Nos. 2020-1173, -1174

IN THE
UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

IMPLICIT, LLC,

Appellant

v.

SONOS, INC.,

Appellee

JOHN A. SQUIRES, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE,

Intervenor

Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board, IPR2018-00766 and IPR2018-00767

IMPLICIT, LLC'S PETITION FOR REHEARING EN BANC

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UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

CERTIFICATE OF INTEREST

Case Numbers: 2020-1173, -1174

Short Case Caption: Implicit, LLC v. Sonos, Inc.

Filing Party/Entity: Implicit, LLC

Instructions:

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Date: April 23, 2026 Signature: /s/ J. Derek McCorquindale

Name: J. Derek McCorquindale

1. Represented Entities. Fed. Cir. R. 47.4(a)(1).	**2. Real Party in Interest.** Fed. Cir. R. 47.4(a)(2).	**3. Parent Corporations and Stockholders.** Fed. Cir. R. 47.4(a)(3).
Provide the full names of all entities represented by undersigned counsel in this case.	Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities. ☒ None/Not Applicable	Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities. ☒ None/Not Applicable
Implicit, LLC		

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4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this **court** for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

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STATEMENT OF COUNSEL UNDER FEDERAL CIRCUIT RULE 40(c)

Based on my professional judgment, I believe the panel decision is contrary to at least the following statute and precedents of this court: *Egenera, Inc. v. Cisco Sys., Inc.*, 972 F.3d 1367 (Fed. Cir. 2020); *Stark v. Advanced Magnetics, Inc.*, 119 F.3d 1551 (Fed. Cir. 1997); *Stark v. Advanced Magnetics, Inc.*, 29 F.3d 1570 (Fed. Cir. 1994); 35 U.S.C. § 256 (Addendum B).

Date: April 23, 2026

/s/ J/ Derek McCorquindale
J. Derek McCorquindale

INTRODUCTION

A panel of this Court erred in holding that nonstatutory, discretionary "forfeiture principles"—applied here by APJs—could defeat the application of 35 U.S.C. § 256(b) inventorship corrections. Op. 6-7. This issue of first impression arises in the PTAB, but the panel strayed from decades of Article III jurisprudence applying this unique "savings provision" enacted to benefit inventors. *Egenera*, 972 F.3d at 1376-77. The precedential opinion concluded: "We hold that forfeiture can apply to Implicit's antedating argument despite the 35 U.S.C. § 256 correction of inventorship." Op. 6 (Addendum A). But forfeiture is not possible here as a matter of law.

This Court has never permitted forfeiture to thwart application of a § 256 correction to save *issued* patents—neither after final jury verdicts, nor while on appeal, nor even when inventorship is changed and then changed back again. *See infra* §§II.A, III.B (collecting cases). While the matter is still pending, such inventorship corrections are always honored under the plain language of § 256(b): "The error of omitting inventors … *shall not invalidate* the patent in which such error occurred if it can be corrected…." *Accord Egenera*, 972 F.3d at 1376 ("Our precedent recognizes that a patent *cannot be invalidated* if inventorship can be corrected instead.").

This Court has consistently interpreted § 256 as having no intent requirement and no timing limitation. *Stark*, 29 F.3d at 1576-77. This is, in part, because the inventorship analysis is complex and can be later informed by the factfinders' view of the evidence, such that waiting for their determination is not untimely. *Egenera*, 972 F.3d at 1379; *see infra* §§II.A, III.B.

In view of detailed PTAB findings regarding the development of the claimed inventions, Implicit sought inventorship corrections to U.S. Patent Nos. 7,391,791 and 8,942,252 *after* the Final Written Decisions ("FWDs") but *before* the Director Review in these *inter partes* review proceedings ("IPRs"). *See infra* pp. 6-7. Notwithstanding, the panel decided that "Implicit had the opportunity to seek correction of inventorship and assert its change of inventorship theory earlier," and so deemed it "appropriate to apply forfeiture principles in a case when a § 256 correction has issued." Op. 6-7. This contradicts precedent. *See supra* p. viii.

The panel's assertion that "diligence in seeking correction of inventorship is 'determined on the facts of that case'" stemmed from a facial misreading of *Stark*. Op. 6-7 (quoting *Stark*, 29 F.3d at 1575). *Stark* came to the opposite conclusion, distinguishing the diligence required in other contexts from the prerogative of § 256 to correct *issued* patents at any time. 29 F.3d at 1574-77. By design, § 256 simply "does not limit the time during which inventorship can be corrected." *Id.* at 1573. Without rehearing en banc, the panel opinion will undercut Congress's intent

to ensure that the retroactive application of § 256 saves patents from invalidation whenever inventorship can be corrected. *See infra* §§I-II.

The panel opinion further creates divergent litigation tracks wherein consideration of "forfeiture principles" is allowed for APJs, but not district court judges who adhere to § 256 without regard to timing. *See infra* §III.C. There is no legal basis for such a divide, rejected long ago. *Stark*, 119 F.3d at 1553 ("[S]ection 256 expressly applies the standards of the entire section … to both *administrative and judicial proceedings*."). It abuses discretion for APJs "to decide when and under what terms to allow correction," by installing diligence requirements in IPRs that are not found in § 256 itself. *Id*.

