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MINERVA I AM NOT – THE MATERIALLY BROADER CLAIM STANDARD AND ASSIGNOR ESTOPPEL

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ABSTRACT

A longstanding equitable principle of patent law has been that persons who sell their patent to another cannot later disparage or otherwise deny the existence of those government rights in a suit for infringement brought by the buyer against the seller. This equitable doctrine is known as assignor estoppel. The foundational legal and moral rationale that undergirds this rule is fair play and fair dealing. The important legal questions in *Minerva Surgical, Inc. v. Hologic, Inc.* were: (1) whether to strike down the equitable doctrine and (2) if the doctrine survives what should be the scope of its reach? After answering the first question in the affirmative, a divided Supreme Court established new limits for the application of the doctrine – the materially broader claim standard. This new requirement states that claims of a patent that are materially broader than those originally assigned are outside the assignee’s safe harbor of the assignor estoppel. Unfortunately, the Court provided no guidance about how to recognize when one claim is materially broader than another. Thus, the standard is just another judicial line drawing test fraught with uncertainty as to its application. This article suggests that a focus on the technical disclosure, and not the claims, when deciding whether or not to apply the doctrine is a sounder approach. The reason being is that a patent’s specification provides more certainty as to the property conveyed by virtue of its inherent nature as a robust and concrete description of the invention(s). The scope of claims in stark contrast is often unknown at the time of the patent conveyance which creates substantial uncertainty that often leads to judicial speculation as to the patent property.



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I. INTRODUCTION

Over a year ago, the United States Supreme Court addressed the topic of assignor estoppel in *Minerva Surgical, Inc. v. Hologic, Inc.* This equitable rule prevents a person who sells a patent from challenging the validity of that intellectual property in a subsequent suit for infringement brought against him by the buyer of those rights.¹ The central issue in that case was whether to abandon the doctrine of assignor estoppel. After readily recognizing the rule's continued value, the Court decided not to abandon it, but made clear that there were limits to its application.² In particular, when claims of a patent go beyond that which an assignor intended to claim as patentable, then the equitable rule does not apply. Refraining from applying assignor estoppel when claims go beyond an inventor's intent is justifiable because the assignor did not warrant the validity of such claims.³ In other words, the material changes to claims voids any representation or warranty given by the assignor concerning the validity of the property exchanged as part of the patent conveyance. Unfortunately, this logic is outside our patent jurisprudence. Representations and warranties are terms of contract, not patent law. Moreover, the materially broader standard is no standard at all. The Court provides no guidance about how to distinguish between claims for which the doctrine applies and those for which it does not. The standard is simply another subjective, line-drawing test fraught with practical difficulties in its application. Thus, the Court's decision to limit assignor estoppel using the materially broader claim standard renders for all intents and purposes this important common law rule to the dustbin of legal history.

In *Minerva*, the inventor was the founder of Minerva Surgical, Inc., which was a fateful choice of company name.⁴ As you may recall from mythology, the Roman goddess Minerva turned the priestess Medusa from a beautiful maiden into a monster with hissing snakes for hair and lacking personal charm.⁵ The inventor in this patent

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¹ See J. THOMAS MCCARTHY, DESK ENCYCLOPEDIA OF INTELLECTUAL PROPERTY 34 (3d ed. 2004).

² *Minerva Surgical, Inc. v. Hologic, Inc.*, No. 20-440, slip op. 1, 14 (2021).

³ See *id.* at 16.

⁴ *Hologic, Inc. v. Minerva Surgical, Inc.*, 325 F. Supp. 3d 507, 517 (D. Del. 2018).

⁵ See Madeleine Glennon, *Medusa in Ancient Greek Art*, THE METROPOLITAN MUSEUM OF ART (Mar. 2017), http://www.metmuseum.org/toah/hd/medu/hd_medu.html.

dispute, however, is not playing the role of his company's namesake to transform Hologic's patent from a valuable government right into a worthless piece of paper. Rather, the inventor attempts to play the part of Perseus, the heroic mythical figure who used Medusa's own reflection to defeat her.⁶ Just as Medusa was deficient in personal charm, bad patents lack the inventive charm that promotes innovation. Bad patents are those patents that should never have been granted by the patent office, but yet somehow make it through and find their way to issuance. Such patents include claims of overly expansive scope, and thus take technology out of the public domain and thereby fail to promote technological innovation for the benefit of society⁷. These bad patents give other persons in the market pause and thus stifle innovation. This suppressive effect is reminiscent of Medusa's mystical power to turn people to stone.⁸

Assignor estoppel is a legal shield to protect bonafide purchasers of patent rights from unscrupulous so-called inventors. The judicial doctrine of assignor estoppel was founded on the principle of fair play and dealing.⁹ After all, inventors understand and appreciate their inventions better than anyone else, and they should bear the equitable burden of dealing fairly and honestly with purchasers of their innovations. Here, however, Hologic chose to put down its equitable shield and instead grasped its contrived legal sword forged in the enduring flames of assignor estoppel. Once unsheathed, the sword was raised to put down a competitor on the legal battlefield. This, Hologic cannot do. Hologic cut off a powerful legal defense which Minerva had an equitable right to use. By striking with the sword of assignor estoppel, the doctrine no longer stops unfairness. Rather, it inflicts it.

The decision in *Minerva* rests on a misconception introduced in *Westinghouse Elec. Mfg. Co. v. Formica Insulation Co.*, that the property conveyed in patent transactions is the claimed invention in view of the claims as assigned rather than the technical disclosure that underlies the claims.¹⁰ This misconception goes to the core of the Court's decision in *Minerva*. It is the very reason why the Court announced its unworkable materially broader standard. We need to get back to the basics. The disclosure is the intellectual property; the claims merely define its bounds. Patent specifications often describe inventions having many variations, any one of which can possibly be claimed. In some instances, those variations can result in different patentable inventions altogether, as evidenced by the patent office's restriction rules.¹¹ So, when a patentee claims just one invention, does that mean that any of the other inventions disclosed were not part of the patent conveyance? A focus on claim evolution to determine the property conveyed in a patent transaction is too narrow a view and leads to troublesome problems about how to determine intellectual property.

⁶ EDITH HAMILTON, MYTHOLOGY: TIMELESS TALES OF GODS AND HEROES 150-51 (Warner Books 1969) (1942).

⁷ See *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 6 (1966)). ("Congress may not create patent monopolies of unlimited duration, nor may it 'authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available.'").

⁸ HAMILTON, *supra* note 6, at 149.

⁹ *Westinghouse Elec. & Mfg. Co. v. Formica Insulation Co.*, 266 U.S. 342, 350 (1924).

¹⁰ See *id.* at 350-51 ("measuring the extent of the grant the government intended and which the assignor assigned").

¹¹ 37 C.F.R. § 1.142 (2009) ("(a) If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted . . .").

Instead, using the technical disclosure as the legal lens through which to view the patent property conveyed avoids all the unpleasant messiness and pitfalls that occur when comparing originally filed and granted claims. A patent's written description changes very little, if at all, during the pendency of the application. In the unlikely event that a change is made, the written description offers a robust disclosure of the invention that provides sufficient context to understand the reason and scope of the amendment.¹² Such changes are often generally clarifying in nature.¹³ Claims, on the other hand, are amended frequently during patent prosecution. Claim amendments are also made in varying degrees of scope and complexity. The point of demarcation between claim amendments that invoke the doctrine and others that do not is unknown. The Court's decision in *Minerva* provides little to no guidance about how to locate that proverbial line in the sand. Would the doctrine apply when an amendment merely changes one word or two? Perhaps removal or addition of an entire claim element would justify not invoking the doctrine. Or, could modification of a claim preamble justify non-application of the doctrine. No one knows the answers to these questions. Under the Court's approach, the bargain between assignor and assignee becomes ill-defined at best or is, at worst, without definition at all.

In *Minerva*, the inventor was not saying what he invented was worthless as has so often been the case in many previous court decisions.¹⁴ *Minerva* is different. The inventor was saying that the claimed invention was not his.¹⁵ Or, in other words, the claimed invention was never conveyed in the first place.¹⁶ Unlike those previous cases, the inventor in *Minerva* is not taking inconsistent positions to weasel out of a bargain

¹² See, e.g., *General Elec. Co. v. Cooper Hewitt Elec. Co.*, 249 F. 61, 63-65 (6th Cir. 1918) ("The original drawing did not show any anode bulb or passage thereto from the illuminating tube, nor did the specification contain any particular description of either. During the progress of the application, an amended drawing was filed as above, and the specification was made to say, in so many words, that the anode bulb was larger than the cathode, and that the passage leading from the illuminating tube to the anode was larger than the passage or intermediate tube leading to the cathode bulb. . . . It is clear to us that Kuch's original application did cover and include these features sufficiently to justify the later fuller description and drawing. After reciting that the evolution of heat at the anode was greater than at the cathode, so that the vaporization at the latter was less, he said that the first object of his invention was to so determine the sizes of the two electrode vessels that they should be in the same proportion as the heats developed in them, and that the second object was to connect the cathode with the illuminating tube by means of a narrow intermediate tube.").

¹³ See, e.g., *Bickell v. Smith-Hamburg-Scott Welding Co.*, 53 F.2d 356, 358 (2d Cir. 1931) ("It is true that the original application did not mention the word 'siphon,' and that only one of the seventeen original claims could possibly be read as claiming a tank truck discharging by siphonic action. The original specifications and drawings disclosed a tank divided into compartments and equipped with two systems of piping, one for discharging the gasoline, and the other a fire-fighting apparatus. . . . While it seems somewhat strange that the original application did not in express terms refer to 'siphonic discharge,' the specifications and drawings show a machine which could operate in that way, and claim 13 can be read as claiming it. Therefore the amendment of 1926 did not introduce a new and previously undisclosed invention.").

¹⁴ See, e.g., *Westinghouse Elec. & Mfg. Co.*, 266 U.S. at 351 (discussing a myriad of circuit and district court cases that developed the rule that an assignor of a patent right is estopped from attacking the utility, novelty, or validity of a patented invention).

¹⁵ See *Hologic, Inc.*, 325 F. Supp. 3d at 526 ("Minerva's argument that the Patents-in-Suit had to provide a written description and enablement of the accused devices plasma formation feature is unavailing. The claims at issue herein do not recite a plasma formation feature.").

¹⁶ See *id.* at 527 (discussing how Minerva made arguments that exemplary embodiments define "the invention" and require a "moisture transport system" with a "permeable external array").

as some form of seller's remorse.¹⁷ Rather, he maintains his position and points to his specification to support his stance. That specification memorializes his contributions to the useful arts and establishes that the principles of equity that undergird the doctrine do not apply in this instance. Unfortunately, the courts refused to consider Minerva's arguments that the technical disclosure failed to describe the claimed invention.¹⁸ The tools of written description and enablement provide the Court with ready and well-understood means to determine whether Minerva's invalidity challenge raised equitable concerns, yet the Court refused to apply them. Rather, the Court instead pronounced the materially broader claim standard with no guidance as to how to apply it.¹⁹ The Court's approach is not only unworkable, but also likely renders the doctrine of assignor estoppel out of reach to many patentees who have received patents with claims different from those originally assigned.

II. A MISTAKE OF BARGAINS

The patenting process often involves two different but related bargains: one between assignor (i.e., inventor) and assignee (e.g., an employer or other third party), and another between the applicant (i.e., the inventor or assignee) and the public.²⁰ The first being a transfer of intellectual property in the form of a technical disclosure (i.e., the patent specification).²¹ The second, on the other hand, is a negotiation of rights that focuses on claims derived from that technical disclosure.²² The dispute in *Minerva*

¹⁷ See, e.g., *Faulks v. Kamp*, 3 F. 898, 899 (S.D.N.Y. 1880) ("The defendants now deny validity of the patent because they say that Brown was not the original and first inventor of the improvement described in it.").

¹⁸ See, e.g., *Hologic, Inc.*, 325 F. Supp. at 527 ("Minerva's other criticisms for the descriptions are also directed at exemplary embodiments and raise previously rejected arguments that would serve to improperly limit that [sic] claims. The court finds Minerva's section 112 arguments rest on a flawed definition of the claims that ignores the court's claim constructions.").

¹⁹ See *Hologic, Inc. v. Minerva Surgical, Inc.*, 44 F.4th 1358, 1365 (Fed. Cir. 2022) (stating that materially broader claim standard requires construing the assigned and issued claims and comparing the properly construed claims, but the court lacks any citation to the Supreme Court's decision in *Minerva* to support such a requirement).

²⁰ See e.g., *Westinghouse Elec. & Mfg. Co.*, 266 U.S. at 348 (discussing the assignability of patents); MCCARTHY, *supra* note 1, at 434 ("A patent may be analogized to a bargain between the inventor and the government.").

²¹ See JASPER SILVA COSTA, LAW OF INVENTING IN EMPLOYMENT 74-75 (1953) ("The employee may contract away his inventive efforts if they result in a patent, a patent being property title to which passes by assignment. It follows that if the patent is assignable the underlying invention may also be the subject of a bargain, title to which passes in the execution thereof."). See also *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1345 (Fed. Cir. 2010) ("Every patent must describe an invention. It is part of the quid pro quo of a patent; one describes an invention, and, if the law's other requirements are met, one obtains a patent.").

²² See *Bonito Boats, Inc.*, 489 U.S. at 150-51 ("The Applicant whose invention satisfies the requirements of novelty, nonobviousness, and utility, and who is willing to reveal to the public the substance of his discovery and 'the best mode . . . of carrying out his invention,' 35 U.S.C. § 112, is granted 'the right to exclude others from making, using, or selling the invention throughout the United States,' for a period of 17 years. 35 U.S.C. § 154. The federal patent system thus embodies a carefully crafted bargain for encouraging the creation and disclosure of new, useful, and nonobvious advances in technology and design in return for the exclusive right to practice the invention for a period of years.

is about the first transaction, not the second. For the reasons discussed in more detail below, Hologic claimed an invention that fell outside the technical disclosure conveyed and thus made the doctrine not applicable.

