

Minerva Surgical, Inc. v. Hologic, Inc., 141 S. Ct. 2298 (2021)

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The inventor of a patent assigned to Hologic subsequently founded Minerva Surgical. Hologic then filed a continuation with broader claims. Based on that broader patent, Hologic brought an infringement case against Minerva, which asserted the patent was invalid. Hologic argued that the invalidity defense was barred under the doctrine of assignor estoppel and the district court agreed. The U.S. Court of Appeals for the Federal Circuit affirmed that decision, rejecting Minerva's argument that assignor estoppel does not apply because Hologic broadened the claims—after the inventor's assignment—without the inventor's input. The U.S. Supreme Court granted certiorari on the issue.

Assignor estoppel remains a valid doctrine, but its scope is limited.

The Court held that assignor estoppel was still a valid doctrine but that it was more limited in scope than the Federal Circuit recognized. Specifically, the Court held that an accused infringer is only estopped from setting forth invalidity defenses that are in conflict with a prior explicit or implicit representation that the infringer made in assigning the patent. For example, in this case, assuming that the new claims were materially broader than the old ones, the assignor had not made any representation about the new claim's validity. Therefore, assignor estoppel would not apply. As such, the Court vacated and remanded the Federal Circuit's judgment.

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