

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.,  
Petitioner,

v.

CHAMPION POWER EQUIPMENT, INC.,  
Patent Owner.

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IPR2025-01384  
Patent 11,905,895

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**PATENT OWNER CHAMPION POWER EQUIPMENT, INC.'S  
PRELIMINARY RESPONSE**

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## GLOSSARY

<b>Abbreviation</b>	<b>Term</b>
'895 Patent	U.S. Patent No. 11,905,895
Board	Patent Trial and Appeal Board
Challenged Claims	Claims 1-21 of the '895 Patent
Generac	Generac Power Systems, Inc.
Harbor Freight	Harbor Freight Tools USA, Inc.
MWE	MWE Investments, LLC
Patent Owner	Champion Power Equipment, Inc.
Petition	Petition for Inter Partes Review of U.S. Patent No. 11,905,895 (Paper 4)
Petitioner	Harbor Freight, Generac, and MWE, collectively
POSITA	Person of Ordinary Skill in the Art
USPTO	United States Patent & Trademark Office

Pursuant to 37 C.F.R. § 42.107, Patent Owner Champion Power Equipment, Inc. hereby submits its Preliminary Response to the Petition filed by MWE Investments, LLC, Harbor Freight Tools USA, Inc., and Generac Power Systems, Inc. (collectively, “Petitioner”), challenging Claims 1-21 of U.S. Patent No. 11,905,895.

## I. INTRODUCTION

Petitioner’s proposed grounds are identified below:

Ground	Claims	Basis	Primary Reference	Secondary Reference(s)
1	1-4, 6-10, 12-13	103	DuroMax	Elsdon
2	5, 11, 14-21	103	DuroMax	Elsdon, Parlatore, LP-Gas Handbook
3A	1, 6, 7	102	Hallberg	-
3B	2, 8, 12, 13	103	Hallberg	-
4	14, 15, 17-21	103	Hallberg	Parlatore, LP-Gas Handbook

Discretionary denial pursuant to 35 U.S.C. § 314(a), 35 U.S.C. § 325(d), and the *Fintiv* and *Advanced Bionics* factors<sup>1</sup> is warranted for the reasons set forth in

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<sup>1</sup> *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (precedential); *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (P.T.A.B. Feb. 13, 2020) (precedential).

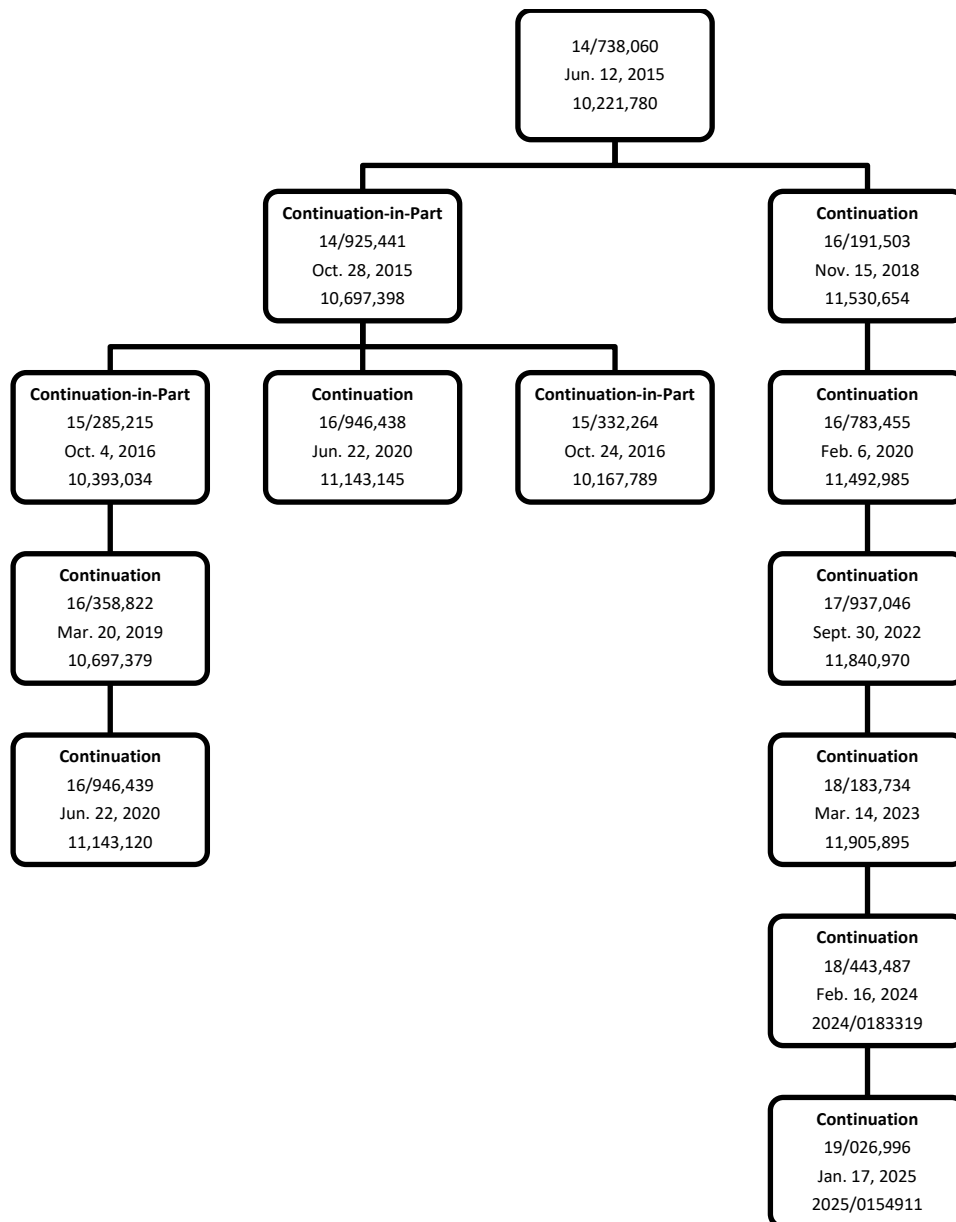
Patent Owner's Brief in Support of its Request for Discretionary Denial of Institution  
(Paper 11).

Denial is also appropriate based on non-discretionary factors because (1) the Petition relies on constructions that are not consistent with Patent Owner's litigation positions, (2) the Petition improperly relies on unsupported "apparent" constructions allegedly (and incorrectly) grounded in Patent Owner's litigation positions, and (3) Petitioner has repeatedly advanced invalidity arguments in co-pending district court litigation based on a plethora of system art, which must be adjudicated regardless of the Board's decision in this IPR or in any of the 12 related IPRs. Each argument is discussed in turn, below, and presents an independent basis for denial.

Finally, denial is appropriate on the merits because each of Petitioner's Grounds 1-4 (which address Independent Claims 1, 8, and 14) are deficient. Grounds 1 and 2 are deficient at least because (1) Petitioner's purported motivation to combine is improperly grounded in hindsight, and (2) Petitioner's analysis of Elements 1.2, 1.3, 8.2, 8.3, and 14.7 lacks evidentiary support. Grounds 3A, 3B, and 4 are deficient at least because (1) Petitioner improperly relies on "apparent" constructions of claim terms which it contends are incorrect, and (2) Hallberg does not disclose the claimed mechanical fuel valve.

## II. OVERVIEW OF THE '895 PATENT

The '895 Patent was filed as U.S. Patent Application No. 18/183,734 on Mar. 14, 2023. EX1001, (21), (22). The '895 Patent is one of thirteen members of a patent family directed to multi-fuel engine technology, which are collectively referred to as the "2015 Family." The 2015 Family is depicted below:



**A. The Specification of the '895 Patent**

The '895 Patent, titled “Dual Fuel Lockout Switch for Generator Engine,” is directed to mechanical fuel lockout switch for a multi-fuel engine. *Id.*, Abstract.

