No. 20-440

In The
Supreme Court of the United States

MINERVA SURGICAL, INC.,

Petitioner,

v.

HOLOGIC, INC., CYTYC SURGICAL PRODUCTS, LLC,

Respondents.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

BRIEF OF ENGINE ADVOCACY AS *AMICUS CURIAE* IN SUPPORT OF PETITIONER

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INTERESTS OF *AMICUS CURIAE*[1]

Amicus curiae Engine Advocacy ("Engine") is a non-profit technology policy, research, and advocacy organization that bridges the gap between policymakers and startups. Engine works with government representatives and a community of high-technology, growth-oriented startups across the nation to support the development of technology entrepreneurship. Engine conducts research, organizes events, and spearheads campaigns to educate elected officials, the entrepreneur community, and the general public on issues vital to fostering technological innovation.

Engine writes to share the perspective of nascent technology companies regarding the Federal Circuit's broad application of assignor estoppel to shield low-quality patents (*e.g.*, patents that are vague, overbroad, claim what is known in prior art, or otherwise cover inventions that ought not be considered patentable) from scrutiny. Specifically, Engine submits this brief to highlight the harm to innovation, entrepreneurship, and healthy employee mobility that results from the

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[1] Pursuant to Supreme Court Rule 37, counsel for *amicus curiae* represent that they authored this brief in its entirety and that none of the parties or their counsel, nor any other person or entity other than *amici* or their counsel, made a monetary contribution intended to fund the preparation or submission of this brief. Counsel for petitioner gave blanket consent to the filing of *amicus* briefs, counsel for respondents has consented to *amicus curiae*'s request for consent to the filing of this brief, and both parties received timely notice of *amicus curiae*'s intent to file this brief.

appellate court's expansive approach to this patent-specific, judge-made doctrine.

The doctrine of assignor estoppel, by design, limits the courses of action one may take when seeking to challenge low-quality patents. Such patents are often the bane of a startup's existence, to the extent that they frequently stand in the way of innovation. For that reason alone, if it has any proper place in the law, assignor estoppel should be very narrowly-tailored.

In the case at hand, the Federal Circuit moved in the opposite direction—expanding the doctrine and thus reducing opportunities for startups and their high-skilled employees to pursue disruptive new technologies. The case represents just the latest effort to broaden this doctrine, without basis in law, and is directly contrary to the core purpose of the patent system (which exists to incentivize, not stifle, innovation). The case cries out for this Court's review, and Engine therefore respectfully urges this Court to grant the petition for certiorari.

SUMMARY OF ARGUMENT

The judge-made doctrine of assignor estoppel is limited by Supreme Court precedent, and in keeping with pro-innovation law and policy both circuit and district courts eliminated the doctrine before the formation of the Federal Circuit. But assignor estoppel has strayed far from its origins and modern technology

companies and employment practices have undermined assignor estoppel's original principles. No longer a protection against bad faith assignments, assignor estoppel has morphed into a powerful tool to preserve invalid patents from scrutiny.

The many harmful effects of the doctrine are felt especially acutely by startups. Startup founders and employees can be haunted by low-quality patents wielded in anti-competitive ways. Indeed, assignor estoppel is most often raised in cases against newer companies that employ the patent-assignee's former staff. The doctrine leaves those companies with few options for a defense, which is detrimental in cases where low-quality patents are asserted. This problem also trickles down to reduce employee mobility and restrict productive business arrangements.

Because this judge-made doctrine hurts innovation and competition, all in the name of protecting low-quality patents, assignor estoppel deserves a second look from this Court.

ARGUMENT

I. Assignor estoppel is in direct conflict with pro-innovation law and policy, which favors enforcement only of valid patents, and the doctrine must therefore be sharply limited.

Assignor estoppel prevents the assignor of a patent from challenging the validity of that patent.

Westinghouse Elec. & Mfg. Co. v. Formica Insulation Co., 266 U.S. 342, 349, 45 S. Ct. 117, 119, 69 L. Ed. 318 (1924). The doctrine arose as a method of preventing bad faith transactions and the assignment of patents that sellers believe are without value. *See Scott Paper Co. v. Marcalus Mfg. Co.*, 326 U.S. 249, 251, 66 S. Ct. 101, 102, 90 L. Ed. 47 (1945).

