

IN THE 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.,

Petitioners,

v.

CHAMPION POWER EQUIPMENT, INC.,

Patent Owner.

U.S. Patent No. 11,530,654

Issued: December 20, 2022

Title: OFF - BOARD FUEL REGULATOR FOR GENERATOR ENGINE

Inter Partes Review No. IPR2025-01423

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

TABLE OF CONTENTS

TABLE OF CONTENTS	i
TABLE OF AUTHORITIES	ii
UPDATED EXHIBIT LIST	iv
GLOSSARY.....	vii
I. INTRODUCTION	1
II. THE PETITION COMPLIES WITH <i>REVVO</i> AND <i>TESLA</i>	2
III. RESOLVING THE DISPUTE AT THE PTAB IS MORE EFFICIENT	5
IV. EXAMINER MATERIAL ERROR WEIGHS AGAINST DISCRETIONARY DENIAL	6
V. SETTLED EXPECTATIONS WEIGH AGAINST DISCRETIONARY DENIAL	7
VI. <i>FINTIV</i> FACTORS WEIGH AGAINST DISCRETIONARY DENIAL.....	8
VII. SECTION 325(d) WEIGHS AGAINST DISCRETIONARY DENIAL	15
A. The Prior Art in the Petition is Neither the Same Nor Substantially the Same as the Art Previously Considered by the Office	16
B. The Office Erred During Prosecution.	20
VIII. CONCLUSION.....	20

TABLE OF AUTHORITIES

Cases

<i>Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH,</i> IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020)	16
<i>Advanced Micro Devices, Inc., et al. v. Concurrent Ventures, LLC et al.,</i> IPR2025-00478, Paper 10 (PTAB July 31, 2025)	8
<i>Anthony Inc. v. ControlTec, LLC,</i> IPR2025-00559, Paper 12 (PTAB July 16, 2025)	6
<i>Apple Inc. v. Fintiv, Inc.,</i> IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020)	2, 9
<i>Berkshire Hathaway Energy Co. v. Olson, Edwins.,</i> IPR2025-0274, Paper 23 (PTAB July 2, 2025)	6, 8, 14
<i>Cambridge Indus. USA, Inc. v. Applied Optoelectronic, Inc.,</i> IPR2025-00434, -00436, Paper 11 (PTAB June 26, 2025)	8
<i>Ecto World LLC v. Rai Strategic Holdings Inc.,</i> IPR2024-01280, Paper 13 (PTAB May 19, 2025)	16, 20
<i>FaceTec, Inc. v. iProov, Ltd.,</i> No. 2:21-cv-02252, Dkt. 188 (D. Nev. June 18, 2025)	9
<i>Google LLC v. Withrow Networks Inc.,</i> IPR2025-00775, Paper 10 (PTAB Aug. 14, 2025)	11
<i>iRhythm Techs., Inc., v. Welch Allyn, Inc.,</i> IPR2025-00377, Paper 10 (PTAB June 6, 2025)	9
<i>Microsoft Corp. v. ParTec Cluster Competence Ctr. GmbH,</i> IPR2025-00318, Paper 9 (PTAB June 12, 2025)	6, 16
<i>Microsoft Corp. v. XI Discovery, Inc.,</i> IPR2025-00253, Paper 13 (PTAB June 25, 2025)	6
<i>Parson Xtreme Golf LLC v. Taylor Made Golf Co. Inc.,</i> No. 17-cv-03125, ECF No. 187 (D. Ariz. Nov. 29, 2018)	10

IPR2025-01423	
U.S. Patent No. 11,530,654	
<i>POSCO Co. v. ArcelorMittal</i> ,	
IPR2025-00370, Paper 10 (PTAB June 25, 2025).....	10, 12, 15
<i>Shenzhen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc.</i> ,	
IPR2025-00438, Paper 10 (PTAB July 17, 2025)	6, 13
<i>Sotera Wireless, Inc. v. Masimo Corp.</i> ,	
IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020).....	13
<i>Taiwan Semiconductor Mfg. Co. Ltd. v. Marlin Semiconductor Ltd.</i> ,	
IPR2025-00847, Paper 11 (Sept. 3, 2025)	7
<i>Tesla, Inc. v. Charge Fusion Techs., LLC</i> ,	
IPR2025-00152, Paper 11 (PTAB June 12, 2025)	6
<i>Tesla, Inc. v. Intell. Ventures II</i> ,	
IPR2025-00339, Paper 10 (PTAB June 13, 2025).....	14
<i>Tesla, Inc. v. Sec’y of the Navy ex rel. United States</i> ,	
IPR2025-00341, Paper 12 (PTAB June 13, 2025).....	13
<i>USAA Federal Savings Bank v. PACid Techs., LLC</i> ,	
IPR2025-00697, Paper 9 (PTAB Aug. 14, 2025)	11
<i>Webgroup Czech Republic , A.S. et al., v. Dish Technologies LLC.</i> ,	
IPR2025-00467, Paper 14 (PTAB July 16, 2025)	8
<i>Xencor, Inc. v. Merus N.V.</i> ,	
IPR2025-00604, Paper 12 (PTAB July 17, 2025)	6
<u>Statutes</u>	
35 U.S.C. §325	15

