

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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

Petitioners,

v.

CHAMPION POWER EQUIPMENT, INC.,

Patent Owner.

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U.S. Patent No. 11,905,895

Issued: February 20, 2024

Title: DUAL FUEL LOCKOUT SWITCH FOR GENERATOR ENGINE

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*Inter Partes* Review No. IPR2025-01384

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

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## UPDATED EXHIBIT LIST

Exhibit	Description
<b>Ex.1001</b>	U.S. Patent No. 11,905,895 (“the ’895 Patent”)
<b>Ex.1002</b>	File History of the ’895 Patent
<b>Ex.1003</b>	Declaration of Mahdi Shahbakhti
<b>Ex.1004</b>	U.S. Patent No 1,931,698 to Holzapfel (“Holzapfel”)
<b>Ex.1005</b>	LP-Gas Code Handbook, Eighth Edition, Lemoff, Theodore C., (2008) (excerpted) (“LP-Gas Handbook”)
<b>Ex.1006</b>	2-Stage Regulator Assembly (“2-Stage Assembly”) with WayBack Machine certification
<b>Ex.1007</b>	<i>American Heritage Dictionary of the English Language</i> (3d ed. 1996).
<b>Ex.1008</b>	File History of U.S. Patent No. 10,221,780
<b>Ex.1009</b>	Champion’s Claim Construction Brief CV-23-2371-PHX-DWL
<b>Ex.1010</b>	DuroMax XP4400EH Operator’s Manual (“DuroMax”)
<b>Ex.1011</b>	Declaration of David Raskin (dated May 7, 2025)
<b>Ex.1012</b>	U.S. Patent No. 5,718,265 to Elsdon (“Elsdon”)
<b>Ex.1013</b>	U.S. Patent Application No. 2011/0100335 A1 to Parlatore (“Parlatore”)
<b>Ex.1014</b>	U.S. Patent No. 4,492,207 to Hallberg (“Hallberg”)
<b>Ex.1015</b>	“Convert Blackmax 7000 Watt Generator to Propane and Natural Gas,” YouTube Video, posted October 11, 2013 ( <i>available at</i> <a href="https://www.youtube.com/watch?v=Ip7ckWAZ3xQ">https://www.youtube.com/watch?v=Ip7ckWAZ3xQ</a> )
<b>Ex.1016– Ex.1054</b>	Reserved.
<b>Ex.1055</b>	Order on Defendant/Counter-Claimant’s Motion for Partial Stay, <i>FaceTec, Inc. v. iProov, Ltd.</i> , No. 21-cv-2252, Dkt. 188 (D. Nev., order dated June 18, 2025)
<b>Ex.1056</b>	Docket Navigator Statistics Regarding Judge Adelman’s Grant Rate for Motions to Stay
<b>Ex.1057</b>	Docket Navigator Statistics Regarding Grant Rate for Motions to

	Stay in Eastern District of Wisconsin
<b>Ex.1058</b>	Docket Navigator Statistics Regarding Motions to Stay in District of Nevada
<b>Ex.1059</b>	Declaration of Eric Huang (dated Sept. 12, 2025)
<b>Ex.1060</b>	Order, <i>Parsons Xtreme Golf LLC v. Taylor Made Golf Co.</i> , No. 17-cv-3125, Dkt. 187 (D. Ariz., order dated Nov. 29, 2018)
<b>Ex.1061</b>	Email from Taylor R. Stemler to Jennifer Hoekel et al. (Aug. 13, 2025)
<b>Ex.1062</b>	Docket Navigator Statistics Regarding Grant Rate for Uncontested Motions to Stay in Eastern District of Wisconsin
<b>Ex.1063</b>	Docket Navigator Statistics Regarding Grant Rate for Uncontested Motions to Stay in District of Nevada
<b>Ex.1064</b>	Docket Navigator Time to Trial Statistics for District of Nevada
<b>Ex.1065</b>	Docket Navigator Time to Milestone Statistics for Judge Adelman
<b>Ex.1066</b>	Docket Navigator Time to Milestone Statistics for Eastern District of Wisconsin
<b>Ex.1067</b>	Docket Navigator Time to Milestone Statistics for Central District of California
<b>Ex.1068– Ex.1069</b>	Reserved.
<b>Ex.1070</b>	Memorandum in Support of Plaintiff’s Motion to Sever Defendant’s Counterclaims for Infringement or in the Alternative for Leave to File an Amended Answer and Counter-Counterclaim, <i>Champion Power Equipment, Inc. v. Generac Power Systems, Inc.</i> , No. 24-cv-1281, Dkt. 38 (E.D. Wis. July 3, 2025)
<b>Ex.1071– Ex.1079</b>	Reserved.
<b>Ex.1080</b>	Champion Dual Fuel Generator Model 100153 Operator’s Manual
<b>Ex.1081– Ex.1082</b>	Reserved.
<b>Ex.1083</b>	Amended Scheduling Order, <i>Champion Power Equipment, Inc. v. Generac Power Systems, Inc.</i> , No. 24-cv-01281, Dkt. 59 (E.D. Wis. Sept. 17, 2025)

