

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
Patent No. 9,457,487

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

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PETITIONER EXHIBIT LIST

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1003	Expert Declaration of Dr. John M. Collins, Ph.D. in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 9,457,487
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1005	WO 03/065786 (“Lindee”)
1006	U.S. Patent No. 9,296,120 B2 (“McLaughlin”)
1007	U.S. Patent Publication No. 2009/0188358 (“Hansen”)
1008	U.S. Patent No. 5,499,719 (“719Lindee”)
1009	U.S. Patent Publication No. 2006/0196328 (“Pryor”)
1010	U.S. Patent No. 4,570,729 (“Rosso”)
1011	U.K. Patent Application No. GB 2 352 675 (“Doe”)
1012	U.S. Patent Publication No. 2010/0275789 (“Lee”)
1013	U.S. Patent Publication No. 2005/0279228 A1 (“Julian”)
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1025	U.S. Patent No. 4,570,729 (“Del Rosso”)
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I. INTRODUCTION

The Board found in the Institution Decision that Provisur’s Petition presented “compelling, if not conclusive, evidence” of unpatentability of at least independent claims 1 and 22 of the ’487 removable conveyor patent. (Paper 8, 2, 11.) In response, Patent Owner Textor non-contingently cancelled all claims-at-issue except for claim 22. The Patent Owner Response (Paper 12, “POR”) is left arguing for patentability based on two rudimentary claim features: (1) a conveyor belt unit that could be removed “without tools”; and (2) a removable conveyor belt unit with two lanes. (POR, 25-26, 57-59.)

Textor—again—“ignores, and blatantly disregards, Provisur’s clear and overwhelming disclosure of” unpatentability, as the Institution Decision stated. (Paper 8, 11.) For example, Textor ignores the overwhelming evidence that “a POSA would have been aware of other prior art that discuss toolless conveyor removal,” such as Lee stating “[n]o tools are required to remove conveyor assemblies.” (Pet., 42.) Textor disregards that “[t]he types of components and principles required to accomplish [toolless removal] (detent fits, snap fits, latches, drive belts, conveyor belts, etc.) would have been the type of components a person would learn about at the undergraduate level,” as shown with the Petition. (EX1003, ¶232.) Textor’s own expert even conceded under cross examination that

these kinds of toolless removal options were well-known and conventional. (See, *e.g.*, EX1045, 143-154.)

Textor also ignores the Petition’s clear showing that “it would have been obvious to include a second lane with a second drive in Konishi’s conveyor apparatus.” (Pet., 47.) Provisur relies on *unrebutted* expert testimony to show that it would have been obvious to modify Konishi’s or McLaughlin’s removable conveyors to have a two-drive conveyor for a two-lane configuration for added throughput and productivity. (Pet., 46-49, 74-75.) Textor’s expert does not even submit any opinions to support the patentability of claim 22. That is because the claim is clearly unpatentable.

Below, Petitioner addresses how (1) Konishi anticipates toolless removal; (2) Konishi’s and McLaughlin’s conveyors render obvious the contingently and non-contingently proposed claims; and (3) Textor’s secondary considerations arguments fail.

For the reasons discussed in the Petition, below, and in the opposition to the motion to amend (“MTA”), the original and proposed claims are unpatentable.

II. DISTRICT COURT UPDATE

The District Court has moved the trial involving the ’487 patent back to January 27, 2025, with jury selection occurring January 24, 2025. (EX1066.) Trial

starts twelve days after the scheduled oral hearing in this case. A prompt final written decision could serve the PTAB's goal to "simplify the issues for trial and ease the district court's burden." (Paper 8, 10.) Further, Provisur points out that Textor continues to assert claim 16 in the district court despite non-contingently cancelling that claim.

