

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

WEBER, INC.,
Petitioner,

v.

PROVISUR TECHNOLOGIES, INC.,
Patent Owner.

IPR2022-00599
Patent 8,408,109 B2

Before KATHERINE K. VIDAL, *Under Secretary of Commerce for
Intellectual Property and Director of the United States Patent and
Trademark Office.*

DECISION
Vacating the Final Written Decision and
Remanding to the Patent Trial and Appeal Board Panel
for Further Proceedings

I. INTRODUCTION

Weber, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1–17 of U.S. Patent No. 8,408,109 B2 (Ex. 1001, “the ’109 patent”). On August 24, 2022, the Board instituted an *inter partes* review (Paper 6), and on August 23, 2023, the Board issued a Final Written Decision (Paper 65, “Final Dec.”). The Final Written Decision determined that Petitioner had shown by a preponderance of the evidence that claims 1–15 and 17 were unpatentable, and that Petitioner had not shown that claim 16 was unpatentable. Final Dec. 87–88. The Final Written Decision also dismissed as moot Petitioner’s motion to exclude several of Patent Owner’s exhibits (Paper 48, “Motion to Exclude”), stating that the Board did not rely upon the challenged evidence. Final Dec. 86.

On September 22, 2023, Provisur Technologies, Inc. (“Patent Owner”) filed a request for Director Review. Paper 72 (“Request” or “Reh’g Req.”). In the Request, Patent Owner argues that

[t]he Board’s unpatentability decision rests on legal error and abuse of discretion because it ignores direct evidence of patentability in the record as “moot”—even though the evidence was decidedly not moot.

In its obviousness finding, the Board acknowledged that Patent Owner had submitted contested affirmative evidence of non-obviousness, such as evidence of the many known challenges in making the claimed combination known in the industry around the time of invention. (FWD, 86–88; *see* Exhibits 2024, 2026, 2027, 2028, 2035–2037, 2052–2058, 2060, 2061, 2065, 2066, 2070, and 2075.) The Board violated the APA and abused its discretion when it did not either consider the evidence on the merits or exclude the evidence. (*Id.*)

Reh’g Req. 1. Patent Owner notes that, rather than address the evidence, “[t]he Board simply declared, without explanation, ‘We do not, in this Final

Written Decision, rely on any of the contested evidence. Accordingly, Petitioner’s motion is dismissed as moot.” *Id.* (citing Final Dec. 86). Patent Owner argues that “[i]t was improper for the Board to find the claims unpatentable while ignoring Patent Owner’s evidence of patentability.” *Id.*

For the reasons set forth below, I vacate the Board’s Final Written Decision and remand to the Board for further proceedings consistent with this Decision.

II. BACKGROUND

The ’109 patent relates to a food slicing machine. Ex. 1001, code (57). Petitioner asserted that the claims were unpatentable as obvious over several combinations of references. Pet. 15–16; Final Dec. 9–10. In its briefing, Patent Owner argued that Petitioner had failed to show an adequate motivation to combine the references asserted in the Petition. As part of those arguments, Patent Owner introduced what it characterizes as “contemporaneous documentary evidence that showed those of skill in the industry would not have combined the prior art.” Reh’g Req. 4; *see* Paper 16 (“PO Resp.”), 29–30, 45–48 (citing Exs. 2024, 2026–2028, 2035, 2036, 2053, 2054, 2056, 2057, 2058, 2060, 2061); Paper 45 (“PO Sur-reply”), 2, 5–12, 16–21, 24 (citing Exs. 2026, 2028, 2035–2037, 2053, 2054, 2055, 2056, 2057, 2058, 2060, 2061, 2065, 2066, 2070, 2075). Patent Owner argues that “[t]he evidence showed Petitioner’s proposed combination would have been viewed as a major hygiene risk,” and that “[h]ygiene was a significant consideration given the ’109 patent’s food-slicing technology.” Reh’g Req. 4 (citing Ex. 2024; Ex. 2028; Ex. 2070, 2); *see* PO Resp. 29; PO Sur-reply 16, 21. Patent Owner asserts that it “also introduced industry evidence that showed—prior to the ’109 patent—no industry members had successfully developed the features embodied in the

'109 patent's claims." Reh'g Req. 5 (citing Ex. 2060, 1); *see* PO Resp. 45; PO Sur-reply 21. Patent Owner contends that its "contemporaneous evidence further demonstrated that industry figures . . . believed that developing a machine with the features of the '109 patent was technologically advanced . . . , difficult . . . and prohibited by cost." Reh'g Req. 5 (citing Ex. 2024; Ex. 2026; Ex. 2028, 6; Ex. 2035; Ex. 2036; Ex. 2060, 1; Ex. 2070, 2); *see* PO Resp. 29, 45–47; PO Sur-reply 2, 6, 18–21. Petitioner filed a motion to exclude, arguing that most of the exhibits cited in support of these arguments were inadmissible under the Federal Rules of Evidence. Paper 48 (moving to exclude Exhibits 2026, 2028, 2035–2037, 2052–2055, 2057, 2058, 2061, 2065, 2066, 2070, and 2075, but not Exhibits 2024, 2027, 2056, and 2060).

