

No. 20-440

In the Supreme Court of the United States

MINERVA SURGICAL, INC., PETITIONER,

v.

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

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

BRIEF FOR RESPONDENTS

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QUESTION PRESENTED

The question presented is whether this Court should eliminate the longstanding doctrine of assignor estoppel or, alternatively, narrow the doctrine in some way.

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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INTRODUCTION

For a century and a half, American courts have held that assignors are estopped from challenging the value and validity of the patent rights they assign. A hundred years ago, this Court unanimously upheld this doctrine in *Westinghouse Electric & Manufacturing Co. v. Formica Insulation Co.*, 266 U.S. 342 (1924). The Court declared that Congress “manifestly intended” assignor estoppel as part of the statute authorizing assignment of patent rights, and that, even at that time, assignor estoppel was too “well settled” to upend. *Id.* at 349. Courts applied assignor estoppel regularly for the next three decades in the context of both assigned patents and assigned applications, and in 1952, against the backdrop of that unbroken consensus, Congress reenacted the relevant provision.

Minerva now claims that every single one of those dozens of judicial decisions was not just wrong, but “uncommonly lawless.” Br. 2. Minerva accordingly wants this Court either to eliminate assignor estoppel entirely or to substantially narrow the doctrine’s traditional scope.

Eliminating assignor estoppel would require overriding both Congress and this Court’s own precedent. Congress cemented assignor estoppel in the patent laws in 1952 by reenacting language this Court had construed to incorporate the doctrine, consistent with a universal lower-court consensus. Congress aside, *Westinghouse* authoritatively holds that the patent laws incorporate assignor estoppel. Notably, not a single *amicus* meaningfully argues for eliminating the doctrine entirely.

Minerva offers scant support for ripping away layer upon layer of settled law. Its textual argument rests on statutory language that is not new but has coexisted with assignor estoppel all along, and in any event says nothing to contradict the doctrine. Any concern about barring assignors from challenging their own patents in court is less

significant than ever before, now that the Patent Office can reconsider any patent's validity if there is real cause for concern. And this Court's abrogation of a different estoppel doctrine in 1969 does nothing to unsettle assignor estoppel today.

Contrary to Minerva's narrative, this case falls in assignor estoppel's heartland. Minerva's principal, Csaba Truckai, invented an innovative medical device that his company sold to Hologic's predecessor, with the accompanying patent rights, for millions of dollars. Truckai then formed Minerva to sell a new device that, in its own words, is "almost dead identical." And to avoid the resulting infringement liability, Minerva now seeks to invalidate a Hologic patent through arguments that directly contradict Truckai's sworn representations to the Patent Office. Truckai had declared under oath that his original invention did not require a moisture-permeable applicator head. But Minerva wants to argue the opposite, and Truckai testified at trial that he had secretly doubted whether his earlier representations were true. That is exactly the kind of opportunistic about-face that assignor estoppel prohibits—and rightly so.

Nor should this Court narrow assignor estoppel's scope. Minerva and several *amici* offer a menu of "options" to amend the doctrine. Br. 42. But selecting among competing policy proposals is a project better suited for Congress, especially when the proposals on the table are all riddled with doctrinal and practical problems.

American courts have long recognized the value of assignor estoppel in promoting innovation, facilitating patent sales, and keeping inventors honest. For decades, *millions* of patents have been sold on the assumption that the doctrine applies. Minerva seeks to unsettle that consensus, those reliance interests, and any hope of clear assignment rules for years to come. This Court should decline its invitation.

STATUTES INVOLVED

Pertinent statutes are set forth in Appendix A.

STATEMENT**A. Legal Background**

Since at least 1880, American courts have held that the patent laws bar assignors and their privies from attacking the validity of the patent rights they assign. That doctrine, drawn from the common-law principle of estoppel by deed, is now known as assignor estoppel.

1. The earliest recorded application of assignor estoppel is an English decision by Lord Chief Justice Kenyon in 1789. As Lord Kenyon later described: “In the case of *Oldham v. Langmead*, the patentee has conveyed his interest in the patent to the plaintiff, and yet . . . he afterwards infringed the plaintiff’s right, and then attempted to deny his having had any title to convey: but I was of opinion that he was estopped by his own deed, from making that defence.” *Hayne v. Maltby* (1789) 100 Eng. Rep. 665, 666; 3 T.R. 438, 441. English courts applied the doctrine throughout the 19th century. *See, e.g., Chambers v. Chrichley* (1864) 55 Eng. Rep. 412, 412; 33 Beav. 374, 374 (“It does not lie in [an assignor’s] mouth to say that the patent is not good.”).

American courts began applying assignor estoppel by 1880. As explained in *Faulks v. Kamp*, 3 F. 898 (C.C.S.D.N.Y. 1880):

Whosoever assumes to sell a patent assumes to sell that property, and assumes that he had it to sell. . . . After that, in justice, they ought not to be heard to say that they had it not and did not sell it, and to be allowed to derogate from their own grant by setting up that it did not pass.

Id. at 900-01.

The doctrine quickly gained universal acceptance. The 1883 edition of a leading patent treatise declared that “[e]stoppel by matter of deed may . . . arise in patent affairs,” and thus “[w]here . . . an assignor or grantor of a patent right, afterward infringes the right which he conveyed, he is estopped, by his conveyance, from denying the validity of the patent.” Albert H. Walker, *Text-Book of the Patent Laws of the United States of America* § 469, at 336 (1883). An 1890 treatise agreed that “[t]he assignor of a patented invention is estopped from denying the validity of the patent.” 2 William C. Robinson, *The Law of Patents for Useful Inventions* § 787, at 555-57 (1890); see U.S. Br. 16 (citing additional treatises).

Courts soon described assignor estoppel as “well settled,” *Noonan v. Chester Park Athletic Club Co.*, 99 F. 90, 91 (6th Cir. 1900), and “the undoubted rule,” *W. Tel. Constr. Co. v. Stromberg*, 66 F. 550, 551 (C.C.N.D. Ill. 1895)—subject to “no doubt,” *Daniel v. Miller*, 81 F. 1000, 1001 (C.C.E.D. Pa. 1897), and “no question,” *Burdsall v. Curran*, 31 F. 918, 919 (C.C.N.D. Ill. 1887). The doctrine was “so well established and generally accepted that citation of authority is useless.” *Griffith v. Shaw*, 89 F. 313, 315 (C.C.S.D. Iowa 1898). Assignor estoppel was applied routinely, including when the assigned rights evolved after assignment. *E.g.*, *Burdsall*, 31 F. at 919; *Onderdonk v. Fanning*, 4 F. 148, 148-50 (C.C.E.D.N.Y. 1880); *Nat’l Conduit Mfg. Co. v. Conn. Pipe Mfg. Co.*, 73 F. 491, 494-95 (C.C.D. Conn. 1896); Walker, *supra*, § 469.

At least 69 cases applied or recognized assignor estoppel between 1880 and 1924. App. B.

2. In 1924, this Court first considered assignor estoppel in *Westinghouse*. Writing for a unanimous Court, Chief Justice Taft found that, given the statutory provision authorizing assignment of patents and patent applications, it was “manifestly intended by Congress to surround the conveyance of patent property with safeguards

resembling those usually attaching to that of land,” including the common-law principle of “estoppel by deed.” 266 U.S. at 348-49. Because “myriad” lower-court decisions had applied assignor estoppel, this Court declared that it would “not now lightly disturb a rule well settled by 45 years of judicial consideration and conclusion.” *Id.* at 349.

From 1924 to 1952, almost twenty cases—including seven circuits—cited *Westinghouse* as upholding assignor estoppel. App. C. The First and Sixth Circuits, for instance, recognized that *Westinghouse* “announced the conclusion”—*i.e.*, “held”—that “an assignor of a patent right is estopped to attack the utility, novelty, or validity of a patented invention[] which he has assigned.” *West v. Premier Register Table Co.*, 27 F.2d 653, 654 (1st Cir. 1928) (quotation marks omitted); *Buckingham Prods. Co. v. McAleer Mfg. Co.*, 108 F.2d 192, 193 (6th Cir. 1939). Other post-*Westinghouse* cases described assignor estoppel as “clear,” *Wilson v. Byron Jackson Co.*, 93 F.2d 572, 575 (9th Cir. 1937), subject to “no doubt,” *Automatic Draft & Stove Co. v. Auto Stove Works*, 34 F. Supp. 472, 476 (W.D. Va. 1940), and “well” or “firmly settled,” *Frick Co. v. Lindsay*, 27 F.2d 59, 61 (4th Cir. 1928); *U.S. Appliance Corp. v. Beauty Shop Supply Co.*, 121 F.2d 149, 151 (9th Cir. 1941); *Casco Prods. Corp. v. Sinko Tool & Mfg. Co.*, 116 F.2d 119, 121 (7th Cir. 1940); *Crom v. Cement Gun Co.*, 46 F. Supp. 403, 406 (D. Del. 1942).

Treatises during this period continued to recognize assignor estoppel as settled law, citing *Westinghouse*. *E.g.*, Joseph V. Meigs, *Time, the Essence of Patent Law* 240-45 (1940); 3 Anthony W. Deller, *Walker on Patents* § 685, at 1994-99 (1937 ed.).

3. In *Scott Paper Co. v. Marcalus Manufacturing Co.*, 326 U.S. 249 (1945), this Court 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). The Court carved out an exception where “the accused machine is precisely that of an expired patent,” *id.* at 254, but explicitly declined to disturb *Westinghouse*’s general “rule,” *id.* at 253.

Following *Scott Paper*, lower courts continued to recognize assignor estoppel as settled law. *E.g.*, *Timken-Detroit Axle Co. v. Alma Motor Co.*, 163 F.2d 190, 191 (3d Cir. 1947) (“[T]he state of the art cannot be used to destroy the patent and defeat the grant, because the assignor is estopped to do this.” (quoting *Westinghouse*, 266 U.S. at 351)); *Brown v. Insurograph, Inc.*, 90 F. Supp. 828, 830 (D. Del. 1950) (reiterating “the broad, general rule” of assignor estoppel, citing *Westinghouse* and *Scott Paper*); *cf. Hope Basket Co. v. Prod. Advancement Corp.*, 187 F.2d 1008, 1012 (6th Cir. 1951) (“This basic rule of estoppel may have been somewhat modified by the ruling in *Scott Paper* . . . , but it was not abolished.”).

From 1945 to 1952, treatises continued to describe assignor estoppel as settled law, acknowledging *Scott Paper*. *E.g.*, Robert Calvert, *Patent Practice & Management for Inventors & Executives* 220 & n.12 (1950); Harry Aubrey Toulmin, Jr., *Patents and the Anti-Trust Laws of the United States, Including Trade-Marks and Copyrights* § 6.9, at 129-32 (1950).

4. In 1952, Congress reenacted without material change the patent-assignment provision that this Court had construed in *Westinghouse*. See Pub. L. No. 82-593, § 261, 66 Stat. 792, 810 (1952) [1952 Patent Act] (codified as amended at 35 U.S.C. § 261). Congress also reenacted without material change a provision stating that “invalidity” shall be a defense “in any action” for infringement. 1952 Patent Act § 282 (codified as amended at 35 U.S.C. § 282(b)). The 1870 statute had likewise made invalidity a

defense “in any action” for infringement, Act of July 8, 1870, ch. 230, § 61, 16 Stat. 198, 208 [1870 Patent Act], and the 1793 statute “in an action.” Act of Feb. 21, 1793, ch. 11, §§ 5-6, 1 Stat. 318, 322 [1793 Patent Act].

