UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENERAC POWER SYSTEMS, INC.,
Petitioner

v.

PSLC LLC,
Patent Owner

Case IPR2026-00022
U.S. Patent No. 11,967,857

PETITIONER'S OPPOSITION TO
PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

TABLE OF CONTENTS

I. INTRODUCTION 1

II. BACKGROUND 2

A. Patent Owner PSLC LLC and Inventor J. Carl Cooper 2

B. The Present Dispute 2

III. INSTITUTION SHOULD NOT BE DISCRETIONARILY DENIED 5

A. Settled Expectations Favor Institution. 5

B. Institution Is Warranted Because the Examiner Erred by Failing to Consider Lasseter. 7

C. *Fintiv*'s Factors Disfavor Discretionary Denial. 10

1. Factor 1: Whether the court granted a stay or whether evidence exists that one may be granted if an IPR is instituted 10

2. Factor 2: Proximity of the court's trial date to the Board's projected statutory deadline for a Final Written Decision 11

3. Factor 3: Investment in the parallel proceeding 12

4. Factor 4: Overlap between issues raised in the petition and in the parallel proceeding 14

5. Factor 5: Whether the petitioner and the defendant in the parallel proceeding are the same party 16

6. Factor 6: Other circumstances that impact the Board's exercise of discretion, including the merits 17

D. Instituting All Three Petitions is Most Efficient for the Board, the Parties, and the Court. 18

IV. CONCLUSION 20

EXHIBITS

EX1001	U.S. Patent No. 11,967,857 to Cooper ("the '857 Patent")
EX1002	Excerpts from the Prosecution History of the '857 Patent
EX1003	Declaration and Curriculum Vitae of Dr. Steven Leeb
EX1004	Complaint, *PSLC LLC v. Generac Power Systems, Inc*., 2:24-cv-01270-SCD filed October 7, 2024
EX1005	U.S. Patent Appl. No. 2006/0208574 ("Lasseter")
EX1006	Rashad M. Kamel & B. Kermanshahi, *Enhancement of Micro-Grid Dynamic Performance Subsequent to Islanding Process Using Storage Batteries*, 34 IRAN. J. SCI. TECH. 605 (Dec. 2010)
EX1007	Alexander Kusko & Marc T. Thompson, POWER QUALITY IN ELECTRICAL SYSTEMS (2007)
EX1008	U.S. Patent No. 8,410,633 ("Batzler")
EX1009	U.S. Patent No. 7,149,605 ("Chassin")
EX1010	Declaration and Curriculum Vitae of June Ann Munford
EX1011	J.A. Peças Lopes et al., *Defining Control Strategies for MicroGrids Islanded Operation*, 21 IEEE TRANSACTIONS POWER SYSTEMS 916 (May 2006)
EX1012	A.G. Madureira & J.A. Peças Lopes, *Coordinated Voltage Support in Distribution Networks with Distributed Generation and Microgrids*, 3 IET RENEWABLE POWER GENERATION 439 (2009)
EX1013	Netra Gyawali & Yasuharu Ohsawa, *Improved Power Sharing Scheme for a Microgrid with Multiple Distributed Generators*, 128 IEEJ TRANSACTIONS ON ELECS., INFO. & SYSTEMS1635 (2008)

EX1014	Rashad M. Kamel, Aymen Chaouachi & Ken Nagasaka, *Effect of Wind Generation System Rating on Transient Dynamic Performance of the Micro-Grid During Islanding Mode*, 1 LOW CARBON ECON. 29 (2010)
EX1015	Robert Lasseter, *Providing Premium Power Through Distributed Resources*, PROCS. 33RD HAWAII INT'L CONF. SYS. SCIS. (2000)
EX1016	R. H. Lasseter, *Smart Distribution: Coupled Microgrids*, 99 PROCS. IEEE 1074 (June 2011)
EX1017	Nosh K. Medora et al., *Impact of Line Voltage Sag on Switch Mode Power Supply Operation*, 2008 3RD IEEE CONFERENCE ON INDUSTRIAL ELECTRONICS AND APPLICATIONS (July 2008)
EX1018	Reserved
EX1019	R.P. Rodrigues & P.M. Silveira, *A Survey of Techniques Applied to Non-stationary Waveforms in Electrical Power Systems*, IEEE PROCEEDINGS OF THE 14TH INTERNATIONAL CONFERENCE ON HARMONICS AND QUALITY OF POWER (Jan. 2010)
EX1020	U.S. Patent Appl. No. 2004/0051387
EX1021	U.S. Patent Publ. No. 2010/0019574 ("Baldassarre")
EX1022	Paul Sherz, PRACTICAL ELECTRONICS FOR INVENTORS (2000)
EX1023	U.S. Patent Publ. No. 2007/0222294 ("Tsukida")
EX1024	U.S. Patent No. 8,204,632
EX1025	U.S. Patent No. 7,356,422
EX1026	U.S. Patent No. 7,274,975 ("Miller")
EX1027	U.S. Patent No. 6,314,378
EX1028	Robert Lasseter et al., *White Paper on Integration of Distributed Energy Resources*, CONSORTIUM FOR ELECTRIC RELIABILITY

