

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PROVISUR TECHNOLOGIES, INC.,
Petitioner,

v.

TEXTOR MASCHINENBAU GMBH,
Patent Owner.

IPR2024-00224
Patent 9,457,487 B2

Before JEREMY M. PLENZLER, CARL M. DeFRANCO, and
JASON W. MELVIN, *Administrative Patent Judges*.

DeFRANCO, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

Provisur Technologies, Inc. (“Provisur”) filed a Petition requesting *inter partes* review of claims 1–4, 6, 9, 10, 14–16, and 22 of U.S. Patent No. 9,457,487 B2 (Ex. 1001, “the ’487 patent”). Paper 2 (“Pet.”). Textor Maschinenbau GMBH (“Textor”), the owner of the ’487 patent, filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). Textor identifies Weber Textor Maschinenbau GmbH, Weber, Inc., Textor, Inc., Weber Maschinenbau GmbH Breidenbach, and Weber Maschinenbau GmbH Neubrandenburg (“Weber”) as real parties-in-interest. Paper 5, 2.

Because we determine that Provisur presents *compelling* evidence that at least independent claims 1 and 22 of the ’487 patent are unpatentable, we institute *inter partes* review of all claims as challenged in the Petition.

I. BACKGROUND

A. Related Matters

The ’487 patent is the subject of a parallel infringement action, *Provisur Technologies, Inc. v. Weber, Inc.*, No. 5-21-cv-06113 (W.D. Mo.) (“the parallel Missouri action”).¹ See Paper 5, 2. That case began with Provisur’s filing of a complaint in September 2021, asserting another patent, US 8,408,109 B2 (“the ’109 patent”). See Ex. 3001, Dkt. #1, 4. The ’109 patent is currently the subject of another IPR proceeding, IPR2022-00599.

Two-years after Provisur filed its complaint, Weber filed a counterclaim asserting the ’487 patent under challenge here. *Id.*, Dkt. #204. In turn, Provisur diligently filed the instant Petition within three-months of

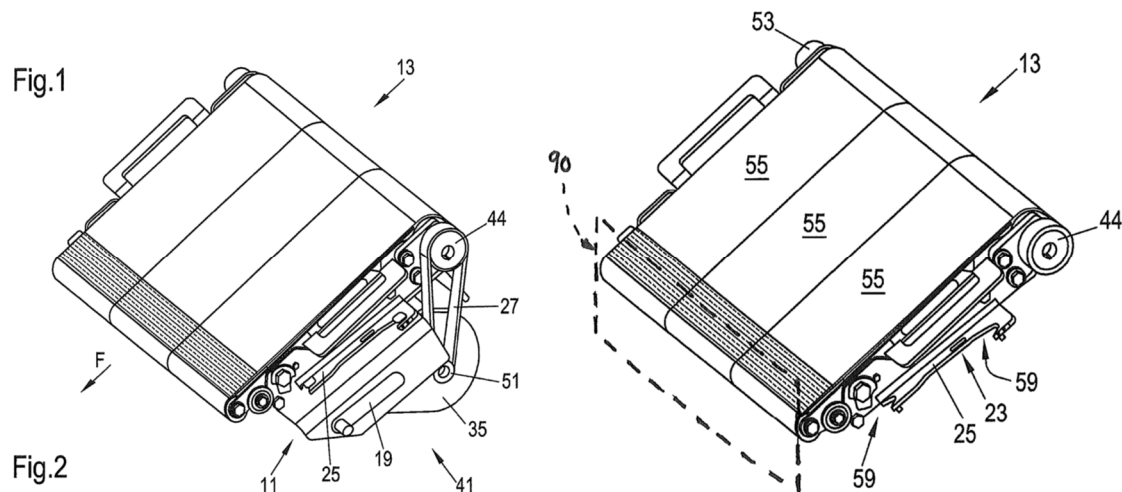
¹ The district court’s docket sheet (Ex. 3001) was consulted to determine the status of the Missouri action. The parties are instructed to update the Board on any material events occurring in the case. See 37 C.F.R. § 42.8(a)(3).

Weber's counterclaim and within days of learning the exact claims Weber was asserting. *See* Pet. 81.