Beneficially, embodiments of the invention provide for a mechanical fuel lockout switch to ensure that two fuels are not simultaneously delivered to a dual fuel internal combustion engine. Embodiments of the invention also provide for a dual fuel generator with a remotely mounted gaseous fuel regulator system.

EX1001, 10:60-65.

Therefore, according to one embodiment of the invention, a mechanical fuel lockout switch for a dual fuel engine includes a mechanical fuel valve actuatable between a first position and a second position to selectively control fuel flow to the dual fuel engine from a first fuel source through a first fuel line and a second fuel source through a second fuel line. The mechanical fuel valve may be configured to allow communication between the first fuel source and the dual fuel engine and prevent communication between the second fuel source and the dual fuel engine while in the first position, and prevent communication between the first fuel source and the dual fuel engine while in the second position. The mechanical fuel lockout switch may also include a fuel lockout apparatus coupled to the mechanical fuel valve and configured to prevent the second fuel source from coupling to the second fuel line while the mechanical fuel valve is in the first position, and permit the second fuel source to couple to the second fuel line while the mechanical fuel valve is in the second position.

*Id.*, 10:66-11:17.

**B. The Independent Claims of the '895 Patent**

Claims 1, 8, and 14 are reproduced below:

**1. Claim 1.**

1. A mechanical fuel lockout switch for a dual fuel engine comprising:  
a mechanical fuel valve actuatable between a first position and a second position to selectively control fuel flow to the dual fuel engine from a first fuel source through a first fuel line and a second fuel source through a second fuel line, the mechanical fuel valve configured to:  
allow communication between the first fuel source and the dual fuel engine and prevent communication between the second fuel source and the dual fuel engine while in the first position,  
and  
prevent communication between the first fuel source and the dual fuel engine while in the second position; and  
a fuel lockout apparatus coupled to the mechanical fuel valve and configured to:  
prevent the second fuel source from coupling to the second fuel line while the mechanical fuel valve is in the first position,  
and  
permit the second fuel source to couple to the second fuel line while the mechanical fuel valve is in the second position.

**2. Claim 8.**

8. A mechanical fuel lockout switch for a dual fuel engine comprising:

a mechanical fuel valve actuatable between a first position and a second position to selectively control fuel flow to the dual fuel engine from a first fuel source through a first fuel line and a second fuel source through a second fuel line, the mechanical fuel valve configured to:

allow communication between the first fuel source and the dual fuel engine and prevent communication between the second fuel source and the dual fuel engine while the first position, and

prevent communication between the first fuel source and the dual fuel engine while in the second position; and

a fuel lockout apparatus coupled to the mechanical fuel valve and configured to prevent actuation of the mechanical fuel valve to the first position when the second fuel source is in communication with the dual fuel engine.

**3. Claim 14.**

14. A dual fuel generator and fuel delivery system comprising:

a dual fuel generator configured to operate on a liquid fuel supplied from a liquid fuel source through a liquid fuel line and a gaseous fuel supplied from a pressurized fuel source through a gaseous fuel line;

a fuel regulator system located off board the dual fuel generator, the fuel regulator system comprising:

a primary pressure regulator couplable to a service valve of the pressurized fuel source and configured to regulate the gaseous

- fuel supplied from the pressurized fuel source to a reduced pressure, and
- a secondary pressure regulator couplable to the primary pressure regulator and configured to regulate the gaseous fuel supplied from the primary pressure regulator to a desired pressure for delivery through the gaseous fuel line to operate the dual fuel generator;
- a mechanical fuel valve actuatable between a first position and a second position to selectively control fuel flow to the dual fuel generator from the liquid fuel source through the liquid fuel line and the pressurized fuel source through the gaseous fuel line, the mechanical fuel valve configured to open and close the liquid fuel line to selectively control fuel flow from the liquid fuel source to the dual fuel generator; and
- a fuel lockout apparatus coupled to the mechanical fuel valve and configured to:
  - prevent the pressurized fuel source from coupling to the gaseous fuel line while the liquid fuel line is open, and
  - permit the pressurized fuel source to couple to the gaseous fuel line while the liquid fuel line is closed by the mechanical fuel valve.

### **III. LEVEL OF ORDINARY SKILL IN THE ART**

A POSITA pertinent to the Challenged Claims would have a four-year degree in mechanical engineering or a closely related field and at least one year of experience designing, developing, servicing, or operating fuel-powered machinery.

Additional education could substitute for professional experience and significant work experience—such as working with, servicing, or operating such machinery in the field—could substitute for formal education.

Petitioner alleged that a POSITA:

[W]ould have at least a Bachelor of Science degree in mechanical engineering, physics, or related fields, and three years of work experience in combustion engines. Additional higher graduate education could substitute for work experience, and extensive experience/technical training could substitute for formal education.

Petition, 21-22 (citing EX. 1003, ¶28). Petitioner’s proposed definition is deficient. Specifically, Petitioner has failed to support its contention that an undergraduate physics degree is pertinent to the Challenged Claims, or that three years of work experience in combustion engines is necessary. Regardless, the arguments advanced herein are not impacted based on which definition is applied.

#### **IV. CLAIM CONSTRUCTION**

Claim terms are to be construed in accordance with the standard set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (*en banc*). But “[o]nly terms which are in controversy need to be construed, and then only to the extent necessary to resolve the controversy and material to the decision.” *Facebook, Inc. v. Sound View Innovations, LLC*, IPR2017-01005, Paper No. 13 at 6 (P.T.A.B. Sept. 1, 2017) (citing *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed.

Cir. 1999)). For purposes of the arguments set forth in this Preliminary Response, Patent Owner applies the plain and ordinary meaning of each claim limitation which is addressed.

Petitioner, meanwhile, spends more than *nine pages* of its Petition arguing for specific constructions of the terms “fuel lockout apparatus,” “prevent ... coupling” and “permit ... to couple.” Pet., 22-31. Petitioner’s proposed constructions (1) mirror the constructions applied by Harbor Freight in district court (EX2095, 36-37; EX2110, 16-20), and (2) are applied for Petitioner’s Grounds 1 and 2. Pet., 22-31. Patent Owner reserves the right to address the substance of Petitioner’s arguments regarding claim construction if this Petition is instituted.

After spending vast swathes of its Petition detailing what Petitioner deems the correct construction of “fuel lockout apparatus,” “prevent ... coupling” and “permit ... to couple,” Petitioner spends a single paragraph purportedly identifying alternative “apparent” constructions (Pet., 31-32) that allegedly control Grounds 3A, 3B, and 4. With the exception of the terms “fuel lockout apparatus,” “prevent ... coupling” and “permit ... to couple,” Petitioner states that “[f]or the purpose of this Petition, no other terms in the Challenged Claims require construction.” *Id.*, 22. As such, Petitioner alleges that it applies the “ordinary and customary meaning as understood by a POSA viewing the claim terms in the context of the entire patent.” *Id.*

However, despite asserting that the ordinary and customary meaning applies here, Harbor Freight proposed and argued for narrow constructions of two other terms in co-pending district court litigation. Specifically, Harbor Freight argued that (1) the term “a mechanical fuel valve” should be construed as “a single mechanical fuel valve” (EX2095, 36; *see also* EX2110, 15-16), and (2) the term “communicate” / “communication” should be construed as “allow fuel flow” / “fuel flow.” EX2095, 37; *see also* EX2110, 20-21.

At the same time, Generac argued the terms (1) “A mechanical fuel valve actuatable between a first position and a second position to selectively control fuel flow to the dual fuel generator from the liquid fuel source through the liquid fuel line and the pressurized fuel source through the gaseous fuel line,” and (2) “desired pressure” are indefinite. EX2113, 49-50, 54.