The Court's approach in *Westinghouse* is outdated and no longer suitable to follow as legal precedent. The Court in *Minerva* noted as such by mentioning that patent claims are now construed mainly by reference to their text (i.e., the specification).²³ This admission alone should have been sufficient justification to overrule *Westinghouse*. As such, the Court in *Minerva* should have felt free to lift off the shackles of *stare decisis* to take a fresh look at the issue. The difficulty with *Westinghouse* is that the Court conflates the right of exclusivity as defined by the claims with that of the property conveyed under patent assignment (i.e., the technical disclosure).²⁴ These are two separate, but related ideas. Claims are separate and distinct from the specification.²⁵ They merely lay out the metes and bounds of the government rights in the technical property described in the specification.²⁶ The employee may contract away his inventive efforts including any rights therein. If those efforts result in a patent, the patent being property title to which passes by assignment then becomes part of the transaction as well. It follows then that if the patent is assignable the underlying invention(s) is also the subject of the same bargain, title to which passes in the execution of the assignment.

To set those bounds, the claims must be rooted in the content of the specification.²⁷ In other words, the scope of a patent's claims determines what infringes the patent; it is no measure of what it discloses.²⁸ Thus, the technical disclosure is the intellectual

[The inventor] may keep his invention secret and reap its fruits indefinitely. In consideration of its disclosure and the consequent benefit to the community, the patent is granted.”)

²³ *Minerva Surgical, Inc.*, 141 S. Ct. at 1078.

²⁴ See *Westinghouse Elec. & Mfg. Co.*, 266 U.S. at 353 (“When the assignment is made before [the granting of the] patent, the claims are subject to change by curtailment or enlargement by the Patent Office with the acquiescence or at the instance of the assignee and the extent of the claims to be allowed may ultimately include more than the assignor intended to claim. This 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.”).

²⁵ See *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1274 (Fed. Cir. 1992) (stating that specification is distinct from claims).

²⁶ *Motion Picture Pats. Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 510 (1917) (citing to *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 278 (1877)) (“The scope of every patent is limited to the invention described in the claims contained in it, read in the light of the specification. These mark where the progress claimed by the patent begins and where it ends that they have been aptly likened to the description in a deed, which sets the bounds to the grant which it contains. It is to the claims of every patent, therefore, that we must turn when we are seeking to determine what the invention is, the exclusive use of which is given to the inventor by the grant provided for by the statute, — ‘He can claim nothing beyond them.’”). See also *A.B. Dick Co. v. Burroughs Corp.*, 713 F.2d 700 (Fed. Cir. 1983) (“It is elementary that the property right bestowed by a patent is measured in the first instance by the claims.”).

²⁷ See *In re Rasmussen*, 650 F.2d 1212, 1214 (C.C.P.A. 1981) (“Section 112, first paragraph, requires that claim language be supported in the specification.”).

²⁸ *In re Benno*, 768 F.2d 1340, 1346 (Fed. Cir. 1985) (“A patent discloses only that which it describes, whether specifically or in general terms, so as to convey intelligence to one capable of understanding.”).

property conveyed under a patent assignment and any legal rights flow from ownership of that disclosure.

A property right is one that is derived from ownership of property.²⁹ Just as landowners have the right to quiet enjoyment of their land, so too do patent owners have the right to exclude others from the technological territory.³⁰ But these rights are derived from property ownership.³¹ Without ownership, there are no enforceable rights.³² For instance, in a simple transaction of real property (assuming no covenants or rights of way) the property is the land. Any rights and causes of legal action are derived from being a landowner. Similarly, a patentee's right of exclusivity is derived by ownership of the technological disclosure along with the patent office's acceptance of the claimed invention as disclosed therein (i.e., the granted patent).³³ Any causes of action to exclude others from the disclosed technology are derived from ownership of that disclosure and its granted claims.³⁴ Just as the tort of trespass is a cause of action derived from land ownership, so too is patent infringement derived from ownership of technical disclosure in the form of a government patent. *Westinghouse* led us down a wrong path that viewed the patent property conveyed as the legal right to exclude others. The Court today should have corrected that misstep.

If one takes the Court's approach that the patent property is right to exclude others as defined by the claims, then the analogy to land falls apart. Mischief begins to creep into the Court's approach because the property of exclusivity is dependent on the claims which are subject to change.³⁵ Even granted patents can have their claims

²⁹ See *Property*, BLACK'S LAW DICTIONARY (8th ed. 2004) ("1. The right to possess, use, and enjoy a determined thing (either a tract of land or a chattel); the right of ownership . . . 2. Any external thing over which the rights of possession, use, and enjoyment are exercised.").

³⁰ See *Enjoyment-Quiet Enjoyment*, BLACK'S LAW DICTIONARY (8th ed. 2004) ("The possession of land with the assurance that the possession will not be disturbed by a superior title"); see *Trespass-Trespass Quarentis Clausum Fregit*, BLACK'S LAW DICTIONARY (8th ed. 2004) ("1. A person's unlawful entry on another's land that is visibly enclosed. This tort consists of doing any of the following without lawful justification: (1) entering upon land in possession of another . . .").

³¹ See, e.g., *Sicom Systems, Ltd. v. Agilent Tech., Inc.*, 427 F.3d 971, 980 (Fed. Cir. 2005) ("Unlike an assignee who may sue in its own name, an exclusive licensee having fewer than all substantial patent rights and seeking to enforce its rights in a patent generally must sue jointly with the patent owner") (citing *Ortho Pharm. Corp. v. Genetic Inst., Inc.*, 52 F.3d 1026, 1030 (Fed. Cir. 1995)).

³² See ALBERT H. WALKER & ANTHONY WILLIAM DELLER, WALKER ON PATENTS § 425 (Deller's ed. 1937) ("The plaintiff in an action or suit based on an infringement of a patent may be the patentee, or the sole assignee of that patent; or any grantee under a patent may sue alone, for any infringement committed within his territory.").

³³ See *id.* at § 450 ("The grant of a patent confers upon the patentee the exclusive right to make, use, and vend the invention or discovery throughout the United States, and the Territories thereof . . .").

³⁴ See *Bushnell, Inc. v. Brunton Co.*, 659 F. Supp. 2d 1150, 1158 (D. Kan. 2009) (footnote omitted) ("The essence of a patent is the legal right to exclude others from making, using, selling or offering to sell the patented invention in the United States, or importing the invention into the United States. 35 U.S.C. §§ 154, 271. The patent statutes give rise to the right to sue for patent infringement. *Morrow*, 499 F.3d at 1339. Standing to sue for patent infringement derives from 35 U.S.C. § 281, which provides that a "patentee" can sue for patent infringement. *Int'l Gamco*, 504 F.3d at 1276; see also *Morrow*, 499 F.3d at 1339. The term 'patentee' includes the patentee's successors in title. 35 U.S.C. § 100(d) (2006); *Int'l Gamco*, 504 F.3d at 1276.").

³⁵ 37 C.F.R. § 1.121 (2022).

changed, such as in a broadening patent reissue.³⁶ This problem does not exist for land because real property does not physically move. Therefore, the *Westinghouse* Court begins by saying that a patent's scope is not easily determined, unlike a piece of land.³⁷ This statement makes sense if one takes a view of the property to be simply the patent claims. But if one takes the view that the property conveyed is the technical disclosure, then the analogy to land becomes less problematic. Just as a surveyor might confirm a land description by surveying the physical property, courts too can go back to the disclosure and survey its contents to confirm its claims.³⁸ The difficulty with unsettled claims was discussed and put off in *Westinghouse* and then unsuccessfully resolved in *Minerva*.³⁹ The Court's continued focus on the patent property being solely the claimed invention is the wrong approach. Rather, a patent's specification is the entirety of the property conveyed.⁴⁰ Disputes about that patent property must focus on claims in view of their specification, not just the claims in view of themselves. Any other approach takes too narrow a view of the patent conveyance. *Westinghouse's* claim-centric approach to patent property is based on a fallacy that the patent property conveyed by a patent assignment is merely that which is claimed.⁴¹

The structure and content of patent assignment documents also make clear that it is the technical disclosure, not the claims, which is the property conveyed. For example, patent assignments are ordinarily written in broad and general terms that convey the entirety of property described in the specification, not just the claimed

³⁶ 35 U.S.C. § 251 (2011) "(a) IN GENERAL.— Whenever any patent is, through error, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue. . . . (d) REISSUE PATENT ENLARGING SCOPE OF CLAIMS. —No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent."

³⁷ *Westinghouse Elec. & Mfg. Co.*, 266 U.S. at 350 ("The grantor purports to convey the right to exclude others, in one instance, from a defined tract of land, and in the other, from a described and limited field of the useful arts. The difference between the two cases is only the practical one of fixing exactly what is the subject matter conveyed. A tract of land is easily determined by survey. Not so the scope of a patent right for an invention.")

³⁸ See *LizardTech, Inc. v. Earth Res. Mapping, Inc.*, 424 F.3d 1336, 1346 (Fed. Cir. 2005) ("After reading the patent, a person of skill in the art would not understand how to make a seamless DWT generically and would not understand LizardTech to have invented a method for making a seamless DWT . . .").

³⁹ *Westinghouse Elect. & Mfg. Co.*, 266 U.S. at 352-53 ("We have been speaking of the application of estoppel in the assignment of patents after they have been granted and their specifications and claims have been fixed. The case before us, however, concerns assignment of an invention and an inchoate right to a patent therefor [*sic*] before the granting of it after the assignment at the instance of the assignee, ripened into a patent. . . . This difference [in the claims after assignment] might justify the view that the range of relevant and competent evidence in fixing the limits of the estoppel should be more liberal than in the case of an assignment of a granted patent. How this may be, we do not find it necessary to decide.")

⁴⁰ See *RIDSDALE ELLIS, PATENT ASSIGNMENTS AND LICENSES* 44 (1936) ("No particular form of assignment is required so long as: "(2) It is executed after the invention has been reduced to practice either actually or constructively.")

⁴¹ *Westinghouse Elec. & Mfg. Co.*, 266 U.S. at 350-51 ("[T]he scope of the right of exclusion granted . . . measuring the extent of the grant the government intended and which the assignor assigned would be denied to the court in reaching a just conclusion.")

invention.⁴² Assignments must identify the patent property conveyed.⁴³ Oftentimes, such documents simply include a title to a patent application and its serial number assigned by the patent office to identify the property being conveyed.⁴⁴ References to claims or a claimed invention are not required nor desired.⁴⁵ Identifying patent property by its claims in an assignment would lead to practical difficulties in establishing ownership as claims are subject to change⁴⁶. Amendments to the claims could negate the effectiveness of the property transfer under general principles of contract law.⁴⁷ If the view that claims define the property is followed, then how can any patent assignment be effective without specifying the claimed invention? The reality is that patent assignments convey technical disclosure. Any part of that disclosure can be claimed as a patentable invention.⁴⁸ As such, discussions about the

⁴² See BRIAN G. BRUNSVOLD & DENNIS P. O'REILLY, DRAFTING PATENT LICENSE AGREEMENTS 262 (4th ed. 1998) (“Form B3 -Assignment of an Invention, With Ensuing Patent Rights – by the Inventor to a Corporation, ‘sell and assign to ABC Company, a Delaware corporation, the entire right, title and interest in and to the _____ invented by me as described in the application for U.S. patent”).

⁴³ See *Euclid Chemical Co. v. Vector Corrosion Tech.*, 561 F.3d 1340, 1349 (Fed. Cir. 2009) (“Such a prospective provision does not remove the obligation of contracting parties to identify the existing patent properties that are being assigned. It is a truism of patent practice that transfers of patent property require specificity as to the property transferred.”). See, e.g., *Estate of Paxton v. Comm’r*, 44 T.C.M. (CCH) 771 (T.C.1982) (“During all times herein, it was a well-established trade practice for patent lawyers to describe and identify inventions with specificity in legal instruments licensing the right to exploit, assigning or otherwise affecting property rights in the invention.”).

⁴⁴ See *Poole v. Comm’r*, 46 T.C. 392, 406 (T.C. 1966) (“We have examined the Revolvex-Poole agreement of March 1, 1956, and find that it did not obligate Poole to assign the patent applications for the hinged bay window. The 1956 contract clearly identified by number the patent applications included in the contract and bound Poole to assign the patents on those applications only. The contract did not mention the hinged bay window.”).

⁴⁵ See WALKER & DELLER, *supra* note 32, at § 340 (“The patent assigned ought to be described in the assignment by its number and date, and by the name of the patentee, and by the name of the invention which it purports to cover”). See also ELLIS, *supra* note 40, at 44 (“However, positive identification by reference to a specific application or patent is necessary to enable a record of the assignment to constitute constructive notice . . . and to enable the assignee to claim rights and privileges of an assignee in the Patent Office. The identification required by the Patent Office is specified in Rules 26 and 186. Rule 26 provides that ‘if it (*i.e.*, the assignment) be dated subsequently to the execution of the application, it must give the date of the execution of the application, or the date of filing, or the serial, so that there can be no mistake as to the particular invention intended.’ Rule 186 provides that: ‘Such instrument (*i.e.*, assignment) should identify the patent by date and number.’”).

⁴⁶ 37 C.F.R. § 1.121 (2022).

⁴⁷ See RESTATEMENT (SECOND) OF CONTRACTS, § 33 (AM. L. INST. 1981) (“Certainty (1) Even though a manifestation of intention is intended to be understood as an offer, it cannot be accepted so as to form a contract unless the terms of the contract are reasonably certain.”).

⁴⁸ See, e.g., *In re Heinle*, 342 F.2d 1001, 1007 (C.C.P.A. 1965) (“There remains the rejection of these claims because they contain a limitation said to be without support in the disclosure. The limitation is that the width of the apertures in the core is ‘approximately one-fourth of the circumference of said core.’ . . . The examiner . . . finding no specific mention of it in the words of the specification, rejected appellant’s argument that the width dimension of these claims is shown in the drawings. . . . Our inspection of the application drawings leads us to agree with the board that Fig. 2 depicts a pair of slots with the claimed width dimensions and to disagree that Figs. 1 and 4 fail to show that same dimension. The latter figures are perspective views and it seems to us that they conform to the one-fourth circumference limitation almost exactly.”).

property conveyed in a patent assignment must focus on the technical disclosure, not the claims. To do otherwise would perpetuate a legal fiction where the patent assignment document controls the transaction but claims yet to be written define the chattel.

