UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

CHAMPION POWER EQUIPMENT, INC.,
Patent Owner.

IPR2025-01423
Patent 11,530,654

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

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GLOSSARY

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

Pursuant to 37 C.F.R. § 42.107, Patent Owner Champion Power Equipment, Inc. hereby submits its Preliminary Response to the Petition filed by MWE Investments, LLC, Harbor Freight Tools USA, Inc., and Generac Power Systems, Inc. (collectively, "Petitioner"), challenging Claims 1-11 of U.S. Patent No. 11,530,654.

I. INTRODUCTION

Petitioner's proposed grounds are identified below:

Ground	Claims	Basis	Primary Reference	Secondary Reference(s)
1	1, 3-11	103	DuroMax	Parlatore, Elsdon
2	1, 3-7, 9-11	103	Hallberg	Parlatore
3	10, 11	102	Tri-Fuel Video	-
4	10, 11	102	Chaudhari	-
5	2	103	DuroMax	Parlatore, Elsdon, LP-Gas Handbook or Hallberg, Parlatore, LP-Gas Handbook

Discretionary denial pursuant to 35 U.S.C. § 314(a), 35 U.S.C. § 325(d), and the *Fintiv* and *Advanced Bionics* factors[1] is warranted for the reasons set forth in

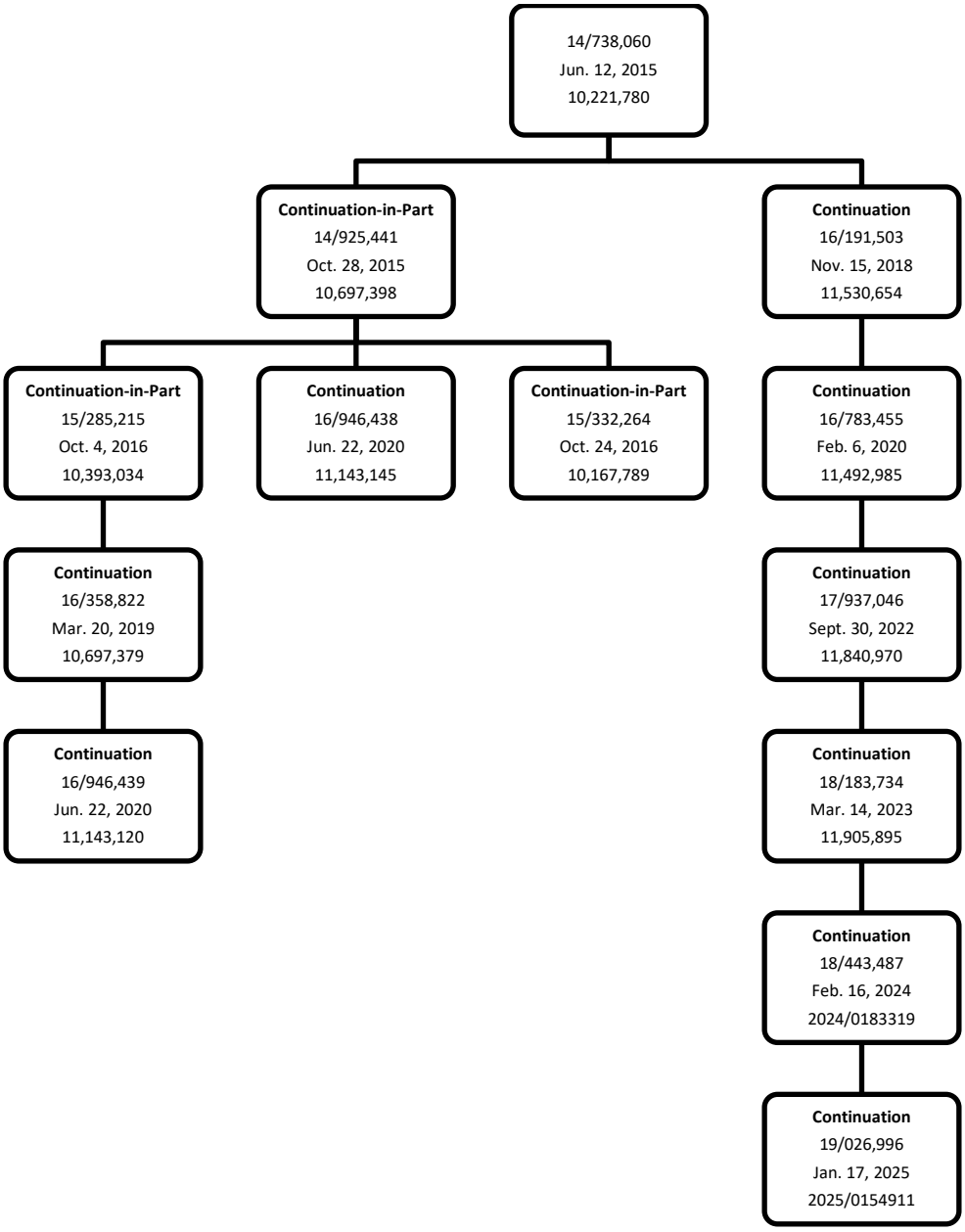
[1] *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (precedential); *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (P.T.A.B. Feb. 13, 2020) (precedential).

