IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF MISSOURI
ST. JOSEPH DIVISION

PROVISUR TECHNOLOGIES, INC., *Plaintiff,* v. WEBER, INC., *et al*., *Defendants,* and WEBER, INC., *et al*., *Counter-Plaintiffs*, v. PROVISUR TECHNOLOGIES, INC. *Counter-Defendant.*	Civil Action No. 5:21-cv-06113 Hon. Judge Bough **JURY TRIAL DEMANDED**

PROVISUR TECHNOLOGIES, INC.'S DISCLOSURE OF INVALIDITY CONTENTIONS AGAINST WEBER COUNTERCLAIM PATENTS PURSUANT TO PATENT LOCAL RULE 3.3

IPR2024-00235
Weber EX2004 Page 1

Table of Contents

I. PRELIMINARY STATEMENTS AND RESERVATIONS 3
A. Asserted Claims 3
B. Reservation of Rights 3
C. Discovery is Ongoing 3
D. Claim Construction 4
E. Priority Date 5
F. Priority Art Identification 5
II. IDENTIFICATION OF PRIOR ART 6
A. Prior Art Patent Applications and Patents 7
G. Prior Art Publications 7
H. Prior Art Public Uses/Sales/Offers for Sales Under § 102(f) 8
III. IDENTIFICATION OF EXEMPLARY ANTICIPATION AND OBVIOUSNESS ARGUMENTS 10
IV. INVALIDITY CLAIM CHARTS 11
V. INVALIDITY BASED ON 35 U.S.C. § 112 13
VI. INVALIDITY AS UNPATENTBALE ABSTRACT IDEA UNDER 35 U.S.C. § 102 14
VII. DOCUMENT PRODUCTION 14

Pursuant to Patent Local Rule 3.3, the Supplemental Scheduling Order (Dkt. 214), and the rules and orders of this Court, Provisur submits the following initial Invalidity Contentions against the Weber counterclaim patents, U.S. Patent Nos. 8,529,321; 9,457,487; 10,647,013; 11,331,823. These Invalidity Contentions include invalidity claim charts, attached as Exhibits A-1 through D-4.

I. PRELIMINARY STATEMENTS AND RESERVATIONS

A. Asserted Claims

Weber asserts against Provisur in this case claims 1, 2, 3, 4, 5, 6, 10, 13, 16, of U.S. Patent No. 8,529,321; claims 1, 3, 4, 6, 7, 9, 10, 14, 16, 18, 21, 22 of U.S. Patent No. 9,457,487; claims 1, 2, 3, 16, 18, 20 of U.S. Patent No 10,647,013; claims 1, 2, 4, 5, 7, 8, 10, 12, 18, of U.S. Patent No 11,331,823 (collectively, the "Asserted Claims"). These Contentions are expressly limited to these Asserted Claims.

B. Reservation of Rights

These Contentions are subject to supplementation and/or amendment as provided in the Local Rules, the Federal Rules of Civil Procedure, and/or any Order of this Court. These Contentions are based on Provisur's current knowledge, understanding, and belief as to the facts and information available at this time. Provisur has not yet completed their investigation, collection of information, discovery, or analysis relating to this action, non-infringement, and/or invalidity. In particular, Provisur just answered the counterclaim days ago on October 27, 2023. Provisur fully reserve the right to so amend these contentions in accord with Patent L.R. 3.5.

C. Discovery is Ongoing

For example, Provisur has not had the opportunity to take the depositions of the named inventors of the Asserted Patents and/or other persons having potentially relevant information.

Provisur is in the process of investigating prior art from individuals believed to have knowledge or information relating to invalidity or prior art, including third parties. Provisur also continues to investigate the operation of the Accused Products. It is likely that Provisur will hereafter discover additional prior art or information pertinent to the Asserted Claims of the Asserted Patents, and Provisur reserves the right to seek to amend and/or supplement these contentions within a reasonable time after becoming aware of additional information.

