

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PROVISUR TECHNOLOGIES, INC.,
Petitioner,

v.

WEBER FOOD TECHNOLOGY GMBH,
Patent Owner.

IPR2024-00269
Patent 11,331,823 B2

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

Opinion for the Board filed by SILVERMAN, *Administrative Patent Judge*.

Concurring Opinion filed by DEFRANCO, *Administrative Patent Judge*.

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

Provisur Technologies, Inc. (“Provisur”) filed a Petition requesting *inter partes* review of claims 1, 2, 4, 5, 7, 8, 10, 12, 17, and 18 of US 11,331,823 B2 (Ex. 1001, “the ’823 patent”). Paper 2 (“Pet.”). Provisur states that it is the sole real party in interest. *Id.* at 72.

Weber Food Technology GmbH (“Weber”),¹ the owner of the ’823 patent, filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). In addition to itself, Weber identifies Textor Maschinenbau GmbH, Weber, Inc., Textor, Inc., and Weber Maschinenbau GmbH Neubrandenburg as real parties-in-interest. Paper 3, 2.

As explained herein, because Provisur sufficiently establishes that at least one claim of the ’823 patent is unpatentable, we institute *inter partes* review of all challenged claims on the grounds presented in the Petition.

The parties address the issue of the Board’s discretion to deny institution, under 35 U.S.C. § 314(a). *See* Pet. 69–72; Prelim. Resp. 1–13. We have considered the parties’ positions and, for the reasons provided below, do not exercise such discretion.

I. BACKGROUND

A. Related Matters

The ’823 patent is a subject of a parallel action, *Provisur Technologies, Inc. v. Weber, Inc.*, No. 5:21-cv-06113 (W.D. Mo.) (“the

¹ After the petition was filed, Patent Owner filed a notice of name change from Weber Maschinenbau GmbH Breidenbach to Weber Food Technology GmbH. *See* Paper 6, 2. Accordingly, the caption in this matter is hereby amended to reflect this name change.

parallel Missouri action” or “*Provisur v. Weber Litig.*”).² See Paper 3, 2. In addition to the ’823 patent, the parallel Missouri action involves, *inter alia*, allegations of infringement by Provisur, Weber, and/or their related entities, of the following patents: US 8,408,109 B2 (“the ’109 patent”), US 10,625,436 B2 (“the ’436 patent”), US 10,639,812 B2 (“the ’812 patent”), US 9,457,487 B2 (“the ’487 patent”), US 8,529,321 B2 (“the ’321 patent”), and US 10,467,013 B2 (“the ’013 patent”). See *Provisur v. Weber Litig.*, First Amended Complaint (June 23, 2023), Dkt. #167 ¶¶ 128, 150, 151, Weber’s Answer and Counterclaims to First Amended Complaint (Aug. 24, 2023), Dkt. #204 ¶¶ 36, 54, 72.

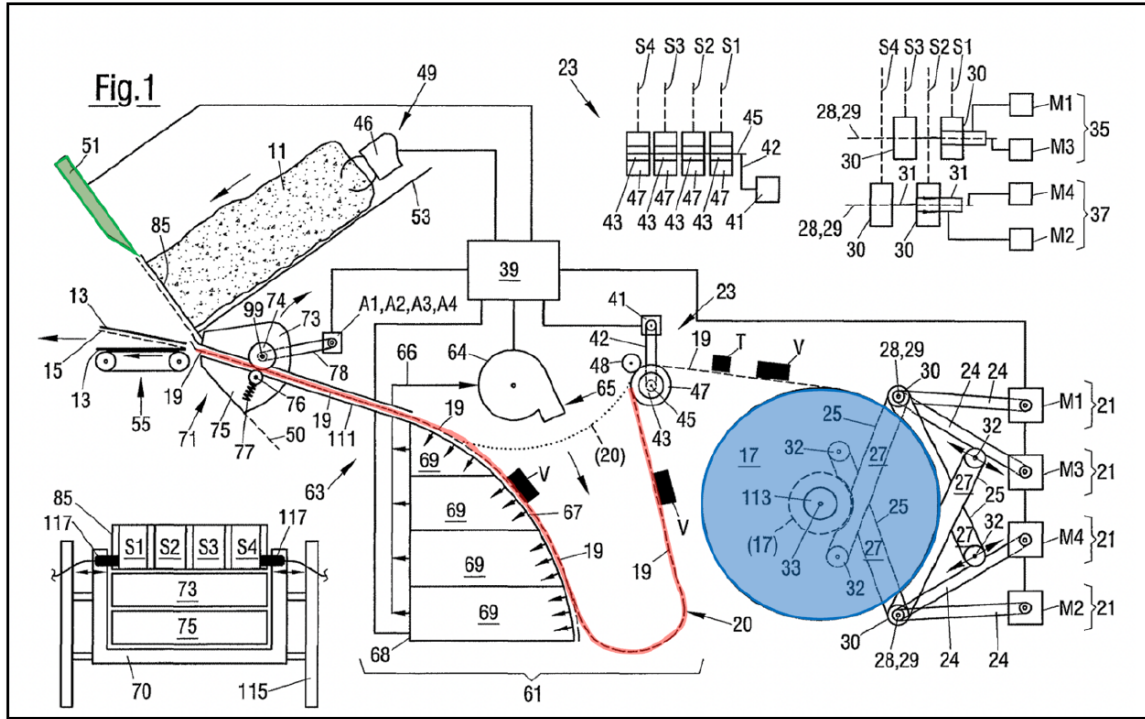
All the patents in the parallel Missouri action are (or have been) subjects of proceedings before the Office: IPR2020-01556 (the ’436 patent); IPR2020-01557 (the ’812 patent); IPR2022-00599 (the ’109 patent); IPR2024-00224 (the ’487 patent); IPR2024-00235 (the ’321 patent); IPR2024-00258 (the ’013 patent); and the present IPR2024-00269 (the ’823 patent).

B. The ’823 Patent

The ’823 patent relates to a slicer machine — usable with food products such as sausage, meat, or cheese — that provides interleaved sheet material, such as paper or plastic film, between the slices. Ex. 1001, 1:17–45; 2:7–19; 7:32–35.