BRIEF SUMMARY OF PROCEEDINGS

Sonos, Inc. ("Sonos"), petitioned for IPR of Implicit's '791 and '252 patents. Op. 3; Appx301-381; Appx4001-4078. Sonos relied in all its unpatentability grounds on a would-be prior-art reference called *Janevski*, with a December 11, 2001, critical date. Op. 3. Implicit countered that the challenged claims were conceived and reduced to practice by December 9, 2001. *Id*.; Appx2575-2591[¶¶31-75]; Appx483-501; Appx4173-4190; Appx2564-2593[¶¶1-80]; Appx40-42; Appx112-116; Appx123-124; Appx2920-2922; Appx3313-3360.

An issue before the PTAB was Implicit's ability to swear behind the two-day priority of Sonos's *Janevski* reference. Op. 3-4; Appx1789-1808; Appx5336-5355;

Appx335; Appx4031-4033. Implicit attempted to antedate *Janevski* by detailing the inventive activities of then-named coinventors Messrs. Balassanian (company founder) and Bradley (development manager), including how they instructed the company's Engineering Master, Mr. Carpenter, to implement the inventions of the challenged claims. Op. 3-4; Appx2575[¶¶32-33]; Appx1974[59:5-18]; Appx40-42; Appx112-116.

Mr. Carpenter did so in a December 9, 2001, document entitled "synchronization.doc," which serves as the disclosure for Implicit's provisional application and pre-dates the *Janevski* reference. Appx2920-2922; Appx46-47; Appx123-124; Appx3313; Appx3360; Appx6974-6976; Appx6977; Appx7367; Appx7414. In the metadata, the author indicated is "guyc," signifying Guy Carpenter, who wrote the source code. Appx3360; Appx2923. That the contributions of Mr. Carpenter should inure to the benefit of Messrs. Balassanian and Bradley was consistent with their mutual understanding since 2008 when the patents issued. Appx40-42; Appx112-116.

Despite submitting dozens of company documents and extensive testimony—some 75 exhibits—the FWDs concluded that the evidence did not prove Implicit's premise, i.e., that the named inventors conceived of the inventions and communicated them to Mr. Carpenter. Appx6-7; Appx46-47; Appx125. Specifically, the PTAB found that "synchronization.doc" was indeed

> drafted at least as early as December 9, 2001. The evidence shows, however, that the December 9 version of this document, which appears to be the version that was the basis for the provisional application, *was authored by non-inventor Mr. Carpenter*.

Appx123-124 (citing Appx2923; Appx3315). And there was no indication "that anyone else was involved in development of the source code besides Mr. Carpenter." Appx46-47; Appx123-125; Appx156; Appx3312-3315; Appx2923. The PTAB therefore held that the source-code creation by Mr. Carpenter did not inure to the then-named inventors. Appx156; Appx123-124; Appx46. As such, *Janevski* constituted prior art for all PTAB conclusions of unpatentability under §§102/103. Appx48; Appx74; Appx156; Appx126.

Within weeks of the PTAB's decision, this Court in another matter issued the *Arthrex* decision on October 31, 2019. *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320 (Fed. Cir. 2019), *remanded sub nom. United States v. Arthrex, Inc.*, 594 U.S. 1 (2021). It concluded that the PTAB—including when it issued FWDs in this case—was unconstitutional and "remanded to a new panel of APJs," *Arthrex*, 941 F.3d at 1325. Already on appeal, Implicit was granted vacatur of its cases due to *Arthrex*-based violations and remand followed. Op. 4. While the USPTO sought Supreme Court review, *e.g.*, Petition for Writ of Certiorari, *Hirshfeld v. Implicit, LLC*, 20-1631 (S. Ct. May 21, 2021), the adverse PTAB opinions against Implicit stood vacated for nearly two years. Op. 4; D.I. 70.

Throughout this period, Implicit considered the PTAB's detailed findings on inurement and recognized that the case might be reinstated depending on the appellate resolution of *Arthrex*. Indeed, the PTAB's prior FWDs were reinstated when the Supreme Court decided that a Director Review option could cure unconstitutionality. Accordingly, on December 17, 2021, Implicit filed petitions for inventorship correction, specifying that the "addition of Guy A. Carpenter as an inventor is requested." Op. 4; D.I. 78, Exs. E-F. Implicit's corrections were thus already on file before Director Review occurred to conclude the IPRs below. Notwithstanding Implicit's explanation of § 256, the Acting Director rubberstamped the PTAB's prior FWDs without opinion. Op. 4.

Implicit appealed. When inventorship corrections were granted by the new Director in August 2022, this Court remanded to the PTAB for an order "addressing what, if any, impact the certificates of correction would have" on the merits of the FWDs. Op. 4-5 (quoting D.I. 85, 2). But the PTAB held on September 19, 2023, that "even in light of the general retroactive effect of 35 U.S.C. § 256, … waiver [sic] appl[ies] under the specific circumstances of these cases." Appx2; Appx79. Implicit timely appealed. Appx1279; Appx4963.

BRIEF SUMMARY OF PANEL DECISION

The panel decision affirmed the PTAB on forfeiture grounds. Op. 2. It did not disturb the PTAB's threshold recognition that § 256 "is generally retroactive…."

