SUPREME COURT
OF THE UNITED STATES

IN THE SUPREME COURT OF THE UNITED STATES

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MINERVA SURGICAL, INC.,)

Petitioner,)

v.) No. 20-440

HOLOGIC, INC., ET AL.,)

Respondents.)

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10 Washington, D.C.

11 Wednesday, April 21, 2021

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13 The above-entitled matter came on

14 for oral argument before the Supreme Court of the

15 United States at 11:14 a.m.

16

17 APPEARANCES:

18 ROBERT N. HOCHMAN, ESQUIRE, Chicago, Illinois; on

19 behalf of the Petitioner.

20 MORGAN L. RATNER, Assistant to the Solicitor General,

21 Department of Justice, Washington, D.C.; for the

22 United States, as amicus curiae, supporting

23 neither party.

24 MATTHEW M. WOLF, ESQUIRE, Washington, D.C.; on behalf

25 of the Respondents.

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1 P R O C E E D I N G S
2 (11:14 a.m.)
3 CHIEF JUSTICE ROBERTS: We will hear
4 argument next in Case 20-440, Minerva Surgical,
5 Incorporated versus Hologic, Incorporated.
6 Mr. Hochman.
7 ORAL ARGUMENT OF ROBERT N. HOCHMAN
8 ON BEHALF OF THE PETITIONER
9 MR. HOCHMAN: Mr. Chief Justice, and
10 may it please the Court:
11 The Patent Act doesn't provide for
12 assignor estoppel and never has. In fact, it
13 says invalidity shall be a defense in any
14 action. That's essential to the fundamental
15 patent market. The public grants exclusive
16 rights but only to the extent inventors publicly
17 share useful advances in knowledge. Accused
18 infringers who prove a patent is invalid
19 vindicate the right of all to make and use and
20 sell unpatented project -- products.
21 Hologic says Congress didn't have to
22 write assignor estoppel into the Patent Act. It
23 reads this Court's 1924 decision in Formica as
24 having settled assignor estoppel into patent
25 law. We don't think that's what Formica did,

1 but it doesn't matter because the world didn't
2 stop in 1924.
3 In 1945, this Court allowed an
4 assignor to invalidate a patent in Scott Paper.
5 That's squarely contrary to assignor estoppel.
6 In 1947, in Katzinger, this Court confirmed that
7 Scott Paper meant an assignor was free to
8 challenge the validity of a patent. And Lear,
9 looking back on the state of the law before
10 1952, said that this Court had by then
11 undermined the very basis of any general rule of
12 patent estoppel.
13 The logic of this Court's decisions
14 require abandoning assignor estoppel.
15 Exposing bad patents is vital patent
16 law policy, and allowing assignors to do so
17 carries no meaningful costs. No reliance
18 interests stand in the way of eliminating this
19 anomalous doctrine. And a patent-law-specific
20 limitation on the rights of assignors is nothing
21 like claim preclusion or issue preclusion or
22 even equitable estoppel, which are generally
23 applicable rules woven into our basic notions of
24 fair and efficient litigation.
25 At the very least, an inventor should

1 be allowed to show that the assignee is
2 asserting a claim broader than what the inventor
3 adequately described and enabled. Not even
4 estoppel by deed, assignor estoppel's supposed
5 model, supports preventing challenges that
6 appear on the face of the patent.
7 And when, as here, the assignee, not
8 the assignor, prosecuted the relevant claim nine
9 years after the patent rights were sold and did
10 so to prevent competition from the assignor's
11 new improved device, assignor estoppel is
12 particularly at odds with patent law policy.
13 This Court should order the Federal
14 Circuit to consider Minerva's Section 112
15 invalidity argument on the merits.
16 Be happy to take any questions.
17 CHIEF JUSTICE ROBERTS: Thank you,
18 Mr. Hochman.
19 I want to focus a little bit on your
20 -- your policy argument that getting rid of
21 assignor estoppel would help, you know, get rid
22 -- rid of bad patents in encouraging inventors
23 to -- to challenge particular claims.
24 But I thought strong patents was the
25 way we encourage invention and that assignor

1 estoppel helped ensure the strength and
2 stability of -- of those patents. How do you
3 sort out those competing policy arguments?
4 MR. HOCHMAN: Well, I think the main
5 policy point is that our -- our -- our patent
6 system absolutely believes in encouraging
7 innovation, but it's -- as I referred in my
8 opening to the patent bargain, it's for --
9 there's -- there's a -- there's a bargain on the
10 other side. The inventors have to provide,
11 among other things, a description and -- and
12 enablement of what they've done. They have to
13 give that to the public in order to get the
14 benefit.
15 And our patent system depends on
16 challenges to validity to make sure that we
17 don't over-protect, we don't provide the
18 benefits of patent exclusivity without the
19 parties doing all the things, without the
20 inventors doing all the things, necessary to
21 earn that substantial public benefit.
22 That includes the time-limited nature
23 of the -- of the exclusivity in Scott Paper, and
24 it includes, among other things, the written
25 description and enable -- enablement issues

1 involved here.
2 So it -- it's true that assignor
3 estoppel leads to challenging bad patents, but
4 that strengthens the overall policy of the
5 patent system and corrects -- and helps correct
6 for the over-patenting that is built into the
7 system and has been discussed by scholars for a
8 long time.
9 CHIEF JUSTICE ROBERTS: Counsel, if --
10 if we do not agree with you that we should get
11 rid of assignor estoppel altogether, do you have
12 any complaints about the position of the United
13 States on how to limit it?
14 MR. HOCHMAN: Yeah. I think -- I
15 think we would certainly prevail on the position
16 of the United States. I think the most
17 important thing to say about the position of the
18 United States is that we -- we do not agree that
19 this Court should simply send it back to the
20 Federal Circuit to figure out whether assignor
21 estoppel should apply in this case.
22 This Court should do that in this case
23 for a number of reasons. First, it's
24 exceedingly important that the assignor estoppel
25 issue, which is a threshold question -- it's

1 going to open up or close a -- a -- a -- a
2 complicated question about validity that
3 involves experts and litigation and all sorts of
4 other costly litigation processes. It's
5 important that that issue be decided clearly and
6 -- and decisively early on in the case. And it
7 --
8 CHIEF JUSTICE ROBERTS: Thank you,
9 counsel.
10 Justice Thomas.
11 JUSTICE THOMAS: Yes, thank you,
12 Mr. Chief Justice.
13 Counsel, you said that the -- you
14 could not compare assignor estoppel to issue --
15 concepts such as issue preclusion or claim
16 preclusion, et cetera. You -- you distinguished
17 them, but I don't think you demonstrated why
18 those principles, which do not appear in the
19 Patent Act, are applicable or acceptable, but
20 assignor estoppel is not.
21 MR. HOCHMAN: Yeah. So, Justice --
22 thank you, Justice Thomas. Our argument with
23 respect to that is there are -- we don't dispute
24 that there are times when common law principles
25 inform the background assumptions against which

1 Congress legislates. It's just not everything
2 in the common law, and it's not every -- and
3 it's not every common law principle.
4 And issue preclusion and claim
5 preclusion, I think, are maybe unique both in
6 the length of which -- that they've been part of
7 the common law and the uniformity with which
8 they have been adopted not just in patent cases,
9 and -- and not need to be adapted to patent
10 cases, but are applicable generally across the
11 board.
12 I would think issue preclusion and
13 claim preclusion is a background assumption of
14 every statute, every cause of action Congress
15 writes, unless it says otherwise.
16 This Court, you know, for -- for
17 hundreds -- for more than 150 years has said
18 those doctrines are implicit in the notion of a
19 fair and efficient judicial system.
20 Assignor estoppel is nothing like
21 that.
22 JUSTICE THOMAS: Well, let's --
23 Petitioner here -- I'm really interested in
24 clarification more than anything else on this
25 point. But Petitioner here assigned a certain

1 patent. There were changes to that, and I
2 didn't quite get how much the patent was changed
3 or continued. If you could help me on that, I'd
4 appreciate it.
5 MR. HOCHMAN: Yeah, and -- and for
6 this, it -- it -- it -- it would help if you
7 could turn to the Joint Appendix at page 833,
8 the supplemental appendix. That's the patent.
9 And then maybe put a finger in the same
10 supplemental appendix, 903, which is Claim 31.
11 I mean, here -- here's the difference.
12 Okay? Their -- their position is that their
13 patent, claim -- which is Claim 1, it's Column
14 19 at page 833, and I'm going to focus on the
15 second paragraph there, an applicator -- which
16 -- which has the term "applicator head."
17 The -- the dispute is whether an
18 applicator head, the -- the -- the part that
19 comes into contact with the endometrial lining,
20 can be moisture-permeable, has to be
21 moisture-permeable, or can be
22 moisture-impermeable. They are --- their --
23 their invention, their -- their patent says --
24 has been construed to allow a
25 moisture-impermeable applicator head.

1 Now they don't -- they -- they have
2 exactly one thing they point to that suggests --
3 that they say suggests that the -- the inventor,
4 Csaba Truckai, when he originally filed his
5 application, had the same thing, and they point
6 to this page, 903.
7 And you'll notice one -- one most --
8 the most conspicuous and obvious thing about
9 this is that the term "applicator head" isn't
10 even in that claim. It's not even there.
11 And I hasten to add that if you go
12 back to 833 and you go down about line 13, it
13 says that "when the applicator head is in its
14 expanded state, it's configured to form to the
15 shape of the uterus." So it's coming into
16 contact. It's -- it's -- it's -- that claim --
17 that claim limitation is also not in Claim 31.
18 So what they have is a claim where a
19 -- a moisture-impermeable device traps moisture
20 by conforming to the shape of the uterus and
21 traps moisture there. And they're saying that
22 Truckai did that as well. And there's simply
23 nothing -- nothing at all in Claim 31 that even
24 remotely suggests that moisture should be
25 trapped.

1 That, by the way --

2 CHIEF JUSTICE ROBERTS: Thank --

3 MR. HOCHMAN: -- is another --

4 CHIEF JUSTICE ROBERTS: -- thank you,

5 counsel.

6 Justice Breyer.

7 JUSTICE BREYER: Thank you.

8 Counsel, I've seen -- I assume that

9 there's -- assume with me that there's quite a

10 lot of precedent in favor of some form of the --

11 of the -- of the -- of the doctrine.

12 Now you want to abolish it entirely,

13 but we have many briefs that suggest not

14 entirely but limited.

15 Which set of limitations, in your

16 opinion, would be the best? And, in particular,

17 as the Chief asked, what's wrong with the

18 limitations set forth by the government?

19 MR. HOCHMAN: Well, I'll start with

20 the -- I'll start with the government's

21 position.

22 JUSTICE BREYER: I don't want you to

23 go back to do nothing. I -- I got that point.

24 MR. HOCHMAN: Let me --

25 JUSTICE BREYER: I want you to choose

1 among them.

2 MR. HOCHMAN: Understood. Understood,

3 Justice Breyer.

4 I'm going to -- I'm going to start

5 with the government's position. My -- my

6 fundamental quibble -- and it's really -- it's

7 really in this case a quibble with the

8 government's position -- really turns on how --

9 how to implement this materially identical. I

10 think that's a pernicious introduction of

11 ambiguity in the application of the doctrine.

