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U.S. PATENT & TRADEMARK OFFICE

Paper No. ___
Filed: October 10, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONOS, INC.,
Petitioner,

v.

IMPLICIT, LLC,
Patent Owner.

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

PATENT OWNER'S SECOND AMENDED NOTICE OF APPEAL

Pursuant to 35 U.S.C. §§ 141(c) and 319 and 37 C.F.R. §§ 90.2(a) and 90.3(b)(1), and *Implicit, LLC, v. Sonos, Inc.*, Case Nos. 2020-1173, -1174, Dkt. No. 90 (Fed. Cir. Oct. 6, 2023), Patent Owner hereby provides its Notice that it appeals to the United States Court of Appeals for the Federal Circuit from the Final Written Decision entered September 16, 2019, (Paper 40), from the Final Written Decision on Remand entered on September 19, 2023 (Paper 60), and from all underlying

orders, decisions, rulings, and opinions regarding U.S. Patent No. 8,942,252 B2 (“the ’252 patent”) set forth in *Inter Partes Review* IPR2018-00767.

In accordance with 37 C.F.R. § 90.2(a)(3)(ii), the issues on appeal include, but are not limited to:

1. whether the Board erred when it found that claims 1–3, 8, 11, and 17 of the ’252 Patent were shown to be unpatentable under 35 U.S.C. § 103(a) as obvious in view of U.S. Patent No. 7,296,338 (“Janevski”) and Azevedo¹, Janevski and Mills², Janevski and Berthaud³, and/or Janeveski and Eidson⁴;
2. whether the Board erred when it concluded that Janevski is prior art to the ’252 patent under 35 U.S.C. § 102.
3. whether the Board erred when it construed terms of the claims of the ’252 patent;
4. whether the Board erred in assessing the correction of inventorship certificate in “consider[ing] the impact of these intervening circumstances on the decisions on appeal in the first instance,” and whether or not it properly

¹ Azevedo, *Fault-Tolerant Clock Synchronization for Distributed Systems with High Message Delay Variation*, IEEE Workshop on Fault-Tolerance Par. and Dist. Syst., (1994) (“Azevedo”).

² Mills, *Network Time Protocol (Version 3) Specification, Implementation and Analysis*, Network Working Group, University of Delaware (March 1992) (“Mills”).

³ Jean-Marc Berthaud, *Time Synchronization Over Networks Using Convex Closures*, IEEE/ACM Transactions on Networking (Apr. 2000) (“Berthaud”).

⁴ U.S. Patent No. 6,278,710 (“Eidson”).

“issue[d] an order addressing what, if any, impact the certificates of correction would have on the final written decisions in these cases.” *Implicit, LLC, v. Sonos, Inc.*, Case Nos. 2020-1173, -1174, Dkt. No. 85 (Fed. Cir. Nov. 9, 2022).

5. whether judicial estoppel and waiver were proper grounds for the Board to rely on in response to the Court’s limited remand order and whether these doctrines were applied without error. *See id*
6. whether the February 7, 2022 Order (Paper 47), issued by Commissioner for Patents, Andrew Hirshfeld, as the Official Performing the Functions and Duties of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, comports with the Supreme Court’s decision in *United States v. Arthrex, Inc.*, 141 S. Ct. 1970 (2021) or the Federal Vacancies Reform Act;
7. whether Commissioner for Patents, Andrew Hirschfeld, as the Official Performing the Functions and Duties of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office erred when denying Patent Owner’s Request for Director Review, including application of improper procedures;
8. all other issues decided adversely to Patent Owner in any order, decision, ruling or opinion underlying or supporting the Final Written Decision (Paper

40) or the Order Denying Patent Owner's Request for Director Review (Paper 47), or the Final Written Decision on Remand entered on September 19, 2023 (Paper 60), or any other order adversely affecting Patent Owner. Copies of the decisions being appealed are attached to this Notice.

Pursuant to 35 U.S.C. § 142 and 37 C.F.R. § 90.2(a), this Notice is being filed with the Director of the United States Patent and Trademark Office, and a copy of this Notice is being concurrently filed with the Patent Trial and Appeal Board. In addition, a copy of this Notice is being filed with the Clerk's Office for the United States Court of Appeals for the Federal Circuit via CM/ECF.⁵

Dated: October 10, 2023

By: /Timothy P. McAnulty/
Timothy P. McAnulty (Back-up Counsel)
Reg. No. 56,939
FINNEGAN, HENDERSON, FARABOW,
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⁵ Pursuant the United States Court of Appeals for the Federal Circuit Order dated February 28, 2022, “[n]o additional docketing fee is required for any amended notices of appeal in this matter.” *Implicit, LLC, v. Sonos, Inc.*, Case Nos. 2020-1173, -1174, Dkt. No. 72 (Fed. Cir. Feb. 28, 2022); *Implicit, LLC, v. Sonos, Inc.*, Case Nos. 2020-1173, -1174, Dkt. No. 85 (Fed. Cir. Nov. 9, 2022) (“This court retains jurisdiction over the appeals.”).