Although the doctrine came about as a method of preventing gamesmanship, it has evolved into a tool that enables low-quality patents to hinder innovation and entrepreneurship when there is no bad faith and when none of the hallmarks of assignor conduct that prompted the doctrine are present. It now extends far beyond its original purpose and stands as a purely judge-made doctrine that stifles innovation, contradicts the plain text of the Patent Act, and undermines this Court's and Congress's emphasis on the need to enable challenges to low-quality patents. There is no indication that the legislature intended for the courts to create such a harsh limitation on innovation and competitive markets. Indeed, assignor estoppel finds no support in the U.S. patent statute which, instead, establishes invalidity as a defense for "any action" involving the infringement of a patent. 35 U.S.C. § 282(b). The expansive doctrine of assignor estoppel created by the Federal Circuit is not just textually groundless; it erodes patent law values. Lara J. Hodgson, *Assignor Estoppel: Fairness at What Price*, 20 Santa Clara High Tech. L.J. 797, 807-08 (2004).

In evaluating patent law, this Court has consistently "emphasiz[ed] the necessity of protecting our

competitive economy by keeping open the way for interested persons to challenge the validity of patents which might be shown to be invalid." *Edward Katzinger Co. v. Chi. Metallic Mfg. Co.*, 329 U.S. 394, 400-01 (1947). This consideration motivated the Court to narrow assignor estoppel before the creation of the Federal Circuit, trying to safeguard against the doctrine's being used to "recapture" material rightly in the public domain. *Scott Paper*, 326 U.S. at 256-57; *see also*, *e.g.*, Lara J. Hodgson, *Assignor Estoppel: Fairness at What Price*, 20 Santa Clara High Tech. L.J. 797, 808 (2004).

Invalidity challenges empower innovators to continue expanding their technological contributions, free from interference by those who own improvidently-granted patents. These challenges not only free active innovators to create further economic opportunities and jobs but also enhance the public interest by eliminating low-quality patents. In accordance with this compelling interest, this Court has, at every opportunity, "remov[ed] . . . restrictions on those who would challenge the validity of patents." *Blonder-Tongue Labs., Inc. v. Univ. of Ill. Found.*, 402 U.S. 313, 344-45 & n.42 (1971) (collecting cases); *see also Kimble v. Marvel Entm't, LLC*, 135 S. Ct. 2401, 2407 (2015).

In that vein, this Court correctly rejected the notion of licensee estoppel—which barred a licensee from challenging a patent's invalidity—more than fifty years ago. *Lear, Inc. v. Adkins*, 395 U.S. 653 (1969). Before the creation of the Federal Circuit, circuit courts and numerous district courts determined that this

Court overruled assignor estoppel in *Lear*. *See Coastal Dynamics Corp. v. Symbolic Displays, Inc.*, 469 F.2d 79, 79 (9th Cir. 1972) (per curiam); *see*, *e.g.*, *Interconnect Planning Corp. v. Feil*, 543 F. Supp. 610, 613 (S.D.N.Y. 1982); *Marvacon Indus., Inc. v. Thermacon Indus., Inc.*, No. 79/1121, 1980 WL 30274, at *4-5 (D.N.J. May 28, 1980). This case law evinces a long history of the Court fostering challenges to low-quality patents consistent with the constitutional underpinnings of "promot[ing] the Progress of Science and useful Arts." U.S. Const. art. I, § 8, cl. 8.

The notion that assignor estoppel should apply, if at all, only in the narrowest possible range of cases is also consistent with both the plain text of the Patent Act and the intent of Congress to protect invalidity challenges. *See* 35 U.S.C. § 282(b). Indeed, Congress created *inter partes* review ("IPR") to "protect the public's paramount interest in seeing that patent monopolies are kept within their legitimate scope." *See Arista Networks, Inc. v. Cisco Sys., Inc.*, 908 F.3d 792, 804 (Fed. Cir. 2018) (citations/quotations omitted). The Federal Circuit looked to both the language and policy underpinning IPR in deciding that assignor estoppel has no place in that forum. *Id.* at 803-04.

As Judge Stoll wrote in this case, the Federal Circuit's approach to assignor estoppel is now at odds with itself. Pet. App. 31a–32a. "Our precedent thus presents an odd situation where an assignor can circumvent the doctrine of assignor estoppel by attacking the validity of a patent claim in the United States Patent and Trademark Office, but cannot do the same in district

court." *Id.* Against this backdrop, the instant case presents a timely opportunity to revisit assignor estoppel altogether, to assess whether it still has any place in the law, or at least help align the doctrine with this Court's precedent and the text and purpose of the Patent Act.