UPDATED EXHIBIT LIST

Exhibit	Description
1001	U.S. Patent No. 11,530,654 (“’654 Patent”)
1002	File History of U.S. Patent No. 11,530,654 (“’654 File History”)
1003	Declaration of Mahdi Shahbakhti (“Decl.”)
1004	DuroMax XP4400EH Operator’s Manual (“DuroMax”)
1005	U.S. Patent No. 5,718,265 to Elsdon (“Elsdon”)
1006	U.S. Patent No. 4,492,207 to Hallberg (“Hallberg”)
1007	U.S. Patent Publication No. 2011/0100335 A1 to Parlatore (“Parlatore”)
1008	Tri-Fuel YouTube Video (https://www.youtube.com/watch?v=DpknaAPTQ9U) (“Tri-Fuel Video”)
1009	LP-Gas Code Handbook, Eighth Edition, Lemoff, Theodore C., (2008) (excerpted) (“LP-Gas Handbook”).
1010	Indian Patent No. 207333 (“Chaudhari”) (certified)
1011	Application Details for Indian Patent No. 207333 (Chaudhari)
1012	<i>American Heritage Dictionary of the English Language</i> (3d ed. 1996) (excerpted)
1013	Declaration of Mr. John Ley re Tri-Fuel Video
1014	Declaration of Mr. Jared Bennett re Tri-Fuel Video
1015	Excerpts of File History for U.S. Patent No. 10,221,780 (“’780 File History”).
1016	Champion’s Claim Construction Brief in 23-cv-2371-PHX-DWL

1017	Declaration of David Raskin (dated May 7, 2025)
1018	“Convert Blackmax 7000 Watt Generator to Propane and Natural Gas,” YouTube Video, posted October 11, 2013 (<i>available at</i> https://www.youtube.com/watch?v=Ip7ckWAZ3xQ)
1019	U.S. Patent No 1,931,698 to Holzapfel (“Holzapfel”)
1020	2-Stage Regulator Assembly (“2-Stage Assembly”) with WayBack Machine certification
1021–1054	Reserved.
1055	Order on Defendant/Counter-Claimant’s Motion for Partial Stay, <i>FaceTec, Inc. v. iProov, Ltd.</i> , No. 21-cv-2252, Dkt. 188 (D. Nev., order dated June 18, 2025)
1056	Docket Navigator Statistics Regarding Judge Adelman’s Grant Rate for Motions to Stay
1057	Docket Navigator Statistics Regarding Grant Rate for Motions to Stay in Eastern District of Wisconsin
1058	Docket Navigator Statistics Regarding Motions to Stay in District of Nevada
1059	Declaration of Eric Huang (dated Sept. 12, 2025)
1060	Order, <i>Parsons Xtreme Golf LLC v. Taylor Made Golf Co.</i> , No. 17-cv-3125, Dkt. 187 (D. Ariz., order dated Nov. 29, 2018)
1061	Email from Taylor R. Stemler to Jennifer Hoekel et al. (Aug. 13, 2025)
1062	Docket Navigator Statistics Regarding Grant Rate for Uncontested Motions to Stay in Eastern District of Wisconsin
1063	Docket Navigator Statistics Regarding Grant Rate for Uncontested Motions to Stay in District of Nevada
1064	Docket Navigator Time to Trial Statistics for District of Nevada
1065	Docket Navigator Time to Milestone Statistics for Judge Adelman
1066	Docket Navigator Time to Milestone Statistics for Eastern District of Wisconsin
1067–1069	Reserved.

