

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 IPR2024-00258
U.S. Patent No. 10,647,013

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

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I. INTRODUCTION

The '013 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 II.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 79-80. As set forth in Sections III and IV, the Proposed Grounds fall far short. Indeed, Ground 1 proposes a combination of Müller and Waffner but completely ignores that Müller uses a two-buffer arrangement and fails to address how Waffner's loose loop-based teachings would work with Müller's two-buffer setup. Ground 2 proposes a combination of Jordan and Fukuchi but fails to describe how Jordan's sorting and packing machine discloses slicing food and interleaving material in the same cutting region. The Petition is also silent as to why a POSA would implement Fukuchi's alleged two-part "removal device" in Jordan's system when, according to Petitioner's expert, Jordan already describes a two-part removal device.

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

II. 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 less than a week away set on June 12, 2024 and dispositive motions will be exchanged two days later. *Id.*; Ex. 2003. 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 in June 2025. This is approximately **seven 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 78. 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 II.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 six 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 six 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 a week; 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

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).

these circumstances, this factor weighs heavily in favor of discretionary denial.

Duplo U.S.A. Corp., IPR2023-00936, Paper 8 at 17-18.

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 overlapping prior art. Three of the four 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. Jordan, a reference cited on the face of the ’013 Patent, is the only reference not at issue there. 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 obviousness grounds from this Petition in the district court.” Petition at 79. 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 III-IV below, each Proposed Ground suffers dispositive flaws. Ground 1 proposes a

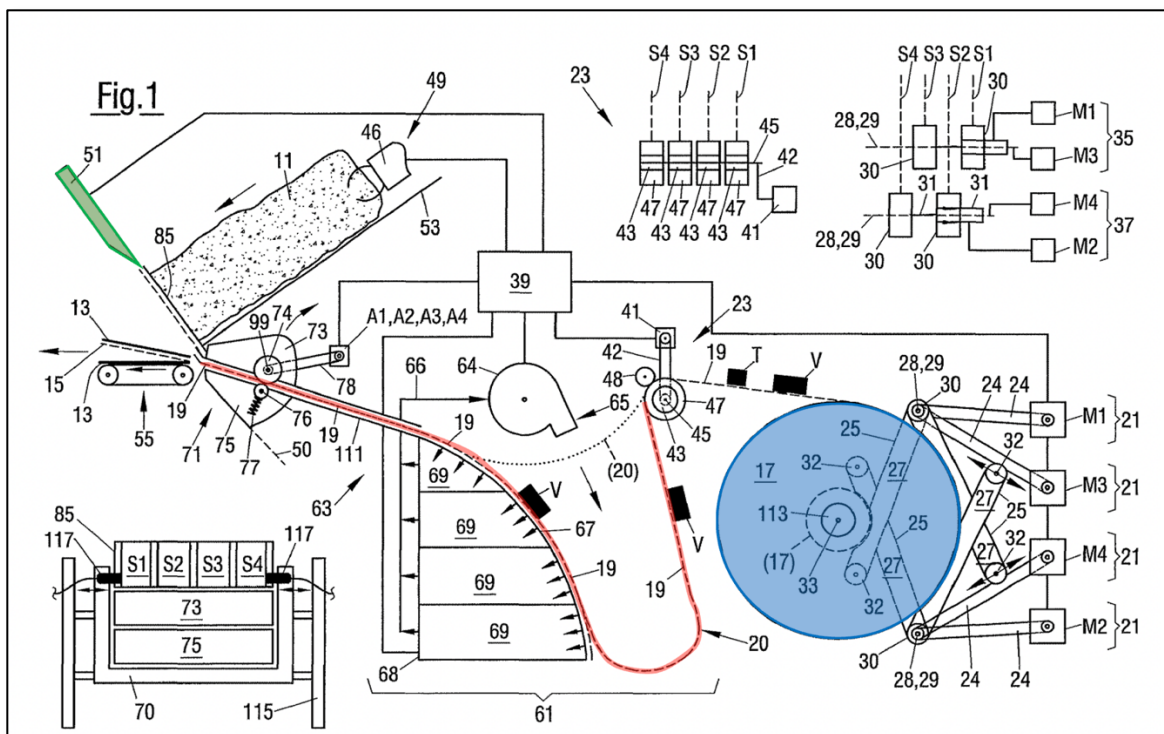
combination of Müller and Waffner, but Petitioner fails to describe the combination with any specificity, leaving unanswered what the combination is and how it would work. Petitioner critically ignores that Müller utilizes a two-buffer setup: (1) buffer 8 downstream of the material roll and (2) buffer 12 just before cutting; and that buffer 8 provides the very same advantages Petitioner seeks from its combination with Waffner. Nor does Petitioner describe how Waffner's teachings to maintain a loose loop for buffer 12 would work with buffer 8 and Müller's two-buffer architecture in general. Ground 2 then proposes a combination of Jordan, a reference directed to a sorting and packing machine well downstream of a slicer, with Fukuchi's disclosures relating to feeding chip paper for a cigarette. Petitioner's analysis provides no discussion of how this combination teaches slicing food product and interleaving material at the same cutting region as claimed. The Petition also fails to describe with specificity why a POSA would replace Jordan's purported two-part removal device with the alleged two-part removal device of Fukuchi.

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).

