

No. 20-

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IN THE

**Supreme Court of the United States**

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MINERVA SURGICAL, INC.,

*Petitioner,*

v.

HOLOGIC, INC., CYTYC SURGICAL PRODUCTS, LLC,

*Respondents.*

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**On Petition for a Writ of Certiorari  
to the United States Court of Appeals  
for the Federal Circuit**

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**PETITION FOR A WRIT OF CERTIORARI**

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## QUESTION PRESENTED

In the Patent Act, Congress established that invalidity is a “defense[] in *any* action involving the validity or infringement of a patent.” 35 U.S.C. § 282(b) (emphasis added). There is no textual exception to this command. The Federal Circuit nonetheless applies a judge-made “equitable” exception to the statute’s unqualified language known as “assignor estoppel.” Assignor estoppel prevents an inventor who has assigned a patent from later contesting the patent’s validity.

The question is whether a defendant in a patent infringement action who assigned the patent, or is in privity with an assignor of the patent, may have a defense of invalidity heard on the merits.

**PARTIES TO THE PROCEEDING AND RULE  
29.6 STATEMENT**

Petitioner Minerva Surgical, Inc. (“Minerva”) has no parent corporation. Boston Scientific Corporation, a publicly traded company, holds 10 percent of Minerva’s stock. No other publicly held company owns 10 percent or more of Minerva’s stock.

Respondents are Hologic, Inc. and Cytoc Surgical Products, LLC.

### **RELATED PROCEEDINGS**

There are no proceedings directly related to this case within the meaning of Rule 14.1(b)(iii). Other proceedings that are not directly related to this case but involve the same parties are:

*Minerva Surgical, Inc. v. Hologic, Inc. et al.*, No. 1:18-cv-00217-JFB-SRF (D. Del.);

*Hologic, Inc. et al. v. Minerva Surgical, Inc.*, No. 1:20-cv-00925-JFB-SRF (D. Del.).

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## PETITION FOR A WRIT OF CERTIORARI

The Patent Act makes invalidity a defense in “any action” for patent infringement. 35 U.S.C. § 282(b). Yet the Federal Circuit has decided that invalidity is *not* a defense in a patent infringement action brought against an inventor who previously assigned the patent or those in privity with the assignor of the patent. This judge-made doctrine, known as “assignor estoppel,” is contrary to the Act’s clear text and to this Court’s repeated command that courts “should not read into the patent laws limitations and conditions which the legislature has not expressed.” *Bilski v. Kappos*, 561 U.S. 593, 602–04 (2010). Assignor estoppel undermines, rather than serves, patent law values. Nonetheless, the Federal Circuit not only has continued to apply this textually groundless doctrine, it has expanded it at every opportunity.

The doctrine’s persistence in the Federal Circuit cannot mask its controversial status. Indeed, despite the fact that the Federal Circuit’s exclusive jurisdiction in patent-law cases prevents patent-law issues from presenting traditional “circuit splits,” there is a very real split of authority regarding assignor estoppel. The Federal Circuit recently ruled that assignor estoppel does *not* bar an assignor (or those in privity with an assignor) from challenging the validity of a patent in an *inter partes* review proceeding. *Arista Networks, Inc. v. Cisco Sys., Inc.*, 908 F.3d 792, 803–04 (Fed. Cir. 2018). As Judge Stoll remarked in this case, that leaves the Federal Circuit’s approach to assignor estoppel at odds with itself. Pet. App. 31a–32a. Moreover, decades ago, in *Lear, Inc. v. Adkins*, 395 U.S. 653 (1969), this Court rejected assignor estoppel’s cousin, licensee estoppel (which bars a licensee of a patent from challenging the patent’s invalidity). After that

ruling, which occurred before the Federal Circuit was created, the Ninth Circuit and numerous district courts observed that *Lear* signaled the end of assignor estoppel as well. *Coastal Dynamics Corp. v. Symbolic Displays, Inc.*, 469 F.2d 79, 79 (9th Cir. 1972) (per curiam); see, e.g., *Interconnect Planning Corp. v. Feil*, 543 F. Supp. 610, 613 (S.D.N.Y. 1982); *Marvacon Indus., Inc. v. Thermacon Indus., Inc.*, No. 79/1121, 1980 WL 30274, at \*4–5 (D.N.J. May 28, 1980). Federal Circuit judges have remarked that they believe the doctrine merits reconsideration, but have taken the view that the Federal Circuit is powerless to eliminate the doctrine under this Court’s precedents. See *Mentor Graphics Corp. v. EVE-USA, Inc.*, 870 F.3d 1298, 1305 (Fed. Cir. 2017) (Moore, J., concurring in denial of panel rehearing). There is no reason to believe the Federal Circuit will, on its own, revisit assignor estoppel. This Court’s review is necessary.

Assignor estoppel has no more of a place in district court litigation than it does in *inter partes* reviews. In addition to being contrary to the Patent Act’s text, it undermines the patent law’s crucial public purposes. Assignor estoppel singles out a class of individuals—inventors, who are likely well positioned to expose a patent’s flaws or highlight the way an assignee has asserted a patent beyond its legitimate scope—and bars them from challenging validity. The result is that bad patents stand and frustrate legitimate competition. This Court has long “emphasiz[ed] the necessity of protecting our competitive economy by keeping open the way for interested persons to challenge the validity of patents which might be shown to be invalid.” *Edward Katzinger Co. v. Chi. Metallic Mfg. Co.*, 329 U.S. 394, 400–01 (1947). Invalidity challenges thus serve not only private interests, but those of the public as well. *Id.* To protect the public interest in eliminating bad

patents, this Court has time and again “remov[ed] . . . restrictions on those who would challenge the validity of patents.” *Blonder-Tongue Labs., Inc. v. Univ. of Ill. Found.*, 402 U.S. 313, 344–45 & n.42 (1971) (collecting cases); see also *Kimble v. Marvel Entm’t, LLC*, 135 S. Ct. 2401, 2407 (2015). Assignor estoppel should be the next such restriction to fall.

