

No. 20-

In the Supreme Court of the United States

HOLOGIC, INC. AND CYTYC SURGICAL PRODUCTS, LLC,
CROSS-PETITIONERS,

v.

MINERVA SURGICAL, INC., CROSS-RESPONDENT.

*ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE
FEDERAL CIRCUIT*

**CROSS-PETITION FOR A WRIT OF
CERTIORARI**

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QUESTION PRESENTED

American courts have long relied on the doctrine of assignor estoppel “to prevent unfairness and injustice.” *Diamond Sci. Co. v. Ambico, Inc.*, 848 F.2d 1220, 1224 (Fed. Cir. 1988) (citation omitted). In its most basic form, the doctrine “prohibits an assignor of a patent, or one in privity with an assignor, from attacking the validity of that patent when he is sued for infringement by the assignee.” *MAG Aerospace Indus., Inc. v. B/E Aerospace, Inc.*, 816 F.3d 1374, 1379-80 (Fed. Cir. 2016). At the rule’s heart lies a straightforward intuition: “an assignor should not be permitted to sell something and later to assert that what was sold is worthless, all to the detriment of the assignee.” *Diamond Sci.*, 848 F.2d at 1224.

Under the Patent Act and the America Invents Act, a party may challenge the validity of an issued patent not only in infringement litigation in district court, but also through administrative proceedings before the Patent Office. The Federal Circuit has held that the Patent Office’s administrative finding of invalidity can give rise to collateral estoppel in infringement litigation in district court.

The question presented is whether an assignor of a patent may circumvent the doctrine of assignor estoppel by challenging the validity of the assigned patent in administrative proceedings before the Patent Office, and then using the Patent Office’s finding of invalidity to collaterally estop the *assignee* from relying on the patent in infringement litigation in district court.

(I)

RULE 29.6 STATEMENT

Cross-petitioner Cytoc Surgical Products, LLC is a wholly owned subsidiary of cross-petitioner Hologic, Inc. The Vanguard Group, Inc. and T. Rowe Price Associates, Inc. each own more than ten percent of the stock of cross-petitioner Hologic, Inc.

(II)

RELATED PROCEEDINGS

This case is directly related to *Minerva Surgical, Inc. v. Hologic, Inc. et al.*, No. 20-440 (pet'n for cert. filed Sept. 30, 2020). Other proceedings that are not directly related to this case but involve the same parties are:

Minerva Surgical, Inc. v. Hologic, Inc. et al., No. 1:18-cv-00217-JFB-SRF (D. Del.);

Hologic, Inc. et al. v. Minerva Surgical, Inc., No. 1:20-cv-00925-JFB-SRF (D. Del.).

(III)

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(IV)

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