

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
U.S. Patent No. 9,457,487

**PATENT OWNER'S SUR-REPLY
TO PETITIONER'S REPLY**

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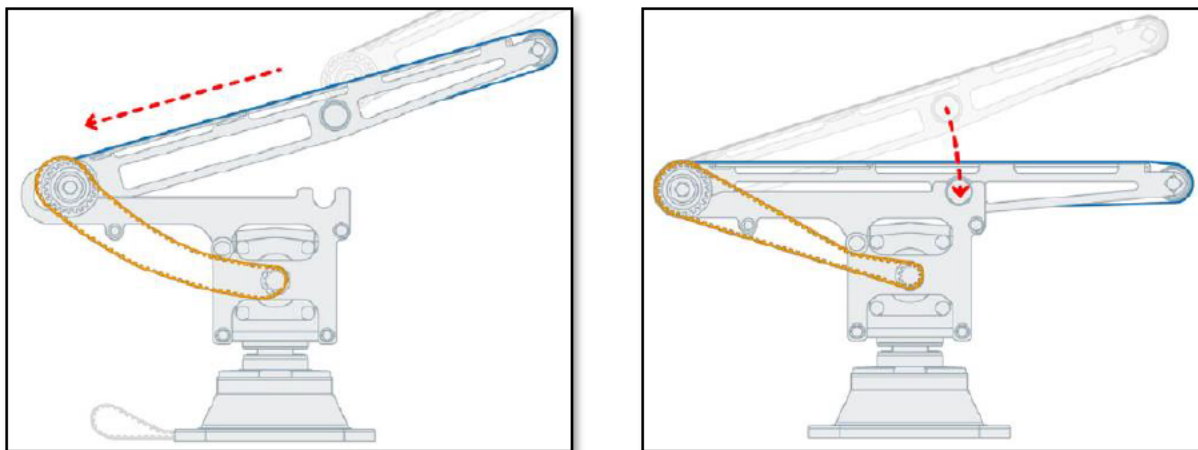
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I. INTRODUCTION

All Challenged Claims¹ now require a conveyor belt unit “configured to be removed and/or installed without tools” (the “Toolless Limitation”). Petitioner does not dispute that the Toolless Limitation demands transitioning, without tools, from a secured and fully operational state to an unsecured state where the conveyor can be removed from the substructure (or vice versa). Accordingly, the question is not simply whether a conveyor belt unit may be moved into and out of its operational location without tools. Petitioner must prove that transitioning between an operational state and a removed state without tools was anticipated or obvious. Each Proposed Ground fails on this point.

All Proposed Grounds rely on the removable conveyor units in either Konishi or McLaughlin, which describe mechanically similar designs. As illustrated below for McLaughlin, both teach conveyor units that are first placed into a diagonally oriented mounting slot on the drive side and are then pivoted into a vertically oriented mounting slot on the non-drive-side:

¹ As explained in the Reply in Support of the Motion to Amend, filed concurrently, Petitioner's proposed Claim 22 amendment is no longer contingent. Accordingly, all Challenged Claims have been non-contingently amended to require the Toolless Limitation of Claim 16.

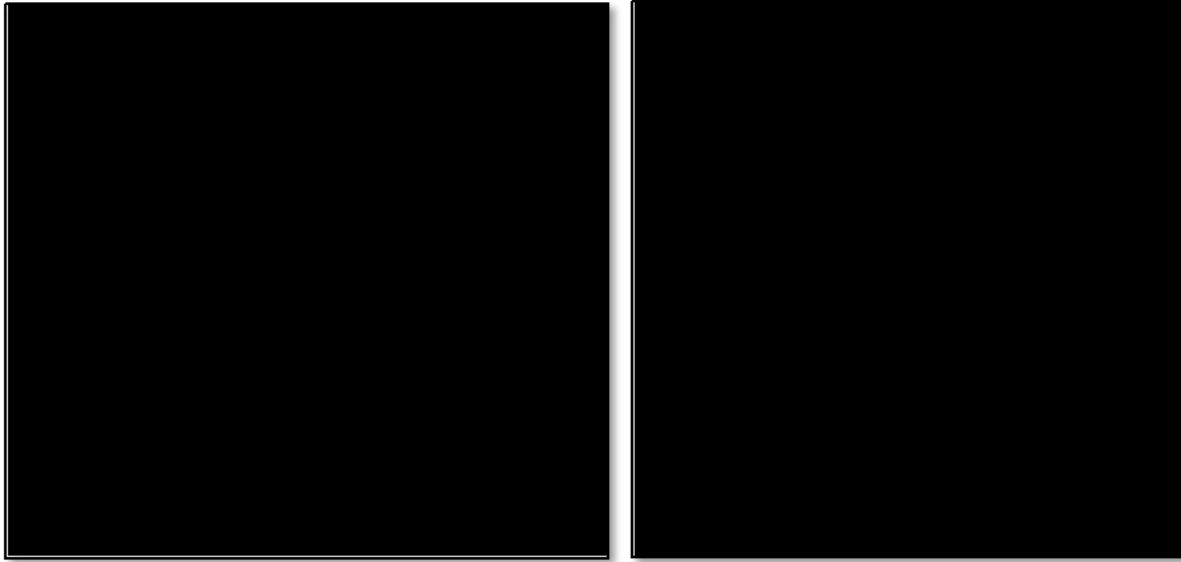


Petition, 58-59. Neither Konishi nor McLaughlin discuss how its conveyor units are secured in the vertically oriented slot to prevent popping out of place during operation. In all grounds presented in the *Petition* (Grounds 1-4), Petitioner argues that a POSITA would have interpreted the references' silence to mean that the conveyor units require no physical securing mechanisms and are held in place by gravity and friction alone.² The record disputes this interpretation.