Even if this Court declines to eliminate assignor estoppel entirely, it should still accept review to define its very limited contours. According to the Federal Circuit, the doctrine is intended to prevent “unfairness and injustice” by barring someone who “assigned the patent rights to another for valuable consideration . . . from defending patent infringement claims by proving that what he assigned was worthless.” *Diamond Sci. Co. v. Ambico, Inc.*, 848 F.2d 1220, 1224, 1226 (Fed. Cir. 1988). Even if that were a legitimate basis to read a limitation into the unqualified text of the Patent Act, that rationale would provide no basis for the ways the Federal Circuit has expanded the doctrine. See Mark A. Lemley, *Rethinking Assignor Estoppel*, 54 *Hous. L. Rev.* 513, 519–24 (2016).

This case provides a perfect vehicle for considering whether to abandon or limit assignor estoppel. The Federal Circuit expanded assignor estoppel in this case to bar petitioner Minerva from raising invalidity defenses that arose only because the ultimate assignee of the patent rights, respondent Hologic, had *broadened the scope* of the patent beyond anything the inventor had claimed. Minerva’s invalidity defense was based solely on Section 112’s written description and enablement requirements. The Federal Circuit had never before applied assignor estoppel to that kind of invalidity defense, and there is no reason why it should. The defense does not assert that what the inventor “assigned was worthless.” Rather, the defense

was based on the fact that more than ten years *after the inventor assigned the patent*, Hologic learned that the inventor had developed wholly new technology that could compete with and outperform Hologic's product embodying the assigned patent. So Hologic took the old assigned patent specification, drafted and prosecuted a new patent claim broader than what the inventor had claimed or assigned, and wielded that claim against Minerva. Minerva's invalidity defense did not assert that what the inventor had originally assigned many years earlier lacked value. Hologic has obtained value from those patents for years. Minerva asserted only that Hologic's *expansion* of what the inventor had assigned was an improper attempt to widen Hologic's patent monopoly. Barring Minerva from presenting that defense advances no patent policy, and frustrates the goal of preventing bad patents from impeding legitimate competition.

Two years ago, this Court called for the views of the Solicitor General in a case asking this Court to review the Federal Circuit's assignor estoppel law. *EVE-USA, Inc. v. Mentor Graphics Corp.*, 138 S. Ct. 1608 (Apr. 23, 2018) (No. 17-804). That case settled prior to this Court's disposition of the petition. This Court's review of the Federal Circuit's ever-expanding judge-made assignor estoppel rule, contrary to the Patent Act, is now clearly needed. It is time for this Court to declare that assignor estoppel is dead. At a minimum, the Court should constrain the doctrine. When, as here, the assignee seeks to bar a challenge based on written description and enablement to an assignee's expansion of a patent after assignment, assignor estoppel should not apply.

## OPINIONS BELOW

The Federal Circuit’s opinion is reported, 957 F.3d 1256, and is reproduced at Pet. App. 1a–32a. The unreported order denying the petition for rehearing and rehearing *en banc* is reproduced at Pet. App. 79a–80a. The district court’s grant of summary judgment on assignor estoppel is reported, 325 F. Supp. 3d 507, and is reproduced at Pet. App. 33a–78a.

## JURISDICTION

The Federal Circuit entered its judgment on April 22, 2020, Pet. App. 1a, and denied a timely-filed petition for rehearing and rehearing *en banc* on July 22, 2020, Pet. App. 80a. This Court has jurisdiction over this petition pursuant to 28 U.S.C. § 1254(1).

## STATUTORY PROVISIONS

35 U.S.C. § 282(b) provides:

(b) Defenses.—The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

(1) Noninfringement, absence of liability for infringement or unenforceability.

(2) Invalidity of the patent or any claim in suit on any ground specified in part II as a condition for patentability.

(3) Invalidity of the patent or any claim in suit for failure to comply with—

(A) any requirement of section 112, except that the failure to disclose the best mode shall not be a basis on which any claim of a patent may be canceled or held invalid or otherwise unenforceable; or

(B) any requirement of section 251.

(4) Any other fact or act made a defense by this title.

35 U.S.C. § 282(b).

35 U.S.C. § 112(a) provides:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

35 U.S.C. § 112(a).

### STATEMENT OF THE CASE

1. In the 1990s, Csaba Truckai invented a medical device for treating a common and serious medical problem: Abnormal Uterine Bleeding, or AUB. One treatment option for AUB is a procedure called endometrial ablation. The procedure ablates (*i.e.*, destroys) the endometrial lining of the uterus with the goal of stopping or at least significantly reducing bleeding. Truckai's device was designed for use in endometrial ablations.

Truckai filed a provisional patent application relating to his invention in 1998. The key to his innovation—as claimed in the patent and as described in its title, abstract, summary, and every embodiment—was that the device's applicator head was moisture-permeable and designed to transport moisture out of the patient's uterine cavity during the ablation treatment.

As the patent specification explains, moisture retained at the ablation site posed problems during the ablation procedure for previous endometrial ablation methods. Heating tissue to ablate it causes the tissue to release moisture. Early endometrial ablation devices created an extremely conductive liquid layer which could cause uncontrolled ablation well beyond the intended depth. Steam could also build up and force itself into surrounding tissue, causing embolism or unintended burning. Truckai's invention solved these problems "[b]y shunting moisture away from the ablation site and thus preventing liquid build-up." The moisture transport feature cannot function if the device's applicator head is not moisture permeable.

The patent's title is "Moisture Transport System for Contact Electrocoagulation." Its abstract states that the apparatus includes a "fabric electrode array which is substantially absorbent and/or permeable to moisture" and that "[t]he moisture permeability and/or absorbency of the electrode carrying member allows the moisture to leave the ablation site." The summary explains that the "present invention . . . includes a fluid permeable elastic member" and "[d]uring use, . . . moisture generated during dehydration is actively or passively drawn into the array and away from the tissue."

Truckai prosecuted a family of patents from his "Moisture Transport" specification, all of which included language in the patent claims expressly limited to moisture-permeable applicator heads. Truckai assigned those patents in 1998, along with the right to continuation patents, to Novacept, a company he founded. Novacept went on to develop and obtain FDA approval for a device embodying the patents in 2001, two years after Truckai had ceased any day-to-day operation of the company.

Novacept was acquired by Cytoc Corporation in 2004 and Hologic acquired Cytoc Corporation more than three years later. Hologic has for many years and still today sells a device which embodies these patents. The device has generated billions of dollars in revenue for Hologic.