CERTIFICATE OF SERVICE AND FILING

I hereby certify that on this 10th day of October 2023, in addition to being filed and served electronically through the Board's P-TACTS System, a true and correct copy of the foregoing "**PATENT OWNER'S SECOND AMENDED NOTICE OF APPEAL**," was filed and served on the Director of the United States Patent and Trademark Office by hand delivery at the following address:

Office of the General Counsel
U.S. Patent and Trademark Office
Madison Building East, Room 10B20
600 Dulany Street
Alexandria, Virginia 22314

I also hereby certify that on this 10th day of October 2023, a true and correct copy of the foregoing "**PATENT OWNER'S SECOND AMENDED NOTICE OF APPEAL**" was filed with the Clerk's Office of the United States Court of Appeals for the Federal Circuit, via CM/ECF.

I also hereby certify that on this 10th day of October 2023, a true and correct copy of the foregoing "**PATENT OWNER'S SECOND AMENDED NOTICE OF APPEAL**," was served electronically by email in its entirety upon Petitioner as follows:

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

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Petitioner has consented to service by electronic mail.

Dated: October 10, 2023

By: /Lisa C. Hines/
Lisa C. Hines
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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.

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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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D. Issues Related to the Status of Janevski as Prior Art

Janevski is the primary prior art reference that Petitioner relied upon in its challenges to claims in IPR766 and IPR767. *See* Final Dec. 2–3. Patent Owner asserted that Janevski does not constitute prior art to the challenged claims under § 102(e) because the subject matter of the claims was conceived and actually reduced to practice prior to Janevski’s filing date of December 11, 2001. *Id.* at 11. During the trials, Patent Owner contended that Edward Balassanian and Scott Bradley conceived of the inventions of the patents at least by December 11, 2001. *Id.* at 15. Patent Owner asserted that the inventors communicated the inventions to an internal engineering and development staff, working primarily with engineer Guy Carpenter for implementation.⁴ *Id.* Patent Owner argued that source code corroborated Mr. Balassanian’s testimony concerning the invention’s conception and reduction to practice prior to December 11, 2001. *Id.*

We determined that the evidence was insufficient to establish the conception of the invention and the communication of the invention to Mr.

⁴ The most relevant evidence of record related to these issues is Mr. Balassanian’s declaration testimony that:

Mr. Bradley and I solved the synchronization problem and conceived the inventions set forth in the Claims of the Patents. We then began working on the implementation of the inventions thereafter, as detailed below. We communicated those inventions to BeComm’s internal engineering and development staff to reduce them to practice. We worked primarily with Guy Carpenter, an Engineering Master at BeComm, to implement the inventions, as I describe below.

Ex. 2001 ¶ 33. Also relevant is Mr. Balassanian’s deposition testimony: “Q. Did Guy Carpenter contribute to . . . to any conception of the claims? . . . THE WITNESS: I don’t believe so.” Ex. 1019, 59:9–18.

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Carpenter such that any reduction to practice could inure to the inventors' benefit. *See* Final Dec. 18–22. We therefore found that because Patent Owner failed to meet its burden to demonstrate earlier conception of the invention such that antedating did not apply, Janevski constituted prior art to the challenged claims of the patents under § 102(e). *Id.* at 22. We found the challenged claims unpatentable as anticipated by Janevski or obvious over Janevski, alone or in combination with other prior art. *Id.* at 50.

Since the time of trial, as discussed above, Patent Owner petitioned for and received certificates of correction of inventorship, which name Guy Carpenter as an inventor of the patents in the proceedings. *See* Ex. 2097; Paper 62, 5–6. Below we discuss and evaluate the potential impact the certificates of correction have on the Final Written Decisions in these cases in accordance with the Federal Circuit's Order.

III. DISCUSSION

A. 35 U.S.C. § 256

The parties take differing positions on whether certificates of correction have retroactive effect on inventorship under 35 U.S.C. § 256. Patent Owner argues that the language of the statute strongly indicates that inventorship corrections have retroactive effect because, in contrast to other correction provisions, such as §§ 254 and 255, that “contain an explicit limitation ‘for causes thereafter arising,’ . . . such prospective-bound language is entirely absent from inventorship corrections of § 256.” PO Remand Br. 7 (emphasis omitted). Patent Owner argues that under a plain language analysis of the statute, the legislative intent of these correction provisions is clear: a “Certificate of Correction issued for correction of inventorship has retroactive effect.” *Id.* at 7–8 (quoting *Roche Palo Alto LLC v. Ranbaxy Labs. Ltd.*, 551 F. Supp. 2d 349, 357, 359 (D.N.J. 2008)).

