

No. 20-440

In the Supreme Court of the United States

MINERVA SURGICAL, INC., PETITIONER,

v.

HOLOGIC, INC., CYTYC SURGICAL PRODUCTS, LLC,
RESPONDENTS.

*ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE
FEDERAL CIRCUIT*

BRIEF IN OPPOSITION

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QUESTION PRESENTED

American courts have long relied on the doctrine of assignor estoppel “to prevent unfairness and injustice,” *Diamond Sci. Co. v. Ambico, Inc.*, 848 F.2d 1220, 1224 (Fed. Cir. 1988) (citation omitted), and this Court endorsed the doctrine almost a century ago, *Westinghouse Elec. & Mfg. Co. v. Formica Insulation Co.*, 266 U.S. 342, 350 (1924). In its most basic form, the doctrine “prohibits an assignor of a patent, or one in privity with an assignor, from attacking the validity of that patent when he is sued for infringement by the assignee.” *MAG Aerospace Indus., Inc. v. B/E Aerospace, Inc.*, 816 F.3d 1374, 1379-80 (Fed. Cir. 2016). At the rule’s heart lies a straightforward intuition: “an assignor should not be permitted to sell something and later to assert that what was sold is worthless, all to the detriment of the assignee.” *Diamond Sci.*, 848 F.2d at 1224.

The question presented is whether the longstanding common-law doctrine of assignor estoppel should be abrogated by this Court.

RULE 29.6 STATEMENT

Respondent Cytoc Surgical Products, LLC is a wholly owned subsidiary of respondent Hologic, Inc. The Vanguard Group, Inc. and T. Rowe Price Associates, Inc. each own more than ten percent of the stock of respondent Hologic, Inc.

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BRIEF IN OPPOSITION

INTRODUCTION

American courts have consistently applied a simple, intuitive rule grounded in a “rudimentary sense of justice”—that “[w]hen by a fair and free bargain a man sells something to another, it hardly lies in his mouth to say, ‘I have sold you nothing.’” *Scott Paper Co. v. Marcalus Mfg. Co.*, 326 U.S. 249, 258 (1945) (Frankfurter, J., dissenting). In the patent law context, this rule is called “assignor estoppel,” and it precludes inventors who have assigned (*i.e.*, sold) the rights to an invention from later challenging the validity of the rights they sold. That “principle[,] whereby an assignor is held to his bargain with the assignee[,] has been part of the texture of our patent law throughout its history,” *id.* at 263, and this Court expressly and unanimously endorsed it almost a century ago, *Westinghouse Elec. & Mfg. Co. v. Formica Insulation Co.*, 266 U.S. 342, 350 (1924). Courts to this day apply the doctrine of assignor estoppel regularly and without dissent.

The facts of this case provide a textbook example of the doctrine’s application. In 2004, Csaba Truckai sold his business, which had developed an important medical device called “NovaSure,” to the predecessor of respondent Hologic, Inc. for hundreds of millions of dollars. The assignment included the rights to the invention itself and to any patents that might eventually be issued in connection with it. But a few years later, Truckai turned around and founded a new company, petitioner Minerva Surgical, Inc., to compete against Hologic by selling a product that deliberately copied core features of NovaSure—features covered by the patent rights Hologic had bought. Minerva and Truckai characterized their device as “look[ing] like NovaSure,” “almost dead identi-

cal to NovaSure,” and “specifically designed to virtually mimic the steps of the NovaSure procedure.”

Unsurprisingly, patent litigation ensued, but Minerva sought to evade liability by arguing that the asserted patents were invalid—*i.e.*, that some of the patent rights Truckai had sold for hundreds of millions of dollars were, in effect, worthless. The district court and Federal Circuit agreed that Minerva was estopped from making that argument. Having sold for valuable consideration the right to any patent that might be granted on the NovaSure system, Truckai and his privy Minerva could not, in fairness, ask a court to second-guess the validity of those patents merely because Truckai’s commercial interests had shifted. Both courts therefore applied the doctrine of assignor estoppel to preclude Minerva from challenging the validity of the rights Truckai had assigned.

Minerva now asks this Court to abrogate this well-settled doctrine entirely. Respectfully, the Court should decline to take that revolutionary step. The doctrine of assignor estoppel is a core part of patent law—a baseline protection that this Court first endorsed almost a century ago and against which Congress has legislated. No judge on the Federal Circuit has questioned its continuing vitality, and no court outside the Federal Circuit has any controlling precedent rejecting it. That consensus reflects that the doctrine serves patent law’s purposes by increasing the value of patents and encouraging innovation.

On inspection, Minerva’s objections to the doctrine ring hollow and case-specific. Contrary to Minerva’s suggestion, Hologic did not “expand” the scope of the rights it was assigned. The jury *rejected* Minerva’s theory that Hologic misused Minerva’s confidential information to enlarge its patent rights and keep Minerva’s

new product off the market. Furthermore, in addition to applying assignor estoppel, the district court and the Federal Circuit alternatively considered and rejected Minerva's invalidity challenge on the merits, meaning that Minerva's entire petition asks for nothing more than an advisory opinion.

The one persuasive point Minerva makes is that this case has laid bare a stark divergence in the Federal Circuit's assignor estoppel precedent. Assignors are barred from attacking the validity of assigned patent rights in district court, but they are permitted to attack those same rights in administrative proceedings before the Patent Office. Assignors can then use an administrative finding of invalidity procured from the Patent Office to collaterally estop the *assignee* from relying on the patent in district court. That makes no sense, and this Court should resolve the conflict. To do so, the Court should grant Hologic's cross-petition, filed simultaneously with this brief in opposition. But regardless, Minerva's petition should be denied.

STATEMENT OF THE CASE¹

A. Factual Background

1. Csaba Truckai is the founder, President, and CEO of petitioner Minerva Surgical, Inc. Pet. App. 6a. Before founding Minerva, Truckai co-founded another company called NovaCept, Inc., which in the late 1990s invented a medical device called the NovaSure system. Pet. App. 5a. NovaSure revolutionized the medical procedure of endometrial ablation, in which the lining of the uterus is ablated, or destroyed, to treat menorrhagia, or abnormally heavy menstrual bleeding. Pet. App. 2a.

¹ A materially identical statement of the case is included in Hologic's cross-petition.

Compared with earlier products, NovaSure made the procedure considerably safer, quicker, cheaper, and more convenient for patients. *Hologic, Inc. v. Minerva Surgical, Inc.*, No. 1:15-cv-01031, 2016 WL 3143824, at *2 (D. Del. June 2, 2016). NovaSure also made it easier for physicians to detect perforations in the uterus, which can allow the hot fluids generated during ablation to escape and cause serious injury. *Id.*; Pet. App. 2a-3a.