In 2008, a decade after Truckai assigned his moisture transport patents to Novacept, he invented a new device which creates and uses plasma—never before used in this context—as the heat source in endometrial ablation. Unlike his prior invention, this device’s applicator head is and must be *impermeable* to moisture. Indeed, it is designed to use moisture retained at the ablation site to achieve significantly better outcomes for patients. Truckai assigned the patent for this device to Minerva, a company he founded. It took years of experimentation to get the mechanism to work and to obtain FDA approval for the new device. Minerva finally obtained FDA approval in July 2015, years after Truckai had resigned from the company.

The applicator head on Minerva’s new device is a sealed, highly engineered silicone balloon filled with argon gas. When ionized with radio-frequency power, the gas turns into plasma that heats the silicone membrane. The applicator head must be impermeable to liquid because if it were not, the reaction necessary to generate heat inside the silicone balloon would fail. The plasma heats the silicone membrane from the inside, and thermal energy then ablates the surrounding tissue. The plasma in the applicator head does not apply constant energy across all uterine tissue at once. Instead, plasma filaments jump around the applicator head, drawn to the most conductive—which turns out to be the least ablated—areas of the tissue. This fo-

cused energy allows the new device to provide a gentler and more uniform ablation using as little as a quarter of the energy used by Hologic's device.

The lower power level and the electrical parameters with which it is delivered produces a much smaller amount of steam during ablation—not enough to cause the uncontrolled thermal ablation that had plagued earlier ablation devices. In addition, because the applicator head is impermeable to liquid, the moisture released from the tissue during the ablation is retained at the ablation site and is heated by the applicator head. That retained, heated fluid improves tissue ablation because the endometrium, the tissue that lines the uterine cavity, is not smooth and flat. It is composed of millions of tiny folds of tissue. The heated moisture is able to reach and ablate the lining of those otherwise inaccessible folds.

The FDA-approved success rate for Truckai's new device is 93%, far higher than the FDA-approved success rate for Hologic's device of 77.7%. It completely stops bleeding 73% of the time, twice as often as Hologic's device.

In 2013, Truckai obtained U.S. patents covering this latest innovation. Truckai disclosed to the patent office his prior patents, now owned by Hologic, as prior art.

Truckai hoped that Hologic—which had dominated the market for a decade using Truckai's prior invention—would invest in, or acquire, his new innovation. To that end, Minerva disclosed the new device to Hologic in the context of ongoing acquisition discussions. But instead of investing in or acquiring Truckai's new invention, Hologic filed a patent application in 2013. This was a continuation application that used the same "Moisture Transport" specification from Truckai's old, long-ago assigned patents. As noted

above, those patents all specifically limited their claims to a moisture permeable applicator head. And the specification describes an applicator head that is moisture permeable as essential to the invention in all of its title, abstract, summary, and every embodiment. Nonetheless, Hologic sought and received from the patent office a patent claim which did not describe the applicator head as moisture permeable. That patent, U.S. Patent No. 9,095,348 (“the ’348 patent”), issued in August 2015, and it included a claim that said nothing about the applicator head being either moisture permeable or impermeable. This was the first time a patent issued from Truckai’s more than 15-year-old specification claiming an applicator head without explicit permeability-related limitations.

2. Armed with its newly expanded patent claim, Hologic rushed to court. It sued Minerva (which produces Truckai’s new device) in November 2015, accusing Truckai’s new device of infringing the ’348 patent.

Among other defenses, Minerva asserted that the ’348 patent is invalid. Minerva pressed this challenge after the district court agreed with Hologic that the ’348 patent’s new broad language must be construed to broadly cover devices with either moisture permeable or impermeable applicator heads.

Minerva’s invalidity arguments arose from Hologic’s broadening of the patent claim to cover devices with a moisture impermeable applicator head. Minerva asserted that the ’348 patent was invalid for lack of enablement and lack of written description because Truckai’s 15-year-old specification neither describes a non-permeable applicator head nor teaches how to use a non-permeable applicator head without causing precisely the problems that the specification says the patent was designed to solve. In fact, Minerva argued,

the '348 patent could not describe or enable such a device, because, as Truckai was well aware, no such device had been invented when he wrote the '348 patent's specification.

Hologic responded with, among other things, assignor estoppel. According to Hologic, Minerva could not argue that the '348 patent is invalid because Minerva was in privity with Truckai, and no party in privity with Truckai could challenge the validity of *any* patent obtained from Truckai's 1990s specification.

The district court agreed with Hologic and concluded that assignor estoppel barred Minerva from asserting invalidity of the '348 patent. Pet. App. 58a, 63a. The district court also considered the invalidity arguments in the alternative. It concluded that Minerva's arguments failed as a matter of law, though it identified no disclosure in the specification of a moisture impermeable applicator head, no explanation in the specification that a device with a moisture impermeable applicator head could solve the problems of moisture build-up at the ablation site, and it offered no explanation for how a device with a moisture impermeable applicator could incorporate a "moisture transport system," as the patent is titled. *Id.* at 62a–64a. The district court simply treated its *claim construction* ruling, which read the patent's claims broadly to cover moisture impermeable applicator heads, as foreclosing Minerva's *invalidity* argument. *Id.* at 58a, 63a. But nothing in the Court's reasons for construing the claims broadly undermined much less contradicted Minerva's invalidity arguments. Ultimately, the district court went on to find that Minerva infringed the '348 patent as a matter of law. *Id.* at 71a–74a.

3. Minerva appealed, urging the Federal Circuit to abandon assignor estoppel and arguing that, even if assignor estoppel were retained, the doctrine should

not apply here. The rationale for the doctrine was to prevent assignors from later asserting that what they had assigned was worthless. But Minerva never asserted that what Truckai assigned was worthless. It was instead challenging the assignee's (Hologic's) later unsupported expansion of the scope of the patent claims.

The Federal Circuit affirmed the district court's ruling that assignor estoppel prevented Minerva from asserting any invalidity defenses. Pet. App. 17a–20a. The Federal Circuit recognized that when this Court has addressed assignor estoppel it has done so to “carve[] out exceptions to the general assignor estoppel doctrine,” but it concluded that this Court “did not abolish the doctrine.” *Id.* at 11a. The Federal Circuit reaffirmed “the continued vitality of the doctrine of assignor estoppel after *Lear*.” *Id.* at 17a (quoting *Mentor Graphics Corp. v. EVE-USA, Inc.*, 851 F.3d 1275, 1283 (Fed. Cir. 2017)). The Federal Circuit asserted that there is an “important distinction . . . between assignors and licensees” because, unlike a licensee, who “might be forced to continue to pay for a potentially invalid patent, the assignor who would challenge the patent has already been fully paid for the patent rights.” *Id.* at 12a (quoting *Diamond Sci.*, 848 F.2d at 1224).