5. Courts continued applying assignor estoppel regularly in the years after 1952. *E.g.*, *Rex Chainbelt, Inc. v. Gen. Kinematics Corp.*, 363 F.2d 336, 347 (7th Cir. 1966). Following this Court’s decision in *Lear, Inc. v. Adkins*, 395 U.S. 653 (1969), which abrogated the distinct doctrine of licensee estoppel, a few courts expressed uncertainty about assignor estoppel. *See Diamond Sci. Co. v. Ambico, Inc.*, 848 F.2d 1220, 1223 (Fed. Cir. 1988). But in 1988, the Federal Circuit reaffirmed assignor estoppel’s vitality, *id.* at 1224-25, and since then, courts have applied the doctrine consistently, Pet. App. 11a-14a.

B. Factual Background

1. In the late 1990s, Csaba Truckai co-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 (destroyed) to treat abnormally heavy menstrual bleeding. Pet. App. 2a. Earlier devices ablated the endometrial lining either bit by bit or all at once using heated fluids, which posed safety concerns. J.A. 106-07; S.A. 824. NovaSure ablates the entire lining simultaneously using an expandable applicator head that conforms to the shape of the uterus, making the procedure safer, quicker, and cheaper. J.A. 46, 106-07.

In 1998, Truckai and four co-inventors filed a patent application covering the NovaSure system. Some of the claims in the application referred to an ablation device with a permeable applicator head that could transport moisture away from the ablation site. S.A. 898-903. The specification, however, states only that the applicator head is “*preferably* a sack formed of a material which . . .

is permeable to moisture.” S.A. 867 (emphasis added). And notwithstanding the words “Moisture Transport” in the invention’s title, S.A. 834, one of the claims in the application—claim 31—did *not* require any means of moisture transport. S.A. 903.

Truckai signed the inventor’s oath, swearing that he was “an original, first and joint inventor . . . of the subject matter which is claimed and for which a patent is sought”—including claim 31 lacking any moisture-permeability element. J.A. 917-18; *see* 35 U.S.C. § 115(b)(2). Truckai later confirmed that he “understood at the time” that he was “attesting that [he] believed [he] w[as] the original first inventor o[f] the subject matter of claim 31.” J.A. 449-50. Truckai thus agreed that when he signed the inventor’s oath, he “didn’t believe that moisture transport was an essential part of [his] invention.” J.A. 451.

Later in 1998, Truckai assigned his interest in the NovaSure patent application to his company, Novacept, Inc. S.A. 909. In addition to the application itself, the assignment included any “continuations,” *id.*—*i.e.*, follow-on applications pursuing additional patent claims based on the same specification and priority date, 35 U.S.C. § 120.

In 2000, after the Patent Office examiner initially rejected claim 31 as anticipated by prior art, S.A. 925, Truckai and Novacept successfully persuaded the examiner that claim 31 was “not anticipated,” S.A. 939; *see* S.A. 947. In 2001, however, the examiner determined that the application claimed two different inventions—an apparatus (claim 31 and other claims) and a method (the remaining claims). S.A. 963-64. The examiner required Truckai and Novacept to choose which of the two sets of claims to pursue in that application. *Id.*; *see* 35 U.S.C. § 121. They elected to pursue the method claims, S.A. 965-66, 969-70, but they remained free to pursue the apparatus claims—including claim 31 and allowable variations—through a separate continuation application.

2. In 2004, Truckai sold Novacept and the NovaSure system to Cytyc Corporation for \$325 million. Pet. App. 5a. Truckai received \$8 million, J.A. 391-92, and he later acknowledged that “a big part of the deal was the intellectual property,” J.A. 450. Novacept assigned Cytyc any and all “inventions, discoveries, or improvements, . . . whether or not patented, patentable, . . . or reduced to practice,” including continuation applications. J.A. 613, 718-19. In the agreement—“approved and adopted” by Novacept’s board, of which Truckai was a member, J.A. 611—Novacept represented and warranted that it had no knowledge that any assigned intellectual property was “invalid or unenforceable.” J.A. 638.

Truckai later acknowledged that “when [Cytyc] bought this patent [application], they had [his] sworn statement that [he] didn’t believe that moisture transport was an essential part of [his] invention.” J.A. 451. While Truckai testified that he “came to change [his] mind” about the scope of his invention, “at the time, it wasn’t like [he] told [Cytyc], [‘]look, these patents only apply to moisture transport and you are not going to get protection against someone that uses something different.[’]” *Id.*

In 2007, Hologic acquired Cytyc and subsequently invested \$140 million in making NovaSure the leading endometrial-ablation treatment. Pet. App. 6a; J.A. 324-25.

3. In 2008, Truckai founded Minerva to develop a new device that would compete against Hologic’s NovaSure system. Pet. App. 6a. Like NovaSure, Minerva’s device uses an expandable applicator head that conforms to the shape of the uterus to ablate the entire endometrial lining simultaneously. *Id.*; J.A. 111-17. Minerva told the FDA that its device was “almost dead identical to NovaSure,” and it was pitched as “look[ing] like NovaSure” and “specifically designed to virtually mimic the steps of the NovaSure procedure.” J.A. 330, 733, 739. A member of Minerva’s Medical Advisory Board warned of “major ‘patent

infringement’ disputes for this device vs Novasure.” J.A. 297.

Minerva and Hologic discussed the possibility of Hologic acquiring Minerva and its device, but Hologic saw no reason to “buy [its] own device again.” Trial Transcript at 634:21-635:23, *Hologic, Inc. v. Minerva Surgical, Inc.*, No. 1:15-cv-01031 (D. Del. July 18, 2018), ECF No. 513.

4. In 2013, Hologic filed a continuation of Truckai’s original application that had included claim 31. S.A. 802. The continuation application claimed an ablation device with (among other elements) an expandable applicator head that facilitates ablating the entire endometrial lining simultaneously. S.A. 833. The continuation included claims that, like Truckai’s original claim 31, do not require a permeable applicator head or other means of moisture transport. *Id.* Truckai refused to sign a declaration stating that he was an original first inventor of the subject matter recited in Hologic’s application, *see* Br. 12, but both of the other co-inventors who could be located did sign such a declaration, including one who was working for Minerva. Declarations of Estela Hilario and Russel Mahlon Sampson, File Wrapper of U.S. Patent No. 9,095,348 (filed Apr. 21, 2015), *available at* <https://portal.uspto.gov/pair/PublicPair>.

In 2015, the Patent Office granted Hologic’s application and issued U.S. Patent No. 9,095,348 (the ’348 Patent). S.A. 802. Claim 1 of that patent (like Truckai’s original claim 31) does not require a permeable applicator head or other means of moisture transport. S.A. 833.

5. Meanwhile, Minerva launched its device. J.A. 107. The main difference between Minerva’s device and the NovaSure system is that NovaSure ablates endometrial lining using radiofrequency energy, while Minerva’s device primarily uses thermal energy. J.A. 138, 149-50; *see* Br. 10. According to peer-reviewed literature, the success rates of the two devices are “[e]ssentially comparable.”

J.A. 323; *see* J.A. 321-22 (explaining why clinical data from 2001 cannot be compared to data from 2017). Minerva’s device, however, poses a higher risk of serious internal burns. Trial Transcript at 1805:23-1806:20, *Hologic*, No. 1:15-cv-01031 (D. Del. July 24, 2018), ECF No. 512.

C. Proceedings Below

In November 2015, Hologic sued Minerva in the District of Delaware, alleging that Minerva’s device infringed claim 1 of the ’348 Patent. Pet. App. 6a. Minerva repeatedly argued in various contexts that Truckai’s specification requires a moisture-permeable applicator head. The lower courts rejected that argument a half-dozen times.

1. At the preliminary-injunction stage, Minerva argued that the specification and an exemplary embodiment required the term “applicator head” in claim 1 to include “a permeable external electrode array into which moisture is drawn using suction.” J.A. 115 n.9 (citation omitted). The district court disagreed, explaining that Minerva improperly “seeks to narrow the claim language to [one] embodiment and adds limitations which are not required by the specification or claim language.” J.A. 115.

At the claim-construction stage on the merits, Minerva again “presented extensive argument” that the specification limits claim 1 and requires a moisture-permeable applicator head. J.A. 130 n.6. Again, the district court held that neither the specification nor exemplary embodiments “narrow the disputed claim limitation.” *Id.*; *see* J.A. 132-35.

At summary judgment, Minerva repeated its same basic argument—that Truckai’s specification requires moisture-permeability—in the context of assignor estoppel, invalidity, and infringement. The district court rejected Minerva’s argument on all three issues.

First, the court held that assignor estoppel bars Minerva from challenging the '348 Patent's validity. Minerva did not "seriously dispute" that Truckai and Minerva are in privity. Pet. App. 58a. And the court rejected Minerva's contention that assignor estoppel does not apply to its argument that claim 1 is overly broad and therefore not adequately described or enabled by Truckai's specification under 35 U.S.C. § 112. That "overly broad claims argument is effectively foreclosed by the court's adoption of Hologic's claim construction." *Id.*

Second, the court held that, assignor estoppel aside, Minerva's § 112 invalidity arguments failed on the merits. Pet. App. 62a. Once again, the court had "already rejected Minerva's argument that exemplary embodiments define 'the invention' and require a 'moisture transport system' with a 'permeable external array' during the claim construction phase." Pet. App. 63a. Minerva's invalidity arguments thus "rest[ed] on a flawed definition of the claims that ignores the court's claim constructions." *Id.*

Third, on infringement, the court held yet again that "Minerva's non-infringement arguments were essentially mooted when the court rejected Minerva's erroneous claim constructions." Pet. App. 71a.

At trial on damages and other remaining issues, Minerva argued that Hologic had intentionally broadened claim 1 of the '348 Patent to cover Minerva's device after learning about it pursuant to a non-disclosure agreement. J.A. 393-95. But the jury found that Hologic had not misused confidential information, J.A. 318, and awarded Hologic almost \$4.8 million in damages. J.A. 317. The court later awarded another \$1.6 million. Pet. App. 10a.

2. The Federal Circuit affirmed in relevant part. After explaining assignor estoppel's long history, Pet. App. 11a-14a, the court declined to abrogate the doctrine, Pet. App. 17a.

The court then held that assignor estoppel applies here. While Minerva “emphasize[d] that Hologic, not Mr. Truckai, prosecuted claim 1,” the court “[f]ound Minerva’s argument unpersuasive.” Pet. App. 19a. Truckai had “executed a broad assignment of his patent rights,” including the right to continuation applications, knowing that the patent claims could “later [be] amended . . . in the application process (a very common occurrence in patent prosecutions).” Pet. App. 18a-19a (citation omitted).

The Federal Circuit next affirmed the district court’s claim construction. It agreed with the district court that “[n]either the claim nor the specification describes the ‘applicator head’ as being permeable or requiring moisture removal.” Pet. App. 21a (citation omitted). “To be certain, the specification emphasizes the importance of moisture removal,” and Minerva “emphasize[d] that an embodiment of the invention” included an applicator head “permeable to moisture.” *Id.* But “neither the plain claim language ‘applicator head’ nor the specification includes a moisture removal requirement.” *Id.*

SUMMARY OF ARGUMENT

I. This Court should not eliminate assignor estoppel after the Court upheld the doctrine a century ago and Congress later ratified it.