² The parties are reminded to update the Board regarding any material events occurring in the parallel Missouri action. See 37 C.F.R. § 42.8(a)(3).

The operation of a disclosed embodiment of the '823 patent may be understood with reference to the following annotated version of Figure 1, provided in Weber's Preliminary Response. *See* Prelim. Resp. 14.



Shown, above, is an annotated version of Figure 1 of the '823 patent, which depicts a schematic side view of a slicer and interleaver. Ex. 1001, 7:22–25. In this annotated Figure 1, a material store of interleaver material (e.g., a roll of paper) (material roll 17 of material web 19, in Figure 1) is shaded blue, a cutting region (including cutting blade 52) is shaded green, and a loop store (including material loop 20) is shaded red. *See* Prelim. Resp. 13; Ex. 1001, 7:39–49; 9:1–21. As Weber explains, loop 20 “serves as a buffer between the high speed and dynamic needs of the cutting area and the relatively sluggish material store.” Prelim. Resp. 14 (citing Ex. 1001, 2:24–40).

The technique for maintaining tension in material web 19 is an issue in the Petition. As Weber explains:

To maintain tension over this loose loop, the loop store includes a suction device 63 behind a contact surface 67 that pulls a vacuum. [Ex. 1001], 3:1–3, 12:62–13:31. In this way, the contact surface serves to brake the loop when the loop is pulled out of the loop store into the cutting region during cutting cycles. *Id.*

Prelim. Resp. 14.

C. The Challenged Claims

Of the challenged claims, claims 1 and 17 are independent. Claim 1, reproduced below, including Provisur’s added sub-numbering (*see, e.g.*, Pet. 12–13), illustrates the challenged claims:

[1.Preamble] 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:

[1.1] a material store;

[1.2] a removal device for a removal of a material web from the material store;

[1.3] 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, the loop store having a brake for the material web that actively increases the friction for the material web; and

[1.4] wherein the loop store comprises a contact surface for at least one region of the material loop at the outgoing side of the loop, wherein the contact surface belongs to the brake for the material web.

Ex. 1001, 19:7–24.

D. The Asserted Challenges

Provisur contends that claims 1, 2, 4, 5, 7, 8, 10, 12, 17, and 18 of the '823 patent are unpatentable based on the following grounds (Pet. 21–22):

Ground	Claims Challenged	35 U.S.C. §	Basis
1	1, 2, 4, 5, 7, 8, 10, 12, 17, 18	103	Müller, ³ GEA438 ⁴
2	1, 2, 4, 5, 7, 8, 10, 12, 17, 18	103	Müller, DePoi ⁵

Provisur filed a Declaration of Michael Jobin (Ex. 1003) with the Petition.

II. ANALYSIS

A. Level of Ordinary Skill in the Art

Provisur proposes, and Weber does not dispute, that a person of ordinary skill in the art of the '823 patent, at the time relevant for the analysis herein, would have possessed the following background and qualifications:

- (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. 13–14. Provisur's proposed definition appears to be consistent with the problems and solutions addressed in the '823 patent and the prior art of

³ US 2016/0023370 A1, pub. Jan. 28, 2016 (Ex. 1004, "Müller").

⁴ US 2019/0329438 A1, pub. Oct. 31, 2019 (Ex. 1005, "GEA438").

⁵ US 2009/0159631 A1, pub. June 25, 2009 (Ex. 1006, "DePoi").

record. Therefore, for the purposes of this Decision, we adopt Provisur's characterization of the level of ordinary skill in the art.

B. Claim Construction

Provisur submits that it “has construed the claim terms according to their plain and ordinary meanings as understood by a POSA [i.e., a person of ordinary skill in the art] in view of the specification” and that “[n]o terms require an explicit construction from the Board to resolve the unpatentability issues between the parties in this proceeding.” Pet. 14 (citing *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017)).

Weber's Preliminary Response does not manifest any claim construction dispute that would bear upon this Decision.

Therefore, we need not expressly construe any claim terms at this preliminary stage. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (“[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.”)

C. Discretionary Denial

Institution of *inter partes* review is discretionary. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he [U.S. Patent and Trademark Office] is permitted, but never compelled, to institute an IPR proceeding.”)

Weber argues that the status of the parallel Missouri action (where trial is scheduled to begin on November 18, 2024) establishes a basis for an exercise of discretion to deny institution of the requested *inter partes* review under 35 U.S.C. § 314(a), per the factors identified in *Apple, Inc. v. Fintiv*,

Inc., No. IPR2020-00019 (PTAB March 20, 2020), Paper 11 (precedential) (“*Fintiv*”). *See* Prelim. Resp. 2–13.

Provisur argues that, “[o]n balance, the *Fintiv* factors weigh against denial.” Pet. 69.

“[I]n evaluating the factors,” set forth in *Fintiv*, “the Board takes a *holistic* view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Fintiv* 6 (emphasis added). In view of the following discussion of these factors, under the circumstances as they appear from the present record, the efficiency and integrity concerns, referenced in *Fintiv*, are best served by not exercising our discretion to deny the Petition without considering the merits.

1. Factor One

The first *Fintiv* factor, concerning the likelihood of a stay in the parallel Missouri action, weighs in favor of denying the Petition. Weber states, in the Preliminary Response:

At the September 13, 2023 Scheduling Conference, Judge Bough doubled down on his prior directives [regarding the pending trial schedule] 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.

Prelim. Resp. 4.

Provisur, acknowledging that “no motion to stay pending IPR has yet been filed in the district court case,” contends that “*Fintiv* factor one is

neutral given that courts commonly stay cases upon IPR institution, including the W.D. Mo.” Pet. 69. Provisur goes on to state that “[i]n previous cases between the parties, the assigned district court judge has granted multiple stay motions.” *Id.* (citing *Provisur v. Weber*, No. 21-cv-06113, Dkt. #95 (W.D. Mo. Sept. 16, 2022); No. 20-cv-6069, Dkt. #74 (W.D. Mo. April 8, 2021); No. 19-cv-6021, Dkt. #43 (W.D. Mo. Aug. 29, 2019)).

