

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

Record of Oral Hearing
Held: January 15, 2025

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

APPEARANCES:

ON BEHALF OF THE PETITIONER:

MICHAEL BABBIT, ESQ.
MITCHELL FELDHAKE, ESQ.
Willkie, Farr & Gallagher LLP
300 North LaSalle Dr.
Chicago, IL 60654-3406
mBabbit@willkie.com
mfeldhake@willkie.com
312-728-9051 (Feldhake)

ON BEHALF OF THE PATENT OWNER:

PAUL HART, ESQ.
Erise IP, P.A.
717 17th St., Suite 1400
Denver, CO 80202
913-777-5615
Paul.hart@eriseip.com

The above-entitled matter came on for hearing Wednesday, January 15, 2025, commencing at 1:00 p.m. EST, via Video-conference.

P-R-O-C-E-E-D-I-N-G-S

1:00 p.m.

JUDGE MELVIN: Thank you. Good afternoon. I am Judge Melvin, joined by Judges Plenzler and DeFranco. This is a hearing for IPR 2024-00224 in which Provisur Technologies challenges a patent owned by Textor Maschinenbau, that is US Patent 9457487.

Can we have the parties make their appearances, please, starting with Petitioner?

MR. FELDHAKKE: -- Feldhake. I am the LEAP practitioner in this proceeding here on behalf of Petitioner, Provisur Technologies. Also in the room for me is lead counsel Mike Babbit.

JUDGE MELVIN: Okay, thank you, and for Patent Owner?

MR. HART: Thank you, Your Honor. This is Paul Hart with Erise IP for the Patent Owner.

JUDGE MELVIN: Thank you. And Petitioner, I would just note your microphone is awfully quiet. Is there any way you could adjust that? It's notably different.

MR. FELDHAKKE: Just one moment. Is this any better, Your Honor?

JUDGE MELVIN: That is better, thank you.

MR. FELDHAKKE: Is this good enough for the proceeding?

JUDGE MELVIN: That's good enough for me. Does anybody else have a problem? No? We're good? All right. So Petitioner, as you noted, you guys have a LEAP request that's been granted.

So Petitioner will have 60 minutes and Patent Owner will have 45 minutes. You may use your time as you please reserving up to half your time for rebuttal or surrebuttal.

1 Just let me know how much you'd like to reserve and I will try to give
2 you a warning when you are into that or close to it.

3 MR. BABBIT: Thank you, Your Honor. I'd like to reserve 30
4 minutes for rebuttal.

5 JUDGE MELVIN: Okay. So I would just ask that you keep track of
6 your time yourself if possible, but like I said, I will be doing so on my end
7 and I'll try and let you know when we're around that time.

8 So we have your demonstratives. We have the full record. You may
9 share your screen with us if you choose but you need not do so. I'll leave
10 that choice up to each of you.

11 Unless you guys have any questions, we're ready when you are.

12 MR. BABBIT: No questions from Petitioner.

13 JUDGE MELVIN: Great.

14 MR. HART: And no questions from Patent Owner.

15 JUDGE MELVIN: Okay.

16 MR. BABBIT: So thank you, Your Honors, and may it please the
17 Board. I will not be sharing a screen today. I'll refer to the slides as I move
18 through those.

19 My name is Mitch Feldhake and I am here on behalf of Petitioner,
20 Provisur Technologies, Inc., and the LEAP practitioner, and I will be
21 delivering the bulk of Petitioner's argument today with lead counsel Mike
22 Babbit potentially chiming in at the end.

23 So, Your Honors, this IPR entails one ground based on anticipation
24 and five ground based off of obviousness. Patent Owner's arguments have
25 largely focused in on this toolless limitation that was present in original
26 claim 16.

1 And so touching on that issue from an anticipation perspective,
2 Konishi anticipates this toolless limitation. Konishi submitted nine
3 paragraphs in its specification discussing the installation, removal, and
4 reinstallation process of its conveyor belt units.

5 And none of those paragraphs require tools. This is an issue that Your
6 Honors touched on in the Decision on Institution where at Page 11 Your
7 Honors stated that Paragraphs 33-41 of Konishi, quote, “describe in no
8 uncertain terms the process of reassembling the conveyor belt unit on the
9 subframe,” end quote.

10 And Your Honors were correct that Konishi provides a clear
11 description of the installation and removal process, and that Your Honors
12 need to resolve this case.

13 The 487 Patent’s toolless removal requirement is disclosed by
14 Konishi, and that should end the inquiry. If Your Honors determine that the
15 487 Patent’s toolless requirement is not anticipated and Your Honors reach
16 the obviousness grounds then the question at issue here is whether or not it
17 was a point of novelty a mere ten years ago to implement a toolless design.

18 And Your Honors, that’s Provisur’s case at a high level. If you have
19 any questions that you would like me to address at this time, I am happy to
20 address those. Otherwise, I’ll go one level deeper on each of those issues.

21 Hearing nothing, Your Honors, I will move to Slide 2 of Petitioner’s
22 Demonstrative Exhibits. Cancelled Claim 16 and Proposed Claim 25
23 include the toolless limitation.

24 Konishi anticipates this toolless limitation. If Your Honors would
25 turn to Page 6 of Konishi, this includes Paragraphs 33-41 of Konishi.

1 This entire page is dedicated to the installation, removal, and
2 reinstallation process of Konishi. These nine paragraphs discuss in great
3 detail Konishi's conveyor belt going from its operating state to its non-
4 operating removed state and back to its operating state, and none of these
5 paragraphs require tools.

6 So now I'm going to walk Your Honors through each of these
7 paragraphs to discuss what is disclosed in them. If Your Honors turn to
8 Paragraph 33, Paragraph 33 discusses the fact that you stop the motor from
9 driving the conveyor, which puts an end to the operation of the conveyor
10 belt unit.

11 After ending that operation, you quote, "lightly lift upward," end
12 quote, the conveyor belt unit, and that light upward lift relaxes the timing
13 belt.

14 This light upward lift is described immediately after you stop the
15 conveyor. So you stop the machine, you reach in, and you pull the conveyor
16 belt unit out. That is what Konishi describes.

17 If you turn to Paragraph 34, this paragraph talks about removing the
18 conveyor belt from the remaining supporting pin that is there.

19 Paragraph 35 discusses options for further disassembling the conveyor
20 belt unit. Paragraph 36 discusses how removing the conveyor belt unit
21 allows for easy cleaning.

22 And Paragraph 37 expands on that cleaning process. Paragraph 38
23 begins the reinstallation process and discusses adjusting the drive belt
24 tension if it is so required.

1 Paragraph 39 discusses the rear pin and attaching the drive belt, and
2 Paragraph 40 discusses pivoting the conveyor belt unit into place, which
3 simultaneously engages and tensions the drive belt.

4 And if Your Honors look to Paragraph 42 on the next page, there
5 Konishi states that the assembled position is a normal state in use.

6 So after Konishi spends this entire page and all nine paragraphs
7 discussing its installation and removal process. In Paragraph 42, it states
8 that the assembled position that I just described is the normal state in use.

9 Konishi simply does not require any tools to install or remove its
10 conveyor belt unit. A detailed disclosure that walks through every step of
11 this process supports that.

12 And Provisur's petition stated such. If you look at the petition on
13 Page 28, the petition walks through the simple toolless removal process that
14 Konishi discloses.

15 And if you turn to the next page in the petition, Page 29, the petition
16 states that a POSA would recognize that toolless removal makes the removal
17 of the conveyor belt unit easier or more simple.

18 That statement relies on our expert's declaration and that statement is
19 consistent with the purpose stated on the front page of Konishi.

20 Those pages of the petition cite to Paragraphs 114-116 of our opening
21 expert declaration, which is Exhibit 1003. The paragraphs of the expert
22 declaration confirm why a POSA would understand that Konishi exposed a
23 toolless removal process.

24 In Paragraph 115, our experts stated that Konishi's purpose was to
25 make it easier to remove the conveyor belt unit and make that process more

1 simple. That is also the purpose that is stated on the cover, on the front page
2 of Konishi.

3 In the same paragraph of the expert declaration, Paragraph 115, our
4 experts said, and I quote, a POSA would have understood that a more simple
5 removal process would have not involved tools, end quote.

6 So Patent Owner argues that a POSA would have reviewed Konishi
7 and thought something was missing here. And in Patent Owner's next
8 logical step is not only is something missing here, but what is missing has to
9 be a tooled means to secure this conveyor belt unit.

10 But Your Honors should not credit this argument. Textor is
11 manufacturing a narrative that does not give due credit to the extent of
12 Konishi's disclosure.

13 Provisur's argument, on the other hand, is consistent with the
14 disclosure of Konishi and it relies on information that are within the four
15 corners of that reference.