A. In *Westinghouse*, a case with striking similarities to this one, this Court held that Congress manifestly intended to incorporate assignor estoppel into the provision of the patent laws authorizing assignment of patent rights. And given the longstanding lower-court consensus recognizing assignor estoppel, the Court found that, by 1924, the doctrine was already too well settled to disturb.

B. Congress incorporated both *Westinghouse*’s interpretation and the continued lower-court consensus when it reenacted the assignment provision in 1952 without material change. This Court presumes that Congress knows

of established statutory constructions—whether from this Court or lower courts—and adopts those constructions when it reenacts the same language. By 1952, assignor estoppel was a well-established part of the patent laws. By reenacting the relevant provision, Congress cemented the doctrine into the statute.

Separately, Congress is also understood to legislate against a background of well-established common-law adjudicatory principles. Assignor estoppel was and is one of those principles, and Congress presumptively enacted the 1952 statute expecting the doctrine to apply.

C. Congressional ratification aside, *stare decisis* independently precludes abrogating assignor estoppel. In *Westinghouse*, this Court considered and answered whether and how the rule of assignor estoppel applies, as to both issued patents and ungranted applications, and the Court’s detailed treatment of the doctrine carries precedential force. Overruling *Westinghouse* would require an especially compelling justification, as its statutory construction has not been altered by Congress and involves property and contract rights. *Minerva* offers no valid justification for overturning *Westinghouse*. *Minerva*’s invocation of this Court’s other caselaw is unconvincing; its attacks on *Westinghouse*’s reasoning fall flat; and its policy concerns are both mistaken and directed to the wrong branch of government.

II. This Court likewise should not narrow assignor estoppel’s traditional scope.

A. *Minerva* proposes limiting the doctrine to issued patents. But *Westinghouse* rejected that limitation, which in any event conflicts with both common sense and commercial expectations. In a variation on *Minerva*’s proposal, the government advocates limiting assignor estoppel to patent claims that are “materially identical” to claims granted or pending at the time of assignment. But

that, too, is inconsistent with *Westinghouse* and clashes with basic rules of patent prosecution.

B. Minerva next argues that assignor estoppel should not apply to invalidity arguments under § 112. That argument is waived, and on the merits, it is impossible to justify treating § 112 arguments differently from other invalidity challenges.

C. Finally, Minerva argues that no estoppel should apply absent an express representation of validity by the assignor and reasonable reliance by the assignee. But as Minerva tacitly admits, that is just a thinly veiled attempt to abrogate the doctrine that fails for all the same reasons.

ARGUMENT

I. This Court Should Not Eliminate Assignor Estoppel

Minerva asks this Court to eliminate assignor estoppel on the theory that the doctrine has always conflicted with the plain text of the patent laws and that every court to apply or recognize the doctrine since 1880 has been “uncommonly lawless.” Br. 2. But this Court construed the patent laws to incorporate assignor estoppel in *Westinghouse*, and both Congress’s reenactment of the relevant statutory language in 1952 and principles of *stare decisis* preclude abrogating the doctrine now.

A. This Court in *Westinghouse* Interpreted the Patent Laws to Incorporate Assignor Estoppel

Any analysis of assignor estoppel’s vitality and scope must account for this Court’s decision in *Westinghouse*. Following a lower-court consensus recognizing the doctrine, *Westinghouse* interpreted a provision of the patent laws to incorporate assignor estoppel. In the process, it rejected many of the same arguments Minerva makes here.

1. Daniel O’Conor, a Westinghouse employee, invented a new way of manufacturing composite insulation

materials. *Westinghouse*, 266 U.S. at 343, 345. Prior methods heated the materials once, but O’Conor’s improved method heated them twice. *Id.* at 343-46. He applied for a patent and assigned all rights to the invention to Westinghouse for \$1. *Id.* at 345.

With his application pending, O’Conor left Westinghouse and formed a new venture, the Formica Company, which manufactured a competing product using the old one-step process. *Id.* at 345-46, 354. Meanwhile, Westinghouse amended O’Conor’s assigned application to add two new claims for a process of manufacturing materials that are “nonplaniform” (not flat). *Id.* at 344. These new claims did not expressly reference O’Conor’s two-step process, so on their face they could be read to claim the manufacture of nonplaniform materials even using the old one-step process. *Id.* at 344, 354.

After obtaining a patent with the added claims, Westinghouse sued, alleging that Formica was infringing them by manufacturing nonplaniform materials with a one-step process. *Id.* at 354. Formica argued invalidity and noninfringement, and in response to the invalidity defense, Westinghouse raised assignor estoppel. *Id.* at 344-45.

The Sixth Circuit held that the two claims added post-assignment were invalid and that assignor estoppel did not apply. *Westinghouse Elec. & Mfg. Co. v. Formica Insulation Co.*, 288 F. 330, 333-34 (6th Cir. 1923). The court acknowledged that assignor estoppel had gained “general acceptance,” but nevertheless questioned its “basis [and] theory.” *Id.* at 332. Specifically, the court doubted that assignor estoppel was rooted in “estoppel by deed” rather than “estoppel *in pais*,” also known as equitable estoppel or estoppel by conduct. *Id.* at 333. And even if the estoppel-by-deed analogy were sound, the court held that assignor estoppel does not apply “to the transfer of [an] inchoate right” like a patent application. *Id.* Because O’Conor had not represented that any valid patent would

issue post-assignment, the court held that no estoppel applied. *Id.* at 333-34.

2. This Court unanimously rejected the Sixth Circuit's view and held that Congress "manifestly intended" for assignor estoppel to apply to both issued patents and patent applications. *Westinghouse*, 266 U.S. at 349.

The Court explained that "[t]he important question in this case is the operation of the principle of estoppel on the character of defense to which the assignor of a patented invention is limited in a suit for infringement by the assignee." *Id.* at 348. Specifically, the case raised two issues: first, "the rule that should obtain where the assignment is made after the issue of the patent," and second, "the difference in the rule, if any, where the assignment was made before the granting of the patent." *Id.*

On the first issue, the Court began with the assignment provision of the 1870 Patent Act, which authorized assignment of patents and patent applications, and established a system for recording assignments with the Patent Office. *Id.* Given the "clear" analogy to rules governing conveyances of land, this Court discerned a congressional intent to apply "the principles of estoppel by deed . . . to assignment of a patent right in accordance with the statute." *Id.* at 348-50. The Court thus held 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.* at 349.

The Court's interpretation of the statute was consistent with "myriad" lower-court decisions—including by "nearly all the Circuit Courts of Appeal"—holding that "an assignor of a patent right 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.* This Court held that it would not "lightly disturb a rule well settled by 45 years of judicial consideration and conclusion." *Id.*

“[F]air dealing should prevent [a patent assignor] 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.*

Although assignors are estopped from challenging the validity of assigned patent rights, the Court held that they may nonetheless invoke prior art to define the scope of those rights. *Id.* at 350. That holding did not “significantly narrow[]” assignor estoppel, as *Minerva* contends, Br. 20, but rather adopted the overwhelming majority view, 266 U.S. at 350-52 (siding with six circuits over one outlier). The Court took pains to emphasize that assignors may use prior art *only* to avoid infringement, not to contest validity: “Of course, the state of the art cannot be used to destroy the patent and defeat the grant, *because the assignor is estopped to do this.*” *Id.* at 351 (emphasis added).

Applying these principles, the Court held that O’Conor was estopped from challenging validity, but that Formica had not infringed the two claims at issue, when properly construed. “If [O’Conor’s] two-step process was new, *and the estoppel requires us to hold as against O’Conor that it was*, his assignee had a right to claim the application of it as new not only to flat articles . . . but also to nonplaniform articles.” *Id.* at 354 (emphasis added). But prior art made clear that the added claims were limited to a two-step process, and thus Formica’s *one*-step process did not infringe those claims. *Id.* at 354-55.

After *Westinghouse*, lower courts and treatises uniformly recognized that this Court had authoritatively upheld assignor estoppel. *See supra* p. 5.

B. Congress Incorporated Assignor Estoppel into the Patent Act of 1952

When Congress reenacted the patent-assignment provision without material change in 1952, it ratified this

Court’s interpretation of that provision as well as the lower-court consensus that the patent laws incorporate assignor estoppel.

1. *The 1952 Patent Act Reenacted Statutory Language that Courts Had Consistently Construed To Incorporate Assignor Estoppel*

a. “Congress is presumed to be aware of an administrative or judicial interpretation of a statute and to adopt that interpretation when it re-enacts a statute without change.” *Lorillard v. Pons*, 434 U.S. 575, 580 (1978). And when statutory language has received a consistent interpretation, it acquires “a technical legal sense . . . that should be given effect in the construction of later-enacted statutes” that use the same language. Antonin Scalia & Bryan A. Garner, *Reading Law: The Interpretation of Legal Texts* 324 (2012). A “prior construction, having . . . been enshrined in the statute, can no longer be overruled.” *Id.*

As a “[s]tabilizing” principle, *id.* at 318, this canon applies when either this Court or lower courts have adopted a prior interpretation of statutory language, *id.* at 322, 324 & n.7; see also, e.g., *Lamar, Archer & Cofrin, LLP v. Appleing*, 138 S. Ct. 1752, 1762 (2018). This Court has held, for example, that interpretations by “three Federal Courts of Appeals” triggered the canon when “there [was] no reason to suppose that Congress disagreed with those interpretations.” *Jerman v. Carlisle, McNellie, Rini, Kramer & Ulrich L.P.A.*, 559 U.S. 573, 590 (2010). In the patent context, the Court has applied the canon where this Court had “never addressed” the precise question at issue, but the Federal Circuit had “made explicit what was implicit in [this Court’s] precedents.” *Helsinn Healthcare S.A. v. Teva Pharm. USA, Inc.*, 139 S. Ct. 628, 633 (2019).

b. By 1952, the conclusion that the patent laws incorporate assignor estoppel was about as firmly settled as interpretive propositions can get. Assignor estoppel was not just implicit but explicit in this Court’s precedent, and the doctrine had been accepted as part of the patent laws by not just three circuits but eight.

Westinghouse alone triggers the prior-construction canon. There, this Court held that Congress “manifestly intended” assignor estoppel as part of the statutory provision authorizing assignment of patent rights. 266 U.S. at 349. In *Scott Paper*, this Court then reaffirmed “[t]he rule, as stated by this Court in [*Westinghouse*].” 326 U.S. at 251. And this Court’s precedents aside, the lower-court consensus independently suffices. At least 88 lower-court cases applied or recognized assignor estoppel from 1880 to 1952. Apps. B, C.

c. In 1952, Congress ratified this Court’s construction of the assignment provision and the lower-court consensus it followed when Congress reenacted that provision without material change. Compare 1870 Patent Act § 36, with 1952 Patent Act § 261 (codified as amended at 35 U.S.C. § 261). The 1952 assignment language was “the same as in the corresponding section of [the prior] existing statute.” H.R. Rep. 82-1923, at 27 (1952). The one new sentence—stating that, “[s]ubject to the provisions of this title, patents shall have the attributes of personal property,” 1952 Patent Act § 261 (codified at 35 U.S.C. § 261)—was “declaratory only,” H.R. Rep. 82-1923, at 27 (1952), and “effect[ed] no change,” Subcomm. No. 4 of the H. Comm. on the Judiciary, *Proposed Revision and Amendment of the Patent Laws: Preliminary Draft with Notes* 52 (1950). That sentence has no bearing on assignor estoppel anyway, because estoppel by deed, upon which assignor estoppel is based, can apply to “real or personal property.” 31 C.J.S. *Estoppel and Waiver* § 9.

