

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS
AMERICA, INC., SAMSUNG SEMICONDUCTOR, INC., and SAMSUNG
AUSTIN SEMICONDUCTOR LLC,
Petitioners,

v.

W&WSENS DEVICES INC.,
Patent Owner.

Case IPR2025-00995
U.S. Patent No. 10,468,543

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

This Reply addresses Samsung's new argument that the Examiner erred during prosecution of the '543 Patent. As set forth below, there was no error and, in any event, Samsung's Petition is not the vehicle to address the alleged error. Thus, Samsung fails to rebut W&Wsens' showing that institution should be denied.

I. THERE WAS NO ERROR DURING PROSECUTION

There was no error during prosecution of the '543 Patent because its claims were already different from the claims of its parent when the parent application was amended to achieve allowance and because the Examiner pointed to limitations found only in the '543 Patent in its Notice of Allowance.

When the '543 Patent application was filed, W&Wsens submitted a preliminary amendment presenting claims that were "like allowed" claims of the '700 Patent application (allowed as of a Notice of Allowance dated 2/06/2019), but included differences. See Ex. 1044 at 626, 632; Ex. 1003 at 312; *compare* Ex. 1042 at 118:23-38 (reciting "at least one of said **regions, and an optional overlying covering region, ...**", "the MSPD includes reverse-bias **contacts**") with Ex. 1001 at 118:39-54. Accordingly, the claims of the '543 Patent application were already distinct from the claims of the '700 Patent application on 3/14/2019, when W&Wsens re-opened prosecution of the '700 Patent application to submit a corrected Application Data Sheet and an IDS. Ex. 1003 at 269-281.

Given this difference in claim scope, it is incorrect for Samsung to conclude that the limitation added to the '700 Patent application to achieve allowance was also necessary for the '543 Patent. In addition, the *same* Examiner handled the examination of both Patents, W&Wsens submitted similar IDSs in both examinations, and the Examiner allowed the applications for different reasons. Ex. 1003 at 422-435, 139-142; Ex. 1044 at 16-49. Thus, there was no material error in the Examiner's allowance of the '543 Patent without importing the limitation from the '700 Patent. *Advanced Bionics*, IPR2019-01469, Paper 6 at 9 ("If reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability.")

The Examiner's Reasons for Allowance of the '543 Patent dispels any notion that the '543 Patent's claims should have been rejected under the same rationale as those of the '700 Patent because those Reasons expressly refer to limitations that are recited only in the '543 Patent. Ex. 1044 at 137. Indeed, the Examiner's Amendment that placed the '543 Patent application in condition for allowance was sent *after* the office action rejecting the '700 Patent application, which further supports the conclusion that the Examiner could not sustain a prior art rejection of the '543 Patent application following its preliminary amendment and examiner's amendment. Ex. 1044 at 135-136 (8/13/2019); Ex. 1003 at 145 (3/26/2019); Ex. 1044 at 626 (3/8/2019). Samsung, therefore, identifies no error in the

Examiner's analysis.

II. THIS CASE IS NOT THE VEHICLE TO ADDRESS ANY ERROR

Samsung's allegation of examiner error is also irrelevant to the petitioned grounds. Whether an Examiner "materially erred" during examination arises in the context of the *Advanced Bionics* framework and § 325(d). *Advanced Bionics*, Paper 6 at 8. W&Wsens raised no § 325(d) argument in this case because Kuboi is far less relevant to the claimed invention than the prior art considered during examination. *See* Paper 10; Paper 13 (POPR) at 10-14; IPR2025-00994, Paper 10 at 16-17 ("Kuboi is less relevant to patentability than any of the references cited during prosecution or in the Petition"). Petitioners' allegation of "material error," considered under step two of the *Advanced Bionics* framework, is irrelevant.

Petitioners' reliance on *Activision Blizzard, Inc.*, is similarly inapt. *Pet. Opp.* at 3-4 (citing IPR2025-00708, Paper 13). In that case, determining whether the Examiner "materially erred" in considering one reference (Kelly918) was necessary to determine whether to deny a petition asserting a very similar reference (Kelly683). IPR2025-00708, Paper 8 at 3-9. Here, Kuboi was not considered during examination and the Petition's grounds do not assert any references considered during examination. *Ex. 1003* at 145-46. Thus, because the alleged error is not related to the grounds raised in the Petition, this is not the correct vehicle to correct it and it has no relevance to the discretionary denial analysis for these grounds.

Patent Owner's Reply on Discretionary Denial
IPR2025-00995 (U.S. Patent No. 10,468,543)

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies, in accordance with 37 C.F.R. § 42.6(e), and pursuant to agreement by the parties that filing with the Board through the Patent Trial and Appeal Case Tracking System (P-TACTS) constitutes electronic service, that service was made on Petitioner as detailed below.

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