	TECHNOLOGY SOLUTIONS (Apr. 2002)
EX1029	Robert Lasseter & Pablo Piagi, *Microgrid: A Conceptual Solution*, PESC' AACHEN, GERMANY (June 25, 2004)
EX1030	STANDARD FOR EMERGENCY AND STANDBY POWER SYSTEMS, NFPA® 110 (2010 ed.)
EX1031	*PSLC LLC*, SEC. STATE WYO., (last visited and verified Jan. 19, 2025)
EX1032	As-filed Application for U.S. Patent No. 11,967,857 (Nov. 18, 2020)
EX1033	Application Data Sheet for U.S. Patent No. 10,879,727 (May 26, 2012)
EX1034	Application Data Sheet for U.S. Patent No. 10,892,618 (July 24, 2017)
EX1035	Application Data Sheet for U.S. Patent No. 11,967,857 (Nov. 18, 2020)
EX1036	Final Rejection of U.S. Patent Application No. 17/388,120 (April 17, 2023).
EX1037	U.S. Patent No. 10,879,727 ("the '727 Patent")
EX1038	*National Judicial Caseload Profile*, United States District Courts (March 31, 2025).
EX1039	Transcript, *PSLC LLC v. Generac Power Systems, Inc*., 2:24-cv-01270-SCD, Dkt. 21, filed Aug. 8, 2025
EX1040	Scheduling Order, *PSLC LLC v. Generac Power Systems, Inc*., 2:24-cv-01270-SCD, Dkt. 30, filed Oct. 17, 2025
EX1041	Motion to Dismiss, *PSLC LLC v. Generac Power Systems, Inc*., 2:24-cv-01270-SCD, Dkt. 9, filed Dec. 2, 2024
EX1042	Protective Order, *PSLC LLC v. Generac Power Systems, Inc*.,

	12:24-cv-01270-SCD, Dkt. 36, filed Dec. 30, 2025
EX1043	*2024 Annual Report*, GENERAC (2024).
EX1044	*Smart Management Modules*, GENERAC (copyright 2020)
EX1045	Generac Power Systems – Clean Energy Solutions, WEB.ARCHIVE.ORG (Aug. 30, 2020).
EX1046	Excerpts from the Prosecution History of the ’857 Patent II
EX1047	U.S. Patent No. 11,108,265
EX1048	U.S. Patent No. 12,119,705

I. INTRODUCTION

Patent Owner's discretionary-denial request is maintained only by extensive omissions of key undermining facts and should be denied. Patent Owner repeatedly asserts that Petitioner was on notice of the '857 Patent since February 2012. Not so. The 2012 communications did not disclose the core element of the '857 patent: affirmative control of the AC frequency. Patent Owner makes no attempt to show otherwise. Patent Owner also omits that it deliberately concealed its patenting efforts from Generac through serial non-publication requests. The first publication describing the claimed subject matter was a patent issued *only in the final days of 2020*. And it did not claim affirmative control of the AC frequency as its invention. Even so, when the inventor purportedly contacted Generac's patent counsel in 2021, he *withheld the existence of the '857 Patent application and its proposed claims*. Patent Owner also cannot claim to have used the '857 Patent.

The omitted facts are fatal Patent Owner's discretionary-denial request. Patent Owner has no settled expectations. The petitions are strong on the merits, seek to correct an examiner's error with prior art overlooked during examination, the *Fintiv* factors do not favor denial, and review at the PTAB is the most efficient path—particularly because the '857 Patent's cancellation would streamline the district-

court case rather than complicate it.[1]

II. BACKGROUND

A. Patent Owner PSLC LLC and Inventor J. Carl Cooper

Founded in July 2024, EX1031 (three months before it sued Petitioner), PSLC was "set up" by the '857 Patent's inventor "to enforce his . . . patent[s]." EX1004, ¶ 9. PSLC, short for "Power Source Load Control," is named after its "sole asset"—a patent portfolio that includes the '857 Patent. *Id.* It is not a practicing entity.