III. THE SINGLE-INVENTION FALLACY

There is a fallacy among some that inventors assign their rights to a single invention. Oftentimes, however, the language of the assignment can be much broader than that. In many cases, inventors assign away their rights to all inventions described in the patent application.⁴⁹ This is well-understood by practitioners who prosecute patent applications. Applications for patent protection often include several embodiments of an inventive concept any one of which can be claimed as a patentable invention.⁵⁰ This kind of thorough and detailed description is a best practice in patent preparation because such complete descriptions give applicants confidence that the Patent Office will likely find something worthy of a patent protection and thereby justify the significant time and expense to file a patent application.⁵¹ The patent system also reflects the reality of multiple inventions within a single patent application. For instance, the patent system allows for divisional patent applications and continuation of patent applications.⁵² Also, the Patent Office's long-standing practice of restricting claims that seek protection for different inventions by its very nature concedes that patent applications often include multiple inventions.⁵³ Thus, patent applications commonly describe multiple inventions that are transferred by patent assignments.

In *Minerva*, the inventor executed an assignment document written in broad terms that assigned rights to all inventions described in the application for patent.⁵⁴ The plain language of the agreement unambiguously identifies the intention of the parties to transfer rights to all inventions disclosed in the patent application⁵⁵.

⁴⁹ See ELLIS, *supra* note 40, at 40 (“In the case of assignments before issue, it is especially important in identifying the subject-matter of the assignment that it should be made clear that the invention is assigned as well as the application relating to thereto, so as to cover divisionals, renewals and continuations.”).

⁵⁰ JOSEPH ROOT, RULES OF PATENT DRAFTING: GUIDELINES FROM FEDERAL CIRCUIT CASE LAW 39 (2016) (“No matter whether the inventor provides one embodiment or five, the drafter’s job is to build in as many alternatives as both she and the inventor can imagine. . . . The objective is to provide as much material as possible to demonstrate the inventor’s intent to disclose as broad an invention as possible, entitling her to commensurate claim scope.”).

⁵¹ *Id.* at 28 (“Rule 2: Describe multiple embodiments or examples, and with those embodiments set out alternatives and variations. Use both generic and specific language to claim items.”).

⁵² MANUAL OF PATENT EXAMINING PROCEDURE (“MPEP”) § 201.06 (2020) (“A later application for an independent or distinct invention, carved out of a pending application and disclosing and claiming only subject matter disclosed in the earlier or parent application, is known as a divisional application or ‘division’”); *In re Bauman* 683 F.2d 405, 408 (Fed Cir. 1982) (“A continuation application enables an applicant to, inter alia, claim inventions disclosed but not previously claimed . . .”).

⁵³ MPEP, *supra* note 52, § 802.01. If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions.

⁵⁴ See *Hologic, Inc. v. Minerva Surgical*, 957 F.3d 1256, 1263 (Fed. Cir. 2020).

⁵⁵ See *id.* at 1268 (referring to the inventor’s execution of a broad patent assignment).

Language from the patent assignment, such as “all right, title, and interest in and to the said invention, said application for United States Letters Patent, and any Letters Patent which may hereafter be granted on the same in the United States and all countries ... including any divisions ... and continuations...”, is unambiguous and clear. Thus, on its face, the assignment plainly indicates the intention of the parties to transfer rights in all inventions as described in the patent application. *Minerva* does not dispute the terms or effectiveness of that document.⁵⁶

IV. A DOCTRINE ROOTED IN FAIR PLAY & DEALING

The equitable roots of assignor estoppel have stretched deep into the fertile ground of our legal tradition for over 100 years.⁵⁷ In *Westinghouse*, the Court took up the doctrine as a matter of first impression.⁵⁸ *Westinghouse* staked out the equitable ground in which the Court firmly planted assignor estoppel, giving life to the doctrine of fair dealing.⁵⁹ Since then, subsequent courts have recognized that other factors exist in support of the assignor estoppel doctrine, but fair play and dealing remain the touchstone for application of the doctrine.⁶⁰

Fairness, however, is not a one-way street. Rather, equity requires fair play and dealing from both parties, not just the assignor.⁶¹ Our legal precedents have dealt with assignor estoppel to address unfair behavior of the assignor. But what happens if the assignee acts unjustly? For example, what if an assignee claims more patent protection than he or she has the right to do by law? Can the assignee deflect reasonable inquiries into such an overreach of patent rights by invocation of the doctrine? That is the legal question in *Minerva*. Put differently, the inventor in *Minerva* was not saying that the

⁵⁶ *Id.*

⁵⁷ *Westinghouse Elec. & Mfg. Co.*, 266 U.S. at 349; *Scott Paper Co. v. Marcalus Mfg. Co.*, 326 U.S. 249, 260 (1945) (Frankfurter, J., dissenting) (“The principle of fair dealing as between assignor and assignee of a patent whereby the assignor will not be allowed to say that what he has sold as a patent was not a patent has been part of the fabric of our law throughout the life of this nation.”).

⁵⁸ *Westinghouse Elec. & Mfg. Co.*, 266 U.S. at 349.

⁵⁹ *Id.* at 350 (“If one lawfully conveys to another a patented right to exclude the public from the making, using, and vending of an invention, fair dealing should prevent him from derogating from the title he has assigned, just as it estops a grantor of a deed of land from impeaching the effort of his solemn act as against a grantee.”).

⁶⁰ *Diamond Scientific Co. v. Ambico, Inc.*, 848 F.2d 1220, 1224-25 (Fed. Cir. 1988) (“Assignor estoppel is an equitable doctrine that prevents one who has assigned the rights to a patent (or patent application) from later contending that what was assigned is a nullity. . . . The four most frequently mentioned justifications for applying assignor estoppel are the following: ‘(1) to prevent unfairness and injustice; (2) to prevent one [from] benefiting from his own wrong; (3) by analogy to estoppel by deed in real estate; and (4) by analogy to a landlord-tenant relationship.’ . . . Although each rationale may have some utility depending on the facts presented by the particular case, our concern here is primarily with the first one . . . we believe that the primary consideration in now applying the doctrine is the measure of unfairness and injustice that would be suffered by the assignee if the assignor were allowed to raise defenses of patent invalidity.”).

⁶¹ *Clean Hands*, A DICTIONARY OF LAW (7th ed. 2009, rev. 2013), Oxford Reference, <https://www.oxfordreference.com/view/10.1093/oi/authority.20110803095616664> (“A phrase from a maxim of equity: he who comes to equity must come with clean hands, i.e. a person who makes a claim in equity must be free from any taint of fraud with respect to that claim. For example, a person seeking to enforce an agreement must not himself be in breach of it.”).

invention he assigned was no good, but rather that the claimed invention was not his.⁶² Unlike previous cases, the inventor here is not taking any contrary positions in relation to the patent conveyance. His stand remains consistent and firmly resolute.⁶³ His position is evidenced by the technical disclosure of the patent. His contribution to the useful arts as memorialized in that document makes clear the property conveyed. But if Hologic drafted claims unsupported by the inventor's assigned disclosure then there is no unfairness on the part of the inventor to challenge the claimed invention on the grounds of invalidity. Equity examines the conduct of all of the parties, not just some.⁶⁴ Moreover, equity focuses on actions performed, not merely roles played.⁶⁵ Our patent laws should encourage strong patents by permitting challenges to bad patents by anyone unless there are legal or equitable reasons not to do so.

In *Minerva*, Hologic drafted significantly broader claims in a continuation of a patent application to read on a competing product sold by Minerva.⁶⁶ This is a common practice among sophisticated patent filers to achieve more robust patent protection and to increase their competitive advantage.⁶⁷ There is no unfairness in filing such secondary applications if the claims are supported by the original patent disclosure.⁶⁸ Here, patent 9,095,348 ('348 patent) at issue in *Minerva* claims priority to U.S. Patent No. 6,813,520 ('520 patent).⁶⁹ The '520 patent includes over 40 claims and 24 of which

⁶² See, e.g., *Hologic, Inc.*, 325 F. Supp. 3d at 525 ("Minerva . . . argues instead that the doctrine is not applicable to bar a § 112 defense. It relies on a balance-of-equities argument, contending Hologic attempts to assert overly broad claims and therefore keep Minerva's competing product out of the market.").

⁶³ See *Diamond Scientific Co.*, 848 F.2d at 1224 ("Assignor estoppel is an equitable doctrine that prevents one who has assigned the rights to a patent (or patent application) from later contending that what was assigned is a nullity"); *Westinghouse Elec. & Mfg. Co.*, 266 U.S. at 349 (quoting *Noonan v. Chester Park Athletic Club Co.*, 99 F. 90, 91 (6th Cir. 1900)) ("It seems to be well settled that the assignor of a patent is estopped from saying his patent is void for want of novelty or utility, or because anticipated by prior inventions"); *Faulks*, 3 F. at 900-901 ("The defendants now deny the validity of the patent, because they say, that Brown was not the original and first inventor of the improvement described in it The defendants in possession and enjoyment of that exclusive right assumed to sell and transfer it. After that, in justice, they ought not to be heard to say that they had it not and did not sell it").

⁶⁴ See A DICTIONARY OF LAW, *supra* note 61 ("[H]e who comes to equity must come with clean hands.").

⁶⁵ See *id.*

⁶⁶ See *Minerva Surgical, Inc., v. Hologic, Inc.*, No. 141 S. Ct. at 2309-10 (2021) ("Aware of Truckai's activities, Hologic drafted one of those claims to encompass applicator heads generally, without regard whether they are moisture permeable.").

⁶⁷ See Reginald Ratliff, *Patent Procurement and Strategy for Business Success Part II: Claims – Targeting the Right Infringers*, IP WATCHDOG (June 17, 2021), <https://ipwatchdog.com/2021/06/17/patent-procurement-strategy-business-success-part-ii-claims-targeting-right-infringers/id=134626/#>.

⁶⁸ See *Kingsdown Medical Consultants, Ltd. v. Hollister, Inc.*, 863 F.2d 867, 874 (Fed. Cir. 1988) ("It should be made clear at the outset of the present discussion that there is nothing, improper, illegal or inequitable in filing a patent application for the purpose of obtaining a right to exclude a known competitor's product from the market; nor is it in any manner improper to amend or insert claims intended to cover a competitor's product the applicant's attorney has learned about during the prosecution of the application. Any such amendment or insertion must comply with all statutes and regulations, of course, but, if it does, its genesis in the marketplace is simply irrelevant and cannot of itself evidence deceitful intent.").

⁶⁹ U.S. Patent No. 9,095,348 (issued Aug. 8, 2013).

are independent claims.⁷⁰ Claim 1 (reproduced below) from the ‘520 patent is representative of the scope of these independent claims.

A method of ablating and/coagulating tissue, comprising the steps of:

- (a) providing an ablation device including an expandable electrode array carried by an elongate tubular member and a pair of elongate flexures wherein each flexure includes at least one opening, **the electrode array including a fluid permeable elastic member** having insulating regions and conductive regions thereon, wherein the fluid permeable elastic member includes metallized fabric;
- (b) positioning the electrode array in contact with tissue to be ablated and moving the array to an expanded condition by expanding the flexures;
- (c) delivering RF energy through the array to the tissue to cause the tissue to dehydrate; and
- (d) **permitting moisture** generated during the dehydration of step (c) **to pass into the permeable elastic member and away from the tissue** and allowing at least a portion of the moisture to pass through the openings in the flexures.⁷¹

From the prosecution history of the ‘520 patent, the novelty of the invention is the fluid permeable member to move moisture away from body tissue.⁷² Thus, the fluid permeable member gives the claims their inventive charm. No other conclusion can be drawn when you look at the ‘520 patent overall. First, the title of the patent is “Method for ablating and/or coagulating tissue using moisture transport.”⁷³ Second, the Abstract of the patent not only mentions a member being permeable to remove moisture from the treatment site, but also identifies the technical problem caused by the presence of moisture.⁷⁴ Finally, the description identifies specific problems with prior art devices related to the presence of moisture at the treatment site.⁷⁵

⁷⁰ U.S. Patent No. 6,813,520 claims 1-47 (issued June 23, 1998).

⁷¹ *Id.* at col. 19 1.49-67 and col. 20 1.1-3.

⁷² *See, e.g.*, Non-Final Office Action at 5 (issued June 18, 1999). The examiner indicates that claims 5-7, 15, 17, and 24 would be allowable if rewritten in independent form and stated that the prior art of record does not teach openings in members of the devices for actively withdrawing moisture from the treatment site.

⁷³ U.S. Patent No. 6,813,520 Title (issued June 23, 1998).

⁷⁴ *Id.* at *Abstract* (“An apparatus and method for use in performing ablation or coagulation of organs and other tissue includes a metallized fabric electrode array which is substantially absorbent and/or permeable to moisture and gases such as steam and conformable to the body cavity. The array includes conductive regions separated by insulated regions arranged to produce ablation to a predetermined depth. Following placement of the ablation device into contact with the tissue to be ablated, an RF generator is used to deliver RF energy to the conductive regions and to thereby induce current flow from the electrodes to tissue to be ablated. As the current heats the tissue, moisture (such as steam or liquid) leaves the tissue causing the tissue to dehydrate. Suction may be applied to facilitate moisture removal. The moisture permeability and/or absorbency of the electrode carrying member allows the moisture to leave the ablation site so as to prevent the moisture from providing a path of conductivity for the current.”).