## **V. THE PRIOR ART**

The Petition asserts invalidity over five different grounds—including numerous alternative arguments based on Petitioner’s vague and confusing claim construction positions—which include multiple combinations of five different prior art references. As explained in Section VI, the Petition can be summarily denied in light of deficiencies in Petitioner’s proposed combinations of the DuroMax, Elsdon, and Hallberg references. Each reference is discussed in turn, below:

**A. DuroMax Dual Fuel Hybrid Elite XP4400EX (“DuroMax”) (EX1010)**

DuroMax discloses a dual fuel generator separately operable on liquified petroleum gas (“LPG”) and gasoline. EX1010, 2. The DuroMax generator includes a manual gasoline fuel valve for controlling gasoline fuel flow. *Id.*, 011. However, it *does not* include any component for controlling the flow of LPG. Instead, DuroMax relies solely on the user to turn off the gasoline fuel valve before operating the engine on LPG. *Id.*, 12.

**B. U.S. Patent No. 5,718,265 to Elsdon (“Elsdon”) (EX1012)**

Petitioner alleges that Elsdon discloses an assembly with cap 16 and shield 14, wherein cap 16 “is hingedly connected to shield 14 and is readily movable between an open position ... and a closed position ... in which cap 16 in positioned over the coupler 12 to prevent coupling with a fuel hose.” Pet., 35 (citing EX1012, 1:10-13, 3:4-11, Fig. 9).

**C. U.S. Patent No. 4,492,207 to Hallberg (“Hallberg”) (EX1014)**

Hallberg discloses “A dual fuel system for use with internal combustion engines comprising a manually actuated dual fluid valve which alternatively supplies gasoline to the engine’s carburetor or engine intake manifold vacuum to a single-stage liquified gas to gaseous fuel converter.” EX1014, Abstract. A more fulsome description of Hallberg’s dual fuel system is contained in §VI.B.2.b, *infra*.

## VI. ARGUMENT

Denial is appropriate based on non-discretionary factors (including but not limited to Petitioner’s reliance on contradictory claim construction positions), and on the merits. Each argument is discussed in turn, below, and provides an independent basis for denial.

### A. Institution should be denied in light of non-discretionary factors, including but not limited to Petitioner’s inconsistent claim construction positions.

The USPTO’s institution process considers both “the merits, [and] other non-discretionary considerations” and is designed “[t]o improve efficiency, consistency, and adherence to the statutory requirements for institution.” *See, e.g.*, October 17, 2025 Memorandum from J. Squires at 1-2. Here, the Petition engages in rampant gamesmanship. Denial is appropriate without the need to reach the merits.

First, the Petition relies on claim constructions that are not consistent with Patent Owner’s litigation positions. Second, the Petition improperly relies on unsupported “apparent” constructions allegedly (and incorrectly) grounded in Patent Owner’s litigation positions.<sup>2</sup> Third, the Petitioner has repeatedly advanced

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<sup>2</sup> Patent Owner’s Preliminary Response does not reach the merits of Petitioner’s proposed constructions. Patent Owner reserves the right to address claim construction on the merits if the instant Petition is instituted.

invalidity arguments in co-pending district court litigation based on a plethora of system art, which (1) must be adjudicated regardless of the Board’s decision in this IPR or in any of the 12 related IPRs, and (2) creates a significant risk of inconsistent results among and between the various proceedings. Each deficiency independently supports denial and is addressed below.

**1. Petitioner’s inconsistent litigation positions support denial.**

Despite (1) arguing for constructions of “a mechanical fuel valve” and “communicate” / “communication” in the Harbor Freight district court proceeding, and (2) arguing that the terms “A mechanical fuel valve actuatable between a first position and a second position to selectively control fuel flow to the dual fuel generator from the liquid fuel source through the liquid fuel line and the pressurized fuel source through the gaseous fuel line,” and “desired pressure” are indefinite in the Generac district court proceeding, Petitioner applies the plain and ordinary meaning of each term here. Notably, Petitioner does not provide *any basis* for its inconsistent positions.

**a. Petitioner’s inconsistent claim construction positions support denial.**

On November 3, 2025, the Director’s Order in *Revvo Techs., Inc., v. Cerebrum Sensor Techs., Inc.*, was designated precedential. IPR2025-00632, Paper 20 (P.T.A.B. November 3, 2025) (precedential). There, the Director explicitly stated that “[t]he Board’s claim construction rules are designed to ensure that the Board

correctly construes claim terms and to minimize inconsistency in claim construction between forums. To that end, the rules *discourage petitioners from seeking broader constructions at the Board to support a patentability challenge while seeking narrower constructions in litigation to avoid infringement liability.*” *Id.* at 4 (citing Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340 at 51,349-51,350 (Oct. 11, 2018)) (emphasis added). Nevertheless, that is precisely Petitioner’s approach here.

As explained in *Revvo Technologies*, “[a]llowing petitioners to continue this practice [i.e., proposing different claim constructions in the two forums] does not further the Office’s goal of ‘providing greater predictability and certainty in the patent system.’” *Id.* at 4. Here, Petitioner provided no explanation whatsoever for its inconsistent positions, which alone merits denial. *Id.* at 5 (“Ordinarily, that would mean a denial of institution.”).

Moreover, Petitioner’s gamesmanship here is particularly egregious in light of the constructions in question. For example, Claim 1 of the ’895 Patent recites “a mechanical fuel valve ... configured to: ... prevent communication between the second fuel source and the dual fuel engine.” Under Petitioner’s district court constructions, Claim 1 would require “a single mechanical fuel valve ... configured to ... prevent fuel flow between the second fuel source and the dual fuel engine.”

But, the alleged “mechanical fuel valve” of DuroMax does not allow or prevent LPG fuel flow. EX1010, 11-12. Rather, DuroMax discloses a *second* fuel valve. *See e.g., id.*, 12 (“To start your generator with LPG ... turn on the liquid propane gas supply.”).

To the extent that Petitioner asserts that Elsdon’s “fuel conduit coupler shield 14 and cap 16” are (1) a part of the “single mechanical fuel valve” and (2) “prevent fuel flow between the second fuel source and the dual fuel engine,” that theory is directly contradicted by the Petition itself. Even under Petitioner’s theory, Elsdon’s “fuel conduit coupler shield 14 and cap 15” appear to be the claimed “fuel lockout apparatus coupled to the mechanical fuel valve” which is configured to “prevent the second fuel source from coupling to the second fuel line.” Pet., 53-54.<sup>3</sup> Coupling is separate and distinct from fuel flow.

Thus, Petitioner’s district court constructions are directly contradicted by the invalidity theories presented in the Petition. Institution should be denied.

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<sup>3</sup> The Petition does not explicitly identify which elements of the prior art are mapped to each claim element. Pet., 53-54. Thus, Petitioner’s actual position is unclear.

**b. Petitioner’s indefiniteness arguments in parallel proceedings support denial.**

*Tesla* explicitly held that “[a]llowing a petitioner to advance a claim construction before the Board when that petitioner has made inconsistent indefiniteness arguments in district court fails to further, but instead detracts from, the Office’s goal of ‘providing greater predictability and certainty in the patent system.’” IPR2025-00340, Paper 18 at 4 (P.T.A.B. Nov. 5, 2025) (informative) (citing *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR202500632, Paper 20 at 3–5 (P.T.A.B. Nov. 3, 2025) (precedential)). And yet, as explained above Petitioner has expressly advanced contradictory indefiniteness positions which support denial.

Specifically, Generac alleged that two terms (“A mechanical fuel valve actuatable between a first position and a second position to selectively control fuel flow to the dual fuel generator from the liquid fuel source through the liquid fuel line and the pressurized fuel source through the gaseous fuel line,” and “desired pressure”) are indefinite. EX2113, 49-50, 54. Petitioner’s inconsistent indefiniteness arguments alone merit denial.