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Patent Owner asserts that, in addition to the language of the statute, case law supports the retroactive effect of inventorship corrections. PO Remand Br. 8–11. For example, Patent Owner contends that in *SIPCO*, the Board analyzed the statutory language of § 256 in view of that of § 255 and found that § 256 has retroactive effect. *Id.* at 8–10 (citing *Emerson Elec. Co. v. SIPCO, LLC*, IPR2016-00984, Paper 52 at 17-21 (PTAB Jan. 24, 2020) (“*SIPCO*”) (citing to *Vikase Corp. v. Am. Nat’l Can Co.*, 261 F.3d 1316, 1329 (Fed. Cir. 2001); *Roche*, 551 F. Supp. 2d at 355)).

Patent Owner also asserts “that § 256 was enacted as a ‘savings Provision’ to attenuate the harsh effects on actual inventors of errors in ascertaining proper inventorship.” PO Remand Br. 11 (citing *Egenera, Inc. v. Cisco Systems, Inc.*, 972 F.3d 1367, 1377 (Fed. Cir. 2020) (“*Egenera*”). Patent Owner asserts that provisions such as § 256 should be given liberal construction in favor of applicants. *Id.* at 12 (citing *Patterson v. Hauck*, 341 F.2d 131, 138 (CCPA 1965)).

Petitioner asserts that a certificate of correction for inventorship cannot be used to cure a finding of invalidity under 35 U.S.C. §§ 102(a), (b), and (e), or 103(a). Pet. Remand Br. 2. More specifically, Petitioner contends that “the statute specifies that correcting inventorship can overcome invalidity if the invalidity arises from the act of misnaming inventors. The act of misnaming inventors invalidates a patent under pre-AIA § 102(f).” *Id.* Petitioner argues that Patent Owner “misreads § 256’s invalidity-savings provision as granting it the right to use changed inventorship to retroactively address any type of invalidity,” but “[t]he language of § 256 does not provide for this.” *Id.* at 3. In support, Petitioner refers to *Egenera*, where the alleged infringer raised an improper inventorship issue under § 102(f) as an invalidity defense. *Id.* (citing

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Egenera at 1372). Petitioner distinguishes other cases, not having to do with inventorship or corrections thereof, from the circumstances here. *Id.* at 5–6.

Petitioner further contends that the operative issue “is not whether § 256 applies retroactively in some scenarios, the question is ‘does it apply retroactively in this scenario?’” Pet. Remand Resp. Br. 1–2 (emphasis omitted). Petitioner asserts that § 256 applies retroactively to misjoinder and nonjoinder of inventors, but here “correction does not remove the basis for invalidity – it has no direct effect on the §§ 102, 103 invalidity grounds here.” *Id.* at 2. Petitioner argues that the case law cited by Patent Owner in its opening remand briefing does not support the retroactive application of § 256. *Id.* at 2–5.

Patent Owner responds by arguing that there are precedential Federal Circuit decisions that addressed the application of § 256 in cases where § 102(f) was not at issue. PO Remand Resp. Br. 2–4. Patent Owner acknowledges that § 102(f) challenges are the most common, but points to the *Riverwood* case, where the Federal Circuit considered the potential application of § 256 under an assessment of prior art under § 102(e). *Id.* at 2–3 (citing *Riverwood Int’l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1356 (Fed. Cir. 2003)). Patent Owner also relies upon a *Google* case, which considered § 256 under an obviousness analysis with § 102(a) prior art. *Id.* at 3 (citing *Google LLC v. IPA Techs, Inc.*, 34 F.4th 1081, 1088 (Fed. Cir. 2022)). Patent Owner argues that “Section 256 is thus not limited to validity challenges under § 102(f) alone.” *Id.*

We begin with the statute. Section 256 states, in relevant part:

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

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requirements as may be imposed, issue a certificate correcting such error.

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.

35 U.S.C. § 256 (emphasis added). In view of the language of the statute, we agree with Patent Owner that it supports the conclusion that a certificate of correction of inventorship should apply retroactively in general. Section 255 states that a certificate of correction “shall have the same effect and operation in law on the trial of actions for causes thereafter arising,” indicating that the certificate shall only be effective after issuance. In contrast, § 256’s statement “shall not invalidate the patent” “if it can be corrected” indicates that the correction of inventorship generally has a retroactive effect. *Id.*; 35 U.S.C. § 255; *see also SIPCO* at 10, 18–21. The interpretation of § 256 to allow for retroactivity is also consistent with the case law on this issue. *See Vikase*, 261 F.3d at 1329; *Roche*, 551 F. Supp. 2d at 357–358; *Riverwood*, 324 F.3d at 1356; *Google*, 34 F.4th at 1088.

As to Petitioner’s arguments, generally, that the retroactive effect of § 256 applies only to 102(f) issues, we do not agree. Consideration of the *Google* case is instructive. In *Google*, the issue the Federal Circuit considered was effect of potential correction of inventorship on whether a reference would be considered prior art under 102(a) under § 256. *Google*, 34 F.4th at 1084, 1088. Similarly, in *Riverwood*, the Federal Circuit considered the potential effect of correction of inventorship to determine whether a reference would be prior art under § 102(e) under § 256. *Riverwood*, 324 F.3d at 1355–56.

