remaining allegations in Paragraph 99 of the Counterclaims.

1 100. HFT admits that the '145 patent, on its face, identifies Champion Power
2 Equipment, Inc. as the assignee. HFT does not have sufficient information to admit
3 or deny the remaining allegations in Paragraph 100 of the Counterclaims and on that
4 basis denies them.

5 101. HFT does not have sufficient information to admit or deny the allegation
6 that Champion "has acquired and inspected" any generator model, and on that basis
7 denies that allegation. HFT denies the remaining allegations in Paragraph 101 of the
8 Counterclaims, including all allegations of infringement therein including in sub-
9 paragraphs 101(a) through 101(b).

10 102. HFT does not have sufficient information to admit or deny the allegation
11 as to any determination made regarding the identified Model, and on that basis denies
12 that allegation. HFT denies the remaining allegations in Paragraph 102 of the
13 Counterclaims, including all allegations of infringement therein including in sub-
14 paragraphs 102(a) through 102(i).

15 103. HFT denies the allegations in Paragraph 103 of the Counterclaims.

16 104. HFT denies the allegations in Paragraph 104 of the Counterclaims,
17 including all allegations in sub-paragraphs 104(a) through 104(c).

18 105. HFT denies the allegations in Paragraph 105 of the Counterclaims.

19 106. HFT denies the allegations in Paragraph 106 of the Counterclaims.

20 107. HFT denies the allegations in Paragraph 107 of the Counterclaims.

21 108. HFT admits that it received correspondence from Champion on March
22 27, 2024, May 17, 2024, and June 28, 2024, but denies the remaining allegations in
23 Paragraph 108 of the Counterclaims.

24 109. HFT denies the allegations in Paragraph 109 of the Counterclaims.
25
26
27
28

COUNTERCLAIM X

(Infringement of U.S. Patent No. 10,598,101)

110. HFT incorporates by reference its responses to all preceding paragraphs as if fully set forth herein.

111. HFT admits that U.S. Patent No. 10,598,101 (the “’101 patent”) was issued by the USPTO, on its face, reflects an issue date of March 24, 2020, and is entitled “DUAL FUEL SELECTOR SWITCH.” HFT denies that this patent was duly and legally issued. HFT denies the remaining allegations in Paragraph 111 of the Counterclaims.

112. HFT admits that the ’101 patent, on its face, identifies Champion Power Equipment, Inc. as the assignee. HFT does not have sufficient information to admit or deny the remaining allegations in Paragraph 112 of the Counterclaims and on that basis denies them.

113. HFT does not have sufficient information to admit or deny the allegation that Champion “has acquired and inspected” any generator model, and on that basis denies that allegation. HFT denies the remaining allegations in Paragraph 113 of the Counterclaims, including all allegations of infringement therein including in sub-paragraphs 113(a) through 113(b).

114. HFT does not have sufficient information to admit or deny the allegation as to any determination made regarding the identified Model, and on that basis denies that allegation. HFT denies the remaining allegations in Paragraph 114 of the Counterclaims, including all allegations of infringement therein including in sub-paragraphs 114(a) through 114(i).

115. HFT denies the allegations in Paragraph 115 of the Counterclaims.

116. HFT denies the allegations in Paragraph 116 of the Counterclaims, including all allegations in sub-paragraphs 116(a) through 116(h).

117. HFT denies the allegations in Paragraph 117 of the Counterclaims.

1 118. HFT denies the allegations in Paragraph 118 of the Counterclaims.

2 119. HFT denies the allegations in Paragraph 119 of the Counterclaims.

3 120. HFT admits that it received correspondence from Champion on March
4 27, 2024, May 17, 2024, and June 28, 2024, but denies the remaining allegations in
5 Paragraph 120 of the Counterclaims.

6 121. HFT denies the allegations in Paragraph 121 of the Counterclaims.

7 **COUNTERCLAIM XI**

8 **(Infringement of U.S. Patent No. 11,306,667)**

9 122. HFT incorporates by reference its responses to all preceding paragraphs
10 as if fully set forth herein.

11 123. HFT admits was issued by the USPTO, on its face, reflects an issue date
12 of April 19, 2022, and is entitled “DUAL FUEL SELECTOR SWITCH.” HFT denies
13 that this patent was duly and legally issued. HFT denies the remaining allegations in
14 Paragraph 123 of the Counterclaims.

15 124. HFT admits that the ’667 patent, on its face, identifies Champion Power
16 Equipment, Inc. as the assignee. HFT does not have sufficient information to admit
17 or deny the remaining allegations in Paragraph 124 of the Counterclaims and on that
18 basis denies them.

19 125. HFT does not have sufficient information to admit or deny the allegation
20 that Champion “has acquired and inspected” any generator model, and on that basis
21 denies that allegation. HFT denies the remaining allegations in Paragraph 125 of the
22 Counterclaims, including all allegations of infringement therein including in sub-
23 paragraphs 125(a) through 125(b).

24 126. HFT does not have sufficient information to admit or deny the allegation
25 as to any determination made regarding the identified Model, and on that basis denies
26 that allegation. HFT denies the remaining allegations in Paragraph 126 of the
27
28

1 Counterclaims, including all allegations of infringement therein including in sub-
2 paragraphs 126(a) through 126(r).

3 127. HFT denies the allegations in Paragraph 127 of the Counterclaims.

4 128. HFT denies the allegations in Paragraph 128 of the Counterclaims,
5 including all allegations in sub-paragraphs 128(a) through 128(e).

6 129. HFT denies the allegations in Paragraph 129 of the Counterclaims.

7 130. HFT denies the allegations in Paragraph 130 of the Counterclaims.

8 131. HFT denies the allegations in Paragraph 131 of the Counterclaims.

9 132. HFT admits that it received correspondence from Champion on March
10 27, 2024, May 17, 2024, and June 28, 2024, but denies the remaining allegations in
11 Paragraph 132 of the Counterclaims.

