

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PROVISUR TECHNOLOGIES, INC.,

Petitioner,

v.

WEBER FOOD TECHNOLOGY GMBH,

Patent Owner

Case IPR2024-00235
U.S. Patent No. 8,529,321

**PATENT OWNER'S PRELIMINARY RESPONSE
TO PETITION FOR *INTER PARTES* REVIEW**

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I. INTRODUCTION

The '321 Patent is involved in a parallel litigation in the Western District of Missouri that is barreling toward trial in November of this year. That case is the finale of a five-year, multi-litigation dispute between the parties and the Court has made crystal clear that the culmination of the parties' grievances will be tried to a jury in 2024. *Infra*, Section III.A. To date, the parties and Court have expended significant resources preparing the case for trial, including litigating the very same invalidity theories presented in the Petition. The District Court's long history with the parties and technology make it the more suitable forum to adjudicate these issues. It will also move more quickly than the Board, conducting a jury trial more than six months before the Board's possible final written decision. Given the overlapping issues with which the District Court is intimately familiar, timeline, late stage of the parallel litigation and mountain of resources already expended, this is a textbook case where IPR proceedings will **not** be a "quick and cost effective alternative[]" to litigation[]." H. Rep. No. 112-98, pt. 1, at 45-48 (2011).

To be sure, where parallel litigation is at an advanced stage, as here, there is still a role for the *Inter Partes* Review process as a "true alternative" to the District Court. This is realized through a *Sotera* stipulation by which a petitioner may elect the PTAB as the sole tribunal hearing invalidity issues. Plaintiff here has refused to proffer a *Sotera* stipulation. Instead, it invites the Board to expend resources in

parallel to the district court, potentially involving the same prior art references as those litigated in the district court, knowing the jury trial will conclude long before the Board's work. The Board should decline Petitioner's invitation.

As set forth below, *Fintiv* Factors 1-5 weigh strongly in favor of denial. Petitioner nonetheless asks this Board to institute review, insisting that the Proposed Grounds satisfy the heightened "compelling evidence of unpatentability" standard. Petition at 76-77. As set forth in Sections IV, V, and VI, the Proposed Grounds fall far short. Indeed, Ground 1 proposes that Young anticipates the '321 Patent's claimed fat thickness measurements despite Petitioner acknowledging that Young's system is fat thickness agnostic. Ground 2 seeks to bolster Young's deficient teachings with Norrie, but Petitioner fails to describe with the requisite specificity what the combination is and how it would work and ignores that Young teaches away from Norrie. Ground 3 then proposes a combination of Johnson—a probe fat measurement system like the Applicant Admitted Prior Art the '321 Patent sought to improve—with Belk—a camera fat measurement system immaterially different than numerous other camera-based references considered during prosecution. Not only is this ground cumulative to the art already considered by the Office, Petitioner's proposed rejection uses the '321 Patent specification as a blueprint and it based entirely on hindsight.

Because the *Fintiv* factors strongly favor denial and because each Proposed Ground is critically flawed, the Board should deny institution.

II. SUMMARY OF THE '321 PATENT'S INTRINSIC RECORD

A. '321 Patent

The '321 Patent presents a novel apparatus for separating at least a portion of a fat cover from a flesh component of a meat product in an automated process that overcomes many of the drawbacks of conventional systems with “significantly lower economic effort.” Ex. 1001 at Abstract, 2:19-37. A meat product generally comprises three components: rind, fat, and flesh. *Id.* at 1:14-17. To remove portions of the fat cover, i.e., the rind and fat, the '321 Patent explains that conventional systems measured the thickness of the fat cover with an insertable probe that detected changes in brightness of different tissues. *Id.* at 1:18-36. In these systems, the “meat product is damaged by the insertion of the sensor,” particularly when one or more sensors have to be “inserted at multiple sites of the product for a reliable” fat thickness determination. *Id.* The non-contact measurements in the '321 Patent's invention determine “the thickness of a fat cover of a meat product without damaging the meat product[.]” *Id.* at 1:37-2:5 (describing exemplary optical non-contact measurements using light detectors and a CCD camera), 4:18-5:6.

The measured thickness of the fat cover is then “transferred from the evaluation unit of the measurement device” to a control unit of a cutting device. *Id.*

at 5:24-28. This control unit “determines the anatomy of the meat product [] from the measured result” and then selects a stored “travel profile”—which are “product-dependent or anatomy-dependent” profiles that “effect a change in the setting of the cutter bar in dependence on the feed of the meat product [] to be processed.” *Id.* at 5:24-43. In this way, the cutting device includes a cutting blade that “is variable relative to a product support” such that the “cutting blade position can be adapted to differently thick fat covers or the thickness can be set” for separation of a portion of the fat cover. *Id.* at 2:46-52.

In other words, the claimed invention measures the thickness of the fat cover; selects a travel profile that approximates the anatomy of this product based on this thickness and the product feed; and then removes portions of the fat cover based on this approximation. *See id.*, generally. This requires “significantly lower economic effort” than conventional manual or overly precise fat cover measurement systems such as those raised during prosecution (*infra*, Section II.B describing CT scan for fat thickness) or by Petitioner (*infra*, Sections IV, V, and VI describing controlling cutting with imaging systems using real-time feedback that follows specific fat/lean line per product).

