

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

CHAMPION POWER EQUIPMENT, INC.,

Patent Owner.

Patent No. 11,492,985

Issued: November 8, 2022

Title: OFF-BOARD FUEL REGULATOR FOR GENERATOR ENGINE

Inter Partes Review No. IPR2025-01272

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

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I. INTRODUCTION

Petitioners oppose Patent Owner Champion Power Equipment Inc.’s (“Patent Owner”) request for discretionary denial. Paper 8 (hereinafter “RDD”).

The Deputy Director recently referred the “closely related”¹ ’034 Patent IPR and the ’101 Patent IPR to the merits panel. IPR2025-00805, Paper 20 (“’034 Referral Decision”); IPR2025-00951, Paper 18 (“’101 Referral Decision”). Discretionary denial is not appropriate here for the same reasons, including the efficiencies from consolidating multiple litigations involving many patents and the Examiner’s material error during prosecution. ’034 Referral Decision at 2-3.

“Patent Owner has sued a large number of parties in a multitude of districts.” *Id.* at 2. Petitioners filed thirteen IPRs challenging all patents asserted across the three litigations against Petitioners (the “Related IPRs”). As the Director recognized in the ’034 and ’101 Referral Decisions, consolidating invalidity arguments across three litigations into a single set of IPRs is an efficient use of resources, especially since none of the three litigations have trial dates and any trials are expected to occur after a FWD here. *Id.*; *see also* ’101 Referral Decision at 2.

Additionally, the ’985 Patent was improperly granted due to a critical

¹ *See* IPR2025-00951, Paper 8 (Patent Owner describing its 2015 Patent family—of which the ’034 and ’985 Patents are members as “closely related” to its 2013 Patent family—of which the ’101 Patent is a member).

Examiner oversight, which included failing to consider at least the Honda EU20i Video (EX2076), which anticipates at least Claim 1. Instituting this IPR would allow the Board to address this material error, in addition to the strong merits of the Petition which advances three independent §102 references.

Furthermore, Patent Owner has no settled expectations in the '985 Patent. It is only three years old, three years younger than the referred '034 Patent and almost two years younger than the referred '101 Patent. Petitioners' forceful rebuke of Patent Owner's enforcement attempts for the '101 Patent further eliminates Patent Owner's expectations in the '985 Patent.

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

In sum, when holistically assessing the facts, evidence, circumstances, and other considerations, discretionary denial is not appropriate. This Petition should be instituted for consideration the merits.

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

“Because the litigation between the parties would proceed to several district court trials in different jurisdictions, resolving the dispute between the parties at the Office would be more efficient.” '034 Referral Decision at 2. Allowing this IPR (and the Related IPRs) to proceed represents the epitome of efficient and appropriate use

of Office resources, given that the alternative is having four different jury trials proceed to assess invalidity of the asserted patents in four different district courts. Such piecemeal adjudication creates a high likelihood of inconsistent outcomes. Compared to presenting broad invalidity cases to four different juries, the Board is much better positioned to grasp and efficiently handle a single set of challenges to so many patents from two different families involving complicated aspects of multi-fuel engine/generator designs. The vast efficiencies gained by consolidating the three Petitioner district court invalidity proceedings into a single set of proceedings before the PTAB is a highly appropriate use of Office resources, and reason enough by itself to refuse discretionary denial. *Berkshire Hathaway Energy Co. v. Birchtech Corp.*, IPR2025-00274, Paper 23, at 2-3 (July 2, 2025); *Shenzhen Tuozhu Tech. Co. v. Stratasys, Inc.*, IPR2025-00438, Paper 10, at 3 (July 17, 2025) (referring to the Board where the district court proceeding involved a “large number and vast scope” of patents). Both the ’034 Patent IPR from the same patent family and the related ’101 Patent IPR have already been referred to the merits panel for these efficiencies.’034 Referral Decision at 2-3; ’101 Referral Decision at 2. This IPR should be instituted to realize those efficiency gains. *Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12, at 3-4 (July 26, 2025).