Ratifying assignor estoppel was consistent with the 1952 Patent Act’s “main purpose”—“codification and enactment of title 35 into law, with only some minor procedural and other changes deemed substantially noncontroversial and desirable.” H.R. Rep. 82-1923, at 3 (1952); S. Rep. 82-1979, at 4 (1952) (similar). Where Congress intended the 1952 statute to override this Court’s prior constructions of the patent laws, it made its intentions clear,¹ as one would expect for “a change of that kind,” *TC Heartland LLC v. Kraft Food Grp. Brands LLC*, 137 S. Ct. 1514, 1520 (2017). But nothing in the text or history of the 1952 statute suggests any intent to displace assignor estoppel.

Minerva points to one witness—someone from the Aircraft Industry Association—whose written testimony to a House subcommittee advocated codifying assignor and licensee estoppel in a way that would have overturned *Scott Paper* and a precedent of this Court involving licensee estoppel. *Patent Law Codification and Revision: Hearings on H.R. 3760 Before Subcomm. No. 3 of the H. Comm. on the Judiciary*, 82d Cong. 115, at 113, 115-16 (1951); see Br. 30-31. But Congress demurred, leaving assignor estoppel exactly where it stood—a longstanding doctrine subject to recognized limits.

d. Ratification aside, the 1952 Patent Act incorporated assignor estoppel based on the canon that Congress “legislate[s] against a background of common-law adjudicatory principles.” *Astoria Fed. Sav. & Loan Ass’n v. Solimino*, 501 U.S. 104, 108 (1991). Statutes “will not be interpreted as changing the common law unless they effect

¹ Compare *Cuno Eng’g Corp. v. Automatic Devices Corp.*, 314 U.S. 84 (1941), with 1952 Patent Act § 103; *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1 (1946), with 1952 Patent Act § 112; *Mercoid Corp. v. Mid-Continent Inv. Co.*, 320 U.S. 661 (1944), with 1952 Patent Act § 271(c); see also Br. 30.

the change with clarity,” which “ordinarily” requires more than “implied change.” Scalia & Garner, *supra*, at 318. The Court applies this canon regularly, including in patent and other intellectual property cases. U.S. Br. 21-22.

By 1952, assignor estoppel was well established enough to trigger the canon. Indeed, assignor estoppel was far more settled than other common-law doctrines that this Court has found sufficient to trigger the canon, such as administrative preclusion, *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 162-67 (2015) (Thomas, J., joined by Scalia, J., dissenting), and patent exhaustion for foreign sales, *Impression Prods., Inc. v. Lexmark Int’l, Inc.*, 137 S. Ct. 1523, 1535-38 (2017). And Minerva cannot point to anything in the 1952 statute that makes any intent to abrogate assignor estoppel “evident,” *Astoria*, 501 U.S. at 108.

2. *Minerva’s Statutory Arguments Fail*

a. Minerva argues that assignor estoppel is inconsistent with § 282(b), which provides that “[i]nvalidity” shall be a defense “in any action” for infringement. *See* Br. 17-19. That language, however, was not new in 1952—it appeared in the 1870 statute, and similar language appeared in the 1793 statute as well. *See* 1870 Patent Act § 61 (“in any action”); 1793 Patent Act §§ 5-6 (“in an action”). Both the House and Senate reports make clear that when Congress carried this language forward in 1952, it did “not materially chang[e] the substance.” H.R. Rep. 82-1923, at 10 (1952); *see* S. Rep. 82-1979, at 6 (1952). Reenacting language that was already on the books when courts were consistently applying assignor estoppel cannot possibly have been intended to abrogate the doctrine.

Minerva thus argues that the “in any action” language has *always* foreclosed assignor estoppel, and that the mountain of cases applying or recognizing the doctrine before (and after) 1952 are all “uncommonly lawless.” Br. 2,

29-30. That argument is as misguided as it is audacious. This Court should not lightly conclude that scores of federal judges in dozens of cases over 140 years—including all nine justices in *Westinghouse*—lawlessly ignored an on-point statute. Regardless, by reenacting that language in 1952 against the background of extensive precedent, Congress plainly ratified assignor estoppel. Whether this Court’s interpretation was correct in 1924 is no longer the question. See *Kurns v. R.R. Friction Prod. Corp.*, 565 U.S. 625, 638 (2012) (Kagan, J., concurring).

In any event, Minerva’s argument fails on its own terms because § 282(b) is entirely compatible with assignor estoppel. Invalidity remains a *defense* “in any action,” just as § 282(b) provides it “shall be”—if properly pleaded and proven, invalidity precludes infringement liability. Assignor estoppel is merely one of many rules that prevent particular *defendants* from successfully pleading and proving that defense in particular cases. See U.S. Br. 22. If § 282(b) were incompatible with assignor estoppel because *every defendant* had to be able to assert an invalidity defense *in every case*, irrespective of its own past conduct, then it would be equally incompatible with other preclusion doctrines like collateral estoppel, equitable estoppel, and judicial estoppel. This Court has held, however, that collateral estoppel applies to prior adjudications of invalidity—in an opinion that quoted § 282, no less. *Blonder-Tongue Labs., Inc. v. Univ. of Ill. Found.*, 402 U.S. 313, 335 (1971). The Court has also noted the availability of equitable estoppel in infringement actions. *SCA Hygiene Prod. Aktiebolag v. First Quality Baby Prod., LLC*, 137 S. Ct. 954, 967 (2017). Minerva’s argument thus proves too much.

b. Minerva argues that *Lear* and *Scott Paper* “fully support abandoning assignor estoppel.” Br. 19 (capitalization altered). *Lear*, however, was decided in 1969, long

after 1952. Absent a congressional time machine, *Lear* is irrelevant to the meaning of the 1952 Patent Act, as is any post-*Lear* congressional testimony. See Br. 31-32.

Scott Paper predates the 1952 statute, but it did not overturn *Westinghouse* or the universal lower-court consensus recognizing assignor estoppel. Quite the contrary, *Scott Paper* reaffirmed “[t]he rule, as stated by this Court in [*Westinghouse*],” and declined an invitation to “reject[]” the doctrine. 326 U.S. at 251, 254. The Court held only that *Westinghouse* was “not controlling” where “the accused machine is precisely that of an expired patent”—a unique situation that had never arisen in “any other” assignor estoppel case. *Id.* at 254. In those unusual circumstances, the Court reasoned, assignor estoppel is limited by the separate statutory provision that fixes a patent’s term, after which “the public [is] free to use the invention.” *Id.* at 254-55. Since *Scott Paper*, this Court has reaffirmed the importance of that patent-expiration provision. *Kimble v. Marvel Ent., LLC*, 576 U.S. 446, 451-52 (2015) (citing cases).²

Justice Frankfurter’s dissent and one isolated contemporary comment notwithstanding, see Br. 21-22, 30, nothing in this Court’s actual opinion in *Scott Paper* suggests that it was “chok[ing] assignor estoppel to death,” as Minerva graphically asserts. Br. 21. Courts and treatise-writers at the time believed assignor estoppel was still very much alive. See *supra* p. 6.

² Minerva claims that this Court later described *Scott Paper* as holding that an assignor “was free to challenge the validity of the patent and thereby defeat an action for infringement.” Br. 21-22 (quoting *Edward Katzinger Co. v. Chi. Metallic Mfg. Co.*, 329 U.S. 394, 400 (1947)). That misleadingly cuts the Court’s description short. The Court stated that, under *Scott Paper*, an assignor may “. . . defeat an action for infringement by showing that the invention had been described in an expired patent.” 329 U.S. at 400 (emphasis added).

c. Finally, Minerva asserts that assignor estoppel “was not well established.” Br. 29 (capitalization altered). That is impossible to square with the historical record. *Westinghouse* described the doctrine as “well settled” *in 1924*. 266 U.S. at 349. It was even more well settled by 1952. *See supra* pp. 5-6. Minerva does not cite a single case that rejected assignor estoppel before 1952.

C. *Stare Decisis* Compels Adherence to this Court’s Precedent Upholding Assignor Estoppel

Beyond Congress’s ratification and incorporation of assignor estoppel, this Court’s precedent forecloses abrogating the doctrine. *Westinghouse* squarely upheld assignor estoppel as a part of the patent laws, and that holding is shielded by superpowered *stare decisis*. Minerva offers no convincing reason to overturn *Westinghouse*.

1. Westinghouse Held that the Patent Laws Incorporate Assignor Estoppel

Minerva asserts that “[a]bandoning assignor estoppel would not require overruling any decision of this Court.” Br. 40. It certainly would. Minerva misunderstands both what counts as precedent and what *Westinghouse* decided.

This Court is bound by both the narrow result of its cases and “the well-established rationale upon which the Court based the result[.]” *Seminole Tribe of Fla. v. Florida*, 517 U.S. 44, 66-67 (1996). Put differently, “*stare decisis* directs us to adhere not only to the holdings of our prior cases, but also to their explications of the governing rules of law.” *Cty. of Allegheny v. Am. C.L. Union Greater Pittsburgh Chapter*, 492 U.S. 573, 668 (1989) (Kennedy, J., concurring in the judgment in part and dissenting in part); *see Ramos v. Louisiana*, 140 S. Ct. 1390, 1416 n.6 (2020) (Kavanaugh, J., concurring in part) (citing same). Indeed, “[i]t is usually a judicial decision’s reason-

ing—its *ratio decidendi*—that allows it to have life and effect in the disposition of future cases.” *Id.* at 1404 (Gorsuch, J., joined by Ginsburg and Breyer, JJ.). That is because this Court’s “principal function is to establish *precedent*—that is, to set forth principles of law that every court in America must follow.” *United States v. Virginia*, 518 U.S. 515, 596 (1996) (Scalia, J., dissenting). This Court often announces a legal holding that favors one party even when it goes on to decide the case against that party on the facts. *E.g.*, *Gonzalez v. Crosby*, 545 U.S. 524, 536 (2005) (affirming even though “our holding” on the question presented favored the petitioner).

Here, this Court is bound by *Westinghouse*’s “explication” of the “governing rule” of assignor estoppel. The Court there unambiguously considered and answered “[t]he important question” of the “operation of the principle” of assignor estoppel in the context of assigned patents and applications. 266 U.S. at 348. After analyzing the assignment provision and the analogy to common-law estoppel by deed, the Court announced “the rule”—“that an assignor of a patent right is estopped to attack the utility, novelty or validity of a patented invention which he has assigned.” *Id.* at 349. This “rule,” the Court emphatically declared, was “manifestly intended by Congress.” *Id.* That is no “mild endorsement,” Br. 20; it is the language of precedent, not dicta, as lower courts and treatises recognized, *see supra* p. 5.