B. The '321 Patent's US Prosecution

Application No. 12/738,969 was filed as a PCT application on September 12, 2008 and claims foreign priority back to German Application No. 10 2007 050 857 filed on October 24, 2007. Ex. 1001 at cover.

This PCT application was submitted to the Office with an attached International Search Report identifying several references "relevant" to the then-pending claims. Ex. 1002 at 86-91. This includes WO 2006/136814 to Burton (Ex. 1002 at 86, 90, 138, 175-219) and WO 2004/106020 to Gruntvig (Ex. 1002 at 86, 90, 223-240), references with substantially similar material disclosures to Petitioner's advanced rejections advanced in Ground 3 as discussed in more detail below. *Infra*, Section VI.A.1 (further identifying GB 2,364,894 to Kim with overlapping disclosures). Kim was also submitted to the PTO during examination. Ex. 1002 at 241-276.

On November 26, 2012, the Office rejected then-pending claims 1-21 of the '321 Patent as anticipated by Christensen (US Patent 7,918,718). Ex. 1002 at 358. In response, applicant amended the claims for allowance. Ex. 1002 at 387-394. Namely, applicant redrafted claim 8 into independent form and rolled certain features from the dependent claims into claim 8, including: (1) clarifying the "determination of the thickness of the fat cover takes place in a contactless manner;" (2) claiming a "cutting blade whose position is variable relative to a product

support;” and (3) claiming a “control unit for control of the position of the cutting blade in dependence on the thickness determined by the measurement device, wherein at least one travel profile is stored...”. *Id.*

To differentiate Christensen, applicant stated that its system selects travel profiles to change the position of a cutting blade based on fat thickness measurements in contrast to Christensen’s system that adjusts blade position from the entire “actual shape” of the fat cover. *Id.* at 393 (explaining that Christensen “measures ‘[t]he lean meat content...with great accuracy’...by taking, e.g., 130 CT sectional images along the entire length of” the meat product...The actual shape of the fat layer is input so that the derinding/fat trimming machine will follow this contour[]” which is “in direct contrast to the presently claimed ‘travel profiles’” that are selected based on “a small number of measurements of the thickness of the fat cover”). Put simply, applicant explained that its invention adjusts cutting position based on fat thickness and approximated meat product shapes whereas Christensen’s (and Petitioner’s references in at least its first and third proposed Grounds) rely on product-specific contours and cross-section lines for cutting.

III. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION UNDER 35 U.S.C. § 314(A)

The Board considers the status of parallel litigation in deciding whether to exercise its discretion to deny institution under 35 U.S.C. § 314(a). *NHK Spring Co.*

v. Intri-Plex Techs., Inc., No. IPR2018-00752 (P.T.A.B. Sept. 12, 2018), Paper 8. In deciding whether to discretionarily deny institution, the Board considers six factors. *Apple, Inc. v. Fintiv, Inc.*, No. IPR2020-00019 (P.T.A.B. Mar. 20, 2020), Paper 11. Here, these factors strongly favor discretionary denial.

A. Factor 1 — No Stay Has Been Requested And The Evidence Shows No Stay Would Be Granted.

No stay has been requested, and the record strongly suggests the district court would reject any such request. Indeed, the district court has repeatedly confirmed that the parties' disputes *will be* tried in 2024. In the June 23, 2023 Scheduling and Discovery Dispute hearing, Judge Bough gave clear directives that "[w]e're trying this in 2024. We're not trying it in 2025." Ex. 2001 (*Provisur Tech., Inc. v. Weber Inc. et al.*, Case No. 5:21-cv-06113, Dkt. 166) at 7:15-16. To accomplish this, Judge Bough explained he is "going to put [his] foot on the gas pedal[.]" leaving no room for delay. *Id.* at 8:17-9:14. He went on to state:

But local rules are not Federal Rules of Civil Procedure, and if I need to abandon them, even though I'm the judge in charge of the local rules, I'll just abandon them. But we need to figure out how to take advantage of the experience that we've had getting here, the experience that we theoretically could have had a trial in the summer of next year but for my ruling and Provisur's desire to incorporate this additional claim. So we're not talking about having it in May of 2024, **but we're having it in 2024.** So either oppose or find a way to make it happen.

Id. (emphasis added). This same rationale was reiterated throughout the hearing. *Id.* at 11:3-11 ("We're just going to make this thing happen in 2024. All these dates,

including anything set forth in the Federal Rules of Civil Procedure, I can change and do. Right? I mean, I do. I tell people all the time that you're going to get this served on the parties quicker, and if I have to adjust every date along the way, I will. But we have -- if dragging it out as long as we've dragged it out hasn't gotten us all the way to the end zone, then I'm just going to have to gas pedal it."); *see also id.* at 12:2-14 ("And all I have done for years now is hear parties on both sides tell me how it can't be done and how it's got to have more time. All I have seen is millions of dollars spent on attorneys' fees on this case. **And I'm done.**"); 12:23 ("And we've just got to get this thing done in 2024").

