

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PROVISUR TECHNOLOGIES, INC.,

Petitioner,

v.

TEXTOR MASCHINENBAU GMBH,

Patent Owner

Case IPR2024-00224
U.S. Patent No. 9,457,487

**PATENT OWNER'S PRELIMINARY RESPONSE
TO PETITION FOR *INTER PARTES* REVIEW**

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I. INTRODUCTION

The '487 Patent is involved in a parallel litigation in the Western District of Missouri that is barreling toward trial in November of this year. That case is the finale of a five-year, multi-litigation dispute between the parties and the Court has made crystal clear that the culmination of the parties' grievances will be tried to a jury in 2024. *Infra*, Section III.A. To date, the parties and Court expended significant resources preparing the case for trial, including litigating the very same invalidity theories presented in the Petition. The District Court's long history with the parties and technology make it the more suitable forum to adjudicate these issues. It will also move more quickly than the Board, conducting a jury trial more than six months before the Board's possible final written decision. Given the overlapping issues with which the District Court is intimately familiar, timeline, late stage of the parallel litigation and mountain of resources already expended, this is a textbook case where IPR proceedings will **not** be a "quick and cost effective alternative[] to litigation[]." H. Rep. No. 112-98, pt. 1, at 45-48 (2011).

To be sure, where parallel litigation is at an advanced stage, as here, there is still a role for the *Inter Partes* Review process as a "true alternative" to the District Court. This is realized through a *Sotera* stipulation by which a petitioner may elect the PTAB as the sole tribunal hearing invalidity issues. Plaintiff here has refused to proffer a *Sotera* stipulation. Instead, it invites the Board to expend resources in

parallel to the district court, potentially involving the same prior art references as those litigated in the district court, knowing the jury trial will conclude long before the Board's work. The Board should decline Petitioner's invitation.

As set forth below, *Fintiv* Factors 1-5 weigh strongly in favor of denial. Petitioner nonetheless asks this Board to institute review, insisting that the Proposed Grounds satisfy the heightened "compelling evidence of unpatentability" standard. *Petition*, 81-82. As set forth in Sections IV and V, the Proposed Grounds fall far short. Indeed, for Grounds 1, 2, and 4, Petitioner critically ignored half of element 1[C2], focusing entirely on Konishi's removal process and failing to even mention Konishi's installation process. For Ground 3, Petitioner's theory presumes that McLaughlin utilizes a removable conveyor belt unit. But McLaughlin is entirely silent on the issue. It does not teach or suggest removing or installing a conveyor belt, and Petitioner does not even attempt to explain or support its foundational assumption that McLaughlin's conveyor unit is removable.

Because the *Fintiv* factors strongly favor denial and because each Proposed Ground is critically flawed, the Board should deny institution.

II. BRIEF OVERVIEW OF THE INTRINSIC RECORD

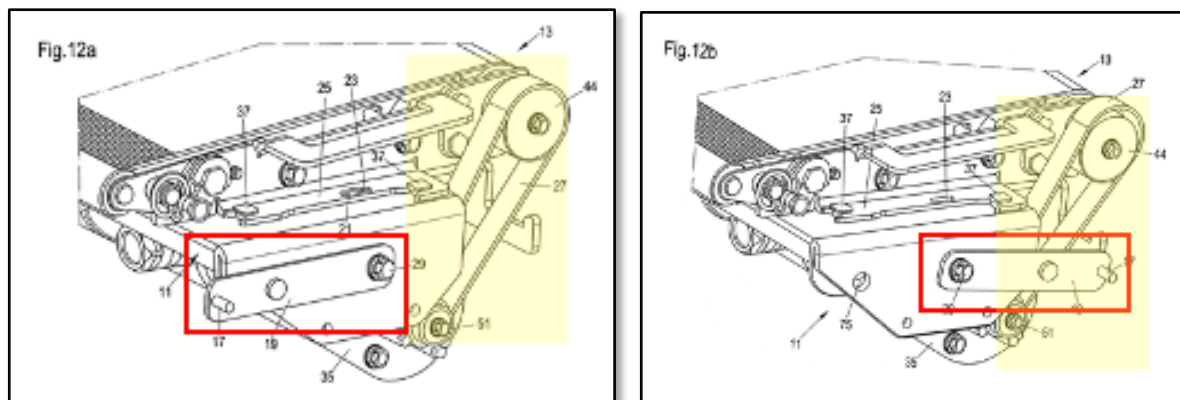
A. The '487 Patent

The '487 Patent describes a "slicing apparatus for food products," such as a high-performance slicer, that includes a belt conveyor configured as a removable

conveyor belt unit. '487 Patent (Ex. 1001) at Abstract, 1:15-18. High-performance slicers often include actively driven conveyor belts to both supply food products to a cutting plane (i.e., traction belts) and to collect recently cut slices for grouping into portions (i.e., portioning belts). *Id.* at 1:22-46; *see also id.* at Figs. 1-5 (depicted single-track traction conveyors), Figs. 8-10 (depicting single-track portioning conveyors). In practice, both the traction belts and portioning belts “are customarily greatly contaminated during the operation of a slicing apparatus[,]” which can require daily cleaning, sometimes several times a day. *Id.* at 1:50-57. To thoroughly clean belts in a high-performance slicer, the belt bands or transport straps need to be removed. *Id.*

