

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

CHAMPION POWER EQUIPMENT, INC.,
Patent Owner.

IPR2025-01457
Patent 11,143,145

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

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GLOSSARY

Abbreviation	Term
2015 Family	U.S. Patent Nos.: 10,393,034; 11,143,120; 10,221,780; 11,492,985; 10,697,398; 11,530,654; 11,840,970; 11,905,895; and 11,143,145 (collectively)
'145 Patent	U.S. Patent No. 11,143,145
Board	Patent Trial and Appeal Board
Challenged Claims	Claims 1-16 of the '145 Patent
Firman	Firman Power Equipment, Inc.
Generac	Generac Power Systems, Inc.
Harbor Freight or HFT	Harbor Freight Tools USA, Inc.
MWE	MWE Investments, LLC
Patent Owner	Champion Power Equipment, Inc.
Petition	Petition for Inter Partes Review of U.S. Patent No. 11,143,145 (Paper 4)
Petitioner	HFT, Generac, and MWE, collectively
POSITA	Person of Ordinary Skill in the Art
USPTO	United States Patent & Trademark Office

Pursuant to 37 C.F.R. § 42.107, Patent Owner Champion Power Equipment, Inc. hereby submits its Preliminary Response to the Petition filed by MWE Investments, LLC , Harbor Freight Tools USA, Inc., and Generac Power Systems, Inc. (collectively, “Petitioner”), challenging Claims 1-16 of U.S. Patent No. 11,143,145.

I. INTRODUCTION

Petitioner’s proposed grounds are identified below:

Ground	Claims	Basis	Primary Reference	Secondary Reference(s)
1	1-7, 10	103	Workshop Manual	-
2	8-9	103	Workshop Manual	Matsushima, Olmr
3	1-10	103	Nakafushi	Matsushima, Olmr
4	1-10	103	Holzapfel	Matsushima, Olmr
5	11-16	103	Workshop Manual	Matsushima, Winberg
6	11-16	103	Nakafushi	Matsushima, Winberg
7	11, 13, 14	103	Holzapfel	
8	12, 15, 16	103	Holzapfel	Matsushima, Winberg

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

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*

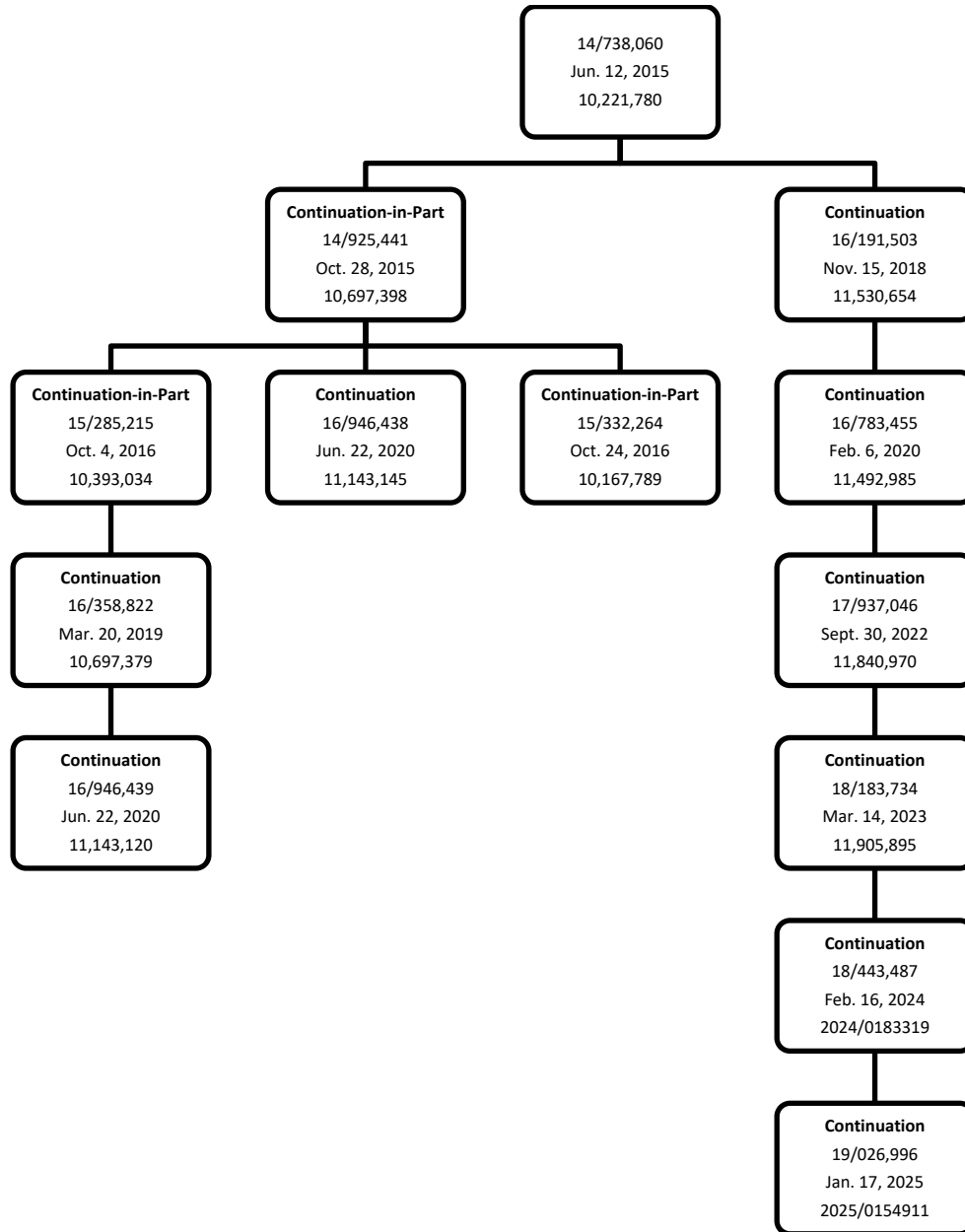
Patent Owner's Brief in Support of its Request for Discretionary Denial of Institution
(Paper 10).