First, Patent Owner ("PO") relies on the sole examples in the record of how conveyor units of this type are actually implemented. McLaughlin is a reference assigned to Petitioner, and it is undisputed that two commercial embodiments

² Although the Reply makes vague allusions to other "known" mechanisms that *could be* used to secure conveyor units, Patent Owner's expert confirmed that Grounds 1-4 do not propose physically modifying Konishi or McLaughlin with respect to the Toolless Limitation. Accordingly, Grounds 1-4 are limited to the theory that Konishi's or McLaughlin's conveyor units are secured for operation by gravity and friction.

implement McLaughlin's conveyor unit. Critically, Petitioner does not dispute that McLaughlin's commercial embodiments secure their conveyor units *with a tool*:



Ex. 1031, 54 (annotated); *POR*, 43-44 (discussing both commercial embodiments). There is no contrary evidence in the record showing—or even suggesting—that conveyor units of this type were ever implemented in the prior art without physical mechanisms securing the conveyor units in place during operation. These commercial embodiments are Petitioner's own. If it were reasonable to operate McLaughlin's conveyor unit without physically securing it, one would expect Petitioner to advance some supporting evidence. Tellingly, it has not.

Second, Petitioner's expert relies primarily on a force analysis that purports to show Konishi's and McLaughlin's conveyor units will remain in place during operation. Critically, this force analysis ignores the impact of vibrations. As Petitioner's expert admitted on cross examination, vibrational forces are *the* main

concern seeking to ensure conveyors remain in place during operation. Because Petitioner's expert failed to consider the force *he identified* as most important, his conclusions do not withstand scrutiny.

Further, secondary considerations of non-obviousness, including commercial success and fulfillment of a long-felt industry need, overwhelmingly support PO's assertion of non-obviousness for its patented toolless removable conveyor technology. Indeed, the record demonstrates that the patented toolless removal feature is directly linked to remarkable success in the marketplace and that this specific product feature solved a long-standing industry problem: the need for a hygienic, quickly disassembled conveyor belt unit using toolless installation and removal.

II. THE TOOLLESS LIMITATION REQUIRES SECURING FOR OPERATION OR REMOVING FROM OPERATIONAL STATE WITHOUT TOOLS

As set forth in the POR, the '487 Patent describes and claims "a mechanism allows the user to remove the conveyor for cleaning from a fully secured state (i.e., the state in which the conveyor operates) without any tools." *POR*, 5; *see also id.*, 5-7 (describing lever-based embodiment), 7-11 (describing latch-based embodiment); 25 (noting the Toolless Limitation requires "transition[ing], without tools, from a secured and fully operational state to an unsecured state where the conveyor can be removed from the substructure" and vice versa).

Petitioner does not dispute this interpretation. It has not suggested that simply placing the conveyor unit into position or removing it from its operational position suffices. Instead, as its expert has repeatedly confirmed, Petitioner's theories assume the Toolless Limitation requires securing the conveyor for operation or removing it from an operational state without tools. *See* Ex. 2014 (Collins Dep. Tr.), 29:3-14; Ex. 1003, ¶230 (arguing that McLaughlin renders obvious the Toolless Limitation because it "could be designed to be tight enough to not require any additional tools to secure the conveyor belt unit to the substructure and hold it in place through gravity alone" during operation); Ex. 1040, ¶¶46-47 (arguing Konishi satisfies the Toolless Limitation because "a POSA would have understood that the weight and frictional forces at play would have kept the removable conveyor belt unit in place" during operation.).

III. GROUNDS 1-4 FAIL TO TEACH THE TOOLLESS LIMITATION

The originally presented grounds all turn on the same narrow issue—whether a POSITA would have interpreted Konishi's and McLaughlin's silence to mean they do not require separate physical securing mechanisms. The record establishes conclusively that Petitioner has failed to support such an interpretation.

