Nos. 20-1173, -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.

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

SONOS, INC.'S RESPONSE TO PETITION FOR REHEARING EN BANC

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UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

CERTIFICATE OF INTEREST

Case Number 20-1173, -1174

Short Case Caption Implicit LLC v. Sonos, Inc.

Filing Party/Entity Sonos, Inc.

Instructions:

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Date: 06/01/2026

Signature: /s/ Elizabeth R. Moulton

Name: Elizabeth R. Moulton

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
Sonos, Inc.		BlackRock Inc.

☐ Additional pages attached

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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5. Related Cases. Other than the originating case(s) for this case, are there related or prior cases that meet the criteria under Fed. Cir. R. 47.5(a)?

☑ Yes (file separate notice; see below) ☐ No ☐ N/A (amicus/movant)

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INTRODUCTION

It is a longstanding common-law rule that a party to a pending proceeding must diligently press its rights to the tribunal or risk forfeiting those rights. *See United States v. Olano*, 507 U.S. 725, 733 (1993). For at least 30 years, this Court has applied that rule in the context of arguments based on a change of inventorship and held that "[w]hether diligent action is required in a particular case [involving a § 256 correction] must be determined on the facts of that case." *Stark v. Advanced Magnetics, Inc.* (*Stark I*), 29 F.3d 1570, 1575 (Fed. Cir. 1994). Applying that rule here, the panel held based on the particular and uncommon facts of this case that the Board did not abuse its discretion in finding that Implicit forfeited new antedating arguments based on a change of inventorship it attempted to raise years after the Board issued its final written decision. That decision creates no conflict with § 256; under § 256(a), the Patent Office "issue[d] a certificate correcting" inventorship. And under § 256(b), Implicit's patent was not invalidated for failure to correct inventorship, but rather for failure to antedate prior art. That failure to antedate was based on the arguments Implicit

chose to raise before the Board and the Board's discretionary decision finding that other types of antedating arguments were forfeited.

Implicit now urges this Court to go en banc to consider whether forfeiture may *ever* apply to arguments that rely on a change of inventorship. But Implicit fails to identify any basis for rehearing. Implicit does not argue that this question is one of exceptional importance—nor could it, given it rarely arises and has only limited application to post-AIA patents. And the panel decision is fully supported by all the decisions Implicit contends it conflicts with as well as § 256.

The petition for rehearing should be denied.

BACKGROUND

Implicit, LLC owns U.S. Patent Nos. 7,391,791 and 8,942,252. On Sonos's petition, the PTAB instituted inter partes review of the patents. Sonos's petition argued that the challenged claims were anticipated or obvious over the *Janevski* reference, which had a December 11, 2001 priority date. In response, Implicit attempted to swear behind *Janevski*. Implicit argued that a document allegedly prepared two days earlier, on December 9, 2001, as well as source code files,

demonstrated that it reduced its invention to practice before *Janevski's* priority date. Appx123.

But there was a problem. The patents named two inventors: Edward Balassanian and Scott Bradley, employees at Implicit's predecessor, BeComm. Appx40-41. The document and the source-code files appear to have been created by a third person, Guy Carpenter. *See* Appx46. Implicit elected to square that circle by arguing that Carpenter did not contribute to the conception of the claimed inventions. Rather, Balassanian and Bradley directed Carpenter to reduce their conceptions to practice. When asked at deposition whether "Guy Carpenter contribute[d] to … any conception of the claims," co-inventor Balassanian testified, "I don't believe so." Appx1974. At no point in its Patent Owner Response or at the hearing on Sonos's petition did Implicit raise an alternative argument that Carpenter in fact invented the challenged claims.

The Board rejected Implicit's argument. The Board's final written decision found insufficient evidence corroborating the claim that Balassanian and Bradley conceived the inventions or communicated the inventions to Carpenter. Specifically, the Board determined that "none

of the BeComm internal documents, demonstrations of BeComm technology, or BeComm source code corroborate Mr. Balassanian's testimony that he and Mr. Bradley conceived of the challenged claims or that they communicated the inventions to Mr. Carpenter." Appx125; *see also* Appx47. It therefore concluded that Implicit had not demonstrated prior conception and diligent reduction to practice, which meant that *Janevski* was prior art and the challenged claims were unpatentable. *See* Op. 3-4. In so holding, the Board did not "reach the issue of whether [the] … source code practices the claim limitations." Appx126. The Board also made no findings about whether Carpenter should have been named as an inventor. The Board did not find, for example, that Carpenter conceived any of the claimed material or did anything more than translate into code ideas conceived by others.