Patent Owner asserted 13 patents against the three Petitioners in three different district courts in California (Harbor Freight), Wisconsin (Generac), and

Nevada (MWE), and has asked a fourth court in Arizona to adjudicate the same patents as to non-petitioner Firman. RDD, 8-10. Petitioners filed IPR petitions against all 13 patents to streamline the invalidity challenges in a single set of IPRs and ensure consistent invalidity determinations. The combined 13 IPRs set forth only 27 prior art references in total, applied against approximately 320 challenged claims. This is an average of about two prior art references per patent, and only one reference for every 12 challenged claims. The Petitions thus represent a greatly streamlined invalidity case as compared to, for example, the 69 prior art references asserted by Firman. RDD, 8.

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

Material error during prosecution also weighs heavily against discretionary denial, often overcoming facts that may otherwise favor denial. *See Freightcar Am., Inc. v. Nat'l Steel Car Ltd.*, IPR2025-01046, Paper 20, 2-3 (Oct. 10, 2025) (referring petition for a 13-year old patent, based on examiner error where “examiner overlooked certain teachings of” a reference cited in an IDS “that appear[s] to disclose the allowable features”); *Taiwan Semiconductor Mfg. Co. Ltd. v. Marlin Semiconductor Ltd.*, IPR2025-00847, Paper 11, 3-4 (Sept. 3, 2025) (referring despite challenged patent being in force for 15 years, because the “Office erred in a manner material to the patentability of the challenged claims during patent examination” by “overlook[ing] certain teachings in” a reference from prosecution “that appear to

disclose the claimed features that the patent examiner indicated were not taught by the prior art of record, including” the reference); *Xencor, Inc. v. Merus N.V.*, IPR2025-00604, Paper 12, at 2-3 (July 17, 2025) (referring based on Petitioner’s persuasive evidence that the teachings of a cited reference were overlooked).

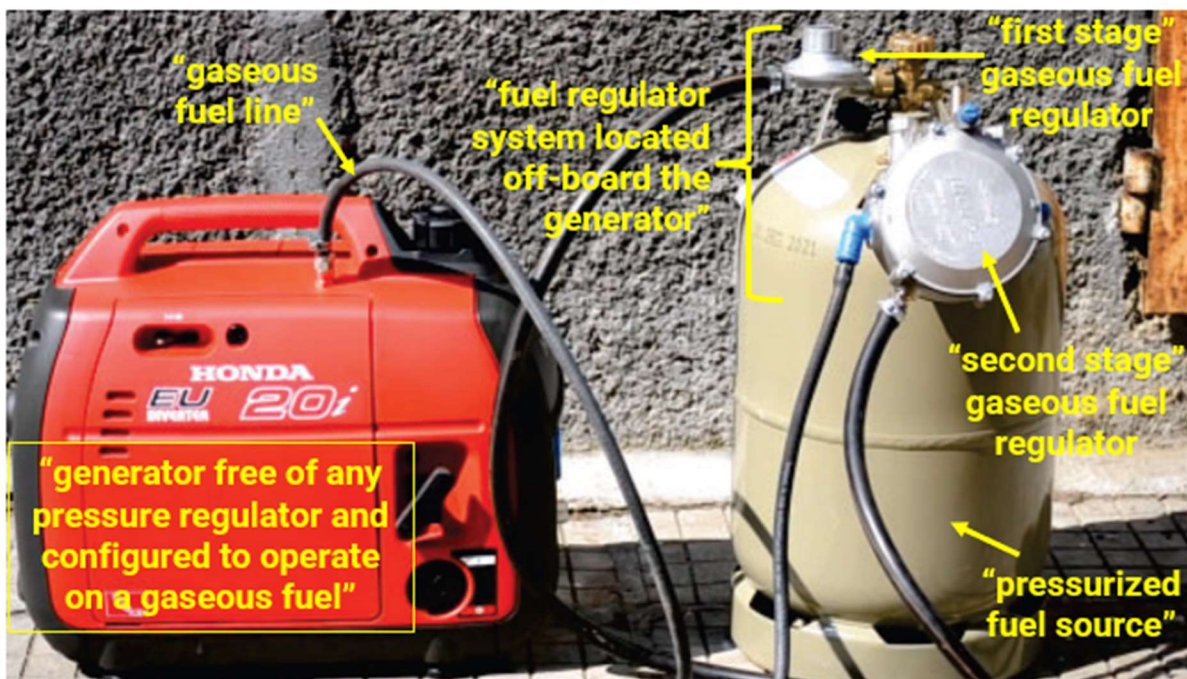
During prosecution, the Examiner’s rejection based on the “Bassguitarist1985” video was appealed to the Board. EX1002, 147, 152-64. In the Appeal Decision, the Board focused on the claim language “fuel regulator system located off-board the generator,” and determined that Bassguitarist1985’s gaseous fuel regulator was mounted to and located with the generator. *Id.*, 234-39. Thus, the Examiner’s rejection was reversed because the fuel regulator was not located “off-board” or remote from the generator. *Id.* The Examiner subsequently allowed the pending claims without amendment “as per the patent board decision.” *Id.*, 273. Accordingly, the prosecution history shows that the allegedly novel feature of the claims was having a fuel regulator system located “off-board” the generator.

