

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SONOS, INC.,  
Petitioner,

v.

IMPLICIT, LLC,  
Patent Owner.

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

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**PATENT OWNER IMPLICIT, LLC'S REQUEST FOR REHEARING BY  
THE DIRECTOR PURSUANT TO *UNITED STATES V. ARTHREX***

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## I. Introduction

In IPR2018-00767, Patent Owner Implicit, LLC (“Implicit”) requests Director review of the Board’s September 16, 2019, Final Written Decision (Paper 40) (“Decision”) finding unpatentable the challenged claims of U.S. Patent No. 8,942,252 (Ex. 1001, “the ’252 patent”). The Board held as the linchpin of the Decision that U.S. Patent No. 7,269,338 to Janevski (“Janevski”) (Ex. 1007) was prior art, by just six days, to the provisional application resulting in the ’252 patent. Decision at 9-23.

Specifically, the Board determined that the work of a company engineer—Mr. Carpenter—could not inure to the benefit of the two named inventors—Messrs. Balassanian and Bradley—in order to antedate Janevski. *See id.* Because of its conclusion that the source code development efforts of Mr. Carpenter were not legally attributable to the inventors named on the ’252 patent, the Board based its obviousness analysis primarily on Janevski. *See id.* at 5-6, 23-50.<sup>1</sup>

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<sup>1</sup> The Board held that Petitioner demonstrated that the ’252 patent’s claims 1–3, 8, 11 and 17 would have been obvious over the combination of Janevski and other references such as Azevado (Ex. 1010), Mills (Ex. 1011), Berthaud (Ex. 1012), and/or Eidson (Ex. 1013). Decision at 3, 53-54.

Implicit appealed,<sup>2</sup> and successfully sought remand pursuant to the Federal Circuit's decision in *Arthrex*. Subsequent to the Supreme Court's remedy articulated in *United States v. Arthrex Inc.*, 141 S. Ct. 1970 (2021), the Federal Circuit ordered that Implicit file its requests for Director rehearing within 30 days. *Implicit, LLC v. Sonos, Inc.*, 2020-1173, -1174, D.I. 70 at 2 (Fed. Cir. Nov. 30, 2021).

This request seeks Director rehearing of the Decision now that Implicit seeks to correct inventorship of the '252 patent under 37 CFR § 1.324. On December 17, 2021, Implicit separately sought to correct the '252 patent by adding Mr. Carpenter as a co-inventor, commensurate with the conclusions of Board and its findings. *See* Decision at 9-23. Implicit's Petition for Correction of Inventorship of the '252 patent, with its accompanying statements and fees, were filed with the agreement

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<sup>2</sup> 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. *Implicit, LLC v. Sonos, Inc.*, 2020-1173, -1174, D.I. 2 (Fed. Cir. Dec. 2, 2019). Petitions to the Director are being filed in both IPRs simultaneously.

of the currently named inventors, Mr. Balassanian and Mr. Bradley, as well as the assignee of record, Implicit.

Implicit has thus pursued its statutory rights under 35 U.S.C. § 256 and met the regulatory requirements of 37 CFR § 1.324(a)-(b) to correct the '252 patent's inventorship. With such a change to the inventorship, Implicit would successfully antedate the Janevski reference. Significantly, corrections of named inventors under § 256 have been deemed by the Federal Circuit, district courts, and this agency to apply retroactively. *See infra* § III.B (collecting cases).

Inasmuch as IPR2018-00767 is awaiting final agency review, Implicit respectfully requests that the Director hold this rehearing request until the correction of the '252 patent inventorship is finalized, and then remand proceedings to the Board for further consideration of patentability.

## **II. Background**

### **A. The '252 Patent**

The '252 patent is entitled "Method and System Synchronization of Content Rendering" and issued on January 27, 2015. Ex. 1001. The '252 patent claims priority to U.S. Provisional Application No. 60/341,574, filed on December 17, 2001. *Id.* at [60].<sup>3</sup> The problem of synchronizing the rendering of content is an old

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<sup>3</sup> The '252 patent is a continuation of the '791 patent (at issue in IPR2018- 00766).

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