B. The '487 Patent

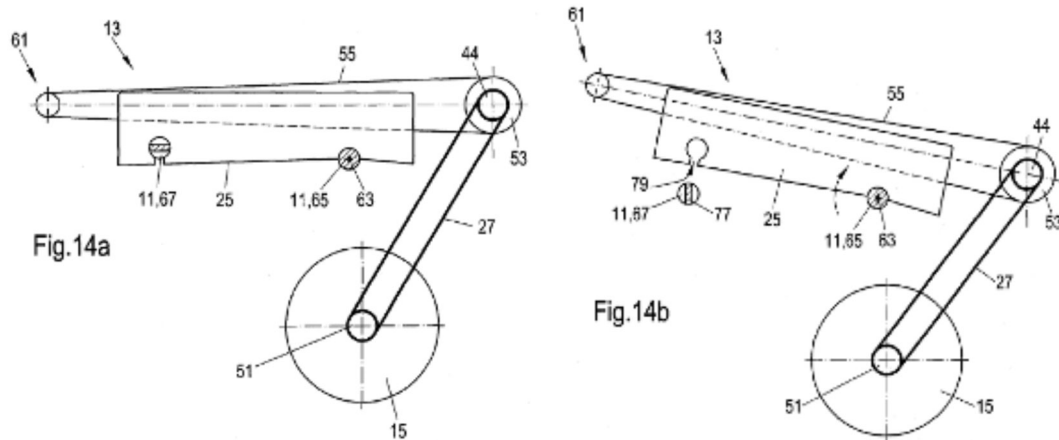
The '487 patent describes a "slicing apparatus for food products" that includes a "removable conveyor belt unit." Ex. 1001, Abstract, 1:15–18, 2:25–26. These conveyor belts "are customarily greatly contaminated during the operation of a slicing apparatus" so as to require daily cleaning, "frequently even several times daily." *Id.* at 1:50–55. To carry out a thorough cleaning, the belts need to be removed. *Id.* at 1:55–57.

The '487 patent describes a removable conveyor belt unit that facilitates easy cleaning. *Id.* at 2:20–27. As shown in Figures 1 and 2 below, removable conveyor belt unit 13 includes base 25 coupled to substructure 41 via mount 11. *Id.* at 7:30–34.



As shown, substructure 41 is also provided with drive shaft 51 and drive belt 27, which is coupled to drive wheel 44 on conveyor belt unit 13. *Id.* at 8:20–29. Conveyor belt unit 13 may be removed from substructure 41 by means of "relative movement" between drive shaft 15 on the substructure and drive wheel 44 on the conveyor belt unit. *Id.* at 3:52–4:18. This relative

movement is accomplished in the manner shown below in Figures 14a and 14b.



As shown above, conveyor belt unit 13 can be pivoted, which reduces the space between drive wheel 44 on the conveyor belt unit and stationary drive shaft 51 on drive motor 15, thereby allowing drive belt 27 to be “relaxed” or “tautened” for removing or installing the base on mounts 11 of the substructure. *Id.* at 4:1–26, 12:30–40, 13:7–36.

C. The Challenged Claims

Of the challenged claims, claims 1 and 22 are independent. Claim 1, reproduced below and annotated by Provisur, is illustrative of the challenged claims:

[1.Pre] A slicing apparatus for food products, the slicing apparatus comprising:

[1.A] a removable conveyor belt unit (13) having at least one track and a base (25);

[1.B] a substructure (41) having a mount (11) coupled to the base (25); and

[1.C1] a drive (15) coupled to the conveyor belt unit (13) by a drive belt (27),

[1.C2] the conveyor belt unit (13) is configured to be cancelled by relaxing the drive belt (27) and is configured to 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).

Pet. 7.

Claim 22 shares a similar claim scope with claim 1, but adds “a second drive (15)” and that “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 (15) and the second drive (15).”

Ex. 1001, 16:31–43.

D. The Asserted Challenges

Claims Challenged	35 U.S.C. §	Basis
1, 6, 9, 15, 16	102	Konishi, ²
1–4, 6, 9, 10, 14–16, 22	103(a)	Konishi, Linde ³
1–4, 6, 9, 10, 14–16, 22	103(a)	McLaughlin ⁴
1–4, 6, 9, 10, 14–16, 22	103(a)	McLaughlin, Konishi

II. ANALYSIS

A. Level of Ordinary Skill in the Art

Provisur proposes, and Textron does not dispute, that one skilled in the art would have had:

(1) a bachelor’s degree (or equivalent) in mechanical engineering (or a similar field) and at least two years of experience working as an engineer (or similar role) on food processing and/or packaging systems (or in a similar field); or (2) at least seven years of experience working as an engineer (or similar role) on food processing and/or packaging systems (or in a similar field).

² Japanese Patent Publication 06-117905, published Apr. 28, 1994 (Ex. 1004, “Konishi”).