III. GROUND 1 – DISPOSITIVE FLAWS

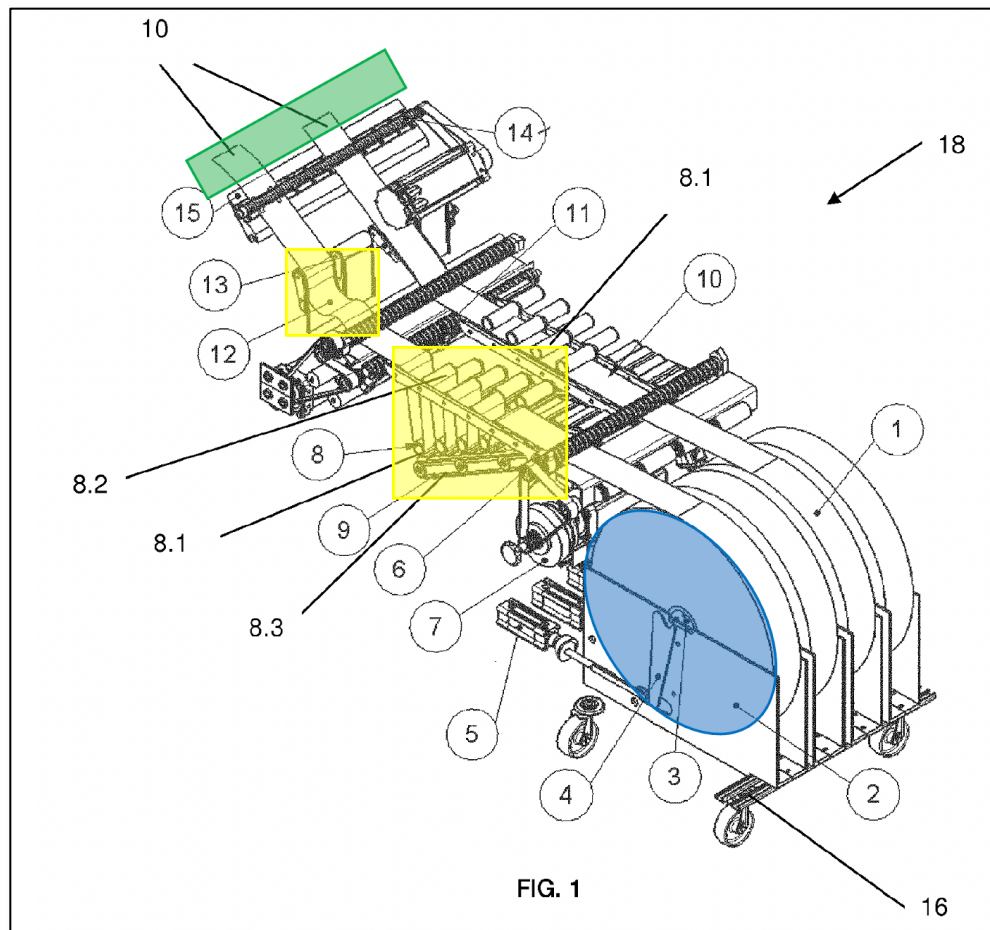
A. Petitioner Ignores Müller's Operation and Fails to Explain How the Proposed Combination Incorporates Waffner's Teachings.

The challenged independent claims of the '013 Patent describe an apparatus for provisioning web-like interleaved sheet material (e.g., paper) at a cutting region in which products (e.g., cheese or meat) are supplied on a track, cut into slices, and interleaved sheets are introduced between slices. Ex. 1001 at claim 2; *see also id.* at claims 17 and 19 (reciting the same). As illustrated in annotated Fig. 1 below, the claimed apparatus comprises several components, including: a material store (e.g., a roll of paper), a cutting region, and a loop store between the material store and cutting region:



The loop serves as a buffer between the high speed and dynamic needs of the cutting area and the relatively sluggish material store. *Id.* at 2:24-40 (noting the invention ensures “ejection of the material web into the cutting region is [] ***reliably decoupled*** from the process of the removal of the material web from the material store at comparatively high cutting speeds”).

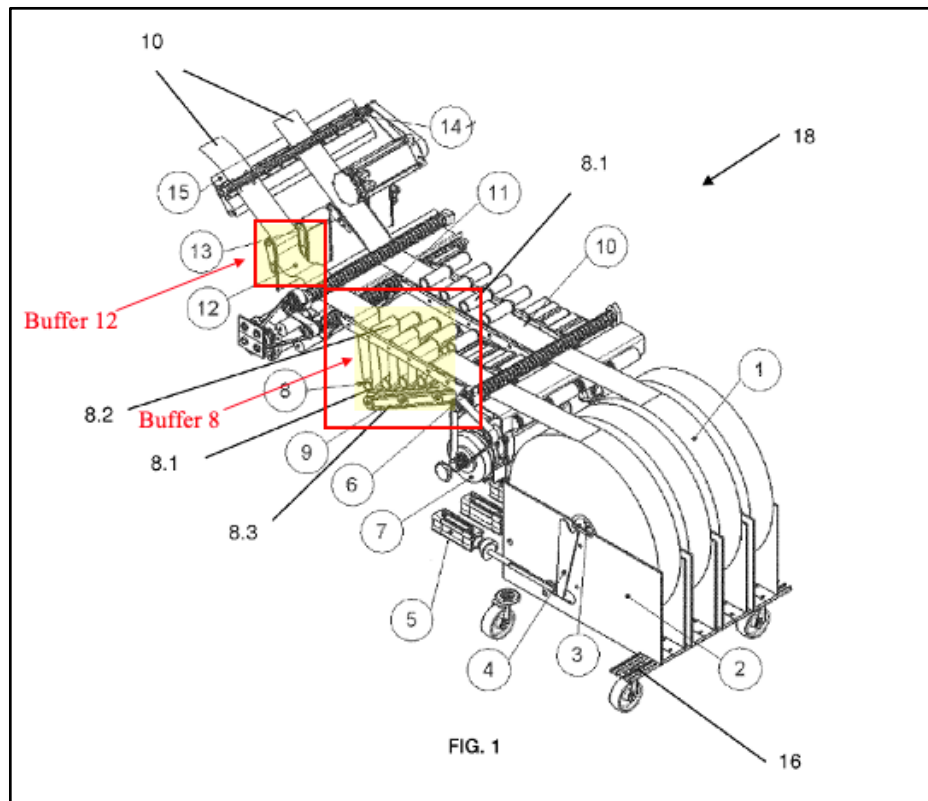
Ground 1 proposes a combination of “Müller[’s] interleaver system with Waffner’s [loose loop] technique to more precisely detect, determine, and control loop length.” Petition at 38. Petitioner’s challenge fails to acknowledge that Müller’s interleaver system importantly relies on two distinct buffer mechanisms—(1) a first that interfaces the paper roll, storing large amounts of slack and acting to decouple the speed of the paper roll supply from the cutting region needs and (2) a significantly smaller tight loop buffer that directly interfaces the cutting region and stores only enough slack to accommodate the next cutting/interleaving action. Annotated Fig. 1 below illustrates large buffer 8 and the smaller tight loop buffer 12 arranged between the **paper roll** and **cutting region**:



Ground 1 proposes replacing Müller's tight loop buffer 12 with Waffner's loose loop approach. But the Petition does not wrestle in any meaningful way with Müller's fundamental nature as a two-buffer system. It entirely ignores the critical (and dominant) role of Müller's large buffer 8 and makes no attempt to explain how Müller's existing large buffer could compatibly interface Waffner's large buffer. Indeed, Petitioner does not even explain whether Müller's large buffer remains in the proposed combination and certainly does not wrestle with any role it might serve after Waffner's loose loop technique replaces Müller's tight loop buffer. By ignoring

Müller's large buffer, the proposed combination effectively reads this key feature out of Müller's system. Such a drastic change in Müller's basic principles weighs strongly against obviousness, particularly where Petitioner fails to even acknowledge the loss of a key feature. *Plas-Pak Industries, Inc. v. Sulzer Mixpac AG*, 600 F. App'x 755, 758 (Fed. Cir. 2015) (“[C]ombinations that change the basic principles under which the prior art was designed to operate, or that render the prior art inoperable for its intended purpose, may fail to support a conclusion of obviousness.”); *see also Cook Grp. Inc. v. Bos. Sci. Scimed, Inc.*, 809 F. App'x 990, 1001 (Fed. Cir. 2020) (“[T]he Board properly weighed the loss of key functions as a relevant factor in the motivation to combine analysis[.]”).

In more detail, Petitioner's base reference, Müller, generally describes an easy-to-remove “unreeling device” for food slicers containing multiple interleaver reels. Ex. 1004 at [0001]-[0004]. Müller's unreeling device is constructed to introduce interleaver strips into the cutting plane “with a very high acceleration” without needing a brake on the cartridge containing the reels. Ex. 1004 at [0007], [0010], [0039]; Petition at 20-21. To appreciate these benefits, Muller's device 18 utilizes two “accumulators” or “buffers”—i.e., accumulations of interleaving material—to mitigate tearing or damage to the material strip when feeding interleaving material at high speeds. *Id.* at [0026]. These two buffers are depicted in annotated Figure 1 below:



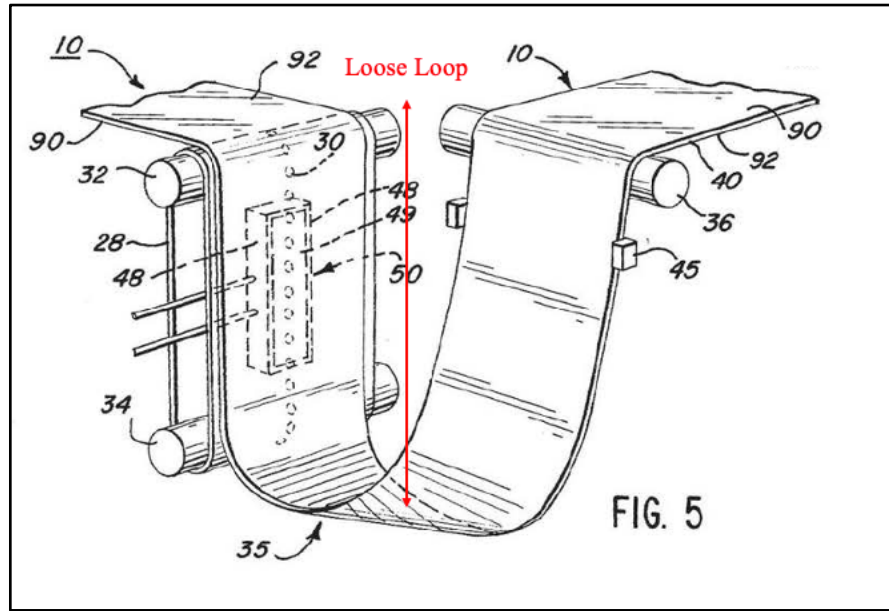
Müller maintains these buffers at different storage capacities. *Id.* at [0026]. Buffer 12 maintains a “small storage capacity” compared to the “high storage capacity” of buffer 8. *Id.* This is intentional. Müller explains that the higher storage capacity of buffer 8 “compensates for a difference between the unreeling speed and the consumption of the interleaver strip” such that it has a “residual buffer capacity that is sufficiently large that, in the event of a necessary stop, it buffers the overrun of the interleaver reel, which is braked only by friction.” *Id.* at [0035]. On the other hand, buffer 12 “preferably has a substantially lower capacity than the buffer 8 and preferably buffers only as much interleaver material as is needed for the ejection of an interleaver.” *Id.* at [0048]. In other words, buffer 8 provides the critical role of

decoupling the paper roll material removal from the high speed and dynamic cutting region while buffer 12 merely supplies just enough loose paper material for the next cutting/interleaving action.

Petitioner relies on Müller's smaller buffer 12 as the claimed "loop" in the challenged claims. Petition at 27, 32-33. Petitioner then proposes modifying Müller's unreeling device 18 to include: (1) Waffner's purported air-permeable belt 28 and vacuum chamber in lieu of Müller's interleaver strip guide 13; and (2) Waffner's contact sensor and loop control techniques in lieu of Müller's sensor. Petition at 33-35, 40-41. However, what Petitioner does not propose is *how* Waffner's belt and vacuum chamber teachings and loose loop control would work in Müller's fundamentally different system—a system that obviates the need for a loose loop by implementing a two-buffer arrangement.

The crux of Waffner's invention—a printing press disclosure—is "to provide an improved apparatus which is utilized to control the infeed speed of a continuous web so that **a loose loop** is formed and maintained in the web so as to substantially eliminate damage to the web." Ex. 1006 at 2:58-62; *see also id.* at 2:63-3:4 ("provide an improved loose loop feed control apparatus"), 3:5-13, 3:36-45, 5:8-10, 6:50-54, claim 1; Ex. 1003 at ¶ 205 ("Waffner directly explains that its techniques can be used to improve the control over a loose loop of web material"). Indeed, Waffner is

titled “Loose Loop Feed Control Apparatus.” Ex. 1006 at title. Waffner’s “loose loop” is illustrated in Figure 5 below:



Id. at Fig. 3.