B. The Present Dispute

Patent Owner characterizes Cooper's 2012 letters as beginning a "nearly fourteen-year notice of the inventions of the '857 Patent family." Paper 11, 1. These letters, however, did not provide notice of the '857 Patent's purported invention, nor did they mention patents or any filed patent applications. *See*, EX2001, EX2004. Cooper's letters attached a meager 7-page description that pales in comparison to the 125-page application that later became the '857 Patent. EX1032. Unsurprisingly, this scant description was incomplete, lacking the crux of the '857 Patent. The '857 Patent was allowed because the examiner failed to find "a power source . . . operating to control the frequency of the output AC power to have a first frequency when the power source is not overloaded and a second frequency when the power source is

[1] Because Patent Owner's briefs for each of the three proceedings, IPR2026-00022, -00023 and -00024, mirror the same reasoning and conclusions, so do Generac's.

overloaded." EX2010 (examiner's reasons for allowance). The 2012 letters make no mention of controlling frequency of the output AC power. *See*, EX2001. Thus, they provided no notice of the '857 Patent's claimed invention.

Nor did Cooper's 2021 purported communication provide notice. *See* EX2005. The communication, made after nearly a decade of silence, referred to a stack of patents he characterized as related to "backup power systems, and in particular to using load controls to prevent overloading"—a broad field encompassing over a century of development. EX2005; *see also* US Patent No. 643,133 "Safety device for electric-distribution systems," issued 2/13/1900, US Patent No. 9,54,845 "Overload protective device," issued 4/12/1910, and US Patent No. 1,852,835 "Generator overload stop," issued 4/5/1932. Cooper's 2021 communication was also not notice of the '857 Patent's inventions and made no mention of frequency control. It was a cold call invitation for a fishing expedition in a potentially barren pond.

Notably, the 2021 communication did not implicate the '857 Patent. EX2005. Even though Cooper had filed the '857 Patent's application a year before, he withheld its existence. *Id*. This concealment was typical of Cooper's filings. He kept the applications for the '857 Patent and its predecessors secret for ***nearly a decade*** by non-publication requests. *See, e.g.*, EX1033 at 2 (checking the nonpublication request box in the grandparent application); EX1034 at 2 (same for parent application); EX1035 at 2 (same for '857 Patent's application). Cooper was not practicing his

technology and had no commercial need for such secrecy.

Patent Owner notes that, in 2022, a predecessor of the ’857 Patent was cited in rejection of Generac’s application and argues that this, too, amounts to notice. Patent Owner omits that the claims of the rejected application were directed to an invention for load shedding *in response* to frequency—not the affirmative *control* of frequency claimed in the ’857 Patent. *See* EX2006 at Abstract and Cls. 1, 7, 16 (describing and claiming frequency-reactive load management strategies). The rejection did not relate to, or even mention, the *control* of AC frequency like in the ’857 Patent. *See generally* EX1036. Nor did the rejection indicate that Cooper’s patent claimed to have invented load shedding *in response* to AC frequency. To the contrary, it described that technique as prior art. EX1037, 6:26-50 (describing a prior commercial embodiment). Generac had no reason to dig deeper into Cooper’s cited patent. Patent Owner also fails to mention that Generac’s application overcame the rejection and was patented, as was a subsequent continuation. EX1047, EX1048.

The ’857 Patent’s application (again, filed under a nonpublication request) was allowed in 2024 only after the Examiner identified a single limitation he failed to find in the prior art, EX1002, EX1046 (a limitation Generac easily found in an unconsidered reference, *see* Paper 10). So, the first time anyone could have learned that Cooper claimed a technique related to *control* of AC frequency was upon issuance of the ’857 Patent in April 2024. His claims were public *for only six months*

before Patent Owner filed its Complaint in the underlying lawsuit. EX1004.

III. INSTITUTION SHOULD NOT BE DISCRETIONARILY DENIED

A. Settled Expectations Favor Institution.

Patent Owner cannot plausibly invoke "settled expectations" to justify discretionary denial. ***First***, Generac did not sit on known, actionable claims. To the contrary, Generac lacked both notice of and reason to believe its products implicated the asserted patent family, let alone the '857 Patent's claims. In any event, even as measured from the earliest issued family member, issued in 2020, Generac filed its Petition within the six-year settled expectations timeframe.