After the Board issued its final written decisions in September 2019, Implicit appealed to this Court, which ultimately remanded in November 2021 to allow Implicit to seek Director Rehearing in light of *United States v. Arthrex, Inc.*, 594 U.S. 1 (2021). It was only after that remand order—more than two years after the Board had issued its final written decisions—that Implicit finally requested certificates of

correction from the Patent Office adding Carpenter as an inventor. Op. 4. Implicit then filed a request for Director Rehearing, in which it raised—for the first time—a new antedating argument premised on adding Carpenter as an inventor. *See* Appx1108-1109.

Director Rehearing was denied in February 2022. Appx1123-1124. In August 2022, the Patent Office issued certificates of correction adding Carpenter as an inventor. Appx174, Appx192.[1] Consistent with the Manual of Patent Examining Procedure, the Patent Office did not substantively evaluate the petition. MPEP § 1481.02; *see also Egenera, Inc. v. Cisco Sys., Inc.*, 972 F.3d 1367, 1380 (Fed. Cir. 2020).

Implicit appealed again, and this Court remanded for the Board to 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. On remand, Implicit argued that, because Carpenter was now a named inventor, the December 9 document and the source code antedated the *Janevski* reference. The Board found that, while certificates of correction generally have retroactive effect, Implicit was

[1] Implicit's request for the certificates of correction did not include any discussion of the basis for its purported error. *See* ECF No. 78 at Exs. E, F (Petitions for Correction of Inventorship).

judicially estopped from raising its change-in-inventorship-based argument, that it had forfeited/waived the argument by not raising it during the original inter partes review trial, and that the final written decisions had not revealed an error in inventorship that would justify reopening the proceedings. *See* Appx13, Appx21-24.

Implicit appealed and this Court affirmed. The panel first rejected Implicit's argument that 35 U.S.C. § 256(b), which provides that inventorship errors "shall not invalidate the patent in which such error occurred if it can be corrected," abrogates a litigant's duty to raise arguments in a timely manner or risk forfeiting them. Op. 8-9. The panel relied in part on *Stark v. Advanced Magnetics, Inc. (Stark I)*, 29 F.3d 1570 (Fed. Cir. 1994), which held that a patent owner must diligently seek correction of inventorship when "a change of inventorship can directly affect the trial and outcome of [a pending] proceeding." Op. 7 (quoting *Stark I*, 29 F.3d at 1575).

The panel then concluded that the Board did not abuse its discretion in finding Implicit's change-in-inventorship-based argument forfeited. Op. 7-8. The panel found that, "[f]rom the beginning, Implicit 'had in its sole possession the evidence of inventorship and intentionally

presented evidence asserting a certain inventorship'" without Carpenter. Op. 9 (quoting Appx23, Appx100). The panel further found Implicit failed to "adequately explain[]" its delay. Op. 9. The panel concluded that allowing patent owners a do-over in such cases "raises concerns of sandbagging." *Id.*

REASONS FOR DENYING THE PETITION

I. The Panel's Decision Does Not Contradict This Court's Precedents.

Implicit asserts rehearing is warranted because the panel's holding that a party may forfeit untimely antedating arguments involving a certificate of correction purportedly conflicts with three of this Court's precedents—*Stark v. Advanced Magnetics, Inc. (Stark I)*, 29 F.3d 1570 (Fed. Cir. 1994), *Stark v. Advanced Magnetics, Inc. (Stark II)*, 119 F.3d 1551 (Fed. Cir. 1997), and *Egenera, Inc. v. Cisco Sys., Inc.*, 972 F.3d 1367 (Fed. Cir. 2020). *See* Pet. viii. There is no conflict.

A. For at least 30 years, the rule in this Court has been that "[w]hether diligent action is required in a particular case [involving a § 256 correction] must be determined on the facts of that case." *Stark I*, 29 F.3d at 1575. In *Stark I*, this Court applied that rule to an omitted inventor's inventorship challenge and considered "whether the

circumstances of th[at] case required diligent legal action by [omitted inventor] Dr. Stark." *Id.*

The Court has consistently applied that rule after *Stark I*. For example, in *LendingTree, LLC v. Zillow, Inc.*, 656 F. App'x 991 (Fed. Cir. 2016), following a general verdict invalidating a patent for improper inventorship, the patent owner secured a § 256 correction and argued that the jury verdict *must* be vacated. This Court disagreed. It instead remanded to the trial court to consider whether vacatur was "inappropriate" "given that LendingTree did not timely request identification of the inventors by the jury" and the verdict was ambiguous as to who the real inventors were. *Id.* at 999; *see also* Order at 2, *Airbus DS Commc'ns, Inc. v. Microdata GIS, Inc.*, No. 2015-1037 (Fed. Cir. Mar. 18, 2015), ECF No. 28 (remanding "for the district court to decide Airbus's motion to vacate the invalidity judgment pursuant to Fed. R. Civ. P. 60.").