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<b>Ex.1084</b>	Champion's Infringement Contentions for U.S. Patent No. 11,905,895 as Asserted Against Generac Model DF3500E et al. (served Apr. 15, 2025)
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**GLOSSARY**

<b>Abbreviation</b>	<b>Term</b>
“034 IPR”	Petition for Inter Partes Review of U.S. Patent No. 10,393,034 (IPR2025-00805)
“034 Referral Decision”	Decision Denying Patent Owner’s Request for Discretionary Denial of Institution of Inter Partes Review of U.S. Patent No. 10,393,034 (IPR2025-00805, Paper 20)
“034 Institution Decision”	Decision Granting Institution of Inter Partes Review of U.S. Patent No. 10,393,034 (IPR2025-00805, Paper 24)
“101 IPR”	Petition for Inter Partes Review of U.S. Patent No. 10,598,101 (IPR2025-00951)
“101 Referral Decision”	Decision Denying Patent Owner’s Request for Discretionary Denial of Institution of Inter Partes Review of U.S. Patent No. 10,598,101 (IPR2025-00951, Paper 18)
“101 Institution Decision”	Decision Granting Institution of Inter Partes Review of U.S. Patent No. 10,598,101 (IPR2025-00951, Paper 22)
“780 Patent”	U.S. Patent No. 10,221,780
“895 Patent”	U.S. Patent No. 11,905,895
“Board”	Patent Trial and Appeal Board
“Firman”	Firman Power Equipment Inc.
“Generac”	Generac Power Systems, Inc.
“Harbor Freight”	Harbor Freight Tools USA, Inc.
“MWE”	MWE Investments, LLC
“Patent Owner” and “Champion”	Champion Power Equipment, Inc.
“Petition”	Petition for Inter Partes Review of U.S. Patent No. 11,905,895 (Paper 4)
“Petitioners”	MWE, Harbor Freight, and Generac
“POSA”	Person of Ordinary Skill in the Art

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“Request for Discretionary Denial” and “RDD”	Patent Owner’s Request for Discretionary Denial of Institution of Inter Partes Review of U.S. Patent No. 11,905,895 (Paper 11)
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## I. INTRODUCTION

Petitioners oppose Patent Owner’s Request for Discretionary Denial. The Director referred both the family-member ’034 IPR and the “closely related”<sup>1</sup> ’101 IPR for a decision on institution. ’034 Referral Decision; ’101 Referral Decision. Discretionary denial also is not appropriate here. *Id.*

In the ’034 IPR and ’101 IPR, the Director cited the following: “[T]he district court litigations involved thirteen patents asserted in multiple district courts”; “Because the litigation between the parties would proceed to several district court trials in different jurisdictions, resolving the dispute between the parties at the Office would be more efficient”; and “In addition, no trial date has been set in any of the parallel proceedings, and the parties have made relatively little investment into the multi-district litigation.” ’034 Referral Decision at 2; ’101 Referral Decision at 2 (incorporating analysis from ’034 Referral Decision). Each of these characteristics of the ’034 Referral Decision and ’101 Referral Decision are present here, and this alone is sufficient for referral of this Petition for a decision on institution.

In addition, Champion’s inconsistent arguments on the meaning of “mechanical fuel valve” led to the Examiner’s material error due to misinterpretation of the prior art and improper allowance.

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<sup>1</sup> See IPR2025-00951, Paper 8 (Patent Owner describing its 2015 and 2013 Patent families as “closely related”).