A. Grounds 1-4 Allege Konishi's and McLaughlin's Conveyor Units Teach the Toolless Limitation Because They Are Secured for Operation Via Weight and Friction Alone

Petitioner's expert confirmed Grounds 1-4 turn on the theory that a POSITA would interpret Konishi and McLaughlin to teach removable conveyor units secured

for operation by weight and friction alone. Ex. 1040, ¶47 (Re Ground 1: “As shown in my first declaration, Konishi anticipates [the Toolless Limitation,] disclos[ing] a conveyor that can be installed and/or removed without requiring tools. . . . [A] POSA would have understood that the weight and frictional forces at play would have kept the removable conveyor belt unit in place.”), ¶62 (Re Ground 2: “As shown in my first declaration, . . . Konishi clearly discloses a conveyor mount that does not require tools to install or remove the conveyor. . . . [A] POSA would have understood that in addition to its weight, friction resulting from forces that react the belt tension forces would keep the removable conveyor belt unit in place[.]”), ¶100 (Re Ground 3: “As shown above and in my first declaration, . . . [a] POSA would have understood that McLaughlin’s removal process would not require any tools. . . . [A] POSA would have appreciated that the interconnecting fit between the two components would be designed to be tight enough to not require any additional tools to lock the conveyor belt unit to the substructure[, and] a POSA would have designed the conveyor such that it was held in place by gravity alone.”), ¶132 (confirming Ground 4 merely incorporates his prior Konishi and McLaughlin theories by reference).

Further, Petitioner’s expert confirmed that none of Grounds 1-4 propose adding a specific physical securing mechanism to either Konishi’s or McLaughlin’s conveyor unit. Ex. 2016 (Second Deposition Transcript of Dr. Collins), 8:15-10:3 (confirming Ground 1 does not rely on any physical securing mechanisms added to Konishi’s conveyor unit), 10:8-21:2 (confirming Ground 2 does not rely on any

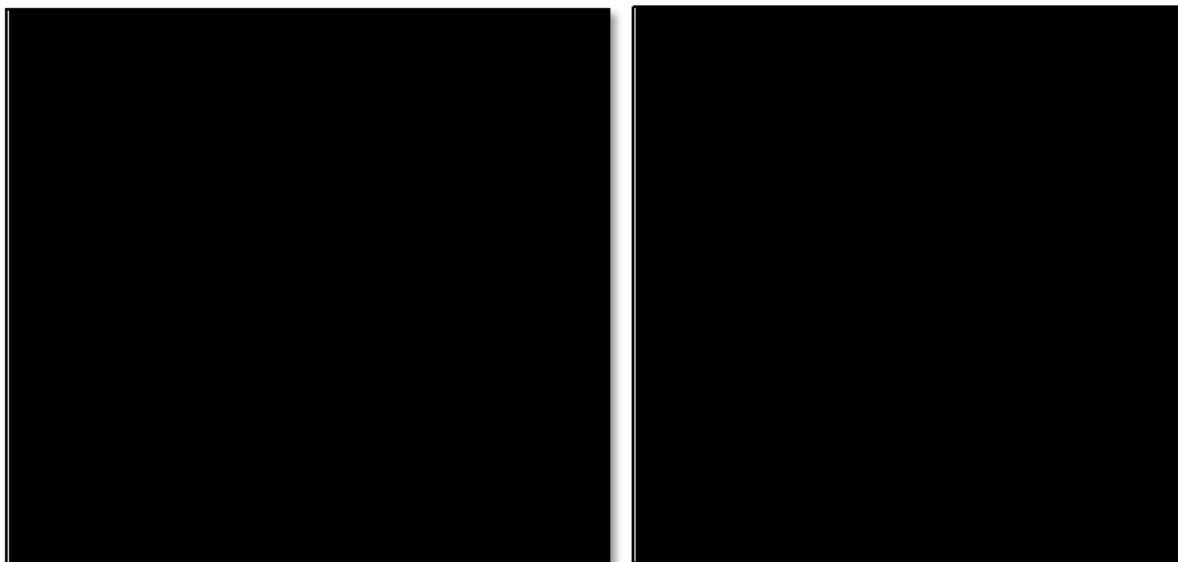
physical securing mechanisms added to Konishi's conveyor unit), 23:15-26:7 (same), 21:9-23:14 (confirming Ground 3 does not rely on any physical securing mechanisms added to McLaughlin's conveyor unit), 26:12-28:23 (same).

B. The Record Does Not Support Petitioner's Weight and Gravity Theory

1. The Only Concrete Evidence of Installed and Operational Conveyor Units Demonstrates That Konishi and McLaughlin Require Physical Securing Mechanisms

Despite Konishi's and McLaughlin's silence, there is concrete evidence in the record that demonstrates how a POSITA would secure their conveyor units. Namely, the exclusive concrete evidence of record shows that conveyor units of this type are secured via locking nuts *using a tool*.

McLaughlin is a reference assigned to Petitioner, and it is undisputed that two commercial embodiments implement McLaughlin's conveyor unit. *POR*, 41-44. As illustrated below, it is also undisputed that McLaughlin's commercial embodiments secure their conveyor units with a tool:



Ex. 1031, 54 (annotated); *POR*, 43-44 (discussing both commercial embodiments).

Tellingly, there is no contrary evidence in the record showing—or even suggesting—that conveyor units of this type were ever implemented in the prior art without physical mechanisms securing the conveyor units in place during operation. These commercial embodiments are Petitioner's own. If it were reasonable to operate McLaughlin's conveyor unit without physically securing it, one would expect Petitioner to advance some supporting evidence. It could have introduced evidence that its own prototypes were secured without tools. It could have introduced evidence that certain of its customers left their conveyor units secured by weight and gravity alone. Tellingly, it has introduced no such evidence.