Notwithstanding the possibility that a party could seek a stay of the parallel Missouri action (at least, as to the trial of the ’823 patent), Judge Bough’s remarks (quoted above) suggest that the issuance of any such stay would be unlikely.

2. *Factor Two*

The second *Fintiv* factor — concerning the proximity of the trial date (in the parallel Missouri action) and the projected date for the Board’s final written decision in the requested *inter partes* review — weighs in favor of denying the Petition.

Weber states: “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.” Prelim. Resp. 5 (citing Ex. 2003 (*Provisur Tech., Inc. v. Weber Inc. et al.*, Case No. 5:21-cv-06113, Dkt. 214) at 4).

Provisur argues that this factor weighs against discretionary denial, in view of the Western District of Missouri’s “median time from filing to trial for civil cases” (identified as 25.5 months) and the date of Weber’s counterclaim that asserted the ’823 patent (August 24, 2023), which would

yield a district court trial “around September 2025.” Pet. 70. Yet, the trial date set by the district court, even though potentially subject to alteration, seems to be a more reasonable data point for assessing the proximity of the district court’s trial date to the Board’s final written decision, in this instance — particularly in view of Judge Bough’s remarks (quoted above).

3. *Factor Three*

The third *Fintiv* factor, concerning the investment in the parallel Missouri action by the district court and the parties, weighs against discretionary denial of the Petition.

In one aspect, this factor is related to the second factor, because “more work completed by the parties and court in the parallel proceeding tends to support the arguments that the parallel proceeding is more advanced, a stay may be less likely, and instituting would lead to duplicative costs.”

Fintiv 10. Weber points to significant investment by the parties and the district court, such as serving thousands of pages of contentions, responding to multiple rounds of discovery requests, producing millions of pages of documents, inspecting the parties’ products, and briefing various motions, and undertaking more than 30 fact depositions. Prelim. Resp. 7. But, Weber’s account of expenditures appears to describe the entirety of the parallel Missouri action — not the portion attributable to the ’823 patent alone. Further, although Weber refers to the claim construction undertakings in the district court (*id.* at 7–8 (“all disputed claim terms for all patents at issue have already been adjudicated”)), there appear to be no disputed claim construction issues bearing upon Provisur’s Petition.

In discussing the third factor, *Fintiv* contemplates the significance of the filing date of a petition, explaining that “it may impose unfair costs to a patent owner if the petitioner, faced with the prospect of a looming trial date, waits until the district court trial has progressed significantly before filing a petition at the Office.” *Fintiv* 11. On the other hand, “[i]f the evidence shows that the petitioner filed the petition expeditiously, such as promptly after becoming aware of the claims being asserted, this fact has weighed against exercising the authority to deny institution.” *Id.* Here, Provisur filed the Petition on December 7, 2023 — just fifteen weeks after Weber filed the counterclaim adding the ’823 patent to the parallel Missouri action. *See Provisur v. Weber Litig.*, Weber’s Answer and Counterclaims to First Amended Complaint, Dkt. #204 (Aug. 24, 2023). In view of this circumstance, the third *Fintiv* factor weighs against discretionary denial.

4. *Factor Four*

The fourth *Fintiv* factor, concerning the overlap between issues raised in the Petition and in the parallel Missouri action, weighs against discretionary denial of the Petition.

Fintiv explains that “if the petition includes materially different grounds, arguments, and/or evidence than those presented in the district court, this fact has tended to weigh against exercising discretion to deny institution.” *Fintiv* 12–13.

Provisur argues that there is no “direct overlap of issues” between the Petition and the parallel Missouri action: “The Petition challenges four claims that are not asserted in the district court (in addition to six asserted claims), and the prior art grounds here are not the same as the district court.”

Pet. 71. Further, Provisur submits the following stipulation: “Petitioner will not raise the same obviousness grounds from this Petition in the district court (including neither the Ground 1 Müller and GEA438 combination, nor the Ground 2 Müller and DePoi combination).” *Id.*

Weber contends that Provisur “challenges the same claims in this IPR that it is challenging in the district court with the same prior art” and “[a]ll of the references used in Petitioner’s proposed grounds in its Petition have also been raised in its invalidity contentions at the district court.” Prelim.

Resp. 9. In support, Weber (*id.*) cites Provisur’s November 1, 2023, invalidity contentions (Ex. 2004 at 7) (“Contentions”), and points out that, in the Contentions, the GEA438 reference (along with counterpart patents/applications) is identified as “Bader et al.”

It appears that the Müller, GEA438, and DePoi references are identified among the other listed of “prior art patent applications and patents that anticipate or render obvious” one or more of the asserted claims (of one or more of the four Weber counterclaim patents, which include the ’823 patent). Ex. 2004, at 7. However, none of Müller, GEA438, and DePoi is identified in the portion of the Contentions describing the specific bases of alleged invalidity of claims of the ’823 patent. *Id.* at 12–13.⁶

Furthermore, each of the Contentions’ invalidity bases, for the ’823 patent, includes at least one reference that is a product — as opposed to a

⁶ Although the Contentions state that the ’823 patent “is anticipated by the Bader Interleaver,” this appears to be a product, rather than the GEA438 patent application or any of its identified counterpart applications/patents (which identify the inventors as “Bader et al.”). Ex. 2004, at 7. Perhaps this might be clarified in the claim charts provided with the Invalidity Contentions (*see id.* at 11), but these are not part of Ex. 2004.

patent or publication.⁷ Such grounds could not be raised in the Petition, which must be brought “only on the bases of prior art consisting of patents or printed publications.” 35 U.S.C. § 311(b). Therefore, it appears that Provisur is pursuing invalidity arguments, in the parallel Missouri action, that could not be addressed in an *inter partes* review before the Board.

Weber argues that Provisur’s stipulation (discussed above) is in the style of that employed in *Sand Revolution II, LLC v. Cont’l Intermodal Grp. — Trucking LLC*, IPR2019-01393, Paper 24 (PTAB June 16, 2020) (informative). Prelim. Resp. 9–10. Weber states that this form of stipulation is less effective in avoiding an overlap of issues addressed in *inter partes* review and a parallel district court action than a stipulation to not pursue, in the district court litigation, any ground that is raised or that could have been reasonably raised in an *inter partes* review — a so-called *Sotera* stipulation. *Id.* See *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, at 18–19 (PTAB Dec. 1, 2020) (precedential).