Op. 5; *id*. at 6 (citing Appellant's Br. 45-47). The panel held, however, that "notwithstanding the retroactive effect of 35 U.S.C. § 256 … the Board did not abuse its discretion in applying forfeiture to the circumstances of this case." Op. 6.

The panel first analyzed whether forfeiture could even apply as a matter of law "where a section 256 correction has been issued." Op. 6. The panel determined that forfeiture can be invoked based on a faulty reading of *Stark*: "[W]e have indicated that whether there is a requirement of diligence in seeking correction of inventorship is 'determined on the facts of that case.'" Op. 6-7 (quoting *Stark*, 29 F.3d at 1575). The panel turned next to whether the PTAB abused its discretion by applying forfeiture here, even when § 256 corrections were timely raised before the PTAB decisions were finalized in Director Review. Op. 7-10. The panel held that Implicit should have presented any alternate inventorship still "earlier" in the trial proceedings, calling the post-FWD timing "sandbagging." Op. 9. To so find, it artificially cabined *Egenera*'s teaching allowing for a factfinder's assessment and limited it to claim-scope determinations only. Op. 8-9 ("the key circumstance allowing a mid-litigation effort to seek correction" was "a judicial adoption of a particular claim construction" (citing *Egenera*, 972 F.3d at 1377-78)).

ARGUMENT

I. Corrections Under § 256 Apply Retroactively

The panel—and Intervenor—agreed that § 256 has retroactive effect in general, i.e., as though in corrected form from original patent issuance, and effective to avoid invalidation under § 102(a), (b), (e), or § 103(a), not just misjoinder under § 102(f). Op. 6; Intervenor Br. 19-20 n.1 (D.I. 113). The panel ignores the logical extent of this retroactivity, however, contending that the PTAB's forfeiture rule can supersede the operation of the statute. Op. 6-7 ("forfeiture can apply notwithstanding the retroactive effect of 35 U.S.C. § 256").

Related correction provisions in the Patent Act, such as §§ 254-255, demonstrate § 256's retroactive application relative to the rest: While § 254 contains a limitation on other types of corrections to "causes thereafter arising," that clause is absent from § 256, which also remains silent as to any specific invalidation subsection. *See Roche Palo Alto LLC v. Ranbaxy Lab'ys Ltd.*, 551 F. Supp. 2d 349, 357-59 (D.N.J. 2008); *Google LLC v. IPA Techs Inc.*, 34 F.4th 1081, 1088 (Fed. Cir. 2022) (pre-AIA § 102(a) prior art); *Riverwood Int'l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1355-56 (Fed. Cir. 2003) (pre-AIA § 102(e) prior art); *Emerson Elec. Co. v. SIPCO, LLC*, IPR2016-00984, Paper 52 at 17-21 (PTAB Jan. 24, 2020), *aff'd*, 834 F. App'x 595 (Fed. Cir. 2021).

Because the now-corrected inventorships of the '791 and '252 patents have retroactive effect against Sonos's §§102/103 challenges, adding Mr. Carpenter as a coinventor should have altered the Board's merits analysis, as this Court previously ordered. *See supra* pp. 5-7; Op. 4-5 (quoting D.I. 85 at 2). Anything less fails to actually give the retroactive effect to corrections that Congress envisioned would benefit omitted inventors. The panel paid lip-service to retroactivity in principle, but through "forfeiture principles" denied it in fact, Op. 6-7, vitiating the plain language and proper application of § 256.

II. As a Matter of Law, Forfeiture Cannot Override Congress's Broad Savings Provision Applied Retroactively

A. The Plain Language of § 256 Is Broadly Drafted and Construed

This Court has recognized that § 256 was enacted as "a savings provision, functioning to prevent invalidation when correction is available." *Egenera*, 972 F.3d at 1376-77; *Stark*, 29 F.3d at 1573. In strongest terms, Congress mandated that errors in inventorship "*shall not* invalidate the patent" when, as here, they are correctable. 35 U.S.C. § 256(b). Discretionary doctrines like forfeiture should not be used to nullify statutes like § 256 with "mandatory 'shall'" verbiage. *See generally Miller v. French*, 530 U.S. 327, 337 (2000) ("The mandatory 'shall' … normally creates an obligation impervious to judicial discretion[.]") (citation omitted).

There is no timing limitation in the statutory text permitting APJ discretion to override the "shall not invalidate" imperative on forfeiture grounds. The panel's view that "[t]he Board merely decided that Implicit could not make new antedating arguments based on this correction of inventorship" renders § 256 meaningless. Op. 6. If inventorship can be corrected under § 256, then the "new antedating arguments" presented by Implicit to avoid invalidation *must* be considered on the merits. *Contra id*. The statute ordains this result as a legal matter, and this Court has forcefully echoed: "Our precedent recognizes that a patent *cannot be invalidated* if inventorship can be corrected instead." *Egenera*, 972 F.3d at 1376.