12 But here's how I understand the

13 government's position, and this may help. The

14 government seems to be focused on ensuring that

15 if an inventor has made a genuine representation

16 that his invention encompasses, you know, as

17 much as the assignee ultimately obtains, that

18 the inventor should be held to that.

19 And my concern is that if -- if -- if

20 you -- if you go back to the estoppel-by-deed

21 roots of this, the kind of genuineness, the kind

22 of representation has to be rock solid. It has

23 to be truly firm.

24 A warranty deed accompanied by a seal

25 is a special kind of assertion about a true fact

1 in the state of the world in all of the law.
2 And to allow debates over the scope of
3 never-issued patent claims like claim -- like
4 Application Claim 31 at Joint Appendix 903 is to
5 -- is to introduce a completely different sort
6 of ambiguity into the process than -- than --
7 than has any kind of basis for an estoppel.
8 So I would say it should be, you know,
9 very, very close to text -- would require very,
10 very close to textual identity, and,
11 importantly, I would also add -- and the
12 government's a little ambiguous about this -- it
13 has to have been pending both at the time the
14 party against whom the estoppel is asserted
15 assigned away the rights and the party who is
16 asserting the estoppel obtained the rights.
17 In other words, it has to have been a
18 representation that was made and actually
19 somebody looking at the patent file at the time
20 thinks was still being made at the time of the
21 assignment.
22 I also --
23 JUSTICE THOMAS: Thank you.
24 CHIEF JUSTICE ROBERTS: Justice Alito.
25 JUSTICE ALITO: Well, my fundamental

1 question is, why is this a question for us and
2 not a question for Congress? It's a question of
3 statutory interpretation ultimately. There's
4 precedent supporting the doctrine in some form.
5 The Federal Circuit, which is the court that
6 Congress created to deal with these issues, has
7 worked out a body of precedent on it.
8 There are policy arguments in both
9 directions. There are potentially influential
10 supporters of both sides of this argument. Why
11 should we get into this? Would we not have to
12 overrule some of our precedents to do what you
13 ask?
14 MR. HOCHMAN: No, Justice Alito, I
15 don't think you would. The only precedent that
16 has been -- that is even purporting to require
17 being overruled is Formica. And, remember,
18 Formica allowed a party, an assignor, to use
19 prior art to narrow the scope of the claims.
20 The government agrees that today
21 that's an invalidity argument. This is exactly
22 the kind of doctrinal dinosaur, as -- as this
23 Court said in Kimble, that you -- you abandon,
24 that you give up on. Lear and Scott Paper have
25 already done all of the work. It's not --

1 JUSTICE ALITO: You think Kim -- you
2 think Kimble's approach to statute -- to stare
3 decisis supports you here?
4 MR. HOCHMAN: I actually think -- I
5 actually think it does, Your Honor, because I --
6 I don't think you have a square holding in
7 Formica in favor, as we've argued in our brief,
8 and -- and we can -- we can get into this if you
9 want. We read Formica exactly the way the
10 United States read Formica in the Katzinger
11 case, as providing only implied approval.
12 This isn't -- this isn't the kind of
13 precedent that you have to -- you know, you have
14 to treat as settled and -- because it doesn't
15 appear to have been settled. And I would
16 emphasize also Scott Paper, you know, as this
17 Court said in Katzinger, expressly allowed --
18 already did the work, expressly allowed an
19 assignor to challenge invalidity.
20 It is exceedingly difficult to come up
21 with a principle, Lear said it's impossible to
22 come up with a principle, that can constrain the
23 rationale for allowing an assignor in -- the
24 assignor in Scott Paper to challenge validity
25 for the reasons asserted there and any other

1 invalidity challenges.
2 JUSTICE ALITO: All right. One -- one
3 other -- one other question if I can get it in.
4 Can parties contract around this? Can an
5 assignment specify whether the assignor can
6 challenge the patent or not, or would that be
7 against public policy in some sense?
8 MR. HOCHMAN: Yeah, I think -- you
9 know, this Court hasn't squarely answered that
10 question. I think, in fairness, this Court --
11 most of what this Court has had to say on the
12 subject of that question points away from
13 allowing parties to do that for the same reason
14 that this Court has repeated -- has -- has so
15 deeply undermined assignor estoppel.
16 This Court has said over and over for
17 more than 150 years going back -- you know, for
18 -- for roughly 150 years going way, way back
19 saying that it is critical that everyone be
20 available to challenge the validity of patents.
21 Assignors in particular are super well
22 positioned to do that and do the public service
23 of invalidating bad patents and freeing up
24 competition.
25 JUSTICE ALITO: All right. Thank you.

1 CHIEF JUSTICE ROBERTS: Justice
2 Sotomayor.
3 JUSTICE SOTOMAYOR: Counsel, I will
4 ask the government about the limitations to its
5 theory -- to its proposal, but its proposal is
6 very close to Westinghouse, isn't it?
7 MR. HOCHMAN: I think that's a fair
8 characterization. I mean, I think, honestly --
9 JUSTICE SOTOMAYOR: In other words,
10 when -- when Westinghouse was decided, patent
11 overbroadness or patent narrowness was an issue
12 that came into claim construction, but now it
13 comes in under validity. Correct?
14 MR. HOCHMAN: Was allowed to come in
15 under -- there wasn't really as stark a
16 difference between infringe -- non-infringement
17 and validity as there is today so that the --
18 the arguments didn't quite --
19 JUSTICE SOTOMAYOR: Raise?
20 MR. HOCHMAN: -- way back when --
21 JUSTICE SOTOMAYOR: Yeah.
22 MR. HOCHMAN: -- hash out that way,
23 but now they do. So that --
24 JUSTICE SOTOMAYOR: Right.
25 MR. HOCHMAN: -- I believe that's --

1 JUSTICE SOTOMAYOR: That's part of the
2 problem, which is things have changed since
3 then.
4 MR. HOCHMAN: Yes, right.
5 JUSTICE SOTOMAYOR: So that the SG's
6 proposal is really to bring things back to where
7 Westinghouse left it, correct?
8 MR. HOCHMAN: Well, I don't think so,
9 because I think the SG's proposal, in fairness,
10 is very, very close to our view about exempting
11 1 -- Section 112 challenges like ours. And, you
12 know, obviously, the -- the -- the attorney for
13 the government will speak to that issue herself,
14 but, you know, they -- they say that the -- the
15 threshold question of whether estoppel can apply
16 in a case involving a 112 issue substantially
17 overlaps with the substance of the 112 issue
18 itself.
19 To be quite honest, I think it is
20 exactly the same, and I don't think there's any
21 space between --
22 JUSTICE SOTOMAYOR: I'll let them tell
23 us if there's a different space.
24 MR. HOCHMAN: Okay.
25 JUSTICE SOTOMAYOR: But my next

1 question for you is, going back to what Justice
2 Alito started with, there may have been a period
3 of -- of uncertainty between Lear and the Fed
4 Circuit ruling in 1988 that estoppel was --
5 assignor estoppel was still being used.
6 Given that Congress did a major
7 overhaul of the Patent Act -- was it 20 --
8 MR. HOCHMAN: 2011, Your Honor.
9 JUSTICE SOTOMAYOR: -- yeah, 2011 --
10 shouldn't -- why should we interfere when this
11 type of defense has been approved for such a
12 long period of time?
13 MR. HOCHMAN: Well, let's not
14 understate the gap. It's 30 years without
15 anybody thinking assignor estoppel was the law
16 between Lear and Diamond Scientific. And it
17 would be an astonishing inversion of the
18 judicial hierarchy for this Court to infer
19 congressional acquiescence to the Federal
20 Circuit's view on patent law even while this
21 Court's decisions in Scott Paper and Lear had,
22 for 30 years, left the doctrine dead.
23 I think that's -- I don't think
24 there's any basis for any kind of post-enactment
25 -- any kind of -- that would be a -- an uncommon

1 and never-before-seen standard of post-enactment
2 inference. And I also think, with respect, that
3 the Federal Circuit -- it -- it persisted for so
4 long only because the Federal Circuit has
5 exclusive jurisdiction over patent law.
6 CHIEF JUSTICE ROBERTS: Justice Kagan.
7 MR. HOCHMAN: And it would have been a
8 certain spin.
9 JUSTICE KAGAN: Mr. Hochman, I'd like
10 you to assume with me, as you did for Justice
11 Breyer, that there is a lot of precedent for
12 some form of this doctrine, that Westinghouse
13 called it a settled rule, that Scott Paper did
14 nothing more than create an exception to it, and
15 that Lear said that the equities were far more
16 compelling for assignor estoppel than for the
17 licensee estoppel that they eliminated.
18 So let's just say it's a settled rule,
19 and you need some special factor to justify
20 overturning the doctrine under our stare decisis
21 principles. What are your special factors?
22 MR. HOCHMAN: So I think the special
23 factors are that Scott Paper has already allowed
24 it to happen, as I mentioned at the argument as
25 to how --

1 JUSTICE KAGAN: Well, you're just
2 quibbling with my assumption, because my
3 assumption was that Scott Paper created an
4 exception to it, left the rule in place.
5 So what are your --
6 MR. HOCHMAN: Right.
7 JUSTICE KAGAN: -- what are your
8 special factors for overturning --
9 MR. HOCHMAN: Well --
10 JUSTICE KAGAN: -- the basic rule?
11 MR. HOCHMAN: Well, what makes it --
12 what makes it a doctrinal dinosaur is that what
13 Scott Paper and -- and Formica considered
14 non-infringement arguments are now, as we sit
15 here today, invalidity arguments. Practicing
16 the prior art defense is -- is actually an
17 invalidity argument.
18 Narrowing the claim in light of the
19 prior art is, you know, a kind of absolute
20 method of last resort and you -- in fact, is
21 preferred as an invalidity argument. So the law
22 has moved in -- in that respect in a significant
23 way.
24 Lear specifically said that looking --
25 that -- that it was not the general rule, so --

1 but, by the time, you know, that the -- the --
2 the case of -- you know, it's considering
3 licensee estoppel, the idea that patent estoppel
4 was a general rule had been -- has already been
5 declared by this Court no longer a general rule.
6 So I think, under these circumstances
7 -- oh, I would also add --
8 JUSTICE KAGAN: Okay. Let me -- let
9 me take you to a different place. Let's think
10 about the core application of assignor estoppel,
11 and I guess I want to know why it is that you
12 don't think that this core application makes a
13 lot of sense and accords with our basic
14 principles of fairness.
15 So let's say that an inventor invents
16 something. She obtains a patent. She later
17 sells the patent. And she then argues that the
18 invention was completely obvious all the time
19 and isn't patentable.
20 So the question is, why is it fair to
21 entertain that invalidity argument? It seems as
22 though it's a total bait-and-switch.
23 MR. HOCHMAN: Right. If it's a
24 bait-and-switch, then you have a very -- a
25 traditional equitable estoppel argument. But

1 assignor estoppel is different from equitable
2 estoppel, right? And the equitable -- you know,
3 equitable estoppel, which this Court recognized
4 in SCA Hygiene as available, you know, would --
5 would apply if, in that situation, the inventor
6 --
7 JUSTICE KAGAN: Well, I mean, that's
8 --
9 MR. HOCHMAN: -- knew all along --
10 JUSTICE KAGAN: -- semantics, Mr.
11 Hochman. That's semantics. Is -- is -- is that
12 estopped?
13 MR. HOCHMAN: No, I don't think that
14 is semantics, though.
15 JUSTICE KAGAN: Well, is that
16 estopped, Mr. Hochman?
17 MR. HOCHMAN: If -- if she knew at the
18 time of the assignment that it was invalid and
19 she had -- and -- and she -- and she said, I --
20 I'm going to sneak this away, then it's a --
21 then it's fraud, and there's state law --
22 there's state law remedies and -- and she can be
23 prosecuted and --
24 JUSTICE KAGAN: Mr. Hochman, I just
25 want to know if it's estopped or not.