12 133. HFT denies the allegations in Paragraph 133 of the Counterclaims.

13 **COUNTERCLAIM XII**

14 **(Infringement of U.S. Patent No. 11,761,390)**

15 134. HFT incorporates by reference its responses to all preceding paragraphs
16 as if fully set forth herein.

17 135. HFT admits that U.S. Patent No. 11,761,390 (the “’390 patent”) was
18 issued by the USPTO, on its face, reflects an issue date of September 19, 2023, and
19 is entitled “DUAL FUEL SELECTOR SWITCH.” HFT denies that this patent was
20 duly and legally issued. HFT denies the remaining allegations in Paragraph 135 of
21 the Counterclaims.

22 136. HFT admits that the ’390 patent, on its face, identifies Champion Power
23 Equipment, Inc. as the assignee. HFT does not have sufficient information to admit
24 or deny the remaining allegations in Paragraph 136 of the Counterclaims and on that
25 basis denies them.

26 137. HFT does not have sufficient information to admit or deny the allegation
27 that Champion “has acquired and inspected” any generator model, and on that basis
28

denies that allegation. HFT denies the remaining allegations in Paragraph 137 of the Counterclaims.

138. HFT does not have sufficient information to admit or deny the allegation as to any determination made regarding the identified Model, and on that basis denies that allegation. HFT denies the remaining allegations in Paragraph 138 of the Counterclaims, including all allegations of infringement therein including in subparagraphs 138(a) through 138(j).

139. HFT denies the allegations in Paragraph 139 of the Counterclaims.

140. HFT denies the allegations in Paragraph 140 of the Counterclaims.

141. HFT denies the allegations in Paragraph 141 of the Counterclaims.

142. HFT admits that it received correspondence from Champion on March 27, 2024, May 17, 2024, and June 28, 2024, but denies the remaining allegations in Paragraph 142 of the Counterclaims.

143. HFT denies the allegations in Paragraph 143 of the Counterclaims.

COUNTERCLAIM XIII

(Infringement of U.S. Patent No. 11,905,896)

144. HFT incorporates by reference its responses to all preceding paragraphs as if fully set forth herein.

145. HFT admits that U.S. Patent No. 11,905,896 (the “’896 patent”) was issued by the USPTO, on its face, reflects an issue date of February 20, 2024, and is entitled “DUAL FUEL SELECTOR SWITCH.” HFT denies that this patent was duly and legally issued. HFT denies the remaining allegations in Paragraph 145 of the Counterclaims.

146. HFT admits that the ’896 patent, on its face, identifies Champion Power Equipment, Inc. as the assignee. HFT does not have sufficient information to admit or deny the remaining allegations in Paragraph 146 of the Counterclaims and on that basis denies them.

1 147. HFT does not have sufficient information to admit or deny the allegation
2 that Champion “has acquired and inspected” any generator model, and on that basis
3 denies that allegation. HFT denies the remaining allegations in Paragraph 147 of the
4 Counterclaims, including all allegations of infringement therein including in
5 subparagraphs 147(a) through 147(b).

6 148. HFT does not have sufficient information to admit or deny the allegation
7 as to any determination made regarding the identified Model, and on that basis denies
8 that allegation. HFT denies the remaining allegations in Paragraph 148 of the
9 Counterclaims, including all allegations of infringement therein including in sub-
10 paragraphs 148(a) through 148(f).

11 149. HFT denies the allegations in Paragraph 149 of the Counterclaims.

12 150. HFT denies the allegations in Paragraph 150 of the Counterclaims,
13 including all allegations in sub-paragraphs 150(a) through 150(e).

14 151. HFT denies the allegations in Paragraph 151 of the Counterclaims.

15 152. HFT denies the allegations in Paragraph 152 of the Counterclaims.

16 153. HFT denies the allegations in Paragraph 153 of the Counterclaims.

17 154. HFT admits that it received correspondence from Champion on March
18 27, 2024, May 17, 2024, and June 28, 2024, but denies the remaining allegations in
19 Paragraph 154 of the Counterclaims.

20 155. HFT denies the allegations in Paragraph 155 of the Counterclaims.

21 **CHAMPION POWER EQUIPMENT, INC.’S PRAYER FOR RELIEF**

22 With respect to Champion’s Prayer for Relief Sections A-S, on pages 97-98 of
23 its Answer and Counterclaims, HFT denies that Champion is entitled to such relief
24 and any other relief sought in its Answer and Counterclaims, or any portion thereof
25 and/or any other form of relief whatsoever.

26 **JURY DEMAND**

27 HFT also demands a trial by jury on all issues so triable.
28

1 **AFFIRMATIVE DEFENSES**

2 Subject to the responses above, HFT alleges and asserts the following defenses
3 in response to the allegations, undertaking the burden of proof only as to those
4 defenses deemed affirmative defenses by law, regardless of how such defenses are
5 denominated herein. In addition to the affirmative defenses described below, subject
6 to its responses above, HFT specifically reserves all rights to allege additional
7 affirmative defenses that become known through the course of discovery.

8 **FIRST AFFIRMATIVE DEFENSE—FAILURE TO STATE A CLAIM**

9 156. Champion’s Counterclaims fail to state a claim on which relief may be
10 granted.

11 **SECOND AFFIRMATIVE DEFENSE—NONINFRINGEMENT**

12 157. HFT does not infringe and has not infringed and is not liable for
13 infringement of, any valid and enforceable asserted claims of the ’034 patent; the ’120
14 patent; the ’985 patent; the ’654 patent; the ’970 patent; the ’780 patent; the ’895
15 patent; the ’398 patent; the ’145 patent; the ’101 patent; the ’667 patent; the ’390
16 patent; and the ’896 patent (collectively, the “Asserted Patents”), either because the
17 claim limitations of the Asserted Patents are not met literally and the doctrine of
18 equivalents does not apply, or under the reverse doctrine of equivalents.

