

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners

v.

CHAMPION POWER EQUIPMENT, INC.,

Patent Owner.

Patent No. 10,393,034

Issued: August 27, 2019

Title: FUEL SYSTEM FOR A MULTI-FUEL INTERNAL COMBUSTION
ENGINE

Inter Partes Review No. IPR2025-00805

**PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL OF INSTITUTION**

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I. INTRODUCTION

Petitioners oppose Patent Owner Champion Power Equipment, Inc.’s (“Champion” or “Patent Owner”) request for discretionary denial (Paper 8 (hereinafter “RDD”)).

The ’034 Patent at issue in this proceeding is one of thirteen patents asserted by Champion against multiple Petitioners across three separate litigations in California, Wisconsin, and Nevada, as well as a fourth litigation involving non-petitioner Firman in Arizona. A Final Written Decision (“FWD”) is expected in this proceeding in November of 2026—some nine months to two years before the expected trial dates in any of Petitioners’ cases. The Firman case is running far behind its predicted schedule and is likewise not likely to reach trial before the FWD date.

Accordingly, in lieu of three separate jury trials on invalidity before three different district courts operating on different timelines, it is a highly appropriate and efficient use of Office resources to consolidate each of Petitioners’ separate invalidity arguments against the asserted patents in a single set of proceedings before the PTAB. Furthermore, by Champion’s own admissions, the majority of Petitioners’ cases are in their infancy, and none are at an advanced stage. All of the cases are also likely to be stayed upon institution of one or more of the IPRs. Petitioners have also provided or committed to provide broad stipulations for all

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asserted patents that go beyond the typical *Sotera* stipulation to further include system-based prior art that is commensurate with any prior art raised in the IPRs, thus ensuring no overlap between the PTAB's work and any district court proceeding in the unlikely event one or more case does go forward.

In addition to a single set of IPRs here being much more efficient than having three separate trials, the Board should also decline to discretionarily deny this Petition so that the Board may address material errors by the Examiner during prosecution. After three consecutive rejections in the parent case finding that a reference (Tsuda) taught a critical claim element (i.e., a liquid fuel cutoff incorporated into the carburetor), the Examiner inexplicably changed course and stated the opposite in the parent case Notice of Allowance. This feature is unmistakably disclosed in Tsuda, and the Examiner's change of course is all the more perplexing given that Patent Owner's appeal brief did not even challenge this point from the Examiner's prior rejections. The error regarding Tsuda materially impacted prosecution of the '034 Patent given that two of its independent claims are directed to and were allowed based on the alleged absence of this feature in the art, despite Tsuda's clear teachings.

To the extent there is any question whatsoever regarding Tsuda's disclosure of this critical feature, the primary references relied on in the Petition here (e.g., Nakafushi and the Kubota Workshop Manual) even more clearly disclose a liquid

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fuel cutoff incorporated into the carburetor and located downstream from the carburetor float bowl, with the Workshop Manual explicitly disclosing the cutoff as a solenoid and Nakafushi showing it as such. In view of this prior art, the challenged claims clearly should not have issued, especially given the well-known nature of using solenoids for fuel cutoffs.

Finally, the '034 Patent issued in the latter half of 2019, and this IPR Petition was filed less than six years after issuance. Thus, Champion has not developed settled expectations that its patent would not be challenged. To the contrary, the only settled expectation Champion should have had was that its patents would in fact be challenged in IPRs if it were to move forward with its unreasonable interpretation and assertion of its claims against Petitioners, just as Champion was told would happen in written correspondence when it first raised its potential infringement allegations.

In sum, when holistically assessing the facts, evidence, circumstances, and other considerations (explained below), discretionary denial is not appropriate. This Petition should be referred to the Board for assessment on the merits.

II. FACTUAL BACKGROUND

Petitioners have filed/will file thirteen IPRs challenging the thirteen patents asserted across the three litigations against Petitioners (which Patent Owner also asserted in a fourth litigation against non-petitioner Firman). The thirteen patents

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stem from two different patent families and cover a diverse range of technical concepts. Details of the filed or to-be-filed IPRs (the '034 IPR and the “Related IPRs”) are as follows:

IPR No.	Patent No.	IPR Filing Date	Challenged Claims	Grounds Asserted
IPR2025-00805	10,393,034	Apr. 29, 2025	24	8
IPR2025-00951	10,598,101	May 16, 2025	19	5
IPR2025-01099	11,306,667	June 17, 2025	18	5
IPR2025-01121	11,143,120	June 23, 2025	19	9
IPR2025-01228	11,905,896	July 11, 2025	38	5
IPR2025-01185	10,221,780	July 22, 2025	15	5
IPR2025-01272	11,492,985	July 30, 2025	19	7
IPR2025-01384	11,905,895	Aug. 20, 2025	21	5
IPR2025-01438	11,761,390	Aug. 28, 2025	21	5
IPR2025-01423	11,530,654	imminent	11	5
IPR2025-01457	11,143,145	imminent	19	~4
IPR2025-01271	10,697,398	imminent	45	~9
IPR2025-01463	11,840,970	imminent	52	~6

While Patent Owner suggests or insinuates throughout its brief that in filing these IPRs Petitioners are acting in concert with non-petitioner Firman (*e.g.*, RDD, 3 (“Petitioners have been cooperating with Firman”)), this is categorically false.

Firman is not a petitioner nor a real-party-in-interest here (nor in any of the Related

IPRs), and is not in privity with any Petitioner. In fact, Petitioners and Firman have had to seek relevant discovery from each other by resorting to third-party subpoenas under the formal discovery procedures in their respective cases—precisely the type of discovery provided for under the Federal Rules of Civil Procedure when seeking relevant information as between unrelated third parties.

To be clear, Petitioners developed the invalidity theories and evidence raised in this IPR and the Related IPRs independently from Firman. For example, Petitioners identified and located the Kubota Workshop Manual and obtained relevant declarations regarding it (*see, e.g.*, Exs. 1014, 1015) with no assistance from or discussions with Firman, which is equally true of the other art relied on in the Related IPR petitions. Moreover, it is hardly surprising that Firman has chosen to rely on its own prior art product, the RD9000E generator, as the centerpiece of its invalidity case (*see* RDD, 9, 13, 45), nor that Petitioners would easily identify this prior art through publicly-filed documents¹ (amongst a host of other prior art) and incorporate it in their invalidity contentions (RDD, 33-34) in the event that Firman prevails in its invalidity arguments based on this system. This is a standard and customary approach to invalidity contention practice in patent litigation.

¹ For example, Firman identified the RD9000E as prior art in its Answer and Counterclaims, which is a publicly-available document filed in January 2024. *See* Ex. 1039, 57-60.

In sum, Patent Owner's claims to the effect that "Petitioners' invalidity theories are largely developed by Firman" (RDD, 40) are entirely false, and Patent Owner sets forth no reasoning or evidence suggesting otherwise.

III. THE *FINTIV* FACTORS WEIGH AGAINST DISCRETIONARY DENIAL

This is the quintessential case for institution. None of the *Fintiv* factors favor discretionary denial and, in fact, a majority of the *Fintiv* factors weigh strongly against discretionary denial. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 5-6 (P.T.A.B. March 20, 2020). Specifically, this IPR should not be discretionarily denied at least because:

- a decision in this IPR will issue far ahead of the trials in Petitioners' pending district court cases, which are in their earliest stages and are likely to be stayed upon institution;
- consolidating the invalidity arguments from 3 separate jury trials into a single set of PTAB proceedings is a highly efficient and appropriate use of Office resources, especially in view of Petitioners' broad *Sotera*-plus type stipulations;
- the '034 Patent was challenged less than six years after its issuance, such that Patent Owner did not have settled expectations that its patents would not be challenged in an IPR proceeding; and

- material errors by the Examiner during prosecution need addressing, especially given the Petition's strong invalidity grounds.

The weight of the *Fintiv* Factors and related considerations against discretionary denial are further detailed below.

A. Factor 1 – the Likelihood of a Stay – Weighs Against Discretionary Denial Because the District Courts Have a Record of Granting Stay Motions on Similar Facts

Factor 1 weighs against discretionary denial. This factor considers how the district courts in question will likely rule on a post-institution motion to stay. *See iRhythm Techs., Inc., v. Welch Allyn, Inc.*, IPR2025-00377, Paper 10, at 2-3 (P.T.A.B. June 6, 2025) (determining that Factor 1 weighs against discretionary denial where petitioner intends to file a motion to stay upon institution and statistics suggest a subsequent stay is likely); *see also id.*, Paper 9, at 34-35 (indicating petitioner's intent to file a motion to stay). Patent Owner incorrectly solely focuses on whether the parallel proceedings have been stayed or have a pending motion to stay. RDD, 31-32. Yet, as explained below, the relevant data suggests that, even if contested, stays will likely be granted upon institution in one or more of the pending litigations given these courts' history of deference to the expertise of the PTAB regarding validity challenges. Furthermore, Patent Owner has expressed an openness to litigation stays if this IPR is not discretionarily denied, essentially ensuring stays in the co-pending litigations.

1. The MWE, Generac, and Harbor Freight Cases

The MWE case is pending in the District of Nevada, before Judge Traum. As Patent Owner concedes (RDD, 31), Judge Traum has granted a contested motion to stay based on similar facts upon IPR institution. *See FaceTec, Inc. v. iProof, Ltd.*, No. 2:21-cv-02252, ECF No. 188 (D. Nev. June 18, 2025) (granting the motion to stay the case pending an IPR where the case was in the early discovery stage) (attached as Exhibit 1023). And this district has granted complete or partial stays 67% of the time (14 partial or complete stays out of 21). Ex. 1026.

The Generac case is pending in the Eastern District of Wisconsin, before Judge Adelman. Judge Adelman has granted contested motions to stay pursuant to post-grant proceedings 70% of the time (7 out of 10) (Ex. 1024), which is comparable to the average grant rate of 73% (8 of 11) in the Eastern District of Wisconsin on such motions (Ex. 1025).

