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13
14 UNITED STATES DISTRICT COURT
15 DISTRICT OF ARIZONA
16

17 Champion Power Equipment, Inc.,

18 Plaintiff,

19 v.

20 Firman Power Equipment Inc.,

21 Defendant.
22

Case No. 2:23-cv-02371-DWL

**FIRMAN POWER EQUIPMENT
INC.'S INVALIDITY CONTENTIONS**

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I. INTRODUCTION

Pursuant to the Court’s Case Management Order (Doc. 33), Defendant Firman Power Equipment Inc. (“Firman”) provides these preliminary Invalidity Contentions (collectively, “Contentions”).

In this case, Plaintiff Champion Power Equipment Inc. (“Champion”) asserts certain claims of U.S. Patent No. 10,393,034; U.S. Patent No. 10,598,101; U.S. Patent No. 11,143,120; U.S. Patent No. 11,143,145; U.S. Patent No. 11,306,667; U.S. Patent No. 11,761,390; U.S. Patent No. 11,905,896; U.S. Patent No. 10,697,398; U.S. Patent No. 11,492,985; U.S. Patent No. 11,530,654; U.S. Patent No. 11,840,970; U.S. Patent No. 10,221,780; and U.S. Patent No. 11,905,895 (collectively, “Asserted Patents”).

Firman’s discovery and investigation in connection with this lawsuit are continuing and, thus, these Contentions are based on knowledge and information presently available to Firman. Firman reserves the right to amend and/or supplement these Contentions (including, without limitation, in the event that additional information is identified during the course of discovery, after the Court has construed the claims of the Asserted Patents, after Champion and/or its expert witness(es) disclose their positions and opinions, and/or in response to any amendment by Champion of its Infringement Contentions).

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II. PRIOR ART INVALIDITY

Firman identifies the following prior art references that anticipate and/or render obvious the asserted claims of the Asserted Patents.

Appendix A identifies prior art patents by patent number, country of origin, date of issue, and production number.

Appendix B identifies prior art publications by title, date (or estimated date) of publication, and where feasible, author and publisher, as well as production number.

Appendix C identifies prior art in the form of sales, offers for sale, or uses by specifying the item offered for sale or publicly used or known, the date (or estimated date) the offer or use took place or the information became known, and the identity of

1 the person or entity which made the use or which made and received the offer, or the
2 person or entity which made the information known or to whom it was made known,
3 and production number if available.

4 **A. Anticipation**

5 These Contentions rely on (without conceding) the priority dates of each of the
6 Asserted Patents as asserted by Champion in its Infringement Contentions as the earliest
7 possible priority date Champion asserts. Champion, however, has failed to respond to
8 discovery seeking Champion's alleged support for its contentions. To the extent
9 Champion alters its priority claim when it provides the requested support, Firman
10 reserves the right to amend its contentions accordingly.

11 To the extent the exemplary references describe various implementations of the
12 same underlying system, that underlying system is a single reference under 35 U.S.C.
13 §§ 102(a), 102(b), and/or 102(g). The exemplary references are evidence of the
14 capabilities of the prior art system, and each chart provided for a prior art system should
15 be understood to incorporate by reference all printed publications describing or relating
16 to that prior art system and all charts provided for those printed publications. Even if the
17 exemplary references are not treated as a single prior art reference, it would have also
18 been obvious to combine the features described in those references because the
19 individual references discuss the same system.

20 The cited portions of prior art references are exemplary and representative of the
21 content of the prior art references, and should be understood in the context of the
22 reference as a whole, as understood by one of ordinary skill in the art. The patents and
23 patent publications listed above are representative and incorporate related patent
24 applications, patent publications, and issued patents. For example, in some cases
25 Firman charts patent application publication, but pursuant to 35 U.S.C. 102, the issued
26 patent resulting from the application would be prior art for the same reason. Firm thus
27 intends its citations to the location in the patent application publication to refer to the
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1 same relative location in the issued patent, and vice versa where Firman charts a patent
2 rather than a patent application publication.

3 Firman's charts include citations to exemplary translations of foreign language
4 reference (which are being produced with these Invalidity Contentions). These citations
5 are for exemplary and for illustrative purposes only. Firman relies on the original
6 references, rather than after cited translation, as prior art.

7 In addition, Firman incorporates prior art references of record in the prosecution
8 of the Asserted Patents and related applications, as well as prior art discussed in the
9 specifications of the Asserted Patents.

10 Nothing in these Contentions should be construed as an admission that the
11 asserted claims are infringed by any accused product, that any particular feature or
12 aspect of any of the accused products practices any elements of the asserted claims, or
13 that Champion's apparent claim constructions are supportable or proper. These
14 Contentions address the apparent constructions and interpretations that Champion is
15 relying on for its infringement contentions, and Firman reserves its right to dispute any
16 such interpretations. Therefore, to the extent the prior art discloses the same features
17 and functionality that Champion has identified in its infringement contentions, Firman
18 reserves the right to argue that the features or functionality do not practice any element
19 of any of the asserted claims.

20 To the extent Firman cites or quotes any exemplary portion of any prior art
21 reference with respect to a particular claim limitation in any of the attached charts,
22 Firman reserves the right to rely on such portion of the prior art reference (and any
23 similar disclosure in the reference) for all purposes with respect to such claim limitation
24 (including, but not limited to, in connection with any other invalidity defense involving
25 such prior art reference), any related claim limitation, and any substantially similar
26 limitation(s) of any other claim(s). Firman reserves the right to identify additional
27 portions in the same prior art disclosed herein to support its invalidity theories. Firman
28 also reserves the right to rely on uncited portions of the prior art references and on other

1 publications and testimony as aids in understanding and interpreting the cited portions,
2 as providing context for the state of the art and knowledge of persons skilled in the art,
3 as additional evidence that a claim is known or disclosed, and as evidence supporting
4 obviousness. Firman's identification of any portion of a prior art reference with respect
5 to any limitation of any claim of any asserted patent is not an admission that such
6 limitation satisfies the requirements of 35 U.S.C. § 112.

7 Firman intends to take discovery concerning the prior art and the invalidity of the
8 Asserted Patents, including for example, testimony from authors or named inventors of
9 the identified prior art, testimony from other individuals associated with the identified
10 prior art, or additional evidence concerning the identified prior art. Each exemplary
11 printed publication describing or relating to a prior art system should be understood to
12 discuss the system's capabilities generally and also to discuss specific implementation
13 examples of specific installations of the particular system, which, upon information and
14 belief, was made, used, known, and on sale before the priority date of the Asserted
15 Patents; thus, the making, using, knowledge of, and/or sale of the system is itself
16 invalidating prior art.