19 **THIRD AFFIRMATIVE DEFENSE—INVALIDITY**

20 158. The asserted claims of the Asserted Patents are invalid and
21 unenforceable under 35 U.S.C. §§ 101, 102, 103, and/or 112.

22 159. By way of example, the asserted claims of the ’034 patent are invalid
23 based at least on Japanese Laid-Open Patent Publication No. JPS61283734A
24 (“Nakafushi”), U.S. Patent No. 5,301,644 (“Olmr”), U.S. Patent No. 4,372,276
25 (“Bernhardsson”), and/or the prior art references listed on the face of the patent.

26 160. By way of example, the asserted claims of the ’120 patent are invalid
27 based at least on U.S. Patent No. 4,811,720 (“Katumata”), U.S. Patent No. 4,878,475
28

1 (“Birsa”), U.S. Patent No. 3,911,956 (“LeBreton”), and/or the prior art references
2 listed on the face of the patent.

3 161. By way of example, the asserted claims of the ’985 patent are invalid
4 based at least on LeBreton, U.S. Patent No. 4,287,908 (“Storgard”), U.S. Patent No.
5 4,323,046 (“Barber”), and/or the prior art references listed on the face of the patent.

6 162. By way of example, the asserted claims of the ’654 patent are invalid
7 based at least on U.S. Patent No. 7,954,479 B2 (“Kojima”) and/or the prior art
8 referenced listed on the face of the patent.

9 163. By way of example, the asserted claims of the ’970 patent are invalid
10 based at least on U.S. Patent No. 11,530,654 B2 (“Sarder”) and/or the prior art
11 references listed on the face of the patent.

12 164. By way of example, the asserted claims of the ’780 patent are invalid
13 based at least on U.S. Patent No. 4,492,207 (“Hallberg”), U.S. Patent No. 8,613,276
14 (“Parrish”), and/or the prior art references listed on the face of the patent.

15 165. By way of example, the asserted claims of the ’895 patent are invalid
16 based at least on Hallberg, Parrish, and/or the prior art references listed on the face of
17 the patent.

18 166. By way of example, the asserted claims of the ’398 patent are invalid
19 based at least on U.S. Patent No. 3,412,258 (“Satter”), U.S. Patent No. 3,659,574
20 (“Reschke”), and/or the prior art references listed on the face of the patent.

21 167. By way of example, the asserted claims of the ’145 patent are invalid
22 based at least on U.S. Patent No. 9,988,990 (“Ping”), U.S. Patent No. 3,807,377
23 (“Bhatt”), and/or the prior art references listed on the face of the patent.

24 168. By way of example, the asserted claims of the ’101 patent are invalid
25 based at least on Japanese Laid-Open Patent Publication No. 2005330867
26 (“Fujisawa”), U.S. Patent No. 6,591,817 (“Deutsch”), U.S. Patent No. 8,887,799
27 (“Smith”), and/or the prior art references listed on the face of the patent.
28

1 169. By way of example, the asserted claims of the '667 patent are invalid
2 based at least on Fujisawa, Deutsch, Smith, and/or the prior art references listed on
3 the face of the patent.

4 170. By way of example, the asserted claims of the '390 patent are invalid
5 based at least on Fujisawa, Deutsch, Smith, and/or the prior art references listed on
6 the face of the patent.

7 171. By way of example, the asserted claims of the '896 patent are invalid
8 based at least on Fujisawa, Deutsch, Smith, and/or the prior art references listed on
9 the face of the patent.

10 **FOURTH AFFIRMATIVE DEFENSE**

11 **PROSECUTION HISTORY ESTOPPEL**

12 172. By reason of statements, representations, concessions, admissions,
13 arguments, and/or amendments, whether explicit or implicit, made by or on behalf of
14 the applicant during the prosecution of the patent applications that led to the issuance
15 of the Asserted Patents, Champion's claims of patent infringement are barred, in
16 whole or in part, by the doctrine of prosecution history estoppel. To the extent
17 Champion's alleged claim for infringement of any of the Asserted Patents in the
18 Counterclaims is based on the doctrine of equivalents, Champion is barred under the
19 doctrine of prosecution history estoppel and/or other limits to the doctrine of
20 equivalents, and Champion is estopped from claiming that the Asserted Patents cover
21 any accused method, system, and/or product.

22 **FIFTH AFFIRMATIVE DEFENSE—DAMAGES AND COST LIMITATION**

23 173. On information and belief, Champion's claims for relief are limited or
24 barred, in whole or in part, by 35 U.S.C. §§ 286, 287, and/or 288.

25 **SIXTH AFFIRMATIVE DEFENSE—NO EXCEPTIONAL CASE**

26 174. Champion cannot prove that this is an exceptional case justifying an
27 award of attorneys' fees against HFT pursuant to 35 U.S.C. § 285.
28

1 **SEVENTH AFFIRMATIVE DEFENSE—NO WILLFUL INFRINGEMENT**

2 175. Champion is not entitled to enhanced damages under 35 U.S.C. § 284
3 because Champion has failed to meet, and cannot meet as a matter of law, the
4 requirements for willful infringement.

5 **EIGHTH AFFIRMATIVE DEFENSE—UNENFORCEABILITY**
6 **(INEQUITABLE CONDUCT)**

7 176. The claims of the Asserted Patents are unenforceable due to inequitable
8 conduct. The '780 patent, '398 patent, '120 patent, '145 patent, '985 patent, '654
9 patent, '970 patent, and '895 patent (collectively, "the 2015 Patent Family") is
10 unenforceable at least because the patents were obtained through inequitable conduct.

11 177. Mark J. Sarder, Aleko D. Sotiriades, James. J. Dehn, Leigh Jenison,
12 Kendall J. Collie, and Hiroaki Sato ("the Named Inventors") are listed as the named
13 inventors in the 2015 Patent Family. Mark J. Sarder, Aleko D. Sotiriades, James. J.
14 Dehn, and Leigh Jenison are listed as named inventors for each patent in the 2015
15 Patent Family. Kendall J. Collie is listed as a named inventor for the '398, '145, and
16 '120 patents. Hiroaki Sato is listed as a named inventor for the '398 and '145 patents.