However, this exact teaching was before the Examiner in other prior art. Specifically, the Examiner failed to consider the EU20i Video (EX2076), cited with the grandparent ’780 Patent (*see* RDD, 17), which discloses the allegedly novel feature and also anticipates at least Claim 1 of the ’985 Patent.

Patent Owner admits that the EU20i Video was before the Examiner during prosecution, and that it “disclose[s] an external propane tank that supplies LPG fuel

to an engine and two pressure regulators in line with the LPG supply hose.” *Id.* Moreover, as Patent Owner’s own screen shots from the EU20 Video show, the first and second pressure regulators (which together constitute the claimed “fuel regulator system”) are attached to the LPG tank. *See, e.g.,* EX2075, 6 (showing two gray-colored regulators attached to the LPG tank); *see also* EX2076 at 01:24 (showing the operator adjusting the primary regulator, with both regulators attached to LPG tank). Thus, the EU20 Video discloses the very feature upon which allowance was based, but was missed by the Examiner during prosecution. This alone amounts to Examiner error sufficient to overcome discretionary denial. *TSMC*, IPR2025-00847, Paper-11, 3-4.

Further, the EU20 Video goes beyond just disclosing the allegedly novel feature, it actually discloses every limitation of Claim 1, as illustrated below:



EX2075, 6 (annotated). It was therefore Examiner error to not reject Claim 1 based on the EU20 Video.

Patent Owner argues that Parlature is substantially the same as the EU20i Video. RDD, 17. The Parlature grounds in the Petition (*see* Pet., Grounds 1-2, 6-8) similarly invalidate the '985 Patent claims, and instituting the Petition will allow the Board to address the material errors made during examination.

IV. SETTLED EXPECTATIONS WEIGH AGAINST DISCRETIONARY DENIAL

Petitioner argues its expectations in the '985 Patent “have been settled for years.” RDD, 4. But the '985 Patent had not even been in force for three years—it issued on November 8, 2022—before this IPR was filed. Challenges to patents in force for much longer durations are consistently characterized as “early” and “favor[ing] robust predictable patent rights and weigh[ing] against discretionary denial.” *See, e.g., TankLogix, LLC v. SitePro, Inc.*, IPR2025-00650, Paper 10, at 2 (July 31, 2025) (“[T]he patents challenged ... have not been in force for a significant amount of time (issued in 2019,...). Accordingly, Patent Owner has not developed strong settled expectations that favor discretionary denial.”); *Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc.*, IPR2025-00434, Paper 11, at 2-3 (June 26, 2025) (“Furthermore, most of the challenged patents have not been in force for a significant period of time (issued in 2020, 2019 and 2019), and, accordingly, Patent Owner has not yet developed strong settled expectations that favor discretionary

denial as to at least those patents.”); *Berkshire Hathaway*, IPR2025-00274, Paper 23, at 3 (referring to the Board where Patent Owner had not developed strong settled expectations for the challenged patents that issued in 2019 and 2020); *WebGroup Czech Republic, A.S. v. Dish Techs. LLC.*, IPR2025-00467, Paper 14, at 2 (July 16, 2025) (“[T]he challenged patents have not been in force for a significant period of time (2019, 2021, 2022, and 2023), such that the Patent Owner has not developed strong settled expectations.”).