The Harbor Freight case is pending in the Central District of California, before Judge Wilson. While Judge Wilson has not handled many patent matters and apparently has not ruled on a contested motion to stay, statistics show that this district has granted stays in total or in part at a 66% rate (Ex. 1027, ¶5, Ex. B), suggesting that a stay is more likely than not, even if contested.

2. The Firman Case

Firman is not a petitioner, privy, or real-party-in-interest here, which alone weighs against discretionary denial. *POSCO Co. v. Arcelormittal*, IPR2025-00370, Paper 10, at 2-3 (P.T.A.B. June 25, 2025) (noting that petitioner not being a party in a parallel proceeding counsels against discretionary denial). To the extent Firman's case is considered, it also weighs against discretionary denial under this factor because, as Patent Owner concedes (RDD, 31-32), the presiding judge has granted a motion to stay based on similar facts upon IPR institution. *See Parson Xtreme Golf LLC v. Taylor Made Golf Co. Inc.*, No. CV-17-03125, ECF No. 187 (D. Ariz. Nov. 29, 2018) (attached as Exhibit 1028).

3. Patent Owner's Statements Regarding a Stay

Both Generac and Harbor Freight have had separate meet-and-confers with Patent Owner regarding their respective intentions to seek stays of their litigations upon IPR institution.² In neither case did Patent Owner indicate that it outright opposed such stays. Patent Owner instead indicated a desire to wait for the outcome of this first discretionary denial decision, with an openness to stays in the

² MWE has not yet discussed a stay of its case with Patent Owner because a motion to transfer venue is pending. *Champion Power Equip., Inc. v. Westinghouse Electric Corp. et al*, No. 3-25-cv-00239, ECF No. 35 (D. Nev. Aug. 11, 2025).

MWE intends to seek a stay once venue has been settled.

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litigations should the '034 Petition not be discretionarily denied. Ex. 1027, ¶4; *see also* Ex. 1029, 1.

Patent Owner's statements suggest that if this IPR is not discretionarily denied, it may either agree to a stay or at least not oppose Petitioners' stay requests, creating a very high likelihood of the MWE, Generac, and Harbor Freight cases being stayed pending these IPRs. *See, e.g.*, Ex. 1030 (showing that all uncontested stays have been granted in EDWI).

Fintiv Factor 1 thus weighs against discretionary denial, given that all of the relevant district courts are more inclined than not to stay cases pending IPR even when contested, and that Patent Owner has indicated that it may not even contest the stays if this IPR is not discretionarily denied.

B. Factor 2 – Parallel Trial Date – Weighs Against Discretionary Denial Because the Board is Likely to Issue a Final Order Before the District Court Proceedings Reach Trial

Factor 2, focused on the timing of parallel proceeding trial dates, weighs against discretionary denial. There are three parallel litigations involving Petitioners, none have scheduled trials dates, and a FWD will almost certainly issue well before any of these cases reach trial. As discussed below, even the case involving non-Petitioner Firman is running far behind schedule, suggesting that its trial date will likewise fall well after a FWD here.

1. The MWE, Generac, and Harbor Freight Cases

No trial dates have been scheduled in any of the three parallel litigations involving Petitioners. The lack of trial dates weighs against discretionary denial, especially where a FWD will reduce the chances of inconsistent outcomes among numerous tribunals, as would otherwise be quite likely under the circumstances here if four different courts have to each adjudicate the issues independently.

USAA Federal Savings Bank v. PACid Techs., LLC, IPR2025-00697, Paper 9, at 2 (P.T.A.B. Aug. 14, 2025) (denying a request for discretionary denial where “it is likely that a final written decision in this proceeding will issue before the district court trial occurs, reducing the immediate concern of inconsistent outcomes or significant duplication of efforts”).

Regarding the MWE case currently pending in Nevada, of the ten patent cases making it to trial in that district since 2008, the average time to trial has been 53 months, with a median of 42 months. Ex. 1031. With the MWE complaint filed May 14, 2025, and even assuming the shorter median time to trial of 42 months, this suggests a trial date at the very end of 2028, two years after the FWD here (expected in November of 2026), while using the average time to trial would further widen that gap by nearly another year.

Regarding the Generac case pending before Judge Adelman and filed October 9, 2024, Judge Adelman has only presided over one patent case since

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2008. That case took 43 months to reach trial (Ex. 1032); a similar timeline here would place trial somewhere around April 2028 – again, nearly two years after the expected FWD in this proceeding. Even if the overall Eastern District of Wisconsin median time-to-trial of 34 months is considered (Ex. 1033), trial still would not be expected to occur until August 2027, nine months after a FWD in this case.

Regarding the Harbor Freight case, Patent Owner references a prior jointly-filed proposed schedule (DDR, 27), but fails to mention that this proposal was filed with a different judge and was never adopted. No such proposal is before Judge Wilson, and it is unknown when trial date scheduling will occur. The median time to trial in the Central District of California is 35 months. Ex. 1034, 1. With a case filing date of October 9, 2024 (the same date as the Generac case), trial is projected to occur in September 2027, ten months after a FWD in this case.

Accordingly, while no trial dates have been set in any of the litigations involving Petitioners, statistics from each of the three relevant jurisdictions all suggest trial dates **long after** the FWD in this proceeding. These facts weigh strongly against discretionary denial. *See, e.g., Google LLC v. Withrow Networks Inc.*, IPR2025-00775, Paper 10, at 2 (P.T.A.B. Aug. 14, 2025) (referring to the Board where there is no trial date scheduled in co-pending litigation and the time-to-trial statistics suggest that trial would not begin until after the FWD).

2. The Firman Case

As previously mentioned, the Firman case does not support discretionary denial here because Petitioners are not a party to the Firman case and Firman is not a privy or real-party-in-interest here. *POSCO*, IPR2025-00370, Paper 10, at 2-3.

Nonetheless, Patent Owner's discretionary denial brief relies heavily on the Firman trial allegedly occurring a few weeks before the FWD date.³ RDD, 33, 35. While median time-to-trial statistics for that jurisdiction may suggest a trial date at around the same time as the FWD date, Patent Owner has ignored the fact that the Firman case is already **running significantly behind schedule** relative to the statistical averages on which Patent Owner relies.

³ Patent Owner purports to rely on "median" time to trial statistics for the Firman count (RDD, 11, 33), but appears to use the shorter average time of 36 months in its calculations, rather than the median of 36.5 months. *See* EX2047, 2. Using the median-time-to-trial number suggests trial around November 25, 2026. Also, the Notice of Filing Date Accorded in this proceeding was issued May 29, 2025, which suggests a FWD deadline of November 29, 2026, not December 1, 2026 as suggested by Patent Owner (RDD, at 33). With November 29, 2026, falling on a Sunday, a FWD will likely issue no later than the Friday before, or November 27, 2026. Accordingly, the median-time-to-trial statistics and a proper estimate of the FWD date suggest that the two projected dates are nearly identical, not a month apart as suggested by Patent Owner (RDD, 11).

Specifically, Patent Owner's own exhibit indicates a median time to claim construction of 15.7 months for the Firman court. Ex. 2047, 1-2. Based on the Firman case filing date of November 10, 2023 (RDD, 11), a claim construction ruling would have been predicted to issue by the end of February 2025. Yet now, as of the end of August 2025, a *Markman* hearing has yet to occur or even be scheduled, and no claim construction ruling has issued. Thus, the Firman case is already running at least **six months or more** behind schedule as compared to the statistics Patent Owner uses for its prediction.

Furthermore, Patent Owner concedes that the remaining deadlines in the Firman case are tied to the issuance of a claim construction ruling. RDD, 11. Accordingly, based on Patent Owner's own admissions and how far it is already behind schedule, the Firman case is highly unlikely to meet the median-time-to-trial predicted date of November 2026. On the contrary, given that it is already at least six months behind schedule, any such trial in the Firman case will likely occur well after the November 2026 FWD date here.

Further in regards to the Firman case, Patent Owner alleges that Firman's "allegations based on the RD9000E system art are central to the defenses and counterclaims in the Firman [case]." *Id.*, 41; *see also id.*, 9, 13, 45. To Petitioners' knowledge, Firman's RD9000E prior art system is not described in a printed publication and thus not subject to an IPR proceeding at all; certainly nothing

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regarding the RD9000E system has been raised in the IPRs filed by Petitioners.

Thus, Patent Owner's allegation that the issues presented in the Petition are allegedly "the same as, or substantially similar to, those already or about to be litigated" (RDD, 33 (citations and extra quotation marks omitted)) is inconsistent with Patent Owner's own characterization of the focus of Firman's invalidity case which is primarily based on the RD9000E generator according to Patent Owner. Accordingly, the Firman court's adjudication of this issue – likely occurring well after a FWD in this IPR regardless – will have no overlap with the arguments raised in Petitioners' IPRs.

Furthermore, the first amended complaint in the Firman case shows that Patent Owner is **not** asserting claims 3, 6, 12, 20, or 22 from the '034 Patent against Firman. Ex. 1035, 14. But Patent Owner **is** asserting those claims against Petitioner Harbor Freight. Ex. 1036, 2. Thus, even if the Firman case goes to trial, it will not adjudicate many claims challenged in the Petition and the Related IPRs.⁴

Taken together, all of the above facts establish that *Fintiv* Factor 2 weighs against discretionary denial. See, e.g., *USAA Federal Savings Bank*, IPR2025-00697, Paper 9, at 2 (denying a request for discretionary denial where the time-to-

⁴ Similar non-overlap exists with other patents at issue. E.g., compare Ex. 1035, 35 with Ex. 1036, 2 (showing that claims 8, 19, and 58 of the '398 Patent are asserted against Harbor Freight, but not Firman).

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trial statistics suggest trial would not begin until about four months after the final written decision); *Røde Microphones, LLC v. Zaxcom, Inc.*, IPR2025-00557, Paper 11, at 2 (P.T.A.B. July 17, 2025) (referring to the Board where time-to-trial statistics suggest a trial between one and six months after the final written decision); *Google LLC v. Brodti Inc.*, IPR2025-00472, Paper 19, at 2 (P.T.A.B. June 25, 2025) (denying a request for discretionary denial where “the median time-to-trial statistics suggest trial will begin . . . significantly after the projected final written decision due date”).