16 As Your Honors noted in the preliminary guidance, Petitioner's expert
17 opinions are consistent with Konishi. And Patent Owner's expert opinions
18 are not rooted in Konishi's disclosure.

19 And Your Honors, this fits into the framework set forth by the
20 Novartis case that Patent Owner cited in its Patent Owner's response. So
21 Novartis says that you must review a prior art disclosure through the lens of
22 a person of ordinary skill in the art or interpret that reference as a person of
23 ordinary skill in the art would.

24 Novartis also discusses analyzing the four corners of the reference in
25 determining what is disclosed within the four corners of the reference.

1 That is exactly what our expert did. It analyzed Konishi and he
2 addressed what was disclosed in Konishi. Petitioner's Expert, on the other
3 hand, runs away from those four corners and does not want to deal with what
4 is disclosed within the four corners of Konishi.

5 He wants to talk about any other reference, any other disclosure,
6 anything but address what is in Konishi.

7 So Your Honors, for all of these reasons, Your Honors should
8 determine that Konishi anticipates the toolless limitation.

9 I'll turn to the next slide, Petitioner's Demonstrative Slide 3.
10 Continuing with the anticipation theme here, Your Honors, anticipation
11 moots all of Textor's remaining arguments for patentability.

12 Textor's teaching away argument is mooted because teaching away is
13 not an argument that can defeat an anticipation analysis. Secondary
14 considerations are mooted because secondary considerations do not apply to
15 anticipation.

16 So the inquiry regarding the toolless limitation should end here.
17 Proposed Claims 25, 29, 30, and 33 are anticipated by Konishi because
18 Konishi discloses toolless removal.

19 If Your Honors have any questions on the anticipation issue, I'm
20 happy to address those now. Otherwise, I will be moving on to obviousness.

21 Hearing none, I will move to Petitioner's Demonstrative Four and
22 start addressing obviousness.

23 So Your Honors, the record has ample evidence that illustrates
24 creating a toolless removable conveyor at the time of the 487 patent would
25 have both been obvious and within the skill of a person of ordinary skill in
26 the art.

1 The shape of Konishi's diagonal hook groove and that Konishi's
2 conveyor can be removed from a work perspective support the obviousness
3 inquiry here.

4 McLaughlin is the other primary reference that Provisur relies on, and
5 it discloses a similarly shaped hook groove. Provisur's expert described
6 how a POSA would have recognized the benefit of McLaughlin's shape in
7 preventing detachment during use, and he explained how a person of
8 ordinary skill in the art would have known to design the connection points
9 such that the conveyor belt unit was secured.

10 He talks about this connection point design at Paragraph 230 of his
11 opening declaration, which is Exhibit 1003.

12 In addition to those primary references, Your Honor, you can see on
13 the slide here these four references that would have been part of the
14 knowledge of a person of ordinary skill in the art.

15 So these additional references show that a person of ordinary skill in
16 the art would have been aware of a toolless means to secure the removal of
17 conveyor belt units.

18 Turning to Slide 5, Your Honors, there is no dispute in the record that
19 the benefits of toolless removal were none. This chart includes some of the
20 evidence of record that shows that removal conveyor belt units were known
21 to provide the benefits of easy cleaning and simplified and easier
22 maintenance.

23 These well known benefits would have been the base of a motivation
24 for a POSA to implement a toolless removable conveyor belt unit.

1 Moving on to Slide 6, Your Honors, I'll address Patent Owner's
2 teaching away argument. So Konishi and McLaughlin do not teach away, as
3 Patent Owners suggest.

4 To briefly summarize Textor's argument here, Patent Owner suggests
5 that because Konishi and McLaughlin disclose weight conveyors that those
6 weight conveyors would have been designed to be so lightweight that a
7 person of ordinary skill in the art would not understand them to be secured
8 by gravity or weight alone.

9 But Textor's entire argument here is misplaced as Konishi does not
10 only teach removable weight conveyors, its other conveyor is removable,
11 too.

12 Konishi in Paragraph 18 and 32 discusses how the removal process
13 described in Konishi applies to both conveyor device 3 and weighing
14 conveyor 5.

15 Konishi is simply not limited to weight conveyors. And Purvisor's
16 condition never limited its argument as such. And further, the doctrine of
17 teaching away requires some type of criticizing, discrediting, or other
18 discouragement against combining the identified prior art.

19 Neither Konishi, McLaughlin, or any of the other prior art in record in
20 this proceeding rise to this level. And as Your Honors can see on this slide
21 here, in his deposition, Patent Owner's expert admitted that neither Konishi
22 or McLaughlin teach away.

23 Since Patent Owner's own expert surrendered this teaching away
24 argument and because the prior art does not criticize, discredit, or otherwise
25 discourage investigation into toolless removal, Your Honors should not
26 credit this teaching away argument.

1 Moving on to Slide 7, Your Honors, Patent Owner Textor also argued
2 that the forces that a removable conveyor would see during normal operation
3 would lead to a POSA understanding that the removal conveyor belt unit
4 would need to be secured by some type of tooled mechanism during
5 operation.

6 And as this slide shows, Textor's forced arguments have narrowed as
7 the records in this proceeding developed. The Patent Owner started by
8 arguing that the normal forces seen during the operation of the conveyor belt
9 unit might lead to a risk of popping out of place during operation.

10 But as the case proceeded, Patent Owner's arguments focused in on
11 the vibrations issue. But Patent Owner's vibration arguments ignored
12 portions of Petitioner's analysis.

13 Petitioner's expert showed that the prior art accounted for vibrations
14 during normal operation. And Your Honors, the citations for this I
15 recognize are not on the slide, but this comes up in Petitioner's surreply to
16 the Opposition to the Motion to Amend.

17 And, Your Honors, another issue with Patent Owner's arguments on
18 this force analysis is that when discussing these vibrations, Patent Owner's
19 arguments relied on issues that were specific to the food processing industry,
20 but the patent is not limited to just the food processing industry.

21 Your Honors turn to Page 8. Continuing with this preamble issue,
22 Textor never argued that the patent was limited by the preamble.

23 The prosecution history reflects that the patent is not limited to the
24 food slicing industry, and when asked about this issue during his deposition,
25 Patent Owner's expert agreed that the 487 patent is not so limited.

1 So in light of this, Your Honors should not credit Textor's arguments
2 that hinge on the application of the 487 Patent in the food processing
3 industry.

4 Turning now to Slide 9, Your Honors, based off of Patent Owner's
5 demonstratives, this is an issue that I anticipate will come up often during
6 the argument, so I would like to address that now.

7 Throughout the briefing, Patent Owner has repeatedly argued that a
8 POSA would not trust removal conveyors that are secured by weight alone,
9 but this ignores the prior art teachings of record.

10 Lee, which is on this slide, and is Exhibit 1012 in this proceeding,
11 teaches that its removable conveyors do not require tools to be removed and
12 those removable conveyors are locked into place by their own weight.

13 Textor tries to distinguish Lee by arguing this vertical versus
14 horizontal orientation as compared between Lee, Konishi, and McLaughlin.

15 But this is not a persuasive argument, Your Honors. Lee is analogous
16 art here, and Textor has not contested otherwise. Lee is also part of an
17 obviousness grounds.

18 It's not an anticipation reference. A POSA would have been able to
19 review Lee and take that knowledge and apply it to a conveyor that is
20 oriented horizontally.

21 There is no evidence in the record that applying the knowledge in this
22 manner would have been beyond the skill of a POSA. So Lee supports
23 Petitioner's expert contention that a removable conveyor could be secured
24 in place by its own weight.

1 Moving on to Slide 10, Your Honors, I'd like to briefly address the
2 Sud-Chemie case. So Sud-Chemie addressed an issue regarding negative
3 limitations.

4 The negative limitation in Sud-Chemie was the lack of adhesive
5 coatings used during an adhering process. And the Federal Circuit affirmed
6 a District Court's determination that the negative limitation was taught
7 because the prior art repeatedly referred to the adhering process with no
8 indication that adhesive coatings were used during the process.

9 So after Petitioner relied on Sud-Chemie, Patent Owner tried to
10 distinguish it, but I think Patent Owner's arguments actually bolster
11 Petitioner's position here.

12 So as you can see in the slide here, Your Honors, if instead of talking
13 about a heat sealing process that makes no mention of adhesives, we talk
14 about a conveyor removal process that makes no mention of tools, the
15 parties agree that a negative limitation would be met.

16 And Your Honors, if you refer to -- if Your Honors refer to the Sud-
17 Chemie decision, this negative limitation issue arises on reporter cites Pages
18 1004-1005.