1 MR. HOCHMAN: Sure, it can be
2 estopped, but --
3 JUSTICE KAGAN: Okay. Now let me --
4 MR. HOCHMAN: -- that's not what
5 assignor estoppel is.
6 JUSTICE KAGAN: -- ask you about
7 another question, Mr. Hochman. So is there a
8 meaningful difference between that case and a
9 case where the inventor invents something, she
10 swears an oath, she transfers the application
11 before she receives a patent, and the final
12 patent is exactly the same as the application?
13 MR. HOCHMAN: Yes, I think there is
14 because, I mean, in that situation, if -- again,
15 if she knew at the time she swore the oath that
16 she breached her duty of candor, then I think
17 you could have an estoppel. But there are all
18 sorts of --
19 JUSTICE KAGAN: Thank you, Mr.
20 Hochman.
21 MR. HOCHMAN: -- things that a
22 patentee can learn --
23 CHIEF JUSTICE ROBERTS: Justice --
24 MR. HOCHMAN: -- between then --
25 CHIEF JUSTICE ROBERTS: -- Justice

1 Gorsuch.
2 JUSTICE GORSUCH: Let me come at the
3 problem a different way. It -- it seems to me
4 that we all agree that the common law would have
5 had an equitable estoppel defense here
6 available. And you don't contest that.
7 The question is whether this Court
8 should create something more on the basis of
9 Formica and Scott Paper, which I understand the
10 criticisms of. And the -- but the SG says we --
11 we can -- we can save the day, we can fix it.
12 And it's going to be more than equitable
13 estoppel, but it isn't going to be that much
14 more. A arm's-length valuable consideration of
15 materially identical claims.
16 I want to know what I'm buying there.
17 What -- what -- I know how to apply equitable
18 estoppel. What kinds of questions do you think
19 will arise that this Court will have to address
20 if we bless this new -- new revised and improved
21 version of assignor estoppel?
22 MR. HOCHMAN: Thank you, Justice
23 Gorsuch. My view on this is that the most
24 troubling question that you'd be buying is what
25 to do about the disputed meanings of

1 never-issued or -- or -- or the disputed
2 understanding of pending applications for
3 patents, pending patent claim terms.
4 Materially identical, again, I mean,
5 if it's given a really robust application by
6 this Court and it's made clear that it is, you
7 know, something in the nature of approaching
8 textually identical, well, then you have, I
9 think, a fairly strong basis for being assured
10 of consistent application.
11 But the -- the risk of inconsistent
12 application, the risk that an inventor never
13 intended something but is later, with the
14 benefit of hindsight and -- and -- you know, and
15 able -- able lawyering, as -- as -- you know,
16 attorneys for Hologic are obviously able
17 lawyers, going back and -- and -- and -- and
18 filling in inferences and assertions about what
19 was written down in an application in 1998 means
20 -- should be understood to mean today in light
21 of everything we know today, I think, is
22 pernicious, and I don't think we should be
23 getting into that.
24 JUSTICE GORSUCH: Why would equitable
25 estoppel solve that problem?

1 MR. HOCHMAN: Because equitable
2 estoppel is -- is focused on actual
3 representations, you -- you need to have an
4 actual representation, what is it, and you also
5 need to have reliance. So, because you need
6 both an actual representation and reliance --
7 and, you know, we've obviously briefed that we
8 think assignor estoppel too requires
9 representation and reliance with the questions
10 you've asked me --
11 JUSTICE GORSUCH: So let -- let me
12 interrupt you there, I'm sorry, just to see if I
13 understand the -- the -- the -- the delta here.
14 Most of these cases involve small inventors
15 assigning patents to very large corporations and
16 who are fully capable of examining the patent
17 and may be in better position to identify its
18 validity and who undoubtedly very rarely rely on
19 these individuals.
20 And if we get rid of material identity
21 -- if we require material identically claims and
22 get rid of reliance, we're -- we're really just
23 advantaging the large inventors to the
24 disadvantage of the -- the -- the -- sorry, the
25 large purchasers to the disadvantage of the

1 individual inventors.
2 MR. HOCHMAN: That -- that's exactly
3 right. I think one of the things that makes
4 reliance so important is that it ensures that
5 there's a kind of -- of something -- something
6 akin to a meeting of the minds. Everybody knows
7 at the relevant time what they're talking about.
8 And having to figure that out with the
9 benefit of hindsight, you know, here we are
10 almost --
11 JUSTICE GORSUCH: Blowing away a
12 reliance requirement just gives a -- a -- a free
13 pass to the large purchasers?
14 MR. HOCHMAN: Exactly, exactly.
15 JUSTICE GORSUCH: All right. Thank
16 you.
17 CHIEF JUSTICE ROBERTS: Justice
18 Kavanaugh.
19 JUSTICE KAVANAUGH: Thank you, Chief
20 Justice.
21 And good morning, Mr. Hochman. Your
22 lead argument in the brief from pages 17 to 41
23 is to eliminate the doctrine of assignor
24 estoppel, and I guess I want to pick up on
25 Justice Kagan's questions on that.

1 You have Chief Justice Taft, of
2 course, in Westinghouse referring to the
3 doctrine at that point in 1924 as well-settled
4 since 1880, and it's continued without
5 elimination since then.
6 So what -- what is -- I'm not sure I
7 heard exactly what is the special justification
8 and particularly in a statutory case, where, as
9 Justice Alito said, our -- our doctrine of stare
10 decisis is especially strong. So why -- why get
11 involved in overturning something that was well
12 settled as of 1924?
13 MR. HOCHMAN: Because -- because it --
14 it didn't stay well settled because this Court
15 in Scott Paper very clearly allowed an
16 invalidity claim capping their -- agreed with
17 that characterization of it. The -- so the
18 result is you actually -- the -- the -- the rule
19 -- the rule of assignor estoppel is assignor
20 cannot challenge the validity of the patent.
21 Scott Paper says the assignor can
22 challenge the validity of the patent.
23 So now we have something that's no
24 longer actually a rule. And Lear already --
25 already recognized this. So, in other words,

1 this is a kind of, as -- as Kimble says,
2 doctrinal dinosaur. It has been whittled away.
3 It has been -- the arguments for it have not
4 only been undermined as a matter of policy,
5 assignors are -- are -- are available to do a
6 very -- a very important public service of
7 exposing bad patents.
8 The argument that it was just a --
9 that Formica sort of gave -- gave full
10 consideration, I think that doesn't hold up to
11 inspection. It didn't discuss the relevant
12 statutory language. It didn't cite Pope
13 Manufacturing, which was the principal case from
14 this Court 30 years earlier, that it said --
15 JUSTICE KAVANAUGH: Well, it went
16 through -- I mean, I'm looking right at it. It
17 went through a lot of the lower court cases and,
18 you know, starts with 1880, and -- I guess I'm
19 not sure about that, but let me ask you a
20 different question.
21 In the Respondents' brief, they say
22 that assignor estoppel has engendered serious
23 reliance interests, which is something we also
24 have to think about, and they say -- I just want
25 to get your reaction to -- for decades, millions

1 of patents and applications have been assigned
2 on the assumption that assignor estoppel bars
3 assignors from later challenging the validity of
4 the assigned patent rights.
5 Just want to get your reaction to
6 that.
7 MR. HOCHMAN: Yeah, I -- I think my
8 principal reaction to that is for nearly 30
9 years there was no case applying assignor
10 estoppel. Courts had said it was dead.
11 Commentators had said it was dead.
12 And for 30 years, between Lear and
13 Diamond Scientific, there was no issue about
14 patent assignments. There was nobody running
15 around claiming that their reliance interests
16 had been undermined.
17 And, true, you know, the Federal
18 Circuit's rule has been in place since Diamond
19 Scientific. But let's -- you know, there's been
20 no discussion of the magnitude. You know, the
21 -- the -- the notion that parties pay a premium
22 so that -- because assignors aren't going to be
23 able to challenge the validity of the patent is
24 pure speculation --
25 CHIEF JUSTICE ROBERTS: Justice

1 Barrett.

2 JUSTICE KAVANAUGH: Thank you.

3 MR. HOCHMAN: -- and they have no

4 remedy for that.

5 JUSTICE BARRETT: Mr. Hochman, I want

6 to ask you about equitable estoppel.

7 So how might equitable estoppel play

8 out in this particular case? Let's say there's

9 no assignor estoppel. You know, you have them

10 alleging that Mr. Truckai had lied in his

11 inventor's oath and then admitted that after the

12 fact. And then you have this dispute about

13 Claim 31 of his original application being

14 nearly identical to Claim 1 of the later patent.

15 So is there any way that's just about

16 a lack of reliance interest? Or, if you assume

17 that those allegations that your friends on the

18 other side make are true, would there be any

19 case for equitable estoppel here?

20 MR. HOCHMAN: Yeah, I think the case

21 for equitable estoppel would be dead. I mean,

22 there would be no -- there would be no equitable

23 estoppel argument here at all, respectfully.