C. Factor 3 – Investment in Parallel Proceeding at the DI Deadline – Weighs Against Discretionary Denial Because the District Court Cases Are at Early Stages for the Petitioner Involved Cases

Factor 3 weighs against discretionary denial because the district court cases involving the Petitioners are their very early stages.

For example, the MWE case is still subject to a motion to change venue, and even Patent Owner admits that this case is still in its infancy. RDD, at 38.

Similarly, while Patent Owner attempts to suggest that substantial investment has been made by the parties in the Generac case (*id.*, 37), Patent Owner’s recent pleadings in that case tell a very different story. Specifically, just last month (July) Patent Owner twice described the Generac case as being in its “infancy” when advocating to the district court to be allowed to amend its pleadings in order to assert two new patents and to include additional defenses.

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Ex. 1037, 13-14 (“This case is in its infancy, the parties having just recently even agreed on a protective order.”), 15 (“The proposed-amendment would also not cause any ‘undue prejudice’ because, again, this case is in its infancy.”). Patent Owner should not be allowed to take a contradictory position before the Board simply to suit its needs here.

While the Harbor Freight case currently has a Markman hearing set for September 30, 2025, there is no deadline for when the court will issue a claim construction ruling. With the decision on discretionary denial expected by September 29, and given Patent Owner’s openness to a stay in that case if this IPR is not discretionarily denied (Ex. 1027, ¶4), there is no reason why the claim construction hearing could not be stayed and the court’s burden to issue a claim construction decision avoided.

In addition, substantial work still remains in the Harbor Freight case, as the court has not yet issued a protective order, document discovery has yet to begin in earnest, no schedule dates other than those for the *Markman* hearing have been entered, and the parties have not conducted any depositions or any substantive fact or expert discovery, let alone prepare for trial. Under similar circumstances, the Board has found this factor to “weigh only marginally, if at all” toward discretionary denial. *See, e.g., Sand Revolution II, LLC v. Continental Intermodal Group – Trucking LLC*, IPR2019-01393, Paper 24, at 10-11 (P.T.A.B. June 16,

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2020) (informative) (noting that even though district court had held a *Markman* hearing and construed the claims, “much of the district court’s investment relates to ancillary matters untethered to the validity issue itself” and “much work remains in the district court case as it relates to invalidity”).

Finally, Patent Owner again makes much of the parties’ purported “investment” in the Firman case but cites no authority for why that case – in which Petitioners have no involvement whatsoever and the primary invalidity argument is based on system art – has any bearing on *Fintiv* Factor 3 here.

In sum, at least two of Petitioners’ litigations are in their infancies (by Patent Owner’s own admissions), and the third case has had minimal document discovery, zero depositions, and will not have even had a claim construction ruling before an expected decision on discretionary denial (after which, assuming that this IPR will proceed, Patent Owner has indicated an openness to considering a stay). Based on the collective statuses of the Petitioners’ three pending litigations, Factor 3 overall weighs against discretionary denial. *See, e.g., Alliance Laundry Systems, LLC v. Payrange LLC*, IPR2025-00573, Paper 9, at 2 (P.T.A.B. July 17, 2025) (referring to the Board where there was, *inter alia*, “relatively little investment” in the parallel proceeding).

D. Factor 4 – Overlap Between Petition and Parallel Proceeding – Weighs Against Discretionary Denial Because the Stipulations Remove Overlap with Parallel Proceedings

This factor weighs heavily against discretionary denial because Petitioners have committed to broad “*Sotera-plus*” stipulations that will eliminate overlap between the district court proceedings and this IPR (as well as the Related IPRs), if instituted. Specifically, Petitioners have stipulated that if this IPR is instituted (and not vacated/terminated), they will forego invalidity challenges in all three of their respective district court cases that involve:

- (i) the specific grounds raised in the Petition;
- (ii) any other grounds that could have reasonably been raised in the IPR proceeding (i.e., any ground that could have reasonably been raised under §§102 or 103 on the basis of prior art patents or printed publications); and
- (iii) any ground based on system prior art (either alone or in combination with other references) that directly corresponds to a printed publication reference asserted as part of a ground raised in said instituted (and not vacated) petition.

Ex. 2015, 1-2; Ex. 2026, 2; Ex. 2052, 1-2. Petitioners have offered or committed to offering identical stipulations for all of the Related IPRs as well.

These stipulations extend far beyond the more typical *Sotera*-type stipulation⁵ to ensure that there will be no overlap with any arguments raised in the litigations, including for system prior art reflected in the relied-upon printed publications, making this IPR (and the related IPRs) a true alternative to district court for determining invalidity. These broad stipulations weigh heavily against discretionary denial. See *Shenzen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc.*, IPR2025-00438, Paper 10, at 3 (P.T.A.B. July 17, 2025) (rejecting discretionary denial request where petitioner has “filed a broad stipulation”); *Tesla, Inc. v. U.S. Sec’y of the Navy*, IPR2025-00341, Paper 12, at 2 (P.T.A.B. June 13, 2025) (same); *Tesla, Inc. v. Intell. Ventures II*, IPR2025-00339, Paper 9, at 2 (P.T.A.B. June 13, 2025) (same).

Patent Owner complains that the stipulations do not cover the various “system” prior art cited, *inter alia*, by Firman in its case, such as the Firman RD9000E generator. RDD, 30, 40. However, Petitioners cannot control Firman or what invalidity arguments it chooses to raise in defending itself against a separate lawsuit initiated by Patent Owner. Further, the Firman RD9000E generator is not at issue in this IPR nor any of the Related IPRs, so even if Firman or anyone else pursues this prior art as a basis for invalidity, there will still be no overlap between

⁵ *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (P.T.A.B. Dec. 1, 2020) (precedential as to § II.A) (“*Sotera*”).

those arguments and the PTAB's work here.⁶ The same is true of all the system art that has been identified in the various invalidity contentions—Petitioners have stipulated that system art corresponding to relied-upon printed publications will not be pursued in the district court trials (which are likely to occur, if at all, long after a FWD here), specifically to avoid duplication of effort amongst the three district courts and the PTAB.

Patent Owner inexplicably claims that “the Stipulations do little to narrow the issues before the district courts.” *Id.*, 40. This absurd claim is refuted simply by considering the alternative—if the Board refuses to institute these IPRs, then

⁶ Without explanation, Patent Owner claims that “Petitioners’ invalidity theories are largely developed by Firman,” and that “the RD9000E system art [is] central to the defenses and counterclaims in the Firman, Generac, and Harbor Freight Cases.” RDD, 40-41. While Petitioners have issued subpoenas seeking discovery relating to the Firman case—a logical part of any sound litigation strategy—it is demonstrably false to allege that Firman “developed” Petitioners’ invalidity theories, or that Firman’s RD9000E generator is “central” to Petitioners’ defenses and counterclaims. Furthermore, with the trial in the Firman case likely occurring before any of the Petitioners’ three trials, if Firman were to fail in its own litigation based on its own product, it would be nonsensical for Petitioners to make this product “central” to their own defenses in the situation where Firman had already failed on the very same argument. Patent Owner’s allegations regarding Firman’s RD9000E generator are thus without merit or logic.

four separate district courts will each have to separately adjudicate **all** of the invalidity issues raised by the individual defendants in each of those cases. On the other hand, if instituted, all invalidity grounds based on printed publications that were raised or that could have been raised in the IPRs, as well as system art corresponding to the printed publications that were raised as part of a challenge, will be consolidated into a single set of proceedings before the PTAB, instead of piecemeal proceedings before a multitude of different district courts. This clearly weighs strongly against discretionary denial. *Berkshire Hathaway Energy Co. v. Birchtech Corp.*, IPR2025-00274, Paper 23, at 2-3 (P.T.A.B. July 2, 2025) (referring to the Board where there is multi-district litigation because “resolving the dispute between the parties at the Office would be more efficient”).

1. Minor Indefiniteness Issues Do Not Give Rise to Overlap

Patent Owner complains that the Harbor Freight district court may still have to address two potentially indefinite claim terms from the '034 Patent.⁷ However, having two such minor claim terms pales in comparison to the whopping number of some 119 claims across 13 patents Patent Owner has asserted against Harbor

⁷ Patent Owner has been subsequently informed that Harbor Freight intends to drop its indefinite allegation against the claim term “gaseous cutoff solenoid” in view of the Certificate of Correction (*see* Ex. 1002, 1).

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Freight alone, which Petitioners seek to have collectively resolved in a single set of proceedings here instead of individually in all three of their respective proceedings.

Moreover, while indefiniteness arises under the statutory requirements of 35 U.S.C. §112 and can lead to patent invalidity, indefiniteness is not solely limited to assessing invalidity in view of the prior art; indefiniteness can also or alternatively be relevant to assessing the scope/clarity of the claims for determining whether an accused product infringes those claims. Here, Petitioners and their expert had no problem identifying the potentially indefinite claim limitations in the prior art regardless of how interpreted, making this a non-issue for the Board. *See, e.g.*, Petition, 30-34, 76-78 (identifying prior art disclosures of a liquid cutoff solenoid “coupled to” the carburetor), 34-35, 78-79 (identifying prior art disclosures of a “gaseous cutoff coupled to open and close a gaseous fuel source”).

That one district court may have to resolve two indefiniteness issues from among a total of 119 asserted claims—for example, to assess whether the meaning and scope of the claims is sufficiently clear for a jury to decide Patent Owner’s infringement allegations—should not dissuade the Board from simplifying the invalidity issues for all three of the Harbor Freight, MWE, and Generac courts by assessing the invalidity issues presented in this IPR and the Related IPRs in one forum. Furthermore, should this IPR be successful, the Harbor Freight district

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court will not even have to make the determination at all since both of the claim terms at issue appear in the '034 Patent.

For all of these reasons, and especially in view of Petitioners' "Sotera-plus" type stipulations, there will be little to no overlap between the IPRs and Petitioners' three parallel proceedings, such that Factor 4 weighs against discretionary denial.