Notwithstanding the less complete form of stipulation that Provisur employs, the circumstances described above weigh against discretionary denial of the Petition.

⁷ The Contentions state that the ’823 patent is “anticipated by the Bader Interleaver,” “rendered obvious by the Weber CCI Interleavers in view of ‘Vacuum Brakes’”; “rendered obvious by U.S. Patent Application US2015/0135652 to Pryor et al. (Pryor) in view of ‘Vacuum Brakes’”; and “rendered obvious by U.S. Patent No. 9,399,531 (Provisur) in view of ‘Vacuum Brakes.’” Ex. 2004 at 12–13. We understand that “the Bader Interleaver,” “the Weber CCI Interleavers,” and “Vacuum Brakes” refer to products in public use or on sale, as opposed to patents or printed publications.

5. *Factor Five*

The fifth *Fintiv* factor concerns whether the Petitioner is the same party defending against the '823 patent counterclaim in the parallel Missouri action. There is no dispute that the parties to the present proceeding are the same as those in the parallel Missouri action. *See* Pet. 71; Prelim. Resp. 10. Therefore, the fifth *Fintiv* factor weighs in favor of discretionary denial of the Petition.

6. *Factor Six*

The sixth *Fintiv* factor concerns “other circumstances that impact the Board’s exercise of discretion, including the merits.” *Fintiv* 6. This factor weighs against discretionary denial of the Petition.

For example, although the proximity of the scheduled trial date, in the parallel Missouri action, relative to the likely date of a final written decision in an *inter partes* review, weighs in favor of discretionary denial, the district court’s schedule does not account for post-trial briefing — which could be extensive, given the number and variety of issues in that proceeding — and may delay final judgment in the parallel Missouri action until after the projected deadline for a final written decision in an *inter partes* review.

Further, instituting *inter partes* review may help to simplify and clarify the issues being addressed in the parallel Missouri action.

In addition, as noted above, the Board instituted *inter partes* review of all of the other patents involved in the parallel Missouri action.⁸ Instituting

⁸ However, the institution decision in IPR2024-00258 (regarding the '013 patent) has not yet issued.

review of the '823 patent would further the goals of efficiency and consistency in addressing the patentability issues presented in the Petition.

D. Analysis of the Asserted Grounds

We have authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314; 37 C.F.R. § 42.4(a). Under 35 U.S.C. § 314(a), we may not authorize an *inter partes* review unless the information in the petition and the preliminary response “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons that follow, and solely for the purposes of this Decision, we determine that Grounds 1 and 2 of the Petition (as identified below) satisfy this standard.

Provisur contends that claims 1, 2, 4, 5, 7, 8, 10, 12, 17, and 18 of the '823 patent are unpatentable as obvious under 35 U.S.C. § 103, based on: the combination of Müller and GEA438 (Ground 1); and the combination of Müller and DePoi (Ground 2). Pet. 21–69.

A claim is unpatentable under 35 U.S.C. § 103 if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level

of skill in the art;⁹ and (4) when in evidence, objective evidence of obviousness or non-obviousness (i.e., so-called secondary considerations).¹⁰ *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). We also recognize that prior art references must be “considered together with the knowledge of one of ordinary skill in the pertinent art.” *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (citing *In re Samour*, 571 F.2d 559, 562 (CCPA 1978)).

1. Ground 1: Obviousness Based on Müller and GEA438

In regard to independent claim 1 of the ’823 patent, using Provisur’s number designations noted above, Provisur maps the claim preamble and limitations 1.1 (“material store”) and 1.2 (“removal device”) to Müller. Pet. 24–28. In addition, Provisur maps limitations 1.3 (“a loop store . . . having a brake for the material web that actively increases the friction for the material web”) and 1.4 (“wherein the loop store comprises a contact surface . . . belong[ing] to the brake for the material web”) to the combination of Müller and GEA438. *Id.* at 28–31. Provisur’s arguments, regarding the alleged unpatentability of claim 1 of the ’823 patent are further supported by the as-yet unrebutted declaration testimony of Mr. Jobin (*see* Pet. 24–36), who “ha[s] 32 years of experience in product and technology development as a mechanical engineer, consultant and entrepreneur.” Ex. 1003 ¶ 1.

The Müller reference “relates to an unreeling device with which an interleaver strip is unreeled from an interleaver reel,” together with “a

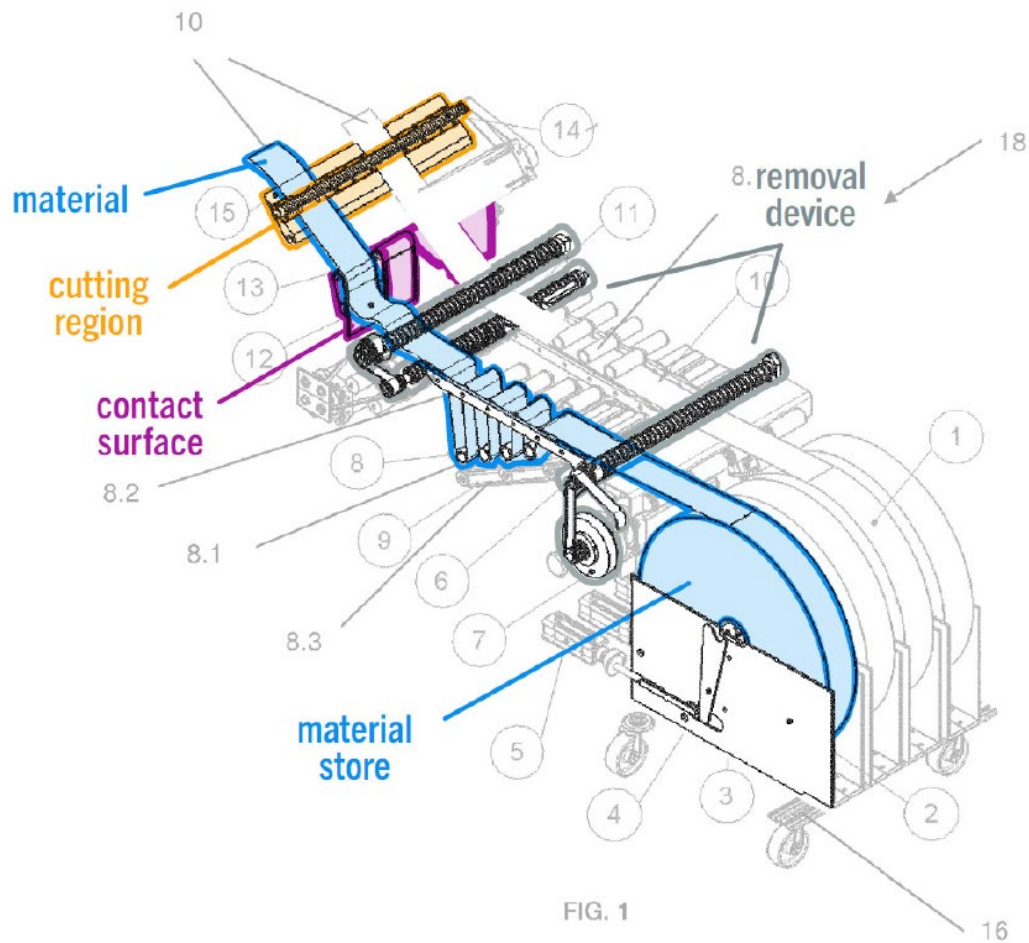
⁹ *See supra* Section II.A.

