

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

CHAMPION POWER EQUIPMENT, INC.,
Patent Owner.

IPR2025-01438
Patent 11,761,390

PATENT OWNER CHAMPION POWER EQUIPMENT, INC.'S
BRIEF IN SUPPORT OF REQUEST FOR DISCRETIONARY
DENIAL OF INSTITUTION

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EX2005	Firman Case, Firman’s Motion to Amend Invalidity Contentions, ECF No. 115
EX2006	Firman Case, Declaration and Exhibit, ECF No. 116
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EX2009	Firman’s Nov. 2024 Subpoena to third-party Generac (Firman Case)
EX2010	<i>Reserved</i>
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EX2058	August 4, 2025 Stipulation from Generac
EX2059	August 4, 2025 Stipulation from Harbor Freight
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Petitioners Generac Power Systems, Inc. (“Generac”), Harbor Freight Tools USA, Inc. (“HFT”), and MWE Investments, LLC (“MWE”) (collectively, “Petitioners”), request *inter partes* review (“IPR”) of all claims of U.S. Patent No. 11,761,390. Paper 1 (“Pet.”). For the reasons discussed in detail herein, Patent Owner Champion Power Equipment, Inc. (“Patent Owner”) respectfully requests the Director exercise discretion and deny institution of this IPR.

This Petition is part of a coordinated, multi-front campaign to invalidate Patent Owner’s multi fuel generator patents led by its long-time competitors. Patent Owner first filed suit against Firman Power Equipment Inc. (“Firman”) on November 10, 2023—more than two years ago. EX2001. Firman elected not to petition for IPR and is now time-barred. Almost a year later—on October 9, 2024—Petitioner HFT filed a complaint for *declaratory judgment of non-infringement*, which prompted Patent Owner’s compulsory infringement counterclaims. EX2017; EX2018. While HFT could have challenged the validity of Patent Owner’s patents in its complaint, it elected to commence separate actions against Patent Owner in both the district court and before the Board.

There can be no legitimate dispute that Petitioners are closely aligned with Firman as they have adopted Firman’s invalidity strategy—both at the district court level (including Firman’s assertions of system art and § 112 argument) and in this and twelve other IPRs. Notably, the district court case against HFT (as well as non-

petitioner Firman) contain dozens of invalidity grounds that cannot be adjudicated in this proceeding and are on track to go to trial or make significant progress before a Final Written Decision (“FWD”) in this IPR. *See, e.g.*, EX2006, 40-42. Because granting institution would duplicate substantial efforts already underway in multiple district courts, discretionary denial is appropriate.

Discretionary denial is also appropriate because Champion held long-settled expectations based on years of inaction from Generac (ten years) and MWE (five years). Granting institution undercuts Patent Owner’s reliance on years of inaction, rewards Petitioners’ calculated delay, and benefits Champion’s other competitors, including HFT (who voluntarily initiated district court litigation) and non-Petitioner Firman (who is statutorily time-barred). Champion reasonably relied on Petitioners’ inaction and should not be forced to defend its patent in multiple forums.

Finally, in related proceedings Petitioners represent they are pursuing IPR “in lieu of three separate jury trials on invalidity.” IPR2025-00805, Paper 14 at p. 1; *see also id.* at 26 (“the alternative is having four different jury trials proceed to assess invalidity of the asserted patents in four different district courts”). This argument is demonstrably false. Rather, Petitioners seek to challenge the ’390 Patent on the basis of printed publications before the Board and maintain robust system art-based challenges before multiple district courts. Institution will only serve to allow another bite at the invalidity apple for each relevant party, including non-Petitioner Firman

and declaratory judgment challenger HFT.

Discretionary denial is warranted under 35 U.S.C. § 314(a), 35 U.S.C. § 325(d), and the *Fintiv* and *Advanced Bionics* factors. *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).