17 Pursuant to the Court's Case Management Order (Doc. 33), Firman's invalidity
18 contentions respond to Champion's infringement contentions. Champion's
19 infringement contentions accused numerous Firman products, but have mapped only
20 two such products. For example, Champion provided a single claim chart mapping a
21 single product, but alleges that chart is sufficient to allege infringement against the
22 Model H05751, Model H03651, Model H03652, Model H03654, Model H05752,
23 Model H05753, Model H05754, Model H07552, Model H07553, Model H07554,
24 Model H08051, Model H08052, Model H08053, Model T04073, Model T07571, Model
25 T07571F, Model T07573, Model T08071, Model T08072, Model T09275, Model
26 T09371, Model WH03562OF, and Model WH03662OF. Similarly, Champion provided
27 a single claim chart mapping a single product, but alleges that chart is sufficient to
28 allege infringement against Model WH02942, Model WH02942F, Model WH03041,

1 Model WH03042, Model WH03242, Model WH03342, Model WH03242F, and Model
 2 WH03344. Responding to Champion’s contentions, Firman therefore provides claim
 3 charts representing groups of references. The following table identifies each claim chart
 4 and the additional references Firman groups with that chart. Firman has grouped those
 5 references according to the chart below because those grouped references have similar
 6 disclosures located at similar places to the reference Firman has charted. Firman
 7 contends that all grouped references represent invalidating prior art for the same reasons
 8 it contends the corresponding charted reference represents invalidating prior art.

Ex.	Mapped Reference	Grouped Reference
1.	Bai	
2.	Bernhardsson	
3.	Cao	
4.	Champion 71532 Manual	Champion 100153 Manual (2014) Champion 100153 Device Champion 71532 Device Champion 71530 Manual Champion 71531 Manual Champion 76533 Manual Champion 76555 Manual Champion 100122 Manual Champion 100155 Manual Champion 100230 Manual Champion 100230 Manual Champion 71530 Device Champion 71531 Device Champion 76533 Device Champion 76555 Device Champion 100122 Device Champion 100155 Device Champion 100230 Device Champion 100230 Device
5.	Chen	
6.	Deng '518	Deng '277
7.	Deng '819	

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Ex.	Mapped Reference	Grouped Reference
8.	ECO8990E with Kit	ECO8990E ECO8990E Gas Kit ECO8990E Manual (expressly mapped in Ex. 8) ECO8990E Gas Kit Instruction (expressly mapped in Ex. 8)
9.	GasHose	
10.	Hallberg '207	
11.	Hallberg '763	
12.	Honda EU2000i Video	Honda EU2000i Honda EU2000i with Conversion
13.	Honda EU20i Manual	Honda EU20i Manual A Honda EU20i Manual B Honda EU20i Manual C Honda EU20i Manual D Honda EU20i Manual E Honda EU20i Manual F Honda EU20i Manual G Honda EU20i
14.	Honda EU20i Video	Bassguitarist1985 Honda EU20i with Conversion
15.	Hoots	
16.	Jaasma	
17.	Kern	
18.	Kubota Engine	Kubota Manual (expressly mapped in Ex. 18) Kubota DF972-E2 Engine
19.	Lian '307	
20.	McLean	
21.	Nishida '116	
22.	NoOutage	
23.	Northstar 8000 TFG Manual	Northstar 8000 TFG
24.	Olmr	
25.	Parlatore	
26.	Poehlman '699	Poehlman '848
27.	Pursifull	
28.	RD9000E	RD9000E Manual (expressly mapped in Ex. 28)
29.	Sarder '230	Sarder '101 Sarder '273 Sarder '390 Sarder '667 Sarder '896

Ex.	Mapped Reference	Grouped Reference
30.	SCAG Manual	SCAG IPL 06216 SCAG IPL 06292 SCAG IPL 06201 SCAG Manual 03278 SCAG Manual 03331
31.	Sugimoto	
32.	Swanson	
33.	Takahashi	
34.	Tsuda	
35.	Walker	
36.	Wang	
37.	Winco HPS12000HE with Kit	Winco HPS12000HE Manual (expressly mapped in Ex. 37) Winco Solenoid Kit Instruction Sheet (expressly mapped in Ex. 37) Winco Solenoid Kit Diagram(expressly mapped in Ex. 37) Winco HPS12000HE Winco Solenoid Kit AFC Valve Winco HPS9000VE Winco HPS6000HE Winco HPS9000VE Solenoid Kit Winco HPS6000HE Solenoid Kit Winco HPS9000VE Manual Winco HPS6000HE Manual Winco HPS12000HE Manual Winco HPS Owners Manual Winco Dyna Manual Winco Solenoid Kit Instruction Sheet 2 Winco HPS6000HE Instruction Sheet Winco HPS9000VE Instruction Sheet Winco HPS12000HE Manual 2
38.	Zhang	
39.	Zhao Yunying	

In addition to the above, the manner in which SCAG Turf Tiger maps to the Asserted Claims is demonstrated through the combination of Exs. 18 and 30.

Exhibits 1 through 39 provide claim charts mapping each element of each asserted claim, to each prior art reference. Except where those charts state that an

1 element would be obvious, Firman contends that each prior art reference anticipates
2 each asserted claim, pursuant to 35 U.S.C. § 102.

3 Firman also Incorporates by reference Exhibits 1 and 3 of Champion's
4 Infringement Contentions as admitting Firman H03651, Firman H03652, Firman
5 H05751, and Firman H08051 would anticipate the claims of U.S. Patent No. 10,393,034
6 ("the '034 patent") and U.S. Patent No. 11,143,120 ("the '120 patent") should they
7 predate those patents. Firman offered for sale and publicly disclosed the Firman
8 H03651, Firman H03652, Firman H05751, Firman H08051 generators (or equivalent
9 versions of those generators containing the accused functionality) at the 2016 National
10 Hardware Show on May 2-4 2016. Just months after that, on October 4, 2016,
11 Champion filed the application resulting in the '034 patent. This application was a
12 continuation-in-part of Champion's earlier patent applications and added new matter to
13 that application. The '120 patent claims priority to the application that led to the '034
14 patent. Thus, any claims of the '034 or '120 patents that contain matter disclosed for
15 the first time on October 4, 2016, would be entitled to a priority date no earlier than
16 October 4, 2016. Champion's discovery responses currently deny that any asserted
17 claims are entitled to a priority date of no earlier than October 4, 2016. In discovery,
18 Firman requested Champion provided its basis for this contention, but Champion has
19 refused. Champion bears the burden for establishing its priority claim. Should
20 Champion be unable to support its current priority claim for any claim of the '034 or
21 '120 patents, all such claims would be anticipated by Firman H03651, Firman H03652,
22 Firman H05751, Firman H08051 for the reasons Champion laid out in Exhibits 1 and 3
23 of its Infringement Contentions.