The Federal Circuit parroted its prior reasoning that “it is the implicit representation by the assignor that the patent rights that he is assigning (presumably for value) are not worthless that sets the assignor apart from the rest of the world and can deprive him of the ability to challenge later the validity of the patent.” Pet. App. 12a–13a (quoting *Diamond Sci.*, 848 F.2d at 1224). Yet the Federal Circuit did not deny that Minerva's invalidity arguments—against Hologic's overbroad patent claim obtained in 2015—did not call into

question any “implicit representation” by Truckai in 1998 that what he was assigning then had value. The Federal Circuit did not even consider whether any such “implicit representation” could or should bar the specific invalidity challenge Minerva raised here.

According to the Federal Circuit, Minerva could challenge Hologic’s broadening of the patent’s claims after assignment, but only by “introduc[ing] evidence of prior art to narrow the scope of” the claim “so as to bring [Minerva’s] accused product ‘outside the scope of” the claim. Pet. App. 20a (quoting *Diamond Sci.*, 848 F.2d at 1226). But Minerva’s argument was not that prior art should narrow the scope of Hologic’s broad patent. Minerva maintained that Hologic impermissibly broadened the patent many years after Truckai’s assignment.

Having ruled that Minerva’s invalidity arguments were barred by assignor estoppel, the Federal Circuit refused to consider Minerva’s invalidity arguments. The infringement judgment and millions of dollars in damages stood even though no court had ever explained how the ’348 patent could validly cover a device that uses an impermeable applicator head, when that patent’s specification repeatedly and without fail describes and requires a moisture permeable applicator head to work.

Judge Stoll wrote separately to encourage the Federal Circuit “to consider *en banc* the doctrine of assignor estoppel.” Pet. App. 32a. Judge Stoll noted that the Federal Circuit had created an “odd and seemingly illogical regime in which an assignor cannot present any invalidity defenses in district court but can present a limited set of invalidity grounds in an IPR proceeding.” *Id.* at 31a–32a (citing *Arista Networks, Inc.*, 908 F.3d at 803–04). “In *Arista*,” the Federal Circuit

“held that the judge-made doctrine of assignor estoppel does not apply in the context of an *inter partes* review.” *Id.* at 31a. But “[a]t the same time,” the court “continue[s] to bar assignors from challenging in district court the validity of the patents they assigned.” *Id.*

Minerva timely petitioned for rehearing and rehearing *en banc*. After receiving a response to the petition, the Federal Circuit denied it on July 22, 2020. Pet. App. 80a.

### **REASONS FOR GRANTING THE PETITION**

Assignor estoppel finds no support in the statute, this Court’s decisions, or the policies the Patent Act serves. The doctrine presents as close to a traditional “split of authority” requiring this Court’s intervention as a patent law issue can present. And this case presents an ideal vehicle to examine the doctrine and either abandon it entirely or tightly constrain its application. For each of these reasons, this Court should grant the petition.

This Court did not create assignor estoppel, and every time it has considered the doctrine, it has narrowed the doctrine and ruled against its application. Nonetheless, the Federal Circuit has persistently expanded assignor estoppel, unmooring it from any rationale. It is time for this Court to put a halt to the Federal Circuit’s disregard of the statutory command to allow defendants in *any* patent lawsuit to assert invalidity as a defense. The Federal Circuit already acknowledged that a similar statutory command requires rejecting assignor estoppel in *inter partes* review proceedings. There is no reason to believe Congress wanted to create a dual-track system that shields patents from an assignor’s legitimate invalid-

ity defenses in district court litigation but allows assignors to raise those defenses in the Patent Office. Assignor estoppel should be discarded, just as this Court discarded the closely related doctrine of licensee estoppel.

This case presents an ideal vehicle for this Court to consider assignor estoppel. It is hard to imagine a case that better exemplifies how the doctrine stifles innovation at the public's expense, while serving no equitable end. Minerva was barred from showing that Hologic obtained invalidly overbroad patent claims out of Truckai's specification—even though Hologic sought and obtained those claims *years after Truckai had assigned his invention*. Hologic's efforts impeded Truckai from bringing his further innovation to market, an innovation that offers materially improved results to patients over Hologic's product embodying Truckai's older technology.

For the same reasons, this case also provides this Court with an opportunity to narrow assignor estoppel, if it chooses not to abandon it entirely. Here, the assignee, Hologic, filed a continuation and expanded the scope of the patent's claims beyond that which was assigned by Truckai years earlier. An assignor (and those in privity with him or her) should be able to assert invalidity based on the failure of the original inventor's specification to adequately support the newly obtained, broad claims.

### **I. ASSIGNOR ESTOPPEL IS CONTRARY TO THE PATENT ACT'S TEXT AND THE PURPOSES OF PATENT LAW.**

Assignor estoppel is contrary to the text of the Patent Act and the objectives of patent law. This Court did not create the doctrine and has consistently narrowed the doctrine whenever confronted with it. The

Federal Circuit’s persistent expansion of assignor estoppel, without any support from Congress or this Court, merits this Court’s scrutiny.

1. The Patent Act authorizes an accused infringer to raise “[i]nvalidity” as a “defense[] in *any* action involving the validity or infringement of a patent.” 35 U.S.C. § 282(b) (emphasis added). The words “in *any* action” make no exception for an action against an assignor and leave no room for assignor estoppel. For this reason alone, assignor estoppel should be rejected.

The Federal Circuit does not pretend that assignor estoppel is rooted in statutory text. Instead, as the Federal Circuit recognizes, the doctrine is an “equitable,” “judge-made doctrine” rooted in principles of private contractual equities. Pet. App. 2a, 31a.