Conventionally, these belts were removed by suspending the conveyor unit at one side of the slicer and removing the belts while the conveyor unit that drove those belts remained on the slicer. *Id.* at 1:58-67. This disadvantageously required a lot of space next to the conveyor unit to remove these belts. *Id.* Other conventional methods were able to remove the conveying means entirely, but these conveyors were often coupled to a drive unit via a coupling. *Id.* at 2:1-16. In these setups, a drive motor usually had to be arranged next to a drive roller of a conveyor, resulting in a large width and the inability to connect multiple drives to a single removable conveyor. *Id.*

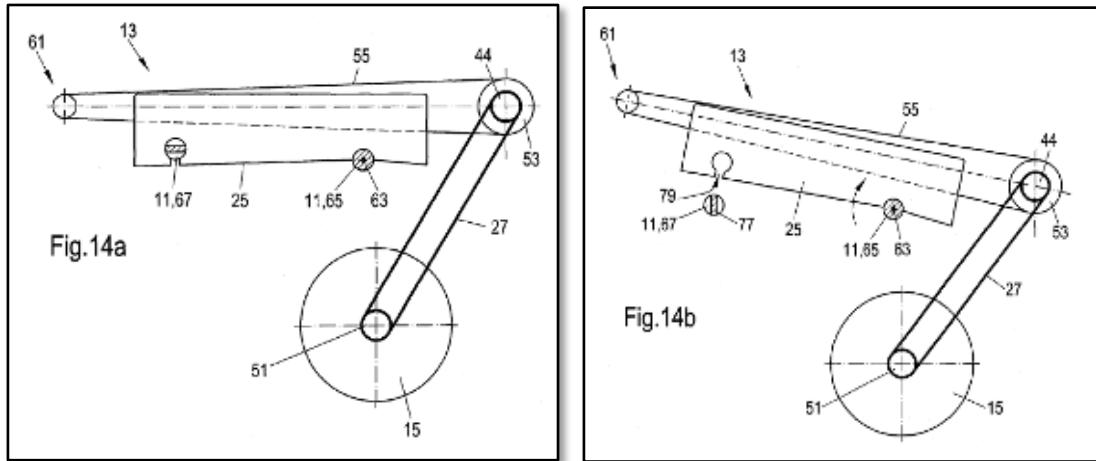
The '487 Patent describes a removable conveyor for a slicing apparatus that facilitates (1) easy cleaning, (2) a space-saving structure, and (3) inexpensive construction, comprising: a removable conveyor unit 13 having at least one track and a base 25, a substructure 41 with a mount 11 coupled to the base 25, and a drive 15 coupled to the conveyor belt unit 13 by a drive belt 27 that facilitates removal and installation of the conveyor belt unit by relaxing and tautening the drive belt 27 using a relative movement between the drive 15 and the conveyor belt unit 13. *Id.* at 2:20-25, 2:48-3:9; *see also id.* at claim 1. Two methods of toolless removal can be effectuated by the invention of the '487 Patent. In the first, a lever 19 can be moved to unlatch the base 25 and move the drive shaft closer to the drive wheel 44 to relax the drive belt 27. *Id.* at 8:66-9:30. This is shown in Figures 12a and 12b below:



Id. at Figs. 12a and 12b (annotated). In the second method for toolless removal, the conveyor belt unit 13 is pivoted which reduces the space between the drive wheel 44 of the conveyor belt unit and the stationary drive shaft 51 of the drive motor 15

which consequently relaxes the drive belt 27 and unlatches the base 25. *Id.* at 13:7-

36. This is shown in Figures 14a and 14b below:



Id. at Figs. 14a and 14b. In this way, the claimed invention of the '487 Patent facilitates simple cleaning practices for slicing apparatus conveyors with a space-saving and inexpensive construction. *Id.* at 2:20-24.

B. The '487 Patent's Prosecution

Patent Owner filed the application that issued as the '487 Patent on December 2, 2013. This application claims priority German Application No. 10 2012 222 042 filed on December 3, 2012. Ex. 1001 at cover.

The claims of the '487 Patent underwent two rejections by the Examiner, and the applicant twice amended the claims to obtain issuance. In response to the second Office Action, the applicant amended what would issue as Claim 1—then-pending independent claim 33—to include “the limitations of [then-pending] claim 42,” requiring a specific installation and removal process. Ex. 1002, 27-28, 34 (requiring

a “*conveyor belt unit . . . configured to be cancelled by relaxing a drive belt (27)* and can be *established by tautening the drive belt (27)*, with the relaxing and tautening of the drive belt (27) *each being provided by a relative movement between the drive (15) and the conveyor belt unit (13)*”), 34.

III. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION UNDER 35 U.S.C. § 314(A)

The Board considers the status of parallel litigation in deciding whether to exercise its discretion to deny institution under 35 U.S.C. § 314(a). *NHK Spring Co. v. Intri-Plex Techs., Inc.*, No. IPR2018-00752 (P.T.A.B. Sept. 12, 2018), Paper 8. In deciding whether to discretionarily deny institution, the Board considers six factors. *Apple, Inc. v. Fintiv, Inc.*, No. IPR2020-00019 (P.T.A.B. Mar. 20, 2020), Paper 11. Here, these factors strongly favor discretionary denial.

A. Factor 1 — No Stay Has Been Requested And The Evidence Shows No Stay Would Be Granted.

No stay has been requested, and the record strongly suggests the district court would reject any such request. Indeed, the district court has repeatedly confirmed that the parties' disputes *will be* tried in 2024. In the June 23, 2023 Scheduling and Discovery Dispute hearing, Judge Bough gave clear directives that “[w]e’re trying this in 2024. We’re not trying it in 2025.” Ex. 2001 (*Provisur Tech., Inc. v. Weber Inc. et al.*, Case No. 5:21-cv-06113, Dkt. 166) at 7:15-16. To accomplish this, Judge

Bough explained he is “going to put [his] foot on the gas pedal[,]” leaving no room for delay. *Id.* at 8:17-9:14. He went on to state:

But local rules are not Federal Rules of Civil Procedure, and if I need to abandon them, even though I'm the judge in charge of the local rules, I'll just abandon them. But we need to figure out how to take advantage of the experience that we've had getting here, the experience that we theoretically could have had a trial in the summer of next year but for my ruling and Provisur's desire to incorporate this additional claim. So we're not talking about having it in May of 2024, **but we're having it in 2024**. **So either oppose or find a way to make it happen.**

Id. (emphasis added). This same rationale was reiterated throughout the hearing. *Id.* at 11:3-11 (“**We’re just going to make this thing happen in 2024**. All these dates, including anything set forth in the Federal Rules of Civil Procedure, I can change and do. Right? I mean, I do. I tell people all the time that you’re going to get this served on the parties quicker, and if I have to adjust every date along the way, I will. But we have -- if dragging it out as long as we’ve dragged it out hasn’t gotten us all the way to the end zone, then I’m just going to have to gas pedal it.”); *see also id.* at 12:2-14 (“And all I have done for years now is hear parties on both sides tell me how it can’t be done and how it’s got to have more time. All I have seen is millions of dollars spent on attorneys’ fees on this case. **And I’m done.**”); 12:23 (“And we’ve just got to get this thing done in 2024”).

At the September 13, 2023 Scheduling Conference, Judge Bough doubled down on his prior directives and informed the parties that “we need to get this thing

done...put your saddle on, put it on tight[.]” Petitioner’s counsel affirmed it is “ready to do that” and confirmed the November 18th, 2024 trial. Ex. 2002 (*Provisur Tech., Inc. v. Weber Inc. et al.*, Case No. 5:21-cv-06113, Dkt. 216) at 3:22-25, 6:17-20. Since that scheduling order was entered over four months ago, there has been no change to the scheduled trial date.

Meanwhile, the district court litigation has progressed substantially. Claim construction proceedings have completed and fact discovery closes in a week on March 6, 2024. By the date of an institution decision, expert discovery will be nearly complete and the deadline to exchange dispositive motions will be less than three-weeks away. The advanced stage of the district court case and Judge Bough’s publicly stated position that he intends to hold the parties to their scheduled trial date strongly suggests that no stay would be granted. Accordingly, this factor weighs heavily in favor of denial.

B. Factor 2 — The Court’s Trial Date Predates Any Projected Final Written Decision By Six Months.

Fintiv factor 2, which considers the timing of the district court trial and projected date for a final written decision, weighs heavily in favor of denial. A final written decision is set to issue by the end of May 2025. This is more than **six months** after the district court’s scheduled trial, which is set to start on November 18, 2024. Ex. 2003 (*Provisur Tech., Inc. v. Weber Inc. et al.*, Case No. 5:21-cv-06113, Dkt. 214) at 4. Because the district court’s trial date is far earlier than the Board’s

projected statutory deadline for a final written decision, this factor weighs strongly in favor of denial. *Fintiv*, Paper 11 at 9.

Petitioner contends that based on the median time-to-trial statistics for the Western District of Missouri, trial would be around September 2025. Petition at 80. There are several issues with Petitioner's projection. The parallel litigation was filed on September 21, 2021. Using the median time-to-trial statistics offered by Petitioner, trial would have *already occurred* back in November 2023 if properly calculated from the filing date of the case. Petitioner appears to be starting its calculation from the date Patent Owner introduced its counterclaims of infringement against Petitioner in August 2023. Petitioner provides no authority that supports using the counterclaim date as the starting point for the median-time-to-trial statistics. Under Petitioner's estimate, the trial schedule would have to be delayed *ten months* from the scheduled trial date. As noted above, there is strong evidence in the record indicating the district court will not delay the current schedule and intends to hold the parties to the current, mutually agreed-to schedule. *Supra*, Section III.A.

