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The Precedent: Federal Circuit Applies Forfeiture to Section 256 Correction Theory in *Implicit, LLC v. Sonos, Inc.*

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In this edition of *The Precedent*, we outline the decision in *Implicit, LLC v. Sonos, Inc.*

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Overview

In *Implicit, LLC v. Sonos, Inc.*, the Federal Circuit affirmed the Patent Trial and Appeal Board's decision on remand that certificates of correction adding a new co-inventor had no impact on its earlier unpatentability rulings. The Federal Circuit held that *Implicit* forfeited its new antedating theory based on the added co-inventor because it could have raised that theory from the start of the *inter partes* review ("IPR") but did not do so until after losing on the merits.

Issues

1. Can a patentee rely on a late-obtained inventorship correction under 35 U.S.C. § 256 to support a new antedating or priority theory after the Board has already issued final written decisions?
2. Did the Board abuse its discretion in treating *Implicit*'s new theory as forfeited?

Holdings

1. A Section 256 correction does not automatically reopen issues. The Board may apply forfeiture where the patentee had the evidence and a full opportunity to present a theory earlier but waited until after an adverse decision to do so.
2. The Board did not abuse its discretion. *Implicit* had all the information about the allegedly omitted inventor from the beginning and intentionally pursued only one inventorship and priority theory during the IPRs.

Background and Reasoning

Implicit owned two related patents that were submitted for IPR by Sonos. During the IPRs, it defended against Sonos's prior art by arguing that an engineer named Carpenter's work inured to the benefit of the originally named inventors, allowing Implicit to antedate a key reference. The Board rejected that argument and issued final written decisions finding all challenged claims unpatentable.

After the initial appeal was remanded for Director review under *Arthrex*, and after Implicit requested such review, Implicit sought and obtained certificates of correction under 35 U.S.C. § 256 to add Carpenter as a co-inventor on the two patents. Following a denial of Director review and issuance of the certificates of correction, the Federal Circuit, again, remanded Implicit's appeal to the Board to answer what, if any, impact the certificates of correction would have on the Board's final written decision.

The Board determined that Implicit was precluded from relying on the certificates of correction of inventorship in the IPR proceedings as a basis for undoing the Board's final written decision. It treated Implicit's new theory as forfeited and concluded that the certificates had no effect on the final written decisions. On appeal, the Federal Circuit agreed that forfeiture could apply even when a patent has been corrected under Section 256.

The Federal Circuit emphasized that, in an IPR, parties are expected to present their theories in a timely manner. Although Section 256 allows inventorship correction at any time, that does not guarantee that a newly corrected inventorship theory can be raised after the fact to undo an IPR outcome.

The Federal Circuit noted that Implicit had all of the relevant information about Carpenter and his contributions during the original IPR proceedings. Implicit's original theory was that Carpenter's work inured to the previously named inventors, not that he was a co-inventor. Implicit chose not to pursue a co-inventorship theory until after the Board had already rejected its antedating arguments and issued its decisions.

The Federal Circuit distinguished this from situations where a new legal development, such as a claim construction, justifies a change in inventorship theory. Here, there was no such intervening change. The Federal Circuit saw nothing in the record to suggest that Implicit could not have argued Carpenter's co-inventorship from the start.

The Federal Circuit also pointed out that the Board's treatment of Implicit's new theory as forfeited was consistent with the general principle that arguments not presented in a timely way at the Board are lost. The key was that Implicit had a fair opportunity to raise its theory and chose not to.

Takeaway

This decision underscores that while Section 256 allows inventorship corrections at any time, patentees cannot assume that such corrections will justify reconsideration or the addition of new theories long after final written decisions. Parties should present all plausible inventorship and priority theories during the IPR itself. Holding back a theory in the hope of a second chance is likely to be treated as forfeiture.