D. Claim Construction

The Court has also not yet construed any terms of the Asserted Claims, and Weber has not yet disclosed its positions on any claim constructions. Provisur thus also reserves the right to supplement and/or amend these contentions after the Court has construed disputed claim terms, in accordance with Patent Local Rule 3.5(a). Provisur's Contentions concerning the invalidity of the Asserted Claims of the Asserted Patents may change based upon the Court's construction of the claims or upon positions that the Parties may take leading up to and after such construction. The analysis provided in these Contentions in some instances uses Weber proposed (or implied) claim constructions, which Provisur do not believe will be sustained by the Court. Moreover, the deficiencies of Weber's Infringement Contentions have impeded Provisur's ability to understand how Weber is construing the Asserted Claims and applying those constructions. These Invalidity Contentions are not, and should not be interpreted as, adoptions or admissions as to the accuracy of such scope or construction.

Nothing contained in these Contentions should be understood or deemed to be an express or implied admission or contention with respect to the proper construction or scope of any terms in the Asserted Claims, nor should they be understood to endorse Weber's stated claim construction or its proposed scope of the Asserted Claims, to the extent discernible.

E. Priority Date

Weber has not shown that it is entitled to the benefit of the priority date of any earlier filed applications. Moreover, Provisur understands Weber does not allege any earlier date for conception, reduction to practice, design, or development of the inventions claimed in each Asserted Patent, insofar as Weber produced no documents sufficiently evidencing any such earlier date in its Patent L.R. 3.2(b) disclosures.

Provisur reserves the right to challenge any assertion of an earlier date for conception, reduction to practice, design, or development of the inventions claimed in each Asserted Patent. Provisur further reserves the right to challenge any assertion that an Asserted Claim may seek the benefit of an earlier-filed provisional application. Provisur may seek discovery to establish conception and reduction-to practice dates, as appropriate, to demonstrate the earlier invention by other parties under 35 U.S.C. § 102(g). Provisur may therefore seek discovery on the issues of improper inventorship and/or derivation under 35 U.S.C. § 102(f), public use and/or the on-sale bar under 35 U.S.C. § 102(b), and/or applicants' failure to comply with 35 U.S.C. § 112.

F. Prior Art Identification

Provisur identifies specific portions of prior art references that disclose limitations of the Asserted Claims, pursuant to Patent L.R. 3.3 and 3.4. However, each and every element disclosed in a reference that corresponds to a limitation is not necessarily specified. In an effort to focus the issues, Provisur has specified only exemplary portions of cited references. Persons of ordinary skill in the art generally read a prior art reference as a whole and in the context of other publications and literature and in light of the knowledge of one of ordinary skill in the art. To understand and interpret any specific statement or disclosure within a prior art reference, such

persons would rely on other information within the reference, along with other publications and their scientific or engineering knowledge.

Provisur consequently reserves the right to rely upon other unspecified portions of the prior art references and on other publications and expert testimony as to the knowledge of a person of ordinary skill to provide context, and as aids to understanding and interpreting the portions that are identified. Provisur also reserves the right to rely on other portions of the prior art references, other publications, and the testimony of experts to establish that a person of ordinary skill in the art would have been motivated to modify or combine certain of the cited references so as to render the claims obvious.

II. IDENTIFICATION OF PRIOR ART

Provisur identifies below each item of prior art that allegedly anticipates, renders obvious, or evidences the invalidity of each Asserted Claim. Provisur also intends to rely on the prior art below as illustrative of the background knowledge and common sense of those of ordinary skill in the art around the alleged time of invention. In addition, Provisur intends to rely on the file histories related to this prior art, as well as all prior art cited or disclosed in the file histories of the ’321; ’487; ’103; and ’823 patents and related patents and applications.