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

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

II. OVERVIEW OF THE '654 PATENT

The '654 Patent was filed as U.S. Patent Application No. 16/191,503 on November 15, 2018. EX1001, (21), (22). The '654 Patent is one of thirteen members of a patent family directed to multi-fuel engine technology, which are collectively referred to as the "2015 Family." The 2015 Family is depicted below:



A. The Specification of the ’654 Patent

The ’654 Patent, titled “Off-Board Fuel Regulator for Generator Engine,” is directed to a generator and off-board fuel delivery system. *Id.*, Abstract. The ’654 Patent explains that:

> The dual fuel generator and fuel delivery system also includes a fuel regulator system located off board the dual fuel generator to control the pressure of fuel from the pressurized fuel source and deliver the fuel at a desired pressure for operation of the generator. The fuel regulator system includes a primary pressure regulator coupled to a service valve of the pressurized fuel source and configured to regulate the fuel supplied from the pressurized fuel source to a reduced pressure. The fuel regulator system also includes a secondary pressure regulator coupled 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.

Id., 2:30-43.

B. The Independent Claims of the '654 Patent

Claims 1, 6, and 10 are reproduced below:

1. Claim 1.

1. 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 supplied from a pressurized fuel source through a gaseous fuel line;
   a fuel regulator system located off board the dual fuel generator, the fuel regulator system comprising:
      a primary pressure regulator coupled to a service valve of the pressurized fuel source and configured to regulate the fuel

supplied from the pressurized fuel source to a reduced pressure; and

a secondary pressure regulator coupled 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; and

a fuel lockout apparatus coupled to the mechanical fuel valve; and

wherein when the mechanical fuel valve is in the first position, the fuel lockout apparatus communicates the liquid fuel source to the dual fuel generator and prevents the pressurized fuel source from coupling to the dual fuel generator, and actuation of the mechanical fuel valve to the second position causes the fuel lockout apparatus to permit the pressurized fuel source to couple to the dual fuel generator, and interrupts the liquid fuel source communication with the dual fuel generator.

2. Claim 6.

6. 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 supplied from a pressurized fuel source through a gaseous fuel line;

a fuel regulator system located off board the dual fuel generator, the fuel regulator system comprising:

a primary pressure regulator coupled to a service valve of the pressurized fuel source and configured to regulate the fuel supplied from the pressurized fuel source to a reduced pressure; and

a secondary pressure regulator coupled 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; and

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; and

wherein mechanical fuel valve opens and closes the liquid fuel line to selectively control fuel flow from the liquid fuel source to the dual fuel generator; and further comprises:

a fuel lockout apparatus coupled to the mechanical fuel valve and configured to prevent the pressurize fuel source from coupling to the gaseous fuel line while the mechanical fuel valve opens the liquid fuel line, and permit the pressurized fuel source to couple to the gaseous fuel line while the mechanical fuel valve closes the liquid fuel line.