At the September 13, 2023 Scheduling Conference, Judge Bough doubled down on his prior directives and informed the parties that "we need to get this thing done...put your saddle on, put it on tight[.]" Petitioner's counsel affirmed it is "ready to do that" and confirmed the November 18th, 2024 trial. Ex. 2002 (*Provisur Tech., Inc. v. Weber Inc. et al.*, Case No. 5:21-cv-06113, Dkt. 216) at 3:22-25, 6:17-20. Since that scheduling order was entered over four months ago, there has been no change to the scheduled trial date.

Meanwhile, the district court litigation has progressed substantially. Claim construction proceedings have completed and fact discovery is set to close on March 20, 2024. *Provisur Tech., Inc. v. Weber Inc. et al.*, Case No. 5:21-cv-06113, Dkt. 355. By the date of an institution decision, close of expert discovery will be two

weeks away set on June 12, 2024 and dispositive motions will be exchanged two days later. *Id.*; Ex. 2003 (*Provisur Tech., Inc. v. Weber Inc. et al.*, Case No. 5:21-cv-06113, Dkt. 214). The advanced stage of the district court case and Judge Bough's publicly stated position that he intends to hold the parties to their scheduled trial date strongly suggests that no stay would be granted. Accordingly, this factor weighs heavily in favor of denial.

B. Factor 2 — The Court's Trial Date Predates Any Projected Final Written Decision By Six Months.

Fintiv factor 2, which considers the timing of the district court trial and projected date for a final written decision, weighs heavily in favor of denial. A final written decision is set to issue by the end of May 2025. This is more than **six months** after the district court's scheduled trial, which is set to start on November 18, 2024. Ex. 2003 (*Provisur Tech., Inc. v. Weber Inc. et al.*, Case No. 5:21-cv-06113, Dkt. 214) at 4. Because the district court's trial date is far earlier than the Board's projected statutory deadline for a final written decision, this factor weighs strongly in favor of denial. *Fintiv*, Paper 11 at 9.

Petitioner contends that based on the median time-to-trial statistics for the Western District of Missouri, trial would be around September 2025. Petition at 80. There are several issues with Petitioner's projection. The parallel litigation was filed on September 21, 2021. Using the median time-to-trial statistics offered by

Petitioner, trial would have *already occurred* back in November 2023 if properly calculated from the filing date of the case. Petitioner appears to be starting its calculation from the date Patent Owner introduced its counterclaims of infringement against Petitioner in August 2023. Petitioner provides no authority that supports using the counterclaim date as the starting point for the median-time-to-trial statistics. Under Petitioner's estimate, the trial schedule would have to be delayed *ten months* from the scheduled trial date. As noted above, there is strong evidence in the record indicating the district court will not delay the current schedule and intends to hold the parties to the current, mutually agreed-to schedule. *Supra*, Section III.A.

Under these circumstances, the “scheduled trial date is a better measure of the expected trial date than the median-time-to-trial statistic[.]” *Resmed Corp. v. Cleveland Med. Devices Inc.*, IPR2023-00565, Paper 13, at *11-12 (PTAB Sep. 25, 2023) (noting the Board “generally take[s] courts’ trial schedules at face value absent sufficient evidence to the contrary”). Petitioner has provided no evidence or argument at all that trial is likely to be postponed by ten months in contravention to the district court’s repeated directives. The parties mutually agreed to a November 2024 trial and there has been no change to the scheduled trial date since the Scheduling Order issued over four months ago. Therefore, like in *Resmed Corp.*, Petitioner has offered “no reason to believe that the scheduled trial date will be postponed” and this factor weighs heavily in favor of exercising discretion to deny

institution. *Resmed Corp.*, IPR2023-00565 at 12; *see also Duplo U.S.A. Corp. v. MGI Digital Tech., S.A.*, IPR2023-00936, Paper 8 at 16-17 (PTAB Dec. 5, 2023) (denying institution under *Fintiv* and finding this factor weighs “heavily in favor of discretionary denial” while refusing to credit statistics that would require parallel litigation to be delayed for over a year).

C. Factor 3 — The Parties And Court Have Already Invested Substantial Resources In The Parallel Proceeding.

Under this factor, the Board must consider the amount and type of work already completed in the parallel litigation by the court and the parties *at the time of the institution decision*. *Fintiv*, Paper 11 at 9. Both parties have invested significant time and money into the parallel proceeding and so has the District Court. Even more time and resources will be invested by the time the Board reaches its decision on institution. Fact discovery is set to close in twelve days in the parallel litigation. *Provisur Tech., Inc. v. Weber Inc. et al.*, Case No. 5:21-cv-06113, Dkt. 355. To date, the parties have served thousands of pages of infringement, non-infringement, validity, and invalidity contentions; responded to multiple rounds of discovery requests (including 35 interrogatory responses per side, hundreds of requests for productions, and numerous sets of requests for admission); produced millions of pages of documents; have briefed responsive motions to several amended pleadings, have inspected each side's accused products; and have or will have after the next

twelve days conducted over 30 fact depositions. Expert discovery opens on March 20 and the parties will be investing substantial resources into the same validity issues presented to the Board. Additionally, all disputed claim terms for all patents at issue have already been adjudicated.¹ By the time the Board reaches an institution decision, fact discovery will have long closed; the close of expert discovery will be quick to follow; the parties will be exchanging dispositive motions within two weeks; and pretrial work will be underway. *Id.*