24 **B. Obviousness**

25 Firman also contends that the prior art renders the Asserted Patents obvious for
26 the reasons that follow. Firman makes this obviousness contention in addition to it
27 anticipatory contention. For example, for the reasons set forth in Ex. 28, Firman
28 contends the RD9000E anticipates all asserted claims except those few claims in which

1 Ex. 28 expressly identifies elements as being rendered obvious rather than expressly
2 present in the RD9000E. In addition to that anticipation contention, Firman also
3 contends the RD9000E renders obvious the asserted claims for the reasons outlined
4 below.

5 In *KSR Int’l Co. v. Teleflex Inc.*, the Supreme Court clarified the standard for
6 what types of inventions are unpatentable as obvious. 550 U.S. 398 (2007). “In *KSR*, the
7 Supreme Court criticized a rigid approach to determining obviousness based on the
8 disclosures of individual prior-art references, with little recourse to the knowledge,
9 creativity, and common sense that an ordinarily skilled artisan would have brought to
10 bear when considering combinations or modifications.” *Randall Mfg. v. Rea*, 733 F.3d
11 1355, 1362 (Fed. Cir. 2013). The Court explained that in many cases a person of
12 ordinary skill “will be able to fit the teachings of multiple patents together like pieces of
13 a puzzle.” *KSR*, 550 U.S. at 420–21. Accordingly, the Court emphasized that inventions
14 arising from ordinary innovation, ordinary skill, or common sense should not be
15 patentable. *Id.* at 415–22, 427. “[W]hen a patent simply arranges old elements with each
16 performing the same function it had been known to perform and yields no more than
17 one would expect from such an arrangement, the combination is obvious.” *Id.* at 417. A
18 “court must ask whether the [claimed] improvement is more than the predictable use”—
19 a “predictable variation”—“of prior art elements according to their established
20 functions,” considering whether the alleged invention is merely “the simple substitution
21 of one known element for another or the mere application of a known technique to a
22 piece of prior art ready for the improvement.” *Id.* at 417. In that regard, a patent claim
23 may be obvious if the combination of elements was “obvious to try” or if “there existed
24 at the time of the invention a known problem for which there was an obvious solution
25 encompassed by the patent’s claims.” *Id.* at 419-21. “[I]f a technique has been used to
26 improve one device, and a person of ordinary skill in the art would recognize that it
27 would improve similar devices in the same way, using the technique is obvious unless
28 its actual application is beyond his or her skill.” *Id.* at 417.

1 In addition, “[w]hen a work is available in one field of endeavor, design
2 incentives and other market forces can prompt variations of it, either in the same field or
3 a different one.” *Id.* “If a person of ordinary skill can implement a predictable variation,
4 Section 103 likely bars its patentability.” *Id.*

5 Firman believes that no showing of a specific motivation to combine prior art is
6 required to combine the references disclosed above and in the attached charts, as each
7 combination of art would have no unexpected results, and at most would simply
8 represent a known alternative to one of skill in the art. *See id.* at 415–17 (rejecting the
9 Federal Circuit’s “rigid” application of the teaching, suggestion, or motivation to
10 combine test, instead espousing an “expansive and flexible” approach). Nevertheless, in
11 addition to the information contained in the sections immediately above and elsewhere
12 in these contentions, Firman identifies exemplary motivations and reasons to combine
13 the cited art. As explained below, motivations to combine the teachings of the prior art
14 references disclosed herein are found in the references themselves and: (1) the nature of
15 the problem being solved, (2) the express, implied and inherent teachings of the prior
16 art, (3) the knowledge of persons of ordinary skill in the art, (4) the predictable results
17 obtained in combining the different elements of the prior art, (5) common subject
18 matter, and (6) same or similar fields of use.

19 The subsections below therefore identify various combinations of references,
20 along with exemplary motivations to combine. Multiple combinations, however, apply
21 to the same reference to the extent identified below. For example, for the reasons stated
22 in Section II.B.2. below, it would be obvious to combine the RD9000E with any of the
23 references disclosing pressure regulation devices located off board the generator.
24 Likewise, for the reasons stated in Section II.B.3. below, it would be obvious to
25 combine the RD9000E with any of the references disclosing the use of a solenoid to
26 control gaseous fuel flow. Each of these combinations apply in an additive—not
27 mutually exclusive—manner. Thus, for the reasons identified in Section II.B.2 and
28 Section II.B.3, it would have been obvious combine the RD9000E with any of the

1 references disclosing pressure regulation devices located off board the generator *and*
2 any of the references disclosing the use of a solenoid to control gaseous fuel flow.
3 Thus, for the reasons discussed below its obviousness combinations are additive and not
4 mutually exclusive, and may therefore stack.

5 **1. *Pressure regulation was obvious.***

6 Locating two stages of devices that regulate the pressure of fuel supplied from a
7 pressurized fuel source at a location apart from the device utilizing that fuel was well
8 known in the art. The following prior art references disclose this functionality.

- 9 • Bassguitarist1985
- 10 • NoOutage (and grouped references)
- 11 • Northstar 8000 TFG Manual (and grouped references)
- 12 • Parlatore (and grouped references)
- 13 • RD9000E (and grouped references)
- 14 • Honda EU20i Video
- 15 • Honda EU2000i Video
- 16 • Honda EU2000i with Conversion

17 It would have been obvious to modify any device utilizing fuel from a
18 pressurized source to locate at least two stages of pressure regulating devices at a
19 location apart from the device utilizing that fuel because doing so represents that mere
20 altering a position of a component, that has a known and predicible functionality well
21 known to one of skill in the art, and one of skill in the art would have been motivated to
22 do this to save space. Specifically, in the context of a generator, which includes two
23 potential positions for the pressure regulation equipment: on the pressurize fuel source
24 (e.g., an LNG or propane tank) or on the generator itself. Inverter generators have less
25 available space, making it obvious to locate pressure regulating devices on the fuel
26 source, as the above cited references have done.