3. Claim 10.

10. A generator and fuel delivery system comprising:

a generator configured to operate on a gaseous fuel supplied from a pressurized fuel source through a gaseous fuel line;

a fuel regulator system located off-board the generator, the fuel regulator system configured to:

regulate the gaseous fuel supplied from the pressurized fuel source in a first stage, the gaseous fuel regulated down to a reduced pressure in the first stage; and

regulate the reduced pressure gaseous fuel in a second stage, the reduced pressure gaseous fuel from the first stage regulated down to a desired pressure in the second stage for delivery through the gaseous fuel line to operate the generator; and

wherein the generator is free of any pressure regulator.

III. LEVEL OF ORDINARY SKILL IN THE ART

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

Petitioner alleged that a POSITA:

> [W]ould have at least a Bachelor of Science degree in mechanical engineering, physics, or related fields, and three years of work experience in combustion engines. Additional higher graduate

> education could substitute for work experience, and extensive experience/technical training could substitute for formal education.

Petition, 20 (citing EX. 1003, [0028]). Petitioner's proposed definition is deficient. Specifically, Petitioner has failed to support its contention that an undergraduate physics degree is pertinent to the Challenged Claims, or that three years of work experience in combustion engines is necessary. Regardless, the arguments advanced herein are not impacted based on which definition is applied.

IV. CLAIM CONSTRUCTION

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

Petitioner, meanwhile, spends several pages arguing for specific constructions of the terms "fuel lockout apparatus," "prevent … coupling" and "permit … to couple." Pet., 20-29. Petitioner's proposed constructions of these terms are applied for Petitioner's Grounds 1 and 3-5. Patent Owner reserves the right to address the substance of Petitioner's arguments regarding claim construction if this Petition is

instituted. After spending vast swathes of its Petition detailing what Petitioner deems the correct construction of "fuel lockout apparatus," "prevent … coupling," and "permit … to couple," Petitioner spends a single paragraph purportedly identifying alternative "apparent" constructions (Pet., 30) that allegedly control Ground 2.[2]

With the exception of the terms, "fuel lockout apparatus," "prevent … coupling" and "permit … to couple," Petitioner states that "no other terms in the Challenged Claims require construction." Pet., 20. As such, Petitioner alleges that it applies the "ordinary and customary meaning as understood by a POSA." *Id.*

However, despite asserting that the plain and ordinary meaning applies here, Harbor Freight proposed and argued for narrow constructions of two terms in co-pending district court litigation. Specifically, Harbor Freight argued that (1) the term "a mechanical fuel valve" should be construed as "a single mechanical fuel valve" (EX2110, 15-16), and (2) the term "pressure regulator" should be construed as "a

[2] Confusingly, Petitioner appears to apply its "apparent" constructions for portions (but not all) of Ground 5. Pet., 116. Specifically, Ground 5 appears to reference both Ground 1 (allegedly applying Petitioner's proposed constructions) and Ground 2 (allegedly applying the "apparent" constructions). *Id.* The Petition does not explain the discrepancy. Pet., 30 (alleging "Ground 2" shows obviousness "under Patent Owner's apparent constructions").

device that reduces and controls the pressure of gaseous fuel." EX2110, 24-25. Petitioner has repeatedly stated that "Generac and MWE expect to take the same claim construction positions at the time such disclosures are due." IPR2025-01185, Paper 20 at 1; *see also* IPR2025-01099, Paper 20 at 1; IPR2025-01228, Paper 23 at 1.

Generac, meanwhile, argued that the terms (1) "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," and (2) "Desired pressure," were indefinite in co-pending district court litigation. EX2113, 53-54.

V. ARGUMENT

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

First, the Petition improperly relies on the plain and ordinary meaning of terms which Petitioner construed in parallel district court litigation. Second, the Petition is inherently at odds with Petitioner's district court indefiniteness arguments. Third, the Petition improperly relies on unsupported "apparent" constructions allegedly

(and incorrectly) grounded in Patent Owner's litigation positions. Each deficiency independently supports denial and is addressed below.[3]

A. Petitioner's inconsistent claim constructions in co-pending parallel litigation support denial.

Despite arguing for constructions of "a mechanical fuel valve" and "pressure regulator" in the Harbor Freight district court proceeding, Petitioner applies the plain and ordinary meaning of each term here. Notably, Petitioner does not provide *any basis* for its inconsistent positions.