The parallel litigation has been pending since September 2021 and is extremely advanced—far beyond the typical district court setting when the Board would decide institution. The late stage of this case, along with the volume of issues at play, has commensurately required an extreme expenditure of resources. Under these circumstances, this factor weighs heavily in favor of discretionary denial. *Duplo U.S.A. Corp.*, IPR2023-00936, Paper 8 at 17-18.

¹ “If, at the time of the institution decision, the district court has issued substantive orders related to the challenged patent, such as a claim construction order, this fact weighs in favor of denial.” *Nokia of Am. Corp. v. Good Kaisha IP Bridge 1*, IPR2022-00755, Paper 9 at 11 (PTAB Nov. 2, 2022) (citing *Fintiv*, Paper 11 at 9-10).

D. Factor 4 — Petitioner Fails To Offer A *Sotera* Stipulation And There Is Significant Overlap Between Issues Raises In The Petition And In The Parallel Litigation.

This factor evaluates “concerns of inefficiency and the possibility of conflicting decisions” when substantially similar prior art is submitted in the both the district court and IPR proceeding. *Fintiv*, Paper 11 at 12. These concerns are particularly troubling for Petitioner’s challenge.

Petitioner challenges the same claims in this IPR that it is challenging in the district court with the same prior art. All of the references used in Petitioner’s proposed grounds in its Petition have also been raised in its invalidity contentions at the district court. Ex. 2004 at 7. Though Petitioner notes the petition challenges seven claims not asserted in the parallel litigation, simply challenging additional claims does not preclude a finding of substantial overlap. *Resmed Corp.*, IPR2023-00565 at 14; *Next Caller Inc. v. TRUSTID, Inc.*, IPR2019-00961, Paper 10 at 14 (PTAB Oct. 16, 2019); *see also Fintiv*, Paper 11 at 13 (“[I]f a petition involves the same prior art challenges but challenges claims in addition to those that are challenged in the district court, it may still be inefficient to proceed because the district court may resolve validity of enough overlapping claims to resolve key issues in the petition[.]”).

Despite this substantial overlap, Petitioner chose not to offer a *Sotera*-type stipulation and instead stipulated that it “will not raise the same grounds from this

Petition in the district court.” Petition at 81. This narrow stipulation fails to diminish the overlap between the proceedings. It gives up only the precise grounds advanced in the petition, leaving open the invalidity defenses that rely on the same references in different ways. Referred to as a *Sand Revolution* stipulation, Petitioner’s agreement to give up only the specific grounds advanced in its petition does far less to mitigate *Fintiv* concerns than a *Sotera* stipulation. *See, e.g., April 21, 2023 Advanced Notice of Proposed Rulemaking* (Ex. 2005), 13 (“A *Sand Revolution* stipulation, in contrast [to a *Sotera* stipulation], does not necessarily prevent a petitioner from using a reference that was not raised, but reasonably could have been raised in an IPR, as part of an invalidity argument in district court” and, accordingly, “does not eliminate the concerns about overlapping issues and duplicative efforts[.]”).

Given the overlap in claims, prior art, and arguments between this IPR and the district court, and Petitioner’s refusal to proffer a *Sotera* stipulation weighs heavily in favor of denial.

E. Factor 5 — The Parties Are The Same.

The parties are the same in both proceedings. This weighs in favor of denial. *Resmed Corp.*, IPR2023-00565 at 15; *Duplo U.S.A. Corp.*, IPR2023-00936, Paper 8 at 19. Petitioner’s reliance on *Weatherford U.S. v. Enventure Global Tech., Inc.*, IPR2020-01684, Paper 16 at 11-13 (PTAB Apr. 14, 2021) to suggest this factor is

neutral when the parties are the same is misplaced. Binding authority dictates this factor weighs in favor of denial when the same parties are involved in this proceeding and the district court. *Sotera Wireless, Inc., V. Masimo Corp.*, IPR2020-01019, Paper 12, at 19 (PTAB Dec. 1, 2020) (citing *Fintiv*, Paper 15 at 15; *Sand Revolution*, Paper 24 at 12-13).

F. Factor 6 — Petitioner's Grounds Do Not Meet The Heightened "Compelling Merits" Standard.

Fintiv factors 1-5 plainly favor discretionary denial. Despite this, Petitioner refused to offer a *Sotera* stipulation—the procedural mechanism it could have used to avoid a *Fintiv* denial. To salvage its Petition, Petitioner must now show it has presented the Board with a compelling meritorious unpatentability challenge—a heightened standard that permits the PTAB to institute exceptionally strong invalidity challenges despite duplicating effort with the district court litigation. Petitioner has failed to meet this heightened burden.