I. FACTUAL BACKGROUND

A. Champion's Two Patent Families

Champion owns two patent families directed to multi-fuel generators. The first claims priority to a November 1, 2013 application that resulted in 5 patents, including U.S. Patent Nos.: 10,598,101; 11,306,667; 11,905,896; and the '390 Patent that is the subject of this proceeding ("2013 Family"). EX1001, (60). Champion has asserted infringement of each enumerated patent, and Petitioners have filed corresponding IPRs. EX2058; EX2059; EX2069; EX2084; EX2085.

The second claims priority to a June 12, 2015 application that resulted in 11 patents, including 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 ("2015 Family"). EX2086. Champion has asserted infringement of each enumerated patent, and Petitioners have filed corresponding IPRs. EX2058; EX2059; EX2069; EX2083; EX2084; EX2085.

B. Petitioners Asserted the Champion Patent Families were Invalid Years Ago and Did Nothing

Champion has long settled expectations that the '390 Patent would not be challenged in an IPR. “Although there is no bright-line rule on when expectations become settled, in general, the longer the patent has been in force, the more settled expectations should be.” *Dabico Airport Sols. Inc. v. AXA Power APS*, IPR2025-00408, Paper 21 at 3 (P.T.A.B. June 18, 2025). Here, the senior member of the 2013 Family was granted in 2016 and has been in force for approximately nine years. EX1013. Indeed, the '390 Patent claims a priority date of November 1, 2013 and is twelve years into its enforceable term. EX1001, (63); *Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00601, Paper 9 at 3 (P.T.A.B. July 24, 2025) (“the challenged patents have been in force for seven and six years, respectively, creating strong settled expectations...”).

Petitioners have not been diligent in challenging the '390 Patent, and Patent Owner's expectations have been settled for years. Champion began enforcing the 2013 Family just weeks after the grandparent '101 Patent issued in 2020. Champion sent cease-and-desist letters to Generac and MWE in 2020, accusing each of infringing Champion's multi-fuel generator patents. EX2033; EX2036.

On July 31, 2020, MWE alleged it was “aware of and/or in possession of prior art that will support invalidation” and was “prepared to present this evidence in

litigation or in an Inter Partes Review proceeding if it becomes necessary.” EX2034. MWE provided a detailed list of prior art and claim charts it asserted would “be fatal to” Champion’s rights in multi-fuel generators. EX2035. Champion promptly submitted IDSs in 2020 in all pending cases (including in the ’667 Patent to which the ’390 Patent claims priority) identifying all prior art cited by Petitioners. *See, e.g.*, EX2109, 314-317; *see also* MPEP § 609.02(II)(A)(2) (“The examiner will consider information which has been considered by the Office in a parent application.”). Importantly, the art identified by MWE *is not* the basis of the current Petition. Meanwhile, MWE did nothing for five years.

Generac likewise asserted that “the claims of the ’101 patent are invalid.” EX2037. Despite asserting that the Patent Office had erred, Generac did not identify any prior art, explain its invalidity challenges, or provide any evidentiary support for its conclusory assertions. EX2037. In fact, Generac asserted that it had “no plans to continue selling the accused products after the existing inventory [was] depleted.” *Id.* Like MWE, Generac did not file suit or initiate an IPR against any patent in the 2013 or 2015 Families for five years.

Petitioners are sophisticated long-time competitors of Champion in the same technology space and actively monitored Champion’s generator patents as members of the same generator manufacturers’ groups. Notably, Petitioners should have been aware of Champion’s commercial products and related patent filings over a decade

ago. Generac admits that “Champion and Generac are both members of the Portable Generator Manufacturers’ Association (‘PGMA’), an organization that seeks to develop safety standards for portable generators.” EX2011, 70. Generac concedes it “would have come across” Champion’s patents “during PGMA’s regular monitoring” process. *Id.*; *see, e.g.*, EX2054. Thus, Generac has been aware that Champion obtains patents since as early as 2015. EX2070; EX2071.