From this record, only one conclusion can be drawn: Petitioner's expert is wrong that a POSITA would have left McLaughlin's conveyor unit secured by weight and friction alone. As set forth in the *POR*, a POSITA would have recognized

that Konishi's conveyor unit is ***more likely*** to require physical securing than McLaughlin's. *POR*, 44-46. Petitioner does not dispute this.

Accordingly, the sole concrete evidence of how conveyor units of this type were implemented exclusively supports the conclusion that both McLaughlin and Konishi would have required additional physical securing mechanisms.

2. *Petitioner's Gravity and Friction Theory is Fatally Flawed*

Petitioner only briefly mentions the evidence supporting its theory that Konishi's and McLaughlin's conveyor units would be secured by weight and friction alone. The Reply cites a force analysis in Dr. Collins's supplemental declaration that concludes neither conveyor unit would "pop-up during use." *Reply*, 13-14 (citing Ex. 1040, ¶¶35-42). This analysis and its conclusions are fatally flawed. Dr. Collins ignored vibrations—the dynamic forces he previously admitted must be accounted for.

When asked why removable conveyor units like McLaughlin must be secured during operation, Dr. Collins identified *only* vibrational forces that a POSITA would be concerned about. Specifically, he explained that vibrations within the "mechanically robust environment" in which conveyors operate would "end[] up causing the conveyor to vibrate up." Ex. 2014, 32:2-24.

In the force analysis now relied upon by Petitioner, Dr. Collins ignores vibrations completely. He concludes that, due to a combination of weight and friction created by belt tension, neither Konishi's nor McLaughlin's conveyor units

would pop out of place during operation. Ex. 1040, ¶¶36-42. However, on cross examination, he admitted that neither force analysis discussed nor accounted for vibrations. Ex. 2016, 54:20-55:6.

After having identified **only** vibrations as the forces a POSITA would need to secure conveyor units against, Dr. Collins's failure to discuss these forces is fatal, and his conclusions must be rejected as internally inconsistent.

In sum, PO relies prominently on the only concrete evidence of record demonstrating how conveyor units of this type are actually implemented. That evidence—of Petitioner's own commercial embodiments—unambiguously demonstrates that these conveyor belts are physically secured with tools to avoid popping out during operation. Petitioner relies primarily on a flawed force analysis that fails to consider the one force its own expert testified would need to be addressed. On this record, the only reasonable conclusion is that a POSITA would not interpret Konishi or McLaughlin to describe removable conveyor units that may be left without physical securing mechanisms during operation.

C. Petitioner's Mischaracterizations of Law and Fact Cannot Resurrect Ground 1

Attempting to resurrect Ground 1, Petitioner (1) mischaracterizes testimony and evidence, (2) misinterprets the law, and (3) seeks to improperly shift its burden. *Reply*, 5-7.

1. *Petitioner Mischaracterizes Patent Owner's Evidence and its Experts' Testimony*

Petitioner falsely claims that PO “offers no evidence that a POSA would understand Konishi would not be secured by toolless means.” *Reply*, 6. To the contrary, PO provided a breadth of evidence explaining why a POSITA would have found neither Konishi nor McLaughlin to be secured by toolless means. *POR*, 25-50; Ex. 2006, ¶¶55-91.

Petitioner even argues that PO's expert testified that Konishi's conveyor unit would be secured by toolless means. *Reply*, 6. Dr. Reinholtz said nothing of the sort. As the transcript reveals, because Petitioner did not propose or describe adding a latch to Konishi, Dr. Reinholtz did not analyze all the “issues that might arise in attempting to do” so. Ex. 1045, 200:8-201:16 (noting he hasn't “seen any proposal for how it might be done” and hasn't “formed an opinion on it”). Konishi does not describe any latch or other mechanism to secure its conveyor, and Petitioner's attempt to pull in a distinctly separate method of securing a conveyor unit is a red herring. Ground 1 is an anticipation theory that turns on whether a POSITA would understand Konishi's conveyor unit is adequately secured by gravity and friction alone. The separate question of whether a POSITA *could* implement a latch is entirely irrelevant to Ground 1.

Petitioner further mischaracterizes Dr. Reinholtz's testimony, claiming he “opines that a conveyor secured by friction and gravity are insufficient to meet the toolless requirement.” *Reply*, 6. Neither PO nor Dr. Reinholtz have advanced such a

categorical take on the Toolless Limitation. Instead, Dr. Reinholtz's theories target the ***specific systems*** described in Konishi and McLaughlin—because those conveyors ***require*** physical securing mechanisms and do not simply hold themselves in place during operation, they do not satisfy the Toolless Limitation. Petitioner also mischaracterizes Dr. Meyer on this issue. *Reply*, 6. He merely testified that the claims do not expressly exclude conveyors secured by weight and friction. Ex. 1053, 58:7-16.