On November 3, 2025, the Director's Order in *Revvo Techs., Inc., v. Cerebrum Sensor Techs., Inc.,* was designated precedential. IPR2025-00632, Paper 20 (P.T.A.B. November 3, 2025) (precedential). There, the Director explicitly stated that "[t]he Board's claim construction rules are designed to ensure that the Board correctly construes claim terms and to minimize inconsistency in claim construction between forums. To that end, the rules *discourage petitioners from seeking broader constructions at the Board to support a patentability challenge while seeking narrower constructions in litigation to avoid infringement liability*." *Id.* at 4 (citing

[3] Patent Owner's Preliminary Response does not reach the merits of Petitioner's proposed constructions. Patent Owner reserves the right to address claim construction on the merits if the instant Petition is instituted.

Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340 at 51,349-51,350 (Oct. 11, 2018)) (emphasis added). Nevertheless, that is precisely Petitioner's approach here.

As explained in *Revvo Technologies*, "[a]llowing petitioners to continue this practice [i.e., proposing different claim constructions in the two forums] does not further the Office's goal of 'providing greater predictability and certainty in the patent system." *Id.* at 4. Here, Petitioner provided no explanation whatsoever for its inconsistent positions, which alone merits denial. *Id.* at 5 ("Ordinarily, that would mean a denial of institution.").

Moreover, Petitioner's gamesmanship here is particularly egregious in light of the constructions in question. In related district court proceedings, Harbor Freight argued the term "pressure regulator" should be construed as "a device that reduces and controls the pressure of gaseous fuel." EX2110, 24-25. Importantly, Champion's proposed construction in district court was the plain and ordinary meaning, which it explained was "a device that controls pressure." *Id*. Harbor Freight, however, repeatedly emphasized it believes *reducing* pressure is a key component of the claimed "pressure regulator." *Id.*; *see also* EX2111, 23-24. According to Harbor Freight, the broader construction proposed by Champion—which did not contain the requirement of "reducing" pressure—was nothing more than Patent Owner's alleged

attempt to "manufacture infringement by disregarding the specification's plain teachings." EX2111, 23-24.

Conversely, the Petition relies on alleged secondary regulators that *do not disclose* "reducing" pressure. For example, the Chaudhari reference's *only disclosure* of its alleged secondary regulator is a single sentence: "The second stage regulator (5) meters exact quantity of gas as per engine load and speed." EX1010, 7. Chaudhari's claim 1 similarly calls for "a second stage metering regulator." *Id.*, 11. However, neither Chaudhari itself—nor Petitioner's discussion of Chaudhari—contain any evidentiary support that said regulator "reduces" pressure. Instead, both the Petition and corresponding expert declaration merely repeat the claim language in conclusory fashion without explanation. *See, e.g.,* Pet., 115 ("Chaudhari discloses the second stage regulator 5 regulates LPG from the first stage regulator 3 down to a desired pressure for supply through the gaseous fuel line"); *see also Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15 (P.T.A.B. August 24, 2022) (precedential) (expert testimony that "merely repeats, *verbatim*, the conclusory assertion for which it is offered to support … is conclusory and unsupported, adds little to the conclusory assertion for which it is offered to support, and is entitled to little weight.").