Further, in 2015, Generac, and subsequently Firman, each hired Champion’s former VP (Mr. Greg Montgomery). Mr. Montgomery was employed by Champion for nearly a decade, was aware of Champion’s research and development efforts, and knew that Champion was actively seeking patent protection. Mr. Montgomery knew Champion filed the grandparent to the ’390 Patent in 2013 and knew Champion was actively working on another application when he left Champion in December 2014. EX2064. He joined Generac in early 2015 as a high-level executive (VP and General Manager) and immediately led a team in developing multi-fuel generators based on Champion’s designs. EX2065 at 14; EX2073 at 3; EX2074 at 12-13. Firman subsequently hired Mr. Montgomery as its CEO in mid-2015. Thus, both Generac and Firman had *actual knowledge* of Champion’s patent applications in early 2015.

Rather than challenge validity as previously threatened, MWE and Generac waited years until Champion initiated litigation. However, the timing of the Patent

Owner's infringement challenge does not excuse Petitioners' delay. *See Kahoot! AS v. Interstellar Inc.*, IPR2025-00696, Paper 12 at 2 (P.T.A.B. July 31, 2025) ("Petitioner's argument that Patent Owner does not have settled expectations because Patent Owner did not previously assert the challenged patent against Petitioner does not defeat Patent Owner's settled expectations."). HFT also chose not to file an IPR in response to Champion's cease-and-desist letter. EX2038; EX2039. Instead, it filed a declaratory judgment action alleging non-infringement (but not invalidity) in district court, further underscoring the strategic delay and reluctance of Petitioners to use the IPR process. EX2017.

Petitioners' delay suggests a tactical decision to hedge litigation risk rather than a genuine interest in timely resolving patentability concerns. This prolonged inaction gave Champion settled expectations that the '390 Patent would not be challenged in an IPR, especially since Generac's knowledge of this Patent Family dates back 10 years. These settled expectations are dispositive and, on their own, far "outweigh . . . the [other] considerations" that would "weigh against discretionary denial." *iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 (P.T.A.B. June 6, 2025) (discretionarily denying institution). Allowing a late-stage IPR now would destabilize long-standing patent rights and reward Petitioners' delay at Champion's expense. *Kahoot!*, IPR2025-00696, Paper 12 at 2 ("[T]he challenged patent has been in force for over six years, creating strong settled expectations");

Cambridge Indus. USA, Inc. v. Applied Optoelectronics, Inc., IPR2025-00433, Paper 12 at 3 (P.T.A.B. June 26, 2025) (discretionarily denying institution challenging seven and nine year old patents); *Amgen*, IPR2025-00601, Paper 9 at 3. Ultimately, a “Petitioner’s failure to seek early review of the patents favors denial.” *Nvidia Corp. v. Neural AI, LLC*, IPR2025-00606, Paper 18 at 3 (P.T.A.B. July 31, 2025).

Champion’s settled expectations favor discretionary denial.

C. The ’390 Patent Is Being Challenged in Two Parallel Cases

There are four active cases regarding the 2013 Family against MWE (EX2051), Generac (EX2029), HFT (EX2017), and non-petitioner Firman (EX2003). The ’390 Patent is at issue in both the Firman and HFT cases. In each, the challenger has asserted invalidity in view of expansive “system” art and §112 grounds. For example, Firman’s initial invalidity contentions included 39 claim charts comprising 5,000 pages and 69 references. EX2005, p. 7; EX2006, pp. 3, 12-14. Of the 69 asserted references, 33 constitute system art. *See* EX2006, pp. 8-9, 40-42; *see* EX2055, pp. 6-8. Firman later amended its contentions based on thousands of pages of allegedly invalidating references it received from Generac including two more “system” products allegedly purchased by Generac in 2015.¹ EX2005, p. 6,

¹ These are the very same generators developed under Mr. Montgomery based on Champion generator designs allegedly sold to Generac by its Chinese suppliers.