Moreover, denial is appropriate because of inconsistencies between Petitioner's claim construction positions before the Board and in multiple district court proceedings. For example, the Petition improperly relies on the plain and ordinary meaning of terms, which Petitioner construed differently in parallel district court litigation, and Petitioner's district court indefiniteness arguments inherently contradict the Petition. Moreover, the Petition is deficient on the merits, at least because (1) the preambles to Claims 1 and Claim 11 are limiting, (2) none of the identified prior art discloses a dual fuel generator, and (3) Petitioner's implied obviousness arguments are deficient. Each argument is discussed in turn below and presents an independent basis for denial.

II. OVERVIEW OF THE '145 PATENT

The '145 Patent was filed as U.S. Patent Application No. 16/946,438 on June 22, 2020. EX1001, (21), (22). The '145 Patent is one of thirteen members of a patent family directed to multi-fuel engine technology, which are collectively referred to as the "2015 Family." The 2015 Family is depicted below:

GmbH, IPR2019-01469, Paper 6 (P.T.A.B. Feb. 13, 2020) (precedential).



A. The Specification of the '145 Patent

The '145 Patent, titled “Batteryless Dual Fuel Engine with Liquid Fuel Cut-Off,” is directed to a liquid fuel cut-off attached to a carburetor to interrupt liquid fuel upon actuation of the switch from liquid fuel to gaseous fuel. *Id.*, Abstract. The '145 Patent explains that:

In order to provide the liquid and gaseous fuel to the engine, the dual fuel engine may have a first fuel line for liquid fuel and a second fuel line for gaseous fuel. A liquid fuel source and a gaseous fuel source may be coupled to the respective lines to provide fuel to the engine. However, a common problem with such configurations that couple two fuel sources to a single engine is the engine can experience overly rich air-fuel ratio when both fuels are simultaneously engaged during cross-over switching between the fuel sources. Such simultaneous delivery of fuel from the first fuel line and the second fuel line may make the engine hard to start or lead to unstable operating conditions. Further, a float bowl in the carburetor that must first fill or empty prior to changeover causes delay in cross-over switching between the fuel sources.

Therefore, it would be desirable to design a dual fuel generator having a liquid fuel and gaseous fuel delivery system that overcomes the aforementioned detriments without substantially increasing the overall cost of the system.

Id., 1:56-2:7.