Finally, Champion has not developed settled expectations that its patent would not be challenged, and none of the *Fintiv* factors<sup>2</sup> favor discretionary denial. In fact, a majority of the *Fintiv* factors weigh strongly against discretionary denial.

In sum, when holistically assessing the facts, evidence, circumstances, and other considerations, discretionary denial of this Petition is not appropriate.

## **II. GIVEN THE NUMBER OF DISTRICT COURT TRIALS IN DIFFERENT JURISDICTIONS, RESOLVING THE DISPUTE AT THE PTAB IS MORE EFFICIENT**

Patent Owner has asserted thirteen different patents against 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, 7–9. All thirteen patents are the subject of IPR petitions filed collectively by Petitioners to streamline the invalidity challenges in a single set of IPR proceedings and ensure consistency on the invalidity determinations. “Because the litigation between the parties would proceed to several district court trials in different jurisdictions, resolving the dispute between the parties at the Office would be more efficient.” ’034 Referral Decision at 2. Allowing this IPR to proceed represents the epitome of efficient and appropriate use of Board resources. The alternative is having four different jury trials proceed to assess

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<sup>2</sup> *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 5–6 (PTAB Mar. 20, 2020).

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invalidity of the asserted patents in four different district courts. Such piecemeal adjudication creates a very high likelihood of inconsistent outcomes. The Board is better positioned to grasp and efficiently handle a single set of challenges to many patents from two different patent families involving complicated aspects of multi-fuel engine/generator designs. The efficiencies to be gained by consolidating Petitioners' district court invalidity proceedings into a single set of proceedings before the PTAB is a highly appropriate use of Board resources, and reason enough by itself to refuse discretionary denial. *Berkshire Hathaway Energy Co. v. Olson, Edwins.*, IPR2025-0274, Paper 23, at 2–3 (PTAB July 2, 2025); *Shenzhen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc.*, IPR2025-00438, Paper 10, at 3 (PTAB July 17, 2025) (referring to the Board where the district court proceeding involved a “large number and vast scope” of patents). The family-member '034 IPR and closely related '101 IPR already were referred for a decision on institution based on these efficiencies. This IPR also should be referred to realize those efficiency gains. *Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12, at 3-4 (PTAB July 26, 2025); *Advanced Micro Devices, Inc., et al. v. Concurrent Ventures, LLC et al.*, IPR2025-00478, Paper 10, at 3 (PTAB July 31, 2025) (“[T]he parallel district court proceeding between Petitioner and Patent Owner involves other patents that have been referred to the Board...Under these circumstances, it is an efficient use of Board resources to address the challenged patent as well.”).

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### **III. MATERIAL ERROR DURING PROSECUTION WEIGHS AGAINST DISCRETIONARY DENIAL**

Material error during prosecution also weighs 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 (PTAB July 17, 2025); *Microsoft Corp. v. ParTec Cluster Competence Ctr. GmbH*, IPR2025-00318, Paper 9, at 3 (PTAB June 12, 2025); *see also Tesla, Inc. v. Charge Fusion Techs., LLC*, IPR2025-00152, Paper 11, at 2-3 (PTAB June 12, 2025); *Anthony Inc. v. ControlTec, LLC*, IPR2025-00559, Paper 12, at 2 (PTAB July 16, 2025); *Microsoft Corp. v. XI Discovery, Inc.*, IPR2025-00253, Paper 13, at 2 (PTAB June 25, 2025).

The Examiner issued no substantive rejection of the pending claims of the '895 Patent, which overlap extensively with the limitations in the parent '780 Patent. Ex.1002, 45–50. During prosecution of the parent '780 Patent, facing an anticipation rejection over Champion's Model 100153 Operator's Manual for the commercial embodiment of the '101 Patent (Ex.1080), Champion argued that the "mechanical fuel valve" limitation is not met because the manual discloses separate valves for separate fuel sources. Ex.1008, 195–197. Champion argued that the "mechanical fuel valve" must be a single valve.

Champion took a contradictory position in the Generac litigation when it argued in its infringement contentions that Generac's two separate valves in its fuel selector assembly meets the "mechanical fuel valve" limitation of the '895 Patent

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claims. Ex.1084, 5–7. If this is the case, then the two-valve arrangement in Champion’s prior art generator manual also should have been construed to meet this limitation for the same reasons as Champion now argues that Generac’s two-valve arrangement meets this limitation. In *Sun Pharmaceuticals v. Nivagen Pharmaceuticals*, IPR2025-00893, Paper 18, at 2–3 (PTAB, September 19, 2025) the Director found that petitioner inconsistency in claim construction positions is a factor in favor of discretionary denial. Symmetry and equity demand that ***Patent Owner inconsistency*** in claim construction positions, as is the case here, should be a factor ***against*** discretionary denial.

