PROVISUR TECHNOLOGIES, INC. v. WEBER, INC., Appeal No. 2021-1942, 1975 (Fed. Cir. September 27, 2022). Before Prost, Reyna, and Stark. Appealed from the P.T.A.B.

Background:

Weber filed an IPR petition challenging the validity of Provisur's patent. Provisur's patent is directed to classifying groups of sliced food (e.g., bacon) based on image data of a top slice of the food and determining, for example, the surface area and fat content of the top slice. Weber argued, among other things, that the cited art teaches the claimed "determining a surface area of the top slice," i.e., the "surface-area limitations."

First, the Board concluded that the cited references teach the "surface-area limitations" of the independent claims based on (i) Weber's arguments and evidence and (ii) the fact that Provisur had not disputed that Weber had shown that the combined teachings of the cited art teach the "surface-area limitations." Second, the Board concluded that dependent claims 11 and 12, which additionally recite the physical arrangement of a camera over a weight conveyor, are valid. Provisur appealed and Weber cross-appealed.

Issue/Holding:

Did the Board err in its finding of validity/invalidity? Yes, vacated-in-part and remanded.

Discussion:

The Federal Circuit found that the Board erred by failing to address Provisur's argument that Weber failed to explain how the prior art combinations teach the "surface-area limitations." The Federal Circuit stated that under the Administrative Procedures Act (APA) the Board must fully and particularly set out the bases upon which it reached its decision. Here, the Board focused its analysis on a separate issue regarding an evidentiary dispute with regard to a "digital image receiving device" in the independent system claim. Regarding the "surface-area limitations," the Board adopted Weber's arguments as its own, based in part on a presumption that Provisur had not disputed these arguments. However, the Federal Circuit held, citing the parties' responses on the record, that Provisur plainly argued this point and that Weber had even responded to Provisur's argument. Accordingly, the Federal Circuit found that the Board's failure to address Provisur's argument, as well as its failure to document its reasoning for combining the prior art on the record, had violated the APA such that it was unable to engage in meaningful appellate review.

Regarding Weber's cross-appeal of claims 11 and 12, the question before the Federal Circuit was whether the teachings of a secondary reference (Wyslotsky) taught the recited physical arrangement. Here, Provisur argued that Weber had failed to identify a motivation for incorporating Wyslotsky's structure. However, the Federal Circuit agreed with Weber's application of the cited art, that the base references taught the physical structure, and that Wyslotsky taught why a skilled artisan would arrange the positions of the physical structure as recited. Importantly, the Federal Circuit noted that the Board had inconsistently applied Wyslotsky to claims 11 and 12 and to claims 2, 6, and 7. The Federal Circuit resolved this inconsistency and determined that, if the Board once again found the independent claims to be unpatentable on remand, then dependent claims 11 and 12 should also be found unpatentable.


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