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Date: October 25, 2024

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*.

PRELIMINARY GUIDANCE
PATENT OWNER'S MOTION TO AMEND
37 C.F.R. § 42.121(e)

I. INTRODUCTION

On March 20, 2024, we instituted trial as to claims 1–4, 6, 9, 10, 14–16, and 22 of U.S. Patent No. 9,457,478 B2 ("the '487 patent"). Paper 8 ("Decision" or "Dec."). After institution, Patent Owner filed a Motion to Amend proposing non-contingently to cancel original claims 1–4, 6, 9, 10, 14, and 15, and replace them with substitute claims 25–33, and proposing contingently to cancel claim 22 and replace it with substitute claim 34. Paper 13 ("Motion" or "Mot."). Patent Owner also non-contingently cancels original claim 16, incorporating it into proposed substitute claims 25 and 34 to replace original claims 1 and 22. *See id.* Petitioner filed an Opposition to the Motion. Paper 35 (Public Version), Paper 36 (Confidential Version), ("Opposition" or "Opp.").

In the Motion, Patent Owner requests that we provide preliminary guidance in accordance with the Board's pilot program concerning motion to amend practice and procedures. Mot. 2; *see also Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board*, 84 Fed. Reg. 9,497 (Mar. 15, 2019). Notably, after Patent Owner filed the Motion, the Office implemented new rules governing motion to amend practice. *See* 37 C.F.R. § 42.121(a)(1)(ii), 37 C.F.R. § 42.121(e)(1) (Oct. 18, 2024); *see also Rules Governing Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board*, 89 Fed. Reg. 76,421 (Sept. 18, 2024). As such, we preliminarily consider the Motion in light of these newly-implemented rules.

II. BACKGROUND

In this Preliminary Guidance, we provide information indicating our initial, preliminary, non-binding views on whether Patent Owner demonstrates a

reasonable likelihood it has met the statutory and regulatory requirements associated with filing a motion to amend, and whether Petitioner (or the record) demonstrates a reasonable likelihood that the proposed substitute claims are unpatentable. *See* 37 C.F.R. § 42.121(e)(1), (2); *see also* 35 U.S.C. § 316(d) (statutory requirements for a motion to amend). The reasonable likelihood standard that this Preliminary Guidance applies is different than the preponderance of the evidence standard applied when ultimately deciding the Motion. *Compare* 37 C.F.R. § 42.121(e)(1), *with* 37 C.F.R. § 42.121(d)(1)(2). Finally, this preliminary guidance is not a "decision" for purposes of rehearing under 37 C.F.R. § 42.71(d). *See* 37 C.F.R. § 42.121(e)(2).

For purposes of this Preliminary Guidance, we focus on the substitute claims, and specifically on the amendments proposed in the Motion. *See* 37 C.F.R. § 42.121(e)(1). We do not address the patentability of the originally challenged claims. Moreover, in formulating our preliminary views on the Motion and Opposition, we have not considered the parties' other substantive papers on the underlying merits of Petitioner's challenges. We emphasize that the views expressed in this Preliminary Guidance are subject to change upon consideration of the complete trial record, including any revision to the Motion filed by Patent Owner. Thus, this Preliminary Guidance is not binding on the Board when rendering a final written decision or any other subsequent decision in this proceeding. *See* 37 C.F.R. § 42.121(e)(2); *Medytox, Inc. v. Galderma S.A.*, 71 F.4th 990, 1000 (Fed. Cir. 2023).

III. ANALYSIS

A. Statutory and Regulatory Requirements

Patent Owner bears the ultimate burden to show that its motion to amend complies with the requirements of 35 U.S.C. § 316(d)(1), (3) and 37 C.F.R.

§ 42.121(a)(2), (a)(3), (b)(1), and (b)(2). 37 C.F.R. § 42.121(d)(1). For the reasons discussed below, and based on the current record, we find that Patent Owner demonstrates a reasonable likelihood it has satisfied all the statutory and regulatory requirements associated with filing a motion to amend. *See* 37 C.F.R. § 42.121(e)(1).

1. Reasonable Number of Substitute Claims

Does Patent Owner propose a reasonable number of substitute claims? (35 U.S.C. § 316(d)(1)(B))
Yes. Patent Owner proposes, on a *non-contingent* basis, cancelling nine claims and replacing them with nine substitute claims, as well as outright canceling another claim. And, on a *contingent* basis, Patent Owner proposes replacing one issued claim with one proposed claim. Mot. 1–2. The statute states that "[f]or each challenged claim," the patent owner may "propose a reasonable number of substitute claims." 35 U.S.C. § 316(d)(1)(B). Because Patent Owner proposes one claim for each issued claim, we find the proposed number of claims to be reasonable.