In view of Champion’s inconsistent positions on the meaning of “mechanical fuel valve” in the ’895 Patent, allowance of the ’895 Patent over the Champion manual was in error.

#### **IV. SETTLED EXPECTATIONS WEIGH AGAINST DISCRETIONARY DENIAL**

The ’895 Patent issued in 2024 and has been in force for less than two years— not long enough to establish a legitimate claim to settled expectations. Challenges to patents in force four times that duration are consistently characterized as “early” and “favor[ing] robust predictable patent rights and weigh[ing] against discretionary denial.” *See, e.g., Tanklogix v. Sitepro*, IPR2025-00650, Paper 10, at 2 (PTAB Jul. 31, 2025); *Cambridge Indus. USA, Inc. v. Applied Optoelectronic, Inc.*, IPR2025-00434, -00436, Paper 11, at 2–3 (PTAB June 26, 2025); *Berkshire Hathaway*,

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IPR2025-00274, Paper 23, at 3; *Webgroup Czech Republic, A.S. et al., v. Dish Technologies LLC.*, IPR2025-00467, Paper 14, at 2 (PTAB July 16, 2025). Patent Owner appears to believe that it had settled expectations in the '895 Patent upon issuance because of its parent patents. RDD, 4–7. But Patent Owner does not have settled expectations in the parent patents. The family-member '034 Patent (IPR2025-00805) was issued in 2019—years earlier than the '895 Patent—and was referred for a decision on institution, and *Inter Partes* Review of the '034 Patent was instituted. '034 Referral Decision; '034 Institution Decision. The closely related '101 Patent that issued in 2020 was referred for a decision on institution, and *Inter Partes* Review of the '101 Patent was instituted. '101 Referral Decision; '101 Institution Decision.

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 related patent's claims. *See Padagis*, IPR2025-00464, Paper 12, at 3–4 (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 (PTAB July 31, 2025).

Moreover, Patent Owner's prior communications with Petitioners gave rise to an expectation of IPR filings. Patent Owner sent “cease-and-desist” letters to MWE

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and Generac in 2020, alleging infringement of the '101 Patent (Ex.2033; Ex.2036), which is not even in the same family as the '895 Patent. Patent Owner did not raise the '101 Patent with Harbor Freight until a March 27, 2024, letter, which did not even accuse Harbor Freight of infringing the '101 Patent. Ex.2038, 2. In response to the 2020 letters, both MWE and Generac informed Patent Owner that its claims were invalid. Ex.2034, Ex.2035, Ex.2037. MWE even told Patent Owner that it *would file an IPR* if Patent Owner further pursued its dubious infringement claims (Ex.2034). Tellingly, prior to embarking on its current litigation campaign (initiated four years after its last communications on the matter), Patent Owner never again raised the infringement issues with either MWE or Generac. 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 the '101 Patent 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. And that is exactly what has transpired.

#### **V. FINTIV FACTORS WEIGH AGAINST DISCRETIONARY DENIAL**

None of the *Fintiv* factors favor discretionary denial, and a majority of the *Fintiv* factors weigh strongly against discretionary denial. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 5-6 (PTAB Mar. 20, 2020). 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. Patent Owner focuses on whether the parallel proceedings have *already* been stayed (RDD, 10-11), but this factor considers how the district courts will *likely* rule on a motion to stay. *See iRhythm Techs., Inc., v. Welch Allyn, Inc.*, IPR2025-00377, Paper 10, at 2–3 (PTAB June 6, 2025). The data shows that stays will likely be granted.

**1. The MWE, Generac, and Harbor Freight Cases**

The MWE case is pending in the District of Nevada before Judge Traum. Judge Traum has granted a contested motion to stay on similar facts. *See FaceTec, Inc. v. iProov, Ltd.*, No. 2:21-cv-02252, Dkt. 188 (D. Nev. June 18, 2025) (attached as Ex.1055). And this district has granted stays 67% of the time. Ex.1058.

