

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAIHONG DISPLAY DEVICES CO., LTD.,
Petitioner

v.

CORNING INCORPORATED,
Patent Owner

Case IPR2025-00937
U.S. Patent No. 8,640,498

**PATENT OWNER'S REPLY BRIEF ON
DISCRETIONARY DENIAL**

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Patent Owner submits this Reply pursuant to the Board's authorization email sent September 3, 2025. EX3101. Petitioner's Opposition purports to identify a material error in the Office's examination of the claims, but merely identifies disagreement with the Office's ultimate determination of patentability. That is not a basis for institution under § 325(d).

Specifically, the alleged material error Petitioner identifies for Grounds 1 and 4 is that the Examiner did not cite the Miwa '377 and Peuchert '293 references that Petitioner presented in the Petition, and the Examiner did not apply the rejections that Petitioner thinks they should have applied. Opp. at 7-8. That Petitioner would have examined the application differently and applied different rejections is not a material error in the examination of the '498 patent. *See Regeneron Pharms., Inc. v. Kymab Ltd.*, IPR2020-00389, Paper 7 at 14-15 (P.T.A.B. May 26, 2020) (petitioner only offered "a different interpretation" of prior art, which is not material error); *Sony Interactive Ent. LLC v. Terminal Realty, Inc.*, IPR2020-00711, Paper 15 at 11 (P.T.A.B. Oct. 13, 2020) (finding that Petitioner's argument that the asserted references were not evaluated by the Examiner failed to sufficiently identify Examiner error).

Petitioner's attempted reliance on material error for Grounds 1 and 4 is therefore misplaced for the following reasons.

First, the Board's precedent establishes that material error may combat

discretionary denial under § 325(d) based on art or arguments previously presented to the office—it does not provide that material error acts as an affirmative reason to institute review despite other discretionary factors, especially where § 325(d) was not raised in the first place. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, 8-9 (P.T.A.B. Feb. 13, 2020). Here, Patent Owner did not raise a discretionary denial argument under § 325(d) for Grounds 1 and 4 based on the Miwa '377 and Peuchert '293 references. Petitioner's attempt to mischaracterize their absence from prosecution as a material error is irrelevant.

Second, it is always the case that a Petition finds a reference that was not expressly considered during prosecution and/or offers a different interpretation of the prior art. If that were sufficient to preclude discretionary denial under 35 U.S.C. § 325(d), then the statute would be meaningless. Moreover, if an alleged material error in prosecution were sufficient to preclude discretionary denial entirely, e.g., as a gating function—as Petitioner asserts here—it would first invert the *Advanced Bionics* framework (requiring Patent Owner to show no material error) and then elevate material error to a *de facto* gating function for denial, rather than treating material error as **one** equal factor among many to consider for denial. *See Advanced Bionics*, IPR2019-01469, Paper 6. Unsurprisingly, the Office has

repeatedly rejected that sentiment in discretionarily denying Petitions. *Regeneron*, Paper 7 at 14-15; *Sony*, Paper 15 at 11. It should do so here as well.

Third, Petitioner's reliance on material error attempts to sidestep Petitioner's burden in establishing a reasonable likelihood of prevailing to show that the claims challenged in Grounds 1 and 4 are anticipated. The Petition falls well short of establishing that Miwa '377 or Peuchert '293 anticipate at least claim 1 of the '498 patent. DD Br. at 37-39, 42-45, 58-60. That Petitioner would have cited different references and examined the application differently does not amount to a showing that Petitioner has a reasonable likelihood of prevailing on anticipation Grounds 1 and 4.

Respectfully submitted,

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Date: September 5, 2025

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

I certify that the above-captioned **PATENT OWNER'S REPLY BRIEF**
ON DISCRETIONARY DENIAL was served in its entirety on September 5,
2025, upon the following parties via electronic mail:

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