EX2007. Generac’s invalidity contentions mirror those of Firman. *See e.g.*, EX2055; EX2009, EX2013. Generac’s Answer and Counterclaims reference the RD9000E 47 times and “Firman” 32 times and Generac asserts most of the same references mapped by Firman. EX2011. HFT’s invalidity defenses include word-for-word copies of Generac’s Answer and Counterclaims. EX2019, ¶219. EX2011, ¶139.

Firman. Trial in the Firman case is expected November 10, 2026. EX2002; EX2047. The parties have engaged in significant discovery, including producing over 35,000 pages of documents. Claim construction is complete and the upcoming Markman Order will trigger a 90-day deadline for the close of discovery and subsequent deadlines for expert discovery and dispositive motions. EX2002 at 9-12.

HFT. Significant progress will be made in the HFT Case before the institution deadline. Champion and HFT have produced thousands of pages of documents. The parties exchanged proposed constructions, filed opening and responsive claim construction briefs, held a Markman hearing on September 30, 2025, and filed supplemental claim construction briefs following the hearing, all well before the March 11, 2026 institution deadline. EX2016, p. 10. Pursuant to the parties’ joint proposed schedule, fact discovery, expert discovery and disclosures, and dispositive motion briefing are scheduled to conclude by August 21, 2026. EX2020, 11. The Final Pretrial Conference is December 10, 2026—three months *before* the March 11, 2027, FWD deadline. *Id.* The trial could begin as early as January 19, 2027. *Id.*

D. Petitioners’ Multiple IPR Filings and *Sotera* Stipulations

Petitioners have filed IPR proceedings challenging each of the 13 Champion patents asserted across the four co-pending cases, the most recent of which was not filed until October 7, 2025. EX2083; EX2084; EX2085. Petitioners’ stipulations do not apply to the litany of “system art” asserted by Firman and copied by the Petitioners in each case. EX2084; EX2085.

II. THE BOARD SHOULD EXERCISE ITS DISCRETION UNDER 35 U.S.C. § 314(a) TO DENY THE PETITION

A. Factor 1 (Presence of a Stay) Weighs in Favor of Denial

Neither of the parallel district court proceedings have been stayed, nor have Petitioners submitted any evidence that a stay is likely. Indeed, unless IPR is instituted for all 13 asserted patents a stay is unlikely. Given the fact that Petitioners’ latest IPR challenge was not filed until October 7, 2025 (more than five months *after* Petitioners’ first IPR challenge), it is likely that one or more of the parallel cases will have advanced far enough to render a stay improper. And, contrary to Petitioners’ representations in related proceedings, Patent Owner *has not* agreed to a stay in any of these cases. *See* IPR2025-00805, Paper 14 at pp. 9-10. Finally, it is unlikely the Firman court will grant a stay because Firman is not a petitioner, its statutory deadline to file a petition has long passed, the parties have invested significant time and resources, and the case will likely proceed to trial before a FWD.

B. Factor 2 (Proximity to Trial) Weighs in Favor of Denial

Although no trial date has been set in the HFT, Generac, and MWE cases, significant progress will be made in each before FWD. *See* §I.C, above. The presence of “events in other proceedings related to the same patent” (such as the Firman case) may weigh against granting a petition. Consolidated Trial Practice Guide, 58.

Moreover, Generac and HFT have been actively collaborating with Firman throughout discovery in the district court cases, exchanging documents and evidence relating to their respective litigations. EX2013; EX2009; EX2023. Generac’s and HFT’s discovery requests to Champion have also been Firman-focused. Petitioners have co-opted the Firman Case entirely, adopting Firman’s invalidity counterclaims as their own and actively collaborating with Firman throughout discovery. They have incorporated Firman’s arguments, evidence, and statements regarding invalidity and claim construction, and have exchanged thousands of pages of references, contentions, and expert reports with Firman.

Given the extent of Petitioners’ reliance on the Firman Case, and the fact that the Firman Case is likely to go to trial before FWD, Factor 2 weighs strongly in favor of discretionary denial.

