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Petitioner And Amicus Briefs Lay Out Arguments In Supreme Court Fight Over Assignor Estoppel

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Kilpatrick Townsend's Post-Grant Team is pleased to highlight a recent post from our Firm's Biopharma MEMO Blog.

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As previously reported, in January 2021, the Supreme Court granted a petition for a writ of certiorari filed by Minerva Surgical, Inc. on the question of "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."[1,2]

At issue is the doctrine of assignor estoppel, an equitable doctrine that prevents a party (or other entities in privity) who assigned a patent to another from later challenging the validity of the assigned patent in district court.[3] Minerva argues for the abolition of the doctrine, which prevents it from challenging the validity of two patents owned by Hologic because these patents were assigned by Minerva's founder and president to a company that was eventually acquired by Hologic.[4]

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[1] Petition for Writ of Certiorari at *i, *Minerva Surgical, Inc. v. Hologic, Inc*., No. 20-440, 2020 WL 5947901 (U.S. Sept. 30, 2020).

[2] *See Hologic, Inc. v. Minerva Surgical, Inc*., 957 F.3d 1256 (Fed. Cir. 2020), *cert. granted*, 141 S. Ct. 975 (2021), and *cert. denied*, No. 20-631, 2021 WL 78178 (Jan. 11, 2021).

[3] *See* 957 F.3d at 1260.

[4] *See id*. at 1261-62.