

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

**PETITIONERS' SUR-REPLY OPPOSING PATENT OWNER'S REQUEST
FOR DISCRETIONARY DENIAL OF INSTITUTION**

W&W's Reply fails to rebut Petitioners' showing that the Office materially erred in granting the '543 Patent because the issued claims are essentially identical to rejected claims of the parent '821 Application. Opp. 2-4. W&W argues that (1) "there was no error during prosecution" because there were "differences" in the claims, (2) "the *same* Examiner handled the examination of both Patents," and (3) there was an Examiner's amendment to the '543 Patent's claims before issuance. Reply 1-2. None rebut Petitioners' showing of material error.

Regarding the alleged claim "differences," W&W does not identify any specific difference other than vague references to two terms of the '543 Patent: "'at least one of said *regions, and an optional overlying covering region, ...*', [and] 'the MSPD includes reverse-bias *contacts*.'" Reply. 1. But the *rejected* claims of the parent '821 Application recited essentially identical elements: "'at least one of said *layers, or an overlying covering layer*" and "the MSPD includes reverse-bias *contacts*." Ex. 1003, 342 (emphases added). Although "contacts" was later replaced with "electrodes" in the '821 Application, there is no substantive difference between a "region" and a "layer"; between "and an optional ... region" and "or an optional ... region" when both are "optional"; or between "contacts" and "electrodes." When W&W filed the '543 Patent, it also filed a Terminal Disclaimer over the then-pending '821 Application because the claims were not materially distinct. Ex. 1044, 622; *id.*, 138. W&W cannot identify any meaningful difference between the '543

Patent's claims and the rejected '821 Application's claims, which confirms the Office materially erred when it granted the '543 Patent.

W&W's argument that the "**same** Examiner handled the examination of both Patents" (Reply 2) only confirms the error. The Examiner found essentially identical claims unpatentable in the '821 Application and required amendment at the same time that they allowed essentially identical claims to issue in the '543 Patent. Opp. 2-4. That error requires correction. W&W argues that finding error would require "importing the limitation from the '700 Patent" into the '543 Patent's claims, but W&W cannot identify any such limitation. Reply 2. As shown above, the only differences in the claims are trivial variations of identical concepts. *See* Opp. 3-4.

The Examiner's Amendment in the '543 Patent was to "overcome potential 112 scope of enablement issues," Ex. 1044, 124-125, and did not change the claim scope because the amendments were trivial, not substantive. The amendments changed "or" to "and" and corrected grammar—from "at least one of said regions, **or** an overlying covering region that may be present, **has** holes intentionally formed therein" to "at least one of said regions, **and** an optional overlying covering region, **have** holes intentionally formed therein." *Compare* Ex. 1044, 632, *with id.*, 136. But the change from "or" to "and" was trivial because the claimed "overlying covering region" was made "optional" (thereby undermining the effect of "and"). Such trivial amendments to an optional element confirm that the claims were issued in error.

Even more, in its Reasons for Allowance, the Examiner recites elements of the '821 Application's *rejected* claim. *Compare* Ex. 1044, 137, *with* Ex. 1003, 123.

W&W's argument that "material error" can only "arise[] in the context of the *Advanced Bionics* framework and § 325(d)" is wrong. Reply 3. First, the Director has not limited "material error" analysis to only § 325(d). In the Interim Process Memorandum, the Director explained that "the parties are permitted to address all relevant considerations." *Interim Processes for PTAB Workload Management* at 2 (Mar. 26, 2025). That includes whether it would be an efficient use of Board resources to address a "material error" that the Office committed during prosecution. *See, e.g., Samsung Elecs. Co. v. Wilus Institute of Standards and Tech. Inc.*, IPR2025-00935, Paper 12, at 2-3 (Deshpande, C.J., Sept. 26, 2025) (finding a "material" error counsels against discretionary denial without considering § 325(d)); *Activision Blizzard, Inc. v. Milestone Ent., LLC*, IPR2025-00708, Paper 13 at 2-3 (Deshpande, C.J., Aug. 14, 2025) (same).

Second, the Director *has* found material error even when the reference in the petition is not the same reference considered during prosecution. In *Anthony Inc. v. ControlTec, LLC*, the Director found "material error" and denied the discretionary denial request where, like here, the prior art in the petition was not considered at all during prosecution. IPR2025-00559, Paper 12, at 2 (Director July 16, 2025).

The Director should thus decline to discretionarily deny this Petition.

Date: October 7, 2025

Respectfully submitted,

/ Joshua L. Goldberg /

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Petitioners' Sur-
Reply Opposing Patent Owner's Request for Discretionary Denial of
Institution** was served on October 7, 2025, via email directed to counsel of record
for the Patent Owner at the following:

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Dated: October 7, 2025

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