

No. _____

IN THE
Supreme Court of the United States

PROVISUR TECHNOLOGIES, INC.,
Petitioner,

v.

WEBER, INC.,
Respondent.

*ON PETITION FOR A WRIT OF CERTIORARI TO
THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT*

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

The questions presented by the decision below are:

- I. Whether the Federal Circuit applied an incorrect standard of review for appeals of a Judgment as a Matter of Law (JMOL) and, as a result, improperly assumed the role of factfinder in overturning a jury verdict of willful patent infringement?
- II. Whether the Seventh Amendment permits the Federal Circuit to reexamine a jury's factual findings and credibility determinations in reaching a verdict of willful patent infringement?

PARTIES TO THE PROCEEDING

Petitioner, who was Appellee below, is Provisur Technologies, Inc. Respondent is Weber, Inc., and was Appellant below.

RULE 29.6 DISCLOSURE STATEMENT

Petitioner Provisur Technologies, Inc. is owned by Provisur S LLC. Provisur S LLC has no parent corporations and no publicly held company owns 10% or more of its stock.

RELATED PROCEEDINGS

Provisur states that the below listed proceedings are directly related to the case in this Court within the meaning of Rule 14.1(b)(iii):

- *Provisur Technologies, Inc. v. Weber, Inc.*, No. 5:19-cv-06021, U. S. District Court for the Western District of Missouri. Judgment entered October 28, 2022.
- *Provisur Technologies, Inc. v. Weber, Inc.*, No. 5:20-cv-06069, U. S. District Court for the Western District of Missouri. Judgment entered October 28, 2022.
- *Provisur Technologies, Inc. v. Weber, Inc.*, No. 23-1438, U. S. Court of Appeals for the Federal Circuit. Judgment entered October 2, 2024.

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PETITION FOR A WRIT OF CERTIORARI

Petitioner Provisur Technologies, Inc. (“Petitioner” or “Provisur”) respectfully petitions for a writ of *certiorari* to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.

OPINIONS BELOW

A panel of the Federal Circuit’s decision affirming in part, reversing in part, and remanding the United States District Court for the Western District of Missouri’s denial of judgment as a matter of law of noninfringement and no willfulness of claims 9-12 and 16 of U.S. Patent No. 10,625,436, claims 1, 7, and 8 of U.S. Patent No. 10,639,812, and claim 14 of U.S. Patent No. 7,065,936 is reported at 119 F.4th 948 (Fed. Cir. 2024), and reprinted in the Appendix (“App.”) at App. 1a-19a.

The decision of the District Court for the Western District of Missouri denying Weber’s motion for judgment as a matter of law is entered at Case No. 5:19-cv-06021-SRB (Jan. 9, 2023), and reprinted at App. 38a-42a.

JURISDICTION

The Federal Circuit entered judgment on October 2, 2024. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS

The Seventh Amendment provides in relevant part:

[T]he right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise reexamined in any court of the United States, than according to the rules of the common law.

35 U.S.C. § 298 provides:

The failure of an infringer to obtain the advice of counsel with respect to any allegedly infringed patent, or the failure of the infringer to present such advice to the court or jury, may not be used to prove that the accused infringer willfully infringed the patent or that the infringer intended to induce infringement of the patent.

STATEMENT OF THE CASE

Petitioner Provisur Technologies, Inc. (“Provisur”) seeks certiorari because a panel of the Federal Circuit (the “Panel”) improperly overturned a jury finding of willful infringement when it held that the United States District Court for the Western District of Missouri erred in denying Respondent Weber, Inc.’s (“Weber”) motion for judgment as a matter of law (“JMOL”).

The Panel’s decision to reverse the district court’s JMOL ruling was based on the Panel’s own reassessment of the evidence presented to the jury at trial. Rather than crediting the jury’s factual determination that Weber willfully infringed Provisur’s patents—and without viewing the evidence in the light most favorable to Provisur or giving Provisur the benefit of all favorable inferences that may reasonably be drawn—the Federal Circuit stepped into the role of factfinder, undertaking its own evaluation and weighing of the trial evidence. In overturning the jury’s verdict, the Panel discounted Provisur’s evidence demonstrating that Weber was aware of Provisur’s patents and knew they were highly relevant to Weber’s business; disregarded evidence showing Weber concealed its knowledge of the asserted patents and other evidence demonstrating the lack of credibility of Weber’s witnesses; and robbed the jury of its ability to make and rely upon inferences regarding such evidence. Based on the evidence presented, the jury was entitled to conclude, as the district court did in awarding Provisur enhanced damages, that Weber intentionally copied Provisur’s patented innovations and that its

willful infringement was an “egregious case[] of misconduct.” App. 36a.

Compounding the error, the Panel arrived at its improper fact finding by improperly disregarding testimony of Provisur’s expert witness. Specifically, the Panel held that Provisur presented expert testimony violating 35 U.S.C. § 298, which prohibits a patentee from using an alleged infringer’s failure to consult counsel as evidence of willful infringement. The Panel’s Section 298 ruling was improper because it was not based on testimony at all—rather the Panel relied on information contained in Provisur’s expert’s report, which was never part of the trial record and never before the jury.

The Panel’s decision to overturn the jury verdict was legally improper in two critical respects. First, the Panel misapplied the standard of review for a JMOL decision, which requires construing all facts in favor of the non-movant (Provisur) and giving the non-movant all favorable inferences that can be drawn. *Holmes v. Slay*, 895 F.3d 993, 1001 (8th Cir. 2018); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255 (1986).

Second, the Panel’s decision violated Provisur’s fundamental right to a jury trial under the Reexamination Clause of the Seventh Amendment, which dictates that “the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise reexamined in any court of the United States.” The Seventh Amendment is vitally important to our nation’s justice system. James Madison, in proposing the Bill of Rights to the Constitution, called trial by jury in civil cases “as essential to secur[ing]

the liberty of the people as any one of the pre-existent rights of nature.” 1 ANNALS OF CONG. 454 (1789) (Joseph Gales ed., 1834). Centuries later, Chief Justice Rehnquist wrote, “[t]he [F]ounders of our Nation considered the right of trial by jury in civil cases an important bulwark against tyranny and corruption, a safeguard too precious to be left to the whim of the sovereign, or, it might be added, to that of the judiciary.” *Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 343 (1979) (Rehnquist, J., dissenting).

The Seventh Amendment applies with equal force to patent owners facing infringement. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 377 (1996). Nonetheless, the rate at which the Federal Circuit overturns jury verdicts has increased significantly in recent years. Academics and practitioners alike believe that guidance from this Court relevant to the Federal Circuit’s adherence to the Seventh Amendment is critical at this juncture.

For these reasons, this case presents an opportunity for the Court to address the critical issue regarding the sanctity of jury verdicts in the patent context.

I. Factual and Procedural History Below

Provisur is an industry-leading designer and seller of commercial food slicing machines and related products. Through its brand Formax, Provisur has been a leading force in the U.S. and global food processing markets since developing the first high-capacity food forming system more than 45 years ago. Provisur has driven innovation in the food processing industry and has diligently sought and received

numerous patents for its innovations, including scales, slicers, scanners, loading conveyors, and pick-and-place robotics that prepare a variety of deli meats, cheeses, and bacon. Like Provisur, Weber designs, manufactures, and sells industrial food processing machinery, including slicers and food packing machines.

The two Provisur patents at issue in this petition are U.S. Patent Nos. 10,625,436 and 10,639,812, which relate to high-speed mechanical slicers for use in food processing and packaging plants. App. 2a. Provisur filed its first infringement action against Weber on February 22, 2019, *Provisur I* (No. 19cv06021), Dkt. 1, and a second infringement action on May 6, 2020, *Provisur II* (No. 20cv06069), Dkt. 1, for infringement of the '812 and '436 patents, among others. On July 28, 2022, the Court consolidated the two cases (*Provisur II*, Dkt. 289), and in October 2022, a jury trial commenced on Provisur's infringement claims.

Over the course of a nine-day trial, Provisur presented the jury with extensive evidence demonstrating that Weber's accused products infringed the patents in suit—including technical documentation, product videos, and the testimony of Provisur's technical expert. The jury also heard extensive evidence that Weber's infringement was willful, as discussed further below. In particular, Provisur presented un rebutted evidence from its expert, Mr. John White, about industry standards for intellectual property management and Weber's failure to adhere to those standards. *See, e.g.*, D.I. 508 Trial Tr. 656:24-657:8. Provisur also presented

evidence that Weber had systematically tracked and rated Provisur's patented technologies using a sophisticated software program known as PATOffice, which automatically monitored and rated Provisur's patents. D.I. 508 Trial Tr. 625:6-657:8. In Weber's PATOffice "patent matrix," Weber's employees rated the patents at issue here with a "3" (the highest possible score), indicating that the Provisur patents at issue were highly relevant to Weber's business. D.I. 508 Trial Tr. 626:11-627:16; 641:8-16; 644:23-645:17; 650:19-651:5. The documentary evidence showed that multiple Weber personnel reviewed and rated the patents at issue—including several high-ranking Weber employees. Yet these witnesses incredibly denied, under oath, any knowledge of the asserted patents. *See* D.I. 508 Trial Tr. 597:7 (video deposition wherein Weber witnesses denied knowledge of Provisur's patents under oath); D.I. 508 Trial Tr. 641:10-16 (evidence of Weber employees rating Provisur patents with a score of "3"); 645:5-14 (same); 651:1-5 (same). Weber did not offer any evidence that it had a good-faith belief that its products did not infringe Provisur's patents.

At the trial's conclusion, the jury deliberated for less than four hours before reaching their verdict that Weber had willfully infringed the '436 patent, the '812 patent, and a third patent not at issue in this petition, but that Weber had not infringed the remaining Provisur patent. For the Provisur patents that the jury determined Weber infringed, the jury awarded Provisur the full amount of damages: \$3,747,046.50 for the '436 patent, \$3,747,046.50 for the '812 patent, and \$3,013,068 for the third patent.

Following the verdict, Weber moved for JMOL on the issues of infringement and willfulness pursuant to Federal Rule of Civil Procedure Rule 50(b) and for a new trial on infringement, willfulness, and damages pursuant to Rule 59. App. 38a-39a. The district court denied both motions. App. 42a. At the same time, Provisur moved for enhanced damages on the issue of willful infringement. *See* D.I. 498. The district court granted Provisur’s motion and doubled its damages award, holding, among other things, that “the evidence show[ed] that [Weber] intentionally copied [Provisur’s] patented ideas,” Weber did not follow any “standard industry practices to avoid infringement,” Weber “fail[ed] to engage in remedial action,” Weber “had a motivation to harm” Provisur, and this was “an egregious case[] of misconduct beyond typical infringement.” App. 25a, 27a, 34a, 35a, 36a.

Weber appealed the district court’s denial of its JMOL and Rule 50(b) motions¹ and argued, in pertinent part, that the trial evidence was insufficient to support the jury’s finding that Weber willfully infringed Provisur’s patents. App. 12a. More specifically, Weber argued that Mr. White’s testimony concerning Weber’s failure to comply with industry norms for intellectual property management was inadmissible pursuant to Section 298, and that evidence that Weber rated Provisur’s patents and then sought to conceal its knowledge of the patents was irrelevant to willfulness. *See* D.I. 15 at 32.

¹ Weber did not appeal the district court’s enhanced damages order.

On appeal, the Panel reversed, agreeing with Weber that Provisur’s expert testimony on Weber’s failure to adhere to industry standards was inadmissible, and that the remaining evidence was insufficient to establish willfulness, which requires a patentee to show that the accused infringer had a specific intent to infringe at the time of the challenged conduct. App. 12a-14a.

REASONS FOR GRANTING THE PETITION

The Panel’s decision offers the Court an opportunity to provide much-needed guidance regarding the extent to which the Federal Circuit may substitute its judgment on issues of fact for that of the jury under either the Reexamination Clause of the Seventh Amendment or the JMOL standard of review articulated by this Court, the Eighth Circuit, and numerous other circuit courts.

I. The Federal Circuit Did Not Apply the Correct Standard of Review for the Denial of a Motion for JMOL.

A court may grant a motion for judgment as a matter of law if it finds that “a reasonable jury would not have a legally sufficient evidentiary basis to find for the party on that issue.” Fed. R. Civ. Pro. 50(a)(1). Here, the district court found that “[a] reasonable jury could have found for [Provisur] under the evidence and applicable law,” and therefore denied Weber’s motion for JMOL. App. 40a. But despite the ample evidence in the record supporting the jury’s finding of willful infringement, the Panel disagreed with the district court, disregarding the correct standard of review for the denial of a JMOL motion—which, per

this Court, the Eighth Circuit, and many other circuit courts, requires deference to the jury’s verdict—and taking on the role of factfinder. Based on the Panel’s own reassessment of the evidence presented at trial—and, notably, its consideration of certain information *not* in the trial record – the Panel reversed the district court’s denial of judgment as a matter of law of noninfringement and willfulness,² thereby overturning the jury’s verdict of willful patent infringement.

A. The JMOL Standard.

A district court’s grant or denial of JMOL is reviewed under the standard of the regional circuit, as noted by the Federal Circuit in its Opinion. App. 6a (citing *Apple Inc. v. Wi-LAN Inc.*, 25 F.4th 960, 969 (Fed. Cir. 2022)). The Eighth Circuit reviews JMOL rulings de novo, applying the same standard as the district court. App. 6a (citing *Penford Corp. v. Nat’l Union Fire Ins. Co. of Pittsburgh, PA*, 662 F.3d 497, 503 (8th Cir. 2011)). The Panel noted that a court may render judgment as a matter of law when “there is no legally sufficient evidentiary basis for a reasonable jury to find for the nonmoving party on an issue and all of the evidence directs against a finding for the nonmoving party.” App. 6a (quoting *Jones v. TEK Indus., Inc.*, 319 F.3d 355, 358 (8th Cir. 2003)).

This Court and numerous circuit courts across the nation require that jury verdicts be reviewed with

² The Federal Circuit improperly substituted its judgment for that of the jury with respect to the jury’s factual findings of both infringement and willfulness. However, the focus of this petition is the willfulness finding.

ample deference to the jury's findings. This Court has held that when a party moves for judgment as a matter of law, the court should "review all of the evidence in the record," and "draw all reasonable inferences in favor of the nonmoving party," without making credibility determinations or weighing the evidence, and the court "must disregard all evidence favorable to the moving party that the jury is not required to believe." *Reeves v. Sanderson Plumbing Prods., Inc.*, 530 U.S. 133, 150-51 (2000). "Credibility determinations, the weighing of the evidence, and the drawing of legitimate inferences from the facts are jury functions [E]vidence of the non-movant is to be believed, and all justifiable inferences are to be drawn in his favor." *Anderson*, 477 U.S. at 255. Circuit courts across the country have also emphasized the deference that must be applied in reviewing jury verdicts. *See, e.g., Duke v. Uniroyal Inc.*, 928 F.2d 1413, 1417 (4th Cir. 1991) ("When determining whether the evidence is sufficient to support the jury's verdict, the evidence must be reviewed in the light most favorable to plaintiffs, giving them the benefit of all inferences. If, with that evidence, a reasonable jury could return a verdict in favor of plaintiffs, the court must defer to the judgment of the jury, even if the court's judgment on the evidence differs."); *Rideau v. Parkem Indus. Services, Inc.*, 917 F.2d 892, 897 (5th Cir. 1990) ("On appeal, we are bound to view the evidence and all reasonable inferences in the light most favorable to the jury's determination."); *King v. Deutsche Dampfs-Ges*, 523 F.2d 1042, 1044-45 (2d Cir. 1975) ("On appeal we are no more free than the district court to ignore evidence favorable to plaintiff or to set aside the jury verdict merely because the jury could have drawn different inferences . . .").