B. The Independent Claims of the '145 Patent

Claims 1 and 11 are reproduced below:

1. Claim 1.

1. A dual fuel generator comprising:

- an engine operable on a gaseous fuel and a liquid fuel;
- an electrical power generator driven by the engine and comprising a charging coil;

a switch to change operation of the engine between gaseous fuel and liquid fuel;

a carburetor attached to an intake of the engine to mix air and fuel and connect to a gaseous fuel source and a liquid fuel source;

a liquid fuel cut-off solenoid to interrupt liquid fuel flow to the engine upon actuation of the switch from liquid fuel to gaseous fuel; and

a voltage regulator coupled to the charging coil to receive power therefrom and that operates to provide a regulated voltage to the liquid fuel cut-off solenoid.

2. Claim 11.

11. A dual fuel generator comprising:

an engine operable on a gaseous fuel and a liquid fuel;

a carburetor attached to an intake of the engine to mix air and fuel and connect to a gaseous fuel source and a liquid fuel source; and

a manually actuated fuel shutoff coupled to the carburetor, the manually actuated fuel shutoff comprising:

a first end in the carburetor that actuates to selectively allow or block a flow of fuel through the carburetor; and

and a second end external to the carburetor to actuate the first end.

III. LEVEL OF ORDINARY SKILL IN THE ART

A POSITA pertinent to the Challenged Claims would have a four-year degree in mechanical engineering or a closely related field and at least one year of experience designing, developing, servicing, or operating fuel-powered machinery.

Additional education could substitute for professional experience and significant work experience—such as working with, servicing, or operating such machinery in the field—could substitute for formal education.

Petitioner alleged that a POSITA:

[W]ould have at least a Bachelor of Science degree in mechanical engineering, physics, or related fields, and three years of work experience in combustion engines. Additional higher graduate education could substitute for work experience, and extensive experience/technical training could substitute for formal education.

Petition, 16 (citing EX. 1003, [0028]). Petitioner’s proposed definition is deficient. Specifically, Petitioner has failed to support its contention that an undergraduate physics degree is pertinent to the Challenged Claims, or that three years of work experience in combustion engines is necessary. Regardless, the arguments advanced herein are not impacted based on which definition is applied.

IV. CLAIM CONSTRUCTION

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

Cir. 1999)). Unless otherwise noted, 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, contends that it “has not identified any claim terms that need construction in order to address the issues raised by this petition.” Pet., 16-17. As such, Petitioner alleges that it applies the “plain and ordinary meaning as understood by a person of ordinary skill in the art and the prosecution history.” *Id.*

However, despite asserting that the plain and ordinary meaning applies here, Harbor Freight proposed and argued for narrow constructions of the term “switch ... to change operation of the engine between gaseous fuel and liquid fuel” in co-pending district court litigation. Specifically, Harbor Freight argued that the term should be construed as “a device for making, breaking, or changing the connections in an electrical circuit that causes a change in operation.” EX2110, 21-22. In supplemental briefing, Harbor Freight modified its proposed construction, as follows:

a device for making, breaking, or changing the connections in an electrical circuit that controls mechanical movement and causes a change in operation of the engine between gaseous and liquid fuel.

EX2124, 5. Harbor Freight asserted that the '145 Patent “clearly requires an electrical switch, not a purely mechanical one.” *Id.*

Generac, meanwhile, argues in its parallel litigation that the same “switch” term construed by Harbor Freight is actually indefinite, due to “the specification’s attempt to define ‘switch’ to include an electro-mechanical switch.” EX2113, 54.²

V. ARGUMENT

The USPTO’s institution process considers both “the merits, [and] other non-discretionary considerations” and is designed “[t]o improve efficiency, consistency, and adherence to the statutory requirements for institution.” *See, e.g.*, October 17, 2025 Memorandum from J. Squires at 1-2. Here, not only does the Petition engage in rampant gamesmanship, but it is also deficient on the merits.