The Generac case is pending in the Eastern District of Wisconsin before Judge Adelman. Judge Adelman has granted contested motions to stay 70% of the time (Ex.1056), which is comparable to the district’s average grant rate of 73% (Ex.1057).

The Harbor Freight case is pending in the Central District of California. This district has granted stays at a 66% rate (Ex.1059, ¶5, Ex. B, 12).

Furthermore, both Generac and Harbor Freight have had meet-and-confers

with Patent Owner regarding their intention to seek stays of their litigations.<sup>3</sup> In both cases, Patent Owner instead indicated an openness to stays should the IPRs not be discretionarily denied (Ex.1059, ¶4; Ex.1061, 1), creating a high likelihood the MWE, Generac, and Harbor Freight cases will be stayed. *See, e.g.*, Ex.1062 (showing that all uncontested stays have been granted in EDWI); Ex.1063 (showing that all uncontested stays have been granted in Nevada).

## 2. The Firman Case

Firman is not a petitioner, privy, or real-party-in-interest, which alone weighs against discretionary denial. *POSCO Co. v. ArcelorMittal*, IPR2025-00370, Paper 10, at 2–3 (PTAB June 25, 2025). To the extent Firman’s case is considered, it weighs against discretionary denial because the presiding judge has granted a motion to stay on similar facts. *See Parson Xtreme Golf LLC v. Taylor Made Golf Co. Inc.*, No. 17-cv-03125, ECF No. 187 (D. Ariz. Nov. 29, 2018) (attached as Ex.1060).

### **B. Factor 2—Parallel Trial Date—Weighs Against Discretionary Denial Because the Board is Likely to Issue a Final Written Decision Before the District Court Proceedings Reach Trial**

Factor 2, focused on the timing of parallel proceeding trial dates, weighs against discretionary denial. None of the three parallel litigations involving

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<sup>3</sup> A motion to transfer venue is pending in the MWE case. *Champion Power Equip., Inc. v. Westinghouse Elec. Corp.*, No. 25-cv-00239, Dkt. 35 (D. Nev. Aug. 11, 2025). MWE intends to seek a stay once venue has been settled.

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Petitioners have scheduled trial dates, and a FWD will almost certainly issue well before these cases reach trial. Even the case involving non-petitioner Firman is running behind schedule, suggesting that its trial date will fall well after the FWD.

### **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. *USAA Federal Savings Bank v. PACid Techs., LLC*, IPR2025-00697, Paper 9, at 2 (PTAB Aug. 14, 2025); *Google LLC v. Withrow Networks Inc.*, IPR2025-00775, Paper 10, at 2 (PTAB Aug. 14, 2025).

Regarding the MWE case, the average time to trial in Nevada is 53 months, with a median of 42 months. Ex.1064. Even using the shorter median, the data suggests a trial date at the end of 2028, nearly two years after the FWD.

Regarding the Generac case, Judge Adelman has presided over one patent case since 2008, which took 43 months to reach trial. Ex.1065. A similar timeline here would place trial around April 2028—over a year after the FWD. Even if the district’s overall median time-to-trial of 34 months is considered (Ex.1066), trial would not be expected to occur until August 2027, five months after the FWD. The Generac court also recently extended its case schedule, further delaying this parallel proceeding. Ex.1083.

Regarding the Harbor Freight case, Patent Owner references a prior proposed schedule (RDD, 8-9), but fails to mention that this proposal was filed with a different judge and never adopted. With a median time to trial of 35 months, trial is projected to occur in September 2027, six months after the FWD. Ex.1067, 1.

## 2. The Firman Case

Patent Owner alleges that the Firman trial will occur before the FWD date. RDD, 8. While time-to-trial statistics in a vacuum may suggest a trial date around the same time as the FWD, the Firman case is already running significantly behind schedule. Specifically, statistics indicate a median time to claim construction of 15.7 months (Ex.2047, 1–2), suggesting that a *Markman* ruling should have occurred in February 2025. Yet now, as of November 2025, a *Markman* hearing has yet to occur or even be scheduled. Thus, the Firman case is already running at least *eight months* behind schedule compared to Patent Owner’s relied-upon statistics. As a result, any trial in the Firman case will likely occur well after the FWD. Moreover, discretionary denial is unsupported because Petitioners are not a party to the Firman case, and Firman is not a privy or real-party-in-interest in this IPR. *POSCO*, IPR2025-00370, Paper 10, at 2–3.