Similar issues impact Petitioner's treatment of the Parlatore reference. For example, while Parlatore explicitly discloses that its "primary regulator 106 may be

such that it reduces pressure of the propane," it merely states that "secondary regulator 110 can act as a vacuum-controlled flow rate regulator" without any disclosure of "reducing" pressure. EX1007, [0016]. Petitioner relies on the fact that Parlatore discloses that "the secondary regulator 110 can meter propane gas to an engine" and "a low pressure output of the secondary regulator 308 may be attached to a propane carburetor." Pet., 64 (citing EX1007, [0016], [0020]). But, Petitioner has failed to show that the "metering" disclosed by Parlatore inherently reduces pressure, and the mere fact that the output of the alleged secondary regulator is "low pressure" does not mean that the regulator actually *reduces* pressure. Again, Petitioner's corresponding expert declaration "merely repeats, *verbatim*, the conclusory assertion for which it is offered to support … is conclusory and unsupported, adds little to the conclusory assertion for which it is offered to support, and is entitled to little weight." *Xerox Corp.*, Paper 9 at 15. Simply put, the Petition ostensibly relies on the plain and ordinary meaning of the term "pressure regulator" to hand-wave over additional requirements it proposed in district court; namely, that the claimed regulator "reduces" and "controls" the pressure of gaseous fuel. Petitioner's gamesmanship attempts to mask substantial deficiencies in the prior art.

Finally, Petitioner's proposed district court construction is inherently contradictory with its position in related IPR proceedings. For example, in IPR2025-01121 (involving the related U.S. Patent No. 11,143,120), Petitioner argued that

"[t]he art expressly recognizes that vaporizers can simultaneously function as regulators." IPR2025-01121, Paper 19 at 3. Petitioner's district court construction, however, limited the term "regulator" to structures which "reduce[] and control[] the pressure of *gaseous* fuel." EX2110, 24-25 (emphasis added); EX2111, 23-24. This necessarily *excludes* vaporizers, which transform liquid fuel to gaseous fuel. Not only does Petitioner rely on inconsistent constructions between the instant proceeding and co-pending district court litigation—it also makes inconsistent arguments based on the same construction(s) among and between the various IPRs. Petitioner's gamesmanship is clear and warrants denial.

B. Petitioner's inconsistent indefiniteness arguments in co-pending parallel litigation support denial.

Despite arguing that the terms (1) "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," and (2) "Desired pressure," were indefinite in the Generac district court litigation, Petitioner applies the plain and ordinary meaning of each term here. Notably, Petitioner does not provide *any basis* for its inconsistent positions.

The Director's informative Order in *Tesla, Inc. v. Intellectual Ventures II LLC* held that "when a petitioner advances different positions before the Board and a

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

However, Petitioner did not address its inconsistent indefiniteness arguments in the Petition. Pet., 20-30. Specifically, Petitioner failed to explain how the disputed terms are both (1) sufficiently definite so as to inform Petitioner's invalidity challenges raised in the Petition, and (2) "fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention." *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014). The Petition should be denied on this basis alone.

Petitioner's failure to justify its inconsistent positions is particularly egregious here, where Petitioner repeatedly hand-waves over the "desired pressure"

requirement of the Challenged Claims. For example, neither Parlatore nor Chaudhari disclose secondary regulators (or second stage regulators) that reduces pressure to a "desired pressure." *See e.g.,* Pet., 63-64, 115. In each instance, the *only* refence to a "desired pressure" consists of (1) a conclusory recitation of the claim language, coupled with (2) expert testimony which directly mirrors the conclusory statements in the Petition. *Id.*; *see also Xerox Corp.*, Paper 9 at 15. The Petition treats the "desired pressure" limitation as inherently present in the Parlatore and Chaudhari disclosures, or at least assumes it is so obviously apparent that it does not require discussion. This interpretation is necessarily at odds with Generac's indefiniteness challenge, which states the same limitation "fails to inform a person of ordinary skill in the art of the scope of the invention with reasonable certainty." EX2113, 54. Institution should be denied.

C. Petitioner's reliance on "apparent" constructions that it contends are "wrong" supports denial.

The Director's precedential order in *Revvo Technologies, Inc. v. Cerebrum Sensor Technologies, Inc.* held that "when a petitioner takes alternative positions before the Board and a district court, that petitioner should, at a minimum, explain why alternative positions are warranted." *Revvo Techs.*, IPR2025-00632, Paper 20 at 3-4 (citing *Cambridge Mobile Telematics, Inc. v. Sfara, Inc.*, IPR2024-00952, Paper 12 at 8-9 (P.T.A.B. Dec. 13, 2024)).

