

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 SUR-REPLY TO THE OPPOSITION
TO THE MOTION TO AMEND**

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PETITIONER EXHIBIT LIST

EX	Description
1001	U.S. Patent No. 9,457,487 B2
1002	File Wrapper for U.S. Patent No. 9,457,487 B2
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
1004	JPH 06 117905 (“Konishi”)
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”)
1014	U.S. Patent Publication No. 2007/0214969 (“Mueller”)
1015	U.S. Patent No. 6,640,681 (“Weber”)
1016	U.S. Patent No. 6,201,218 (“Chandler”)
1017	U.S. Patent No. 5,704,265 (“Johnson”)
1018	U.S. Patent No. 8,408,109 (“Lindee109”)

EX	Description
1019	Provisur Patents Webpage
1020	<i>Provisur v. Weber III</i> , Sept. 5, 2-23 Hearing Tr., 5
1021	U.S. Patent No. 7,605,940 (“Silverbrooke”)
1022	Canadian Patent CA2499480 (“Haan”)
1023	WO 2011/056602A1 (“McLaughlin602”)
1024	U.S. Patent No. 6,578,705 (“Lunghi”)
1025	U.S. Patent No. 4,570,729 (“Del Rosso”)
1026	EP0713753B1 (“Lindee753”)
1027	WO2003103906A1 (“Pryor906”)
1028	U.S. Patent No. 7,603,936 (“Pryor936”)
1029	U.S. Patent No. 5,628,237 (“Lindee237”)
1030	PoweMax3000 Slicer Operating Manual
1031	PowerMax4000 Slicer Operating Manual
1032	Dr. Collins CV
1033	U.S. Patent No. 8,549,966 (“Hansen966”)
1034	Automation in the Food Industry
1035	Declaration of Keaton A. Sheeler in Support of Motion for Pro Hac Vice Admission
1036	U.S. Patent No. 3,517,605 (“Hursch”)
1037	U.S. Patent Application No. 20080016999A1 (“Mathues”)

EX	Description
1038	U.S. Patent Application No. 20080289619A1 (“Schjerven”)
1039	U.S. Patent No. 3,162,226A (“Toby”)
1040	Reply Declaration of John M. Collins, Ph.D. regarding U.S. Patent No. 9,457,487
1041	U.S. Patent No. 6,755,149 (“Herman”)
1042	U.S. Patent No. 3,601,901 (“Rader”)
1043	EP1729875B1 (“Gerber”)
1044	EP2401564B1 (“Candeo”)
1045	Deposition Transcript of Dr. Reinholtz (08/23/2024)
1046	U.S. Patent No. 4,195,867 (“Baillie”)
1047	2024.09.13 IPR Deposition Tr. of Dr. Kindler (EX2008’s declarant)
1048	U.S. Patent No. 9,400,456 (“Iwakoshi”)
1049	U.S. Patent No. 9,702,168 (“Jadallah”)
1050	Counsel Emails regarding Depositions
1051	U.S. Patent No. 9,963,919 (“Sugiura”)
1052	U.S. Patent No. 7,621,109 (“Momich”)
1053	2024.09.18 IPR Deposition Tr. of Dr. Meyer (EX2007’s declarant)
1054	2024.09.18 IPR Deposition Tr. of Jarrod McCarroll
1055	2024.03.05 District Court Deposition Tr. of Jarrod McCarroll
1056	2024.09.19 IPR Deposition Tr. of Steffen Boss
1057	2024.02.09 District Court Deposition Tr. of Kevin Duesterhaus