### 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

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involving the Petitioners are all at very early stages. For example, even Patent Owner admits that the MWE case is still in its infancy. RDD, 12. Similarly, Patent Owner recently described the Generac case as being in its “infancy.” Ex.1070, 13–15. Patent Owner should not be allowed to take a contradictory position before the Board simply to suit its needs here.

Substantial work remains in the Harbor Freight case, as the court has not yet issued a protective order, document discovery has yet to begin in earnest, there are no scheduled dates currently entered by the Court, and the parties have not conducted any fact depositions or any substantive discovery, let alone prepared for trial. While the Harbor Freight court issued tentative constructions on October 15, 2025, it also ordered supplemental briefing before issuing any final claim construction ruling. Ex.1084. 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. Cont’l Intermodal Grp. – Trucking LLC*, IPR2019-01393, Paper 24, at 10–11 (PTAB June 16, 2020).

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 there is no invalidity argument based on the prior art combinations presented in this IPR, has any bearing on *Fintiv* Factor 3 here.

**D. Factor 4—Lack of Overlap in the 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<sup>4</sup> that will eliminate overlap between the district court proceedings and this IPR (as well as the related IPRs). Specifically, Petitioners have stipulated that they will forego invalidity challenges involving:

- (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.2083; Ex.2084; Ex.2085.

These stipulations extend far beyond the more typical *Sotera*-type stipulation

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<sup>4</sup> *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, at 18–19 (PTAB Dec. 1, 2020) (precedential as to §II.A) (“*Sotera*”).

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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 Shenzhen*, IPR2025-00438, Paper 10, at 3 (rejecting discretionary denial request where petitioner has “filed a broad stipulation”); *Tesla, Inc. v. Sec’y of the Navy ex rel. United States*, IPR2025-00341, Paper 12, at 2 (PTAB June 13, 2025) (same); *Tesla, Inc. v. Intell. Ventures II*, IPR2025-00339, Paper 10, at 2 (PTAB June 13, 2025) (same).

Patent Owner inexplicably claims that “the stipulations do little to narrow the issues before the district courts.” RDD, 13. This absurd claim is refuted simply by considering the alternative—if the Board refuses to institute these IPRs, then ***four separate district courts*** will each have to separately adjudicate ***all*** of the invalidity issues raised by the individual defendants in each case. 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. As the Director already found with respect to the ’034 Patent and ’101 Patent, this factor clearly weighs strongly against discretionary denial. ’034 Referral Decision; ’101 Referral Decision; *Berkshire*

**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 40 times. Yet Firman is conspicuously absent from Patent Owner’s discussion of this factor. RDD, 15. 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 with respect to the Firman case, where Petitioners are not a party. Given Patent Owner’s extensive attempt to rely on the Firman case in its arguments, this fact weighs *Fintiv* Factor 5 against discretionary denial. *Cf. POSCO*, IPR2025-00370, Paper 10, at 2.

**F. Factor 6—Other Considerations—Weigh Against Discretionary Denial**

Multiple considerations under Factor 6 weigh strongly against discretionary denial. Patent Owner’s arguments for Factor 6 (RDD, 15–16) overlook or sidestep the most important considerations, as discussed below.

**1. 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, 15. In fact, the merits of the Petition are strong and include well-grounded theories of invalidity.

**2. No Forum Has Adjudicated Any Claim of the '895 Patent, Which Weighs Against Discretionary Denial**

The '895 Patent's claims have not been reexamined, reissued, or otherwise adjudicated in any other forum to Petitioners' knowledge, nor are they expected to be adjudicated in any other forum before a FWD is expected to issue in this proceeding, if instituted. §V.B, *supra*.

**VI. 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). In determining whether to discretionarily deny a petition under §325(d), Office policy requires a determination of “(1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential).

The limitations in the claims of the '895 Patent overlap extensively with the limitations in the claims of the parent '780 Patent. None of the prior art cited in the Petition was cited during the prosecution of the '895 Patent or the '780 Patent. *Microsoft v. ParTec*, IPR2025-00318, Paper 9 at 2–3 (finding discretionary denial

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under § 325(d) is inappropriate where there was “persuasive evidence that the Office erred in a manner material to the patentability of the challenged claims by overlooking the teachings of” prior art that were not presented to the patent examiner.); *see also Ecto World LLC v. Rai Strategic Holdings Inc.*, IPR2024-01280, Paper 13 at 5 (PTAB May 19, 2025) (precedential) (citing *Advanced Bionics* at 10).