In *Revvo Techs.*, the petitioner did not propose "its own constructions for claim terms in the Petition, but instead" merely accepted the patent owner's "proposed constructions from the parties' district court litigation." *Id.* 2. Importantly, the Director explained that while the petitioner "proposed different constructions for the claim terms in the district court litigation, [it] did not explain why it was taking a different position" before the Board. *Id.*

Here, Petitioner improperly relies on *Patent Owner's* "apparent" constructions of "fuel lockout apparatus," "prevent … coupling" and "permit … to couple." Pet., 30. An IPR petition must "[p]rovide a statement of the precise relief requested for each claim challenged. The statement must identify the following:

1) The claim;
2) The specific statutory grounds under 35 U.S.C. 102 or 103 on which the challenge to the claim is based and the patents or printed publications relied upon for each ground; [and]
3) How the challenged claim is to be construed. . . ."

37 C.F.R. § 42.104(b). Importantly, the petition must identify "in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim." 35 U.S.C. § 312(a)(3).

The Board's Decision Denying Institution of *Inter Partes* Review in *Vicor Corp. v. Delta Elecs., Inc.* is instructive. IPR2024-00704, Paper 11 (P.T.A.B.

October 2, 2024). There, the patent at issue "describe[d] a DC-DC conversion system that include[d] a buck converter and a resonant converter." *Id.*, 3. Petitioner's Ground 1 did "not purport to correctly construe the 'over-current' limitations" but rather applied what Petitioner deemed "Patent Owner's Apparent Construction" or "Patent Owner's Assumed Construction." *Id.,* 7. The "apparent" constructions were purportedly based on the "specific arrangement" of certain accused products in parallel district court litigation. *Id.*, 7 n.6.

However, "Petitioner [did] not establish that such interpretations [were] appropriate," which the Board found "[f]atal to Petitioner's Ground 1." *Id.*, 8. Fundamental to the Board's finding was that "Petitioner acknowledges that its Ground 1 does not apply a 'proper' claim construction." *Id.* The Board found "Petitioner has not supported the claim interpretations on which its Ground 1 relies, and Petitioner therefore has not shown a reasonable likelihood that it would prevail in its challenge asserted as Ground 1." *Id.*, 9; *see also Microchip Tech. Inc. v. Aptive Technologies AG*, IPR2024-00494, Paper 12 at 10 (P.T.A.B. October 7, 2024) (denying institution where "the proposed construction on which the Petition is based is contingent upon adopting a claim construction that Petitioner opposes in the district court litigation and that Petitioner believes is incorrect"); *Cambridge Mobile Telematics, Inc. v. Sfara, Inc.*, IPR2024-00952, Paper 12 (P.T.A.B. Dec. 13, 2024) (informative); *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632,

Paper 20 at 3-5 (P.T.A.B. November 3, 2025) ("[W]hen a petitioner takes alternative positions before the Board and a district court, that petitioner should, at a minimum, explain why alternative positions are warranted… Simply noting that the petitioner is adopting a patent owner's claim construction proposals from district court, however, is not a sufficient reason for advancing different positions in the two forums.") (precedential).

1. The Petition does not support the Petitioner's "apparent" constructions.

Petitioner's "apparent" constructions of "fuel lockout apparatus," "prevent … coupling" and "permit … to couple" are allegedly based on positions taken by Patent Owner in parallel litigation. Pet., 30. However, Petitioner does not identify—much less with particularity—the "apparent construction" of each term. Rather, Petitioner's *entire analysis* consists of a single sentence:

> Patent Owner appears to adopt a claim construction wherein (1) the "fuel lockout apparatus" can be any apparatus that prevents selection of more than one fuel source; (2) "prevent … coupling" can be any means to prevent fuel flow without necessarily preventing physical attachment of a fuel source to a fuel line; and (3) "permit … to couple" can be any means to permit fuel flow without necessarily permitting physical attachment of a fuel source to a fuel line."