To maintain this “loose loop” in Waffner’s printing apparatus, Waffner’s system measures the “degree of vacuum in the chamber 50” which changes based on the “number of apertures 30 in the belt 28 which are covered by the” loop. *Id.* at 5:8-16. For example, if the outfeed speed of the web is less than the infeed speed, the loop will lengthen and cover more apertures, increasing pressure in chamber 50. *Id.* at 5:17-35. This change in vacuum is sent as a “vacuum signal” to a control to change the outfeed speed. *Id.* Waffner’s invention therefore is to maintain a “loose loop” by detecting changes in vacuum from the number of apertures covered by this loose loop. This loose loop is intended to prevent damage to the web from over-

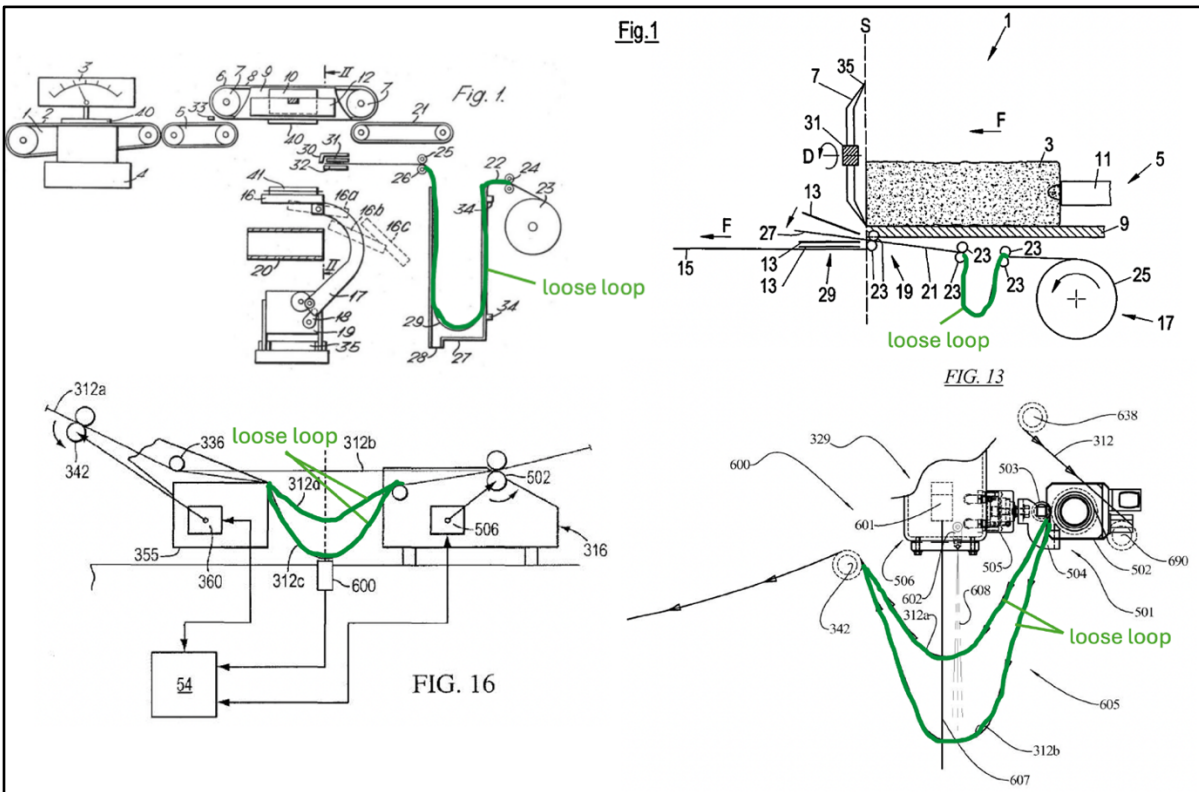
tension when the infeed speed of material does not match the outfeed speed. *Id.* at 6:50-53.

Müller, in stark contrast, avoids the need to maintain a loose loop adjacent to the cutting region (and the complexity that accompanies such a loose loop arrangement). Indeed, Müller's buffer 8 is designed to "compensate[] for a difference between the unreeling speed and the consumption of the interleaver strip"—the traditional role of a loose loop buffer like that in Waffner. Ex. 1004 at [0035]. Buffer 8, which is located directly downstream from the material roll, utilizes a snaking design to "implement a residual buffer capacity" such that "in the event of a necessary stop, it buffers the overrun of the interleaver reel, which is braked only by friction." *Id.* Buffer 8 performs the same functions as a loose loop, with buffer 12 acting as a quick repository of material so that it "buffers only as much interleaver material as needed" for each slice. This two-buffer system is the entire point and distinguishing feature of Müller from the other prior art relied-upon and cited by Petitioner.