17 178. On information and belief, Sarder was Champion's Vice President of
18 Engineering at least from 2015 to 2019.

19 179. On information and belief, Dehn was Champion's Chief Engineer at least
20 from 2015 to 2019.

21 180. The Named Inventors had a duty to disclose any prior art relevant to the
22 2015 Patent Family to the PTO.

23 181. Timothy Ziolkowski, Jacob Fritz, Kevin R. Rosin, Stephanie Laundre,
24 and Andrew C. Stark ("the Prosecuting Attorneys") prosecuted the patents in the 2015
25 Patent Family. At least one of the Prosecuting Attorneys prosecuted each of the
26 patents in the 2015 Patent Family.

1 182. The Prosecuting Attorneys had a duty to disclose any prior art relevant
2 to the 2015 Patent Family to the USPTO.

3 183. On information and belief, Dennis M. Trine, Lei Zhao, and Jiehui Ma
4 (“the Champion Officers”) are officers of Champion. The Champion Officers own
5 and/or operate Champion.

6 184. On information and belief, the Champion Officers have directed and/or
7 participated in and continue to direct and/or participate in the prosecution and
8 enforcement of the 2015 Patent Family.

9 185. The Champion Officers had a duty to disclose any prior art relevant to
10 the 2015 Patent Family to the USPTO.

11 186. The RD9000E dual fuel generator was publicly available and sold by
12 Firman Power Equipment Inc. (“Firman”) prior to June 12, 2015. On information and
13 belief, Firman publicly displayed the RD9000E dual fuel generator at a trade show in
14 May 2015.

15 187. On information and belief, named inventor Sarder went to the May 2015
16 trade show in which Firman displayed the RD9000E dual fuel generator.

17 188. On information and belief, named inventor Sarder inspected the
18 RD9000E dual fuel generator at the trade show in May 2015.

19 189. On information and belief, Sarder shared his observations regarding the
20 features of the RD9000E dual fuel generator with the Prosecuting Attorneys,
21 Champion Officers, and other Named Inventors prior to June 12, 2015.

22 190. On information and belief, in 2015, Champion purchased the RD9000E
23 dual fuel generator from Firman.

24 191. On information and belief, a manual for the RD9000E dual fuel
25 generator was packaged with the generator that Champion received.

26 192. On information and belief, Champion purchased a sample RD9000E
27 dual fuel generator in order to inspect and test it.

28

1 193. On information and belief, Champion inspected and tested the sample in
2 2015. On information and belief, the Named Inventors inspected and tested the
3 sample in 2015 and/or the results of inspection and testing were disclosed to the
4 Named Inventors in 2015.

5 194. On information and belief, Champion inspected and tested the sample in
6 2015. On information and belief, the Prosecuting Attorneys inspected and tested the
7 sample in 2015 and/or the results of inspection and testing were disclosed to the
8 Prosecuting Attorneys in 2015.

9 195. On information and belief, the results of the inspection and testing were
10 disclosed to the Champion Officers in 2015.

11 196. On information and belief, on September 9, 2019, Champion sent a cease
12 and desist letter to Firman, alleging infringement of one or more of the patents in the
13 2015 Patent Family.

14 197. On information and belief, on October 8, 2019, Firman sent a response
15 letter notifying Champion that the RD9000E dual fuel generator was prior art that
16 anticipated the asserted patents in the 2015 Patent Family.

17 198. On information and belief, on October 10, 2019, Champion sent a letter
18 to Firman acknowledging receipt of Firman's October 10, 2019, letter and requesting
19 documentary proof of the on sale or public availability date of the RD9000E dual fuel
20 generator.

21 199. On information and belief, on October 18, 2019, Firman sent a letter to
22 Champion attaching business records depicting sales of the RD9000E dual fuel
23 generator prior to June 12, 2015. Firman invited Champion to inspect a sample of the
24 RD9000E dual fuel generator.

25 200. On information and belief, on November 20, 2019, Champion's counsel
26 Sam Sumitami and Senior Technical Engineer Jim Miotto inspected a sample of the
27
28

1 RD9000E dual fuel generator at the offices of Firman's counsel in Seattle,
2 Washington.

3 201. On information and belief, Champion's representatives inspected at least
4 the features of the sample RD9000E dual fuel generator that are visible without
5 disassembling the generator. On information and belief, Champion declined an
6 invitation from Firman to inspect the internal components of the generator.

7 202. On information and belief, Sumitami observed that the sample RD9000E
8 dual fuel generator included every claimed feature of the claims of the 2015 Patent
9 Family.

10 203. On information and belief, Miotto observed that the sample RD9000E
11 dual fuel generator included every claimed feature of the claims of the 2015 Patent
12 Family.

13 204. On information and belief, in 2019 Champion sent copies and/or drafts
14 of the September 9, October 8, October 10, and October 18 correspondence between
15 Champion and Firman to the Named Inventors, Prosecuting Attorneys, and/or
16 Champion Officers.

17 205. On information and belief, Champion's representatives at the November
18 20, 2019 inspection shared their observations regarding the features of the RD9000E
19 dual fuel generator with the Named Inventors, Prosecuting Attorneys, and/or
20 Champion Officers.

21 206. On information and belief, Champion's representatives at the November
22 20, 2019 inspection shared their observations that the RD9000E dual fuel generator
23 includes every claimed feature of the 2015 Patent Family with the Named Inventors,
24 Prosecuting Attorneys, and/or Champion Officers.

25 207. On information and belief, on July 7, 2020, Champion sent a demand
26 letter to Generac asserting that accused generators DF3500E and DF7500E infringe
27 the '101 patent.

28

1 208. On information and belief, Champion's July 7, 2020 demand letter did
2 not assert infringement of the 2015 Patent Family because Champion knew that the
3 2015 Patent Family was invalid and/or unenforceable.