The Eighth Circuit adheres to the same principle of deference in reviewing jury verdicts as this Court and other circuit courts. The Eighth Circuit’s review of a jury verdict is “extremely deferential” – the Eighth Circuit “will not reverse for insufficient evidence unless after viewing the evidence in the light most favorable to the verdict, we conclude that no reasonable juror would have returned a verdict for the non-moving party.” *Holmes*, 895 F.3d at 1001. As elaborated by the district court, a motion for judgment as a matter of law may be granted only when there is a “complete absence of probative facts to support the conclusion reached so that no reasonable juror could have found for the nonmoving party.” App. 39a-40a (quoting *Foster v. Time Warner Ent. Co.*, 250 F.3d 1189, 1194 (8th Cir. 2001)). The jury’s verdict must be affirmed “unless, viewing the evidence in the light most favorable to the prevailing party, . . . a reasonable jury could not have found for that party.” App. 39a (quoting *Hite v. Vermeer Mfg. Co.*, 446 F.3d 858, 865 (8th Cir. 2006)).

In ruling on a motion for JMOL, courts review “sufficiency of the evidence in the light most favorable to the verdict, drawing all reasonable inferences in favor of the nonmoving party.” *Bennett v. Riceland Foods, Inc.*, 721 F.3d 546, 551 (8th Cir. 2013). Specifically, “the district court must (1) consider the evidence in the light most favorable to the prevailing party, (2) assume that all conflicts in the evidence were resolved in favor of the prevailing party, (3) assume as proved all facts that the prevailing party’s evidence tended to prove, and (4) give the prevailing party the benefit of all favorable inferences that may reasonably be drawn from the facts proved.” *Ryan*

Data Exch., Ltd. v. Graco, Inc., 913 F.3d 726, 732-33 (8th Cir. 2019) (citation omitted).

The Eighth Circuit has made it clear that courts are “not free to reweigh the evidence and set aside the jury verdict merely because the jury could have drawn different inferences or conclusions or because judges feel that other results are more reasonable.” *Fireman’s Fund Ins. Co. v. Aalco Wrecking Co.*, 466 F.2d 179, 186 (8th Cir. 1972). “[T]he law places a high standard on overturning a jury verdict because of the danger that the jury’s rightful province will be invaded when judgment as a matter of law is misused.” *Ryan Data*, 913 F.3d at 732.

As this Court explained in *Cone v. West Virginia Pulp & Paper Co.*, “[d]etermination of whether a new trial should be granted or a judgment entered under Rule 50(b) calls for the judgment in the first instance of the judge who saw and heard the witnesses and has the feel of the case which no appellate printed transcript can impart.” 330 U.S. 212, 216 (1947). Trial judges “have the unique opportunity to consider the evidence in the living courtroom context, while appellate judges see only the cold paper record.” *Gasperini v. Ctr. for Humanities, Inc.*, 518 U.S. 415, 438 (1996). This Court has also recognized that the appellate function is “limited to deciding the issues raised on appeal by the parties, deciding these issues only on the basis of the record made below,” and “requiring appropriate deference be applied to the review of fact findings.” *Apple Inc. v. Samsung Elecs. Co.*, 839 F.3d 1034, 1039 (2016).

B. Provisur Presented Evidence Supporting the Jury’s Willfulness Finding.

Willful infringement is a question of fact reviewed for substantial evidence. *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1341-42 (Fed. Cir. 2016). To establish willfulness, the patentee must show that the accused infringer had a specific intent to infringe at the time of the challenged conduct. *Bayer Healthcare LLC v. Baxalta Inc.*, 989 F.3d 964, 987 (Fed. Cir. 2021). “Specific intent” is not necessarily actual intent; if the infringement risk was “so obvious that it *should have been known*,” specific intent exists. *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 579 U.S. 93, 97 (2016) (emphasis added). Similarly, “reckless disregard” of patent rights is sufficient to find specific intent. *Ironburg Inventions Ltd. v. Valve Corp.*, 64 F.4th 1274, 1296 (Fed. Cir. 2023). Specific intent may be inferred from circumstantial evidence. *Centripetal Networks, LLC v. Palo Alto Networks, Inc.*, No. 2:21-CV-00137, 2024 WL 23133 at *9 (E.D. Va. Jan. 2, 2024).

In reviewing a denial of a JMOL motion on willfulness, the court of appeals “will not second-guess the jury or substitute [the court’s] judgment for its judgment where the verdict is supported by substantial evidence.” *Arctic Cat Inc. v. Bombardier Recreational Prods. Inc.*, 876 F.3d 1350, 1371 (Fed. Cir. 2017). Willfulness is “a classical jury question of intent. When trial is had to a jury, the issue should be decided by the jury.” *Kohler*, 829 F.3d at 1341 “[A]s with any question of fact, the fact-finder (here, the jury) [i]s entitled to credit [one party]’s evidence over

[another]’s,” and the appellate court must “not substitute [its] view of the conflicting evidence for that of the jury.” *Id.* at 1336.

At trial, Provisur presented more than enough evidence for a reasonable jury to determine that Weber had willfully infringed Provisur’s patents. The jury was instructed that, in determining whether Weber acted willfully in infringing Provisur’s patents, it should consider facts such as: “whether Weber acted consistently with the standards of behavior for its industry;” “whether Weber intentionally copied a product of Provisur’s that is covered by the asserted patent claims;” “whether Weber reasonably believed it did not infringe or that the patent was invalid;” “whether Weber made a good-faith effort to avoid infringing . . . any of [the] patents, for example, whether Weber attempted to design around the asserted patents;” and “whether Weber tried to cover up its patent infringement.” D.I. 485 (Jury Instructions) at 30.

The evidence Provisur presented at trial demonstrates Weber’s willfulness with respect to the factors the jury was instructed to consider. Among other evidence probative of willfulness, Provisur presented evidence showing that Weber was well aware of Provisur’s patents and knew that they were highly relevant to Weber’s business, yet did nothing to avoid infringing the patents; Weber concealed and repeatedly lied about its knowledge of the asserted patents; and Weber failed to observe industry standards for avoiding patent infringement. Weber, on the other hand, could not present a single employee

to testify about any belief of invalidity or non-infringement of the asserted patents.

Provisur presented evidence showing that Weber Germany had a sophisticated Patent Management Group (“PMG”) that used an AI-enabled software system, PATOffice, for monitoring and rating Provisur’s patent portfolio. D.I. 508 Trial Tr. 625:6-657:8. The software automatically scored Provisur’s patents, and assigned a high score to the asserted patents. D.I. 508 Trial Tr. 626:11-627:16; 641:8-16; 644:23-645:17; 650:19-651:5. In addition to the score generated by the software, Weber’s employees assigned their own rating; numerous individuals at Weber, including high-ranking employees, rated each of Provisur’s patents a “3,” which was the highest score available. D.I. 508 Trial Tr. 641:10-16 (evidence of Weber employees rating Provisur patents with a score of “3”); 645:5-14 (same); 651:1-5 (same). Those ratings confirmed Weber’s understanding that Provisur’s patents were highly relevant to Weber’s business.

Weber, on the other hand, could not provide a single employee to testify as to “any belief of invalidity or non-infringement of the asserted patents” (App. 27a) – another fact the jury was instructed to consider in determining willfulness. In fact, Tobias Weber, Weber Germany’s CEO, testified that Weber had no system to avoid patent infringement. D.I. 510 Trial Tr. 1158:14-17. Jarrod McCarroll, Weber U.S.’s CEO, testified that he had no idea if Weber had a system to avoid patent infringement; although he agreed he was responsible for Weber’s compliance with U.S. patent laws, Mr. McCarroll had no knowledge of how that

would happen and had “no involvement in patents.” D.I. 507 Trial Tr. 349:16-350:1, 398:1-14, 426:3-427:14, 436:19-438:1. Nonetheless, McCarroll testified that he verified Weber’s interrogatory responses relating to Weber’s knowledge and awareness of the patents, yet did nothing to verify the interrogatory responses. *Id.*

Provisur’s evidence further showed that, although Weber’s knowledge of the asserted patents was clearly documented in Weber’s patent scoring matrix, Weber’s deposition witnesses—who knew that Weber had withheld its patent matrix from discovery—denied knowledge of Provisur’s patents under oath. The jury saw excerpts of the videotaped depositions of these witnesses (Mr. Joachim Schaub, Mr. Marco Nichau, Mr. Joerg Schmeiser, and Mr. Ingo Rother) in which each witness denied his knowledge of the patents. *See* D.I. 508 Trial Tr. 597:7 (video depositions wherein Weber witnesses denied knowledge of Provisur’s patents under oath); D.I. 508 Trial Tr. 641:10-16 (evidence of Weber employees reviewing and rating Provisur patents with a score of “3”); 645:5-646:7 (same); 647:2-648:8 (same). Mr. McCarroll also signed numerous verified interrogatory responses relating to each Defendant’s knowledge of the asserted patents. As Mr. McCarroll testified, he verified those responses without any knowledge about their accuracy, and contrary to Mr. McCarroll’s testimony at trial, he verified that the Weber U.S. entity had knowledge of the patents. D.I. 507 Trial Tr. 415:13-438:3. And Mr. White testified that he did not have access to the PATOffice spreadsheet until after his initial report and deposition. D.I. 508 Trial Tr. 696:14-697:12. As

discussed further below, the jury was entitled to infer from Weber's concealment of its knowledge of the asserted patents that Weber had knowledge of its infringement, which supports the jury's finding of willful infringement.

Furthermore, as acknowledged by the district court in awarding Provisur enhanced damages, Provisur presented evidence showing that "Defendants intentionally copied Plaintiff's patented ideas." App. 25a. Specifically, in addition to Provisur's evidence of Weber's systematic monitoring and rating of the asserted patents (D.I. 508 Trial Tr. 627:1-629:12), and later sales of the same ideas and designs, the jury heard evidence that Weber's chief technology officer, Joerg Schmeiser, told his subordinates that he would do "[w]hatever it takes" to compete with Provisur. D.I. 507 Trial Tr. 377:7-9, 385:18-386:1. Schmeiser collected detailed notes on the designs of Formax's machines from Weber employees. *See id.* And, as the jury found, Weber developed products that successfully embodied Provisur's patented technology. D.I. 509 Trial Tr. 843:2-23, 848:5-17, 890:3-22, 896:10-897:9, 924:5-21, 947:1-11. The jury also heard testimony that Jarrod McCarroll told Weber employees that "nothing's off limits" with respect to strategies for competing with Provisur D.I. 507 Trial Tr. 386:14-25.

Finally, Provisur presented powerful evidence, through testimony given by Mr. White—one of the country's foremost intellectual property management experts—that Weber failed to observe industry

standards for intellectual property management.³ D.I. 508 Trial Tr. 606:2-16 (Mr. White testifying that Weber did not “comply with the industry standards for avoiding patent infringement.”). Mr. White testified that Weber was plainly aware of Provisur’s patents but did nothing else; Weber did not conduct a landscape search, a background search, a state of the art search, or a freedom to operate analysis regarding the patents. Nor did Weber attempt to design around, license, or file an IPR of the patents, all of which are standard industry practices to avoid infringement risks. D.I. 508 Trial Tr. 652:8-658:21 (Mr. White testifying that Weber failed to take multiple steps to avoid patent infringement consistent with industry standards; these failures include Weber’s failure to investigate the patent, failure to consult a third party such as Weber’s PATOffice programming, failure to conduct a landscape search, failure to conduct a background search, and failure to conduct a freedom to operate analysis). Notably, Weber did not call any expert witness to rebut Mr. White’s testimony.

The evidence Provisur presented showing that Weber failed to adhere to industry standards for intellectual property management is exactly the type of evidence that supports a finding of willfulness. *See, e.g., Green Mountain Glass LLC v. Saint-Gobain Containers, Inc.*, 300 F. Supp. 3d 610, 621-22 (D. Del. 2018) (evidence of the alleged infringer’s failure to investigate the scope of the patent or form a good-faith belief that the patent was invalid or not infringed,

³ As discussed below, *infra* I(C), the Panel ruled that this testimony was inadmissible based on the Panel’s improper reliance on information contained in Mr. White’s expert report, which was not part of the trial record.

along with evidence of the infringer’s attempts to conceal its infringement, was sufficient to support jury finding of willfulness); *WCM Indus., Inc. v. IPS Corp.*, 721 Fed. App’x. 959, 970-71 (Fed. Cir. 2018) (finding sufficient evidence to support jury finding of willful infringement, including evidence of infringer’s monitoring of patentee’s products and failure to conduct an investigation).

Taken together, this evidence is more than sufficient to support a finding of willful infringement.

C. The Federal Circuit Improperly Discounted Evidence of Weber’s Willful Infringement.

As outlined above, Provisur presented ample evidence that Weber willfully infringed Provisur’s patents. But rather than crediting the jury’s factual finding of willful infringement and viewing the evidence in the light most favorable to Provisur—as the Panel was required to do under the deferential JMOL standard dictated by this Court, the Eighth Circuit, and many other circuit courts—the Federal Circuit systematically discounted or disregarded Provisur’s evidence. In doing so, the Panel improperly invaded the purview of the jury and engaged in a reweighing of the evidence.

The Federal Circuit ruled that: (1) Mr. White’s testimony about Weber’s failure to consult a third party to evaluate the infringed patents violated 35 U.S.C. § 298 and therefore was inadmissible; and (2) the remainder of Mr. White’s testimony, concerning Weber’s patent matrix that tracked patents in related food processing technologies, was “insufficient as a

matter of law to establish willfulness.” App. 14a. In ruling that Mr. White’s testimony on industry standards was inadmissible, the Federal Circuit improperly considered information contained in Mr. White’s expert report, which was not part of the trial record. But even if that portion of Mr. White’s testimony was properly excluded, the jury’s willfulness finding was amply supported by other evidence in the record—in particular, the evidence relating to Weber’s patent matrix in conjunction with Weber’s concealment of its knowledge of the asserted patents—which the jury was entitled to credit.

i. The Federal Circuit Improperly Considered Evidence Outside of the Record in Ruling that Mr. White’s Testimony Violated 35 U.S.C. § 298.

The foundation of the Federal Circuit’s opinion on willfulness was its determination that Mr. White’s testimony on Weber’s failure to adhere to industry standards violated 35 U.S.C. § 298 and therefore was inadmissible. Section 298 states that the failure of an accused infringer’s failure to obtain the advice of counsel may not be used as an element of proof that the accused infringer willfully infringed. Prior to trial, the district court granted a motion by Weber to exclude testimony from Mr. White concerning Weber’s failure to obtain advice of counsel.⁴ App. 55a-56a.

⁴ The jury was also instructed not to consider the fact that Weber did not obtain a legal opinion in determining whether Weber acted willfully in infringing the asserted patents. D.I. 485 at 30 (“You may not assume that merely because Weber did not obtain a legal opinion about whether it infringed the Asserted Patents that the opinion would have been unfavorable. The absence of a

Mr. White's testimony adhered to the district court's ruling and did not run afoul of Section 298. At trial, Mr. White testified that Weber took "[n]o steps" consistent with industry standards. D.I. 508 Trial Tr. 656:24-657:8. Although Mr. White is a lawyer, he testified that the actions required to comply with industry standards do not require lawyers; for instance, Mr. White explained that the PATOffice patent-monitoring system is a non-attorney resource that companies such as Weber use to evaluate patents without seeking advice of counsel. D.I. 508 Trial Tr. 653:18-654:7. Mr. White testified that Weber did not provide any evidence that it performed a number of evaluation steps, such as a freedom to operate analysis. D.I. 508 Trial Tr. 654:24-655:5. Mr. White did not suggest that Weber should have hired attorneys to analyze Provisur's patents; he simply provided evidence that industry standards required Weber to have some third party analyze those patents. D.I. 508 Trial Tr. 653:18-654:7.

Weber argued in its motion for JMOL that, although Mr. White did not testify about Weber's failure to consult counsel, Mr. White's testimony about Weber's failure to adhere to industry standards was tantamount to the type of testimony prohibited by Section 298. D.I. 502 at 22-24. The district court rejected Weber's argument. App. 40a-42a. The Federal Circuit nonetheless concluded that Mr. White's testimony violated Section 298. However, the Panel reached this conclusion based on information that was not presented to the jury—namely, information from Mr. White's expert report. The

legal opinion may not be used by you to find that Weber acted willfully.”).

Federal Circuit provided the following explanation for its ruling:

“During trial, . . . Mr. White testified that Weber did not provide any evidence that it performed a number of evaluation steps, such as freedom to operate analysis. ***In his expert report***, Mr. White explained a freedom to operate analysis is ‘typically reviewed by a qualified patent attorney’ which may include ‘opinions as to which patents may be problematic.’ Mr. White’s testimony referenced other potentially legal services that Weber allegedly failed to seek.”