The documents bearing the production numbers PR01923908-PR01926753; PR01926812-PR01926852 include patents and printed publications, photos, and videos that are pertinent to the invalidity of the Asserted Claims of the Asserted Patent. Exhibits A1-D4 contain charts for all of the prior art identified in this section, which set forth examples of where each of the elements of the Asserted Claims of the patent is found in the prior art. Provisur reserves the right to revise these Invalidity Contentions or to reflect the state and scope of the art at the time

of the filing of the Asserted Patent in a manner consistent with the Federal Rules of Civil Procedure and the Court's Rules.

A. Prior Art Patent Applications and Patents

Provisur hereby identifies the following prior art patent applications and patents that anticipate or render obvious the Asserted Claims of the Asserted Patents under 35 U.S.C. §§ 102(a), (b), and/or (e) and/or 35 U.S.C. § 103:

U.S. PATENT NO.	INVENTOR	FILING DATE
11,014,258 2019/0329438 EP 3 558 854 WO 2018/115178	Bader et al.	December 20, 2017
2016/0023370	Muller	March 20, 2014
2009/0159631	DePoi et al.	December 24, 2007
5,697,573	Fukuchi et al.	January 25, 1996
10,106,356	Krohnert	October 6. 2009
4,253,597	Waffner	July 9, 1979
2015/0135652	Pryor et al.	January 26, 2015
9,399,531	Pryor et al.	October 25, 2006
2,921,753	Lahti et al.	May 17, 1954
8,549,966	Hansen et al.	October 21, 2008
9,296,120	McLaughlin et al.	March 29, 2016
6,929,540	Johnson et al.	May 14, 2004
7,285,040	Ilch et al.	April 5, 2004
6,198,834	Belk et al.	March 6, 2001
4,423,671	Murphy	May 5, 1983
4979269	Norrie	August 3, 1989
2003/0036344	Sigurdsson et al.	October 16, 2002
JPH 06 117905	Konishi et al.	February 12, 1993
WO 03/065786	Lindee	February 5, 2003
5,514,032	Young et al.	February 17, 1995
6,129,625	Cate et al.	August 28, 1999

G. Prior Art Publications

Provisur contends that the following publications anticipate and/or render obvious one or more Asserted Claims of the Asserted Patent under pre-AIA 35 U.S.C. §§ 102(a) and/or (b) and/or 35 U.S.C. § 103. To the extent any of the identified publications also disclose how the

prior art systems identified below in Section III. (C) operated and functioned, Provisur intends to also rely on the following publications as independent and distinct prior art references and does not rely on these publications solely as disclosing how those prior art systems operated and functioned:

Prior Art Publication	Publication Date	Bates
Cognex In-Sight Press Release	January 30, 2001	PR01925279

H. Prior Art Public Uses/Sales/Offers for Sales Under § 102(f)

Provisur contends that the following prior art anticipate and/or render obvious one or more Asserted Claims of the Asserted Patent under pre-AIA 35 U.S.C. §§ 102(a) and/or (b) and/or 35 U.S.C. § 103. To the extent any of the identified publications also disclose how the prior art systems identified below in Section III. (C) operated and functioned, Provisur intends to also rely on the following publications as independent and distinct prior art references and does not rely on these publications solely as disclosing how those prior art systems operated and functioned:

Product or System Name	Description
Weber CCI Interleavers	Based on information and belief, the Weber CCI Interleavers qualify as prior art under at least 35 U.S.C. § 102(a)(1) because it was in public use, on sale, or otherwise available to the public at least by the July 3, 2017 earliest possible effective filing date of the ’013 patent and ’823 patent. Based on information and belief, Weber used the Weber CCI Interleavers, offered the Weber CCI Interleavers, and otherwise made available the Weber CCI Interleavers at least by the July 3, 2017. For example, on information and belief, Weber sold and/or offered hundreds of Weber Interleavers between February 7, 2002 and June 9, 2011. WEBER3-0739778. For further example, Weber sold and/or offered a Weber Interleaver to Sargento Foods as part of Line 906-3105 on or around March 10, 2015. WEBER-0079932. *See* also, WEBER-0005689