27 It would therefore have been obvious to combine any of the above refences with
28 any of the above identified prior art engines or generators, which each use a regulated

1 pressurized fuel source: Champion 71532 Manual (and grouped references), Deng '819
2 (and grouped references), Hallberg '207 (and grouped references), Hallberg '763 (and
3 grouped references), Honda EU20i Manual (and grouped references), Jaasma (and
4 grouped references), Kern (and grouped references), Kubota Engine (and grouped
5 references), McLean (and grouped references), Nishida '116 (and grouped references),
6 Northstar 8000 TFG Manual (and grouped references), Poehlman '699 (and grouped
7 references), Pursifull (and grouped references), RD9000E (and grouped references),
8 Sarder '230 (and grouped references), SCAG Manual (and grouped references),
9 Sugimoto (and grouped references), Takahashi (and grouped references), Tsuda (and
10 grouped references), Walker (and grouped references), Winco HPS12000HE Manual,
11 Winco HPS9000VE Manual, Winco HPS6000HE Manual, Winco HPS Owners Manual,
12 Winco HPS12000HE Manual 2, Winco HPS12000HE, Winco HPS9000VE, Winco
13 HPS6000HE, Winco Dyna Manual, Winco HPS12000HE with Kit, SCAG Turf Tiger,
14 ECO8990E with Kit, ECO8990E Manual, ECO8990E, Honda EU2000i Video, Honda
15 EU2000i with Conversion, and Honda EU2000i (hereinafter the “Prior Art Engines and
16 Generators”). Similarly, it would have been obvious to use with the Prior Art Engines
17 and Generators multiple stages of regulation (as many regulators are designed with
18 designated operating ranges that require using multiple stages of regulation to achieve
19 the desired pressure change), to disconnect a fuel source or the fuel regulation from the
20 device using the fuel (as simply needed to transport the device or store it when not in
21 use), and to include a valve at the output of a fuel source, (also as simply needed to
22 transport the device, to store it when not in use, and for safety).

23 **2. Off board pressure regulation was obvious.**

24 Locating all devices that regulate the pressure of fuel supplied from a pressurized
25 fuel source at a location apart from the device utilizing that fuel was well known in the
26 art. The following prior art references disclose this functionality.

- 27
- Bassguitarist1985
 - GasHose (and grouped references)
- 28

- 1 • Winco Solenoid Kit Diagram
- 2 • Winco Solenoid Kit
- 3 • Winco HPS9000VE Solenoid Kit
- 4 • Winco HPS6000HE Solenoid Kit
- 5 • Winco Solenoid Kit Instruction Sheet 2
- 6 • Winco HPS6000HE Instruction Sheet
- 7 • Winco HPS9000VE Instruction Sheet
- 8 • Winco HPS12000HE with Kit
- 9 • SCAG Turf Tiger
- 10 • AFC Valve

11 It would have been obvious to modify any device utilizing gaseous fuel to
12 include a solenoid to cutoff or control the flow of a gaseous fuel because doing so
13 represents an intended well-known use of a component with predicable functionality
14 that was itself also well-known to a person of skill in the art. One of skill in the art
15 would be motivated to use a solenoid in place of a manual valve to automate the
16 otherwise manual process of opening and closing a valve. In some multifuel engines,
17 one fuel line may be controlled by a manual valve and another was controlled by a
18 solenoid. It would have been obvious to flip this arrangement and control either fuel
19 with either a manual or solenoid valve because doing so was a well known use of a well
20 known component, and one of skill in the art would be motivated to do so to automate a
21 manual process or add reliability, safety, or regulatory compliance. Likewise, one of
22 skill in the art would be motivated to add an additional solenoid to a device that
23 included a manual valve as an added level of security in the switching process and
24 regulatory compliance, which represents another use well known to one of skill in the
25 art. In doing so, it would likewise have been obvious to configure the additional
26 solenoid to be normally open to ensure that, absent power, the solenoid performs its
27 intended function. It would therefore have been obvious to combine any of the above
28 references with any of the Prior Art Engines and Generators. It would likewise have been

1 obvious to modify any of the Prior Art Engines and Generators to include such elements
2 based solely on the knowledge of one of skill in the art for the reasons stated above.

3 **4. Use of valves and switches for fuel selection was obvious.**

4 Using valves and switches for fuel selection was obvious. The following prior
5 art references disclose this functionality.

- 6 • Bai (and grouped references)
- 7 • Bernhardsson (and grouped references)
- 8 • Cao (and grouped references)
- 9 • Champion 71532 Manual (and grouped references)
- 10 • Deng '518 (and grouped references)
- 11 • Deng '819 (and grouped references)
- 12 • Hallberg '207 (and grouped references)
- 13 • Hallberg '763 (and grouped references)
- 14 • Kubota Engine (and grouped references)
- 15 • Lian '307 (and grouped references)
- 16 • McLean (and grouped references)
- 17 • Northstar 8000 TFG Manual (and grouped references)
- 18 • Poehlman '699 (and grouped references)
- 19 • Pursifull (and grouped references)
- 20 • RD9000E (and grouped references)
- 21 • Sarder '230 (and grouped references)
- 22 • SCAG Manual (and grouped references)
- 23 • Sugimoto (and grouped references)
- 24 • Takahashi (and grouped references)
- 25 • Tsuda (and grouped references)
- 26 • Zhang (and grouped references)
- 27 • SCAG Turf Tiger

1 It would have been obvious to modify any engine or generator that ran on
2 multiple fuels to use valves and switches to facilitate the process of selecting a fuel to
3 provide to the engine because doing so represents a use known to a person of skill in the
4 art, of components with predictable functionality that was itself also well-known to a
5 person of skill in the art. One of skill in the art would be motivated to use valves and
6 switches to facilitate the process of selecting a fuel and automate the otherwise manual
7 process of opening and closing valves one at a time, or coupling or decoupling fuel
8 lines. Likewise, one of skill in the art would be motivated to use valves and switches to
9 avoid the unintentional introduction of multiple fuels at the same time, a risk well
10 known to one of skill in the art. It would therefore have been obvious to combine any
11 of the above references with any of the Prior Art Engines and Generators.

12 **5. Use of an engine or device using an engine to power a generator.**

13 Using an internal combustion engine to power a generator was obvious. The
14 following prior art references discloses such engines.