II. Assignor estoppel directly conflicts with innovation at large, and with especially damaging effects to startups.

The key practical problem inherent in the application of assignor estoppel is that it limits the ability of parties with significant relevant technical knowledge about the subject matter of a given low-quality patent to challenge that patent's validity. Low-quality patents create unjustified (and unjustifiable) barriers for innovative startups. The availability of assignor estoppel provides anti-innovation protections to those who own low-quality patents and enables the ongoing assertion of such patents against new market entrants. The effects of this doctrine permeate every level of the startup ecosystem, limiting employee mobility and discouraging productive business activity. *See*, *e.g.*, Robert L. Harmon, *Seven New Rules of Thumb: How the Federal Circuit Has Changed the Way Patent Lawyers Advise Clients*, 14 Geo. Mason U. L. Rev. 573, 579 (1992) (for "high-tech spinoffs and startups, many involving a gifted inventor, the resurrection of assignor estoppel by the Federal Circuit is certain to have significant consequences").

a. Assignor estoppel protects invalid patents in a way that is uniquely harmful to startups.

This Court has repeatedly recognized that invalid patents prevent fair competition in the market and hamper innovation. *Supra*, part I. Furthermore, "both [the Federal Circuit] and the Supreme Court have recognized that there is a significant public policy interest in removing invalid patents from the public arena." *SmithKline Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1354 (Fed. Cir. 2005). Accordingly, the ability to challenge the validity of a patent is a vital safeguard provided to defendants in infringement suits.

For startups, the harm caused by invalid patents is particularly acute, and the ability to challenge low-quality patents is especially important. Startups, operating on thin margins, are very sensitive to accusations of infringement, but such assertions are "particularly problematic when the underlying patent being wielded against the startup is more likely than not invalid." *See*, *e.g.*, Stuart J.H. Graham *et al.*, *High Technology Entrepreneurs and the Patent System: Results of the 2008 Berkeley Patent Survey*, 24 Berkeley Tech. L.J. 1255, 1315 (2009). Such abusive assertions can drain the resources of a nascent company. *See*, *e.g.*, Colleen V. Chien, *Of Trolls, Davids, Goliaths, and Kings: Narratives and Evidence in the Litigation of High-Tech Patents*, 87 N.C. L. Rev. 1571, 1587-89 (2009) (describing "strategic use of patent litigation by established companies to impose distress on their financially disadvantaged rivals"). Even a meritless lawsuit can force an

early-stage startup to face needless crises—for example substantially damaging its credit, valuation, or relationships with customers and investors; at worst, some startups facing litigation will have to close up shop. *See*, *e.g.*, *id.*[2] Those risks are wholly unjustified in cases built around invalid patents.

In spite of the integral role that validity challenges play in the market, assignor estoppel makes it harder to weed out low-quality patents that stand in the way of innovation. Mark A. Lemley, *Rethinking Assignor Estoppel*, 54 Hous. L. Rev. 513, 534-37 (2016). Indeed, assignor estoppel often serves to protect patents most likely to be asserted against disruptive, innovative new companies. It is a familiar scenario when an established high-technology company files a patent suit against a small startup founded by its former employees. *See*, *e.g.*, Alexander E. Silverman, *Intellectual Property Law and the Venture Capital Process*, 5 High Tech. L.J. 157, 158 (1990). This is a common scenario

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[2] Examples of the startup experience shed further light on how low-quality patents can slow or stall nascent companies. *E.g.*, Ethan Rothstein, *Arlington Startups Founder Testifies Before Congress About Patent Trolls*, ARL Now (Mar. 27, 2015), https://www.arlnow.com/2015/03/27/arlington-startup-founder-testifies-before-congress/ (referring to "college students developing a product in a startup incubator who were threatened with a lawsuit" and "folded their company because they couldn't even pay the licensing fee" requested to avoid the lawsuit); *Startups Need Comprehensive Patent Reform Now*, Engine 7-14, *available at* http://static1.squarespace.com/static/571681753c44d835a440c8b5/57323e0ad9fd5607a3d9f66b/57323e14d9fd5607a3d9faec/1462910484459/Startup-Patent-Troll-Stories1.d.pdf?format=original (summarizing experience of several startups).