2. Respond to Ground of Unpatentability

Does the Motion respond to a ground of unpatentability involved in the trial? (37 C.F.R. § 42.121(a)(2)(i))
Yes. Patent Owner contends the limitation from dependent claim 16, which is incorporated into proposed claims 25 and 34, "is not present in Konishi (Ex. 1004), Lindee (Ex. 1005) or McLaughlin (Ex. 1006)." Mot. 3–4. Petitioner does not argue that the Motion is nonresponsive. *See generally* Opp. Under the Rule, the requirement is for the amendment to be responsive to "a ground of unpatentability." 37 C.F.R. § 42.121(a)(2)(i). Because Patent Owner appears to amend the claims in response to the asserted prior art, we find that Patent Owner has met this requirement.

3. Scope of Amended Claims

Does the amendment seek to enlarge the scope of the claims? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))
No. Patent Owner contends the "proposed substitute claims add additional elements to the issued claims of the '487 Patent that narrow their scope." Mot. 4. Petitioner does not contend otherwise. Because no subject matter appears to be removed along with the addition of new limitations, we find that the amendments do not seek to enlarge the scope of the claims.

4. New Matter

Does the amendment seek to add new subject matter? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))
No. In addition to the limitations in each of original claims 1–4, 6, 9, 14, 15, and 22, which form the bulk of proposed substitute claims 25–34, Patent Owner shows written description support for the limitation of original (and now canceled) claim 16, at paragraphs 45, 74, 75, 97, and 98 of U.S. Patent Application No. 14/094,136 ("the '136 Application"). *See* Mot. 9–10, 21–23; *see also id.* at 6–23. Patent Owner also cites paragraphs 103–105 and 111–113 of the '136 Application. Specifically, paragraph 45 discloses that "the conveyor belt unit can be removed and/or installed without tools." Ex. 1002 ¶ 45.[1] The '136 Application also discloses "by rotation of the shaft 29 by approximately 180° by means of the lever 19 a pivot movement of both linkages 35 simultaneously is effected such that both belts 27 are relaxed or tautened simultaneously." *Id.* ¶ 97. Petitioner does not argue that the proposed claims lack written description support. *See generally* Opp. Given Patent Owner's showing that '136 Application provides written description support for the limitations of the proposed substitute claims, we find that the amendment does not add new matter.

[1] We cite to the paragraphs of the original English-language version of the Specification, which are at pages 444–468 of the file history in Exhibit 1002.

B. Patentability

For the reasons discussed below, and based on the current record,[2] we find that Petitioner demonstrates a reasonable likelihood that at least substitute claims 25 and 34 are unpatentable.

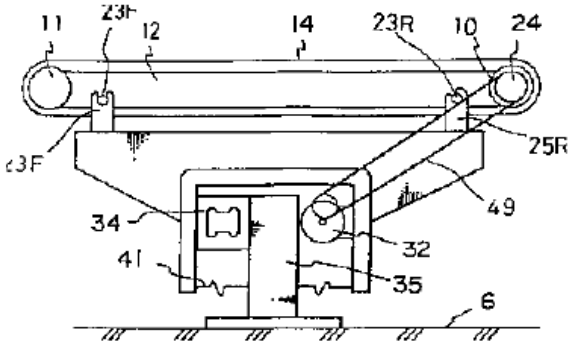
Does the record establish a reasonable likelihood that the proposed substitute claims are unpatentable?
Yes. At this stage of the proceeding, Petitioner demonstrates a reasonable likelihood that substitute claims 25–34 are anticipated by and/or rendered obvious over the prior art of record. Proposed substitute claims 25 and 34 replace original independent claims 1 and 22, while adding the limitation from original dependent claim 16, namely, "wherein the conveyor belt unit (13) is configured to be removed and/or installed without tools." *See* Mot., App. A. <u>Ground 1 – Anticipation by Konishi</u> As for substitute claim 25, Petitioner contends that Konishi "explains that the timing belt is relaxed by the first movement [i.e., lightly lifting up the front part of subframe 12 and removing support pin 23F], and that 'the timing belt 49 can be easily removed from the timing pulley 24 of the driver roller 10,'" and, once the timing belt is removed, Konishi explains "'the rear part of the subframe 12 is pulled diagonally upward' to complete the separation." Pet. 28 (citing Ex. 1004 ¶¶ 33–34). Petitioner also points to Konishi's disclosure "that installation is completed by 'performing the operation opposite.'" *Id.* (citing Ex. 1004 ¶¶ 22, 39). Patent Owner contends the limitation from original claim 16 "is not present in Konishi (Ex. 1004)." Mot. 3–4. Referencing its Patent Owner Response ("PO Resp."), Patent Owner contends Konishi teaches away from conveyors held in place by weight alone, because Konishi teaches that its conveyor belt unit "should be lightweight (1) to allow their easy removal and re-installation and (2) to ensure their conveyed food products can be accurately weighed." *Id.* at 4 (citing PO Resp. 26, 36–38). And, in its Patent Owner Response, Patent Owner contends that "[Konishi's] conveyor belt units must be secured by physical