E. Factor 5 – Whether the Parties are the Same – Does Not Favor Discretionary Denial Because Petitioners are Not a Party to the Firman Case

Patent Owner's discretionary denial brief mentions Firman over 160 times. Yet, Firman is conspicuously absent from Patent Owner's discussion of this factor. RDD, 43. Patent Owner cannot have it both ways—relying on the Firman case when it suits its needs for other factors, while ignoring Firman for its discussion of *Fintiv* Factor 5.

The parties before the Board and their three respective district court cases are the same, as in almost all IPRs. However, the opposite is true in regards to the Firman case, where Petitioners are not a party. Given Patent Owner's extensive attempted reliance on the Firman case for nearly all of its arguments, this fact weighs *Fintiv* Factor 5 against discretionary denial. *Cf. POSCO*, IPR2025-00370, Paper 10, at 2 (referring to the Board where Petitioner is not a party in the parallel proceeding).

F. Factor 6 – Other Considerations – Weigh Against Discretionary Denial

Multiple considerations under Factor 6 weigh strongly against discretionary denial, as discussed below. Patent Owner's arguments for Factor 6 (RDD, 43-52) overlook or sidestep the most important considerations, as discussed below.

1. Efficient Use of Board Resources

Of all the arguments Patent Owner raises in its discretionary denial brief, perhaps the most untenable is the assertion that it would somehow be more efficient to have multiple district courts each independently assess the invalidity of each of the asserted patents than to have a single set of consolidated proceedings before the Board. Exactly the opposite is true, as recognized by the Board. *Berkshire Hathaway*, IPR2025-00274, Paper 23, at 2-3 (referring to the Board where there is multi-district litigation because “resolving the dispute between the parties at the Office would be more efficient”).

Here, Patent Owner has asserted 13 different patents against the three Petitioners in three different district court proceedings in California (Harbor Freight), Wisconsin (Generac), and Nevada (MWE), and has asked a fourth court in Arizona to adjudicate the same patents as to non-petitioner Firman. RDD, 11, 14, 21, 27. All 13 patents are or will be the subject of IPR petitions filed collectively by the three Petitioners (*see supra*, §II), precisely to streamline the invalidity challenges in a single set of IPR proceedings and ensure consistency on

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the invalidity determinations, which will conclude long before any of the trials in the respective district court proceedings.⁸ *See supra*, §III.B. The IPRs are also accompanied (or will be accompanied) by stipulations in each proceeding providing that Petitioners will not pursue invalidity grounds in their respective litigations that were raised or that could have been raised in the IPRs, nor grounds based on system art corresponding to printed publication art raised in the IPRs. *See supra*, §III.D.

Allowing this IPR (and the Related IPRs) to proceed represents the epitome of efficient and appropriate use of Office resources, given that the alternative is having four different jury trials proceed to assess invalidity of the asserted patents in four different district courts. Such piecemeal adjudication creates a very high likelihood of inconsistent outcomes, and given that each case on its own timeline, any consolidation of appeals at the Federal Circuit would also be hindered.

While Patent Owner complains that the '034 IPR involves eight prior art references in its grounds of unpatentability (RDD, 52), the more important point is that the combined 13 IPRs filed by Petitioners only collectively are expected to set forth only 25 prior art references in total, applied against approximately 320 challenged claims. This is an average of fewer than two prior art references **per**

⁸ Because the Firman case is already far behind schedule, its trial will also likely occur well after a FWD here. *Supra*, §III.B.2.

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patent, and only one reference for every 12-13 challenged claims on average. The Petitions together thus represent a greatly reduced and streamlined invalidity case as compared to, for example, the sixty-nine prior art references asserted by Firman. RDD, 12.

Moreover, as the Board has recently noted:

The large number and vast scope of the patents asserted in the district court litigation weighs against discretionary denial, as the Board is better suited to review a large number of patents involving diverse subject matter.

Tesla, IPR2025-00339, Paper 9, at 2 (citations omitted). Here, as compared to presenting broad invalidity cases to four different juries, the Board is much better positioned to grasp and efficiently handle a single set of challenges to so many patents from two different patent families involving complicated aspects of numerous multi-fuel engine/generator designs.

The vast efficiencies to be gained by consolidating the three Petitioner district court invalidity proceedings into a single set of proceedings before the PTAB is a highly appropriate use of Office resources, and reason enough by itself to refuse discretionary denial. *Berkshire Hathaway*, IPR2025-00274, Paper 23, at 2-3; *Shenzen Tuozhu Tech.*, IPR2025-00438, Paper 10, at 3 (referring to the Board where the district court proceeding involved a “large number and vast scope” of patents).

2. Material Error by the Examiner During Prosecution Weighs Heavily Against Discretionary Denial

Material error during prosecution also weighs heavily against discretionary denial, often overcoming facts that would otherwise have resulted in a *Fintiv* denial. See *Xencor, Inc. v. Merus N.V.*, IPR2025-00604, Paper 12, at 2-3 (P.T.A.B. July 17, 2025) (referring to the merits panel, despite strong settled expectations and high chances that a FWD would issue before trial, because “Petitioner provides persuasive evidence that the Office erred in a manner material to the patentability of the challenged claims by overlooking the teachings of [a reference during prosecution]”); *Microsoft Corp. v. Partec Cluster Competence Ctr. GmbH*, IPR2025-00318, Paper 9, at 3 (P.T.A.B. June 12, 2025) (referring to the panel because “Petitioner appears to show a material error by the Office and it is an appropriate use of Office resources to review the potential error”); see also *Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025-00152, Paper 11, at 2-3 (P.T.A.B. June 12, 2025) (referring to the panel where there was evidence that the “Office erred in a manner material to the patentability of the challenged claims by overlooking the teachings of [a prior art reference]”); *Anthony, Inc. v. ControlTec, LLC*, IPR2025-00559, Paper 12, at 2 (P.T.A.B. July 16, 2025) (finding that petitioner’s showing of material error favored referring to panel for 17- and 18-year old patents); *Microsoft Corp. v. XI Discovery, Inc.*, IPR2025-00253, Paper 13, at 2 (P.T.A.B. June 25,

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2025) (refusing discretionary denial where claims were likely erroneously allowed over the prior art).

Here, despite Patent Owner never citing Tsuda to the Examiner during prosecution of the '034 Patent and Tsuda not being cited on the face of the '034 Patent, Patent Owner concedes that the Tsuda reference (U.S. Patent No. 5,809,979 (Ex. 1018)) was before the Examiner during prosecution by virtue of its inclusion in the prosecution of U.S. Patent No. 10,697,398 (“the '398 Patent”), the parent of the '034 Patent. RDD, 54-55. Remarkably, Tsuda was never relied upon by the Examiner during prosecution of the '034 Patent, which can only be explained by the Examiner’s material misunderstanding of Tsuda’s teachings, as explained below. This material error—overlooking features that are clearly disclosed in the prior art and highly relevant to the issued claims of the '034 Patent—weighs heavily against discretionary denial and offers an independent reason to refer the Petition to the merits panel regardless of the other factors.

a. Prosecution of the Parent '398 Patent

During prosecution of the '398 Patent, the Examiner relied on Tsuda extensively (in combination with another reference to Poehlman), rejecting the pending claims three consecutive times and finding that Tsuda’s “liquid fuel cut-off (14) is incorporated into the carburetor (... shown in Fig 1) to interrupt liquid fuel

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upon actuation of the switch from liquid fuel to gaseous fuel.” Ex. 1038, 338-39;
see also id., 382, 428-29.

Patent Owner never refuted this finding by the Examiner, and instead admitted that Tsuda’s valve 14 is within the carburetor, explaining:

An inner bottom portion of the float chamber 4 is provided with a liquid fuel inlet 13, through which the float chamber 4 communicates with the liquid fuel nozzle 5. Tsuda, Col. 2, lns. 58-60. Laterally arranged at a lower portion of the float chamber 4 is a liquid fuel valve 14 for opening or closing the inlet 13. Tsuda, Col. 2, lns. 61-62.

Id., 372 (citations in original); *see also id.*, 466 (noting Tsuda’s teaching of “a liquid fuel valve 14 included in the carburetor 1 (FIG. 1)”). Patent Owner’s Appeal Brief likewise did not contest this aspect of the Examiner’s characterization of Tsuda, and instead attacked the motivation to combine Tsuda with Poehlman (*id.*, 466-67) and whether either reference disclosed **both** a liquid fuel valve **and** a liquid fuel cutoff (*id.*, 467-68).

Given Patent Owner’s own admissions regarding the location of Tsuda’s liquid fuel cutoff 14, and that the issue was not even contested in Patent Owner’s Appeal Brief, it is remarkable—and inexplicable—that the Examiner responded to the Appeal Brief by allowing the claims, explaining only that:

The closest prior art references, Poehlman (US 4,489,699) and **Tsuda et al. (US 5,809,979)**, teach a

similar engine but are deficient in having a liquid cut-off incorporated into the carburetor. It would not have been obvious to further modify the combination of Poehlman and Tsuda et al. to include the additional fuel cut-off.

Ex. 1038, 511.⁹ This conclusion by the Examiner in the Notice of Allowance contradicts all of the Examiner's prior findings and Patent Owner's admissions, and is clearly and materially erroneous in view of Tsuda itself.

For example, Figure 1 of Tsuda illustrates the carburetor (yellow) for Tsuda's dual-fuel engine (Ex. 1018, 1:65-67), which clearly shows the liquid fuel cutoff valve 14 (green) incorporated into the carburetor for opening or closing the inlet 13 (purple), as seen below:

⁹ All emphases herein are added, unless otherwise noted.

