

Minerva Surgical, Inc. v. Hologic, Inc., Appeal No. 20-440 (June 29, 2021). Kagan, Roberts, Breyer, Sotomayor, Kavanaugh. Appealed from Federal Circuit (Stoll, K., Wallach, E., Clevenger, R.).

Background:

Truckai, founder of Novacept, invented a device to treat abnormal uterine bleeding. He filed a patent application and assigned it to Novacept. Novacept then sold assets (including pending applications) to another company who subsequently sold to Hologic.

The patented device is an applicator head to destroy targeted cells in the uterine lining. The head is moisture permeable to conduct fluid to and from the uterine cavity. Truckai later founded Minerva Surgical, Inc. and developed an improved device using an applicator head that was moisture impermeable. Hologic filed a continuation to add claims that did not specify whether the applicator heads were moisture permeable to cover Minerva's product. Hologic sued Minerva for patent infringement.

As a defense, Minerva asserted that Hologic's patent was invalid because the broader claims were not supported by the specification. Hologic invoked assignor estoppel, asserting that because Truckai assigned the application, he could not later impeach the patent's validity.

The Federal Circuit found assignor estoppel applied and it was irrelevant that, at the time of assignment, the inventor's patent application was pending and the assignee could later amend the claims without the inventor's input. The Supreme Court granted writ of certiorari.

Issues/Holdings:

Should the assignor estoppel doctrine be abolished? No, affirmed. Should the assignor estoppel doctrine bar Minerva from asserting an invalidity defense? No, not if claims were materially broadened after Truckai assigned his rights to Hologic.

Discussion:

Minerva argued assignor estoppel should be abolished for three reasons. Minerva argued that Congress repudiated the doctrine in Patent Act of 1952 because it states that invalidity of the patent shall be a defense in any action involving infringement. The Supreme Court found that Minerva's interpretation would eliminate all common law preclusion doctrines in patent cases.

Minerva also argued that *Westinghouse v. Formica* raised the issue of whether estoppel should apply differently for a patent application, and that post-*Westinghouse* decisions "eliminated any justification for assignor estoppel and repudiated the doctrine." The Supreme Court decided the doctrine remains intact but has limitations.

Specifically, assignor estoppel only applies when the inventor says one thing (explicitly or implicitly) in assigning a patent and the opposite when litigating against the patent's owner. The Supreme Court found that when the assignor hasn't made any explicit or implicit representations in conflict with his invalidity defense, there is no unfairness. Thus, if the new claims are materially broader than the old claims, the assignor did not warrant to the new claims' validity. If Hologic's new claim is materially broader than the ones Truckai assigned, Truckai could not have warranted its validity in making the assignment. And without such a prior inconsistent representation, there is no basis for estoppel.

Dissenting Opinion by J. Alito

The majority improperly failed to properly address the *Westinghouse* case. To reach their outcome they should have overruled it but did not.

Dissenting Opinion by J. Barrett, joined by J. Thomas and J. Gorsuch

Assignor estoppel is not a "well-settled" doctrine and if anything "it was on life support." The Patent Act of 1952 did not incorporate this doctrine.