24 So, first off, there's no reason to

25 believe at the time in two -- in 2004 that

1 anybody at Cytyc thought or believed they were
2 buying a patent that could cover a
3 moisture-impermeable device. The only thing
4 they've -- but they've never said Mr. Truckai
5 said anything to that effect to them, and the
6 only thing they pointed to, again, is this
7 Application Claim 31.
8 And, respectfully, it just doesn't do
9 that. It doesn't -- it not only doesn't have
10 the language in the -- in their claim. They
11 didn't pick up Application Claim 31 and
12 prosecute it. They wrote a different claim.
13 And they did it because it doesn't
14 have the claim term "applicator head." The
15 closest thing it has is the term "electrode
16 array." And the term "electrode array," their
17 view is, oh, because the term, it says
18 "electrode array," but it doesn't say
19 "moisture-impermeable" expressly, that means it
20 must be -- it must cover moisture-permeable.
21 But I don't even know what a
22 moisture-permeable electrode array would be.
23 That -- the electrode array is just the
24 positioning, how the electrodes are positioned
25 on some other part of the product, whether it's

1 the applicator -- called the applicator head or
2 sometimes called the electrode carrying means.
3 The electrode --
4 JUSTICE BARRETT: Can I ask you
5 something else about the estoppel?
6 MR. HOCHMAN: Yeah.
7 JUSTICE BARRETT: So, you know, I
8 think that the assignor estoppel doctrine, you
9 know, as estoppel doctrines often do when
10 they're thinking about fairness, you know,
11 punishes a turncoat assignor, right, and there's
12 something unseemly about representing to the
13 person to whom you're assigning a patent, it
14 doesn't cover this, you know, it's -- it's
15 valid, and then turning around and -- and we all
16 see the problem.
17 You suggest that there can really be
18 no reliance because people, especially
19 sophisticated parties, as Justice Gorsuch
20 suggests, are -- are doing their own
21 investigation of the patent's validity.
22 Is there any reason why the reliance
23 incurred or why there would be reliance by the
24 parties who are the assignees that could hurt
25 them? I mean, you suggest that they're

1 perfectly capable of analyzing the patents and
2 they're not going to be, you know, led down the
3 primrose path by the assignor.
4 MR. HOCHMAN: Yeah, I mean, I think --
5 well, with respect to this issue in particular,
6 Section 112, all you have to do is pick up the
7 -- the patent specification and look at it, and
8 you can find that there's just no explanation at
9 all that could support a moisture-impermeable
10 device. So I don't -- if they -- if -- if -- I
11 don't know what they could have relied on under
12 these circumstances.
13 But I -- I -- I -- I also think it's
14 important to note, and one of the things that
15 hasn't come out, is that when you have a patent
16 application, there's all this turncoat concern.
17 Before a claim issues, the patent
18 prosecution process -- and both parties agree
19 about this -- necessarily involves a lot of give
20 and take with the patent examiner. Sometimes
21 you go back and you do your own further research
22 or further work on the product, and you discover
23 new things about the product, and that requires
24 changing the claims. Sometimes it requires
25 removing claims. Sometimes it requires

1 expanding them. Sometimes it requires narrowing
2 them. And it's that --
3 CHIEF JUSTICE ROBERTS: A minute to
4 wrap up, Mr. Hochman.
5 MR. HOCHMAN: Thank you.
6 And -- and just to complete that
7 question, the fact that you -- you have a patent
8 claim that ends up looking different, that the
9 -- that the inventor thinks -- no longer thinks
10 that what they filed -- you know, Paramount
11 Publix and Hawhee and other cases make clear
12 that the inventor oath is not -- is not violated
13 by simply deciding that it -- it -- it's not a
14 viable patent.
15 Look, as this discussion makes clear,
16 assignor estoppel is a doctrinal dinosaur. We
17 should abandon it. But, at a minimum, no
18 plausible justification supports applying
19 assignor estoppel here.
20 Hologic chose to draft and prosecute
21 its own broad claim that finds no support in
22 Truckai's then 15-year-old specification, and it
23 did so precisely because it wanted to frustrate
24 competition from Truckai's latest innovation.
25 Having gone beyond the specification, it has

1 also gone beyond the range of any even arguable
2 estoppel. As a matter of equitable estoppel or
3 any other kind of estoppel, this Court should
4 not allow assignor estoppel to be wielded as a
5 sword to frustrate legitimate competition.
6 CHIEF JUSTICE ROBERTS: Thank you,
7 counsel.
8 Ms. Ratner.
9 ORAL ARGUMENT OF MORGAN L. RATNER
10 FOR THE UNITED STATES, AS AMICUS CURIAE
11 SUPPORTING NEITHER PARTY
12 MS. RATNER: Mr. Chief Justice, and
13 may it please the Court:
14 As Petitioner has explained, the
15 Federal Circuit's test for assignor estoppel is
16 too broad. That court prevents an assignor from
17 challenging any claim relating to an assigned
18 invention, even if that claim looks nothing like
19 the claims that existed at the time of the
20 assignment. That's not how estoppel ordinarily
21 works.
22 The foundational requirement for
23 estoppel is inconsistency, and an assignor acts
24 inconsistently only when the claims it
25 challenges at time two are the same as the

1 claims it sold at time one.
2 But, while we agree with Petitioner
3 that the Federal Circuit got it wrong, we don't
4 agree that this Court should get rid of assignor
5 estoppel altogether. Lower courts have applied
6 the doctrine for 140 years. This Court approved
7 it in 1924, and Congress hasn't seen fit to
8 eliminate it over all that time.
9 Assignor estoppel can still play an
10 important role but only if it's limited to a
11 true estoppel doctrine reflecting its origins in
12 estoppel by deed.
13 I welcome the Court's questions.
14 CHIEF JUSTICE ROBERTS: Ms. Ratner,
15 you say that the Court should only apply
16 assignor estoppel where the assignor sells
17 patent rights for valuable consideration.
18 How do you tell what valuable
19 consideration is?
20 MS. RATNER: Our basic point here, Mr.
21 Chief Justice, is that if there are
22 circumstances in which someone agrees to
23 transfer any rights to an invention before that
24 invention exists or before any bargaining over
25 the value of that invention, then you can't

1 really be said to implicitly represent that that
2 invention has value.
3 CHIEF JUSTICE ROBERTS: So the --
4 MS. RATNER: And it's that implicit --
5 CHIEF JUSTICE ROBERTS: I'm sorry, go
6 ahead.
7 MS. RATNER: I -- I -- it's that
8 implicit representation that there's value
9 that's really the key to assignor estoppel.
10 CHIEF JUSTICE ROBERTS: So the
11 familiar process where a company hires an
12 employee in a technical or whatever area and the
13 employee signs over inventions that they may
14 discover in the course of their employment to
15 the employer, that would be or wouldn't be
16 valuable consideration?
17 MS. RATNER: We think that that --
18 whether that would be valuable consideration in
19 terms of a -- the legal aspect of contract law,
20 we don't think that would be sufficient for
21 applying assignor estoppel because, if employees
22 have agreed up front to transfer any inventions
23 and leave it to their company to figure out
24 whether there's something patentable there and
25 pursue patent rights, then you wouldn't have any

1 sort of implicit warranty that what that
2 employee is transferring is patentable and
3 valuable.
4 CHIEF JUSTICE ROBERTS: Justice
5 Thomas.
6 JUSTICE THOMAS: Thank you, Mr. Chief
7 Justice.
8 Counsel, the -- could you give me your
9 best take on the difference between the original
10 -- what was originally assigned and what
11 Respondent has now?
12 MS. RATNER: Sure, Justice Thomas,
13 although I would emphasize this is exactly the
14 question that we think that the court of appeals
15 should address, because there are really three
16 questions here.
17 JUSTICE THOMAS: Hmm.
18 MS. RATNER: The first is, which is
19 the relevant assignment? There was an
20 assignment from Truckai in 1998 to NovaCept, and
21 we don't really know the circumstances of his
22 continued relationship with NovaCept to know
23 whether the next assignment from -- in 2004 is
24 also relevant.
25 So the court of appeals has to figure

1 out which of those two assignments and then what
2 claims were pending at the time. And at the
3 time of the '98 assignment but not the 2004
4 assignment, there was this Claim 31. And then
5 the question would be, we think, is Claim 31
6 essentially the same as Claim 1? And I -- I
7 think Petitioner has point -- pointed to some
8 reasons why it might not be.
9 But -- but, again, we would leave the
10 court of appeals to sort those out.
11 JUSTICE THOMAS: Thank you.
12 CHIEF JUSTICE ROBERTS: Justice
13 Breyer.
14 JUSTICE BREYER: Well, my question was
15 really the same as the Chief's, if you want to
16 say anything more about that. But I have a -- a
17 second question, which I'll say what it is, is
18 what I'm having trouble doing.
19 I can understand abolishing it. I can
20 understand keeping it. But limiting it, I'm
21 finding trouble in finding the right way to do
22 that. Why? Well, Smith invents a widget. He
23 goes to another company, having assigned the
24 widget to the first company, and the second
25 company wants to go ahead and sell widget prime.

1 The first company sues, and what they
2 want to argue, perhaps like here, is, wait a
3 minute, what we want to make has nothing to do
4 with that patent. Oh, no, it does, go look at
5 the claims. Well, he can't because, if it did
6 include widget prime, the patent would be
7 unlawful. So you see it can't. Well, says the
8 Fed Circuit, you can't argue that; you're
9 attacking your own patent.
10 So I -- I think, my God, they're
11 foisting this invention on the public forever
12 and they can't argue even something like that
13 and they can't even make widget prime?
14 Do you see the problem?
15 MS. RATNER: I do, Justice Breyer.
16 JUSTICE BREYER: And how are you
17 solving that?
18 MS. RATNER: So I think we're solving
19 it in two ways. There are two basic questions
20 that we think need to be addressed before
21 assignor estoppel is applied.
22 The first is, is this a real
23 transaction? That's the -- the discussion I was
24 having with the Chief. Is this the type of
25 transaction that someone might be said to be

1 making implicit warranties? Is this sort of an
2 arm's-length sale between party A and party B?
3 And -- and that could knock out any
4 circumstances like an employee who agrees up
5 front to give anything invented.
6 And then the second is, is there a
7 match between what someone said was valuable at
8 the time of the sale and what's at issue now?
9 And we think if after patent rights are assigned
10 that the assignee goes out and gets extremely
11 broad new patents, then the price for that is
12 they have to defend the breadth of that claim
13 against the world, including the person who
14 assigned those claims.
15 CHIEF JUSTICE ROBERTS: Justice Alito.
16 JUSTICE ALITO: Where does your test
17 come from? Is it just what you think is good
18 policy?
19 MS. RATNER: No, Justice Alito. We do
20 think it is -- is good policy, but we also think
21 that it derives both from this Court's decision
22 in Westinghouse and, before that, from basic
23 principles of estoppel by deed. And there has
24 been a lot of discussion about equitable
25 estoppel here, but I think it's important to

1 remember that at common law, estoppel consisted
2 of estoppel by deed, estoppel by conduct, or
3 estoppel by record. Estoppel by conduct is what
4 we now think of as equitable estoppel.
5 And -- and these are the basic
6 principles, we think, that control the estoppel
7 by deed such that what we're trying to do is
8 really apply a patent-specific version of
9 estoppel by deed.
10 JUSTICE ALITO: If you would think
11 about the second prong of your test, what
12 decision of a federal court has applied that
13 prong?
14 MS. RATNER: So there isn't a
15 decision. This is the question that the Court
16 left open in Westinghouse. And I think
17 Westinghouse identified the problem. It said,
18 look, it may be harder to know whether to do
19 estoppel when this is a pending patent claim as
20 opposed to an issued claim.
21 And so we're trying to answer that
22 question with the reasoning of Westinghouse and,
23 again, estoppel by deed. And we think the
24 answer is, well, you have -- that pending claim
25 has to look like or -- or be essentially the

1 same as the issued claim that you're now saying
2 is invalid.
3 JUSTICE ALITO: All right. Thank you.
4 CHIEF JUSTICE ROBERTS: Justice
5 Sotomayor.
6 JUSTICE SOTOMAYOR: Counsel,
7 Petitioner's counsel tried to do amendments to
8 your proposal. Could you respond to those,
9 number one?
10 And, number two, am I clear that
11 you're really not trying to return completely to
12 Westinghouse because Westinghouse seemed to
13 suggest that a court assignor estoppel would
14 reach questions of overbroad claims, and you're
15 not -- your test doesn't reach that at all,
16 meaning you would just look, it seems, as to the
17 time -- the claim that was claimed at the time
18 of assignment and those issued in the patent,
19 and you don't even get to the question of
20 whether or not -- Justice Breyer's question,
21 whether or not that reading is overbroad.
22 MS. RATNER: So, on your first
23 question, Justice Sotomayor, in terms of
24 Petitioner's limitations, I think we are fine
25 with a requirement that this be rock solid. I