Patent Owner appears to believe that it had settled expectations in the ’985 Patent upon issuance because of its parent patents. RDD, 4. But Patent Owner cannot develop expectations in the ’985 Patent based on its ancestors. Continuations often broaden their claims relative to their parents, such that the child may be subject to invalidity attacks that are not applicable to their parents. This is precisely what has occurred here, where Claim 1 of the ’985 Patent is not even limited to a *dual-fuel* generator/engine, unlike the claims of the ’034 and ’101 Patents. *See* IPR2025-00805, EX1001; IPR2025-00951, EX1001.

To the extent parent-child relationships are considered, the ’034 Patent IPR was already referred, making it efficient to institute the ’985 Patent. For example, in *Embody, Inc. v. Lifenet Health*, both a parent patent and its child were challenged via IPR. IPR2025-00248, Paper 13 (June 26, 2025). The child was deemed to not trigger settled expectations and was referred to the merits panel. The parent was also

referred to the merits panel because “it is an efficient use of Board resources to address the related patent.” *Id.*, 3; *see also Padagis*, IPR2025-00464, Paper 12, at 3-4 (same). Efficiency gains in the present case are particularly pronounced, given identical specifications of the directly related patents, the overlap in limitations of the child patents’ claims and those of the parent patents, and the referral of the “closely related” ’034 and ’101 Patent IPRs.

Moreover, Patent Owner’s prior communications with Petitioners gave rise to an expectation of IPR filings. Patent Owner sent “cease-and-desist” letters to MWE and Generac in 2020, alleging infringement of the ’101 Patent (EX2033; EX2036), which is not even in the same family as the ’985 Patent. Patent Owner did not raise the ’101 Patent with Harbor Freight until a March 27, 2024, letter, which did not even accuse Harbor Freight of infringing the ’101 Patent. EX2038, 2. In response to the 2020 letters, both MWE and Generac informed Patent Owner that its claims were invalid. EX2034, EX2035, EX2037. MWE even told Patent Owner that it **would file an IPR** if Patent Owner further pursued its dubious infringement claims (EX2034).

Tellingly, prior to embarking on its current litigation campaign (initiated four years after its last communications on the matter), Patent Owner never again raised the infringement issues with either MWE or Generac. Under these circumstances, it would be illogical and contrary to the evidence of record to find that Patent Owner had any “reasonable expectation” that the validity of the ’101 Patent would not be

challenged. Indeed, the only “reasonable expectation” to be taken from their prior correspondence exchanges is that Patent Owner understood that its patents **would be challenged in IPR proceedings** in the event that Patent Owner sought to enforce them. And that is exactly what has transpired.

V. FINTIV FACTORS WEIGH AGAINST DISCRETIONARY DENIAL

This is the quintessential case for institution. All *Fintiv* factors weigh against discretionary denial. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 5-6 (Mar. 20, 2020). The weight of the *Fintiv* factors and related considerations against discretionary denial are further detailed below:

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

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

1. The MWE, Generac, and Harbor Freight Cases

The MWE case is pending in the District of Nevada before Judge Traum. Judge Traum has granted a contested motion to stay on similar facts. *See FaceTec, Inc. v. iProov, Ltd.*, No. 21-cv-02252, Dkt. 188 (D. Nev. June 18, 2025) (attached as EX1055). And this district has granted stays 67% of the time. EX1058.

The Generac case is pending in the Eastern District of Wisconsin before Judge Adelman. Judge Adelman has granted contested motions to stay 70% of the time (EX1056), which is comparable to the district's average grant rate of 73% (EX1057).

The Harbor Freight case is pending in the Central District of California. This district has granted stays at a 66% rate (EX1059, ¶5, Ex. B, 12).

Furthermore, both Generac and Harbor Freight have had meet-and-confers with Patent Owner regarding their intention to seek stays of their litigations.² In both cases, Patent Owner indicated an openness to stays if the IPRs are referred to the Board (EX1059, ¶4; EX1061, 1), creating a high likelihood the MWE, Generac, and Harbor Freight cases will be stayed. *See, e.g.*, EX1062 (showing that all uncontested stays have been granted in EDWI); EX1063 (same in Nevada).