First, denial is appropriate under *Revvo Techs.* and *Tesla* because Petitioner has advanced contradictory and inconsistent claim construction positions among and between the Harbor Freight, Generac, and instant IPR proceedings. Second, the Petition is deficient on the merits, at least because (1) the preambles to Claims 1 and Claim 11 are limiting, (2) none of the identified prior art discloses a dual fuel

² Generac’s supplemental preliminary invalidity contentions refer to the term “switch” as recited in Claims 1 and 57 of the ’398 Patent, and Claim 1 of the “’345 Patent.” EX2113, 54. There is no “’345 Patent” at issue in the dispute between Patent Owner and Generac. Presumably, Generac intended to refer to the instant ’145 Patent that is a continuation of the ’398 Patent. *Id.*

generator, and (3) Petitioner's implied obviousness arguments are deficient. Each deficiency independently supports denial and is addressed below.³

A. Petitioner's inconsistent claim construction positions support denial.

Despite arguing for construction of the term “switch ... to change operation of the engine between gaseous fuel and liquid fuel” in the Harbor Freight district court proceeding, and asserting that the same term is indefinite in the Generac proceeding, Petitioner applies the plain and ordinary meaning of the term here. Notably, Petitioner does not provide *any basis* for its inconsistent positions.

On November 3, 2025, the Director's Order in *Revvo Techs., Inc., v. Cerebrum Sensor Techs., Inc.*, was designated precedential. IPR2025-00632, Paper 20 (P.T.A.B. November 3, 2025) (precedential). There, the Director explicitly stated that “[t]he Board's claim construction rules are designed to ensure that the Board correctly construes claim terms and to minimize inconsistency in claim construction between forums. To that end, the rules *discourage petitioners from seeking broader*

³ Notably, Patent Owner's arguments regarding (1) Petitioner's inconsistent indefiniteness positions, and (2) the merits, do not reference the Harbor Freight or MWE district court proceedings *at all*, and thus are not impacted by any developments in those proceedings.

constructions at the Board to support a patentability challenge while seeking narrower constructions in litigation to avoid infringement liability.” *Id.* at 4 (citing Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340 at 51,349-51,350 (Oct. 11, 2018)) (emphasis added). Nevertheless, that is precisely Petitioner’s approach here.

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

1. Harbor Freight’s district court constructions directly contradict the Petition.

Petitioner’s gamesmanship here is particularly egregious in light of the construction in question. In related district court proceedings, Harbor Freight proposed and argued for a narrow construction of the term “switch ... to change operation of the engine between gaseous fuel and liquid fuel.” Specifically, Harbor Freight argued that the term should be construed as:

a device for making, breaking, or changing the connections in an electrical circuit that controls mechanical movement and causes a change in operation of the engine between gaseous and liquid fuel.

EX2124, 5. Harbor Freight asserted that the '145 Patent “clearly requires an electrical switch, not a purely mechanical one.” *Id.*

Conversely, the Petition alleges that a mechanical structure is the claimed “switch.” *See e.g.,* Pet., 80-81 (alleging that Holzapfel’s “rod or wire 47 simultaneously controls valves 14 and 39 by control of operating levers 45 and 46.”). But, “rod or wire 47” is not an electrical switch, as would be required by Petitioner’s proposed district court construction. Rather, Holzapfel merely discloses a mechanical structure that can be used to actuate two valves simultaneously. EX1008, 2:100-107 (“operating levers 45 and 46 for the valves 14 and 39, respectively, are connected to a rod or wire 47 which extends to a point of convenient access to the operator of the vehicle such as, for example, the dashboard 48 so that the rod or wire 47 may be manipulated to simultaneously control both valves 14 and 39.”); *see also id.*, 2:108-123 (“Operating the rod or wire 47 will reverse the valves 14 and 39 so that the gaseous fuel supply is cut off and the liquid fuel supply connected to feed the carburetor.”).

Simply put, the Petition ostensibly relies on the plain and ordinary meaning of the claimed “switch” to hand-wave over additional requirements Petitioner

proposed in district court; namely, that the switch is *electrical* in nature. Petitioner's gamesmanship attempts to mask substantial deficiencies in the prior art.

2. Generac's inconsistent indefiniteness arguments support denial.

Despite advancing different constructions of the term "switch ... to change operation of the engine between gaseous fuel and liquid fuel" in the parallel Harbor Freight litigation and before the Board (§V.A.1, *supra*), Petitioner also argues in the Generac litigation that the same "switch" term is actually indefinite, due to "the specification's attempt to define 'switch' to include an electro-mechanical switch." EX2113, 54. It is unclear how the same term can be (1) limited to electrical switches, as alleged in the Harbor Freight litigation, (2) broad enough to also encompass mechanical switches, as alleged before the Board, and (3) indefinite for failing to inform the scope of the "electro-mechanical switch" as alleged in the Generac litigation. Notably, Petitioner does not provide *any basis* for its inconsistent positions.