19 And if you turn to the 1005 page and look at the first full paragraph
20 there, the Federal Circuit discusses the evidence that was relied on to some
21 of the evidence that was relied on to support this conclusion, and the Federal
22 Circuit drops a block quote there of the specification that is ten lines long.

23 So it's one paragraph and ten lines long and the Federal Circuit
24 affirmed the District Court on the finding that this was sufficient. We had
25 ten paragraphs in this case. We had a whole page in this case.

1 There is more supporting our position in this case than there was
2 determined to support in the Sud-Chemie case. So for those reasons, Your
3 Honor, you should determine that. Sud-Chemie supports Petitioner's opinion
4 that there is enough evidence in this case to show that the negative limitation
5 has been met.

6 And Your Honors, I'm going to skip ahead to Slide 20 of Petitioner's
7 Demonstratives here. And I'll address Textor's only other patentability
8 argument, which is the two-lane requirement of Original Claim 22.

9 The Petitioner reply in the preliminary guidance discussed how
10 Provisur's expert testimony on this issue was unrebutted, and that testimony
11 remains unrebutted today.

12 Nothing on this issue has changed since the preliminary guidance.
13 Just to quickly touch on some of the evidence, Your Honors, using Ground 2
14 as just one example, although this is also addressed in Grounds 3 and 4, you
15 look at Pages 43-44 of the Petition, Provisur discussed how Wendy
16 disclosed a two-lane conveyor.

17 On Pages 46-49, the Petition discussed how taking this two-lane
18 conveyor and turning it into a two-lane removable conveyor would have
19 required nothing more than an obvious duplication and moving of parts.

20 And those pages also discuss a reasonable expectation of success.
21 And as Your Honors can see on the slide here, Demonstrative Page 20, after
22 the Petition was filed in this case, the 47 Patent's inventor voluntarily said
23 that this was an exactly mirrored version of the one-way machine.

24 Because of the ample evidence in the record that a two-lane
25 removable conveyor would have been obvious, Your Honors should also

1 determine that Original Claim 22 and the corresponding proposed claims are
2 obvious.

3 And that's all I have for my opening, Your Honors. If there are any
4 questions, I'm happy to address those now. Otherwise, I will reserve the
5 maximum allotted time for rebuttal.

6 JUDGE MELVIN: Okay, you have 38 minutes remaining, so we can
7 just say 30 minutes, I guess, and --

8 MR. BABBIT: Yes, that sounds good, Your Honor. Thank you.

9 JUDGE MELVIN: All right, thank you.

10 MR. HART: Your Honor, Paul Hart for Patent Owner. Are you
11 ready for me to reserve time and move forward?

12 JUDGE MELVIN: Yes, Mr. hart, how much time would you like to
13 reserve?

14 MR. HART: Very good. Makes me a little nervous they have 30
15 minutes left, but I will just reserve ten minutes, and I'll try to move quickly,
16 just in case I need more.

17 All right, very good. To start things off, as we just heard, a big part of
18 Petitioner's case here is interpreting the silence in both Konishi and
19 McLaughlin with respect to the toolless limitation.

20 Counsel for Petitioner noted the Novartis case, 21 F4 1362, that Patent
21 Owner relied upon in its papers here. That case includes what they call a
22 correct statement of the law, that the mere absence of a positive recitation is
23 not enough and silence alone is insufficient.

24 Rather, when you're dealing with the absence of an expressed
25 discussion in a prior art reference, you must view that reference from the

1 perspective of a POSITA to determine whether that prior reference does in
2 fact teach a negative limitation.

3 That's the issue we have here. Neither Konishi nor McLaughlin says
4 anything about how their removable conveyor units are secured for
5 operation.

6 And so the question is, how would a POSITA view those teachings?

7 Let me quickly go over the high level summary of the issues presented
8 in this proceeding. First, only Konishi and McLaughlin, two structurally
9 similar machines, are relied upon as having the specific physical conveyor
10 design required of the claims.

11 Neither reference, neither Konishi nor McLaughlin, says anything
12 about how their conveyor units are secured for operation. Petitioner argues
13 that a POSITA would interpret the reference's silence to mean they do not
14 require any additional physical security.

15 Patent Owner's expert disputes this interpretation for a number of
16 reasons. Among those, Patent Owner's expert relies on the only concrete
17 and objective evidence of record demonstrating how these types of conveyor
18 units were actually implemented, namely, Petitioner's own commercial
19 embodiments of the McLaughlin design.

20 McLaughlin is Petitioner's own patent, and Petitioner has conceded
21 that there were multiple prior art commercial embodiments of the
22 McLaughlin design.

23 Critically, every single example of McLaughlin was physically
24 secured for operation. Petitioner has presented no evidence that any
25 horizontal conveyor unit was ever left unsecured for operation, its own or
26 any third parties.

1 Further, there is undisputed expert testimony showing that Konishi's
2 conveyor unit has a greater need than McLaughlin's for physical security.

3 On this record, the reference's silence is simply insufficient to satisfy
4 the toolless limitation.

5 Petitioner also identifies a laundry list of latching mechanisms known
6 in the art insisting that a POSITA can figure out how to implement any of
7 them to secure Konishi or McLaughlin.

8 None of those mechanisms were used to secure against forces
9 experienced by Konishi or McLaughlin.

10 As I'll cover in detail today, when the specific details of this case are
11 considered as the law demands, the weight of the evidence strongly favors
12 confirming patentability.

13 Now one of the key questions here is what does the toolless limitation
14 require? The parties have significantly narrowed their disputes here.

15 We are really just talking about what was the limitation that was in
16 original claim 16 has now been made part of all challenged claims, which
17 the parties refer to as the toolless limitation.

18 PX 2 through PX 7 in Patent Owner's slides provide an overview of a
19 patent and this specific toolless limitation. Starting with PX 2, the 487
20 Patent targets a specific design for a removable conveyor unit describing and
21 claiming a way in which that conveyor unit is engaged and disengaged.

22 From the Motion to Amend, all challenged claims now require a
23 toolless process for installation or removal. In PX 3, we see the actual claim
24 language that lays out that process for placing the removable conveyor unit
25 into its operational location as well as toollessly securing it for operation.

1 In red, we see the claim language on PX 3 requiring the conveyor unit
2 be placed into its operational location via relative movement between the
3 unit itself and the conveyor drive. And in green, we see the Claim 16
4 language which adds in that the installation or removal process is completed
5 without tools.

6 As Patent Owner has stated repeatedly in its papers here, including in
7 this excerpt from the Patent Owner response at Page 5, the toolless
8 mechanisms described and claimed in the 487 Patent allow conveyor units to
9 transition without tools into or out of a fully secured and operational state.

10 PX 4 and PX 5 illustrate the two distinct embodiments of this toolless
11 mechanism described in the 487 patent. As we see in PX 4, this illustrates a
12 lever. This is Lever 19 that is rotated 180 degrees.

13 And through that single motion, the removable conveyor unit is both
14 placed into its operational location and Latch 21 is moved into place to
15 secure that removable conveyor unit in place for operation.

16 So a single motion of that lever in order to both place the conveyor
17 unit into its operational location and secure it for operation. In PX 5, we see
18 a second embodiment, which is a distinct embodiment in the 487 Patent.

19 Here there are two distinct motions, a first motion that relies on a
20 pivot that places that removable conveyor unit into its operational location,
21 and then a second motion which is a hand turned latch that locks or secures
22 that removable conveyor unit into place for operation.

23 So these are the two distinct and different embodiments of the toolless
24 mechanism described in the 487 Patent.

25 PX 6 and PX 7 address the meaning of the toolless limitation. Now, I
26 think it's a simple question and I believe it's undisputed in this record, both

1 here at the PTAB in this proceeding and in the parallel District Court
2 litigation, both parties appear to agree that the toolless limitation that was in
3 Original Dependent Claim 16 requires without tools transitioning into or out
4 of a fully secured and operational state.

5 It is not enough that the conveyor unit is put into or removed from its
6 operational location without tools. There is a requirement for securing that
7 is part of this toolless limitation disputed between the parties.

8 JUDGE DEFRANCO: Mr. Hart?

9 MR. HART: Yes, Your Honor?

10 JUDGE DEFRANCO: Looking at PX 5 of your demonstratives, in
11 the middle diagram labeled Transitional, the pivot point 63, there's no latch
12 there, correct? So the base of the conveyor then is just sitting on top of the
13 support bar 63. Am I correct?

14 MR. HART: At that point, it is sitting on top of the pivot point 63.
15 Yes, Your Honor.

16 JUDGE DEFRANCO: But the only latch in that figure, in all three
17 figures, is the latch, what, 77?

18 MR. HART: Yes, there are a number of numerical indicators there,
19 but that, you have identified the location of the latch. So that latch holds the
20 left side of the conveyor unit in place, prevents it from rotating back up, and
21 the belt on the right side holds the right side of the conveyor unit in place for
22 operation.