The panel applied that same longstanding rule to the particular and uncommon facts of this case. Op. 6-7. After advancing and losing on one antedating argument, Implicit waited *two years* to file a § 256 correction and then even longer to argue that the Board should reopen

its final written decision to consider new antedating arguments based on Implicit's new position on inventorship and certificate of correction. On these particular facts, the panel held the Board did not abuse its discretion in finding that Implicit forfeited the ability to advance new antedating arguments.

B. Implicit's claims of conflict distort this Court's prior cases. Implicit cites no examples—precedential or not—in which this Court held that forfeiture may not apply to a change-in-inventorship-based argument. Instead, the Court's cases show that forfeiture *may* apply; it depends on the facts of each case. Because Implicit does not challenge the panel's application of forfeiture principles, but challenges only whether forfeiture can apply at all, there is no identified conflict with the Court's prior cases.

Stark I. Implicit argues that, far from supplying the case-specific forfeiture rule the panel applied, *Stark I* holds "that[,] for inventorship corrections to *issued* patents, a diligence requirement is never applied." Pet. 12. Implicit conflates what the patentee did in *Stark I*—seek correction without demonstrating diligence—with the behavior that Implicit wants excused here—making new validity arguments without

demonstrating diligence. *Stark I* does not support that conflation, and in fact rejects it. *Stark I* involved an excluded inventor's attempt to add himself to an issued patent. The Court held that in that context, unlike in the pre-issue context, there is no *statutory* diligence requirement to seeking correction that requires "diligence as a matter of law." *See Stark I*, 29 F.3d at 1574-75. But the absence of a statutory diligence requirement in seeking correction did not mean that diligence could never be required. Rather, as the Court explained, in the issued-patent context, "[w]hether diligent action is required in a particular case must be determined on the facts of that case." *Id.* at 1575. And after stating that diligence is case-specific, the Court went on to determine whether diligence was required "on the facts of that case," which involved an issued patent. *Id.* at 1575-76. This assessment would have been superfluous and nonsensical if, as Implicit reads that opinion, diligence could never be required in such cases.

Moreover, throughout its decision, the Court discussed circumstances in which diligence may be required under the common-law doctrine, apart from an express statutory requirement. For example, the Court recognized "that diligent action is required during a

pending interference proceeding" because "a change of inventorship can directly affect the trial and outcome of the proceeding." *Id.* at 1575. The Court noted that this is one of the "ordinary principles governing the duties of parties litigant." *Id.* (citing *Van Otteren v. Hafner*, 278 F.2d 738 (C.C.P.A. 1960)). That duty applies to Implicit, because Implicit is the party that believes its correction "can directly affect the trial and outcome of the proceeding" in Implicit's favor.

Egenera. Implicit next argues the panel's decision conflicts with *Egenera*. Pet. 15-17. But *Egenera* says nothing about diligence or forfeiture. The issue there was whether the trial court correctly applied judicial estoppel to prevent a patent owner that had already obtained a correction of inventorship from later changing it back to avoid an invalidity judgment after claim construction proceedings clarified the scope of the claims. 972 F.3d at 1369-70. The Court *declined* to adopt Implicit's position that equitable rules, like estoppel and forfeiture, can never foreclose new arguments based on a § 256 correction. *Id.* at 1378 ("We need not decide" whether "judicial estoppel can *never* prevent § 256 from saving a patent's validity."). It instead held judicial estoppel did not apply on the facts of that case. *Id.* And it further recognized

that other equitable doctrines like "inequitable-conduct rules … provide a safety valve in the event of deceit." *Id.* at 1377.

Egenera is further distinguishable on its facts. The patent owner there did what Implicit should have done here—it preserved its alternative change-in-inventorship-based argument during the summary judgment proceedings that resulted in the appealed judgment. *See Egenera*, 972 F.3d at 1372. Further, while the Court in *Egenera* found an inventorship error, neither the panel nor the Board reached that conclusion here. The Board found simply a lack of evidence that Carpenter's source code was an implementation of the named inventors' concept. *See* Appx47 ("[T]here is no evidence provided by Patent Owner as to who conceived of the invention ….") . The decision did not conclude (or otherwise reveal) that Carpenter was an inventor. And further still, in *Egenera*, the change-in-inventorship-based argument followed a claim construction ruling that revealed "who should be listed on the face of the patent," while there was no such clarification of claim scope here. *Egenera*, 972 F.3d at 1376.

Stark II. Finally, Implicit argues the panel opinion conflicts with *Stark II*'s rule that § 256 applies equally to district courts and

administrative agencies, creating a "dual-track system" that permits the Board to find forfeiture where district courts could not. Pet. 17. But Implicit's premise is wrong. This Court has held that district courts may find a change-in-inventorship-based argument forfeited, just as the Board did in this instance. *See Stark I*, 29 F.3d at 1575-76 (considering whether district court properly required diligence); *LendingTree*, 656 F. App'x at 999 (remanding for district court to consider whether argument preserved); *supra* at 8.