For decades, the Federal Circuit has taught that § 256 "does not limit the time during which inventorship can be corrected." *Stark*, 29 F.3d at 1573 (citation omitted). Article III courts have thus approved inventorship corrections far later in the proceedings without suggesting forfeiture. *Airbus*, for example, saw this Court reopen final judgment after a jury verdict and remand to reassess invalidity in light of inventorship corrections granted during appeal; on remand, the district court noted the paradoxical nature of § 256, yet reasoned that its retroactive effect overcame invalidity irrespective of the contrary jury determination. *Airbus DS Commc'ns, Inc. v. microDATA GIS, Inc.*, 2015-1037, -1192, D.I. 28 (Fed. Cir. Mar. 18, 2015) (nonprecedential), *and Cassidian Commc'ns, Inc. v. Microdata GIS, Inc.*, No. 2:12-CV-162-JRG, 2015 WL 1848533, at *4 (E.D. Tex. Apr. 20, 2015)

(Gilstrap, J.) ("At a cursory level, Airbus's Motion might appear to present a difficult and seemingly circular proposition.… Considering § 256, this outcome should not be surprising. It is clear to this Court—as it has been to the other Courts that have addressed § 256—that Congress intended § 256 to broadly allow the correction of errors in inventorship…."). And in *LendingTree*, the case was already on appeal from a jury verdict of invalidity when the Court remanded for fear of "violat[ing] the letter and spirit of § 256," because patentee had suggested the possibility of inventorship correction below. *LendingTree, LLC v. Zillow, Inc.*, 656 F. App'x 991, 999 (Fed. Cir. 2016); *id.* at 992 ("we remand to permit LendingTree, if it chooses to do so, to file a motion under Fed. R. Civ. P. 60(b) to vacate the judgment of invalidity for improper inventorship").

Implicit likewise raised inventorship correction *during* the proceedings below and its certificates have already been *granted*, putting this case in a more favorable position than either *LendingTree* or *Airbus*. Yet the panel ignored this caselaw entirely. *Compare* Op. 1-10 *with* Implicit Br. 38-41 *and* Implicit Reply Br. 18-20. At bottom, no case has been identified where this Court has allowed discretionary "forfeiture principles" to defeat the application of § 256(b) for *issued* patents, regardless of timing.

B. *Stark* Stands for the Opposite Proposition

According to the panel, *Stark* supports requiring "diligence in seeking correction of inventorship," which "is 'determined on the facts of that case.'" Op. 6-7 (quoting *Stark*, 29 F.3d at 1575). That language in *Stark* was explaining the difference between regulatory situations where, unsurprisingly, "varying degrees of diligence may be required, depending on the circumstances," but *Stark* then distinguished these from § 256 specifically, 29 F.3d at 1573-77, because "diligence is not a requirement to correct inventorship," 119 F.3d at 1554.

The panel's error was to equate these *post-grant* IPR proceedings, challenging *issued* patents, with the "diligent action [that] is required during a *pending interference proceeding*," when no patent yet exists. Op. 7 (quoting *Stark*, 29 F.3d at 1575). That difference is dispositive here. *Stark* made clear that for inventorship corrections to *issued* patents, a diligence requirement is never applied. *Id.* at 1574-75 ("Neither 35 U.S.C. § 256 nor 37 C.F.R. § 1.324 requires that an omitted inventor of an *issued* patent must diligently bring a lawsuit to correct inventorship or be forever barred from doing so.").

Notably, the panel improperly seized on *pre-issuance* diligence language, but even the requirement that corrections to *pending applications* "be diligently made," was removed from the regulations decades ago. *Schulze v. Green*, 136 F.3d 786, 789 n.3 (Fed. Cir. 1998) ("As of December 1, 1997, however, the requirement that

an amendment of the inventorship under section 1.48 [i.e. 37 C.F.R. §1.48(a) (pre-1997)] be made 'diligently' has been removed."). The panel has no basis to introduce a "diligent action" requirement into IPR proceedings now, Op. 7, effectively reviving the same legal error that *Stark* identified more than thirty years ago. *Cf.* 29 F.3d at 1575 ("The PTO Board of Interferences had referred to a judicially-imposed diligence requirement of § 256, *thus incorporating the error into PTO proceedings*." (clarifying *Willis v. Suppa*, 209 USPQ 406 (BPAI 1980))).

In sum, there cannot be "judicially imposed" diligence requirements for *issued* patents, so forfeiture is unavailable in this case "as a matter of law." *See id*.; *see also id*. at 1576-77 ("The requirement of diligence in bringing suit to correct inventorship under 35 U.S.C. § 256 was incorrect in law."). So there was no need for Implicit to "adequately explain[] why it could not have … more diligently sought correction of inventorship," Op. 9, because for *issued* patents this is immaterial. The panel imported an improper standard into this *post-grant* context, then faulted Implicit for not acting timely to correct inventorship before the FWDs. Op. 7 ("[W]e have 'agree[d] that diligent action is required *during a pending interference proceeding* ….' These principles apply in this case." (second alteration original) (citation omitted)). A misreading of *Stark* led to legal error which should be addressed en banc. *Compare id*. *with* Implicit Reply Br. 19

(signaling that Sonos was "misstating that *Stark* imposes a diligence requirement for IPRs").

III. The Panel Undermines the Protections of § 256 by Repeating the Same Forfeiture Mistakes as the PTAB

Even if legally permissible to apply forfeiture to prevent inventorship corrections on *issued* patents—it is not—the panel decision affirming the PTAB's abuse of discretion here undermines § 256 for at least three reasons.