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

The Examiner issued no substantive office action during the prosecution of the '895 Patent, issuing just a single rejection on double patenting grounds. Ex.1002, 45–50. Only two prior art references are listed on the face of the '895 Patent, (Ex.1001, 1), and even those were only “made of record and *not relied upon*” by the examiner. Ex.1002, 50 (emphasis added). Patent Owner cannot justify its argument that DuroMax, Hallberg, LP-Gas Handbook, Parlatore, and Elsdon are cumulative to art already considered during prosecution (RDD, 16–19) at least because none of these references was cited in the prosecution of the '895 Patent, or its parent applications, much less relied on or consider by the Examiner. The fact that there are so many closely related prior art references describing mechanical fuel lockout switches for a dual fuel engine demonstrates how ubiquitous Champion’s purported “invention” was prior to the 2015 priority date of the '895 Patent.

Patent Owner alleges that DuroMax is “substantially the same as (1) the YouTube Video of the Honda EU20i generator (“EU20i Video”) (Ex.2075;

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Ex.2076), and (2) U.S. Publication No. 2002/0134362 (“Deutsch”). Ex.2060, [0010]. RDD 17. Neither reference was relied upon or even cited by the examiner in the ’895 Patent. Moreover, neither reference was considered in combination with Elsdon, as DuroMax is here.

Patent Owner attempts to dismiss Hallberg because it, like Sugimoto, describes dual fuel engines that uses a valve control and a switch that operate a cable to select one of a gasoline or propane fuel source. RDD at 17–18. Hallberg predates Sugimoto by more than twenty years. During prosecution of the parent ’780 Patent, Patent Owner repeatedly (though incorrectly) argued that Sugimoto did not disclose a “fuel lockout apparatus coupled to the mechanical fuel valve.” Ex.1008, 129. Hallberg expressly discloses that the fuel lockout apparatus is coupled to the mechanical fuel valve, where control cable 302 couples the fuel lockout apparatus comprising fluid dual value control 301 and control cable 302 to the mechanical fuel valve. Ex.1014, FIG 1.

Patent Owner suggest that Elsdon is “substantially similar” to the unexamined and uncited Conroy reference because it “discloses a removable fuel cap on threaded opening 26 on fuel tank 22.” RDD at 18–19. Patent Owner includes a citation to “[o]ther previously-considered references” without discussion. *Id.* Patent Owner ignores Elsdon’s disclosure of a fuel conduit coupler shield 14 and cap 16 that when closed prevents coupling of a fuel source. Ex.1005, 3:3–14. This feature is not

present in Conroy, and therefore Elsdon is not cumulative.

Patent Owner's attack on Parlatore is that the uncited the EU20i Video prior art reference also discloses "remote propane tank with two pressure regulators and a supply hose." RDD at 18. Petitioners rely on Parlatore as a reference for elements that the Examiner in the '780 Patent found "are extremely old and well-known in the art." *See, e.g.*, Ex.1008 at 50. Likewise, while the LP-Gas Handbook discloses well-known features in the art, nothing in the threadbare prosecution of the '895 Patent claims discloses the quick connectors. Moreover, Parlatore and the LP-Gas Handbook become centrally relevant in the Petition after they are combined with DuroMax, Elsdon, and/or Hallberg.

Since the Examiner did not have DuroMax, Hallberg, LP-Gas Handbook, Parlatore, or Elsdon, or the support of an expert declaration explaining a POSA's understanding of these references, the Examiner did not have the opportunity to consider the arguments raised under the grounds presented in the Petition.

**B. The Office Erred During Prosecution.**

Material error during prosecution also weighs heavily against discretionary denial, often overcoming facts that would otherwise have resulted in a *Fintiv* denial. *See Xencor*, IPR2025-00604, Paper 12, at 2–3. Here, the '895 Patent, like its parent the '780 Patent, should not have been allowed over the Champion manual based on Champion's inconsistent positions on the meaning of "mechanical fuel valve."



**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on November 25, 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 P-TACTS system along with service to the email addresses listed below:

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