Product or System Name	Description
	(Betriebsanleitung Interleaver CCI 303); WEBER-0000465 (Operating Manual Interleaver CCI 904-906)
PowerMax Products	The Prior Art PowerMax Products qualify as prior art under at least 35 U.S.C. §§ 102(a) and 102(b) because it was known or used by others, offered for sale, or sold at least by the December 2, 2012, earliest priority date of the '487 patent. The PowerMax Products were sold or offered for sale at least by Jul 28, 2008. For example, the PowerMax4000 was first on public display on October 24, 2007. The PowerMax4000 was first sold on July 28, 2008. PR00004856. For further example, the PowerMax3000 was known by others or in public use or on sale by the earliest priority date of the '487 Patent. WEBER3-0327620, WEBER3-0327621. *See also* PR00363646 *et seq.* (PowerMax 3000 Manual), PR00364862 *et seq.* (PowerMax 4000 Manual)
Gigaslicer Machine	Based on information and belief, the Gigaslicer Slicing Machine was known or used by others, offered for sale, or sold at least as early as August 2010 in the U.S. to one or more distributors, customers or potential customers, including customers or potential customers obtained through distributors. The Gigaslicer Slicing Machine is thus prior art under at least 35 U.S.C. §§ 102(b), 102(a) (pre-AIA). *See*, WEBER3-0098967; WEBER3-0329732; WEBER3-0339830
Provisur Slicers	Based on information and belief, the FX180/S-180/FXPlus/Powermax Machines were known or used by others, offered for sale, or sold at least as early as December 3, 2012 in the U.S. to one or more distributors, customers or potential customers, including customers or potential customers obtained through distributors. The FX180/S-180/FXPlus/Powermax Machines are thus prior art under at least 35 U.S.C. §§ 102(b), 102(a) (pre-AIA). PR00245101 *et seq.* (FX180 Manual)
Imaging Devices	Based on information and belief, the Cognex In-sight was known or used by others, offered for sale, or sold at least as early 2000 in the U.S. to one or more distributors, customers or potential customers, including customers or potential customers obtained through distributors. Cognex In-sight is thus prior art under at least 35 U.S.C. §§ 102(b), 102(a) (pre-AIA). *See*, WEBER-0005121; WEBER-0966603.

III. IDENTIFICATION OF EXEMPLARY ANTICIPATION AND OBVIOUSNESS ARGUMENTS

Provisur contends that at least claims 1, 3, 4, 6, 7, 9, 10, 14, 16, 18, 21, 22 of U.S. Patent No. 9,457,487 are anticipated under 35 U.S.C. § 102 by at least the following prior art: "PowerMax Product." Provisur contends that at least claims 1, 2, 4, 5, 7, 8, 10, 12, 18 of U.S. Patent No. 11,331,823 are anticipated under 35 U.S.C. § 102 by at least the following prior art: "The Bader Interleaver."

Provisur further contend that at least each Asserted Claim would have been obvious to one of ordinary skill in the art at the time of the alleged invention under 35 U.S.C. § 103. *See KSR Int'l v. Teleflex, Inc.*, 550 U.S. 398 (2007); *Randall Mfg. v. Rea*, 733 F.3d 1355 (Fed. Cir. 2013). Provisur contends that one of ordinary skill would have been motivated to combine the references disclosed herein in such a way as to render obvious the alleged inventions. Each of the references disclosed herein were directed at the same or similar field of technology and the same or similar problem as the Asserted Patents. The teaching, suggestion, or motivation to combine these references may be found, explicitly or implicitly, and as discussed in more detail below and in the accompanying invalidity claim charts, in one or more of the following:

(1) the combination results from a simple substitution of one known element for another to obtain predictable results;