Truckai filed two relevant patent applications covering the NovaSure system and assigned his interest in those applications to NovaCept. Pet. App. 5a. Truckai's broad assignment to NovaCept also included the rights to all continuation applications—that is, follow-on applications pursuing additional patent claims based on the same descriptions and priority dates as the original applications. *Id.*; see 35 U.S.C. § 120. Because the applications had not yet been granted as issued patents, Truckai knew that the scope of the patent claims might change during prosecution, as occurs routinely.

2. In 2004, Truckai sold NovaCept and the NovaSure system to Cytyc Corporation for \$325 million. C.A. App. 30612. Truckai personally received approximately \$8 million from the deal. *Id.* As part of the transaction, NovaCept assigned all of its patent rights, including to continuation applications, to Cytyc. C.A. App. 36355. In 2007, respondent Hologic, Inc. acquired Cytyc. Pet. App. 5a-6a. Hologic subsequently invested approximately \$140 million in making NovaSure the leading treatment for menorrhagia. C.A. App. 30194-95.

In 2005 and 2015, the U.S. Patent and Trademark Office issued two patents covering the NovaSure system—U.S. Patent No. 6,872,183 (the '183 Patent) and U.S. Patent No. 9,095,348 (the '348 Patent). The two patents were based upon continuation applications claiming priority to the original applications that Truckai had as-

signed to NovaCept and that NovaCept had later assigned to Hologic's predecessor Cytoc. Pet. App. 6a.

3. Meanwhile, Truckai left NovaCept, and in 2008 he founded Minerva to develop and sell a new endometrial ablation system that would compete against Hologic. *Id.* Minerva's product deliberately copied core features of NovaSure—including features covered by the '183 and '348 Patents. Pet. App. 6a; C.A. App. 29004. Minerva assured the U.S. Food and Drug Administration that Minerva's device was "almost dead identical to NovaSure," and it was pitched to physicians as "look[ing] like NovaSure" and "specifically designed to virtually mimic the steps of the NovaSure procedure." C.A. App. 36416, 31468, 36715. Peer-reviewed literature showed that the success rates of the two systems were "[e]ssentially comparable." Transcript of Jury Trial at 513:13, *Hologic, Inc. v. Minerva Surgical, Inc.*, No. 1:15-cv-01031 (D. Del. July 17, 2018), ECF No. 508 [hereinafter July 17 Trial Transcript]. Indeed, the similarities between NovaSure and Minerva's system were so apparent that one of Minerva's Medical Advisory Board members warned management that he "envision[ed] major 'patent infringement' disputes for this device vs Novasure." C.A. App. 17637.

Minerva and Hologic at one point discussed the possibility of Hologic acquiring Minerva and the rights to its new device, but no deal was ever reached. *Hologic*, 2016 WL 3143824, at *10.

B. Proceedings Below

1. In November 2015, Hologic sued Minerva, alleging that Minerva's ablation system infringed certain claims of the '183 and '348 Patents. Pet. App. 6a.

Just four months later, Minerva filed two petitions with the Patent Trial and Appeal Board (PTAB) requesting *inter partes* review (IPR) of the claims of the '348

Patent that Minerva's ablation system infringed. C.A. App. 8288, 8310. One month after that, Minerva filed a third IPR petition seeking review of the asserted claims of the '183 Patent. C.A. App. 19111. In all three petitions, Truckai's new company (Minerva) argued that some of the patent rights Truckai's old company (Nova-Sept) had assigned to Hologic's predecessor were invalid and worthless in light of certain prior art. Pet. App. 6a. The PTAB denied review of the '348 Patent, finding no reasonable likelihood that any of the asserted patent claims were invalid. *Id.* But the PTAB instituted review of the '183 Patent. *Id.*

On December 15, 2017, the PTAB issued a final written decision finding that the asserted claims of the '183 Patent were invalid. Pet. App. 6a-7a. On April 19, 2019, the Federal Circuit affirmed. *Hologic, Inc. v. Minerva Surgical, Inc.*, 764 F. App'x 873, 881 (Fed. Cir. 2019).

2. In the meantime, back in district court, Hologic and Minerva cross-moved for summary judgment on the issues of infringement, assignor estoppel, and invalidity.

On infringement, the district court had previously rejected Minerva's overly narrow claim constructions, denying Minerva's contention that a broad construction was inconsistent with the specification. C.A. App. 5 n.6. Applying its construction, the court concluded that "Minerva's accused product infringes the asserted claims of the patents." Pet. App. 71a.

The district court further held that assignor estoppel barred Minerva from challenging the validity of the '183 and '348 Patents. Minerva "d[id] not seriously dispute th[e] facts" establishing "privity between Truckai and Minerva." Pet. App. 58a. And the court rejected Minerva's contention that assignor estoppel does not apply to invalidity defenses based on the written description and enablement requirements imposed by 35 U.S.C.

§ 112, as opposed to the novelty and nonobviousness requirements imposed by Sections 102 and 103. The court also rejected Minerva’s contention that Hologic’s supposedly “overly broad claims” tipped the equities in Minerva’s favor. *Id.* The court agreed with Hologic “that—more than 19 years after Mr. Truckai executed his initial patent assignment—Minerva and Truckai [were] attempt[ing] to destroy the value of what Truckai sold to Hologic so that Minerva c[ould] directly compete with Hologic using patented technology he already sold to Hologic.” Pet. App. 55a. “Considering the balance of equities and the relationship of Minerva and Truckai,” the court concluded, “assignor estoppel applies.” Pet. App. 58a.

In addition to applying assignor estoppel, the district court also held, in the alternative, that “even if Minerva were not estopped,” Minerva’s invalidity arguments failed on the merits. Pet. App. 62a. “No reasonable jury,” the court concluded, “could find that Minerva ha[d] met its burden of proving by clear and convincing evidence that the claimed [elements] are not properly described or enabled,” as Section 112 requires. Pet. App. 63a.

The district court then held a trial on certain of Minerva’s state-law counterclaims, as well as on damages and willful infringement. During trial, Minerva argued that Hologic had intentionally broadened the ’348 Patent’s claims to cover Minerva’s device after learning about Minerva’s technology pursuant to a non-disclosure agreement. C.A. App. 2220. The jury disagreed, finding that Hologic had not misused Minerva’s confidential information. C.A. App. 98. The jury also awarded Hologic almost \$4.8 million in damages for Minerva’s infringement of Hologic’s patents. Pet. App. 8a.

After the verdict, Hologic moved for additional damages under both patents and for a permanent injunction against further infringement of the '183 Patent. Pet. App. 8a-9a.²

On May 2, 2019, the district court granted certain additional damages for the '348 Patent, but denied additional damages and an injunction for the '183 Patent. Cross-Pet. App. 7a, 20a-21a. The court's sole basis for denying relief for the '183 Patent was the Federal Circuit's decision, issued less than two weeks earlier, affirming the PTAB's IPR decision finding the '183 Patent invalid. Cross-Pet. App. 7a, 20a. While the district court concluded that the Federal Circuit's intervening decision effectively nullified the district court's earlier assignor estoppel ruling as to the '183 Patent, it did not disturb the assignor estoppel ruling as to the '348 Patent, on which the PTAB had denied review. Cross-Pet. App. 7a.