2. Petitioner Misinterprets Süd-Chemie's Holding

Petitioner mischaracterizes *Süd-Chemie* to suggest that Konishi's silence regarding tools and securing its conveyor unit satisfies the Toolless Limitation. *Reply*, 5-7. PO does not dispute that a reference may satisfy a negative limitation without expressly addressing it. But silence is only sufficient where a POSITA would understand that the reference does indeed teach the negative limitation. *POR*, 27 (citing *Novartis Pharms. Corp. v. Accord Healthcare, Inc.*, 21 F.4th 1362, 1373 (Fed. Cir. 2022)).

Süd-Chemie does not hold otherwise. There, the claims required adhering films together *without* the use of adhesives. *Süd-Chemie, Inc. v. Multisorb Techs., Inc.*, 554 F.3d 1001, 1004-05 (Fed. Cir. 2009). The Federal Circuit relied on ***affirmative*** teachings in the prior art that its films were adhered through heat sealing without adhesives, and further noted that the patent owner “has not offered any evidence that a reference to a microporous or laminate film would be understood by

one of skill in the art as contemplating a film with an adhesive coating attached.” *Id.* In light of an ***affirmative*** teaching of the heat sealing process that made no mention of adhesives and no evidence that adhesives were required, the negative limitation was satisfied. *Id.*

Here, in contrast, there is no affirmative teaching. Konishi does not describe how its conveyor unit is secured for operation. There is also ample evidence that Konishi's conveyor unit could not be left unsecured. Accordingly, unlike in *Süd-Chemie*,³ Konishi's silence is insufficient to satisfy the negative Toolless Limitation.

When fielding similar logic, the Federal Circuit explained that silence “would not itself suffice for the Petitioner to meet its burden to prove, by a preponderance of the evidence,” that a negative limitation existed in the prior art. *IBM v. Iancu*, 759 F. App'x 1002, 1011 (Fed. Cir. 2019). In anticipation of Petitioner's natural next move, the Federal Circuit explained that Petitioner could not then shift the burden of proof onto PO. *Id.* (“Nor would that burden be met merely by adding a finding that [PO] did not prove the opposite...”).

³ The Board has rejected similar attempts to mischaracterize *Süd-Chemie*. “*Süd-Chemie* does not hold that silence in the prior art is sufficient *per se* to satisfy a negative limitation.” *Google, Inc. v. Core Wireless Licensing S.A.R.L.*, IPR2015-01715, Paper 30 at 15 (PTAB Sept. 27, 2019).

3. *Petitioner Seeks to Improperly Shift its Burden*

The Board should also reject Petitioner's attempt to shift the burden to PO. *Reply*, 6 (“[PO] offers no evidence that a POSA would understand Konishi would not be secured by toolless means.”). As set forth above, Petitioner is factually wrong that PO has advanced no such evidence. But its attempt to shift the burden is also legally flawed. As the Board has confirmed in prior cases, “Petitioner bears the burden of showing that [its reference] adequately described the [negative limitation].” *Core Wireless*, IPR2015-01715, Paper 30 at 23.

IV. PETITIONER HAS FAILED TO SUFFICIENTLY ARTICULATE ANY COMBINATION THAT WOULD MEET THE TOOLLESS LIMITATION

As set forth in Section III.A, Petitioner's expert confirmed that none of Grounds 2-4 propose adding physical securing mechanisms to either Konishi's or McLaughlin's systems. Instead, each of these grounds turns on a theory that a POSITA would understand Konishi and McLaughlin to describe conveyor units that do not need additional physical securing mechanisms. Despite this unambiguous testimony, Petitioner argues 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.” *Reply*, 7. Petitioner further alludes to the general existence of latches, fasteners, detents, friction fits, jackscrews, and thumbscrews in alleged support of its obviousness Grounds 2-4. *Id.*, 8-10. Finally, Petitioner briefly points to Dr. Collins's supplemental declaration that includes general summaries of toolless

mechanical devices and alleged explanations of how they would be used to secure removable conveyors. *Id.*, 11.

The Board should reject Petitioner's attempt to treat these physical securing mechanisms as part of its obviousness theories advanced in Grounds 2-4. Petitioner does nothing more than cite a handful of generic examples of latches from background references, concluding that a "POSA would have been motivated to use a latch as an option." *Id.* Nowhere does Petitioner discuss *how* the references would be combined with sufficient specificity to permit PO an opportunity to respond. Indeed, this lack of specificity appears to be intentional. Petitioner even goes so far as to contend that "explain[ing] how a POSA would have implemented these [background] devices into a system with a removable conveyor. . . [is] not required to show obviousness." *Reply*, 11. Petitioner is wrong.