In its Final Written Decision, the Board found claims 1–15 and 17 unpatentable as obvious. In its unpatentability analysis, the Board addressed generally Patent Owner's arguments regarding Petitioner's motivation to combine the references, but did not cite or discuss Exhibits 2026–2028, 2035–2037, 2052–2058, 2060, 2061, 2065, 2066, 2070, and 2075, or address the arguments based specifically on those exhibits.¹ The only place where the Board cited any of these exhibits was when it addressed Petitioner's Motion to Exclude. Final Dec. 86. In that discussion, the Board merely stated "[w]e do not, in this Final Written Decision, rely on any of the contested evidence. Accordingly, Petitioner's motion is dismissed as moot." *Id.*

¹ I note that the Board did cite to Exhibit 2024. *See* Final Dec. 32. I also note that Patent Owner did not appear to cite Exhibit 2052 in either its Patent Owner Response or Patent Owner Sur-reply.

III. ANALYSIS

The Board must decide dispositive issues properly before it, even if they are contrary to its ultimate conclusion. *See Parus Holdings, Inc. v. Google LLC*, 70 F.4th 1365, 1372 (Fed. Cir. 2023). Here, I find that Board failed to address Patent Owner’s evidence supporting its arguments on motivation to combine. Patent Owner argued that Exhibits 2024, 2026–2028, 2035–2037, 2053–2058, 2060, 2061, 2065, 2066, 2070, and 2075 supported its arguments that a person of ordinary skill in the art would not have been motivated to combine the references in the manner asserted by Petitioner. PO Resp. 29–30, 45–48 (citing Exs. 2024, 2026–2028, 2035, 2036, 2053, 2054, 2056, 2057, 2058, 2060, 2061); PO Sur-reply 2, 5–12, 16–21, 24 (citing Exs. 2026, 2028, 2035–2037, 2053–2058, 2060, 2061, 2065, 2066, 2070, 2075). Petitioner moved to exclude most of this evidence as inadmissible under the Federal Rules of Evidence. *See* Paper 48.

Although the Board properly considered most of Patent Owner’s arguments regarding the sufficiency of Petitioner’s motivation to combine showing, it failed to evaluate Patent Owner’s disputed Exhibits for its arguments in this regard or in relation to Petitioner’s related Motion to Exclude. Instead, the Board dismissed Petitioner’s Motion to Exclude as moot because the Board “did not rely on any of the contested evidence.”² *See* Final Dec. 86. That explanation did not adequately address the disputed evidence. The Board could not, as the statement suggests, reject Patent Owner’s arguments on motivation to combine without either considering the disputed evidence proffered by Patent Owner in support of those arguments or excluding that

² As noted above, although the Board did cite to Exhibit 2024, it is not clear whether (or how) the Board considered this exhibit.

evidence. Having found the claims unpatentable as obvious, it was incumbent on the Board either to consider and address Patent Owner's properly submitted evidence, or to exclude the exhibits based on Petitioner's Motion to Exclude.³

On remand, the Board shall address Exhibits 2024, 2026–2028, 2035–2037, 2052–2058, 2060, 2061, 2065, 2066, 2070, and 2075. I leave it to the Board to determine whether this evidence should be excluded or considered. For any evidence that is considered, the Board should address the impact (if any) of the evidence on the obviousness analysis (including the weight that should be given) and provide a reasoned explanation to support its determination.

IV. CONCLUSION

I find that the Board should have either (i) considered Patent Owner's evidence (as noted above), when determining whether Petitioner has sufficiently established a motivation to combine the cited references, or (ii) excluded the evidence in response to Petitioner's Motion to Exclude. Accordingly, I vacate the Board's Final Written Decision and remand to the Board to proceed consistent with this Decision.

³ My decision here should not be mistaken as requiring that the Board must discuss every exhibit in the record or argument however cursory. *See Parus Holdings*, 70 F.4th at 1372 (noting that the Board does not have to “review evidence and issues introduced by a party in violation of its rules or not introduced at all”).

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Board's Final Written Decision is vacated; and

FURTHER ORDERED that the case is remanded to the Board for further proceedings consistent with this Decision.

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