23 So a single latch, and you're right, it's on the left side around the 77,
24 79 numerical indicators.

25 JUDGE DEFRANCO: And that's sufficient to prevent pop out,
26 correct?

1 MR. HART: That is correct because it is a pivoting design that is held
2 in place on the right side by the belt and held in place on the left side by that
3 latch.

4 JUDGE DEFRANCO: And how is that a figure of -- I think those are,
5 what, Figures 14a and 14b of the challenged patent?

6 MR. HART: That's right.

7 JUDGE DEFRANCO: How are they different from Figure 8 of
8 Konishi? Because Konishi seems to show a U-shaped groove that the
9 conveyor belt sits in on one side and then it has a diagonal groove which
10 holds the conveyor belt in, in that diagonal groove.

11 And the diagonal groove covers the pin. So how is that different from
12 Figure 14a's -- how is the diagonal groove in Konishi different from the
13 latch in the challenged patent, and the other pivot point where the conveyor
14 unit is just simply sitting there?

15 MR. HART: Sure, so in Konishi, we luckily have the same
16 orientation. We have the belt on the right side that is placing a lower -- a
17 downward force on the right side of the removable conveyor.

18 We have a pivot point at 26R or 25R that we see there on Figures 1
19 and 8 on PX 8. And then we have an open slot, vertically open slot on the
20 left.

21 That vertically open slot in Konishi is the same, effectively the same
22 location as the latch in the second embodiment of the 487. Now, the
23 important difference is that nothing holds Konishi, nothing described in
24 Konishi holds the conveyor belt into that vertically open contact point on the
25 left.

1 It does not have a latching mechanism like the second embodiment
2 described in the 487 patent. The 487 patent uses that hand turned 90 degree
3 turn latch to ensure that the conveyor unit cannot pop out of that contact
4 point on the non-drive side.

5 There is no similar securing mechanism described or suggested in
6 Konishi. That is the key distinction and that is the primary fight between the
7 parties regarding Konishi.

8 JUDGE DEFRANCO: Why doesn't the hook shaped groove in
9 Konishi accomplish the same thing, as far as holding the conveyor belt
10 down?

11 MR. HART: And by hook shaped, you mean on the right 25 R that is
12 angled?

13 JUDGE DEFRANCO: The diagonal groove.

14 MR. HART: It does. So it does hold the conveyor unit in place on
15 the right side on the drive side. The risk in Konishi is not that it will pop out
16 of that angle or diagonal contact point.

17 The risk is that it will pop out of the vertically open contact point on
18 the left side. That is the side that requires securing for operation in the same
19 way that the 487 second embodiment latches that non-drive side contact
20 point.

21 So in the 487, there is a latch that is turned, and that prevents the
22 conveyor from lifting up during operation as a result of vibrations or forces
23 from the belt.

24 In Konishi, you will also have vibrations and forces from the belt that
25 will tend to lift up the conveyor belt during operation. And because there is

1 no latching mechanism on the left side of Konishi where that vertically open
2 contact point exists, it must be physically secured.

3 There must be some additional physical securing to ensure that it stays
4 in place and remains operational. That is the key distinction.

5 JUDGE DEFRANCO: Okay. Everything you just said about this
6 concern over vibrational forces, where is this addressed in the specification
7 of the challenged patent?

8 MR. HART: The latching mechanism, the toolless latching
9 mechanism, is that --

10 JUDGE DEFRANCO: No, the concern with vibrational forces as far
11 as popping out the conveyor belt unit from its mount.

12 MR. HART: I don't believe there is a discussion of the vibrational
13 concern. The entire 487 specification presumes that the conveyor belt needs
14 to be secured for operation.

15 And it describes two distinct embodiments, both of which protect
16 against a conveyor belt popping out during operation from vibrational or
17 other dynamic forces. In fact --

18 JUDGE DEFRANCO: So you --

19 MR. HART: Go ahead, Your Honor.

20 JUDGE DEFRANCO: So you agree that the specification of the
21 challenged patent is silent as to this concern with vibrational forces resulting
22 in a pop out, correct?

23 MR. HART: I am not aware of a specific discussion of vibrations, but
24 I would point out critically that this is not a disputed issue in this case, and
25 PX 16 of patent owner slides, I have testimony from Petitioner's expert, Dr.

1 Collins, where I asked him why do these conveyor belts need to be secured?
2 What are we securing against?

3 And he identified vibrations. It was well known from a POSITA's
4 perspective that these are dynamic machines, that these operate in a
5 mechanically robust environment and there can be vibrations, was his
6 answer, and therefore, these conveyor belts need to be secured against those
7 vibrations to ensure they do not pop out of place during operation.

8 So this is not a disputed point. It may not have been well developed
9 in the express language of the 487 Patent specification, but it was well
10 recognized by POSITAs in the art, and it is not disputed.

11 Both parties' experts agree that these conveyor units are operating in a
12 vibration prone environment and risk popping out due to those vibrations.

13 JUDGE MELVIN: I'm sorry to interrupt, Mr. Hart, just before you
14 go on, could Petitioner, could you turn your video back on? We just want to
15 make sure you're still connected. All right, thank you.

16 MR. HART: Proof of life. All right. Very good. I know we've spent
17 quite a bit of time, so I'm going to jump ahead a few slides and I want to
18 address, I want to turn to PX 12 and really hit head on this question of
19 whether silence is sufficient.

20 That is the thrust of Petitioner's case in this proceeding. The key
21 question pursuant to the case that I talked about earlier and the Petitioner's
22 counsel talked about in Novartis, is how would a POSITA interpret the
23 silence in Konishi and McLaughlin?

24 Would a Petitioner, or I'm sorry, would a POSITA interpret the
25 references' silence concerning securing mechanisms to mean either that no

1 securing is required or second, that securing mechanisms are required
2 implementation details that simply are not addressed by the Patent?

3 Patent Owner's position, as we have addressed in detail on this case,
4 is that no reasonable POSITA would consider relying on gravity and friction
5 to secure these types of conveyor units.

6 How they are secured for operation is simply an implementation detail
7 that the references leave unaddressed. Turning to PX 13, the most important
8 evidence of record to support that point is concrete, specific evidence for
9 how these conveyor units were actually implemented in the field.

10 McLaughlin, as I mentioned, is Petitioner's own patent. Petitioner
11 conceived that multiple commercial embodiments existed. In every single
12 example of Petitioner's prior art commercial embodiments, the conveyor
13 units were secured for operation and they were secured using a wrench.

14 It's worth pausing on this for a moment. This is Petitioner's own
15 product. It has presented no evidence whatsoever that it ever left the
16 conveyor unit unsecured for operation.

17 It did not test, it has no evidence that it ever tested that concept. It has
18 never identified a single customer that ever ran these conveyor units without
19 physical securing.

20 Instead, every single instance we know of, the conveyor units were
21 secure and they were secured with tools. This cuts strongly against the idea
22 that a POSITA would read these references and interpret their silence
23 regarding securing to mean that they do not require physical securing.

24 All concrete and objective evidence points to the contrary and
25 demonstrates that these do need to be secure for operation. And PX 14, we

1 saw a new and interesting argument from Petitioner in its surreply to the
2 Motion to Amend.

3 Here on PX 14, an excerpt from the surreply, Petitioner filed and
4 noted correctly that its own SX 30 has been found to infringe as a matter of
5 law, that summary judgment in the parallel District Court limitation.

6 It then argued that Patent Owner can't claim on the one hand that
7 McLaughlin fails to render obviousness claims while on the other hand
8 arguing that McLaughlin's commercial embodiments literally infringe.

9 There are two critical facts missing from this portion of the surreply.
10 First, the SX 380 is not prior art. Whatever mechanisms it uses to secure its
11 conveyor have no bearing on invalidity.

12 Second, after the 487 patent issues, Provisur released the SX 380 with
13 a new toolless securing mechanism to hold the conveyor unit in place.

14 This is a significant omission from the Petitioner's briefing. Indeed,
15 the SX 380 forms the basis of the copying allegations that support secondary
16 indicia of non-obviousness.

17 That Provisur used tools to secure its prior art conveyor units, and
18 then implemented the toolless mechanism to secure them after the 487 patent
19 issues strongly supports non-obviousness rather than obviousness.

20 Turning to PX 15, with one sided record showing that McLaughlin's
21 conveyor units were always secured with tools, it is a critical point that the
22 design of Konishi's conveyor unit makes it more likely to pop out of place
23 during operation and thus is in more need of physical securing than
24 McLaughlin's.