¹⁰ The present record does not include any evidence of any proposed objective evidence of non-obviousness.

cutting device,” whereby “[i]nterleavers, for example pieces of paper, are placed between two slices or food, for example, in order to reduce the adhesion thereof to one another.” Ex. 1004 ¶¶ 1, 2.

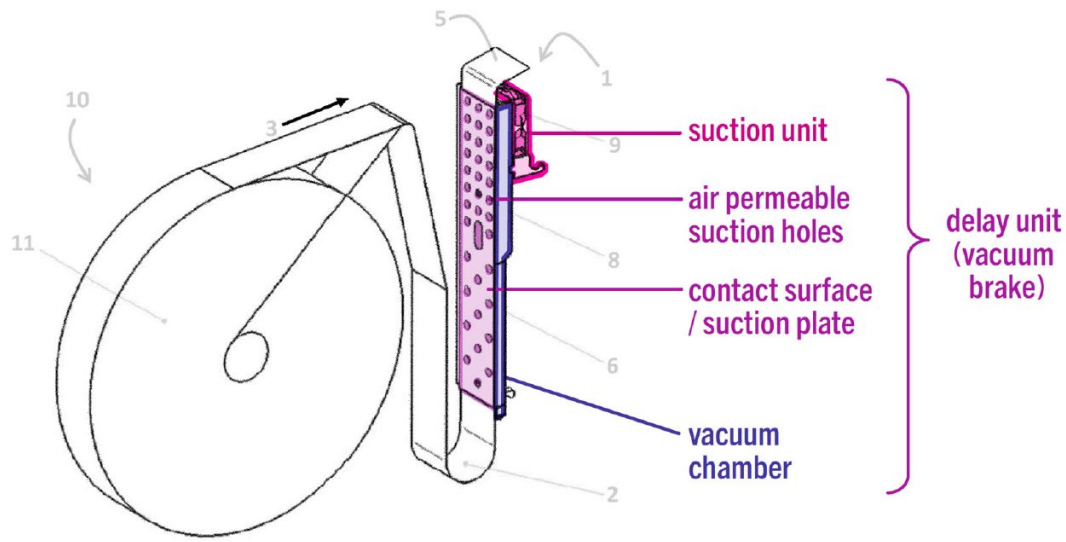
The GEA438 reference relates to “a delay unit for an unrolling device” that “is configured for delaying a transporting movement of separating material which is unrolled from the unrolling device and is provided in a cutting region of a cutting machine.” Ex. 1005 ¶ 1. “Such delay units . . . keep[] the separating material under tension when unrolling.” *Id.* ¶ 2. The “separating material typically compris[es] a tape of film or paper material” and “is typically referred to as an ‘interleaver’ and the tape is typically referred to as an ‘interleaver strip.’” *Id.* GEA438 goes on to disclose that “[t]he delay unit according to the invention” delays “the transporting movement of the separating material . . . by exerting pressure on the separating material per se.” *Id.* ¶ 9. “For example, the separating material by means of positive pressure or by means of negative pressure can be pressed onto a bearing face or suction plate.” *Id.*

Provisur’s annotated version of Müller’s Figure 1, reproduced below, shows Provisur’s mapping of the identified limitations of claim 1 to Müller.



Provisur’s annotated version of Müller’s Figure 1 identifies limitations of claim 1 of the ’823 patent: “material” and “material store” (shaded blue); “cutting region” (shaded orange); “removal device”; and “contact surface” (shaded pink). Pet. 25.

Provisur’s annotated version of GEA438’s Figure 1, reproduced below, shows Provisur’s mapping of the identified limitations of claim 1 (as well as limitations of other challenged claims) to GEA438.