App. 12a-13a (emphasis added).

Importantly, Mr. White’s expert report was not presented to the jury, and Mr. White did not testify at trial that a freedom to operate analysis—or any of the other steps Weber failed to take to adhere to industry standards on intellectual property management—is typically reviewed by an attorney. It was therefore improper for the Federal Circuit to consider that information from Mr. White’s expert report in the course of its review of the jury’s willfulness finding.

The jury’s finding that Weber willfully infringed Provisur’s patents was a factual finding, and therefore should have been reviewed under the substantial evidence standard. *Kohler*, 829 F.3d at 1341-42; *see also Versata Software, Inc. v. SAP America, Inc.*, 717 F.3d 1255, 1261-69 (Fed. Cir. 2013) (reviewing jury’s finding of infringement and lost-profits under a substantial evidence standard). This Court has explicitly stated that substantial evidence

review must be based on the trial record alone. *Reeves*, 530 U.S. 133 at 150-151 (“[On] motion for judgment as a matter of law, the court should review all of the evidence *in the record* . . . [and] draw all reasonable inferences in favor of the nonmoving party.”) (emphasis added). The Federal Circuit acknowledges this rule. *See, e.g., GlaxoSmithKline LLC v. Teva Pharms. USA, Inc.*, 7 F.4th 1320, 1336 (Fed. Cir. 2021) (“On appeal, we review the jury’s verdict for substantial evidence based upon the record; we cannot hunt outside the record to find evidence to try to contradict the verdict.”).

If the Panel had considered only the evidence in the trial record, as it was required to do, there would have been no basis for its determination that Mr. White’s testimony violated Section 298. Although the Panel stated that “Provisur cannot circumvent § 298 by substituting advice from a third party for advice from counsel,” App. 13a, Section 298 does not prohibit a patentee from using evidence of the infringer’s failure to consult third parties as evidence of willful inducement. Concluding that Section 298 extends to advice from third parties would subvert the purpose of the statute, which was “designed to protect attorney-client privilege and to reduce pressure on accused infringers to obtain opinions of counsel for litigation purposes,” and which “reflects a policy choice that the probative value of this type of evidence is outweighed by the harm that coercing a waiver of attorney-client privilege inflicts on the attorney-client relationship.” H.R. Rep. 112-98(l) at *53.

Beyond the Federal Circuit’s improper consideration of evidence outside of the record, the

Federal Circuit’s conclusion that the district court “erred in admitting the portion of Mr. White’s testimony related to seeking advice from a third party” did not properly credit the district court’s evidentiary rulings. App. 13a. “A district court’s rulings on admissibility of evidence are entitled to great deference” and should only be reversed if the district court committed a “clear abuse of discretion.” *Safety Nat’l Cas. Corp. v. Austin Resols., Inc.*, 639 F.3d 498, 503 (8th Cir. 2011). “Moreover, a jury’s verdict will not be disturbed absent a showing that the evidence was so prejudicial as to require a new trial which would be likely to produce a different result.” *Id.* (quoting *Paul v. Farmland Indus., Inc.*, 37 F.3d 1274, 1277 (8th Cir.1994)).

ii. The Federal Circuit Improperly Discounted the Weight of Provisur’s Evidence on the Patent Matrix.

After ruling that Mr. White’s testimony on Weber’s lack of adherence to industry standards violated 35 U.S.C. § 298, the Federal Circuit concluded that the remainder of Mr. White’s evidence, concerning Weber’s patent matrix, was admissible but “insufficient as a matter of law to establish willfulness.” App. 13a. Specifically, the Federal Circuit held that, “[a]t most, the patent matrix demonstrates Weber’s knowledge of the asserted patents and their relevance to Weber’s business in general.” App. 14a. The Federal Circuit concluded that, because “knowledge of the asserted patent and evidence of infringement is necessary, but not sufficient, for a finding of willfulness,” Provisur’s evidence was “not enough to establish deliberate or

intentional infringement.” App. 14a (quoting *Bayer Healthcare LLC*, 989 F.3d at 988).

While the Federal Circuit may have disagreed with the jury’s willfulness finding, Provisur presented more than enough evidence on Weber’s patent matrix—particularly in conjunction with the evidence of Weber’s concealment and other evidence demonstrating the lack of credibility of Weber’s witnesses, discussed *supra* I(B)—for a reasonable jury to have determined that Weber intentionally infringed Provisur’s patents. At a minimum, Provisur’s evidence that Weber knew about the asserted patents and their relevance to Weber’s business, and yet took no steps whatsoever to avoid infringement, demonstrates Weber’s reckless disregard of Provisur’s patent rights and therefore supports the jury’s willfulness finding. *Ironburg* 64 F.4th at 1296 (“reckless disregard” of patent rights is sufficient to find specific intent).

Nonetheless, the Federal Circuit concluded that Provisur’s evidence on the patent matrix was insufficient to support such a finding. App. 13a-14a. The Federal Circuit cited *Bayer* for the proposition that evidence of the alleged infringer’s knowledge of the asserted patent and evidence of infringement is not sufficient for a willfulness finding. App. 14a. But as recounted above, Provisur’s evidence concerning Weber’s patent matrix established not just Weber’s knowledge of the asserted patents but also its knowledge that those patents were highly relevant to Weber’s business. Such evidence was absent in *Bayer*, which distinguishes it from the present case. And the Federal Circuit cited no case law for its conclusion

that Weber’s knowledge of the relevance of the asserted patents to its business does not support the jury’s willfulness finding. Furthermore, *Bayer* did not involve evidence of the infringer’s concealment, as is present in this case, from which the jury was free to draw an inference that Weber willfully infringed Provisur’s patents.

The jury was entitled to weigh Provisur’s evidence regarding the patent matrix, in conjunction with the other evidence it heard, to conclude that Weber willfully infringed Provisur’s patents. In determining that Provisur’s evidence was insufficient to support the jury’s willfulness finding, the Federal Circuit improperly usurped the role of factfinder and credited its own assessment of Provisur’s evidence, rather than that of the jury. This is exactly what appellate courts are required to avoid. *Arctic Cat*, 876 F.3d at 1371 (courts of appeals “will not second-guess the jury or substitute [the court’s] judgment for its judgment”).

iii. The Federal Circuit Improperly Disregarded Evidence of Weber’s Concealment and Other Evidence Relevant to Credibility.

Provisur presented compelling evidence at trial showing that Weber attempted to conceal its knowledge of the asserted patents. *See supra* I(B). From this evidence of Weber’s concealment, the jury was entitled to infer that Weber had knowledge of its infringement, therefore supporting its finding of willful infringement. *See Reeves*, 530 U.S. at 147 (it is a “general principle of evidence law that the factfinder is entitled to consider a party’s dishonesty about a

material fact as ‘affirmative evidence of guilt’”); *Afros S.p.A. v. Krauss-Mafei Corp.*, 671 F. Supp. 1402, 1439-40 (D. Del. 1987) (“The defendant’s unacceptable tactics bear directly on the issue of willfulness because the documents it attempted to shield from discovery form part of the core proof on this question.”); *Stryker Corp. v. Zimmer, Inc.*, 2017 WL 4286412, at *3 (W.D. Mich. July 12, 2017), *aff’d*, 745 F. App’x 167 (Fed. Cir. 2018) (finding it probative to “whether defendant attempted to conceal its misconduct” that defendant refused to turn over certain details regarding its patent application until after discovery had ended). In fact, the jury was specifically instructed that, “[i]n deciding what testimony to believe,” they should consider “how consistent [the witnesses’] testimony is with other evidence that you believe.” D.I. 485 at 4-5. The evidence of Weber’s concealment, considered alongside the other evidence Provisur presented at trial, provided ample support for a jury finding of willfulness.

The Federal Circuit completely disregarded this vital evidence of Weber’s concealment in determining that Provisur failed to establish willful infringement and that the district court should have granted Weber’s JMOL motion. The court did not so much as mention Weber’s concealment in its opinion, let alone acknowledge that the jury could have reasonably inferred from Weber’s concealment of its knowledge of the asserted patents that Weber had a specific intent to infringe Provisur’s patents.

Furthermore, the Federal Circuit did not take into consideration the numerous instances in which Weber’s witnesses demonstrated their lack of

credibility before the jury. For instance, during the deposition of Tobias Weber, Weber Germany's CEO, Mr. Weber refused to answer questions about patents or the PMG, and did not claim to have any detailed knowledge of the accused products. However, after "rehearsing" his testimony in preparation for trial D.I. 510 Trial Tr. 1143:7-1143:20, Mr. Weber arrived at trial with different personal knowledge and stated for the first time that he reviewed patents at Weber, D.I. 510 Trial Tr. 1130:5-8. Mr. Weber also testified extensively about PMG's activities, and stated that a high patent matrix rating did not indicate infringement risk. D.I. 510 Trial Tr. 1132:25-1133:1. Mr. Weber miraculously also recalled Weber's development of products that occurred when Mr. Weber was in high school and college, long before he even worked at the company. *See* D.I. 510 Trial Tr. 1111:4-7; 1116:19-20. Based on Mr. Weber's inconsistent testimony, the jury was entitled to discredit him as a witness and infer that his dishonesty was "affirmative evidence of guilt" and indicative that Weber had a specific intent to infringe Provisur's patents. *Reeves*, 530 U.S. at 147.

In wholly ignoring the evidence of Weber's concealment and the lack of credibility of Weber's witnesses, the Federal Circuit again improperly took away from the jury its role in "weighing the evidence" and "drawing . . . legitimate inferences from the facts," while failing to credit Provisur's evidence and draw "all justifiable inferences" in Provisur's favor. *Anderson*, 477 U.S. at 255.

In discounting and disregarding Provisur's evidence that Weber was aware of Provisur's patents

and knew they were highly relevant to Weber's business, and that Weber concealed its knowledge of the asserted patents (as well as numerous instances in which Weber's witnesses demonstrated their lack of credibility), the Federal Circuit violated the JMOL standard set out by this Court, the Eighth Circuit, and other circuit courts across nation, which required the Panel to view all evidence in the light most favorable to Provisur and give Provisur the benefit of all favorable inferences that may reasonably be drawn—namely, the inference that Weber had the specific intent to infringe Provisur's patents. The Federal Circuit instead stepped into the role of factfinder, improperly invading the province of the jury and crediting its own assessment of Provisur's evidence over that of the jury and district court who heard the evidence firsthand.

II. The Panel's Decision Erodes the Application of the Seventh Amendment to Patent Cases and Violates Provisur's Right to a Jury Trial.

The right to a jury trial is at the foundation of our nation's justice system. Even before the Constitution and Bill of Rights were adopted, every colony guaranteed its citizens the right to a trial by jury. Stephan Landsman, *The Civil Jury in America: Scenes from an Unappreciated History*, 44 Hastings L.J. 579, 592 (1993). This Court has long recognized the importance of a jury's role in our justice system. In 1830, Justice Story observed that “[t]he trial by jury is justly dear to the American people. It has always been an object of deep interest and solicitude, and every encroachment upon it has been watched

with great jealousy.” *Parsons v. Bedford*, 28 U.S. 433, 441 (1830). In *Parsons*, this Court held that the right to a jury was not limited to “suits, which the common law recognized among its old and settled proceedings, but [rather the right extends to] suits in which legal rights were to be ascertained and determined, in contradistinction to those where equitable rights alone were recognized, and equitable remedies were administered.” *Id.* at 447. Nearly two hundred years later, this Court continues to echo Justice Story’s sentiments, noting that the “right to trial by jury is ‘of such importance and occupies so firm a place in our history and jurisprudence that any seeming curtailment of the right’ has always been and ‘should be scrutinized with the utmost care.’” *SEC v. Jarkesy*, 144 S. Ct. 2117, 2128 (2024) (citing *Dimick v. Schiedt*, 293 U. S. 474, 486 (1935)).

Basic principles of appellate review, as well as the Federal Rules of Civil and Appellate Procedure, echo the historical respect for trial by jury. Rule 50 of the Federal Rules of Civil Procedure, for example, only permits a court to set aside a jury verdict where the court concludes that “a reasonable jury would not have a legally sufficient evidentiary basis” to reach its conclusion. Fed. R. Civ. P. 50(a)(1). Rule 10 of the Federal Rules of Appellate Procedure dictates that the record on appeal consists of “the original papers and exhibits filed in the district court” and “the transcript of the proceedings,” reflecting the fundamental principle that federal courts of appeal are limited to the trial court’s record. Fed. R. App. P. 10. Appellate courts may not make credibility determinations or reweigh the facts underlying factual determinations made in the trial court. *See, e.g., Wood v. Milyard*, 566

U.S. 463, 473 (2012) (“For good reason, appellate courts ordinarily abstain from entertaining issues that have not been raised and preserved in the court of first instance.”); *Anderson*, 477 U.S. at 255 (“Credibility determinations . . . are jury functions, not those of a judge. . . .”). In *Fairmount Glass Works v. Cub Fork Coal Co.*, Justice Brandeis described how “Appellate courts should be slow to impute to juries a disregard of their duties, and to trial courts a want of diligence or perspicacity in appraising the jury’s conduct.” 287 U.S. 474, 485 (1933).

This fundamental right to, and respect for, a jury trial applies with equal force to patent owners facing infringement. *Markman*, 517 U.S. at 377 (“[T]here is no dispute that infringement cases today must be tried to a jury, as their predecessors were more than two centuries ago.”). In *Apple Inc. v. Samsung Electronics, Co.*, the Federal Circuit granted Apple’s *en banc* petition to “affirm our understanding of the appellate function as limited to deciding the issues raised on appeal by the parties, deciding these issues only on the basis of the record made below, and *as requiring appropriate deference be applied to the review of fact findings.*” 839 F.3d at 1039 (Moore, J.) (emphasis added). In affirming and reinstating the district court’s judgment, Judge Moore explained that “[o]ur job is not to review whether Samsung’s losing position was also supported by substantial evidence or to weigh the relative strength of Samsung’s evidence against Apple’s evidence. We are limited to determining whether there was substantial evidence for the jury’s findings, *on the entirety of the record.*” *Id.* at 1052 (emphasis added).

Despite the fact that the Seventh Amendment applies equally to patent litigants—which the Federal Circuit itself has acknowledged—the Federal Circuit’s track record nonetheless reflects its willingness to reexamine and overturn jury verdicts to a greater degree than other circuit courts of appeals. Over the past decade, the Federal Circuit has reversed countless jury verdicts involving patent infringement and validity and resulting damages. *See, e.g., Commil USA, LLC v. Cisco Sys., Inc.*, 813 F.3d 994, 997 (Fed. Cir. 2015); *ParkerVision, Inc. v. Qualcomm Inc.*, 621 F. App’x. 1009, 1017 (Fed. Cir. 2015); *Phillip M. Adams & Assocs., LLC v. Dell Comput. Corp.*, 519 F. App’x 998, 1005 (Fed. Cir. 2013); *Mirror Worlds, LLC v. Apple Inc.*, 692 F.3d 1351, 1358 (Fed. Cir. 2012); *Smith & Nephew, Inc. v. Arthrex, Inc.*, 453 F. App’x 977, 981 (Fed. Cir. 2011); *Becton, Dickinson & Co. v. Tyco Healthcare Grp.*, 616 F.3d 1249, 1257–58 (Fed. Cir. 2010); *ABT Sys., LLC v. Emerson Elec. Co.*, 797 F.3d 1350, 1357 (Fed. Cir. 2015); *I/P Engine, Inc. v. AOL Inc.*, 576 F. App’x 982, 992 (Fed. Cir. 2014), *cert. denied*, 136 S. Ct. 54 (2015); *Alexsam, Inc. v. Gap, Inc.*, 621 F. App’x 983, 995 (Fed. Cir. 2015); *Sealant Sys. Int1, Inc. v. TEK Glob., S.R.L.*, 616 F. App’x 987, 999 (Fed. Cir. 2015); *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1253 (Fed. Cir. 2014); *ClearValue, Inc. v. Pearl River Polymers, Inc.*, 668 F.3d 1340, 1342 (Fed. Cir. 2012); *ArcelorMittal France v. AK Steel Corp.*, 700 F.3d 1314, 1323 (Fed. Cir. 2012); *VLSI Tech. LLC v. Intel Corp.*, 87 F.4th 1332 (Fed. Cir. 2023); *Cal. Inst. of Tech. v. Broadcom Ltd.*, 25 F.4th 976 (Fed. Cir. 2022).