1 mean, we chose the term "materially identical"
2 and think that means something.
3 And -- and as for the second proposed
4 limitation, they suggested that -- that there
5 should be -- that claim should exist both at the
6 time of the assignment from the assignor and at
7 the time of the assignment to the person
8 ultimately bringing the challenge. That
9 limitation, we don't agree with. We think this
10 is focused on the assignor's representations.
11 As to your second question about claim
12 construction, it's -- it's true that claim
13 construction has, I think, changed to some
14 degree over time. Prior art tends to be
15 relevant in narrowing a claim but only under a
16 canon of essentially narrowing an ambiguous
17 claim to preserve validity. What we don't think
18 is still viable anymore is sort of a
19 free-standing practicing-the-prior-art defense.
20 JUSTICE SOTOMAYOR: Well, that somehow
21 -- that, in my mind, gives credence to
22 Petitioner's counsel that maybe the doctrine has
23 lost its utility, because Westinghouse was
24 really premised on a claim not dissimilar from
25 this one, that if you read the claim in context,

1 it would be overbroad to the description in the
2 other claims.
3 But you've just admitted that -- that
4 things have gone -- have changed, how you read
5 patents has fundamentally issued -- has
6 fundamentally changed.
7 MS. RATNER: I -- I think it has
8 changed to some degree, Justice Sotomayor, but
9 that doesn't change the ultimate point of
10 Westinghouse, which was you can't have a core
11 attack on the value of something, the validity
12 of something that the day before you may have
13 implicitly represented has value.
14 CHIEF JUSTICE ROBERTS: Justice Kagan.
15 JUSTICE KAGAN: Ms. Ratner, you give
16 three examples in your brief of places where you
17 think, under your reformed doctrine, assignor
18 estoppel wouldn't apply or might not apply.
19 It's pre-invention assignments, continuation
20 applications, and changes in the law.
21 Is -- is -- is that it? Is that sort
22 of an exclusive list, or do you have other to
23 add to it?
24 MS. RATNER: So, Justice Kagan, I
25 don't have others that I'm hiding from you. I

1 -- I don't want to say it's exclusive if there's
2 some other unusual circumstances that would
3 arise that would undermine the basic notion that
4 what someone is saying at time two was
5 inconsistent with what they're saying at time
6 one.
7 JUSTICE KAGAN: But you think those
8 three are basically the world of -- of cases in
9 which that's true?
10 MS. RATNER: That covers the cases
11 that I -- I -- I can think of, yes.
12 JUSTICE KAGAN: Okay. Mr. Hochman
13 said -- when I gave him what I considered to be
14 the sort of paradigm cases of assignor estoppel
15 and asked whether they should be estopped, he
16 said yes, but they should be estopped under the
17 equitable estoppel doctrine.
18 And I take it what that would do for
19 him is that it would impose a reliance
20 requirement and that it would impose a sort of
21 extra special affirmative, clear representation,
22 so there could be nothing implicit about it,
23 maybe he wouldn't rely on the oath. I'm making
24 this up a little bit.
25 But I guess the question is, what's

1 the difference between equitable and assignor
2 estoppel in your mind as to these paradigmatic
3 cases, which we think of as bait-and-switch
4 cases, and does that difference make a
5 difference?
6 MS. RATNER: I -- I think you've put
7 your finger on the two main differences. The
8 first is a knowing affirmative
9 misrepresentation, and the second is justifiable
10 reliance on it. And we do think that would make
11 a -- a difference. It would be extremely
12 difficult to show that in most cases. And this
13 Court in Westinghouse specifically said, look,
14 that's estoppel by conduct, that's not estoppel
15 by deed. That's page 351 of Westinghouse.
16 And so I -- I think the Court has
17 already made clear that that's a different
18 branch of estoppel doctrine. And what we're
19 getting at here is not necessarily about one
20 party misleading another as much as confidence
21 and conclusiveness in a particular type of
22 formal transaction.
23 JUSTICE KAGAN: Thank you.
24 CHIEF JUSTICE ROBERTS: Justice
25 Gorsuch.

1 JUSTICE GORSUCH: Ms. Ratner, as I
2 understand it, no court's ever applied the
3 version of estoppel that you're proposing now.
4 And so I -- I guess my first question is, why
5 doesn't it face the same stare decisis
6 challenges that the Petitioner has? So that's
7 one set of questions for you.
8 Second is, with respect to the -- the
9 choice of relying on estoppel by deed and the
10 analogy to physical property, it allows -- your
11 test would allow liability even when there's no
12 misrepresentation of fact and the buyer, often
13 in these cases large and sophisticated, more so
14 than the seller, could easily determine the
15 validity of the patent on its own and is better
16 positioned to do so. And you also get rid of
17 reliance. And I guess I don't understand why we
18 would impose liability on statements that even
19 you'd agree were utterly meaningless at the
20 time.
21 And all that points to my third
22 question, and then I'll stop, and that is, if
23 we're going to look at estoppel doctrine, I -- I
24 -- I guess I'm a little confused why we would
25 look to real -- physical real estate as the

1 example, where deeds, recorded deeds, have a
2 special role in our -- in our system and have a
3 special validity, rather than personal --
4 personal property, where these elements,
5 misrepresentation of facts and -- and reliance,
6 are required, given that patents are so easily
7 killable and challengeable in ways that physical
8 real estate, much harder to do so.
9 So those are my three questions. Have
10 at them in any order you want.
11 MS. RATNER: Sure. I'll take them in
12 order.
13 First, in terms of stare decisis, we
14 do think that we're applying the rationale of
15 Westinghouse to the one area that Westinghouse
16 --
17 JUSTICE GORSUCH: But you do agree
18 that no -- no court's ever applied anything like
19 the test you're proposing, right?
20 MS. RATNER: That's correct, Your
21 Honor, but this one --
22 JUSTICE GORSUCH: Okay. So let's move
23 on to the second one then.
24 MS. RATNER: Sure. The second one, I
25 -- I would strongly resist the idea that we're

1 suggesting you get rid of reliance. We're
2 talking about a different branch of estoppel
3 doctrine. Again, this Court made clear in
4 Westinghouse which branch --
5 JUSTICE GORSUCH: But you say no
6 reliance is required to prove your version of
7 assignor estoppel, right?
8 MS. RATNER: Correct, because no --
9 JUSTICE GORSUCH: Okay. So you are
10 getting rid of reliance then.
11 MS. RATNER: No. No, Justice Gorsuch,
12 because reliance is an aspect of estoppel by
13 conduct. It's not an --
14 JUSTICE GORSUCH: Yes. You're just
15 saying -- you're getting rid of it in this area.
16 You're not getting rid of it everywhere, I
17 accept that, but you're getting rid of it here.
18 And -- and I guess I'm just curious why -- why
19 we would get rid of that and the material
20 misrepresentation of fact in -- in this
21 particular context and -- and why the analogy to
22 -- to deeds and to real -- real property makes
23 sense more than -- than personal property?
24 MS. RATNER: So I'd point you to page
25 351 of Westinghouse and page 902 of the Faulks

1 decision, which was the first decision out of --
2 JUSTICE GORSUCH: Yes, but if -- if
3 we're -- if we're modifying and we're doing
4 something nobody's ever done before, why not get
5 it right?
6 MS. RATNER: Well, I think those give
7 the reasons, Your Honor, which is we're talking
8 about a particular formal transaction here, and
9 the point here is to --
10 JUSTICE GORSUCH: Well, a contract is
11 a formal transaction. There are lots of formal
12 transactions.
13 MS. RATNER: The point -- the point is
14 to preserve the conclusiveness of these
15 transactions, just as they would be for their --
16 if this -- if this were real property, and I
17 think in -- as for personal property, that there
18 might be other things, like a warranty of
19 merchantability, that would also prevent someone
20 from saying, at time one, this thing has value
21 and, at time two, that it's valueless.
22 CHIEF JUSTICE ROBERTS: Justice
23 Kavanaugh.
24 JUSTICE GORSUCH: Thank you.
25 JUSTICE KAVANAUGH: Thank you, Chief

1 Justice.

2 And good afternoon, Ms. Ratner. I

3 want to follow up on the three examples on page

4 20 of your brief that Justice Kagan was

5 referencing and focus in particular on the first

6 one and make sure I understand what you're

7 saying exactly.

8 The brief says, if an employee assigns

9 to his employer all patent rights to any

10 inventions he may develop in the course of his

11 employment, the assignment generally would not

12 imply any representation as to the patentability

13 of particular inventions.

14 And I want to know what you mean by

15 the word "generally" or what's -- what's

16 captured there and what's not captured there.

17 MS. RATNER: Sure, Justice Kavanaugh.

18 Our -- our point is the same one that I made

19 earlier to the Chief Justice, which is, is this

20 the type of sale or assignment where someone

21 might be said to implicitly represent that the

22 patent rights have value?

23 And it's easy to see that if we're

24 talking about an arm's-length sale between A and

25 B. If we're talking about an ex ante assignment

1 of any inventions that haven't yet even been
2 invented, then you don't have that sort of
3 suggestion or -- or implicit warranty that
4 there's value there.
5 JUSTICE KAVANAUGH: Why do you say
6 "generally" instead of "not always" then?
7 MS. RATNER: I say "generally" because
8 we're talking about equitable doctrines where
9 there can always be fact-specific situations
10 that I -- I haven't thought of and that we don't
11 want to foreclose analysis of.
12 JUSTICE KAVANAUGH: Okay. There's
13 nothing you're -- you're thinking of, though?
14 You just want to be careful not to foreclose it?
15 MS. RATNER: As I said to Justice
16 Kagan, I'm not intending to hide anything in the
17 paragraph on this page.
18 JUSTICE KAVANAUGH: And then
19 Petitioners object to the phrase "materially
20 identical," and I just want to give you an
21 opportunity to respond to that again.
22 MS. RATNER: Yeah. Again, to the
23 extent that they're talking about a rock-solid,
24 I think is the phrase Petitioner used, a
25 rock-solid textual similarity, we're perfectly

1 fine with that. Our -- our point is that there
2 may be some minor changes, say, in -- in
3 paragraphs or in commas or in a unimportant term
4 that doesn't actually change the claim
5 limitations. And -- and if that's the case,
6 then we don't think that should undermine the
7 application of assignor estoppel.
8 JUSTICE KAVANAUGH: Thank you,
9 Ms. Ratner.
10 CHIEF JUSTICE ROBERTS: Justice
11 Barrett.
12 JUSTICE BARRETT: Good afternoon,
13 Ms. Ratner. So I have a question about the
14 choice that -- the choice that we're facing
15 here. As Justice Breyer pointed out, you know,
16 we can keep -- or let's just assume for the sake
17 of this argument that I agree that stare decisis
18 establishes that the assignor -- assignor
19 doctrine exists.
20 We have a choice between two
21 bright-line rules, either we have it or we
22 don't, or we can do this middle course that
23 you're charting that, as you say, no court has
24 applied before.
25 It seems to me that your approach

1 doesn't give us the efficiency of -- of estoppel
2 doctrines generally. I mean, think about
3 Blonder Tongue, patent context, and, you know,
4 estoppel there, issue -- issue preclusion shuts
5 it down and makes litigation more efficient.
6 But, here, as I take it, your proposal
7 would probably enmire the parties in fights
8 about what's materially identical. I mean,
9 would that be a battle of the experts?
10 MS. RATNER: So I -- I think, as an
11 ordinary sense, no. If we're talking about the
12 simple assessment of, are these claims -- are
13 there the same claim limitations, or are there
14 extra claim limitations added, we think that
15 could be done in a relatively straightforward
16 way.
17 But I -- I would add, to the extent
18 there are some factual questions here, we think
19 that that's a benefit of our theory. The
20 problem of the -- with the Federal Circuit's
21 theory here is that it basically treats the
22 application of an equitable estoppel principle
23 as an on/off switch, and -- and that's the --
24 the underlying problem that we're trying to
25 resolve.