III. KONISHI ANTICIPATES TOOLLESS INSTALLATION/REMOVAL.

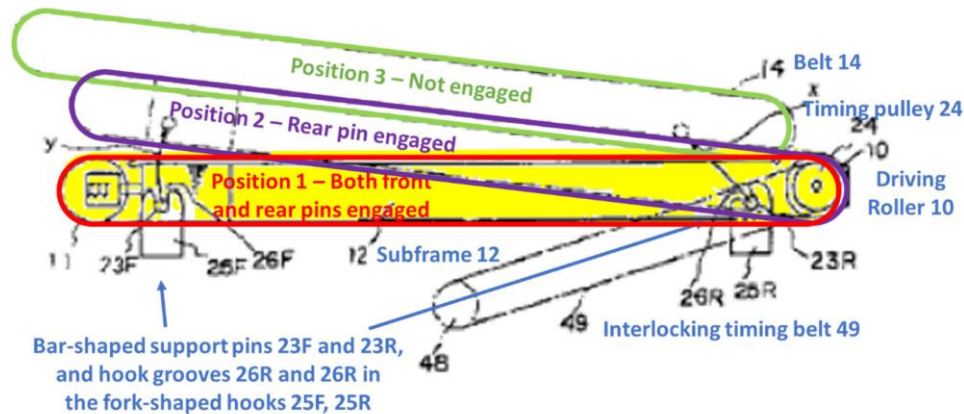
The Petition's Ground 1 based on Konishi discloses the '487 patent's toolless removal process that Textor touts in its response. (POR, 25-26.) Textor is flat wrong that there is "silence" on this issue. (*Id.*, 26-29.) Provisur and its expert maintain that Ground 1 anticipates Textor's proposed claim 25. (EX1040, ¶¶47-48.) Provisur and its expert also maintain that Ground 1 anticipates proposed claims 29, 30, and 33. (EX1040, ¶¶51, 54, 57.)

A. Konishi is not "silent"; it describes installation/removal without tools.

The Petition explained that "Konishi describes a tool-less removal process with simple movements." (Pet., 28.) Konishi's Figure 8, copied and annotated

below, shows that Konishi's conveyor is pivoted through three positions to slide out of place without tools.¹

Figure 8



(EX1003, ¶45.)

Konishi desired to “simplify the structure of the subframe...to make it easier to remove from the frame.” (Pet., 29.) A “POSA would recognize that tool-less removal makes the substructure simpler while making conveyor belt unit removal easier. (EX1003, ¶¶115-116.)” (*Id.*) Textor’s expert, Dr. Reinholtz, does not rebut

¹ Textor’s arguments regarding teaching away, as well as secondary considerations, are irrelevant to anticipation. See *ClearValue, Inc. v. Pearl River Polymers, Inc.*, 668 F.3d 1340, 1344 (Fed. Cir. 2012) (“[W]hether a reference ‘teaches away’ from [an] invention is inapplicable to an anticipation analysis.”).

Provisur's expert's, Dr. Collins, opinion that a "POSA would have understood that a more simple removal process would have not involved tools." (EX1003, ¶115.)

B. Konishi teaches Textor's "negative limitation."

Textor argues that the '487 patents toolless installation/removal is a negative limitation that requires heightened scrutiny of the prior art under the law. (POR, 27.) Even if applicable, Textor's law supports Provisur, as "a reference need not state a feature's absence in order to disclose a negative limitation." *AC Techs., S.A. v. Amazon.com, Inc.*, 912 F.3d, 1358, 1367 (Fed. Cir. 2019); POR, 27.

The Federal Circuit's *Sud-Chemie* decision is instructive. In *Sud-Chemie*, the Federal Circuit addressed whether a prior art reference disclosed a negative claim limitation requiring film "uncoated with an adhesive." *Sud-Chemie, Inc. v. Multisorb Techs., Inc.*, 554 F.3d 1001, 1004 (Fed. Cir. 2009). The prior art "repeatedly refer[red] to the process...with no indication that the process contemplates the use of adhesive coatings on the films." *Id.* The patentee argued that the prior art's failure to "specifically refer to the films as 'uncoated'...[meant that] it fails to teach the" "uncoated with an adhesive" requirement. *Id.* The Federal Circuit was unpersuaded, finding that the prior art "plainly teaches that the containers can be made of films...without coatings." *Id.*, 1004-05.

Similarly here, Konishi “repeatedly refer[s] to the process” of installation/removal “with no indication that the process contemplates the use of” tools. *Id.*; *see also* Pet. 28-29. Like *Sud-Chemie*’s patentee, Textor argues that Konishi’s lack of specifically referring to the removal process as not requiring tools is insufficient. (POR, 27-29). Yet, Textor offers no evidence that a POSA would understand Konishi would not be secured by toolless means. (See EX2006, ¶¶55-91.) To the contrary, its expert testified the opposite under oath: “[Do] you think as of 2011 it would have been beyond the skill of a POSA to implement a latch to secure a conveyor belt unit in Konishi?...[A.] I’m not prepared to sit here today and say either with respect to McLaughlin or Konishi what issues might arise in attempting to do this.” (EX1045, 200:8-201:16.)

Finally, while Dr. Reinholtz opines that a conveyor secured by friction and gravity are insufficient to meet the toolless requirement, EX2007’s declarant, Dr. Meyer, admitted this configuration was within the scope of the claims: “[T]here’s nothing in claim 16 that specifically prohibits a conveyor belt unit being held in place by friction and gravity.” (EX1053, 58:7-16.) Dr. Meyer is correct that the claims are not so limited.