Second, Cooper's alleged letters were insufficient to put Generac on notice of the '857 Patent's subject matter. Cooper's 2012 description—a mere fraction of the eventual 125-page patent application—did not disclose the deliberate frequency control to which the '857 Patent's claims are directed. *Compare* EX2001, 3–9 *with* EX1001. So, Patent Owner's contentions that Generac was on notice since 2012 are false. Cooper's 2021 communication—made within the six-year settled expectations timeframe—fares no better. Cooper's listing of a stack of patents, none of which were the '857 Patent, without context suggesting he had claimed or would claim the inventions in the '857 Patent, cannot be notice. Finally, the 2022 rejection based on Cooper's earlier patent—not the '857 Patent—was also within the six-year settled expectations timeframe and directed to a different invention and so is not notice.

Third, Cooper concealed the ’857 Patent’s core disclosure for nearly a decade through serial nonpublication requests, preventing Generac from even theoretically reading the relevant specification (let alone learning it is something he claimed as his invention) until December 2020. EX1037 (Dec. 29, 2020). During that nonpublication period, Generac developed and commercialized products alleged to infringe the ’857 Patent without access to the patent’s specification or claims. EX1044 (copyright 2020); EX1045 (archived Sept. 30, 2020); EX2020, at 3. Moreover, the ’857 Patent did not issue until 2024, after allowance based on an Examiner oversight of a limitation later found in unconsidered prior art. Generac’s first meaningful opportunity to assess and challenge the issued claims arose only in April 2024—approximately six months before the parties’ litigation.

Fourth, even ignoring the foregoing (as does Patent Owner), Generac still filed its Petition well within the Board’s prescribed six-year timeframe. Indeed, Generac filed within six years of the ’857 Patent’s earliest family member—U.S. Pat. No. 10,879,727, EX1037 (Dec. 29, 2020)—which marks the first time the ’857 Patent’s relevant disclosure was publicly available and is squarely within the timeline the Board has recognized as before settled expectations develop.

Fifth, even if Patent Owner could articulate some abstract expectations, it would not be reasonable here. Cooper does not claim to be practicing the patent. Nor is he marking products with the patent, licensing it, or otherwise ordering his affairs

in reliance on its validity during the years of concealment. Any claimed "expectation" rests not on public reliance, but on his private nonpublication and concealment.

In short, there is no inequity in permitting review. Generac acted diligently once the claims were visible, filing its petition less than two years after '857 Patent's issuance and well within the recognized settled-expectations timeframe. Generac should not be penalized for its inability to challenge concealed, non-threatening, and ultimately defective claims earlier.

B. Institution Is Warranted Because the Examiner Erred by Failing to Consider Lasseter.

As discussed in its Search Disclosure Declaration, *see* Paper 10, Generac easily discovered Lasseter, which discloses the core invention of the '857 Patent and was overlooked by the examiner. The examiner erred by having identified another Lasseter patent publication—a reference he felt merited discussion in the reasons for allowance—but failing to look past that one publication to one of the few other similar patent publications by Lasseter, including the one presented by Generac. *Id.*

Patent Owner incorrectly argues that Lasseter does not teach the claimed requirement of a second frequency when the microsources are overloaded. As an initial matter, Patent Owner purports to discuss the merits but refuses to engage with the analysis by Generac and Generac's expert identifying Lasseter's relevant overload disclosures. *See generally* Paper 3; EX1003. Lasseter discloses "P_{max}," the "maximum rated power of the microsource," Paper 3, 8, that "can be exceeded…if the

limit on maximum power is also exceeded, i.e. there are more loads than generation," EX1005, ¶[0130]. Exceeding P_{max} is an "overload" because it "cause[s] a departure from specifications for the power output from the source." EX1003, ¶58. Lasseter, in certain embodiments, preemptively "disconnects" loads when it expects that "the combined power capacity of the microsources…is not adequate to supply the total load from loads." EX1005, ¶[0099]. These are overload scenarios pursuant to the '857 Patent's own definition. EX1003, ¶¶34, 54–60.