Under these circumstances, the "scheduled trial date is a better measure of the expected trial date than the median-time-to-trial statistic[.]" *Resmed Corp. v. Cleveland Med. Devices Inc.*, IPR2023-00565, Paper 13, at *11-12 (PTAB Sep. 25, 2023) (noting the Board "generally take[s] courts' trial schedules at face value absent sufficient evidence to the contrary"). Petitioner has provided no evidence or

argument at all that trial is likely to be postponed by ten months in contravention to the district court's repeated directives. The parties mutually agreed to a November 2024 trial and there has been no change to the scheduled trial date since the Scheduling Order issued over four months ago. Therefore, like in *Resmed Corp.*, Petitioner has offered "no reason to believe that the scheduled trial date will be postponed" and this factor weighs heavily in favor of exercising discretion to deny institution. *Resmed Corp.*, IPR2023-00565 at 12; *see also Duplo U.S.A. Corp. v. MGI Digital Tech., S.A.*, IPR2023-00936, Paper 8 at 16-17 (PTAB Dec. 5, 2023) (denying institution under *Fintiv* and finding this factor weighs "heavily in favor of discretionary denial" while refusing to credit statistics that would require parallel litigation to be delayed for over a year).

C. Factor 3 — The Parties And Court Have Already Invested Substantial Resources In The Parallel Proceeding.

Under this factor, the Board must consider the amount and type of work already completed in the parallel litigation by the court and the parties *at the time of the institution decision*. *Fintiv*, Paper 11 at 9. Both parties have invested significant time and money into the parallel proceeding and so has the District Court. Even more time and resources will be invested by the time the Board reaches its decision on institution. Currently, fact discovery is set to close in one week in the parallel litigation. Ex. 2003 at 2. By the close of fact discovery, the parties will have served thousands of pages of infringement, non-infringement, validity, and invalidity

contentions; responded to multiple rounds of discovery requests (including 35 interrogatory responses per side, hundreds of requests for productions, and numerous sets of requests for admission); produced millions of pages of documents; will have briefed responsive motions to several amended pleadings, and will have conducted over 30 fact depositions. Expert discovery will open on March 6 and the parties will be investing substantial resources into the same validity issues presented to the Board. Additionally, all disputed claim terms for all patents at issue have already been adjudicated.¹ By the time the Board reaches an institution decision, fact discovery will have long closed; expert discovery will be set to close within a week; the parties will be exchanging dispositive motions within three weeks; and pretrial work will be underway. *Id.*

The parallel litigation has been pending since September 2021 and is extremely advanced—far beyond the typical district court setting when the Board would decide institution. The late stage of this case, along with the volume of issues at play, has commensurately required an extreme expenditure of resources. Under

¹ “If, at the time of the institution decision, the district court has issued substantive orders related to the challenged patent, such as a claim construction order, this fact weighs in favor of denial.” *Nokia of Am. Corp. v. Good Kaisha IP Bridge 1*, IPR2022-00755, Paper 9 at 11 (PTAB Nov. 2, 2022) (citing *Fintiv*, Paper 11 at 9-10).

these circumstances, this factor weighs heavily in favor of discretionary denial.

Duplo U.S.A. Corp., IPR2023-00936, Paper 8 at 17-18.

D. Factor 4 — Petitioner Fails To Offer A *Sotera* Stipulation And There Is Significant Overlap Between Issues Raises In The Petition And In The Parallel Litigation.

This factor evaluates “concerns of inefficiency and the possibility of conflicting decisions” when substantially similar prior art is submitted in the both the district court and IPR proceeding. *Fintiv*, Paper 11 at 12. These concerns are particularly troubling for Petitioner’s challenge.

Petitioner challenges the same claims in this IPR that it is challenging in the district court with the same prior art. All of the references used in Petitioner’s proposed grounds in its Petition have also been raised in its invalidity contentions at the district court. Ex. 2004 at 7. Though Petitioner notes the petition challenges five claims not asserted in the parallel litigation, simply challenging additional claims does not preclude a finding of substantial overlap. *Resmed Corp.*, IPR2023-00565 at 14; *Next Caller Inc. v. TRUSTID, Inc.*, IPR2019-00961, Paper 10 at 14 (PTAB Oct. 16, 2019); *see also Fintiv*, Paper 11 at 13 (“[I]f a petition involves the same prior art challenges but challenges claims in addition to those that are challenged in the district court, it may still be inefficient to proceed because the district court may resolve validity of enough overlapping claims to resolve key issues in the petition[.]”).

