

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
PRELIMINARY RESPONSE**

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GLOSSARY

Abbreviation	Term
'390 Patent	U.S. Patent No. 11,761,390
Board	Patent Trial and Appeal Board
Challenged Claims	Claims 1-21 of the '390 Patent
Generac	Generac Power Systems, Inc.
Harbor Freight	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. 11,761,390 (Paper 1)
Petitioner	Harbor Freight, 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 Generac Power Systems, Inc., Harbor Freight Tools USA, Inc., and MWE Investments, LLC (collectively, “Petitioner”), challenging Claims 1-21 of U.S. Patent No. 11,761,390.

I. INTRODUCTION

Petitioner’s proposed grounds are identified below:

Ground	Claims	Basis	Primary Reference	Secondary Reference(s)
1	11-16, 20-21	103	DuroMax	De Vries
2	1-21	103	DuroMax	De Vries; Nakafushi; and Olmr
3	11-16, 21	102	Fujisawa	
4	11-16, 20-21	103	Fujisawa	DuroMax
5	1-21	103	Fujisawa	DuroMax; Nakafushi; and Olmr

Discretionary denial pursuant to 35 U.S.C. § 314(a), 35 U.S.C. § 325(d), and the *Fintiv* and *Advanced Bionics* factors¹ is warranted for the reasons set forth in Patent Owner’s Brief in Support of its Request for Discretionary Denial of Institution

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).

(Paper 9). Moreover, denial is appropriate for several reasons. First, Petitioner’s reliance on multiple contradictory constructions of “selector switch” (including construing the term differently in Claim 1 and Claim 11, relying on alternative “apparent” constructions, and asserting indefiniteness arguments in district court), without sufficient justification merits denial. Second, the proposed combination of DuroMax in view of De Vries (Grounds 1 and 2) does not disclose or otherwise render obvious the claimed invention—specifically absent are the claimed “selector switch” (Cl. 1) and “valve assembly” (Cl. 11). Third, under Petitioner’s proposed construction of “valve assembly,” Fujisawa does not disclose or otherwise render obvious the claimed “valve assembly” (Grounds 3-5).

II. OVERVIEW OF THE ’390 PATENT

The ’390 Patent was filed as U.S. Patent App. No. 17/651,245 on February 16, 2022, and is one of five issued patents in a patent family directed to multi-fuel generator technology, and collectively referred to as the “2013 Family.” EX1001, (21), (22), (63). The priority chain of the 2013 Family is depicted below:

App. No.	Filing Date	Pat. / Pub. No.	Relationship
14/069,747	Nov. 1, 2013	9,435,273	
15/015,205	Feb. 4, 2016	10,598,101	Continuation of ’273 Patent
16/789,722	Feb. 13, 2020	11,306,667	Continuation of ’101 Patent
17/651,245	Feb. 16, 2022	11,761,390	Continuation of ’667 Patent

18/330,807	Jun. 7, 2023	11,905,896	Continuation of '390 Patent
18/443,530	Feb. 16, 2024	2024/0183321	Continuation of '896 Patent
19/027,054	Jan. 17, 2025	2025/0154912	Continuation of '530 App.
19/027,095	Jan. 17, 2025	2025/0163860	Continuation of '530 App.

A. The Specification of the '390 Patent

The '390 Patent, titled Dual Fuel Selector Switch, is generally directed to a selector switch for a multi-fuel generator operable on both liquid fuel and gaseous fuel. EX1001, Abstract.

As the '390 Patent explains, “[c]ertain generators are defined as ‘dual fuel’ generators that include an engine having the ability to be fueled with either of two fuels, such as either gasoline or liquefied petroleum gas (LPG), for example. These ‘dual fuel’ generators may selectively operate on gasoline or LPG as desired and controlled by an operator, such as being operated on LPG/gasoline for a first period of operation and selectively switching over to the other of LPG/gasoline for another period of operation, with such a switching of fuels being controlled as desired by an operator.” *Id.*, 1:37-46.

The '390 Patent explains that problems with previous multi-fuel generators included inadvertently allowing multiple fuel sources to be on at the same time:

Typical dual fuel generators utilize separate valves for each fuel type, such as an LPG valve and a gasoline valve, to control flow of the

respective fuels to the engine. While the existence of two separate valves allows one fuel type to have its valve “on” while the other has its valve “off,” there is nothing to prevent both valves from being “on” at the same time. As such, it is possible for both valves to be in the “on” position, which can lead to a potentially unsafe condition resulting from the mixture of the fuels.

EX1001, 1:46-55.

To address this problem, the ’390 Patent explains that “it would be desirable to provide a dual fuel generator with a selector switch that would prohibit the mixing of two differing types of fuels.” *Id.*, 1:56-58. More specifically, in one embodiment, the multi-fuel generator of the ’390 Patent includes “a fuel selector 22 constructed to provide for selection of a desired fuel source 18, 20 for supplying fuel to the engine 12. The fuel selector 22 not only provides for selection of a desired fuel source 18, 20 for supplying fuel to the engine 12, but also selectively restricts the selection of a fuel source so as to enable the use of only one fuel at a time.” *Id.*, 4:2-8. “As a result, fuel from the first fuel source 18 cannot flow to engine 12 while fuel from the second fuel source 20 is flowing to engine 12, and vice versa.” *Id.*, 4:8-11.

B. The Independent Claims of the ’390 Patent

Claims 1 and 11 are reproduced below:

1. Claim 1.

1. A fuel selector of a dual fuel generator comprising:
a selector switch having:

a first fuel mode configured to enable a first fuel flow from a first fuel source to an engine of the dual fuel generator; and
a second fuel mode configured to enable a second fuel flow from a second fuel source to the engine of the dual fuel generator;
a fuel solenoid having open and closed positions; and
a solenoid switch having a closed position to activate the fuel solenoid and an open position;
wherein, when the selector switch is in the first fuel mode, the fuel solenoid is in the closed position and, when the selector switch is in the second fuel mode, the solenoid switch is in the open position and the fuel solenoid is in the open position.

2. Claim 11.

11. A fuel selector for use with a dual fuel generator, the fuel selector comprising:
a valve assembly fluidly connectable to each of a first fuel source and a second fuel source, the valve assembly comprising a first selector switch operable to selectively control a first fuel flow and a second selector switch operable to selectively control a second fuel flow from the first fuel source and the second fuel source, respectively, to an engine of the dual fuel generator; and
an interlock positioned on or adjacent the valve assembly to prevent simultaneous operation of the first selector switch and the second selector switch.

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 a college degree in mechanical engineering, physics, or related fields, and three years of work experience in combustion engines operating on various fuel sources. Additional higher graduate education could substitute for work experience, and additional work experience/training could substitute for formal education.