⁷⁵ *Id.* at col. 1 1.64-67 and col. 2 1.1-31 (“Both the heated fluid techniques and the latest RF techniques must be performed using great care to prevent over ablation. Monitoring of tissue surface temperature is normally carried out during these ablation procedures to ensure the temperature does

A patentee is perfectly within their rights to draft claims having a broad scope of protection only if the claims are supported by disclosure in the application.⁷⁶ In other words, the written description must show that the inventor had possession of the claimed invention.⁷⁷ As will be discussed later, Hologic did not possess what they claimed to have invented. Now, Hologic requests a broad application of the doctrine of assignor estoppel to block a legitimate inquiry as to whether Hologic possessed what they claimed. The unfairness resides with Hologic, not the inventor. Application of assignor estoppel in this case would not cure unfairness, but rather inflict it.

V. UNPERSUASIVE PRECEDENT

The record of the Federal district court is clear. Minerva attempted to argue that the '348 patent was invalid because the claims were unsupported by the specification and thus failed to satisfy enablement and written description requirements.⁷⁸ The district court, however, stated that invalidity defenses were barred by assignor estoppel.⁷⁹ After admitting that assignor estoppel generally concerns anticipation or obviousness⁸⁰, the district court cites a lone district court opinion as precedent for application of assignor estoppel to bar defenses under 35 U.S.C. 112.⁸¹ However, the facts of that case are different from the facts here.

not exceed 100° C. If the temperature exceeds 100° C., the fluid within the tissue begins to boil and to thereby produce steam. Because ablation is carried out within a closed cavity within the body, the steam cannot escape and may instead force itself deeply into the tissue, or it may pass into areas adjacent to the area intended to be ablated, causing embolism or unintended burning. Moreover, in prior art RF devices the water drawn from the tissue creates a path of conductivity through which current traveling through the electrodes will flow. This can prevent the current from traveling into the tissue to be ablated. Moreover, the presence of this current path around the electrodes causes current to be continuously drawn from the electrodes. The current heats the liquid drawn from the tissue and thus turns the ablation process into a passive heating method in which the heated liquid around the electrodes causes thermal ablation to continue well beyond the desired ablation depths. Another problem with prior art ablation devices is that it is difficult for a physician to find out when ablation has been carried out to a desired depth within the tissue. Thus, it is often the case that too much or too little tissue may be ablated during an ablation procedure. It is therefore desirable to provide an ablation device which eliminates the above-described problem of steam and liquid buildup at the ablation site. It is further desirable to provide an ablation method and device which allows the depth of ablation to be controlled and which automatically discontinues ablation once the desired ablation depth has been reached.”)

⁷⁶ See *In re Rasmussen*, 650 F.2d at 1214 (“An applicant is entitled to claims as broad as the prior art and his disclosure allow.”).

⁷⁷ *In re Wright*, 866 F.2d 422, 424 (Fed. Cir. 1989) (“The specification as originally filed must convey clearly to those skilled in the art the information that the applicant has invented the specific subject matter later claimed. . . . When the original specification accomplishes that, regardless of how it accomplishes it, the essential goal of the description requirement is realized”) (citing *In re Smith*, 481 F.2d 910, 914 (C.C.P.A. 1973)).

⁷⁸ *Hologic, Inc.*, 325 F. Supp. 3d at 525.

⁷⁹ *Id.* at 526.

⁸⁰ *Id.* at 524 (“Assignor estoppel generally arises in the context of an anticipation or obviousness defense.”). See also *Westinghouse Elec. & Mfg. Co.*, 266 U.S. at 351 (citing *Noonan*, 99 F. at 91) (“It seems to be well settled that the assignor of a patent is estopped from saying his patent is void for want of novelty or utility, or because anticipated by prior inventions.”).

⁸¹ *Hologic, Inc.*, 325 F. Supp. 3d at 524.

First, the district court in *Pandrol USA, LP v. Airboss Ry. Products, Inc.*, ruled that there was no issue of material fact about whether the patent at issue satisfied the requirements of 35 U.S.C. § 112.⁸² The district court made a factual determination about the written description even though the argument was made by the inventor.⁸³ In contrast, the district court in *Minerva* applied claim construction findings to cut off any inquiry into whether the patent satisfies 112 requirements.⁸⁴ Next, the inventor in *Pandrol* sought to testify about his own declaration which set forth his interpretation of the patent specification.⁸⁵ In *Pandrol*, the concern was that inventor would attack the validity of his invention and thus diminish the patent's value.⁸⁶ The district court declined to give the inventor in *Pandrol* the opportunity to re-write the meaning and content of his patent because that would be contrary to the historical principle of fair dealing.⁸⁷ Thus, the *Pandrol* decision stands for a limited application of assignor estoppel regarding inventor testimony about his own invention. *Pandrol* does not stand for the broad legal proposition that assignor estoppel doctrine prevents all written description and enablement challenges raised by inventors. That is too sweeping and unreasonable a view of the facts and reading of *Pandrol*. The facts at issue in *Minerva* are quite different. For instance, in *Minerva*, the inventor sought to present arguments about whether the patent satisfied the statutory requirements of written description and enablement.⁸⁸ The inventor was not seeking to testify about his opinion of the invention.⁸⁹ An objective inquiry about whether the description within the four corners of the patent sufficiently discloses and teaches the claimed invention invokes no unfairness. This is especially true for secondary patent applications where the inventor had no active involvement in its preparation and prosecution, and strategically drafted to read another's products, as was the case in *Minerva*.⁹⁰

A more apt, yet still distinguishable, case precedent is *Diamond Scientific Co. v. AMBICO, Inc.* In *Diamond Scientific Co.*, multiple invalidity grounds were raised including those under 35 U.S.C. § 112.⁹¹ After reviewing the history of the doctrine, Judge Davis concluded that primary consideration of the doctrine is the unfairness suffered by the assignee if such invalidity defenses were raised.⁹² In this court's view,

⁸² *Pandrol USA, LP v. Airboss Ry. Products, Inc.*, No. 99-0182-CV-W-SOW, 2003, WL 24272366 at *4 (W.D. Mo. Oct. 15, 2003) (granting Plaintiff's motion for summary judgment on the issue of validity as to all claims of U.S. Patent No. 5,110,046).

⁸³ *Id.* ("The patent as originally filed does disclose the claimed invention . . .").

⁸⁴ *Hologic, Inc.*, 325 F. Supp. 3d at 527.

⁸⁵ *Pandrol USA, LP*, WL 24272366 at *4.

⁸⁶ *Id.*; see also *Pandrol USA, LP v. Airboss Ry. Products, Inc.*, 424 F.3d 1161, 1167 (Fed. Cir. 2005).

⁸⁷ *Pandrol USA, LP*, WL 24272366 at *4.

⁸⁸ *Hologic, Inc.*, 325 F. Supp. 3d at 525 ("Minerva contends that all the asserted claims are invalid for failure to meet the written description and enablement requirements of 35 U.S.C. § 112.").

⁸⁹ See *id.* at 526-27.

⁹⁰ *Minerva Surgical, Inc. v. Hologic, Inc.*, No. 20-440, 2021 WL 285659, slip op. at 3 (D. Delaware July 8, 2021) ("Not through with inventing, Truckai founded in 2008 petitioner Minerva Surgical, Inc. . . . Meanwhile, in 2013, Hologic filed a continuation application requesting to add claims to its patent for the NovaSure System. Aware of Truckai's activities, Hologic drafted one of those claims to encompass applicator heads generally, without regard to whether they are moisture permeable.").

⁹¹ *Diamond Scientific Co.*, 848 F.2d at 1220.

⁹² *Id.* at 1225 ("As noted above, we believe that the primary consideration in now applying the doctrine [of assignor estoppel] is the measure of unfairness and injustice

the test is a balance of equities.⁹³ First, the court looked at whether the inventor signed formal documents, such as a patent assignment and oath attesting to an inventor's belief about the validity of a patent application at the time of its filing.⁹⁴ Next, the court found the inventor's actions, such as drafting claims and consulting on their revision, to be active participation weighing in favor of application of the doctrine.⁹⁵ Thus, the court concluded that application of assignor estoppel was appropriate.⁹⁶

The facts in *Minerva* do not align with those of *Diamond Scientific Co.* First, Hologic drafted claims based on awareness of the inventor's activities.⁹⁷ Hologic was likely motivated to draft claims of different scope because they viewed Minerva as having a competitive advantage in the marketplace. Two common reasons to draft such strategic applications are to get a better seat at the bargaining table to negotiate a royalty or to stop the actions of another.⁹⁸ Thus, the equitable analysis should start with Hologic, and not jump right to Minerva. Second, there is no evidence that the inventor in *Minerva* assisted with drafting claims of the continuation application or provided any input about whether there was support for the newly drafted claims.⁹⁹ Next, the facts about executed assignments or oaths are less influential in *Minerva* because those documents were originally signed over a decade before filing of the '348 patent.¹⁰⁰ In short, Hologic was in complete control of the process to identify inventions disclosed by the specification and then decide which one to claim. Furthermore, Hologic made their decision to select and claim a particular invention individually and in plain view of all facts (i.e., in view of the specification). Hologic was not influenced by any duplicity or unfairness on the part of the inventor when filing the continuation patent application. Rather, the inventor had already spoken, and his inventive contributions were memorialized in the patent's description of the invention. Any of those inventions

that would be suffered by the assignee if the assignor were allowed to raise defenses of patent invalidity.”).

⁹³ *Id.*

⁹⁴ *Id.* (“We note first that Dr. Welter assigned the rights to his inventions to Diamond in exchange for valuable consideration (one dollar plus other unspecified compensation – presumably his salary over many years and other employment benefits). Dr. Welter also executed an inventor's oath, which stated his belief, *inter alia*, that he was the first and sole inventor, that the invention was never known or used before his invention and that it was not previously patented or described in any publication in any country. . . . When the inventor-assignor has signed the Oath, Power of Attorney and Petition, which attests to his belief in the validity of the patents, and has assigned the patent rights to another for valuable consideration, he should be estopped from defending patent infringement claims by proving that what he assigned was worthless. That is an implicit component of the assignment by Welter to Diamond which is immune from contradiction.”).

⁹⁵ *Id.* at 1225 (“Furthermore, Dr. Welter apparently participated actively in the patent application process, including drafting the initial version of the claims and consulting on their revision.”).

⁹⁶ *Diamond Scientific Co.*, 848 F.2d at 1227.

⁹⁷ *Minerva Surgical, Inc.*, No. 20-440, slip op. at 3.

⁹⁸ See, e.g., *Continuation Patent Applications: 10 Reasons You Should Consider Filing*, NUTTER (May 1, 2017), <https://www.nutter.com/ip-law-bulletin/continuation-patent-applications-10-reasons-you-should-file> (“3. Go On the Offensive. Continuation applications can also be used offensively. For example, one can file a continuation with claims covering a competitor's product as long as it is described in the original parent application.”).

⁹⁹ *Minerva Surgical, Inc.*, No. 20-440, slip op. at 3.

¹⁰⁰ U.S. Patent Application No. 13/962,178 (issued Aug. 5, 1998) (Csaba Truckai, Russel Mahlon Sampson, Stephanie Squarcia, Alfonso Lawrence Ramirez & Estela Hilario), Patent Assignment at ¶ 1.

described in that description would have been fair game for Hologic to select, but it appears they did not claim one of them. Hologic's receipt of more government rights than it was entitled was unfair. Thus, Hologic should bear the burden to establish that they come to court with clean hands before they seek equity.

VI. CLAIM CONSTRUCTION FORECLOSES WRITTEN DESCRIPTION ANALYSIS

In its opinion, the Federal district court of Delaware conflated the requirements of 35 U.S.C. § 112 and claim construction.¹⁰¹ The two concepts are separate and distinct, and combining them together in its legal analysis was plain error. The former concerns whether claims are properly supported by their accompanying disclosure to justify granting government rights for an invention.¹⁰² The latter, on the other hand, concerns interpretation of the claims in view of a patent's written description to determine their proper scope.¹⁰³ The district court's blunt assertion that Minerva's § 112 arguments were foreclosed by court's claim construction was incorrect. Section 112 stands on its own as a legal requirement that all patents must satisfy.¹⁰⁴ Claim construction has nothing to do with written description and enablement requirements.¹⁰⁵ The language of the statute is plain and unambiguous—claim construction is not mentioned or otherwise implied therein.

Furthermore, the district court's approach here appears opposite to that taken in *In re Wright*.¹⁰⁶ In that case the Federal Circuit began its analysis with the specification.¹⁰⁷ After first reiterating some fundamental principles of patent law, Judge Rich justified his decision that the claim amendments were adequately supported by the original disclosure based on a reading of the specification – not a particular construction of the claims.¹⁰⁸ In fact, the decision only includes one vague mention of claim construction.¹⁰⁹ Thus, the fundamental rationale in *Wright* was that the specification as a whole supports the claims appended thereto.¹¹⁰ Here in this case,

¹⁰¹ See *Hologic, Inc.*, 325 F. Supp. 3d at 527 (“Minerva’s other criticisms for the descriptions are also directed at exemplary embodiments and raise previously rejected arguments that would serve to improperly limit that [sic] claims. The court finds Minerva’s section 112 arguments rest on a flawed definition of the claims that ignores the court’s claim constructions.”).

¹⁰² 35 U.S.C. § 112 (2022) (“(a) In General.— The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.”)

¹⁰³ *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (“The claims must be read in view of the specification, of which they are a part.”).

¹⁰⁴ See 35 U.S.C. § 112 (2022) (codifying written description requirement).

¹⁰⁵ See *id.* The statutory language does not explicitly or implicitly invoke claim construction.

¹⁰⁶ See *In re Wright*, 866 F.2d at 424-25.

¹⁰⁷ *Id.* at 424 (stating that when the original specification conveys clearly to those skilled in the art the information that the applicant invents then the essential goal of the description requirement is met).

¹⁰⁸ *Id.* at 424-25.

¹⁰⁹ *Id.* at 425 (“We have read the specification, in the light of which all that the claims must be construed . . .”).

¹¹⁰ *Id.* (identifying particular portions of the specification (both text and drawings) that support the amended claim language of “not permanently fixed”).

the district court in *Minerva* failed to consider the specification as a whole.¹¹¹ Just like in *Wright*, the question to be answered in *Minerva* is whether the specification describes the invention in a way to justify the manner in which it is claimed.¹¹² As *Wright* clearly demonstrates, the answer to that question does not neatly rest or even slightly turn any notation of claim construction.