3. Hologic and Minerva cross-appealed to the Federal Circuit. As relevant here, Hologic challenged the district court's holding allowing Minerva to circumvent assignor estoppel by using the IPR proceedings to attack the validity of the '183 Patent. Minerva challenged the district court's twin holdings (1) that assignor estoppel barred Minerva from disputing the validity of the '348 Patent and (2) that the '348 Patent was valid regardless. On all three issues, the Federal Circuit affirmed.

a. The panel first addressed the district court's refusal to apply assignor estoppel to the '183 Patent. Ordinarily, the panel agreed, "an assignor should not be permitted to sell something and later to assert that what was sold is worthless, all to the detriment of the assignee." Pet. App. 12a (citation omitted). But here, the panel was "bound" by Federal Circuit precedent holding that

² By that point, the '348 Patent had expired. Pet. App. 8a.

“the doctrine of assignor estoppel does not bar an assignor from filing a petition for IPR.” Pet. App. 2a, 14a (citing *Arista Networks, Inc. v. Cisco Sys., Inc.*, 908 F.3d 792, 804 (Fed. Cir. 2018)). So although Minerva was “estopped from challenging the validity of the ’183 patent claims in district court,” it was “able to challenge their validity in an IPR proceeding and, hence, circumvent the assignor estoppel doctrine.” Pet. App. 14a. The panel then concluded that the assignor estoppel doctrine did “not preclude Minerva from relying on” the PTAB’s IPR decision “to argue that the ’183 patent claims are *void ab initio*.” *Id.*

The panel was quick to acknowledge “the seeming unfairness to Hologic in this situation,” and it “underst[oo]d Hologic’s predicament.” Pet. App. 14a, 15a. But bound by “precedent and the limits it places on the assignor estoppel doctrine,” the panel concluded that the Federal Circuit’s affirmance of the PTAB’s IPR decision was “dispositive of the validity of the ’183 patent claims” in district court, even though “assignor estoppel [would] bar[] Minerva from challenging the patent’s validity in this district court case.” Pet. App. 14a-15a.

The panel then turned to the district court’s holding that assignor estoppel precluded Minerva from challenging the validity of the ’348 Patent. The panel “conclude[d] that the district court did not abuse its discretion in applying assignor estoppel here.” Pet. App. 17a. To begin with, the panel “decline[d] Minerva’s invitation to abandon the doctrine of assignor estoppel entirely.” *Id.* The panel acknowledged this Court’s decision in *Lear, Inc. v. Adkins*, 395 U.S. 653 (1969), which abolished the doctrine of licensee estoppel. Pet. App. 17a. But Federal Circuit precedent cogently distinguishes licensees from assignors. Pet. App. 12a (citing *Diamond Sci. Co. v. Ambico, Inc.*, 848 F.2d 1220, 1224 (Fed. Cir. 1988)). Assignor estoppel thus retains a vital role in the

“prevention of unfairness and injustice.” Pet. App. 13a (quotation marks omitted).

The panel then “agree[d] with the district court that the equities weigh in favor of [assignor estoppel’s] application in this case.” Pet. App. 18a. “Minerva disputed none of the pertinent facts below or on appeal.” *Id.* And while Minerva “emphasize[d] that Hologic, not Mr. Truckai, prosecuted [the relevant] claim ... of the ’348 patent,” the panel was “unpersuad[ed].” Pet. App. 19a. Truckai “executed a broad assignment of his patent rights,” including the right to continuation applications, knowing full well that the patent claims could “later [be] amended ... in the application process (a very common occurrence in patent prosecutions), with or without the inventor’s assistance.” *Id.* (citation, quotation marks, and brackets omitted). So while Minerva was free to “introduce evidence of prior art to narrow the scope of” the patent claims, the prosecution history of the ’348 Patent did not require the district court to balance the equities in Minerva’s favor. Pet. App. 20a (citation omitted).

Finally, the panel agreed with the district court that, assignor estoppel aside, Minerva’s challenge to the validity of the ’348 Patent failed on the merits. The panel thus “affirm[ed]” not only “the district court’s ... summary judgment that assignor estoppel bars Minerva from challenging the validity of the asserted ’348 patent claim,” but *also* “the district court’s summary judgment of no invalidity.” Pet. App. 30a-31a.

b. Judge Stoll, who authored the panel decision, wrote separately “to highlight and question the peculiar circumstances created in this case by [the Federal Circuit]’s precedent.” Pet. App. 31a (Stoll, J., additional views). That precedent produced “an odd situation where an assignor can circumvent the doctrine of assignor estoppel by attacking the validity of a patent claim in

the Patent Office, but cannot do the same in district court.” *Id.* She called on the full court “to clarify this odd and seemingly illogical regime” and to “consider en banc the doctrine of assignor estoppel as it applies both in district court and in the Patent Office.” Pet. App. 32a.

4. Hologic petitioned for rehearing en banc, and Minerva cross-petitioned for panel rehearing or rehearing en banc. Hologic sought review of the panel’s refusal to apply assignor estoppel to the ’183 Patent, highlighting the divergence in the Federal Circuit’s assignor estoppel precedent between district court and IPR proceedings. Hologic Pet. for Reh’g 3. Minerva sought review of the panel’s application of assignor estoppel to the ’348 Patent, as well as a fact-bound claim construction issue. Minerva Pet. for Reh’g 2-3. After the Federal Circuit called for a response, Hologic pointed out that any further review of the application of assignor estoppel to the ’348 Patent would constitute an impermissible advisory opinion, because the panel had already affirmed the district court’s alternative holding that Minerva’s invalidity arguments failed on the merits. Hologic Resp. at 6.

On July 22, 2020, the Federal Circuit denied both rehearing petitions. Pet. App. 80a.

REASONS THE PETITION SHOULD BE DENIED

Justice Frankfurter observed that the doctrine of assignor estoppel has “been part of the fabric of our law throughout the life of this nation.” *Scott Paper*, 326 U.S. at 260 (Frankfurter, J., dissenting). Minerva nonetheless asks this Court to tear the doctrine out of American law completely, or, failing that, to cut it down significantly. The Court should decline, for three basic reasons.

First, Minerva is wrong in arguing that assignor estoppel’s continued vitality is clouded by splits of authority with this Court’s decision in *Lear*, within the Federal Circuit, and with other courts. The Federal Circuit care-

fully distinguished *Lear* 32 years ago. No Federal Circuit judge has indicated that assignor estoppel should be repudiated. And there is no controlling authority from any other court rejecting assignor estoppel's continued vitality.