To satisfy the heightened standard, Petitioner must present challenges “in which the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence.” *Commscope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23, 3 (PTAB Feb. 27, 2023) (precedential) (citing Guidance Memo at 4)). “[T]he compelling merits is a higher standard than the standard set for institution by statute.” *Commscope Techs.*,

IPR 2022-01242, Paper 23, 3 (citing Guidance Memo at 4-5). Under the compelling merits standard, “[a] challenge can only ‘plainly lead to a conclusion that one or more claims are unpatentable’ if it is highly likely that the petitioner would prevail with respect to at least one challenged claim.” *Id.* at 3-4 (quoting *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper 102, 49-50 (PTAB Oct. 4, 2022) (precedential)).

The compelling merits determination does not replace a *Fintiv* analysis. Rather, “PTAB panels...only consider compelling merits if they first determine[] that *Fintiv* factors 1-5 favor[] a discretionary denial.” *Commscope Techs.*, IPR 2022-01242, Paper 23, 4. Where the Board finds compelling merits, it “must provide reasoning to explain and support its determination as to compelling merits sufficient to allow the parties to challenge that finding and sufficient to allow for review of that decision.” *Id.* at 5-6.

Petitioner's challenge does not present a reasonable likelihood of success on the merits, let alone a “compelling” meritorious challenge. As set forth in Sections IV-VI below, each Proposed Ground suffers dispositive flaws. Ground 1 contends Young anticipates the claimed fat thickness measurements despite Petitioner acknowledging that Young's system is fat thickness agnostic. Ground 2 seeks to bolster Young's teachings with Norrie, but Petitioner fails to describe the combination with any specificity, leaving unanswered (1) what the combination is

and (2) how it would work. Additionally, Petitioner critically ignores that Young teaches away from Norrie. Ground 3 then proposes a combination of Johnson—a probe fat measurement system like the Applicant Admitted Prior Art the '321 Patent sought to improve—with Belk—a camera fat measurement system immaterially different than numerous other camera-based references considered during prosecution. Because it asks the Board to assess teachings cumulative to those considered during prosecution, the Board should exercise its discretion under §325(d) and decline to retread ground thoroughly covered during prosecution. Further, Petitioner uses the '321 Patent specification as a blueprint for its proposed rejection, which is unsurprisingly driven by hindsight bias.

In sum, there are substantial issues with Petitioner's analysis of the challenged claims such that the evidence does not plainly support Petitioner's position. Accordingly, this factor supports denial. *International Business Machines Corp. v. Digital Doors, Inc.*, IPR2023-00970, Paper 8, at 32 (PTAB Jan. 12, 2024) (denying institution under *Fintiv* and applying the precedential *CommScope* framework).

IV. GROUND 1 – YOUNG DOES NOT DETERMINE THE THICKNESS OF THE FAT COVER AS CLAIMED

Claim 1 of the '321 Patent recites a “measurement device for automatic determination of the **thickness of the fat cover**, wherein the **determination of the**

thickness of the fat cover takes place in a contactless manner” (Element 1A²). Ex. 1001 at 6:25-28. A “cutting device” is “coupled to measurement device for automatic separation of the fat cover from the flesh component **in dependence on the thickness** determined by the measurement device” (Element 1B). *Id.* at 6:29-32. This cutting device is controlled by a “control unit for control of the position of the cutting blade **in dependence on the thickness** determined by the measurement device...” (Element 1D). *Id.* at 6:36-38; *see also* Petition at 10 (identifying commensurate limitations in independent claim 14 which fails for the same reasons herein). The claims on their face openly require the thickness of the fat cover to be determined. Despite this, Petitioner advances an anticipation ground using Young—a reference that does not measure the thickness of the fat cover and that is expressly agnostic as to the thickness of fat on a meat product. This deficiency is fatal to Petitioner’s challenge.

Petitioner relies on Young’s “imaging system 190” as the claimed “measurement device for automatic determination of the thickness of the fat cover.” Petition at 30. Petitioner asserts that this measurement device, through several cameras including “fat line camera 198,” determines a “backbone line and a fat/lean separation line on the side of meat.” Petition at 30-31, 35 (stating camera 198 is

² For consistency, Patent Owner adopts Petitioner’s element references.

“primarily used to provide dynamic (real-time) image data of the fat/lean separation line for the pork side proximate the backbone”). According to Petitioner, “[c]ontroller 172 uses this information to dynamically modify the cutting profile of loin knife assembly 100 so that the assembly follows a fixed distance from the separation line to provide the optimum fat cover for the loin.” Petition at 35 (citing Ex. 1004 at 18:36-40), 38-39 (same).