Now, the dispute in *Wright* arises in the context of the patent office.¹¹³ The issue in *Minerva*, on the other hand, occurs in district court.¹¹⁴ Such differences as to the venue of legal proceedings should not result in different applications of the same legal requirement.¹¹⁵ The application of the standard should be the same regardless of the proceeding – judicial, administrative, or otherwise. If not, then the written description requirement raises significant public policy concerns about the fairness and consistency of its application.

VII. A FAILURE TO SURVEY

Just as newcomers to a residential neighborhood might improperly locate and install new fencing due to their unfamiliarity with the neighborhood, new assignees might too mis-locate their patent fence to improperly claim more inventive real estate than that to which they are entitled. In land disputes, such issues are quickly resolved with a survey of the physical parcel. Patent disputes about the property conveyed should be no different. A patent’s specification provides the surveyable terrain to fully identify the intellectual property conveyed.¹¹⁶ Such inquiry is straightforward - review property as described in the patent’s specification. There is no need to look at and evaluate prior art or make any substantive legal leaps of interpretation. All the facts lie within the four corners of the patent document.¹¹⁷ The invention is either described therein, or it is not.

¹¹¹ *Hologic, Inc.*, 325 F. Supp. 3d at 524 (“The court finds *Minerva*’s overly broad claims argument is effectively foreclosed by the court’s adoption of *Hologic*’s claims construction. . . . The court 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.”).

¹¹² *In re Wright*, 866 F.2d at 424.

¹¹³ *Id.* at 422.

¹¹⁴ *Hologic, Inc.*, 325 F. Supp. 3d at 512.

¹¹⁵ See 35 U.S.C. § 112 (2022). 35 U.S.C. § 112 provides a single set of requirements, and those requirements do not include any allowances or variations in the requirements for different judicial or administrative proceedings).

¹¹⁶ See, e.g., *LizardTech, Inc. v. Earth Resource Mapping, Inc.*, 424 F.3d 1336, 1345 (Fed. Cir. 2005) (“After reading the patent, a person of skill in the art would not understand how to make a seamless DWT generically and would not understand *LizardTech* to have invented a method for making a seamless DWT . . .”).

¹¹⁷ *Ariad Pharm., Inc.*, 598 F.3d at 1351 (“The term ‘possession,’ however, has never been very enlightening. It implies that as long as one can produce records documenting a written description of a claimed invention, one can show possession. But the hallmark of written description is disclosure. Thus, ‘possession as shown in the disclosure’ is a more complete formulation. Yet whatever the specific articulation, the test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art. Based on that inquiry, the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed.”).

The district court in this case, however, failed to make such a survey of the Hologic’s inventive landscape (i.e., the patent’s disclosure) to find support for the claims. If a proper survey had been done by the district court, it would have shown the property conveyed was not the same as the property claimed. In other words, the patent would have failed to meet the statutory requirements of written description and enablement. A patent must satisfy both of these requirements to be valid.¹¹⁸ There is a presumption that a patent is valid, but that presumption is rebuttable.¹¹⁹ The district court improperly addressed the written description requirement by commingling its claim construction into the § 112 analysis as previously addressed above.¹²⁰ Based on such a flawed analysis, the court put down its surveying gear and instead quickly picked up its drafting pen to move onto to other legal concerns.¹²¹ The district court clearly erred in its decision not to complete a thorough examination of the patent property conveyed.

A proper patent survey is illustrated by the teachings of *Lizardtech Inc., v. Earth Resource Mapping, Inc.* The facts of that case are strikingly similar to *Minerva*, and the analysis from *Lizardtech* is instructive. In *Lizardtech*, the Federal Circuit noted that the problem was that the specification provided only one method for creating seamless discrete wavelet transform (“DWT”) based on maintained updated sums, but the claim was not limited to those sums.¹²² Rather, the claim referred to DWT generically.¹²³ Next, the court reiterated the long-settled standard set forth by 35 U.S.C. § 112¹²⁴. The standard, as reiterated by the court, is twofold: (1) the specification must describe the making and using of an invention to enable one of ordinary skill to practice the invention without undue experimentation and (2) the specification must sufficiently convey to a person of ordinary skill that the patentee had possession of the claimed invention.¹²⁵ The standard does not require the specification to describe every possible detail of the invention, but rather only enough information to convince a person of ordinary skill that the inventor possessed the invention and to enable others

¹¹⁸ 35 U.S.C. § 112 (2022).

¹¹⁹ *Id.* at § 282; *Lannom Mfg. Co., Inc. v. U.S. Int’l Trade Comm’n*, 799 F.2d 1572, 1578 (Fed. Cir. 1986) (“[T]he Commission consistently afforded the patent the presumption of validity, subject to rebuttal by clear and convincing evidence.”).

¹²⁰ *Hologic, Inc.*, 325 F. Supp. 3d at 527 (“The court finds *Minerva*’s Section 112 arguments rest on a flawed definition of the claims that ignores the court’s claim constructions.”).

¹²¹ *Id.* (“*Minerva* has not satisfied its burden of showing invalidity by clear and convincing evidence. No reasonable jury could find that *Minerva* has met its burden of proving by clear and convincing evidence that the claimed ‘applicator head,’ ‘indicator mechanism’ and ‘one or more electrodes’ are not properly described or enabled in the asserted claims.”).

¹²² *LizardTech, Inc.*, 424 F. 3d at 1344.

¹²³ *Id.* (“The trouble with allowing claim 21 to cover all ways of performing DWT-based compression processes that lead to a seamless DWT is that there is no support for such a broad claim in the specification. There is no evidence that the specification contemplates a more generic way of creating a seamless array of DWT coefficients.”).

¹²⁴ *Id.*

¹²⁵ *Id.* at 1344-45 (“The ‘written description’ clause of section 112 has been construed to mandate that the specification satisfy two closely related requirements. First, it must describe the manner and process of making and using the invention so as to enable a person of skill in the art to make and use the full scope of the invention without undue experimentation. . . . Second, it must describe the invention sufficiently to convey to a person of skill in the art that the patentee has possession of the claimed invention at the time of the application, i.e., that the patentee invented what is claimed.”).

to make and use it.¹²⁶ Just like Minerva’s arguments concerning the breadth and scope of the claims, the court in *Lizardtech* was also worried about claims that covered all ways of performing DWT-based compression processes without broad written support.¹²⁷ After reading the specification, the Federal Circuit was not convinced of the patentee’s possession of the invention.¹²⁸ Therefore, the generic claim 21 was found invalid.¹²⁹ In support of its conclusion, the Federal Circuit relied on *Tronzo v. Biomet, Inc.* In *Tronzo*, the specification disclosed that prior art shapes were inferior and made mention of advantages of conical shapes, but claims recited the shape of the cups generically.¹³⁰ The *Tronzo* court concluded that no other shapes besides conical shapes were a part of the disclosure, and thus the patent failed to provide the necessary support of the claims.¹³¹ Referring back to *LizardTech*, the Federal Circuit further buttressed its conclusion with policy that undergirds the entire patent system that of the patent bargain between inventor and public.¹³² Specifically, the court referred to a Supreme Court directive, “[i]t seems to us that nothing can be more just and fair, both to the patentee and the public, than that the former should understand, and correctly describe, just what he has invented, and for what he claims a patent.”¹³³ Merely describing one embodiment of an invention may not be sufficient to support expansive claim language.¹³⁴

Just like the patents at issue in *LizardTech* and *Tronzo*, the specification of the ‘348 patent clearly does not support the expansive claims appended thereto. The facts are strikingly similar. First, the specification of ‘348 patent distinguishes the invention from the prior art and makes clear the inferiority of that art.¹³⁵ In particular, the specification discloses that prior art technologies give inaccurate impedance readings due to liquid buildup around electrodes of the device.¹³⁶ Next, the specification gives a clear and unmistakable warning about the deficiencies with present technology—excessive ablation depth due to thermal conduction caused by liquid buildup.¹³⁷

¹²⁶ *Id.* at 1345.

¹²⁷ *LizardTech, Inc.*, 424 F.3d at 1344.

¹²⁸ *Id.* (“After reading the patent, a person of skill in the art would not understand how to make a seamless DWT generically and would not understand LizardTech to have invented a method for making a seamless DWT, except by ‘maintaining updating sums of DWT coefficients.’”).

¹²⁹ *Id.* at 1346.

¹³⁰ *Id.* at 1344 (“In describing the shape of the cup implants, the specification distinguished prior art shapes as inferior and ‘tout[ed] the advantage of conical shape.’ . . . However, the claims spoke of the shape of the cups generically.”).

¹³¹ *Id.* at 1346 (“This court recognized that there was nothing in the patent’s specification ‘to suggest that shapes other than conical are necessarily a part of the disclosure.’ Therefore, the court held that the patent failed to provide the written description necessary to support the claims.”).

¹³² *LizardTech, Inc.*, 424 F.3d at 1346.

¹³³ *Id.*

¹³⁴ *Id.*

¹³⁵ See U.S. Patent No. 9,095,348 col. 2 l.1-30 (issued Aug. 8, 2013).

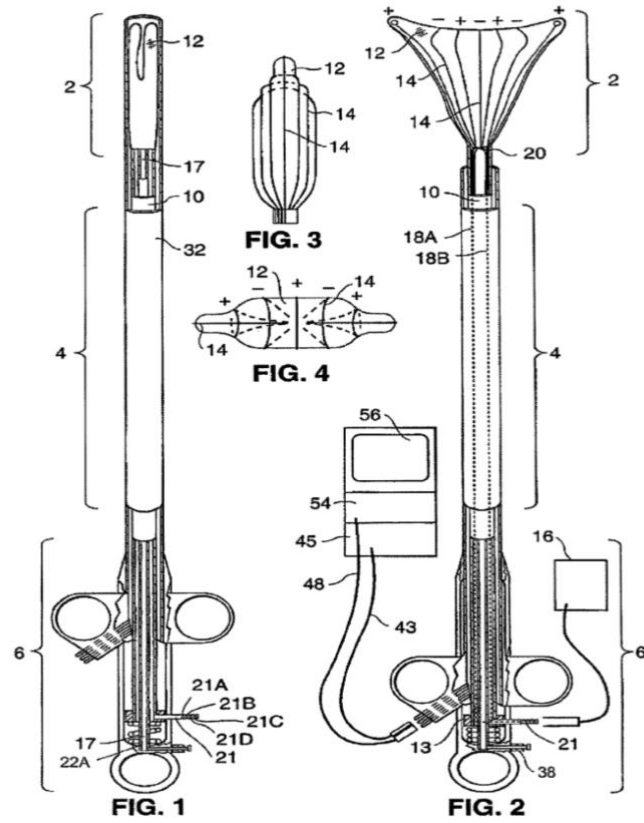
¹³⁶ *Id.* at col. 11 l.22-28 (“By contrast, if a prior art bipolar RF ablation device was used together with an impedance monitor, the presence of liquid around the electrodes would cause the impedance monitor to give a low impedance reading regardless of the depth of the ablation which had already been carried out, since current would continue to travel through the low-impedance liquid layer.”).

¹³⁷ *Id.* at col. 11 l.1-28 (“Removal of the moisture from the ablation site prevents formation of a liquid layer around the electrodes. As described above, liquid build-up at the ablation site is detrimental in that [sic] provides a conducive layer that carries current from the electrodes even when ablation has reached the desired depth. This continued current flow heats the liquid and surrounding tissue, and thus causes ablation to continue by unpredictable thermal conduction . . . By shunting

Further, like in *LizardTech*, the specification gives only a limited number of examples of the invention—in fact, just two. The first embodiment removes liquid from the ablation site by enabling moisture to permeate the electrode carrying member 12 and to move away from electrodes 14.¹³⁸ The placement and arrangement of the member 12 and electrodes 14 are readily apparent from Figs. 1-4 of the ‘348 patent (reproduced below).

moisture away from the ablation site and thus preventing liquid build-up, there is no liquid conductor at the ablation area during use of the ablation device of the present invention. Thus, when ablation has reached the desired depth, impedance at the tissue surface becomes sufficiently high to stop or nearly stop the flow of current into the tissue.”)

¹³⁸ *Id.* at col. 10 l.59-67.



Figures 1-4 from '348 Patent

The liquid then passes through holes 17a in the suction tube 17 and exits the device at port 38.¹³⁹ Holes 17a are clearly illustrated in Figs. 8-11 of the '348 patent.