- 15 • Hallberg '207 (and grouped references)
- 16 • Hallberg '763 (and grouped references)
- 17 • Jaasma (and grouped references)
- 18 • Kubota Engine (and grouped references)
- 19 • McLean (and grouped references)
- 20 • Poehlman '699 (and grouped references)
- 21 • Pursifull (and grouped references)
- 22 • SCAG Manual (and grouped references)
- 23 • Takahashi (and grouped references)
- 24 • Tsuda (and grouped references)
- 25 • Walker (and grouped references)
- 26 • SCAG Turf Tiger

27 It would have been obvious to use any of those engines to power a generator
28 because generators were well known in the prior art, as was the need to power the

1 rotation of internal electrical power generation components. One of skill in the art
2 would be motivated to use an internal combustion engine to power a generator to
3 achieve the rotational energy required to generate electricity. Indeed, manufacturers of
4 generators (and other similar products and industries) often use the same engines that
5 power their generators to power other small equipment and view the internal
6 combustion engines as interchangeable. It would therefore have been obvious to
7 combine any of the above references with any of the prior art generators: Champion
8 71532 Manual (and grouped references), Deng '819 (and grouped references), Honda
9 EU20i Manual (and grouped references), Kern (and grouped references), Nishida '116
10 (and grouped references), Northstar 8000 TFG Manual (and grouped references),
11 RD9000E (and grouped references), Sarder '230 (and grouped references), Sugimoto
12 (and grouped references), Winco HPS12000HE Manual, Winco HPS9000VE Manual,
13 Winco HPS6000HE Manual, Winco HPS Owners Manual, Winco HPS12000HE
14 Manual 2, Winco HPS12000HE, Winco HPS9000VE, Winco HPS6000HE, Winco
15 Dyna Manual, Winco HPS12000HE with Kit, ECO8990E with Kit, ECO8990E Manual,
16 ECO8990E, Honda EU2000i Video, Honda EU2000i with Conversion, and Honda
17 EU2000i.

18 **6. Use of quick connects was obvious.**

19 Using a quick connect to control the coupling and decoupling of a fuel line was
20 well known in the art. The following prior art references disclose this functionality.

- 21 • Champion 71532 Manual (and grouped references)
- 22 • GasHose (and grouped references)
- 23 • Honda EU20i Manual (and grouped references)
- 24 • NoOutage (and grouped references)
- 25 • Sarder '230 (and grouped references)
- 26 • Sugimoto (and grouped references)
- 27 • Honda EU2000i Video
- 28 • Honda EU2000i with Conversion

- 1 • Honda EU2000i

2 It would have been obvious to modify any device having gaseous fuel line to use
3 a quick connect for coupling and decoupling the fuel line in place of a traditional
4 coupling because doing so represents an intended use of a component with a predicable
5 functionality that was well-known to a person of skill in the art. One of skill in the art
6 would be motivated to use a quick connect in order to make coupling or decoupling the
7 fuel line easier for a user, to provide an added level of safety by avoid missed
8 connection, and to avoid leakage during the coupling/decoupling process. It would
9 therefore have been obvious to combine any of the above references with any of the Prior
10 Art Engines and Generators. It would likewise have been obvious to modify any of the
11 the Prior Art Engines and Generators to include a quick connect based solely on the
12 knowledge of one of skill in the art for the reasons stated above.

13 **7. Use of carburetor cutoff solenoids was obvious.**

14 Using a solenoid mounted on, in, or near a carburetor to control the fuel flow into
15 the carburetor was well known in the art. The following prior art references disclose
16 this functionality.

- 17 • Bernhardsson (and grouped references)
- 18 • Champion 71532 Manual (and grouped references)
- 19 • Chen (and grouped references)
- 20 • Kubota Engine (and grouped references)
- 21 • Nishida '116 (and grouped references)
- 22 • Northstar 8000 TFG Manual (and grouped references)
- 23 • Olmr (and grouped references)
- 24 • RD9000E (and grouped references)
- 25 • Sarder '230 (and grouped references)
- 26 • SCAG Manual (and grouped references)
- 27 • Sugimoto (and grouped references)
- 28 • Swanson (and grouped references)

- 1 • Tsuda (and grouped references)
- 2 • Walker (and grouped references)
- 3 • Wang (and grouped references)
- 4 • Zhao Yunying (and grouped references)
- 5 • SCAG Turf Tiger
- 6 • ECO8990E with Kit
- 7 • ECO8990E Manual
- 8 • ECO8990E

9 It would have been obvious to modify any carbureted engine to include a
10 solenoid mounted on, in, or near the carburetor to control the fuel flow because
11 carburetor solenoids were well-known to a person of skill in the art, and were
12 components with a predicable functionality that was itself also well-known to a person
13 of skill in the art. Namely, one of skill in the art was aware of the need to quickly and
14 immediately cutoff fuel flow into the carburetor to assist in shutting off the engine, such
15 that the vacuum the engine created would not continue to automatically draw fuel after
16 the user shut off the ignition. One of skill in the art would have recognized the
17 existence of this cutoff could be coopted for use in fuel switching as well, as that
18 requires the same thing as starting and stopping the engine: control of the flow of fuel
19 into the engine. It would also have been obvious to configure those solenoids to be
20 normally open to ensure that absent power, they performed their intended function.
21 Likewise, it would have been obvious to locate that carburetor to cut off fuel flow from
22 the float bowl to a nozzle in a venturi of the carburetor upstream from a throttle for the
23 engine because it provides the most geometrically advantageous position, a position that
24 was used by many preexisting carburetor that was both well known to a person of skill
25 in the art and one that would be obvious to figure out. It would therefore have been
26 obvious to combine any of the above refences with any of the Prior Art Engines and
27 Generators. It would likewise have been obvious to modify any of the Prior Art
28 Engines and Generators to include a solenoid mounted on, in, or near the carburetor to

1 control the fuel flow based solely on the knowledge of one of skill in the art for the
2 reasons stated above.

3 **8. Use of standard fuels was obvious.**

4 Using a gasoline and LPG to fuel an engine was well known in the art. The
5 following prior art references disclose this functionality.

- 6 • Champion 71532 Manual (and grouped references)
- 7 • Jaasma (and grouped references)
- 8 • Northstar 8000 TFG Manual (and grouped references)
- 9 • Poehlman '699 (and grouped references)
- 10 • RD9000E (and grouped references)
- 11 • Sarder '230 (and grouped references)
- 12 • SCAG Manual (and grouped references)
- 13 • Walker (and grouped references)
- 14 • Winco HPS12000HE Manual
- 15 • Winco HPS9000VE Manual
- 16 • Winco HPS6000HE Manual
- 17 • Winco HPS Owners Manual
- 18 • Winco HPS12000HE Manual 2
- 19 • Winco HPS12000HE
- 20 • Winco HPS9000VE
- 21 • Winco HPS6000HE
- 22 • Winco Dyna Manual
- 23 • Winco HPS12000HE with Kit
- 24 • SCAG Turf Tiger
- 25 • ECO8990E with Kit
- 26 • Honda EU2000i Video
- 27 • Honda EU2000i with Conversion

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1 These were common fuels, well known to a person of skill in the art, and
2 operated with a predicable functionality that was itself also well-known to a person of
3 skill in the art. Indeed, these are some of the most commonly found for sale in
4 commercial fueling stations, or used as fuel sources for home, recreational vehicle, or
5 camping supplies, which are all areas portable generators and small internal combustion
6 engines are commonly found. It would therefore have been obvious to select either of
7 these as an engine fuel for any of the Prior Art Engines and Generators. It would have
8 likewise been obvious to do that based solely on the knowledge of one of skill in the art.