For nearly a century, this Court has made clear that this kind of “equitable” exception to the patent laws as expressed by Congress is disfavored. Courts “should not read into the patent laws limitations and conditions which the legislature has not expressed.” *Bilski v. Kappos*, 561 U.S. 593, 602–04 (2010); *United States v. Dubilier Condenser Corp.*, 289 U.S. 178, 198–99 (1933), *amended*, 289 U.S. 706 (1933) (mem.). This Court has repeatedly rejected the Federal Circuit’s attempts to read atextual limitations into the patent laws, especially limits adopted in the name of equity. See, e.g., *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, 137 S. Ct. 954, 967 (2017) (rejecting equitable defense of laches for claims brought within the statute of limitations); *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 136 S. Ct. 1923, 1931–34 (2016) (rejecting non-statutory test for enhanced damages); *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 572 U.S. 545, 553–58 (2014) (eliminating non-statutory attorneys’ fees framework); *Bilski*, 561 U.S. at 602–04

(removing atextual limitations on patentable processes).

Recognizing that “federal law requires that all ideas in general circulation be dedicated to the common good unless they are protected by a valid patent,” this Court has been vigilant in ensuring that invalid patents are not propped up as barriers to free competition. *Lear*, 395 U.S. at 668. Challenges to a patent’s validity serve the public interest by ensuring that bad patents cannot stifle innovation. *Edward Katzinger Co.*, 329 U.S. at 400–01; *Pope Mfg. Co. v. Gormully*, 144 U.S. 224, 234–35 (1892). The public interest in eliminating bad patents is so strong that this Court has recognized that “the right to make the [invalidity] defence is not only a private right to the individual, but it is founded on public policy which is promoted by his making the defence, and contravened by his refusal to make it.” *Pope Mfg. Co.*, 144 U.S. at 235 (quoting *Crane v. French*, 38 Miss. 503, 532 (Miss. Err. & App. 1860)). Thus, “[i]n case after case, the Court has construed [the patent] laws to preclude measures that restrict free access to . . . unpatentable[] inventions.” *Kimble*, 135 S. Ct. at 2407 (“Allowing even a single company to restrict its use of an expired or invalid patent . . . ‘would deprive . . . the consuming public of the advantage to be derived’ from free exploitation of the discovery.” (second omission in original)).

This Court has “remov[ed] . . . restrictions on those who would challenge the validity of patents” as fast as the lower courts can create them. *Blonder-Tongue Labs., Inc.*, 402 U.S. at 344–45 (1971) (discussing the “line of cases eliminating obstacles to suit by those disposed to challenge the validity of a patent”); see, e.g., *Lear*, 395 U.S. 673–74 (eliminating licensee estoppel); *Pope Mfg. Co.*, 144 U.S. at 236–37 (refusing to enforce contractual agreement not to contest patent’s validity);

*Edward Katzinger Co.*, 329 U.S. at 401–02 (“[A] contract not to challenge the validity of [the] patent can no more override congressional policy than can an implied estoppel.”); *MacGregor v. Westinghouse Elec. & Mfg. Co.*, 329 U.S. 402, 407 (1947) (refusing to enforce licensee’s agreement not to challenge patent); *Scott Paper Co. v. Marcalus Mfg. Co.*, 326 U.S. 249, 254 (1945) (removing equitable bar on assignor asserting that innovation practiced expired patent). No policy of patent law favors enforcement of invalid patents against *anyone*.

Indeed, assignor estoppel advances no public policy that patent law is designed to serve. Hologic has suggested and the Federal Circuit seemed to believe that assignor estoppel protects assignees from competition from inventor-assignors. The idea appears to be that every patent assignment should be understood as including the equivalent of a covenant not to compete. If such a rule has any public value, it would not be a public value reflected in *patent* law. No identifiable policy of patent law is served by treating every inventor who sells his patent as having exited the field for the life of the assigned patent. The patent laws do not grant broad monopolies against competition from particular persons. They grant limited monopolies over the scope of inventions described and enabled in the specifications and claims of patents.

2. Consistent with this Court’s general view favoring invalidity challenges to patents, this Court has addressed assignor estoppel only to limit or criticize it. This Court did not create the doctrine. Lower courts began applying it around 1880. *Westinghouse Elec. & Mfg. Co. v. Formica Insulation Co.*, 266 U.S. 342, 349 (1924) (citing *Faulks v. Kamp*, 3 F. 898 (C.C.S.D.N.Y. 1880)). This Court has never squarely considered whether to maintain the doctrine. It has, instead, only

assumed its validity even as it has consistently narrowed its application.

This Court first addressed assignor estoppel in *Formica*. *Id.* While the Court would “not now lightly disturb” the rule as adopted by the lower courts, it significantly narrowed the doctrine so that it did not apply to the facts of the case. *Id.* Lower courts had held that assignor estoppel prevented assignors from using prior art to narrow the scope of patent claims. *Id.* at 350–51. This Court disagreed. The assignor could point to prior art, because that was the best way of “measuring the extent of the grant the government intended and which the assignor assigned.” *Id.* The assignor could show “what the thing was which was assigned” in the first place. *Id.* at 351 (quoting *Noonan v. Chester Park Athletic Club Co.*, 99 F. 90, 91 (6th Cir. 1900)).

Allowing the inventor to use prior art was especially important, the Court indicated, because the inventor had assigned his rights before the relevant patent had issued. Thus, the claims were “subject to change by curtailment or enlargement by the Patent Office with the acquiescence or at the instance of the assignee” and the new claims “*may ultimately include more than the assignor intended to claim.*” *Id.* at 352–53 (emphasis added). This Court allowed the inventor to defend against the infringement suit by showing that the patent claims—as asserted by the assignee—exceeded what he had invented and assigned. *Id.* at 355; see also Lemley, *supra*, at 518 (“[T]he assignor estoppel claim in *Westinghouse* actually failed . . .”).

The Court noted that assignor estoppel might bar an inventor from relying on prior art “in a case in which the assignor made specific representations as to the scope of the claims and their construction, inconsistent with the state of the art, on the faith of which the assignee purchased; but that would be a special instance

of estoppel by conduct.” *Formica*, 266 U.S. at 351. In the absence of such specific representations, there was no justification for broadly forbidding an inventor/assignor from relying on prior art to narrow the assigned patent’s claims.

