

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONOS, INC.,
Petitioner,

v.

IMPLICIT, LLC,
Patent Owner.

IPR2018-00766 (Patent 7,391,791 B2)
IPR2018-00767 (Patent 8,942,252 B2)¹

Before MICHELLE N. WORMMEESTER, SHEILA F. McSHANE, and
NABEEL U. KHAN, *Administrative Patent Judges*.

McSHANE, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ We exercise our discretion to issue one Order to be filed in each proceeding. The parties are not authorized to use this style heading for any subsequent papers.

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On November 9, 2022, the Federal Circuit issued an Order in the appeals concerning IPR2018-00766 and IPR2018-00767, taking note of Implicit, LLC's ("Patent Owner") request for a remand in view of intervening correction of inventorship certificates that Patent Owner alleged would serve to moot the appeals. Paper 59.² The Order directed that

These appeals are remanded for the sole purpose of having the PTAB issue an order addressing what, if any, impact the certificates of correction would have on the final written decisions in these cases. This court retains jurisdiction over the appeals.

Id. at 2.

The parties requested a conference call to discuss the procedure on remand. On January 25, 2023, a call was convened with counsel for Patent Owner and Sonos, Inc. ("Petitioner"). Patent Owner had arranged for a court reporter and agreed to file a copy of the transcript on the docket. We refer to the filed transcript for the details of the discussions during the call. Generally, both parties requested briefing, with opening briefs of 15 pages, and agreed that briefing was to be directed to the potential retroactive effect of the certificates of correction on the Final Written Decisions. Petitioner also asserted that the briefing should be permitted to identify the issues which had not been addressed in the Final Written Decisions if it were to be determined that there is retroactive effect of the certificates of correction on our Final Written Decisions. Neither party sought to address the merits of the cases as presented pre-appeal or to file additional evidence. Petitioner requested simultaneous opening and responsive briefing, and Patent Owner

² All citations are to IPR2018-00766 because the filings in IPR2018-00767 have the same substantive content.

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requested that it be permitted to file an opening brief, with Petitioner filing a responsive brief, and with Patent Owner filing a reply.

Under these circumstances, briefing would be helpful to the Board. Each party is hereby authorized to file, as set forth below, an opening brief on the same day not to exceed 15 pages addressing what, if any, impact the certificate of correction has on our Final Written Decision in each of these cases and a response not to exceed 7 pages that may respond only to arguments made in the corresponding opening brief. No additional evidence is to be filed and the arguments shall not address the substantive merits relating to antedating or unpatentability as set forth in the pre-appeal record.

It is, therefore,

ORDERED that the parties may each file an opening brief not to exceed 15 pages addressing what, if any, impact the certificate of correction has on our Final Written Decision in each case by February 10, 2023;

FURTHER ORDERED that the parties may each file a response not to exceed 7 pages that respond only to arguments made in the corresponding opening brief by March 1, 2023; and

FURTHER ORDERED that no additional evidence shall be filed and the arguments shall not substantively address the merits relating to antedating or unpatentability.

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