1 This is an opinion that was introduced in the opening declaration for
2 patent owner's declarant, Dr. Reinholtz. Petitioner did not cross-examine
3 Dr. Reinholtz on this point, as Petitioner's expert did not dispute the point.

4 Accordingly, the objective evidence and the undisputed expert
5 testimony in this case demonstrate that both Konishi and McLaughlin
6 require physical securing for operation.

7 PX 16 through PX 20 address the two components of Petitioner's
8 silence is sufficient theory, that friction and weight alone would secure these
9 conveyor units for operation.

10 In PX 16, I've already touched on this in response to Your Honors'
11 questioning, but Petitioner's expert confirmed on cross-examination that the
12 reason these conveyors need to be secure for operation is to avoid becoming
13 displaced due to vibrations.

14 Turning to PX 17, when Dr. Collins, after having testified that
15 vibrations are the thing we are securing against, when he analyzed these
16 conveyor units and proposed a force analysis concluding that these conveyor
17 units of Konishi and McLaughlin would never pop out under any weight, he
18 did not address vibrations, did not discuss them, did not consider them, did
19 not incorporate them into his lengthy set of equations proposed in his
20 supplemental declaration.

21 This is a critical omission. Dr. Collins was the expert who proposed
22 that these conveyor belts need to be secure to avoid popping out due to
23 vibrations.

24 Yet, when he analyzed the forces at issue when these things are
25 running, he ignored, entirely ignored, vibrations.

1 Turning to PX 18, and PX 18 and PX 19, I'm going to quickly touch
2 on this, Patent Owner's expert Dr. Reinholtz provided a lengthy analyses
3 explaining why vibrations alone are not sufficient to hold these conveyor
4 units in place.

5 And the logical carry over from that point is that some physical
6 securing is required. In PX 18, Dr. Reinholtz explained that as disclosed in
7 Del Roso, a background reference introduced by Petitioner in this reference,
8 or I'm sorry, in this proceeding, weigh conveyors, which both Konishi and
9 McLaughlin are weigh conveyors, they are of the type where you are
10 weighing the product as it is conveyed across, weigh conveyors are
11 particularly susceptible to inaccuracies in their weight functions due to
12 vibrations.

13 Any rattling around, any movement of the conveyor unit within the
14 base unit, will throw off the accuracy of those measurements, the scale
15 measurements or weight measurements.

16 Accordingly, any securing mechanisms must ensure that that
17 removable conveyor unit remains tightly locked into the base unit. There
18 must be a tight securing connection between the conveyor unit and its base
19 in order to maintain accurate scale readings.

20 Now, worth noting, Petitioner's Slide 6 suggests that Konishi is not
21 limited to weigh conveyors. I believe Counsel said that they did not
22 expressly limit their case to Konishi's weigh conveyor.

23 Whether they expressly limited it or not, they only analyzed Konishi's
24 weigh conveyors. There is no analysis from Petitioner, nor is there any
25 analysis from Petitioner's expert regarding Konishi's non-weigh-based, non-
26 scale-based conveyor units.

1 Their entire case turns on Konishi's scale based conveyors. And
2 therefore, this point from Patent Owner's expert that scale based conveyor
3 units in particular must have a tight non-rattling, non-oscillating connection
4 holds for both the Konishi grounds and the McLaughlin grounds.

5 Turning to PX 19, Dr. Reinholtz explained --

6 JUDGE DEFRANCO: Counsel, what if we don't limit Konishi or
7 Petitioner's arguments to the weighing conveyor? And we say for Konishi,
8 Petitioner made arguments with respect to both conveyors?

9 MR. HART: Sure, I've not --

10 JUDGE DEFRANCO: It's not --

11 MR. HART: As I noted, they did not analyze it at all. There is no
12 record on which to analyze the non-weight conveyors in Konishi. But as a
13 hypothetical question, the argument in PX 19 still holds.

14 In PX 19, Patent Owner's expert explained that friction, which is the
15 primary force Petitioner's expert proposes would hold these conveyor units
16 in place during this operation.

17 Friction is not a reliable force to hold these in place. Friction is
18 notoriously variable and unreliable, as Dr. Reinholtz explained. That is
19 particularly true when vibrations make the instantaneous friction forces
20 difficult if not impossible to calculate.

21 Put simply, in a vibrating environment, in a dynamic environment in
22 which these conveyor units operate, friction is not a reliable force and would
23 not serve to hold these units in place. That is testimony from Dr. Reinholtz,
24 that Petitioner chose not to cross-examine.

25 There is no challenge to that opinion in this case and that friction, that
26 unreliable friction opinion of Dr. Reinholtz holds whether you look at

1 Konishi's weigh-based conveyor or any other conveyor that is not physically
2 secured and is held in by friction and weight alone.

3 JUDGE DEFRANCO: Do you agree that the claim, Claim 16, is not
4 limited to any particular type of food slicing?

5 MR. HART: No, I would disagree with that. Claim 16 is now or has
6 always been part of -- has always included the limitations of Claim 1. What
7 we see in Claim 1 and Claim 16 is that the relationship between the
8 removable conveyor unit and the base unit is very specific and has specific
9 structural requirements.

10 There needs to be relative movement between the conveyor unit and
11 the base in order to be engaged that conveyor unit into its operational
12 location, and then per Claim 16, there needs to be a toolless mechanism that
13 secures that conveyor unit in place for operation.

14 And so, those two together do require a very specific structural
15 makeup, and here, only Konishi and McLaughlin satisfy that structural
16 makeup for the actual relative movement, and neither one of those has any
17 kind of physical securing mechanisms described in their disclosures.

18 They leave that open to implementation, and as we've explained in
19 our papers here, one of skill in the art would have understood based on the
20 record that some additional physical securing would be required to keep
21 those conveyors in place for operation.

22 JUDGE DEFRANCO: Do all conveyor belts undergo some sort of
23 vibration that might incur a pop out?

24 MR. HART: There are many designs that are designed specifically so
25 they do not pop out. In this case, Konishi and McLaughlin are nearly
26 identical structures.

1 They both slot in on the drive side in the angled open slot that Your
2 Honor was questioning me about earlier. And on the non-drive side, they
3 both plop down into a vertically open and unsecured contact point.

4 Now those designs, that design that is representative by both Konishi,
5 or represented both by Konishi and by McLaughlin, is susceptible to
6 popping out if unsecured.

7 And the main forces, as Dr. Collins admitted, are vibrational. The
8 vibrational forces coupled with the forces of the belt tend to cause the
9 conveyor belts to pop out during operation and that's why they require
10 physical securing.

11 There are many ways to secure other conveyor belts such that they
12 might not pop out. We see Herman that was introduced in Ground 5 in
13 response to the Motion to Amend. That conveyor belt is mounted on two
14 permanent mounting rods that prevent that conveyor belt from lifting up
15 during operation.

16 It is those mounting rods that prevent rotational movement. And there
17 are other examples in the record.

18 What is really important to stress here is that every single example,
19 we have Konishi and McLaughlin who are silent. These are horizontal
20 conveyor units that are susceptible to popping out and do not describe how
21 they are secured.

22 Every other example of a horizontal conveyor unit in this case include
23 some physical securing mechanism. Herman, Matthews, the list goes on and
24 on and on, all examples of horizontal conveyor units are physically secured.

1 And that also supports our experts, Dr. Reinholtz as a POSITA, his
2 interpretation that Konishi's and McLaughlin's silence, are simply
3 insufficient.

4 You cannot take their silence to mean that they do not require physical
5 securing when all the evidence of record here shows that they must be
6 physically secured for operation.

7 JUDGE MELVIN: I have a question. I'd like to better understand
8 this physical securing requirement. I mean, let's accept that that's a feature
9 of practical machines.

10 But as to claim language, you're reading that in through which term?

11 MR. HART: So, Claim 16, toolless installation or removal requires
12 the conveyor belt to be secure for operation. Both parties agree that is the
13 interpretation that both parties have applied.

14 Now to your point, if Konishi or McLaughlin could be run and would
15 be secured without additional physical securing, then they satisfy that
16 limitation. We don't dispute that.

17 We are not attempting to incorporate an additional unstated physical
18 latching mechanism into Claim 16. What we are saying is that neither
19 Konishi nor McLaughlin describes how they are physically secured for
20 operation.

21 The evidence of record demonstrates that they must be physically
22 secured for operation, and therefore there must be some additional
23 implementation details, some additional latching mechanism or wrenching
24 mechanism that holds them in place before they are run.

25 JUDGE MELVIN: I mean, just to step back a minute, I mean, how
26 does this work more generally, right? Like, you might have a reference that

1 describes a concept, and it is true that, like you said, there would be
2 implementation details, but isn't the argument that the concept is not
3 enabled, perhaps?