Further, Patent Owner myopically bases its defense on a single embodiment from Lasseter, where a microgrid is engineered so that overload is impossible. Patent Owner fails to acknowledge this limitation, quoting a line from ¶[0120] (incorrectly attributed to ¶[0132]) and ignoring the preceding paragraph, which introduces an embodiment where a "system is engineered such that the combined power capacity of all the microsources in the system exceeds the maximum combined load." *Id.* at ¶[0119]. In this specific embodiment, the loads' maximum possible draw is less than the sources' maximum capacity, so there will be no overload—as acknowledged by ¶[0120]. *Id.* at ¶[0120] (specifying the setup "***as seen before***," i.e., in ¶[0119]). But Lasseter's other embodiments relied on in the petition cannot be overlooked. Lasseter expressly discloses "controlling the instantaneous frequency and power from one or more microsources in ways that tend to ensure that the microsources stay within their normal operating ranges"—the core invention of the '857 Patent. *Id.* at ¶[0009].

Besides its baseless attacks of Lasseter, Patent Owner does not refute the other art asserted by Generac, conceding that the disclosures in Lopes, Miller, Baldassarre, and Tsukida are relevant to determining the ’857 Patent’s patentability. The examiner also did not evaluate Lopes, Miller, or their derivatives, further indicating the ’857 Patent should not have issued. Under these circumstances, lack of § 102 art is not relevant to institution. Whether a patent found unpatentable under § 103 is also anticipated under § 102 matters not—it is unpatentable. If anything, Generac’s reliance on § 103 art supports institution, because the Board is well-equipped to assess the relevant skill and knowledge of a POSITA while evaluating Generac’s grounds.

Finally, Patentee’s assertions regarding reliance on expert testimony do not shift discretionary denial considerations. Generac properly relies on expert testimony from Dr. Leeb to support its arguments—including detailed and focused testimony on how a POSITA would have predictably combined the identified references and how such combinations apply to the challenged claims. Here, Dr. Leeb provided context not available to the examiner during examination regarding the knowledge of a POSITA and the understanding that a POSITA would have gathered from the cited prior art references. Patentee’s arguments regarding reliance on expert testimony ignore why such testimony is required—the length of the expert declaration reflects the number of claims, the requirements for a fulsome analysis under *KSR* and other precedent, and the PTAB’s own rules at 37 CFR § 42.65(a). When

the ’857 Patent sprawls across 48 pages, 73 columns of written description, and 71 claims (9 of which are independent), it is no surprise that Dr. Leeb’s declaration supporting three petitions must be lengthy to adequately address it.

C. *Fintiv*’s Factors Disfavor Discretionary Denial.

1. *Factor 1: Whether the court granted a stay or whether evidence exists that one may be granted if an IPR is instituted*

With no citations, Patent Owner argues that the “district court has not granted a stay” and so “the first *Fintiv* factor weighs in favor of discretionary denial.” Paper 11, at 14. Not so. Factor 1 is “neutral” because there is no indication the court will deny a stay if one is requested after this action is maintained. *Nikon Corp. et al. v. Optimum Imaging Techs.*, LLC, IPR2024-01372, Paper No. 17 at 10–11 (Apr. 23, 2025) (The Board “will not attempt to predict how the court in the parallel district court proceedings would proceed if a stay is requested,” and so Factor 1 is neutral.). Moreover, where the district court judge has never before addressed a motion to stay pending resolution of an *inter partes* review, assigning weight to this *Fintiv* factor by attempting to predict whether stay will be granted would be inappropriate.

Institution could further the opportunity for a stay in the underlying litigation such that validity would be determined by the PTAB and thereby streamline the district court case. Thus, at a minimum, Factor 1 remains “neutral.” *Nikon*, IPR2024-01372, Paper 17 at 10-11; *Sand Revolution II, LLC v. Cont’l Intermodal Grp. - Trucking LLC*, IPR2019-01393, Paper 24 at 7 (PTAB June 16, 2020).

2. *Factor 2: Proximity of the court's trial date to the Board's projected statutory deadline for a Final Written Decision*

The proximity of the court's trial date—or rather, the lack thereof—favors institution. The Federal Court Management Statistics show the Eastern District of Wisconsin averages 32.2 months to trial, and in the prior three years, has averaged 42.8, 41.3 and 47.7 months to trial. EX1038 at 52. Patent Owner filed suit on October 7, 2024. Thus, the earliest likely trial is in mid-June 2027—2 months after the expected Final Written Decisions here.