Accordingly, the Board should follow *Sud-Chemie*'s precedent and determine that Konishi's repeated referral to installation/removal without the use of tools meets the claimed toolless removal in this case.

IV. GROUNDS 2-4 RENDER OBVIOUS THE TOOLLESS INSTALLATION/REMOVAL CLAIMS.

The Petition's Grounds 2-4 render obvious the '487 patent's toolless installation/removal process and the claim as a whole. Thus, Provisur and its expert maintain that Grounds 2-4 render obvious Textor's proposed claim 25. (EX1040, ¶¶61-62.) Provisur and its expert also maintain that Grounds 2-4 render obvious proposed claims 26-34. (*Id.*, ¶¶70, 74, 77, 81, 86, 90, 94.)

A. The prior art teaches that toolless removable conveyor belt units, and their benefits, were well known and conventional before the '487 patent.

The Petition showed that in combinations including Konishi or McLaughlin “[a] POSA would have been motivated to use a latch as an option, such as disclosed in Lee.” (Pet., 42, 69-70, 39-40, 67-68.) Provisur showed “a latch is desirable ‘to prevent the conveyor assemblies from being accidentally lifted out of position ... [and to] reduce the likelihood that a conveyor assembly’ might become disconnected ‘due to the reactive force created by the friction of a food product.’”

(Pet., 39-40; *see also* Pet., 42, 68, 70; EX1003, ¶¶163-64, 222-23, 232.) Textor fails to grapple with Lee’s latch disclosure and explicit reason to combine.²

Rather, Textor argues that “neither Petitioner nor its expert identifies a single supporting example” of “conveyor belt units...left unsecured during operation and held in place by gravity alone.” (POR, 25.) Textor is wrong. The Petition and Dr. Collins relied on Lee, which teaches “the conveyor assembly 40A is effectively locked into the toaster by its own weight.” (EX1012, ¶0026; Pet., 39-42, 70; EX1003, ¶¶171-172, 223, 231-33.)

Further, Textor’s expert, Dr. Reinholtz, conceded under cross-examination that latches used for toolless conveyor removal were well known in the art. (EX1045, 195:22-196:7 (“As of 2011, a POSA would have been aware of other latches besides that disclosed in Lee; correct?...There are certainly other ways to

² Further, if Textor’s vertical/horizontal conveyor argument is a non-analogous art argument (POR, 40-41), such argument is legally flawed. *See, e.g., In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1380 (Fed. Cir. 2007) (concluding that analogous art for “a treadmill with a folding mechanism and a means for retaining that mechanism in the folded position” includes “any area describing hinges, springs, latches, counterweights, or other similar mechanism—such as the folding bed”).

implement a latch. And I think a person of ordinary skill in the art would be familiar with some of those.”); *see also id.*, 143:20-44:16 (“Q: Does a latch require tools to latch or unlatch?...A: In general, no, there are latches that do not require tools....Q: [W]ere latches known in the art before the ’487 patent?...[A.] I think latches were known and probably used.”).) Further, like Petitioner’s expert, Dr. Reinholtz agrees that it would have been within the skill of an undergraduate engineering student to implement a latch. (EX1045, 194:21-195:20 (“I think an engineering student would have the skill to implement a latch.”).)

In addition to latches, Dr. Reinholtz admitted ***several*** other toolless conveyor removal components were well known in the art before the ’487 patent, including:

- Quick disconnect fasteners (EX1045, 150:18-151:21; *see also id.*, 211:21-212:22.)
- Toolless detents (*Id.*, 139:3-21 (“I think a designer would know about detents that is designing this kind of equipment.”));
- Friction fit (*Id.*, 147:14-149:1 (“[A] designer of this kind of equipment would know about friction fits.”));
- Jackscrews (*Id.*, 152:3-153:18 (admitting jackscrews are “common mechanical devices” known in the art));

- Thumbscrews (*Id.*, 153:22-154:17 (“[M]ost thumbscrews don’t require a tool.”)).

These admissions are further compelling evidence of obviousness and fully support Dr. Collins’ opinions.

Nonetheless, Textor tries to urge that “Konishi’s and McLaughlin’s conveyor belt units would be left unsecured during operation and held in place by gravity alone.” (POR, 28-29.) This argument has two problems.

First, Textor alleges that Dr. Collins failed to account for certain forces encountered in a production environment. (POR, 29-31.) But Dr. Collins addressed this point in his opening report, and opined that “any reactive force created by conveying food product...would have...motivated [a POSA] to add a latch...for the reasons described in Lee.” (EX1003, ¶163.)