Moreover, “when a petitioner advances different positions before the Board and a district court, that petitioner is *required* to explain why those different positions are warranted.” *Tesla*, Paper 18 at 3 (citing *Revvo Techs., Inc. v. Cerebrum*

*Sensor Techs., Inc.*, IPR202500632, Paper 20 at 3–5 (P.T.A.B. Nov. 3, 2025) (precedential)). Here, Petitioner did not articulate *any* basis for its contradictory indefiniteness positions, and that also supports denial.

**2. Petitioner’s reliance on “apparent” constructions that it contends are “wrong” supports denial.**

Despite refusing to apply its own proposed constructions from co-pending district court litigation, Petitioner improperly relies on *Patent Owner’s* “apparent” constructions. An IPR petition must “[p]rovide a statement of the precise relief requested for each claim challenged. The statement must identify the following:

- 1) The claim;
- 2) The specific statutory grounds under 35 U.S.C. 102 or 103 on which the challenge to the claim is based and the patents or printed publications relied upon for each ground; [and]
- 3) How the challenged claim is to be construed. . . .”

37 C.F.R. § 42.104(b).

Importantly, the petition must identify “in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3).

The Board’s Decision Denying Institution of *Inter Partes* Review in *Vicor Corp. v. Delta Elecs., Inc.* is instructive. IPR2024-00704, Paper 11 (P.T.A.B.

October 2, 2024). There, the patent at issue “describe[d] a DC-DC conversion system that include[d] a buck converter and a resonant converter.” *Id.*, 3. Petitioner’s Ground 1 did “not purport to correctly construe the ‘over-current’ limitations” but rather applied what Petitioner deemed “Patent Owner’s Apparent Construction” or “Patent Owner’s Assumed Construction.” *Id.*, 7. The “apparent” constructions were purportedly based on the “specific arrangement” of certain accused products in parallel district court litigation. *Id.*, 7 n.6.

However, “Petitioner [did] not establish that such interpretations [were] appropriate,” which the Board found “[f]atal to Petitioner’s Ground 1.” *Id.*, 8. Fundamental to the Board’s finding was that “Petitioner acknowledges that its Ground 1 does not apply a ‘proper’ claim construction.” *Id.* The Board found “Petitioner has not supported the claim interpretations on which its Ground 1 relies, and Petitioner therefore has not shown a reasonable likelihood that it would prevail in its challenge asserted as Ground 1.” *Id.*, 9; *see also Microchip Tech. Inc. v. Aptive Technologies AG*, IPR2024-00494, Paper 12 at 10 (P.T.A.B. October 7, 2024) (denying institution where “the proposed construction on which the Petition is based is contingent upon adopting a claim construction that Petitioner opposes in the district court litigation and that Petitioner believes is incorrect”); *Cambridge Mobile Telematics, Inc. v. Sfara, Inc.*, IPR2024-00952, Paper 12 (P.T.A.B. Dec. 13, 2024) (informative); *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632,

Paper 20 at 3-5 (P.T.A.B. November 3, 2025) (“[W]hen a petitioner takes alternative positions before the Board and a district court, that petitioner should, at a minimum, explain why alternative positions are warranted.... Simply noting that the petitioner is adopting a patent owner’s claim construction proposals from district court, however, is not a sufficient reason for advancing different positions in the two forums.”) (precedential).

**a. The Petition does not support the Petitioner’s “apparent” constructions.**

After spending vast swathes of its Petition detailing and debating the purported construction of “fuel lockout apparatus,” “prevent ... coupling” and “permit ... to couple” (Pet., 22-31), Petitioner spends a single paragraph discussing alternative “apparent” constructions (*id.*, 31-32), which allegedly control Grounds 3A, 3B, and 4. *Id.*, 31-32. The purported “apparent constructions” are allegedly based on positions taken by Patent Owner in parallel litigation. *Id.* However, Petitioner does not identify—much less with particularity—the “apparent construction” of each term. Rather, Petitioner’s *entire analysis* consists of a single sentence:

Patent Owner appears to adopt a claim construction wherein (1) the “fuel lockout apparatus” can be any apparatus that prevents selection of more than one fuel source; (2) “prevent ... coupling” can be any means to prevent fuel flow without necessarily preventing physical attachment

of a fuel source to a fuel line; and (3) “permit ... to couple” can be any means to permit fuel flow without necessarily permitting physical attachment of a fuel source to a fuel line.”

*Id.* Notably, Petitioner does not include *any analysis* explaining how it arrived at its proposed “apparent constructions” or any evidence asserting that these constructions are in fact correct. Moreover, Petitioner does not provide any authority that (1) listing proposed “apparent constructions” and (2) citing Patent Owner’s district court claim construction brief (which merely advocated for the plain and ordinary meaning of each term), constitutes identifying “in writing and with particularity” “how the challenged claim is to be construed.” 35 U.S.C. § 312(a)(3); 37 C.F.R. § 42.104(b).

Based on these disparate statements, Petitioner “include[s] Grounds 3A/B and 4, showing how even under Patent Owner’s apparent construction the claims are anticipated or obvious over the prior art.” Pet., 32.<sup>4</sup> Petitioner emphatically concludes that it does “not admit or concede that Patent Owner’s apparent constructions are correct.” *Id.* In fact, Petitioner explicitly asserts that “Patent Owner’s apparent constructions are wrong.” *Id.* Yet, Petitioner expressly includes

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<sup>4</sup> Tellingly, Petitioner does not identify any evidence that the alleged “constructions” were actually proposed by Patent Owner.

arguments based on claim construction positions it explicitly disputes as yet another “alternative” invalidity challenge.

**b. Petitioner’s allegation that the Challenged Claims are invalid based on Petitioner’s reliance on Patent Owner’s “apparent” construction of “fuel lockout apparatus,” “prevent ... coupling” and “permit ... to couple” is improper.**

Petitioner relies on Patent Owner’s “apparent” constructions in Grounds 3A, 3B, and 4. Pet., 31-32. However, Petitioner explicitly acknowledges that (in its view) “Patent Owner’s apparent constructions are wrong.” *Id.* Moreover, Petitioner does not define or support the purported “apparent” constructions that it is relying on as the basis of Ground 8. §VI.A.2.a, *supra*.

Like in *Vicor Corporation*, institution is improper because Petitioner’s Grounds 3A, 3B, and 4 “do[] not purport to correctly construe the [disputed] limitations” but rather applied what Petitioner deemed Patent Owner’s “apparent” construction. *Vicor Corp.*, Paper 11 at 7. And, like in *Vicor Corporation*, “Petitioner [did] not establish that such interpretations [were] appropriate,” which is “fatal.” *Id.* at 8; *see also* §VI.A.2.a, *supra*. “Petitioner acknowledges that its [Grounds 3A/B and 4 do] not apply a ‘proper’ claim construction.” *Id.* at 8. As such, like the Board concluded in *Vicor Corporation*, “Petitioner has not supported the claim interpretations on which its [Grounds 3A/B and 4 rely], and Petitioner therefore has not shown a reasonable likelihood that it would prevail in its challenge.” *Id.* at 9.

Petitioner’s gamesmanship is clear. Petitioner advanced narrow constructions of “fuel lockout apparatus,” “prevent ... coupling” and “permit ... to couple” in parallel district court litigation to manufacture non-infringement positions. EX2110, 16-20. Further, in related proceedings, Petitioner has indicated its intent to move to stay the district court litigation if institution is granted. IPR2025-00805, Paper 14 at 7-10. In stark contrast, Petitioner now attempts to rely on broad and amorphous “apparent” constructions of those same terms—without actually defining or supporting the constructions—in the hopes of convincing the Board to institute. Petitioner has advanced broad constructions before the Board, while at the same time maintaining narrower district court constructions (and corresponding non-infringement positions) if its IPR challenge proves unsuccessful. Institution should be denied.