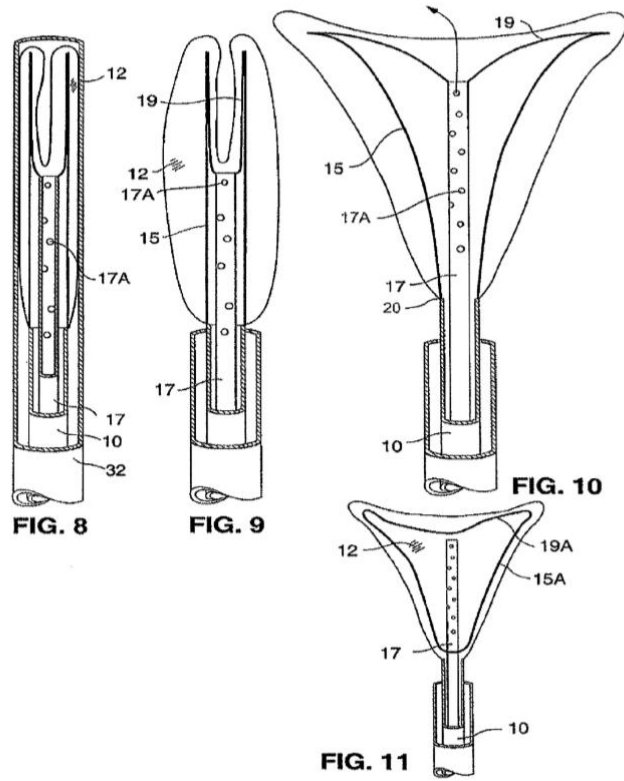
¹³⁹ *Id.*

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Figures 8-11 from '348 Patent

As shown in Figs. 6 and 7 of the '348 patent (reproduced below), a suction unit 40 can be attached to the device to facilitate removal of liquid from the ablation site.¹⁴⁰

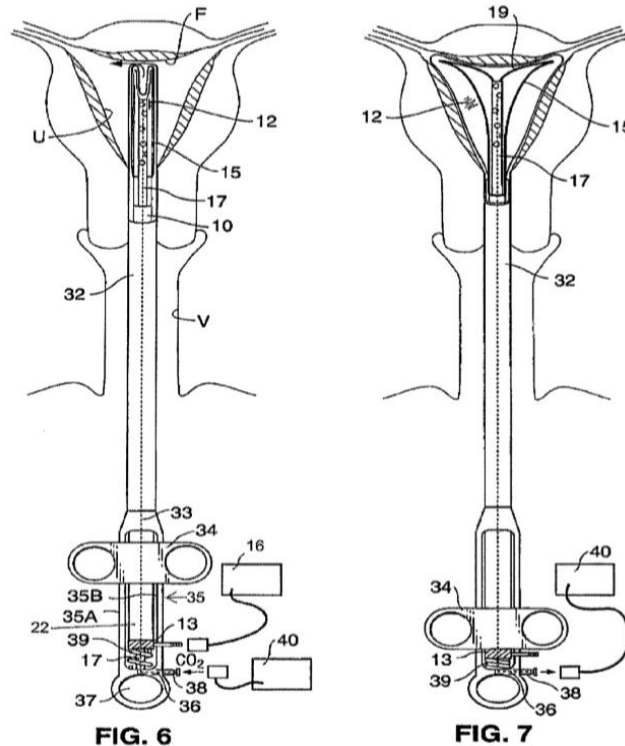
¹⁴⁰ U.S. Patent No. 9,095,348 col. 10 1.59-67 (issued Aug. 8, 2013).

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Figures 6-7 from '348 Patent

As will be discussed in further detail below, claim 1 does not recite an electrode carrying member 12 or an applicator that is permeable to moisture.

The second exemplary embodiment disclosed by '348 patent is also narrowly described. In the section of the Specification labeled, Second Exemplary Embodiment - Operation, it discloses that moisture is withdrawn from the uterine cavity via apertures 126 in flexures 124.¹⁴¹ The removal of moisture can clearly be seen in Fig. 28 of the '348 Patent (reproduced below).

¹⁴¹ U.S. Patent No. 9,095,348 col. 18 l.44-52 (issued Aug. 8, 2013) ("The tissue is heated as the RF energy passes from electrodes 118a-d to the tissue, causing moisture to be released from the tissue. The vacuum source 252 helps to draw moisture from the uterine cavity into the hypotube 122. Moisture withdrawal is facilitated by the apertures 126 formed in flexures 124 by preventing moisture from being trapped between the flexures 124 and the lateral walls of the uterus.").

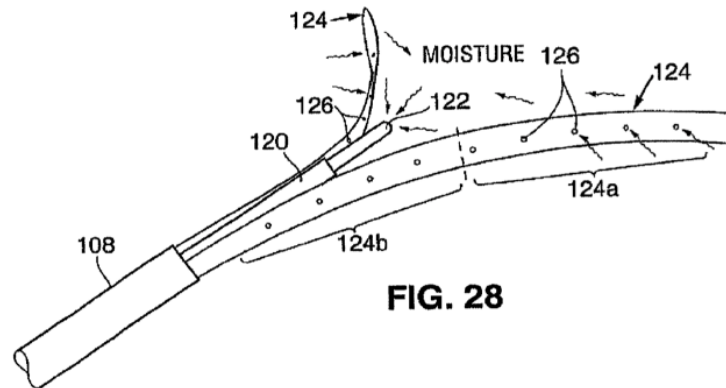


Figure 28 from '348 Patent

Finally, the claim language of the '348 Patent is expansive, just like the language in *LizardTech* and *Tronzo*, in which the Federal Circuit found the claims unsupported by the specification.¹⁴² Claim 1 from the '348 patent is provided below as a representative claim.

1. A device for treating uterus comprising:

an elongate member having a proximal portion and a distal portion, the elongate member comprising an outer sleeve and an inner sleeve slideably and coaxially disposed within the outer sleeve;

an applicator head coupled to the distal portion, the applicator head defining an interior volume and having a contracted state and an expanded state, the contracted state being configured for transcervical insertion and the expanded state being configured to conform to the shape of the uterus, the applicator head including one or more electrodes for ablating endometrial lining tissue of the uterus;

a handle coupled to the proximal portion of the elongate member, wherein the handle comprises a frame, a proximal grip and a distal grip pivotally attached to one another at a pivot point and operably coupled to the applicator head so that when the proximal grip and the

¹⁴² *LizardTech, Inc.*, 424 F.3d at 1346 (“Thus, a patentee cannot always satisfy the requirements of section 112, in supporting expansive claim language, merely by clearly describing one embodiment of the thing claimed. For that reason, we hold that the description of one method for creating seamless DWT does not entitle the inventor of the '835 patent to claim any and all means for achieving that objective.”). *See also* *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1159 (Fed. Cir. 1998) (“[T]he specification specifically distinguishes the prior art as inferior and touts the advantages of the conical shape of the '589 cup. *See, e.g., id.* at col. 3, ll. 63 (“Another extremely important aspect of the present device resides in the configuration of the acetabular cup as a trapezoid or a portion of a truncated cone.”). Such statements make clear that the '589 patent discloses only conical shaped cups and nothing broader. The disclosure in the '589 specification, therefore, does not support the later-claimed, generic subject matter in claims 1 and 9 of the '262 patent.”).

distal grip are moved closer together, the applicator head transitions from the contracted state to the expanded state;

a deflecting mechanism including flexures disposed within the applicator head, the flexures including first and second internal flexures and first and second external flexures, the first and second external flexures being coupled to the outer sleeve and the first and second internal flexures being coupled to the inner sleeve, wherein the deflecting mechanism is configured so that translating the inner sleeve relative to the frame causes the applicator head to transition from the contracted state to the expanded state; and

an indicator mechanism operably coupled to the inner sleeve, the indicator mechanism configured to indicate a dimension of the uterus.¹⁴³

As can be seen, claim 1 does not recite an electrode carrying member or an applicator that is permeable to moisture or flexures having apertures. Rather, claim 1 recites an ablation device in a generic fashion like the claimed devices of *LizardTech* and *Tronzo*¹⁴⁴. Such broad claim language covers both permeable and non-permeable applicators. The claim also recites flexures, but there is no mention of them being permeable or including holes. A fundamental rule of claim interpretation is that limitations disclosed in the specification cannot be read into the claims.¹⁴⁵ Therefore, the flexures should be understood as not being limited to permeable flexures. Yet the specification is silent about how non-permeable applicators or flexures would solve the known problems with the prior art described in the patent.¹⁴⁶ Thus, the claim lacks any inventive charm or soul. As such, a person of ordinary skill would have difficulty understanding and practicing the claimed invention as the key features of both embodiments disclosed by the specification are absent. Anyone who made and used a device as depicted would experience the same problem of moisture buildup around the electrodes as prior-art devices. Therefore, it is difficult to conclude that one of ordinary skill would be reasonably convinced that the Hologic possessed the invention as claimed.

VIII. EQUITY ANALYSIS DRIFTS AWAY FROM ITS MOORING OF THE PATENT CONVEYANCE

After declining to abandon the doctrine of assignor estoppel, the Federal Circuit in 2020 began their analysis with the statement that assignor estoppel is not a broad

¹⁴³ U.S. Patent No. 9,095,348 col. 19 l.9-42 (issued Aug. 8, 2013).

¹⁴⁴ *LizardTech, Inc.*, 424 F.3d at 1345; *Tronzo*, 156 F.3d at 1159.

¹⁴⁵ *Superguide Corp. v. DirectTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004) (“Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment.”). *See also* *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 906 (Fed. Cir. 2004) (discussing recent cases wherein the court expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment).

¹⁴⁶ *See, e.g.*, U.S. Patent No. 9,095,348 col. 2 l.1-30 (issued Aug. 8, 2013).

equitable device susceptible to automatic application.¹⁴⁷ However, the court's application of the doctrine appears to be just that. The facts identified by the court as being dispositive are one sided in favor of application of the doctrine.¹⁴⁸ The doctrine, however, involves a balancing of equities between the parties.¹⁴⁹ The court identifies no facts against application of the doctrine. No statements are provided to justify this absence of fact. Therefore, the opinion offers a one-sided analysis of the equities to invoke the doctrine of assignor¹⁵⁰. In fact, the court completes its analysis in just eight paragraphs of a sixteen-page opinion. Such a perfunctory analysis begs the question of whether the court is giving lip service to their statements about automatic application of the doctrine.

Moreover, the assignor estoppel analysis is no longer moored to the stable buoy of the patent conveyance. The origins of the doctrine were concerned with the assignors of a patent being estopped from saying their patent was void for want of novelty or utility.¹⁵¹ Such concerns strike at the heart of the exchange of property between assignor and assignee. But only one factor identified by the Federal Circuit goes to the patent conveyance: assignment of patent rights.¹⁵² The court opines that the assignment is a very broad one and analogizes this case with that of the court's decision in *Diamond Scientific*.¹⁵³ However, no one is disputing that the inventor executed a broad assignment of patent rights.¹⁵⁴ Rather, Minerva asserts that Hologic claimed more than they were entitled to under the law.¹⁵⁵ The Federal Circuit, however, follows its own precedent in *Diamond* without hesitation.¹⁵⁶ Yet, *Diamond* is silent about patentees claiming more legal rights than to which they are entitled.¹⁵⁷ The court looks

¹⁴⁷ *Hologic, Inc.*, 957 F.3d at 1268.

¹⁴⁸ *Id.* (“The facts here are analogous to those in *Diamond Scientific*, *Shamrock*, and other cases in which an inventor executes broad assignments to his employer, leaves his employer, founds or takes on a controlling role at a competing company, and is directly involved in the alleged infringement.”).

¹⁴⁹ *Shamrock Technologies, Inc. v. Medical Sterilization, Inc.*, 903 F.2d 789, 793 (Fed. Cir. 1990) (“Assignor estoppel is an equitable doctrine . . . ‘that is mainly concerned with the balance of the equities between the parties.’”).

¹⁵⁰ *Hologic, Inc.*, 957 F.3d at 1268.

¹⁵¹ *Westinghouse Elec. & Mfg. Co.*, 266 U.S. at 351; *see also Faulks*, 3 F. at 900-901 (“Whosoever assumes to sell a patent assumes to sell that property, and assumes that he had it to sell. . . . The defendants in possession and enjoyment of that exclusive right assumed to sell and transfer it. 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 grant by setting up that it did not pass.”).

¹⁵² *Hologic, Inc.*, 957 F.3d at 1268 (“Minerva disputed none of the pertinent facts below or on appeal. Mr. Truckai ‘executed a broad assignment of his patent rights to NovaCept and later sold NovaCept to Hologic’s predecessor for \$325 million.’ . . . Mr. Truckai then ‘founded Minerva’ and ‘used his expertise to research, develop, test, manufacture, and obtain regulatory approval for the Minerva EAS.’ . . . Mr. Truckai’s ‘job responsibilities as Minerva’s President and CEO included bringing the accused product to market to directly compete with Hologic.’”).

¹⁵³ *Id.*

¹⁵⁴ *Id.*

¹⁵⁵ *Id.* (“Instead, Minerva contends that ‘Hologic is deploying assignor estoppel to shield its unwarranted expansion of the patent’s scope from the invalidity arguments created by its own overreach.’”).

¹⁵⁶ *See id.* at 1268. The court begins its legal analysis of the issue with an explanation of its decision in *Diamond Scientific Co. v. Ambico, Inc.*, 848 F.2d 1220 (Fed. Cir. 1988).

¹⁵⁷ *See Diamond Scientific Co.*, 848 F.2d at 1225 (“Appellants would now defend against accusations of infringement by trying to show that the three patents in issue are invalid because the

beyond this glaring deficiency and cites the proposition that the timing of the assignments and amendments to the claims do not have to coincide within one another.¹⁵⁸ This is true, but common practice and timing are not the touchstone for written description and enablement. Rather the touchstone is disclosure.¹⁵⁹ Claim amendments must be firmly rooted in the content of the disclosure of the patent application.¹⁶⁰ No new matter outside the disclosure can be introduced into the claims.¹⁶¹ Minerva is not arguing that Hologic had no right to amend the claims after the inventor left or that such amendments are unfair because of lack of inventor participation. Instead, Minerva argues that the new claims are unsupported by the disclosure, and thus contrary to patent laws.¹⁶² In other words, the claimed invention is outside the patent conveyance between assignor and assignee.

The court also makes note that the inventor started another company that competed against his former employer.¹⁶³ Although this factual statement was not foundational to the court's decision to affirm the district court, it is a clue to the court's view of the underlying question of fairness and the balance of equities. Here, it appears that the court believes competition against a former employer necessarily involves some level of unfairness.¹⁶⁴ That view, however, is too simplistic and off the mark. Such a view is one of unfair competition, not patent law. The decision to apply the doctrine of assignor estoppel should focus on the unfairness of the patent conveyance, and nothing else. Again, there is no unfairness in questioning whether claims are supported by a patent specification unless the inventor contributed to the defects in that document. Both assignees (e.g., employers or third-party purchasers) and assignors (e.g., inventors or patent owners) alike are participants in that exchange of property.¹⁶⁵ The microscope of equity should not focus its high-powered lens solely on the actions of the assignee to the exclusion of the assignor. Rather, both participants should face equitable scrutiny before application of an equitable doctrine. Although the

inventions either were inadequately disclosed by the specifications, lacked novelty, or would have been obvious to one of ordinary skill at the time the inventions were made.”).

¹⁵⁸ *Hologic, Inc.*, 957 F.3d at 1268.