Second, Textor fails to address Dr. Collins’ deposition testimony regarding Lee (EX1012) and other toolless methods. Dr. Collins explained that Lee illustrates that a POSA “would have been aware of other prior art that teaches toolless installation and removal” and “that it’s well-known in the art to have things that can be moved without the use of a tool.” (EX2014, 35:5-36:11.) Further, Dr. Collins’ declaration stated “[t]he types of components and principles required to accomplish [toolless removal] (detent fits, snap fits, latches...)” were known in the art and

“would have required nothing more than the predictable use of known components.” (EX1003, ¶¶231-32; *see also id.*, ¶¶171-72, 266, 163-64, 221-23.) With this reply, Dr. Collins summarizes multiple responsive pieces of prior art that show conventional, toolless mechanical devices that would have been used to lock a conveyor in place. (EX1040, ¶¶16-25.) Dr. Collins also goes a step further and explains how a POSA would have implemented these devices into a system with a removable conveyor, even though not required to show obviousness. (*Id.*, ¶¶26-33.)

Additionally, the Petition argued that the toolless removal would have been obvious in view of McLaughlin/Konishi and “in light of the knowledge of a POSA.” (Pet., 39, 69, 78.) As illustrated by Dr. Reinholtz’s admissions and Dr. Collins’ opinions, it is beyond dispute that a POSA’s knowledge would include simple, toolless securing devices and that a POSA could implement such devices, as claimed. (EX1045, 192:12-193:15.) The Federal Circuit has previously affirmed PTAB decisions that rendered claims obvious based on testimony of generally known components. *See Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330, 1338-39 (Fed. Cir. 2020) (affirming single reference obviousness where missing limitation was “generally known” in the art). The same result applies here.

Accordingly, the Board should determine that Grounds 2-4 render obvious the toolless installation/removal limitations for these reasons.

B. Konishi and McLaughlin do not teach away.

Textor argues that Konishi and McLaughlin’s “lightweight” conveyors “teach away” from a combination where the conveyor belt units are secured by their weight. (POR, 36-40.) Specifically, Textor argues the conveyors “might” pop out of place during operation. (*Id.*) This is a legally irrelevant. Because Konishi and McLaughlin’s conveyors should be lightweight does not mean Konishi and McLaughlin “criticize, discredit, or otherwise discourage” toolless removable conveyor units. A conveyor can be both lightweight and removable.

Long-standing precedent holds that a prior art reference does not teach away if it “merely expresses a general preference for an alternative invention but does not criticize, discredit, or otherwise discourage” the new invention. *Incept LLC v. Palette Life Scis., Inc.*, 77 F.4th 1366, 1375 (Fed. Cir. 2023).

Dr. Reinholtz conceded that McLaughlin does not teach away according to this precedent. (EX1045, 289:16-290:13 (“Can you point me to where McLaughlin criticizes, discredits, or otherwise discourages investigation into a toolless removable conveyor? A. I don’t think you’ll see that in my declaration...[McLaughlin] doesn’t criticize the prior art in that regard. I would not say this is disparaging or criticizing the prior art to teach away.”); *see also id.*, 291:7-295:21.)

Further, Textor’s argument that Konishi’s conveyor “might” pop out of place during operation (POR, 29-31) ignores precedent that a reference “need not be enabled; it qualifies as a prior art, regardless, for whatever is disclosed therein.” *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1357 (Fed. Cir. 2003). Here, Textor does not dispute that Konishi and McLaughlin were able to do what the claims require—Textor only argues that the prior art would not work in a production environment. (POR, 31-40.) Even if functionality in a production environment were required, Konishi teaches that the disclosure “maintain[s] the functionality of the equipment in stable and good condition.” (EX1004, [0004].) In *Geo M. Martin Co. v. Alliance Machine Systems Intern. LLC*, the Federal Circuit determined that a piece of prior art was still prior art “insofar as it was able to do what” elements of the claim require, despite the fact that the machine “did not work at ‘production speed.’” 618 F.3d 1297, 1303 (Fed. Cir. 2010). Even if Textor were correct, which it is not, that legal principle would hold true here to show unpatentability.

Finally, Textor spends pages on a force analysis based on numerous unsupported assumptions. (POR, 31-36.) In his rebuttal analysis, Dr. Collins shows that the weight of Konishi or McLaughlin’s conveyor belt units would have to be negative to have the conveyor pop-up during use. (EX1040, ¶¶39, 42.) Dr. Collins

also illustrates the importance of the factors that Dr. Reinholtz ignored. (EX1040, ¶¶35, 37-38, 41-42.) Textor’s flawed analysis does not overcome the clear evidence of unpatentability.