Some academics have argued for a so-called “complexity exception” to the Seventh Amendment in

patent litigation, which would provide the judiciary with discretion to withhold cases from a jury in instances where the facts or underlying legal issues are too complex for an average juror to comprehend, thus leading to an unfair or irrational verdict. *See, e.g.*, Joseph C. Wilkinson, Jr. et al., *A Bicentennial Transition: Modern Alternatives to Seventh Amendment Jury Trial in Complex Cases*, 37 U. KAN. L. REV. 61, 62 (1988) (suggesting juries be eliminated in complex civil cases); Joseph A. Miron, Jr., Note, *The Constitutionality of a Complexity Exception to the Seventh Amendment*, 73 CHI.-KENT L. REV. 865 (1998) (suggesting a complexity exception to the Seventh Amendment is constitutional and consistent with English common law). But this Court has declined to create such an exception to the Seventh Amendment. In *Tull v. United States*, this Court explained that in order to determine whether a constitutional right to a jury trial exists, “the Court must examine both the nature of the action and of the remedy sought.” 481 U.S. 412, 417 (1987). Further, the Court clarified that an inquiry into the “practical abilities and limitations of juries” should be made only when considering the applicability of the Seventh Amendment to administrative law courts, thus ending any speculation that a complexity exception exists in exceptionally complicated cases. *Id.* at 418 n.4.

Despite the absence of a complexity exception in American jurisprudence, legal scholars and practitioners at the patent bar have become increasingly concerned by the Federal Circuit’s *de facto* implementation of a complexity exception to the Seventh Amendment in patent litigation. *See, e.g.*, William C. Rooklidge & Matthew F. Weil, *Judicial*

Hyperactivity: The Federal Circuit's Discomfort with its Appellate Role, 15 BERKELEY TECH. L.J. 725, 729 (2000); *see also* Petition for a Writ of Certiorari, *Commil USA, LLC v. Cisco Sys., Inc.*, No. 15-1446, at 16 (May 27, 2016) (arguing the Federal Circuit usurped the role of the jury); Petition for a Writ of Certiorari, *Alexsam, Inc. v. The Gap, Inc.*, No. 15-736 (Dec. 7, 2015) (“Instead of reviewing evidence which supports the jury’s presumed finding, the Federal Circuit instead looked for evidence that could have supported a different finding, and drew all inferences in favor of [movant.]”). The Federal Circuit, like all other courts, is only permitted to review jury decisions to grant a new trial or for errors of law. *Parsons*, 28 U.S. at 448. The Reexamination Clause of the Seventh Amendment mandates that “no fact tried by a jury, shall be otherwise reexamined in any Court of the United States, than according to the rules of the common law.” U.S. CONST. AMEND. VII. There is no room for a complexity exception in the Seventh Amendment.

Provisur’s plight is no different. As discussed at length above (*supra* I(A)-(C)), the Federal Circuit’s decision to reverse the district court’s JMOL ruling and overturn the jury’s verdict was based on its reevaluation of evidence that Provisur presented at trial demonstrating that Weber willfully infringed Provisur’s patents. While this Court has interpreted the Reexamination Clause to allow courts of appeals to vacate a jury’s verdict based on the sufficiency of the evidence, it has also explained that in reviewing a motion for a directed verdict, a court of appeals can “not itself determine the issues of fact and direct a judgment for the defendant, for this would cut off the

plaintiff's unwaived right to have the issues of fact determined by a jury." *Baltimore & Carolina Line, Inc. v. Redman*, 295 U.S. 654, 658 (1935); *see also* Fed. R. Civ. P. 50 (a reviewing court may only grant JMOL if it "finds that a reasonable jury would not have a legally sufficient evidentiary basis to find for the party"). Rather than crediting the jury's factual determination that Weber willfully infringed Provisur's patents—and without viewing the evidence in the light most favorable to Provisur or giving Provisur the benefit of all favorable inferences that may reasonably be drawn, as the Panel was required to do—the Federal Circuit stepped into the role of factfinder, undertaking its own assessment and weighing of the trial evidence. Based on that assessment, the Federal Circuit determined that substantial evidence did not support the jury's infringement or willfulness findings.

The Federal Circuit's reweighing of the evidence, which was further compounded by its reliance upon materials the jury never saw, directly violated Provisur's Seventh Amendment right. Left unchecked, the Federal Circuit's willingness to reexamine juries' factual findings will continue to erode the applicability of the Seventh Amendment to patent cases—a right the Founders fought to ensure.

CONCLUSION

For the foregoing reasons, the petition for writ of certiorari should be granted.

December 31, 2024

Respectfully submitted,

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APPENDIX A — OPINION OF THE UNITED STATES
COURT OF APPEALS FOR THE FEDERAL
CIRCUIT, FILED OCTOBER 2, 2024

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

2023-1438

PROVISUR TECHNOLOGIES, INC.,

Plaintiff-Appellee,

v.

WEBER, INC., TEXTOR, INC., WEBER
FOOD TECHNOLOGY GMBH, FKA WEBER
MASCHINENBAU GMBH BREIDENBACH,
TEXTOR MASCHINENBAU GMBH,

Defendants-Appellants.

October 2, 2024, Decided

Appeal from the United States District Court for the
Western District of Missouri in No. 5:19-cv-06021-SRB,
Judge Stephen R. Bough.

Before MOORE, Chief Judge, TARANTO, *Circuit Judge*,
and CECCHI, *District Judge*.¹

1. Honorable Claire C. Cecchi, District Judge, United States
District Court for the District of New Jersey, sitting by designation.

Appendix A

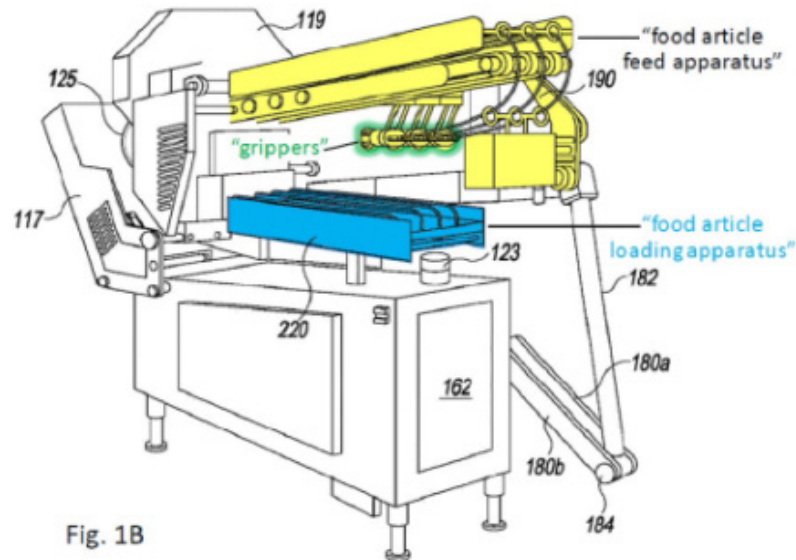
MOORE, *Chief Judge*.

Weber, Inc., Textor, Inc., Weber Maschinenbau GmbH Neubrandenburg, Textor Maschinenbau GmbH, and Weber Maschinenbau Breidenbach (collectively, Weber) appeal the United States District Court for the Western District of Missouri's denial of judgment as a matter of law of noninfringement and no willfulness of claims 9-12 and 16 of U.S. Patent No. 10,625,436, claims 1, 7, and 8 of U.S. Patent No. 10,639,812, and claim 14 of U.S. Patent No. 7,065,936. Weber also appeals the denial of a motion for a new trial on infringement, willfulness, and damages. For the following reasons, we affirm-in-part, reverse-in-part, and remand for further proceedings.

BACKGROUND

Provisur Technologies, Inc. (Provisur) owns the '436, '812, and '936 patents, which generally relate to food-processing machinery. The '436 and '812 patents, which share a common specification, relate to high-speed mechanical slicers used in food-processing plants to slice and package food articles, such as meats and cheeses. '812 patent at Abstract. Figure 1B, annotated below, illustrates the slicer, which contains a food article loading apparatus (blue) with a lift tray assembly (220) into which food is placed. *Id.* at 4:33-43. The lift tray pivots upward and the grippers (green), which are located on the food article feed apparatus (yellow), guide the food forward for slicing. *Id.* at 4:33-43, 9:60-10:4.

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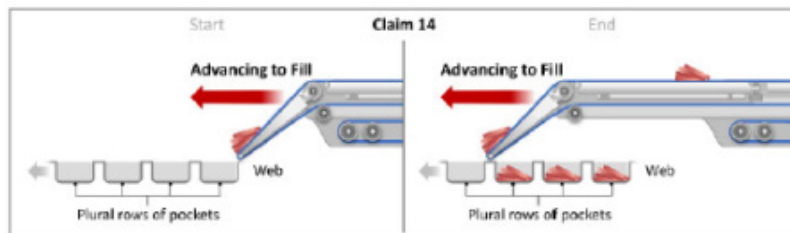


Appellants Op. Br. at 12.

The '936 patent relates to a fill and packaging apparatus for loading sliced foods into packages. '936 patent at Abstract. Figure 1 illustrates a slicing and packaging line. *Id.* at 3:20-21, Fig. 1. The slicing machine (20) "cuts slices from a loaf and deposits the slices on an output conveyor assembly" (30). *Id.* at 3:39-42. The conveyor assembly (30) moves drafts of the appropriate weight onto a staging conveyor (44). *Id.* at 3:50-58. The staging conveyor (44) delivers the rows of drafts onto a shuttle conveyor (52), which delivers the drafts into pockets made of film. *Id.* at 3:59-4:6.

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The '936 patent describes two alternative ways to fill the pockets: retract-to-fill and advance-to-fill. The retract-to-fill embodiment begins with the shuttle conveyor in the extended position and fills the pockets starting farthest from the slicer until the conveyor is fully retracted. *Id.* at 5:33-38. The claims covering the retract-to-fill embodiment, unasserted claims 1-4, 6-13, and 15-20, were found invalid over the prior art. *Provisur Techs., Inc. v. Weber, Inc.*, No. 21-1851, 2022 U.S. App. LEXIS 34590, 2022 WL 17688071, at *5 (Fed. Cir. Dec. 15, 2022). The asserted claim covers the advance-to-fill embodiment. The advance-to-fill embodiment begins with the shuttle conveyor in the retracted position and fills the pockets closest to the slicer and advances until the conveyor is fully extended. '936 patent at 5:39-44. The annotated figure below shows the advance-to-fill embodiment.



Appellants Op. Br. at 17.

Claim 14, the only asserted claim for the '936 patent, recites:

14. The apparatus according to claim 10, wherein said shuttle conveyor is configured to fill plural rows of pockets while said web is stationary in said fill station, and *said shuttle*

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conveyor is configured to retract from an extended position to a retracted position to fill a new first row of a group of empty pockets while said web advances to locate a succeeding plural row of pockets in said fill station.

Relevant to this appeal, Provisur sued Weber for willfully infringing the '812, '436, and '936 patents. Provisur alleged Weber's 905, 906, 908, and S6 food slicers infringed the '812 and '436 patents and Weber's SmartLoader products infringed the '936 patent.

A jury trial was held in October 2022. The jury found Weber willfully infringed claims 9-12 and 16 of the '436 patent, claims 1, 7, and 8 of the '812 patent, and claim 14 of the '936 patent. J.A. 61-62.² The jury awarded Provisur \$3,013,068 for the '936 patent, \$3,747,046.50 for the '436 patent, and \$3,747,046.50 for the '812 patent. J.A. 63. Following the verdict, Weber moved for judgment as a matter of law (JMOL) on the issues of infringement and willfulness, and a new trial on infringement, willfulness, and damages, but the district court denied both motions. J.A. 69-72.³

Weber appealed. We have jurisdiction under 28 U.S.C. § 1295(a)(1).

2. The jury also found no infringement of claim 12 of U.S. Patent No. 6,997,089. J.A. 61. This issue is not before us.

3. The district court also granted Provisur's motion for enhanced damages, doubling the jury's award. J.A. 73-86. This issue is not before us.

*Appendix A***DISCUSSION**

We review a district court’s grant or denial of JMOL under the standard of the regional circuit. *Apple Inc. v. Wi-LAN Inc.*, 25 F.4th 960, 969 (Fed. Cir. 2022). The Eighth Circuit reviews JMOL rulings de novo, applying the same standard as the district court. *Penford Corp. v. Nat’l Union Fire Ins. Co. of Pittsburgh, PA*, 662 F.3d 497, 503 (8th Cir. 2011). “A court may render judgment as a matter of law when there is no legally sufficient evidentiary basis for a reasonable jury to find for the nonmoving party on an issue and all of the evidence directs against a finding for the non-moving party.” *Jones v. TEK Indus., Inc.*, 319 F.3d 355, 358 (8th Cir. 2003).

I. INFRINGEMENT

Infringement is a question of fact that is reviewed for substantial evidence when tried to a jury. *Lucent Techs., Inc. v. Gateway, Inc.*, 580 F.3d 1301, 1309 (Fed. Cir. 2009). “A factual finding is supported by substantial evidence if a reasonable jury could have found in favor of the prevailing party in light of the evidence presented at trial.” *Godo Kaisha IP Bridge 1 v. TCL Commc’n Tech. Holdings Ltd.*, 967 F.3d 1380, 1383 (Fed. Cir. 2020).

With respect to the ’812 and ’436 patents, Weber conceded its noninfringement arguments are no longer available in this appeal in light of an intervening decision.⁴

4. Weber’s concession of infringement for purposes of this appeal should have no impact on the pending *inter partes* review, which could affect liability in this case on remand.

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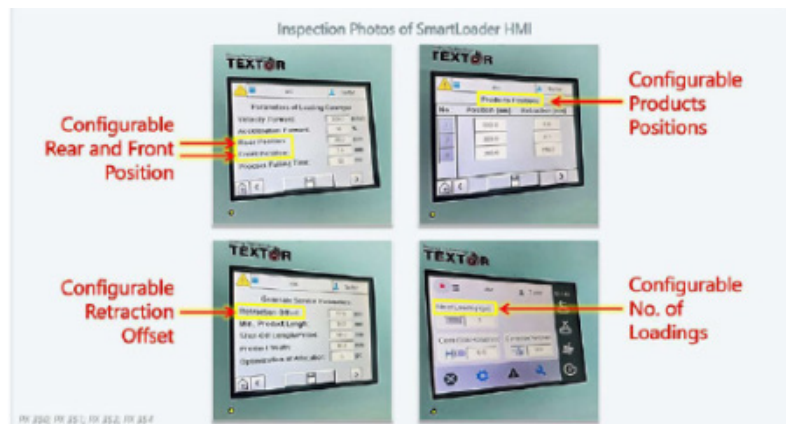
Rule 28(j) Citation of Supplemental Authority, No. 23-1438 (Fed. Cir. Apr. 1, 2024), ECF No. 57 (citing *Weber, Inc. v. Provisur Techs., Inc.*, 92 F.4th 1059 (Fed. Cir. 2024)); *see also* Oral Arg. at 0:51-4:05, https://oralarguments.cafc.uscourts.gov/default.aspx?fl=23-1438_06052024.mp3. We therefore affirm the district court's denial of JMOL for non-infringement for the '812 and '436 patents.

With respect to the '936 patent, the jury found Weber's SmartLoader infringes claim 14. J.A. 61. After post-trial briefing, the district court determined Weber was not entitled to judgment as a matter of law or a new trial. J.A. 70-71. Weber contends the district court erred in denying JMOL for noninfringement because Provisur failed to prove Weber's SmartLoader satisfies the claimed advance-to-fill limitation. Appellants Op. Br. at 43-54.

Claim 14 requires an advance-to-fill conveyor. J.A. 30862. The record indisputably shows Weber's SmartLoader is sold to customers as a retract-to-fill conveyor. J.A. 66993; J.A. 42045 (Trial Tr. 1559:5-15), J.A. 41439 (Trial Tr. 953:12-14); J.A. 89412. There are no pictures or videos showing the SmartLoader operating as an advance-to-fill conveyor. Provisur's expert Dr. Keith Vorst conceded as much. J.A. 41441, 41443 (Trial Tr. 955:7-12, 957:8-16). He also admitted he found no evidence that any Weber customer ever used the SmartLoader to operate as an advance-to-fill conveyor. J.A. 41443 (Trial Tr. 957:21-25).

