

**IN THE UNITED STATES DISTRICT COURT FOR THE
WESTERN DISTRICT OF MISSOURI
ST. JOSEPH DIVISION**

PROVISUR TECHNOLOGIES, INC.,	)	
	)	
Plaintiff,	)	
	)	
v.	)	Case No. 21-cv-06113-SRB
	)	
WEBER, INC., et al.,	)	
	)	
Defendants.	)	

ORDER

Before the Court is Plaintiff Provisur Technologies, Inc.’s (“Plaintiff”) Motion to Sever Weber’s Four New Patent Counterclaims. (Doc. #211.) As set forth below, the motion is DENIED.

I. FACTUAL BACKGROUND

This is the third patent infringement case filed in this Court by Plaintiff against Defendant Weber, Inc. and related entities (“Defendants” or “Weber”). See *Provisur Technologies, Inc. v. Weber, Inc., et al.*, Case No. 19-cv-06021-SRB (W.D. Mo.) (“*Provisur I*”); *Provisur Technologies, Inc. v. Weber, Inc. et al.*, Case No. 20-cv-06069-SRB (W.D. Mo.) (“*Provisur II*”). All three cases generally allege that Defendants’ food slicing machines infringe Plaintiff’s patents. *Provisur I* and *II* were consolidated, and a jury trial commenced on October 14, 2022. In part, the jury found that Defendants willfully infringed Plaintiff’s patents.

This case (“*Provisur III*”) alleges that Defendants infringed Plaintiff’s U.S. Patent Nos. 8,408,109 B2 (“the ‘109 patent”), 10,625,436 (“the ‘436 patent”), and 10,639,812 (“the ‘812 patent”). The First Amended Complaint asserts the following claims: Count I—Infringement of the ‘109 Patent; Count II—Infringement of the ‘436 and ‘812 Patents; and Count III—Unfair Competition Under Missouri Law. In part, Plaintiff alleges that Defendants infringed the ‘109

patent “by making, using, offering to sell, selling, and/or importing into the United States products that include, but are not limited to, the Weber Slicer S6, the Weber Slicer 904-02 (and later versions of the Weber Slicer 904), the Weber Slicer 905, and the Weber Slicer 906[.]” (Doc. #167, ¶ 132.) Plaintiff also alleges that Defendants’ WeSLICE machine infringes the ’436 and ’812 patents.

In response to the First Amended Complaint, Defendants filed an Answer and six Counterclaims against Plaintiff. The Counterclaims at issue are as follows: Count 1—Infringement of Defendants’ U.S. Patent No. 9,457,487 B2 (the “‘487 Patent”); Count 2—Infringement of Defendants’ U.S. Patent No. 8,529,321 B2 (the “‘321 Patent”); Count 3—Infringement of Defendants’ U.S. Patent No. 10,647,013 B2 (the “‘013 Patent”); and Count 4—Infringement of Defendants’ U.S. Patent No. 11,331,823 B2 (the “‘823 Patent”).¹ The alleged infringing products include Plaintiff’s SX330 Slicer, SX380 Slicer, and the Hoegger TrimX.

Plaintiff now moves to sever Defendants’ four patent infringement counterclaims from this case. Plaintiff argues the patent counterclaims are dissimilar from its patent infringement claims, would confuse the jury, and would delay resolution of this case. Defendants oppose the motion, and the parties’ arguments are addressed below.

II. LEGAL STANDARD

Under Federal Rule of Civil Procedure 21, “the court may . . . sever any claim against a party.” Fed. R. Civ. P. 21. In general, “[c]ourts consider the following five factors when examining whether to sever a case: whether (1) the claims arise out of the same transaction or occurrence; (2) the claims present some common questions of law or fact; (3) settlement of the claims or judicial economy would be facilitated; (4) prejudice would be avoided if severance

¹ Defendants also assert unfair competition and trade secret counterclaims, but Plaintiff does not move to sever those counterclaims.

were granted; and (5) different witnesses and documentary proof are required for the separate claims.” *Broadcom Corp. v. Sony Corp.*, SACV 16-1052 JVS (JCGx), 2016 WL 9108039, at *2 (C.D. Cal. Dec. 20, 2016) (considering whether to sever patent counterclaims); *see also In re EMC Corp.*, 677 F.3d 1351, 1356 (Fed. Cir. 2012).² However, “[i]t is the interest of efficient judicial administration that is to be controlling under the rule, rather than the wishes of the parties.” *Viasat, Inc. v. Space Sys./Loral, Inc.*, No. 12-CV-00260-H-WVG, 2012 WL 12844702, at *2 (S.D. Cal. Aug. 23, 2012) (citation and quotation mark omitted).