But that case is moving even more slowly than typical. In fact, Patent Owner asked for a trial date, and the Court responded that it "rarely set[s] a trial date at the Rule 16 stage" because "so much water . . . can pass under the bridge" during a case and the Court's "criminal calendar ends up sometimes being a driver" of civil timelines. EX1039 at 61:9–13. Instead, the court will wait to "set dates for the final pretrial conference or the trial until dispositive motions have been ***decided***." EX1040 at 4 (emphasis added). There will likely be substantial time between the filing of dispositive motions and the Court's decisions, given that the Court's busy docket delayed a ruling on Generac's motion to dismiss ***for over eight months***. *Compare* EX1041 (filed Dec. 2, 2024) *with* EX1039 (giving an oral ruling on Aug. 8, 2025).

If the Court rules on a consistent timeline for other significant deadlines—and Patent Owner identifies no facts suggesting otherwise—then a distant trial seems likely. Indeed, Patent Owner omits that the Court's Scheduling Order sets out no

specific dates beyond claim construction and instead measures all subsequent deadlines from the Court's claim construction order. EX1040 at 3–4. Even if the Court rules on claim constructions for disputed terms across three patents twice as fast as it ruled on Generac's motion to dismiss (i.e., by July 2026), the parties would not file dispositive motions until March 2027. *See* EX1040 at 3–4.

Contrary to Patent Owner's representation that "trial would be imminent" after dispositive motions are filed, Paper No. 11 at 15, it seems more likely that the Board will issue its Final Written Decisions comfortably before the parties even file dispositive motions. Factor 2 thus disfavors discretionary denial.

3. *Factor 3: Investment in the parallel proceeding*

The investment in the parallel proceedings is low. The District Court case remains in its nascent stages with much of the work yet to be done. Meaningful discovery only just began, with the parties recently having finalized the protective order. EX1042 (Dec. 30, 2025). Indeed, no motions to compel have been filed, and notable case milestones like the *Markman* hearing are still on the horizon.

As evident from the minimal document productions and lack of disputed motions, the district court case is in its infancy. Patent Owner's briefing notes the case's early status, referring to milestones that have not yet been reached. Paper No. 11 at 15. Indeed, while *preliminary* infringement and invalidity contentions have been served, discovery has just begun—contentions are not finalized, no depositions are

scheduled, and expert discovery is far off. *See* EX1040 at 3–4. While each party has served an initial set of interrogatories and requested document production, surely neither party is already satisfied—indeed, Patent Owner has only produced 105 total documents, a significant portion of which are the patents at issue and public filings.

Moreover, other notable district court milestones are distant, too. The parties have not argued claim construction. *Id.* Even assuming the Court issues its Claim Construction order within a month of briefing closing, (which appears improbable, as discuss in Part III.C.2), the close of fact discovery would still occur in late August 2026—months away. *See id.* Expert discovery would extend even past that point. *Id.* (disclosures of experts and reports due thirty days after close of fact discovery).

Thus, the bulk of the district court milestones have yet to occur—and certainly the parties have made little or no investment regarding the merits of prior art/invalidity disputes. In accordance with PTAB precedent, the current stage of the parallel proceeding indicates that Factor 3 weighs against discretionary denial. *Sotera Wireless, Inc. v. Masimo Corporation*, IPR2020-01019, Paper No. 12 at 16–17 (Dec. 1, 2020) (designated "precedential" Dec. 17, 2020) (holding that Factor 3 weighs against discretionary denial when no *Markman* briefing has occurred as this indicates "relatively limited investment in the parallel proceeding").

Finally, that the Court denied Generac's motion to dismiss does not warrant a different outcome. The Court made clear it did so "at the Motion to Dismiss stage

[standard].” EX1039 at 58:23–25. The Court believed it is “more efficient to wait to determine a patent’s 101 eligibility until after fact discovery has opened” and “after issuing its claim construction order.” *Id.* at 48:18–21. Indeed, when invited to resolve any claim construction issues preventing it from granting Generac’s motion, the Court refused, stating it does not “think that’s appropriate at . . . the Motion to Dismiss stage.” *Id.* at 10:4–8. Given the Court’s ruling was preliminary in nature and did not invest in analyses like claim construction, its Order does not tip the needle in Patent Owner’s favor. Thus, Factor 3 disfavors discretionary denial.

4. *Factor 4: Overlap between issues raised in the petition and in the parallel proceeding*

The fourth *Fintiv* factor also supports institution. Patent Owner incorrectly posits that the district court litigation could resolve all issues raised in the petitions. Where it only asserts fourteen of the seventy-one claims of the ’857 Patent in the underlying litigation, even a court-issued adjudication of invalidity would leave most of the claims alive. But 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. Given the breadth of this patent, surviving claims cast shadows of uncertainty in the technical field in which Generac conducts business.