(2) the combination results from the use of known techniques to improve similar methods in the same way;

(3) the combination results from applying a known technique to a known method ready for improvement to yield predictable results;

(4) the combination results from choosing a finite number of identified, predictable solutions, with a reasonable expectation of success, and therefore is obvious to try;

(5) the combination results from known work in one field of endeavor prompting a variation of it for use in either the same field or a different

one based on design incentives or other market forces and the variations would have been predictable to one of ordinary skill in the art; or

(6) the combination results from using known techniques or solutions to address a problem addressed by the invention or a problem that would be encountered by one of ordinary skill in the art working in that field.

Provisur also intends to rely on the background knowledge and common sense of those of ordinary skill in the art at the alleged time of invention to show invalidity.

Specific claim limitations with references that render the alleged claims obvious are identified in the accompanying invalidity claim charts. For the references identified in Provisur's claim charts, if any particular claim limitation is alleged to not be disclosed or inherent in those references, then Provisur's position is that it would have been obvious to combine the charted reference with one or more of the references identified in the charts for the particular claim limitations.

IV. INVALIDITY CLAIM CHARTS

Provisur identifies below representative prior art that renders invalid one or more of the Asserted Claims and include accompanying claim charts that identify specific examples in each item of prior art where each element of each Asserted Claim is found, attached as **Exhibits A-1 through D-4**:

Exhibit A-1: U.S. Patent No. 9,457,487 is anticipated and/or rendered obvious by the PowerMax Products as shown in exhibit A-1;

Exhibit A-2: U.S. Patent No. 9,457,487 is rendered obvious by the Provisur Slicers as shown in exhibit A-2;

Exhibit A-3: U.S. Patent No. 9,457,487 is rendered obvious by the Gigaslicer Machine in view of JPH 06 117905 to Konishi et al. (Konishi) as shown in exhibit A-3;

Exhibit B-1: U.S. Patent No. 8,529,321 is rendered obvious by U.S. Patent Application US2003/ 0036344 to Sigurdsson (Sigurdsson) in view of "Imaging Devices," in further view of U.S. Patent No. 6,129,625 to Cate et al. (Cate) as shown in exhibit B-1;

Exhibit B-2: U.S. Patent No. 8,529,321 is rendered obvious by the U.S. Patent No. 7,285,040 to Belk et al. (Belk) in view of "Imaging Devices," in further view of U.S. Patent No. 6,129,625 to Cate et al. (Cate) as shown in exhibit B-2;

Exhibit B-3: U.S. Patent No. 8,529,321 is rendered obvious by the U.S. Patent No. 5,514,032 to Young et al. (Young), in view of "Imaging Devices," in further view of U.S. Patent No. 4,979,269 to Norrie (Norrie) as shown in exhibit B-3;

Exhibit B-4: U.S. Patent No. 8,529,321 is rendered obvious by U.S. Patent No. 6,929,540 Johnson et al. (Johnson), in view of U.S. Patent No. 7,285,040 to Belk et al. (Belk), in further view of "Imaging Devices," as shown in exhibit B-4;

Exhibit C-1: U.S. Patent No. 10,647,013 is rendered obvious by the "Bader Interleaver" in view of "Pressure Sensors" as shown in exhibit C-1;

Exhibit C-2: U.S. Patent No. 10,647,013 is rendered obvious by the Weber CCI Interleavers in view of "Pressure Sensors" as shown in exhibit C-2;

Exhibit C-3: U.S. Patent No. 10,647,013 is rendered obvious by U.S. Patent Application US2015/ 0135652 to Pryor et al. (Pryor 652) in view of "Pressure Sensors" as shown in exhibit C-3;

Exhibit C-4: U.S. Patent No. 10,647,013 is rendered obvious by U.S. Patent No. 9,399,531 (Pryor 531) in view of "Pressure Sensors" as shown in exhibit C-4;