The precedential weight of the Court’s treatment of assignor estoppel is especially clear in context—the Court answered the questions presented, in detail, after full adversarial briefing. The Sixth Circuit had held that assignor estoppel is a form of estoppel *in pais* and thus applies only if an assignor represented validity. *Westinghouse*, 288 F. at 333. *Westinghouse*’s petition for certiorari presented the questions of whether assignor estoppel “is an estoppel *in pais* and not an estoppel by deed,” and

whether it “appl[ies] to the assignment of an *application* for patent.” Pet. at 2, *Westinghouse Elec. & Mfg. Co. v. Formica Insulation Co.*, 266 U.S. 342 (1924) (No. 23-102) [*Westinghouse* Pet.]. In the merits briefing, Westinghouse argued that assignor estoppel was “well settled” and applies based on the assignment alone, Br. for Pet’r at 33-51, *Westinghouse, supra* (No. 23-102) [*Westinghouse* Br.], while Formica argued that estoppel does not apply absent an “express warranty of validity in the instrument of assignment,” or at least where the assigned patent rights were broadened post-assignment, Br. for Resp. at 56, *Westinghouse, supra* (No. 23-102) [*Formica* Br.]; *see id.* at 10-36, 42-57. The Court thus did not simply assume assignor estoppel’s existence on its way to allowing assignors to use prior art to construe a patent’s claims, as *Minerva* suggests. Br. 20. Neither party even disputed such use of prior art. *See Westinghouse* Br. 32.

Indeed, the Court addressed—and rejected—many of the same arguments *Minerva* makes here. *Formica* argued, for instance, that patent assignments warrant nothing beyond title. *Formica* Br. 13-14, 55-57. So does *Minerva*. Br. 34-35, 47. *Formica* argued that assignor estoppel is a tax on employee mobility. *Formica* Br. 32-36. So does *Minerva*. Br. 38-39. *Formica* argued that assignor estoppel should not apply to the assignment of patent applications. *Formica* Br. 28-32. So does *Minerva*. Br. 35-36, 43-45. In fact, *Minerva* draws its arguments word-for-word from the Sixth Circuit opinion that *Formica* was defending. Br. 34-35 (quoting *Westinghouse*, 288 F. at 333). This case is *Westinghouse* all over again.³

³ Although not essential to its precedential value, *Westinghouse*’s treatment of assignor estoppel was necessary to the Court’s claim construction. The entire exercise of construing the claims in light of prior art logically depended on the Court’s prior conclusion that assignor estoppel permits assignors to narrow claims in that way.

2. *Westinghouse Is Protected by a “Superpowered Form of Stare Decisis”*

“Overruling precedent is never a small matter.” *Kimble*, 576 U.S. at 455. *Stare decisis* is “a foundation stone of the rule of law,” *Michigan v. Bay Mills Indian Cmty.*, 572 U.S. 782, 798 (2014), and this Court treats requests to reconsider its prior decisions with “the utmost caution,” *State Oil Co. v. Khan*, 522 U.S. 3, 20 (1997). Reversing precedent requires “special justification—over and above the belief that the precedent was wrongly decided.” *Kimble*, 576 U.S. at 456 (quotation marks omitted).

For three reasons, *Westinghouse* is entitled to an especially strong—even “superpowered”—form of *stare decisis*. *Kimble*, 576 U.S. at 458. First, parties seeking “to overrule a point of statutory construction” bear an even “greater” burden. *Patterson v. McLean Credit Union*, 491 U.S. 164, 172 (1989). *Stare decisis* gains “enhanced force” in this context because critics “can take their objections across the street, and Congress can correct any mistake it sees.” *Kimble*, 576 U.S. at 456. This enhanced *stare decisis* applies regardless of whether the Court’s decision “focused only on statutory text or also relied . . . on the policies and purposes animating the law,” *id.*; see *Bilski v. Kappos*, 561 U.S. 593, 601-02 (2010), or “even when a decision has announced a judicially created doctrine designed to implement a federal statute,” *Kimble*, 576 U.S. at 456 (quotation marks omitted). If the Court’s decision, “in whatever way reasoned,” is subject to congressional change, it is more strongly insulated from challenge. *Id.*; see *Bay Mills*, 572 U.S. at 802 & n.12.

This enhanced statutory *stare decisis* applies here. Like the precedent this Court refused to overturn in *Kimble*, *Westinghouse* interpreted a patent provision in accordance with “the policies and purposes animating the law.” *Id.* at 456. Even if assignor estoppel were a “judicially-created doctrine,” Br. 40, rather than an expression

of Congress’s will (as *Westinghouse* held), it is indisputably “designed to implement a federal statute,” *Kimble*, 576 U.S. at 456, triggering statutory *stare decisis*.

Second, those challenging this Court’s precedent bear yet a greater burden when Congress has acquiesced in this Court’s decision. Such acquiescence “enhance[s] even the usual precedential force we accord to our interpretations of statutes,” and doubly so where Congress has left an interpretation intact despite reworking other parts of the relevant law. *Kimble*, 576 U.S. at 456-57; accord *Glob.-Tech Appliances, Inc. v. SEB S.A.*, 563 U.S. 754, 765 (2011). Overturning precedent “in these circumstances would scale the heights of presumption” and “replace Congress’s considered judgment with our contrary opinion.” *Bay Mills*, 572 U.S. at 803. As explained, Congress amended the patent laws in 1952 to overrule three *other* decisions of this Court, but not *Westinghouse*. See *supra* p. 21 & n.1; U.S. Br. 18. Since then, Congress has revised the assignment provision three times,⁴ each time leaving assignor estoppel untouched. Even 14 years of congressional acquiescence enhances “the usual precedential force” of this Court’s statutory decisions, *Watson v. United States*, 552 U.S. 74, 82-83 (2007) (citation omitted); here, there has been nearly a century.

Third, *stare decisis* reaches its “acme in cases involving property and contract rights,” *Khan*, 522 U.S. at 20, because “parties are especially likely to rely on such precedents when ordering their affairs,” *Kimble*, 576 U.S. at 457. When “[a] precedent creates a rule of property—a widely relied-on legal principle established by a judicial decision . . . relating to title to . . . intellectual property—[it] is generally treated as inviolable.” Bryan A. Garner et

⁴ See Pub. L. No. 112-211, tit. II, § 201(d), 126 Stat. 1527, 1535 (2012); Pub. L. No. 97-247, § 14(b), 96 Stat. 317, 321 (1982); Pub. L. No. 93-596, § 1, 88 Stat. 1949, 1949 (1975).

al., *The Law of Judicial Precedent* 421 (2016). Like the doctrine upheld in *Kimble*, assignor estoppel “involv[es] property and contract rights.” *Kimble*, 576 U.S. at 457. Even if there were “uncertainty” over whether assignor estoppel has engendered reliance—and there is not, *see infra* pp. 34-35—there is at least “a reasonable possibility that parties have structured their business transactions in light of” the doctrine. *Id.* at 457-58. That is “one more reason to let [*Westinghouse*] stand.” *Id.* at 458.

3. *Minerva Offers No Persuasive Justification for Overruling Westinghouse*

Because *Westinghouse* is protected by “superpowered” *stare decisis*, this Court cannot overrule it absent a “superspecial justification.” *Id.* at 458. *Minerva* offers *no* valid justification—superspecial or otherwise.

a. *Minerva* first points to *Scott Paper* and *Lear*. Neither decision supports overruling *Westinghouse*. As explained, *Scott Paper* reaffirmed the general “rule” of assignor estoppel, 326 U.S. at 251, and its result and reasoning fit comfortably with *Westinghouse*. *See supra* p. 24.

Lear did not even involve assignor estoppel, but instead abrogated the separate doctrine of licensee estoppel. In so doing, the Court relied on its sense of wise “policy” and the purported “demands of the public interest,” rather than anything Congress had written or ratified in the Patent Act. 395 U.S. at 668, 670. That policy-driven reasoning has been sharply criticized. *See, e.g.*, Rochelle Cooper Dreyfus, *Dethroning Lear: Licensee Estoppel and the Incentive to Innovate*, 72 Va. L. Rev. 677 (1986). Result aside, *Lear* is hardly a “clear model,” Br. 22, for the Court to follow today.

Furthermore, *Lear*’s abrogation of licensee estoppel does not support abrogating assignor estoppel. To start, the two estoppels have different doctrinal foundations.

Assignor estoppel has roots in estoppel by deed, *see Westinghouse*, 266 U.S. at 348-49, a property-based doctrine that offers no support for licensee estoppel, which did not involve any transfer of title and rested solely on “the common law of contracts,” *Lear*, 395 U.S. at 668. The estopped parties also are different because licensees are *buyers* of patent rights, while assignors are *sellers*. Buyers do not implicitly assume the validity of the patent rights they purchase; a licensee may, without contradiction, sincerely believe that a patent is invalid and nevertheless buy a license to avoid “the necessity of defending an expensive infringement action.” *Id.* at 669. On the other hand, sellers *do* implicitly assume the validity and value of transferred patent rights—that is why they receive valuable consideration in exchange.

Licensee estoppel also raised policy concerns that assignor estoppel does not. Before buying a license, licensees cannot practice a patent without risking expensive infringement litigation. *Lear*, 395 U.S. at 669. And after the license transaction, licensee estoppel effectively forced licensees to “shut up and keep paying,” even if the patent was invalid. Amber L. Hatfield, Note, *Life After Death for Assignor Estoppel: Per Se Application to Protect Incentives to Innovate*, 68 Tex. L. Rev. 251, 270 (1989); *see* U.S. Br. 23-24. Before a patent is assigned, by contrast, the assignor holds the patent rights and thus can freely practice the invention without fear of infringement liability. And if the assignor wishes to continue practicing the patent post-assignment, he can bargain for that right. But assignor estoppel will *never* compel any assignor to “shut up and keep paying” for the right to practice an invalid patent, because the assignor is the one receiving payment, not making it.

Licensee estoppel also raised antitrust concerns that assignor estoppel does not. Patent holders could potentially stifle competition by licensing invalid patents to

competitors and then wielding licensee estoppel to prevent those competitors from attacking the patents' validity. Consistent with this threat, licensee estoppel was long subject to a broad "anti-trust exception" applicable in "the large number of cases" where a license "contained restrictions that were arguably illegal under the antitrust laws." *Lear*, 395 U.S. at 666-67. Because assignor estoppel raises no similar concerns, it has never been subject to any antitrust exception. *See id.*

b. Minerva also contends that *Westinghouse* is inconsistent with decisions questioning whether courts can enforce certain private contracts not to challenge the validity of patents. Br. 26. One of those cases predates *Westinghouse*, and none reflects any categorical rule that parties can never "disable themselves from challenging the validity of issued patents," Br. 26, including through waiver, settlement, or other types of estoppel. In fact, Minerva concedes that "the Court has never held that agreements not to challenge validity are *always* unenforceable." Br. 27 n.1. If some such agreements are enforceable and others may not be, then Minerva's entire point is simply question-begging.

Similarly, Minerva invokes cases holding that certain state laws precluding validity challenges are preempted. *See* Br. 27. But those cases merely demonstrate that whatever balance Congress strikes between the competing policies of patent law must be respected by states, not that that balance prohibits assignor estoppel.

c. Minerva argues that *Westinghouse* was wrong. But "even a good argument to that effect . . . cannot by itself justify scrapping settled precedent," especially one shielded by "superpowered" *stare decisis*. *Kimble*, 576 U.S. at 455, 458. Regardless, it is Minerva that is wrong.

