

Licensing Hot Topics: Assignor Estoppel & Forum Selection

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Introduction to Assignor Estoppel

- Assignor estoppel – common law doctrine that prevents any person or entity that assigns a patent to another from challenging the validity of the assigned patent (*Westinghouse Elec. & Mfg. Co. v. Formica Insulation Co.*, 266 U. S. 342, 349 (1924))
- Equitable doctrine that prevents an assignor who assigns a patent for valuable consideration from later contending that what was assigned is worthless

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Introduction

- Assignor estoppel is binding on the assignor
- Assignor estoppel is also binding on those in privity with the assignor, e.g., a parent company of an assigning subsidiary



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Facts of *Minerva Surgical, Inc. v. Hologic, Inc.*

- Inventor Csaba Truckai co-founded Novacept, Inc. and invented a device to treat abnormal uterine bleeding called the NovaSure system, which uses a **moisture-permeable** applicator head
- Truckai filed a patent application, from which the claims of U.S. Patent No. 9,095,348 claim priority, and assigned the application and any continuations to Novacept in 1998
- Truckai filed another patent application, from which the claims of U.S. Patent No. 6,872,183 claim priority, and assigned the application and any continuations to Novacept in 2001

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Facts of *Minerva Surgical v. Hologic*

- Cytoc Corporation acquired Novacept
- Novacept assigned its patent rights, including rights to continuation applications, to Cytoc
- Hologic acquired Cytoc in 2007
- Continuation application that issued as the '183 was filed in May 2004 and issued in March 2005

Truckai → Novacept → Cytoc → Hologic



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Facts of *Minerva Surgical v. Hologic*

- Truckai founded Minerva Surgical in 2008, and served as Minerva's President, Chief Executive Officer, and a member of its Board of Directors
- Truckai invented a new device to treat abnormal uterine bleeding called the Minerva Endometrial Ablation System, which uses a **moisture-impermeable** applicator head
- Hologic filed a continuation application in 2013, including a claim to encompass applicator heads, without regard to moisture-permeability

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