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1058	2022.01.04 District Court Deposition Tr. of Kevin Duesterhaus
1059	Dr. Kindler notes (WEBER3A-00207143)
1060	2024.02.27 District Court Deposition Tr. of Joerg Schmeiser
1061	2024.09.26 IPR Deposition Rough Tr. of Mr. Leathers (EX2011's declarant)
1062	Weber Patent Marking Webpage (WEBER3-1446499)
1063	2024.01.26 District Court Deposition Tr. of Josef Mayer
1064	Case No. 5:21-cv-06113-SRB District Court Doc. #485 (Defs' Opp to Mtn to Exclude Leathers)
1065	2024.06.11 District Court Deposition Tr. of Mr. Leathers (EX2011's declarant)
1066	Case No. 5:21-cv-06113-SRB District Court Doc. #466 (Notice of Jury Trial Date)
1067	Engineering Toolbox Webpage
1068	2024.09.26 Leathers Deposition Exhibit 1
1069	2024.09.26 Leathers Deposition Exhibit 2
1070	2024.09.26 Leathers Deposition Exhibit 3
1071	2024.09.26 Leathers Deposition Exhibit 4

I. INTRODUCTION

Petitioner Provisur has presented a straightforward unpatentability case throughout this proceeding, and the Board has thus far credited Petitioner's arguments. The Board should stay its course.

All original and proposed amended claims are directed at a generic removable conveyor. Patent Owner Textor rests its patentability theory on the rudimentary idea of making the conveyor removable "without tools." However, the Board was correct in finding in both its Institution Decision and Preliminary Guidance that this idea was anticipated by Konishi. At a minimum, the claimed arrangement is obvious in view of the long and demonstrable history of toolless removable conveyors using latches and other toolless removals.

Textor's reply alleged that the Board's preliminary guidance was "unclear." (MTA Reply, 2.) It was not. For example, the Board found that Konishi's conveyor is secured without tools to "prevent detachment of the subframe from the frame *during use*." (Prelim. Guid., 7-8 (emphasis added).) And, it is easily detached from the frame without tools "*from a work perspective*," for example, to help workers remove and clean the conveyor. (*Id.* (citing EX1004, ¶45).) But Textor's MTA Reply did not address these disclosures in Konishi or the Board's findings. (*See generally* MTA Reply.) Instead, Textor alleged a non-existent lack of clarity from

the Board. Accordingly, the Board should confirm its previous findings and determine that Konishi anticipates or at least renders obvious the '487 patent.

Below, Provisur summarizes the obviousness evidence that Textor overlooked in the MTA Reply for (1) original grounds 1-4, and (2) new grounds 5-6. Then, Provisur addresses the guiding obviousness case law on bodily incorporation and remaining issues on secondary considerations, priority, and the district court status.

II. THE ORIGINAL AND NEW GROUNDS MAKE THE CLAIMS UNPATENTABLE.

Textor asserts that Provisur's original grounds 1-4 fail because Provisur's expert, Dr. Collins, offered an "insufficient" analysis. (MTA Reply, 4-8.) Textor further alleges Provisur's new grounds 5-6 fail because of the specific physical orientation of the latches disclosed in the prior art. (MTA Reply, 9-12.) Both arguments are wrong.

A. Original Grounds 1-4 render the challenged claims unpatentable.

Textor's reply presents four issues for the original grounds that Provisur addresses below in the same order as Textor.

First, Textor incorrectly asserts that no evidence exists showing that McLaughlin would be used in a toolless manner. (MTA Reply, 4.) The reference itself contradicts Textor's interpretation. As Dr. Collins opined, a POSA reviewing McLaughlin would understand that it disclosed a toolless arrangement. (See, e.g.,

EX1003, ¶¶230-32; EX1040, ¶¶102-04.) And, the Board agreed in the Institution Decision as well as the Preliminary Guidance.

Further, McLaughlin contemplates toolless conveyor removal according to Textor’s own interpretation of products marked with that reference. Textor argued to the district court that Provisur’s SX380—a product marked with McLaughlin (EX1019, 9)—met the claims of the ’487 patent. (*Provisur Technologies, Inc. v. Weber, Inc. et al.*, Case No 5-21-cv-06113 (WDMO), Doc. #518 (filed 09/18/2024), p. 16.) Textor moved for summary judgment on this argument, and the court granted that motion. (*Id.*, p. 17.) It is inconsistent for Textor to argue that products covered by McLaughlin literally meet the ’487 claims in the district court while arguing that McLaughlin does not render obvious the ’487 claims here.