**3. Petitioner’s extensive reliance on system art in corresponding district court litigation supports denial.**

Petitioner’s gamesmanship is further exacerbated by Petitioner’s extensive reliance on system art not covered by Petitioner’s *Sotera* stipulations or 35 U.S.C. § 315(e). The Petition explicitly relies on an instruction manual for the DuroMax XP4400EH dual fuel generator which Petitioner contends “runs alternatively on gasoline or liquified petroleum gas.” *See, e.g.,* Pet., 32-34 (citing EX1010). Meanwhile, Generac’s district court invalidity contentions allege the same generator

that was the subject of DuxoMax is allegedly invalidating system art. EX2113, 30-31. Although Petitioner’s *Sotera* stipulation allegedly covers system art “that directly corresponds to” DuroMax, Generac has also alleged invalidity in the district court based on system art comprising *different generators* modified by *different conversion systems* that are not covered by its *Sotera* stipulation. *Id.*; *see also* EX2083; EX2089; EX2085 (“To be clear, this stipulation does not cover other system prior art. For example, because a manual for the DuroMax XP4400EH generator is relied upon as part of a ground in IPR2025-01384, the XP4400EH generator is covered by this stipulation. However, other systems/engines are not covered, even if similar to the XP4400EH.”). In other words, the scope of Petitioner’s *Sotera* stipulations is substantially diminished.

Petitioner’s improper reliance on inconsistent claim construction positions allows it to maintain both broad invalidity challenges before the Board, and narrow non-infringement positions in co-pending district court litigation. *See* §VI.A.1, *supra*. And, Petitioner’s reliance on duplicative system art allows it to maintain robust prior art-based invalidity positions in district court despite its *Sotera* stipulations and §315(e) estoppel. Simply put, in light of Petitioner’s gamesmanship, the IPR process has been converted into a supplemental invalidity challenge, rather than a “true alternative” to district court proceedings. *Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3–4 (P.T.A.B. Mar. 28, 2025) (Director Review)

(denying institution despite Petitioner’s *Sotera* stipulation, in part, because “Petitioner’s stipulation does not ensure that the[] IPR proceedings would be a ‘true alternative’ to the district court proceeding”).

Petitioner has failed to explain why the Board should institute the instant Petition despite the need for resolution of its system art-based claims (applying differing claim construction) in district court. In the recent decision in *Tesla, Inc. v. Intell. Ventures II LLC*, the Director addressed how “[a]llowing a petitioner to advance a claim construction before the Board when that petitioner has made inconsistent indefiniteness arguments in district court fails to further, but instead detracts from, the Office’s goal of ‘providing greater predictability and certainty in the patent system.’” IPR2025-00340, Paper 18 at 4 (P.T.A.B. Nov. 5, 2025) (informative) (quoting *Revvo Techs.* at 4-5). The same reasoning applies to inconsistent system art-based allegations. Petitioner’s current strategy creates the distinct possibility that (1) the Board reaches one outcome considering “printed publications” consisting of *manuals depicting system art generators* under a first set of constructions, while (2) the district court (or courts) reach contradictory outcomes considering *actual system art generators* under a second set of constructions. That is, since the Board cannot wholly resolve Petitioner’s invalidity challenges—and a significant risk of inconsistent outcomes exists—institution of this Petition would

not provide “greater predictability and certainty in the patent system.” *See id.* Denial is appropriate for at least this reason.

**B. Institution should also be denied on the merits.**

The Petition does not demonstrate a reasonable likelihood that at least one challenged claim is unpatentable.

Claims 1, 8 and 14 of the '895 Patent are independent claims. If Petitioner is unable to show a reasonable likelihood that it will prevail with respect to any of the independent claims, institution should be denied. *See, e.g., Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1576 n. 36 (Fed. Cir. 1987) (“Because [independent] claim 1 is not invalid, the presence of all its limitations in [dependent] claim 6 preserves the latter’s validity.”). Of relevance to Patent Owner’s Preliminary Response, the Petition alleges the following grounds of invalidity:

- **Ground 1** alleges that Independent Claims 1 and 8 are obvious over DuroMax in view of Elsdon. Pet., 12.
- **Ground 2** alleges that Independent Claim 14 is obvious over DuroMax in view of Elsdon, Parlatore, and the LP-Gas Handbook.
- **Ground 3A** alleges that Independent Claim 1 is anticipated by Hallberg. *Id.*
- **Ground 3B** alleges that Independent Claim 8 is obvious over Hallberg. *Id.*

- **Ground 4** alleges that Independent Claim 14 is obvious over Hallberg, in view of Parlatore and the LP-Gas Handbook. *Id.*

Patent Owner's Preliminary Response asserts that denial is proper because Petitioner does not demonstrate a reasonable likelihood that any claims are unpatentable.

First, Petitioner's Grounds 1 and 2 are deficient at least because (1) Petitioner's purported motivation to combine is improperly grounded in hindsight, and (2) Petitioner's analysis of Elements 1.2, 1.3, 8.2, 8.3, and 14.7 lack evidentiary support. Each argument provides an independent basis for denial of institution, and is discussed in §VI.B.1, below. Second, Grounds 2A and 2B improperly rely on "apparent" constructions of certain claim terms which Petitioner contends are incorrect. Moreover, Hallberg does not disclose the claimed mechanical fuel valve. Again, each argument provides an independent basis for denial, and is discussed in §VI.B.2, below.

**1. Grounds 1 and 2 do not demonstrate a reasonable likelihood that any claims are unpatentable.**

Petitioner alleges that the Challenged Claims are invalid over the combination of DuroMax and Elsdon. Pet., 43-86. Petitioner's challenge fails for two independent reasons. *First*, Petitioner's proposed motivation to combine DuroMax and Elsdon is improperly grounded in hindsight. *Second*, Petitioner fails to identify "in writing and

with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and *the evidence that supports the grounds* for the challenge to each claim.” 35 U.S.C. § 312(a)(3) (emphasis added). Specifically, Petitioner’s analysis of Elements 1.2, 1.3, 8.2, 8.3, and 14.7 is deficient for failing to identify the relevant evidence with particularity.