4 MR. HART: No, I think there's --

5 JUDGE MELVIN: I don't think that's what you're arguing, so --

6 MR. HART: Right, no, it's a great point. And there's an important
7 distinction between non-enablement argument, which we're not advancing
8 here, and what we are advancing here.

9 So an enablement argument in the context of prior art typically arises
10 where there is a teaching of the limitation in the prior art and the Patent
11 Owner argues that that teaching is not enabled.

12 It fails to satisfy the limitation because it would not work for some
13 reason. That is not the situation we have here. This is an absence of a
14 teaching.

15 There is no discussion of how these conveyor units are secured for
16 operation, and therefore, we have to look to how a POSITA would interpret
17 their teachings. Would a POSITA --

18 JUDGE MELVIN: Well, the claim is an apparatus claim and it
19 doesn't really talk about operation, and it determines installed without tools,
20 right?

21 So you're saying installed without tools requires installed such that
22 the machine could be operated?

23 MR. HART: That's exactly right, and that is an undisputed
24 interpretation of this limitation between the parties. Both parties here and in
25 the District Court appear to agree that Claim 16, when it is installed without

1 tools or removed without tools, that is transitioning into or out of a secured
2 and operational state.

3 And if we go back to the claim language itself, we see that there is
4 distinction between putting the conveyor unit into place and installing the
5 conveyor unit without tools as Claim 16 requires.

6 And so, putting it into place, if we go back to PX 3 where I have the
7 annotated claim language red and green, in red, we are relaxing or tautening
8 in order to put this conveyor unit into its operational location.

9 In green, the toolless limitation, we are, without tools, removing or
10 installing that conveyor unit. Both parties agree on this record that that
11 toolless installation or removal limitation requires transitioning into or out of
12 a fully secured and operational state.

13 That is built into our interpretation of why Konishi and McLaughlin
14 and their silence regarding securing are insufficient.

15 JUDGE MELVIN: Thanks.

16 MR. HART: I believe I'm being pestered by teammates about how
17 much time I have left, so let me just check here.

18 JUDGE MELVIN: You have 12 minutes on my clock.

19 JUDGE DEFRANCO: Counsel?

20 MR. HART: Very good.

21 JUDGE DEFRANCO: But Counsel, you want us to interpret the
22 limitation reciting to install without tools to mean that it's operational with
23 toolless latches?

24 MR. HART: Well, it doesn't have to be a latch. It is toolless,
25 expressly. So that's built in. But yes, we are asking, and Petitioner has not

1 disputed, that that toolless limitation requires placing the conveyor unit
2 without tools into an operational state, a secured state ready to run, or --

3 JUDGE MELVIN: This is -- let me interrupt you real quick. Can you
4 just tell me where in the papers Petitioner -- because you said there's no
5 dispute, right -- where in the papers does Petitioner agree with that?

6 And also, where do you expressly make that construction in your
7 papers in this proceeding?

8 MR. HART: Sure, so in PX 3, I have an excerpt describing the
9 toolless removal at POR Page 5, stating that it is from a fully secured state,
10 i.e., the state in which the conveyor operates without tools.

11 Turning to PX 6, another cite to the Patent Owner response at Page
12 25, stating the toolless limitation requires transitioning without tools from a
13 secured and fully operational state to an unsecured state where the conveyor
14 can be removed from the substructure.

15 And then in the reply, also on PX 6, reply in support of the Motion to
16 Amend, I'm sorry, I believe that is our reply, yes, our reply in support of our
17 Motion to Amend on Page 2, the toolless limitation does not simply require
18 a conveyor unit to move into and out of its operational location without
19 tools.

20 Rather, Petitioner must prove that transitioning between an
21 operational state and a removed state without tools was anticipated or
22 obvious.

23 So we have over and over in our papers laid out our interpretation of
24 the toolless limitation. I am not aware of any arguments from Petitioner
25 disputing that interpretation.

1 And while I am not on the trial team in the District Court litigation, I
2 believe that is also the operative interpretation of the limitation in the
3 District Court case.

4 JUDGE PLENZLER: Let me just -- I know you're running short on
5 time. So just one real quick question. I know you just referenced your reply
6 in Support of Motion to Amend, what are we supposed to do with the first
7 section that you have there on Page 1 where you're talking about all of a
8 sudden now not cancelling Claim 16?

9 MR. HART: This is just a renumbering. So it's just a clerical issue.
10 We are, so we needed two things in the reply in support of a Motion to
11 Amend.

12 JUDGE PLENZLER: So it's not a revised motion to amend, though,
13 right, you're not -- I'm just wondering, what's the mechanism that we use to
14 get you the result that you want?

15 MR. HART: It is simply to adopt the numbering that is set forth in
16 the reply in support of the Motion to Amend. So the rules on a revised
17 motion to amend require that we respond to arguments, respond to evidence,
18 revise the proposed amendments in some way in response to the board's
19 preliminary guidance, or in response to the Petitioner's reply.

20 That is not what we are responding to here. This is not a substantive
21 change. This is a clerical change. So in the original Motion to Amend, what
22 we proposed doing is because all the majority of the challenged claims
23 depend on Claim 1, we added the toolless limitation from Claim 16 into
24 Claim 1 to minimize the number of amendments that were required by that
25 Motion to Amend.

1 In response to that, Petitioner in the District Court litigation, and then
2 we also because now Claim 1 is co-extensive with Original Claim 16, to
3 avoid having two claims of identical scope, we proposed canceling Claim
4 16.

5 Petitioner in the District Court litigation took advantage of that and
6 they filed a motion asking the District Court to kill the infringement claim
7 regarding Claim 16 because it had been cancelled in our Motion to Amend.

8 Now, the District Court saw through that and they said, well, there is
9 no change in scope here, and this is a preliminary Motion to Amend, so I'm
10 going to deny your motion.

11 But Petitioner had signaled that it is going to re-raise that issue in the
12 District Court and potentially, at the appellate level, expending
13 unnecessarily, expending time and resources from the courts and the parties.

14 And so all we're doing in our revised Motion to Amend is saying with
15 no change whatsoever in the proposed --

16 JUDGE PLENZLER: I'm going to correct you, it's not a revised
17 Motion to Amend, though, right?

18 MR. HART: Sorry, in our reply in support of the Motion to Amend,
19 you got it exactly right, we are saying we are not changing the scope of
20 those claims, those amended claims whatsoever.

21 We're simply renumbering them to preserve the number 16 on the
22 claim that includes the limitations of original Claim 1, Independent Claim
23 16.

24 So that tweak is clerical in nature. It only changes the number of the
25 claim. It does not impact the scope of any amended claim proposed for this
26 board to assess.

1 And I know it's a complicated setup. It is more a procedural issue
2 avoiding unnecessary briefing in the District Court litigation than it is a
3 substantive issue here on a claim scope.

4 It does not change the claim scope we are requesting through the
5 Motion to Amend process.

6 Any other questions on that? I know it's not exactly straightforward.

7 JUDGE DEFRANCO: Yes, Counsel, does your clerical tweak change
8 the scope of grounds the Petitioner can now assert?

9 MR. HART: No, it does not. Because it does not change the scope of
10 the claims, period, it has no impact on the scope of the amended claims. It
11 does not reset the clock on how the Petitioner can respond, nor has it --

12 JUDGE PLENZLER: It doesn't remove their ability to assert
13 Grounds 5 and 6.

14 MR. HART: That's exactly right, we do not dispute -- that's exactly
15 right. We're not disputing that Grounds 5 and 6 were appropriately inserted
16 into the case, and it literally, it is just a clerical change on the numbering for
17 those amended claims.

18 It does not change the substance of the scope of those claims, nor does
19 it change the substance of Petitioner's challenge.

20 JUDGE DEFRANCO: And Counsel, you agree that you've had
21 adequate opportunity to respond to those new grounds, 5 and 6?

22 MR. HART: Yes, Your Honor, we --

23 JUDGE DEFRANCO: As submitted by Petitioner?

24 MR. HART: We have not -- we have not disputed a fair opportunity to
25 respond to those. And part of --

1 JUDGE DEFRANCO: Just to put it in a positive manner, you agree
2 that you've had adequate opportunity to respond to new Grounds 5 and 6,
3 correct?

4 MR. HART: We do, yes, Your Honor. And the process has
5 proceeded per the standard Motion to Amend practice. There is a criticism
6 that we should have submitted a Revised Motion to Amend instead of
7 making -- proposing this clerical error, I'm sorry, this clerical change in our
8 reply.

9 The revised Motion to Amend practice per the PTAB guidance is
10 really to make a substantive change in response to that preliminary guidance.