1 JUSTICE BARRETT: How much are you
2 driven by stare decisis here as opposed to, if
3 you were starting from scratch, this is what you
4 would propose that the Court adopt?
5 MS. RATNER: I think that we are
6 probably somewhere in between those two things
7 given the long period of time in which assignor
8 estoppel has existed and in which Congress could
9 have acted. We -- we give great weight to that.
10 That said, I do think that the
11 historical analogs here still provide support
12 from that if we were -- for the doctrine if we
13 were deciding in the first instance.
14 JUSTICE BARRETT: Thank you.
15 CHIEF JUSTICE ROBERTS: A minute to
16 wrap up, Ms. Ratner.
17 MS. RATNER: Thank you, Mr. Chief
18 Justice.
19 I guess I would just emphasize what we
20 think is the core advantage of our test, and
21 that's that it puts intellectual property on par
22 with other kinds of property, whereas the
23 parties' theories would create a mismatch in one
24 direction or the other.
25 So Minerva, on one side, wants to

1 eliminate assignor estoppel altogether, but that
2 would mean that sales of real property are
3 protected by estoppel by deed and personal
4 property may be protected by warranties of
5 merchantability, but there would be no analog
6 for intellectual property.
7 And, on the other side, the Federal
8 Circuit and Hologic would apply a reflexive rule
9 that covers all invalidity disputes. But, as we
10 discussed, that would mean that estoppel applies
11 even in the absence of logically inconsistent
12 positions, and that's not consistent with
13 historical estoppel doctrines.
14 So we think that our approach here is
15 most consistent with Westinghouse, with that
16 historical development of assignor estoppel, and
17 with the animating principles behind estoppel
18 doctrines generally.
19 Thank you.
20 CHIEF JUSTICE ROBERTS: Thank you,
21 Ms. Ratner.
22 Mr. Wolf.
23 ORAL ARGUMENT OF MATTHEW M. WOLF
24 ON BEHALF OF THE RESPONDENTS
25 MR. WOLF: Thank you, Mr. Chief

1 Justice, and may it please the Court:
2 In 1924, this Court held that assignor
3 estoppel was manifestly intended by Congress.
4 In the 100 years since, Congress has maintained
5 the relevant statutory language through multiple
6 revisions of patent law.
7 This Court has explicitly refused to
8 overrule the doctrine, and dozens of lower
9 courts have applied assignor estoppel without
10 significant incident or controversy, including
11 recently in Diamond Scientific, which explicitly
12 incorporated the claim construction doctrines of
13 Westinghouse.
14 Minerva asks this Court to disregard
15 all of this in the service of the purportedly
16 paramount goal of eliminating bad patents. But
17 patent laws have other critical objectives,
18 including incentivizing scientific progress
19 through the protection of patents and fostering
20 predictability in commercial transactions.
21 Hologic respectfully submits that, if
22 the costs and benefits of assignor estoppel are
23 to be reweighed, it should be Congress handling
24 the scales. Whether couched in the principles
25 of stare decisis or ratification, this Court

1 should not undermine the hundreds of thousands
2 of still extant bargains struck against the
3 backdrop of assignor estoppel.
4 The bargain in this case included Mr.
5 Truckai and his co-inventors expressly selling
6 the rights to future patent applications. The
7 parties valued those rights based on the
8 understanding that Respondent would secure
9 whatever claims the Patent Office would allow,
10 in this case, a claim just like the one that Mr.
11 Truckai successfully secured allowance of with
12 original Claim 31, and that Mr. Truckai would
13 not subsequently challenge their validity.
14 And if Mr. Truckai wanted a different
15 deal, he was free to contract around assignor
16 estoppel, per Mentor Graphics, and accept a
17 concomitantly reduced purchase price. But Mr.
18 Truckai now wants to keep both the $8 million he
19 pocketed and the right to undermine what those
20 millions purchased.
21 The inequity of that position has been
22 apparent since the founding of this country, and
23 the doctrine of assignor estoppel borne from
24 that recognition should not be cast aside.
25 CHIEF JUSTICE ROBERTS: Mr. Wolf, you

1 began by talking about stare decisis and cited
2 some authority for it, but you have to weigh
3 against that, don't you, the Court's description
4 of assignor estoppel as a failure and the
5 Court's statement that, to whatever extent that
6 doctrine may be deemed to have survived the
7 Formica decision or to be restricted by it, it's
8 not controlling. So it's -- it's not the
9 strongest stare decisis argument?
10 MR. WOLF: Your Honor, respectfully,
11 in -- in Scott Paper, this Court considered
12 whether or not to reverse Westinghouse and
13 expressly said it was not doing so. Rather, it
14 created a narrow exception based on this Court's
15 long-held concerns about temporal expansions of
16 patent monopolies.
17 In Lear, respectfully to the Court in
18 that case, there was really no discussion of
19 stare decisis. There was no discussion of
20 congressional intent. And as was noted earlier,
21 the Court specifically held or noted that the
22 estoppel in the assignor context was far more
23 compelling than in the licensee context that
24 Lear addressed.
25 So, while there has been critical

1 language, when the Court explicitly refute --
2 refuses to overturn a case, there's no
3 conclusion other than it remains good law.
4 CHIEF JUSTICE ROBERTS: I'd -- I'd
5 like to see if there's a difference between your
6 position and that of the Solicitor -- Solicitor
7 General, in particular, for the person who
8 enters employment and signs a general assignment
9 of all her inventions to her employer.
10 Does equitable or assignor estoppel
11 apply in that case?
12 MR. WOLF: Well, obviously, Your
13 Honor, that's -- that's not our case. We're not
14 an employee/employee -- employee/employer
15 context, but --
16 CHIEF JUSTICE ROBERTS: I -- I wasn't
17 -- I wasn't confused about that.
18 MR. WOLF: Yes, Your Honor.
19 Apologies. I would suggest that -- that
20 employers pay employees for research and
21 development. They provide the resources to
22 perform that research and development. It is
23 not inequitable for them to expect that the
24 fruits of that research should be given to the
25 employer.

1 So I think we do disagree at least to
2 some degree. I mean, I -- I can think of
3 circumstances where an employee would not be
4 estopped, putting privity issues aside, for
5 example, if they refused to sign the oath, but
6 there is some daylight between our position and
7 the government's position in that regard.
8 CHIEF JUSTICE ROBERTS: Thank you,
9 counsel.
10 Justice Thomas.
11 JUSTICE THOMAS: Thank you, Mr. Chief
12 Justice.
13 Counsel, it seems as though your view
14 of assignor estoppel begins to approach the
15 assignments that one would require from an
16 employee. It seems -- so how far would you go
17 from the original assignment? Would you -- in
18 this case, in the current case, the -- we're
19 talking about a patent that is quite different
20 from the original patent.
21 MR. WOLF: Respectfully, Your Honor,
22 we -- we disagree very strongly. Mr. Truckai --
23 and this is at JA 449 -- at trial acknowledged
24 that at the time he filed his application, he
25 did -- he thought that he was entitled to a

1 claim without moisture transport.
2 He fought for Claim 31 and succeeded
3 in obtaining Claim 31 that did not have moisture
4 transport before the assignment. And so, when
5 Hologic took this portfolio over, when they were
6 assigned it, they had express representations
7 from Mr. Truckai that he was entitled to the
8 very claim that they now say we're not entitled
9 to.
10 It was only after the fact that he
11 purportedly changed his mind and realized the
12 error of his ways. Of course, that kind of
13 financially induced change of memory is
14 precisely the kind of morass that assignor
15 estoppel is designed to avoid.
16 JUSTICE THOMAS: You say that if there
17 are any changes to estoppel -- assignor
18 estoppel, it should be done by Congress. But
19 couldn't you say that, that if you want assignor
20 estoppel, Congress should amend the Patent Act?
21 MR. WOLF: Respectfully, Your Honor,
22 we believe that's backwards. When, in
23 Westinghouse, this Court said that assignor
24 estoppel was manifestly intended by Congress,
25 one, that's pretty strong language.

1 Congress in 1952 noted when the
2 Supreme Court weakened contributory
3 infringement, for example, and emphatically
4 rejected the Supreme Court's rejection -- I'm
5 not sure that's appropriate legal language --
6 but, in any event, the -- the -- Congress was
7 put on notice of the Supreme Court's view of its
8 intent and how it understood the assignment
9 provision, and it re-ratified it in 1952.
10 And then, in 2011/2012, with the
11 America Invents Act, which wholesale changed
12 certain provisions of patent law, it once again
13 just reiterated the assignment provision as is.
14 JUSTICE THOMAS: But it seems as
15 though you are -- you want Congress by statute
16 to make changes to something that doesn't appear
17 in the Patent Act. So I don't know how that's
18 backwards to say, well, maybe Congress should
19 amend the Patent Act to include assignor
20 estoppel in the first instance?
21 MR. WOLF: Your Honor, in Kimble, for
22 example, this Court noted that stare decisis
23 applies regardless of whether decisions focused
24 only on statutory text or also relied on the
25 policies and purposes animating the law.