Accordingly, the Board should reject Textor’s conclusory teaching away argument.

C. Textor relies on improper bodily incorporation arguments.

As the Board knows well, it is improper to require a petitioner to “prove” that the teachings of one reference “could be ‘bodily incorporated’ into” the other reference. *Intel Corp. v. PACT XPP Schweix AG*, 2023 WL 2198649, *3 (Fed. Cir. Feb. 24, 2023). Longstanding precedent holds that “[t]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference” and “[i]t is well-established that a determination of obviousness based on teachings from multiple references does not require an actual, physical substitution of elements.” *Id.* (quoting *Allied Erecting & Dismantling Co. v. Genesis Attachments, LLC*, 825 F.3d 1373, 1381 (Fed. Cir. 2016), and *In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012)).

Nonetheless, Textor and its expert presented a flawed legal theory based on no more than actual physical substitution. Textor asserts that a “POSITA would not have considered Lee’s structure relevant to” Konishi and McLaughlin. (POR, 46-

50.) Dr. Reinholtz made clear in his deposition that his “understanding of the law” required that Provisur “tell [Textor] how you would implement” Lee’s latch in the physical structure of Konishi and McLaughlin. (EX1045, 201:18-202:15.) He is wrong.

Textor’s distinction between horizontal and vertical conveyors is also improper bodily incorporation. Lee’s latch would improve any conveyor—horizontal or vertical—in the manner Lee teaches. (EX1003, ¶¶163, 172, 232.) Thus, the Board should credit Provisur’s un rebutted position that toolless removal mechanisms were predictable components known in the art, especially in light of Dr. Reinholtz’s admissions during his deposition. (See Section IV.A.)

Provisur has met the correct *KSR* obviousness standard. For example, Provisur offered evidence that “the types of components and principles require to accomplish [toolless removal] (detent fits, snap fits, latches, drive belts, conveyor belts, etc.)...required nothing more than the predictable use of known components.” (EX1003, ¶232; Pet., 70, 42); see *KSR Intern Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007). Textor and Dr. Reinholtz failed to refute this argument and have not alleged that using known components—like latches—would yield more than one would expect “from such an arrangement.” *KSR*, 550 U.S. at 417. Likewise, Dr. Collins

said a POSA would recognize Lee's latch would improve Konishi or McLaughlin based on the teachings in Lee. (EX1003, ¶¶163, 172, 232.)

D. Provisur's PowerMax product manuals describe a simple design choice that does not show non-obviousness.

Textor argues that it would not have been obvious to create a toolless removal system because some of McLaughlin's embodiments required tools. (POR, 41-44.) However, even if the PowerMax product required tools, all of the toolless prior art are similar features that yield the same predictable results for standard engineering design choices. *See also* EX1003, ¶223 ("using latches to secure devices would have been well known...and an obvious design choice."). This shows obviousness, not non-obviousness. *In re Magna Elecs., Inc.*, 611 Fed. Appx. 969, 974 (Fed. Cir. 2015) (holding a feature "would be an obvious design choice within the skill of the art" because the feature "provide[s] the same...functionality as [the prior art], and cannot be used as a distinguishing factor to render the claims nonobvious").

E. Textor's secondary considerations are inadequate to overcome the strong obviousness evidence.

Textor has insufficient evidence of secondary considerations to overcome the strong case of obviousness. *See ZUP, LLC v. Nash Manufacturing, Inc.*, 896 F.3d 1365, 1375 (Fed. Cir. 2018) ("The weak evidence of secondary considerations presented here cannot overcome the strong showing of obviousness.").

To support its secondary considerations argument, Textor submits out of context and inapplicable excerpts from district court expert reports. These expert report excerpts have over ***one hundred and fifty*** citations to documents, depositions, interviews, and other evidence that Textor did not submit in this proceeding. The Board cannot assess the credibility of the experts' representations if the Board has no evidence to weigh.³ See *Upjohn Co. v. Mova Pharm. Corp.*, 225 F.3d 1306, 1311 (Fed. Cir. 2000) ("Lack of factual support for expert opinion to factual determinations, however, may render the testimony of little probative value in a validity determination.").

