UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

W&WSENS DEVICES INC.,
Patent Owner.

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Case IPR2025-00996
U.S. Patent No. 10,446,700

PATENT OWNER'S REPLY ON DISCRETIONARY DENIAL

This Reply addresses Samsung's new argument that the Examiner erred during prosecution of the '700 Patent. As set forth below, Samsung's alleged error is not relevant to its proposed grounds and, therefore, it has no bearing on the reasons the Director should deny institution. Moreover, there was no error during prosecution of the '700 Patent. Thus, institution should be denied.

I. SAMSUNG'S ALLEGATION OF ERROR IS IRRELEVANT

Samsung's allegation of material error during examination of the '700 Patent is not relevant to the grounds at issue. Whether an Examiner "materially erred" during examination arises in the context of the *Advanced Bionics* framework for evaluating whether to deny a petition under 35 U.S.C. § 325(d). *See Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, No. IPR2019-01469, Paper 6 at 8 (P.T.A.B. Feb. 13, 2020) (precedential). W&Wsens raised no such argument in this case because Kuboi is far less relevant to the claimed invention than the prior art distinguished during examination. *See* Paper 13 at 10-14 (distinguishing Kuboi's organic photodetector from the claimed invention); 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"). Accordingly, allegations of "material error," considered under step two of the *Advanced Bionics* framework, are irrelevant.

The cases Samsung cites in its Opposition, including *Xencor, Inc., v. Merus N.V.,* No. IPR2025-00604, Paper 12 at 3 (P.T.A.B. June 17, 2025), are likewise

inapt. In *Xencor*, the main asserted reference had been considered during examination, so the question of whether the Examiner "materially erred" in consideration of ***that*** reference was crucial to determining whether to deny the petition under § 325(d). That scenario is not present here because Kuboi, the only reference at issue, was not considered during examination. The other cases cited in the Opposition are also irrelevant because they concern whether to institute trial ***even though*** the petition presents the same or substantially the same art or arguments previously presented to the Office. *See* Paper 11 ("Pet. Opp.") at 3. Thus, even if there was an error during examination, it was not related to Kuboi and, therefore, does not impact the discretionary denial analysis.

II. THERE WAS NO ERROR DURING PROSECUTION

There was no material error during examination. Material error requires a finding that "the ***previously presented*** art teaches the limitations of the challenged claims, and that no reasonable examiner could have found otherwise." *Ecto World, LLC v. RAI Strategic Holdings, Inc*., No. IPR2024-01280, Paper 13 at 6 (P.T.A.B. May 19, 2025) (precedential). Samsung does not allege that "previously presented art teaches the limitations of the challenged claims." Instead, it argues that a reference that was ***not before the Examiner*** teaches the limitations of the challenged claims. Pet. Opp. at 2; Pet. at 8, 51. Thus, Samsung fails to allege, let alone show, any error in the Examiner's analysis of the art considered during examination. As

the author of its own petition, Samsung could have asserted one or more grounds that presented Kuboi in combination with the references cited against the '700 Patent during prosecution, but it chose not to. *SAS Inst., Inc. v. Iancu*, 584 U.S. 357, 363 (2018) ("[I]n an *inter partes* review the petitioner is master of its complaint and normally entitled to judgment on . . . the claims it raises.").

Samsung's allegation of "material error" also improperly assumes that the Examiner would have found motivation to combine Kuboi with other art of record if Kuboi was before him. *See Advanced Bionics,* 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"); Pet. Opp. at 2 (arguing that the Examiner erred by failing to determine that "said reverse-bias electrodes being free of a pattern of openings that matches said holes" could have been "met by simply not having holes in a transparent electrode layer, as in Kuboi"). If Samsung had raised that ground, it would have had the burden to demonstrate that Kuboi discloses the "reverse-bias electrode" limitation ***and*** that it would have been obvious to combine Kuboi with those references. *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) ("[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was . . . known in the prior art."). Samsung's hypothetical counterfactual does not establish material error during prosecution.

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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Documents served	PATENT OWNER'S REPLY ON DISCRETIONARY DENIAL
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