1 So whether or not one views the
2 holding of Westinghouse as expressly construing
3 Section 261 or understanding the animating
4 policy behind 261, either way it's subject to
5 the same deferral to Congress and it should be
6 up to Congress to change it.
7 JUSTICE THOMAS: Thank you.
8 CHIEF JUSTICE ROBERTS: Justice
9 Breyer.
10 JUSTICE BREYER: How do you respond to
11 what I've gotten out of some of the -- the
12 briefs? There is precedent, it has problems,
13 but 80 years old, 100 years old, what's changed?
14 One, employment practices. So you've
15 got general assignment. You go to work
16 somewhere else and the new company is afraid to
17 go anywhere near it.
18 Second, nature of invention.
19 Artificial intelligence, robots, dah, dah, dah,
20 dah, dah. Okay?
21 Third, complexity. And complexity
22 means this: Widget, patent, assigned to A. Go
23 to work for B. B, widget prime. A sues B. All
24 he wants to argue is, of course, the patent on
25 widget doesn't cover widget prime because, if it

1 did, then, since it wasn't described properly
2 and couldn't be practiced by someone, there
3 wasn't enough information, the patent would have
4 been unlawful. Okay?
5 No, says the Federal Circuit, you
6 can't even argue that. Result, result,
7 extension of many important patent monopolies
8 which shouldn't be there and which, in fact,
9 will cost the public the loan advances, and you
10 can imagine that.
11 All right. Now I may have overstated
12 it. That's how I'm understanding it now. So
13 they're saying do something. One side says
14 there's nothing you can do except abolish it.
15 Others say limit it.
16 I want to hear your response.
17 MR. WOLF: Your Honor, I have a number
18 of responses to that, that notion of how the
19 world has changed.
20 First, of course, Westinghouse itself
21 was an employer/employee case. So it -- it's
22 changed in -- in -- in amount but not in kind.
23 Secondly, one thing that has changed
24 is that the PTAB, through the America Invents
25 Act, now allows an inventor to challenge the

1 very thing you are concerned about, whether it
2 be a matter of prior art or, under post-grant
3 review, it'd be a matter of issues of written
4 description or enablement.
5 We also, Your Honor, have -- your
6 question hinted at privity issues, and, of
7 course, there is -- if -- if an employee goes
8 from company A to company B and is not
9 sufficiently directing the activities, then the
10 privity would break the chain -- the privity
11 analysis would break the chain and you would not
12 have assignor estoppel.
13 And, finally, there are -- as I noted
14 before, if the inventor thinks that the way
15 company A characterized his or her invention is
16 not right, he or she can refuse to sign the
17 oath. And in that case, again, you raise the
18 prospect of breaking the chain. But, if an
19 employee at company A turns around and, for
20 example, founds a company to compete against the
21 very work he or she did, that, I think, offends
22 our traditional notice -- notions just as much
23 today as it did 100 years ago.
24 CHIEF JUSTICE ROBERTS: Justice Alito.
25 JUSTICE ALITO: I have no questions.

1 CHIEF JUSTICE ROBERTS: Justice
2 Sotomayor.
3 JUSTICE SOTOMAYOR: Counsel, I'd like
4 to pursue Justice Breyer's question on one
5 level, okay?
6 MR. WOLF: Yes, Your Honor.
7 JUSTICE SOTOMAYOR: You're resisting
8 any limitation to assignor estoppel, but as --
9 but there is a fairness element that you're not
10 responding to, which is, if assignor estoppel
11 isn't tethered in some way to the scope of the
12 rights that were actually assigned, then I don't
13 know why it's fair to estop an assignor from
14 seeking to invalidate something that he or she
15 did not actually assign.
16 So, for example, if the original '072
17 application had only one claim that required
18 moisture permeability but later you change, if
19 Mr. Truckai assigned the patent that way and you
20 revised it deleting that reference, why should
21 Mr. Truckai be estopped? You did something that
22 he didn't attest to, that wasn't within the
23 claims specified. What sense does it make not
24 to let him raise that defense?
25 MR. WOLF: Yeah. So three responses,

1 Your Honor.
2 First, from the reliance perspective,
3 he was paid and NovaCept was paid 325 million,
4 he personally pocketed 8 million, against the
5 backdrop of the current assignor estoppel
6 regime. So whether you want to call this a
7 reliance interest or a fairness interest, it's
8 the same interest, which is he -- he -- he was
9 paid knowing that Hologic would get what it
10 would get from the Patent Office. And now
11 having pocketed that money, he says: Well, I
12 want a different deal.
13 So that's -- that's a different
14 component of fairness. That's --
15 JUSTICE SOTOMAYOR: I'm sorry. He
16 pocketed money on a deal that included just one
17 item. You then changed it.
18 Are you saying he pocketed money
19 knowing you would and could change it, so you're
20 just out of luck?
21 MR. WOLF: I wouldn't phrase it as out
22 of luck, Your Honor. I'm assuming the facts
23 you're stating. Obviously, we disagree with
24 some of the premises of what Petitioner has
25 said.

1 But assuming the hypothetical, as
2 Diamond Scientific noted, what you're buying is
3 the full scope of what the specification will
4 bear.
5 There is no dispute in this case that
6 everything that's in Claim 1, the infringed
7 claim, is identified in Mr. Truckai's
8 application. What he asserts is that it wasn't
9 novel, it wasn't new.
10 Well, if he was right, he is free to
11 rely upon Westinghouse and Diamond Scientific's
12 claim construction principles. But we know in
13 this case he's wrong, and we know he's wrong for
14 two reasons. First, the Patent Office
15 originally allowed Claim 31. And, second, they
16 tried to institute an IPR against Claim 1, and
17 they didn't even achieve institution.
18 So the fairness here, we agree that
19 there are issues of fairness, but if you're
20 going to rebalance the equation, that is for
21 Congress, not the courts, to do that balancing.
22 CHIEF JUSTICE ROBERTS: Justice Kagan.
23 JUSTICE KAGAN: Mr. -- Mr. Wolf, you
24 just talked to Justice Sotomayor and before that
25 to Justice Thomas about this case and -- and how

1 we should understand things to have played out
2 over time.
3 But let's just assume a hypothetical
4 case, and -- and I'm not meaning it to have any
5 necessary relationship to yours. And the
6 hypothetical is an inventor who assigns an
7 application, and then the assignee broadens the
8 patent claim beyond anything that the inventor
9 would have thought patentable in the first
10 instance. Why -- why should she be estopped?
11 MR. WOLF: Your Honor, first of all,
12 she can go to the Patent Office and institute a
13 post-grant review and make that argument to the
14 Patent Office, to an organization that is not --
15 and I'm quoting here from the AIPLA brief, and,
16 of course, they're the folks that do this stuff
17 for a living, both for plaintiffs and
18 defendants, where they note that inventors "loom
19 large and have a greater influence over trier of
20 fact than anybody else."
21 And so Congress has decided that if
22 you're going to make a Section 112 challenge as
23 an inventor, you can go to the Patent Office,
24 where they are not like --
25 JUSTICE KAGAN: Right. Well, she

1 could do that. I mean, I take the point, Mr.
2 Wolf. She could do that. But -- but why should
3 she be estopped under the assignor estoppel
4 doctrine in any event, regardless of that
5 alternative path?
6 I mean, it -- it does seem as though
7 the warranty that she made is not inconsistent
8 with what she's doing now. And I would think
9 that that's the critical question for -- for any
10 estoppel doctrine.
11 MR. WOLF: Well, one response, Your
12 Honor, is that -- that no case that I'm aware of
13 in this Court or any other has distinguished
14 Section 112 invalidity from any other form of
15 invalidity. So, from a purely stare decisis or
16 ratification perspective, you -- you can't argue
17 invalidity, period.
18 JUSTICE KAGAN: Yeah, I didn't really
19 mean to be making a 112 argument because I -- I
20 just -- I think that this could be true under --
21 under 112 or not true under 112.
22 I mean, the -- the -- the -- the point
23 of my hypothetical was just to say that -- that
24 something meaningful has happened between time
25 one and time two with respect to the claim.

1 MR. WOLF: If I understand your
2 hypothetical in your question correctly, Your
3 Honor, I would say that the -- the -- and,
4 again, putting the PTAB issue aside,
5 Westinghouse and Diamond Scientific just -- in
6 1988, make clear that as the inventor, you're
7 allowed to say that if you read the patent the
8 way the plaintiff wants to, it's invalid. And
9 so you should read it in a narrower way.
10 And that's exactly what happened in
11 Westinghouse and -- and in any number of the
12 assignor estoppel cases. So that fairness
13 correction is already built into the
14 jurisprudence. And if there -- if there is a
15 way to -- if there's an approach to rebalancing
16 that we want to do prospectively, I'm sure there
17 are good policy reasons behind what Your Honor
18 is suggesting, but that should be applied
19 prospectively through statute.
20 JUSTICE KAGAN: Thank you.
21 CHIEF JUSTICE ROBERTS: Justice
22 Gorsuch.
23 JUSTICE GORSUCH: So, counsel, on the
24 stare decisis front, I think I heard the SG's
25 office acknowledge we're somewhere in between

1 things.

2 And as I come at it -- and tell me

3 what's wrong with this -- Westinghouse didn't

4 actually apply the doctrine. It acknowledged

5 its existence and allowed the challenges over

6 the scope of the -- of the patent.

7 Scott Paper called it a logical

8 embarrassment. Lear said that Scott had

9 undermined the basis for patent estoppel even

10 more than Westinghouse had. So it read

11 Westinghouse as undermining the basis for patent

12 estoppel.

13 The world has changed greatly since

14 then, as Justice Breyer pointed out, in terms of

15 employee/employer relations and how these

16 contracts of adhesions are often used against

17 employees.

18 And now we have the Patent Office

19 itself refusing to apply patent estoppel in its

20 own proceedings, for -- in IPR proceedings. So

21 the only place left that this doctrine seems to

22 apply is in court.

23 Isn't that a strange state of affairs

24 to -- to rest on stare decisis?

25 MR. WOLF: Your Honor, respectfully, I

1 strongly disagree with the premise of your first
2 statement about Westinghouse. Westinghouse did
3 apply assignor estoppel. Now --
4 JUSTICE GORSUCH: Okay. Other than
5 that, do you have any other concerns besides
6 Westinghouse?
7 MR. WOLF: Well -- well, we have
8 Diamond Scientific, again, in 1988, which is the
9 -- every single currently existing patent
10 assignment is operating under Diamond
11 Scientific. It is --
12 JUSTICE GORSUCH: Unless they get
13 challenged in the Patent Office in the IPR,
14 which they could be. And then --
15 MR. WOLF: Right.
16 JUSTICE GORSUCH: -- it doesn't apply,
17 right?
18 MR. WOLF: Right. In ERISA, the --
19 the Court suggested that Congress --
20 JUSTICE GORSUCH: Okay.
21 MR. WOLF: -- unambiguously --
22 JUSTICE GORSUCH: Okay.
23 MR. WOLF: Sorry, Your Honor.
24 JUSTICE GORSUCH: So -- so -- so we
25 got that. And then, if we're going to monkey

1 with it, if we're going to change it, the
2 Solicitor General says we should analogize to
3 patents by deed -- sorry, estoppel by deed,
4 which has to do with real estate, and it said it
5 only did that because that's kind of what
6 Westinghouse talked about.
7 Why wouldn't the more natural place to
8 look at is -- is -- is just plain old estoppel
9 with respect to personal property, rather than
10 real estate transactions, given that, if you
11 look at estoppel by deed, there's no need for
12 material misrepresentations. There's no need
13 for reliance.
14 And this would be -- this seemingly
15 would be an area in which those would be very
16 critical considerations when a large purchaser
17 is taking a property off of a smaller inventor,
18 someone who's well positioned to see whether
19 there are any problems with the patent and who
20 may not rely on a stray misstatement or puffery.
21 MR. WOLF: Your Honor, first, on the
22 issue of estoppel by deed, estoppel by deed does
23 not just apply to land. It also applies to
24 personal property when there are the formalities
25 of transfer. So a patent is as heightened a