In addition, Textor has submitted no evidence in this proceeding that its supposed experts are qualified to testify on their respective issues. The lack of evidence infects Textor's commercial success expert report excerpts (EX2008), its patent embodiment excerpts (EX2007; see also EX1053, 65:3-68:6), and its copying expert report excerpts (EX2011). Mr. Leathers (EX2011's declarant) specifically

³ This hole in Textor's case is exacerbated by Textor's expert's inability to answer questions asked during remote deposition without inappropriately reviewing documents during the deposition on his personal computer that are not evidence in this proceeding. (EX1053, 60:19-63:9.)

confirmed he is not a POSA. (EX1061, 19:1-20:1, 26:5-19.) *See Kyocera Senco Indus. Tools Inc. v. Int’l Trade Comm’n*, 22 F.4th 1369, 1377 (Fed. Cir. 2022) (“To offer expert testimony from the perspective of a skilled artisan in a patent case...a witness must at least have ordinary skill in the art.”).

Even if Textor had submitted supporting evidence and relied on proper experts, which it does not, Textor’s secondary considerations fail for the below additional reasons.

1. Textor fails to establish nexus.

This patent is not coextensive with the product. Textor does not assert otherwise. *See Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper No. 33, *33 (PTAB Jan. 24, 2020) (Precedential) (finding that a patent owner “d[id] not provide an analysis demonstrating that the products are coextensive” and, thus, concluding “a presumption of nexus is inappropriate”). Textor’s slicers include many features beyond what is claimed in the ’487 patent. (EX1053, 26:6-27:3.) Indeed, the removable conveyor slicers are marked with over twenty patents. (EX1062.)

Attempting to establish nexus, Textor first makes an overbroad and improper incorporation by reference of Meyer’s district court allegations that “each product practices claim 16.” (POR, 51; *see* 37 C.F.R. §42.6(a)(3) (“Arguments must not be

incorporated by reference from one document into another.”).⁴ As expanded upon in below Sections IV.E.2-4, Textor does not submit sufficient evidence that the slicers’ alleged commercial success, the alleged long-felt needs, or the alleged copying were connected specifically to the toolless removable conveyors. Textor’s nexus argument should be disregarded.

In addition, Textor relies on two deposition transcripts from the district court proceeding to support its faulty nexus analysis. (EX2012, EX2013.) Textor’s witnesses’ testimony, however, shows that there is no nexus between any alleged secondary considerations and the ’487 patent’s claimed features. For example, the ’487 patent’s inventor testified that there were other reasons customers purchased slicers. (EX1063, 277:21-278:16; *see also id.*, 284:12-17 (“Are you aware of any customer who would not have bought a slicing line if that slicing line did not have a removable conveyor belt unit in it? ... A. No, I haven’t heard about that.”).) This does not meet Textor’s burden of proof.

⁴ Textor likewise improperly incorporates over thirty five paragraphs of Mr. Leathers’ (EX2011’s declarant) analysis via a single sentence. (POR, 56-57.)

Further undermining the argument that the '487 patent provided any nexus to alleged secondary considerations, Joerg Schmeiser (Weber's CBDO⁵), downplayed the importance of the removable conveyor technology. (EX1060, 250:9-17 ("It's a conveyor. You know, it's – it's not a core technology.").)

For these reasons, Textor has failed to establish any nexus between its commercial success, long-felt need, or copying considerations. Regardless, Provisur addresses these specific considerations in turn below.

2. Textor fails to show copying.

As a threshold issue, Textor's counsel represented [REDACTED]
[REDACTED]
[REDACTED] (EX1064, 2.) Mr. Leathers, by his own admission [REDACTED] (EX1065, 47:3-18; *see also* EX1061, 59:5-20, 62:2-6). And he did not conduct a validity or an objective indicia analysis. (EX1061, 83:3-8, 94:3-14; *see also* EX1065, 32:2-33:7, 190:4-191:11, 271:8-9.)

Leathers simply did not opine that Provisur copied any of the claimed features of the '487 patent. For these reasons, Textor's copying arguments fail.

⁵ EX1060, 11:15-19.

3. Textor fails to show commercial success.

Textor argues that the “claimed toolless removable conveyor...contributed critically to Weber’s commercial success.” (POR, 52.) Yet Weber offers no evidence that ties the alleged “small footprint,” “accessibility from both sides,” or “high level of hygienic design” to the *toolless* aspect of the removable conveyor. The toolless limitation is the only limitation that Textor has argued is not present in the prior art, and Federal Circuit precedent teaches that a secondary consideration fails when it “actually results from something other than what is both claimed and *novel* in the claim.” *Kennametal, Inc. v. Ingersoll Cutting Tool Co.*, 780 F.3d 1376, 1385 (Fed. Cir. 2015).

