

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PROVISUR TECHNOLOGIES, INC.,
Petitioner,

v.

WEBER FOOD TECHNOLOGY GMBH,
Patent Owner.¹

IPR2024-00258
Patent 10,647,013 B2

Before CARL M. DEFRANCO, ROBERT J. SILVERMAN, and
RYAN H. FLAX, *Administrative Patent Judges*.

DEFRANCO, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

¹ After the petition was filed, Patent Owner filed a notice changing its name from Weber Maschinenbau Gmbh Breidenbach to the name currently in the case caption. *See* Paper 6.

Provisur Technologies, Inc. (“Provisur”) filed a petition requesting *inter partes* review of claims 2, 3, 9, 10, 12, 13, and 16–20 of US 10,647,013 B2 (Ex. 1001, “the ’013 patent”). Paper 2 (“Pet.”). Weber Food Technology GmbH (“Weber”), the owner of the ’013 patent, filed a preliminary response. Paper 7 (“Prelim. Resp.”). Weber identifies Textor Maschinenbau GmbH, Weber, Inc., Textor, Inc., and Weber Maschinenbau GmbH Neubrandenburg as additional real parties-in-interest. Paper 3, 2.

We have considered the parties’ positions. Because Provisur demonstrates a reasonable likelihood that at least independent claims 2, 17, and 19 of the ’013 patent are unpatentable, we institute *inter partes* review of all claims as challenged in the Petition.

I. BACKGROUND

A. Related Matters

The ’013 patent is the subject of a parallel infringement action, *Provisur Technologies, Inc. v. Weber, Inc.*, No. 5-21-cv-06113 (W.D. Mo.) (“the parallel Missouri action”). See Paper 3, 2. That case began with Provisur alleging that Weber infringed three of Provisur’s patents—US 8,408,109 B2 (“the ’109 patent”), US 10,625,436 B2 (“the ’436 patent”), and US 10,639,812 B2 “the ’812 patent”).² Two-years later, Weber counterclaimed by alleging that Provisur infringed four of Weber’s patents—the ’013 patent challenged here, as well as US 9,457,487 B2 (“the ’487 patent”), US 8,529,321 B2 (“the ’321 patent”), and US 11,331,823

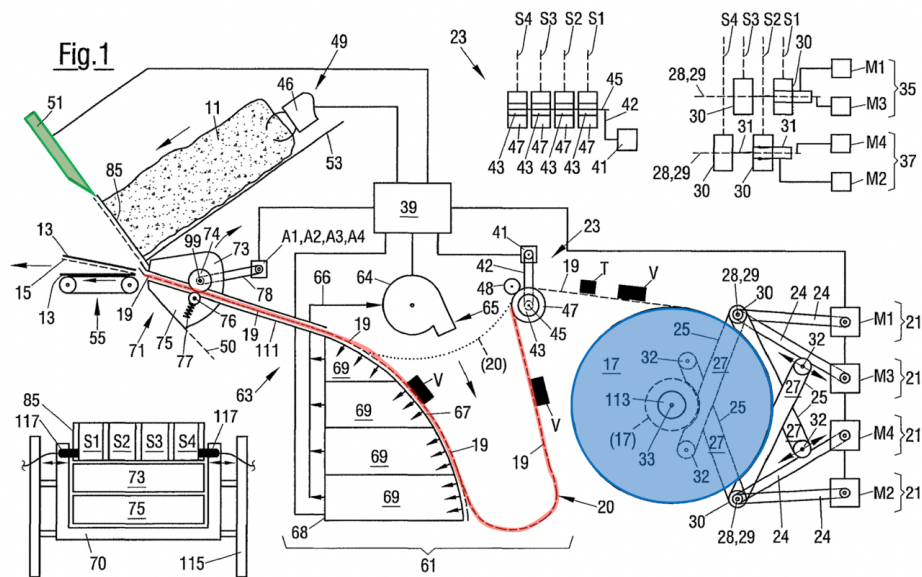
² The district court’s docket sheet was consulted to determine the status of the Missouri action. The parties are reminded to update the Board on any material events occurring in that case. See 37 C.F.R. § 42.8(a)(3).