4 209. On information and belief, four years later, the Prosecuting Attorneys
5 sent another demand letter on behalf of Champion to Generac, now asserting that
6 certain generators also infringe the 2015 Patent Family.

7 210. The Named Inventors, Prosecuting Attorneys, and/or Champion Officers
8 violated their duty of candor to the USPTO by failing to disclose the RD9000E dual
9 fuel generator during prosecution of the 2015 Patent Family.

10 211. On information and belief, the Named Inventors, Prosecuting Attorneys,
11 and Champion Officers knew that the RD9000E dual fuel generator anticipated the
12 claims of the 2015 Patent Family after Sarder inspected the generator at the May 2015
13 trade show.

14 212. On information and belief, the Named Inventors, Prosecuting Attorneys,
15 and Champion Officers continued to prosecute the 2015 Patent Family after
16 inspecting or learning of the inspection of the RD9000E generator at the May 2015
17 trade show.

18 213. On information and belief, the Named Inventors, Prosecuting Attorneys,
19 and Champion Officers knew that the RD9000E dual fuel generator anticipated the
20 claims of the 2015 Patent Family after Champion purchased and tested the RD9000E
21 dual fuel generator in 2015.

22 214. On information and belief, the Named Inventors, Prosecuting Attorneys,
23 and Champion Officers continued to prosecute the 2015 Patent Family after
24 participating in and/or learning the results of the purchase and testing of the RD9000E
25 dual fuel generator in 2015.

26 215. On information and belief, the Named Inventors, Prosecuting Attorneys,
27 and Champion Officers knew that the RD9000E generator anticipated the claims of
28

1 the 2015 Patent Family after Champion inspected or learned of the inspection of the
2 RD9000E dual fuel generator on November 20, 2019.

3 216. On information and belief, the Named Inventors, Prosecuting Attorneys,
4 and Champion Officers continued to prosecute the 2015 Patent Family after learning
5 the results of the November 20, 2019 inspection.

6 217. On information and belief, the Named Inventors, Prosecuting Attorneys,
7 and Champion Officers withheld information regarding the RD9000E dual fuel
8 generator from the USPTO.

9 218. The withheld information was “but for” material to the prosecution of
10 the 2015 Patent Family because the RD9000E dual fuel generator includes at least
11 one element of at least one claim of each patent in the 2015 Patent Family, thereby
12 making it “but for” material, noncumulative prior art that those involved in
13 prosecution of the patent knew would invalidate the sought after claims.

14 219. To the extent that the claims of the ’780 patent are construed to cover the
15 Firman models that Champion has accused of infringement in *Champion Power*
16 *Equipment, Inc. v. Firman Power Equipment, Inc.*, Case No. 2:23-cv-02371-DWL (D.
17 Ariz.), on information and belief, the RD9000E dual fuel generator discloses every
18 element of at least the following claims of the ’780 patent:

- 19 a. Independent claim 1 by specifically including a mechanical fuel
20 lockout switch for a dual fuel engine having a mechanical fuel
21 valve actuatable between a first position and a second position to
22 selectively control fuel flow to the dual fuel engine from a first
23 fuel source through a first fuel line and a second fuel source
24 through a second fuel line and a fuel lockout apparatus coupled to
25 the mechanical fuel valve, wherein the mechanical fuel lockout
26 switch communicates the first fuel source to the dual fuel engine
27 and prevents communication between the second fuel source and
28 the dual fuel engine when the mechanical fuel valve is in the first
position and communicates the second fuel source to the dual fuel
engine and interrupts the first fuel source communication with the
dual fuel engine when in the second position and wherein the fuel
lockout apparatus is configured to prevent the second fuel source

1 from coupling to the second fuel line while the mechanical fuel
2 valve is in the first position and permit the second fuel source to
3 couple to the second fuel line while the mechanical fuel valve is
in the second position, as called for in claim 1 of the '780 patent.

4 b. Independent claim 8 by specifically including a mechanical fuel
5 fuel lockout switch for an internal combustion engine, the mechanical
6 fuel lockout being assembled by providing an internal combustion
7 engine configured to operate on a fuel from a first fuel source and
8 a different fuel from a second fuel source, coupling a mechanical
9 fuel valve to the internal combustion engine actuatable between a
10 first position and a second position to selectively control fuel flow
11 to the internal combustion engine from the first fuel source
12 through a first fuel line and the second fuel source through a
13 second fuel line, and coupling a fuel lockout apparatus to the
mechanical fuel valve, wherein the fuel lockout apparatus
prevents actuation of the mechanical fuel valve to the first position
when the second fuel source is coupled to the internal combustion
engine, as called for in claim 8 of the '780 patent.

14 c. Independent claim 15 by specifically including a mechanical fuel
15 fuel lockout switch for a dual fuel engine having a mechanical fuel
16 valve actuatable between a first position and a second position to
17 selectively control fuel flow to the dual fuel engine from a first
18 fuel source through a first fuel line and a second fuel source
19 through a second fuel line and a fuel lockout apparatus coupled to
20 the mechanical fuel valve, wherein the mechanical fuel lockout
21 switch communicates the first fuel source to the dual fuel engine
22 and prevents communication between the second fuel source and
23 the dual fuel engine when the mechanical fuel valve is in the first
24 position and communicates the second fuel source to the dual fuel
25 engine and interrupts the first fuel source communication with the
dual fuel engine when in the second position and wherein the fuel
lockout apparatus prevents actuation of the mechanical fuel valve
to the first position when the second fuel source communicates
with the dual fuel engine, as called for in claim 15 of the '780
patent.