The Director's informative Order in *Tesla, Inc. v. Intell. Ventures II LLC* held that "when a petitioner advances different positions before the Board and a district court, that petitioner is *required* to explain why those different positions are warranted." IPR2025-00340, Paper 18 at 3 (P.T.A.B. November 5, 2025) (citing *Cambridge Mobile*, IPR2024-00952, Paper 12 at 8-9 (P.T.A.B. December 13, 2024);

Revvo Techs., IPR2025-00632, Paper 20 at 3-5) (emphasis in original). In *Tesla*, the petitioner had “argued indefiniteness in the district court and then adopted Patent Owner’s plain and ordinary meaning construction from the district court litigation in its Petition.” *Id.* at 4. Specifically, the Director explained that “[a]llowing a petitioner to advance a claim construction before the Board when that petitioner has made inconsistent indefiniteness arguments in district court fails to further, but instead detracts from, the Office’s goal of ‘providing greater predictability and certainty in the patent system.’” *Id.* (citing *Revvo Techs.*, IPR2025-00632, Paper 20 at 3–5).

However, the Petition does not address Petitioner’s inconsistent indefiniteness arguments (which contradict both Harbor Freight’s litigation construction, and Petitioner’s application of the plain and ordinary meaning before the Board). Pet., 16-17. Specifically, Petitioner failed to explain how the disputed term 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.

Allowing the instant Petition to proceed highlights the very policy issues *Revvo Techs.* and *Tesla* were designed to prevent. Petitioner has raised three contradictory theories regarding the scope of the claimed switch among and between

the Harbor Freight and Generac district court litigations, and the instant IPR proceedings. If instituted, Patent Owner will be forced to defend against invalidity challenges relying on constructions directly counter to those advanced in two different parallel proceedings.⁴ There can be no reasonable explanation (other than rampant gamesmanship) for Petitioner's inconsistent arguments. Thus, like in *Revvo Techs.*, Petitioner's reliance on inconsistent claim construction positions "[sh]ould mean a denial of institution." *Revvo Techs.*, Paper 20 at 5.

B. The Petition does not establish that there is a reasonable likelihood that the Petitioner would prevail with respect to any Challenged Claims.

The Petition does not demonstrate a reasonable likelihood that at least one Challenged Claim is unpatentable.

⁴ Harbor Freight's withdrawal should have no impact on these arguments. Harbor Freight and Generac intentionally asserted contradictory claim construction positions both in their respective parallel litigations and before the Board. Presumably, this was done with the understanding that if *any* of the contradictory arguments were successful, the '145 Patent would be held invalid, benefiting Harbor Freight, Generac, and MWE. Allowing the instant IPR to proceed merely because Harbor Freight was able to successfully leverage a settlement prior to institution only serves to reward Petitioner's gamesmanship.

Claims 1 and 11 of the '145 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 1 is obvious over the Workshop Manual. Pet., 10.
- **Ground 3** alleges that Independent Claim 1 is obvious over a combination of prior art based on Nakafushi. *Id.*
- **Ground 4** alleges that Independent Claim 1 is obvious over a combination of prior art based on Holzapfel. *Id.*
- **Ground 5** alleges that Independent Claim 11 is obvious over a combination of prior art based on the Workshop Manual. *Id.*
- **Ground 6** alleges that Independent Claim 11 is obvious over a combination of prior art based on Nakafushi. *Id.*
- **Ground 7** alleges that Independent Claim 11 is obvious over Holzapfel. *Id.*
- **Grounds 2 and 8** relate solely to dependent claims. *Id.*

Denial is proper because Petitioner does not demonstrate a reasonable likelihood that any claims are unpatentable. Specifically, both Independent Claims recite: “A dual fuel generator comprising...” The Petition is deficient at least because (1) the preambles to Claims 1 and Claim 11 are limiting, (2) none of the identified prior art discloses a dual fuel generator, and (3) Petitioner’s implied obviousness arguments are deficient.