C. Factor 3 (Investment in Parallel Proceedings) Weighs in Favor of Denial

There has been meaningful investment in the co-pending cases. Discretionary denial may be warranted where the parties “have made meaningful investment in the

district court proceeding,” for example, when “the parties have exchanged infringement and invalidity contentions, have already conducted over seven months of fact discovery, and a Markman hearing is scheduled to occur before the due date for an institution decision.” *Advanced Micro Devices, Inc. v. Concurrent Ventures, LLC*, IPR2025-00223, Paper 9 at 2 (P.T.A.B. June 12, 2025) (denying institution). Substantial discovery has already taken place in both the Firman and HFT cases. *See* §I.C, above.

In short, thousands of pages of infringement, non-infringement, and invalidity contentions, in addition to significant written discovery and document productions, have already been exchanged or will have been exchanged in the Firman and HFT Cases before the institution deadline. A claim construction order will issue soon in the Firman Case and a claim construction hearing was held in the HFT Case on September 30, 2025, followed by supplemental claim construction briefing. Accordingly, the third *Fintiv* factor weighs in favor of denial.

D. Factor 4 (Overlap in Issues) Weighs in Favor of Denial

Petitioners’ belated and limited stipulations cannot moot their expansive invalidity theories in the co-pending cases, including invalidity based on system art, §112 arguments, and inequitable conduct allegations the Board cannot resolve.

A timely *Sotera* stipulation is “will not be dispositive by itself.” Director’s March 24, 2025 Memorandum at 2-3, citing *Sotera Wireless, Inc. v. Masimo Corp.*,

IPR2020-01019, Paper 12 (P.T.A.B. Dec. 1, 2020). HFT served its stipulation with respect to the '390 Patent on August 29, 2025. EX2084.

In any event, the stipulation does little to narrow the issues before the district courts. “Where the petitioner is relying on corresponding system art in a co-pending proceeding and/or several other invalidity theories, a stipulation may not be particularly meaningful[.]” Interim Director Discretionary Process, Section I(D). The invalidity theories asserted across the four co-pending cases are not only developed by Firman, but also involve numerous combinations of system art that the stipulations do not moot. *See Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3–4 (P.T.A.B. Mar. 28, 2025) (Director Review) (“Petitioner’s invalidity arguments in the district court are more expansive and include combinations of the prior art asserted in these proceedings with unpublished system prior art, which Petitioner’s stipulation is not likely to moot”).

Petitioners have parroted Firman’s entire case and have focused discovery on the exact same systems that Firman asserts against both patent families. For example, the RD9000E system art is central to the defenses and counterclaims in both the Firman and HFT Cases. *See* §I.C, above. As such, district courts will still have to grapple with numerous system art and §112-based invalidity grounds. *See Motorola Sols.*, IPR2024-01205, Paper 19 at 3–4 (denying institution despite Petitioner’s *Sotera* stipulation, in part, because “Petitioner’s stipulation does not ensure that the[]

IPR proceedings would be a ‘true alternative’ to the district court proceeding”).

While the stipulation provides that HFT will not assert in *its* litigation “system prior art ... that directly corresponds to a printed publication” raised in the Petition, nothing prevents *Firman* from alleging invalidity based on those systems in its far more advanced litigation. Moreover, the stipulations do not prevent HFT from relying on corresponding system art (e.g., the DuroMax XP4400EH generator) in other capacities, including as evidence of the state of the art or with respect to other asserted patents. Likewise, HFT’s stipulation reserve the use of other “similar” systems. For example, while the stipulations exclude the Kubota DF-972 engine in related proceedings, they simultaneously reserve the right to rely on *that same engine* while contained within a larger system, such as a lawnmower. EX2084. In light of the limitations in HFT’s stipulations, it is unclear which other “systems/engines” Petitioners contemplate are “similar to the [DuroMax] XP4400EH generator” at issue here. *Id.* As such, corresponding system art will likely still be at issue in the parallel district court cases. Moreover, HFT’s stipulations do not apply *in any capacity* to a litany of unrelated system art, including the Firman ECO8990E, as well as numerous Winco, Honda, Northstar, and SCAG Turf Tiger devices. EX2006, 40-42.