Second, the Federal Circuit correctly applied assignor estoppel to the '348 Patent. Minerva principally argues that assignor estoppel should be abrogated entirely. But Minerva overlooks assignor estoppel's deep roots in the common law, as well as this Court's endorsement of the doctrine almost a century ago. Subsequent cases have hardly sounded the doctrine's death knell, and it remains, like its close cousins collateral estoppel and *res judicata*, a background presumption of law against which Congress legislates. Minerva's claims that the doctrine is "textually groundless," Pet. 1, thus ignores basic principles of statutory interpretation.

Minerva similarly misses the mark in claiming that assignor estoppel should not apply on the facts of this case—a fact-bound contention not meriting this Court's review anyway. Minerva argues that Hologic "expanded" the scope of the assigned rights post-assignment, but Minerva is measuring from the wrong baseline. Truckai assigned the rights to *any* future patent on his invention, including the patent rights Minerva seeks to invalidate. This Court and others have confirmed that this kind of situation warrants the application of assignor estoppel. Minerva also suggests that assignor estoppel should not bar invalidity defenses based on the written description and enablement requirements under Section 112, but that argument is waived.

Third, Minerva's petition suffers from fatal vehicle problems. Most importantly, the Federal Circuit has already affirmed the district court's rejection of Minerva's invalidity challenge on the merits. So a decision by this

Court on whether assignor estoppel bars Minerva from challenging the '348 Patent's validity would make no difference to the outcome—either way, the '348 Patent is valid. Granting Minerva's petition also would not allow this Court to address the only real doctrinal divergence Minerva has identified—the rift in the Federal Circuit's precedents between the application of assignor estoppel in district court and in IPR proceedings. To address that important question, this Court should grant Hologic's cross-petition. Minerva's petition should be denied.

I. There Is No Split of Authority on Whether Assignor Estoppel Should Be Abrogated

Minerva contends that assignor estoppel is subject to “the patent law equivalent of a split of authority.” Pet. 23. But there is no split at all on the doctrine's vitality—not with *Lear*, not within the Federal Circuit, and not with any other court's controlling precedent.

A. Assignor Estoppel Is Consistent with this Court's Decision in *Lear*

Seeking to show “a conflict of authority,” Minerva first contends that assignor estoppel contravenes this Court's decision in *Lear*, which abolished the doctrine of licensee estoppel more than 50 years ago. Pet. 23-24. But the Federal Circuit cogently rejected Minerva's analogy to *Lear* more than 30 years ago.

The Federal Circuit first considered assignor estoppel in *Diamond Scientific Co. v. Ambico, Inc.*, 848 F.2d 1220 (Fed. Cir. 1988). *Lear* had repudiated licensee estoppel almost two decades prior, and the assignor in *Diamond Scientific* argued that *Lear* demolished the foundation of assignor estoppel. But after carefully analyzing *Lear* and this Court's other assignor estoppel precedents, the Federal Circuit concluded that “the automatic application to assignment cases of the rationale underlying *Lear* and licensees” would be inappropriate. *Id.* at

1224. “The public policy favoring allowing a licensee to contest the validity of the patent,” the court explained, “is not present in the assignment situation.” *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.* This Court then denied the assignor’s petition for certiorari. *Ambico, Inc. v. Diamond Sci. Co.*, 487 U.S. 1265, 1265 (1988).

In the 32 years since, the Federal Circuit has regularly applied assignor estoppel when the equities warrant.³ In all that time, the Federal Circuit has not once suggested that the doctrine should be abolished entirely. On occasion, infringing assignors have pressed the court to reconsider *Diamond Scientific*, but each time, the court has refused. *See, e.g., Mentor Graphics Corp. v. EVE-USA, Inc.*, 851 F.3d 1275, 1283 (Fed. Cir. 2017); *Mentor Graphics Corp. v. EVE-USA, Inc.*, 870 F.3d 1298, 1304-06 (Fed. Cir. 2017) (Moore, J., concurring in the denial of panel rehearing). *Minerva* is only the latest party to see its “invitation to abandon the doctrine of assignor estoppel” rejected. Pet. App. 17a (quotation marks omitted).

The distinction the Federal Circuit has long drawn between licensee estoppel and assignor estoppel is sound. *See infra* Part II.A. But regardless, *Minerva*’s disagreement with the Federal Circuit’s decades-old

³ *See, e.g., MAG Aerospace Indus., Inc. v. B/E Aerospace, Inc.*, 816 F.3d 1374, 1379-80 (Fed. Cir. 2016); *Pandrol USA, LP v. Airboss Ry. Prods., Inc.*, 424 F.3d 1161, 1166 (Fed. Cir. 2005); *Mentor Graphics Corp. v. Quickturn Design Sys., Inc.*, 150 F.3d 1374, 1377 (Fed. Cir. 1998); *Carroll Touch, Inc. v. Electro Mech. Sys., Inc.*, 15 F.3d 1573, 1579 (Fed. Cir. 1993); *Shamrock Techs., Inc. v. Med. Sterilization, Inc.*, 903 F.2d 789, 794-95 (Fed. Cir. 1990).

reasoning does not create a split of authority, nor “the patent equivalent” thereof.

B. There Is No Split Over the Continued Vitality of Assignor Estoppel within the Federal Circuit

Minerva next attempts to show division over the continued vitality of assignor estoppel within the Federal Circuit. This supposed “split” does not withstand scrutiny.

1. Minerva cherry-picks bits and pieces from a concurrence in the denial of panel rehearing in *Mentor Graphics Corp. v. EVE-USA, Inc.*, but that concurring opinion does not constitute or reflect any “split of authority.” On Minerva’s telling, Judge Moore, joined by Judge Chen, subjected the doctrine of assignor estoppel to “extensive criticism” but ultimately concluded that it was “impossible” for the Federal Circuit to change it. Pet. 28; *see* Pet. 2 (same). That account seriously distorts what the judges said.

Judges Moore and Chen did not criticize assignor estoppel at all, much less “extensive[ly].” In fact, they expressly rejected the notion that the Federal Circuit “should entirely abolish the doctrine of assignor estoppel.” *Mentor Graphics*, 870 F.3d at 1306 (Moore, J., concurring in the denial of panel rehearing); *see id.* at 1304 (“[W]e do not believe we can *or should* eliminate the doctrine in its entirety ...” (emphasis added)). The closest they came to criticizing assignor estoppel was in stating that they “may be inclined” in a future case to reexamine some aspects of the doctrine’s scope. *Id.* at 1304. Far from demonstrating assignor estoppel’s “controversial status,” Pet. 1, the *Mentor Graphics* concurrence confirms that not a single Federal Circuit judge has questioned its basic applicability.