Fatal to Petitioner's challenge, Young *does not* determine the thickness of the fat cover. Nor does Young need to. Young's system simply identifies the line between the fat cover and the lean meat (fat/lean separation line) and follows this line during cutting. Young's system never measures, for example, a three inch fat cover and based on this measurement and settings in the controller, sets its blade up three inches to cut away this fat cover. Instead, it measures the precise line between the lean meat and the fat, dynamically tracks this line, and cuts a fixed distance from this line to “provide the optimum fat cover for the meat product.” Ex. 1004 at 18:32-46. In other words, Young is agnostic to the thickness of the fat, and will separate at the junction point between the tissues regardless of the fat thickness.

While Petitioner advances that Young describes measuring other parameters of the meat product generally (e.g., its height, length, and width), Young says nothing about measuring the fat cover specifically. *See* Ex. 1004 at 18:17-23 (camera 197 used to “determine the height of the pork side and the positioning of the ‘T’-

shaped bone of the pork side), 24:10-22 (“In block 258, the height, width and length of the pork side is calculated...”), 24:34-36 (“In block 258, it may also be preferable to calculate a separate height for the ribs in addition to the height of the backbone”). Notably absent is any disclosure of the height, length, width, or any other dimensions for the fat cover. And again, that makes sense because Young’s system cuts along a specific junction line (fat/lean separation line) regardless of fat cover thickness.

Because Young is agnostic to fat thickness, it cannot “plainly teach” the fat thickness measurements requisite in elements 1A, B, and D, and this ground falls far short of a compelling meritorious ground required for institution here. *Zhuhai Cosmx Battery Co., Ltd. v. Ningde Amperex Tech. Ltd.*, IPR2023-00587, Paper 12 at 20 (Sep. 22, 2023) (denying institution under compelling merits standard where petition’s assumption of “porous layer thickness” was “not plainly supported by the record for the purposes of an anticipation challenge”).

V. GROUND 2 – PETITIONER FAILED TO SATISFY ITS BURDEN TO EXPLAIN WITH PARTICULARITY ITS COMBINATION OF YOUNG WITH NORRIE

Acknowledging the shortcomings of Ground 1, Petitioner proposes a combination of Young with Norrie in Ground 2 should Young “not disclose determining the ‘thickness’ of a fat cover, as claimed[.]” Petition at 51. Fatal to this alternative theory, Petitioner has failed to carry its burden to describe with any supporting detail what the combination of Young and Norrie is or how it would

work. *Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir. 2017) (holding obviousness determination to be improper where the record lacked a “clear, evidence-supported account” of “how the combination” would work).

“To satisfy its burden of proving obviousness, a petitioner cannot employ mere conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016). Focusing on purported benefits—even though inapposite, *infra*, Section V.A—without explaining how the combination would work in the first place cannot satisfy this burden. *The Walt Disney Co., et al. v. WAG Acquisition, L.L.C.*, IPR2022-01346, Paper 12 at 24-26 (PTAB Mar. 10, 2023) (denying institution where a petitioner did not “set forth sufficient details on what aspects from [secondary] would be combined with [primary] and how such aspects would work together”). In *Walt Disney Co.*, the Board faulted Petitioner for failing to state whether the secondary reference was “meant to supplant” functionality in the primary entirely or “whether the two systems are mean to coexist in some fashion.” *Id.* at 25. The Petition here shares these same faults.

Petitioner dedicates a total of two-and-a-half pages of analysis to Ground 2. From the backdrop of this sparse record, Petitioner proposes that: (1) Norrie discloses “sensing the thickness of back fat” on a loin using a camera and light source

54; (2) Young mentions Norrie in its background and notes Norrie's advantages over old manual fat measurement systems; (3) Young generally describes that its design can be modified; and (4) therefore it would have been obvious "to apply the determination of thickness by the camera and controller taught in Norrie in the context of Young's camera." Petition at 51-54. What Petitioner does not propose is *how* Young is modified by Norrie. For instance, does Norrie's camera and light source replace the three-camera imaging system in Young? Or does Norrie's camera system somehow work together with Young's already-present imaging system? Petitioner's limited analysis fails to answer those fundamental questions.

Conclusory statements cannot replace reasoned evidentiary support. *See* Petition at 53 ("[a] POSA would have been able to apply the determination of thickness by the camera and controller taught in Norrie in the context of Young's camera"), *id.* (the "combination would only require routine modifications, like changing the cameras and connecting the components"). And Petitioner's expert, Dr. Collins, does not bridge the gap. Dr. Collins provides two short "example[s]" for how this combination "could" work:

As an example a POSA could modify Young's controller 172's processing to determine thickness as in Norrie's computer 64. This would be a routine software modification within the level of skill of a POSA. As another example, a POSA could implement Norrie's camera 54 and computer 64 into Young's apparatus as routine change of components. This would be a routine modification and

only involve a change of components and a connection of the new components to the apparatus.

Ex. 1003 at ¶177. But the same basic questions remain: What in Norrie is modifying controller 172's processing? How is this processing being modified? And how does Young's system work if Norrie's camera supplants Young's imaging system? Without answering these basic questions, Petitioner leaves Patent Owner and the Board guessing as to what its combination is. Petitioner cannot satisfy its burden, particularly its heightened burden to show compelling merits, with these conclusory allegations.