E. Factor 5 (Same Party) Weighs in Favor of Discretionary Denial

The parties to the Petition are the same as those in the HFT case. Accordingly,

Factor 5 weighs in favor of denial. *See Sotera*, IPR2020-01019, Paper 12 at 19 (precedential as to Section II.A). Petitioners have filed 13 IPRs of Patent Owner's patents. This Petition requires the Board's analysis of 5 references asserted across 5 separate grounds, all of which will need to be fully addressed in the FWD. In total, Petitioners raise 85 grounds involving at least 27 references across the 13 IPR petitions.

F. Factor 6 (Other Circumstances) Weighs in Favor of Denial

First, the Petition's merits are weak, as Champion will establish in its Preliminary Response. *Second*, Champion has long-settled expectations the '390 Patent would not be challenged in an IPR, in light of Petitioners' prolonged inaction. *See* §I.B, *supra*. *Third*, Petitioners are thwarting a principal goal of IPR: to serve as an efficient and alternative forum for the promotion of robust and predictable patent rights. *Gen. Plastic Indus. Co., Ltd. v. Kaisha*, IPR2016-01357, Paper 19 at 15–16 (P.T.A.B. Sept. 6, 2017) (precedential). Petitioners have filed 13 IPRs over more than 5 months, resulting in multiple, staggered IPR schedules and a significant drain on the Board's limited resources, which is unwarranted and wasteful when multiple district courts will nevertheless be tasked with resolving Firman's and HFT's myriad system art and §112-based invalidity grounds.

Given a holistic view of the *Fintiv* factors and consistent with the Director's mandate to ensure the PTAB complies with pendency goals for *ex parte* appeals, its

statutory deadlines for AIA proceedings, and other workload needs, the Director should exercise discretion and deny institution.

III. THE DIRECTOR SHOULD EXERCISE DISCRETION TO DENY INSTITUTION UNDER SECTION 325(D)

The Board should deny institution under 35 U.S.C. § 325(d) because Petitioner relies solely on art and arguments that are the same or substantially the same as those considered by the Examiner during prosecution, and Petitioner has not and cannot meet its burden to demonstrate material error by the Examiner. *See, e.g., Advanced Bionics*, IPR2019-01469, Paper 6 at 10; *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (P.T.A.B. Dec. 15, 2017).

A. Petitioners' Art is Merely Cumulative

The Petition relies on DuroMax (Grounds 1-2) and Fujisawa (Grounds 4-5) as primary obviousness references and asserts anticipation by Fujisawa (Ground 3). De Vries, Nakafushi, Olmr, and DuroMax are also used as secondary references. Pet., 3-4. Each reference has a substantially similar counterpart that was considered during prosecution, thereby rendering each reference cumulative.

DuroMax is substantially the same as the Honda EU20i Video and Deutsch references already considered by the Examiner. Petitioners assert DuroMax discloses a generator configured to run on either gasoline or LPG delivered via a hose and two pressure regulators. *Id.*, 6. The alleged generator includes a manual gasoline shutoff valve. Petitioners also stress the importance of shutting off each of

the fuel sources before switching fuels based on a cautionary warning. *Id.*, 7-8.

Every feature relied on by Petitioners or otherwise taught by DuroMax is similarly taught by (1) the YouTube Video of the Honda EU20i generator (“EU20i Video”) (EX2075; EX2076) and (2) U.S. Publication No. 2002/0134362 (“Deutsch”). EX2060, [0010]. Both were cited in a November 22, 2019 IDS during examination of the grandparent ’101 Patent and therefore have already been considered. EX1028 at 031, 033; *see also* MPEP § 609.02(II)(A)(2) (“The examiner will consider information which has been considered by the Office in a parent application.”). The Petition does not rely on DuroMax for any feature or function apart from those known and considered during examination of the ’390 Patent.