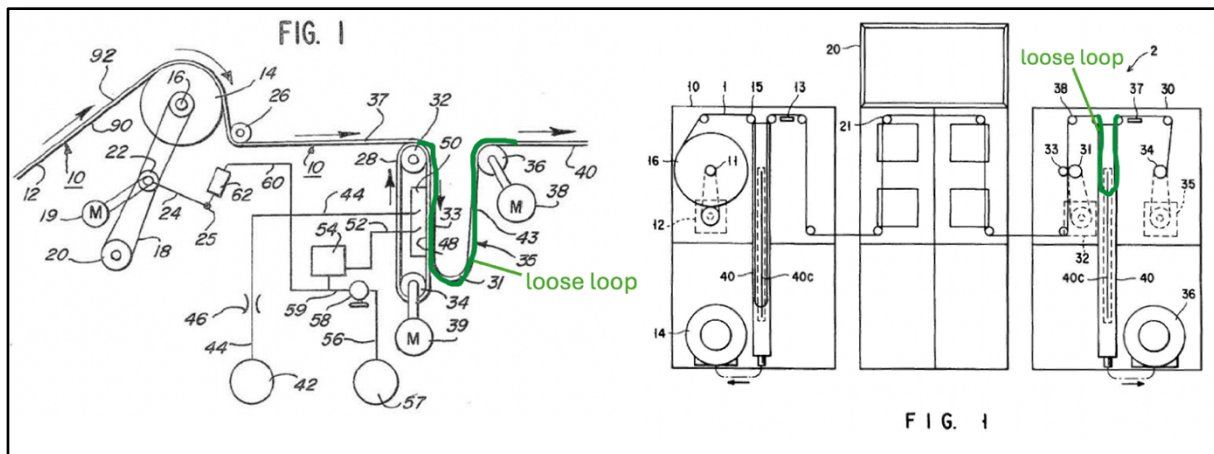
Indeed, Petitioner's expert, Mr. Jobin, walks through examples of "earlier interleavers" that "used a loose loop of web as a buffer" like those relied-upon in its proposed Grounds with a loose loop positioned between the material roll and the cutting area at the functional end of the process. Ex. 1003 at ¶ 77. These loose loops

cited in Mr. Jobin's declaration and those used in Petitioner's other references in its rejections are annotated in green below.

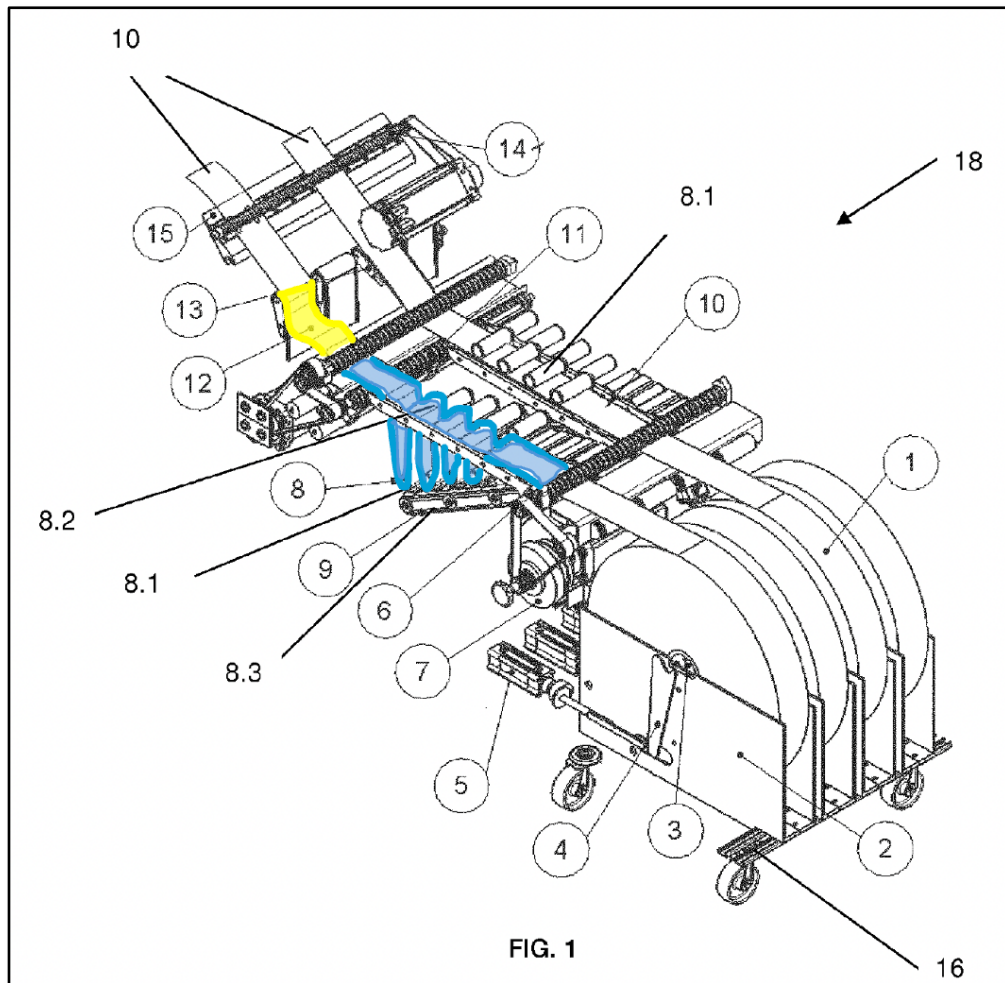
Background references:



Secondary references in Grounds:



As noted, these loose loops generate enough slack to reduce tension for feeding material to the cutting region. Müller does this differently. Buffer 8 in blue is on the roller side and provides the requisite speed/tension compensation while buffer 12 in yellow can be more simplistic and streamlined:



Despite these contrasting disclosures, Petitioner fails to explain how Waffner's loose loop techniques would function with Müller's two-buffer system. Petitioner does not address what role buffer 8 would have in the combination, if any

at all. Given the importance of buffer 8 to Müller's operation, Petitioner's failure to discuss it in any meaningful way is fatal to the proposed combination.

At bottom, the Petition glosses over the incompatibilities between Müller and Waffner and fails to grapple with how Müller's two-buffer and Waffner's loose loop teachings could produce an operative system. Petitioner simply alleges that a POSA could swap out Müller's loop sensors with Waffner's and implement Waffner's loose loop control without sufficiently explaining how this swap would result in a functional system. This is dispositive of Petitioner first ground. *See Samsung Electronics Co. Ltd., v. Mojo Mobility Inc.*, IPR2023-01097, Paper 11 at *19 (PTAB Feb. 12, 2024) (denying institution where Petitioner offered a combination that "appears unworkable and mixes incompatible features" of the references without sufficient explanation); *see also 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").

