

HOLOGIC, INC. v. MINERVA SURGICAL, INC., Appeal Nos. 2019-2054, -2081 (Fed. Cir. August 11, 2022). Before Stoll, Clevenger, and Wallach. Appealed from D. Del. (Judge Bataillon).

Background:

This infringement case came back to the Federal Circuit on remand from the Supreme Court, which vacated an original judgment by the Federal Circuit affirming the district court's grant of summary judgment of no invalidity to Hologic based on assignor estoppel. The Supreme Court confirmed the existence of assignor estoppel but limited its application to when an invalidity defense in an infringement suit conflicts with an explicit or implicit representation made in assigning patent rights. The Supreme Court held that the Federal Circuit failed to fully consider Minerva's contention that assignor estoppel should not apply because it was challenging a claim that was materially broader than the claims the inventor had assigned. Therefore, the Federal Circuit reconsidered whether the district court abused its discretion in determining that assignor estoppel barred Minerva's invalidity defenses in light of the Supreme Court's guidance.

Issue/Holding:

The issue was whether the district court erred in granting summary judgment of no invalidity based on the doctrine of assignor estoppel? No, affirmed.

Discussion:

The analysis involved comparison of two claims: one from a Hologic patent that claimed priority back to an original application filed by the inventor through NovaCept, which assigned its rights in the NovaCept application to a company ultimately bought by Hologic, and one from the original NovaCept application that was canceled two years before NovaCept assigned its rights to the Hologic predecessor.

In view of the Supreme Court's holding, the Federal Circuit first considered whether the inventor actually warranted the validity of the NovaCept claim at the time of assignment considering that the claim was canceled from that application. The Federal Circuit held that the grounds for cancellation were essentially procedural in nature and did not nullify the claim in any way. As such, the Federal Circuit held that the inventor warranted the validity of the canceled claim in the assignment.

The Federal Circuit then considered whether the claim from the Hologic patent was materially broader than the canceled NovaCept claim. The parties agreed that the "materially broader" analysis depended on the difference between "moisture-permeable" and "moisture-impermeable" devices such that if the canceled claim was limited to "moisture-permeable" devices, the Hologic claim would be materially broader and assignor estoppel would not bar Minerva from asserting its invalidity defenses. The parties also agreed that the canceled claim did not have an express moisture-permeability limitation. The Federal Circuit found the plain language of the canceled claim broad enough to encompass "moisture-impermeable" as well as "moisture-permeable" devices. The Federal Circuit also cited the doctrine of claim differentiation in recognizing that NovaCept recited the moisture permeability feature in other claims and therefore must have been aware of this feature and have intentionally left it out of the canceled claim.

Thus, the Federal Circuit held that the claim from the Hologic patent was not materially broader than the canceled NovaCept claim, and concluded that the district court did not abuse its discretion in applying the doctrine of assignor estoppel and granting summary judgment of no invalidity.