26 220. To the extent that the claims of the '398 patent are construed to cover the
27 Firman models that Champion has accused of infringement in *Champion Power*
28

1 *Equipment, Inc. v. Firman Power Equipment, Inc.*, Case No. 2:23-cv-02371-DWL (D.
2 Ariz.), on information and belief, the RD9000E dual fuel generator discloses every
3 element of at least the following claims of the '398 patent:

- 4 a. Independent claim 1 by specifically including a dual fuel engine
5 comprising: an engine operable on a gaseous fuel and a liquid
6 fuel; a switch to change operation of the engine between gaseous
7 fuel and liquid fuel; a carburetor attached to an intake of the engine
8 to mix air and fuel and connect to a gaseous fuel source and a
9 liquid fuel source; a liquid fuel valve positioned along a liquid fuel
10 line coupling the liquid fuel source to the carburetor; a gaseous
11 fuel valve positioned along a gaseous fuel line coupling the
12 gaseous fuel source to the carburetor; and a liquid fuel cutoff
13 incorporated into the carburetor to interrupt liquid fuel upon
14 actuation of the switch from liquid fuel to gaseous fuel, as called
15 for in claim 1 of the '398 patent.
16
17 b. Independent claim 57 by specifically including a method of
18 assembling a dual fuel engine comprising: providing an engine
19 operable on a gaseous fuel and a liquid fuel; attaching a carburetor
20 to an intake of the engine, the carburetor comprising: a throat to
21 mix gaseous fuel with air and liquid fuel with air, a float bowl, and
22 a fuel passage extending from the float bowl to the throat to
23 provide liquid fuel; coupling a switch to the engine to change
24 operation of the engine between gaseous fuel and liquid fuel; and
25 attaching a liquid fuel cutoff to the carburetor to close the fuel
26 passage upon actuation of the switch from liquid fuel to gaseous
27 fuel, as called for in claim 57 of the '398 patent.
28

221. To the extent that the claims of the '120 patent are construed to cover the
22 Firman models that Champion has accused of infringement in *Champion Power*
23 *Equipment, Inc. v. Firman Power Equipment, Inc.*, Case No. 2:23-cv-02371-DWL (D.
24 Ariz.), on information and belief, the RD9000E dual fuel generator discloses every
25 element of at least the following claim of the '120 patent:

- 26 a. Independent claim 12 by specifically including a multifuel
27 generator and fuel delivery system having a multifuel internal
28 combustion engine configured to operate on a liquid fuel supplied
from a liquid fuel source through a liquid fuel line and a gaseous
fuel supplied from a pressurized fuel source through a gaseous fuel

1 line, an alternator driven by the multifuel internal combustion
2 engine, and a fuel regulator system including a primary pressure
3 regulator coupled to a service valve of a pressurized fuel source to
4 regulate fuel supplied from the pressurized fuel source to a
5 reduced pressure and a secondary pressure regulator coupled to
6 the primary pressure regulator to regulate fuel supplied from the
7 primary pressure regulator to a desired pressure for delivery
8 through the gaseous fuel line to operate the engine, as called for in
9 claim 12 of the '120 patent.

10 222. To the extent that the claims of the '145 patent are construed to cover the
11 Firman models that Champion has accused of infringement in *Champion Power*
12 *Equipment, Inc. v. Firman Power Equipment, Inc.*, Case No. 2:23-cv-02371-DWL (D.
13 Ariz.), on information and belief, the RD9000E dual fuel generator discloses every
14 element of at least the following claim of the '145 patent:

- 15 a. Independent claim 1 by specifically including a dual fuel
16 generator comprising: an engine operable on a gaseous fuel and a
17 liquid fuel; an electrical power generator driven by the engine and
18 comprising a charging coil; a switch to change operation of the
19 engine between gaseous fuel and liquid fuel; a carburetor attached
20 to an intake of the engine to mix air and fuel and connect to a
21 gaseous fuel source and a liquid fuel source; a liquid fuel cut—off
22 solenoid to interrupt liquid fuel flow to the engine upon actuation
23 of the switch from liquid fuel to gaseous fuel; and a voltage
24 regulator coupled to the charging coil to receive power therefrom
25 and that operates to provide a regulated voltage to the liquid fuel
26 cut-off solenoid, as called for in claim 1 of the '145 patent.

27 223. To the extent that the claims of the '985 patent are construed to cover the
28 Firman models that Champion has accused of infringement in *Champion Power*
Equipment, Inc. v. Firman Power Equipment, Inc., Case No. 2:23-cv-02371-DWL (D.
Ariz.), on information and belief, the RD9000E dual fuel generator discloses every
element of at least the following claim of the '985 patent:

- a. Independent claim 16 by specifically including a dual fuel
generator and fuel delivery system having a dual fuel generator
configured to operate on a liquid fuel supplied from a liquid fuel
source through a liquid fuel line and a gaseous fuel supplied from

1 a pressurized fuel source through a gaseous fuel line; and a fuel
2 regulator system located off board a dual fuel generator, including
3 a primary pressure regulator coupled to a service valve of a
4 pressurized fuel source, configured to regulate the gaseous fuel
5 supplied from the pressurized fuel source in the first stage, the
6 gaseous fuel regulated down to a first reduced pressure in the first
7 stage and regulate the gaseous fuel output from the first stage in
8 the second stage, the first reduced pressure gaseous fuel from the
9 first stage being regulated down to a second reduced pressure in
10 the second stage for delivery through the gaseous fuel line to
operate the generator, wherein the fuel regulator system outputs
gaseous fuel to the generator for operation of the engine at the
second reduced pressure, as called for in claim 16 of the '985
patent.