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Provisur's infringement theory relied on establishing Weber's SmartLoader could be reprogrammed to operate as an advance-to-fill conveyor. Provisur did not proffer sufficient evidence to meet its burden. Dr. Vorst testified the SmartLoader can be configured to operate as an advance-to-fill conveyor by manipulating certain parameters of the conveyor. J.A. 41396 (Trial Tr. 910:10-13). He testified the SmartLoader includes a human machine interface (HMI) that allows someone to create a new program and adjust the parameters of the conveyor to advance or retract it. J.A. 41396-400 (Trial Tr. 910:18-913:14, 914:6-10). He specifically relied on a demonstrative of the HMI screens that allegedly enable configuration of these parameters (shown below). J.A. 41396-400 (Trial Tr. 910:18-913:14). Dr. Vorst testified that by adjusting parameters, such as the front and rear position, the SmartLoader can be configured as an advancing conveyor. J.A. 41400 (Trial Tr. 914:6-10).



J.A. 93782.

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“An accused device may be found to infringe if it is reasonably capable of satisfying the claim limitations.” *Hilgraeve Corp. v. Symantec Corp.*, 265 F.3d 1336, 1343 (Fed. Cir. 2001). “But a device does not infringe simply because it is possible to alter it in a way that would satisfy all the limitations of a patent claim.” *High Tech Med. Instrumentation, Inc. v. New Image Indus., Inc.*, 49 F.3d 1551, 1555 (Fed. Cir. 1995). We have held an accused device to meet the capability standard if it is readily configurable to infringe. *See, e.g., Fantasy Sports Props., Inc. v. Sportslines.com, Inc.*, 287 F.3d 1108, 1118 (Fed. Cir. 2002) (explaining the accused device infringes where the user must only activate the functions already present); *Finjan, Inc. v. Secure Computing Corp.*, 626 F.3d 1197, 1205 (Fed. Cir. 2010) (same).

Here, Provisur proffered no evidence that Weber’s customers could readily activate the alleged advance-to-fill functionality. Dr. Vorst testified about configuring the SmartLoader through the HMI, but he had access to screens that Weber’s customers do not. Indeed, Dr. Vorst explained that during his inspection he had to ask Weber technicians for permission to access certain HMI screens. J.A. 41259-60 (Trial Tr. 773:19-774:2); *see also* J.A. 41403-04 (Trial Tr. 917:16-918:9). Dr. Vorst further testified that at least two of these screens, including the screens for configuring the rear and front position of the loading conveyor and for configuring the products positions, are necessary to reconfigure the SmartLoader to advance-to-fill. J.A. 41404 (Trial Tr. 918:13-19). But Weber’s source code expert Dr. Valerdi testified that only one screen of the HMI is available to Weber’s customers. J.A. 41893-94

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(Trial Tr. 1407:19-1408:23 (“Q: And so just which of these four screens is available to the customer? A: Only the bottom right screen that has the configurable number of loadings and some adjustment parameters. That’s the only one that’s available to a customer of Weber.”)). Weber’s technical expert Dr. Reinholtz similarly testified that most of the HMI screens are only available to Weber’s service technicians, but not customers. J.A. 42133 (Trial Tr. 1647:2-6); *see also* J.A. 42121 (Trial Tr. 1635:2-5). The screens required to reconfigure the SmartLoader according to Dr. Vorst’s theory are not available to Weber’s customers.

This is not an infringement scenario where customers can simply activate the infringing configuration. *See Fantasy Sports*, 287 F.3d at 1118; *Finjan*, 626 F.3d at 1205. Dr. Vorst is an expert who was provided access to Weber’s products during an inspection. Weber’s customers do not have access to the screens Provisur contends are necessary for the SmartLoader to be reconfigured to operate as an advance-to-fill conveyor. Only Weber and its technicians have access to the configurable parameters. Provisur has not identified any evidence in the record that puts this fact genuinely in dispute. Given these facts, Weber’s Smart-Loader is not readily configurable to infringe claim 14 of the ’936 patent. The SmartLoader can only infringe if Weber modifies it to operate as an advance-to-fill conveyor.

Even with access provided by Weber, Dr. Vorst only testified that he *could have* reconfigured the SmartLoader. He did not testify that he was able to

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configure it to advance-to-fill. *See* J.A. 41441 (Trial Tr. 955:7-12), J.A. 42542 (Trial Tr. 2056:19-22), J.A. 43386 (Provisur’s opposition to Weber’s motion for a new trial). Dr. Vorst provided no evidence Weber’s SmartLoader ever was configured to advance-to-fill and no evidence that he configured it to advance-to-fill. He admitted as much, explaining that he was unable to demonstrate the advance-to-fill configuration because he ran out of time. J.A. 41441-43 (Trial Tr. 955:7-12, 956:21-957:16). And Provisur did not request additional inspections. J.A. 41443 (Trial Tr. 957:18-20).

Dr. Vorst’s testimony is therefore not substantial evidence demonstrating Weber’s SmartLoader infringes claim 14 of the ’936 patent. The district court erred in denying Weber’s motion for judgment as a matter of law for noninfringement for claim 14 of the ’936 patent. We therefore reverse the district court’s denial of judgment as a matter of law for noninfringement of claim 14 of the ’936 patent and remand for further proceedings.

II. WILLFULNESS

Willful infringement is a question of fact reviewed for substantial evidence following a jury trial. *Polara Eng’g Inc v. Campbell Co.*, 894 F.3d 1339, 1353 (Fed. Cir. 2018). “To establish willfulness, a patentee must show that the accused infringer had a specific intent to infringe at the time of the challenged conduct.” *BASF Plant Sci., LP v. Commonwealth Sci. and Indus. Rsch. Org.*, 28 F.4th 1247, 1274 (Fed. Cir. 2022).

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Weber appeals the district court's denial of JMOL of no willfulness. Specifically, Weber contends the district court erred in admitting testimony in violation of 35 U.S.C. § 298, and the remaining evidence is insufficient to support the jury's verdict of willful infringement. We agree.

Section 298 states:

The failure of an infringer to obtain the advice of counsel with respect to any allegedly infringed patent, or the failure of the infringer to present such advice to the court or jury, may not be used to prove that the accused infringer willfully infringed the patent or that the infringer intended to induce infringement of the patent.

Patentees are prohibited from using the accused infringer's failure to obtain the advice of counsel as an element of proof that the accused infringer willfully infringed.

Prior to trial, Weber moved to exclude testimony from Provisur's expert, Mr. John White, that Provisur asserted willful infringement based in part on Weber's failure to present evidence of advice of counsel. J.A. 6. The district court granted Weber's motion to exclude Mr. White's testimony on Weber's alleged failure to obtain advice of counsel. J.A. 8.

During trial, however, Mr. White testified about Weber's failure to consult a third party to evaluate the

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allegedly infringed patents. J.A. 41138-43 (Trial Tr. 652:17-657:8). Specifically, Mr. White testified that Weber did not provide any evidence that it performed a number of evaluation steps, such as a freedom to operate analysis. J.A. 41140-41 (Trial Tr. 654:24-655:5). In his expert report, Mr. White explained a freedom to operate analysis is “typically reviewed by a qualified patent attorney” which may include “opinions’ as to which patents may be problematic.” J.A. 9040-41 ¶ 57. Mr. White’s testimony referenced other potentially legal services that Weber allegedly failed to seek.

Mr. White’s testimony violated 35 U.S.C. § 298. Provisur argues Mr. White’s testimony is about industry standards for intellectual property management. Appellee Br. 41. But Mr. White, an attorney, did not distinguish between legal and non-legal services when testifying about consulting a third party. Provisur cannot circumvent § 298 by substituting advice from a third party for advice of counsel. The district court thus erred in admitting the portion of Mr. White’s testimony related to seeking advice from a third party.

The remainder of Mr. White’s testimony is admissible, but insufficient as a matter of law to establish willfulness. Mr. White testified about Weber’s patent matrix that tracked patents in related food processing technologies, including the asserted patents. J.A. 41112 (Trial Tr. 626:11-21). He explained software and Weber personnel provided a rating out of 3 for each patent in the matrix. *Id.* These ratings were described as indicating whether the patent was relevant for purposes of further evaluation.

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J.A. 41113 (Trial Tr. 627:3-16). For the asserted patents, Mr. White testified each one was provided a high score of 3. J.A. 41127 (Trial Tr. 641:8-16) ('936 patent), J.A. 41130-31 (Trial Tr. 644:23-645:17) ('812 patent), J.A. 41136-37 (Trial Tr. 650:19-651:5) ('436 patent).

At most, the patent matrix demonstrates Weber's knowledge of the asserted patents and their relevance to Weber's business in general. The patent matrix and corresponding testimony do not provide any level of specificity as to the relevance of the tracked patents for any of Weber's products. There is no dispute Weber knew of the asserted patents. J.A. 31387-88. The issue here is whether Weber knew of its alleged infringement and had a specific intent to infringe. *BASF Plant Sci*, 28 F.4th at 1274. There is no evidence Weber knew of its alleged infringement. We have held "knowledge of the asserted patent and evidence of infringement is necessary, but not sufficient, for a finding of willfulness." *Bayer Healthcare LLC v. Baxalta Inc.*, 989 F.3d 964, 988 (Fed. Cir. 2021). Provisur's evidence as a matter of law is not enough to establish deliberate or intentional infringement. *Id.* The district court should have granted Weber's motion for judgment as a matter of law. We reverse the district court's willfulness finding.

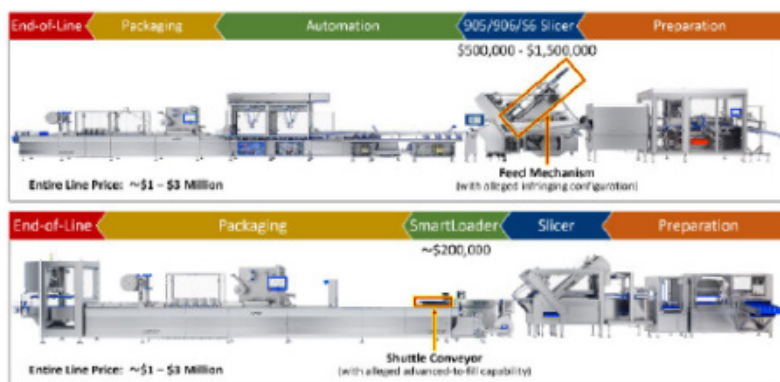
III. DAMAGES

When reviewing damages, we apply the law of the regional circuit. *Exmark Mfg. Co. Inc. v. Briggs & Stratton Power Prods. Grp., LLC*, 879 F.3d 1332, 1347 (Fed. Cir. 2018). The Eighth Circuit reviews a denial of a motion for a

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new trial on damages for abuse of discretion. *See Harrison v. Purdy Bros. Trucking Co.*, 312 F.3d 346, 351 (8th Cir. 2002). Evidentiary rulings, including the admissibility of damages expert evidence, are also reviewed for abuse of discretion. *See Barrett v. Rhodia, Inc.*, 606 F.3d 975, 980 (8th Cir. 2010). “A district court abuses its discretion when its decision is based on clearly erroneous findings of fact, is based on erroneous interpretations of the law, or is clearly unreasonable, arbitrary or fanciful.” *Whitserve, LLC v. Comput. Packages, Inc.*, 694 F.3d 10, 26 (Fed. Cir. 2012).

The jury awarded Provisur about \$10.5 million in the form of a reasonable royalty. J.A. 63. Provisur accused certain features on Weber’s slicers and SmartLoader of infringement. These features are parts of a larger component, either the slicer or automation component, which themselves are each just one component of an entire multicomponent slicing line (see below).



Appellant Op. Br. at 62.

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The damages verdict rests on Provisur’s reliance on the entire market value rule. Weber argues the district court erred by permitting Provisur to use the entire market value rule. We agree. The district court abused its discretion and should have granted a new trial on damages.

“A patentee is only entitled to a reasonable royalty attributable to the infringing features.” *Power Integrations, Inc. v. Fairchild Semiconductor Int’l, Inc.*, 904 F.3d 965, 977 (Fed. Cir. 2018). We have required any royalties be apportioned between infringing and noninfringing features of the accused product. *Id.* An apportionment analysis generally requires determining a royalty base to which a royalty rate will be applied. *Id.* For elements of multi-component products accused of infringement, the royalty base should be based on the smallest salable patent-practicing unit. *LaserDynamics, Inc. v. Quanta Comput., Inc.*, 694 F.3d 51, 67 (Fed. Cir. 2012). A necessary condition for using “an entire multi-component product” as the base is that the patentee proves the patented feature is the basis for customer demand. *Id.*; see also *Lucent Techs., Inc. v. Gateway, Inc.*, 580 F.3d 1301, 1336 (Fed. Cir. 2009).

Provisur’s use of the entire market value rule was impermissible because it failed to present sufficient evidence demonstrating the patented features drove the demand for the entire slicing line. Provisur’s damages expert, Ms. Julie Davis, used the value of the entire slicing line as the royalty base and applied a royalty rate to calculate the reasonable royalty damages. J.A.

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41524-27 (Trial Tr. 1038:16-1041:22). Ms. Davis relied on Dr. Vorst's testimony to support using the entire market value as the royalty base. J.A. 41554-55 (Trial Tr. 1068:3-1069:1). Dr. Vorst testified that the patented features drive the demand or substantially create the value of Weber's accused products. J.A. 41310 (Trial Tr. 824:17-24). But Dr. Vorst's testimony was conclusory and did not provide any evidence, *e.g.*, evidence from customers, to show the patented features drove the demand for the entire slicing line.

For example, for the '812 and '436 patents, Dr. Vorst testified that various features on the slicing machines are considered conventional, and the patented features are unique selling points. J.A. 41311-12 (Trial Tr. 825:2-826:19). The "conventional" features he discusses include the slicing blade, guards, conveyors, and other components of the slicer. *Id.* His testimony does not explain why these "conventional" features do not provide any value or drive customer demand.⁵

5. For the '936 patent, infringement of which is no longer at issue for damages purposes, *see supra*, Dr. Vorst's testimony was similarly conclusory and only states the configurable feature of the SmartLoader as substantially creating the value of Weber's slicing lines. J.A. 41406 (Trial Tr. 920:3-7). Asserted claim 14, however, only covers an advance-to-fill conveyor, not any configuration of a smart conveyor. J.A. 30862. Additionally, Dr. Vorst does not point to any evidence of Weber or Weber's customers using the device in an infringing manner. It is inconceivable how the advance-to-fill conveyor feature is a driver of customer demand where Weber's customers have not used the feature.

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Provisur failed to proffer sufficient evidence that other features of the slicing line do not cause customers to purchase the accused products. On cross-examination, Dr. Vorst agreed that Weber has patents that cover the features of its slicing lines. J.A. 41445-46 (Trial Tr. 959:24-960:11). He also agreed that Weber's customers buy slicing lines for different reasons. J.A. 41447-48 (961:24-962:10). Dr. Vorst did not conduct any market studies or consumer surveys to determine whether the demand for Weber's slicing lines was driven by the patented features. There is simply no evidence at all that the patented features drove customer demand or substantially created the value of the entire slicing lines. No one type of evidence is needed to show the patented features drove customer demand, but here there is none. We have explained that "[w]hen the product contains other valuable features, the patentee must prove that those other features do not cause consumers to purchase the product." *Power Integrations*, 904 F.3d at 979. The district court should have granted a new trial on damages because there is no evidence, apart from conclusory expert testimony, that supports invoking the entire market value rule. While expert testimony alone may be sufficient, in this case, where the entire slicing line includes multiple separate machines (see Figure above) from the preparation machinery to the slicing machinery to the automation machinery to the packaging machinery to the end-of-line machinery, and the patented technology is just one small component of one of the machines, and no other evidence supports the notion that this small component of just one portion of such a large system ever drove customer demand, it was an abuse of discretion to allow this case to proceed on the entire market value rule.

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We therefore reverse the district court's denial of a new trial on damages.