1070	Memorandum in Support of Plaintiff’s Motion to Sever Defendant’s Counterclaims for Infringement or in the Alternative for Leave to File an Amended Answer and Counter-Counterclaim, <i>Champion Power Equipment, Inc. v. Generac Power Systems, Inc.</i> , No. 24-cv-1281, Dkt. 38 (E.D. Wis. July 3, 2025)
1071–1082	Reserved.
1083	Amended Scheduling Order, <i>Champion Power Equipment, Inc. v. Generac Power Systems, Inc.</i> , No. 24-cv-01281, Dkt. 59 (E.D. Wis. Sept. 17, 2025)
1084	Reserved.
1085	Excerpts from Generac’s Supplemental Preliminary Invalidity Contentions (Sept. 25, 2025)

GLOSSARY

Abbreviation	Term
“’034 IPR”	Petition for Inter Partes Review of U.S. Patent No. 10,393,034 (IPR2025-00805)
“’034 Ref. Dec.”	Decision Denying Patent Owner’s Request for Discretionary Denial of Institution of Inter Partes Review of U.S. Patent No. 10,393,034 (IPR2025-00805, Paper 20)
“’034 Inst. Dec.”	Decision Granting Institution of Inter Partes Review of U.S. Patent No. 10,393,034 (IPR2025-00805, Paper 24)
“’101 IPR”	Petition for Inter Partes Review of U.S. Patent No. 10,598,101 (IPR2025-00951)
“’101 Ref. Dec.”	Decision Denying Patent Owner’s Request for Discretionary Denial of Institution of Inter Partes Review of U.S. Patent No. 10,598,101 (IPR2025-00951, Paper 18)
“’101 Inst. Dec.”	Decision Granting Institution of Inter Partes Review of U.S. Patent No. 10,598,101 (IPR2025-00951, Paper 22)
“’780 Patent”	U.S. Patent No. 10,221,780
“’654 Patent”	U.S. Patent No. 11,530,654
“Board”	Patent Trial and Appeal Board
“Firman”	Firman Power Equipment Inc.
“Generac”	Generac Power Systems, Inc.
“Harbor Freight”	Harbor Freight Tools USA, Inc.
“MWE”	MWE Investments, LLC
“Patent Owner” and “Champion”	Champion Power Equipment, Inc.
“Petition”	Petition for Inter Partes Review of U.S. Patent No. 11,530,654 (Paper 4)
“Petitioners”	MWE, Harbor Freight, and Generac
“POSA”	Person of Ordinary Skill in the Art

IPR2025-01423

U.S. Patent No. 11,530,654

“Request for Discretionary Denial” and “RDD”	Patent Owner’s Request for Discretionary Denial of Institution of Inter Partes Review of U.S. Patent No. 11,530,654 (Paper 9)
--	---

I. INTRODUCTION

On December 15, 2025, Harbor Freight informed Generac and MWE that Harbor Freight had settled its disputes with Champion, including this IPR, the related IPRs, and the litigation involving the '654 Patent that is pending in the Central District of California. The remaining Petitioners, Generac and MWE, understand that Harbor Freight will withdraw from this IPR and the related IPRs imminently, and that the litigation between Harbor Freight and Champion will be dismissed in due course.

Petitioners oppose Patent Owner's Request for Discretionary Denial. Contrary to Patent Owners' assertions in related IPRs, Petitioners alternative claim construction and indefiniteness positions in the Related Litigations comply with the *Revvo* and *Tesla* decisions. *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 (PTAB Nov. 3, 2025) (precedential) [hereinafter *Revvo*]; *Tesla, Inc. v. Intell. Ventures II LLC*, IPR2025-00340, Paper 18 (PTAB Nov. 5, 2025) (informative) [hereinafter *Tesla*].

Moreover, the Director explained that "the district court litigations involved thirteen patents asserted in multiple district courts," and "[b]ecause 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"; and "In addition, no trial date has been set in any of the parallel

proceedings, and the parties have made relatively little investment into the multi-district litigation.” ’034 Ref. Dec. at 2; ’101 Ref. Dec. at 2 (incorporating analysis from ’034 Ref. Dec.). Each of these characteristics remain present here and alone are sufficient for referral of this Petition for institution.

Additionally, the ’654 Patent was improperly granted due to a critical Examiner oversight, which included failing to consider at least the Honda EU20i Video (EX2076). Instituting this IPR would allow the Board to address this material error in addition to the strong merits of the Petition. Finally, Champion has not developed settled expectations that its patent would not be challenged, and none of the *Fintiv* factors¹ favor discretionary denial. 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 of this Petition is not appropriate.