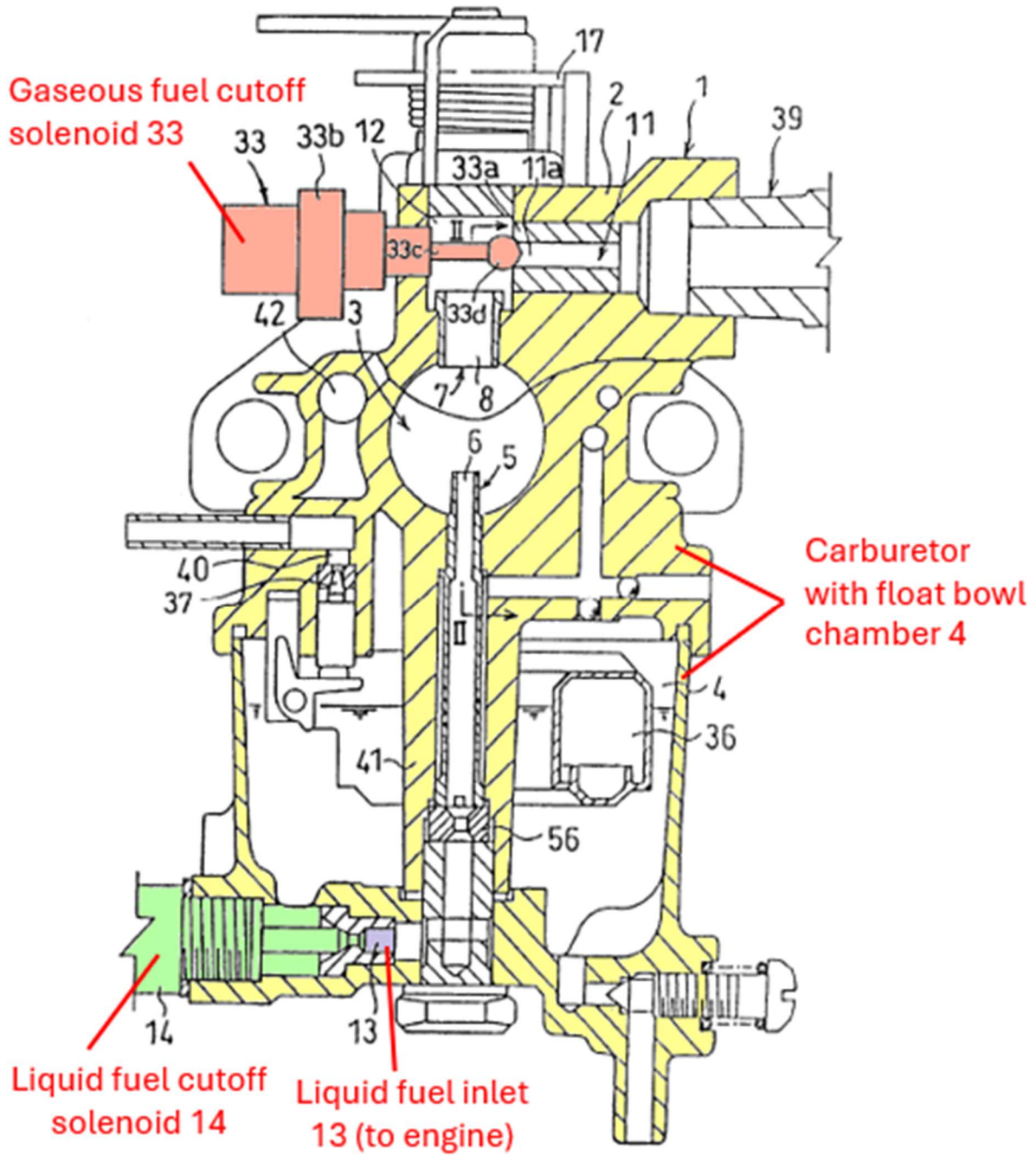


FIG. 1

Ex. 1018, Fig. 1 (annotated); *see also id.*, 2:61-62 (explaining the operation of valve 14 and inlet 13), 3:37-45 (same), 4:62-5:2 (same). Indeed, Tsuda explains that this arrangement solves the very same problems with dual-fuel engine

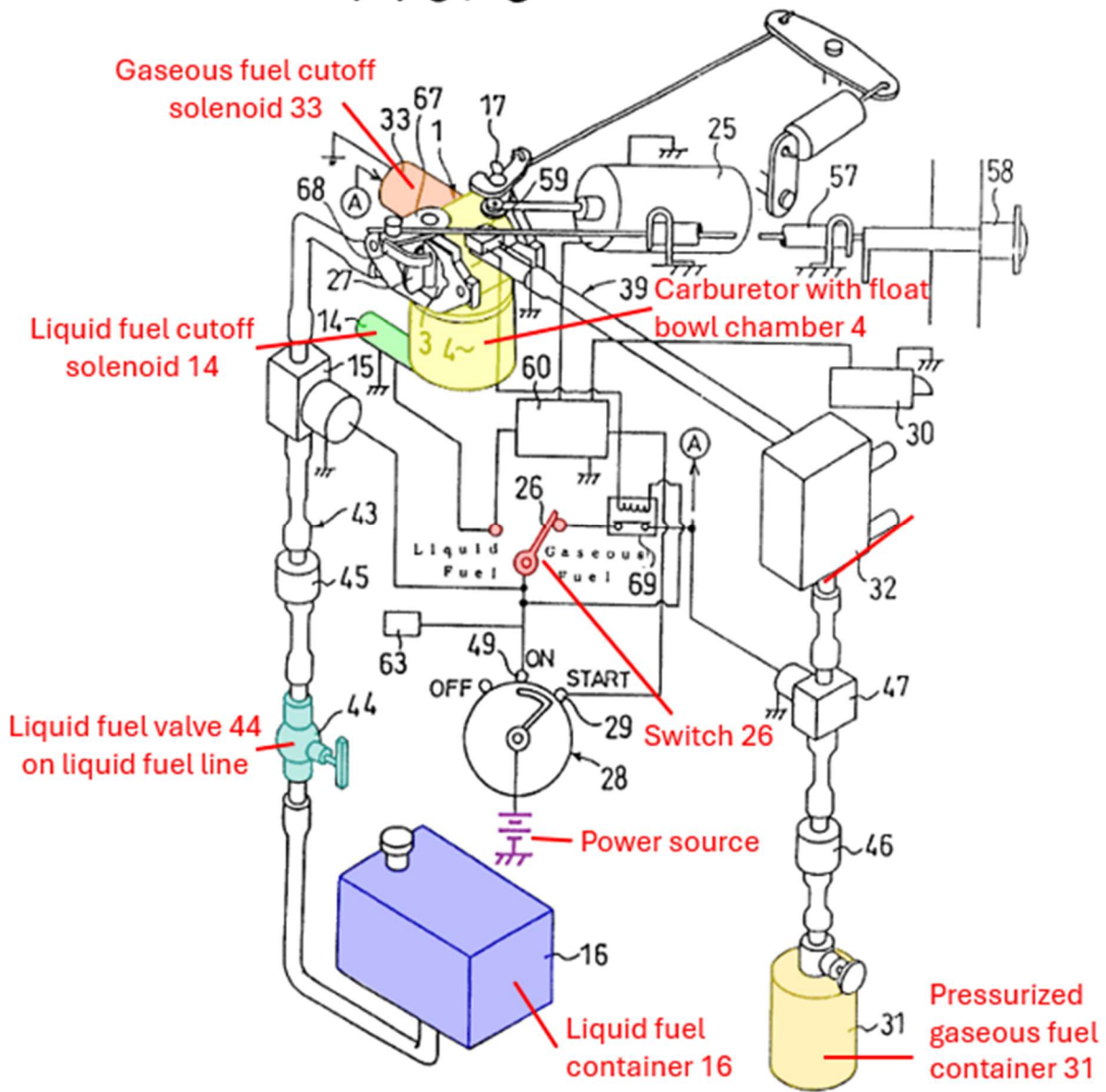
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operation as allegedly identified in the '034 Patent specification. *Compare id.* 5:2-11 *with* Ex. 1001, 7:38-53.

Moreover, while Patent Owner's Appeal Brief also argued that Tsuda further failed to teach both a liquid fuel valve and a liquid fuel cutoff as required by claim 1 of the '398 Patent (Ex. 1038, 468), this is also incorrect. Tsuda teaches not only liquid cutoff valve 14 incorporated into the carburetor as noted above, but also a separate liquid fuel valve ("cock") 44 (annotated in turquoise below) positioned along the liquid fuel line (Ex. 1018, 3:14-20), as seen below:

FIG. 3



Ex. 1018, Fig. 3 (annotated).

Accordingly, given Tsuda's express teachings as well as Patent Owner's admissions that Tsuda's cutoff valve 14 is located within the carburetor, the Examiner clearly erred in concluding otherwise in the Notice of Allowance leading to issuance of the parent '398 Patent.

The Examiner's error is material here because the Examiner never cited Tsuda once during the prosecution leading to the '034 Patent, despite Tsuda disclosing all of the limitations of claims 1 and 18 of the '034 Patent as illustrated above (*see also* Petition, 69-80 (describing where the claimed features are found in the Kubota Workshop Manual, which addresses the same engine as Tsuda)). This error most obviously stemmed from the misunderstanding adopted in the Notice of Allowance for the '398 Patent where the Examiner erroneously stated that Tsuda did not disclose a "a liquid cut-off incorporated into the carburetor" (Ex. 1038, 511).

b. Prosecution of the '034 Patent

During prosecution of the '034 Patent, the Examiner rejected claim 1, asserting, *inter alia*, that the Poehlman reference disclosed liquid and gaseous cutoff solenoids. Ex. 1002, 142-45. Patent Owner argued in response that Poehlman did not disclose valves that are *solenoids*:

There is no disclosure in Poehlman that the liquid fuel control valve 43 and gaseous fuel control valve 45 are **solenoids** that are coupled to open and close a liquid fuel path to the engine and coupled to open and close a gaseous fuel source to the engine, as called for in claim 1.

Id., 73 (emphasis in original).

The Examiner thereafter argued that using solenoid valves in Poehlman would have been obvious in view of Walker (U.S. Patent No. 3,718,000), which discloses “a similar multi-fuel engine in which the liquid and gaseous fuel lines comprise a control valve 85 being energized by a solenoid 84 to control the flow of gasoline; and a control valve 99 energized by a solenoid 98 to control the gaseous fuel flow.” *Id.*, 47. The Examiner concluded it would have been obvious to combine Poehlman with Walker because doing so would “minimize the connective elements of an electromechanical control for each fuel cutoff...” *Id.*, 48.