Exhibit D-1: U.S. Patent No. 11,331,823 is anticipated by the Bader Interleaver as shown in exhibit D-1;

Exhibit D-2: U.S. Patent No. 11,331,823 is rendered obvious by the Weber CCI Interleavers in view of "Vacuum Brakes" as shown in exhibit D-2;

Exhibit D-3: U.S. Patent No. 11,331,823 is rendered obvious by U.S. Patent Application US2015/ 0135652 to Pryor et al. (Pryor) in view of "Vacuum Brakes" as shown in exhibit D-3;

Exhibit D-4: U.S. Patent No. 11,331,823 is rendered obvious by U.S. Patent No. 9,399,531 (Provisur) in view of "Vacuum Brakes" as shown in exhibit D-3

V. INVALIDITY BASED ON 35 U.S.C. § 112

In the alternative, Provisur contends that the Asserted Claims are invalid for failure to comply with the definiteness requirements of 35 U.S.C. § 112, ¶ 2 and the enablement and written description requirements of 35 U.S.C. § 112, ¶ 1 to the extent that Weber contends or attempts to show that the accused products meet each and every claim limitation.

Weber has not yet provided its position on claim construction for any of the Asserted Claims. Provisur therefore, cannot provide a complete list of 35 U.S.C. § 112 defenses because Provisur does not know whether Weber will proffer a construction for certain terms and phrases that is broader than, or inconsistent with, the construction that would be supportable by the disclosure set forth in the specification. Provisur offers these contentions without prejudice to any position it may ultimately take as to any claim construction issues. Accordingly, Provisur reserves the right to supplement, amend, and/or modify these 35 U.S.C. § 112 Contentions, including potential invalidity contentions under pre-AIA 35 U.S.C. § 112, ¶6, as discovery progresses and consistent with L.R. 3.5.One or more Asserted Claims are invalid under § 112 for failing to particularly point out and distinctly claim the subject matter that the patentee regards as its alleged invention such that one of ordinary skill in the relevant art would be reasonably

apprised of the bounds of the Asserted Claims when read in light of the specification. *See Nautilus, Inc. v. Biosig Inst., Inc.*, 134 S. Ct. 2120 (2014).

VI. INVALIDITY AS UNPATENTBALE ABSTRACT IDEA UNDER 35 U.S.C. § 101

In the alternative, the asserted claims of the ’321 patent are not directed to patent eligible subject matter under 35 U.S.C. § 101 for at least the reasons set forth below.

- All of the asserted claims of the ’321 are directed toward nothing more than measuring fat width and removing that fat – processes that are longstanding human activities. The ’321 patent merely automates the actions of a human operator by replacing the operator with known camera, image processing, and motor control techniques.

Weber has not yet provided its claim construction positions for the Assert Claims. Provisur therefore, cannot provide a complete list of 35 U.S.C. § 101 defenses because Provisur does not know whether Weber will proffer a construction for certain terms that may implicate further 35 U.S.C. § 101 invalidity defenses. Moreover, discovery is still on-going, and thus Provisur reserves the right to supplement these contentions with additional evidence and theories, including, for example, additional evidence of conventional activities, processes, and elements.

VII. DOCUMENT PRODUCTION

Pursuant to Local P.R. 3.4, Provisur has produced, or will produce, each item of prior art identified herein that is not in the file history of the patents at issue.

Respectfully submitted, this 1st day of November, 2023.

Dated: November 1, 2023 /s/ Michael G. Babbitt

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CERTIFICATE OF SERVICE

I hereby certify that on November 1, 2023, I caused a true and correct copy of the foregoing:

PROVISUR TECHNOLOGIES, INC.'S DISCLOSURE OF INVALIDITY CONTENTIONS PURSUANT TO PATENT LOCAL RULE 3.3

to be served on all counsel of record via the Court's CM/ECF system pursuant to Federal and local rules.

/s/ Michael G. Babbitt