II. THE PETITION COMPLIES WITH *REVVO* AND *TESLA*

Patent Owner has not yet raised issue with the Petitioners’ proposed claim construction. Nevertheless, Petitioners address the impact of the *Revvo* and *Tesla* decisions on this proceeding in view of recent PTAB activity.

The Petition complies with 37 C.F.R. § 42.104 because it identifies “[h]ow the challenged claim[s are] to be construed.” *See* Pet., §V. This case is distinguishable

¹ *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 5–6 (PTAB Mar. 20, 2020).

from *Revvo*, because here the Petitioners “propose[d their] own constructions for claim terms in the Petition” and “explain[ed] why [they were] taking a different position” in the litigation. *Revvo* at 2. Petitioners proposed constructions for “Fuel Lockout Apparatus,” “Prevent...Coupling,” and “Permit...to Couple” comply with 37 C.F.R. § 42.104. Further, Petitioners explained why Patent Owner’s constructions of these terms in litigation are wrong (Pet., §V.C), yet also present alternative grounds of invalidity specific to Patent Owner’s litigation constructions. Pet., §§VII.B, VII.E. Alternative invalidity grounds dependent on later claim construction findings are routine in litigation and are likewise permissible before the Board. *smaXtec Inc. v. ST Reproductive Techs. LLC*, IPR2024-00875, Paper 18 at 21 & n.7 (PTAB Nov. 22, 2024) (stating “[i]t is common for Petitioners to present alternative claim constructions” and holding that arguing invalidity under both constructions satisfies 37 C.F.R. § 42.104). “The Board is required to construe ‘only those terms ... necessary to resolve the controversy.’” *Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019). The Petition’s invalidity grounds that cite combinations of DuroMax, Elsdon, Parlatore, and the Tri-fuel Video are sufficient to show invalidity under Petitioners’ constructions or Champion’s constructions.

Moreover, Patent Owner’s arguments in Patent Owner’s Preliminary Response that was filed today, December 16, 2025, in support of denial of institution based on *Revvo* cite only positions taken by Harbor Freight. IPR2025-01423, Paper

11 at 9–12. Patent Owner should be fully aware that it already settled its disputes with Harbor Freight prior to filing the Patent Owner’s Preliminary Response. Patent Owner also should be fully aware that such arguments are mooted by Patent Owner’s settlement with Harbor Freight and Harbor Freight’s imminent withdrawal from this IPR and the related IPRs. Patent Owner’s attempt to rely on arguments that it knows are not valid can be viewed only as gamesmanship, and should not be rewarded.

Under *Tesla*, alternative indefiniteness positions are permitted when “notwithstanding the alleged indefiniteness of the claim term, an ordinarily skilled artisan would understand that the asserted art satisfies the claim limitation.” *Tesla* at 3–4. This is consistent with Federal Circuit precedent. *See, e.g., Intel Corp. v. Qualcomm Inc.*, 21 F.4th 801, 813 (Fed. Cir. 2021) (“The indefiniteness of a limitation ... precludes a patentability determination **only** when indefiniteness renders it **logically impossible** for the Board to reach such a decision.” (emphasis added)). Generac served contentions asserting that the “claims, specification, and prosecution history of the patent fail to inform a person of ordinary skill in the art with reasonable certainty about the **full scope** of the definitions of either ‘actuatable’ or ‘selectively control fuel flow.’” EX1085, 25 (emphasis added). The DuroMax/Elsdon and Tri-Fuel combinations cited in the Petition are structurally identical to the only embodiment disclosed by the ’654 Patent. In compliance with the written description requirement, the only disclosed embodiment is covered by

the proposed claim language. *See Johns Hopkins Univ. v. CellPro, Inc.*, 152 F.3d 1342, 1355 (Fed. Cir. 1998) (“A patent claim should be construed to encompass at least one disclosed embodiment in the written description portion of the patent specification.”). Therefore, any ambiguity in the boundary of the claim language is not relevant to assessing the validity of the claims over the structurally identical DuroMax/Elsdon and Tri-Fuel Video combinations, as these combination fall squarely within the scope of the claims.

