UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONOS, INC.
Petitioner

v.

IMPLICIT, LLC
Patent Owner

IPR2018-00767
U.S. Patent No. 8,942,252

PETITIONER'S RESPONSE TO PATENT OWNER'S OPENING BRIEF AFTER REMAND

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INTRODUCTION

Implicit's post-Final Written Decision change in inventorship does not undo the invalidity decided in these Final Written Decisions because § 256 limits retroactive validity applications to scenarios of misjoinder or nonjoinder under § 102(f). The Board did not hold the challenged claims invalid under § 102(f) and thus § 256 does not apply to undo The Board's invalidity finding here. Principles of waiver and judicial estoppel, as outlined in Sonos's opening brief, support this notion as it has long been a hallmark of the American Judicial system that parties cannot return to tribunals and reopen decisions by advancing new arguments or changing certain facts. Setting these dispositive aspects aside, even were the Board to consider the changed inventorship, the result will ultimately be the same because there are other reasons independent of inventorship why the swear-behind attempt fails. Undoing the invalidity decisions at this stage, based on activity occurring years after the issuance of the Final Written Decisions, would also violate Due Process and the APA, capping off why changed inventorship does not resurrect the invalid claims here.

Implicit advances two unpersuasive arguments in its opening brief. First, Implicit argues that § 256 can apply retroactively, compared to §§ 254 and 255, which apply prospectively. But this does not get Implicit the relief it asks for. The question is not whether § 256 applies retroactively in ***some*** scenarios, the question

is "does it apply retroactively in ***this*** scenario?" Where misjoinder or nonjoinder were not at issue in the IPRs, the statute and caselaw are clear that Implicit cannot use § 256 as a get-out-of-jail free card for other types of invalidity. It makes sense why § 256 applies retroactively only for cases of misjoinder or nonjoinder because with misjoinder or nonjoinder the correction completely removes the basis for invalidity. In cases with other types of invalidity, like ours, correction does not remove the basis for invalidity – it has no direct effect on the §§ 102, 103 invalidity grounds here, and there remains independent reasons why Implicit's swear-behind fails. Second, Implicit argues that public policy supports correction because it rewards the actual inventors. But public policy supports the principles of finality, waiver, and judicial estoppel as well. Allowing Implicit to resurrect its challenged claims by changing inventorship after issuance of the Final Written Decisions would encourage parties to play a wait-and-see game with swear-behinds, molding inventorship after the fact to whatever inventive entity fits their evidence. Such gamesmanship should not be rewarded.

I. IMPLICIT'S CASELAW DOES NOT SUPPORT REVISITING THE FINAL WRITTEN DECISIONS

Sonos's opening brief demonstrated why § 256 retroactively applies to cure §102(f) invalidity but does not apply to cure other types of invalidity. Implicit's brief fails to cite any authority permitting the type of retroactive application of § 256 Implicit asks for. Instead, Implicit attempts to show that § 256 applies

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