B2 (“the ’823 patent”).³ All seven of the patents at issue in the parallel Missouri action—Provisur’s three patents and Weber’s four patents—are currently the subject of proceedings before the Office. For instance, the ’487 and ’321 patents are the subject of recently instituted *inter partes* review proceedings. *See* IPR2024-00224, Paper 8; IPR2024-00235, Paper 10. Moreover, the ’109 patent was the subject of a Rehearing Decision from the Director and a subsequent Final Written Decision from the Board (IPR2022-00599, Papers 74, 76), while the ’436 and ’812 patents are currently before the Board on remand from our reviewing court (IPR2020-01556, 1557, Paper 71). Thus, the Board is familiar with the parties, the patents, and the technology at issue in the parallel Missouri action.

B. The ’013 Patent

The ’013 patent describes an apparatus for providing web-like interleaved sheet material (e.g., paper) to a cutting region where products (e.g., cheese or meat) are supplied on a track and cut into slices, and interleaved sheets are introduced between the slices. Ex. 1001. Figure 1 of the ’013 patent, as annotated by Weber (Prelim. Resp. 14) and reproduced below, illustrates the primary components of the apparatus.

³ Provisur diligently filed the instant Petition within three-months of Weber’s counterclaims and within days of learning the claims that Weber was asserting. *See* Pet. 78–79.



As shown above, the apparatus comprises several primary components: material store 17 (blue), cutting region 51 (green), and loop store 61 (red) positioned between the material store and the cutting region. Notably, the loop store serves as a buffer between the high speed and dynamic needs of the cutting area and the relatively sluggish operation of the material store. *See id.* at 2:24–55 (noting that the loop store 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” (emphasis added)).

C. The Challenged Claims

Of the challenged claims, claims 2, 17, and 19 are independent. Claim 2, reproduced below, is illustrative of the challenged claims:

2. 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, the apparatus comprising:

a material store;
a removal device for a removal of a material web from the material store;
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;
a contact surface having at least a portion thereof that is air permeable, the contact surface at least partially bounding the loop store and at least partially covered by the loop that contacts the contact surface; and
a device for determining a size of the loop formed in the loop store, the device detecting changes in at least one of a pressure differential and a flow condition, the pressure differential being a difference in pressure between a first side of the contact surface and a second side of the contact surface, the flow condition being a change of the flow of air through the air permeable portion of the contact surface, wherein the changes in the pressure differential and/or the flow condition represent a varying influence of the material loop on the air permeable portion of the contact surface that is provided as a measure for the loop size.

Ex. 1001, 19:8–35.

D. The Asserted Challenges

Claims Challenged	35 U.S.C. §	Basis
2, 3, 9, 10, 12, 13, 16–20	103	Müller, ⁴ Waffner ⁵
2, 3, 9, 12, 13, 16–20	103	Jordan, ⁶ Fukuchi ⁷

⁴ US 2016/0023370 A1, published Jan. 28, 2016 (Ex. 1004, “Müller”).

⁵ US 4,253,597, issued Mar. 3, 1981 (Ex. 1006, “Waffner”).

⁶ US 3,848,757, issued Nov. 19, 1974 (Ex. 1005, “Jordan”).

⁷ US 5,697,573, issued Dec. 16, 1997 (Ex. 1007, “Fukuchi”).

II. ANALYSIS

A. Level of Ordinary Skill in the Art

Provisur proposes that one of ordinary skill in the art typically would have had:

(1) a bachelor's degree (or equivalent) in mechanical engineering (or a similar field) and at least two years of experience working as an engineer (or similar role) on food processing and/or packaging systems (or in a similar field); or (2) at least seven years of experience working as an engineer (or similar role) on food processing and/or packaging systems (or in a similar field).

Pet. 17.

Weber does not contest Provisur's framing of the level of ordinary skill in the art. *See generally* Prelim. Resp. Because Provisur's proposed definition is consistent with the level of skill described in the '013 patent and the prior art of record, we adopt it here for purposes of institution.

B. Claim Construction

Provisur asserts that the claim terms should be construed "according to their plain and ordinary meanings as understood by [one of ordinary skill in the art] in view of the specification and prosecution history" and that "[n]o terms require an explicit construction to resolve the unpatentability controversy between the parties here." Pet. 18. Weber appears to agree, stating in the parallel Missouri action that "most of [Weber's] patent claims are plain and ordinary . . . [t]hey're not difficult or complex claims or claim terms." Ex. 1028, 5.

There being no dispute, we need not expressly construe any claim terms at this stage of the proceeding, because we can decide the threshold question of institution without further construction. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir.

2017) (approving Board decision not to construe claim language where the construction is not material to the dispute).