11 224. To the extent that the claims of the '654 patent are construed to cover the
12 Firman models that Champion has accused of infringement in *Champion Power*
13 *Equipment, Inc. v. Firman Power Equipment, Inc.*, Case No. 2:23-cv-02371-DWL (D.
14 Ariz.), on information and belief, the RD9000E dual fuel generator discloses every
15 element of at least the following claim of the '654 patent:

- 16 a. Independent claim 6 by specifically including a dual fuel
17 generator and fuel delivery system having a dual fuel generator
18 configured to operate on a liquid fuel supplied from a liquid fuel
19 source through a liquid fuel line and a gaseous fuel supplied from
20 a pressurized fuel source through a gaseous fuel line, a fuel
21 regulator system located off board the dual fuel generator and
22 having a primary pressure regulator coupled to a service valve of
23 a pressurized fuel source and configured to regulate a gaseous fuel
24 supplied from the pressurized fuel source to a first reduced
25 pressure and a secondary pressure regulator coupled to the
26 primary pressure regulator and configured to regulate the gaseous
27 fuel supplied from the primary pressure regulator down from the
28 first reduced pressure to a second reduced pressure for delivery
through a gaseous fuel line to operate the dual fuel generator, a
mechanical fuel valve actuatable between a first position and a
second position to selectively control fuel flow to the dual fuel
generator from a liquid fuel source through a liquid fuel line and
the pressurized fuel source through the gaseous fuel line and that
opens and closes the liquid fuel line to selectively control fuel flow

1 from the liquid fuel source to the dual fuel generator, and a fuel
2 lockout apparatus coupled to the mechanical fuel valve and
3 configured to prevent the pressurized fuel source from coupling to
4 the gaseous fuel line while the mechanical fuel valve opens the
5 liquid fuel line and permit the pressurized fuel source to couple to
6 the gaseous fuel line while the mechanical fuel valve closes the
7 liquid fuel line, as called for in claim 6 of the '654 patent.

8 225. To the extent that the claims of the '970 patent are construed to cover the
9 Firman models that Champion has accused of infringement in *Champion Power*
10 *Equipment, Inc. v. Firman Power Equipment, Inc.*, Case No. 2:23-cv-02371-DWL (D.
11 Ariz.), on information and belief, the RD9000E dual fuel generator discloses every
12 element of at least the following claims of the '970 patent:

13 a. Independent claim 1 by specifically including a dual fuel
14 generator and fuel delivery system including a dual fuel generator
15 having an engine configured to operate on a liquid fuel supplied
16 from a liquid fuel source through a liquid fuel line and a gaseous
17 fuel supplied from a pressurized fuel source through a gaseous fuel
18 line and a carburetor attached to an intake of the engine to mix air
19 and fuel and connect the liquid fuel line to the intake; a fuel
20 regulator system located off board the dual fuel generator, the fuel
21 regulator system including a primary pressure regulator coupled
22 to a service valve of the pressurized fuel source and configured to
23 regulate the fuel supplied from the pressurized fuel source to a
24 reduced pressure and a secondary pressure regulator coupled to
25 the primary pressure regulator and configured to regulate the
26 gaseous fuel supplied from the primary pressure regulator to a
27 desired pressure for delivery through the gaseous fuel line to
28 operate the dual fuel generator; and a mechanical fuel valve
actuatable between a first position and a second position to
selectively control fuel flow to the engine from the liquid fuel
source through the liquid fuel line and the pressurized fuel source
through the gaseous fuel line, as called for in claim 1 of the '970
patent.

b. Independent claim 20 by specifically including a dual fuel
generator and fuel delivery system comprising: a dual fuel
generator configured to operate on a liquid fuel supplied from a
liquid fuel source through a liquid fuel line and a gaseous fuel

1 supplied from a pressurized fuel source through a gaseous fuel
2 line, the dual fuel generator comprising: a gaseous fuel valve
3 coupled to an inlet of the gaseous fuel line and connectable to the
4 pressurized fuel source, and a mechanical fuel valve actuatable
5 between a first position and a second position to selectively
6 control fuel flow to the dual fuel generator from the liquid fuel
7 source through the liquid fuel line and the pressurized fuel source
8 through the gaseous fuel line; and a fuel regulator system located
9 off board the dual fuel generator, the fuel regulator system
10 comprising: a primary pressure regulator connectable to a service
11 valve of the pressurized fuel source and configured to regulate the
12 fuel supplied from the pressurized fuel source to a reduced
13 pressure, and a secondary pressure regulator coupled to the
14 primary pressure regulator and connectable to the gaseous fuel
15 valve, the secondary pressure regulator configured to regulate the
16 gaseous fuel supplied from the primary pressure regulator to a
17 desired pressure for delivery through the gaseous fuel line to
18 operate the dual fuel generator, as called for in claim 20 of the
19 '970 patent.

20 226. To the extent that the claims of the '895 patent are construed to cover the
21 Firman models that Champion has accused of infringement in *Champion Power*
22 *Equipment, Inc. v. Firman Power Equipment, Inc.*, Case No. 2:23-cv-02371-DWL (D.
23 Ariz.), on information and belief, the RD9000E dual fuel generator discloses every
24 element of at least the following claims of the '895 patent:

- 25 a. Independent claim 1 by specifically including a mechanical fuel
26 lockout switch for a dual fuel engine having a mechanical fuel
27 valve actuatable between a first position and a second position to
28 selectively control fuel flow to the dual fuel engine from a first
fuel source through a first fuel line and a second fuel source
through a second fuel line, the mechanical fuel valve configured
to allow communication between the first fuel source and the dual
fuel engine and prevent communication between the second fuel
source and the dual fuel engine while in the first position and
prevent communication between the first fuel source and the dual
fuel engine while in the second position; and a fuel lockout
apparatus coupled to the mechanical fuel valve and configured to
prevent the second fuel source from coupling to the second fuel
line while the mechanical fuel valve is in the first position and

1 permit the second fuel source to couple to the second fuel line
2 while the mechanical fuel valve is in the second position, as called
3 for in claim 1 of the '895 patent.

4 b. Independent claim 8 by specifically including a mechanical fuel
5 lockout switch for a dual fuel engine having a mechanical fuel
6 valve actuatable between a first position and a second position to
7 selectively control fuel flow to the dual fuel engine from a first
8 fuel source through a first fuel line and a second fuel source
9 through a second fuel line, the mechanical fuel valve configured
10 to allow communication between the first fuel source and the dual
11 fuel engine and prevent communication between the second fuel
12 source and the dual fuel engine while the first position and prevent
13 communication between the first fuel source and the dual fuel
14 engine while in the second position; and a fuel lockout apparatus
15 coupled to the mechanical fuel valve and configured to prevent
16 actuation of the mechanical fuel valve to the first position when
17 the second fuel source is in communication with the dual fuel
18 engine, as called for in claim 8 of the '895 patent.