1. The preambles of Claim 1 and Claim 11 are limiting.

As an initial matter, the preambles of Claim 1 and Claim 11 (each of which recites “A dual fuel generator comprising:”) are limiting. It is long settled that “terms appearing in a preamble may be deemed limitations of a claim when they ‘give meaning to the claim and properly define the invention.’” *In re Paulsen*, 30 F.3d 1475, 1479 (Fed. Cir. 1994); *see also Gerber Garment Tech., Inc. v. Lectra Sys., Inc.*, 916 F.2d 683, 688, 16 USPQ2d 1436, 1441 (Fed. Cir. 1990) (quoting *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 896, 221 USPQ 669, 675 (Fed. Cir. 1984), cert. denied, 469 U.S. 857, 83 L. Ed. 2d 120, 105 S. Ct. 187 (1984)).

“Although no ‘litmus test’ exists as to what effect should be accorded to words contained in a preamble, review of a patent in its entirety should be made to determine whether the inventors intended such language to represent an additional structural limitation or mere introductory language.” *Paulsen*, 30 F.3d at 1479 (“review of the ’456 patent as a whole reveals that the term ‘computer’ is one that

‘breathes life and meaning into the claims and, hence, is a necessary limitation to them’” even where “the term ‘computer’ is found only in the preamble of the claims at issue”); *see also Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989) (“the ‘915 specification makes clear that the inventors were working on the particular problem of an effective optical communication system not on general improvements in conventional optical fibers. To read the claim in light of the specification indiscriminately to cover all types of optical fibers would be divorced from reality. The invention is restricted to those fibers that work as waveguides as defined in the specification, which is not true with respect to fibers constructed with the limitations of paragraphs (a) and (b) only. Thus, we conclude that the claim preamble in this instance does not merely state a purpose or intended use for the claimed structure.”)

Here, the very first substantive sentence of the ’145 Patent emphasizes that “Embodiments of the invention relate generally to *dual fuel generators*, and more particularly, to an apparatus and method for delivering liquid fuel or gaseous fuel to a *dual fuel generator*.” EX1001, 1:17-20 (emphasis added). In fact, the ’145 Patent provides additional guidance regarding the structure of the claimed generator: “Dual fuel generator 30 includes a dual fuel internal combustion engine 34 within housing 36 at one end 38, operatively connected to an alternator 40 also enclosed in housing 36 at another end 42 by conventional means.” EX1001, 4:5-9. Thus, like the

computer in *Paulsen* and the waveguides in *Corning Glass*, a POSITA would have understood the inventors of the '145 Patent were working on the particular problem of improved *generators*, not on general improvements in conventional engines. The term “dual fuel generator” in the preambles of Claims 1 and 11 connotes structural limitations above and beyond those specified in the body of the claims.

Moreover, “the preamble constitutes a limitation when the claim(s) depend on it for antecedent basis.” *In re Fought*, 941 F.3d 1175, 1178 (Fed. Cir. 2019) (citing *C.W. Zumbiel Co., Inc. v. Kappos*, 702 F.3d 1371, 1385 (Fed. Cir. 2012); *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002)); *see also Bell Commc’ns Rsch., Inc. v. Vitalink Commc’ns Corp.*, 55 F.3d 615, 620-21 (Fed. Cir. 1995); *Electro Sci. Indus., Inc. v. Dynamic Details, Inc.*, 307 F.3d 1343, 1348 (Fed. Cir. 2002); *Pacing Techs., LLC v. Garmin Int’l, Inc.*, 778 F.3d 1021, 1024 (Fed. Cir. 2015). For example, the preamble of Claim 1 provides antecedent basis support for the term “dual fuel generator” in Claim 9. *See, e.g.*, EX1001, Cl. 14 (“wherein the dual fuel generator is a batteryless dual fuel generator”).

2. The prior art relied on by Petitioner does not disclose a dual fuel generator.

As detailed in the below table, Petitioner separately cites to each of the Workshop Manual, Nakafushi, Matsushima, and Holzapfel references as allegedly

disclosing Elements 1.0 and 11.0 (“A dual fuel generator comprising”). However, *none* of the listed references actually disclose the claimed “dual fuel generator.”

<u>Element 1.0:</u> A dual fuel generator comprising:	• <u>Ground 1:</u> Workshop Manual. Pet., 30 • <u>Ground 3:</u> Nakafushi, Matsushima. Pet., 56. • <u>Ground 4:</u> Holzapfel, Matsushima. Pet., 79.
<u>Element 11.0:</u> A dual fuel generator comprising:	• <u>Ground 5:</u> Workshop Manual. Pet., 98. • <u>Ground 6:</u> Nakafushi, Matsushima. Pet., 113. • <u>Ground 7:</u> Holzapfel. Pet., 116.