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We next turn to Petitioner's assertion that Section 256 should not be applied under the specific circumstances here because of judicial estoppel and waiver.

B. Judicial Estoppel

Petitioner argues that judicial estoppel applies here to preclude the retroactive effect of § 256. Pet. Remand Br. 6–9. Petitioner asserts that judicial estoppel applies against a party when: (1) the party takes a later position that is “clearly inconsistent” with an earlier position; (2) the party succeeds in persuading a court to adopt the earlier position (which thus poses a “risk of inconsistent court determinations”); and (3) the party seeking to assert an inconsistent position would derive an unfair advantage or impose an unfair detriment on the opposing party if not estopped. *Id.* at 7 (citing *Transclean Corp. v. Jiffy Lube Intern., Inc.*, 474 F.3d 1298, 1307 (Fed. Cir. 2007)). Petitioner contends that all three factors are met because Patent Owner asserted that Mr. Balassanian and Mr. Bradley were inventors and communicated the invention to Carpenter for his subsequent reduction to practice, the Board accepted the premise for the purposes of making findings of fact and rulings of law, and Patent Owner now seeks to derive the unfair advantage of revisiting the Final Written Decisions. *Id.* at 7–9.

In response, Patent Owner argues that estoppel factors 1 and 2 do not apply because its previous position was that “Balas[s]annian and Bradley were inventors of valid claims because the work of Mr. Carpenter inured to their benefit,” but Patent Owner did not ““succeed in persuading’ the Board of its position.” PO Remand Resp. Br. 6 (emphasis omitted). Patent Owner asserts that “[b]eing legally wrong, moreover, is not the same as changing factual positions.” *Id.* at 6–7 (emphasis omitted) (citing *Cleveland v. Policy Mgm’t Sys.*, 526 U.S. 795, 802 (1999)).

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Relying on *Egenera*, Patent Owner also contends that “the inventorship analysis can even be informed by a tribunal’s view of the evidence, thereby provoking a subsequent correction petition.” PO Remand Br. 12 (citing *Egenera* at 1376–78). Because contrary inventorship arguments were previously made, but correction was nevertheless permitted in *Egenera*, Patent Owner argues that it “was justified in correcting inventorship notwithstanding what it may have argued prior to the Board’s extensive factfinding regarding Mr. Carpenter and his contributions.” *Id.* Patent Owner also contends that § 256 “does not limit the time during which inventorship can be corrected” and “diligence is not a requirement to correct inventorship under section 256.” *Id.* at 14 (quoting *Stark v. Advanced Magnetics, Inc.*, 119 F.3d 1551, 1554 (Fed. Cir. 1997)) (emphasis omitted).

Petitioner contends that *Egenera* is distinguishable here because “inventorship of Implicit’s patent was not at issue in the IPR proceedings.” Pet. Remand Br. 4. Petitioner asserts that Patent Owner’s decision to pursue change in inventorship was not informed by Board’s view on the evidence on inventorship because “the Board did not conclude, and had no occasion to conclude, that Carpenter was either a proper inventor or that he was improperly omitted,” nor did Patent Owner ever assert during the IPR proceedings that there was an error in inventorship. *Id.*

We begin our analysis with the first factor of judicial estoppel. Here, there is no dispute that Patent Owner’s assertions and evidentiary testimony on the inventorship of the patent, which it raised in the context of its attempt to antedate certain prior art, have changed from the time of the trial to the position now taken on corrected inventorship. More specifically, at trial, Patent Owner explicitly asserted, with the support of the testimony of Mr. Balassanian, that Messrs. Balassanian and Bradley conceived of the

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inventions of the patents and communicated those inventions to an internal engineering and development staff, including Mr. Carpenter, for implementation. Paper 13, 19–20; Ex. 2001 ¶¶ 6, 33, 42, 46; *see also* Ex. 1019, 59:9–18. Patent Owner has now changed its position and has sought and obtained a correction of inventorship to add Mr. Carpenter as an inventor. *See* PO Remand Br. 5–6; Ex. 2097.

We do not agree with Patent Owner’s assertion that it “was justified in correcting inventorship” because “the subsequently filed corrections reflect the Board’s determinations.” *See* PO Remand Br. 12–13. The Final Written Decision analyzed whether there was sufficient evidence in the record to corroborate Mr. Balassanian’s testimony on conception and communication of the invention to Mr. Carpenter. *See* IPR2018-00767, Paper 40, 22 (“In summary, 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.”) (emphasis added); *see also* Final Dec. 19–20 (considering documents to determine if they corroborate conception). That is, the issue addressed in the Final Written Decisions was not the correct inventorship of the patents, but rather the *sufficiency* of corroborating evidence of conception and communication of the invention in order for the inventors to benefit from Mr. Carpenter’s work. *See* Final Dec. 19–20. For instance, the document that eventually served as the provisional application, which appears to have been written by Mr. Carpenter, was considered only to determine whether it corroborated Mr. Balassanian’s testimony. *See id.*