Evidence exists that shows the toolless removable conveyors did not drive any alleged commercial success. For example, Dr. Kindler (EX2008’s declarant) [REDACTED]
[REDACTED]
[REDACTED] (EX1059, 1.) Since the TS700 and the TS700 FLEX both have removable conveyors (EX1054, 29:15-19), and the FLEX was cheaper (EX2011, ¶31) this is evidence that customers do not buy Textor’s products because of their removable conveyor belt units, but rather because of other features. (See EX1059, 1 [REDACTED]
[REDACTED].)

Further, Mr. Duesterhaus, a Textor salesman, disclaimed a nexus between customers' decisions to purchase Textor machines and the existence of Textor's removable conveyors. (EX1057, 255:11-256:16.) (“[I]n the end I don’t know what decisions made them purchase that machine.”) Before Textor asserted the ’487 in the district court, Duesterhaus said that it is slicing capacity, relationship with the customer, and the capabilities of the full line solution that drives a customer’s purchasing decision. (EX1058, 46:16-50:7.) His self-serving testimony after the ’487 patent became relevant to the parties’ dispute should be afforded little weight.

Likewise, Weber’s CEO—Mr. McCarroll—admitted that things like requiring fewer “functions,” the type of slicing blade, and the type of product being sliced are what drive customers to purchase certain machines. (EX1054, 35:21-38:8, 38:20-39:2, 41:1-42:16.) And similar to Duesterhaus, before McCarroll was educated on this IPR, McCarroll testified that other reasons led customers to purchase Textor’s slicers, including price, reliability, footprint, throughput, yield, and the full-line solution, among others. (EX1055, 476:19-480:19.) McCarroll’s self-serving IPR testimony deserves no weight.

4. Textor fails to show long-felt but unsolved needs.

Textor offers two categories of evidence supporting its long-felt need arguments: (1) statements from the ’487 patent’s specification; and (2) testimony by

the inventor, Mayer. (POR, 54-56.) Again, Textor fails to show that it was the *toolless* installation/removal requirement that met the alleged long-felt needs of “a large cutting throat but a small footprint...accessible from both sides.” (POR, 55.) In fact, Textor’s own witness testified that toolless removable conveyor belts do not provide any benefit to customers. (EX1056, 52:22-53:3.)

If the ’487 patent offers a small footprint, accessibility from both sides, and a high level of hygienic design, Konishi and McLaughlin offer the same benefits. The Federal Circuit has recognized that a long-felt need does not exist when the need was addressed by the prior art. *See Nike, Inc. v. Adidas AG*, 955 F.3d 45, 55 (Fed. Cir. 2020) (“Substantial evidence supports the Board’s finding that other methods of [solving the alleged long-felt need]...had existed before the date of invention.”).

For these reasons, Textor’s long-felt need arguments fail—along with the other weak secondary considerations arguments.

V. ORIGINAL GROUNDS 2, 3, AND 4 RENDER OBVIOUS CLAIM 22.

The Petition showed that all elements of claim 22, including a two-drive conveyor belt unit, were taught by the art. The Petition showed that the claimed removable conveyors were known in Konishi and McLaughlin (Pet., 42-43), and the Petition showed that two-lane conveyors were known (Pet., 44-45; *see also* Paper 8, 14 (“[W]e 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.”).

The Petition cited Dr. Collins’ opinions that it would have been obvious to modify Konishi or McLaughlin to have a two-drive conveyor belt unit for a two lane configuration, for example, in order to increase production and throughput. (Pet., 46-49, 74-75.) The Petition also argued that claim 22 “would have only required a mirror image” of a single-lane removable conveyor (Pet., 48), a sentiment the ’487 patent’s inventor enthusiastically agreed with in his testimony: “It’s a mirrored -- exactly mirrored version of a standard one lane execution of such a removable conveyor system.” (EX1063, 206:11-207:9.)

Textor resorts to arguing that it would not have been obvious to use McLaughlin’s or Konishi’s removal process on Lindee’s two-lane conveyor. (POR, 60-65.) Tellingly, Textor did not submit any technical expert testimony to support its claim 22 arguments. Textor also did not cite its secondary considerations arguments as support for claim 22. Thus, Textor’s claim 22 argument reduces to the allegation that Provisur failed to meet its burden. Textor is wrong.