A. Implicit's Inventorship Correction Was Raised Below

Implicit's request for inventorship correction came *during* the IPR proceedings below—it was indisputably filed *before* the post-*Arthrex* Director Review. The panel faults Implicit for a purported "failure to raise its new antedating argument until *years* after the [FWDs]." Op. 7. But this ignores nuances in the procedural timeline. *See supra* pp. 5-7; §II.A-B. Aggrieved parties today initiate Director Review immediately. Not so in 2019 when the PTAB decided these IPRs. From November 25, 2019, to December 30, 2021—766 total days—Implicit sought to have these proceedings reviewed by a duly appointed officer; and for the majority of this span, the PTAB's inurement findings remained vacated while *Arthrex* was appealed. The two-year window between the FWDs and Implicit's first opportunity to present its corrections in a Director Review was a delay of the USPTO's making. Implicit made its § 256 arguments to the Director at an appropriate time under the circumstances—it could not have been earlier in the proceedings. *See*

supra pp. 5-7; *cf. Google LLC v. Space Data Corp.*, IPR2018-00947, 2018 WL 5832845, at *2 (PTAB Nov. 7, 2018) ("Correcting inventorship is not within the scope of an *inter partes* review." (citing 35 U.S.C. § 311)); *Google*, 34 F.4th at 1088 ("IPA cannot raise this argument as a defense without actually seeking correction of inventorship of the patents, which it has not.").

B. There Is No Reason to Limit *Egenera* to Claim Construction

Egenera recognizes that inventorship is "complicated, as with complex projects involving many contributors at various times." 972 F.3d at 1376; *Jamesbury Corp. v. United States*, 518 F.2d 1384, 1396 (Ct. Cl. 1975) ("joint inventorship … is one of the muddiest concepts in the muddy metaphysics of the patent law") (citation omitted). So it is unsurprising that the Court permitted the patentee in *Egenera* to await the factfinder's determinations mid-litigation before correcting inventorship. 972 F.3d at 1379 ("[O]nce those issues were decided, it was entirely consistent for Egenera to request an accompanying formal correction of inventorship" for the *second* time.). But when the PTAB's FWD conclusions "illuminated Mr. [Carpenter]'s necessary presence as an inventor" here, *id*. at 1378, the panel limited *Egenera* to only the narrow "'legal determination' of claim construction" as sufficient to "justif[y] a new assessment by the patentee." Op. 8-9 (quoting *Egenera*, 972 F.3d at 1377-78).

Cabining *Egenera* in that way is unsupported by § 256, which is silent as to permissible reasons for reconsidering inventorship. And there is no principled distinction between Egenera correcting inventorship after an adverse claim construction and Implicit doing so after an adverse finding on inurement. *See Egenera*, 972 F.3d at 1377-78. An on-point inurement analysis is as valid a reason—even more so—to directly reassess inventorship. After all, Egenera's claims eventually construed as means-plus-function were also known to it earlier in that litigation, as was the real possibility of new claim scope emerging from *Markman*. *See id*. But *Egenera* did not require affirmatively arguing in the alternative any earlier. *Compare id*. *with* Op. 8-9; *see Airbus*, 2015-1037, -1192, D.I. 28 (no suggestion that patentee should have argued alternative inventorship theories to the jury, yet still permitting a post-trial inventorship correction consistent with the jury's contrary decision, thereby avoiding invalidity).

The panel's pinched interpretation of *Egenera* imposes improper limits on a broad savings statute that should invite reconsideration as a policy matter. *Cf. Patterson v. Hauck*, 341 F.2d 131, 138 (CCPA 1965) (provisions such as § 256 "should be given a liberal construction in favor of applicants, *permitting them to make such changes as more thorough consideration of facts may show to be necessary* in order to comply accurately with the law in naming inventors"). Implicit's inventorship corrections merely harmonized its patents with the PTAB's

view of the evidence, improving accuracy as Congress intended. *See id*. Implicit's original reading of the inventorship facts was consistent for decades—the same trio of actors performing the same activities according to the same evidence—but the PTAB's determination on inurement proved otherwise. *See supra* pp.3-5. Implicit advanced the inventorship listed on the face of presumptively valid patents and was entitled to "believe[] its initial position was correct"; accusations of "sandbagging" are misplaced under the unique operation of § 256. Op. 8-9; *Winbond Elecs. Corp. v. ITC*, 262 F.3d 1363, 1371 (Fed. Cir. 2001) ("This presumption [of validity] embraces as well the notion that a patent's named inventors are the true and only inventors.").

C. This Court Rejects Divergent Standards for Applying § 256

By applying forfeiture principles to § 256, the PTAB assumed for itself power that Article III courts do not even enjoy. *Stark*, 119 F.3d at 1553. The panel's affirmance endorses this dual-track system—contrary to *Stark*, it now permits APJs vast "discretion to decide when and under what terms to allow correction." *Id*.

But there is no daylight between the standards for applying § 256 in these two venues. *Id*. (rejecting notion that separate paths for "administrative and judicial correction somehow freed courts of the constraints included in the remainder of section 256"). "[S]ection 256 expressly applies the standards of the entire section … *to both administrative and judicial proceedings*" because "hold[ing]

otherwise would … contradict the language of the statute." *Id*. Thus, because "diligence is not a requirement to correct inventorship under section 256" in district courts, *id*. at 1554, the PTAB cannot impose its own brand of forfeiture under the same statute. Op. 8-9.

CONCLUSION

For the foregoing reasons, the Court should grant this petition.