The Court next addressed assignor estoppel in *Scott Paper Co. v. Marcalus Manufacturing Co.*, 326 U.S. 249 (1945). The Court was critical of the doctrine, but did not determine to what “extent that doctrine may be deemed to have survived the *Formica* decision” because the doctrine again did not apply. *Id.* at 254. In *Scott Paper*, an assignee sued the inventor/assignor’s company, alleging that the inventor/assignor’s new device infringed the assigned patent. This Court held that the doctrine could not “foreclose the assignor of a patent from asserting the right to make use of the prior art invention of an expired patent, which anticipates that of the assigned patent.” *Id.* at 257–58. Assignor estoppel could not bar the assignor from asserting the “complete defense” that his invention practiced an expired patent. *Id.* The Court focused on the plain terms of the patent laws and on the public interest in free competition, which outweighed any private interest in applying any form of estoppel. The “patent laws . . . preclude the assignor from estopping himself from enjoying rights which it is the policy of the patent laws to free from all restrictions.” *Id.* at 257. And “[f]or no more than private contract can estoppel be the means of successfully avoiding the requirements of legislation enacted for the protection of a public interest.” *Id.*

In sum, this Court has never applied the doctrine to preclude a patent challenge. By contrast, the Federal Circuit *has* “*never once refused to apply the doctrine.*” Lemley, *supra*, at 524 (emphasis added).

Indeed, the Federal Circuit has repeatedly and consistently expanded assignor estoppel, far beyond its

purportedly equitable basis. *Id.* at 519–24. For example, the Federal Circuit now applies assignor estoppel whether or not the assignor received any consideration in exchange for a patent other than a salary. *Carroll Touch, Inc. v. Electro Mech. Sys., Inc.*, 15 F.3d 1573, 1580–81 (Fed. Cir. 1993). And the assignor need not have made any affirmative representation about the patent’s validity to the assignee. See *Shamrock Techs., Inc. v. Med. Sterilization, Inc.*, 903 F.2d 789, 794 (Fed. Cir. 1990). As applied by the Federal Circuit, assignor estoppel even prevents a company from challenging validity in defending a product the company developed before hiring the inventor/assignor. *MAG Aerospace Indus., Inc. v. B/E Aerospace, Inc.*, 816 F.3d 1374, 1380–81 (Fed. Cir. 2016).

In this case, the Federal Circuit expanded assignor estoppel yet again, in a way particularly divorced from the doctrine’s equitable roots. This time, the Federal Circuit applied assignor estoppel to prevent an inventor/assignor from asserting defenses under 35 U.S.C. § 112(a) for lack of enablement and lack of written description. The Federal Circuit has typically applied assignor estoppel to limit invalidity defenses “based on ‘novelty, utility, patentable invention, anticipatory matter, and the state of the art’”—which go to the core of whether an invention is valuable and patentable. *Diamond Sci.*, 848 F.2d at 1224. Here, on the other hand, the Federal Circuit barred defenses which go to whether claims have been broadened beyond what was invented and described in the specification.

It is well settled that the price of overbroad claiming is invalidity. *O’Reilly v. Morse*, 56 U.S. (15 How.) 62, 120–21 (1854). A patent is “conditioned by a public purpose”; it “results from invention and is limited to the invention which it defines.” *Mercoïd Corp. v. Mid-Continent Inv. Co.*, 320 U.S. 661, 666 (1944). This rule

ensures that inventors gain exclusivity only in exchange for publicly disclosing novel advances. This bedrock rule advances patent law’s fundamental purpose to promote innovation, not stifle new inventions. See *O’Reilly*, 56 U.S. at 120–21; *AbbVie Deutschland GmbH & Co., KG v. Janssen Biotech, Inc.*, 759 F.3d 1285, 1298 (Fed. Cir. 2014); *Nat’l Recovery Techs., Inc. v. Magnetic Separation Sys., Inc.*, 166 F.3d 1190, 1195–96 (Fed. Cir. 1999). No patent law policy is served by shielding an assignee’s extension of the patent monopoly beyond what the assignor disclosed. Yet that is what applying assignor estoppel accomplishes here.

Hologic’s patent is invalid because *Hologic* broadened the patent’s claims beyond what Truckai’s specification describes, and it did so years later after learning of Truckai’s new invention, then sought to use those broadened claims to preclude Minerva from offering the public Truckai’s improved endometrial ablation technology. In other words, the Federal Circuit has now ruled that assignor estoppel bars an inventor/assignor from challenging the scope of claims, no matter how far removed they are from what the inventor assigned. No policy motivating assignor estoppel or the Patent Act supports this result.

The Federal Circuit reasoned that “[t]o the extent Hologic may have broadened the claims . . . after Mr. Truckai’s assignment beyond what could be validly claimed in light of the prior art” Minerva could have “introduce[d] evidence of prior art to narrow the scope of” the claim. Pet. App. 20a. That reasoning reveals only how far removed the Federal Circuit’s approach to assignor estoppel is from that of this Court. *Westinghouse* plainly allows what the Federal Circuit imagined. But it does so to ensure that assignor estoppel does not authorize assignees to shield their efforts to

broaden the scope of their monopoly. The same rationale should have led the Federal Circuit to conclude that assignor estoppel cannot bar the defenses of lack of written description or enablement. There is no reason to allow an assignor to show that the scope of a claim is limited by prior art or narrowing language in the specification, but not that a claim is invalid because that same specification fails to describe what the assignee has subsequently claimed. Both allow the assignor to demonstrate “the extent of the grant . . . which [the inventor] assigned.” *Formica*, 266 U.S. at 350–51.

## **II. ASSIGNOR ESTOPPEL PRESENTS THE PATENT LAW EQUIVALENT OF A SPLIT OF AUTHORITY THAT REQUIRES THIS COURT’S INTERVENTION.**

Owing to the Federal Circuit’s exclusive jurisdiction over appeals in patent cases, this Court reviews patent law issues despite the absence of a split of authority. The Federal Circuit’s persistent expansion of assignor estoppel contrary to the text of the statute and this Court’s decisions by itself warrants this Court’s review. Beyond that, there is now what amounts to a conflict of authority regarding assignor estoppel that makes this Court’s intervention particularly needed. This Court has eliminated the closely related doctrine of licensee estoppel, and the reasoning of that ruling strongly suggests assignor estoppel, too, should go. Moreover, the Federal Circuit has ruled that assignor estoppel should not apply in *inter partes* review based on reasoning from statutory language that closely resembles the primary statutory reason to abandon assignor estoppel here. Assignor estoppel is thus an anomaly, and, given the Federal Circuit’s refusal to

reconcile its treatment of the doctrine with these contrary authorities, only this Court can resolve the conflict.

