

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONOS, INC.,
Petitioner,

v.

IMPLICIT, LLC,
Patent Owner.

Case No. IPR2018-00767
Patent No. 8,942,252

**PATENT OWNER IMPLICIT, LLC'S OPENING BRIEF
PURSUANT TO REMAND FROM THE UNITED STATES
COURT OF APPEALS FOR THE FEDERAL CIRCUIT**

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I. Introduction

Implicit, LLC (“Implicit”) hereby submits this opening brief pursuant the Board’s instruction (Paper 60 at 2-3) and following the limited remand order of the United States Court of Appeals for the Federal Circuit (*Implicit, LLC v. Sonos, Inc.*, Nos. 20-1173, -1174, D.I. 85 (Fed. Cir. Nov. 9, 2022)).

In view of the detailed Board findings in the Final Written Decisions concerning Mr. Guy C. Carpenter’s contributions to the claimed inventions, Implicit submitted all necessary fees and affidavits under § 1.324(b) to correct inventorship of U.S. Patent Nos. 7,391,791 and 8,942,252 (collectively “the patents-at-issue”). *See infra* § II (4)-(6). While the consolidated appeals of IPR2018-00766 and IPR2018-00767 were pending before the Federal Circuit,¹ the Director granted both of Implicit’s petitions to correct the inventorship. *See infra* § II (1), (6)-(8). Implicit relied on *SIPCO, LLC v. Emerson Elec. Co.* to seek and obtain a remand to the Board for further consideration of its unpatentability

¹ The Federal Circuit appeal (No. 2020-1173 (lead)) of the Board proceedings in IPR2018-00766 for U.S. Patent No. 7,391,791 (“the ’791 patent”), was consolidated with the appeal (No. 2020-1174) of the Board proceedings in IPR2018-00767 for U.S. Patent No. 8,942,252 (“the ’252 patent”). *See Implicit, LLC v. Sonos, Inc.*, 2020-1173, -1174, D.I. 2 (Fed. Cir. Dec. 2, 2019).

determinations given the issued certificates. *See* No. 2018-1364, D.I. 29 at 2-4 (Fed. Cir. Jun. 27, 2018) (unpublished) (where corrections were granted during appeal, the court ordered the case “remanded for the Board to issue an order addressing what, if any, impact the certificate of correction has on its final written decision in this case.”). Significantly, the *SIPCO* case also explained that corrections of inventorship under § 256 are accorded “retroactive” effect, *i.e.*, as though existing in corrected form from the date of patent issuance. *Emerson Elec. v. SIPCO*, IPR2016-00984, Paper 52 at 17-21 (P.T.A.B. Jan. 24, 2020), *aff’d*, No. 2018-1364, D.I. 78 (Fed. Cir. Jan. 21, 2021); *see infra* § III.A.2.

Implicit respectfully requests on remand that the Board reconsider the Final Written Decision of IPR2018-00767 (Paper 40) and reverse its unpatentability determinations in light of the correct inventive entity applied retroactively. *See infra* §§ III.A., IV. The Board previously relied on U.S. Patent No. 7,269,338 to Janevski (“Janevski,” Ex.1007), which predates the provisional application leading to the ’791 patent by just six days, to find all challenged claims unpatentable.² Paper 40 at 9-10.

² The Board previously held that Petitioner Sonos, Inc. (“Sonos”) demonstrated that the ’791 patent’s claims 1–3, 6–9, 12, 16, 19, and 23–25 are anticipated by Janevski; that claims 1–3, 6–9, and 12 would have been obvious in view of

II. Background

The following facts serve as background:

- 1) The '791 patent is entitled “Method and System for Synchronization of Content Rendering” and issued on June 24, 2008. *See* IPR2018-00766, Ex. 1001. The '252 patent is a continuation of the '791 patent and issued on January 27, 2015. *See* IPR2018-00767, Ex. 1001. The '791 and '252 patents both claim priority to U.S. Provisional Application No. 60/341,574, filed on December 17, 2001. IPR2018-00766, Ex. 1001 at [60]; IPR2018-00767, Ex. 1001 at [60].
- 2) On March 9, 2018, Sonos filed petitions for *inter partes* review of the '791 and '252 patents, alleging unpatentability under 35 U.S.C. §§ 102-103 and relying in each of its grounds on Janevski. *See supra* n.2. Janevski has an effective filing date of December 11, 2001. Paper 40 at 9-10; Ex. 1007, at [22].
- 3) Implicit attempted to antedate Janevski in the IPR proceedings. *See* IPR2018-0767, Paper 9 (POR) at 14-31 (and cited exhibits). Implicit detailed the

Janevski alone; and that claims 1–3, 6–9, and 12 would have been obvious over the combination of Janevski and Schneidewend. *See* IPR2018-00766, Paper 46 at 2, 50. The Board also held that the '252 patent's claims 1–3, 8, 11, and 17 would have been obvious over the combination of Janevski and other references. Paper 40 at 3, 53-54.

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