³ WO 03/065786 A2, published Aug. 14, 2003 (Ex. 1005, “Linde”).

⁴ US 9,296,120 B2, issued Mar. 29, 2016 (Ex. 1006, “McLaughlin”).

Pet. 8–9. Provisur’s proposed definition is consistent with the problems and solutions in the ’487 patent and prior art of record. Accordingly, for purposes of institution, we adopt Provisur’s definition of the level of skill in the art.

B. Claim Construction

Provisur asserts that the claim terms should be construed “according to their plain and ordinary meanings as understood by [one skilled in the art] in view of the specification and prosecution history” and that “[n]o terms require an explicit construction to resolve the unpatentability controversy between the parties here.” Pet. 9. Textron appears to agree, its counsel having stated in the related parallel action that “most of [its] patent claims are plain and ordinary . . . [t]hey’re not difficult or complex claims or claim terms.” Ex. 1020, 5. Thus, at this preliminary stage, we do not perceive the need to expressly construe any claim terms, for we can decide the threshold question of institution without further construction. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (approving Board decision not to construe claim language where the construction is not material to the dispute).

C. Ground 1—Anticipation by Konishi

1. Independent Claim 1

We begin with Provisur’s showing of how Konishi anticipates all the elements of claim 1. *See* Pet. 18–25. In support, Provisur provides a detailed claim chart, reproduced below, mapping each of the recited elements of claim 1 to express disclosures in Konishi. *Id.* at 19.

Claim Element	Konishi Exemplary Disclosures
removable conveyor belt unit	conveyor belt 14, subframe 12, and rollers 10-11, timing pulley 24
Base	subframe 12
substructure	frame 9
mount	hooks 25R, 25F
Drive	drive motor 32
drive belt	timing belt 49, timing pulley 48, conveyor belt 14, timing pulley 24
relaxing/tautening/relative movement	[0033]–[0041]; Figs. 8-9

In our view, Provisur’s claim chart alone identifies the particular evidence on which Provisur relies as proof of anticipation by Konishi. But Provisur does not stop there. In addition, Provisur breaks claim 1 down into four parts—elements 1[A], 1[B], 1[C1], and 1[C2]—and provides annotated figures from Konishi, two of which are reproduced below, to show exactly where and how Konishi teaches each of those claim elements. *Id.* at 19–24.

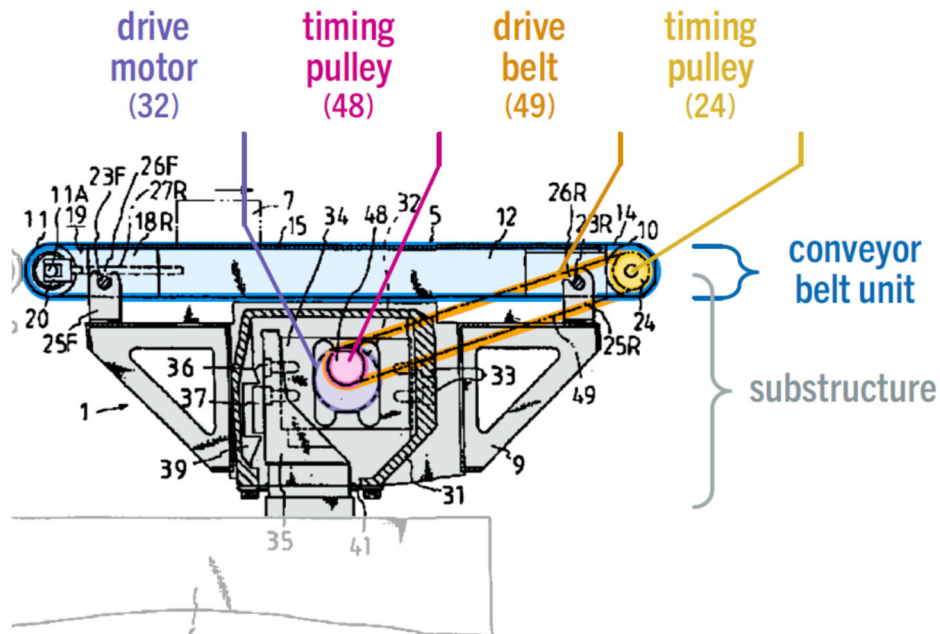
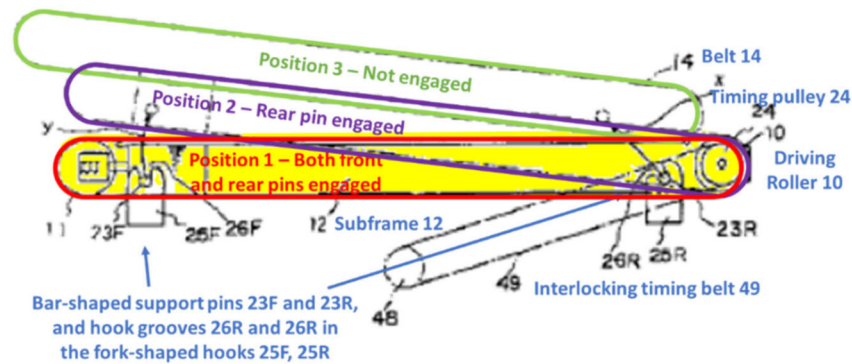