Despite this substantial overlap, Petitioner chose not to offer a *Sotera*-type stipulation and instead stipulated that it “will not raise the same grounds from this Petition in the district court.” Petition at 81. This narrow stipulation fails to diminish the overlap between the proceedings. It gives up only the precise grounds advanced in the petition, leaving open the invalidity defenses that rely on the same references in different ways. Referred to as a *Sand Revolution* stipulation, Petitioner’s agreement to give up only the specific grounds advanced in its petition does far less to mitigate *Fintiv* concerns than a *Sotera* stipulation. *See, e.g., April 21, 2023 Advanced Notice of Proposed Rulemaking* (Ex. 2005), 13 (“A *Sand Revolution* stipulation, in contrast [to a *Sotera* stipulation], does not necessarily prevent a petitioner from using a reference that was not raised, but reasonably could have been raised in an IPR, as part of an invalidity argument in district court” and, accordingly, “does not eliminate the concerns about overlapping issues and duplicative efforts[.]”).

Given the overlap in claims, prior art, and arguments between this IPR and the district court, and Petitioner’s refusal to proffer a *Sotera* stipulation weighs heavily in favor of denial.

E. Factor 5 — The Parties Are The Same.

The parties are the same in both proceedings. This weighs in favor of denial. *Resmed Corp.*, IPR2023-00565 at 15; *Duplo U.S.A. Corp.*, IPR2023-00936, Paper 8

at 19. Petitioner's reliance on *Weatherford U.S. v. Enventure Global Tech., Inc.*, IPR2020-01684, Paper 16 at 11-13 (PTAB Apr. 14, 2021) to suggest this factor is neutral when the parties are the same is misplaced. Binding authority dictates this factor weighs in favor of denial when the same parties are involved in this proceeding and the district court. *Sotera Wireless, Inc., V. Masimo Corp.*, IPR2020-01019, Paper 12, at 19 (PTAB Dec. 1, 2020) (citing *Fintiv*, Paper 15 at 15; *Sand Revolution*, Paper 24 at 12-13).

F. Factor 6 — Petitioner's Grounds Do Not Meet The Heightened "Compelling Merits" Standard.

Fintiv factors 1-5 plainly favor discretionary denial. Despite this, Petitioner refused to offer a *Sotera* stipulation—the procedural mechanism it could have used to avoid a *Fintiv* denial. To salvage its Petition, Petitioner must now show it has presented the Board with a compelling meritorious unpatentability challenge—a heightened standard that permits the PTAB to institute exceptionally strong invalidity challenges despite duplicating effort with the district court litigation. Petitioner has failed to meet this heightened burden.

To satisfy the heightened standard, Petitioner must present challenges “in which the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence.” *Commscope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23, 3 (PTAB Feb. 27, 2023) (precedential) (citing Guidance Memo at 4)). “[T]he compelling merits is a

higher standard than the standard set for institution by statute.” *Commscope Techs.*, IPR 2022-01242, Paper 23, 3 (citing Guidance Memo at 4-5). Under the compelling merits standard, “[a] challenge can only ‘plainly lead to a conclusion that one or more claims are unpatentable’ if it is highly likely that the petitioner would prevail with respect to at least one challenged claim.” *Id.* at 3-4 (quoting *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper 102, 49-50 (PTAB Oct. 4, 2022) (precedential)).

The compelling merits determination does not replace a *Fintiv* analysis. Rather, “PTAB panels...only consider compelling merits if they first determine[] that *Fintiv* factors 1-5 favor[] a discretionary denial.” *Commscope Techs.*, IPR 2022-01242, Paper 23, 4. Where the Board finds compelling merits, it “must provide reasoning to explain and support its determination as to compelling merits sufficient to allow the parties to challenge that finding and sufficient to allow for review of that decision.” *Id.* at 5-6.

Petitioner’s challenge does not present a reasonable likelihood of success on the merits, let alone a “compelling” meritorious challenge. As set forth below in Sections IV and V, each Proposed Ground includes a fatal flaw. Grounds 1, 2 and 4—each relying on base reference, Konishi—fail to map the installation process for Konishi’s removable conveyor belt unit despite independent claim 1 unequivocally requiring both removal and installation. Ground 3 relies critically on a reference that

does not teach or suggest a removable conveyor belt at all. Petitioner attempts to bridge this gap with the conclusory opinion of its expert. But Petitioner's expert did not explain *why* a POSITA would have understood the conveyor belt to be removable. Instead, Petitioner's expert simply presumes the conveyor *is* removable and manufactures a narrative describing the processes through which the presumed removable conveyor unit might be removed and re-installed.

In sum, there are substantial issues with Petitioner's analysis of the challenged claims such that the evidence does not plainly support Petitioner's position. Accordingly, this factor supports denial. *International Business Machines Corp. v. Digital Doors, Inc.*, IPR2023-00970, Paper 8, at 32 (PTAB Jan. 12, 2024) (denying institution under *Fintiv* and applying the precedential *CommScope* framework).