**a. Petitioner’s alleged motivation to combine DuroMax and Elsdon is improperly grounded in hindsight.**

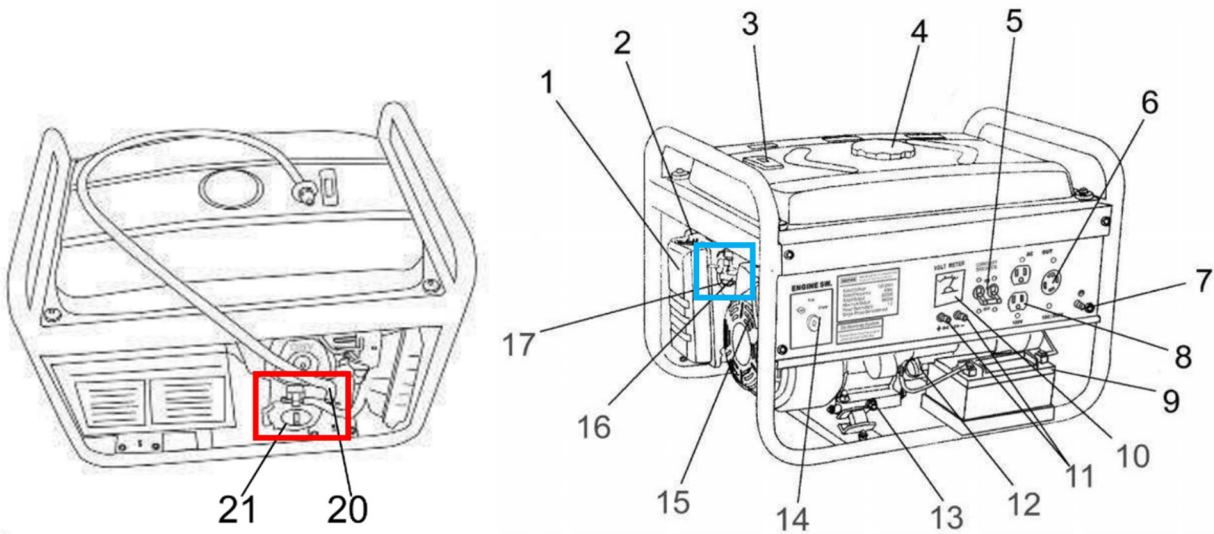
Petitioner alleges that a POSITA “would have understood it to be obvious to combine the Elsdon fuel conduit coupler cap with the mechanical fuel valve of DuroMax to provide a mechanical fuel lockout switch and prevent unsafe operating conditions, such as where both fuels are simultaneously delivered to the generator engine.” Pet., 43-44. Specifically, Petitioner posits that a POSITA “would have been motivated to connect the Elsdon fuel conduit coupler cap to the mechanical fuel valve of DuroMax to restrict access to the LPG hose connector interface of DuroMax when the DuroMax generator is running gasoline fuel.” *Id.*, 48.

Petitioner’s analysis focuses on alleged deficiencies in systems which allow for simultaneous use of LPG and gasoline fuel sources. *See, e.g., id.*, 47 (“prior art dual fuel engines can experience overly rich air-fuel ratio when both fuels are simultaneously engaged which can make the engine hard to start or lead to unstable operating conditions”) (internal citations and quotation omitted). Various solutions

to this problem exist. For example, the '895 Patent discloses mechanical fuel lockout switches which prevent the “unstable operating conditions” identified by Petitioner.

As another example, Petitioner points to a warning label on the DuroMax generator, which states “When using gasoline, LPG must be shut off! When using LPG, gasoline must be shut off!” *Id.*, 46 (citing EX1010, 11). However, Petitioner does not identify any evidence that DuroMax’s warning label is ineffective, or that end users of the DuroMax generator experience problems caused by simultaneous use of both gasoline and LPG fuel. Thus, while “unstable operating conditions” may be a problem among certain dual-fuel systems, Petitioner has failed to identify any evidence that the DuroMax generator experiences these problems.

Moreover, while explaining its proposed combination, Petitioner largely ignores the fact that merely installing the Elsdon fuel conduit coupler cap on the DuroMax fuel valve would have absolutely no impact on the alleged problem. DuroMax’s fuel valve 17 (blue) and hose connector 20 (red) are depicted in the annotated figures below:



EX1010, 7-8. DuroMax describes each component as follows:

- 17. **Fuel valve** - Allows fuel to enter engine.
- 20. **Hose connector** - Connect liquid propane gas to generator.

EX1010, 8. Importantly, these structures are located on different sides of the generator. As such, Elsdon's cap 16 (even if installed on DuroMax's fuel valve, as proposed by Petitioner) would have no impact on DuroMax's LPG hose connector.

Recognizing this, Petitioner includes a single sentence, stating that a POSITA "would have further understood that the fuel valve and LPG fuel conduit coupler of DuroMax could easily be moved to different positions on the generator such that the two components are located immediately next to each other." Pet., 50-51. In support of this statement, Petitioner's expert reiterates this statement verbatim, but provides no analysis that a POSITA would have been motivated to rearrange numerous

components on the DuroMax generator to create Petitioner’s proposed combination. EX1003, 162; *see also Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15 (P.T.A.B. August 24, 2022) (precedential) (expert testimony which “merely repeats, *verbatim*, the conclusory assertion for which it is offered to support ... is conclusory and unsupported, adds little to the conclusory assertion for which it is offered to support, and is entitled to little weight.”). Simply put, “[t]he mere fact that a combination is possible does not establish that a skilled artisan would be motivated to pursue it.” *Motorola Mobility LLC v. Largan Precision Co.*, No. 2024-1414, 2025 U.S. App. LEXIS 23724, at \*7 (Fed. Cir. Sep. 15, 2025) (citing *Adidas AG v. Nike, Inc.*, 963 F.3d 1355, 1359 (Fed. Cir. 2020) (“The obviousness inquiry does not merely ask whether a skilled artisan could combine the references, but instead asks whether ‘they would have been motivated to do so.’”)).

In short, Petitioners have not identified *any evidence* of a deficiency in the DuroMax generator. Relying on generic references to dual-fuel technology and conclusory expert testimony, Petitioner’s propose restructuring the DuroMax generator, and cobbling together portions of the Elsdon system, in order to create a structure which resembles the claimed invention. Petitioner’s approach “risks allowing the challenger to use the challenged patent as a roadmap to reconstruct the claimed invention using disparate elements from the prior art—i.e., the

impermissible *ex post* reasoning and hindsight bias that *KSR* warned against.” *TQ Delta, LLC v. Cisco Sys.*, 942 F.3d 1352, 1361 (Fed. Cir. 2019).

**b. Petitioner’s analysis of certain claim elements is deficient under 35 U.S.C. § 312(a)(3).**

Petitioner does not directly cite *any evidence* in its discussion of at least Elements 1.2, 1.3, 8.2, 8.3, and 14.7, including but not limited to (1) any citations to DuroMax and/or Elsdon, or (2) any citations to expert testimony. Instead, Petitioner merely cites back to its purported motivation to combine and reasonable expectation of success analysis, in support of its conclusory argument that a POSITA would have been motivated to combine Elsdon and DuroMax to arrive at the limitations recited by the Challenged Claims. Pet., 53-54, 61, 80 (citing §§VII.A.1.a.1-2).<sup>5</sup>

Petitioner’s generalized references to its purported motivation to combine analysis do not identify “in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and *the evidence that supports the grounds* for the challenge to each claim.” 35 U.S.C. § 312(a)(3) (emphasis added). “Petitioner’s arguments instead amount to an invitation for [the

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<sup>5</sup> The Petition’s treatment of Element 8.2 merely incorporates its analysis of Element 1.2. Pet., 61. Likewise, the Petition’s treatment of Elements 8.3 and 14.7 merely incorporates its analysis of Element 1.3. Pet., 61, 80.

Board] to cobble together arguments, search for pertinent facts, and inject [its] own reasoning. That is not [the Board’s] role.” *LifeScan Global Corp. v. PHC Holdings Corp.*, IPR2019-01127, Paper 9 at 30 (P.T.A.B. November 18, 2019) (citing *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (requiring *inter partes* review petitions to identify “with particularly . . . the evidence that supports the grounds for the challenge to each claim”); *DeSilva v. DiLeonardi*, 181 F.3d 865, 866-67 (7th Cir. 1999) (“A brief must make all arguments accessible to the judges, rather than ask them to play archeologist with the record.”)). Simply put, “[i]t is Petitioner’s burden to set forth its challenge *with particularity*” and Petitioner has failed to do so here. *Elmos Semiconductor SE v. Texas Instruments Inc.*, IPR2024-00802, Paper 9 at 23 (P.T.A.B. November 5, 2024) (citing *Parus Holdings, Inc. v. Google LLC*, 70 F.4th 1365, 1371-72 (Fed. Cir. 2023) (“Judges are not like pigs, hunting for truffles....”)).<sup>6</sup>

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<sup>6</sup> Petitioner’s treatment of Elements 1.2 and 8.2 underscores Patent Owner’s hindsight argument. *See* §VI.B.1.a, *supra*. Petitioner’s conclusory allegations that it “would have been obvious to connect these components” to arrive at the claimed invention is the very definition of hindsight. *Pet., 53. Graham v. John Deere Co.*, 383 U.S. 1, 36 (1966)

**2. Grounds 3A, 3B, and 4 do not demonstrate a reasonable likelihood that any claims are unpatentable.**

The Hallberg-based grounds (Grounds 3A, 3B, and 4) rely on “Patent Owner’s apparent construction” of “fuel lockout apparatus,” “prevent ... coupling” and “permit ... to couple.” As discussed in section VI.A.2, *supra*, Petitioner’s reliance on “apparent” constructions is legally improper and should be rejected outright.