Egenera presents a different situation from that here. In *Egenera*, the district court’s intervening claim construction justified the change in

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inventorship. *Egenera* at 1376–79. The Federal Circuit acknowledged that “[i]nventorship . . . can depend on claim construction,” and once claim construction was decided, “it was entirely consistent for Egenera” to request correction of inventorship. *Id.*; *see also id.* at 1376 (“Ultimately, *inventorship* is a legal conclusion premised on underlying factual findings, and one that *depends on claim construction*.” (citing *In re VerHoef*, 888 F.3d 1362, 1365 (Fed. Cir. 2018); *Trovan, Ltd. v. Sokymat SA*, 299 F.3d 1292, 1302 (Fed. Cir. 2002)) (emphases added)). The Federal Circuit found that “the district court’s intervening claim-construction and inventorship determinations further justify any seeming inconsistency.” *Id.* at 1376, 1379; *see also id.* at 1379 (“[O]nce those issues were decided [‘a [claim] construction that the inventorship question was directly predicated on’], it was entirely consistent for Egenera to request an accompanying formal correction of inventorship.”).

Here, however, Patent Owner has not identified any changed legal determination upon which inventorship depends that justifies setting aside judicial estoppel. The claim construction ruling in *Egenera* was a legal determination that was largely out of Egenera’s control.⁵ Our determination regarding the sufficiency of corroborating evidence, on the other hand, is a factual determination based on the documentary evidence of record as argued by Patent Owner, and which was in the sole control of Patent Owner. *Fleming v. Escort Inc.*, 774 F.3d 1371, 1377 (Fed. Cir. 2014) (“We have treated the sufficiency of corroboration as a question of fact.”). The

⁵ Indeed, Egenera opposed the district court’s construction. *Egenera* at 1379 (“Egenera consistently protested the means-plus-function construction both at the district court and on appeal—a construction that that the inventorship question was directly predicated on.”)

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documentary evidence in the trial record could be consistent with Patent Owner's assertions during trial that Mr. Balassanian and Mr. Bradley conceived of the invention and then communicated that invention to Mr. Carpenter (had there been sufficient corroborating evidence of that communication). That documentary evidence could also be consistent with Patent Owner's current position that Mr. Carpenter was an inventor all along. We made no such determination, however, specifically regarding inventorship in our Final Written Decisions, nor do we make such a determination now. For example, although we noted in our Final Decision that Mr. Carpenter was the apparent author of the document upon which the provisional application was based and also the apparent author of the source code relied upon by Patent Owner (Final Dec. 20), that determination does not mean that Mr. Balassanian and Mr. Bradley were not the correct inventors of the challenged patents, nor does it mean that Mr. Carpenter was an inventor.⁶ Indeed, that Mr. Carpenter authored the document and source code in question is consistent with Mr. Balassanian's testimony that Mr. Carpenter worked on his behalf in implementing the invention. As seen, correct inventorship in this instance does not depend on our determination in the Final Decision regarding the sufficiency of corroborating evidence presented by Patent Owner. Accordingly, *Egenera* is distinguishable from the situation here.

Additionally, Patent Owner sought the change of inventorship post-trial, and as discussed in *Egenera*, the Patent Office examines a change of inventorship request only for the presence of supporting statements and the

⁶ As we note below, we have not determined whether the source code practices the claimed inventions.

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required fee and “[n]o substantive examination occurs, and the PTO does not consider the substantive adequacy of the petition.” *See Egenera* at 1380 (citing 37 C.F.R § 1.324(b); MPEP § 1481.02). Thus, under *Egenera*, the Patent Office’s grant of a certificate of correction “without more, [does not] count[] as ‘persuasion’ . . . for judicial-estoppel purposes,” and is limited to a ministerial, rather than a legal, determination. *Id.*

We are also not persuaded by Patent Owner’s argument that being legally wrong about inventorship is not the same as changing factual positions. PO Remand Resp. Br. 6–7 (citing *Cleveland Policy Mgm’t Sys.*, 526 U.S. at 802). To the extent that Patent Owner is suggesting that its initial identification of named inventors is merely “legally wrong” based on our determinations in the Final Decisions, rather than factually different, we do not agree. The Final Decisions did not make a determination on inventorship, that is, as discussed, the Decisions only addressed whether the documentary evidence corroborated testimonial evidence of conception and communication of the invention. *See* Final Dec. 20. Patent Owner possessed and presented its documentary evidence, including sworn inventorship testimony, in support of its antedating assertions at trial. Patent Owner’s changed position on inventorship therefore, represents a change in factual positions, contrary to its argument. For instance, Mr. Balassanian’s testimonial evidence concerning the conception and reduction to practice of the invention (Ex. 2001 ¶ 33), which formed the basis for our review of the documentary evidential support at trial, is now contrary to the current named inventorship. Patent Owner’s positions are clearly inconsistent—at trial, Patent Owner asserted a certain inventorship, and Patent Owner then sought a different inventorship. Accordingly, the first factor for judicial estoppel is met.