Fujisawa is substantially similar to Monros (U.S. Patent Pub. No. 2014/0202430), which was cited in the same November 22, 2019 IDS. EX1028, 032; EX2061. Fujisawa discloses a fuel supplying device with a rotary knob. EX1005, ¶¶[0034]-[0036], FIG. 5. Rotating the knob manipulates cams and followers to selectively open and close propane and butane valves to fuel an internal combustion engine. *Id.*, ¶¶[0037]-[0038]. Only one of the valves may open at a time. *Id.*

Similarly, Monros shows a rotating switch 64 only allowing one of gasoline or propane to flow at a time. EX2061, ¶[0028] (“Regardless of mechanism used, the switch box 20 in any embodiment of the present invention will allow only one type of fuel to pass through at a time.”). Monros’ rotating switch 64 can be manually

controlled with a selector switch 78 that “enables the driver to override the automatic programming of the microcontroller 22 (*see* FIG. 4) and switch fuel sources on the fly.” *Id.*, ¶[0030]. Since “the rotating switch 64 is configured to allow only one type of fuel through to the fuel supply line 50 at a time,” fuel only flows through the gasoline supply line 52 or the propane supply line 54 to the engine’s fuel supply line 50. *Id.*, ¶[0027]. Fujisawa is substantially similar to Monros and does not introduce anything new that the Examiner failed to consider.

Petitioners’ secondary references do not cure the failings of the primary references, and they too are each cumulative of the cited art:

- De Vries is cited in Grounds 1-2 for disclosure of a “safety interlock system” and is cumulative of Monros. *Compare* EX1011, Figs. 1A-1C, 5:25-27, 5:31-6:4 *with* EX2061, Abstract, Fig. 4, ¶¶[0027]-[0030].
- Nakafushi is cited in Grounds 2 and 5 for disclosure of a control valve downstream of the float chamber and is cumulative of the Kubota Patent, also cited in the November 22, 2019 IDS. Pet., 12-14, 50-53; EX1028, 031; *compare* EX1009, FIG. 1, 4:23-6:20 *with* EX2062, Fig. 3, 2:39-3:40.
- Olmr is cited in Grounds 2 and 5 for disclosure of a solenoid valve within a carburetor float bowl as a mechanism for cutting off fuel supply to the engine and is cumulative of both the Kubota Patent and Kopa (also cited

in the November 22, 2019 IDS). EX1028, 030; *compare* Pet., 14-15, 50-53 *with* EX2062, 3:14-27; EX2077, 12:58-74.

In view of the above, the Office has already considered the same or essentially the same art and arguments as now presented in the Petition. Prong 1 of the *Advanced Bionics* framework thus weighs in favor of discretionary denial.

B. Petitioners Have Failed to Demonstrate Any Material Error by the Examiner

The Board requires “a showing that the Office erred in evaluating the art....” *Advanced Bionics*, IPR2019-01469, Paper 6 at 8. Petitioners have not alleged any material defect or error of any kind that occurred during examination. Specifically, the Petition does not even attempt to show any of the references cited in the Petition disclose any new material that was not considered during examination. Accordingly, Prong 2 weighs heavily in favor of discretionary denial.

IV. CONCLUSION

Patent Owner respectfully requests the Director exercise discretion under 35 U.S.C. §§ 314(a) and 325(d) to deny institution.

Dated: November 12, 2025

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CERTIFICATE OF PAGE COUNT

The undersigned hereby certifies that the foregoing document is limited to 20 pages.

Dated: November 12, 2025

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CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. § 42.6(e), the undersigned certifies that on November 12, 2025, a complete and entire copy of the foregoing Patent Owner's Brief in Support of Request for Discretionary Denial of Institution, including the exhibits relied upon, was served on counsel of record for Petitioner, as follows:

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Paper 9

Dated: November 12, 2025

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