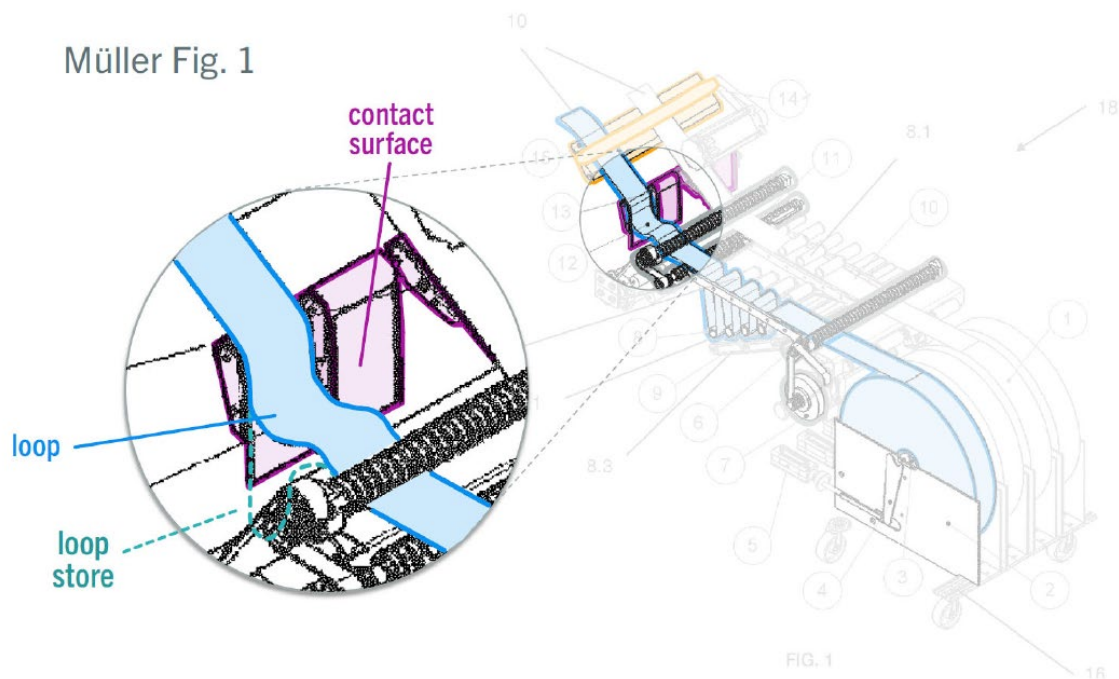
Provisur’s annotated version of GEA438’s Figure 1 identifies limitations of claim 1 of the ’823 patent: the “contact surface” of the “brake” (both shaded pink). Pet. 30.

Of particular significance, with respect to Weber’s counter-argument, is Provisur’s mapping the claimed “loop store” to the references. The relevant claim language (elements 1.3 and 1.4) recites:

[1.3] 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, the loop store having a brake for the material web that actively increases the friction for the material web;

[1.4] wherein the loop store comprises a contact surface for at least one region of the material loop at the outgoing side of the loop, wherein the contact surface belongs to the brake for the material web.

Regarding the “loop store” features mapped to Müller, Provisur (Pet. 29) refers to a further annotated version of Müller’s Figure 1, which is reproduced below.



In this annotated version of Müller’s Figure 1, Provisur includes an enlarged view of the depicted embodiment showing elements corresponding to the “loop store” limitations of claim 1: the region (i.e., the recited “space for the removed material web to form a loop”) of the “loop store” shown in dashed line format (shaded teal); the “loop” (i.e., of “material web”) (shaded blue); and the “contact surface” (shaded pink). *Id.*

Provisur maps claim 1’s “loop store” to Müller’s buffer 12, quoting Müller’s disclosure: “further buffer **12**, a loop here . . . preferably buffers only as much interleaver material as is needed for the ejection of an interleaver”; “buffer **12** preferably has an interleaver strip guide **13**, which is provided so as to be movable and which is able to enlarge or reduce the path of the interleaver strip.” Pet. 28 (quoting Ex. 1004 ¶ 48) (citing Ex. 1003 ¶¶ 142–43, 162–63). Provisur maps claim 1’s “contact surface” to Müller’s strip guide 13. *Id.* at 31 (citing Ex. 1003 ¶¶ 142–43, 157; Ex. 1004 ¶ 48).

Provisur further relies upon teachings of GEA438, as to claim 1's limitations of "a brake for the material web that actively increases the friction for the material web" and "wherein the contact surface belongs to the brake for the material web." Pet. 29–31. Specifically, Provisur cites GEA438's disclosure of "[t]he separating material is . . . braked" by the action of "[d]elay unit 1 compris[ing] a suctioning means in the form of a planar suction plate 6," wherein the advancing "tape [of separating material] is suctioned onto the suction plate 6," such that "[t]he mechanical contact between the tape and the surface of the suction plate 6 leads to a frictional contact which increases the transporting resistance of the tape." *Id.* at 29 (quoting Ex. 1005 ¶¶ 10, 31, 32) (citing Ex. 1003 ¶¶ 145–51).

Provisur's Petition goes on to argue that a person of ordinary skill in the art, at the relevant time, would have had a reason to combine the teachings of Müller and GEA438, so as to achieve what is recited in claim 1 of the '823 patent, and that such a person of ordinary skill in the art would have had a reasonable expectation of success in making the combination. *See* Pet. 32–36.

Notably, Provisur argues that a person of ordinary skill in the art, at the relevant time, would have recognized that the significance of Müller "buffers" for "even[ing] out" the advance of the material web, so as to avoid damage thereto. Pet. 32; Ex. 1004 ¶ 26 ("By means of the buffers, damage, in particular tearing of the interleaver strip, is prevented and/or the unreeling of the interleaver reels can be evened out.") Yet, Provisur contends, "Müller goes on to clarify that the solution it teaches only 'somewhat' addresses these problems" and that "Müller's buffer has room for improvement." Pet. 32 (citing Ex. 1003 ¶¶ 181–85; Ex. 1004 ¶ 26). Further, Provisur

argues, “[a] POSA would have appreciated that GEA438’s delay unit vacuum brake system was a solution to Müller’s buffer problems.” *Id.* at 33 (citing Ex. 1003 ¶¶ 179–187). Specifically:

GEA438 teaches a vacuum brake to prevent “kinks, tears, or back ups” to the paper in the situation where “braking torque is not capable of being set with the desired precision, and heavy wear is created on the interleaver rollers on account of the friction that is initiated in an artificial manner,” such as in Müller. (EX1005, [0030], [0006].) GEA438 “has the advantage that the transporting movement of the separating material is not delayed by mechanically braking an interleaver roller, but is delayed by exerting pressure on the separating material per se.” (EX1005 [0009].) GEA438 does so in a “comparatively precise and simple manner, on account of which the desired delay effect is controllable.” (EX1003, ¶151, 176; EX1005, [0009].) Indeed, GEA438 touts that with its braking, technique a practitioner can implement a brake that is “compact, lighter, cheaper, and less maintenance intensive.” (EX1003, ¶184; EX1005, [0009].) These many stated advantages of GEA438 would have given a POSA compelling reason to combine with Müller.

