

Nos. 19-2054, 19-2081

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

HOLOGIC, INC. AND CYTYC SURGICAL PRODUCTS, LLC,
Plaintiffs-Appellants,

v.

MINERVA SURGICAL, INC.,
Defendant-Cross-Appellant.

Appeal from the United States District Court
for the District of Delaware, No. 1:15-cv-01031

**MINERVA SURGICAL, INC.'S PETITION
FOR REHEARING *EN BANC***

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Sept. 9, 2022

CERTIFICATE OF INTEREST

Counsel for Cross-Appellant Minerva Surgical, Inc. certifies:

1. The full name of every party represented by me is:

Minerva Surgical, Inc.
2. The name of the real party in interest represented by me is:

Minerva Surgical, Inc.
3. All parent corporations and any publicly held companies that own 10 percent or more of the stock in the party represented by me are:

None.
4. The names of all law firms, and the partners or associates, that appeared for the party represented by me in the trial court or are expected to appear in this Court and who are not already listed on the docket for the current case are:

Greenberg Traurig LLP: Benjamin J. Schladweiler.

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5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal are:

Hologic Inc. v. Minerva Surgical, Inc., C.A. No. 20-925-JFB-SRF (D. Del.)

Sept. 9, 2022

/s/ Robert N. Hochman
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RULE 35(b) STATEMENT

Based on my professional judgment, I believe the Panel decision is contrary to the following decisions of the Supreme Court and the precedents of this Court: *Minerva Surgical, Inc. v. Hologic, Inc.*, 141 S. Ct. 2298 (2021).

This appeal also requires an answer to the following precedent-setting question of exceptional importance: For purposes of determining whether assignor estoppel applies, how should a court determine an inventor's representation of patent scope in a never-issued claim in the original patent application?

/s/ Robert N. Hochman
ROBERT N. HOCHMAN
Counsel for Cross-Appellant

INTRODUCTION

This case, remanded from the Supreme Court, is the first opportunity for this Court to apply the Supreme Court’s significantly narrowed assignor estoppel doctrine. The Supreme Court concluded that this Court “ha[d] applied the doctrine too expansively.” *Minerva Surgical, Inc. v. Hologic, Inc.*, 141 S. Ct. 2298, 2307 (2021). The Panel’s decision fails to faithfully apply the Supreme Court’s standard and, if allowed to stand, will restore assignor estoppel to its prior overly broad status, unmoored from its rationale.

The Supreme Court was explicit. Assignor estoppel’s scope must be bounded by its “equitable basis.” *Id.* at 2311. It can “appl[y] only when an inventor says one thing (explicitly or implicitly) in assigning a patent and the opposite in litigating against the patent’s owner.” *Id.* at 2304; *id.* at 2310 (assignor estoppel should “go only so far as, and not beyond, what [an assignor] represented in assigning the patent application”). The Supreme Court remanded for this Court to consider whether Minerva’s “claim of invalidity contradicts explicit or implicit representations [the inventor] made in assigning the patent.” *Id.* at 2302. The limitation on assignor estoppel is defined by representations

the assignor can fairly be said to have made: no inconsistent representation, “no estoppel.” *Id.* at 2310.

On remand, the Panel ignored this command and effectively restored assignor estoppel to its overly expansive scope. In this case, the relevant scope of the assigned invention concerns moisture permeability. Unless the assignor represented that he had invented a device with a moisture *impermeable* applicator head, there must be, under the Supreme Court’s rule, no estoppel. The Panel purported to find such a representation only by disregarding the inventor’s numerous, unqualified statements limiting the invention to one that used only moisture permeable material.

The Panel did not, because it could not, point to any statement even suggesting that the invention could work with moisture impermeable material. The Panel refused to give *any* weight to the title, abstract, and summary of invention—the portions of the specification that best represent the inventor’s intended scope—all of which expressly limit the invention to moisture permeable material. Instead, the Panel relied on a single, never-issued application claim that says

nothing about moisture permeability, and read silence on the subject as a representation of comprehensive scope. Panel Op. 14-16.