IV. GROUNDS 1, 2, AND 4 - PETITIONER FAILED TO MAP KONISHI TO THE CLAIMED INSTALLATION PROCESS FOR THE CONVEYOR BELT UNIT

A. Ground 1 – Konishi Does Not Anticipate The Claims

Limitation 1[C2]² recites distinct processes related to the conveyor belt: (1) **a removal process** where “conveyor belt unit (13) is configured to be cancelled by relaxing the drive belt (27)” and (2) **an installation process** where “conveyor belt unit (13)...is configured to be established by tautening the drive belt (27).” The limitation goes on to state that “the relaxing and tautening of the drive belt (27) each

² For consistency, Patent Owner adopts Petitioner's limitation references.

being provided by a relative movement between the drive (15) and the conveyor belt unit (13).”

Ground 1 relies solely on the teachings of Konishi for limitation 1[C2]. Petition at 23-24, 29-32, 75-78. Fatal to its challenge, Petitioner addresses Konishi's teachings to only one half of the limitation. Indeed, Plaintiff's mapping focuses on the claimed removal process, completely ignoring whether Konishi teaches the claimed installation process. Petition at 23-24 (purporting that “Konishi describes the claimed “configured to be cancelled by relaxing the drive belt” operation and describing Konishi's disclosures relating to its belt becoming “loose” so it can be “easily removed”). The only disclosures from Konishi cited in limitation 1[C2] in the Petition are paragraphs 33 and 34. Petition at 23. These quoted paragraphs exclusively describe Konishi's process for lifting the subframe 12, removing the timing pulley 24 from the drive roller 10, and separating the subframe 12 from frame 9. Ex. 1004 at [0034]-[0035]. There is no discussion at all of Konishi's installation process.

It is Petitioner's burden to identify, *in the Petition*, “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); *see also Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (“It is of the utmost

importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’ 35 U.S.C. § 312(a)(3).”). In the present case, Petitioner entirely failed to carry its burden to explain how Konishi discloses the claimed installation process.

Although Petitioner’s expert does briefly interpret Konishi’s installation process, such testimony is insufficient where the Petition fails to include a corresponding argument/discussion.³ *Department of Justice v. Discovery Patents, LLC*, IPR2016-01039, Paper 10 at 8 (PTAB Nov. 15, 2016) (denying institution and explaining “[t]o the extent an argument is raised solely in [the expert’s] Declaration and not also in the Petition, we have declined to consider it for purposes of this Decision”); *see also RPX Corp., et al. v. Parity Networks, LLC*, IPR2018-00097, Paper 7 at (PTAB Apr. 24, 2018) (denying institution, “Patent Owner argues ‘[t]he only support for this argument is their expert Declaration, which should not be used to fill gaps in the prior art.’ We agree.”); *Fidelity National Information Services, Inc. v. DataTreasury Corp.*, IPR2014-00489, Paper 9 at 9–10 (PTAB Aug. 13, 2014) (“We, therefore, decline to consider information presented in a supporting

³ Petitioner’s reliance on Dr. Collins to supply this mapping is even more tenuous for Ground 1 which is an anticipation ground. *Apple Inc. v. Arigna Tech. Ltd.*, IPR2023-00453, Paper 7 at 13 (PTAB (“To ‘demonstrate anticipation, the proponent must show that the four corners of a single, prior art document describe every element of the claimed invention’”).

declaration, but not discussed sufficiently in a petition; among other reasons, doing so would permit the use of declarations to circumvent the page [or word] limits that apply to petitions.”).

Because each of the remaining claims challenged in Ground 1 (i.e., Claims 6, 7, and 15-16) depend from Claim 1, the Petition's failure to discuss Konishi's installation process in its limitation 1[C2] mapping is fatal to Ground 1. By omitting half of a limitation central to the point of novelty from prosecution, Petitioner falls far short of presenting a challenge with “compelling merits.” *Supra*, Section II.B.

B. Grounds 2 and 4 – Konishi In Combination With Lindee or McLaughlin Suffers The Same Flaws

Ground 2 proposes a combination of Konishi and Lindee, challenging Claim 1 and many of its dependents along with independent claim 22. For these challenges, the Petition incorporates its analysis of limitation 1[C2] from Ground 1. Similarly, Ground 4 proposes a combination of Konishi and McLaughlin, challenging Claim 1 and many of its dependents along with independent claim 22. These challenges also incorporate the Petition's analysis of limitation 1[C2] from Ground 1. Accordingly, all challenges of Claim 1 and its dependents from Grounds 2 and 4 fail for the reasons addressed above in Section IV.A.

After forty-five pages of analysis, Petitioner finally (albeit briefly) addresses Konishi's installation process in its Ground 2 mapping of “Element 22[C3].” Petition at 45. This limitation requires “the coupling between the drives (15) and the

conveyor belt unit (13) is configured to be simultaneously cancelled and established for at least one of the first drive and the second drive.” Here, Petitioner provides a brief contention that installation and removal “are the same, just performed in reverse order.” Petition at 45. Ground 4 also challenges Claim 22, incorporating this brief mapping from Ground 2.