Date: April 23, 2026

Respectfully submitted,

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ADDENDUM A

United States Court of Appeals for the Federal Circuit

IMPLICIT, LLC,
Appellant

v.

SONOS, INC.,
Appellee

JOHN A. SQUIRES, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE,
Intervenor

2020-1173, 2020-1174

Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2018-00766, IPR2018-00767.

Decided: March 9, 2026

JASON LEE ROMRELL, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, Washington, DC, argued for appellant. Also represented by TIMOTHY P. MCANULTY; J. DEREK MCCORQUINDALE, Reston, VA.

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LLP, Chicago, IL, argued for appellee. Also represented by GEORGE I. LEE, RORY PATRICK SHEA, SEAN MICHAEL SULLIVAN.

ROBERT MCBRIDE, Office of the Solicitor, United States Patent and Trademark Office, Alexandria, VA, argued for intervenor. Also represented by PETER J. AYERS, SARAH E. CRAVEN.

Before TARANTO, STOLL, and CUNNINGHAM, *Circuit Judges*.

CUNNINGHAM, *Circuit Judge*.

Implicit, LLC ("Implicit") appeals a final written decision on remand by the Patent Trial and Appeal Board ("Board") in an *inter partes* review ("IPR") of U.S. Patent No. 7,391,791 (the "'791 patent") and U.S. Patent No. 8,942,252 (the "'252 patent"), holding that certificates of correction of inventorship issued after the final written decisions had issued in the respective IPRs had no impact on the final written decisions. *Sonos, Inc. v. Implicit, LLC*, IPR2018-00766, IPR2018-00767, 2023 WL 6367720, at *1 (P.T.A.B. Sept. 19, 2023) ("*Decision on Remand*"). Implicit also appeals the final written decisions in the IPRs of the '791 patent and the '252 patent. *See also Sonos, Inc. v. Implicit, LLC*, IPR2018-00766, 2019 WL 4439131 (P.T.A.B. Sept. 16, 2019) ("*'791 Decision*"); *Sonos, Inc. v. Implicit, LLC*, IPR2018-00767, 2019 WL 4419356 (P.T.A.B. Sept. 16, 2019) ("*'252 Decision*"). For the reasons discussed below, we affirm.

I. BACKGROUND

Implicit owns the '791 and '252 patents. *Decision on Remand* at *1; '791 patent; '252 patent. Both patents originally listed Edward Balassanian and Scott Bradley as the only co-inventors. *'252 Decision* at *4; '791 patent; '252 patent. Mr. Balassanian and Mr. Bradley were both

employees of BeComm Corporation, the predecessor of Implicit. *'252 Decision* at *4; J.A. 2564.

Sonos, Inc. ("Sonos") petitioned for *inter partes* review of both patents, asserting unpatentability under 35 U.S.C. §§ 102 and 103. *'791 Decision* at *3; *'252 Decision* at *2; *see Decision on Remand* at *1. Sonos relied on alleged prior art reference Janevski,[1] which has a filing date of December 11, 2001. *Decision on Remand* at *3 (citing *'791 Decision* at *5, *6–7); J.A. 335; J.A. 4031–33; J.A. 1789. Implicit contended that Mr. Balassanian and Mr. Bradley conceived of the inventions and worked with engineer Guy Carpenter for implementation prior to December 11, 2001. *Decision on Remand* at *3 (citing *'791 Decision* at *6–7). Thus, Implicit argued that Janevski did not constitute prior art because the work of Mr. Carpenter inured to the inventors' benefit and the subject matter of the claims was conceived and actually reduced to practice prior to Janevski's filing date. *Id.*

In September 2019, the Board determined that all challenged claims were unpatentable.[2] *Id.* at *1; *'791 Decision* at *1; *'252 Decision* at *1. The Board concluded that Implicit's "evidence was insufficient to establish the conception of the invention and the communication of the invention to Mr. Carpenter such that any reduction to practice could inure to the inventors' benefit." *Decision on Remand* at *3 (citing *'791 Decision* at *7–9). As a result, the Board determined that Janevski constituted prior art to the challenged claims of the '791 patent and the '252 patent and determined that "the challenged claims [were]

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[1] U.S. Patent No. 7,269,338.

[2] The Board concluded that claims 1–3, 6–9, 12, 16, 19, and 23–25 of the '791 patent and claims 1–3, 8, 11, and 17 of the '252 patent are unpatentable. *'791 Decision* at *1; *'252 Decision* at *1.

unpatentable as anticipated by Janevski or obvious over Janevski, alone or in combination with other prior art." *Id.*

After this court issued *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320, 1325 (Fed. Cir. 2019), Implicit filed notices of appeal in November 2019, identifying various issues to appeal including Appointments Clause violations. J.A. 1083–88; J.A. 4766–71. This court vacated the Board's decisions and remanded to the Board for proceedings consistent with this court's decision in *Arthrex*. ECF No. 61. On June 21, 2021, the Supreme Court in *United States v. Arthrex, Inc.*, 594 U.S. 1 (2021), agreed that there was an Appointments Clause violation, held that the appropriate remedy was to ensure IPR parties an opportunity for Director review of a Board's final written decision, and remanded to provide the opportunity for such Director review. 594 U.S. at 23, 25–26.