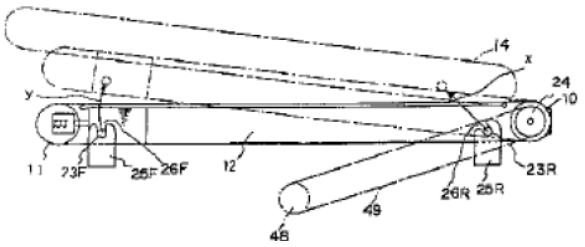
[2] We express no view on the patentability of original claims 1–24 in this Preliminary Guidance, including Patent Owner's assertion of secondary considerations in support of non-obviousness. Instead, we focus on limitations added from the original claims to the substitute claims, as proposed in the Motion.

mechanisms to ensure they do not pop out of place during operation." PO Resp. 27–28 (citing Ex. 2006 ¶¶ 58–60). Patent Owner believes, apparently, that to avoid "damaged . . . food product" and reduce "safety risk to nearby workers," the ordinary artisan "would have been motivated to ensure the conveyors of Konishi . . . would be unable to move vertically with respect to their frames." *Id.* at 30–31 (citing Ex. 2006 ¶¶ 57–61).

In contrast, Petitioner's expert testifies that the ordinary artisan "would have understood that the weight and frictional forces at play would have kept the removable conveyor belt unit in place." Ex. 1040 ¶ 47. Petitioner's expert also articulates that the ordinary artisan "would have understood that Konishi's simple mounting configuration would have not involved tools to install and/or remove the conveyor." *Id.* (citing Ex. 1004, code (57)).

On the current record, we agree with Petitioner and its expert. For example, Konishi shows a conveyor unit having support pins 23F and 23R sitting in grooves 26F and 26R, from which the unit can be lifted up and away from, as shown in Figures 8 and 9 (reproduced below) and described in paragraphs 33–34 and 36.