Patent Owner again amended the claims to require, *inter alia*, that the liquid cutoff solenoid be located “downstream from the float bowl” and/or “within the carburetor,” as shown below:

1. (Currently Amended) A multi-fuel engine comprising:
an engine operable on a liquid fuel and a gaseous fuel;
a carburetor attached to an intake of the engine to mix air and fuel and connect a liquid fuel source to the intake, the carburetor comprising a float bowl;
a liquid cutoff solenoid coupled to the carburetor to open and close a liquid fuel path to the engine downstream from the float bowl;
a gaseous cutoff ~~solenoid~~ coupled to open and close a gaseous fuel source to the engine; and
a switch selectively coupling a power source to the liquid cutoff solenoid to open and close the liquid fuel path ~~and the gaseous cutoff solenoid to switch between fuel sources on the fly during engine operation.~~

20. (Currently Amended) A multi-fuel internal combustion engine comprising:
an engine operable on liquid fuel supplied through a liquid fuel line from a liquid fuel source and gaseous fuel supplied through a gaseous fuel line from a pressurized fuel source;
a carburetor coupled to an intake of the engine to mix air and fuel and connect to the liquid fuel line and the gaseous fuel line;
~~a switch to change operation of the engine from liquid fuel to gaseous fuel and from gaseous fuel to liquid fuel while the engine is running;~~

a ~~liquid fuel~~carburetor cutoff solenoid coupled to control fuel flow within the carburetor from ~~through~~ the liquid fuel line and selectively engage engine operation on liquid fuel; ~~upon actuation of the switch from gaseous fuel to liquid fuel;~~ and
a gaseous fuel ~~cutoff solenoid~~valve coupled to control fuel flow through the gaseous fuel line and selectively engage engine operation on gaseous fuel ~~upon actuation of the switch from liquid fuel to gaseous fuel.~~

Id., 28, 30-31. The Examiner allowed these amended claims (which issued as Claims 1 and 18), reasoning:

The Amendment overcomes the prior art rejection because *neither Poehlman nor Walker teaches a liquid cutoff solenoid coupled to the carburetor downstream from the float bowl*, as well as a switch to selectively couple a power source to the liquid cutoff solenoid to open and close the liquid fuel path. No other reference teaches this structure. Therefore, the multi-fuel engine with a carburetor as claimed is considered a novel approach to utilizing two or more fuels via a selective switch and liquid cutoff solenoid valve.

Id., 16.

As noted in relation to the prosecution of the parent '398 Patent (see Tsuda's annotated Figures 1 and 3 above), Tsuda teaches precisely the features that the Examiner erroneously relied on for allowance, specifically a liquid cutoff solenoid coupled to/within the carburetor and **located downstream from the float bowl**.¹⁰ Given the Examiner's stated reasons for allowance for the '034 Patent, it was error to not reject pending claims 1 and 20 in view of Tsuda (either with or without Walker's express teaching of *solenoid* valves).

This Petition should be referred to the merits panel so that these material errors by the Examiner can be further reviewed by the Board, even if that review focuses more on the corresponding Kubota Workshop Manual than Tsuda itself. *Xencor*, IPR2025-00604, Paper 12 at 2-3 (denying the request for discretionary denial and finding that Petitioner provided persuasive evidence that the Office materially erred in allowing claims where there was evidence that the teachings of a reference cited during prosecution were overlooked).

¹⁰ As shown in annotated Figure 3 above, Tsuda likewise teaches gaseous cutoff 33 for supplying gaseous fuel to the carburetor (Ex. 1018, 3:24-38), and switch 26 that couples Tsuda's power source to the liquid cutoff valve 14 to open and close the liquid fuel path (*id.*, 3:28-52, Fig. 3), as required by claim 1 of the '034 Patent.

3. Strength of Grounds Weighs Against Discretionary Denial

Patent Owner puts forth no true argument as to the merits of the Petition, citing only to its forthcoming Preliminary Response. RDD, 44.¹¹ In fact, the

¹¹ In a separate discussion, Patent Owner appears to allege that both the Kubota Workshop Manual and Nakafushi can be distinguished from the '034 Patent because the former include “vaporizers,” while the '034 Patent allegedly does not. RDD, 56. Any such alleged distinction is without merit. As the '034 Patent specification acknowledges (Ex. 1001, 1:43-49), LPG/propane is commonly “stored under pressure in a liquid state,” but nonetheless serves as the contemplated “gaseous fuel” (*id.*, 3:46-47 (“...the gaseous fuel is liquid petroleum gas (LPG).”)). Because LPG is stored as a liquid but exists as a gas at normal temperature and pressure (i.e., when entering the engine as fuel) (*id.*), the LPG liquid must necessarily vaporize somewhere between the storage tank and carburetor. Thus, Patent Owner’s suggestion that there is no “vaporizer” in the system of the '034 Patent is false—at a minimum, at least the LPG tank itself serves as a vaporizer, with at least some LPG “boiling” in the tank to vaporize from liquid to gas. Some liquid LPG will also flow with the gaseous LPG until reaching a regulator, since the liquid and gas will remain in equilibrium until there is a temperature and/or pressure change.

Dedicated “vaporizers” such as those taught in the Workshop Manual and Nakafushi have the dual function of both converting the LPG from liquid to gas, **and** regulating the pressure. This is confirmed by Tsuda itself, which teaches that its “vaporizer 32 is equipped with a pressure regulating portion and serves also as a regulator.” Ex. 1018, 7:36-38 (underline added); *see also* Ex. 1003, ¶257

merits of the Petition are strong and include well-grounded theories of invalidity based on the proffered prior art.

As explained in the Petition, dual-fuel engines with liquid cutoffs located within the carburetor and downstream of the carburetor float bowl—the main point of alleged novelty of claims 1 and 18 of the '034 Patent according to the Examiner—have been known in the art for nearly a century. *See* Petition, 3-4 (discussing U.S. Patent No. 1,931,698 (“Holzapfel”), filed in 1931). Similarly, the use of solenoids as fuel cutoffs has been known since at least the 1980s. Ex. 1003, ¶37 (citing, *e.g.*, Ex. 1016, a textbook from 1987). Thus, the concept of a liquid cutoff solenoid located downstream from the carburetor float bowl is not even remotely novel.

Given these historical facts, it is unsurprising that nearly all of the challenged claims (including all three independent claims) are anticipated in the prior art, as seen in both Tsuda and the Kubota Workshop Manual. *See* Petition, Ground 6. This anticipation ground avoids entirely Patent Owner’s arguments against combining references raised during prosecution. *See, e.g.*, Ex. 1002, 37-38, 40. While the Petition relies primarily on the Kubota Workshop Manual instead of Tsuda, this is because the Kubota Workshop Manual further details its two-stage

(explaining how regulators can be designed/sized to accommodate the heat effects of vaporizing liquid LPG).

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regulator for regulating the gaseous fuel supply to the engine as called for in claim 11, and it expressly identifies its liquid fuel cutoff as a *solenoid*, as called for in claims 1 and 18 (to be clear, Tsuda discloses the identical solenoid cutoff, just without using the word “solenoid”).

Similarly, given the Examiner’s reasons for allowing claims 1 and 18, the combination of Nakafushi and Olmr likewise present a strong case of unpatentability. Specifically, Nakafushi teaches a liquid cutoff located downstream of the carburetor float bowl. Petition, 30-32. Nakafushi effectively discloses that its liquid cutoff is a solenoid (even though not called as such) (*id.*; Ex. 1003, ¶¶104-09), and Olmr simply makes it clear that it was obvious for Nakafushi’s liquid cutoff to in fact be a solenoid (Petition, 32-34).

The strength of the invalidity arguments presented thus provides yet another reason for rejecting Patent Owner’s request for discretionary denial.

4. Settled Expectations Weigh Against Discretionary Denial

a. Patent Owner has no settled expectations given the early challenge to the ’034 Patent

The ’034 Patent issued in the latter part of 2019, and thus, has been in force for less than six years since the filing date of the Petition—not long enough to establish a legitimate claim to settled expectations, much less strong settled expectations. *See Tanklogix v. Sitepro*, IPR2025-00650, Paper 10, at 2 (P.T.A.B. Jul. 31, 2025) (“[T]he patents challenged ... have not been in force for a significant

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amount of time (issued in 2019,...). Accordingly, Patent Owner has not developed strong settled expectations that favor discretionary denial.”); *Cambridge Industries USA, Inc. v. Applied Optoelectronic, Inc.*, IPR2025-00434, -00436, Paper 11, at 2-3 (P.T.A.B. June 26, 2025) (“Furthermore, most of the challenged patents have not been in force for a significant period of time (issued in 2020, 2019 and 2019), and, accordingly, Patent Owner has not yet developed strong settled expectations that favor discretionary denial as to at least those patents.”); *Berkshire Hathaway*, IPR2025-00274, Paper 23, at 3 (referring to the Board where Patent Owner had not developed strong settled expectations for the challenged patents that issued in 2019 and 2020); *Webgroup Czech Republic, A.S. et al., v. Dish Technologies LLC.*, IPR2025-00467, Paper 14, at 2 (P.T.A.B. July 16, 2025) (“[T]he challenged patents have not been in force for a significant period of time (2019, 2021, 2022, and 2023), such that the Patent Owner has not developed strong settled expectations.”).

Indeed, challenges to patents issued as recently as the '034 Patent have been consistently characterized as “early” and “favor[ing] robust, predictable patent rights and weigh[ing] against discretionary denial.” *See Tanklogix*, IPR2025-00650, Paper 10, at 3 (deeming patent issued in 2019 to “have not been in force for a significant amount of time.”).