1 formal transfer as one can imagine in the
2 property context. So I just want to put a pin
3 in that.
4 On the reliance point, when Mr.
5 Truckai, to use our specific example, applies
6 for a claim, when the Patent Office originally
7 says no, and when Mr. Truckai then successfully
8 fights for allowance of that claim, it's hard to
9 see how that isn't a representation that can be
10 taken seriously --
11 JUSTICE GORSUCH: You --
12 MR. WOLF: -- by a potential
13 purchaser.
14 JUSTICE GORSUCH: -- would win under
15 that standard. I -- I -- I -- I was asking what
16 -- why you'd care about the standard. I
17 understand you think you'd win under that.
18 Thank -- thank you, counsel.
19 MR. WOLF: Yeah.
20 CHIEF JUSTICE ROBERTS: Justice
21 Kavanaugh.
22 JUSTICE KAVANAUGH: Thank you, Chief
23 Justice.
24 Good afternoon, Mr. Wolf. I want to
25 explore the differences you might have with the

1 Solicitor General. The Solicitor General wants
2 to retain the doctrine of assignor estoppel but
3 to limit it, and I want to make sure I
4 understand your concerns about the SG's
5 position.
6 What -- what -- how would you describe
7 your differences with the Solicitor General's
8 position as articulated in the brief and today?
9 MR. WOLF: Yes, Your Honor. And
10 putting aside the reliance issues and the stare
11 decisis issues, if we were talking about ab
12 initio what would we think about it, I -- I
13 think there are -- if I could answer that first
14 at the -- at the theoretical level and then give
15 a very specific example.
16 At the theoretical level, as worded,
17 the SG's proposal is more stringent than the
18 invalidity test itself. The question the law
19 asks when determining the validity of claims
20 sought after an original application was -- was
21 filed is whether they are supported by the
22 original specification.
23 Nowhere in the law can we find a
24 requirement that subsequent claims be materially
25 identical to original claims for Section 112 to

1 be satisfied.
2 So there's an incongruence between the
3 policy the government is espousing, and it's a
4 perfectly reasonable policy, if -- if -- if --
5 if Congress wanted to go there. It just doesn't
6 match up with the text.
7 And let me give the specific example.
8 It is common for a patent examiner to tell an
9 applicant that claims as written will not be
10 allowed, but they're -- if they're modified in
11 one way or the other, the patent will issue.
12 If the applicant takes the PTO up on
13 its suggestion under the government's test,
14 would that result in a loss of protection of
15 assignor estoppel? So it's a -- it -- it -- in
16 the real world, it presents a Hobson's Choice,
17 as -- as phrased, given the way prosecution
18 actually works.
19 And, in fact, Pharma, in its amicus
20 brief, noted the unworkability of the
21 government's test and it said amended or newly
22 added claims can differ from the original claims
23 in many dimensions such that evaluating the
24 amount of their difference would be practically
25 impossible. So it's a difficult test to

1 implement.

2 JUSTICE KAVANAUGH: Thank you, Mr.

3 Wolf.

4 CHIEF JUSTICE ROBERTS: Justice

5 Barrett.

6 JUSTICE BARRETT: Mr. Wolf, do you see

7 this case as one about the reenactment canon

8 where we would say there is a settled

9 interpretation of an act and then Congress

10 reenacted the statute without touching it and,

11 therefore, you know, we assume that Congress

12 intended to ratify it or Congress acquiesced in

13 it, or do you see this as a case in which there

14 was a settled common law background assumption,

15 this assignor estoppel, and Congress took the

16 soil of the common law with it into the Act, and

17 does it matter which way you see it?

18 MR. WOLF: The answer is both and no.

19 JUSTICE BARRETT: Well, I -- I guess I

20 think it might matter because the reenactment

21 canon requires a pretty well-established line of

22 cases that would put Congress on notice. And

23 as, you know, we've talked about a lot this

24 morning, there's uncertainty in the cases,

25 especially ours.

1 MR. WOLF: Your -- Your Honor, prior
2 to 1952, we do not believe there's any
3 uncertainty. Westinghouse said it was
4 manifestly intended by Congress. Scott said
5 expressly and explicitly it was not overturning
6 the doctrine.
7 So, when Congress -- and then, between
8 1945 and 1952, we saw three cases and two
9 treatises all unanimously say that Westinghouse
10 was maintained by Scott. Petitioner can't point
11 to a single case because we're not aware of any
12 that --
13 JUSTICE BARRETT: But, counsel, the --
14 the -- the language -- and, you know, this has
15 come up already -- I mean, when you have the
16 language in Scott Paper and then in Lear saying
17 that Scott Paper undermined any basis for
18 assignor estoppel, I mean, you can't say that it
19 was completely embraced.
20 MR. WOLF: Well, obviously, Your
21 Honor, Lear was many years -- 17 years after the
22 '52 Patent Act. But --
23 JUSTICE BARRETT: But it's showing how
24 the courts understood it, so it's still
25 relevant, right?

1 MR. WOLF: Your Honor, I don't think
2 Lear suggested that Scott Paper overruled
3 Westinghouse. I mean, Lear was a policy-driven
4 case. It did not address stare decisis. It did
5 not address congressional intent, congressional
6 language.
7 And -- and, as I suggested, and I
8 don't want to belabor it, but the Third Circuit
9 and the Sixth Circuit in the intervening years
10 between Scott Paper and the Patent Act expressly
11 acknowledged that Westinghouse was the rule.
12 I mean, we have Hope Basket in 1951
13 saying the basic rule of estoppel may have been
14 somewhat modified by Scott Paper, but it was not
15 abolished. In fact, that case restated the
16 rule.
17 JUSTICE BARRETT: Well, we've -- we've
18 been very clear that, to the extent -- let's
19 assume that Formica/Westinghouse did lay down a
20 rule, although there's some dispute about
21 whether it did that. Let's assume that it did.
22 Let's assume that Scott Paper undercut
23 it. We've been very clear in telling lower
24 courts that, even if our precedents have made --
25 made it a virtual certainty that we would -- we

1 would overrule it, that that's our prerogative.
2 So the fact that lower courts
3 continued to apply it wouldn't necessarily mean
4 that, as we would view it, that it wasn't a dead
5 letter. But my -- my time is up. Thank you.
6 MR. WOLF: Thank you, Your Honor.
7 CHIEF JUSTICE ROBERTS: A minute to
8 wrap up, Mr. Wolf.
9 MR. WOLF: Your Honor, the facts of
10 this case comfortably satisfy the policies
11 underlying any of the modifications of assignor
12 estoppel proposed by Minerva or the amici.
13 But, for many of the same reasons the
14 doctrine should not be abrogated, it also should
15 not be modified by this Court.
16 Assignees have relied on the estoppel
17 when deciding whether, at what price, and under
18 what terms they wish to acquire patents and
19 patent applications.
20 Assignors have benefitted from that
21 reliance through the enhanced assignment value
22 the doctrine creates, and they have also been
23 free to reject the doctrine in whole or in part
24 when negotiating the terms of the assignment.
25 A retrospective change would mean a

1 windfall for assignors and radically
2 undercutting the return on the deal for a
3 quarter century's worth of assignees.
4 Any modification to assignor estoppel
5 should be made only after careful consideration
6 of the advantages, not just the disadvantages of
7 the doctrine. It should be made after input
8 from all of the stakeholders in the marketplace.
9 Given all this and given this Court's
10 precedent, it should be Congress that decides
11 whether, what, and when such changes should be
12 made.
13 Thank you.
14 CHIEF JUSTICE ROBERTS: Thank you,
15 counsel. The case is submitted -- oh? Oh, I'm
16 sorry, Mr. Hochman. You have rebuttal.
17 REBUTTAL ARGUMENT OF ROBERT N. HOCHMAN
18 ON BEHALF OF THE PETITIONER
19 MR. HOCHMAN: Thank you. Thank you,
20 Mr. Chief Justice.
21 CHIEF JUSTICE ROBERTS: Excuse me.
22 MR. HOCHMAN: I will be -- I will be
23 as quick as I can here. I'm going to start from
24 the narrow and move to the broad. I just want
25 to correct a couple of, I think, misstatements

1 that -- that Mr. Wolf made.
2 He -- he -- he said repeatedly that
3 Claim 31 was obtained. That's not true. Claim
4 31 was canceled and it was canceled two years,
5 two full years before Cytyc lost the patent. So
6 it was not -- and -- and -- and that's just the
7 way the patent prosecution process goes.
8 Sometimes you learn things after a claim has
9 been given a tentative allowance by the court
10 and -- and you have to make changes.
11 He pointed to the testimony in -- in
12 -- in -- in -- in the record about Truckai at
13 one time believing that his claim was more than
14 just moisture transport. But that's not the
15 same thing as covering an applicator head with a
16 moisture-impermeable device. Those are
17 different points, and I think -- and I think
18 that that -- that this is exactly the kind of
19 backward-looking overreach that the rules should
20 prohibit.
21 I think Hologic's position makes Claim
22 31 a red herring. It -- you know, it -- they
23 were very clear today. Whatever they can
24 squeeze out of the patent, the assignor is stuck
25 with. And that just doesn't make any sense.

1 You know, Scott allowed -- Scott Paper
2 allowed a party -- an assignor to say that the
3 patent -- that what he was doing was outside of
4 the scope of patent protection because of the
5 time-limited nature of patents. There is no
6 principled reason why an assignor shouldn't be
7 able to say that what he's doing is outside the
8 scope of the patent protection because it's
9 beyond the -- it's -- it's beyond the breadth of
10 the application that he sold.
11 And that's our argument, and -- and --
12 and it's also, by the way, the argument that
13 Westinghouse accepted, and this is toward the
14 end of the Westinghouse opinion. It's page 354,
15 toward the -- toward the bottom there, when it's
16 talking about Claim 6. Claim 6 in that case was
17 pending at the time of the assign -- of -- of --
18 of the assignment, was overbroad, and the
19 assignor was nonetheless allowed to dispute the
20 breadth of even narrower claims than the
21 overbroad claim that had been pending at the
22 time.
23 And this is consistent, by the way,
24 with Kimble. Kimble says in case after case the
25 Court has construed these laws to preclude

1 measures that restrict free access to formerly
2 patent -- patented as well as unpatented
3 inventions, and it cites Scott Paper.
4 That's the point. If you're outside
5 the scope of patent protection, you should be
6 allowed to -- the inventor, even an assignor,
7 should be allowed to challenge it.
8 And then, final -- and -- and, in
9 addition, the AIA and IPRs and post-grant
10 review, that's just another reason to abandon
11 assignor estoppel. That's another one of the
12 significant changes that has taken place. The
13 doctrine doesn't have any legs to stand on.
14 And the -- you know, the government
15 pushes towards the real property analogy and
16 estoppel by deed, but it's really important to
17 remember that assignor estoppel, unlike estoppel
18 by deed, is committing property to the public.
19 And so the analogy doesn't hold when -- when in
20 -- when, in estoppel by deed, somebody is trying
21 to take back what they had sold.
22 But that's not true here. What we're
23 trying to do is ensure that they get to keep the
24 substantial value of what we sold them but no
25 more. And to the extent that there's any

1 concern about real mischievous behavior by
2 assignors, equitable estoppel and state law
3 remedies remain available to address them.
4 For all those reasons, we respectfully
5 request that you vacate the judgment and remand
6 with instructions to consider our Section 112
7 invalidity arguments on the merits.
8 CHIEF JUSTICE ROBERTS: Thank you,
9 counsel. Now the case is submitted.
10 (Whereupon, at 12:43 p.m., the case
11 was submitted.)
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