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As to the second factor, whether the party must have succeeded in persuading a court (or agency)⁷ to adopt the earlier position, as discussed above, we started with the testimonial evidence on inventorship presented by Patent Owner at trial and evaluated other evidence in that light. More specifically, the supporting evidence presented to us includes the testimonial evidence of Mr. Balassanian, with that testimony stating, for example, “Mr. Bradley and I solved the synchronization problem and conceived the inventions set forth in the Claims of the Patents,” and “[w]e communicated those inventions to BeComm’s internal engineering and development staff to reduce them to practice.” Ex. 2001 ¶ 33. Based on the testimonial evidence provided, during trial we accepted Patent Owner’s representations as to the inventorship of the subject matter of the patents, and considered whether the documentary evidence provided corroboration of that testimony under a rule of reason—and our associated determinations were directed to the sufficiency of the documentary evidence.⁸ See Final Dec. 18–22.

Moreover, although Patent Owner argues that it did not ““succeed in persuading’ the Board of its position,” (PO Remand Resp. Br. 6)⁹, as

⁷ Below we discuss the issue of whether judicial estoppel can be applied in an IPR administrative proceeding.

⁸ The situation here differs from that in *Egenera*, where the Federal Circuit considered representations made to the PTO under the second factor because the district court relied only on the PTO’s acceptance of representations in the inventorship petition. *Egenera* at 1380. Here, in contrast, the Board directly considered evidence provided to us by Patent Owner, which, as discussed, was part of the trial record.

⁹ In Patent Owner’s Rehearing Request for Director Review, Patent Owner also argued that “The Board’s Decision identified the specific role that Mr. Carpenter played in the process of invention . . . While Implicit argued in the trial proceedings that the work of Mr. Carpenter, as a company employee,

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explained above, the Final Decisions were based on Patent Owner's representations on inventorship—we evaluated the documentary evidence in light of Patent Owner's testimony and arguments on the correct inventorship. “[A] party need not show that the earlier representation led to a favorable ruling on the merits . . . but must show that the court adopted and relied on the represented position either in a preliminary matter or as part of a final disposition.” *Perry v. Blum*, 629 F.3d 1, 11 (1st Cir. 2010); *see also Transclean Corp. v. Jiffy Lube Intern., Inc.*, 474 F.3d 1298, 1307 (Fed. Cir. 2007). Accordingly, the second factor of judicial estoppel is met.

For the third factor, Petitioner argues that Patent Owner is seeking to change the Board's Final Written Decisions and this prejudices Petitioner because it spent resources litigating this matter to resolution. Pet. Remand Br. 9. In opposition, Patent Owner argues that “[a]fter the Board made its determinations,” Patent Owner “saw the need to correct inventorship in order to avoid future § 102(f) assertions.” PO Remand Resp. Br. 7. Patent Owner asserts that “[t]here is nothing ‘unfair’ about exercising a statutory right to correct inventorship commensurate with Board factfinding.” *Id.*

Patent Owner may avail itself of its statutory rights; however, the issue is not the exercise of those rights, but rather whether this results in a detriment to Petitioner. If there were a continuation of these proceedings under changed circumstances, in order to comply with due process and the

ought to inure to the benefit of Messrs. Balassanian and Bradley as named coinventors, the Board rejected this view.” Paper 52, 10. Although Patent Owner's argument suggests some determination of inventorship at trial, that is not accurate. As discussed above, we evaluated the evidence to determine where there was communication of the invention to Mr. Carpenter for implementation, and there was no determination as to whether Mr. Carpenter was, or should have been named, as an inventor. Final Dec. 21.

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Administrative Procedure Act (APA), Petitioner would be permitted the opportunity to respond to the new inventorship theory, likely through additional briefing, as further discussed below. Accordingly, revisiting these proceedings under changed circumstances would require the additional expenditure of resources by Petitioner. Patent Owner's arguments are further premised on an alleged requirement to change inventorship as a result of the findings of the Final Written Decisions. As discussed, however, the Decisions' evaluation of the evidence provided by Patent Owner was limited to determining whether it provided sufficient evidentiary support for antedating. Accordingly, we do not find Patent Owner's arguments persuasive. In view of the detriment and prejudice to Petitioner, the third factor of judicial estoppel is met.

We now turn to the issue of whether judicial estoppel applies in a situation with a Section 256 inventorship correction. Patent Owner argues that “[j]udicial estoppel—as an equitable doctrine—cannot override a curative statute like § 256.” PO Remand Resp. Br. 5. Patent Owner asserts that Section 256 was enacted as a “savings provision” to mitigate the harsh effects of errors on actual inventors. PO Remand Br. 11 (citing *Egenera* at 1377). Patent Owner urges that provisions such as Section 256 “should be given a liberal construction in favor of applicants.” *Id.* at 12 (quoting *Hauck*, 341 F.2d at 138).