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b. Petitioners' challenges to more recently-issued asserted patents further diminishes settled expectations

In addition to there being no settled expectations as to the '034 Patent, referral to the merits panel is supported by early challenges to other patents asserted in the related litigations. Here, in each of the two families asserted in the litigations against Petitioners, at least one patent is being challenged less than two years from its issue date, and several are being challenged within 3-4 years of issuance. For example, U.S. Patent No. 11,905,895 (which is in the same family as the '034 Patent) issued on February 20, 2024 and was challenged a little over one year later on August 20, 2025 (IPR2025-01384); U.S. Patent No. 11,905,896 (which is not in the same family as the '034 Patent) also issued on February 20, 2024 and was challenged even earlier on July 11, 2025 (IPR2025-01228); U.S. Patent No. 11,905,390 (which is not in the same family as the '034 Patent) issued on September 19, 2023 and was challenged a little less than two years later on August 28, 2025 (IPR2025-01438); U.S. Patent No. 11,306,667 (which is not in the same family as the '034 Patent) issued on April 19, 2022 and was challenged a little over three years later on June 17, 2025 (IPR2025-01099); U.S. Patent No. 11,492,985 (which is in the same family as the '034 Patent) issued on November 8, 2022 and was challenged a little less than three years later on July 30, 2025 (IPR2025-01272); and U.S. Patent No. 11,143,120 (which is a child of the '034

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Patent) issued on October 12, 2021 and was challenged a little over 4 years later on June 23, 2025 (IPR2025-01121).

In *Embody, Inc., et al., v. Lifenet Health* (“*Embody*”), both a parent patent and its child were challenged via IPR, with the parent patent being issued in 2018 and the child being issued in 2022. IPR2025-00248, -00249, Paper 13 (P.T.A.B. June 26, 2025). The child patent was deemed to not trigger settled expectations and was referred to the merits panel. The parent patent was also referred to the merits panel because “it is an efficient use of resources to address the related patent.” *Id.*, at 3 (“Furthermore one of the challenged patents has not been in force for a significant period of time (issued in 2022) and the other patent is a parent of the first. Accordingly, Patent Owner has not developed strong settled expectations that favor discretionary denial as to the first patent, and it is an efficient use of Board resources to address the related patent.”).

The facts of *Embody* bear a striking resemblance to the present facts, where one or more recently issued related patents (the ’895 Patent, which issued in 2024; the ’985 Patent, which issued in 2022; and the ’120 Patent, which issued in 2021) and a parent patent (the ’034 Patent, which issued in 2019 and is a parent of the ’120 Patent) were challenged. Efficiency gains in the present case are particularly pronounced, given the substantial overlap between the specifications of these related patents, along with the overlap in limitations of the child patent’s claims

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(i.e., the '120 Patent's claims) and those of the parent patent (i.e., the '034 Patent).

For example, both independent claim 1 of the '120 Patent and independent claim 1 of the '034 Patent are directed to a “multi-fuel engine,” and include common and similar “engine,” “carburetor,” “liquid cutoff solenoid,” “gaseous cutoff,” and “switch” limitations.

The parallel litigations here involve thirteen patents, some of which, as noted above, were very recently issued. To the extent that the Director refers any of the recently issued patents (such as the '895 and/or '120 Patents) to a merits panel, the '034 Patent should also similarly be referred to the merits panel for efficiency reasons, consistent with *Embody*, even if the Patent Owner were somehow deemed to have settled expectations with respect to the '034 Patent despite its relatively recent issuance in 2019. *See also Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12, at 3-4 (P.T.A.B. July 26, 2025) (referring a petition on a patent in force for over 10 years because “it is an efficient use of Board resources to address the related patent”); *Advanced Micro Devices, Inc., et al. v. Concurrent Ventures, LLC et al.*, IPR2025-00478, Paper 10, at 3 (P.T.A.B. July 31, 2025) (same).

c. Patent Owner's prior communications with Petitioners gave rise to an expectation of IPR filings

Patent Owner sent “cease-and-desist” letters to MWE and Generac in June and July of 2020, respectively, alleging infringement of Patent Owner's '101 Patent, which is in a different patent family than the '034 Patent. Exs. 2033, 2036.

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Even though the '034 Patent had issued nearly a year earlier, neither letter mentioned the '034 Patent, nor any patent in the same family as the '034 Patent. Patent Owner did not raise the '034 Patent with any Petitioner until a March 27, 2024 letter to Harbor Freight, which did not even accuse Harbor Freight of infringing the '034 Patent, but rather just mentioned the '034 Patent as being among Patent Owner's patents. Ex. 2038, 2.

In response to the 2020 letters, both MWE and Generac investigated the '101 Patent, and each informed Patent Owner that its claims were invalid, particularly so under the wildly off-base claim construction Patent Owner was advancing. Exs. 2034, 2035, 2037. MWE even included an extensive list of prior art applicable to the '101 Patent, as well as claim charts (Ex. 2035, 3-17), and told Patent Owner that it **would file an IPR** against the '101 Patent if Patent Owner further pursued its dubious infringement claims. Ex. 2034, 1 (“We are prepared to present this evidence in litigation or in an Inter Partes Review proceeding if it becomes necessary.”).

Tellingly, prior to embarking on its current litigation campaign (initiated nearly five years after its last communications on the matter), Patent Owner never again raised the infringement issues with either MWE or Generac, leading both MWE and Generac to reasonably conclude Patent Owner recognized the lack of

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merit in its claims and that the matter had been resolved without resort to contested proceedings.

Under these circumstances, it would be illogical and contrary to the evidence of record to find that Patent Owner had any “reasonable expectation” that the validity of its patents would not be challenged. Indeed, the only “reasonable expectation” to be taken from their prior correspondence exchanges is that Patent Owner understood that its patents **would be challenged in IPR proceedings** in the event that Patent Owner sought to enforce them under its overly broad, incorrect construction. And indeed, this is exactly what has transpired, just as was indicated to Patent Owner in 2020.

Monitoring Patent Owner’s portfolio and preemptively challenging all potentially relevant patents, as Patent Owner suggests, would be antithetical to the Office’s desire to manage its workload and resources. Here, Patent Owner has 16 issued patents in each of its “2013” and “2015” families, with five more applications currently pending, and as of August 26, 2025, 66 currently active patents. Ex. 1040. In the situation here, application of the “settled expectation” principle as advocated for by Patent Owner would have entailed challenges to a massive number of Patent Owner’s patents, vastly increasing the Office’s workload rather than focusing its efforts on patents actually in dispute.

In sum, since at least its 2020 correspondence with MWE and Generac, Patent Owner has known that the validity of its patents would be challenged if it pursued its meritless infringement allegations, and thus fully expected the current IPRs. In the face of such clear intent to challenge its patents if advanced against Petitioners, Patent Owner cannot assert that its expectations were settled. Petitioners' filings against not only the '034 Patent but also the other asserted patents are "early" and in line with the Director's promotion of such early challenges as favoring "robust, predictable patent rights." *GD Energy Products, LLC v. Kerr Machine Co.*, PGR2025-00031, Paper 14, at 2 (P.T.A.B. June 25, 2025).

5. The Petition's Use of Expert Testimony Weighs Against Discretionary Denial

The expert declaration of Dr. Timothy Morse (Ex. 1003) supports the Petition by including testimony guided both by years of education and experience and by ample documentary evidence that confirm and strengthen the positions and unpatentability arguments in the Petition.

The PTAB clarified in its "FAQs for Interim Processes for PTAB Workload Management" that "[i]t is most helpful if an expert is providing focused testimony, for example to provide helpful context or to explain terms of art." *See also GD Energy Products, LLC v. Kerr Machine Co.*, IPR2025-00031, Paper 11, at 2 (P.T.A.B. June 25, 2025) (denying a request for discretionary denial where the

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expert testimony is merely complying with regulations requiring disclosure of “underlying facts or data”). Furthermore, use of expert testimony “to explain the background knowledge of a person of ordinary skill in the art” with “citations to evidence in support of [the expert’s] statements . . . weighs against discretionary denial.” *iRhythm Techs.*, IPR2025-00377, Paper 10, at 2-3.

Here, Dr. Morse’s declaration is entirely consistent with this guidance by providing context and explanations. Dr. Morse’s regular inclusion of annotated figures further assists the fact-finder in understanding and conceptualizing the relevant teachings of the prior art. Accordingly, this factor disfavors discretionary denial.

Patent Owner attempts to manufacture additional support under this factor by pointing to two sections of Dr. Morse’s declaration and falsely alleging that Dr. Morse attempts to fill in deficiencies of the prior art. First, Patent Owner claims that “Nakafushi does not reference the term ‘solenoid’ or anything akin to a solenoid” and that the Petition does not show how Nakafushi satisfies claim element [1.3]. RDD, 50. However, conspicuously absent from Patent Owner’s argument is any acknowledgement that for claim element [1.3] (which contains the “liquid cutoff solenoid” limitation), the Petition relies on Olmr for expressly teaching this limitation, in combination with Nakafushi. *See* Petition, 32-34.

In addition to Olmr’s express disclosure, Dr. Morse’s cited testimony explains why a POSA would have had the background knowledge to understand that Nakafushi itself discloses a liquid cutoff solenoid despite Nakafushi not using that express term to describe its cutoff. Ex. 1003, ¶¶104-09. Dr. Morse then continues by explaining the similarities between Nakafushi’s disclosure and Olmr’s disclosure—the latter of which expressly identifies its valve as a *solenoid*—and explains the POSA’s motivation to combine the disclosures and why a POSA would have had a reasonable expectation of success in doing so. *Id.*, ¶¶110-31. Notably, these latter two points are at least partially supported by Nakafushi’s disclosure of a solenoid in all but name, which provides the relevance of Dr. Morse’s discussion of Nakafushi’s solenoid structure at paragraphs 104-109 that Patent Owner complains about. In short, Dr. Morse nowhere uses his own testimony to fill in any “missing gaps” in the prior art, first and foremost because there are no missing gaps.

Second, Patent Owner similarly complains about Dr. Morse’s identification of a fuel regulator system in Nakafushi (RDD, 50), which is meritless for the same reasons. Just as with the liquid cutoff solenoid, Dr. Morse explains how a POSA would have had the background knowledge to understand that Nakafushi in fact discloses a fuel regulator system as called for in claim 11, albeit not called as such in Nakafushi. Petition, 56-57; Ex. 1003, ¶¶251-52. Dr. Morse then goes on to

explicitly identify the claimed fuel regulator systems having two regulators (or a single two-stage regulator) in both Parlatore and Jungmann. Ex. 1003, ¶¶253-59.

