

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*.

JUDGMENT

Final Written Decision on Remand
35 U.S.C. §§ 144, 318; 37 C.F.R. § 42.5(a)

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.

I. INTRODUCTION

At trial, Implicit, LLC (“Patent Owner”) attempted to antedate the principal prior art reference asserted by Sonos Inc. (“Petitioner”), arguing that the originally named inventors had conceived of the invention and communicated it to their engineering staff, who then reduced it to practice prior to the effective date of the prior art reference. We determined, however, that Patent Owner’s evidence was insufficient to establish prior conception of the invention and the communication of the invention such that any actual reduction to practice could inure to the inventors’ benefit. Patent Owner appealed our Final Written Decisions, and while the appeals were pending, Patent Owner sought changed inventorship of the patents-at-issue and the USPTO issued corrections to inventorship. The United States Court of Appeals for the Federal Circuit remanded the cases to us for an order addressing what impact, if any, the certificates of correction would have on the Final Written Decisions in the cases. Herein, we determine that, even in light of the general retroactive effect of 35 U.S.C. § 256, judicial estoppel and waiver apply under the specific circumstances of these cases. Accordingly, Patent Owner’s certificates of correction of inventorship have no impact on the Final Written Decisions.

II. BACKGROUND

A. Initial Proceedings Before the Board

Petitioner filed Petitions requesting *inter partes* review of claims 1–3, 6–9, 12, 16, 19, and 23–25 of U.S. Patent No. 7,391,791 B2 (Ex. 1001, “the ’791 patent”) in IPR2018-00766 (“IPR766”) and for review of claims 1–3, 8, 11, and 17 of U.S. Patent No. 8,942,252 B2 (Ex. 1001, “the ’252 Patent”) in IPR2018-00767 (“IPR767”). IPR766, Paper 1; IPR767, Paper 1. Patent Owner filed Preliminary Responses in both cases. IPR766, Paper 6; IPR767,

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Paper 6. On September 19, 2018, in IPR766, we instituted *inter partes* review on the grounds presented in the Petition as to whether claims 1–3, 6–9, 12, 16, 19, and 23–25 of the ’791 patent are anticipated by Janevski² or would have been obvious over Janevski alone and in combination with other prior art. IPR766, Paper 10. On September 19, 2018, in IPR767, we also instituted *inter partes* review on the grounds presented in the Petition as to whether claims 1–3, 8, 11, and 17 of the ’252 patent would have been obvious in view of Janevski alone and in combination with other prior art. IPR767, Paper 8.

Trials were conducted in both IPR766 and IPR767. On September 16, 2019, we entered a Final Written Decision (IPR766, Paper 46, “Final Dec.” or “Final Decision”)³ in IPR766, determining that Petitioner had demonstrated by a preponderance of the evidence that claims 1–3, 6–9, 12, 16, 19, and 23–25 of the ’791 patent are anticipated by Janevski or would have been obvious over Janevski, alone or in combination with other prior art. On September 16, 2019, we also entered a Final Written Decision (IPR767, Paper 40) in IPR767, determining that Petitioner had demonstrated by a preponderance of the evidence that claims 1–3, 8, 11, and 17 of the ’252 patent would have been obvious in view of Janevski alone or in combination with other prior art.

An issue addressed in the Final Written Decisions was Patent Owner’s assertion that Janevski did not constitute prior art to the challenged claims under § 102(e) because the subject matter of the claims was conceived and

² U.S. Patent No. 7,269,338 B2 (issued September 11, 2007) (Ex. 1007).

³ Because of the substantial similarities in issues raised and the contents of the filings in IPR766 and IPR767, hereafter we refer to the filings of IPR766 as representative, unless otherwise noted.

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actually reduced to practice prior to Janevski's filing date of December 11, 2001. *See* Final Dec. 11. We determined that the evidence presented by Patent Owner was insufficient to carry its burden of production to establish conception of the invention and the communication of the invention such that any actual reduction to practice could inure to the inventors' benefit. *See id.* at 17–22.

B. Proceedings Before the Federal Circuit

On November 8, 2019, Patent Owner filed Notices of Appeal to the Federal Circuit for review of the Final Decisions. *See* Paper 47. On November 30, 2021, the Federal Circuit remanded the cases for the limited purpose of allowing Patent Owner the opportunity to request Director review of the Final Written Decisions. Ex. 3003. On December 17, 2021, Patent Owner petitioned for certificates of correction to add an individual, Guy Carpenter, as an inventor to the patents-at-issue. *See* Paper 62, 5 (“PO Remand Br.”). On December 30, 2021, Patent Owner filed requests for Director review of the Final Written Decisions (Ex. 3100), which were denied on February 7, 2022 (*see* Paper 53). On March 7, 2022, Patent Owner filed Amended Notices of Appeal. *See* Paper 54.

On June 9, 2022, at the Federal Circuit, Patent Owner filed a motion for remand to await decision on the petitions and then to require the Board to consider the effect of changed inventorship. *See* PO Remand Br. 6. After the inventorship correction was granted by the USPTO on August 18, 2022, Patent Owner notified the Federal Circuit and reiterated its request for remand to the Board. *See id.* at 6; Ex. 2097 (Certificate of Correction).

On November 9, 2022, the Federal Circuit issued an Order, taking note of the intervening correction of inventorship certificates that Patent Owner alleged would serve to moot the appeals. Paper 59. The Federal

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Circuit stated that “[a]llowing the PTAB to consider the impact of these intervening circumstances on the decisions on appeal in the first instance may conserve party and judicial resources.” *Id.* at 2. The Order directed that

[t]hese 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.

C. Proceedings on Remand

The parties requested a conference call to discuss the procedure on remand. On January 25, 2023, a call was convened with counsel for Petitioner and Patent Owner. *See Ex. 2096.* During the call, both parties requested briefing, with opening briefs of 15 pages, and agreed that briefings were to be directed to the potential retroactive effect of the certificates of correction on the Final Written Decisions. Paper 60, 2. Petitioner asserted that the briefing should be permitted to identify the issues which had not been addressed in the Final Written Decisions, if it was determined that there is a retroactive effect of the certificates of correction on our Final Written Decisions. *Id.*

We permitted additional briefing to address the remand, with Petitioner filing an opening brief (Paper 64, “Pet. Remand Br.”), and Patent Owner filing an opening brief (Paper 62, “PO Remand Br.”). Petitioner filed a responsive brief (Paper 66, “Pet. Remand Resp. Br.”), and Patent Owner filed a responsive brief (Paper 65, “PO Remand Resp. Br.”).

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