We disagree with Patent Owner. In *Egenera*, the Federal Circuit acknowledged judicial estoppel can be applied in the context of an administrative tribunal. *Egenera* at 1380 (“ . . . we agree that judicial estoppel can occur in an administrative tribunal”); *see also id.* n.10 (citing *Trs. v. United States*, 593 F.3d 1346, 1354 (Fed. Cir. 2010) (“Judicial estoppel applies just as much when one of the *tribunals is an administrative*

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agency as it does when both tribunals are courts.”) (emphasis added)). Of note, the Federal Circuit in *Egenera* did not reach the issue of whether “judicial estoppel can *never* prevent § 256 from saving a patent’s validity” because the criteria for judicial estoppel were not met. *Egenera* at 1378; *see also id.* at 1378–1382. The Federal Circuit further held that “[w]e do not go so far as to declare that there would be no potential for judicial estoppel had the Board fully considered and adopted Egenera’s swearing-behind arguments.”¹⁰ *Id.* (emphasis added).

Here, unlike *Egenera*, Patent Owner represented and provided evidence on its asserted correct inventorship directly to the Board. As discussed, Patent Owner asserted and provided evidence that Messrs. Balassanian and Bradley were the inventors of the patents and Mr. Carpenter implemented the invention. Paper 13, 19–20; Ex. 2001 ¶¶ 6, 33, 42, 46; *see also* Ex. 1019, 59:9–18. Patent Owner’s representations were not contested by Petitioner during trial, and Patent Owner’s representations were further consistent with the argument and evidence developed and considered by the Board during trial. Now, Patent Owner’s position on inventorship is inconsistent with its earlier position and Petitioner would be prejudiced absent estoppel. Accordingly, in this particular circumstance, judicial estoppel applies. Judicial estoppel is an equitable doctrine that prohibits a party from taking inconsistent positions in the same or related proceedings and its purpose is “to protect the integrity of the judicial process.”

¹⁰ The Federal Circuit found that there was no unfair advantage to Egenera and no prejudice to the opposing party because the Board considered the opposing party’s prior art without addressing Egenera’s priority arguments, so the change in inventorship “ended up not making a difference.” *Egenera* at 1381.

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Transclean Corp. v. Jiffy Lube Intern., Inc., 474 F.3d 1298, 1307 (quoting *Hossaini v. W. Mo. Med. Ctr.*, 140 F.3d 1140, 1142–43 (8th Cir. 1998)). The application of judicial estoppel is appropriate to hold Patent Owner to its inventorship representations and to the evidence it presented to the Board.

We agree with Petitioner that after Patent Owner was unsuccessful at trial due to the failure of its own evidence, Patent Owner now seeks to have the evidence reconsidered under changed inventorship. Pet. Remand Br. 8–9. Patent Owner had in its sole possession the evidence of inventorship, and we believe that under these circumstances, Patent Owner should be held to the consequences of its choices as to the representations and evidence of antedating that it presented at trial. To hold otherwise would result in prejudice to Petitioner. We consider the potential prejudice to be significant; as discussed, redoing these proceedings would require Petitioner to expend additional resources. Further, under these specific circumstances where Patent Owner has made the inventorship change under its volition, Patent Owner would be afforded the unfair advantage of a “do-over,” absent the application of judicial estoppel.

Accordingly, under these specific circumstances, we determine that judicial estoppel applies precluding Patent Owner from relying on the certificates of correction of inventorship in these proceedings.

C. Waiver

Petitioner contends that waiver provides an independent basis that the certificates of correction should not upset the Final Written Decisions. Pet. Remand Br. 9. Petitioner asserts that Patent Owner “waived the opportunity to argue Carpenter was an inventor by not raising it when it had the chance during the proceeding and, in fact, argu[ed] the opposite – *i.e.*, that

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Carpenter was not an inventor and merely reduced the invention to practice.” *Id.* at 10. Petitioner argues that waiver is the intentional relinquishment of a known right, and that “[i]t is a hallmark of practice before the PTAB that the failure to raise an argument before the Board is a waiver of that argument.” *Id.* (citing, *inter alia*, *VirnetX Inc. v. Apple Inc.*, 665 F. App’x 880, 884 (Fed. Cir. 2016); *Finjan, Inc. v. Cisco Sys., Inc.*, 837 F. App’x 799, 811 (Fed. Cir. 2020)). Petitioner further asserts that Patent Owner “was in possession of all the facts concerning its alleged conception and reduction to practice,” and “specifically chose the argument that Balassanian and Bradley conceived and specifically declined to argue that Balassanian, Bradley, and Carpenter conceived.” *Id.* at 10–11.