II. Section 256 Did Not Abrogate Longstanding Forfeiture Doctrine.

That leaves Implicit's argument that the Court misinterpreted 35 U.S.C. § 256(b). Pet. 9-11. But Implicit nowhere argues that question satisfies this Court's standard for rehearing en banc. Absent a conflict, this Court only rehears "questions of exceptional importance." *See Missouri v. Jenkins*, 495 U.S. 33, 46 n.14 (1990) ("Rehearing in banc is a discretionary procedure employed only to address questions of exceptional importance or to maintain uniformity among Circuit decisions."); *Sony Elecs., Inc. v. United States*, 382 F.3d 1337, 1339 (Fed. Cir. 2004). To that end, this Court requires counsel to certify the basis for rehearing en banc. *See* Fed. Cir. R. 40(c). Implicit elected not to

certify or even argue that the question here meets that standard. *See* Pet. viii; Fed. Cir. R. 40(c).

Nor could it. Forfeiture in the context of change-in-inventorship-based arguments rarely arises. As Implicit concedes, the applicability of forfeiture principles to attempts to swear behind prior art based on change-in-inventorship-based arguments in the PTAB is an "issue of first impression" despite nearly 15 years of post-grant proceedings. Pet. 1. And this issue has an expiration date. With the AIA's change to a first-to-file system, post-AIA patentees may no longer antedate prior art.[2]

The Court's decision is also correct on the merits. As this Court has long held, § 256(b) does not categorically preclude the application of forfeiture to any and all arguments premised on a change of inventorship. *Supra* at 7-11. Nothing in the text of § 256 displaces the ordinary obligation of litigants to raise arguments in a timely fashion. As the Supreme Court held, "'[n]o procedural principle is more familiar to this Court than that a constitutional right,' or a right of any other

[2] A change of inventorship may still have limited relevance if the prior art was authored by the new inventor. *See* 35 U.S.C. § 102(b).

sort, 'may be forfeited in criminal as well as civil cases by the failure to make timely assertion of the right before a tribunal having jurisdiction to determine it.'" *United States v. Olano*, 507 U.S. 725, 731 (1993) (quoting *Yakus v. United States*, 321 U.S. 414, 444 (1944)).

Implicit argues that § 256's mandatory language—that inventorship errors "shall not invalidate the patent" if they can be corrected—forecloses the application of forfeiture doctrine. But even the most sacrosanct of rights—expressed in equally mandatory language—are forfeitable. *See, e.g.*, *Weaver v. Massachusetts*, 582 U.S. 286, 300-01 (2017) (Sixth Amendment public-trial right); *United States v. Cotton*, 535 U.S. 625, 631-34 (2002) (Fifth Amendment grand-jury right); *United States v. Marcus*, 560 U.S. 258, 265 (2010) (Ex Post Facto/Due Process right). Congress did not silently carve out an exception to longstanding forfeiture rules for patent owners.

The panel correctly recognized this. It held that § 256 permitted Implicit to correct its inventorship—and indeed, the Patent Office granted that correction—but that the correction did not entitle Implicit to make a new antedating argument that it had forfeited by failing to raise it during the inter partes review trial. Op. 6. The purpose of

§ 256—to avoid invalidity based solely on a correctable inventorship error—is not undermined by requiring patent owners to timely assert the rights that § 256 affords.

Implicit's contrary reading would threaten the interests of finality, efficiency, and fairness that forfeiture doctrine protects. Nothing would prevent a patent owner from intentionally withholding an argument premised on a change of inventorship, losing at trial, obtaining a correction, and then demanding a do-over. Congress could not have intended such an outcome, and Implicit cites no authority supporting it.[3]

[3] As a fallback position, Implicit argues that it did, in fact, timely raise its change-in-inventorship-based argument in its request for Director Rehearing. But Implicit nowhere argues, nor could it, that a fact-bound question of when a litigant raised a particular argument below merits rehearing. Implicit is also wrong. Nothing prevented Implicit from arguing to the Board in the alternative that Carpenter was the inventor or from seeking a correction before or during the inter partes review. As the panel correctly found, Implicit offers no adequate explanation for waiting until after the Board issued its final written decision.

CONCLUSION

The petition for rehearing en banc should be denied.

June 1, 2026

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

The response complies with the type-volume limitation of Fed. Cir. R. 40(e) because this response contains 3,138 words, excluding the parts of the brief exempted by Fed. R. App. P. 32(f) and Fed. Cir. R. 32(b)(2).

This response complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. P. 32(a)(6) because this response has been prepared in a proportionally spaced typeface using Microsoft Word for Microsoft 365 in Century Schoolbook 14-point font.

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