III. RESOLVING THE DISPUTE AT THE PTAB IS MORE EFFICIENT

Patent Owner asserted thirteen different patents against Petitioners in separate district court proceedings, and asked another court in Arizona to adjudicate the same patents as to non-petitioner Firman. RDD, 7–9. Petitioners collectively challenged all thirteen patents with IPR petitions to streamline the invalidity challenges and ensure consistency on the invalidity determinations. “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 to proceed represents the epitome of efficient and appropriate use of Board resources. The alternative is having multiple different jury trials proceed to assess invalidity of the asserted patents in four different district courts, creating a very high likelihood of inconsistent outcomes. The Board is better positioned to grasp and efficiently handle a single set of

challenges to many patents from two different patent families involving complicated aspects of multi-fuel engine/generator designs. The efficiencies gained by a single set of proceedings before the PTAB is reason enough to refuse discretionary denial. *Berkshire Hathaway Energy Co. v. Olson, Edwins.*, IPR2025-0274, Paper 23, at 2–3 (PTAB July 2, 2025); *Shenzhen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc.*, IPR2025-00438, Paper 10, at 3 (PTAB July 17, 2025) (referring to the Board where the district court proceeding involved a “large number and vast scope” of patents).

IV. EXAMINER MATERIAL ERROR WEIGHS AGAINST DISCRETIONARY DENIAL

Material error during prosecution often overcomes facts that would otherwise have resulted in a *Fintiv* denial. See *Xencor, Inc. v. Merus N.V.*, IPR2025-00604, Paper 12, at 2–3 (PTAB July 17, 2025); *Microsoft Corp. v. ParTec Cluster Competence Ctr. GmbH*, IPR2025-00318, Paper 9, at 3 (PTAB June 12, 2025); see also *Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025-00152, Paper 11, at 2–3 (PTAB June 12, 2025); *Anthony Inc. v. ControlTec, LLC*, IPR2025-00559, Paper 12, at 2 (PTAB July 16, 2025); *Microsoft Corp. v. XI Discovery, Inc.*, IPR2025-00253, Paper 13, at 2 (PTAB June 25, 2025).

The lengthy prosecution of the ’654 Patent focused on the limitation of a fuel regulator system located off board the dual fuel generator, which Patent Owner (incorrectly) insisted was not obvious in light of the prior art and the knowledge of those skilled in the art. EX1002 at 218. Patent Owner eventually rewrote its

dependent claims requiring the additional limitation of a fuel lockout apparatus coupled to the mechanical fuel valve in incorporate the otherwise obvious limitations of its independent claim. *Id.* at 124–128. The examiner allowed all of the pending claims without comment or justification. *Id.* at 7–19. Indeed, the critical “fuel lockout apparatus” limitation is never once discussed by the examiner, the Board, or the applicant anywhere in the prosecution history.

Patent Owner argues that Parlature is substantially the same as the EU20i Video, 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.” RDD, 16–17. Thus, the EU20i 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. *Taiwan Semiconductor Mfg. Co. Ltd. v. Marlin Semiconductor Ltd.*, IPR2025-00847, Paper 11, 3–4 (Sept. 3, 2025).

V. SETTLED EXPECTATIONS WEIGH AGAINST DISCRETIONARY DENIAL

The ’654 Patent issued in 2022 and has been in force for less than three years. Challenges to patents in force many times that duration are consistently characterized as “early” and “favor[ing] robust predictable patent rights and weigh[ing] against discretionary denial.” *See, e.g., Tanklogix v. Sitepro*, IPR2025-00650, Paper 10, at 2 (PTAB Jul. 31, 2025); *Cambridge Indus. USA, Inc. v. Applied*

IPR2025-01423

U.S. Patent No. 11,530,654

Optoelectronic, Inc., IPR2025-00434, -00436, Paper 11, at 2–3 (PTAB June 26, 2025); *Berkshire Hathaway*, IPR2025-00274, Paper 23, at 3; *Webgroup Czech Republic , A.S. et al., v. Dish Technologies LLC.*, IPR2025-00467, Paper 14, at 2 (PTAB July 16, 2025). The efficiency gains in the present case are particularly pronounced, given the substantial overlap between the specifications of these related patents, along with the overlap in limitations of the related patent’s claims. *See Padagis*, IPR2025-00464, Paper 12, at 3–4 (referring a petition on a patent in force for over 10 years because “it is an efficient use of Board resources to address the related patent”); *Advanced Micro Devices, Inc., et al. v. Concurrent Ventures, LLC et al.*, IPR2025-00478, Paper 10, at 3 (PTAB July 31, 2025).