Further, Patent Owner faults Generac for challenging all claims when “Patent Owner has asserted a mere fourteen claims” and thus creating an “undue burden,”

Paper 11, at 17, but conveniently ignores that Patent Owner did not identify which claims it would assert until its infringement contentions on October 17, 2025—*after* the statutory bar date for filing these Petitions. Paper 2 at 3, EX1040. Patent Owner attempts to craft a strategy where Generac faces the substantial burden and expense of discovery and litigation of diverse claims in the district court, but Patent Owner can avoid the substantially reduced burden of examination through this Petition.

Additionally, the '857 Patent is a divisional of the other patents in suit. Thus, the claims challenged in Generac's petitions have substantive differences from those of the other patents, minimizing the potential for overlap should the petitions be instituted. For example, independent claim 17 comprises a "power source having a known at least one power source parameter" and an "output AC power having one or more timely power parameter which is sensed and compared to at least one corresponding power source parameter," a comparison not present in the claims asserted in the underlying litigation. *Compare*, US Pat. No. 10,892,618 and 11,967,857 claims. Similarly, independent claim 34 includes a "second coupling circuit" and independent claim 45 involves synchronization between frequency of the power grid and a device, neither of which is equivalently claimed in the asserted claims. *Id*. Because the claims challenged in this petition differ from those asserted in the underlying litigation, Generac's challenge is non-overlapping.

Patent Owner incorrectly argues that Generac will assert the same or similar

art in the underlying litigation against either the ’857 Patent or the other two asserted patents. As explained above, the ’857 Patent differs substantively from Cooper’s other patents—which do not claim techniques for the *control* of AC frequency—and so art applicable to its invalidity will be less applicable to the other asserted patents. For example, while Lasseter teaches “controlling the instantaneous frequency and power from one or more microsources in ways that tend to ensure that the microsources stay within their normal operating ranges,” EX1005, ¶¶[0058], [0106]-[0142], [0158]-[0171], anticipating the ’857 Patent, it does not contain disclosures anticipating the other asserted patents. The art cited in this Petition is not directed to the core purported inventive concepts of the other asserted patents and would primarily aid Generac only in addressing dependent claims or tangential features.

Similarly, Patent Owner’s arguments about “substantially similar art” is unpersuasive. Just as Cooper’s patents teach different subject matters, so do other patents by the same inventor. Similarly, the Lasseter patent in this Petition has different disclosures than the “related” art Generac asserts in its invalidity contentions. Judging by the content of the references, and not merely by the inventors, there is little overlap between the grounds asserted here and in the underlying litigation. There is thus little risk of overlapping, even without formal *Sand* or *Sotera* declarations.

5. *Factor 5: Whether the petitioner and the defendant in the parallel proceeding are the same party*

Petitioner and the Patent Owner are parties in the parallel proceeding and so

Factor five admittedly weighs in favor of discretionary denial.

6. *Factor 6: Other circumstances that impact the Board's exercise of discretion, including the merits*

The "additional factors" enumerated in the Director Memo favor institution. As discussed above, Generac properly relies on Dr. Leeb's expert testimony. *See supra* Part III.B. Moreover, compelling economic interests disfavor discretionary denial. Generac is an American-founded and American-based company and has been a prominent leader in the market for, *inter alia*, backup-power generation for decades. In contrast, Patent Owner is a non-practicing entity, named after its patents, and formed shortly before filing its lawsuit against Generac. *See supra* Part II.A. Patent Owner appears to have engaged in calculated effort of concealing its applications, and lying in wait until Generac unknowingly (and independently) developed and relied on technology that Patent Owner claims its patents cover.

Moreover, allowing Patent Owner to continue to assert claim scope that ensnares known prior art, which rightfully belongs to the public, would allow Patent Owner to hold an unjust monopoly on such technology. This would have negative economic consequences for the public by restricting the free market to determine the fair price for such technology that is rightfully within the public domain.

Patent Owner's Factor 6 arguments are duplicative of its early discretionary denial arguments and can be rejected under this Factor for the same reasons discussed. For instance, Patent Owner has no settled expectations for the '857 Patent's

frequency-control load management disclosure. *See supra* Part III.A. Contrary to Patent Owner's representations, Generac had no notice of the frequency-control of the '857 Patent after nearly a decade of Cooper's concealing his patent filings. *See supra* Part III.A. Further, Patent Owner's merit-based arguments do not identify flaws in the grounds presented in the Petition. *See supra* Part III.B. And Patent Owner likewise is incorrect that said grounds are cumulative of those rejected by the Examiner. *See supra* Part III.B.