CONCLUSION

We have considered the parties' remaining arguments and find them unpersuasive. We affirm the district court's denial of judgment as a matter of law of noninfringement with respect to the '812 and '436 patents and reverse the denial as to the '936 patent. We reverse the district court's denial of judgment as a matter of law of willfulness. We reverse the district court's denial of a new trial on damages. We remand for further proceedings consistent with this decision.

**AFFIRMED-IN-PART, REVERSED-IN-PART, AND
REMANDED**

COSTS

Costs awarded to Weber.

**APPENDIX B — ORDER OF THE UNITED STATES
DISTRICT COURT FOR THE WESTERN DISTRICT
OF MISSOURI, ST. JOSEPH DIVISION,
FILED JANUARY 9, 2023**

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF MISSOURI
ST. JOSEPH DIVISION

Case No. 19-cv-06021-SRB

PROVISUR TECHNOLOGIES, INC.,

Plaintiff,

v.

WEBER, INC., *et al.*,

Defendants.

ORDER

Before the Court is Plaintiff Provisur Technologies, Inc.'s ("Plaintiff" or "Provisur") Motion for Willful Infringement Enhanced Damages. (Doc. #497.) For the reasons set forth below, the motion is GRANTED.

I. FACTUAL BACKGROUND

The Court's prior Orders and the parties' briefs have exhaustively discussed the facts of this case. This Order assumes familiarity with the facts and law applicable to all claims and defenses. Only those facts and issues necessary to resolve the pending motion are discussed herein. The

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following is a brief factual summary. Additional facts relevant to the pending motion are set forth in Section III.

Plaintiff designs, makes, and sells commercial food processing technologies. Plaintiff owns four patents that are at issue in this case (the “Patents-at-Issue”): United States Patent Nos. 6,997,089 (“the ’089 Patent”), 7,065,936 (“the ’936 Patent”), 10,625,436 (“the ’436 Patent”) and 10,639,812 (“the ’812 Patent”). Defendants Weber, Inc., Textor Inc., Weber Maschinenbau GmbH Breidenbach, Textor Maschinenbau GmbH, and Weber Maschinenbau GmbH Neubrandenburg (“Defendants” or “Weber”) design, manufacture, and sell commercial food processing machinery to their customers.¹

On February 22, 2019, Plaintiff filed this lawsuit against Defendants for patent infringement.² Plaintiff alleged that Defendants manufacture and sell commercial slicing machines that infringe the Patents-at-Issue. The machinery at issue generally involves a high-speed industrial slicing and packaging machine comprised of a series of belts, conveyors, scanners, sensors, and packaging parts. Bulk food items—such as loaves or blocks of meat or cheese, referred to generally as food

1. Defendants are interrelated corporate entities and subsidiaries. The Court acknowledges the differences between these entities. However, for purposes of clarity and consistency, this Order collectively refers to “Defendants” or “Weber.”

2. Plaintiff filed a subsequent lawsuit against Defendants for patent infringement, Case No. 20-cv-06069-SRB. In an Order dated July 28, 2022, the Court consolidated the two cases and ordered that all future filings should be made in Case No. 19-cv-06021-SRB.

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articles or products—are loaded into the slicer, sliced, and transported down the line for additional processing, sorting, weighing, and packaging. The Patents-at-Issue involve different mechanical components that play distinct roles in this overall conveyor and packaging system.

On October 14, 2022, a nine-day jury trial commenced in this case. On October 28, 2022, the jury returned its verdict. The jury found that Defendants infringed all nine asserted claims of the '936, '436, and '812 patents. The jury found that Defendants did not infringe the '089 patent. The jury also found that the Patents-at-Issue were valid and that Defendants willfully infringed the '936, '436, and '812 patents. The jury awarded Plaintiff \$3,013,068 for Defendants' infringement of the '936 patent, \$3,747,046.50 for Defendants' infringement of the '436 patent, and \$3,747,046.50 for Defendants' infringement of the '812 patent. Therefore, the total damages award in favor of Plaintiff was \$10,507,161. On October 28, 2022, the Court entered judgment in favor of Plaintiff.

Plaintiff now moves for enhanced damages under 35 U.S.C. § 284. In particular, Plaintiff “moves the Court to treble the damages found by the jury for Defendants' infringements of [the] '436, '812, and '936 Patents.” (Doc. #497, p. 1.)³ Defendants oppose the motion, and the parties' arguments are addressed below.

3. Plaintiff states that it “does not seek enhanced damages related to the '089 patent, which the jury found valid but not infringed.” (Doc. #498, p. 24 n.9.) All page numbers refer to the pagination automatically generated by CM/ECF.

*Appendix B***II. LEGAL STANDARD**

Under 35 U.S.C. § 284, “the court may increase the damages up to three times the amount found or assessed” for patent infringement. 35 U.S.C. § 284. “A party seeking enhanced damages under § 284 bears the burden of proof by a preponderance of the evidence.” *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1339 (Fed. Cir. 2016). If a jury finds willful infringement, the court “enjoy[s] discretion in deciding whether to award enhanced damages, and in what amount.” *Halo Elec., Inc. v. Pulse Elec., Inc.*, 579 U.S. 93, 104 (2016); *see also Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1377 (Fed. Cir. 2002) (recognizing that a verdict of willful infringement “authorizes but does not mandate” enhanced damages). “The sort of conduct warranting enhanced damages has been variously described . . . as willful, wanton, malicious, bad-faith, deliberate, consciously wrongful, flagrant, or—indeed—characteristic of a pirate.” *Halo Elec.*, 579 U.S. at 103-04.

III. DISCUSSION

To determine “whether enhanced damages are appropriate, courts should consider the overall circumstances of the case.” *Presidio Components, Inc. v. Am. Tech. Ceramics Corp.*, 875 F.3d 1369, 1382 (Fed. Cir. 2017). The following non-exclusive factors guide the analysis:

- (1) whether the infringer deliberately copied the ideas of another;
- (2) whether the infringer,

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when he knew of the other’s patent protection, investigated the scope of the patent and formed a good-faith belief that it was invalid or that it was not infringed; (3) the infringer’s behavior as a party to the litigation; (4) the defendant’s size and financial condition; (5) the closeness of the case; (6) the duration of the defendant’s misconduct; (7) remedial action by the defendant; (8) the defendant’s motivation for harm; and (9) whether the defendant attempted to conceal its misconduct.

Georgetown Rail Equip. Co. v. Holland LP, 867 F.3d 1229, 1244-45 n.6 (Fed. Cir. 2017) (quotation marks and alterations omitted) (citing *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 827 (Fed. Cir. 1992). “An award need not rest on any particular factor, and not all relevant factors need to weigh in favor of an enhanced award.” *Stryker Corp. v. Zimmer, Inc.*, Case No. 1:10–CV–1223, 2017 WL 4286412, at *3 (W.D. Mich. July 12, 2017), *aff’d*, 745 F. App’x 167 (Fed. Cir. 2018). These factors and other relevant considerations are discussed below.

1. Whether Defendants Intentionally Copied Plaintiff’s Patented Ideas

The first factor considers “whether the infringer intentionally copied the ideas of another.” *Stryker Corp. v. Intermedics Ortho., Inc.*, 96 F.3d 1409, 1414 (Fed. Cir. 1996). Plaintiff argues the evidence at trial “showed—at a minimum—circumstantial evidence of [Defendants’] copying of [Plaintiff’s] patents.” (Doc. #498, p. 8.) Defendants claim the evidence shows that they “did not

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copy [Plaintiff's] patented ideas or designs.” (Doc. #524, p. 8.)⁴ Upon review of the record and the parties’ arguments, the Court finds this factor weighs in favor of enhanced damages.

In particular, the Court finds that Plaintiff presented evidence showing that Defendants:

monitor[ed] and rat[ed] . . . the asserted patents and later s[old] . . . the same ideas and designs. [Defendants’] chief technology officer, Joerg Schmeiser, told his subordinates that [Defendants] would do ‘[w]hatever it takes’ to compete with [Plaintiff]. He collected detailed notes on the designs of Formax’s machines from [Defendants’] employees.

(Doc. #498, p. 8) (citations omitted). In addition, the evidence supports a finding—and the jury found—that Defendants developed products that embodied Plaintiff’s patented technology. Consequently, the first factor supports enhanced damages because the evidence shows that Defendants intentionally copied Plaintiff’s patented ideas.

4. Defendants’ opposition brief argues that the pending motion “relies on the jury’s erroneous willfulness finding and therefore should be mooted by Weber’s post-trial motions seeking to correct that error.” (Doc. #524, p. 6.) In a companion Order, the Court denied Defendants’ motion for a new trial and motion for judgment as a matter of law. The pretrial and trial errors alleged by Defendants are unpersuasive and do not weigh against an award of enhanced damages.

*Appendix B***2. Whether Defendants Had a Good Faith Belief that the Patents-at-Issue Were Invalid or Not Infringed**

The second factor considers, in part, whether the infringer “properly investigate[d] the scope of the patents and form[ed] a good-faith belief that the patents were invalid and/or not infringed.” *Arctic Cat Inc. v. Bombardier Rec. Prods., Inc.*, 198 F. Supp. 3d 1343, 1350 (S.D. Fla. 2016). Plaintiff argues this factor “strongly favors enhancing damages.” (Doc. #498, p. 8.) Plaintiff contends the evidence showed that Defendants “failed to undertake any invalidity or non-infringement investigation, despite its extensive tracking, analysis, and rating of [Plaintiff’s] patents.” (Doc. #498, p. 8.) Defendants respond in part that their “purported failure to produce evidence of an investigation does not support enhanced damages” and that Plaintiff failed to carry its burden of showing “intentional and deliberate infringement.” (Doc. #524, p. 11.)

Upon review of the record and the parties’ arguments, the Court finds this factor weighs in favor of enhanced damages. As explained by Plaintiff:

John White, one of the country’s foremost intellectual property management experts, testified how Weber was plainly aware of Provisur’s patents but did nothing else. Weber did not conduct a landscape search, a background search, a state of the art search, or a freedom to operate analysis regarding

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the patents. Weber did not attempt to design around, license, or file an IPR of the patents, all of which are standard industry practices to avoid infringement risks . . . [n]ot a single Weber employee testified about any belief of invalidity or non-infringement of the asserted patents.

(Doc. #498, pp. 8-9) (citations omitted). For these reasons, the second factor supports an award of enhanced damages.

3. Whether Defendants' Behavior During Litigation Supports Enhanced Damages

The third factor considers whether enhanced damages are warranted based on the infringer's litigation conduct. "Many varieties of [litigation] misconduct can support a district court's finding of enhanced damages." *Metso Minerals, Inc. v. Powerscreen Int'l Distrib. Ltd.*, 833 F. Supp. 2d 333, 339 (E.D.N.Y. 2011). However, "[l]itigation misconduct generally involves unethical or unprofessional conduct by a party or his attorneys during the course of adjudicative proceedings." *Id.* at 338. Such conduct includes, but is not limited to, purchasing the silence of a potential witness, destroying relevant documents, and displaying "a lack of regard for the judicial system." *Id.* at 338-39 (collecting Federal Circuit case law).

Plaintiff argues that Defendants' litigation and trial conduct "weigh[] heavily in favor of enhancing damages." (Doc. #498, p. 10.) Specifically, Plaintiff contends that Defendants: "(1) changed fact witness testimony at trial; (2) violated the Court's evidentiary rulings; (3) refused

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to timely limit its prior art references for trial as the Court ordered, and (4) hid and obfuscated key evidence throughout the case.” (Doc. #498, pp. 10-16.) Defendants respond that “[n]othing about [their] litigation and trial conduct evidences willful infringement.” (Doc. #524, p. 11.) Defendants further claim that “if anything, it was Provisur who filled its time at trial with distractions, conjecture, and theater.” (Doc. #524, p. 12.)

Upon review, the Court finds the third factor is neutral and does not weigh in favor of enhanced damages. Throughout this case, Plaintiff and Defendants have repeatedly accused each other of wrongdoing. The parties’ briefs on factor three is the latest example of this. Among other things, Plaintiff claims that Defendants “lied in their interrogatory responses and withheld the truth during two years of discovery.” (Doc. #498, p. 14.) Defendants respond that Plaintiff’s accusation is “baseless and false,” and that Plaintiff “deliberately” misled the jury. (Doc. #524, pp. 13, 15.)

The parties’ arguments on this factor raise many of the same or similar disputes that were previously resolved by the Court, either before or during trial.⁵ In addition, Defendants have provided plausible explanations for their discovery and trial conduct. Viewing the record as a whole, the Court cannot conclude that Defendants’ litigation and trial conduct supports enhanced damages. Consequently, this factor is neutral.

5. By way of one example, the Court denied Plaintiff’s motion for sanctions which alleged discovery misconduct by Defendants. (Doc. #358.)

*Appendix B***4. Whether Defendants' Size and Financial Condition Supports Enhanced Damages**

The fourth factor considers the infringer's size and financial condition. If the infringer is a large company, an enhancement may be warranted "to deter infringing conduct." *Stryker Corp.*, 2017 WL 4286412, at *5. Plaintiff argues that enhancement is necessary "to serve the intended deterrent function" because Defendants' annual revenue "in a single, global pandemic year" was "approximately \$100 million." (Doc. #498, p. 17.) Plaintiff also argues that damages should be enhanced because Defendants failed to use their financial resources to develop a non-infringing alternative.

Defendants respond that this factor "is given weight only *against* enhancement or to inform the amount." (Doc. #524, p. 18) (emphasis in original). Defendants further contend that "[t]o the extent size matters at all, Weber is actually smaller than Provisur." (Doc. #524, p. 18.) According to Defendants, this difference in size "is likely one of the reasons Provisur is trying to bully Weber with multiple successive lawsuits and other litigation costs." (Doc. #524, p. 18.)

Upon review, the Court finds this factor weighs in favor of Plaintiff. Factor four "is often given weight against enhancement in situations where, for instance, the other . . . factors strongly support enhancement but the infringer is in such perilous financial condition that an award of enhanced damages might put it out of business." *See Idenix Pharm. LLC v. Gilead Sciences, Inc.*, 271 F.

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Supp. 3d 694, 701 (D. Del. 2017). But that general rule is not applicable here. Weber is a large company with significant revenue. Defendants' opposition brief "never claims an inability to pay" enhanced damages, or that enhanced damages "could be equivalent to an organizational death sentence." (Doc. #534, p. 11); *Idenix Pharm. LLC*, 271 F. Supp. 3d at 701 (citations omitted). Finally, Defendants did not use their substantial resources, financial or otherwise, to develop a non-infringing alternative. Under these circumstances, and "[t]o deter infringing conduct," the Court finds that Defendants' size and financial condition supports enhanced damages. *Stryker Corp.*, 2017 WL 4286412, at *5 (focusing only on the size of the infringer without discussing the relative size of the parties).

5. Whether this Case Involved Close Issues

Plaintiff contends the fifth factor weighs in favor of enhanced damages because this case did not involve close issues. Plaintiff argues that the jury and the United States Patent and Trademark Office rejected Defendants' validity arguments on each asserted claim of the '936, '436, and '812 patents. Plaintiff also emphasizes that the jury found infringement on all asserted claims of the '936, '436, and '812 patents, and "fully adopted the damages calculated" by Plaintiff's expert. (Doc. #498, p. 20.)

Defendants believe the issues were close, and that they should have obtained a complete victory. Specifically, Defendants argue they "did not prevail on validity at trial because the Court gutted [their] prior-art defenses on the eve of opening statements." (Doc. #524, p. 19.) Defendants

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believe that “Provisur only prevailed on infringement, validity, and damages for the SmartLoader and slicers based on the numerous prejudicial errors discussed in Weber’s post-trial motions. It was not because the evidence actually favored Provisur.” (Doc. #524, p. 19.)⁶

Overall, the Court finds this case did not involve close issues. Although Defendants obtained a verdict of non-infringement on the ’089 patent, the remaining issues were not close. The jury rejected all of Defendants’ validity arguments, found infringement of the ’936, ’436, and ’812 patents, and awarded Plaintiff the full amount of damages on those patents. The jury also needed less than four hours to reach their verdicts. *See Jiaxing Super Lighting Elec. Appliance Co. v. CH Lighting Tech Co., Ltd.*, 6:20-cv-00018-ADA, 2022 WL 3371630, at *6 (W.D. Tex. Aug. 16, 2022) (recognizing that “courts have enhanced damages based in part on the length of the jury’s deliberations and the asymmetry of the outcome.”).