The law demands that petitioners articulate their combinations and motivations to make those combinations with sufficient particularity to permit a PO to respond. *Comcast Cable Comms., LLC v Proptu Systems Corp.*, 838 Fed. Appx. 555, 557 (Fed. Cir. 2021) (finding insufficient motivation to combine where the petition lacked "explanation as to how or why the reference would be combined to produce the claimed invention."); *Shenzhen Jimuyida Tech. Co., Ltd. v. Artec Eur. S.A.R.L.*, IPR2023-01148, Paper 6 at 20 (P.T.A.B. Jan. 16, 2024) (finding Petitioner failed to specify a particular combination where "Petitioner effectively present[ed] a myriad of combinations, tacitly inviting the Board to sift through the references

and discern a potentially invalidating combination out of the many possible combinations.”); *Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir. 2017) (holding obviousness determination improper where the record lacked a “clear, evidence-supported account” of “how the combination” would work); *Shopkick, Inc. v. Novitaz, Inc.*, IPR2015-00279, Paper 7 at 30 (PTAB May 29, 2015) (“[C]onclusory labels do not substitute for a fact-based analysis”).

Petitioner has failed to satisfy this burden with respect to the background references teaching a variety of mechanical securing mechanisms. At no point does Petitioner describe how any physical mechanism would be added to Konishi or McLaughlin, depriving PO the opportunity to respond and leaving the Board to guess how McLaughlin and Konishi would be modified to meet the Toolless Limitation.

Finally, contrary to Petitioner's assertion, *Philips* does **not** support Petitioner's approach. *Reply*, 11. In *Philips*, the petitioner relied on the knowledge of a POSITA for the well-known concept of pipelining, proposing a specific modification to the base reference pursuant to “conventional pipelining (i.e., simultaneous download and playback)[.]” *Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330, 1338 (Fed. Cir. 2020). The Federal Circuit accepted the petitioner's reliance on conventional pipelining, made part of the combination via the knowledge of a POSITA, specifically because the theory was specific and well supported. *Id.* Here, in contrast, Petitioner openly refuses to describe what the proposed

combination is and how it would work. Instead, Petitioner seeks to shoehorn in a litany of mutually exclusive background mechanisms, not originally presented in the proposed grounds, under the veil of the “knowledge of a POSITA” without adequate support or articulation in the record.

In sum, general references to the existence of physical components and principles that could be used to secure conveyors is wholly insufficient under the law to support an obviousness theory.⁴ Petitioner was obligated to specifically set forth the theory of obviousness on which it relies. General hand waving about the existence of snaps and latches falls far short.

A. Petitioner's Teaching Away and Enablement Arguments are Misplaced

As set forth above and in the POR, PO established that a POSITA understands that Konishi and McLaughlin teach conveyor units that must be secured for operation, rather than relying on their weight and friction alone. Among the evidence in support, PO's expert established that relying on weight to secure the conveyor units runs counter to the fact that both Konishi and McLaughlin are weight conveyors that must maintain lightweight conveyor units to ensure accurate measurements. *POR*, 31-40 (further establishing that Petitioner's expert admitted

⁴ Petitioner incorrectly argues that its lack of specificity is permitted by the law, claiming it need not prove “bodily incorporation.” *Reply*, 14-16. Petitioner has not proposed or described **any** specific physical modification, bodily incorporated or not.

that minimizing weight was a design goal in each reference). The Reply seeks to brush off this logically sound evidence on the basis that neither Konishi nor McLaughlin expressly criticizes, discredits, or otherwise discourages toolless removal. *Reply*, 12. This argument is a red herring. Neither reference addresses securing their conveyor units. That's simply an implementation detail left out of their disclosures. So, there would be no expectation that they would disparage any particular form of securing.

Petitioner next argues that Konishi and McLaughlin do not need to be enabled to satisfy the claims, suggesting that they can work poorly and still anticipate or obviate the claims. *Reply*, 13. This ignores the nature of Petitioner's theory as one that seeks to rely on the references' silence to satisfy the negative Toolless Limitation. As set forth above, a POSITA would not have interpreted either Konishi or McLaughlin to teach a conveyor unit that is intended to be left unsecured during operation.

V. SECONDARY CONSIDERATIONS STRONGLY FAVOR A FINDING OF NON-OBVIOUSNESS

As Petitioner identifies, the breadth of the record underlying secondary considerations, particularly evidence of copying, is expansive. Months of discovery, including dozens of depositions, have led to a vast number of documents, depositions, interviews, and other evidence supporting PO's allegations of Petitioner's copying. This record leads to an inescapable conclusion that Petitioner copied the patented technology, releasing products with the patented toolless

removable conveyor unit only after stealing PO's confidential information and key personnel related to PO's commercial embodiment. However, PO concedes that given the limited scope and time available in the present PTAB proceeding, this voluminous record has not been fully developed as in the district court litigation. Accordingly, PO focuses here on its commercial success and solving a long-felt but unmet need, reserving its right to present evidence of copying in the district court with the benefit of a full record.

Notwithstanding, sufficient evidence supports a finding of nonobviousness based on an established nexus between the claimed toolless removal/installation and (1) PO's commercial success, and (2) solving a long-felt but unmet need. Petitioner's arguments to the contrary are unavailing. More specifically, Petitioner both ignores a comprehensive production of evidence and impermissibly narrows the law.