Moreover, Patent Owner’s prior communications with Petitioners gave rise to an expectation of IPR filings. In response to the “cease-and-desist” letters to MWE and Generac in 2020 (EX2033; EX2036), 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). The only “reasonable expectation” is that Patent Owner’s patents **would be challenged in IPR proceedings** in the event that Patent Owner sought to enforce them. Which is exactly what has transpired.

VI. FINTIV FACTORS WEIGH AGAINST DISCRETIONARY DENIAL

This is the quintessential case for institution. None of the *Fintiv* factors favor

discretionary denial, and a majority of the *Fintiv* factors weigh strongly against discretionary denial. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 5–6 (PTAB Mar. 20, 2020). The weight of the *Fintiv* factors and related considerations against discretionary denial are further detailed below:

Factor 1 weighs against discretionary denial because the District Courts have a record of granting stay motions on similar facts. 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 (PTAB June 6, 2025). The data shows that stays will likely be granted.

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. 2:21-cv-02252, Dkt. 188 (D. Nev. June 18, 2025) (attached as EX1055). 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).

Furthermore, Generac had a meet-and-confer with Patent Owner regarding

their intention to seek stays of its litigation.² Patent Owner instead indicated an openness to stays should the IPRs not be discretionarily denied (EX1059, ¶4; EX1061, 1), creating a high likelihood the district court litigations will be stayed. *See, e.g.*, EX1062 (showing that all uncontested stays have been granted in EDWI); EX1063 (showing that all uncontested stays have been granted in Nevada).

Firman is not a petitioner, privy, or real-party-in-interest, which alone weighs against discretionary denial. *POSCO Co. v. ArcelorMittal*, IPR2025-00370, Paper 10, at 2–3 (PTAB June 25, 2025). To the extent Firman’s case is considered, it weighs against discretionary denial because the presiding judge has granted a motion to stay on similar facts. *See Parson Xtreme Golf LLC v. Taylor Made Golf Co. Inc.*, No. 17-cv-03125, ECF No. 187 (D. Ariz. Nov. 29, 2018) (attached as EX1060).

Factor 2 weighs against discretionary denial because a FWD will likely issue before the district court proceedings reach trial. None of the 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 behind schedule, suggesting that its trial date will fall well after the FWD.

No trial dates have been scheduled in any of the parallel litigations involving

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.

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 Federal Savings Bank v. PACid Techs., LLC*, IPR2025-00697, Paper 9, at 2 (PTAB Aug. 14, 2025); *Google LLC v. Withrow Networks Inc.*, IPR2025-00775, Paper 10, at 2 (PTAB Aug. 14, 2025). Regarding MWE, 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 Generac, 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, five months after the FWD. The Generac court also recently extended its case schedule, further delaying this parallel proceeding. EX1083.

Patent Owner alleges that the Firman trial will occur before the FWD date. RDD, 8. While time-to-trial statistics in a vacuum may suggest a trial date around the same time as the FWD, the Firman case is already significantly behind schedule. Specifically, statistics indicate a median time to claim construction of 15.7 months (EX2047, 1–2), suggesting that a *Markman* ruling should have occurred in February 2025. Yet as of December 2025, a *Markman* hearing has yet to occur or even be

scheduled. Thus, the Firman case is already at least *nine months* behind schedule compared to Patent Owner's relied-upon statistics. As a result, any trial in the Firman case will likely occur well after the FWD. Moreover, discretionary denial is unsupported 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.

Factor 3 weighs against discretionary denial because the district court cases involving the Petitioners are all at very early stages.³ Patent Owner admits that the MWE case is still in its infancy (RDD, 12), and 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.

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.

Factor 4 weighs heavily against discretionary denial because Petitioners have

³ Because Harbor Freight has reached a settlement with Champion, its district court litigation is no longer relevant to the present institution decision.

committed to broad *Sotera*-plus stipulations⁴ 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. EX2083; EX2085.

These stipulations extend far beyond the more typical *Sotera*-type stipulation 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 and the IPRs a true alternative to district courts for determining invalidity. These broad stipulations weigh heavily against discretionary denial. *See Shenzhen*, IPR2025-00438, Paper 10, at 3 (rejecting discretionary denial request where petitioner has “filed a broad stipulation”); *Tesla, Inc. v. Sec’y of the Navy ex rel. United States*, IPR2025-00341, Paper 12, at 2 (PTAB June 13, 2025); *Tesla, Inc.*

⁴ *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, at 18–19 (PTAB Dec. 1, 2020) (precedential as to §II.A) (“*Sotera*”).