¹⁵⁹ *In re Wright*, 866 F.2d at 424 (citing to *In re Smith*, 481 F.2d 910, 914 (C.C.P.A. 1973)) (“The specification as originally filed must convey clearly to those skilled in the art the information that the applicant has invented the specific subject matter later claimed. . . . When the original specification accomplishes that, regardless of how it accomplishes it, the essential goal of the description requirement is realized.”). See also *Ariad Pharm. Inc.*, 598 F.3d at 1351 (“The term ‘possession,’ however, has never been very enlightening. It implies that as long as one can produce records documenting a written description of a claimed invention, one can show possession. But the hallmark of written description is disclosure.”).

¹⁶⁰ See *In re Rasmussen*, 650 F.2d at 1214 (“Broadening a claim does not add new matter to the disclosure. Disclosure is that which is taught, not that which is claimed. An applicant is entitled to claims as broad as the prior art and his disclosure allow.”).

¹⁶¹ 35 U.S.C. § 132(a) (2022) (“No amendment shall introduce new matter into the disclosure of the invention.”).

¹⁶² *Hologic, Inc.*, 325 F. Supp. 3d at 525 (“[Minerva] argues instead that the doctrine is not applicable to bar a § 112 defense. It relies on a balance-of-equities argument, contending Hologic attempts to assert overly broad claims and therefore keep Minerva’s competing product out of the market.”).

¹⁶³ *Hologic, Inc.*, 957 F.3d at 1268.

¹⁶⁴ *Id.*

¹⁶⁵ See, e.g., *Hologic Inc.*, 325 F. Supp. 3d at 516 (“In August 1998, Csaba Truckai assigned his interest in U.S. Application No. 09/103,072, an application to which the '348 Patent claims priority, to NovaCept. Hologic acquired the '348 Patent from Cytc on January 15, 2016.”).

inventor in *Minerva* might have some mud on his hands, the cleanliness of the assignee's hands should be checked too before invocation of the doctrine.¹⁶⁶ The Federal Circuit continues to cast off the rope of legal equity from the secure buoy of the patent conveyance to set the doctrine of assignor estoppel adrift along the currents of unfair competition.

IX. ANALYSIS OF THE MAJORITY'S DECISION

Of the two paths offered by the Court, neither approach is sound. The majority's decision to reaffirm assignor estoppel is the right one. Such an approach further strengthens patent rights in the U.S. that have been in decline for nearly a decade now.¹⁶⁷ However, the majority completely missed the mark with its new "materially broader" standard. The Court's view that assignor estoppel should be applied only when its underlying principle of fair dealing comes into play is the correct one.¹⁶⁸ The Court goes on to say that the doctrine is not applicable when there are no explicit or implicit representations that conflict with an invalidity defense.¹⁶⁹ Again, this makes logical sense. An equitable doctrine should not be applied unless there is an equitable reason to do so. The majority loses its balance and falls off the legal tightrope with its reliance on contract law and *Westinghouse*, rather than the equitable principles.¹⁷⁰ Here, the majority goes back to the contract (i.e., the assignment) and applies guidance from *Westinghouse* to solve a question of equity.¹⁷¹ The Court follows the breadcrumbs left behind in *Westinghouse* and looks to changes in the claims that occur after execution of a patent assignment to solve this equitable question.¹⁷² Thus, the solution is a contractual one to an equitable problem.

The issue, however, is not the contract (i.e., the assignment), but rather the behavior of the parties after contract. The Court's approach is simply misguided and wrong. The justification of the Court is that once an assignee owns a patent application, they can change the scope of the claims during prosecution of the application, which would be unfair to the assignor. In short, amendments to the claims change the terms of the contract.¹⁷³ Such amendments to the claims, the Court rationalizes, might go beyond what the assignor intended to claim as patentable.¹⁷⁴ That rationale, however, misses the mark established in both contract law and the patent statutes. Here, the language of the assignment is clear "all right, title, and interest in and to the said invention, said application for United States Letters Patent

¹⁶⁶ *Id.* at 533.

¹⁶⁷ Randall R. Rader, *A Patent Crisis—Supreme Court Can Help America Compete Again*, BLOOMBERG LAW (Sept. 25, 2020), <https://news.bloomberglaw.com/ip-law/a-patent-crisis-supreme-court-can-help-america-compete-again>.

¹⁶⁸ *See Minerva Surgical, Inc.*, No. 20-440, slip op. at 5 ("The doctrine [of assignor estoppel] applies only when an inventor says one thing (explicitly or implicitly) in assigning a patent and the opposite in litigation against the patent's owner.").

¹⁶⁹ *Id.* at 15.

¹⁷⁰ *See id.* at 14-15 (discussing warranties of patent rights and concerns raised in *Westinghouse* about post-assignment claim amendments).

¹⁷¹ *See id.* at 15-16.

¹⁷² *Id.* at 16.

¹⁷³ *Minerva Surgical, Inc.*, No. 20-440, slip op. at 15-16.

¹⁷⁴ *Id.* at 16.

... including any divisionals, renewals, continuations...”.¹⁷⁵ The inventor assigned his rights to everything described in the patent application. In *Minerva*, the assignment language is clear and unambiguous. There is no contractual issue but rather only an equitable one.

The materially broader standard is simply another unworkable test that takes away certainty in the law rather than imparting it. The standard is yet another classic example of legal line drawing with no guidance or detailed explanation about how to draw such lines. There is no mention, comment, or even dicta about how to determine whether one claim is materially broader than another. Is the difference a single element of a claim? Or, is it a single word or select grouping of words? No one knows. Could simply amending the preamble of a claim invoke a material change? Again, we do not know. Certainty is a foundational principle of any legal system. The *Minerva* opinion provides none. Furthermore, the approach is an odd one to take. As the majority notes in footnote 2 of its decision, “[t]he limit set out in *Westinghouse* is not often invoked today, because modern courts construe patent claims . . . mainly by reference to their text.”¹⁷⁶ So why expound on a limit no longer used?

In summary, the majority’s opinion is a misapplication of contract law in lieu of equitable principles. The Court states that, “[t]he doctrine [of assignor estoppel] applies only when an inventor says one thing (explicitly or implicitly) in assigning a patent and the opposite in litigating against the patent’s owner.”¹⁷⁷ That should have been the end of the matter because here, the inventor is not taking conflicting positions.¹⁷⁸ The inventor was not saying what he assigned to the patentee was worthless. Rather, the inventor believes he never assigned that invention in the first place.

X. ANALYSIS OF THE DISSENT WRITTEN BY J. BARRETT

A well-known legal maxim is that Congress is presumed to legislate with knowledge of existing common law.¹⁷⁹ As such, common law must give way to statutory law authorized by Congress.¹⁸⁰ Further, when possible, any continued application of common law must be done in harmony, rather than in conflict, with Congress’s stated prerogative. If not, the language of the statute controls, and common law becomes a relic of legal history.¹⁸¹ Here, Congress has plainly spoken. 35 U.S.C. § 282 allows a

¹⁷⁵ Casba Truckai et al., Patent Assignment for U.S. Patent Application No. 13/962,178 ¶ 6 (Aug. 5, 1998).

¹⁷⁶ *Minerva Surgical, Inc.*, No. 20-440, slip op. at 8, fn 2.

¹⁷⁷ *Id.* at 5.

¹⁷⁸ See *Hologic Inc.*, 325 F. Supp. 3d at 524 (“[Minerva] argues instead that the [assignor estoppel] doctrine is not applicable to bar a §112 defense. It relies on a balance-of-equities argument, contending Hologic attempts to assert overly broad claims . . .”).

¹⁷⁹ *Miles v. Apex Marine Corp.*, 498 U.S. 19, 32 (1990) (“We assume that Congress is aware of existing law when it passes legislation.”).

¹⁸⁰ *Statutory Construction*, CORNELL L. LEGAL INFO. INST. (Aug. 2022), https://www.law.cornell.edu/wex/statutory_construction (“Where legislation and case law conflict, courts generally presume that legislation takes precedence over case law.”).

¹⁸¹ See *Isbrandtsen Co. v. Johnson*, 343 U.S. 779, 783 (1952) (“Statutes which invade the common law or the general maritime law are to be read with a presumption favoring the retention of long-established and familiar principles, except when a statutory purpose to the contrary is evident.”).

defense of patent infringement based on invalidity of the patent or any claim in suit grounded in any of the conditions for patentability laid out in part II of the Code.¹⁸² Those defenses are available to everyone, inventors included, as per the plain and unambiguous language of the Code.¹⁸³ But the common law doctrine of assignor estoppel was generally known to Congress at the time of 1952 Patent Act. For instance, the Supreme Court made rulings about the application of that doctrine in both *Westinghouse* and *Scott Paper* before 1952.¹⁸⁴ Notably, *Scott Paper* was decided in 1945, a mere seven years before the enactment of the Patent Act.¹⁸⁵

The dissent in *Minerva* selected which facts to emphasize and which to ignore in its argument that the 1952 Patent Act eliminated the common law doctrine of assignor estoppel. For example, the dissent stated that common law must be well settled to presume endorsement by Congress, but never defined what it meant for common law to be well settled.¹⁸⁶ The doctrine was settled as the Supreme Court had at least two occasions to jettison the doctrine in *Westinghouse* and *Scott Paper* but chose not to do so. Instead, the Supreme Court chose to refine, and not discard, the doctrine.¹⁸⁷ The *Westinghouse* Court also acknowledged that the doctrine had been settled in the lower courts for 45 years.¹⁸⁸ Additionally, by 1929, the doctrine had made its way into well-known patent treatises.¹⁸⁹ Furthermore, the dissent does not point to any legislative history that indicates an intent of congress to abrogate that doctrine. This lack of legislative intent is a large hole in the dissent's argument. It is reasonable to expect that Congress would provide at least a hint of purpose to change existing judge-made law.¹⁹⁰ Without such evidence, the dissent is merely giving its interpretation of events long passed.

The problem with the dissent's rationale is that it does not solve the equity problem raised by unscrupulous inventors. Instead, the dissent would prefer litigants

¹⁸² 35 U.S.C. § 282 (2022).

¹⁸³ *Id.*

¹⁸⁴ See generally *Westinghouse Elec. & Mfg. Co.*, 266 U.S. 342 (1924); *Scott Paper Co.*, 326 U.S. at 249.

¹⁸⁵ *Westinghouse Elec. & Mfg. Co.*, 266 U.S. 342 (1924).

¹⁸⁶ See *Minerva Surgical, Inc.*, No. 20-440, slip op. at 1, 2.

¹⁸⁷ See, e.g., *Westinghouse Elec. & Mfg. Co.*, 266 U.S. at 350-51 (discussing the permissibility of allowing an assignor to show the state of the art to narrow or qualify the construction of claims to relieve the assignor from the charge of patent infringement); see also, *Scott Paper Co.*, 326 U.S. at 254 (“But in the circumstances of this case we find it unnecessary to pursue these logical refinements, or to determine whether, as respondent asks, the doctrine of estoppel by patent assignment as stated by the *Formica* case should be rejected.”).

¹⁸⁸ *Westinghouse Elec. & Mfg. Co.*, 266 U.S. at 349 (“As to the rest of the world, the patent may have no efficacy and create no right of monopoly; but the assignor cannot be heard to question the right of his assignee to exclude him from its use . . . this court will not now lightly disturb a rule well settled by 45 years of judicial consideration and conclusion . . .”).

¹⁸⁹ ALBERT H. WALKER, A TREATISE ON THE LAW OF PATENTS FOR INVENTIONS 604-05 (John L. Lotsch ed., Baker Voorhis & Co. 1929) (1883) (“§ 519 Estoppel by matter of deed may also arise in patent affairs . . . where an assignor or grantor of a patent right, afterward infringes the right which he conveyed, he is estopped by his conveyance from denying the plaintiff's title, or the validity of the patent, when sued for infringement . . .”).

¹⁹⁰ *Edmonds v. Compagnie Generale Transatlantique*, 443 U.S. 256, 266-67 (1979) (“The reports and debates leading up to the 1972 Amendments contain not a word of this concept. This silence is most eloquent, for such reticence while contemplating an important and controversial change in existing law is unlikely. . . . At the very least, one would expect some hint of a purpose to work such a change, but there was none.”).

fight it out in court and if the dishonest party wins, so be it.¹⁹¹ Getting rid of the doctrine also does not promote judicial efficiency. The doctrine is a warning to the unscrupulous that if you try to abuse the patent system there are legal consequences. If the bad actors persist and litigation ensues, then the doctrine limits available defenses to patent infringement which reduces a patentee's legal obstacles at trial.¹⁹² Furthermore, the dissent jettisons the entire doctrine based on a law enacted almost 70 years ago, which seems rather odd on its face.¹⁹³ In fact, the Federal Circuit has been actively making rulings regarding assignor estoppel for the last 30 years.¹⁹⁴ Over this time, the Court has stood quietly on the sidelines giving what many thought was its tacit approval to a lower court's decisions.¹⁹⁵ The dissent's wholesale change appears to cut down the entire tree of assignor estoppel, rather than merely pruning branches of the doctrine to improve its structure and promote new, healthy growth.

XI. RECENT DEVELOPMENTS

On remand from the Supreme Court, the Federal Circuit reconsidered whether to apply the doctrine of assignor estoppel using the Court's materially broader standard.¹⁹⁶ The Federal Circuit focused its analysis on the prosecution history of '520 Patent (i.e., the '072 application), which is the parent of '348 patent at issue in *Minerva*.¹⁹⁷ In particular, the Court paid special attention to claim 31 of the '072 application (reproduced below) which was canceled during prosecution.

31. An ablation and/or coagulation apparatus for use in delivering energy to tissue for ablation, the apparatus comprising:
 an elongated member;
 a deployment mechanism carried by the elongated member, the deployment mechanism moveable between a retracted position and a plurality of laterally expanded positions;
 an electrode array carried by the deployment mechanism;
 a sheath slideably disposed over the electrode array;
 a handle coupled to the sheath and deployment mechanism, the handle moveable between an insertion position in which the sheath is

¹⁹¹ See *Minerva Surgical, Inc.*, No. 20-440, slip op. at 13-14 (discussing the continued justification assignor estoppel of fair dealing remains, especially in cases when an assignor disavows a patent's validity in an attempt to regain access to the invention he has just sold).