Petition, 15 (citing EX. 1003, ¶118). 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 operating on various fuel sources 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 No. 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)). Unless otherwise stated, for purposes of the arguments set forth in this Preliminary Response, Patent Owner applies the plain and ordinary meaning of each claim limitation which is addressed.

Petitioner, meanwhile, applies numerous different constructions of the term “selector switch.” For example:

- Petitioner asserts that with respect to “claims 1-10 only,” the term “selector switch” should be construed as “a movable component whose positioning enables subsequent user selection of only one fuel source.” Pet., 24.
- Petitioner also argues that with respect to “claims 11-21 only, and only to the extent claims 11-21 satisfy 35 U.S.C. §112, the intrinsic and extrinsic evidence shows that the claimed ‘selector switch’ is a valve handle.” *Id.*, 24-25.
- Petitioner relies on “apparent” constructions of “selector switch” with respect to Ground 5, which are allegedly based on Patent Owner’s litigation positions. *Id.*, 37-38.

- Generac asserts that the term “selector switch” is *indefinite* in parallel district court litigation. EX2113, 51-52.²
- Finally, Petitioner argues that the term “interlock” (Cl. 11) actually refers to “selector switch 30” described in the specification, even though Claim 11 also recites a “selector switch.” Pet., 32.

Although it is unclear from the Petition, it appears that Petitioner has (1) construed the term “selector switch” of Claims 1-10 consistently with Harbor Freight’s district court construction of the same term, (2) construed the term “interlock” of Claims 11-21 consistently with Harbor Freight’s district court construction of “selector switch,” and (3) provided two new constructions of “selector switch” applied respectively for Grounds 3-4 and Ground 5 (but only with respect to Claims 11-21). As explained in additional detail, below, Petitioner’s minimal justification for its plethora of confusing and contradictory constructions of

² To be clear, the ’390 Patent is not at issue in the Generac litigation. However, Generac *did* allege that the term “selector switch” was indefinite with respect to the related ’101, ’667, and ’896 Patents. EX2113, 51-52. And Petitioner emphatically contends that “‘selector switch’ in the ’390 Patent should have identical constructions as in the ’101 Patent.” Pet., 26. Thus, Generac’s indefiniteness arguments should be considered here.

the term “selector switch” is deficient. Institution should be denied. *See e.g., Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 (P.T.A.B. November 3, 2025) (precedential) (suggesting that petitioners should “have less flexibility to advance inconsistent arguments about claim scope, and will instead be required to choose a single claim construction that best captures the true meaning of the patent claim”).

A. Petitioner did not establish “selector switch” should be construed differently with respect to Claim 1 and Claim 11.

Petitioner’s sole explanation for applying different (and contradictory) constructions of the term “selector switch” in Claim 1 and Claim 11 is that (1) “[t]he specification discloses a single ‘selector switch 30,’” and (2) “a POSA would understand that, in order for Claims 11-21 satisfy §112, the claimed first and second selector switches cannot refer to single ‘selector switch 30’ in the specification.” Pet., 30.³ Petitioner’s argument is deficient.

1. Petitioner’s attempt to construe “selector switch” differently in Claims 1 and 11 is not supported.

The weight of legal authority weighs heavily against Petitioner’s suggestion that “selector switch” should be construed *differently* in Claims 1 and 11. Contrary

³ Notably, Petitioner does not provide *any* evidentiary support for its statement regarding the alleged understanding of a POSITA.

to Petitioner’s representation—and supported by Petitioner’s own authority—
“[u]nless the patent otherwise provides, *a claim term cannot be given a different meaning in the various claims of the same patent.*” *Ga.-Pacific Corp. v. U.S. Gypsum Co.*, 195 F.3d 1322, 1331 (Fed. Cir. 1999) (emphasis added); *see also Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1579, 34 U.S.P.Q.2D (BNA) 1673, 1679 (Fed. Cir. 1995) (holding that claim term found in different claims must be interpreted consistently); *Fonar Corp. v. Johnson & Johnson*, 821 F.2d 627, 632, 3 U.S.P.Q.2D (BNA) 1109, 1113 (Fed. Cir. 1987) (holding that a term used in one claim had the same meaning in another claim). “Generally, unless otherwise compelled the same claim term in the same patent or related patents carries the same construed meaning.” *Helios Streaming, LLC v. Starz Ent., LLC*, No. SACV 19-02140JVS(ADSx), 2021 U.S. Dist. LEXIS 22691, at *21 (C.D. Cal. Feb. 4, 2021) (citing *Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1334 (Fed. Cir. 2003); *In re Rambus Inc.*, 694 F.3d 42, 48 (Fed. Cir. 2012)) (cleaned up).

Petitioner cites three cases for the proposition that “[i]n *some cases*, a claim term can be given a different meaning in the various claims of the same patent, when a patent so provides.” Pet., 24-25 (emphasis added). But, the Petition merely acknowledges that claim terms can be construed inconsistently within the same patent in limited circumstances—it does not actually provide guidelines for identifying those circumstances.

For example, the court in *Helios Streaming* “decided that it would not construe the terms separately” and explained “[a] word or phrase used consistently throughout a patent claim should be interpreted consistently.” *Helios Streaming, LLC v. Starz Ent., LLC*, No. SACV 19-02140JVS(ADSx), 2021 U.S. Dist. LEXIS 22691, at *23 n.2 (C.D. Cal. Feb. 4, 2021). Similarly, the Federal Circuit in *Georgia-Pacific* explained: “We are convinced that the district court’s interpretation of ‘sandwiched’ as not precluding the flow through of the gypsum core on one of the fiberglass mats *should have been applied to that term in claim 11* absent any indication that a different meaning was contemplated.” *Ga.-Pacific Corp. v. U.S. Gypsum Co.*, 195 F.3d 1322, 1331 (Fed. Cir. 1999) (emphasis added).

In fact, the *only* case cited by Petitioner where a court *actually* construed a term differently within a single patent is *Spinal Concepts, Inc. v. EBI, L.P.*, No. A-02-CA-636 LY, 2004 U.S. Dist. LEXIS 32678 (W.D. Tex. Apr. 13, 2004). There, the term “during use” was present in several claims directed to spinal implants and bone plate systems. For example, Claim 1 of U.S. Patent No. 6,454,769 recited “a spinal fixation system” with the following limitations:

- a plate for stabilizing a spine, the plate comprising a borehole;
- a bone screw comprising a head and a shank;
- a ring for inhibiting backout of the bone screw from the plate, the ring being positionable within the borehole plate between the plate and the bone

- screw **during use**, and wherein the ring allows the bone screw to be inserted into a bone at a desired angle relative to the plate;
- and wherein the head and the ring are configured to couple together without fixedly engaging the ring to the plate **during use**.