Figure 8



As shown above, the top figure depicts Konishi's conveyor belt unit (blue) installed on a substructure (gray) with the drive belt (orange) in an engaged configuration between two drive pulleys (pink/yellow). The bottom figure, in turn, depicts how Konishi's conveyor belt unit is configured to be removed from the substructure by pivoting the conveyor belt unit from an *installed* configuration (red position), where the drive belt is engaged (i.e., tautened), to a *cancelled* configuration (green position) where the drive belt is disengaged (i.e., relaxed). Provisur also provides credible testimony from its expert to show what one skilled in the art would have understood from reading Konishi's description in conjunction with reviewing Konishi's figures. *See id.* (citing Ex. 1003 ¶¶ 72–92). That evidence is clear and concise in terms of Provisur's proof of how Konishi anticipates each element of claim 1, including disputed element 1[C2].

Textor's sole response to Provisur's extensive proof of anticipation is that Provisur purportedly fails to address how Konishi teaches the second part of claim element 1[C2]. *See* Prelim. Resp. 16–19. In doing so, Textor explains that the first part of element 1[C2] is the "*removal process* where 'conveyor belt unit (13) is configured to be cancelled by relaxing the drive belt (27),' and the second part of element 1[C2] is the "*installation process*

where ‘conveyor belt unit (13) . . . is configured to be established by tautening the drive belt (27).’ *Id.* at 16. According to Textor, “[Provisur’s] mapping focuses on the claimed removal process, completely ignoring whether Konishi teaches the claimed installation process.” *Id.* at 17 (citing Pet. 23–24); *see also id.* (“There is no discussion at all of Konishi’s installation process.”). As such, Textor surmises that, “by omitting half a limitation central to the point of novelty from prosecution, [Provisur] falls far short of a challenge with ‘*compelling merits.*’” *Id.* at 19 (emphasis added).

We disagree. At the outset, we note that Textor repeatedly couches its response in terms of Provisur failing to meet a “compelling merits” standard. *See, e.g.*, Prelim. Resp. 19, 20, 21. The “compelling merits” standard is reserved for cases where a parallel district court action appears to favor exercising our discretion under 35 U.S.C. § 314(a) to deny the petition. *See Commscope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23, 3–5 (PTAB Feb. 27, 2023) (precedential) (“[T]he compelling merits is a higher standard than the standard set for institution by statute” and is applied only where circumstances “favor[] a discretionary denial.”). Apparently, Textor is under the assumption that the compelling merits standard is warranted here because the status and circumstance of the parallel Missouri action favor discretionary denial. *See* Prelim. Resp. 6–16. As such, Textor bypasses the “reasonable likelihood” standard for institution in favor of applying the “compelling merits” standard to Provisur’s Konishi-based challenges. *See id.* 14, 19–21.

We have considered the status and circumstances of the parallel Missouri action. On the one hand, several factors weigh heavily in *favor* of discretionary denial, including:

- (1) the district court’s scheduled trial date of November 18, 2024, which falls approximately four-months before the projected deadline for a final decision here (Ex. 2003, 4);
- (2) the overlap of invalidity issues and the lack of a *Sotera* stipulation by Provisur (Ex. 2004, 3, 7; Pet. 81); and
- (3) the district court’s familiarity with the parties and the technology at issue due to the parallel action being the third in a line of cases between the parties dating back four years or so (Ex. 3002, 1).