Based on the entire record, the Court finds this case did not involve close issues on validity, infringement, or damages. Consequently, the fifth factor supports enhanced damages.

6. Defendants also note that, at the summary judgment stage, the Court found some of their non-infringement positions persuasive. But the Court’s summary judgment orders were entered prior to trial, and without the full presentation of live witnesses and all other evidence.

*Appendix B***6. Whether the Duration of Defendants’ Misconduct Supports Enhanced Damages**

“The sixth factor looks at the duration of the infringer’s misconduct or the duration of infringement when the defendant had knowledge of the patent.” *Canon, Inc. v. Color Imaging, Inc.*, 292 F. Supp. 3d 1357, 1366-67 (N.D. Ga. 2018). Plaintiff argues the duration of Defendants’ infringement weighs in favor of enhanced damages. Defendants respond that this factor supports enhanced damages “only where the defendant continues to infringe after a judicial finding of infringement.” (Doc. #524, p. 20.) Defendants also contend in part that they “only learned of the asserted ’436 and ’812 patents within days of Provisur bringing this action.” (Doc. #524, p. 21.)

Upon review, the Court finds that the duration of Defendants’ conduct supports enhanced damages. As an initial matter, the Court rejects Defendants’ legal argument that this factor is limited to an infringer’s post-judgment conduct. “Although a handful of district courts have interpreted the sixth . . . factor in this narrow manner, this interpretation remains a minority view.” *EagleView Tech., Inc. v. Xactware Sol., Inc.*, 522 F. Supp. 3d 40, 53 (D.N.J. 2021). Post-judgment conduct may be relevant, but such conduct is not exclusive. *See id.*

The duration of misconduct begins when the infringer first learned of the patent. *Milwaukee Electric Tool Corp. v. Snap-On Inc.*, 288 F. Supp. 3d 872, 903 (E.D. Wisc. 2017). Plaintiff argues—and the Court agrees—that Defendants had been aware of the ’936 patent since at

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least March 17, 2014. (Doc. #498, p. 20.) Plaintiff has also shown that Defendants “learned of the ’436 and ’812 patent applications—which the jury found to be substantially identical to the issued patents—on April 30, 2019 and November 21, 2018, respectively.” (Doc. #534, p. 12.) Because Defendants’ infringement continued into 2021 and 2022, the duration of Defendants’ misconduct weighs in favor of enhanced damages. *See Apple Inc. v. Samsung Elec. Co., Ltd.*, 258 F. Supp. 3d 1013, 1015 (N.D. Cal. 2017) (finding that a “10 to 12 month period of infringement [may] weigh[] in favor of enhanced damages”); *I-Flow Corp. v. Apex Med. Tech., Inc.*, No. 07cv1200 DMS (NLS), 2010 WL 114005, at *3 (S.D. Cal. Jan. 6, 2010) (“Six years of misconduct is substantial, and thus this factor weighs in favor of an award of enhanced damages.”)

7. Whether Defendants Engaged in Remedial Action

With respect to factor seven, Plaintiff argues that Defendants failed to take any remedial action. Instead, Defendants “continued selling infringing products through 2022 while, simultaneously, hiding evidence of infringement and willfulness.” (Doc. #498, p. 21.) Defendants respond that they “took no remedial action because [they] saw no need.” (Doc. #524, p. 21.) Upon review, the Court finds this factor weighs in favor of enhanced damages. Despite significant evidence supporting Plaintiff’s validity and infringement arguments, Defendants concede they took no remedial action. Defendants “readily admit[] here that [they] did not attempt to design-around the patents in this case because [they] saw no possibility of infringing

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any valid Provisur claim.” (Doc. #524, p. 22.) Based on these concessions, and the record as a whole, Defendants’ failure to engage in remedial action supports an award of enhanced damages.

8. Whether Defendants Had Motivation to Harm Plaintiff

The eighth factor considers whether the infringer was motivated to harm the plaintiff. *Read Corp.*, 970 F.2d at 827. In general, mere competition between the parties does not show a motivation to harm. *Sunoco Partners Mktg. & Terminals L.P. v. Powder Springs Logistics, LLC*, No. 17-1390-RGA, 2022 WL 3973499, at *2 (D. Del. Aug. 31, 2022) (“[O]rdinary competition driven by a profit motive does not constitute . . . motivation to harm.”). However, “infringement by a direct competitor in a small market mitigates in favor of enhanced damages.” *Jiaxing Super Lighting*, 2022 WL 3371630, at *9 (alterations and citation omitted). This is particularly true when the competition is “fierce,” and the parties are “rivals.” *Id.*

Plaintiff argues this factor weighs in favor of enhanced damages because the parties are “fierce competitors” and “two of the few participants in the industrial food slicing equipment market.” (Doc. #498, p. 22.) Defendants contend that the parties are garden-variety competitors, and that Plaintiff has not produced evidence sufficient to support this factor.

Upon review, the Court finds that factor eight weighs in favor of Plaintiff. The parties agree they are competitors

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in the relatively small industrial food slicing market. In addition, and as explained by Plaintiff:

The jury saw evidence of Weber wanting to ‘beat the shit out of Formax.’ Mr. McCarroll struggled to identify the boundary for competition, saying that Weber would not ‘hold someone hostage.’ The trial evidence showed Weber instructing employees to take ‘whatever it takes’ and ‘[n]othing’s off limits’ approaches to competing with Provisur, and Mr. McCarroll hiring a former Provisur employee and asking him for a copy of Provisur’s confidential customer list.

(Doc. #498, p. 22) (citations omitted). Based on this evidence, along with evidence showing willful infringement, Plaintiff has shown that Defendants had a motivation to harm. Therefore, this factor weighs in favor of enhanced damages.

9. Whether Defendants Attempted to Conceal their Misconduct

For the final factor, Plaintiff argues that Defendants concealed important evidence and witnesses during discovery and at trial. Defendants respond that “[t]here is no evidence—and indeed no allegation—that Weber concealed its allegedly infringing machines from Provisur.” (Doc. #524, p. 23.) Defendants argue that Plaintiff’s “other arguments continue its misrepresentations of the discovery record and the parties’ discovery disputes.” (Doc. #524, pp. 23-24.)

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Upon review, the Court finds this factor is neutral. As discussed above, both parties have accused each other of misconduct throughout this litigation. Both parties have filed motions for sanctions, both motions were denied. Plaintiff has failed to show that Defendants attempted to conceal misconduct in such a way that would support enhanced damages. Consequently, this factor is neutral.

IV. This Case Warrants Enhanced Damages of Double the Jury’s Verdict

As discussed above, factors 1, 2, 4, 5, 6, 7, and 8 weigh in favor of enhanced damages. Based on those factors—and after reviewing the entire record—the Court finds that Defendants’ conduct was an “egregious case[] of misconduct beyond typical infringement.” *Halo Elec.*, 579 U.S. at 103-04, 110. As explained by Plaintiff, enhanced damages are warranted because Defendants’ “systemic misconduct transcended that of a garden-variety infringer.” (Doc. #534, p. 5.)

Plaintiff argues that triple damages should be awarded because all nine factors weigh in its favor. However, the Court found that factors 3 and 9 are neutral. In addition, Defendants were not completely defeated at trial; the jury found non-infringement of the ’089 patent.

Although enhanced damages are warranted, the circumstances of this case “are not so clear to justify treble damages either.” *Pro batter Sports, LLC v. Sports Tutor, Inc.*, 586 F. Supp. 3d 80, 120 (D. Conn. 2022). The Court therefore exercises its discretion and awards

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Plaintiff enhanced damages of double the jury's verdict. *See Halo Elec.*, 579 U.S. at 104 (recognizing that the district court “enjoy[s] discretion in deciding whether to award enhanced damages, and in what amount”); *Del Mar Avionics, Inc. v. Quinton Instr. Co.*, 836 F.2d 1320, 1329 (Fed. Cir. 1987) (holding no abuse of discretion “in doubling the damage award” and stating that “[a] trial court’s exercise of discretion in such circumstances is informed by the court’s familiarity with the matter in litigation and the interest of justice”).

V. CONCLUSION

Accordingly, it is hereby ORDERED that Plaintiff’s Motion for Willful Infringement Enhanced Damages (Doc. #497) is GRANTED. Plaintiff is awarded enhanced damages of double the jury’s verdict on the ’436, ’812, and ’936 patents.

IT IS SO ORDERED.

/s/ Stephen R. Bough
STEPHEN R. BOUGH
UNITED STATES DISTRICT JUDGE

Dated: January 9, 2023

**APPENDIX C — ORDER OF THE UNITED STATES
DISTRICT COURT FOR THE WESTERN DISTRICT
OF MISSOURI, ST. JOSEPH DIVISION,
FILED JANUARY 9, 2023**

UNITED STATES DISTRICT COURT FOR
THE WESTERN DISTRICT OF MISSOURI
ST. JOSEPH DIVISION

Case No. 19-cv-06021-SRB

PROVISUR TECHNOLOGIES, INC.,

Plaintiff,

v.

WEBER, INC., *et al.*,

Defendants.

January 9, 2023, Decided
January 9, 2023, Filed

STEPHEN R. BOUGH,
UNITED STATES DISTRICT JUDGE.

ORDER

Before the Court are Defendant Weber, Inc., Textor Inc., Weber Maschinenbau GmbH Breidenbach, Textor Maschinenbau GmbH, and Weber Maschinenbau GmbH Neubrandenburg's ("Defendants") (1) Rule 50(b) Motion for Judgment as a Matter of Law (Doc. #501); and

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(2) Rule 59 Motion for a New Trial (Doc. #503).¹ Plaintiff Provisur Technologies, Inc. (“Plaintiff”) has filed briefs in opposition to both motions. Upon review, Defendants’ motions are DENIED.

The facts of this case have been exhaustively discussed in the Court’s prior Orders and in the parties’ briefs. They will not be repeated herein. This Order assumes familiarity with the facts and law applicable to the claims and defenses asserted in this case.

Federal Rule of Civil Procedure 50(b) allows a party that has previously moved for judgment as a matter of law to renew that motion no later than 28 days after the entry of judgment. Fed. R. Civ. P. 50(b). When reviewing a motion under Rule 50(b), a court must “affirm the jury’s verdict unless, viewing the evidence in the light most favorable to the prevailing party, . . . a reasonable jury could not have found for that party.” *Hite v. Vermeer Mfg. Co.*, 446 F.3d 858, 865 (8th Cir. 2006) (citation omitted). The court should “review all of the evidence in the record,” and “draw all reasonable inferences in favor of the nonmoving party,” without making credibility determinations or weighing the evidence. *Reeves v. Sanderson Plumbing Prods., Inc.*, 530 U.S. 133, 150, 120 S. Ct. 2097, 147 L. Ed. 2d 105 (2000) (citations omitted). “Judgment as a matter of law is proper only when there is a complete absence of probative facts to support the conclusion reached so that

1. Defendants are interrelated corporate entities and subsidiaries. The Court acknowledges the differences between these entities. However, for purposes of clarity and consistency, this Order collectively refers to Defendants.

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no reasonable jury could have found for the nonmoving party.” *Foster v. Time Warner Entm’t Co.*, 250 F.3d 1189, 1194 (8th Cir. 2001).

In this case, Defendants’ Rule 50(b) motion raises numerous arguments. Defendants’ primary arguments are as follows: there is no evidence that the SmartLoader can operate as an advancing conveyor as properly construed; Plaintiff’s accusations of spoliation and concealing evidence cannot support an infringement verdict as a matter of law; the SmartLoader alone cannot satisfy the web of advancing film limitation as a matter of law; the TS750 and the 908 Slicers do not infringe the ’436/’812 patents as a matter of law; the accused 900-Series slicers do not infringe the ’436/’812 patents as a matter of law; Defendants do not infringe the ’436/’812 patents as a matter of law; and Defendants did not willfully infringe any patent as a matter of law.

Upon review of the record and the parties’ arguments, the Court finds that Defendants are not entitled to judgment as a matter of law. For the reasons stated in Plaintiff’s opposition brief, in the Court’s prior Orders, and by the Court at trial, Defendants’ arguments are rejected. A reasonable jury could have found for Plaintiff under the evidence and applicable law. *Foster*, 250 F.3d at 1194. Therefore, Defendants’ Rule 50(b) motion for judgment as a matter of law is denied.

Defendants also move for a new trial under Federal Rule of Civil Procedure 59. Rule 59 “confirms the trial court’s historic power to grant a new trial based on its

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appraisal of the fairness of the trial and the reliability of the jury's verdict." *Gray v. Bicknell*, 86 F.3d 1472, 1480 (8th Cir. 1996). "A new trial is appropriate when the first trial, through a verdict against the weight of the evidence, an excessive damage award, or legal errors at trial, resulted in a miscarriage of justice." *Id.* When ruling on a motion for a new trial, the court has broad discretion. *Innovative Home Health Care, Inc. v. P.T.-O.T. Assocs. of the Black Hills*, 141 F.3d 1284, 1286 (8th Cir. 1998). However, a Rule 59 motion serves the "limited function of correcting manifest errors of law or fact or to present newly discovered evidence." *Id.*

In this case, Defendants present numerous arguments in support of their motion for a new trial. Defendants' primary arguments are as follows: Plaintiff misrepresented discovery disputes and European proceedings which misled and prejudiced the jury; Plaintiff misrepresented the law on willful infringement that tainted the jury on willfulness and infringement; the Court wrongly precluded Defendants from offering testimony about its patent monitoring program; the Court erroneously instructed the jury on claim construction; the Court erred by preventing Defendants from introducing evidence in support of their invalidity defenses; Defendants were wrongly prevented from presenting deposition testimony of Plaintiff's employees; and the jury's damages verdict was excessive, against the great weight of the evidence, and based on erroneous jury instructions.

Upon review of the record and the parties' arguments, the Court finds that Defendants are not entitled to a

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new trial. For the reasons stated in Plaintiff's opposition brief, in the Court's prior Orders, and by the Court at trial, Defendants' arguments are rejected. Therefore, Defendants' motion for a new trial under Rule 59 is denied.

Accordingly, it is hereby ORDERED that:

(1) Defendants' Rule 50(b) Motion for Judgment as a Matter of Law (Doc. #501) is DENIED; and

(2) Defendants' Rule 59 Motion for a New Trial (Doc. #503) is DENIED.

IT IS SO ORDERED.

/s/ Stephen R. Bough
STEPHEN R. BOUGH
UNITED STATES DISTRICT JUDGE

Dated: January 9, 2023

**APPENDIX D — ORDER OF THE UNITED STATES
DISTRICT COURT FOR THE WESTERN DISTRICT
OF MISSOURI, ST. JOSEPH DIVISION,
FILED JULY 13, 2022**

IN THE UNITED STATES DISTRICT COURT FOR
THE WESTERN DISTRICT OF MISSOURI
ST. JOSEPH DIVISION

Case No. 19-cv-06021-SRB

PROVISUR TECHNOLOGIES, INC.,

Plaintiff,

v.

WEBER, INC., *et al.*,

Defendants.

ORDER

Before the Court is Defendant Weber, Inc., Textor Inc., Weber Maschinenbau GmbH Breidenbach, Textor Maschinenbau GmbH, and Weber Maschinenbau GmbH Neubrandenburg’s (“Defendants”) Motion to Exclude the Improper Expert Opinions of White and McGuire.¹ (Doc. #285.) As set forth below, the motion is GRANTED IN PART and DENIED IN PART.

1. Defendants are interrelated corporate entities and subsidiaries. The Court acknowledges the differences between these entities. However, for purposes of clarity and consistency, this Order collectively refers to Defendants.

*Appendix D***I. FACTUAL BACKGROUND**

The facts of this patent infringement case are discussed in prior Orders and in the parties' briefs, and will not be repeated herein. The following is a brief summary. Plaintiff Provisur Technologies, Inc. ("Plaintiff") designs, makes, and sells commercial food processing technologies. Plaintiff owns four patents that are at issue in this case (the "Patents-at-Issue"): United States Patent Nos. 8,322,537 ("the '537 Patent"), 7,065,936 ("the '936 Patent"), 6,669,005 ("the '005 Patent"), and 6,997,089 ("the '089 Patent"). Defendants design, manufacture, and sell commercial food processing machinery to their customers.