11 It also triggers a new schedule for new briefing. None of that was
12 required here because there were no substantive changes being proposed.
13 They were purely clerical in nature.

14 So yes, to state it affirmatively, Grounds 5 and 6 were properly
15 advanced in response to our original Motion to Amend. The clerical change
16 requested in the reply as part of the Motion to Amend does not change the
17 validity of that.

18 We have had a fair opportunity to respond to those. And I'm happy to
19 address any other questions given the somewhat unique procedural framing
20 here.

21 JUDGE DEFRANCO: Yes, if you could get into the new Grounds 5
22 and 6, that would be good.

23 MR. HART: Sure, let me jump down to PX 23 of Patent Owner's
24 Demonstratives. We have Herman and Mathues. Those are the two new latch
25 teachings that Petitioner has relied upon for Grounds 5 and 6.

1 They are both structurally similar, both highlighted in yellow or
2 annotated in yellow on PX 23. Critically, neither of these latches secures
3 against forces experienced by Konishi's or McLaughlin's conveyor units.

4 In PX 24, as I touched on briefly earlier, Herman's removable conveyor
5 unit slides laterally onto permanent mounting rods. It is those permanent
6 mounting rods that prevent it from lifting up or moving during operation.

7 That yellow latch simply flops over to prevent Herman's conveyor belt
8 from sliding off the end of those rods during operation. That is not protecting
9 against movement, even remotely similar to the forces at issue in Konishi's or
10 McLaughlin's.

11 Turning to PX 25, Mathues on one side of its removable conveyor unit
12 which we see in Figure 12, depicts a yellow hook, 160, that slots over a bar
13 that is part of the removable conveyor unit.

14 But on Figure 13, which depicts the opposite side of that same conveyor
15 unit, we see that Mathues conveyor unit is in fact bolted into place for
16 operation.

17 It is that bolt that holds it in place for operation. It does not rely on that
18 rotational latch, that hook shaped latch, that forms the basis of Petitioner's
19 ground 6 here.

20 Now, Patent Owner --

21 JUDGE DEFRANCO: Where does Mathues say that?

22 MR. HART: Mathues depicts that in Figure 13 as annotated here on
23 PX 25. It does not --

24 JUDGE DEFRANCO: Where do they -- where do they actually say
25 that that's the purpose of that bolt?

1 MR. HART: It does not discuss that bolt. Patent Owner's expert, Dr.
2 Reinholtz, analyzed Mathues's teaching, interpreted Mathues's Figure 13, and
3 explained that the only purpose for the bolt depicted at 143 in Figure 13 in
4 Mathues, is to hold that conveyor unit in place for operation.

5 Now, Petitioner chose not to cross-examine Dr. Reinholtz on that point,
6 and Dr. Collins for Petitioner did not analyze Figure 13 at all, did not discuss
7 that bolt, did not explain it away.

8 So this is uncontested expert testimony interpreting Mathues's
9 teachings, that Mathues's bolt, 143, would hold the conveyor unit in place,
10 not the rotational latch depicted in Figure 12.

11 JUDGE DEFRANCO: Counsel, did your expert consider Paragraph 49
12 in Mathues where it says that the rotatable hooks that go around the pins
13 prevent unintentional removal?

14 MR. HART: He did. He did, Your Honor. He explained --

15 JUDGE DEFRANCO: And what was his response?

16 MR. HART: His response was that a POSITA would understand based
17 on the figures and the description that as the conveyor unit is pushed into
18 place, those latches are placed over the pins in order to secure it in place, in
19 order to make sure that it is fully installed before those bolts are tightened
20 down.

21 The fact that those bolts exist, their only purpose is to hold it in place.
22 If those bolts are tightened, there is no purpose, there is no retaining purpose
23 or holding purpose or responsibility placed on the hook shaped latches.

24 And the fact that they are illustrated in Mathues means that he's right,
25 right, that if they are illustrated there, they have a purpose, and their only
26 purpose can be to lock that conveyor belt in place for operation.

1 So the hook shaped latches he explained are to make sure that the
2 conveyor unit is straight and it's in place before you tighten down those
3 retaining bolts, for operation.

4 JUDGE DEFRANCO: What does your expert say about the meaning
5 of unintentional removal? What does unintentional removal mean?

6 MR. HART: It is part of the installation process. So when you are
7 installing it, you are flipping down those latches to make sure it is fully against
8 the back edges of brackets 150, to make sure it is fully in place, before the
9 bolt is secure.

10 And in the opposite direction, he explained that when you have undone
11 those securing bolts, the latches, make sure it doesn't just fall out as you are
12 undoing those bolts.

13 So the latches provide a mechanism at installation and at removal to
14 ensure the conveyor belt is fully installed and against the back of those
15 brackets when the bolt is tightened or loosened, to ensure it doesn't fall out
16 unnecessarily or inadvertently.

17 It does not, according to Dr. Reinholtz, secure the conveyor unit for
18 operation. It does not secure against vibrational forces or other dynamic
19 forces at issue when this machine is actually running.

20 JUDGE MELVIN: Okay, Mr. Hart, time has expired. So we'll let
21 Petitioner proceed with rebuttal and I'll give you a few minutes just to sort of
22 wrap things up at the end.

23 MR. HART: Thank you, Your Honors.

24 JUDGE MELVIN: All right.

25 MR. FELDHAKE: Can you hear me?

26 JUDGE MELVIN: Yes, we can.

1 JUDGE PLENZLER: Can I just start you out with a question? Do you
2 agree that --

3 MR. FELDHAKE: Yes, sir.

4 JUDGE PLENZLER: Do you agree that the claim requires you have
5 to be secured for operation?

6 MR. FELDHAKE: I do not agree -- well, okay, I'll take a step back,
7 Your Honor. So I think Patent Owner is advocating for a claim construction
8 here. We have not agreed to any sort of claim construction here.

9 This feels like a claim construction in disguise or something. They're
10 trying to turn this into a legal argument, but this is a factual issue of whether
11 or not this is disclosed.

12 And this is disclosed in Konishi. So Konishi, what Konishi teaches is
13 an operable device. It anticipates and teaches an operable device.

14 To the issue of whether or not this is disclosed, this is the real issue
15 here, Your Honors, and that's what Konishi discloses. Does that address your
16 question?

17 JUDGE PLENZLER: Somewhat. I just wanted clarification on the
18 representation that Patent Owner was making about there being no dispute on
19 that issue as far as what the claim requires.

20 MR. FELDHAKE: So, Your Honor, there's been no -- there's been no
21 District Court Markman hearing. The parties did not even brief claim
22 construction issues on this patent in the District Court.

23 And as you're aware in this proceeding, there has been no record on
24 claim construction issues.

25 JUDGE MELVIN: Well, no.

26 MR. FELDHAKE: And if there are any --

1 JUDGE MELVIN: Well, no record on claim construction issues. I
2 think the dispute is about this term installed, right? So just to make sure we're
3 all on the same page, Patent Owner says installed requires putting in an
4 operational state, and I think we're trying to make sure that you don't dispute
5 that.

6 MR. FELDHAKKE: Just one moment, Your Honor. Thank you, Your
7 Honor. I was conferring with lead counsel. We do not think this is a claim
8 construction issue and we think this issue is moot because it is disclosed by
9 the prior art.

10 It is disclosed by Konishi expressly and if not, it is rendered obvious by
11 the five obviousness grounds that petitioner has advanced here.

12 JUDGE MELVIN: Okay.

13 MR. FELDHAKKE: If Your Honors have any other questions, I'm
14 happy to address those. Otherwise, I have a few points that I will run through.

15 All right. So first of all, Your Honors, Patent Owner has repeatedly
16 framed this IPR as an issue of silence. This IPR is not about silence.

17 Konishi is not silent. Konishi has a full page disclosure on its process.
18 There's no silence in that full page. If Your Honors look at Page 29 of the
19 Petition, as that toolless removal makes the substructure simpler while making
20 conveyor belt unit removal easier, end quote.

21 It cites two paragraphs of the expert report which expands on how a
22 person of ordinary skill in the art reviewing Konishi would understand
23 Konishi to disclose a device that is operable and a device that goes from an
24 installed working or operating state to an uninstalled operating state back to
25 an installed operating state.

1 This is not a legal issue about silence. This is an issue about what
2 Konishi discloses and it discloses its complete process.

3 Another point, Your Honor, is percolating throughout all of the
4 briefing, there has been this discussion about the Power Max products. And
5 you heard from Patent Owner that Petitioner has not advanced certain
6 evidence in these proceedings.

7 IPRs are not about physical embodiments. IPRs are about granted
8 publications and other forms of -- and the scope of what an IPR is about. So
9 yes, Your Honors, we did not turn this into a sideshow of what the Power Max
10 does.