in assignor estoppel cases. *See*, *e.g.*, *Battle-ABC, LLC v. Soldier Sports, LLC*, 401 F. Supp. 3d 873 (D. Neb. 2019); *Brilliant Instruments, Inc. v. GuideTech, Inc.*, No. C 09-5517 CW, 2014 WL 516244 (N.D. Cal. Feb. 12, 2014); *Juniper Networks Inc. v. Palo Alto Networks, Inc.*, 15 F. Supp. 3d 499 (D. Del. 2014); *L-3 Commc'ns Corp. v. Jaxon Engineering & Maintenance, Inc.*, 69 F. Supp. 3d 1136 (D. Colo. 2014); *Saint-Gobain Performance Plastics Corp., HCM Div. v. Truseal USA, Inc.*, 351 F. Supp. 2d 290 (D.N.J. 2005); *Hexcel Corp. v. Advanced Textiles, Inc.*, 716 F. Supp. 974 (W.D. Tex. 1989), aff'd, 960 F.2d 155 (Fed. Cir. 1992); *Carroll Touch, Inc. v. Electro Mechanical Syst., Inc.*, 15 F.3d 1573 (Fed. Cir. 1993) (cases in which assignor's previous employer sues assignor's new company and uses assignor estoppel to try to prevent invalidity challenges).

Assignor estoppel's far-reaching effects are especially damaging to startups due to the disparity between resources available to startups and those available to well-established competitors. Because startups have limited resources, plaintiffs can use the fact of a patent lawsuit for other, potentially anticompetitive, purposes, well beyond the scope of reasonable intellectual property enforcement. *See*, *e.g.*, Alexander E. Silverman, *Intellectual Property Law and the Venture Capital Process*, 5 High Tech. L.J. 157, 159 (1990) (noting that "a former employer's intellectual property suit against a start-up is often motivated by concerns other than safeguarding intellectual property," including for example anger, injured feelings, or a desire to prevent a startup from hiring away engineers); *see also*, *e.g.*,

Ted Sichelman, *The Vonage Trilogy: A Case Study in "Patent Bullying*," 90 Notre Dame L. Rev. 543 (2014) (describing how "incumbents [are] able to exploit defects in the patent system in order to prevent disruptive technologies from competing with their outmoded products and services"). As this Court has recognized, even if a "patent is ultimately held invalid, patent holders may be able to use it to threaten litigation and bully competitors, especially those that cannot bear the cost of litigation." *Bilski v. Kappos*, 561 U.S. 593, 656, 130 S. Ct. 3218, 3257 (2010).

Assignor estoppel increases costs and risks that startups face in litigation, because it removes the option of a validity defense. In the types of meritless cases startups often face, that too often forces companies to pursue alternative, costly defenses or pay damages, settlements, or license fees over invalid patents that should not have issued. While the doctrine was initially used to address cases of bad-faith assignments, the doctrine—in its current, expanded form—extends far beyond those limited bad-faith cases and does significantly more harm than good.

b. Assignor estoppel restricts healthy employee mobility without justification.

Not only do low-quality patents create disincentives for innovation, the association of an inventor-employee's previous work with an arguably invalid patent creates barriers to that employee's mobility in the labor force. Because that employee and any companies

she founds or works at could be sued for infringement without a means to challenge validity, many employers and partners may understandably shy away.

Employees are routinely expected to assign their patents as a condition of employment. *See* Mark A. Lemley, *Rethinking Assignor Estoppel*, 54 Hous. L. Rev. 513, 525-26 (2016); Steven Cherensky, *A Penny for Their Thoughts: Employee-Inventors, Preinvention Assignment Agreements, Property, and Personhood*, 81 Cal. L. Rev. 595, 617 (1993). Particularly in technology industries, standard employment agreements include stock language for assignment of current and future inventions. Mark A. Lemley, *Rethinking Assignor Estoppel*, 54 Hous. L. Rev. 513, 525-26 (2016). Likewise, many employees have little say about the actual language in a patent, as employers frequently work with counsel to draft patents. *See id.* These facts contradict the fundamental premise of assignor estoppel, because it is impossible for an employee to assess the validity of an invention that has not yet been contemplated and to patent claims that have not yet been drafted. *See*, *e.g.*, Franklin D. Ubell, Assignor Estoppel: A Wrong Turn from Lear, 71 J. Pat. & Trademark Off. Soc'y 26, 30 (1989) (noting that the court in *Diamond Sci Co.* "fails to consider that the employer has made his own informed decision to seek a patent and understands that it would be ridiculous to presume the inventor could warrant the existence of patent rights in any development") (citing *Diamond Sci. Co. v. Ambico, Inc.*, 848 F.2d 1220 (Fed. Cir. 1988) (holding that assignor estoppel applies even when language of the claims is

amended after assignment)). In these routine employer-employee relationships, the assignee simply does not need the kinds of protections against assignors acting in bad faith that the doctrine was originally intended to address.