Minerva first claims that *Westinghouse* (and countless other decisions and treatises) wrongly analogized assignor estoppel to estoppel by deed. But Minerva admits

that the two estoppels share “some common features.” Br. 33. And Minerva’s argument that patent assignments are more like “quitclaim deeds”—where the seller transfers only whatever interest it has, without warranting valid title—relies heavily on the *Sixth Circuit’s* reasoning in *Westinghouse*, see Br. 34-35, which this Court rejected, see *supra* pp. 16-18. Minerva’s other authorities, moreover, acknowledge that a quitclaim deed “may give rise to estoppel by deed” where “the grantor intended to convey and the grantee expected to acquire a particular estate.” 28 Am. Jur. 2d, *Estoppel and Waiver* § 7. That is so in patent assignments—assignors *must* sincerely believe that the patent rights they are conveying are valuable and valid. See U.S. Br. 15.

Minerva next argues that it is important to allow invalidity challenges to assigned patents because our “patent prosecution system” is “*ex parte*.” Br. 34. But assigned patents *are* subject to challenge by “the rest of the world,” *Westinghouse*, 266 U.S. at 349, just not by the assignor and his privies. That distinction reflects that the assignor received valuable consideration in exchange for the assigned patent rights, as well as the fact that patent applicants must exhibit a “high degree of candor” to the Patent Office. U.S. Br. 15. All patent applications must include an oath or declaration from the inventor attesting, under penalty of perjury, that he is the “original inventor” of the claimed invention. 35 U.S.C. § 115(b)(2). Unlike the rest of the world, an assignor like Truckai cannot be agnostic about the validity of an assigned patent.

Minerva also argues that every estoppel requires “reasonable reliance.” Br. 36. But *Westinghouse* rejected the view that assignor estoppel requires a representation “on the faith of which the assignee purchased.” 266 U.S. at 351. Estoppel by deed likewise does not require reli-

ance, as the United States and state high courts have explained. U.S. Br. 14 n.2; *see, e.g., Shedden v. Anadarko E. & P. Co., L.P.*, 136 A.3d 485, 492 (Pa. 2016).

d. Minerva’s attack on *Westinghouse* boils down to a claim that assignor estoppel hinders some patent policies. That is wrong, and regardless, this Court is not the appropriate venue for such naked policy arguments.

To begin with, eliminating assignor estoppel would dam up “the wellspring of all patent policy: the goal of promoting innovation.” *Kimble*, 576 U.S. at 463. “To promote the Progress of Science and useful Arts,” U.S. Const., art. 1, § 8, cl. 8, Congress has authorized inventors to assign their patents and patent applications, recognizing that making inventions alienable boosts their value and the incentives for innovation. 35 U.S.C. § 261; *see* U.S. Br. 24-26. But if potential assignees cannot trust that potential assignors will not abuse their privileged position as the original inventor to challenge a patent’s validity, they may be less willing to agree to assignments in the first place. Assignor estoppel thus reflects the same logic that supports good faith and fair dealing in all commercial transactions.

Assignor estoppel also has engendered serious reliance interests. For decades, *millions* of patents and applications have been assigned on the assumption that assignor estoppel bars assignors from later challenging the validity of the assigned patent rights. AIPLA Br. 12-14. Minerva discounts these reliance interests on the ground that “the assignee takes the patent knowing that *most* accused infringers will be free to challenge validity.” Br. 41 (emphasis added). But even if others may challenge an assigned patent, *assignors* cannot. That is no minor distinction; an assignor can be uniquely likely to infringe a patent and uniquely dangerous if he does. AIPLA Br. 12-14. An assignor knows the relevant technology (having invented it himself) and, absent assignor estoppel, may

imitate rather than innovate. If he does, he poses an unparalleled litigation risk for the assignee. An inventor can be the most important witness in a patent case, and if he says the patent rights he assigned are invalid, a jury may well simply defer.

Minerva argues that assignor estoppel protects “bad patents,” Br. 38, but that is wrong—assignor estoppel protects against inventors denying the value of their own inventions. Sometimes, that may grant a bad patent a temporary reprieve, but oftentimes it stops an assignor from challenging a *good* patent (as the district court held below). Here, Truckai swore an oath affirming the validity of his application, including claim 31 without any moisture-permeability limitation. But as Truckai’s self-interest changed, so did his tune: At trial, he testified that he had actually (and secretly) thought claim 31 was invalid. That convenient change of heart made no difference to the ’348 Patent’s validity because of assignor estoppel, but it neatly shows the kind of behavior that would likely follow assignor estoppel’s abrogation. Assignor estoppel keeps inventors honest (or at least consistent).

Minerva’s “bad patents” refrain also ignores that assignor estoppel bars only assignors and their privies, leaving “the rest of the world” free to challenge validity. *Westinghouse*, 266 U.S. at 349. And today, there are *more* alternative ways of challenging validity than in *Westinghouse*’s day. Anyone—not just alleged infringers—can now ask the Patent Office to invalidate a patent. 35 U.S.C. § 311 (*inter partes* review); *id.* § 321 (post-grant review); *id.* § 302 (*ex parte* reexamination). The Federal Circuit has held that even assignors can challenge a patent’s validity through *inter partes* review. *Arista Networks, Inc. v. Cisco Sys., Inc.*, 908 F.3d 792, 803 (Fed. Cir. 2018). Here, for instance, Minerva tried but failed to invalidate the ’348 Patent administratively, while successfully invalidating another assigned patent. J.A. 511, 546. Assignors

can also try to narrow the scope of the patent (as *Minerva* attempted to do), 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.

In any event, “[n]o law pursues its purposes at all costs,” *Hernandez v. Mesa*, 140 S. Ct. 735, 741-42 (2020) (quotation marks omitted), least of all the patent laws. Congress instead has struck a balance “between fostering innovation and ensuring public access to discoveries,” *Kimble*, 576 U.S. at 451, while also accounting for basic principles of fairness. This Court and many others concluded long ago that assignor estoppel is consistent with that balance, and if Congress disagrees, it can say so.

What’s more, parties can contract around assignor estoppel, but likely could not contract around its absence. Assignor estoppel is currently a default rule, so an assignor can bargain for the right to later assert invalidity. *Mentor Graphics Corp. v. Quickturn Design Sys., Inc.*, 150 F.3d 1374, 1378 (Fed. Cir. 1998). By contrast, if assignor estoppel were abrogated, it would be difficult or impossible to reestablish it by contract. Courts might decline to enforce such a contract with an injunction, and damages might not adequately remedy an assigned patent’s invalidation. 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). *Minerva*, for its part, previously argued against *any* possibility of contracting around assignor estoppel’s abrogation. Pet. Reply 9. It has now reversed course, Br. 27 n.1, but that newfound equivocation just underscores the uncertainty *Minerva*’s position would create in assignment negotiations for years to come.⁵

⁵ *Minerva* and its *amici* assert that assignor estoppel hinders employee mobility. Br. 39-40; Engine Advocacy Br. 14-21; Scholars

All of these policy arguments just highlight that Minerva has come to the wrong branch of government. When this Court has adopted a rule that is subject to congressional change, those opposing that rule on policy grounds must take their gripes to Congress. This Court need not “take their word for the problem,” especially when they have not offered “any empirical evidence” in support. *Kimble*, 576 U.S. at 464. Only Congress “has the capacity to assess [the] charge” and legislate accordingly. *Id.* at 465.

II. This Court Should Not Narrow Assignor Estoppel

Minerva alternatively presents three underdeveloped “options” to “constrain” assignor estoppel if the Court does not abrogate the doctrine entirely. Br. 42. The government and other *amici* also propose amending the doctrine in conflicting ways. But for the same reasons the Court should not eliminate assignor estoppel, the Court should not tinker with its traditional scope either. Anyway, none of the proposed amendments has merit, and even if they did, Congress, not this Court, should say so.

A. Assignor Estoppel Applies to Assignments of Patent Applications

Minerva first proposes limiting assignor estoppel “to claims already issued at the time of the assignment.” Br. 44. The government recognizes that Minerva’s proposal is no good, but the government’s alternative is no better. Both proposals contravene *Westinghouse*, common sense, and ordinary commercial expectations.

Br. 20-21. Even if that were true (or relevant here), it at most reflects a problem with the doctrines of privity or consideration, not assignor estoppel itself. IPO Br. 14-20. *Westinghouse* reserved the question of how those doctrines apply, 266 U.S. at 355, and in the future this Court could address them as necessary. Privity is conceded here. Pet. i.

1. *Westinghouse* already “consider[ed]” whether there should be any “difference in the rule” of assignor estoppel “where the assignment was made before the granting of the patent.” 266 U.S. at 348. The Court acknowledged that when assignors convey ungranted applications, the scope of the right conveyed “is much less certainly defined than that of a granted patent,” and “[t]his difference might justify the view that the range of relevant and competent evidence in fixing the limits of the subsequent estoppel should be more liberal than in the case of an assignment of a granted patent.” *Id.* at 352-53. But the Court left no doubt that there would *be* a “subsequent estoppel.” *Id.* In fact, in *Westinghouse*, “the estoppel require[d] [the Court] to hold as against [the assignor]” that claims added post-assignment were valid. *Id.* at 354.

Westinghouse’s express “hold[ing]” applying assignor estoppel to an assigned application is binding precedent and part of the statutory and common-law background Congress incorporated into the 1952 Patent Act. *See supra* pp. 18-22. Even the Sixth Circuit—which had held that assignor estoppel did not apply to post-assignment claims—later recognized that “when the Supreme Court affirmed . . . in the *Westinghouse* Case, it considered the distinction between the assignment of a patent and the assignment of a mere inchoate right to a patent, only as it bore upon the *extent* of the estoppel rather than upon the *existence* of the right itself.” *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428, 429 (6th Cir. 1933) (emphases added).

From assignor estoppel’s earliest days, courts have applied the doctrine when the assigned rights evolved after assignment. As explained in an 1887 case involving reissued patents, for example, “if [the assignor] would be estopped from denying the patentability of the devices covered by the originals, as against his assignee, he is

equally so as to the reissues.” *Burdsall*, 31 F. at 919. That is because the assignor, “virtually, by his acts, has said to his assignees, as well as to the patent office: ‘By inadvertence and mistake I did not make my claims in the original patents as broad as my invention. I have therefore surrendered the originals, and taken in their place these reissues which inure to your benefit.’” *Id.*; *see supra* p. 4 (citing additional cases).

As the Federal Circuit later explained, “[t]he fact is that [the assignor] assigned the *rights* to his invention, irrespective of the particular *language* in the claims describing the inventions when the patents were ultimately granted.” *Diamond Sci.*, 848 F.2d at 1226. The assignor and his privies thus “should not be allowed now to destroy those rights by derogating the patents’ validity.” *Id.*

2. Precedent aside, limiting assignor estoppel to claims granted pre-assignment would narrow the doctrine in arbitrary and indefensible ways. There is no reason, for instance, that assignor estoppel should not apply to an assigned application that contains the *exact* language of a claim that is later granted. Or consider a situation where one claim is granted, the assignor executes an assignment, and then the Patent Office grants another claim that is dependent on (and thus narrower than) the first claim. Under Minerva’s rule, the assignor would be permitted to attack the validity of the later-granted dependent claim, but not the earlier-granted independent one. That makes no sense.