IV. GROUND 2 – DISPOSITIVE FLAWS

A. The Proposed Jordan / Fukuchi System Fails To Describe A “Cutting Region” Where Both Food Slices And Paper Are Cut.

1. The claimed “cutting region” in the preamble limits the claims

The Federal Circuit has stressed that there is no “litmus test” for determining whether a preamble is limiting. *See Bicon, Inc. v. Straumann Co.*, 441 F.3d 945, 952 (Fed. Cir. 2006). Rather, “[w]hether to treat a preamble as a claim limitation is determined on the facts of each case in light of the claim as a whole and the invention described in the patent.” *Storage Tech. Corp. v. Cisco Sys., Inc.*, 329 F.3d 823, 831 (Fed. Cir. 2003). The Federal Circuit has provided guiding principles, however, that inform the interpretation at issue here. For example, “[w]hen limitations in the body of the claim rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention.” *Eaton Corp. v. Rockwell Int. ’l Corp.*, 323 F.3d 1332, 1339 (Fed. Cir. 2003); *Meta Platforms, Inc. v. Eight KHZ, LLC*, IPR2023-01004, Paper 9 at 20, Fn. 2 (PTAB Jan. 9, 2024) (citing *Eaton Corp.* and finding preamble limiting because it provides antecedent basis for terms in the body of the claim).

The preambles of the challenged independent claims and the respective limitations by which the preambles provide antecedent basis are identified in the chart below:

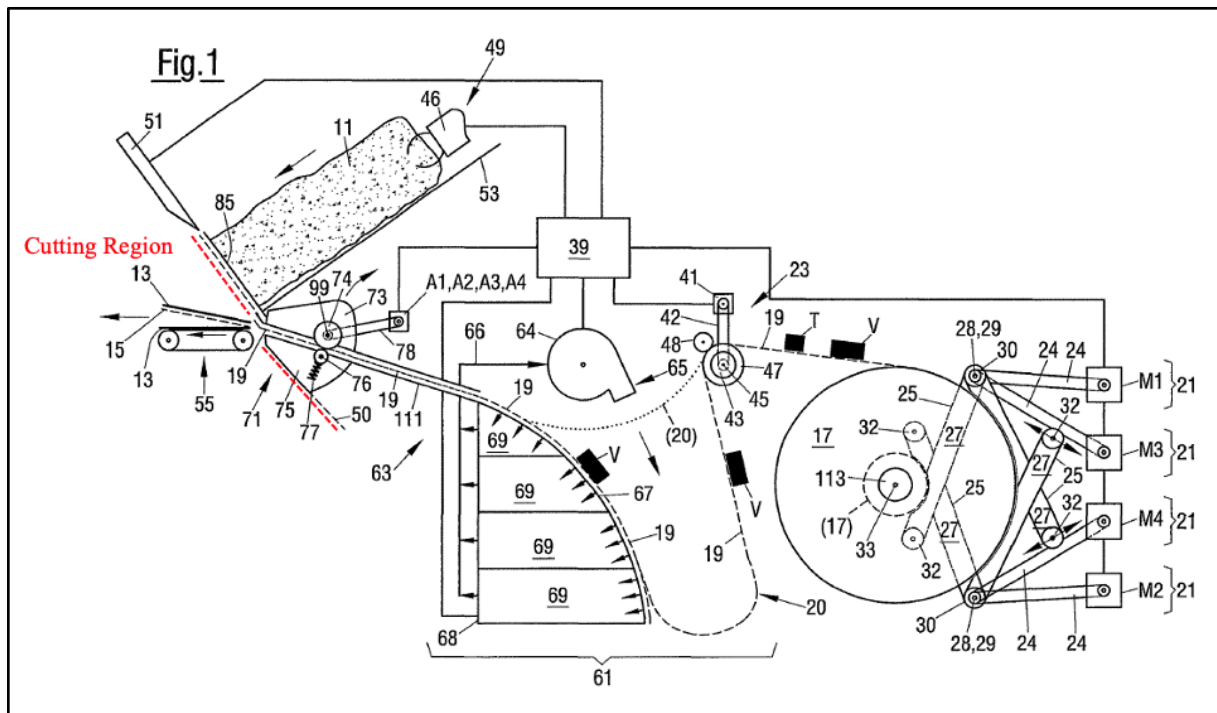
Claim 2	Claim 17	Claim 19
2[Pre]. An apparatus for a single-track or multitrack provision of web-like interleaved sheet material at a cutting region in which products supplied on one track or on multiple tracks are cut into slices and interleaved sheets are introduced which are cut off from the provided interleaved sheet material in the cutting region	17[Pre]. An apparatus for a single-track or multitrack slicing of food products having a product feed which supplies products to be sliced on one track or on multiple tracks to a cutting region in which a cutting blade moves in a rotating and/or revolving manner to cut the supplied products into slices, and having an apparatus for the provision of web-like interleaved sheet material at the cutting region in which the products supplied are cut into said slices and interleaved sheets are introduced which are cut off from the provided interleaved sheet material in the cutting region	19[Pre]. An apparatus for a single-track or multitrack slicing of food products having a product feed which supplies products to be sliced on one track or on multiple tracks to a cutting region in which a cutting blade moves in a rotating and/or revolving manner to cut the supplied products into slices, and having an apparatus for the provision of web-like interleaved sheet material at the cutting region in which the products supplied are cut into said slices and interleaved sheets are introduced which are cut off from the provided interleaved sheet material in the cutting region
2c. a loop store defining a space for the removed material web to form a loop, the loop store located between the material store and the cutting region ;	17c. a loop store defining a space for the removed material web to form a loop, the loop store located between the material store and the cutting region ;	19c. a loop store defining a space for the removed material web to form a loop, the loop store located between the material store and the cutting region

As shown, all challenged claims recite a “cutting region” in the preamble. This “cutting region” is later recited in the body of the claim to provide bounding structure

for the location of the claimed “loop store”—claiming a loop store “located between the material store and the cutting region.” The preamble therefore provides antecedent basis for the claimed “cutting region” which informs the structural location of other components and is thus a necessary component of the claims. *Eaton Corp*, 323 F.3d at 1339.