Petitioner appears to concede this point, because in each instance, Petitioner merely asserts that each reference discloses a dual fuel engine; *not* the claimed dual fuel generator:

- “Workshop Manual teaches a dual fuel engine.” Pet., 30.
- “Nakafushi and Matsushima disclose a dual fuel engines [sic].” Pet., 56.
- “Holzapfel and Matsushima discloses [sic] a dual fuel engines [sic].” Pet., 79.
- “Workshop Manual teaches a dual fuel engine.” Pet., 98.
- “Nakafushi and Matsushima disclose a dual fuel engines [sic].” Pet., 113.
- “Holzapfel teaches a dual fuel engine.” Pet., 116.

After implicitly conceding that each of the cited references *do not* disclose the claimed dual fuel generator, Petitioner nevertheless argues that the Challenged Claims are obvious because “dual fuel generators were well known as of the earliest priority date of the ’145 Patent.” Pet., 30 (citing EX1016; EX1003, [0088]); *see also id.*, 56, 79, 98, 113, 116. As explained in additional detail, below, Petitioner’s conclusory and unsupported obviousness allegations are insufficient. Institution should be denied.

3. Petitioner’s obviousness arguments are deficient.

As stated above, Petitioner’s obviousness “analysis” is based on a single conclusory sentence alleging it would have been obvious to implement each of the prior art engines in a generator because “dual fuel generators were well known as of the earliest priority date of the ’145 Patent.” Pet., 30 (citing EX1016; EX1003, [0088]); *see also id.*, 56, 79, 98, 113, 116.

Petitioner’s purported “analysis” is deficient for several reasons. First, the mere fact that dual fuel generators were allegedly well known says nothing about whether a POSITA would have been motivated to implement the specific prior art engines at issue here in a specific generator. Specifically, neither Petitioner nor its expert provide any analysis regarding how (or why) each specific prior art engine would have been implemented in a generator. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (“[I]t can be important to identify a reason that would have

prompted a [POSITA] to combine the elements in the way the claimed new invention does” and “this analysis should be made explicit.”); *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1373 (Fed. Cir. 2008) (“[K]nowledge of a problem and motivation to solve it are entirely different from motivation to combine *particular references*...”); *Google LLC v. Sonos, Inc.*, No. 2023-1259, 2024 U.S. App. LEXIS 12394, at *5 (Fed. Cir. May 23, 2024) (“generic or conclusory analysis is insufficient when it bears no relation to any specific combination of prior art elements *from specific references* and doesn’t explain why a skilled artisan would have combined them in the way the claimed invention does.”) (cleaned up) (emphasis added). The Petition’s conclusory recitation that dual fuel generators were well known in the art is insufficient to show that a POSITA would have been motivated to make the proposed implementation. *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d1364, 1380 (Fed. Cir. 2016).

Second, Petitioner’s sole support for the statement that “dual fuel generators were well known” is a single generic reference to Exhibit 1016 (the operator’s manual for a single, specific DuroMax generator). Petitioner does not cite any portion of the operator’s manual that allegedly supports its proposition that similar generators were “well known.” And, it is unclear from the Petition whether Petitioner proposed implementing the alleged prior art dual fuel engines in a generic,

hypothetical “dual fuel generator,” or specifically combining each engine with the DuroMax XP4400EH generator described EX1016.

If Petitioner intends the latter, the Petition is utterly devoid of any analysis or explanation indicating how or why a POSITA would have been motivated to replace the engine already present in the DuroMax XP4400EH generator with each of the identified prior art engines, or any analysis indicating that a POSITA would have had a reasonable expectation of success in doing so. If, however, Petitioner merely intends to reference a generic, hypothetical dual fuel generator, the Petition is nothing more than an attempt to side-step the motivation to combine and reasonable expectation of success requirements of an obviousness analysis, and is explicitly precluded by the Director’s July 31, 2025 Memorandum addressing Enforcement and Non-Waiver of 37 C.F.R. § 42.104(b)(4) and Permissible Uses of General Knowledge in Inter Partes Reviews, which held “that applicant admitted prior art (AAPA), expert testimony, common sense, and other evidence that is not ‘prior art consisting of patents or printed publications’ (collectively, ‘general knowledge’) may not be used to supply a missing claim limitation.” 37 C.F.R. § 42.104(b)(4). In either event, institution should be denied.

