

Fed. Circ. In March: IPR And The Limits Of Retroactivity

By **Sean Murray and Jeremiah Helm** (April 30, 2026)

*This article is part of a monthly column that highlights an important recent patent appeal. In this installment, we examine the Federal Circuit's ruling in *Implicit LLC v. Sonos Inc.**

Although attorneys are generally comfortable with them, laws and actions that have retroactive effect are at odds with the common sense that prevails in the real world. In the real world, if you crash your car, there is no reset button that can rescue it from the scrap heap. But in the legal world, it is sometimes possible to correct mistakes so completely it's as if they never happened.

The U.S. Court of Appeals for the Federal Circuit addressed the limits of retroactivity in its recent decision, *Implicit LLC v. Sonos Inc.* There the court considered Implicit's attempt to erase a loss in inter partes review proceedings by retroactively correcting the two invalidated patents. The Federal Circuit ruled that, even though the retroactive correction theoretically should have changed the outcome of the IPRs, thereby saving Implicit's patents from invalidation, Implicit had forfeited the right to rely on the correction.

The saga began when Implicit sued Sonos for patent infringement in March 2017. A year later, Sonos petitioned for inter partes review of Implicit's patents. The duration of the parties' IPR dispute — eight years from the filing of the petitions to the Federal Circuit's final decision in March 2026 — shows that these were no ordinary IPRs. Many IPRs can be wrapped up in two and a half years through appeal.

The Patent Trial and Appeal Board issued written decisions invalidating Implicit's patents in September 2019. The board ruled that the challenged claims were unpatentable over a December 2011 Janevski patent.

Implicit had argued that the claimed inventions had been reduced to practice before December 2011 by an engineer working at their direction. But the board found that, while the documentary evidence showed that the engineer wrote the software code, no documentary evidence corroborated the testimony of the named inventors that, prior to December 2011, they conceived the invention and communicated it to the engineer so that he could reduce it to practice on their behalf. Implicit therefore failed to prove an invention date prior to Janevski.

In 2019, the Federal Circuit issued its decision in *Arthrex Inc. v. Smith and Nephew Inc.*, in which the court vacated a board decision because the patent judges on the board were principal officers under the appointments clause of the U.S. Constitution. The court remanded so that the IPR proceedings could be held before a properly constituted board panel. The following month, Implicit appealed the board's final decisions to the Federal Circuit and argued that the decisions should be vacated and remanded under *Arthrex*. The Federal Circuit did exactly that.

In June 2021, before the proceedings on remand concluded, the U.S. Supreme Court affirmed the *Arthrex* decision and ruled that the appropriate remedy was to ensure



Sean Murray



Jeremiah Helm

that IPR parties have an opportunity to seek director review of the board's final written decisions. In November 2021, the Federal Circuit then remanded the Sonos-Implicit matters for the limited purpose of allowing Implicit to petition for director review.

In December 2021, while on remand, Implicit requested that the USPTO correct the inventorship of its patents to add Guy Carpenter as an inventor. The USPTO granted that request and issued certificates of correction in August 2022.

This tactic was brilliantly conceived. The documentary evidence did not indicate that Carpenter was acting on behalf of the named inventors, so Implicit simply added him as an inventor. This meant Implicit did not need to prove that the named inventors communicated their invention to Carpenter, so that his work could inure to their benefit. Carpenter became a co-inventor, and his work counted as a reduction to practice prior to Janevski's invention in December 2011.

Best of all, correction of inventorship under Title 35 of the U.S. Code, Section 256, is retroactive to the issuance of the patent. This meant that Carpenter had actually been a named inventor when the board ruled that Implicit's patents were invalid. Implicit therefore could argue that the IPR proceedings should be redone under the newly correct facts.

The certificates of correction issued in August 2022, while the Federal Circuit was considering Implicit's appeal from the director's denial of its petitions for director review. The Federal Circuit remanded again, this time for the purpose of having the board determine what effect the certificates of correction should have on the Implicit-Sonos cases. In September 2023, the board ruled that, while correction of inventorship is retroactive, Implicit could not rely on the certificates to revisit the final written decisions. Implicit then appealed to the Federal Circuit for a third time.

The Federal Circuit affirmed. Relying on precedent from the patent-interference context, the court held that the board did not abuse its discretion in ruling that Implicit had forfeited its right to make new antedating arguments based on the certificates by failing to diligently seek correction of inventorship.

The Federal Circuit noted that, unlike in its 2025 ruling in *Egenera Inc. v. Cisco Systems Inc.*, on which Implicit relied, no claim-construction ruling that altered the scope of the claims justified Implicit's mid-litigation effort to seek correction of inventorship. The court also suggested that Implicit's delay raised concerns of "sandbagging," where Implicit could strategically suggest the board take a particular course and later argue that course constituted reversible error.

The Implicit decision is interesting for many reasons. First, by deciding the forfeiture question under the abuse-of-discretion standard, the court, which many perceive to have become more skeptical of patents, has given more latitude to a U.S. Patent and Trademark Office that has recently become increasingly pro-patent. This continues a trend we have seen in the context of mandamus challenges to the USPTO's discretionary denial of IPR petitions.

Second, the Implicit decision should disabuse any idealists in the bar of the notion that an adjudicator will necessarily act upon late-arising facts in the search for the truth of the case before them. Legal proceedings are based on the evidence and arguments that the parties properly and timely present to the tribunal. In this case, the documents reviewed by the board suggested that Guy Carpenter really was an inventor and, therefore, that Janevski was not prior art. The USPTO's decision to correct inventorship further supports this view of

the facts. But Implicit forfeited the right to make that argument and establish those facts by waiting too long. Forfeiture is a risk that cannot be overcome by marshaling evidence after the fact.

Finally, the Implicit decision highlights the risks associated with relying on a clever argument — even a very clever argument — to get a second bite at the apple. Like everyone else, judges have a sense that this is unfair and are likely to prevent it from happening. Indeed, the core of doctrines like waiver and forfeiture is that it would not be fair to either the trial court or the opposing party for the appellate court to consider new arguments and evidence. The tell in this case was the patentee's effort to change the record after losing, a clever shot that nevertheless missed the mark.

Sean Murray and Jeremiah Helm are partners at Knobbe Martens.

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