2. *Scope of the limiting preamble*

The claims and specification are clear that *both* food product and interleaver material are cut in the claimed “cutting region.” The ’013 Patent describes its invention as an “apparatus for a single-track or multitrack provision of web-like interleaved sheet material **at a cutting region** in which products supplied on one track or on multiple tracks are cut into slices and interleaved sheets are introduced which are cut off from the provided interleaved sheet material **in the cutting region**[.]” Ex. 1001 at Abstract, 1:12-17, 5:47-53; *see also id.* at title (“Providing A Cutting Area With Web-Like Interleaver Material”). This cutting region is identified below in annotated Figure 1:



Id. at Fig. 1 (annotated).

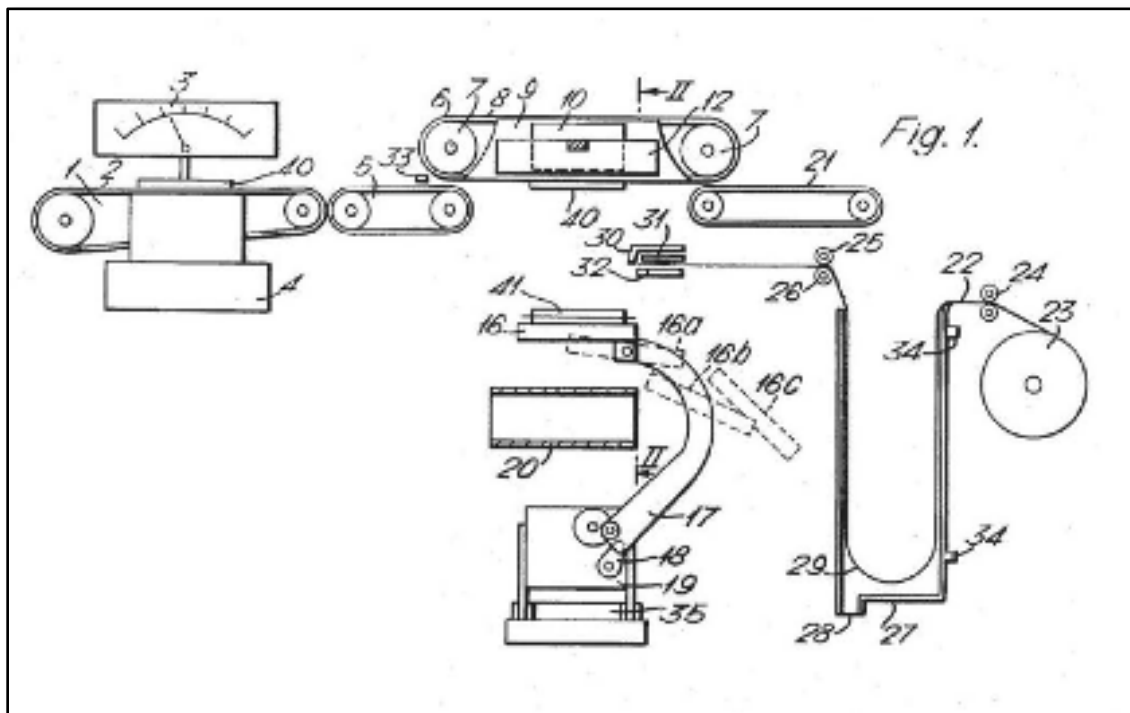
In Figure 1, food product 11 is sliced by cutting blade 51 at cutting plane 50. *Id.* at 7:22-31. Then, “endless material webs 19 are ejected in the region of the cutting plane 50 coming from below in accordance with the clocking predefined by the cutting movement of the cutting blade 51.” *Id.* at 8:16-22. Thus, “the front end of the respective material web 19” “together with the slice 13” is cut “by means of the cutting blade 51 and thus forms an interleaved sheet.” *Id.* at 8:22-27, 15:31-37; *see also* Ex. 1001 at 1:18-20 (“In the cutting region, slices cut off from the products can consequently be provided with the interleaved sheets introduced into the cutting region”), 1:60-64 (“The invention also relates to an apparatus for slicing food products, having a product feed which supplies products to be sliced to a cutting

region in which a cutting blade moves in a rotating and/or revolving manner to cut the supplied products into slices”), 2:35-38 (“It is the object of the invention to improve an apparatus for the provision of web-like interleaved sheet material to the extent that the process of the ejection of the material web into the cutting region...”).

In the '013 Patent's invention, and as recited in the claims, food product *and* the corresponding interleaver material are cut in the cutting region.

3. *Petitioner's proposed combination does not meet the preamble*

Petitioner's Ground 2 rejection relies principally on Jordan, a reference dedicated to “Sorting And Stacking Of Food Slices” downstream of already sliced food products. Ex. 1005 at title, 1:5-8. Jordan explains its process with regard to Figure 1:



Ex. 1005 at Fig. 1. Here, “slices 40 fall from a cutting apparatus (not illustrated) preferably first on to a weighing conveyor” 1; slices 40 are then conveyed with “conveyor belt 5” to conveying device 6; conveying device 6 either carries slices with the wrong weight to be cast out on conveyor 21 or drops the correctly weighted slices to stack 41. *Id.* at 3:65-4:24. To feed paper 22 between the falling slices, Jordan provides:

The web 22 of paper is drawn by the take-up rollers 24 from a magazine roll 23 and conveyed to a paper cutter 30 which cuts off the individual sheets. The paper is fed in by feed rollers 25 and 26 at about the time the air permeable conveying device 6 grips a slice of the right weight. The sheet of paper fed in under the cutter 30 is cut off when the falling slice 40 comes into contact with the paper.

Id. at 5:30-38.

In other words, Jordan's system cuts slices at an un-illustrated cutting device presumably located at the far left of Figure 1; sends these slices through three separate conveyor units; and then introduces paper from a paper feed apparatus at the far right of Figure 1 by dropping already-cut slices over a paper feed that contacts a separate cutter. At no point does Jordan's system cut both food product and paper in the same “cutting region” as claimed. And this makes sense because Jordan's system is directed to a sorting and packaging system downstream of a slicer that already cut slices of food product.