In November 2021, this court remanded the present case for the limited purpose of allowing Implicit to request rehearing and review by the Director of the final written decisions in light of the Supreme Court's *Arthrex* decision. ECF No. 70 at 2; *see Decision on Remand* at *2. On February 7, 2022, the requests for Director review were denied without opinion. J.A. 1123–24. Implicit was granted a new deadline to file its amended notice of appeal to challenge the denial of Director review. ECF No. 72; *Decision on Remand* at *2.

On December 17, 2021, Implicit requested that the United States Patent and Trademark Office correct the inventorship of the '791 and '252 patents to add Mr. Carpenter as an inventor. *Decision on Remand* at *2; ECF No. 78, Exs. E–F. The corresponding certificates of correction for both patents issued in August 2022. J.A. 174, 192. After the certificates of correction issued, this court remanded to the Board "for the sole purpose of having the [Board] issue an order addressing what, if any, impact the certificates of

correction would have on the final written decisions in these cases." ECF No. 85 at 2; *Decision on Remand* at *2.

On September 19, 2023, the Board determined that while 35 U.S.C. § 256 is generally retroactive, "judicial estoppel and waiver appl[ied] under the specific circumstances of these cases." *Decision on Remand* at *1; *see id.* at *10 n.11 (acknowledging that waiver and forfeiture applied). Subsequently, the Board concluded that Implicit was precluded from relying on the certificates of correction of inventorship in the IPR proceedings as a basis to revisit the final written decisions. *Id.* at *10–11.

Implicit timely appealed. We have jurisdiction under 28 U.S.C. § 1295(a)(4)(A).

II. STANDARD OF REVIEW

"We review the Board's legal conclusions de novo and its fact findings for substantial evidence." *Game & Tech. Co. v. Wargaming Grp. Ltd.*, 942 F.3d 1343, 1348 (Fed. Cir. 2019) (citation omitted). "We set aside the Board's action if it is 'arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law.'" *Veritas Techs. LLC v. Veeam Software Corp.*, 835 F.3d 1406, 1413 (Fed. Cir. 2016) (quoting 5 U.S.C. § 706(2)(A)). "Whether a party forfeited an argument by failing to timely raise it is . . . reviewed for abuse of discretion." *Centripetal Networks, LLC v. Palo Alto Networks, Inc.*, 156 F.4th 1368, 1374 (Fed. Cir. 2025). "An abuse of discretion is found if the decision: (1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact finding; or (4) involves a record that contains no evidence on which the Board could rationally base its decision." *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016) (quoting *Bilstad v. Wakalopulos*, 386 F.3d 1116, 1121 (Fed. Cir. 2004)).

III. DISCUSSION

Implicit contends that 35 U.S.C. § 256 corrections have a retroactive effect, and as a result, equitable doctrines such as judicial estoppel, waiver, and forfeiture should not apply "to nullify the effect of that correction." Appellant's Br. 45–47. Additionally, Implicit argues that its case has not met the substantive requirements of judicial estoppel, waiver, or forfeiture and that the Board erred in applying such doctrines in its decision. *Id.* at 27–44. We hold that forfeiture can apply notwithstanding the retroactive effect of 35 U.S.C. § 256 and that the Board did not abuse its discretion in applying forfeiture to the circumstances of this case. Accordingly, we need not and do not reach the issues of judicial estoppel or waiver.

A.

We begin by addressing whether forfeiture applies in cases where a section 256 correction has been issued. Implicit argues that section 256 does not limit the time during which inventorship can be corrected, and thus, forfeiture is inapplicable to section 256 corrections of inventorship. Appellant's Br. 38–39. Sonos and the United States Patent and Trademark Office ("PTO") argue that forfeiture can apply even after section 256 corrections have been issued. Appellee's Br. 27–28; Intervenor's Br. 30–33. We agree with Sonos and the PTO.

We hold that forfeiture can apply to Implicit's antedating argument despite the 35 U.S.C. § 256 correction of inventorship. As an initial matter, the PTO granted Implicit's petitions to correct inventorship. *Decision on Remand* at *2; ECF No. 78, Exs. E–F; J.A. 174, J.A. 192. The Board merely decided that Implicit could not make new antedating arguments based on this correction of inventorship. *Decision on Remand* at *10 & n.11. Even so, we have indicated that whether there is a requirement of diligence in seeking correction of inventorship is "determined on the facts of that case." *Stark v. Advanced Magnetics, Inc.*,

29 F.3d 1570, 1575 (Fed. Cir. 1994). For example, we have "agree[d] that diligent action is required during a pending interference proceeding, where a change of inventorship can directly affect the trial and outcome of the proceeding." *Id.* These principles apply in this case where Implicit had the opportunity to seek correction of inventorship and assert its change of inventorship theory earlier in this proceeding, and such a change could "directly affect the trial and outcome of the proceeding." *Id.* Thus, we hold that it can be appropriate to apply forfeiture principles in a case when a 35 U.S.C. § 256 correction has issued.

B.

We next consider whether the Board abused its discretion in determining that Implicit forfeited its ability to argue a new antedating argument based on the correction of inventorship. Implicit argues that its assertion of correction of inventorship was timely because it sought correction of inventorship for its patents while proceedings were ongoing, before Director Review finalized the proceedings. Appellant's Br. 39–41. Sonos and the PTO argue that Implicit's failure to raise its new antedating argument until years after the final written decisions and without sufficient justification for the delay constituted forfeiture and that the Board did not abuse its discretion in determining that Implicit forfeited this new antedating argument. Appellee's Br. 24–27; Intervenor's Br. 27–30. We agree with Sonos and the PTO.