Second, Textor argues Petitioner’s expert, Dr. Collins, failed to account for vibrational forces. (MTA Reply, 42, 4-6.) Textor is wrong. Dr. Collins considered and addressed the effects of vibrational forces. He stated in his opening declaration “a latch provides the additional benefit of preventing the conveyor from being lifted out of place due to any reactive force created by conveying food product.” (EX1003, ¶¶163, 222; *see also* EX1040, ¶¶149, 186.) He also agreed in deposition that “vibrations [would] be considered one of the specific forces seen during operation of a slicer.” (EX2016, 61:2-16.) Further, Dr. Collins clarified that McLaughlin

teaches a “vibration dampener[.]” that was “very well known in the art.” (EX2016, 62:5-25.) Textor ignores this evidence.

Third, Textor alleges that Dr. Collins made flawed mathematical assumptions with respect to the coefficient of friction and reactionary forces. (MTA Reply, 6-8.) Again, Textor is wrong. Textor’s arguments hinge on the claims being limited to application in a food slicing machine. The patent is not so narrow. As the Petition contended, the claimed combination is not limited to a slicing machine because the preamble is not limiting. (Pet., 10-11, 25.) Patent Owner never argued that the preamble was limiting. (*See generally*, POR, MTA Reply; *see also* EX1045, 52:15-53:5.) In addition, the specification states the invention may be components of generic “conveying devices,” not limited to slicing machines (EX1001, 6:56-59, 7:23-26.) Thus, Patent Owner’s arguments about specific issues (i.e., lard reducing friction) that *might* occur and are limited to food slicers are misplaced.

Accordingly, the Board should determine that Ground 1 anticipates amended claims 25, 29, 30, 33.¹ The Board should further determine that Ground 2 renders

¹ Provisur’s claim listing refers to the claims as numbered in the original motion to amend, as Textor’s “clerical change” is not procedurally proper without a revised motion to amend under 37 C.F.R. § 42.121(f). Textor’s Sur-Reply FN 1 states that

obvious amended claims 25-34. If the Board reaches Grounds 3 and 4, the Board should find that those Grounds render obvious claims 25-34.

B. New Grounds 5 and 6 render the challenged claims obvious.

For Provisur’s new Grounds 5-6, Textor does not dispute that latches for toolless conveyor removal were known. Instead, Textor narrowly contends that the known latches did not have the proper physical orientation to work in the combination. (MTA Reply, 9-12.) Yet again, Textor overlooks contrary evidence.

Dr. Collins opined that a POSA would have known that using a latch to secure the conveyor belt unit would “prevent[] the conveyor belt unit from being lifted out of place due to the reactive forces that the conveyor belt unit would experience during normal use.” (EX1040, ¶149; Opp. to MTA, 10 (Ground 5); *see also* EX1040, ¶223; Opp. to MTA, 19 (Ground 6).) Dr. Collins further opined that “if necessary, a POSA would have re-oriented the latch in a manner that would have secured the conveyor belt unit against the specific forces that the removable conveyor belt unit would have seen during operation or accidental contact.”

“all Challenged Claims have been non-contingently amended.” (PO Sur-Reply, pg. 1, FN 1.) Yet, Textor’s MTA Reply, states “PO asks that the Board permit a clerical change...preserving Claim 16 in its existing form and scope.” (MTA Reply, 1.)

(EX1040, ¶155; Opp. to MTA, 11 (Ground 5); *see also* EX1040, ¶231; Opp. to MTA, 19 (Ground 6); EX2016, 59:19-61:16.) And yet again, Textor stuck with its preordained theory and ignored the substance of Dr. Collins’ opinions.

Thus, if the Board reaches Provisur’s new Grounds 5-6, the Board should find that those Grounds render obvious amended claims 25-34.