C. Discretionary Denial Under 35 U.S.C. § 314(a)

Weber requests that we exercise our discretion under 35 U.S.C. § 314(a) to deny institution due to the advanced state of the parallel Missouri action. *See* Prelim. Resp. 3–13. Although Provisur argues that discretionary denial is not warranted (Pet. 73–77), it nonetheless submits a *Sotera* style stipulation (Ex. 1029) in an effort to resolve the issue.⁸ In light of Provisur’s *Sotera* stipulation, we will not discretionarily deny institution under § 314(a). *See* Director Memorandum, *Interim Procedure for Discretionary Denials in AIA-Post Grant Proceedings With Parallel District Court Litigation*, U.S. PATENT AND TRADEMARK OFFICE (June 21, 2022), at 3, 7.

D. Ground 1—Obvious Over Müller and Waffner

Provisur challenges claims 2, 3, 9, 10, 12, 13, and 16–20 as being rendered obvious by Müller and Waffner. *See* Pet. 26–53. We begin with Provisur’s challenge of independent claims 2, 17, and 19. In support, Provisur provides a claim chart, reproduced below, mapping various elements of the independent claims to express disclosures in Müller and Waffner. *Id.* at 27.

⁸ Although Provisur received authorization to file the *Sotera* stipulation, Provisur is advised that the *Sotera* stipulation should have been filed with an accompanying *notice* rather than simply being identified in an updated exhibit list (i.e., Paper 9).

'013 Patent Claim Element	Exemplary Feature in Müller (EX1004)	Exemplary Feature in Waffner (EX1006)
Apparatus for ... provision	“System” 18; “interleaver strip” 10; “cutting plane”	
Apparatus for... slicing	“Cutting device;” “products” such as “food;” “slices of food”	
Material store	“Interleaver reel” 1	“Supply roll”
Removal device	“Unreeling device” 18	“Feed roll” 14 and “belt” 28
Loop store	“Buffer” 12 for “loop”	“Belt” 28 and “outfeed roll” 36 for “loop” 35
Contact surface	“Strip guide”	“Belt 28”
Vacuum chamber		Vacuum chamber 50
Device for determining a size of the loop		Device using a “vacuum signal” to “change... the speed of rotation of... roll 14”

Provisur also enumerates the specific elements of the independent claims and explains in greater detail, with annotated figures, how Müller and/or Waffner teaches each of those claim elements. *See id.* at 28–38 (claim 2), 47–52 (claim 17), 53 (claim 19). And Provisur provides credible (and unrebutted) testimony from its expert as to why one of ordinary skill in the art would have combined the teachings of Müller and Waffner with an expectation of success. *See id.* at 38–42 (citing Ex. 1003 ¶¶ 199–228, 233–238).

In response, Weber differentiates Müller’s “two-buffer” interleaver system from Waffner’s “one-buffer” interleaver system to argue that the proposed combination of their teachings would result in an inoperable system. *See Prelim. Resp.* 15–24. More specifically, according to Weber,

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 [with] 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.

Id. at 15–16. Similarly, Weber argues that, by “gloss[ing] over the incompatibilities between Müller and Waffner,” Provisur “fails to grapple with how Müller's two-buffer and Waffner's loose loop teachings could produce an operative system.” *Id.* at 24.

We disagree that the evidence of record supports that Müller and Waffner are incompatible or that the combination of their teachings would result in an inoperable system. Contrary to Weber's argument, Provisur did not need to address how incorporating Waffner's teachings might negatively impact Müller's “two-buffer” system. Prelim. Resp. 16, 19, 21, 23. That is because Müller expressly teaches that its interleaver system is fully capable of operating as either a one-buffer or two-buffer system. *See* Ex. 1004 ¶ 26 (noting that “[a]t least *one* of the two buffers, preferably both buffers, *is/are* provided for each track and independently of each other.”). In other words, although disclosing that a two-buffer system is preferable, Müller clearly discloses that its interleaver system may also operate with only one buffer (i.e., buffer 12).