Moreover, Hallberg does not disclose “a mechanical fuel valve ... to selectively control fuel flow to the dual fuel engine from ... a second fuel source through a second fuel line.” Independent Claims 1 (Ground 3A) and 8 (Ground 3B) of the ’895 Patent each recite “a mechanical fuel valve actuatable between a first position and a second position to selectively control fuel flow to the dual fuel engine from ... a second fuel source through a second fuel line.” Petitioner asserts that “second position” is “propane.” Pet., 90-92. Thus, in order to anticipate Claim 1 (Ground 3A) or otherwise render Claim 8 obvious (Claim 3B), Petitioner must show that Hallberg discloses a mechanical fuel valve which (when actuated to the “propane” position) selectively controls fuel flow from a source, through a fuel line, to the dual fuel engine<sup>7</sup>. As evidenced by Petitioner’s fundamental misunderstanding of Hallberg, the claimed features are not disclosed.

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<sup>7</sup> These deficiencies apply with equal force to Ground 4 (Claim 14). *See e.g.*, Pet.,

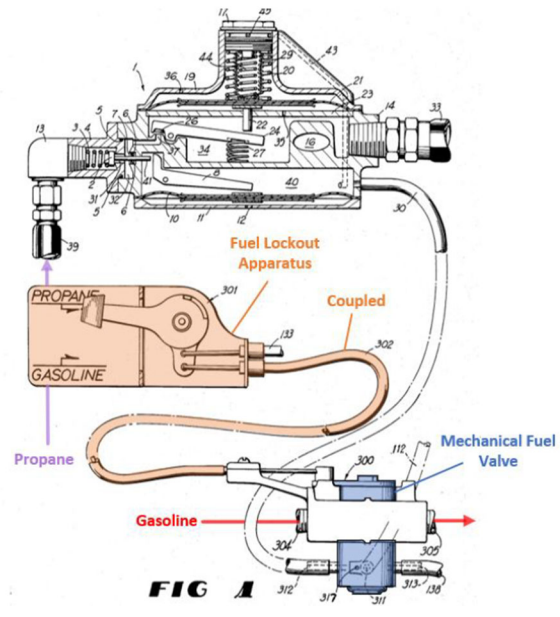
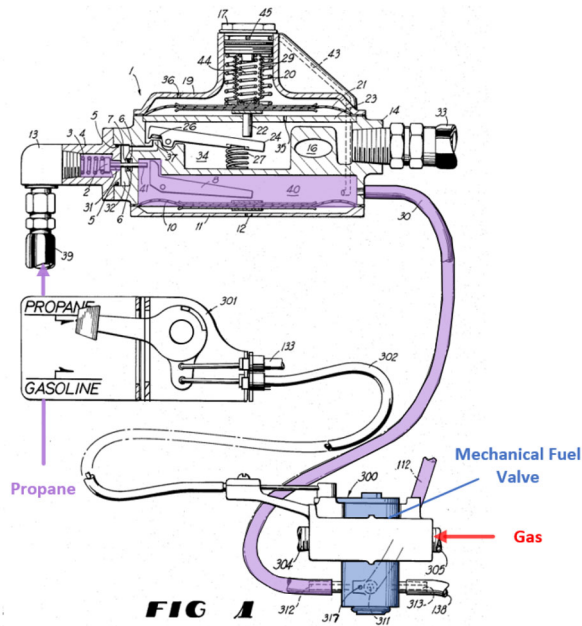
**a. The Petition relies on a fundamental misunderstanding of Hallberg.**

Petitioner relies on expert testimony to describe the structure, function, and operation of the Hallberg reference. *See e.g.*, Pet., §§VII.C-D. However, Petitioner's expert has offered blatantly contradictory interpretations of the Hallberg reference in related proceedings.

In related IPR2025-01185, Petitioner's expert prepared the following figure (below, left), which appears to depict propane (purple) flowing through engine intake manifold pressure chamber 40, converter vacuum line 30, first vacuum outlet port 312, before dual valve structure 300, and intake manifold vacuum line 112. But, contrary to Petitioner's representations, converter vacuum line 30 and intake manifold vacuum line 112 are *vacuum* lines which provide for the flow of air, *not* propane fuel lines. Additionally, Hallberg does not disclose fluid connection between liquified fuel passage 32 and engine intake manifold pressure chamber 40.

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105 (incorporating analysis with respect to Element [1.1]).



**EX2119**  
**(IPR2025-01185, EX1003, ¶212)**

**IPR2025-01384, EX1003, ¶295**

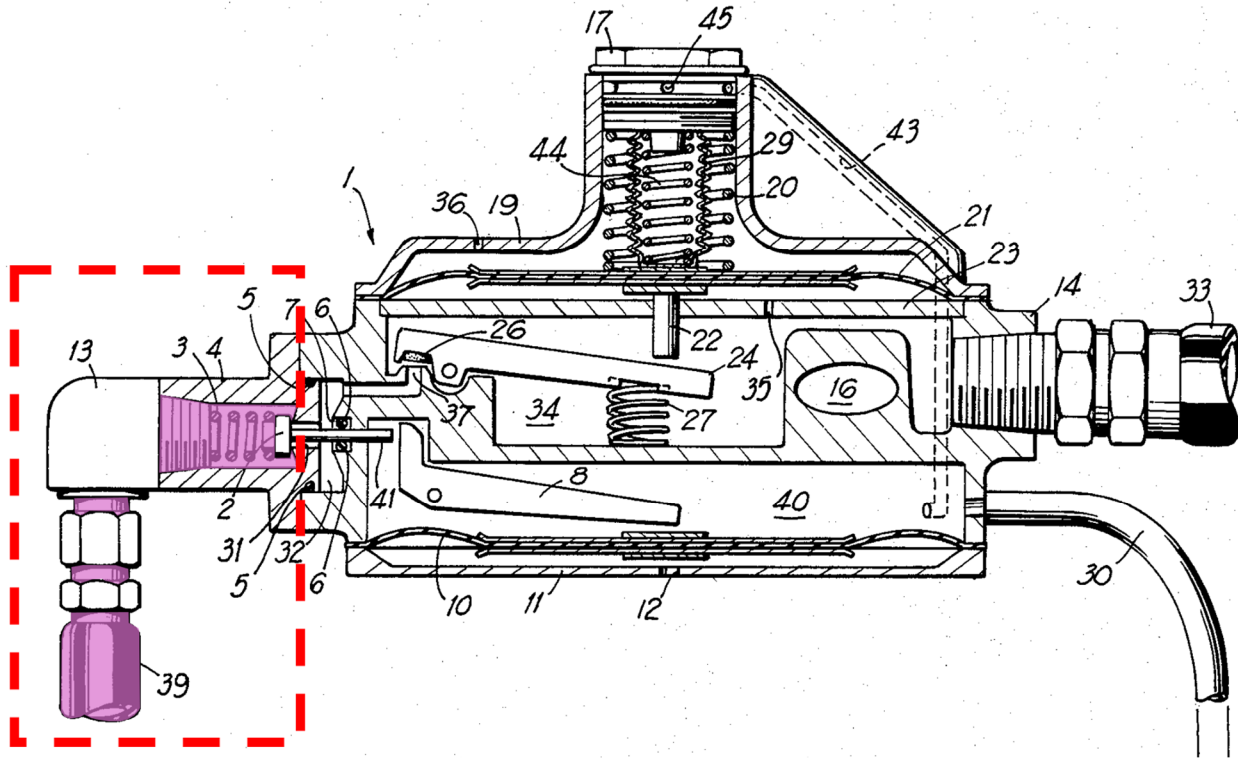
In this proceeding, Petitioner took a different approach (above, right). For example, Petitioner's expert (1) reversed the direction of gasoline flow through the alleged mechanical fuel valve, and (2) no longer depicted propane as flowing through vacuum tubes and into the mechanical fuel valve. In fact, Petitioner's expert no longer provides any depiction of the path that propane allegedly takes to the engine. It is unclear whether the discrepancies between Petitioner's contradictory interpretations of the Hallberg reference occur as a result of gamesmanship (e.g., Petitioner is attempting to render different claims invalid based on different interpretations of the prior art), or whether the contradictory interpretations result from Petitioner's misunderstanding of the Hallberg reference. Regardless, these contradictory interpretations cast doubt on the accuracy of the Petition (particularly