A. The Petition addressed claim 22’s limitations, including a two-drive conveyor belt unit.

Textor argues that the Petition “propos[ed] to duplicate Konishi’s and [M]cLaughlin’s conveyor units and motors fails to satisfy the required single conveyor belt unit.” (POR, 60.) This is inaccurate. The Petition clearly proposed a

single conveyor belt unit with two drives in the proposed combination, as evidenced by the singular form of “a two-lane conveyor belt unit.” (Pet., 48.) The Petition stated “[i]t would have been obvious to modify Konishi in view of Lindee to include a second lane with a second drive to increase production and throughput.” (Pet., 46; *see also* Pet., 72-74.) It further argued that “given a two-lane conveyor belt unit, designing the two-lane conveyor belt unit to cancel/establish the two drives simultaneously would have only required an obvious, simple structural duplication of parts.” (*Id.*, 48; *see also id.*, 73.) There is no missing element from the proposed combination.

B. Textor’s motivation argument is legally flawed.

Textor argues that there is no evidence of “improved weighing functions” as a reason to combine for the proposed combinations including Konishi or McLaughlin. (POR, 61.) This is an unclaimed feature and irrelevant. Provisur need not show this specific reason to combine. “Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *KSR*, 550 U.S. at 420.

The Petition provided un rebutted evidence that a second independent lane “would increase production and throughput” as an exemplary reason to combine.

(Pet., 46-47.) The Petition also provided un rebutted evidence that a “POSA would have appreciated multiple streams of conveying surfaces would have...multiple advantages.” (*Id.*, 47.) The Petition explained that a POSA “would have been motivated to make the coupling between a first and second drive configured to be simultaneously cancelled/established to simplify the installation/removal process...in light of the explicit teachings in Konishi.” (*Id.*, 48.) Provisur’s un rebutted expert evidence carries the day over Textor’s unsubstantiated attorney argument. *See Keynetik, Inc. v. Samsung Elecs. Co.*, No. 2022-1127, 2023 WL 2003932 at *2 (“[Appellant] offers only attorney argument alleging [expert] testimony is inadequate. But attorney argument is no substitute for evidence.”).

Textor also argues that Provisur’s prior art is inapplicable because the prior art teaches “exclusively... how those product tracks are conveyed to a cutting plane.” (POR, 62.) Textor’s argument is wrong, as Textor is either (1) reading in a non-existent limitation that claim 22 only applies to conveyors after a slicing blade; or (2) making a bodily incorporation argument that Konishi or McLaughlin conveyors could not be used before a slicing blade. The first argument fails as nothing in claim 22 limits the conveyors to their relative location. The second argument fails as Dr. Collins provided un rebutted opinions regarding why it would

have been within a POSA's skill to implement two-lane removable conveyors upstream or downstream of the blade. (Pet., 48-49; *see also id.*, 33, 60.)

VI. SUMMARY OF ISSUE NARROWING

Textor's POR did not respond to all of the Petition's arguments. Thus, the live issues have been narrowed.

First, Textor non-contingently cancelled claims 1-4, 6, 9-10, and 14-16. Thus, Patent Owner has finally cancelled these claims and the PTAB will not address the patentability of those claims, even though Textor continues to assert cancelled claim 16 in the district court.

Second, Textor did not argue that the limitations disclosed in claims 1-4, 6, 9-10, and 14-15 were not anticipated or rendered obvious by the prior art. Thus, only the elements of claims 16 and 22 are currently in dispute.

Third, Textor did not argue that the preamble of the '487 patent is limiting.

Fourth, Textor's MTA submitted evidence that the proposed claims are supported by US Patent Application 2014/0174891 A1, filed on June 26, 2014. The MTA did not provide support from any other application. "Any motion to amend must also set forth the support in...any application for which the benefit of the filing date of the earlier filed disclosure is sought. 37 C.F.R. §§ 42.121(b), 42.221 (b)." (TPG, 69.) Thus, the '487 patent's proposed claims can only claim priority back to

June 26, 2014.⁶ Accordingly, post-AIA law applies to the '487 patent's proposed claims, and Petitioner can rely on prior art between 2012 and June 26, 2014. This is noteworthy as Provisur relies on intervening prior art in its reply declaration and opposition to the motion to amend.

⁶ If Textor had relied on the earliest application, Provisur may have addressed §112 issues.

Respectfully submitted,

Dated: September 27, 2024

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CERTIFICATE OF COMPLIANCE

The undersigned certifies that this brief complies with the applicable type-volume limitations of 37 C.F.R. § 42.24. Exclusive of the portions exempted by 37 C.F.R. § 42.24(a), this brief contains 5,266 words as counted by the word processing program used for its preparation (Microsoft Word 2013).

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CERTIFICATE OF SERVICE

I hereby certify that on September 27, 2024, I caused a true and correct copy of the foregoing materials:

- **PETITIONER’S REPLY TO PATENT OWNER’S RESPONSE**

to be served via electronic mail to the Patent Owner’s Counsel of Record.

Respectfully submitted,

Dated: September 27, 2024

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