Petitioner raises 27 separate challenges in Grounds 1, 2, and 4. Even assuming, *arguendo*, that Petitioner's mapping of Claim 22 is not infected by the same fatal flaw as its other challenges in these grounds, Petitioner raising two potentially viable challenges out of 27 cannot satisfy the heightened compelling merits standard sufficient for institution. Indeed, it would be exceptionally inefficient for the Board to institute this proceeding based on a single claim while expending resources on many more challenges that are not viable. The Board is “guided by the philosophy embodied in the statutory requirement to promulgate regulations for inter partes review that further “the efficient administration of the Office [and] the ability of the Office to timely complete proceedings.” *Opec Engineering Co., Ltd. v. Berkenhoff GmbH*, IPR2019-01090, Paper 11 at 7-8 (PTAB Dec. 9, 2019) (citing 35 U.S.C. § 316(b) and 37 C.F.R. § 42.1(b)). “Consistent with these policies, Office guidance explains that [the Board] may consider the number of claims and grounds that meet the reasonable likelihood standard when deciding whether to institute inter partes review under 35 U.S.C. § 314(a)” *Id.* at 8. In *Opec*

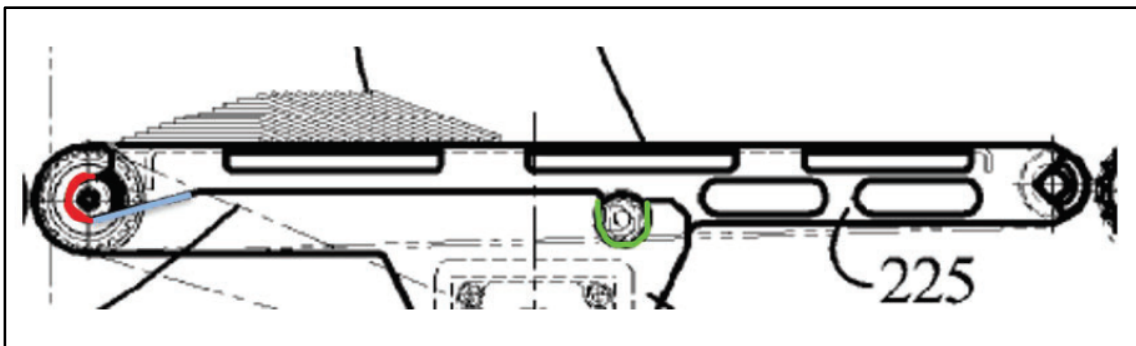
Engineering Co., the petition challenged six claims on five asserted grounds and the panel found that only two grounds with one challenged claim presented a reasonable likelihood of success and therefore denied institution under §314(a). *Id.* Like in *Opec Engineering Co.*, the Petitioner here fails to demonstrate a reasonable likelihood (or a heightened compelling merits challenge) on a vast majority of its asserted grounds and on nearly all of its challenged claims. *Id.* at 9. The Board must decide if the game is worth the candle. Here, it undoubtedly is not.

V. GROUND 3 - PETITIONER PRESENTED NO EVIDENCE THAT MCLAUGHLIN'S CONVEYOR BELT IS REMOVABLE⁴

Ground 3 proposes a single-reference obviousness rejection over McLaughlin. Underlying this invalidity theory, Petitioner presumes McLaughlin teaches a system with a removable conveyor belt unit. *See, e.g.*, Petition at 14 (“**McLaughlin discloses** a slicing machine, a slice scale, and **a check scale that includes a removable conveyor assembly.**”), 52 (“McLaughlin discloses ‘a removable conveyor belt unit (13) having at least one track and a base (25).’”). Critically, McLaughlin says nothing about installing or removing its conveyor belt unit and does not teach or suggest that the unit could be removed. Indeed, there is not a single statement in this reference stating or suggesting that its conveyors are removable.

⁴ Ground 4 fails for this additional reason as well.

Fatal to Petitioner's challenge, the Petition does not even acknowledge McLaughlin's deficiency. Petitioner simply assumes that McLaughlin's conveyor unit is removable and relies on its expert to manufacture a narrative about how the unit might be removed and re-installed. *See* Petition at 52-60 (citing Ex. 1003 at ¶¶ 184-197). Without citation to McLaughlin or to its expert's declaration, the Petition contends that McLaughlin's Fig. 2 "would have made it obvious to a POSA that check scale 200, including its support frame 225 and conveying surface 200, were removable from sidewalls 230." Petition at 53. The petition then cites its expert in support of its theory for how the conveyor *would be* removed. Petition at 52-54 (citing Ex. 1003 at ¶¶ 189-190). The entirety of Petitioner's expert's theory turns on the Fig. 2's illustration of two contact points annotated below:



Ex. 1003 at ¶190. According to Petitioner's expert, Dr. Collins, the purported red C shaped portion represents an open attachment point 1 and the purported green C shaped portion represents an open attachment point 2. *Id.* From this, Dr. Collins

manufactures a narrative, describing how the conveyor belt would be installed and removed into and out of these contact points. *Id.*

Dr. Collin's analysis (and Petitioner's reliance on his analysis) is flawed from the start. It rests on an unfounded assumption that McLaughlin's conveyor is removable, failing to support this assumption in any way. Dr. Collins does not cite a single passage from McLaughlin that describes or suggests removing the conveyor unit. Nor does he discuss why a POSITA might interpret the contact points illustrated in McLaughlin's Fig. 2 as teaching or suggesting a removable configuration, rather than merely contact points for a conveyor unit that is installed in the system and left permanently in place (i.e., non-removable) after said installation. Dr. Collins states that the conveyor unit illustrated in Fig. 2 is removable, and then goes far beyond any express disclosures in McLaughlin to explain how the conveyor might be removed and re-installed. There is nothing adequately tying his conjecture to the actual disclosures in McLaughlin.

Dr. Collins's conclusory analysis is woefully deficient for institution. McLaughlin is Petitioner's own patent. To the extent Petitioner contends that any of its own commercial systems embody McLaughlin and do in fact include removable conveyor belt units, Petitioner can advance that system prior art theory at the district court where such theories are properly heard. 35 U.S.C. § 311(b) (limiting *inter*

partes review “only on the basis of prior art consisting of patent or printed publications”).

The Board cannot institute here where McLaughlin says nothing about a removable conveyor belt and the Petition only offers Dr. Collins's unsupported conjecture. Dr. Collin's opinions should be given no weight. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15 (PTAB Aug. 24, 2022) (precedential) (denying institution and finding that conclusory testimony that “does not cite to any additional supporting evidence or provide any technical reasoning to support [that testimony] . . . is entitled to little weight”); *see also* 37 C.F.R. § 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”); *Upjohn Co. v. Mova Pharm. Corp.*, 225 F.3d 1306, 1311 (Fed. Cir. 2000) (“Lack of factual support for expert opinion going to factual determinations, however, may render the testimony of little probative value in a validity determination.”); *Carella v. Starlight Archery & Pro Line Co.*, 804 F.2d 135, 138 (Fed. Cir. 1986) (“Although in some circumstances unsupported oral testimony can be sufficient to provide prior knowledge or use, it must be regarded with suspicion and subjected to close scrutiny.”).

This is particularly problematic in cases where, like here, expert testimony is offered not simply to provide a motivation to combine prior art teachings, but rather to supply a limitation missing from the prior art. *See KSR Int'l. Co. v. Teleflex Inc.*,

550 U.S. 398, 421 (2007) (stating that a “factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning”); *Arendi S.A.R.L. v. Apply, Inc.*, 832 F.3d 1355, 1361-62 (Fed. Cir. 2016) (holding that reliance on only expert knowledge in an obviousness analysis is “typically invoked to provide a known motivation to combine, not to supply a missing claim limitation”).

VI. CONCLUSION

For the foregoing reasons, the Board should deny institution and allow the District Court to adjudicate issues it is well-familiar with and that will be resolved long before any projected final written decision here.

Respectfully submitted,

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APPENDIX OF EXHIBITS

Exhibit 2001	<i>Provisur Tech., Inc. v. Weber Inc. et al.</i> , Case No. 5:21-cv-06113, Dkt. 166, Transcript of Scheduling & Discovery Dispute Hearing, June 20, 2023
Exhibit 2002	<i>Provisur Tech., Inc. v. Weber Inc. et al.</i> , Case No. 5:21-cv-06113, Dkt. 216, Transcript of Scheduling Hearing, September 5, 2023
Exhibit 2003	<i>Provisur Tech., Inc. v. Weber Inc. et al.</i> , Case No. 5:21-cv-06113, Dkt. 214, Supplemental Scheduling Order, September 5, 2023
Exhibit 2004	<i>Provisur Tech., Inc. v. Weber Inc. et al.</i> , Case No. 5:21-cv-06113, Provisur Invalidity Contention Cover Pleading
Exhibit 2005	<i>Advanced Notice of Proposed Rulemaking 13</i> (“A Sand Revolution stipulation, April 21, 2023

CERTIFICATION OF WORD COUNT

The undersigned certifies pursuant to 37 C.F.R. § 42.24 that the foregoing Patent Owner's Preliminary Response to Petition for *Inter Partes* Review, excluding any table of contents, mandatory notices under 37 C.F.R. § 42.8, certificates of service or word count, or appendix of exhibits, contains 5,784 words according to the word-processing program used to prepare this document (Microsoft Word).

Dated: February 28, 2024

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR INTER PARTES REVIEW was served on February 28, 2024, by email on the following counsel of record for Petitioner:

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