in light of the substantive deficiencies in Petitioner’s analysis of Hallberg identified below). Denial is appropriate.

**b. Dual valve structure 300 does not selectively control fuel flow from a fuel source to the dual fuel engine when in the “propane” position.**

Petitioner identifies numeral 300 (Fig. 8) as the alleged “mechanical fuel valve.” Pet., 88 (“[i]n the figures...300 is the fluid dual valve structure”). Dual valve structure 300 does not control fuel flow from a fuel source to the dual fuel engine when in the “propane” position.

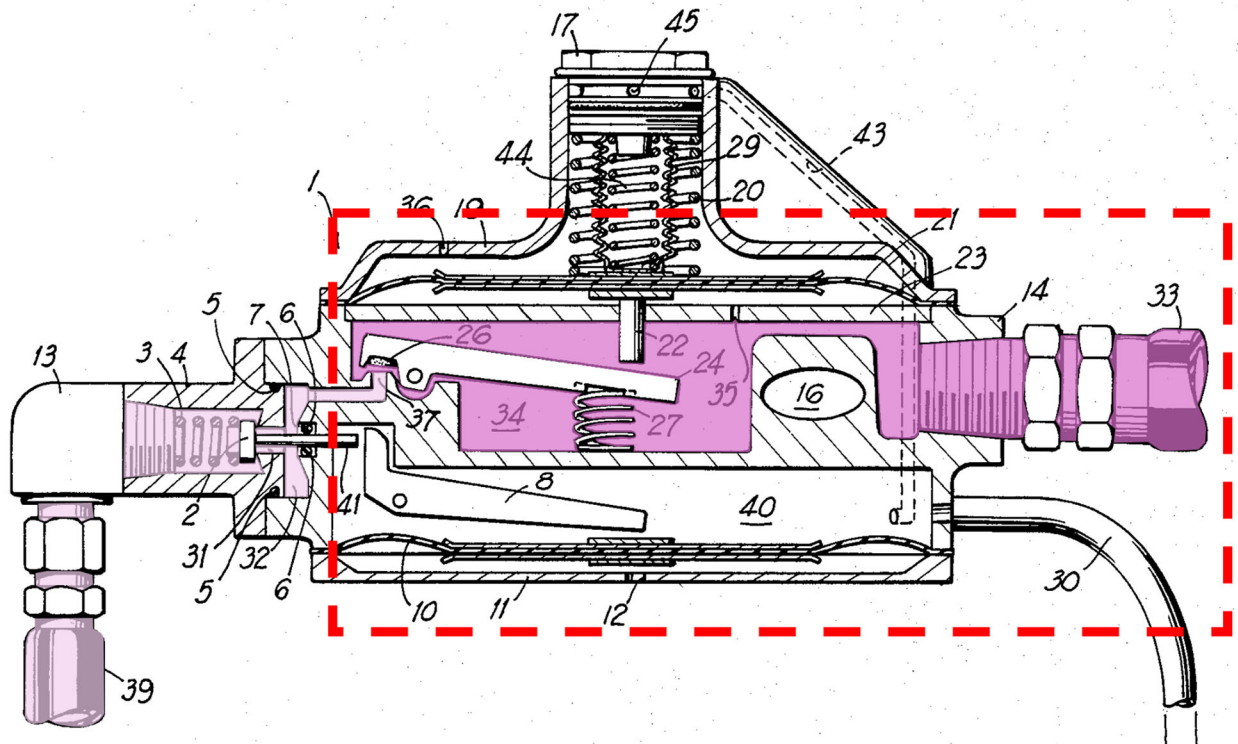
Hallberg discloses that numeral 39 is the “supply” of “pressurized propane.” EX1014, 7:58-59. And Petitioner concedes that when Hallberg’s system is in “gasoline” mode, the supply of propane is impeded by liquid inlet valve 2. Pet., 89-90. This state is depicted in annotated Figure 1, below.



As Petitioner explains, when Hallberg’s “engine is started, a vacuum is created in line 30, urging diaphragm 10 upward against liquid inlet lever 8.” Pet., 91 (citing EX1014, 8:31-38). Petitioner continues: “Actuating inlet lever 8 drives inlet valve shaft 41 against bias spring 3 which opens liquid inlet valve 2 *allowing propane to flow through the propane fuel line to the engine.*” Pet., 91 (citing EX1014, 8:38-42) (emphasis added). However, Hallberg does not state that opening liquid inlet valve 2 allows propane to flow through propane fuel line to the engine. Instead, it states that “liquified gaseous fuel flows through inlet valve orifice 31 into liquified fuel passage 32.” EX1014, 8:40-42; *see also id.*, 4:19-40 (“Movement of the inlet valve lever urges the liquid inlet valve open, thereby permitting liquid propane to enter a fuel passage in the converter.”).



Fuel outlet cover 26 is actuated to an open position when “the pressure within gaseous fuel chamber 34 of converter 1 is reduced” which is caused when “mixer 100 admits pressurized gaseous fuel to the engine ... through gaseous fuel line 33 when the engine is being started or is running.” EX1014, 8:56-60. This state (where fuel outlet cover 26 is in an open position, and propane is admitted to the engine) is depicted in annotated Figure 1, below.



Simply put, the Petition does not adequately allege that actuation of the alleged “mechanical fuel valve” “selectively control[s] fuel flow to the dual fuel

engine from ... a second fuel source through a second fuel line.”<sup>9</sup> Rather, delivery of fuel to the engine is controlled (at least in part) using pressure imbalances caused by the engine’s operation. If the engine is not active (and therefore fuel is not exiting gaseous fuel chamber 34), fuel outlet cover 26 remains closed, preventing fuel flow *to the dual fuel engine* as required by the claim.

## VII. CONCLUSION

For at least the reasons discussed above, the Petition fails to establish that the Challenged Claims are invalid.

Dated: November 25, 2025

Respectfully submitted,

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<sup>9</sup> In fact, the Petition does not actually identify the alleged “first fuel line” or “second fuel line” with particularity. Pet., 88-92.

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**CERTIFICATE OF SERVICE**

In accordance with 37 C.F.R. § 42.6(e), the undersigned certifies that on November 25, 2025, a complete and entire copy of the foregoing Patent Owner's Preliminary Response, including the exhibits relied upon, was served on counsel of record for Petitioner, as follows:

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**CERTIFICATE OF WORD COUNT**

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that the foregoing Patent Owner's Preliminary Response, excluding the portions exempted under 37 C.F.R. § 42.24(b), contains 7,638 words according to Microsoft Word's word count feature.

Dated: November 25, 2025

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