Patent Owner argues that waiver does not apply under *Egenera* because “[i]t does not matter that” Patent Owner never tried to change inventorship during the *inter partes* proceeding or failed to timely raise this argument when it had the chance during the proceeding. PO Remand Resp. Br. 5. Patent Owner asserts that it “was permitted to seek inventorship corrections when it did. The Board’s conclusions ‘illuminated Mr. [Carpenter]’s necessary presence as an inventor,’ and timely led to correction petitions.” *Id.* (citing *Egenera* at 1378). Patent Owner contends that Section 256 provides “unique statutory rights” and “is not time-bound.” *Id.*

For reasons similar to the discussion on judicial estoppel, we determine that Patent Owner has waived its assertions on revised inventorship because it failed to present them during the trial in these proceedings. Waiver is the intentional relinquishment of a known right. *In*

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re Google Tech. Holdings LLC, 980 F.3d 858, 862 (Fed. Cir. 2020).¹¹

During the course of trial, Patent Owner was cautioned “that any arguments concerning patentability not raised in the response may be deemed waived.” Paper 11, 5; *see also In re Nuvasive, Inc.*, 842 F.3d 1376, 1379–82 (Fed. Cir. 2016) (holding Patent Owner waived an argument by not raising the argument in the Patent Owner Response). This is consistent with the Board’s Consolidated Trial Practice Guide to waive later arguments when issues are not raised in the patent owner response. Consolidated Trial Practice Guide (Nov. 2019), 52. This is also consistent with the requirement that parties develop their positions through trial and “a party’s argument should not be a moving target.” *Interactive Gift Exp., Inc. v. Compuserve Inc.*, 256 F.3d 1323, 1346 (Fed. Cir. 2001) (quoting *Finnigan Corp. v. Int’l Trade Comm’n*, 180 F.3d 1354, 1363 (Fed. Cir. 1999)).

During the *inter partes* proceedings, Patent Owner had in its sole possession the evidence of inventorship and intentionally presented evidence asserting a certain inventorship. That evidence remained unchanged during the course of the trial. If Patent Owner’s evaluation of its own evidence now justifies a change in inventorship, that evaluation should have also justified such a change during trial when Petitioner had the opportunity to respond to Patent Owner’s changed position. As discussed above, the Final Written Decisions evaluated the sufficiency of the evidence on antedating and did

¹¹ *Google* notes that, although “waiver” and “forfeiture” are commonly used interchangeably, waiver is different than forfeiture. *Google*, 980 F.3d at 862 (“Whereas forfeiture is the failure to make the timely assertion of a right, waiver is the ‘intentional relinquishment or abandonment of a known right.’”). Here, as above, both the criteria of untimeliness and intentionality are met, and therefore both waiver and forfeiture apply. We use the term waiver herein, as that is the terminology typically used in IPR proceedings.

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not reach findings on inventorship¹²—it was Patent Owner who opted later on an untimely basis to seek a change in inventorship and present it as the basis for revisiting determinations of the Final Written Decisions. Further, in this instance, Patent Owner not only waited until after its Patent Owner Response and Sur-reply was filed, but waited until after the trial had already been complete, and an appeal was pending, to seek a certificate of correction. This set of circumstances is more egregious than the typical set of circumstances under which waiver applies in *inter partes* proceedings.¹³

Accordingly, under these specific circumstances, we determine that waiver applies, precluding Patent Owner from relying on the certificates of correction of inventorship in these proceedings.

¹² As discussed above, we disagree with Patent Owner that the findings in the Final Written Decisions “illuminated” the issue of inventorship. That is, Mr. Carpenter’s apparent authorship of the document that eventually served as the provisional application is consistent with Patent Owner’s argument and testimony at trial that Mr. Carpenter implemented the inventions alleged to be conceived by Messrs. Balassanian and Bradley. Further, as discussed, we evaluated the evidence for communication of the invention to Mr. Carpenter for implementation, but there was no determination as to whether Mr. Carpenter was, or should have been named, as an inventor. *See* Final Dec. 21.

¹³ Although waiver was not at issue in *Egenera*, we note that the circumstances here are also distinct from those in *Egenera* where Patent Owner changed inventorship under § 256 during the district court proceeding and during a time when the opposing party would have the opportunity to address the new inventorship position had the court adopted it. *See Egenera* at 1371–72.

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C. Impact Of Certificates of Correction on Final Written Decisions

For the foregoing reasons, we determine that judicial estoppel and waiver apply. Accordingly, the certificates of correction for inventorship have no impact on the Final Written Decisions in these cases.

We also note that if judicial estoppel and waiver had been found not to apply and these proceedings were recommenced under changed inventorship, Petitioner should be permitted the opportunity to respond to Patent Owner's new inventorship of the patents-at-issue at least by being allowed additional briefing in order to comply with due process and the Administrative Procedure Act (APA). *See* Pet. Remand Br. 1. Additionally, if judicial estoppel and waiver had been found not to apply, we also would likely have to determine whether the source code evidence, in view of the related testimonial evidence and argument that is already in the trial record, supports the actual reduction to practice prior to Janevski's effective date, as Patent Owner argues it does. *See* Paper 13, 28–31; Paper 22, 12–22. Amongst other things, this determination would likely entail resolving a claim construction dispute between the parties that may affect the determination of whether the source code practices the claimed invention. *See* Paper 22, 15–16.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's certificates of correction of inventorship have no impact on the Final Written Decisions.

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