But, in the event Provisur's proposed modification of Müller includes both buffer 8 *and* buffer 12, the record supports that one of ordinary skill in

the art reasonably would have understood the advantage of incorporating Waffner's air-permeable contact surface and vacuum chamber into Müller's downstream buffer 12, as opposed to its upstream buffer 8, given that both prior art references emphasize the importance of controlling *the infeed speed and tension of the interleaver material adjacent the cutting region* where rapid acceleration and braking of the interleaver material may result in tearing and wrinkling. *See* Ex. 1004 ¶¶ 26, 48; Ex. 1006, 2:58–3:4, 6:50–56; *see also* Ex. 1003 ¶¶ 200–210 (addressing the teachings of Müller and Waffner in view of the existing knowledge in the art). Indeed, Provisur's expert confirms that “[l]ike many interleaver devices known in the art, Müller discloses creating a buffer loop of web material upstream of the rollers *that insert the web material into the cutting area*,” and that “[i]t was known in the food slicing and interleaving industry that the tension of interleaver material *fed to the cutting region from a loose loop must be controlled*.” Ex. 1003 ¶¶ 199, 220.

And, like Waffner, Müller describes buffer 12 in terms of being a “loop” buffer for controlling the infeed speed of the interleaver material into the cutting region. *See* Ex. 1004 ¶ 48 (“Provided downstream of the first buffer 8 is a further buffer 12, a loop here, which . . . preferably buffers only as much interleaver material as is needed for the ejection of an interleaver.”). In contrast, Müller's buffer 8 is used only “in the event of a[n] emergency stop” for buffering “overrun of the reel.” *Id.* ¶ 33. Thus, based on the current record, we reject the notion that Provisur's proposed modification of Müller's buffer 12, which continuously controls the length of the loop near the cutting region, would have any effect on Müller's buffer 8, which merely stops unraveling near the reel.

Aside from operability, Weber does not further dispute Provisur's showing as to how the asserted combination of Müller and Waffner renders obvious the subject matter of independent claims 2, 17, and 19. *See* Prelim. Resp. 14–24. After analyzing Provisur's showing, including Provisur's mapping of the claim elements to Müller and/or Waffner and its reasoning for why one of ordinary skill in the art would have been led to combine their respective teachings (as discussed above), we find that Provisur demonstrates a reasonable likelihood that at least independent claims 2, 17, and 19 are unpatentable as obvious over the combined teachings of Müller and Waffner. *See* Pet. 28–38 (claim 2), 38–42 (reason to combine), 47–52 (claim 17), 53 (claim 19). Thus, Provisur meets the threshold for institution.

At this stage, Weber offers no response to Provisur's challenge of dependent claims 3, 9, 10, 12, 13, 16, 18, and 20, except presumably to rely on its argument against Provisur's challenge of their respective base claims 2, 17, and 19. *See* Prelim. Resp. 14–24. Because Provisur provides an obviousness challenge that satisfies the “reasonable likelihood” threshold with respect to at least the independent claims, we do not address the dependent claims in the absence of any rebuttal from Weber. Further analysis is best left for trial after full development of the record.

E. Ground 2—Obvious Over Jordan and Fukuchi

Provisur also challenges claims 2, 3, 9, 12, 13, and 16–20 as being rendered obvious by Jordan and Fukuchi. *See* Pet. 54–77. In doing so, Provisur admits that Jordan itself does not disclose the preamble of independent claims 2, 17, and 19. *See id.* at 55–56, 71, 76. Nor does Provisur rely on Fukuchi to cure this deficiency in Jordan. *See id.* Instead, relying on the *unrebutted* testimony of its expert, Provisur contends 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 as well. . . . The basic principle of an interleaver included tracks to drive product into a cutting region where product and interleaver material were cut together by a single rotating blade.

Id. at 56 (citing Ex. 1003 ¶¶ 75, 424–425); *see also id.* at 71 (arguing and citing essentially same).

At this stage, Weber responds only with conclusory argument. *See* Prelim. Resp. 31–32. Without hearing more from Weber as to whether one of ordinary skill in the art would have read Jordan’s disclosure as expansively as Provisur does, we think further analysis of this challenge is best left for trial after full development of the record.

III. CONCLUSION

For the above reasons, we determine that Provisur presents a reasonable likelihood that at least independent claims 2, 17, and 19 of the ’013 patent are unpatentable as obvious over the combined teachings of Müller and Waffner. And, because “[e]qual treatment of claims and grounds for institution purposes has pervasive support in *SAS*,” we institute on all the claims as challenged in the Petition. *See* 37 C.F.R. § 42.108(a), (c); *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018) (citing *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018)).

IV. ORDER

Accordingly, it is:

ORDERED that an *inter partes* review of claims 2, 3, 9, 10, 12, 13, and 16–20 of the '013 patent is *instituted*; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), notice is hereby given of the institution of trial, which will commence on the entry date of this Decision.

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