

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:	J. Carl Cooper	Attorney Docket No. 58936-0002IP1
U.S. Patent No.:	11,967,857	
Issue Date:	April 23, 2024	
Appl. Serial No.:	16/952,007	
Filing Date:	November 18, 2020	
Title:	POWER SOURCE LOAD CONTROL	

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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**PETITIONER'S NOTICE RANKING AND EXPLAINING MATERIAL
DIFFERENCES BETWEEN PETITIONS FOR *INTER PARTES* REVIEW
OF UNITED STATES PATENT NO. 11,967,857**

Under the 2019 Trial Practice Guide Update, multiple petitions for a single challenged patent merit the Board’s consideration where the invalidity challenge’s complexity—substantively and practically—makes district court challenges or use of a single petition impracticable. Here, Petitioner Generac Power Systems, Inc. files three petitions challenging all seventy-one claims of U.S. Patent No. 11,967,857. Even with three petitions, the claims’ subject-matter complexity (requiring an understanding of AC power, frequency, and load effects on generators) and verbosity (comprising 6,229 words in total) limited Generac to a single primary ground in each petition. Because the claims’ subject matter is complex for a jury to understand, because a jury trial on invalidity is unlikely to determine validity of all claims, and because all claims cannot be challenged in less than three petitions (even with claims tables)—all three petitions should be considered.

I. RANKING OF PETITIONS

As discussed *infra*, Parts II–III, all three petitions are merited and justified.

Regardless, Petitioner below provides the requirement for ranking:

<u>Rank</u>	<u>Petition</u>	<u>Asserted Obviousness Grounds</u>
1	IPR2026-00022 (“Petition 1”)	• 1-16; 39-44; 61-65
2	IPR2026-00023 (“Petition 2”)	• 17-38
3	IPR2026-00024 (“Petition 3”)	• 45-60; 66-71

II. EXPLANATION OF THE MATERIAL DIFFERENCES

The ’857 patent concerns power source load management. EX1001, Abstract.

It concerns the control of AC frequency to manage power source loading and avoiding overloads. *Id.* While all claims include frequency control, other elements present only in select independent claim subsets around which each petition is organized:

<u>Rank</u>	<u>Independent Claim Subset</u>
1	Concerns proactive approaches to prevent power source overload prevention and includes all dependent claims involving rechargeable batteries.
2	Concerns frequency control when power sources are already overloaded and includes most dependent claims that require measuring “known” parameters (except for 49 and 50 in Petition 3)
3	Concerns parallel power source-grid configurations.

The differences among the three petitions are material because each addresses a distinct technical subset of the independent claims, and each have unique dependent claims. Although all three petitions rely on the same base references (Lasseter, EX1005, and Lopes, EX1011), the arguments in each petition differ.

For example, Petition 1 concerns proactive overload-prevention. Petition 1 also addresses dependent claims involving rechargeable batteries, and thus includes a ground with Miller (EX1026) to address battery-management features not found in the base Lasseter-Lopes combination. Petition 2, by contrast, addresses responding following an overload. Some of Petition 2’s independent and dependent claims also address certain “known” operating parameters on which the frequency control is premised. These distinguishing characteristics call for analyses that differ in kind, despite using the same base ground.

Petition 3 is yet different. Petition 3 addresses configurations in which microsources operate synchronized and in parallel with the power grid, raising different coordination and switching issues absent from the claims of the other two petitions. Petition 3's claims are drafted such that Lasseter-Lopes requires analysis distinct from Petitions 1 and 2 (where this paralleling aspect is absent).

Dividing the petitions along these lines was necessary to address each independent claim group with arguments tailored to its particular limitations and with the particularity required by 35 U.S.C. § 312(a)(3).

III. WHY THE BOARD SHOULD EXERCISE DISCRETION TO INSTITUTE ADDITIONAL PETITIONS.

The Board should institute all three petitions because the circumstances here—a large and complex claim set, uncertain district court claim identifications, and strong efficiency considerations—make multiple petitions necessary and appropriate. The district court has not yet required the patent owner to identify its asserted claims. To date, Patent Owner's Complaint only identifies Claim 1. EX1004, ¶ 58 (Complaint). Given that Generac does not know which of the '857 patent's seventy-one claims will ultimately be asserted, it would be inefficient and prejudicial to limit institution to a subset of claims when Generac faces potential exposure across a broad and undefined claim set.

Indeed, Generac has an interest in resolving the claims' validity. The '857 patent is directed to systems for managing backup and residential power systems—technology directly relevant to Generac's current (and potentially, future) product lines. While Generac need not—and does not—concede any overlap with its products, it has a substantial interest in removing uncertainty created by the breadth of this patent's claims from the technical field in which Generac conducts business.

Even if the patent owner asserts all claims, the district court may not reach a final decision on validity for them. A finding of no liability (from non-infringement, invalidity, or both) on the patent does not remove the patent from the patent landscape that Generac must consider in its future product development. Resolving all claims in *inter partes* review provides clarity that the district court litigation will not.

Moreover, *inter partes* review is the better vehicle to review this patent, for the '857 patent's subject matter is highly technical, involving interactions between AC power generation, frequency control, and load effects on power sources. The patent owner has demanded a jury trial, EX1004, 25, but these subjects (while well-known by POSITA) would challenge a lay jury's finding of facts in the context of invalidity. The Board—with its technical expertise and experience in evaluating complex patents—is far better equipped to assess the control schemes and electrical characteristics that underlie the challenged claims.

Even if invalidity were tried to a lay jury, the jury would not reach the invalidity of all seventy-one claims. Given the number of claims, trying each for invalidity would require numerous trials, and even that scenario assumes the patent owner asserts all claims. As explained above, without a single, final determination of validity, the patent would cloud Generac's future product development—thus, institution of all three petitions is, necessary for complete resolution invalidity.

Finally, because the '857 patent's claims exceed the scope and complexity contemplated by the word limit, 37 C.F.R. § 42.24(a)(1)(i), three petitions are warranted. The word limit is tailored to typical patents containing approximately twenty total claims, having three independent claims. *See* § 1.492(h)-(i) (noting additional fees for claims in excess of three independent claims or twenty total claims). Here, the '857 patent contains nine independent claims and seventy-one claims total. The claim language alone spans 6,229 words. Even employing a claim table, explaining in less than three petitions how the prior art discloses or renders obvious the claims' limitations with the required "particularity" is not feasible. 35 U.S.C. § 312(a)(3). Indeed, though each petition advances a single primary ground, each petition still approaches the applicable word limit. These circumstances support institution on all three petitions as both necessary and justified under the Board's precedent.

For at least these reasons, Petitioner requests that the Board institute trial on all three petitions.

Respectfully submitted,

Dated October 10, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4)(i) et seq. and 42.105(b), the undersigned certifies that on October 10, 2025, a complete and entire copy of this Petitioner's Notice Ranking and Explaining Material Differences Between Petitions for Inter Partes Review of United States Patent No. 11,967,857 was provided by Federal Express, to the Patent Owner, by serving the correspondence address of record as follows:

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