

- 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

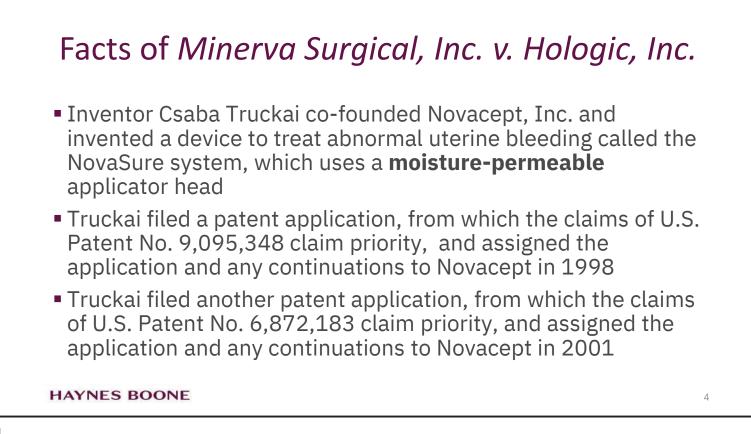
- Assignor estoppel is binding on the assignor
- Assignor estoppel is also binding on those in privity with the assignor, e.g., a parent company of an assigning subsidiary



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## Facts of Minerva Surgical v. Hologic

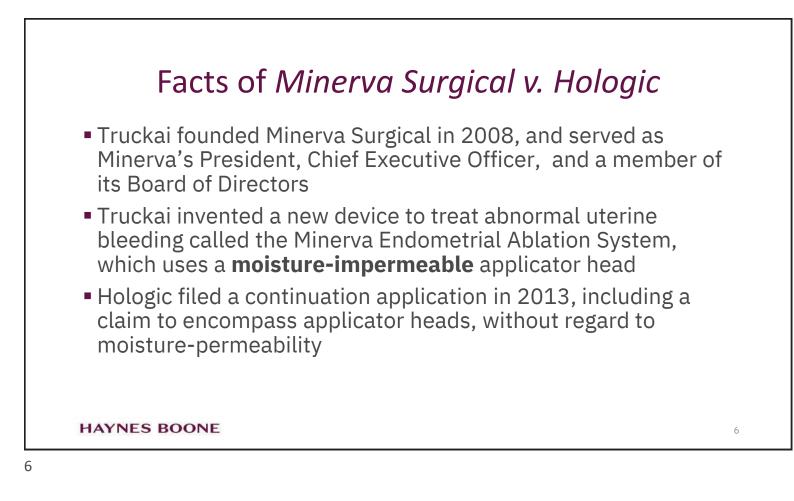
- Cytyc Corporation acquired Novacept
- Novacept assigned its patent rights, including rights to continuation applications, to Cytyc
- Hologic acquired Cytyc in 2007
- Continuation application that issued as the '183 was filed in May 2004 and issued in March 2005

Truckai → Novacept → Cycyt → Hologic



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# Title search: Licensing Hot Topics: Assignor Estoppel & Forum Selection

Also available as part of the eCourse 2022 Advanced Patent Law (USPTO) eConference

First appeared as part of the conference materials for the 17<sup>th</sup> Annual Advanced Patent Law Institute session "Current Topics in Patent Licensing"