The court found that the claimed “use” depended on the surrounding context of the claim—i.e., did the claimed use occur during implantation of the spinal fixation system, after implantation, or both. As such, the court construed the first instance of “during use” as “during or after implantation of the spinal fixation system” because it referred to the position of the ring “at all times after implementation” *and* “during insertion of the bone screw.” *Id.* at *13. However, the court construed the second instance of “during use” as “after implantation” because it was “[i]t is clear from the patent that the ring and the head are not ‘coupled together’ until the device has been implanted.” *Id.* at *18. In particular, the court focused on whether “the phrase connote[d] [any] specific temporal limitation.” *Id.*

Here, conversely, “selector switch” does not connote the temporal limitations that were at issue in *Spinal Concepts*, nor should its construction change depending on the surrounding context. Indeed, Petitioner has not overcome the great weight of authority to prove that “selector switch” should not be construed to encompass both the Claim 1 and Claim 11 embodiments. Petitioner has failed to show (or even argue) that its proposed contradictory constructions of “selector switch” are “compelled”

by the '390 Patent, or that the '390 Patent “otherwise provides” for Petitioner’s proposed interpretation. Rather, the *only* justification Petitioner provides is to improperly import limitations from the specification into the claims. Pet., 30 (“[t]he specification discloses a single ‘selector switch 30’”). But, in addition to being legally unsupported, Petitioner’s argument also fails on the merits.

2. Petitioner’s prior arguments in related proceedings preclude its position here.

In related proceedings addressing U.S. Patent No. 10,598,101 (which Petitioner contends should guide the Board’s construction here), Petitioner explicitly argued that “the use of the indefinite article ‘a’ means ‘one or more’ in the claim term ‘a selector switch.’” IPR2025-00951, Paper 19, 5; *see also* Pet., 26 (“‘selector switch’ in the '390 Patent should have identical constructions as in the '101 Patent.”). Both the originally-filed application for the '390 Patent (and the originally-filed application for its ultimate parent (U.S. Patent No. 9,435,273)) claim “a selector switch.” EX2123, 187; EX1002, 156. Thus, applying the logic that Petitioner expressly advocated for in IPR2025-00951, it is indisputable that the '390 Patent discloses “one or more” selector switches.

3. Petitioner’s claim construction positions are impermissibly conditioned on the resolution of written description arguments which cannot be resolved by the Board.

Petitioner’s “Claim 11” construction of “selector switch” also fails because it is impermissibly conditioned on the outcome of a §112 analysis which is outside of

the Board’s jurisdiction. Petitioner argues that with respect to “claims 11-21 only, and only to the extent claims 11-21 satisfy 35 U.S.C. §112, the intrinsic and extrinsic evidence shows that the claimed ‘selector switch’ is a valve handle.” *Id.*, 24-25. But, the Board lacks jurisdiction to determine whether “claims 11-21 satisfy 35 U.S.C. §112” as Petitioner contends. 35 U.S.C. § 311(b).

B. Petitioner’s reliance on “apparent” constructions is legally improper and should be rejected outright.

“Inter partes review shall not be instituted unless the Board decides that the information presented in the petition demonstrates that there is a reasonable likelihood that at least one of the claims challenged in the petition is unpatentable.” 37 C.F.R. § 42.108. Specifically, the 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 Petitioner’s “apparent” constructions.

After spending vast swathes of its Petition detailing and debating the allegedly correct construction of “valve assembly” and “selector switch” (Pet., 24-37, Petitioner spends a mere two paragraphs purportedly identifying alternative “apparent” constructions, which allegedly control Ground 5. *Id.*, 37-38. The purported “apparent constructions” are allegedly based on positions taken by Patent Owner in parallel litigation. *Id.*, 2-3. However, Petitioner does not clearly articulate the “apparent construction” of each term is. Rather, Petitioner states that:

Patent Owner appears to adopt a claim construction wherein the “selector switch” of claims 1-10 can be a dial or knob that directly actuates the valve assembly.

Id., 38.⁴ Indeed, Petitioner merely supplies various alternative examples of devices which might be covered by the “apparent” construction (i.e., the “selector switch *can be* a dial or knob), but does not actually construe the term. 35 U.S.C. § 312(a)(3); 37 C.F.R. § 42.104(b). Based on this “construction,” Petitioner “include[s] invalidity Ground 5,” which allegedly show invalidity “under Patent Owner’s apparent construction.” Pet., 38. Importantly, Petitioner emphatically concludes that “Petitioners do not admit or concede that Patent Owner’s apparent constructions are correct.” *Id.* In fact, Petitioner explicitly asserts that the “apparent constructions are wrong.” *Id.*

2. Petitioner’s allegation that the Challenged Claims are invalid is deficient because Petitioner’s reliance on Patent Owner’s “apparent” construction of “selector switch” is improper.

Petitioner relies on Patent Owner’s “apparent” construction of selector switch in Ground. Pet., 70-71. However, Petitioner also argues that “Patent Owner’s

⁴ Patent Owner has not asserted Claims 11-21 in parallel litigation. Confusingly, Petitioner references “the ‘selector switch’ of claims 1-10.” Pet., 38. But, Patent Owner has not asserted “selector switch” should be construed differently in Claim 1 and Claim 11 in any parallel litigation.

apparent constructions are wrong.” *Id.*, 38. Moreover, Petitioner does not define the purported “apparent” construction of “selector switch” it is relying on as the basis of Ground 5. §IV.B.1, *supra*.

Like in *Vicor Corporation*, institution is improper because Petitioner’s Ground 5 “does not purport to correctly construe the [disputed] limitations” but rather applied what Petitioner deemed Patent Owner’s “apparent” construction. *Vicor Corp. v. Delta Elecs., Inc.*, IPR2024-00704, Paper 11 at 7 (P.T.A.B. October 2, 2024). And, like in *Vicor Corporation*, “Petitioner [did] not establish that such interpretations [were] appropriate,” which is “fatal” to Ground 5. *Id.* at 8; *see also* §IV.B.1, *supra*. “Petitioner acknowledges that its [Ground 5 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 5 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 a narrow construction of “selector switch” in parallel district court litigation to manufacture non-infringement positions. EX2110, 10-13. 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 a broad and amorphous “apparent” construction of that same term—

without actually defining the construction—in the hopes of convincing the Board to institute. Petitioner has advanced broad constructions before the Board, while maintaining narrower constructions—and corresponding non-infringement positions—if its challenge proves unsuccessful. This approach is *explicitly* precluded by *Revvo Techs.* IPR2025-00632, Paper 20 at 3-5 (“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.”). Institution should be denied.

C. Petitioner’s indefiniteness arguments in parallel proceedings support denial.

Tesla, Inc. v. Intellectual Ventures II LLC explicitly held 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.’” IPR2025-00340, Paper 18 at 4 (P.T.A.B. Nov. 5, 2025) (informative) (citing *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR202500632, Paper 20 at 3–5 (P.T.A.B. Nov. 3, 2025) (precedential)).