On the other hand, several factors weigh heavily *against* discretionary denial, such as:

- (1) the district court’s likelihood of granting a stay given it already did so for another patent, i.e., the ’109 patent, asserted by Provisur in the same action (as noted above in Section I.A) (Ex. 3001, Dkt. #95, #102);
- (2) the fact that the ’487 patent was only recently added to the parallel action via a counterclaim (Ex. 3002, 2) and the district court recently extended several deadlines such that fact discovery is still ongoing and expert discovery is yet to begin (Ex. 3001, Dkt. #355, #364, #365); and
- (3) the fact that moving forward here on the ’487 patent may greatly simplify the issues and ease the district court’s burden on what has evidently become an increasingly frustrating and complex case for the district court (*see, e.g.*, Ex. 2001, 18:24–22:15).

In the end, we find that the sum of these factors is a wash, effectively cancelling each other out and leaving us with no answer on the question of discretionary denial. Nonetheless, out of an abundance of caution and because Textor believes it is warranted, we will proceed with a “compelling merits” analysis of at least the Konishi-based challenges.

Upon review, we find that Provisur presents compelling, if not conclusive, evidence that Konishi anticipates *all* elements of claim 1, including the “relaxing,” “tautening,” *and* “relative movement” limitations of disputed element 1[C2]. Contrary to Textor’s assertion, Provisur does not “completely ignor[e]” the claimed installation, i.e., “tautening,” limitation. Rather, it is Textor who ignores, and blatantly disregards, Provisur’s clear and overwhelming evidence of Konishi’s disclosure of that particular limitation, not to mention Konishi’s clear and undisputed disclosure of the other undisputed elements of claim 1.

Most blatantly, Textor ignores Provisur’s detailed claim chart (as reproduced above), which clearly and concisely maps the recited “relaxing,” “tautening,” and “relative movement” limitations of claim 1 to *paragraphs 33–41* of Konishi, as well as to Konishi’s Figures 8 and 9. Pet. 19. Although Textor acknowledges Provisur’s citation to Konishi’s paragraphs 33–35 for teaching the removal, i.e., “relaxing,” limitation of element 1[C2], Textor fails to acknowledge Provisur’s citation to Konishi’s other paragraphs, such as paragraphs 38–41, for teaching the “tautening” and “relative movement” limitations. *See* Prelim. Resp. 17 (addressing only Provisur’s citation to paragraphs 33–35 of Konishi). Those paragraphs in Konishi describe, in no uncertain terms, the process of “reassembl[ing]” the conveyor belt unit onto the subframe once “cleaning is completed.” Ex. 1004 ¶¶ 33–41.

Textor’s complete and utter disregard of key aspects of Provisur’s reliance on Konishi is fatal to its argument that Provisur’s challenge “falls far short” of the “compelling merits” standard. Prelim. Resp. 19. The cited evidence plainly proves otherwise, indeed, to the point that Provisur is

highly likely to prevail on its Konishi-based challenges. In particular, Konishi’s paragraphs 33–37 explain the removal process where “the timing belt 49 . . . becomes loose” so that the base 12 “still equipped with the conveyor belt 14 . . . can be separated from the frame 9” and “processed with predetermined cleaning,” while Konishi’s paragraphs 38–41 explain the installation process where the base 12 “is assembled to the frame 9” so that “a predetermined tension is applied to the timing belt 49.” *Id.*

Moreover, similar to the challenged patent here, Konishi explicitly states that the reassembly (i.e., installation) process is nothing more than the reverse of the removal process. *Compare* Ex. 1001 (“The installation of the conveyor belt unit 13 takes place in reverse order.”), *with* Ex. 1004 ¶¶ 38–39 (“[A]fter the specified maintenance such as cleaning is completed, it is reassembled . . . by performing the operation opposite to that shown in Figure 8.”). Indeed, Provisur’s expert highlights that very passage in Konishi when explaining how Konishi teaches the second half of claim element 1[C2]—“Konishi further states that the installation is completed by repeating the removal steps in opposite order.” Ex. 1003 ¶ 92 (citing Ex. 1003 ¶¶ 22, 39); *see also* Pet. 24 (citing Ex. 1003 ¶ 92 in support of its showing that “Konishi teaches claim element 1[C2]”).

Collectively, that evidence leads to the unequivocal conclusion that Provisur is highly likely to prevail in showing that at least claim 1 of the ’487 patent is anticipated by Konishi. Thus, based on the preliminary record, we conclude that Provisur meets the “compelling merits” threshold for institution despite any factors favoring discretionary denial, as discussed above.