Id. Notably, Petitioner does not include *any analysis* explaining how it arrived at its proposed "apparent constructions" or any evidence asserting that these constructions

are in fact correct. Moreover, Petitioner does not provide any authority that (1) listing proposed "apparent constructions" and (2) citing Patent Owner's district court claim construction brief (which merely advocated for the plain and ordinary meaning of each term), constitutes identifying "in writing and with particularity" "how the challenged claim is to be construed." 35 U.S.C. § 312(a)(3); 37 C.F.R. § 42.104(b).

Based on these disparate statements, Petitioner "include[s] an alternative position for claims 1, 3-7, and 9-11 in Ground 2," which allegedly show invalidity "under Patent Owner's apparent constructions." Pet., 30. Petitioner emphatically concludes that it does "not admit or concede that Patent Owner's apparent constructions are correct." *Id.* In fact, Petitioner explicitly asserts that "Patent Owner's proposed constructions are wrong." *Id*. Yet, Petitioner expressly includes arguments based on claim construction positions it explicitly disputes as yet another "alternative" invalidity challenge.

2. Petitioner's allegation that the Challenged Claims are invalid based on Petitioner's reliance on Patent Owner's "apparent" construction of "fuel lockout apparatus," "prevent … coupling" and "permit … to couple" is improper.

Petitioner relies on Patent Owner's "apparent" constructions in Ground 2. Pet., 30. However, Petitioner explicitly acknowledges that (in its view) "Patent Owner's apparent constructions are wrong." *Id*. Moreover, Petitioner does not define

or support the purported "apparent" constructions that it is relying on as the basis of Ground 2. §V.C.1, *supra*.

Like in *Vicor Corporation*, institution is improper because Petitioner's Ground 2 "does not purport to correctly construe the [disputed] limitations" but rather applied what Petitioner deemed Patent Owner's "apparent" construction. *Vicor Corp.*, Paper 11 at 7. And, like in *Vicor Corporation,* "Petitioner [did] not establish that such interpretations [were] appropriate," which is "fatal." *Id.* at 8; *see also* §V.C.1, *supra*. "Petitioner acknowledges that its Ground [2] does not apply a 'proper' claim construction." *Id.* at 8. As such, like the Board concluded in *Vicor Corporation*, "Petitioner has not supported the claim interpretations on which its Ground [2] relies, and Petitioner therefore has not shown a reasonable likelihood that it would prevail in its challenge." *Id.* at 9.

Petitioner's gamesmanship is clear. Petitioner advanced narrow constructions of "fuel lockout apparatus," "prevent … coupling" and "permit … to couple" in parallel district court litigation to manufacture non-infringement positions. EX2110, 16-20. Further, in related proceedings, Petitioner has indicated its intent to move to stay the district court litigation if institution is granted. IPR2025-00805, Paper 14 at 7-10. In stark contrast, Petitioner now attempts to rely on broad and amorphous "apparent" constructions of those same terms—without actually defining or supporting the constructions—in the hopes of convincing the Board to institute.

Petitioner has advanced broad constructions before the Board, while at the same time maintaining narrower district court constructions (and corresponding non-infringement positions) if its IPR challenge proves unsuccessful.

Allowing the instant Petition to proceed highlights the very policy issues *Revvo Techs.* and *Tesla* were designed to prevent. Petitioner put forth two competing theories and allowed the Board to choose which was more persuasive. If instituted, Patent Owner will be forced to defend against invalidity challenges (Petitioner's Ground 2) that were not clearly articulated in the Petition, and which Petitioner explicitly asserts are "wrong." Pet., 30. There can be no reasonable explanation (other than rampant gamesmanship) for Petitioner's reliance on alternative "apparent" constructions. Thus, like in *Revvo Techs*., Petitioner's reliance on inconsistent claim constructions "[sh]ould mean a denial of institution." *Revvo Techs*., Paper 20 at 5.

VI. CONCLUSION

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

Dated: December 16, 2025

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CERTIFICATE OF SERVICE

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

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that the foregoing Patent Owner's Preliminary Response, excluding the portions exempted under 37 C.F.R. § 42.24(b), contains 4,709 words according to Microsoft Word's word count feature.

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