A. PO's Supporting Evidence is Proper

PO has provided a host of evidence to establish a sufficient nexus required for secondary considerations, including:

- Evidence regarding the commercial embodiments of the '487 Patent, supported by Dr. Meyer;
- Sales data highlighting the success of the embodying products of the '487 Patent, further supported by declarants Ms. Kindler, Mr. Leathers, Mr. McCarroll, and Mr. Boss; and
- Testimony from several fact witnesses regarding the success attributable to the toolless removable conveyor, including the inventor

of the '487 Patent, Mr. Josef Mayer, Textor CEO Mr. McCarroll, and
Textor salesman, Mr. Duesterhaus.

While Petitioner makes several passing attacks on the sufficiency of some of the evidence, none have merit. For example, Petitioner challenges the sufficiency of expertise required for Dr. Meyer, Ms. Kindler, and Mr. Leathers. *Reply*, 17. However, the only substantive argument presented is against Mr. Leathers with respect to copying allegations. As previously stated, those are no longer being advanced and are therefore moot. Petitioner fails to provide any other supported challenge to Ms. Kindler, Dr. Meyer, or any other declarant. Indeed, Petitioner never challenged the expertise of either Kinder nor Meyer for the exact same substance in the litigation and it is undisputed that Ms. Kindler, as a damages expert, is more than qualified to discuss raw sales data and Dr. Meyer, as a defined POSA, is qualified to opine on commercial embodiments of the '487 Patent. Thus, Petitioner's reliance on excerpts from the experts' reports is proper.

Petitioner also challenges the citation to Dr. Meyer's report by arguing, in a single sentence, that Dr. Meyer's "district court allegations" were improperly incorporated by reference.⁵ *Reply*, 18-19. While it is challenging to fully understand the basis of Petitioner's argument without further articulation, PO's reliance on a portion of Dr. Meyer's analysis from the district court proceeding is not an improper

⁵ Petitioner makes a similar argument with respect to Mr. Leathers and his evidence of copying, but for the same reasons discussed above, these are moot.

incorporation of “arguments.” Rather, it is simply supporting opinion testimony regarding the commercial embodiments of the '487 Patent. These opinions remain substantively unrefuted here and in the district court litigation. PO relies on those opinions and appropriately cites the supporting portions of Dr. Meyer's report, which is not an improper incorporation by reference.

B. PO Establishes a Nexus to Commercial Success

Contrary to Petitioner's assertion, PO has established that the commercial success of PO's embodying products is specifically connected to the toolless removable conveyors. *See POR*, 52-54. Indeed, Textor's CEO, Mr. McCarroll, explained that when PO came out with the toolless removable conveyor, it was one of the “big selling points and honestly one of the big, big, big value points for our customers.” Ex. 1054, 19:18-20:03. Mr. McCarroll further explained that customers specifically discussed the toolless removable conveyor as a “differentiator” when deciding whether to purchase a Textor slicer. *Id.*, 47:14-17. One customer, in particular, referenced the toolless removable cassette specifically when purchasing a Textor slicer. *Id.*, 69:6-71:9. The removable cassette was favored by this customer for its hygienic design and ability to allow the customer to quickly and reliably convert and change products to maximize its daily throughput. *Id.*

The fact that PO's slicers include features beyond what is claimed in the patent is inconsequential to the established nexus—Petitioner's assertion that the patent must be coextensive with the product in order to establish a nexus is fundamentally

incorrect. A nexus may exist even when the patented invention is “only a component of a commercially successful machine or process.” *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988); *Hughes Tool Co. v. Dresser Indus., Inc.*, 816 F.2d 1549, 1556 (Fed. Cir. 1987) (finding a sufficient nexus where there was continuous use of a patented feature among other features). Thus, the nexus between the toolless removable conveyor and the commercial success is not removed simply because the conveyor exists as a component within the larger slicer.

Petitioner is also incorrect that a nexus does not exist where the patented feature is not the exclusive driver of customer demand. *See Reply*, 18-20 (providing no legal support). Indeed, even where other features are important to a product's success, “[i]t is not necessary. . . that the patented invention be solely responsible for the commercial success, in order for this factor to be given weight appropriate to the evidence, along with other pertinent factors.” *Oren Technologies, LLC v. Proppant Express Investments LLC*, No. 2019-1778, 2021 WL 3120819, at *7 (Fed. Cir. July 23, 2021) (citing *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1273 (Fed. Cir. 1991)) (internal citations omitted). As such, the fact that there are other reasons customers purchased slicers is not enough to overcome the established nexus. For example, a customer's decision to purchase a TS700 over a TS700 Flex due to better slicer functionality does not negate the commercial success attributable to the toolless removable conveyor. A nexus remains even where a customer is driven to

purchase a slicer for a multitude of reasons (e.g., slicer functionality *and* toolless removable conveyor). *Continental*, 948 F.2d at 1273.