Despite relying on *three* different constructions of “selector switch” before the Board (Petitioner’s Claim 1 construction, Petitioner’s Claim 11 construction, and Patent Owner’s “apparent” construction), Generac previously argued that the term

was indefinite in the co-pending parallel litigation. EX2113, 51-52.⁵ Patent Owner disputes that *any* terms of the '390 Patent are indefinite. However, Petitioner did not address this discrepancy in the Petition. Pet., 24-38. Specifically, Petitioner failed to explain how the term “selector switch,” when “read in light of the specification delineating the patent, and the prosecution history” is both (1) sufficiently definite so as to inform Petitioner’s invalidity challenges raised in the Petition, and (2) “fail[s] 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. *See, e.g., Cambridge Mobile Telematics, Inc. v. Sfara, Inc.*, IPR2024-00952, Paper 12 (P.T.A.B. Dec. 13, 2024) (informative) (declining to institute where Petitioner (1) alleged certain terms were indefinite in parallel district court litigation, and (2) failed to “explain[] why the plain and ordinary meaning of the [challenged] terms should apply in this proceeding (why the inconsistent positions are warranted) or set forth an alternative claim

⁵ As explained above, Petitioner emphatically contends that “‘selector switch’ in the '390 Patent should have identical constructions as in the '101 Patent.” Pet., 26. Thus, Generac’s indefiniteness arguments regarding the '101 Patent should be considered here.

construction”) (citing Consolidated Trial Practice Guide at 45); *see also Microchip Tech. Inc. v. Aptive Technologies AG*, IPR2024-00494, Paper 12 at 10 (P.T.A.B. October 7, 2024).

Moreover, “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.” *Tesla*, Paper 18 at 3 (citing *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR202500632, Paper 20 at 3–5 (P.T.A.B. Nov. 3, 2025) (precedential)). Here, Petitioner did not articulate *any* basis for its contradictory indefiniteness positions, and that also supports denial.

V. THE PRIOR ART

The Petition asserts invalidity over five different grounds—including numerous alternative arguments based on Petitioner’s vague and confusing claim construction positions—which include multiple combinations of five different prior art references. Each ground relies on one of two primary references. However, as explained in Section VI, the Petition can be summarily denied in light of deficiencies in (1) DuroMax in view of De Vries (Grounds 1-2) and (2) Fujisawa (Grounds 3-5). Each reference is discussed in turn, below:

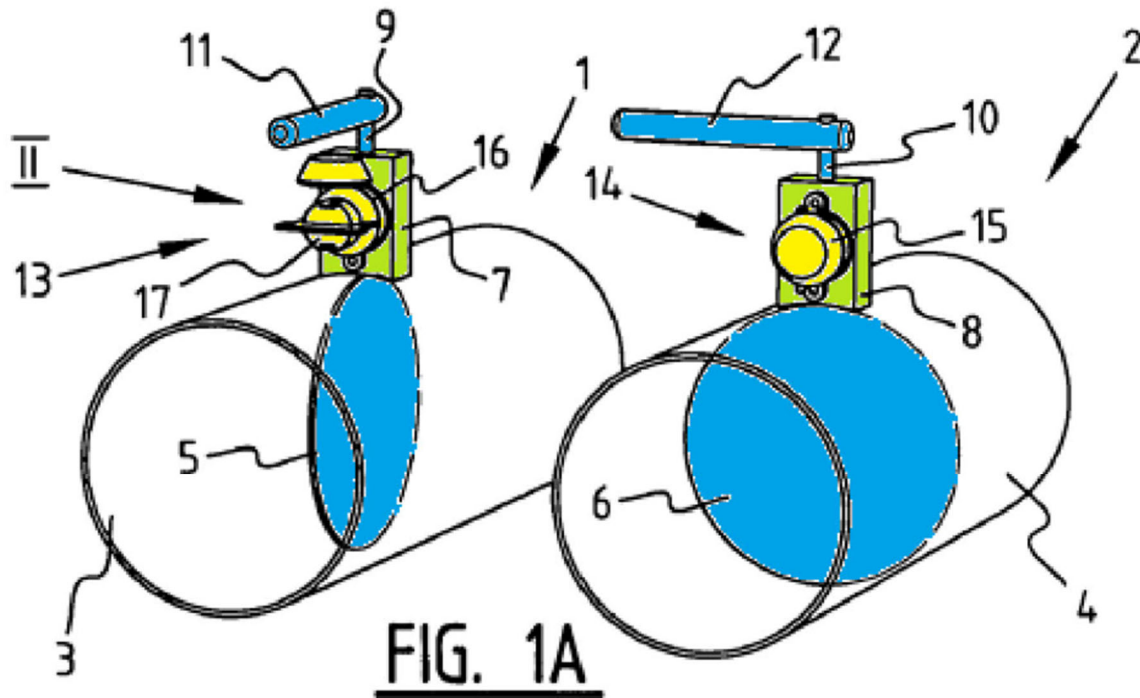
A. DuroMax Dual Fuel Hybrid Elite XP4400EX (“DuroMax”) (EX1006)

DuroMax discloses a dual fuel generator separately operable on liquified petroleum gas (“LPG”) and gasoline. EX1006, 002. The DuroMax generator

includes a manual gasoline fuel valve for controlling gasoline fuel flow. *Id.*, 011. However, it *does not* include any component for controlling the flow of LPG. Instead, DuroMax relies solely on the user to turn off the gasoline fuel valve before operating the engine on LPG. *Id.*, 012.

B. U.S. Patent No. 7,481,087 (“De Vries”) (EX1011)

De Vries discloses an interlocked valve system with two distinct butterfly valves, for use in the petrochemical industry. EX1011. “FIGS. 1A-1C show an embodiment of the interlock system which is applied to the specific example of two closing valves in liquid and/or gas pipelines of a petrochemical plant.” EX1011, 5:25-27. “On support 7 there is provided a first safety system 13 with which the valve can be fixed in a determined position. In similar manner the right-hand part 2 consists of a conveyor pipeline 4 in which a valve 6 is arranged rotatably. For this purpose conveyor pipeline 4 is provided with a support 8 on which a second safety system 14 is arranged.” *Id.* 5:33-38. Without conceding their accuracy, Petitioner’s annotations of De Vries’ Fig. 1A are reproduced below:



Pet., 11 (citing EX1011, Fig. 1A) (annotations in original).

In the shown embodiment the left-hand valve 5 is locked in the opened position, while the right-hand valve 6 is locked in the closed position. This means that when no key 17 of safety system 13, 14 is available, valves 5, 6 remain locked in respectively opened and closed position. In this condition the opened valve 5 and closed valve 6 are in their “normal” or operational mode. When the key 17 associated with the left-hand and the right-hand safety systems 13, 14 is however available, valve 5 can be unlocked by operating the left-hand safety system 13, whereafter the valve can be closed by operating handle 11.