Third, Petitioner’s obviousness analysis with respect to Elements 1.0 and 11.0 relies on conclusory expert testimony, which should be disregarded. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15 (P.T.A.B. August 24, 2022)

(precedential) (expert testimony that “merely repeats, *verbatim*, the conclusory assertion for which it is offered to support ... is conclusory and unsupported, adds little to the conclusory assertion for which it is offered to support, and is entitled to little weight.”). For comparison, Petitioner’s conclusory assertions regarding Elements 1.0 and 11.0 and the expert testimony purportedly supporting those assertions are reproduced below, with the minor discrepancies emphasized with bold and underlined font:

Ground	Excerpt from Petition	Cited Expert Testimony
1	Pet., 30: Workshop Manual teaches a dual fuel engine. Ex.1009, 65. It would have been obvious to a POSA to have implemented Workshop Manual’s dual fuel engine in a generator, as dual fuel generators were well known as of the earliest priority date of the ‘145 Patent. Ex.1016; <u>Ex.1003, [0088]</u> .	EX1003, [0088]: Workshop Manual teaches a dual fuel engine. Ex.1009, 65. It would have been obvious to a POSA to have implemented Workshop Manual’s dual fuel engine in a generator, as dual fuel generators were well known as of the earliest priority date of the ‘145 Patent. Ex.1016, <u>pp.1-31; Ex.1017, p.1</u> .

Ground	Excerpt from Petition	Cited Expert Testimony
3	Pet., 56: Nakafushi and Matsushima disclose a [sic] dual fuel engines. It would have been obvious to a POSA to have implemented a dual fuel engine in a generator, as dual fuel generators were well known as of the earliest priority date of the ‘145 Patent. Ex.1016; <u>Ex.1003, [0154]</u>.	Ex.1003, [0154]: Nakafushi and Matsushima disclose dual fuel engines. It would have been obvious to a POSA to have implemented a dual fuel engine in a generator, as dual fuel generators were well known as of the earliest priority date of the ‘145 Patent. Ex.1016, <u>pp.1-31; Ex.1017, p.1</u>.
4	Pet., 79: Holzapfel and Matsushima discloses a [sic] dual fuel engines. It would have been obvious to a POSA to have implemented a dual fuel engine in a generator, as dual fuel generators were well known as of the earliest priority date of the ‘145 Patent. Ex.1016; <u>Ex.1003, [0219]</u>.	Ex.1003, [0219]: Holzapfel and Matsushima disclose dual fuel engines. It would have been obvious to a POSA to have implemented a dual fuel engine in a generator, as dual fuel generators were well known as of the earliest priority date of the ‘145 Patent. Ex.1016, <u>pp.1-31; Ex.1017, p.1</u>.
5	Pet., 98: Workshop Manual teaches a dual fuel engine that can be implemented in a generator. §VII.A.1.a, <i>supra</i>.	

Ground	Excerpt from Petition	Cited Expert Testimony
6	Pet., 113: Nakafushi and Matsushima disclose a [sic] dual fuel engines that can be implemented in a generator. §VII.C.2.a, <i>supra</i> .	
7	Pet., 116: Holzapfel teaches a dual fuel engine. EX.1008, 1:1-5. It would have been obvious to a POSA to have implemented Holzapfel's dual fuel engine in a generator, as dual fuel generators were well known as of the earliest priority date of the '145 Patent. Ex.1016; <u>Ex.1003, [0333]</u> .	Ex.1003, [0333]: Holzapfel teaches a dual fuel engine. EX.1008, 1:1-5. It would have been obvious to a POSA to have implemented Holzapfel's dual fuel engine in a generator, as dual fuel generators were well known as of the earliest priority date of the '145 Patent. Ex.1016, <u>pp.1-31; Ex.1017, p.1</u> .

Petitioner's conclusory expert testimony is not sufficient to salvage its deficient obviousness analysis. 37 C.F.R. § 42.104(b)(4). Because the cited prior art does not disclose Elements 1.0 and 11.0 and Petitioner's obviousness analysis is deficient, institution should be denied on the merits.

VI. CONCLUSION

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

Dated: January 9, 2026

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CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. § 42.6(e), the undersigned certifies that on January 9, 2026, 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 5,177 words according to Microsoft Word's word count feature.

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