Pet. 33.

Provisur’s Petition proceeds to map the limitations of the other challenged claims (claims 2, 4, 5, 7, 8, 10, 12, 17, and 18) to Müller and/or GEA438, and to articulate a basis for such mapping, as well as further reasoning to support the alleged obviousness of these claims. *See* Pet. 36–46. These arguments are also supported by the unrebutted declaration testimony of Mr. Jobin. *See id.*

Weber disputes the sufficiency of Ground 1, but does not address the propriety of Provisur’s mapping of any claim limitation (of any claim) to Müller and/or GEA438. *See* Prelim. Resp. 14–24. Instead, Weber argues

that the identified teachings of Müller and GEA438 cannot be combined. *See id.* Weber’s argument focuses on Müller’s disclosure, in its Figure 1 embodiment, of two buffers — Müller’s buffer 8 and buffer 12 (*see* Ex. 1004 ¶ 48, Fig. 1):

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.

Id. at 15. Weber argues that the existence of two buffers in Müller’s Figure 1 embodiment confounds Provisur’s Ground 1, because it is unclear whether the combination of Ground 1 includes Müller’s large buffer 8. *Id.* at 16. By ignoring “Müller’s fundamental nature as a two-buffer system,” Ground 1 does not “explain how Müller’s existing large buffer could compatibly interface with GEA438’s vacuum braking system added to Müller’s smaller buffer 12.” *Id.* Alternatively, Provisur’s Ground 1 “fails to describe at all how the drastically modified system would function, having stripped away Müller’s two-buffer setup entirely.” *Id.*

Yet, as an initial matter, Provisur’s combination of Müller and GEA438 does not depend on either the presence or the absence of the two-buffer arrangement shown in Müller’s Figure 1 embodiment. Provisur maps claim 1’s “loop store defining a space for the removed web to form a loop, the loop store located between the material store and cutting region” to Müller’s buffer 12. *See* Pet. 28 (citing Ex. 1003 ¶¶ 142–43). But, claim 1 does not recite structure corresponding to a second buffer, in Provisur’s

analysis. Essentially, Weber’s arguments concern whether the embodiments of the prior art references can be put together, but “[t]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference”; “[r]ather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.” *In re Keller*, 642 F.2d 413, 425 (CCPA 1981); *see also In re Etter*, 756 F.2d 852, 859 (Fed. Cir. 1985) (en banc) (“Etter’s assertions that Azure cannot be incorporated in Ambrosio are basically irrelevant, the criterion being not whether the references could be physically combined but whether the claimed inventions are rendered obvious by the teachings of the prior art as a whole.”)

Furthermore, and contrary to Weber’s assertion, the two-buffer arrangement does not appear to be “fundamental” (Prelim. Resp. 16) to Müller’s techniques. Indeed, Müller states that its system is operable with a *single* buffer, even though two buffers would be preferable. *See* Ex. 1004 ¶ 26 (“At least one of the two buffers, preferably both buffers, is/are provided for each track and independently of each other.”); *see also id.* at claim 16 (reciting “[t]he unreeling device as claimed in claim 1, wherein the unreeling device includes at least one buffer”). Therefore, combining the teachings of Müller and GEA438, per Ground 1, would not effect a “drastic change in Müller’s basic principles,” as Weber contends. Prelim Resp. 16.

In addition, insofar as Weber contends that Müller’s two-buffer arrangement would be inconsistent with the addition of a “brake,” such as that taught in GEA438, Weber appears to misinterpret Müller’s teachings. Weber characterizes Müller as introducing interleaver strips into the cutting plane with high acceleration and “without needing a brake on the cartridge

containing the reels,” a feature that Weber appears to depict as a consequence of the two buffers shown in Müller’s Figure 1. Prelim. Resp. 17 (citing Ex. 1004 ¶¶ 7, 10, 26, 39; Pet. 20–21); *see also id.* at 18 (citing Ex. 1004 ¶ 35). Indeed, Weber proceeds to criticize the Petition for not explaining “*how* GEA438’s vacuum-based delay unit brake for a loose loop would work in Müller’s fundamentally different system — a system that obviates the need for a loose loop buffered by a vacuum brake by implementing a two-buffer arrangement.” *Id.* at 19.

But, Weber does not point to any disclosure in Müller that might indicate that the reference is antithetical to a brake acting upon the unwound interleaver strip being transported through the system toward the cutting area. Rather, the portions of Müller that Weber identifies (*see* Prelim. Resp. 17) concern only whether a brake might be used on the interleaver reel that rotates as it dispenses the wound strip of interleaver material. *See* Ex. 1004 ¶ 7 (“[T]he unreeling device has a plurality of cartridges, in which preferably respectively one interleaver reel is rotatably mounted per cartridge. The interleaver reel rotates as the interleaver strip is unreeled.”) Furthermore, Müller does not forbid using a brake on the interleaver reel, although the brake need not be part of the cartridge. *Id.* ¶¶ 10 (“According to the invention, the respective cartridge has no brake, instead the interleaver reel is braked automatically as soon as there is no need for interleaver strip, for example when a product change is taking place in the cutting device.”), 14 (“A further subject of the present invention is an unreeling device which has a multiplicity of cartridges, in which an interleaver reel is rotatably mounted, in each case, wherein each cartridge has a braking means which is activated individually.”), 48 (“Each cassette 2, which is provided in the shape of a U

in the present case, has a rotary bearing for the interleaver reel and a braking means 3, for example a brake blade 3, which brakes the respective interleaver reel as desired.”)

Beyond its arguments concerning the asserted “incompatibilities between Müller and GEA438” (Prelim. Resp. 24), Weber does not otherwise challenge the sufficiency of Ground 1.

In view of Provisur’s mapping of the challenged claim limitations to Müller and/or GEA438 and its explanation of why a person of ordinary skill in the art, at the relevant time, would have combined the references’ teachings, so as to arrive at the claimed subject matter, Provisur establishes a reasonable likelihood of showing the unpatentability of the challenged claims. Thus, Provisur satisfies the threshold requirement for instituting *inter partes* review, as to Ground 1.