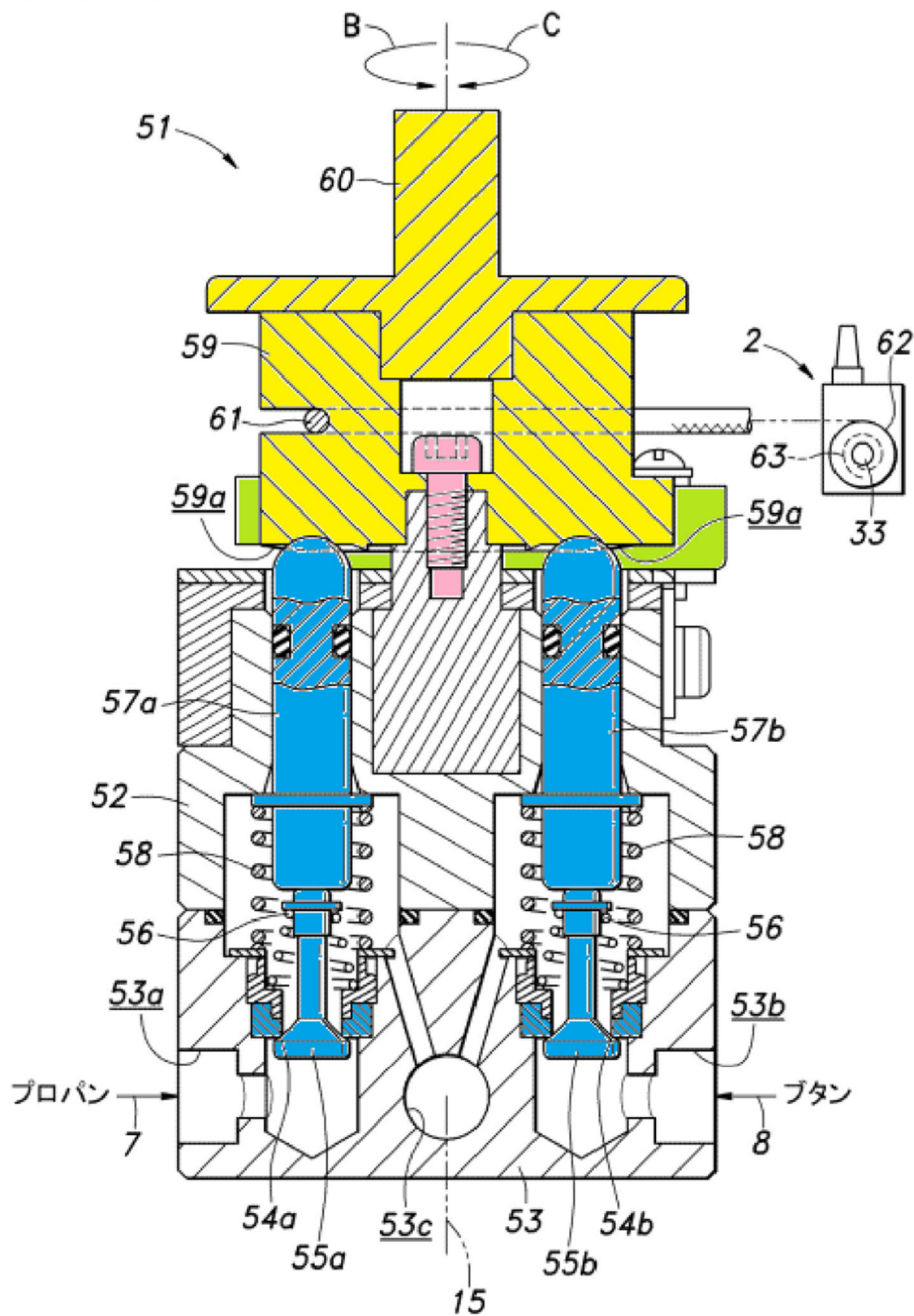
EX1011, 5:43-53. De Vries explains that “[i]n another embodiment it is possible to envisage the safety system 13 being embodied such that key 17 can then only be

removed from the left-hand safety system 13 when the left-hand valve 15 is locked in the closed position.” *Id.*, 5:63-66.

C. JP 2005-330867 (“Fujisawa”) (EX1004; EX1005)

Petitioner contends that Fujisawa “is another example of a prior art dual fuel generator.” Pet., 8. According to Petitioner, “Fujisawa discloses a valve assembly comprising at least valve seats 54a and 54b, valve bodies 55a and 55b, and cam followers 57a and 57b. The cam followers 57a and 57b (blue) are moved up and down by the cam body 59 and rotary knob 60 (yellow) to open and close the valves (blue).” *Id.* Petitioner explains that “[c]am surface 59a is constructed to selectively control the position of cam followers 57a and 57b to open and close the valves.” *Id.*, 10 (citing EX1005, ¶[0035]). Without conceding their accuracy, Petitioner’s annotations to Fujisawa’s Figure 5 are reproduced below:

【図 5】



Id., 9 (citing EX1004, Fig. 5) (annotations in original).

VI. ARGUMENT

The Petition does not demonstrate a reasonable likelihood that at least one challenged claim is unpatentable.

Claims 1 and 11 of the '390 Patent are independent claims. If Petitioner is unable to show a reasonable likelihood that it will prevail with respect to any of the independent claims, institution should be denied. *See, e.g., Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1576 n. 36 (Fed. Cir. 1987) (“Because [independent] claim 1 is not invalid, the presence of all its limitations in [dependent] claim 6 preserves the latter’s validity.”). Of relevance to Patent Owner’s Preliminary Response, the Petition alleges the following grounds of invalidity:

- **Ground 1** alleges that Independent Claim 11 is obvious over DuroMax in view of De Vries. Pet., 3-4.
- **Ground 2** alleges that Independent Claims 1 and 11 obvious over DuroMax in view of De Vries, Nakafushi, and Olmr. Pet., 3-4. Importantly, the Petition merely incorporates its analysis from Ground 1 with respect to Claim 11. *Id.*, 61.
- **Ground 3** alleges that Independent Claim 11 is anticipated by Fujisawa. *Id.*, 3-4.