9 **9. *Use of standard carburetor elements was obvious.***

10 Using a carburetor that has a throat, venturi, float bowl, and fuel passage was
11 well known in the art. These were common element, well known to a person of skill in
12 the art, and operated with a predicable functionality that was itself also well-known to a
13 person of skill in the art. It would therefore have been obvious to modify any internal
14 combustion engine to include these elements based solely on the knowledge of one of
15 skill in the art.

16 **10. *Use of standard engine electronic was obvious.***

17 Using an internal combustion engine that includes a pull start, alternator, and
18 charging coil was well known in the art. These were common elements, well known to
19 a person of skill in the art, and operated with a predicable functionality that was itself
20 also well-known to a person of skill in the art. It would therefore have been obvious to
21 modify any internal combustion engine to include these elements based solely on the
22 knowledge of one of skill in the art. Likewise, it would be obvious to power elements
23 on board an internal combustion engine or a generator (such as switches, solenoid, or
24 other control elements) using the available onboard power, such as power drawn from
25 the alternator, a battery, and a magneto. And when in a generator, it would likewise
26 have been obvious to power elements (such as switches, solenoid, or other control
27 elements) using the power the generator created. Regulating that power (such as
28

1 through the use of a voltage regulator) would have been obvious to avoid unintended
2 opening and closing of switches or other affects caused by unwanted variation in the
3 power levels. Doing so would have been obvious based on the Prior Art Engines and
4 Generators, as well as based solely on the knowledge of one of skill in the art.

5 **11. Positioning known elements was obvious.**

6 Positioning known elements, such as switches and valves, either on or in a
7 generator housing, or on or adjacent other components was well known in the art. Fuel
8 valves and switches were common elements, well known to a person of skill in the art,
9 and operated with a predicable functionality that did not achieve unpredictable results
10 when their location was changed. Moving them around a device would therefore have
11 been obvious because a person of skill in the art frequently applies basic engineering
12 and design choices when determining where to locate a part, such as placing a valve
13 near a switch (e.g., as described in Hoots), or on the surface of a generator where it
14 would be accessible. Likewise, it would have been obvious to couple fuel sources to
15 inlets and outlets as needed to move fuel from one location to another. Variations in the
16 locations of these parts, and parts like them, would therefore have been obvious, and a
17 person of skill in the art would be motivated to do them by standard principles of design
18 that requiring considering different locations and selecting the one that balances form,
19 function, and convince.

20 **III. INDEFINITENESS**

21 Title 35 U.S.C. § 112(b) (formerly 35 U.S.C. § 112, ¶ 2) provides that “[t]he
22 specification shall conclude with one or more claims particularly pointing out and
23 distinctly claiming the subject matter which the applicant regards as his invention.” If a
24 claim fails to satisfy the definiteness requirement, it is invalid. *See, e.g., Bancorp Servs.,*
25 *L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1371 (Fed. Cir. 2004). “In ruling on a
26 claim of patent indefiniteness, a court must determine whether those skilled in the art
27 would understand what is claimed when the claim is read in light of the specification.”
28

1 *Id.*; *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001).
2 The proper test for determining whether a claim satisfies the definiteness requirement is
3 whether the claim provides “reasonable certainty” as to its scope and bounds to a person
4 of ordinary skill in the art at the time of filing. *Nautilus, Inc. v. Biosig Instruments, Inc.*,
5 572 U.S. 898, 901 (2014). “[A] patent is invalid for indefiniteness if its claims, read in
6 light of the specification delineating the patent, and the prosecution history, fail to inform,
7 with reasonable certainty, those skilled in the art about the scope of the invention.” *Id.*

8 Champion has yet to provide a proposed claim construction for the terms below.
9 To the extent Champion argues that the following claim terms in the Patents in Suit should
10 be construed in such a way to cover the Accused Products, the claim terms are indefinite
11 as being insolubly ambiguous. Consequently, the claims in which these terms appear are
12 indefinite under 35 U.S.C. § 112(b). The inclusion of these terms in the Firman’s
13 invalidity and noninfringement charts is not a concession by Firman that these terms are
14 not indefinite.

15 At least the following claims are indefinite for missing antecedent basis or
16 indefinite or inconsistent nomenclature: The '034 patent’s use of “gaseous cutoff coupled
17 to open and close a gaseous fuel source to the engine” in claim 1 and its corresponding
18 use of “the gaseous cutoff solenoid” in claim 2 or indefinite. One of ordinary skill cannot
19 determine whether the term “solenoid” has been omitted from Claim 1 or where any
20 antecedent basis is provided for the “the gaseous cutoff solenoid” in claim 2. These
21 claims are thus indefinite under 35 U.S.C. § 112(b).

22 **IV. LACK OF ENABLEMENT AND FAILURE TO SATISFY WRITTEN**
23 **DESCRIPTION**

24 Title 35 U.S.C. § 112(a) (formerly 35 U.S.C. § 112, ¶ 1) provides that “[t]he
25 specification shall contain a written description of the invention, and of the manner and
26 process of making and using it, in such full, clear, concise and exact terms as to enable
27 any person skilled in the art to which it pertains, or with which it is most nearly connected,
28 to make and use the same, and shall set forth the best mode contemplated by the inventor

1 of carrying out his invention.”

2 The enablement requirement requires that the patent specification enable those
3 skilled in the art to make and use the full scope of the claimed invention without undue
4 experimentation based on the underlying facts. *See, e.g., Genentech, Inc. v. Novo Nordisk*
5 *A/S*, 108 F.3d 1361, 1365 (Fed. Cir. 1997); *In re Wright*, 999 F.2d 1557, 1561 (Fed. Cir.
6 1993); *In re Vaeck*, 947 F.2d 488, 495 (Fed. Cir. 1991). Factors to be considered when
7 evaluating whether there is undue experimentation include: 1) the quantity of
8 experimentation necessary, 2) the amount of direction or guidance presented, 3) the
9 presence or absence of working examples, 4) the nature of the invention, 5) the state of
10 the prior art, 6) the relative skill of those in the art, 7) the predictability or non-
11 predictability of the art, and 8) the breadth of the claims. *In re Wands*, 858 F.2d 731, 737
12 (Fed. Cir. 1988).

13 Likewise, 35 U.S.C. § 112(a) (formerly 35 U.S.C. § 112, ¶1) provides that “[t]he
14 specification shall contain a written description of the invention, and of the manner and
15 process of making and using it, in such full, clear, concise and exact terms as to enable
16 any person skilled in the art to which it pertains, or with which it is most nearly connected,
17 to make and use the same, and shall set forth the best mode contemplated by the inventor
18 of carrying out his invention.”

