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Assignor Estoppel Comes with Limits: Consistency is Key

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In earlier posts, [we reported](#) that the Supreme Court granted Minerva Surgical, Inc's petition for a writ of certiorari on the question of "whether a defendant in a patent infringement action who assigned the patent, or is in privity with an assignor of the patent, may have a defense of invalidity heard on the merits," and [outlined](#) Minerva's arguments for abolishing or severely constraining the doctrine. The Supreme Court refused Minerva's proposal to eliminate the doctrine in its entirety, but found credence in its position that the doctrine is too far reaching.

In its [decision](#) delivered by Justice Kagan, the Court held that the doctrine of assignor estoppel "applies only when its underlying principle of fair dealing comes into play." An assignor cannot make representations, either explicit or implicit, that a patent claim is valid and then reverse her or his position to the assignor's (or to a party in privity with the assignor) benefit. Where no such representations were made, the doctrine cannot be involved as there is no unfairness at play.

The Court provides examples of scenarios in which the doctrine cannot be applied because no contradiction arises, including the following: (1) an inventor assigns rights before she or he can make a representation regarding the validity of any patent claims, such as when an inventor assigns rights in an employment contract to all future inventions developed during her or his employment; (2) a legal development renders the original warranty irrelevant; and (3) the claims of a patent or patent application are materially broadened after the assignment is executed.

Minerva contends that Hologic's claims are materially broader than those that the inventor assigned. The Supreme Court remanded the case to the Federal Circuit to determine whether Hologic's claims are indeed materially broader, which would bar the application of the assignor estoppel doctrine.

Justice Barrett, joined with Justices Thomas and Gorsuch, dissented, stating that the assignor estoppel doctrine is not grounded in the text of the [Patent Act of 1952](#).

Justice Alito dissented separately, stating that the Court cannot answer the Petitioner's question without deciding whether [Westinghouse Elec. & Mfg. Co. v. Formica Insulation Co.](#), which recognizes the assignor estoppel doctrine, should be overruled.



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