III. TEXTOR’S ARGUMENTS IGNORE WELL-SETTLED OBVIOUSNESS CASELAW ON BODILY INCORPORATION.

Further, Textor applies an overly rigid approach to obviousness throughout its arguments. Textor’s counterarguments to Provisur’s obviousness assertion place an inappropriately heightened burden on Provisur to explain exactly how the two references would be bodily incorporated into each other. This is not what the law requires. *Intel Corp. v. PACT XPP Schweix AG*, 2023 WL 2198649, *3 (Fed. Cir. Feb. 24, 2023) (“It is well-established that a determination of obviousness based on teachings from multiple references does not require an actual, physical substitution of elements.”). Obviousness commands a more flexible approach. *KSR Intern Co. v. Teleflex Inc.*, 550 U.S. 398, 420 (2007); *see also 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). Provisur’s obviousness theory is sound and its proof is far beyond the necessary burden.

IV. TEXTOR'S SECONDARY CONSIDERATIONS FAIL.

Textor does not submit sufficient evidence that its proposed amended claims are nonobvious based on secondary considerations. There is not a presumption of nexus, as Textor's products are not coextensive with the '487 patent. *See Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1376-77 (Fed. Cir., 2019), 1376-77 (stating that patent claims regarding an "automobile" that "recite[] little more than the novel brake pads...would not be entitled to a nexus presumption with any secondary considerations evidence tied to commercially sold automobiles containing those brake pads."). The Board should determine that Textor has failed to show secondary considerations or nexus, particularly in light of the testimony that downplayed the importance of the removable conveyor. (Pet. Reply, 18-20.)

V. TEXTOR FAILS TO ESTABLISH PRIORITY.

If determining the priority date becomes necessary to resolve the issues between the parties, the Board should determine that all of the amended claims at issue in this IPR deserve a priority date of no earlier than April 12, 2013.

Textor's priority claims are still flawed after its attempted correction in its Reply (MTA Reply, 1-2). Textor did not provide any priority claim back to the original German application, filed on December 3, 2012. Rather, Textor only now allegedly provides support back to the April 12, 2013, dated German application.

Accordingly, the '487 patent (and its amended claims) deserves a priority date no earlier than April 12, 2013, and the claims should be analyzed under post-AIA law.

VI. DISTRICT COURT STATUS

A final written decision issued before January 27, 2025, that determines that the challenged and amended claims of the '487 patent are anticipated and/or obvious would further the Board's stated goal to "simplify the issues for trial and ease the district court's burden." (Paper No. 8, 10.)

The district court trial schedule remains unchanged, with trial set to begin January 27, 2025. The district court has not permitted any patent claims to be tried in that venue if a final written decision previously determined that those claims were deemed unpatentable. (*Provisur Technologies, Inc. v. Weber, Inc. et al.*, Case No 5-19-cv-06021 (WDMO), Doc. #115 (filed 02/24/2021), p. 11 (Judge Bough stating "we're not going to pursue any more discovery on any of these issues that have been resolved in the IPR process.").) Textor has also repeatedly demanded that Provisur drop any claims that are cancelled by the PTAB. (*Id.*, p. 16 (Textor's counsel stating "no reasonable plaintiff would continue with its infringement allegations after a final written decision from the PTAB.")). Provisur has complied with the district court's precedent and is not asserting such claims for trial.

VII. CONCLUSION

The Board should deny Textor's motion to amend the '487 patent.

Respectfully submitted,

Dated: December 6, 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 is 12 pages or less as counted by the word processing program used for its preparation (Microsoft Word 2013).

Respectfully submitted,

Dated: December 6, 2024

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CERTIFICATE OF SERVICE

I hereby certify that on December 6, 2024, I caused a true and correct copy
of the foregoing materials:

- **PETITIONER’S SUR-REPLY TO THE OPPOSITION TO THE
MOTION TO AMEND**

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

Respectfully submitted,

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