19 The written description requirement is a separate requirement to enablement; it
20 applies to all claims and requires that the patent specification objectively demonstrate that
21 the applicant actually invented (was in possession of) the claimed subject matter. *Ariad*
22 *Pharms., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1349-51 (Fed. Cir. 2010). The test for
23 sufficiency of written description is whether the disclosure of the application reasonably
24 conveys to those skilled in the art that the inventor had possession of the claimed subject
25 matter as of the filing date. *Id.* The level of detail required to satisfy the written description
26 varies depending on the nature and scope of the claims and the complexity and
27 predictability of the relevant technology. *Id.* at 1351-52.

28 The specifications of the Patents in Suit do not provide an adequate written

1 description and have failed to enable numerous claim terms. Namely, the specifications
2 of the Patents in Suit only provide limited disclosure and do not teach one of ordinary
3 skill in the art how to make and use the broader reading of the claims on which
4 Champion’s infringement contentions rely. Consequently, the full scope of each of the
5 claims identified below would require undue experimentation, and the claims are thus
6 invalid as not enabled under 35 U.S.C. § 112(a).

7 Likewise, the specifications of the Patents in Suit do not provide an adequate
8 written description of the broad claims and claimed functions for the asserted claims, and
9 consequently, one of ordinary skill in the art would conclude that the inventors did not
10 have possession of the claimed inventions as of the filing date.

11 Firman’s assertions of lack of enablement and written description are based on its
12 understanding of the Claim Construction on which Champion relies. Firman expressly
13 reserves the right to amend its contentions in this regard should Champion proffer
14 proposed claim constructions affecting additional claim elements. The asserted claims are
15 invalid for failing to meet the written description and enablement requirements for at least
16 the following reasons:

17 The ’101, ’667, ’390, and ’896 patents (“Champion’s Family 1 Patents”) have
18 failed to describe or enable a fuel valve assembly comprising multiple different fuel
19 valves. Instead, the specification of the patents discloses only a valve assembly
20 comprising a single valve. As a result, the specification of Champion’s Family 1 Patents
21 does not provide disclosure of, or teach one of ordinary skill in the art how to make and
22 use, the following claim elements. Likewise, the specifications of the Patents in Suit do
23 not provide an adequate written description of the following claim elements, and
24 consequently, one of ordinary skill in the art would conclude that the inventors did not
25 have possession of the claimed inventions as of the filing date.

- 26 • A “valve assembly fluidly connected to each of a first fuel source and a
27 second fuel source, the valve assembly being operable to selectively control
28 a first fuel flow and a second fuel flow from the first fuel source and the

1 second fuel source.” *See, e.g.*, claims 101-17, 101-18, 667-1, 667-10, 390-
2 3, 896-21, 896-30.

- 3 • A “valve assembly” that comprises “Two fuel inputs” and “Two fuel
4 outputs.” *See, e.g.*, claims 101-18, 667-1, 667-13, 390-5, 896-27, 896-30.
- 5 • A “valve assembly” that comprises “A first fuel valve” and “A second fuel
6 valve.” *See, e.g.*, claims 101-18, 667-3, 667-15, 390-7, 898-28, 896-32.

7 Champion’s Family 1 Patents have failed to describe or enable a fuel valve
8 assembly comprising a solenoid. Instead, the specification of the patents discloses only a
9 valve assembly comprising a mechanical valve actuated by a mechanical handle. Yet
10 Champion appears to interpret the claimed valve assemblies to include an electronically
11 actuated solenoid. As a result, the specification of Champion’s Family 1 Patents does not
12 provide disclosure of, or teach one of ordinary skill in the art how to make and use, the
13 following claim elements. Likewise, the specifications of the Patents in Suit do not
14 provide an adequate written description of the following claim elements, and
15 consequently, one of ordinary skill in the art would conclude that the inventors did not
16 have possession of the claimed inventions as of the filing date.

- 17 • A “valve assembly fluidly connected to each of a first fuel source and a
18 second fuel source, the valve assembly being operable to selectively control
19 a first fuel flow and a second fuel flow from the first fuel source and the
20 second fuel source.” *See, e.g.*, claims 101-17, 101-18, 667-1, 667-10, 390-
21 3, 896-21, 896-30.
- 22 • A “valve assembly” that comprises “Two fuel inputs” and “Two fuel
23 outputs.” *See, e.g.*, claims 101-18, 667-1, 667-13, 390-5, 896-27, 896-30.
- 24 • A “valve assembly” that comprises “A first fuel valve” and “A second fuel
25 valve.” *See, e.g.*, claims 101-18, 667-3, 667-15, 390-7, 898-28, 896-32.

26 Champion’s Family 1 Patents have failed to describe or enable a selector switch
27 that effectuates a selection. Instead, the specification of the patents discloses only a
28 selector switch that enables a user to take a subsequent action that itself effectuates a

1 selection. Yet Champion appears to interpret the claimed selector switch to cover switches
2 that themselves effectuates a selection. As a result, the specification of Champion’s
3 Family 1 Patents does not provide disclosure of, or teach one of ordinary skill in the art
4 how to make and use, the following claim elements. Likewise, the specifications of the
5 Patents in Suit do not provide an adequate written description of the following claim
6 elements, and consequently, one of ordinary skill in the art would conclude that the
7 inventors did not have possession of the claimed inventions as of the filing date.

- 8 • “Positioning of the selector switch. . . enables a selection of one of the first
9 fuel flow and the second fuel flow.” *See, e.g.*, claims 101-17, 667-10, 667-
10 18, 896-21, 896-22.
- 11 • A “selector switch . . . to allow a user to manually select one of the first fuel
12 flow and the second fuel flow.” *See, e.g.*, claims 101-18, 667-1, 896-30.
- 13 • A “selector switch” that is “configured to enable a first fuel flow from a
14 first fuel source” and “a second fuel flow from a second fuel source.” *See,*
15 *e.g.*, claim 390-1.

16 The ’780, ’654, ’985, ’970, ’895, ’398, ’145, ’034 and ’120 patents (“Champion’s
17 Family 2 Patents”) have failed to describe or enable a mechanical valve that controls the
18 flow of fuel from two sources. Instead, the specifications of the patents disclose only a
19 mechanical valve with one input and one output that controls a single flow of fuel from a
20 single fuel source. As a result, the specification of Champion’s Family 2 Patents does not
21 provide disclosure of, or teach one of ordinary skill in the art how to make and use, the
22 following claim elements. Likewise, the specifications of the Patents in Suit do not
23 provide an adequate written description of the following claim elements, and
24 consequently, one of ordinary skill in the art would conclude that the inventors did not
25 have possession of the claimed inventions as of the filing date.