1. In *Lear*, this Court eliminated the nearly identical equitable, judge-made doctrine of licensee estoppel. Licensee estoppel precluded one who licensed a patent from challenging that patent's validity. The rationale for the doctrine mirrored the rationale for assignor estoppel: that it was unfair for "a licensee . . . to enjoy the benefit afforded by the agreement while simultaneously urging that the patent which forms the basis of the agreement is void." *Lear*, 395 U.S. at 656 (quotation marks omitted). *Lear* considered "the competing demands of the common law of contracts and the federal law of patents." *Id.* at 668. And it concluded that the "strong federal policy favoring the full and free use of ideas in the public domain" must prevail. *Id.* at 674. As this Court explained, "equities . . . do not weigh very heavily when they are balanced against the important public interest in permitting full and free competition" by eliminating invalid patents. *Id.* at 670.

This Court emphasized that licensees are especially well-equipped to serve the public interest in challenging invalid patents because of their knowledge of the challenged patents and their incentive to challenge them. *Id.* at 670–71. Regardless of the equities between the parties, it was important to the public that licensees be allowed to serve that public interest.

*Lear's* reasoning applies with even greater vigor to assignor estoppel. Like licensee estoppel, assignor estoppel allows worthless patents to stifle innovation and impede "full and free competition." *Id.* at 670, 673–74 & n.19; see, e.g., Lemley, *supra* at 527–29; Lara J. Hodgson, *Assignor Estoppel: Fairness at What Price?*, 20 Santa Clara Computer & High Tech. L.J. 797, 816–17 (2004); cf. T. Randolph Beard et al., *Quantifying the*

*Cost of Substandard Patents: Some Preliminary Evidence*, 12 Yale J.L. & Tech. 240 (2010) (economic loss due to invalid patents is estimated at \$25.5 billion per year). Inventors who assign patents are also those best equipped to challenge assignees' attempts to broaden their patent monopoly with overly-aggressive interpretations, continuations, and enforcement of their patents. Inventors have the greatest understanding of what was patented in the first place. They are also likely to find themselves accused of infringing their previously assigned patents. As inventors with expertise in a particular field, they are more likely to bring new, competing products to market in that field, and bringing new competing products to market sometimes—like here—prompts infringement claims designed to frustrate competition. Barring inventors from defending their new innovations against overly aggressive assertions of patent infringement both prevents inventors from challenging bad patents and discourages inventors from developing new innovations in the first place. As applied here, Truckai effectively entered into a covenant not to compete just by assigning his old invention.

If anything, the case for eliminating assignor estoppel is stronger than the case that supported eliminating licensee estoppel. In considering the scope of the patent monopoly, this Court often weighs the patent law's competing goals: (a) that of incentivizing innovation by allowing an inventor to enjoy market exclusivity, and (b) that of allowing the public unrestricted access to the benefits of competition. See, e.g., *Mercoïd Corp.*, 320 U.S. at 665. For example, licensee estoppel rewarded inventors. Under that doctrine, if someone licensed an inventor's patent, that licensee could not later challenge the patent's validity. This hurt the public by preventing validity challenges, but it rewarded

inventors by insulating their patents against challenges by licensees. Here, there is no such conflict. Both interests underlying the patent law favor eliminating assignor estoppel. Assignor estoppel hurts the public by allowing bad patents to preclude public use of what should be in the public domain, *and* it disincentivizes further innovation in the field by exposing inventors' new inventions to spurious claims of infringement of overbroad patent claims. Only the inventor, one of those few possessing expertise in the field to bring improved products to market, faces the risk of an infringement lawsuit in which she cannot assert an invalidity defense.

The parallels between licensee estoppel and assignor estoppel were apparent to this Court when it decided *Lear*. *Lear* discussed assignor estoppel and treated it as equivalent to licensee estoppel. 395 U.S. at 664–67. In rejecting the view that “patent estoppel”—which included both licensee and assignor estoppel—was “the general rule,” the Court traced the history of both doctrines. It pointed out that it had repeatedly adopted “exception[s] that undermined the very basis” for *assignor* estoppel. *Id.* at 664–67 (quotation marks omitted) (discussing *Formica*, 266 U.S. at 350–51; *Scott Paper Co.*, 326 U.S. at 257).

Numerous courts recognized decades ago that *Lear* sounded the death knell for assignor estoppel. *Coastal Dynamics Corp.*, 469 F.2d at 79; see *Diamond Sci.*, 848 F.2d at 1223 (collecting cases). Even the Federal Circuit recognized that this Court had “undermined the very basis of” and “sapped much of the vitality, if not the logic, from the assignment estoppel doctrine.” *Diamond Sci.*, 848 F.2d at 1223 (quoting *Lear*, 395 U.S. at 666); cf. *Arista Networks, Inc.*, 908 F.3d at 802.

The Federal Circuit nonetheless revived assignor estoppel, concluding it still “serves important purposes.”

Pet. App. 12a. Instead of grappling with the reasoning that drove this Court’s decision in *Lear*, the Federal Circuit has focused on what it believes to be an “important distinction . . . between assignors and licensees.” *Id.* “Unlike the licensee, who, without *Lear* might be forced to continue to pay for a potentially invalid patent, the assignor who would challenge the patent has already been fully paid for the patent rights.” *Id.* (quoting *Diamond Sci.*, 848 F.2d at 1224). This “specious distinction” is not rooted in *Lear*—which categorically held that the public interest in invalidating bad patents superseded private equities—or any law. See Hodgson, *supra*, at 816–17.

2. The Federal Circuit recently recognized that assignor estoppel has no place in *inter partes* review proceedings. *Arista Networks, Inc.*, 908 F.3d at 803–04. The statute governing *inter partes* reviews provides that “a person who is not the owner of a patent” may institute an *inter partes* review, and, as the Federal Circuit recognized, an assignor is “a person who is not the owner of a patent.” *Id.* Following this Court’s guidance that, when “statutory language is plain, [courts] must enforce it according to its terms,” the Federal Circuit therefore refused to read the atextual limitation of assignor estoppel into the law. *Id.* (quoting *King v. Burwell*, 135 S. Ct. 2480, 2489 (2015)).