To conclude that the presence of other driving factors necessarily negates a nexus would not only run afoul of the law but would require blatant disregard of express evidence to the contrary. For example, Petitioner argues that Mr. Duesterhaus “disclaimed a nexus” where he did not know what decisions caused a customer to purchase a machine. *Reply*, 22. However, in doing so, Petitioner isolates testimony from the immediately preceding lines of his deposition in which Mr. Duesterhaus *confirmed* a nexus. Ex. 1057, 255:3-10 (“I think [PO’s removable conveyor is] a big benefit. It’s a very open design machine and quick to disassemble. I think that’s important for some of my customers.”). Similarly, Petitioner points out that Mr. McCarroll testified about several reasons that lead customers to purchase slicers from PO. *Reply*, 22. Yet, Petitioner fails to include “hygienic design” from the list of factors included in Mr. McCarroll’s full testimony. *Id.*; Ex. 1055, 476:19-480:19. This exclusion is notable because the toolless removable conveyor is a major contributor to the hygienic design of PO’s machines. Thus, McCarroll’s testimony further bolsters the fact that customers are absolutely driven to purchase PO’s slicers with toolless removable conveyors as a direct contribution to hygienic design. Ex. 1054, 43:10-17 (attributing the “tool-free” hygienic design as a driver of success for the TS700).

C. PO Establishes a Nexus to Long Felt But Unmet Need

Petitioner's Reply again overlooks the evidence and blatantly misrepresents the record. PO expressly states that a "hygienic design for quick cleaning processes" was long awaited in the slicer industry and was achieved by toolless removal/installation. *POR*, 55-56. While this evidence may be missing from Petitioner's incomplete recitation of the record, it is clearly present. Further, Petitioner's representation of PO's witness—who did not even know what a removable conveyor was—is entirely unfounded.⁶

For the reasons discussed in detail throughout PO's briefing, Konishi and McLaughlin do **not** offer the same benefits achieved by the novel features of the '487 Patent. Consequently, PO has established that the toolless removal feature of the '487 Patent filled an unmet but long-felt need in the marketplace, supporting a finding of non-obviousness.

VI. CONCLUSION

For all the reasons stated herein and in the *POR*, Petitioner has failed to establish that the challenged claims of the '487 Patent are unpatentable.

⁶ Mr. Boss, a controller at Textor, testified that he (a) did not possess any technical background (16:4-11); (b) did not know what a removable conveyor was (17:11-18:5); (c) could not explain any advantages or disadvantages of the patented technology (18:14-17); (d) did not know technical details of Textor's machines (32:7-13, 39:2-15); and (e) had no knowledge of customer preferences (41:5-11).

Respectfully submitted,

/Adam P. Seitz/

Adam P. Seitz, Reg. No. 52,206

adam.seitz@eriseip.com

Adam M. Sandwell, Reg. No. 72,484

adam.sandwell@eriseip.com

Megan J. Redmond, *pro hac vice* to be filed

megan.redmond@eriseip.com

Hunter A. Horton, *pro hac vice*

hunter.horton@eriseip.com

Carrie Bader, *pro hac vice* to be filed

carrie.bader@eriseip.com

ERISE IP, P.A.

7015 College Boulevard, Suite 700

Overland Park, Kansas 66211

Telephone: (913) 777-5600

Facsimile: (913) 777-5601

PTAB@eriseip.com

Paul R. Hart, Reg. No. 59,646

paul.hart@eriseip.com

Nathan S. Byers, Reg. No. 81,095

nathan.byers@eriseip.com

Christina Canino, *pro hac vice*

christina.canino@eriseip.com

ERISE IP, P.A.

717 17th Street, Suite 1400

Denver Colorado 80202

Telephone: (913) 777-5600

Facsimile: (913) 777-5601

ATTORNEYS FOR PATENT OWNER

APPENDIX OF EXHIBITS

Exhibit 2016	Second Deposition Transcript of Dr. John Collins
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CERTIFICATION OF WORD COUNT

The undersigned certifies pursuant to 37 C.F.R. § 42.24 that the foregoing Patent Owner's Preliminary Response to Petition for *Inter Partes* Review, excluding any table of contents, mandatory notices under 37 C.F.R. § 42.8, certificates of service or word count, or appendix of exhibits, contains 5,532 words according to the word-processing program used to prepare this document (Microsoft Word).

Dated: November 1, 2024

Respectfully submitted,

/Adam P. Seitz/

Adam P. Seitz, Reg. No. 52,206

ERISE IP, P.A.

7015 College Boulevard, Suite 700

Overland Park, Kansas 66211

Telephone: (913) 777-5600

Facsimile: (913) 777-5601

adam.seitz@eriseip.com

PTAB@eriseip.com

ATTORNEYS FOR PATENT OWNER

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY was served on November 1, 2024, by email on the following counsel of record for Petitioner:

Michael G. Babbit	mbabbit@willkie.com
Sara T. Horton	shorton@willkie.com
Ren-how H. Harn	rharn@willkie.com
Mitchell M. Feldhake	mfeldhake@willkie.com

WILLKIE FARR & GALLAGHER LLP
ProvisurPTAB@willkie.com

Dated: November 1, 2024

Respectfully submitted,

/Adam P. Seitz/

Adam P. Seitz, Reg. No. 52,206
adam.seitz@eriseip.com

ATTORNEYS FOR PATENT OWNER