2. The Firman Case

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

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

cv-03125, ECF No. 187 (D. Ariz. Nov. 29, 2018) (attached as EX1060).

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

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

1. The MWE, Generac, and Harbor Freight Cases

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

Regarding the MWE case, the average time to trial in Nevada is 53 months, with a median of 42 months. EX1064. Even using the shorter median, the data suggests a trial date at the end of 2028, nearly two years after the FWD.

Regarding the Generac case, Judge Adelman has presided over one patent case since 2008, which took 43 months to reach trial. EX1065. A similar timeline here

would place trial around April 2028 – over a year after the FWD. Even if the district’s overall median time-to-trial of 34 months is considered (EX1066), trial would not be expected to occur until August 2027, seven months after the FWD. The Generac court also recently extended its case schedule, further delaying this parallel proceeding. EX1083.

Regarding the Harbor Freight case, Patent Owner references a prior proposed schedule (RDD, 8-9), but fails to mention that this proposal was filed with a different judge and never adopted. With a median time to trial of 35 months, trial is projected to occur in September 2027, eight months after the FWD. EX1067, 1.

2. The Firman Case

The Firman case does not support discretionary denial because Petitioners are not a party to the Firman case, and Firman is not a privy or real-party-in-interest in this IPR. *POSCO*, IPR2025-00370, Paper 10, at 2-3. Nonetheless, Patent Owner alleges the Firman trial will occur before the FWD date. RDD, 8. However, the Firman case is already running significantly behind schedule. Specifically, Patent Owner’s own exhibit indicates a median time to claim construction of 15.7 months (EX2047, 1-2), suggesting a claim construction ruling should have occurred in February 2025. Yet now, as of October 2025, no *Markman* hearing has even been scheduled. Thus, the Firman case is already running at least **eight months** behind schedule compared to the statistics Patent Owner relies upon for its prediction. As a

result, any trial in the Firman case will likely occur well after the FWD.

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

Factor 3 weighs against discretionary denial because the district court cases involving the Petitioners are all at very early stages. For example, even Patent Owner admits that the MWE case is still in its “early stages.” RDD, 9.

Similarly, Patent Owner recently described the Generac case as being in its “infancy.” EX1070, 13-15. Patent Owner should not be allowed to take a contradictory position before the Board simply to suit its needs here.

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

Patent Owner again makes much of the parties’ purported “investment” in the

Firman case but cites no authority for why that case – in which Petitioners have no involvement whatsoever and there is no invalidity argument based on the prior art combinations presented in this IPR – has any bearing on *Fintiv* Factor 3 here.

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

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

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

EX2069; EX2089; EX2090.

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

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

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

a single set of proceedings before the PTAB. As the Director already found in the '034 Patent IPR, this factor clearly weighs strongly against discretionary denial. '034 Referral Decision at 2; *Berkshire Hathaway*, IPR2025-00274, Paper 23, at 2-3.

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

Patent Owner's discretionary denial brief mentions Firman nearly 50 times. Yet Firman is conspicuously absent from Patent Owner's discussion of this factor. RDD, 15. Patent Owner cannot have it both ways—relying on the Firman case when it suits its needs for other factors, while ignoring Firman for its discussion of *Fintiv* Factor 5. The parties before the Board and their three respective district court cases are the same, as in almost all IPRs. However, the opposite is true with respect to the Firman case, where Petitioners are not a party. Given Patent Owner's extensive attempted reliance on the Firman case in its arguments, this fact weighs *Fintiv* Factor 5 against discretionary denial. *Cf. POSCO*, IPR2025-00370, Paper 10, at 2.

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

Multiple considerations under Factor 6 weigh strongly against discretionary denial. Patent Owner's arguments for Factor 6 (RDD, 15-16) overlook or sidestep the most important considerations, as discussed below and in §§II–IV above.

1. Strength of Grounds Weighs Against Discretionary Denial

Patent Owner puts forth no true argument as to the merits of the Petition, citing

only to its forthcoming Preliminary Response. RDD, 15. In fact, the merits of the Petition are strong, including well-grounded theories of invalidity based on three separate §102 prior art references. *See* Petition, Grounds 1, 3, 5.