- 26 • A “mechanical fuel valve . . .to selectively control fuel flow . . . from a first
27 fuel source . . . and a second fuel source.” *See, e.g.*, 780-1, 780-8, 780-15,
28 895-1, 895-8.

- 1 • A “mechanical fuel valve . . . to selectively control fuel flow . . . from the
2 liquid fuel source . . . and the pressurized fuel source.” *See, e.g.*, claims 654-
3 1, 654-6, 985-5, 985-15, 970-1, 970-12, 970-44, 895-14.

4 Champion’s Family 2 Patents have failed to describe or enable, particularly within
5 the applications filed as of the alleged priority date of these patents, a switch for changing
6 operation of the engine. Instead, the specifications of the patents disclose a combination
7 of a valve and a selectively accessible port that enable a user to manually reconfigure fuel
8 supply connections. As a result, the specification of Champion’s Family 2 Patents does
9 not provide disclosure of, or teach one of ordinary skill in the art how to make and use,
10 the following claim elements. Likewise, the specifications of the Patents in Suit do not
11 provide an adequate written description of the following claim elements, and
12 consequently, one of ordinary skill in the art would conclude that the inventors did not
13 have possession of the claimed inventions as of the filing date.

- 14 • A “switch to change operation of the engine between gaseous fuel and
15 liquid fuel.” *See, e.g.*, claims 398-1, 398-57, 145-1.
16 • “wherein the switch is an electro-mechanical switch.” *See, e.g.*, claims 398-
17 5, 154-6.

18 Champion’s Family 2 Patents have failed to describe or enable the construction of
19 a fuel lockout apparatus that covers the accused products. Instead, the specifications of
20 the patents disclose a combination of a valve and a selectively accessible port that enable
21 a user to manually reconfigure fuel supply connections. Yet Champion appears to
22 interpret the claimed lockout apparatus to include the knob of the asserted products. As a
23 result, the specification of Champion’s Family 2 Patents does not provide disclosure of,
24 or teach one of ordinary skill in the art how to make and use, the following claim elements.
25 Likewise, the specifications of the Patents in Suit do not provide an adequate written
26 description of the following claim elements, and consequently, one of ordinary skill in
27 the art would conclude that the inventors did not have possession of the claimed
28 inventions as of the filing date.

- A “lockout apparatus.” *See, e.g.*, claims 780-1, 780-2, 780-6, 780-7, 780-8, 780-9, 780-11, 780-13, 780-14, 780-15, 654-1, 654-2, 654-6, 654-7, 985-6, 970-4, 970-5, 970-26, 970-27, 970-51, 895-1, 895-2, 895-6, 895-8, 895-12, 895-14, 895-15.

Champion’s Family 2 Patents have failed to describe or enable the construction of a fuel lockout apparatus that prevents coupling to covers items that have no impact on coupling. Yet Champion appears to interpret the claimed lockout apparatus to covers items that have no impact on coupling. As a result, the specification of Champion’s Family 2 Patents does not provide disclosure of, or teach one of ordinary skill in the art how to make and use, the following claim elements. Likewise, the specifications of the Patents in Suit do not provide an adequate written description of the following claim elements, and consequently, one of ordinary skill in the art would conclude that the inventors did not have possession of the claimed inventions as of the filing date.

- A “fuel lockout apparatus” configured to “prevent the second fuel source from coupling to the second fuel line” or “permit the second fuel source to couple to the second fuel line.” *See, e.g.*, claims 780-1, 780-8, 780-9.
- The “fuel lockout apparatus . . . prevents the pressurized fuel source from coupling to the dual fuel generator.” *See, e.g.*, claim 654-1.
- A “fuel lockout apparatus . . . to prevent the pressurize fuel source from coupling to the gaseous fuel line . . . and permit the pressurized fuel source to couple to the gaseous fuel line.” *See, e.g.*, claims 654-6, 985-6, 970-4, 970-26, 970-50, 895-14.
- A “fuel lockout apparatus” configured to “prevent the second fuel source from coupling to the second fuel line” and “permit the second fuel source to couple to the second fuel line.” *See, e.g.*, claim 895-1.

Champion’s Family 2 Patents have failed to describe or enable, particularly within the applications filed as of the alleged priority date of these patents, an electronic gaseous valve, such a solenoid. Instead, the specifications of the patents disclose a quick connect.

1 As a result, the specification of Champion’s Family 2 Patents does not provide disclosure
2 of, or teach one of ordinary skill in the art how to make and use, the following claim
3 elements. Likewise, the specifications of the Patents in Suit do not provide an adequate
4 written description of the following claim elements, and consequently, one of ordinary
5 skill in the art would conclude that the inventors did not have possession of the claimed
6 inventions as of the filing date.

- 7 • A “gaseous cutoff solenoid.” *See, e.g.*, claim 034-2.
- 8 • “activating the gaseous cutoff simultaneously activates the liquid cutoff
9 solenoid.” *See, e.g.*, claim 034-6.
- 10 • “a gaseous fuel cutoff solenoid.” *See, e.g.*, claims 034-14, 034-19.
- 11 • “a gaseous fuel valve coupled to control fuel flow through the gaseous fuel
12 line and selectively engage engine operation on gaseous fuel.” *See, e.g.*,
13 claim 034-18.
- 14 • “an electro-mechanical valve system coupled to the engine and operated by
15 an electrical switch . . . that controls fuel flow to the engine from the liquid
16 fuel source and the pressurized fuel source.” *See, e.g.*, claims 034-11, 120-
17 13.

18 V. DOCUMENT PRODUCTION

19 Subject to the Federal Rules of Civil Procedure and the Case Management Order
20 (Doc. 33), Firman identifies the following documents that support its these Contentions:
21 FIRMAN_00004526-FIRMAN_00007773 and Firman’s Amended Answer and
22 Counterclaim (Doc. No. 61) and its accompanying exhibits and documents referenced
23 by incorporation.

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DATED this 30th day of August, 2024.

DAVIS WRIGHT TREMAINE LLP

By: /s/ Benjamin J. Byer

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1 **CERTIFICATE OF SERVICE**

2 I certify under the penalty of perjury that on August 30, 2024, I caused the
3 document to which this certificate is attached to be delivered to the following via email
4 per agreement:

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20 I declare under penalty of perjury that the foregoing is true and accurate.
21 Executed August 30, 2024.

22 */s/ Benjamin J. Byer*
23 _____
24 Benjamin J. Byer