While Judges Moore and Chen did express doubt about whether the Federal Circuit could abolish assignor

estoppel altogether consistent with this Court's precedent, *see id.* at 1305-06, that simply highlights how revolutionary abrogating assignor estoppel would be. The weakness of Minerva's merits arguments hardly counsels in favor of granting its petition.

2. Minerva's reliance on Judge Stoll's additional views in this case is equally misplaced. Judge Stoll identified a logical inconsistency and deep unfairness in allowing assignors or their proxies to circumvent the assignor estoppel doctrine through IPR proceedings. *See* Pet. App. 31a-32a (Stoll, J., additional views). But Judge Stoll did not argue, as Minerva implies, that assignor estoppel should not apply in district court proceedings. She instead indicated that the divergence between the two forums could be resolved in two ways: either the Federal Circuit could "change the application of the doctrine in district court, or [it could] revisit [its] construction of the America Invents Act and reevaluate [its] interpretation of the statute as prohibiting the doctrine of assignor estoppel" in IPR proceedings. Pet. App. 32a.

Of the two options, Judge Stoll leaned toward the latter. Since the doctrine's rationale of avoiding unfairness is universal, she found it hard to understand why the doctrine would not apply before the Patent Office. *See* Pet. App. 14a-15a, 31a-32a (Stoll, J., additional views). Judge Stoll questioned: "Do the principles underlying assignor estoppel—unfairness in allowing one who profited from the sale of the patent to attack it—apply in district court but not in Patent Office proceedings?" Pet. App. 31a-32a (Stoll, J., additional views). The answer, of course, is "no"; fairness is fairness, and it should apply across the board.

Minerva is correct in one respect: Judge Stoll has identified a real divergence in the Federal Circuit's precedents that should be resolved, even though Miner-

va's petition is not the right vehicle for it. *See infra* Part III.B. But Judge Stoll did not contend that the Federal Circuit should resolve the divergence by abolishing assignor estoppel entirely. Instead, Judge Stoll's views are entirely consistent with the uniform support of the Federal Circuit for assignor estoppel's continued vitality.

C. No Other Court's Controlling Precedent Rejects Assignor Estoppel

In a last-ditch effort to manufacture a split, Minerva points to non-Federal Circuit cases in the wake of *Lear* suggesting that assignor estoppel was no longer good law. *See* Pet. 2.

None of those decisions, however, is controlling precedent in any jurisdiction. Only one cited decision even comes from a court of appeals, and it is a one-page summary affirmance decided by the Ninth Circuit in 1972. *See Coastal Dynamics Corp. v. Symbolic Displays, Inc.*, 469 F.2d 79 (9th Cir. 1972) (per curiam). A decade later, Congress established the Federal Circuit and gave it "exclusive jurisdiction" over patent appeals. 28 U.S.C. § 1295(a). That development deprived the Ninth Circuit's opinion of any precedential value it might have had, as district courts in that circuit have recognized. *See, e.g., Hewlett-Packard Co. v. Acuson Corp.*, No. 1:93-CV-0808, 1993 WL 149994, at *4 n.6 (N.D. Cal. May 5, 1993). Minerva's remaining cases all come from district courts and pre-date the Federal Circuit's decision in *Diamond Scientific*, which "laid to rest" any doubts over the doctrine's status. *Leading Edge Tech. Corp. v. Sun Automation, Inc.*, Civ. No. H-90-2316, 1991 WL 398682, at *6 (D. Md. Sept. 24, 1991).

II. The Federal Circuit Properly Applied Assignor Estoppel to the '348 Patent

On the merits, Minerva argues that this Court should abrogate assignor estoppel or, failing that, refuse

to apply it to the '348 Patent. The Federal Circuit rejected both of those arguments, and rightly so—assignor estoppel has been endorsed by this Court and remains a core part of patent law in cases like this.

A. The Federal Circuit Has Correctly Refused to Abrogate Assignor Estoppel

American courts have applied assignor estoppel for centuries, dating back to the republic's earliest years. To this day, the doctrine remains fully consistent with this Court's precedents, the Patent Act's text, and the objectives of patent law.

1. Assignor estoppel is a venerable part of the common law that has been “undeviatingly enforced by English-speaking courts in this country, in England, in Canada, and Australia.” *Scott Paper*, 326 U.S. at 260 (Frankfurter, J., dissenting). Since 1793, Congress has allowed inventors to assign their patents, and courts began applying basic estoppel principles in commercial transactions at roughly the same time. *See id.* at 259. During this period, it was “never ... questioned that courts [would] not make themselves instruments of unfair dealing when what is sold is a patent.” *Id.* And once the question of estoppel was squarely raised in patent assignment cases, courts quickly produced a “voluminous[.]” supply of opinions, *id.* at 261, affirming that assignors “in justice” should not “be allowed to derogate from their own grant by setting up that it did not pass.” *Faulks v. Kamp*, 3 F. 898, 901 (C.C.S.D.N.Y. 1880); *see* 6 Moy's Walker on Patents § 17:35 (4th ed. 2017) (suggesting patent estoppel emerged “at least as early as 1856”); Amber L. Hatfield, Note, *Life After Death for Assignor Estoppel: Per Se Application to Protect Incentives to Innovate*, 68 Tex. L. Rev. 251, 259-60 (1989) (citing the doctrine's establishment in Great Britain in 1789 and first appearance in the United States in 1855).

By the time this Court “fully considered” assignor estoppel for the first time in *Westinghouse Electric & Manufacturing Co. v. Formica Insulation Co.*, 266 U.S. 342, 349 (1924), the doctrine was already “well settled” in the lower courts. *Id.* Writing for a unanimous Court, Chief Justice Taft observed that “a myriad” of cases had followed the doctrine’s first recorded application, and subsequent decades of “judicial consideration and conclusion” had led to remarkable unanimity about the doctrine “in the reports of the Circuit and District Court decisions,” as well as those of “nearly all the Circuit Courts of Appeal.” *Id.*

Adding its voice to the chorus, the *Westinghouse* Court unanimously endorsed the assignor estoppel doctrine. The Court found a clear “analogy between estoppel in conveyances of land and estoppel in assignments of a patent right.” *Id.* at 350. In the Court’s view, if someone conveys a patent right, “fair dealing should prevent him from derogating from the title he has assigned, just as it estops a grantor of a deed of land from impeaching the effect of his solemn act as against his grantee.” *Id.* “As to the rest of the world, the patent may have no efficacy and create no right of monopoly,” the Court held, “but the assignor cannot be heard to question the right of his assignee to exclude him from its use.” *Id.* at 349. The Court concluded that “[i]t was manifestly intended by Congress to surround the conveyance of patent property with safeguards resembling those usually attaching to that of land.” *Id.*

Assignor estoppel’s limits of course are not boundless. In *Westinghouse* itself, the Court held that before assignor estoppel can apply, courts must determine what the assignor actually assigned. For that purpose, they may examine prior art—“the most satisfactory means of measuring the extent of the grant ... which the assignor assigned.” *Id.* at 350. The Court further clarified in

Scott Paper Co. v. Marcalus Manufacturing Co., that an assignor accused of infringement may defend itself by showing that “the alleged infringing device is that of an expired patent.” 326 U.S. at 258. But the Court did not allow the assignor to attack the validity of the assignee’s patent itself. *Scott Paper* thus declined to reconsider the doctrine’s continued vitality and in fact reaffirmed “[t]he rule, as stated by this Court in [*Westinghouse*] ... ‘that an assignor of a patent rent is estopped to attack the utility, novelty or validity of a patented invention which he has assigned or granted as against any one claiming the right under his assignment or grant.’” *Id.* at 251-52 (quoting *Westinghouse*, 266 U.S. at 349).