2. No Forum Has Adjudicated Any Claim of the '985 Patent, Which Weighs Against Discretionary Denial

The '985 Patent's claims have not been reexamined, reissued, or otherwise adjudicated in any other forum to Petitioners' knowledge. Nor are they expected to be adjudicated in any other forum before a FWD is expected to issue in this proceeding, if instituted. *See supra*, §V.B.

VI. SECTION 325(d) WEIGHS AGAINST DISCRETIONARY DENIAL

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

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

Patent Owner argues that Parlature is substantially similar to the EU20 video. RDD, 17. But this only highlights the Examiner's error in overlooking the teachings of the EU20 Video, which clearly shows the allegedly novel feature of the fuel regulator system (i.e., the first and second stage gaseous fuel regulators) being located at the LPG tank and thus "off-board" the generator. *See supra*, §III. That both Parlature and the EU20 Video both anticipate various claims of the '985 Patent is hardly a reason to not institute this proceeding.

Furthermore, Parlatore is clearly not cumulative of the EU20 Video with respect to other challenged claims. For example, Claim 2 of the '985 patent calls for a single regulator having two stages therein. As set forth in the Petition, Parlatore describes such a dual-stage regulator, while the EU20 Video shows two separate regulators. *Compare* Pet., 42-43 *with* EX2075, 6. Accordingly, Parlatore is **not** cumulative to the EU20 Video with respect to all challenged claims.

Patent Owner's additional §325(d) arguments fare even worse. For example, Patent Owner tries to say that the Tri-Fuel Video is merely cumulative of the Bassguitarist1985 video relied on by the Examiner. RDD, 17-18 (referring to Bassguitarist1985 as the "EF2000iS Video"). However, as noted previously (*supra*, §III), the Board reversed the Examiner's rejection because Bassguitarist1985 did not disclose a fuel regulator system (i.e., both the first and second stage regulators) located off-board or remote from the generator. EX1002, 238-39. Yet, this is exactly why the Tri-Fuel Video was relied on in the Petition, because it **does** disclose the first and second regulators being located **off-board and remote** from the generator. *See* Pet., 60-63. Given this critical distinction relevant to the patentability of the claims, the Tri-Fuel Video is clearly not "cumulative" to Bassguitarist1985.

Perhaps even more perplexing is Patent Owner's claim (RDD, 18) that the third §102 reference relied upon in the Petition, Chaudhari, is cumulative of Kojima. Even a cursory review of Kojima shows that it never even refers to or uses the word

“generator.” *See* EX1086. Yet generators are taught as a preferred implementation in Chaudhari. EX1008, 4; *see also* id. 6-8 (referencing generators repeatedly). This is a critical distinction given that the claims of the ’985 Patent are directed to generators. Chaudhari is thus clearly not cumulative to Kojima.

Patent Owner’s remaining §325(d) arguments are directed towards references that were applied in the Petition’s obviousness grounds. Because the allowance of the claims turned only on the fuel regulator system being located off-board the generator (EX1002, 238-39, 273), whether or not these remaining references are cumulative of art before the Examiner is irrelevant for purposes here.

B. The Office Materially Erred in Overlooking the EU20 Video

The Office materially erred in overlooking the EU20i Video, as evidenced by the Appeal Board’s reasoning focused on the fuel regulator system being located off-board the generator, which the EU20 Video clearly discloses. *Supra* §III. Discretionary denial is therefore unwarranted under §325(d). *See Ecto World, LLC v. RAI Strategic Holdings, Inc.*, IPR2024-01280, Paper 13 at 5 (May 19, 2025) (explaining that the second part of *Advanced Bionics* is met where the prior art was not a basis for rejection, is not substantially the same as the applied prior art, and includes specific teachings that impact patentability).

VII. CONCLUSION

The Director should reject Patent Owner’s request for discretionary denial.

Date: November 12, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on November 12, 2025, a true and correct copy of the foregoing **PETITIONERS' OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION** was filed through the P-TACTS system along with service to the email addresses listed below:

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