The Petition acknowledges this defect and attempts to bridge this gap² with a single, unsupported conclusory allegation that “[b]ecause a POSA would read Jordan’s disclosures in view of the state-of-the-art at the time of the patent, the POSA would understand that Jordan teaches the cutting region and tracks of the preamble[.]” Petition at 56 (citing ¶¶’s 75, and 424-425 of its expert’s report). Importantly, Petitioner is not proposing a modification to Jordan to cut food and paper in the same cutting region. Instead, Petitioner and its expert suggest that because it was “known [that] high-speed slicing machines cut paper and product at the same cutting surface[.]” the Board should ignore Jordan’s actual teachings and pretend that its slicer cuts both product and paper, as was known in the art. Ex. 1003 at ¶ 424 (“although Jordan literally discloses a ‘cutter 30’ that only cuts paper (because product is sliced at a separate ‘cutting machine’), a POSA reading Jordan at the time of the patent would understand Jordan to disclose a known high-speed slicing machine where the paper cutter and food slicer were a common blade at a common cutting region”). This reasoning fails. As Petitioner admits, Jordan does not disclose a slicer that cuts paper and food product in the same cutting region. Because Petitioner has not proposed (or supported) a theory that a POSITA would have

² Fukuchi does not remedy this deficiency (nor does Petitioner allege otherwise). Fukuchi does not relate to a slicer and instead pertains to feeding paper for a cigarette. Ex. 1007 at 1:7-11.

modified Jordan to cut product and paper in a single cutting region, it is irrelevant that other conventional slicers could do so.

Rather than meeting its burden to show that Jordan teaches or suggests this element, Petitioner simply creates the missing elements out of whole cloth. There is no support at all in Jordan for cutting product and paper at the same location and indeed the literal disclosures, as acknowledged by Petitioner, state the opposite. With no express disclosure and no argument for a modification to capture the missing teachings, Petitioner's analysis for all challenged claims in Ground 2 fails. *Meta Platforms, Inc.*, IPR2023-01004, Paper 9 at 24 (denying institution).

B. Element 2.2 – The Petition Fails To Articulate Any Motivation To Replace Jordan's Alleged “Removal Device” With Fukuchi's.

In Petitioner's Ground 2 proposal, Petitioner appears to rely exclusively on its secondary reference—Fukuchi's—teachings to map to the claimed “removal device” in Element 2.2. Petition at 54 (table identifying Fukuchi's “delivery roller 11” and “feed roller 31”), 57-58. Notably absent from Petitioner's analysis in its Petition is any motivation to supplant or replace any components in its primary, Jordan, with those of Fukuchi. The only modification the Petition attempts to support with any analysis is Petitioner's proposal to implement Fukuchi's loop size determination techniques into Jordan. There is no evidentiary basis articulated in the Petition to further modify Jordan to implement Fukuchi's purported deliver roller 11

and feed roller 31. There is no explanation at all if Jordan's "take up rollers 24" are being replaced with Fukuchi's rollers or if these rollers are intended to function concomitantly in some way. Without reasoned support articulating how and why this modification would work, Petitioner cannot carry its burden to show compelling merits.

To the extent Petitioner argues that high-level discussions in its expert declaration are sufficient to satisfy its burden, they should be rejected. It is Petitioner's burden to identify, *in the Petition*, "in writing and with particularity each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim." 35 U.S.C. § 312(a)(3); *see also Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) ("It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify 'with particularity' the 'evidence that supports the grounds for the challenge to each claim.' 35 U.S.C. § 312(a)(3)."). Here, the Petition falls far short, failing to provide any details describing what the proposed combination *is* or *how* it would work.

In the present case, Petitioner entirely failed to carry its burden to explain how and why Fukuchi's purported deliver roller 11 and feed roller 31 should be implemented in Jordan's system. Petitioner's expert testimony is insufficient where the Petition fails to include a corresponding argument/discussion. *Department of*

Justice v. Discovery Patents, LLC, IPR2016-01039, Paper 10 at 8 (PTAB Nov. 15, 2016) (denying institution and explaining “[t]o the extent an argument is raised solely in [the expert’s] Declaration and not also in the Petition, we have declined to consider it for purposes of this Decision”); *see also RPX Corp., et al. v. Parity Networks, LLC*, IPR2018-00097, Paper 7 at (PTAB Apr. 24, 2018) (denying institution, “Patent Owner argues ‘[t]he only support for this argument is their expert Declaration, which should not be used to fill gaps in the prior art.’ We agree.”); *Fidelity National Information Services, Inc. v. DataTreasury Corp.*, IPR2014-00489, Paper 9 at 9–10 (PTAB Aug. 13, 2014) (“We, therefore, decline to consider information presented in a supporting declaration, but not discussed sufficiently in a petition; among other reasons, doing so would permit the use of declarations to circumvent the page [or word] limits that apply to petitions.”).

Regardless, even if the Board were to consider Petitioner’s expert’s analysis, Mr. Jobin simply notes the benefits associated with a “two-part removal device” in his report. Ex. 1003 at ¶¶ 411 (describing only general motivation to use a two-part removal device), 430-434. However, Mr. Jobin already contends that Petitioner’s primary reference, Jordan, itself discloses a two-part removal device.³ *Id.* at ¶ 431 (describing Jordan’s “take-up rollers 24” and vacuum to draw the loop into shaft 27

³ Petitioner does not advance this argument in its mapping in the Petition.

as a “removal device [that] has two parts”); *see also id.* at ¶ 345 (“In particular, Jordan’s removal device is two-part. First, take-up rollers 24 draw material from the material store. Second, vacuum inserts draw[] material into a loop”). Mr. Jobin fails to articulate any reasoning to support why Jordan’s purported two-part removal device should be replaced with Fukuchi’s redundant teachings further undercutting Petitioner’s proposal. *Hewlett Packard Enterprise Co. v. K.Mizra LLC*, IPR2022-00843, Paper 14 at *21-22 (PTAB Oct. 31, 2022) (denying institution where petition failed under *In re Anova Hearing Labs, Inc.*, 809 F. App’x 840, 843 (Fed. Cir. 2020) to adequately explain why a POSA would substitute redundant functionality in its proposed combination).

V. 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 7,281 words according to the word-processing program used to prepare this document (Microsoft Word).

Dated: March 14, 2024

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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 14, 2024 by email on the following counsel of record for Petitioner:

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