

CAFC Trims the Fat from Meat Slicer Patent Dispute: Additional Evidence on Reply Was Permissible in IPR

Provisur Technologies, Inc. v. Weber, Inc. (Federal Circuit 2022)

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The Court of Appeals for the Federal Circuit (“CAFC”) [recently affirmed in part, vacated in part, and remanded](#) a Patent Trial and Appeal Board (“PTAB”) [decision](#) holding that all but two claims of a patent belonging to Provisur Technologies, Inc. (“Provisur”) were unpatentable as obvious. In doing so, the CAFC upheld the PTAB’s decision to allow the petitioner for *Inter Partes* Review (“IPR”), Weber, Inc. (“Weber”) to introduce evidence for the first time in its reply because doing so was responsive to Provisur’s arguments and because Provisur was not unfairly prejudiced by admission of the evidence.

Weber filed an IPR petition challenging U.S. Patent No. 6,997,089 (the “’089 patent”) which is directed towards a system that uses conveyor belts, slicers, and other devices to arrange slices of food products such as bacon or deli meat based on an optical image of the slice. In the petition, Weber argued that one of its prior art references disclosed a camera that could be “of any known type” and therefore taught the digital camera claimed in the ’089 patent. Provisur argued in its response that because the prior art specifically taught an analog-to-digital converter separate from the camera, it did not teach a digital camera as claimed by the ’089 patent. Weber replied by providing additional evidence of ELECTRIM digital cameras as described in the prior art including both documentation and an expert declaration. Provisur deposed Weber’s expert declarant, obtained admissions that the ELECTRIM cameras were known to Weber prior to the filing of the petition, and moved to exclude this additional evidence for violating both Federal Rule of Evidence 403 and the PTAB’s rules with its untimely submission. But, the PTAB denied Provisur’s motion and found the challenged claims unpatentable based in part on the ELECTRIM evidence. The CAFC upheld this decision.

First, the CAFC held that the PTAB did not abuse its discretion in finding that Weber did not improperly withhold the ELECTRIM evidence, reasoning that Provisur “conflate[d] capability with obligation.” Weber’s petition established a prima facie case of obviousness. The ELECTRIM evidence submitted in reply by Weber was in response to arguments made by Provisur that the prior art did not disclose a digital camera by providing evidence that the prior art used the same type of camera as the ’089 patent. The CAFC agreed with the PTAB that such responsive evidence necessarily fell outside the scope of Weber’s evidentiary burden for its petition so it was immaterial when this evidence *could* have been disclosed. Second, the CAFC held that the PTAB did not abuse its discretion in finding a lack of prejudice to Provisur in the late disclosure of the ELECTRIM evidence. As the evidence was partially dispositive, the evidence was highly probative and under the balancing test of FRE 403 was not outweighed by any unfair prejudice to Provisur. And to address any potential prejudice, Provisur did have time to depose and cross examine Weber’s expert and was permitted to file a sur-reply.

As this case is an affirmance that reviewed the PTAB merely for abuse of its discretion, it is unclear if the CAFC would have found the same had the PTAB granted Provisur’s motion to exclude. Whichever way you slice it, petitioners before the PTAB should still disclose all known probative evidence with their petitions even if it is clear that they need not be clairvoyant of the arguments that the patent owner will make it response.