Likewise, Patent Owner's arguments relating to Generac's prosecution activity are false. Paper No. 11 at 18. Generac has not "been forced to admit it has no reference that anticipates the '857 Patent's claims" nor "that Patent Owner was the first to conceive of the claimed invention." *Id.* First, Generac has never admitted this, and Patent Owner cites nothing for this proposition. *See id.* Second, the Office Action to which Patent Owner refers did not concern managing loads via deliberate frequency-control as claimed in the '857 Patent. *See generally* EX1036.

Thus, Factor 6 disfavors discretionary denial.

D. Instituting All Three Petitions is Most Efficient for the Board, the Parties, and the Court.

This case presents exactly the type of "unlikely . . . circumstances . . . where three or more petitions by a petitioner with respect to a particular patent will be appropriate." *See* Ex. 2016 at P. 59. The '857 Patent is atypical—spanning 71 claims, of which 9 are independent, and including 61 columns of specification. At the time

the petitions were filed, Patent Owner had not indicated which of the 71 claims it would assert. Patent Owner, now having seen the petitions, chose to assert claims from each of the three in the district court, namely claims 1-10, 13, 27, 66 and 71. This Board should not fault Generac for the length and complexity of the challenged patent, which necessarily prompts the "three lengthy petitions and a 252-page expert declaration" maligned by Patent Owner.[2]

Patent Owner's further rehashing of its earlier arguments, including *Fintiv* factors 4 and 6, remains unconvincing. Additionally, Patent Owner's reliance on *SAP Am. Inc.* is misplaced. In that case, the Board denied institution when Factor 6 was "neutral" because "the merits [were not] sufficiently strong." *SAP Am. Inc. v. Cyandia, Inc.*, IPR2024-01496 Paper 13 at 10-11 (PTAB Apr. 7, 2025) (noting the petitioner's challenge was based on the argument that patent owner's claim construction contradicted its infringement contentions). In this case, however, Factor 6 weighs strongly in favor of institution.

Finally, there is good cause to institute all three of Generac's Petitions. Patent Owner complains of its cost and burden to engage in *inter partes* review yet ignores

[2] The word limit for petitions is tailored to typical patents with twenty or fewer claims, three or fewer being independent. See § 1.492(h)-(i) (excess claims fees).

the more significant cost and burden it subjects Generac to in the underlying litigation. Regardless, Patent Owner's implications that institution risks "hard earned" patent rights "deeply important to the American economy" are illusory. To begin, Cooper is a serial patent filer—the sole inventor on 55 applications—but has not asserted to have produced a single product. Yet Patent Owner's suit targets a significant portion of Generac's product portfolio. Generac is an American company, founded in 1959 and headquartered in Waukesha, Wisconsin, with manufacturing facilities in Eagle, Whitewater, Oshkosh, and Berlin, Wisconsin. EX1043, 33–34.

Further, as explained above, Cooper weaponized the non-publication request to conceal patent applications that could have put Generac on notice before it developed the accused products. Cooper presumably continues this practice with at least one pending divisional application still secret (No. 18/937,316). As discovery progresses, more of Generac's sensitive information will be disclosed in the underlying litigation. Accordingly, Generac has an additional interest to resolve the validity of the '857 Patent through the *inter partes* process without requiring potentially harmful fact disclosure.

IV. CONCLUSION

For these reasons, a holistic evaluation of the record strongly weighs against discretionary denial. Generac therefore respectfully requests that this case proceed to an institution determination on the merits.

Respectfully submitted,

Dated January 20, 2026

/Joshua A. Griswold/

Joshua A. Griswold, Reg. No. 46,310
David Conrad, Reg. No. 60,788
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
T: 202-783-5070
F: 877-769-7945

Attorneys for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4) and 42.205(b), the undersigned certifies that on January 20, 2026, a complete and entire copy of this Petitioner's Opposition to Patent Owner's Request for Discretionary Denial and Accompanying Exhibits were provided by email to the Patent Owner by serving the correspondence email address of record as follows:

Alexander N. Yow
Dave R. Gunter
FRIEDMAN, SUDER & COOKE
604 E. Fourth Street, Suite 200
Fort Worth, TX 76102

Email: ayow@fsclaw.com
gunter@fsclaw.com
IPR@fsclaw.com

/Diana Bradley/
Diana Bradley
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
bradley@fr.com