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 multiple district courts will each have to separately adjudicate all the invalidity issues raised by the individual defendants in each case. Alternatively, if instituted, all invalidity grounds based on printed publications raised or that could have been raised in the IPRs, as well as system art corresponding to the printed publications raised as part of a challenge, will be consolidated into a single set of proceedings before the PTAB. This factor clearly weighs strongly against discretionary denial. *Berkshire Hathaway*, IPR2025-00274, Paper 23, at 2–3.

Factor 5 weighs against discretionary denial because the Petitioners are not parties to the *Firman* Case. Patent Owner’s discretionary denial brief mentions *Firman* over 40 times. Yet *Firman* is conspicuously absent from Patent Owner’s discussion of this factor. RDD, 14–15. 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 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 attempt to rely on the *Firman* case in its arguments,

this fact weighs *Fintiv* Factor 5 against discretionary denial. *Cf. POSCO*, IPR2025-00370, Paper 10, at 2.

Factor 6 weighs strongly against discretionary denial. Patent Owner's arguments for Factor 6 (RDD, 15–16) overlook or sidestep the most important considerations. The strength of the ground in the Petition weigh heavily 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 and include well-grounded theories of invalidity. Moreover, the '654 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. *See Factor 2, supra*. This weighs against discretionary denial.

VII. 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). Under §325(d), Office policy requires a determination of “(1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics*,

LLC v. MED-EL Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential).

The limitations in the claims of the '654 Patent overlap extensively with the limitations in the claims of the parent '780 Patent. None of the prior art cited in the Petition was cited during the prosecution of either patent. *Microsoft v. ParTec*, IPR2025-00318, Paper 9 at 2–3 (finding discretionary denial under § 325(d) is inappropriate where there was “persuasive evidence that the Office erred in a manner material to the patentability of the challenged claims by overlooking the teachings of” prior art that were not presented to the patent examiner.); *see also Ecto World LLC v. Rai Strategic Holdings Inc.*, IPR2024-01280, Paper 13 at 5 (PTAB May 19, 2025) (precedential) (citing *Advanced Bionics* at 10).

A. The Prior Art in the Petition is Neither the Same Nor Substantially the Same as the Art Previously Considered by the Office

Patent Owner cannot justify its argument that DuroMax, Hallberg, the Tri-Fuel Video, Chaudhari, LP-Gas Handbook, Parlatore, and Eldson are cumulative to art already considered during prosecution (RDD, 16–19) at least because none of these references was relied on or considered by the Examiner in the prosecution of the '654 Patent or its parent applications⁵. The fact that there are so many closely

⁵ Hallberg was cited in an IDS but was never discussed by either the examiner or the applicant during the prosecution. *See* EX1002-Part 1, Page 271.

related prior art references describing dual fuel generators and fuel delivery systems demonstrates how ubiquitous Champion's purported "invention" was prior to the 2015 priority date of the '654 Patent.

Patent Owner alleges that DuroMax is "substantially the same as (1) the YouTube Video of the Honda EU20i generator ("EU20i Video") (EX2075; EX2076), and (2) U.S. Publication No. 2002/0134362 ("Deutsch") (EX2060, [0010]). RDD 19. Neither reference was relied upon or even cited by the examiner in the '654 Patent. Moreover, neither reference was considered in combination with Palatore and Elsdon, as DuroMax is here.

Patent Owner attempts to dismiss Hallberg because it, like Sugimoto, describes dual fuel engines that uses a valve control and a switch that operate a cable to select one of a gasoline or propane fuel source. RDD at 18. Hallberg predates Sugimoto by more than twenty years. Moreover, during prosecution of the parent '780 Patent, Patent Owner repeatedly (though incorrectly) argued that Sugimoto did not disclose a "fuel lockout apparatus coupled to the mechanical fuel valve." EX1015, 92–93. Hallberg expressly discloses that the fuel lockout apparatus is coupled to the mechanical fuel valve, where control cable 302 couples the fuel lockout apparatus comprising fluid dual value control 301 and control cable 302 to the mechanical fuel valve. EX1006, FIG 1.

Patent Owner argues that Elsdon is "substantially similar" to the unexamined

and uncited Conroy reference because it “discloses a removable fuel cap on threaded opening 26 on fuel tank 22.” RDD at 19. Patent Owner includes a citation to “[o]ther previously-considered references” without discussion. *Id.* Patent Owner ignores Elsdon’s disclosure of a fuel conduit coupler shield 14 and cap 16 that when closed prevents coupling of a fuel source. EX1005, 3:3–14. This feature is not present in Conroy, and therefore Elsdon is not cumulative.