The machinery underling this lawsuit generally involves a high-speed industrial slicing and packaging machine comprised of a series of belts, conveyors, scanners, sensors, and machine parts. Bulk food items—such as loaves or blocks of meat or cheese, referred to generally as food articles or products—are loaded into the slicer, sliced, and transported down the line for additional processing, sorting, weighing, and packaging. The Patents-at-Issue involve different mechanical components that play distinct roles in this overall conveyor and packaging system.

On February 22, 2019, Plaintiff filed this patent-infringement lawsuit against Defendants.² Plaintiff alleges

2. Plaintiff also filed two separate but related patent-infringement cases against Defendants. *See Provisur Technologies, Inc. v. Weber, Inc., et al.*, Case No. 20-cv-06069 (W.D. Mo.) (Bough, J. presiding); *Provisur Technologies, Inc. v. Weber, Inc., et al.*, Case No. 21-cv-06113-SRB (W.D. Mo.) (Bough, J. presiding). All

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that Defendants manufacture and sell commercial slicing machines that infringe the Patents-at-Issue. Plaintiff further alleges that Defendants willfully infringed the Patents-at-Issue which warrants a trebling of “any and all damages” under 35 U.S.C. § 284. (Doc. #15, pp. 38-39.)³

Plaintiff has retained two experts to offer testimony on the topic of willful infringement: John White and Mary-Rose McGuire. Mr. White has over thirty years of experience with patents, and “currently run[s] the PCT Learning Center that provides consulting and educational services regarding international property practice.” (Doc. #286-3, p. 5.) According to Plaintiff, Mr. White “will explain how Defendants failed to meet industry standards for preventing infringement of a competitor’s patents.” (Doc. #314, p. 5.) This explanation will allegedly assist the jury in understanding “industry standards for managing patent portfolios and avoiding patent infringement, and how Defendants’ behavior measures against those standards.” (Doc. #314, p. 5.)

Ms. McGuire is a professor of intellectual property at the University of Osnabrück in Germany. Because some of the Defendants are German companies, Ms. McGuire will allegedly “explain that Defendants’ lack of IP-risk management and lack of respect for existing patents is contrary to custom and practice with respect to German compliance for German companies operating domestically

three cases remain pending.

3. All page numbers refer to the pagination automatically generated by CM/ECF.

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and internationally.” (Doc. #314, p. 6.) According to Plaintiff, Ms. McGuire’s “testimony will provide additional context for the jury to aid in evaluating the foreign standards of an industry to which they otherwise would not have access.” (Doc. #314, p. 6.)

Defendants now move to exclude Mr. White and Ms. McGuire from testifying at trial. Defendants argue their opinions are inadmissible under Federal Rule of Evidence 702 and *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 509 U.S. 579 (1993). Plaintiff opposes the motion, and the parties’ arguments are addressed below.

II. LEGAL STANDARD

Federal Rule of Evidence 702 governs the admissibility of expert testimony. *See* Fed. R. Evid. 702; *Wagner v. Hesston Corp.*, 450 F.3d 756, 758 (8th Cir. 2006). Rule 702 provides that a witness who is qualified as an expert may offer testimony if:

(a) the expert’s . . . specialized knowledge will help the trier of fact to understand the evidence or to determine a fact in issue; (b) the testimony is based on sufficient facts or data; (c) the testimony is the product of reliable principles and methods; and (d) the expert has reliably applied the principles and methods to the facts of the case.

Fed. R. Evid. 702(a)-(d). Federal Rule of Evidence 703 further provides in part that “[a]n expert may base an

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opinion on facts or data in the case that the expert has been made aware of or personally observed.” Fed. R. Evid. 703.

To fulfill its “gatekeeping” role, a court faced with a proffer of expert testimony must determine at the outset whether the evidence “both rests on a reliable foundation and is relevant to the task at hand.” *Daubert*, 509 U.S. at 597. *Daubert* emphasized that the inquiry required by Rule 702 is intended to be flexible. *Id.* at 594. “The proponent of the expert testimony must prove its admissibility by a preponderance of the evidence.” *Lauzon v. Senco Prods., Inc.*, 270 F.3d 681, 686 (8th Cir. 2001).

Due to the liberalization of expert testimony admission standards signaled by *Daubert* and its progeny, and the codification of this trend in Rule 702, the Eighth Circuit has held that expert testimony should be liberally admitted. *Johnson v. Mead Johnson & Co., LLC*, 754 F.3d 557, 562 (8th Cir. 2014) (“*Daubert* and Rule 702 thus greatly liberalized what had been the strict . . . standards for admission of expert scientific testimony.”); *Robinson v. GEICO Gen. Ins. Co.*, 447 F.3d 1096, 1100 (8th Cir. 2006) (“A review of the caselaw after *Daubert* shows that the rejection of expert testimony is the exception rather than the rule.”) (citations and quotations omitted). As long as the expert testimony “rests upon good grounds, based on what is known, it should be tested by the adversary process with competing expert testimony and cross-examination, rather than excluded by the court at the outset.” *Johnson*, 754 F.3d at 562 (citations and quotations omitted). The exclusion of expert testimony is proper

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“only if it is so fundamentally unsupported that it can offer no assistance to the jury[.]” *Wood v. Minn. Mining & Mfg. Co.*, 112 F.3d 306, 309 (8th Cir. 1997) (citations and quotations omitted).

III. DISCUSSION

“A patent owner may seek enhanced damages (up to three times the amount found or assessed) under 35 U.S.C. § 284 when an infringer has willfully infringed the patent.” *Sudenga Indus., Inc. v. Global Indus., Inc.*, Case No. 2:18-cv-02498-HLT, 2021 WL 916630, at *9 (D. Kan. Mar. 10, 2021). An award of enhanced damages is limited “to egregious cases of misconduct beyond typical infringement.” *Halo Elec., Inc. v. Pulse Elec., Inc.*, 579 U.S. 93, 110 (2016). This determination depends on “the totality of the circumstances,” and may include whether the alleged infringer “acted consistently with the standards of behavior for its industry.” *Comark Commc’n, Inc. v. Harris Corp.*, 156 F.3d 1182, 1190 (Fed. Cir. 1998); FCBA Model Patent Jury Insr. B.3.10(1).

In general, “willful infringement is a question for the jury, and several courts have found expert testimony on the ultimate issue of willfulness inappropriate.” *Bombardier Recreational Prods. Inc. v. Arctic Cat Inc.*, Civil No. 12-2706 (JRT/LIB), 2017 WL 758335, at *4 (D. Minn. Feb. 24, 2017). However, an expert may testify on topics that bear on the issue of willfulness. For example, expert testimony may be admissible if it “interpret[s] technical data and provid[es] context for the jury’s decision regarding willfulness.” *Id.* at *5.

*Appendix D***A. Mr. White's Opinions**

Mr. White has years of experience in patent infringement issues, including industry standards for avoiding patent infringement. He has served as the Director of Patent Professional Development at Practising Law Institute, is the principal author for a patent bar exam review course, has served as general patent counsel for various companies, and is a professor on patent courses at the University of Virginia Law School and John Marshall Law School.

Mr. White has authored an Expert Report and Disclosure in this case. Among other things, Mr. White describes the industry standards, practices, and customs for avoiding patent infringement. Based on his experience and review of this case, Mr. White opines in part that “despite clear knowledge of [Plaintiff’s] patents, Defendants failed to meet industry standards and practices for preventing infringement of them.” (Doc. #314, p. 7.)

Defendants argue that Mr. White’s opinions are inadmissible for several reasons. Defendants contend that Mr. White will improperly attempt to explain to the jury case law on the issue of willful infringement, improperly “select[s] certain facts and pieces of evidence in the record and present[s] a narration suggesting Defendants’ state of mind regarding infringement,” and is not qualified to offer opinions on the standard of care in the food-product slicing industry. (Doc. #286, pp. 12-16; Doc. #324, pp. 7-12.) Defendants further contend that Mr. White “improperly

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concludes that Defendants willfully infringed based in part on their failure to present evidence of advice of counsel with respect to the allegedly infringed patents,” in violation of 35 U.S.C. § 298. (Doc. #286, p. 14.)

Upon review, the Court finds that Mr. White’s opinions on industry standards and practices to avoid infringement—and how Defendants’ conduct compared to those standards— are admissible. First, the Court finds Mr. White is qualified to offer such opinions. Even assuming Mr. White does not have experience in the food-product slicing industry, Mr. White testified that the standard of care to avoid patent infringement does not vary by industry. Based on that testimony and Mr. White’s overall experience and knowledge, the Court cannot conclude that he is unqualified to offer his opinions in this case.

Second, it does not appear that Mr. White is attempting to instruct the jury on relevant case law. Instead, as explained by Plaintiff, “Mr. White’s Report cites to law only to explain the framework of how he performed his analysis and arrived at his conclusions, which he is permitted to do.” (Doc. #314, p. 14 n.2.) Third, Mr. White’s report does not contain an improper narrative of the facts and background of this case. Under Federal Rule of Evidence 703, an “expert may base an opinion on facts or data in the case that the expert has been made aware of or personally observed.” Fed. R. Evid. 703. Mr. White’s report contains alleged facts and data that he has been made aware of in order to form an opinion. Under Rule 703, he may use that information to lay the foundation for his opinions.

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For these reasons, the Court denies Defendants' motion to exclude Mr. White from testifying about standards and practices to avoid patent infringement, and how Defendants' conduct compared to those standards. On the current record, Mr. White is qualified, his opinions appear to be relevant, and those opinions are likely to assist the trier of fact. Defendants' arguments are more suited for cross-examination, not exclusion.

However, the Court agrees with Defendants that Mr. White may not offer legal conclusions or opine on Defendants' subjective state of mind. Mr. White's expert report contains impermissible opinions and testimony which will not be permitted at trial. For example, Mr. White will not be permitted to testify that:

- Defendants' directions to their employees were "reckless."
- "[Defendants'] . . . outright corporate espionage . . . intended harm to [Plaintiff], great harm[.]"
- "Defendants' conduct has been deliberate and intended. They have, and had, no reasonable basis to believe that their conduct would not infringe[.]"
- "Defendants intended harm, considerable harm, to [Plaintiff]."
- "[I]t is clear that Defendants ha[d] no intention of allowing fact discovery as to any steps they ever undertook to avoid infringement."

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- “My opinion is that Defendants engaged in the intentional conduct of selling their machinery in the U.S. . . . and did commit willful infringement.

(Doc. #286-3, ¶¶ 119-121, 123-24.)

The foregoing examples are not exhaustive. At trial, Plaintiff’s counsel is precluded from eliciting legal conclusions or opinions about Defendants’ subjective state of mind. *See Trading Techs. Int’l, Inc. v. IBG LLC*, No. 10-715, 2020 WL 12309206, *1-2 (N.D. Ill. Oct. 21, 2020) (“The jurors do not need a patent attorney to tell them whether to believe witnesses when they say they had no intent to infringe or to determine for them what to infer from the evidence about [the defendant’s] intentions.”).

Finally, the Court also agrees with Defendants that Mr. White may not offer testimony regarding Defendants’ alleged failure to obtain the advice of counsel. Under 35 U.S.C. § 298, “[t]he failure of an infringer to obtain the advice of counsel with respect to any allegedly infringed patent, or the failure of the infringer to present such advice to the court or jury, may not be used to prove that the accused infringer willfully infringed the patent or that the infringer intended to induce infringement of the patent.” 35 U.S.C. § 298. Under this statute, an alleged infringer’s “decision not to seek an advice-of-counsel defense is legally irrelevant[.]” *SRL Int’l, Inc. v. Cisco Sys., Inc.*, 930 F.3d 1295, 1309 (Fed. Cir. 2019).

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Plaintiff argues that Mr. White’s advice of counsel opinion does not violate § 298. According to Plaintiff, *Halo Elec., Inc. v. Pulse Elec., Inc.*, 579 U.S. 93 (2016) “clarified that Congress did not entirely prohibit consideration of whether a party sought [] advice of counsel in adopting § 298, but merely corrected the [Federal Circuit’s] prior decision in *Underwater Devices v. Morrison-Knudsen Co.*, 717 F. 2d 1380 (1983), ‘which had imposed an affirmative duty to obtain advice of counsel.’” (Doc. #314, p. 16.) The Court disagrees with Plaintiff’s interpretation. *Halo* did not attempt to rewrite or otherwise limit the plain language of § 298. Indeed, the Federal Circuit Court of Appeals subsequently recognized that advice of counsel is “legally irrelevant” under § 298. *SRL, Int’l*, 930 F.3d at 1309. For these reasons, Mr. White is precluded from testifying regarding whether Defendants sought advice of counsel on the issue of possible infringement.

B. Ms. McGuire

As stated above, Ms. McGuire is a professor of intellectual property at the University of Osnabrück in Germany. Ms. McGuire has research experience with respect to patent management and infringement issues. According to Plaintiff, Ms. McGuire:

sets forth the German standards, practices, and customs in the industry for an international company seeking to avoid patent infringement risks. Much of [the] conduct at issue here took place in Germany. Several defendants in this case are German entities . . . [a]pplying

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Defendants' conduct to these standards, [Ms.] McGuire opines that Defendants' lack of IP-risk management and lack of respect for existing patents is contrary to custom and practice with respect to German compliance for German companies operating domestically and internationally.

(Doc. #314, p. 8.)

Defendants argue these opinions should be excluded at trial. In particular, Defendants contend that “Ms. McGuire is a professor of law in Germany who is admittedly unqualified to offer opinions on U.S. patent law, let alone the concept of willfulness under U.S. law.” (Doc. #286, p. 16.) According to Defendants, “every statement and opinion in her report relates to theoretical German legal concepts and her own subjective beliefs regarding a hypothetical standard of care in Germany—a standard that courts in Germany have never applied . . . and is completely irrelevant to any issue in this case.” (Doc. #286, p. 16-18.)

Upon review, the Court finds that Ms. McGuire's opinions are not relevant to any issue in this case. The claims asserted by Plaintiff in this case arise under United States, not German law. The law of the United States similarly applies to whether Defendants willfully infringed any of the Patents-at-Issue. *See* 35 U.S.C. § 284. Indeed, Ms. McGuire agrees that “German law doesn't apply in the U.S.” (Doc. #286-6, p. 10.) Ms. McGuire acknowledges that “[w]hether Defendants' behavior

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constitutes willful infringement under U.S. patent law is governed by U.S. law” and that she will “provide no opinions about U.S. patent law[.]” (Doc. #286-4, p. 22.) Ms. McGuire further testified that the concept of willfulness under United States law is “beyond her expertise” and that German law does not provide for triple damages upon a showing of willful infringement. (Doc. #286-6, p. 12.)

Under these circumstances, Ms. McGuire’s opinions about German law and German standards of care are irrelevant to any issue in this case. Whether or not Defendants’ conduct met or fell below German law and German standards will not “help the trier of fact to understand the evidence or to determine a fact in issue[.]” Fed. R. Evid. 702(a). Even if Ms. McGuire’s opinions were relevant, the introduction of German law and standards into a case governed by United States law would result in “jury confusion [that] far outweighs any probative value” of such opinions. (Doc. #324, p. 13.) For these reasons, the Court provisionally grants Defendants’ motion to exclude Ms. McGuire from testifying at trial. If warranted, the Court will *sua sponte* reconsider this ruling at a later date.

IV. CONCLUSION

For the foregoing reasons, it is hereby ORDERED that Defendants’ Motion to Exclude the Improper Expert Opinions of White and McGuire (Doc. #285) is GRANTED IN PART and DENIED IN PART. The motion is GRANTED insofar as Mr. White is precluded from testifying about Defendants’ state of mind, from offering legal conclusions, and from offering testimony regarding

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the advice of counsel. The motion is PROVISIONALLY GRANTED insofar as Ms. McGuire is precluded from testifying at trial. The motion is DENIED in all other respects.

IT IS SO ORDERED.

/s/ Stephen R. Bough
STEPHEN R. BOUGH
UNITED STATES DISTRICT JUDGE

Dated: July 13, 2022