Dr. Morse concludes by explaining the motivation to combine Parlatore's and/or Jungman's teachings into Nakafushi, and why a POSA would have reasonably expected success in doing so. *Id.*, ¶¶260-65. Dr. Morse's testimony was cited to support the Petition's argument that claim 11 is obvious over Nakafushi in view of Jungmann and Parlatore. Petition, 53-63.

Thus, once again, Dr. Morse is clearly not using his own testimony to fill any "missing gaps" in the prior art as erroneously alleged by Patent Owner. Instead, he is explaining where the claim limitations are disclosed throughout the art (including in those cases where the prior art did not use the same terminology as the claims), and why it was obvious for a skilled artisan to have arrived at the claimed invention by combining the cited references without using hindsight. This is certainly not the type of faulty expert testimony that might favor discretionary denial, and does not favor discretionary denial here.

6. No Forum Has Adjudicated Any Claim of the '034 Patent, Which Weighs Against Discretionary Denial

No claim of the '034 Patent has been reexamined, the '034 Patent has not been reissued, and the '034 Patent claims have not been otherwise adjudicated in any other forum to Petitioners' knowledge. Nor are they expected to be

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adjudicated in any other forum before a FWD is expected to issue in this proceeding, if instituted. *See supra*, §III.B.

IV. SECTION 325(d) WEIGHS AGAINST DISCRETIONARY DENIAL

Patent Owner fails to establish that the Petition should be denied institution pursuant to 35 U.S.C. §325(d), as further discussed below.

A. The Prior Art in the Petition is Not the Same Nor Substantially the Same as the Art Previously Considered by the Office

a. The Kubota Workshop Manual is not cumulative of Tsuda

Patent Owner argues that the Kubota Workshop Manual is commensurate with Tsuda. RDD, 54-56. While Petitioners agree that both references describe the commercialized Kubota DF-972 dual-fuel engine,¹² there are important distinctions between the Workshop Manual and Tsuda relevant to the proceedings here.

First, Tsuda only discloses a vaporizer 32 for regulating the flow and pressure of LPG to the engine (Ex. 1018, 3:22-25, 7:8-11), but is silent as to whether this vaporizer comprises two pressure regulators or a dual-stage pressure regulator (*id.*, 7:33-38 (merely referencing “a” regulator)). Independent claim 11 of the '034 Patent, on the other hand, calls for a fuel regulating system comprising

¹² The DF-972 engine is exemplary of the system-based prior art that Petitioners' stipulations cover, such that the DF-972 engine itself would not be raised as part of a ground of invalidity in any of the litigations if this IPR is instituted and not terminated. *See* Ex. 2015, 1-2; Ex. 2026, 2; Ex. 2052, 1-2.

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both a primary pressure regulator and a secondary pressure regulator. Claim 17 makes clear that primary and secondary pressure regulators can be part of a dual stage regulator. While Tsuda is silent on these further details, this is precisely what the Workshop Manual discloses – a dual-stage pressure regulator having a primary regulator and a secondary regulator just as called for in claims 11 and 17. *See* Petition, 94-99, 102-03. For this reason alone, which is an issue Patent Owner does not even address, the Workshop Manual is not cumulative of Tsuda.

Second, claim 1 of the '034 Patent calls for liquid cutoff **solenoid**, while claims 14 and 18 call for carburetor cutoff **solenoids**. Similarly, claims 14 and 19 call for gaseous cutoff **solenoids**. These liquid/carburetor/gaseous “solenoid” requirements are particularly relevant here because throughout prosecution of the parent '398 Patent, Patent Owner repeatedly denied that Tsuda disclosed any solenoids, stating, for example, “Tsuda also provides no teaching of a **solenoid** valve that operates within the carburetor 1.” Ex. 1038, 375, 410; *see also id.*, 475 (“none of Poehlman, Tsuda, and/or Sugimoto teaches or suggests a solenoid valve that operates within the carburetor”).

Petitioners believe that a POSA would have recognized that Tsuda discloses both liquid/carburetor and gaseous cutoff solenoids for the same reasons as explained in regards to Nakafushi. *See* Ex. 1003, ¶¶104-09; Ex. 1018, 2:61-65, 3:22-52, Figs. 1, 3. However, during prosecution of the '034 Patent, after the

Examiner had repeatedly rejected the claims over Poehlman, Patent Owner filed an

Appeal Brief arguing:

while the Examiner has asserted that Poehlman discloses “a liquid cutoff solenoid (43) coupled to open and close a liquid fuel path to the engine [and] a gaseous cutoff solenoid (45) coupled to open and close a gaseous fuel source to the engine” (Final Office Action, p. 3), such an assertion distorts what is disclosed in Poehlman. Instead, Poehlman only discloses “a liquid fuel control valve 43 which is incorporated in the liquid fuel supply line 19, which is movable between open and closed positions, which is biased to the closed position, and which, in response to electrical energization, moves to the open position to afford liquid fuel flow to the engine 13” and “a gaseous fuel control valve 45 which is incorporated in the gaseous fuel supply line 25, which is movable between open and closed positions, which is biased to the closed position, and which, in response to electrical energization, moves to the open position to afford gaseous fuel flow to the engine.” Poehlman, Col. 3, ln. 64 to Col. 4, ln. 9. There is no disclosure in Poehlman that the liquid fuel control valve 43 and gaseous fuel control valve 45 are *solenoids* that are coupled to open and close a liquid fuel path to the engine and coupled to open and close a gaseous fuel source to the engine, as called for in claim 1.

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Ex. 1002, 73 (emphasis in original). As seen above, Patent Owner basically denied that anything disclosed in the prior art was a “solenoid” unless it was expressly described as such.

This position by Patent Owner provides yet another reason why the Kubota Workshop Manual is not cumulative of Tsuda. While Tsuda never used the word “solenoid” to describe its electromagnetically-actuated valves, the Workshop Manual makes clear that its liquid/carburetor and gaseous cutoff valves are, in fact, solenoids. *See* Petition, 76-79. With Patent Owner already on record as denying that Tsuda’s valves were solenoids, the Workshop Manual avoids such semantic arguments, even though Patent Owner’s argument regarding Tsuda is incorrect in the first instance.

Finally, when confronted with proposed §103 combinations during the prosecution of both the ’398 Patent and the ’034 Patent, in both cases the Patent Owner argued against the any §103-based combination resulting in a liquid/carburetor cutoff solenoid located downstream of the carburetor float bowl (*see, e.g.*, Ex. 1002, 37), including combinations including Tsuda (Ex. 1038, 466-67). Accordingly, because the Workshop Manual explicitly discloses a liquid/carburetor cutoff **solenoid located downstream of the float bowl**, no §103 combination is needed to address claims 1 and 18, further demonstrating that the Workshop Manual is not cumulative of Tsuda.

b. Nakafushi is not cumulative of Tsuda

Patent Owner similarly argues that Nakafushi is commensurate with Tsuda. RDD, 56. However, as noted previously, during prosecution of the parent '398 Patent, the Examiner (erroneously) concluded that Tsuda failed to teach a liquid cut-off incorporated into the carburetor. Ex. 1038, 511. Yet, such an arrangement is unmistakably taught by Nakafushi. *See* Petition, 30-32. Accordingly, one of two things must be true: either Nakafushi is not cumulative of Tsuda, or the Examiner materially erred in assessing Tsuda in the first instance.

While Petitioners' position is that the latter is true (*see supra*, §III.F.2), either way, the Petition's reliance on Nakafushi does not support discretionary denial since Nakafushi either highlights a material oversight by the Examiner, or it is not cumulative of Tsuda.

B. The Office Materially Erred in Overlooking Tsuda

As discussed previously (*supra*, §III.F.2), the Office materially erred in overlooking the teachings of Tsuda, specifically its disclosure of a liquid/carburetor cutoff solenoid located in the carburetor downstream of the float bowl. Patent Owner cannot have it both ways. To the extent that Patent Owner claims no error by the Examiner on the grounds that Tsuda allegedly does not disclose this feature, then Tsuda cannot be cumulative of the Kubota Workshop Manual (or Nakafushi) since the latter unmistakably discloses this feature. Petition, 76-78, 103.

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Discretionary denial is therefore unwarranted under §325(d). *See Ecto World*, IPR2024-01280, Paper 13, at 5 (“[A] petitioner may argue that it satisfies the second part of *Advanced Bionics* because the asserted prior art was not a basis for rejection during examination, is not substantially the same as prior art the Examiner applied, and includes specific teachings that impact patentability of the challenged claims.”).

V. CONCLUSION

For the foregoing reasons, the Director should reject Patent Owner’s request for discretionary denial, and Petitioners respectfully request that the Petition be submitted to the panel for review on the merits.

Date: August 29, 2025

Respectfully submitted,

By: *s/Michael R. Houston/*

Michael R. Houston

Reg. No. 58,486

FOLEY & LARDNER LLP

321 N. Clark St., Suite 3000

Chicago, Illinois 60654

mhouston@foley.com

Lead Counsel for Co-Petitioners

Counsel for Petitioner Harbor Freight

By: *s/Thomas J. Leach/*

Thomas J. Leach

Registration No. 53,188

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MERCHANT & GOULD P.C.
150 South Fifth Street, Suite 2200
Minneapolis, MN 55402
Counsel for Petitioner Generac

By: *s/Thomas Walsh/*

Thomas Walsh
Registration No. 45,196
ICE MILLER LLP
One American Square, Suite 2900
Indianapolis, IN 46282-0200
Counsel for Petitioner MWE

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on August 29, 2025, a true and correct copy of the foregoing **PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION** was filed through the PTACTs system along with service to the email addresses listed below:

Joseph W. Staley
Email: j.staley@pkhip.com
Scott P. Amy
Email: s.amy@pkhip.com
Thomas F. Finch
Email: t.finch@pkhip.com
Email: championlit@pkhip.com

Date: August 29, 2025

By: s/Michael R. Houston/

Michael R. Houston
Reg. No. 58,486
FOLEY & LARDNER LLP
321 N. Clark St., Suite 3000
Chicago, Illinois 60654
312-832-4500
mhouston@foley.com

*Counsel for Petitioner Harbor Freight
Lead Counsel for Co-Petitioners*