The reasoning at the heart of *Arista*—that the unqualified language of a statute should be given full effect so that *any* party may assert invalidity—applies with equal force to Section 282(b) of the Patent Act, which provides that invalidity defenses are available in *any* case asserting patent infringement. Yet when it comes to considering whether to apply assignor estoppel in district court litigation, the Federal Circuit disregards the statute.

As Judge Stoll pointed out, the Federal Circuit's inconsistent application of assignor estoppel leads to an odd, illogical patent system in which an assignor can assert invalidity defenses in *inter partes* reviews, but cannot assert invalidity defenses in district court. Whether a patent lives or dies will therefore turn on factors wholly unrelated to the merits, such as which forum moves more quickly. There is no indication Congress intended this odd result. Resolving this conflict, too, is a compelling reason for this Court's review.

3. The Federal Circuit's revived doctrine of assignor estoppel has been the subject of extensive criticism, including by Federal Circuit judges. See *Mentor Graphics*, 870 F.3d at 1305 (Moore, J., concurring in denial of panel rehearing); see also, *e.g.*, Lemley, *supra*; Hodgson, *supra*. Yet members of the Federal Circuit have concluded that it is impossible for the Federal Circuit to abolish assignor estoppel without further direction from this Court because this Court has considered cases involving assignor estoppel without explicitly doing away with the doctrine. *Mentor Graphics*, 870 F.3d at 1305 (Moore, J., concurring in denial of panel rehearing). In fact, in this case, the Federal Circuit emphasized that this Court has "not abolish[ed] the doctrine." Pet. App. 11a. Given the Federal Circuit's reluctance to reevaluate the doctrine without explicit direction from this Court, this Court's intervention is required.

### **III. THIS CASE PRESENTS AN IDEAL VEHICLE FOR THIS COURT TO ADDRESS ASSIGNOR ESTOPPEL.**

This case highlights how far the Federal Circuit has expanded the doctrine of assignor estoppel. It thus provides a uniquely valuable opportunity for this Court to

consider not only whether to abandon the doctrine entirely, but also whether to retain the doctrine with clearly defined, narrow limits.

1. Hologic, after learning that Truckai had developed a new and improved medical device that could produce substantially better results for patients and thus effectively compete with Hologic's product, sought and obtained an expansive patent claim that abandoned the moisture-permeability limitation at the heart of the invention Truckai had assigned. Hologic then weaponized that expansive claim against Minerva, the company bringing Truckai's improved device to market. Truckai was the *only* person with the expertise and imagination to conceive his new, plasma-based, impermeable applicator head, and he was the person best situated to explain that his prior innovation did not include impermeable applicator heads. Yet neither he nor Minerva were allowed to challenge Hologic's unsupported expansion of its patent monopoly in district court. The patent laws should not—and do not—sanction this result.

Neither Truckai nor Minerva has ever asserted that what Truckai sold was worthless. To the contrary, Hologic enjoyed years of profitable market dominance, and neither Truckai nor Minerva has ever suggested that Hologic was *not* entitled to market exclusivity over devices with moisture permeable applicator heads for the life of all of the patents Truckai assigned. It is only when Hologic took the extra step of *expanding* the scope of its patent claims beyond what Truckai invented that Minerva asserted invalidity. And the assertion of invalidity concerns *only* a patent claim that Hologic prosecuted, not any of Truckai's earlier issued patents.

2. Moreover, had the Federal Circuit considered Minerva's invalidity arguments, it would have found no

basis for maintaining the validity of the patent. To meet the written description requirement, the specification must provide “a precise definition” of the invention that “clearly allow[s] persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.” *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1350–51 (Fed. Cir. 2010) (en banc) (second alteration in original) (quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991)). To meet the enablement requirement, the specification must describe the invention “in such full, clear, concise, and exact terms as to enable any person skilled in the art . . . to make and use” it. 35 U.S.C. § 112(a). A claim is not enabled if, after reviewing the specification, a person of ordinary skill in the art would be unable to practice the full scope of the claimed invention without engaging in “undue experimentation.” *Trs. of Bos. Univ. v. Everlight Elecs. Co.*, 896 F.3d 1357, 1362–64 (Fed. Cir. 2018).

The district court’s alternative ruling regarding invalidity provided no reference to anything in the specification that could satisfy either standard. Instead, the district court treated its claim construction as dispositive of the invalidity arguments. Pet. App. 58a (“The court finds Minerva’s overly broad claims argument is effectively foreclosed by the court’s adoption of Hologic’s claim construction.”); *id.* at 63a. That was plainly wrong. A broad claim construction cannot cure invalidity. It only exacerbates it. It is well established that if the breadth of claims *as construed* exceeds the breadth of what is described and enabled in the specification, the claims fail. See *Trs. of Bos. Univ.*, 896 F.3d at 1360, 1364. A patent holder thus “create[s] its own enablement problem” by seeking a construction under which a claim encompasses more than the patent enables or describes. *Id.* at 1365; see also *Liebel-Flarsheim*

*Co. v. Medrad, Inc.*, 481 F.3d 1371, 1380 (Fed. Cir. 2007). Hologic did just that.

As expanded, the '348 patent claims an applicator head made of *any* material. Yet the “Moisture Transport” specification describes only a moisture permeable applicator head that transports moisture out of the uterus. The patent nowhere describes or suggests a moisture impermeable applicator head that retains moisture and can still achieve the goals of the device. In fact, not only does the specification fail to describe the use of a non-permeable applicator head to retain, heat, and use the liquid layer inside the uterine cavity for thermal ablation, as the accused device does, but the specification disparages non-permeable applicator heads and explains in detail the need to “eliminate” and “prevent” the formation of a liquid layer between the outer surface of the applicator head and the uterine tissue. In short, the '348 patent specification nowhere teaches how to use a non-permeable applicator head that retains moisture in the uterine cavity without causing the kind of out-of-control thermal ablation the '348 patent described as a problem in the prior art.

It is exceptionally and unusually clear that the '348 patent—as expanded to include impermeable applicator heads—is invalid. That Minerva’s appeal on this issue was resolved without even considering its merits illuminates everything that is wrong with the Federal Circuit’s assignor estoppel doctrine.

**CONCLUSION**

For the foregoing reasons, the petition for a writ of certiorari should be granted.

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