2. Ground 2: Obviousness Based on Müller and DePoi

In regard to independent claim 1 of the ’823 patent, Provisur’s Ground 2 again relies upon Müller, in the same manner as in Ground 1. *See* Pet. 48, 51. However, in lieu of GEA438, Ground 2 relies upon DePoi for teachings relating to limitations 1.3 and 1.4. *Id.* at 48–53.

DePoi relates to “a sheet material feeder and, more particularly, to maintaining tension of a sheet material web in a sheet material feeder.” Ex. 1006 ¶ 1. More specifically, DePoi discloses such techniques for maintaining tension in a sheet material web “comprising a vacuum box adapted to apply a vacuum force to a sheet material web extending into the vacuum box; and a system for applying a friction force to the sheet material web proximate an exit from the vacuum box.” *Id.* ¶ 8.

Provisur’s Petition maps the features in limitations 1.3 and 1.4 to Müller and/or DePoi, with citations to the references and the supporting un rebutted declaration testimony of Mr. Jobin. *See* Pet. 48–53. Provisur also relies upon evidence from the references, along with Mr. Jobin’s un rebutted testimony, to support the position that a person of ordinary skill in the art, at the relevant time, would have had a sufficient reason to combine the teachings of Müller and DePoi, so as to achieve what is recited in claim 1 of the ’823 patent, and that such a person of ordinary skill in the art would have had a reasonable expectation of success in making the combination. *See* Pet. 53–58.

Provisur’s Petition proceeds to map the limitations of the other challenged claims (claims 2, 4, 5, 7, 8, 10, 12, 17, and 18) to Müller and/or DePoi, and to articulate a basis for such mapping, as well as further reasoning to support the alleged obviousness of these claims. *See* Pet. 58–69. These arguments are also supported by the declaration testimony of Mr. Jobin. *See id.*

Weber asserts that Ground 2 is “materially identical to” and “is infected by the same flaws of” Ground 1. Prelim. Resp. 25. Weber further contends that “it would be a waste of the Board’s resources to institute and consider Petitioner’s redundant combination” in Ground 2, because “[t]he inefficiencies in considering two wholly repetitious grounds weigh against institution.” *Id.* In support, Weber cites to the Consolidated Trial Practice Guide’s admonition that “parties should avoid submitting a repository of all the information that a judge could possibly consider.” *Id.* (quoting Consolidated Trial Practice Guide 39 (Nov. 2019)).

We do not regard Provisur's presentation of a Ground 2 to run afoul of the applicable standards.

In addition, Weber repeats its contentions raised with respect to Ground 1, i.e., "the Petition fails to address *how* DePoi's vacuum braking system is supposed to be implemented Müller's two-buffer device" and does not explain how "DePoi's vacuum braking system . . . would modify Müller's narrow contact plate and interface with Müller's short buffer 12." Prelim. Resp. 26.

Our remarks, as to Ground 1, concerning Müller's operability with a single buffer, as well as the notion that obviousness analyses address the combination of reference teachings, rather than bodily incorporation of their exact embodiments (*see Etter*, 756 F.2d at 859), apply equally, here.

In view of Provisur's mapping of the challenged claim limitations to Müller and/or DePoi and its explanation of why a person of ordinary skill in the art, at the relevant time, would have combined the references' teachings, so as to arrive at the claimed subject matter, Provisur establishes a reasonable likelihood of showing the unpatentability of the challenged claims. Thus, Provisur satisfies the threshold requirement for instituting *inter partes* review, as to Ground 2.

III. CONCLUSION

After considering the evidence and arguments presented in the current record, we determine that Provisur has demonstrated a reasonable likelihood that it would prevail with respect to claims 1, 2, 4, 5, 7, 8, 10, 12, 17, and 18 of the '823 patent, as to Grounds 1 and 2 of the Petition. Therefore, we institute *inter partes* review on all grounds presented in the Petition. *See*

SAS Inst. Inc. v. Iancu, 138 S. Ct. 1348, 1352–53, 1359–60 (2018), 37 C.F.R. § 42.108(a) (“When instituting . . . review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.”)

Further, we decline to exercise our delegated discretion to deny institution under *Fintiv*. Thus, we institute *inter partes* review.

We clarify, however, that the analysis, herein, is based only on the record as it stands now and should not be understood as final determination regarding claim construction or patentability. Further, no party should rely on any preliminary finding or determination in this Decision or assume that the evidence cited in this Decision for any preliminary finding or determination will result in a similar finding or determination in the Final Written Decision after a complete record is developed. We emphasize that no arguments from the Preliminary Response carry over to trial and any arguments not presented by Weber in a Response may be deemed to have been waived.

IV. ORDER

Accordingly, it is:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1, 2, 4, 5, 7, 8, 10, 12, 17, and 18 of the ’823 patent is hereby instituted on all the asserted grounds set forth in the Petition; 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.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PROVISUR TECHNOLOGIES, INC.,
Petitioner,

v.

WEBER MASCHINENBAU GMBH BREIDENBACH,
Patent Owner.

IPR2024-00269
Patent 11,331,823 B2

Opinion concurring filed by *Administrative Patent Judge* DEFRANCO.

Overall, I agree with the majority’s analysis of Petitioner’s asserted grounds. I write separately only to express my general disagreement with the analysis of so-called *Fintiv* factors 1 and 2 in the section addressing Patent Owner’s request for discretionary denial. *See Sand Revolution II, LLC v. Continental Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 12, at 20 (PTAB Feb. 5, 2020) (DeFranco, J., dissenting) (“[W]hile the scheduling order in the related district court litigation indicates a jury trial date of July 20, 2020, that date is by no means guaranteed. Indeed, because our institution decision would precede the scheduled jury trial by approximately five months, the district court would be free to stay the litigation pending our Final Decision, as many district courts reasonably do. Also, that a jury trial may occur in the district court before any Final

Decision would be due here does not guarantee the entry of final judgment by the district court before the time of any Final Decision on our part, as the district court litigation may still need to continue with a damages trial and post-trial motions.”).

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