Nevertheless, Minerva argues that assignor estoppel is inconsistent with the Court’s subsequent decision in *Lear*. Decided at the “zenith” of mid-20th century “anti-patent bias,” Hatfield, *supra*, at 266-67 (citation omitted), *Lear* did not even involve assignor estoppel, but rather the separate doctrine of licensee estoppel. The Court acknowledged that patent estoppel doctrines had “been considered by this Court in a line of cases reaching back into the middle of the 19th century,” and that their roots “have often been celebrated in tradition.” *Lear*, 395 U.S. at 662-63. But the Court nonetheless abrogated licensee estoppel because it considered that doctrine inconsistent with the “policy” and “concerns” underlying federal patent law, including the interest in eliminating invalid patents. *Id.* at 668. Finding no “acceptable middle ground” or “creative compromise” between contract law and the policies underlying patent law, *Lear* sided with the latter and determined that the “requirements of contract doctrine must give way before the demands of the public interest.” *Id.* at 668, 670.

Lear does not support the abolition of assignor estoppel. Contrary to Minerva’s claims, *see* Pet. 24, assignor estoppel and licensee estoppel rest on very differ-

ent legal foundations. Assignor estoppel has roots in estoppel by deed, *see Westinghouse*, 266 U.S. at 348-49, which offer no support for doctrines like licensee estoppel, where no title to anything is conveyed.

Assignor estoppel also does not raise the same policy concerns that motivated the Court in *Lear*. As the Federal Circuit has explained, “[t]he public policy favoring allowing a licensee to contest the validity of the patent is not present in the assignment situation.” *Diamond Sci.*, 848 F.2d at 1224. Licensee estoppel compels a licensee “to continue to pay for a potentially invalid patent,” *id.*—to “shut up and keep paying,” Hatfield, *supra*, at 270. An assignor, by contrast, “has already been fully paid for the patent rights” based on a representation that those rights are worth something. *Diamond Sci.*, 848 F.2d at 1224.

Licensee estoppel also would make many patents effectively unchallengeable in ways that assignor estoppel does not. Many markets are dominated by one patent holder who has licensed out an invention to all of its competitors. If licensee estoppel applied to those competitors, who are “often ... the only individuals with enough economic incentive to challenge” a patent, *Lear*, 395 U.S. at 670, it could make the patent effectively invulnerable. But while a patent may have many licensees, it generally has just *one* assignor. And assignor estoppel applies only to that assignor and its privies, leaving “the rest of the world” free to challenge the patent’s validity. *Westinghouse*, 266 U.S. at 349. Furthermore, while assignors are well positioned to contract around assignor estoppel if they want to, bargaining for the right to later challenge the patent rights they are assigning, *see Mentor Graphics*, 150 F.3d at 1378, licensees who need access to the licensor’s invention in order to compete may be less able to do so.

2. Assignor estoppel also is fully consistent with the text of the Patent Act. One of the most fundamental principles of statutory interpretation is that “Congress is understood to legislate against a background of common-law adjudicatory principles.” *Astoria Fed. Sav. & Loan Ass’n v. Solimino*, 501 U.S. 104, 108 (1991). This Court has repeatedly held that “where a common-law principle is well established, *as are the rules of preclusion*, the courts may take it as given that Congress has legislated with an expectation that the principle will apply except when a statutory purpose to the contrary is evident.” *Id.* (emphasis added) (quotation marks omitted); see A. Scalia & B. Garner, *Reading Law* 318 (2012) (“[S]tatutes will not be interpreted as changing the common law unless they effect the change with clarity,” which “ordinarily” requires more than “implied change.”). This Court regularly applies that presumption, including in patent cases. See, e.g., *Impression Prods., Inc. v. Lexmark Int’l, Inc.*, 137 S. Ct. 1523, 1536 (2017) (common-law patent exhaustion “remains an unwritten limit on the scope of the patentee’s monopoly”); *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 148-51 (2015) (preclusive effect of TTAB rulings); *Kirtsaeng v. John Wiley & Sons, Inc.*, 568 U.S. 519, 538-39 (2013) (copyright exhaustion).

Here, Congress did not override the doctrine of assignor estoppel in the Patent Act. Congress certainly did not “speak directly” to the question. *United States v. Texas*, 507 U.S. 529, 534 (1993). And there is nothing to indicate that assignor estoppel’s application would render any aspect of the statute superfluous or inoperative. See *Astoria*, 501 U.S. at 109; *Warner-Jenkinson Co. v. Hilton-Davis Chem. Co.*, 520 U.S. 17, 25-26 (1997) (holding that the 1952 Patent Act did not abrogate the non-statutory doctrine of equivalents). Even in *Lear*, the Court never hinted that Congress abolished licensee es-

toppel or any other estoppel doctrine through the Patent Act.

Minerva nonetheless claims that because the Patent Act does not expressly recognize assignor estoppel, it necessarily abolishes it. That approach not only flips the rules of statutory interpretation on their head, but also proves too much. Taken to its logical conclusion, Minerva's argument would abrogate not just assignor estoppel but *any* preclusion doctrine not mentioned in the Patent Act. That would include patent-specific doctrines like prosecution history estoppel, as well as more general doctrines like collateral estoppel, *res judicata*, and law of the case. It takes considerable chutzpah for Minerva to suggest as much when it deployed one of those very doctrines against Hologic in this case. Minerva prevailed on its challenge to the '183 Patent not because it convinced the district court of the patent's invalidity, but because it used a Patent Office ruling to collaterally estop Hologic. Pet. App. 11a-17a.

Minerva cannot have it both ways: either the Patent Act is read against background common-law principles, as this Court's precedents uniformly provide, or it is not. If the former, then there can be no doubt that the doctrine of assignor estoppel is entirely consistent with the Patent Act.