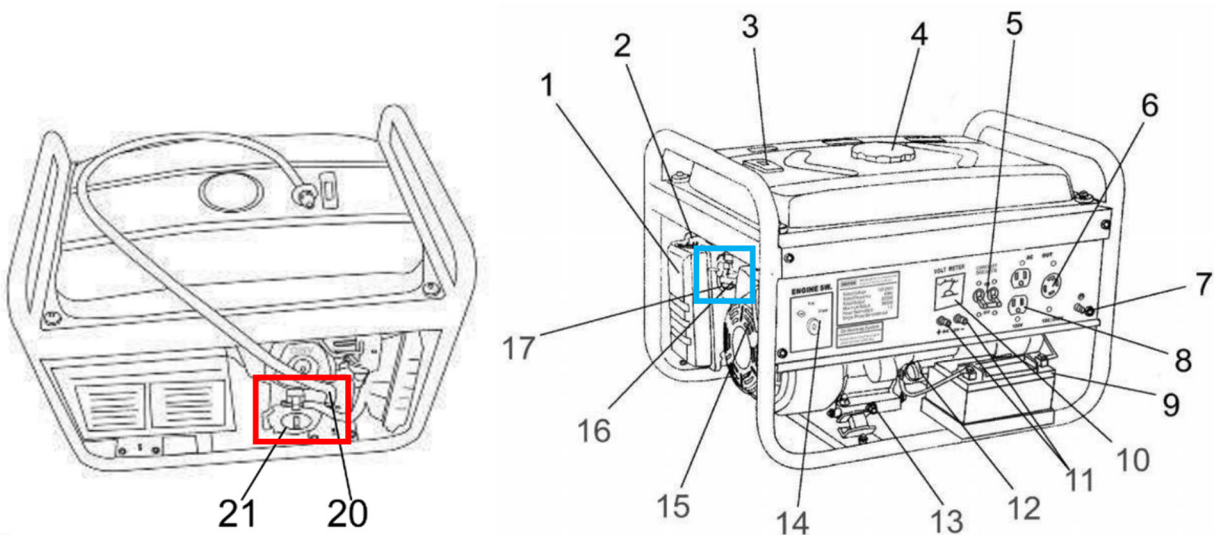
- **Ground 4** alleges that Independent Claim 11 is obvious over Fujisawa in view of DuroMax. *Id.* Importantly, the Petition merely incorporates its analysis from Ground 3 with respect to Claim 11. *Id.*, 70.
- **Ground 5** alleges that Independent Claims 1 and 11 are obvious over Fujisawa in view of DuroMax, Nakafushi, and Olmr. *Id.*, 3-4. Importantly, the Petition merely incorporates its analysis from Ground 3 with respect to Claim 11. *Id.*, 80.

Patent Owner’s Preliminary Response asserts that denial is proper because Petitioner does not demonstrate a reasonable likelihood that any claims are unpatentable. First, the proposed combination of DuroMax in view of De Vries (Grounds 1 and 2) does not disclose or otherwise render obvious the claimed invention. Specifically, the combination of DuroMax and DeVries does not disclose at least the claimed “selector switch” (Cl. 1) or “valve assembly” (Cl. 11). §VI.A, *infra*. Second, Petitioner improperly relies on Patent Owner’s “apparent construction” of “selector switch” (Ground 5, Cl. 1). §§IV.B, *supra*; VI.B, *infra*. Third, under Petitioner’s proposed construction of “valve assembly,” Fujisawa does not disclose or otherwise render obvious the claimed valve assembly (Grounds 3-5, Cl. 11). §VI.B, *infra*. Each argument is discussed in turn below.

A. The DuroMax-based grounds (Grounds 1 and 2) do not demonstrate a reasonable likelihood that any claims are unpatentable.

Petitioner alleges that the Challenged Claims are invalid over the combination of DuroMax and De Vries. Pet., 39-61. Specifically, Petitioner alleges a POSITA “would have been motivated to implement the valve assembly with the safety interlock of DeVries into the dual fuel generator of DuroMax to prevent both the LPG and gasoline fuel sources from simultaneously supplying fuel while the generator is operating to make the generator safer.” *Id.*, 42. According to Petitioner, the proposed combination consists of (1) “substituting the gasoline fuel shutoff valve of DuroMax with a first valve of DeVries” and (2) “adding a second fuel valve of DeVries onto the LPG intake of DuroMax.” *Id.*, 42-43.

DuroMax’s gasoline fuel shutoff valve (fuel valve 17, blue) and LPG intake (hose connector 20, red) are depicted in the annotated figures below:



EX1006, 007-008; Pet., 5-7.⁶ DuroMax describes each component as follows:

- 17. **Fuel valve-** Allows fuel to enter engine.
- 20. **Hose connector-** Connect liquid propane gas to generator.

EX1006, 008.

1. DuroMax in view of De Vries does not disclose or otherwise render obvious the claimed “selector switch” (Cl. 1).

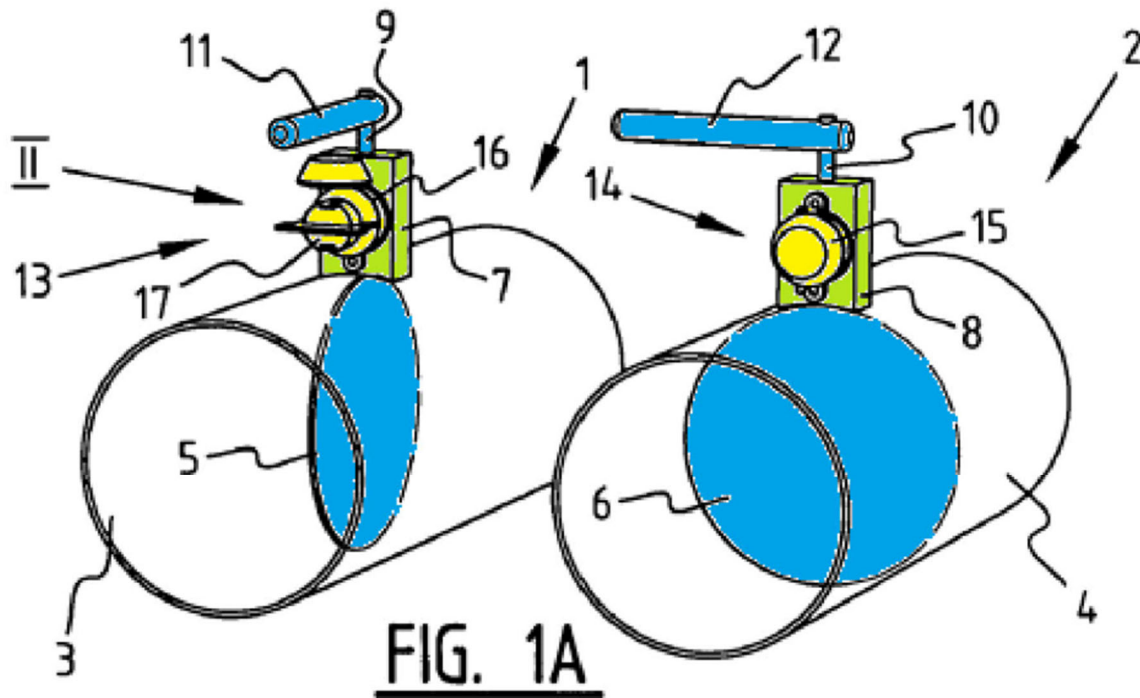
Petitioner proposes the correct construction of the term “selector switch” with respect to Claim 1 is “a movable component whose positioning enables subsequent user selection of only one fuel source.” Pet., 25-26.⁷

The Petition does not correctly apply its own construction of “selector switch” when alleging that DuroMax in view of De Vries discloses or otherwise renders the claimed “selector switch” obvious. Rather, Petitioner alleges that “De Vries teaches a selector switch comprising safety systems 13 and 14 and key 17.” *Id.*, 53. Without

⁶ The Petition does not appear to explicitly enumerate which components allegedly constitute the alleged “LPG intake” of DuroMax, but points generally to the portion of the generator highlighted in red, above. Pet., 7 (citing EX1006, 12).