11 Additionally, there is no evidence in the record that a person of ordinary
12 skill in the art would have been aware of the Power Max manuals.

13 These are not presumably printed publications. There is no evidence in
14 the record that these are printed publications that a person of ordinary skill in
15 the art had got access to and would have considered.

16 Dovetailing with that issue, Your Honors, Patent Owner tied the Power
17 Max and this SX 330, SX 380 issue, into its copying narrative. Patent owner
18 waived its copying arguments.

19 If you look at the Patent Owner's surreply, Patent Owner admits that it
20 did not submit any evidence in this proceeding that advances its copying
21 narratives.

22 So they waived those arguments. They dropped them. And if Patent
23 Owner gets back up here and they say that they didn't drop those arguments,
24 then I invite Your Honors to review the record and look at the fact that the
25 expert that they relied on said that he didn't do things like do a claim by claim
26 analysis or do a technical analysis to determine copying.

1 First of all, he's not a qualified expert to make that analysis. Second of
2 all, he didn't conduct that analysis.

3 Next point, Your Honors, obviousness does not require a mathematical
4 model. Patent Owner was making arguments that Petitioner did not account
5 for vibrations and these mathematical models that it was advancing.

6 And so just to be clear, Your Honors, we put in these mathematical
7 equations in our Petitioner Reply Brief in response to Patent Owner's
8 arguments.

9 We don't think that there is a -- there is a requirement in the obviousness
10 burden to have a mathematical proof to show that something would have
11 worked.

12 KSR requires that the obviousness inquiry is a flexible inquiry and takes
13 into account common sense.

14 Next up, Your Honors, I would like to turn to Page 32 of Konishi. I'm
15 sorry, Paragraph 32 of Konishi. So Patent Owner argued that Petitioner did
16 not analyze anything about Konishi's other conveyor, its non-weighing
17 conveyor unit 3.

18 And there's a reason for that, Your Honors. That's because Konishi
19 did not duplicate its analysis and duplicate its disclosure for the conveyor belt
20 units that are removed in the exact same way.

21 So if you look at the last sentence of Paragraph 32 of Konishi, it says,
22 quote, the procedure for maintaining the conveyor type automatic weighing
23 device, 5, will be described below, but the maintenance for the intake
24 conveyor device 3 is almost the same.

25 And if Your Honors turn to page, or sorry, Paragraph 18, Paragraph 18
26 of Konishi says, quote, since the above mentioned belt conveyor device for

1 taking in products three and belt conveyor device automatic weighing device
2 5 have substantially the same configuration except that the belt conveyor type
3 automatic weighing device 5 is equipped with a weight detector, 34.

4 There was no independent analysis of the conveyor device 3 because
5 there is no further description because Konishi already says that it's the same
6 process.

7 Moving on, Your Honors, to reiterate a point that I made in my opening
8 and predicted in my opening, Patent Owner argued that a person of ordinary
9 skill in the art would not trust conveyors to be held in place by weight alone.

10 We submit exhibit 1012 in this proceeding. It says that you can leave
11 conveyor belt units in place and trust their weight alone to secure them. Have
12 not heard Patent Owner address that disclosure.

13 Moving on to Mathues, Your Honor, and I'm going to turn to Paragraph
14 49, which is what Your Honors flagged during Patent Owner's opening, so if
15 Your Honors, if you read the last sentence of Paragraph 49 of Mathues, it
16 states, quote, removal is accomplished by simply unhooking the hooks 160
17 and 162, sliding the conveyor 30 in the upstream direction, and dropping it
18 downwardly for removal, end quote.

19 I don't know what further disclosure Patent Owner wants than that. It
20 says you simply unhook it and you pull it out. If there is some requirement
21 that these are secured, then here is your disclosure.

22 Just one moment, Your Honors, I'm going to confer with lead
23 counsel.

24 And so, Your Honors, we maintain the position that Konishi discloses
25 all the requirements of Claim 16. And if Your Honors determine that it's not
26 anticipated, then it is most certainly obvious.

1 We respectfully request a written decision that finds that all
2 challenged claims are anticipated and/or obvious. Thank you, Your Honors.

3 JUDGE DEFRANCO: Counsel, one last question. What's the status
4 of the District Court case?

5 MR. FELDHAKKE: Yes, Your Honor. So the status has not changed.
6 A jury selection occurs January 24, which is next Friday. And then the
7 opening arguments will be delivered January 27, the following Monday.

8 And as a little further color there, Your Honors, there are
9 counterclaims in this proceeding. Petitioner, or yes, Petitioner, Provisur,
10 will put its case on first.

11 So we don't know the exact split of trial, but we anticipate that
12 approximately that first week of trial will be dedicated to Provisur's case.

13 And then the second week, which I believe starts sometime in
14 February, that is the part of the case that we anticipate would be dedicated to
15 Textor and/or Webber's portion of the District Court case.

16 So Your Honors, any final written decision that is released before that
17 time would greatly help just to remind the issues here. It would save the
18 judge time, the jury time, Provisur time and resources so it doesn't have to
19 prepare an expert on this issue. That is assuming that Your Honors rule in
20 our favor.

21 So we would greatly appreciate that if that is possible. Any other
22 questions, Your Honors?

23 JUDGE DEFRANCO: This is not the only patent at issue, correct?

24 MR. FELDHAKKE: Correct, Your Honors. So currently, Provisur is
25 asserting two patents, and yes, Provisur is asserting two patents and Textor
26 is asserting four patents currently.

1 There are also non-patent claims at issue.

2 JUDGE DEFRANCO: Thank you.

3 MR. FELDHAKKE: If there are no further questions, Your Honor, I'll
4 yield my time.

5 JUDGE MELVIN: Thank you.

6 MR. FELDHAKKE: Thank you, Your Honors.

7 MR. HART: Your Honors, recognizing that I am already over, I will
8 just make two brief points and then open it up to answer any questions you
9 may have remaining.

10 Regarding whether Konishi is limited to the weigh scale, Petitioner
11 pointed to Konishi's teachings and its weigh scale and its non-weigh scale
12 have similarities.

13 The point here is that none of this was discussed in the proceeding.
14 There is no discussion of Konishi's weigh scale. There's no distinguishing
15 Konishi's weigh scale from its non-weigh scale.

16 There's simply no detail in Petitioner's papers suggesting that it was
17 ever relying on any detail from a non-weight conveyor. Its expert never
18 disputed the points that our expert made regarding weigh scale, or I'm sorry,
19 weigh conveyors specifically.

20 So those criticisms apply to the case Petitioner presented regarding
21 Konishi.

22 The second point I want to make, Counsel suggested that I
23 mischaracterized the record when I stated that there is no teaching in this
24 record of any horizontal conveyor unit left unsecured for operation.

1 It pointed to Lee Exhibit 1012. Lee is not a horizontal conveyor unit.
2 It is a vertical toaster unit that is chain driven and is a fundamentally
3 different structured device than what we see in Konishi and McLaughlin.

4 Patent Owner's expert, Dr. Reinholtz, discussed Lee at length in his
5 opening declaration and his supplemental declaration, over and over and
6 over in response to any detail provided by Petitioner of which there was not
7 much.

8 Dr. Reinholtz analyzed Lee, explained why Lee's teachings are
9 inapplicable, and why Lee's latches would not work to secure Konishi or
10 McLaughlin.

11 So Lee is not evidence that it was known to Lee, horizontal conveyor
12 units, unsecured for operation. It simply is not a horizontal conveyor unit.

13 It has a laundry list of critical distinctions between its mechanisms, its
14 design, and those of Konishi and McLaughlin.

15 And with that, I am happy to address any further questions any of
16 Your Honors have.

17 JUDGE MELVIN: No, I think we're good. Thank you.

18 MR. FELDHAKE: Thank you very much for all your time.

19 JUDGE MELVIN: All right, and thank you to both parties for your
20 presentations today. They were certainly helpful. With that, we can go off
21 the record.

22 (Whereupon, the hearing in the above-entitled matter was concluded
23 at 2:28 p.m.)

PETITIONER:

Michael G. Babbitt
Sara T. Horton
Ren-how H. Harn
Mitchell M. Feldhake
Keeton A. Sheeler
WILLKIE FARR & GALLAGHER LLP
mbabbitt@willkie.com
shorton@willkie.com
rharn@willkie.com
mfeldhake@willkie.com
ksheeler@willkie.com

PATENT OWNER:

Paul R. Hart
Adam P. Seitz
Adam M. Sandwell
Christina Canino
ERISE IP, P.A.
paul.hart@eriseip.com
adam.seitz@eriseip.com
adam.sandwell@eriseip.com
christina.canino@eriseip.com