"[F]orfeiture is the failure to make the timely assertion of a right." *United States v. Olano*, 507 U.S. 725, 733 (1993). A party forfeits an argument that it failed to present to the Board.[3] *See, e.g.*, *Schwendimann v. Neenah,*

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[3] This Court has often used "waiver" and "forfeiture" interchangeably, although waiver is different than

Inc., 82 F.4th 1371, 1383–84 (Fed. Cir. 2023).

The Board did not abuse its discretion when it determined that Implicit forfeited its right to argue that Mr. Carpenter was an inventor to support its antedating argument. The Board explained that Implicit failed to argue before the Board in the first instance any other theories of inventorship and waited until after the final written decisions had already been issued to seek certificates of correction. *Decision on Remand* at *10; *see In re Google*, 980 F.3d at 863. Implicit argues that the final written decisions "illuminated Mr. [Carpenter]'s necessary presence as an inventor," Appellant's Br. 39–41, relying on *Egenera, Inc. v. Cisco Sys., Inc.*, 972 F.3d 1367, 1376, 1378 (Fed. Cir. 2020). But the key circumstance allowing a mid-litigation effort to seek correction of inventorship in *Egenera* is not present here. In *Egenera*, a judicial adoption of a particular claim construction changed the scope of the claims and, hence, justified a new assessment by the patentee of who the co-inventors were. *See Egenera*, 972 F.3d at 1377–78 (relying on the district court's "legal determination" of

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forfeiture. *In re Google Tech. Holdings LLC*, 980 F.3d 858, 862 (Fed. Cir. 2020). But "[w]hereas forfeiture is the failure to make the timely assertion of a right, waiver is the 'intentional relinquishment or abandonment of a known right.'" *Id.*; *Olano*, 507 U.S. at 733 (quoting *Johnson v. Zerbst*, 304 U.S. 458, 464 (1938)). While Implicit briefly argues that the Board's discussion of both terms lacks reasonable clarity required for review under 5 U.S.C. § 706, Appellant's Br. 37–38, the Board's explanation of the difference between the terms and its usage provides "sufficient clarity to permit 'effective judicial review.'" *Timken U.S. Corp. v. United States*, 421 F.3d 1350, 1355 (Fed. Cir. 2005) (quoting *Camp v. Pitts*, 411 U.S. 138, 142–43 (1973)); *Decision on Remand* at *10 n.11 (citing *In re Google*, 980 F.3d at 862).

claim construction as creating a new issue as to an individual's "necessary presence as an inventor"); *id.* at 1376 (describing inventorship as a "legal conclusion" that "may vary depending on what . . . a court determines the claim scope to be").

No change in the claim scope occurred in the present case. From the beginning, Implicit "had in its sole possession the evidence of inventorship and intentionally presented evidence asserting a certain inventorship"—Mr. Balassanian and Mr. Bradley, without Mr. Carpenter. *Decision on Remand* at *10. Implicit has not adequately explained why it could not have made any arguments related to Mr. Carpenter in the first instance or more diligently sought correction of inventorship. When asked at oral argument about difficulties in asserting correction of inventorship earlier, Implicit explained that: (1) it believed its initial position was correct; and (2) Mr. Carpenter resided in Australia. Oral Arg. 9:55–10:50, https://www.cafc.uscourts.gov/oral-arguments/20-1173_10092025.mp3. Implicit's first response raises concerns of sandbagging, where Implicit could "suggest[] or permit[], for strategic reasons, that the [Board] pursue a certain course, and later—if the outcome is unfavorable—claim[] that the course followed was reversible error." *In re Google*, 980 F.3d at 864 (quoting *Freytag v. C.I.R.*, 501 U.S. 868, 895 (1991) (Scalia, J., concurring in part and concurring in the judgment)). And Implicit forfeited its second argument by not arguing it before the Board or in its briefs before us. J.A. 1210–27; J.A. 1257–66; Appellant's Br. 38–41; *Schwendimann*, 82 F.4th at 1383–84; *ABS Global, Inc. v. Cytonome/ST, LLC*, 984 F.3d 1017, 1027 (Fed. Cir. 2021). Given these circumstances, we conclude that the Board did not abuse its discretion in finding that Implicit forfeited its argument. Because forfeiture is an independent ground for affirmance, we need not and do not reach Implicit's arguments regarding judicial estoppel and

waiver. *See, e.g., LSI Corp. v. Regents of Univ. of Minn.*, 43 F.4th 1349, 1355 (Fed. Cir. 2022).

IV. CONCLUSION

We have considered the remaining arguments raised in Implicit's briefing in this appeal and find them unpersuasive. For the foregoing reasons, we affirm.

AFFIRMED

ADDENDUM B

35 U.S.C.A. § 256

§ 256. Correction of named inventor

Effective: September 16, 2012

(a) Correction.--Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.

(b) Patent Valid if Error Corrected.--The error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly.

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July 2020

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

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Case Number: 2020-1173, -1174

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Name: J. Derek McCorquindale