3. Assignor estoppel also serves the objectives of patent law. The Constitution authorizes Congress to grant inventors time-limited monopolies in the form of patents "[t]o promote the Progress of Science and useful Arts." U.S. Const., art. 1, § 8, cl. 8. Congress has exercised that authority to allow inventors to assign their patents (and patent applications) in part because alienability increases the value of those inventions. But if potential assignees cannot trust that potential assignors will not abuse their privileged position as the original inven-

tor to challenge the validity of a patent, then they may be unwilling to agree to the assignment in the first place. Assignor estoppel thus reflects the same logic that supports good faith and fair dealing in every commercial transaction.

If an assignor wishes to preserve its right to challenge the patent rights it is assigning, moreover, he can always contract for that right. *Mentor Graphics*, 150 F.3d at 1378. Even if he does not, he may still try to narrow the scope of the patent (as *Minerva* did here), see *Westinghouse*, 266 U.S. at 350-51, or argue against infringement by invoking an expired patent, see *Scott Paper*, 326 U.S. at 258. If assignor estoppel were abrogated, however, it would be far more difficult to contractually *prohibit* assignors from challenging assigned patent rights. Courts may decline to enforce such an agreement with an injunction, and damages may not adequately remedy an assigned patent being invalidated. See David R. Bauer & Gregory R. Baden, *Patent Buyers Beware—Former Owner of a Patent Can Challenge Its Validity in an Inter Partes Review*, 29 *Intell. Prop. & Tech. L.J.* 3, 5 (2017).

Assignor estoppel also encourages innovation. Once an inventor gives away patent rights for valuable consideration, he has a choice: go back on his word and try to persuade courts that what he sold was actually worthless, or continue to innovate, creating new products that do not infringe his original invention. By preventing the former, assignor estoppel incentivizes the latter, advancing the fundamental purpose of the patent system.

B. The Federal Circuit Correctly Determined that Assignor Estoppel Applies Here

Minerva alternatively argues that even if this Court does not abolish assignor estoppel outright, it should hold that the doctrine does not apply to this specific case.

Those fact-bound arguments are neither meritorious nor worthy of this Court's review.

1. Minerva claims that assignor estoppel should not apply here because Hologic allegedly “expanded the scope of the patent’s claims beyond that which was assigned by Truckai years earlier.” Pet. 15; *see, e.g.*, Pet. 4, 22. That is flatly false, reflecting a fallacy that runs throughout Minerva’s petition. Truckai did not assign the rights to particular patents or patent claims. He assigned the rights to several patent applications, along with the relevant “invention” and “any Letters Patent which may hereafter be granted on the same ... including any ... continuations in whole or in part.” C.A. App. 17204; *see* C.A. App. 16246-47, 17208-09. Minerva is therefore wrong when it claims that it “did not assert that what [Truckai] had originally assigned many years earlier lacked value.” Pet. 4. Of course it did—Minerva asserted, and continues to assert, that one of the “Letters Patent which [was] hereafter ... granted” is worthless, even though that now-issued patent is part of what Truckai originally assigned and what Hologic’s predecessor bought for \$325 million.

Courts, including this one, have endorsed the application of assignor estoppel in cases where the assigned patent rights evolved after assignment. As this Court has recognized, a pre-patent assignment is “subject to change by curtailment or enlargement by the Patent Office with the acquiescence or at the instance of the assignee.” *Westinghouse*, 266 U.S. at 353. Indeed, such changes are “a very common occurrence in patent prosecutions.” *Diamond Sci.*, 848 F.2d at 1226. The fact that the final scope of the patent “may ultimately include more than the assignor intended to claim” can make “fixing the limits of the subsequent estoppel” more difficult, but it does not change the fact that there will be a “subsequent estoppel.” *Westinghouse*, 266 U.S. at 353; *see*

Q.G. Prod., Inc. v. Shorty, Inc., 992 F.2d 1211, 1213 (Fed. Cir. 1993); *Shamrock Techs., Inc. v. Med. Sterilization, Inc.*, 903 F.2d 789, 795 (Fed. Cir. 1990). Put differently, the question is not whether the assignor is estopped from challenging the validity of anything he assigned—he is—but rather whether what he assigned encompasses what he wants to challenge. Here, there is no doubt that what Truckai assigned encompasses the '348 Patent, making this a textbook case for the doctrine's application. See *Diamond Sci.*, 848 F.2d at 1226.

Minerva also claims that Hologic inequitably “expanded” the scope of Truckai’s assignment specifically to box his new product out of the market. See, e.g., Pet. 22. But Minerva provides no evidence—none—to support this insinuation. Worse, Minerva fails to mention that it tried this theory before a jury and lost. Minerva argued at trial that Hologic breached its non-disclosure agreement with Minerva by misusing “Minerva’s confidential information ... to pursue additional intellectual property rights.” C.A. App. 2220. The jury disagreed and found for Hologic. C.A. App. 98. That should dispel any notion that Hologic “weaponized” the rights it purchased. Pet. 29.

The courts below, moreover, considered the evolution of the assigned patent rights as part of their weighing of the equities. See Pet. App. 18a-20a, 58a. Mindful “that assignor estoppel is not a ‘broad equitable device susceptible of automatic application,’” the Federal Circuit nevertheless agreed “with the district court that the equities weigh in favor of [assignor estoppel’s] application in this case.” Pet. App. 18a. The only “seeming unfairness” came not from the doctrine’s application to Minerva as to the '348 Patent, but from the fact that Minerva “circumvent[ed]” the doctrine as to the '183 Patent. Pet. App. 14a. Even if this Court might balance the eq-

unities differently, the lower courts' conclusion was in no way an abuse of discretion.

In any event, Minerva's arguments about an alleged expansion of the assigned patent rights would embroil the Court in fact-bound questions about whether and how the rights here were expanded. For example, Minerva misleads in arguing that Hologic expanded its patent rights to quash a new product that is more effective than NovaSure. *See* Pet. 9. Effectiveness is irrelevant to the application of assignor estoppel, and regardless, many peer-reviewed articles have confirmed that the two products are "[e]ssentially comparable" in their success rates. July 17 Trial Transcript, *supra*, at 513:13. Minerva can claim otherwise only through an apples-to-oranges comparison: contrasting the data for its current product with data collected two decades ago using outdated techniques, a different patient population, and an older model of NovaSure. *Id.* at 511:7-516:21.

Minerva's petition also is replete with detailed discussion of different ablation systems and whether Truckai's original invention was limited to a device with a moisture-permeable applicator head. *See* Pet. 6-11, 29-31. In rejecting Minerva's claim construction and Section 112 invalidity arguments, the lower courts already rejected these fact-bound arguments, and there is no point in this Court granting certiorari so that the parties can relitigate them once again. One can characterize debates over the moisture-permeability of ablation device applicator heads in many ways, but surely they do not merit this Court's review.

2. Minerva also suggests that assignor estoppel should not apply to invalidity challenges based on Section 112's written description and enablement requirements. Pet. 3. Before the Federal Circuit, Minerva did not raise that argument until its reply brief—which, pre-

sumably, is why the decision below does not mention the issue. The argument is waived.