Limiting assignor estoppel to claims granted pre-assignment also clashes with commercial expectations. “It is unnecessary, and even strategically unwise, for the owner of an invention to await the issuance of letters patent before beginning negotiations with prospective . . . assignees.” 5 John Gladstone Mills III et al., *Pat. L. Fundamentals* § 19:2 (2d ed.). After submitting a patent application, inventors often seek quick approval for a few

narrow claims, attempting to show that the invention is patentable and thus commercially viable. The inventor may then sell the application with the understanding that that the buyer will later seek approval for claims as broad as the Patent Office allows. *Cf. Aronson v. Quick Point Pencil Co.*, 440 U.S. 257, 265 (1979) (recognizing that parties negotiate in light of possible Patent Office actions on pending applications). Here, Truckai surely knew that Cytac (and later Hologic) would “amend[] the claims in the application process (a very common occurrence in patent prosecutions).” Pet. App. 19a (citation omitted).

3. The government opposes Minerva’s categorical proposal, arguing instead that assignor estoppel should apply to assigned applications but only if “either the contested claim is materially identical to a claim issued or pending at the time of the relevant assignment, or the assignor’s invalidity defense otherwise contradicts earlier representations pertaining to the validity of the claim.” U.S. Br. 12-13. That variation is equally unsound.

For one, the government’s proposal is inconsistent with *Westinghouse*, which applied assignor estoppel to patent claims added post-assignment, without requiring or relying on any determination that those claims were “materially identical” to any original ones. *See* 266 U.S. at 354. While the added claims were narrower than one original claim, the Court deemed that fact irrelevant because that original claim “was promptly rejected by the Patent Office” and “was so absurdly broad and all inclusive as almost to indicate that it was made to be rejected.” *Id.* at 354-55.

The government’s proposal also ignores basic rules of patent prosecution. The government seems to assume that the representations in a patent application are limited by the claims pending at any given time, but that is mistaken. In most commercial assignments, assignors sell a portfolio of related patents, patent applications, and

other intellectual property, any of which may contain relevant representations. And applications are defined by the invention(s) they disclose, with the claims subject to change during prosecution. Applicants may add new, broader claims, so long as the amended claims do not recite new subject matter not disclosed in the original application. *See* Manual of Patent Examining Proc. (“MPEP”) § 2163.02-03; 35 U.S.C. § 132. Similarly, an applicant may file a continuation application based on the same inventor’s oath or declaration filed with the original application. *See* 35 U.S.C. § 115(g); MPEP § 602.05(a). Assignors know (or should know) about these rules.

4. Regardless, the Court should affirm even under the government’s test because claim 1 of the ’348 Patent is materially identical to claim 31 of Truckai’s original application. While the two claims are not word-for-word identical (claim 1 is *narrower* in some respects), both lack the limitation that, in Minerva’s view, renders claim 1 invalid—a moisture-permeability requirement. *See supra* pp. 8-10. Claim 31 also was pending at the time of Truckai’s assignment to Novacept and had been deemed patentable by the examiner by the time of Novacept’s assignment to Cytoc. On this record, there is no genuine “factual dispute,” U.S. Br. 32, to resolve.

B. Assignor Estoppel Applies to Invalidity Challenges Under § 112

Minerva next proposes that assignor estoppel should not “preclude an assignor from raising the invalidity defenses available under section 112.” Br. 45. That proposal is both waived and meritless.

Before the Federal Circuit, Minerva did not argue that assignor estoppel is categorically inapplicable to invalidity challenges under § 112 until its reply brief. That is presumably why the Federal Circuit did not mention any such argument. The argument is waived.

On the merits, Minerva offers no *textual* basis for distinguishing written-description and enablement challenges from other invalidity arguments for purposes of assignor estoppel. To the contrary, § 282(b) puts these challenges on the same footing as other invalidity grounds.

As a policy matter, assignor estoppel is, if anything, *least* problematic in the context of § 112 challenges. Unlike other invalidity challenges, the Patent Office has everything it needs during prosecution to evaluate written description and enablement (*i.e.*, the language of the specification and the claims). Anticipation and obviousness under §§ 102-103, by contrast, may depend on prior art the examiner has not seen. And if an examiner misses a written-description or enablement problem, an assignor can challenge validity under § 112 through post-grant review within nine months of issuance. 35 U.S.C. § 321.

Minerva argues that because the specification and claims appear on the face of the patent, the assignee can evaluate validity himself and need not rely on any representation by the assignor. Br. 45-46. As explained, however, reliance is not an element of assignor estoppel. *See supra* pp. 33-34. And the fact that § 112 invalidity turns on the specification and claim language does not eliminate the problems with allowing inventors to testify against their own inventions. *See supra* pp. 34-35. Case in point: Minerva uses Truckai's opportunistic trial testimony to support its § 112 arguments. *E.g.*, Br. 6.

Minerva contends that applying assignor estoppel to § 112 defenses gives assignees a skewed incentive to seek overly expansive claim constructions in court, without fear that doing so will render the claim invalid. Br. 46. But an assignee's incentive to advance an expansive claim construction is still limited by the assignor's ability to use the specification to construe the claim and to argue that ambiguous claims "should be construed to preserve their validity." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1327

(Fed. Cir. 2005) (en banc). Minerva’s skewed-incentive argument also ignores that an assignee who advocates a broad construction against an assignor may later end up in litigation with another opponent who is not precluded from challenging that expansively construed claim’s validity. See *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 390-91 (1996) (holding that claim construction, once resolved, remains consistent across lawsuits). Regardless, even if assignor estoppel encouraged assignees to seek broader claim constructions, those constructions still must be independently evaluated by courts. *Id.*

Minerva likens § 112 invalidity challenges to using prior art to “show the extent of the grant” by the assignor, as *Westinghouse* approved. Br. 46 (quotation marks omitted). But what *Westinghouse* approved was a defense based on claim construction and noninfringement, not invalidity. Assignors thus are free to use the specification to “construe and narrow the claims,” as Minerva attempted to do here. *Westinghouse*, 266 U.S. at 351. But assignors must “conced[e] . . . validity,” and may *not* use prior art, the specification, or anything else “to destroy the patent and defeat the grant, because the assignor is estopped to do this.” *Id.*

Even under a less categorical standard—where assignor estoppel would not apply if the assignee broadened the claims post-assignment beyond what the original application supports—the Court should still affirm. As explained, Truckai’s original application supported and in fact included a claim (claim 31) lacking any moisture-permeability requirement. See *supra* pp. 8-10.

Furthermore, the Federal Circuit already held, in affirming the district court’s claim construction, that issued claim 1 is within the scope of Truckai’s application. As explained, Minerva’s claim-construction and assignor-estoppel arguments have always been the same in substance, just under different rubrics. In both instances, Minerva

has asserted that claim 1, read not to require a moisture-permeable applicator head, is inconsistent with Truckai's specification. *See supra* pp. 11-13. But the district court rejected "Minerva's overly broad claims argument" against assignor estoppel because it was "effectively foreclosed by the court's adoption of Hologic's claim construction." Pet. App. 58a. The Federal Circuit "agree[d]" and affirmed the district court's rejection of Minerva's claim construction, explaining that "[n]either the claim nor the specification describes the 'applicator head' as being permeable." Pet. App. 18a, 21a. Contrary to the government's suggestion, U.S. Br. 31-32, Hologic pointed this out in its brief in opposition, Br. in Opp. 25-27.

There are only two possibilities: Either the invention discussed in Truckai's specification necessarily includes a moisture-permeable applicator head (in which case the claim construction adopted by the district court, affirmed by the Federal Circuit, and unchallenged here, is wrong) or it does not (in which case Minerva's broadening argument fails). So even under this alternative standard, there is nothing left to decide, and this Court should affirm.

C. Assignor Estoppel Applies Absent an Express Representation of Validity or Reliance

Lastly, Minerva proposes limiting assignor estoppel "to situations where an assignor made a representation that claims were valid, on which an assignee reasonably relied." Br. 47. But that would simply abrogate the doctrine, transforming it from an estoppel based on the assignment (akin to estoppel by deed) into a form of estoppel *in pais*. *Westinghouse* rejected this argument, establishing that "the estoppel of an assignment" applies "without special matter *in pais*." 266 U.S. at 351; *see supra* pp. 17, 26-27. Minerva tacitly acknowledges what it is actually advocating when, instead of developing this "alternative" argument, it cross-references its earlier attack on the estoppel-by-deed analogy. Br. 47 (citing Br. 34-37).

For all the reasons already discussed, this purported “limit” on assignor estoppel must therefore fail. *See supra* pp. 32-33.

Regardless, this Court should affirm because Truckai represented the validity of claim 31 in his original application, and Novacept represented and warranted to Cytoc that it knew of no reason any assigned intellectual property was “invalid or unenforceable.” J.A. 638. It is reasonable for assignees to rely on such sworn statements and contractual representations and warranties.

* * * * *

Ultimately, deciding whether or how to modify assignor estoppel is not this Court’s job. *Minerva* and *amici* supporting modification cannot even agree on what change would be appropriate—indeed, some of their proposals are mutually inconsistent. Especially after Congress’s ratification of the doctrine in 1952, Congress should be the body to evaluate proposed changes. Unlike the Court, Congress “has the prerogative to determine the exact right response—choosing the policy fix, among many conceivable ones, that will optimally serve the public interest.” *Kimble*, 135 S. Ct. at 2414.

CONCLUSION

The judgment below should be affirmed.

Respectfully submitted.

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APPENDIX

**APPENDIX A:
PERTINENT STATUTES**

35 U.S.C. § 115 - Inventor's oath or declaration

(a) NAMING THE INVENTOR; INVENTOR'S OATH OR DECLARATION.—

An application for patent that is filed under section 111(a) or commences the national stage under section 371 shall include, or be amended to include, the name of the inventor for any invention claimed in the application. Except as otherwise provided in this section, each individual who is the inventor or a joint inventor of a claimed invention in an application for patent shall execute an oath or declaration in connection with the application.

(b) REQUIRED STATEMENTS.—An oath or declaration under subsection (a) shall contain statements that—

- (1) the application was made or was authorized to be made by the affiant or declarant; and
- (2) such individual believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application.

35 U.S.C. § 261 - Ownership; assignment

Subject to the provisions of this title, patents shall have the attributes of personal property. The Patent and Trademark Office shall maintain a register of interests in patents and applications for patents and shall record any document related thereto upon request, and may require a fee therefor.

Applications for patent, patents, or any interest therein, shall be assignable in law by an instrument in

writing. The applicant, patentee, or his assigns or legal representatives may in like manner grant and convey an exclusive right under his application for patent, or patents, to the whole or any specified part of the United States.

A certificate of acknowledgment under the hand and official seal of a person authorized to administer oaths within the United States, or, in a foreign country, of a diplomatic or consular officer of the United States or an officer authorized to administer oaths whose authority is proved by a certificate of a diplomatic or consular officer of the United States, or apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States, shall be prima facie evidence of the execution of an assignment, grant or conveyance of a patent or application for patent.

An interest that constitutes an assignment, grant or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent and Trademark Office within three months from its date or prior to the date of such subsequent purchase or mortgage.