Patent Owner’s attack on Parlature is that the uncited the EU20i Video prior art reference also discloses “an external propane tank that supplies LPG fuel to an engine and two pressure regulators in line with the LPG supply hose.” RDD at 16–17. Petitioners rely on Parlature as a reference for elements that the Examiner found “are extremely old and well-known in the art.” *See, e.g.,* EX1002-Part 2, Page 31. Likewise, while the LP-Gas Handbook discloses well-known features in the art, nothing in the prosecution of the ’654 Patent claims discloses the quick connectors. Moreover, Parlature and the LP-Gas Handbook become centrally relevant in the Petition after they are combined with DuroMax, Elsdon, and/or Hallberg.

Patent Owner alleges that the Tri-Fuel Video is cumulative of the Yamaha EF2000iS Tri Fuel Conversion (“EF2000iS Video”) because both “show an operator modifying a generator for use with a pressurized gaseous fuel for either natural gas or LPG.” RDD at 17 (citing EX1008; EX2103; EX2104). Patent Owner’s EX2103 and EX2104 are screenshots and video submitted in an IDS but not examined or

cited during the prosecution of the '654 Patent. *See* EX1002-Part 1, Page 75. The examiner cited a related EF2000iS Video by the same user along with other videos of similar vintage to show the state of the art. *Id.* at 260; *see also id.* at 202 (“the Examiner did not actually rely on any of the cited videos in the pending rejections as the Appellant asserts.”). None of these videos were examined or evaluated for their disclosure of the specific claim elements. Moreover, Patent Owner argued during prosecution that these videos did not “disclose a generator comprising either two regulators or a single dual-stage regulator located off board a generator.” *Id.* at 218. Yet, the Petition cites the Tri-Fuel Video precisely because it discloses the first and second regulators being located off-board and remote from the generator. *See* Pet., 43–45, 107–111. Given this critical distinction relevant to the patentability of the claims, the Tri-Fuel Video is clearly not “cumulative” to the EF2000iS Video.

Patent Owner argues that Chaudhari is cumulative to the unexamined and uncited Kojima reference. RDD 17–18. 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 uses in Chaudhari. EX1010, 4; *see also id.* 6–8 (referencing generators repeatedly). This is a critical distinction given that the claims of the '654 Patent are directed to generators. Chaudhari is thus clearly not cumulative to Kojima.

Since the Examiner did not have DuroMax, Hallberg, the Tri-Fuel Video, Chaudhari, LP-Gas Handbook, Parlatore, or Eldson, or the support of an expert

declaration explaining a POSA's understanding of these references, the Examiner did not have the opportunity to consider the arguments raised under the grounds presented in the Petition.

B. The Office Erred During Prosecution.

The Office materially erred in overlooking the EU20i Video's clear disclosure of a fuel regulator system being located offboard the generator. *Supra* §III. Discretionary denial is therefore unwarranted under §325(d). *See Ecto World*, IPR2024-01280, Paper 13 at 5 (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).

VIII. CONCLUSION

For the foregoing reasons, the Director should reject Patent Owner's request for discretionary denial, and Petitioners respectfully request that the Petition be submitted for review on the merits.

IPR2025-01423
U.S. Patent No. 11,530,654

Date: December 16, 2025

Respectfully submitted,

By: /Thomas A. Walsh/

Thomas A. Walsh
Registration No. 45,196
ICE MILLER LLP
One American Square, Suite 2900
Indianapolis, IN 46282
Counsel for Petitioner MWE
Lead Counsel for Co-Petitioners

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on December 16, 2025, a true and correct copy of the foregoing **PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION** was filed through the P-TACTS system along with service to the email addresses listed below:

Joseph W. Staley
Email: j.staley@pkhip.com
Scott P. Amy
Email: s.amy@pkhip.com
Thomas F. Finch
Email: t.finch@pkhip.com
Timothy J. Ziolkowski
Email: tjz@zpatents.com
Jacob M. Fritz
Email: jmf@zpatents.com
Email: rlt@zpatents.com
Email: championlit@pkhip.com

Date: December 16, 2025

By: /Thomas A. Walsh/

Thomas A. Walsh
Registration No. 45,196
ICE MILLER LLP
One American Square, Suite 2900
Indianapolis, IN 46282-0200

*Counsel for Petitioner MWE
Lead Counsel for Co-Petitioners*