Regardless, by Minerva's own count, prior to this case, "[t]he Federal Circuit had never before applied assignor estoppel to" a Section 112 invalidity argument. Pet. 3. It has been 32 years since the Federal Circuit affirmed assignor estoppel in *Diamond Scientific*, and more than twice that long since Section 112 was enacted. If this is the first time this issue has arisen, then it is not the kind of "important question of federal law that has not been, but should be, settled by this Court." S. Ct. R. 10(c).

III. Minerva's Petition Is a Poor Vehicle for Addressing the Continued Viability of Assignor Estoppel

Minerva's petition should be denied for reasons beyond its substantive problems. Minerva is asking this Court to render an advisory decision that will have no effect on the outcome of this case. And Minerva's petition is carefully gerrymandered to prevent this Court from engaging with both sides of the only real doctrinal divergence that Minerva has identified.

A. Independent and Adequate Grounds Support the Decision Below Against Minerva

Minerva asks the Court to decide "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." Pet. i. But Minerva omits that it has *already had* its "defense of invalidity heard on the merits," and that defense was rejected. Minerva is thus seeking a mere advisory opinion.

As noted, while the district court held that Minerva was barred by the doctrine of assignor estoppel from disputing the '348 Patent's validity, the court also held that, in any event, the '348 Patent was valid. Pet. App.

62a-63a. It therefore granted Hologic’s motions for summary judgment on both assignor estoppel and invalidity. Pet. App. 58a, 64a.

On appeal, Minerva challenged both of the district court’s holdings—on assignor estoppel and the merits of its invalidity defense—and again lost on both counts. The Federal Circuit not only “affirm[ed] the district court’s ... summary judgment that assignor estoppel bars Minerva from challenging the validity of the asserted ’348 patent claim,” but also separately affirmed “the district court’s summary judgment of no invalidity.” Pet. App. 30a-31a.

Minerva now asks this Court to revisit only the first holding—that assignor estoppel bars Minerva from challenging the ’348 Patent’s validity. Even if Minerva were to prevail on that issue, it would be a Pyrrhic victory—the court of appeals has already affirmed the ’348 Patent’s validity, and Minerva has understandably not petitioned for review of that wholly case-specific determination.

This Court does “not sit to decide hypothetical issues or to give advisory opinions.” *Princeton Univ. v. Schmid*, 455 U.S. 100, 102 (1982). Minerva’s petition should be denied for that reason alone.

B. Hologic’s Cross-Petition Is the Superior Vehicle

Minerva’s petition also is a poor vehicle because it fails to confront the only real divergence in the Federal Circuit’s doctrine on assignor estoppel. Minerva recognizes that the Federal Circuit’s current “approach to assignor estoppel” is “at odds with itself” insofar as it allows assignor estoppel to be applied in district court but not in IPR proceedings. Pet. 1. For the Court to sensibly address that problematic divergence, however, it must be able to consider the doctrine’s application in both forums simultaneously. While Minerva’s petition

does not present that opportunity, Hologic’s cross-petition does.

In recent years, two strands of the Federal Circuit’s case law on assignor estoppel have increasingly diverged. On one hand, the Federal Circuit has faithfully applied the rule endorsed by *Westinghouse* in district courts, ensuring that assignees like Hologic are not unfairly exploited by assignors like Minerva. On the other hand, in a separate case involving the America Invents Act, the Federal Circuit has held that there is “no room for assignor estoppel in the IPR context.” *Arista*, 908 F.3d at 803. The result is an acknowledged “discrepancy between forums”—assignors cannot challenge the validity of an assigned patent in district court, but they can file an IPR petition challenging the validity of that same patent before the PTAB. *Id.* at 804.

Minerva exploited that divergence in this case. While trying to litigate the validity of the relevant patents in the district court, it filed IPR petitions to invalidate the same patents through the PTAB. The PTAB denied Minerva’s attempt as to the ’348 Patent, but it reviewed and ultimately invalidated the asserted claims of the ’183 Patent. Minerva then “circumvent[ed] the assignor estoppel doctrine” by using that administrative invalidation to collaterally estop Hologic back in district court. Pet. App. 14a.

Convinced that it was “bound” by precedent, Pet. App. 2a, the Federal Circuit affirmed Minerva’s end-run around assignor estoppel. But the court had no illusions about the inequity of that result. It was “mindful of the seeming unfairness to Hologic,” Pet. App. 14a, and sympathetic to “Hologic’s predicament,” Pet. App. 15a. Judge Stoll wrote separately to underscore that the outcome was “peculiar,” “odd,” and “seemingly illogical.” Pet. App. 31a-32a (Stoll, J., additional views).

Minerva is right that “[r]esolving this conflict ... is a compelling reason for this Court’s review.” Pet. 28. But Minerva’s petition does not actually allow this Court to grapple with both sides of the “dual-track system.” Pet. 14. By focusing solely on the patent that the PTAB *declined* to review because there was no reasonable likelihood of finding unpatentability (the ’348 Patent), Minerva’s question *avoids* the divergence between the district court and Patent Office. Indeed, Minerva has previously acknowledged that review of the estopped ’348 Patent could bring “consistency to the [Federal Circuit’s] assignor estoppel precedents, but only ... by revising the doctrine’s application in district court.” Minerva Pet. for Reh’g 12. But fixing the inconsistency here requires reevaluating how assignor estoppel “applies *both* in district court *and* in the Patent Office,” Pet. App. 32a (Stoll, J., additional views) (emphases added). Cutting out the IPR half of that equation, as Minerva’s petition does, would defeat that objective and perpetuate the forum-specific analysis that contributed to the problematic divergence in the Federal Circuit’s precedents in the first place.

By contrast, Hologic’s cross-petition gives this Court the opportunity to address the only real split Minerva has identified. Hologic’s cross-petition squarely asks this Court to decide “whether an assignor of a patent may circumvent the doctrine of assignor estoppel by challenging the validity of the assigned patent in administrative proceedings before the Patent Office, and then using the Patent Office’s finding of invalidity to collaterally estop the *assignee* from relying on the patent in infringement litigation in district court.” Hologic Cross-Pet. at I. If the Court grants certiorari on that question, Minerva will still be able to argue that the assignor estoppel doctrine should be repudiated root and branch. But the Court will also be able to consider alternative

ways to resolve the divergence in the doctrine's application—by interpreting the America Invents Act not to prohibit the doctrine of assignor estoppel, or by preserving the separate regimes in each forum but preventing assignors from using the outcome of IPR proceedings to outflank assignees in district court.

Hologic's cross-petition is thus the superior vehicle for addressing the divergence in the assignor estoppel doctrine's application between district courts and IPR proceedings. Minerva's petition should be denied.

CONCLUSION

The Court should deny the petition for a writ of certiorari.

Respectfully submitted.

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