19 c. Independent claim 14 by specifically including a dual fuel
20 generator and fuel delivery system having a dual fuel generator
21 configured to operate on a liquid fuel supplied from a liquid fuel
22 source through a liquid fuel line and a gaseous fuel supplied from
23 a pressurized fuel source through a gaseous fuel line; a fuel
24 regulator system located off board the dual fuel generator, the fuel
25 regulator system including a primary pressure regulator couplable
26 to a service valve of the pressurized fuel source and configured to
27 regulate the gaseous fuel supplied from the pressurized fuel source
28 to a reduced pressure and a secondary pressure regulator couplable
to the primary pressure regulator and configured to regulate the
gaseous fuel supplied from the primary pressure regulator to a
desired pressure for delivery through the gaseous fuel line to
operate the dual fuel generator; a mechanical fuel valve actuatable
between a first position and a second position to selectively
control fuel flow to the dual fuel generator from the liquid fuel
source through the liquid fuel line and the pressurized fuel source
through the gaseous fuel line, the mechanical fuel valve
configured to open and close the liquid fuel line to selectively
control fuel flow from the liquid fuel source to the dual fuel
generator; and a fuel lockout apparatus coupled to the mechanical
fuel valve and configured to prevent the pressurized fuel source

1 from coupling to the gaseous fuel line while the liquid fuel line is
2 open and permit the pressurized fuel source to couple to the
3 gaseous fuel line while the liquid fuel line is closed by the
mechanical fuel valve, as called for in claim 14 of the '895 patent.

4 227. On information and belief, the Named Inventors, Prosecuting Attorneys,
5 and Champion Officers knew that the withheld information was "but for" material
6 and noncumulative to the prosecution of the 2015 Patent Family because they knew
7 that the RD9000E dual fuel generator anticipates and/or renders obvious at least one
8 claim of each patent in the 2015 Patent Family.

9 228. The Named Inventors, Prosecuting Attorneys, and Champion Officers
10 had the specific intent to deceive the USPTO, which can be reasonably inferred from
11 at least the following conduct:

- 12 • Despite having knowledge of the public availability of the RD9000E
13 dual fuel generator at the May 2015 trade show, failing to disclose the
14 RD9000E dual fuel generator to the USPTO;
- 15 • Despite having knowledge that a RD9000E dual fuel generator manual
16 was publicly available prior to June 12, 2015, failing to disclose the
17 generator or its manual to the USPTO;
- 18 • Despite having knowledge that the RD9000E dual fuel generator was
19 sold prior to June 12, 2015, failing to disclose the RD9000E dual fuel
20 generator to the USPTO;
- 21 • Despite having knowledge at least as early as July 7, 2020, that the 2015
22 Patent Family is invalid or unenforceable, asserting infringement of
23 those patents in 2024; and
- 24 • Taking infringement positions in this action, *Champion Power*
25 *Equipment Inc v. Generac Power Systems Inc*, Case No. 2:24-cv-01281-
26 LA (E.D. Wis.), and in *Champion Power Equipment, Inc. v. Firman*
27 *Power Equipment, Inc.*, Case No. 2:23-cv-02371-DWL (D. Ariz.), that
28

1 would clearly render the RD9000E generator an anticipatory prior art
2 reference.

3 * * * *

4 Discovery in this action is in its early stages and HFT continues to investigate
5 the allegations set forth in the Counterclaims. HFT hereby provides explicit notice to
6 Champion that it intends to rely upon such other defenses as may become available
7 by law or in equity, or pursuant to statute, as discovery proceeds in this action, and
8 hereby reserves the right to assert such additional defenses.

9 * * * *

10 WHEREFORE, HFT respectfully requests that the Court enter judgment in its
11 favor and against Champion on Champion's Counterclaims, and grant the following
12 relief:

- 13 1. Dismissing, with prejudice, Champion's Counterclaims against HFT in
14 their entirety;
- 15 2. Denying all relief that Champion seeks in its Counterclaims;
- 16 3. Declaring that HFT does not now and has never infringed, induced the
17 infringement of, or contributed to the infringement of any valid and enforceable claim
18 of the Asserted Patents in the Counterclaims;
- 19 4. Finding this case to be exceptional under 35 U.S.C. § 285 and awarding HFT
20 its costs and attorneys' fees;
- 21 5. Awarding HFT its costs, expenses, disbursements, and attorneys' fees
22 incurred in connection with this action; and
- 23 8. Awarding HFT any other relief the Court deems just and equitable.

1 DATED: March 20, 2025

Respectfully submitted,

2
3 QUINN EMANUEL URQUHART &
SULLIVAN, LLP

4
5
6 By /s/ Eric H. Huang

QUINN EMANUEL URQUHART
& SULLIVAN, LLP

David M. Grable (SBN 237765)
davegrable@quinnemanuel.com

Lauren Lindsay (SBN 280516)
laurenlindsay@quinnemanuel.com
865 South Figueroa Street, 10th Floor
Los Angeles, CA 90017-2543
Telephone: (213) 443 3000
Facsimile: (213) 443 3100

14 QUINN EMANUEL URQUHART
& SULLIVAN, LLP

Eric Huang (*pro hac vice*)
erichuang@quinnemanuel.com
295 Fifth Avenue
New York, NY 10016-7103
Telephone: (212) 849-7000
Facsimile: (212) 849-7100

19
20 *Attorneys for Plaintiff Harbor Freight*
21 *Tools USA, Inc.*

CERTIFICATE OF SERVICE

A true and correct copy of the foregoing instrument was served or delivered electronically via U.S. District Court [LIVE] Document Filing System, to all counsel of record, on March 21, 2025.

/s/ Eric H. Huang

Eric H. Huang