III. DISCUSSION

Here, Plaintiff presents several arguments in support of severing Defendants’ patent counterclaims. Plaintiff primarily argues that Defendants’ patent counterclaims lack commonality with the patent infringement claims asserted by Plaintiff. Plaintiff argues Defendants’ patent counterclaims involve different technologies and products, require new witnesses and evidence, and would impermissibly delay the resolution of its patent infringement claims. Plaintiff argues Defendants’ patent counterclaims “would more than double the length of trial, needlessly complicate the issues for the jury, and require substantial delay under the Patent Local Rules.” (Doc. #211, p. 2.)

Upon review, the Court finds that a severance is not warranted. First, under the unique circumstances presented here, judicial economy carries significant weight. *Provisur I* was filed over four years ago. The Court has expended an extraordinary and inordinate amount of time presiding over *Provisur I*, *II*, and *III*. At a recent hearing, the Court advised counsel for both parties:

² Both parties cite case law applying Federal Circuit and Eighth Circuit case law. *See Samsung Elec. Co., Ltd. v. Netlist, Inc.*, No. 21-1453-RGA-JLH, 2023 WL 5333284, at *3 (D. Del. Aug. 18, 2023) (“In patent cases, motions to sever are governed by Federal Circuit law.”) The Court notes that the case law is not materially different and the result would be the same under both Federal Circuit and Eighth Circuit case law.

[To] look at my ECF. Look at the millions of dollars you've spent . . . I think I have been extremely patient, but there has been millions of pages filed in this case. . . . [T]he problem isn't that you need more due process or you need more pages, its we've got to get this done, and whatever's going on, delay on one side or the other seems to be part of a strategy. And I'm done with that strategy. So the strategy is to get it done at all costs, running over timelines and deadlines to get [the trial] done in 2024. . . . I understand [deadlines] can be amended under Eighth Circuit law, and I'm going to amend them.

(Doc. #166, pp. 25, 27.) Following that hearing, Defendants asserted the patent counterclaims at issue.

The Court then entered a Supplemental Scheduling Order that “governs all claims and counterclaims currently asserted in this case.” (Doc. #214, p. 1.) Under the Supplemental Scheduling Order, trial is set for November 18, 2024. For the reasons previously explained by the Court, this entire case—including Plaintiff’s claims and Defendants’ counterclaims—will be resolved at trial in 2024.³ Consequently, judicial economy weighs strongly against a severance. *See Broadcom Corp.*, 2016 WL 9108039, at *4 (refusing to sever patent counterclaims in part because “if it severs the case, then it will have to spend twice the amount of judicial resources to resolve a dispute between the same parties, who are represented by the same attorneys”).

Second, neither party will suffer prejudice absent a severance. Based on *Provisur I, II*, and *III*, it is clear that Plaintiff has more than enough time and resources to meet the deadlines in the Supplemental Scheduling Order. Defendants are similarly well-equipped to meet the deadlines, and the resolution of their counterclaims should not be delayed. As explained by Defendants, “the current schedule allows ample time for the parties and the Court to” prepare this case for trial in November 2024. (Doc. #215, p. 7.) Indeed, “[b]y not severing the case, the

³ Plaintiff complains that a “jury trial on multiple competing patents within 14 months is unprecedented.” (Doc. #218, p. 2.) Assuming this is accurate, it won’t be unprecedented after this case.

parties are more likely to take steps towards resolving the dispute [and] focus their attention on the most important issues.” *Broadcom Corp.*, 2016 WL 9108039, at *4.⁴

Third, the Court rejects Plaintiff’s arguments that the patent counterclaims “involve technologies and products unrelated to those at issue in this case.” (Doc. #211, p. 2.) The Court agrees with Defendants that:

Provisur’s and Weber’s patents both generally relate to food processing machinery used for slicing and preparing meat and cheese products for sale Both parties’ competing food processing machinery will be relevant to whether each party practices its own asserted patents. . . . Weber’s competing patent infringement counterclaims are not significantly different from those raised by Provisur. Each involve competing food processing machines, technology that has long been at issue in litigation between the parties.

(Doc. #215, p. 14.) For these reasons, and the additional reasons stated by Defendants, the Court will not sever Defendants’ patent counterclaims.

IV. CONCLUSION

Accordingly, it is hereby ORDERED that Plaintiff’s Motion to Sever Weber’s Four New Patent Counterclaims (Doc. #211) is DENIED. It is further ORDERED that the Supplemental Scheduling Order (Doc. #214) governs the remaining deadlines and tasks in this case.

IT IS SO ORDERED.

Dated: September 15, 2023

/s/ Stephen R. Bough
STEPHEN R. BOUGH
UNITED STATES DISTRICT JUDGE

⁴ Plaintiff’s reply states the current schedule will deprive it of “an opportunity to resolve invalidity challenges in the Patent Office PTAB before trial[.]” (Doc. #218, p. 6.) The Court need not address this argument because it was raised for the first time in a reply brief. Even if properly raised, this argument would not result in a severance.