⁷ Patent Owner does not concede Petitioner’s proposed construction is correct and reserves the right to address the substance of Petitioner’s arguments regarding claim construction if this Petition is instituted.

conceding their accuracy, Petitioner's annotations of De Vries' Fig. 1A are reproduced below:



Pet., 11 (citing EX1011, Fig. 1A) (annotations in original).

The Petition is deficient at least because the combination of “safety systems 13 and 14 and key 17” does not form the claimed “selector switch.” First, Petitioner’s proposed construction of selector switch contemplates a single selector switch. For example, Petitioner’s *entire basis* for arguing “selector switch” should be construed differently in Claim 1 and Claim 11 is that (1) “[t]he specification discloses a single ‘selector switch 30.’” Pet., 30. Petitioner, however, identifies the combination of safety systems 13 and 14 and key 17, which collectively constitute a system of

multiple, separate components, including *two* separate key/lock mechanisms, which directly contradicts its claim construction.

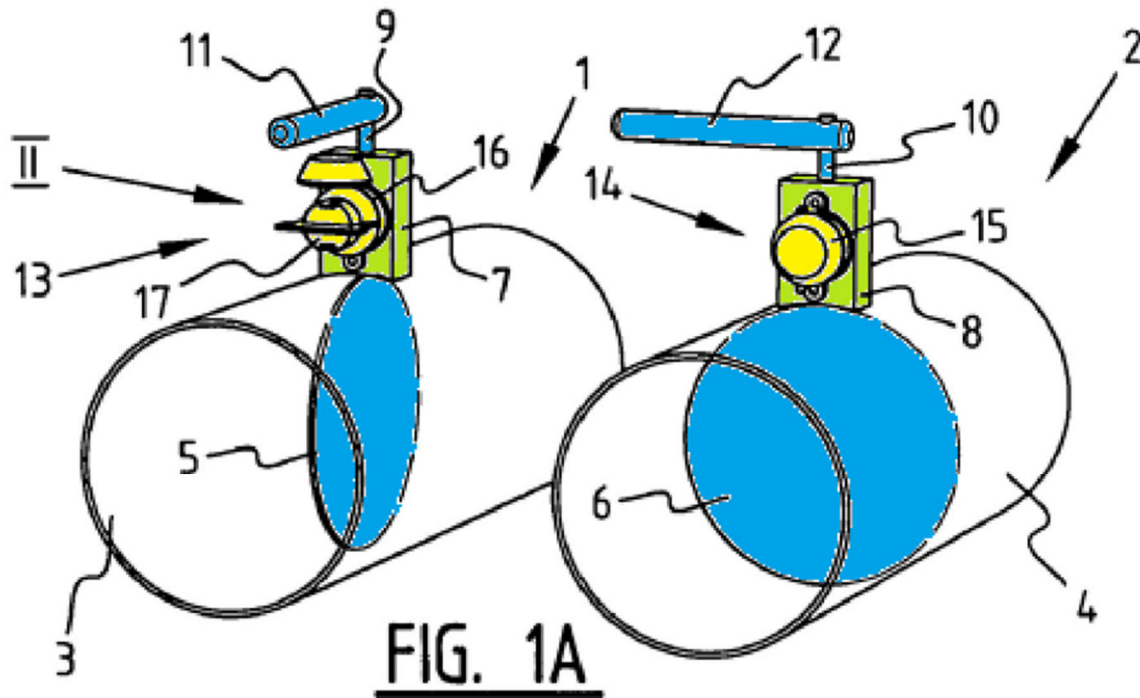
Second, “safety systems 13 and 14 and key 17” are not a “switch.” De Vries teaches that “[o]n support 7 there is provided a first safety system 13 with which the valve can be fixed in a determined position” and “a support 8 on which a second safety system 14 is arranged.” EX1011 5:33-38. Key 17 is required to operate safety systems 13 and 14. EX1011, 5:43-53. De Vries teaches two separate key/lock mechanisms: (1) the combination of safety system 13 and key 17, and (2) the combination of safety system 14 and key 17. Under Petitioner’s theory that a key/lock mechanism constitutes a switch,⁸ De Vries discloses two separate switches, which separately enable subsequent user actuation of valve 5 and valve 6. Simply put, two separate key/lock mechanisms are not a “selector switch.” Institution should be denied.

⁸ To be clear, Patent Owner does not concede that a key/lock mechanism constitutes a “switch” under the plain and ordinary meaning of the term and reserves the right to address this issue further if the Petition is instituted.

2. DuroMax in view of De Vries does not disclose or otherwise render obvious the claimed “valve assembly” (Cl. 11).

Independent Claim 11 of the '390 Patent recites: “a valve assembly” and “an interlock positioned on or adjacent the valve assembly.” EX1001, Cl. 11. Petitioner explicitly argues that “‘valve assembly’ is properly construed as ‘having at least one fuel valve and corresponding valve handle’ and ‘being a *separate structure* from the ... ‘interlock.’” Pet., 32-37 (emphasis added). Petitioner’s proposed combination, however, does not disclose a valve assembly that is *separate from* the alleged interlock.

Petitioner argues that “DeVries teaches a valve assembly comprising at least two butterfly valves 5 and 6, rotation shafts 9 and 10, and ... valve handles 11 and 12.” Pet., 44. Petitioner also argues that “DeVries teaches an interlock comprising safety systems 13 and 14 and key 17.” *Id.*, 45. Again, without conceding their accuracy, Petitioner’s annotations of De Vries’ Fig. 1A are reproduced below:



Pet., 11 (citing EX1011, Fig. 1A) (annotations in original).

Simply put, Petitioner has not met its burden to prove that the “valve assembly” and “interlock” allegedly disclosed by De Vries are *separate structures*, as required by Petitioner’s own construction. In fact, the Petition does not even allege separate structures. Pet., 44-46 (addressing Elements 11.1 and 11.2). And, the mere fact that Petitioner’s annotations identify the structures in different colors is not evidence that they are “separate.” Moreover, DeVries explicitly teaches that “safety system 13, 14 is *integrated with* a valve mechanism.” EX1011, 6:5-6 (emphasis added). As such, the alleged “valve assembly” which Petitioner contends includes “at least one fuel valve and corresponding valve handle” is not a “separate structure”

from the interlock as required by Petitioner's proposed construction. Pet., 32-37. Institution should be denied.