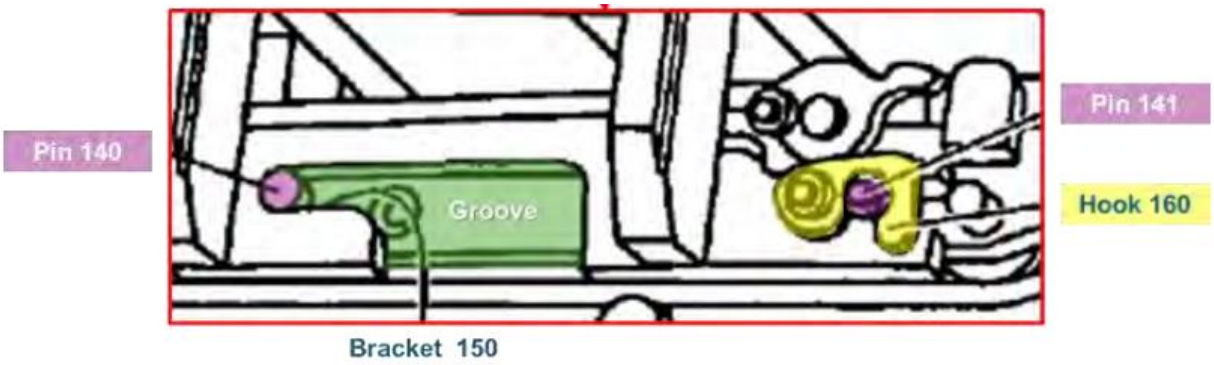


Konishi's Figure 8 (right) and Figure 9 (left) depict pins 23F and 23R of the conveyor unit's subframe 12 resting in grooves 26F and 26R. Figure 8 additionally shows subframe 12 being rotated and "lifted upward" in the direction of arrows x and y so as to be "removed smoothly to the side." Ex. 1004 ¶¶ 33, 34, 36; *see also* id. ¶¶ 20–22. Contrary to Patent Owner's assertion, nowhere do we find any disclosure or suggestion in Konishi that tools are required for removal of the conveyor unit. Instead, consistent with Petitioner's expert, Konishi expressly teaches that "the structure of the subframe side is made simple and lightweight, making it easy to attach and detach from the frame both structurally *and from a work perspective*." Ex. 1004 ¶ 45 (emphasis added). Indeed, Konishi teaches a "diagonal hook groove 26R" to aid

in preventing detachment of the subframe from the frame during use. *Id.* ¶ 34; *see also id.* ¶¶ 21–22.

Ground 6 – Obviousness over Konishi and Mathues

In addition to relying on the grounds advanced in the Petition, Petitioner relies on two new grounds to challenge substitute claims 25 and 34, which replace original independent claims 1 and 22. *See* Opp. 3, 17–24. In particular, Petitioner points to Mathues' disclosure of "a removable conveyor belt unit used in a food article slicing machine," where the "conveyor can be removed 'by simply unhooking the hooks…, sliding the conveyor 30 in the upstream direction and dropping it downwardly for removal.'" *Id.* at 17–18 (citing Ex. 1037, Abstract, ¶¶ 14, 49; Ex. 1040 ¶ 219). Petitioner provides an annotated portion of Mathues' Figure 12, reproduced below, to illustrate this express disclosure.



As shown, the annotated portion of Mathues' Figure 12 depicts pins 140 and 141 inserted into bracket 150 and hook 160. *See id.* at 18 (citing Ex. 1040 ¶ 219). Relying on the testimony of its expert, Petitioner contends it would have been obvious to the ordinary artisan "to implement the concept of Mathues' toolless hooks or similar on Konishi's removable conveyor belt unit to provide the benefit of locking Konishi's conveyor in place." *Id.* (citing Ex. 1040 ¶¶ 220–223). This showing by Petitioner appears to address the "pop out" concern of Patent Owner's expert. *See* Ex. 2006 ¶¶ 57–61. At this stage, we find that testimony persuasive, as it is consistent with the teachings of both Konishi and Mathues.

With respect to the asserted combination's disclosure of the "second drive" limitation of substitute claim 34 (not found in substitute claim 25), Petitioner relies on the unrebutted testimony of its expert to contend "it would have been obvious to design the conveyor such that the coupling between both drives and the conveyor could be simultaneously cancelled/established." Opp. 23–24 (citing Ex. 1040 ¶¶ 296, 299). According to Petitioner, "[t]his would have only

required mirroring Konishi's drive components, using two conveyor belts instead of one, and splitting the conveyor unit into two independently driven lanes." *Id.* at 24 (citing Ex. 1040 ¶¶ 299–300). On the current record, that testimony appears reasonable and consistent with the prior art.

Patent Owner advances no specific argument with respect to Petitioner's challenge based on the combination of Konishi and Mathues, except to generally to assert that Konishi lacks the toolless limitation of original claim 16 that is added to substitute claims 25 and 34. *See* Mot. 3. Patent Owner has not had an opportunity to respond to the new grounds as asserted in Petitioner's Opposition. As such, our analysis of Petitioner's new grounds is preliminary.

IV. CONCLUSION

This Preliminary Guidance is Patent Owner's first option under our rules. *See* 37 C.F.R. §§ 42.121(a)(1)(ii), 42.121(e)(1). Patent Owner has the additional option of filing a Revised Motion to Amend. *See id.*, § 42.121(f)(1); *see also* Paper 10, at 11 ("DUE DATE 3").

In addition to those two options under the Board's rules, Patent Owner is reminded that amendments of the challenged claims may also be pursued in a separate reissue or reexamination proceeding before, during, or after an AIA trial proceeding, including subsequent to the issuance of the Final Written Decision. *See Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*, 84 Fed. Reg. 16,654 (Apr. 22, 2019). Should Patent Owner choose to file a reissue application or a request for reexamination of the challenged pa tent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. *See* 37 C.F.R. § 42.8(a)(3), (b)(2).

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