A. Young Teaches Away From Petitioner's Proposed Modification With Norrie.

Apart from Petitioner's failure to explain its combination, Petitioner also mischaracterizes Young's disclosures and overlooks that Young teaches away from general modification it proposes with Norrie. The premise of Petitioner's motivation to modify Young with Norrie is that Young purportedly expressly motivates the combination. Petition at 52-53 (stating that "Young explicitly points to...Norrie" as 'an automated loin separation system' that addresses 'the problems associated with manual loin separation processes'" and that Young states its system can be modified), 53 (exclaiming that "Young could not have been clearer that it could be combined with the teachings of Norrie"). On the contrary, Young teaches away from this combination.

Young does indeed cite Norrie in its background in a list of references that “address the problems associated with manual loin separation processes.” Ex. 1004 at 2:18-42. Replacing a human with automation, per Young, results “in more efficiency and more repeatable results.” *Id.* Young then disparages these old automated systems as they are “limited in the degree of control they provide over the loin knife and scribe saw” (e.g., in one or two axes of motion) and cannot separate loins from bellies “at the optimum points of separation, often resulting in unacceptable waste product and lower yields.” *Id.*

In Young, controller 172 uses information from its three cameras to “dynamically modify the cutting profile of the join knife assembly 100 so that the assembly follows a fixed distance from the separation line to provide the optimum fat cover for the meat product.” Ex. 1004 at 17:55-59, 18:33-30. As stated above, Petitioner proposes either modifying Young’s controller 172 to implement Norrie’s thickness calculation, or replacing Young’s imaging system with Norrie’s entirely. *Supra*, Section V. However, Norrie discloses a much cruder imaging system that implements a single camera and lamp 54 under the food article that can “observe the thickness of fat on the underside of the loin lying on the conveyor.” Ex. 1005 at 4:23-53. In response to that observation, Norrie will send “fat signals” to the computer that can adjust the position of the blade in between intervals of different loins. *Id.* (noting if the fat portion is thicker, the camera 54 will sense this and move the blade

upward and the reverse if thinner). In other words, Norrie uses a single camera to identify fat at the bottom of the meat and presets a height of a blade in between meat articles to cut away that fat. *Id.*

Implementing Norrie's basic imaging functionalities in Young would render Young incapable of following a fat/lean separation line and would fail to provide the "optimum" separation central to Young's disclosures. By either modifying the controller to operate from an initial fat thickness measurement or by supplanting Young's imaging system with Norrie's, Young's system would create the same waste and inefficiencies expressly disparaged by Young and by which Young's disclosures sought to correct. Indeed, Young dynamically controls cutting "along several axes" to "produce[] an optimum separation between loin and belly, with a desired fat covering left on the loin." Ex. 1004 at 10:40-43. Using simple imaging and a preset blade position would render the dynamic, multiple axes movability in Young's system superfluous and deoptimize Young's separation techniques, motivating *against* the combination.

VI. GROUND 3 – JOHNSON AND BELK ARE CUMULATIVE OF PRIOR ART PREVIOUSLY CONSIDERED BY THE OFFICE AND THE PROPOSED COMBINATION IS GROUNDED IN HINDSIGHT

A. The Board Should Exercise Its Discretion To Deny Institution Under 35 U.S.C. § 325(d)

The Board has discretion to deny institution of a petition when "the same or substantively the same prior art or arguments previously were presented to the

Office.” 35 U.S.C. § 325(d). The Board uses a two-part framework: first determining whether the same or substantially the same art or arguments were previously presented to the Office, and, if so, next assessing whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential) (“*Advanced Bionics*”).

In applying this framework, the Board considers several factors: (a) the similarities between the asserted art and the art previously considered; (b) the cumulative nature of the asserted art and the art previously considered; (c) the extent to which the asserted art was evaluated during examination; (d) the extent of the overlap between the arguments made during examination and the Petitioner’s arguments; (e) whether Petitioner has pointed out how the Examiner erred during examination; (f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments. *See Becton, Dickinson and Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, 17–18 (PTAB Dec. 15, 2017) (“*Becton Dickinson*”).

Becton Dickinson factors (a), (b), and (d) relate to whether the art or arguments presented in the Petition are the same or substantially the same as those previously presented to the Office, and factors (c), (e), and (f) “relate to whether the

petitioner has demonstrated a material error by the Office” in its prior consideration of that art or arguments. *Advanced Bionics*, Paper 6 at 10. “At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Id.* at 9.