**APPENDIX B:
DECISIONS APPLYING OR RECOGNIZING
ASSIGNOR ESTOPPEL FROM 1880 TO 1924**

- *Faulks v. Kamp*, 3 F. 898, 901 (C.C.S.D.N.Y. 1880)
- *Onderdonk v. Fanning*, 4 F. 148, 149 (C.C.E.D.N.Y. 1880)
- *Consol. Middlings Purifier Co. v. Guildler*, 9 F. 155, 156 (C.C.D. Minn. 1881)
- *Curran v. Burdsall*, 20 F. 835, 837 (N.D. Ill. 1883)
- *Time Tel. Co. v. Himmer*, 19 F. 322, 323 (C.C.S.D.N.Y. 1884)
- *Underwood v. Warren*, 21 F. 573, 573 (C.C.E.D. Mo. 1884)
- *Parker v. McKee*, 24 F. 808, 808 (C.C.S.D.N.Y. 1885)
- *Alabastine Co. v. Payne*, 27 F. 559, 559 (C.C.N.D.N.Y. 1886)
- *Am. Paper-Barrel Co. v. Laraway*, 28 F. 141, 143 (C.C.D. Conn. 1886)
- *Burdsall v. Curran*, 31 F. 918, 919–20 (C.C.N.D. Ill. 1887)
- *Adee v. Thomas*, 41 F. 342, 345 (C.C.E.D.N.Y. 1890)
- *Blount v. Societe Anonyme du Filtre Chamberland Systeme Pasteur*, 53 F. 98, 104 (6th Cir. 1892)
- *Corbin Cabinet Lock Co. v. Yale & Towne Mfg. Co.*, 58 F. 563, 565–66 (C.C.D. Conn. 1893)

- *Ball & Socket Fastener Co. v. Ball Glove Fastening Co.*, 58 F. 818, 822–23 (1st Cir. 1893)
- *Woodward v. Bos. Lasting Mach. Co.*, 60 F. 283, 284 (1st Cir.), *aff'd*, 63 F. 609 (1st Cir. 1894)
- *Electric Ry. Co. v. Jamaica & B.R. Co.*, 61 F. 655, 677 (C.C.E.D.N.Y. 1894)
- *Babcock v. Clarkson*, 63 F. 607, 607 (1st Cir. 1894)
- *W. Tel. Constr. Co. v. Stromberg*, 66 F. 550, 551 (C.C.N.D. Ill. 1895)
- *Martin & Hill Cash-Carrier Co. v. Martin*, 67 F. 786, 787 (1st Cir. 1895)
- *Nat'l Conduit Mfg. Co. v. Conn. Pipe Mfg. Co.*, 73 F. 491, 493 (C.C.D. Conn. 1896)
- *Missouri Lamp & Mfg. Co. v. Stempel*, 75 F. 583, 584 (C.C.E.D. Mo. 1896)
- *Daniel v. Miller*, 81 F. 1000, 1001 (C.C.E.D. Pa. 1897)
- *Griffith v. Shaw*, 89 F. 313, 315 (C.C.S.D. Iowa 1898)
- *Noonan v. Chester Park Athletic Club Co.*, 99 F. 90, 91 (6th Cir. 1900)
- *Alvin Mfg. Co. v. Scharling*, 100 F. 87, 90 (C.C.D.N.J. 1900)
- *Force v. Sawyer-Boss Mfg. Co.*, 111 F. 902, 903 (C.C.E.D.N.Y. 1901)
- *Am. Coat Pad Co. of Baltimore City v. Phoenix Pad Co.*, 113 F. 629, 632 (4th Cir. 1902)

- *Marvel Co. v. Pearl*, 114 F. 946, 946 (C.C.S.D.N.Y. 1902)
- *Cont'l Wire Fence Co. v. Pendergast*, 126 F. 381, 383 (C.C.D. Minn. 1903)
- *Frank v. Bernard*, 131 F. 269, 270 (C.C.S.D.N.Y. 1904)
- *Hurwood Mfg. Co. v. Wood*, 138 F. 835, 836 (C.C.D. Conn. 1905)
- *Mellor v. Carroll*, 141 F. 992, 993 (C.C.D. Mass. 1905)
- *Siemens-Halske Elec. Co. v. Duncan Elec. Mfg. Co.*, 142 F. 157, 158 (7th Cir. 1905)
- *Wold v. Thayer & Chandler*, 148 F. 227, 229 (7th Cir. 1906)
- *Mathews Gravity Carrier Co. v. Lister*, 154 F. 490, 490 (C.C.D. Minn. 1906)
- *Nat'l Recording Safe Co. v. Int'l Safe Co.*, 158 F. 824, 825 (C.C.N.D. Ill. 1908)
- *N.Y. Phonograph Co. v. Nat'l Phonograph Co.*, 163 F. 534, 538 (C.C.S.D.N.Y. 1908)
- *Babcock & Wilcox Co. v. Toledo Boiler Works Co.*, 170 F. 81, 84 (6th Cir. 1909)
- *Johnson Furnace & Eng'g Co. v. W. Furnace Co.*, 178 F. 819, 822 (8th Cir. 1910)
- *Macey Co. v. Globe-Wernicke Co.*, 180 F. 401, 403 (7th Cir. 1910)
- *Automatic Switch Co. v. Monitor Mfg. Co.*, 180 F. 983, 986 (C.C.D. Md. 1910)

- *Welsbach Light Co. v. Cohn*, 181 F. 122, 126 (C.C.S.D.N.Y. 1910)
- *Onondaga Indian Wigwam Co. v. Ka-Noo-No Indian Mfg. Co.*, 182 F. 832, 835-36 (C.C.N.D.N.Y. 1910)
- *Leather Grille & Drapery Co. v. Christopherson*, 182 F. 817, 821-22 (9th Cir. 1910)
- *Climax Co. v. Ajax Co.*, 192 F. 126, 128-29 (C.C.W.D.N.Y. 1911)
- *Peelle Co. v. Raskin*, 194 F. 440, 442 (E.D.N.Y. 1912)
- *Northern Insulating Co. v. Union Fibre Co.*, 199 F. 793, 795 (D. Minn. 1912)
- *Fishel, Nessler Co. v. Fishel & Co.*, 204 F. 790, 791 (2d Cir. 1913)
- *Rollman Mfg Co v. Universal Hardware Works*, 207 F. 97, 101 (E.D. Pa. 1913)
- *Roessing-Ernst Co v. Coal & Coke By-Prod. Co.*, 208 F. 990, 992 (3d Cir. 1913)
- *Trussed Concrete Steel Co. v. Corrugated Bar Co.*, 214 F. 393, 395-96 (W.D.N.Y. 1913), *aff'd*, 222 F. 514 (2d Cir. 1915)
- *Standard Plunger Elevator Co. v. Stokes*, 212 F. 941, 943 (2d Cir. 1914)
- *U.S. Frumentum Co. v. Lauhoff*, 216 F. 610, 613 (6th Cir. 1914)
- *Schiebel Toy & Novelty Co. v. Clark*, 217 F. 760, 763 (6th Cir. 1914)

- *Mergenthaler Linotype Co. v. Int'l Typesetting Mach. Co.*, 229 F. 168, 172 (S.D.N.Y. 1914)
- *Roessing-Ernst Co v. Coal & Coke By-Prod. Co.*, 219 F. 898, 899 (3d Cir. 1915)
- *Underwood Typewriter Co. v. Manning*, 221 F. 652, 657 (E.D.N.Y. 1915)
- *United Printing Mach. Co. v. Cross Paper Feeder Co.*, 227 F. 600, 602 (1st Cir. 1915)
- *Crown Cork & Seal Co. v. Carper Auto. Bottling Mach. Co.*, 229 F. 748, 753 (D. Md. 1915)
- *Moon-Hopkins Billing Mach. Co. v. Dalton Adding Mach. Co.*, 236 F. 936, 937 (8th Cir. 1916)
- *Leader Plow Co. v. Bridgewater Plow Co.*, 237 F. 376, 377 (4th Cir. 1916)
- *Martin Gauge Co. v. Pollock*, 251 F. 295, 298-99 (N.D. Ill. 1918), *aff'd* 261 F. 201 (7th Cir. 1919)
- *Foltz Smokeless Furnace Co. v. Eureka Smokeless Furnace Co.*, 256 F. 847, 848 (7th Cir. 1919)
- *Robert Findlay Mfg. Co. v. Hygrade Lighting Fixture Corp.*, 275 F. 362, 363 (E.D.N.Y. 1921)
- *Dynamic Balancing Mach Co v. Akimoff*, 279 F. 285, 287 (E.D. Pa.), *rev'd on other grounds*, 285 F. 480 (3d Cir. 1922)
- *Piano Motors Corp. v. Motor Player Corp.*, 282 F. 435, 437 (3d Cir. 1922)
- *Nat'l Cash Register Co. v. Remington Arms Co.*, 283 F. 196, 198 (D. Del. 1922)

- *New Departure Mfg. Co. v. Rockwell-Drake Corp.*, 287 F. 328, 334 (2d Cir. 1922)
- *Robeson Process Co. v. Robeson*, 293 F. 70, 72-73 (D.N.J. 1923)

**APPENDIX C:
DECISIONS RELYING UPON WESTINGHOUSE
AS UPHOLDING ASSIGNOR ESTOPPEL
FROM 1924 TO 1952**

- *Premier Register Table Co. v. West*, 21 F.2d 762, 763 (D. Mass. 1927), *aff'd*, 27 F.2d 653 (1st Cir. 1928)
- *Frick Co. v. Lindsay*, 27 F.2d 59, 61 (4th Cir. 1928)
- *Skelton v. Baldwin Tool Works*, 58 F.2d 221, 225 (4th Cir. 1932)
- *Mario Tanzi & Bros. v. Tanzi*, 1 F. Supp. 227, 229 (E.D.N.Y. 1932)
- *Libbey Glass Mfg. Co. v. Albert Pick Co.*, 63 F.2d 469, 470 (7th Cir. 1933)
- *Applied Arts Corp. v. Grand Rapids Metalcraft Corp.*, 67 F.2d 428, 429 (6th Cir. 1933)
- *Vogt Instant Freezers, Inc. v. N.Y. Eskimo Pie Corp.*, 69 F.2d 84, 87-88 (2d Cir. 1934)
- *Scovill Mfg. Co. v. Radio Corp. of Am.*, 9 F. Supp. 239, 242-43 (S.D.N.Y. 1935)
- *Wilson v. Byron Jackson Co.*, 93 F.2d 572, 575 (9th Cir. 1937)
- *Buckingham Prods. Co. v. McAleer Mfg. Co.*, 108 F.2d 192, 193 (6th Cir. 1939)
- *Automatic Draft & Stove Co. v. Auto Stove Works*, 34 F. Supp. 472, 476 (W.D. Va. 1940)
- *Casco Prods. Corp. v. Sinko Tool & Mfg. Co.*, 116 F.2d 119, 121 (7th Cir. 1940)

- *B. B. Chem. Co. v. Ellis*, 117 F.2d 829, 832 (1st Cir. 1941), *aff'd*, 314 U.S. 495 (1942)
- *U.S. Appliance Corp. v. Beauty Shop Supply Co.*, 121 F.2d 149, 151 (9th Cir. 1941)
- *Dwight & Lloyd Sintering Co v. Am. Ore Reclamation Co.*, 44 F. Supp. 401, 402 (S.D.N.Y. 1941)
- *Crom v. Cement Gun Co.*, 46 F. Supp. 403, 406 (D. Del. 1942)
- *Cook Elec. Co. v. Persons*, 60 F. Supp. 124, 127 (E.D. Mo. 1945)
- *Timken-Detroit Axle Co. v. Alma Motor Co.*, 163 F.2d 190, 191 (3d Cir. 1947)
- *Brown v. Insurograph, Inc.*, 90 F. Supp. 828, 830 (D. Del. 1950)