¹⁹² See *id.* at 14 ("That course of conduct by the assignor strikes us, as it has struck courts for many a year, as unfair dealing – enough to outweigh any loss to the public from leaving an invalidity defense to someone other than the assignor.").

¹⁹³ See generally 35 U.S.C. § 101 *et seq.* (2022).

¹⁹⁴ *Hologic, Inc.*, 957 F.3d at 1265 ("In *Diamond Scientific*, we recognized that some courts questioned the vitality of the assignor estoppel doctrine following the Supreme Court's decision abolishing licensee estoppel in *Lear, Inc. v Adkins*, 395 U.S. 653, 666 (1969) We concluded, however, that nothing in *Lear* eliminated assignor estoppel Since *Diamond Scientific*, this court has continued to apply the doctrine in a variety of circumstances, often citing prevention of "unfairness and injustice" as the primary justification for its application.").

¹⁹⁵ See *id.* at 1265-66.

¹⁹⁶ *Hologic, Inc.*, 44 F.4th at 1360.

¹⁹⁷ *Id.* at 1363-64.

disposed over the electrode array and the array is in an unexpanded condition, and a deployment position in which the electrode array extends from the distal end of the sheath and is in one of its expanded positions;

a limiting means for selectively limiting lateral expansion of the deployment mechanism and for selectively limiting longitudinal extension of the array from the sheath; and

a source of radio frequency energy electronically coupled to the array.¹⁹⁸

As can be seen, claim 31 does not explicitly recite a moisture permeable limitation. So, the materially broader claim analysis depends on whether claim 31 is interpreted as reciting a moisture-permeable device or not.¹⁹⁹ Instead of following the guidance of *LizardTech* and *Tronzo*, the Federal Circuit applies the canons of claim construction, such as open-ended claim terminology and claim differentiation, to establish that the inventor intended to assign away a broader invention.²⁰⁰ The court even dismisses out of hand specific citations to portions of the application that teach the permeability of the carrying means.²⁰¹ In support of this view, the court stated that restricting claim 31 to a preferable characteristic is improper.²⁰² As basis for this assertion, the court cites to *Comaper Corp. v. Antec, Inc.* and *InterDigital Communc'ns, LLC v. Int'l Trade Comm'n.*²⁰³ But, these citations are off the mark. First, in *Comaper Corp.*, the court determined the meaning of the term “enclosure.”²⁰⁴ There, the court looked to the embodiments disclosed in the patent and found only one – a six-sided enclosure.²⁰⁵ In deciding not to limit the claims to a six-sided enclosure, the court concluded that the patent specification does not assign or suggest a particular definition of the term.²⁰⁶ Here, however, the patent specification does suggest a particular meaning by virtue of the stated problems with the prior art identified in the patent specification and the configuration of other device componentry. First, the patent specification in '520 identifies multiple problems that are caused by excessive water buildup at the ablation site.²⁰⁷ Second, although the patent specification may mention a preferred embodiment of the array, other aspects of the described embodiments support the conclusion that the device is moisture permeable. Components, such as the suction tube 17 and flexures 124, are clearly described (and in some cases depicted) as being capable of receiving moisture without any preferential qualifiers.²⁰⁸ Minerva is not asking the

¹⁹⁸ U.S. Patent Application Serial No. 09/103,072 48 1.7-25 (issued June 23, 1998).

¹⁹⁹ *Hologic, Inc.*, 44 F.4th at 1366.

²⁰⁰ *Id.* at 1368.

²⁰¹ *Id.* (“To be sure, the cited portion of the written description does reference a moisture-permeable electrode array. But this description of the ‘electrode carrying means’ refers merely to ‘preferabl[e]’ characteristics, including permeability ‘and/or a tendency to absorb moisture.’ ‘348 patent col. 5 ll. 52–61. It is not described as a required or mandatory characteristic.”).

²⁰² *Id.*

²⁰³ *Id.*

²⁰⁴ *Comaper Corp. v. Antec, Inc.*, 596 F.3d 1343, 1348 (Fed. Cir. 2010).

²⁰⁵ *Id.*

²⁰⁶ *Id.*

²⁰⁷ U.S. Patent No. 6,813,520 col. 1 1.65-67; col. 2 1.1-30 (issued June 23, 1998).

²⁰⁸ *See* U.S. Patent No. 6,813,520 col. 8 1.51-54 (issued June 23, 1998) (“The insufflation gas travels through the tube 17, through the holes 17 *a*, and into the uterine cavity through the permeable

court to limit the claims to a preferred embodiment but rather to one that is merely disclosed. Otherwise, the patent bargain negatively impacts society by giving the American public less technical disclosure than they are entitled to under law.

Similarly, the court's reliance on *InterDigital* is unpersuasive. There, the court was concerned with claim breadth regarding two disclosed embodiments.²⁰⁹ The administrative law judge in *InterDigital* construed the claims to exclude one of the described embodiments from the scope of the claims.²¹⁰ The Federal Circuit disagreed with the administrative law judge's interpretation of the claims, finding that the specification did not clearly restrict the scope of the claimed invention.²¹¹ In particular, the court found that the invention achieves that principal objective (i.e., to reduce power overshoot) through the use of short codes.²¹² Thus, the court held that an inventor's failure to include a reference to an alternative embodiment in the specification did not justify excluding the embodiment from the coverage of the claims.²¹³ Here, *Minerva* is not asking to exclude one embodiment in favor of another. Rather, the patent at issue only describes moisture permeable devices. How can embodiments be excluded that were never described in the first place? Also, just as the court found that the short codes achieved the principal objective in *InterDigital*, the moisture permeable features achieve the principal objectives of the invention (i.e., (1) eliminate steam and water buildup at the ablation site, (2) control of ablation depth, and (3) discontinuation of ablation once desired depth has been reached).²¹⁴ The court in *InterDigital* did not address the validity of claims that omit short codes, which would be analogous to the issue in *Minerva*. So, *InterDigital* is clearly distinguishable from the present case because that '348 patent only describes moisture permeable devices, and the claims omit the moisture permeable features of the invention required to achieve its principal objective of water removal from the ablation site.

In the end, the Federal Circuit's materially broader claim analysis rests on the principles of claim construction.²¹⁵ However, that cannot be what the Court intended when it announced the materially broader claim standard. Otherwise, the Court would have simply directed the lower courts to apply the well-known canons of claim construction. Therefore, the materially broader claim standard must be something

electrode carrying member 12"); *see also id.* at col. 13 l.43-48 ("A plurality of longitudinally spaced apertures 126 (FIG. 28) are formed in each flexure 124. During use, apertures 126 allow moisture to pass through the flexures and to be drawn into exposed distal end of hypotube 120 using a vacuum source fluidly coupled to hypotube 120.").

²⁰⁹ *InterDigital Commc'ns, LLC v. Int'l Trade Comm'n*, 690 F.3d 1318, 1328 (Fed. Cir. 2012).

²¹⁰ *Id.* at 1327.

²¹¹ *Id.* at 1328 ("[T]he specification did not clearly restrict the scope of the invention to a system in which the power increases continue in the course of each transmission.").

²¹² *Id.*

²¹³ *Id.*

²¹⁴ U.S. Patent No. 9,095,348 col. 2 l.25-30 (issued Aug. 8, 2013); *id.* at 1328 ("Second, while reducing power overshoot is an important objective of the patents in suit, the invention achieves that objective principally through the use of short codes, which decrease the amount of time required to transmit each signal, thus reducing potential for power overshoot.").

²¹⁵ *Hologic, Inc.*, 44 F.4th at 1365 ("Having determined that the 2004 assignment included a warranty as to claim 31's validity, we turn now to the question of whether claim 1 of the '348 patent is 'materially broader' than claim 31 of the '072 application. This requires us to construe the assigned and issued claims and compare the properly construed claims, focusing on the material aspects of those claims. Because this determination rests on principles of claim construction, it is ultimately a question of law we review de novo where, as here, it is decided only on the intrinsic evidence.").

more. That something more, however, remains unknown. For instance, a simple comparison of the plain text of the claims by the Federal Circuit was insufficient to identify a material change.²¹⁶ As previously mentioned, construing claims is not a new concept. Even the Federal Circuit's application of claim construction principles for claims of different applications offers nothing new to the typical claim construction analysis. Thus, creation of the materially broader claim standard appears unnecessary based on the Federal Circuit's application. This result highlights the key problem with the Court's decision.

XII. ACTS OF VIGILANCE RATHER THAN OF RECOVERY

Perhaps, the fix is one of practical nature rather than one of legal means. Minerva's new device seems quite different from Hologic's product and is therefore likely a new invention. The former ionizes a gas to create heat and does not require removal of liquid from the treatment area. The latter, on the other hand, uses conventional electrodes in combination with a moisture transport system to remove water from tissue to effectively transfer heat to the body. While the facts do not say, perhaps there was an opportunity to capture this new invention before the inventor left the company. The inclusion of claim 31 within the '072 application may hint at such an opportunity. Unfortunately, that opportunity was missed during the patent drafting process. Once missed, Hologic had to take the less attractive and more expensive option of asserting patent infringement to recover profits now lost.

As many practicing lawyers know, practical non-legal solutions are often the most effective solutions to legal problems. Here, if Hologic's predecessor had captured and filed for patent rights on the inventor's improved device perhaps no lawsuit would have occurred at all. Thus, the lesson from *Minerva* may be viewed as a cautionary tale for employers to be vigilant about inventions and departing employees to protect their own interests. For example, exit interviews are an important opportunity to capture intellectual property before it walks out the door. To achieve a successful interview, it should be conducted by someone with a technical background who understands the employee's role and responsibilities (e.g., the employee's supervisor or manager). The interview should focus on an employee's current work and any of his previous work at the company as well.

Another practical solution is the implementation of a robust invention harvesting plan. Proactively seeking out and acquiring patent rights in inventions shortly after conception reduces opportunities for intellectual property to later exit your business with a departing employee. A formal invention harvesting program that captures and reviews inventions on a periodic basis is an effective way to not only obtain property but can also instill a corporate culture that intellectual property is important to the business. This culture also makes the exit interview process easier as the employee will likely have an expectation that the employer is going to ask and request inventions not previously submitted.

²¹⁶ See *id.* at 1366-68 (construing the meaning of claim terms before determining whether the claims were materially different from one another).

Akin to the invention harvesting program, engaged technical management can be important to identify intellectual property before it departs with an employee. Managers who understand an employee's work and appreciate its inventiveness and creativity can more readily identify patenting opportunities. Complacent managers, on the other hand, can provide little to no help in capturing intellectual property before it is gone. They do not know what questions to ask or how to ask them.

Finally, do we need to start keeping laboratory notebooks again? If we are to put more rigor into the exit interview process, perhaps it makes sense to have a document to facilitate that conversation. A notebook would certainly aid the busy managers who are often overwhelmed with tasks and supervise a great many employees. Unfortunately, these books have long been forgotten. Many engineers today have never even seen one let alone know how to properly keep records in one. No matter the approach taken, there is much to be gained by proactively and vigilantly inquiring about inventive work of departing employees. The Court's decision today may not have been written if such vigilance had been prudently followed.

XIII. CONCLUSION

Minerva is an example of a case which appears to be about one thing (i.e., how to apply assignor estoppel), but is instead about something else (i.e., whether to apply the doctrine in the first place). Just as the Greeks used wooden boards to hide their presence within the Trojan horse to gain entry to the city of Troy, here Hologic fastened the equitable boards of assignor estoppel to hide deficiencies in their patent application. The legal boards of equity, although loosely nailed and arranged in a patchwork fashion, sufficiently obstructed the gaze of the courts to the extent that neither the district court nor the Federal Circuit peered around the boards of legal equity to see what was behind them. Rather, the gaze of the courts was averted to other legal trappings, such as claim construction or contract law, that did not go to the central issue at stake in this case.

The facts of this case are straightforward. Hologic, after seeing a successful competitor in the marketplace, sought to broaden its patent protection through a continuation patent application. In doing so, the scope of the claims omitted key features of the invention so that the claims would read on *Minerva*'s product. Those omitted key features, however, were the inventor's contribution to the useful arts. Broad patent protection requires broad disclosure of the invention. In other words, a generic monopoly must rest upon a generic discovery.²¹⁷ Unfortunately, Hologic's patent provides none. The disclosure includes all the hallmarks of a narrow rather than a broad disclosure. The description includes warnings about the prior art, statements about deficiencies of the prior art, and includes just two examples of the invention (both of which require removal of water from around the ablation device). When viewed as a whole, claims of '348 generically recite an ablation device while the specification describes devices of greater specificity.

Putting aside the invalidity of Hologic's patent, the next question is whether to invoke the doctrine? If all things are equal or otherwise favoring the assignee, then equity demands application of the doctrine. But when scales of equity favor the

²¹⁷ *Metals Recovery Co. v. Anaconda Copper Mining Co.*, 31 F.2d 206 (9th Cir. 1929).

assignor then the answer is a resounding no. To conclude otherwise would allow the doctrine of assignor estoppel to inflict unfairness rather than cure it. The application of the doctrine would become automatic in favor of assignees. Such a one-sided application would twist the doctrine by uprooting it from its equitable soil of fair play and dealing. Unlike the dissent, who would prefer to abandon the doctrine in its entirety and watch the fruits of the patent plant wither and die in some cases, the majority correctly concludes that the doctrine still offers value when an invasive species of unfair dealing invades the fields of patents. The doctrine still promotes the fruit of the patent plant and protects against those double-dealing pests that attack that fruit. But the approach taken by the majority, however, is not the right one. Instead of a light spray of repellent, the majority's materially broader claim standard is a heavy bucket full of toxic insecticide that is difficult to manage and unwieldy to apply. The lack of clear guidelines for implementation of the standard generates greater legal uncertainty and likely renders the doctrine to the compost heap of legal history.