With this context, it also becomes apparent how assignor estoppel obstructs healthy employee mobility within an industry. Employee-inventors who have assigned rights in this perfunctory way face situations where current (or former) employers can effectively prohibit them from branching off and practicing in the same field. If an employee's previous work is (or can be) embodied in a low-quality patent, that creates a serious threat that her previous work will fuel meritless lawsuits where invalidity issues cannot be asserted in defense. Lara J. Hodgson, *Assignor Estoppel: Fairness at What Price?*, 20 Santa Clara Computer & High Tech. L.J. 797, 825 (2004). Because invalidity defenses are not available, the costs and risks associated with such litigation—and hiring such employee-inventors—may rise to levels that some new market entrants cannot bear.

In effect, assignor estoppel can operate like a twenty-year partial non-compete agreement that encompasses all of an employee's efforts that eventually lead to a patent. Mark. A. Lemley, *Rethinking Assignor Estoppel*, 54 Hous. L. Rev. 513, 537 (2016). But non-compete agreements are generally disfavored under

the law[3]—and with good reason, because they often stifle innovation, restrain trade, and restrict employee livelihoods.[4] Non-compete agreements can block competition by limiting access to skilled, qualified talent. And, startups are hit particularly hard by the negative influence of non-compete agreements in the tech sector. *See*, *e.g.*, Evan Starr, *The Use, Abuse, and Enforceability of Non-Compete and No-Poach Agreements: A Brief*

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[3] *See*, *e.g.*, *Int'l Bus. Machines Corp. v. Johnson*, 629 F. Supp. 2d 321, 337 (S.D.N.Y.), aff'd, 355 F. App'x 454 (2d Cir. 2009) (describing New York's public policy strongly disfavoring non-competition covenants, which militate against sanctioning the loss of an employee's livelihood); *Omniplex World Servs. Corp. v. U.S. Investigations Servs., Inc.*, 618 S.E.2d 340, 342 (2005) (non-competition agreements are "disfavored restraints on trade"); *JAK Prods., Inc. v. Wiza*, 986 F.2d 1080, 1085 (7th Cir. 1993) ("Indiana disfavors covenants not to compete."); *Benfield, Inc. v. Moline*, 351 F. Supp. 2d 911, 917 (D. Minn. 2004) (Minnesota "courts look upon non-competition agreements with disfavor and scrutinize them carefully because they are agreements in partial restraint of trade").

[4] For example, California law has historically disfavored non-competes. *Edwards v. Arthur Andersen LLP*, 44 Cal. 4th 937, 945, 189 P.3d 285, 290 (2008) (in California, pursuant to statute, "covenants not to compete are void, subject to several exceptions") (citing Cal. Bus. & Prof. Code § 16600). Scholars credit this as part of Silicon Valley's success. *See*, *e.g.*, Ronald J. Gilson, *The Legal Infrastructure of High Technology Industrial Districts: Silicon Valley, Route 128, and Covenants Not to Compete*, 74 N.Y.U. L. Rev. 575 (1999) ("Because California does not enforce post-employment covenants not to compete, high technology firms in Silicon Valley gain from knowledge spillovers between firms. These knowledge spillovers have allowed Silicon Valley firms to thrive. . . ."); Timothy B. Lee, *A Little-Known California Law is Silicon Valley's Secret Weapon*, Vox (Feb. 13, 2017), https://www.vox.com/new-money/2017/2/13/14580874/google-self-driving-noncompetes.

Review of the Theory, Evidence, and Recent Reform Efforts, Economic Innovation Group 8-12 (2019), *available at* https://eig.org/wp-content/uploads/2019/02/Non-Competes-2.20.19.pdf (addressing how non-competes restrict new firm development, hiring, and survival). Even in states that allow non-compete agreements, those agreements must be reasonable and narrowly-tailored in scope, geography, and duration to achieve a legitimate purpose.[5] The effect of assignor estoppel, a sort of twenty-year non-compete without geographic limitation, fails to satisfy those thresholds.

For the same reasons that non-compete agreements run counter to innovation, the doctrine of assignor estoppel prevents employee mobility in ways that impede technologists in every field from taking opportunities within an industry to work with new collaborators, create disruptive business models, or launch innovative small firms. Because the doctrine of assignor estoppel often has a similar or more expansive effect than non-competes, and this Court should thus take the opportunity to limit or eliminate the doctrine.