B. The Fujisawa-based grounds (Grounds 3-5) do not demonstrate a reasonable likelihood that any claims are unpatentable.

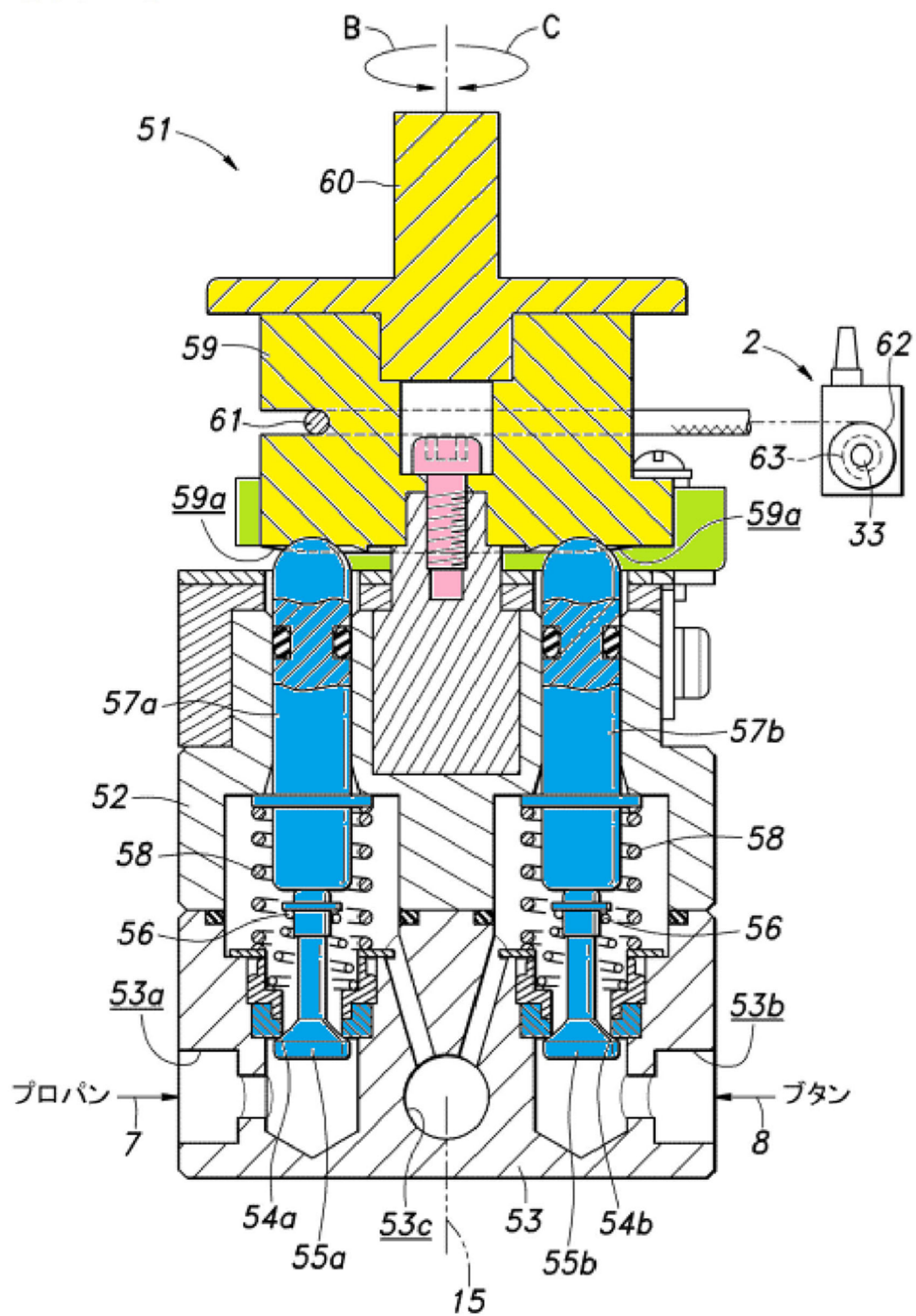
Petitioner's Fujisawa-based grounds are deficient in two respects. First, Petitioner's reliance on "apparent" constructions (Ground 5, Cl. 1) is legally improper and should be rejected outright. §IV.B, *supra*. Second, as explained below, the Challenged Claims are not anticipated or otherwise rendered obvious under Petitioner's proposed construction of valve assembly (Grounds 3-5, Cl. 11).

Claim 11 recites, *inter alia*, a "valve assembly." Petitioner's proposed construction of valve assembly requires that the assembly includes (1) a fuel valve, (2) a corresponding valve handle, and (3) a separate selector switch or interlock. Pet., 32-33. Similarly, with respect to Claim 11 Petitioner argues "the claimed first and second selector switches ... are the valve handles." Pet., 29-32. Fujisawa, however, does not disclose a "valve handle."

Petitioner asserts that "[t]he valve assembly is further comprised of 'selector switch' cam followers 57a and 57b (blue) which control the movement of the valve bodies 55a and 55b between open and closed positions as the valve bodies 55a and 55b are moved up and down." Pet., 62. Similarly, in related proceedings Petitioner argued that "[u]nder the proper construction of 'valve assembly,' cam followers 57a

and 57b are valve handles that control the opening and closing of the valves.” IPR2025-01228, Paper 4, 60; *see also id.*, 65 (“[u]nder the proper construction, which requires the components of the ‘valve assembly’ to be separate and distinct from the ‘selector switch,’ Fujisawa describes valve handles 57a and 57b.”). Petitioner’s annotations of Fujisawa’s Figure 5 are reproduced below, without conceding their accuracy.

【图 5】



Pet., 63 (citing EX1004, Fig. 5) (annotations in original).

Cam follower rods 57a and 57b are components of a fuel switching cock 51 positioned within a casing body having upper and lower casings 52, 53. EX1005, ¶[0031], Fig. 5. Simply put, cam followers 57a and 57b *are not valve handles*. Petitioner concedes that “[t]he cam followers 57a and 57b [Petitioner’s alleged valve handles under Petitioner’s proposed construction] are moved up and down by an undulating lower cam surface 59a of cam body 59 (yellow) which is rotated over the cam followers 57a and 57b by rotary knob 60.” Pet., 62. In effect, the alleged “valve handles” are *pressed* by lower cam surface 59a of cam body 59. Institution should be denied.

VII. CONCLUSION

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

Dated: December 11, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. § 42.6(e), the undersigned certifies that on December 11, 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 6,766 words according to Microsoft Word's word count feature.

Dated: December 11, 2025

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