1. Petitioner Presents The Same Or Substantially The Same Art/Arguments

Ground 3 proposes modifying Johnson's probe-based fat measurement system with Belk's contactless camera-based fat measurement system. Johnson's probe-based fat measurement system is nothing more than the applicant admitted prior art (AAPA) the '321 Patent acknowledges and criticizes:

Known measurement devices provide a sensor for the determination of the thickness of a fat cover of a meat product which is ***inserted into the product*** and detects the environmental brightness during the insertion. A conclusion can be drawn on the consistency of the material pierced by the sensor or at least a change in the consistency can be detected by an evaluation of the different brightness values occurring during the insertion and detected by the sensor, ***from which ultimately the thickness of a fat cover can be determined.***

It is disadvantageous in this connection that the meat product is damaged by the insertion of the sensor, in particular since the sensor has to be inserted at multiple sites of the product for a reliable determination of the thickness of the fat cover or a plurality of sensors arranged in a distributed manner have to be inserted into the product simultaneously.

Ex.1001 at 1:21-36. And Belk's camera-based measurement system is immaterially different than numerous camera-based fat measurement techniques considered by the Examiner during prosecution. *See, e.g.*, WO 2006/136814 to Burton (Ex. 1002 at 86, 90, 138, 175-219), WO 2004/106020 to Grundtvig (Ex. 1002 at 86, 90, 223-240), and GB 2,364,894 to Kim (Ex. 1002 at 241-276).

Here, Petitioner seems to be following the basic blueprint the '321 Patent describes in its background of the invention at the start of its disclosures. In so doing, Petitioner asks the Board to modify Johnson, which is effectively the probe-based applicant admitted prior art discussed in the specification, with Belk's contactless measurement system cumulative of the contactless measurement systems already before the Office. This offers nothing "new" for the Board to consider beyond what was already considered during prosecution. Accordingly, the first *Advanced Bionics* factor is satisfied, and Petitioner can avoid a discretionary denial only by showing material error by the Examiner. *Advanced Bionics* at 8-9.

2. *Petitioner Has Not Alleged And Cannot Allege Material Error*

Dispositive of the material error analysis, the proposed combination fails to cure the deficiencies common to the other Grounds—Johnson and Belk do not adjust a cutting blade based on a travel profile selected in dependence on fat thickness measurements. Like Young, Johnson follows a "fat/lean interface" to cut away portions of fat from a meat product. *Compare* Petition at 34-35 (describing cutting

based on Young's "fat/lean separation line") *with* Petition at 55 (chart mapping "Fat/lean interface" to the claimed "travel profile), 57-59 (citing Johnson, Ex. 1006, at 5:20-26 describing using blade following "the contour of the lean to fat interface" for cutting); *see also* Ex. 1006 at 9:25-27 ("cut dictated by the fat/lean interface map"), claim 6 (claiming adjusting position of blade responsive to signals identifying fat to lean interface). Therefore, like Young, Johnson's fat removal is agnostic as to the thickness of the fat, but rather follows a specific interface or map for the cut and thus fails for the same reasons as Young.

B. Petitioner Cannot Use The '321 Patent As A Blueprint To Motivate The Combination.

Finally, any motivation to modify Johnson pursuant to Belk is grounded in impermissible hindsight. The Courts and PTAB have a long pedigree of rejecting a combination infected with hindsight. These rejections hold particular weight when a petitioner relies on the challenged patent itself as a roadmap for its proposed invalidity theories. *See Grain Processing Corp. v. Am.-Maize Prods. Co.*, 840 F.2d 902, 907 (Fed. Cir. 1988) (quoting *Orthopedic Equip. Co. v. United States*, 702 F.2d 1005, 1012 (Fed. Cir. 1983) ("Care must be taken to avoid hindsight reconstruction by using 'the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.'"); *Cf. Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004)

(“This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result — often the very definition of invention”); *see also KSR*, 550 U.S. at 421 (“A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning”). Relying on the very same probe-based prior art already disclosed in (and disparaged by) the specification of the '321 Patent in combination with optical-based fat measurements described by the '321 Patent therefore uses the precise blueprint of the '321 Patent to form Petitioner's rejection. This is the epitome of hindsight and must be rejected.

VII. CONCLUSION

For the foregoing reasons, the Board should deny institution, allowing the District Court to adjudicate issues it is well-familiar with and that it will resolve long before the projected final written decision here.

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APPENDIX OF EXHIBITS

Exhibit 2001	Provisur Tech., Inc. v. Weber Inc. et al., Case No. 5:21-cv-06113, Dkt. 166, Transcript of Scheduling & Discovery Dispute Hearing, June 20, 2023
Exhibit 2002	Provisur Tech., Inc. v. Weber Inc. et al., Case No. 5:21-cv-06113, Dkt. 216, Transcript of Scheduling Hearing, September 5, 2023
Exhibit 2003	Provisur Tech., Inc. v. Weber Inc. et al., Case No. 5:21-cv-06113, Dkt. 214, Supplemental Scheduling Order, September 5, 2023
Exhibit 2004	Provisur Tech., Inc. v. Weber Inc. et al., Case No. 5:21-cv-06113, Provisur Invalidity Contention Cover Pleading
Exhibit 2005	Advanced Notice of Proposed Rulemaking 13 ("A Sand Revolution stipulation, April 21, 2023

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 7,113 words according to the word-processing program used to prepare this document (Microsoft Word).

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR INTER PARTES REVIEW was served on March 8, 2024, by email on the following counsel of record for Petitioner:

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