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[5] *Zimmer US Inc. v. Mire*, 188 F. Supp. 3d 843, 846 (N.D. Ind. 2016) ("Covenants must be reasonable with respect to the legitimate interests of the employer, restrictions on the employee, and the public interest."); *Seneca One Fin., Inc. v. Bloshuk*, 214 F. Supp. 3d 457, 461 (D. Md. 2016) (finding non-compete "facially overbroad and unenforceable"); *TransPerfect Translations, Inc. v. Leslie*, 594 F. Supp. 2d 742, 755 (S.D. Tex. 2009) (reforming a non-compete that was "extremely broad" and "unreasonable in scope").

c. The expansion of assignor estoppel infects other productive business activity in the startup ecosystem.

Beyond employee mobility, the current expansive notion of assignor estoppel developed and applied by the Federal Circuit can infect and disincentivize other productive business relationships. Because the Federal Circuit's decision in this case takes a generous view of privity, individual assignors and the companies they lead are not the only ones who face the risk of assignor estoppel.

Startups depend on investors, often rely on joint ventures or collaborations for research and development and market entry, and look to mergers and acquisitions for growth and exit opportunities. Due to assignor estoppel, those other entities face the risk of losing the ability to assert a viable invalidity defense when patents are asserted directly against them. *Cf.* Robin Feldman, *Patent Demands & Startup Companies: The View from the Venture Capital Community*, 16 Yale L. J. 236 (2014). Due to the broad reach of the doctrine, the burden of an employee's low-quality patents can travel with her and reach all those with whom she associates throughout the startup ecosystem.

The Federal Circuit has expanded the application of assignor estoppel in a series of cases applying it to an inventor's privies. Defining privity very broadly, the Federal Circuit has continued to gradually expand the doctrine by first applying the doctrine to assignor-founded companies. *See Diamond Sci. Co. v. Ambico,*

Inc., 848 F.2d 1220 (Fed. Cir. 1988). The court then applied it the assignor's new employers. *Shamrock Techs., Inc. v. Med. Sterilization, Inc.*, 903 F.2d 789, 794 (Fed. Cir. 1990). The court went even further, expanding privity to include, for example, subsidiaries purchased after assignment, minority shareholders, and joint venture partners. *See Mentor Graphics Corp. v. Quickturn Design Sys., Inc.*, 150 F.3d 1374 (Fed. Cir. 1998); *Intel Corp. v. U.S. Int'l Trade Comm'n*, 946 F.2d 821 (Fed. Cir. 1991).

The court has continued to broadly define privity with no end in sight, applying this problematic doctrine to parties far removed from the original assignment. Indeed, the Federal Circuit has never found a defendant not to be in privity, seemingly binding business partners to assignor estoppel whenever the argument is raised. Mark A. Lemley, *Rethinking Assignor Estoppel*, 54 Hous. L. Rev. 513, 520-21 (2016). Thus, employee-inventors can quickly become liabilities within their industries, and assignor estoppel engenders disincentives with wide-reaching consequences for companies that partner with or invest in startups.

A similar but distinct concern arises as the Federal Circuit has expanded assignor estoppel in a way that could allow companies to effectively purchase invalidity-proof patents. For example, in the case currently before the Court, the patents-in-suit were originally assigned to one company which was then acquired twice before it came to belong to respondent. *Hologic, Inc. v. Minerva Surgical, Inc.*, 957 F.3d 1256,

1262 (Fed. Cir. 2020). That means the original assignor was held to be estopped from challenging the validity of a patent that was acquired multiple times since it was assigned. An assignor may be rendered defenseless not only against attacks from the original assignee, but also from companies that merge with or acquire that assignee. This creates ways for companies to purchase patents that are effectively shielded from invalidity challenges. *See Mentor Graphics Corp. v. Quickturn Design Sys.*, 150 F.3d 1374 (Fed. Cir. 1998) (holding that assignor estoppel also applies to entities acquired by assignor after the assignment of the patent). Larger firms typically have more of the resources required to drive litigation, and assignor estoppel provides such companies a weapon to offensively scoop up assets to attack smaller competitors and leave those smaller companies defenseless in infringement actions.

The ability for companies to weaponize a judge-made doctrine to protect invalid patents from scrutiny comes at the detriment of both competitors and the public good. *See supra, Part II(a).* Assignor estoppel effectively deters innovation, improperly restricts inventors, and contradicts the text of the Patent Act and the constitutional purpose of patents.

CONCLUSION

For the foregoing reasons, *amicus curiae* Engine Advocacy respectfully requests that this Court grant certiorari in this case.

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