2. Dependent Claims 6, 9, 15, and 16

Textor offers no additional response to Provisur’s challenge of dependent claims 6, 9, 15, and 16 as being anticipated by Konishi, except to rely on its argument against Provisur’s challenge of claim 1. *See* Prelim. Resp. 19. Because Provisur’s anticipation challenge of claim 1 already satisfies the “compelling merits” threshold for institution, we do not see the need at this stage to address the dependent claims in the absence of any rebuttal evidence from Textor. Further analysis is best left for trial after full development of the record.

D. Grounds 2 and 4—Obviousness Over Konishi in View of Lindee or McLaughlin

Provisur challenges claims 1–4, 6, 9, 10, 14–16, and 22 as being rendered obvious by Konishi in combination with either Lindee or McLaughlin. *See* Pet. 29–49, 75–79, respectively. Textor does not separately argue these Konishi-based obviousness challenges, except to assert generally that they “fail for the reasons addressed above” with respect to the anticipation challenge based on Konishi alone. *See* Prelim. Resp. 19. With that in mind, Textor surmises that “[Provisur] cannot satisfy the *heightened compelling merits standard* sufficient for institution” of its Konishi-based obviousness challenges. *Id.* at 20 (emphasis added). In doing so, Textor acknowledges that independent claim 22 is similar to claim 1 in that “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.” *Id.* at 19–20.

In other words, Textor’s sole basis for attacking the Konishi-based obviousness challenges is that the asserted combination lacks claim element 1[C2]. But, as discussed above in Section II.C.1, we reject Textor’s

argument that Konishi lacks any teaching or suggestion of that claim element, instead, finding that Konishi discloses it explicitly. Thus, in the absence of any further rebuttal evidence from Textor, we find that Provisur's Konishi-based obviousness challenges are more than strong enough on their merits to compel our review of at least claims 1 and 22.

E. Ground 3—Obviousness Over McLaughlin

Provisur also challenges claims 1–4, 6, 9, 10, 14–16, and 22 as being rendered obvious by McLaughlin. *See* Pet. 50–75. In support, Provisur points to Figure 2 of McLaughlin as illustrating a conveyor belt unit (225) installed on a substructure (230) via two attachment points. *Id.* at 52–53 (annotating McLaughlin's Fig. 2). As for the conveyor belt unit being removably installed, Provisur relies on the testimony of its expert that one skilled in the art would have understood from McLaughlin's Figure 2 that the two attachment points allow for rotation and removal of the conveyor belt unit from the substructure. *Id.* at 53–55, 57–59.

Textor responds that “McLaughlin says nothing about installing or removing its conveyor belt unit and does not teach or suggest that the unit could be removed.” Prelim. Resp. 21. Instead, according to Textor, “[Provisur] 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” via the attachment points depicted in McLaughlin's Figure 2. *Id.* at 21 (citing Pet. 52–60, Ex. 1003 ¶¶ 184–197).

In making these arguments, Textor never addresses Provisur's reliance on the “shape” and “location” of McLaughlin's attachment points as teaching or suggesting a removable conveyor belt unit. Pet 53–54; *see also* Ex. 1003 ¶¶ 190, 193, 195 (same). Textor also ignores Provisur's reliance

on the level of knowledge in the art regarding removable conveyor belt units at the time of the claimed invention. *See, e.g.*, Ex. 1003 ¶¶ 39, 196.

Moreover, Provisur provides *unrebutted* expert testimony for why one skilled in the art would have understood McLaughlin as teaching the disputed removal and installation limitations. *See* Ex. 1003 ¶¶ 190–195. In the absence of rebuttal expert testimony and based on the current record, we find that Provisur sufficiently shows that McLaughlin teaches or suggests the all the elements of claims 1 and 22, including that the conveyor unit is removable. Thus, at this stage, Provisur demonstrates a reasonable likelihood that at least claims 1 and 22 would have been obvious over McLaughlin.

III. CONCLUSION

For the above reasons, we determine that compelling evidence shows that at least claim 1 is unpatentable as anticipated by Konishi and at least claims 1 and 22 are unpatentable as obvious over Konishi in view of either Linde or McLaughlin. We also determine that a reasonable likelihood exists that claims 1 and 22 are unpatentable as obvious over McLaughlin. And because “[e]qual treatment of claims and grounds for institution purposes has pervasive support in *SAS*,” we institute on all the claims as challenged in the Petition. *See* 37 C.F.R. § 42.108(a), (c); *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018) (citing *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018)).

IV. ORDER

Accordingly, it is:

ORDERED that an *inter partes* review of claims 1–4, 6, 9, 10, 14–16, and 22 of the ’487 patent is *instituted*; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), notice is hereby given of the institution of trial, which will commence on the entry date of this Decision.

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