By allowing that single claim's silence about permeability to negate the numerous and consistent representations in the specification that the material must be moisture permeable, the Panel frustrated the Supreme Court's ruling and the critical gate-keeping role the Supreme Court has given to lower courts. *Minerva Surgical*, 141 S. Ct. at 2308 (assignor estoppel is a "bounded doctrine" with "limits" which courts must guard). At argument, at least one member of the Panel was openly hostile to the Supreme Court's ruling; to him, the Court had laid "a trap for the unwary" assignee who will, in his view, unfairly face challenges to the assigned invention's validity. (1/27/2022 Oral Arg. 16:25.) In truth, the Supreme Court has done the opposite. It released assignors from a trap the expansive version of assignor estoppel had laid. Until the Supreme Court's decision, assignor estoppel kept assignors from competing with their assignees when their assignees *expanded* the assignor's old inventions to frustrate competition from new devices. The Panel has reset the trap for inventors/assignors by treating one instance

of silence by the inventor as a representation that his invention covered what he otherwise expressly excluded throughout the patent.

Without doubt, this first decision applying what is supposed to be the narrowed form of assignor estoppel will be closely watched by trial courts. The Panel's decision is important. Because the Panel ignored clear and extensive descriptions of the invention's narrow scope, in favor of the broadest arguable construction of a single never-issued claim, lower courts will be reinstructed to apply the doctrine broadly and will fail in the duty the Supreme Court set for them. The full Court's consideration is warranted to constrain assignor estoppel within its equitable bounds.

BACKGROUND

A. The '072 Patent Application

In the 1990s, Csaba Truckai invented a medical device for improving the efficacy of endometrial ablation treatments. That device “uses an applicator head [which] is ‘moisture permeable,’ meaning that it conducts fluid out of the uterine cavity during treatment.” *Minerva Surgical*, 141 S. Ct. at 2303. The application—U.S. Patent Application No. 09/103,072 (the '072 application)—was titled “A Moisture Transport

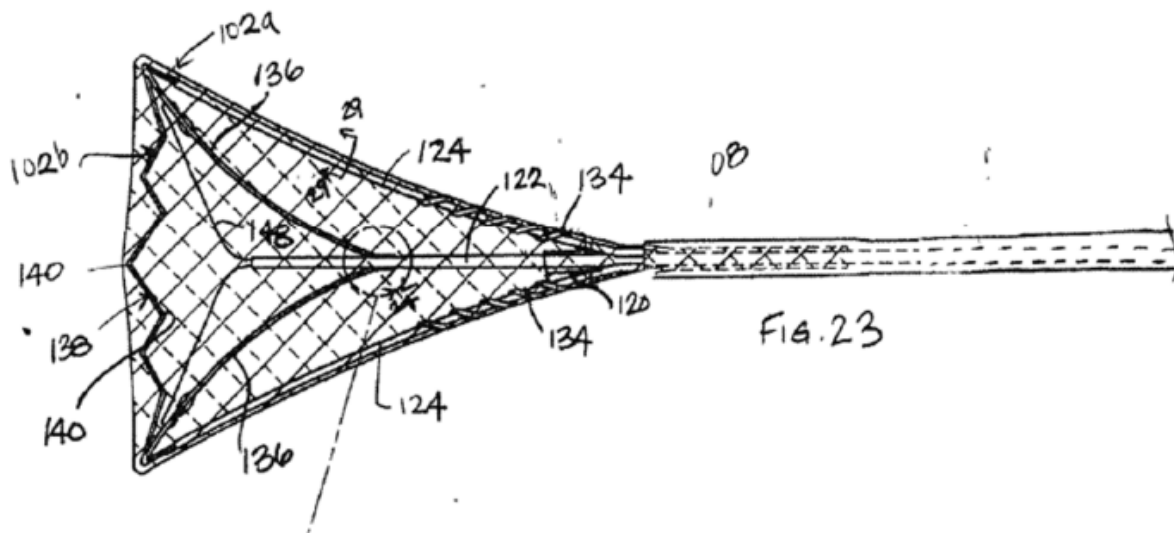
System for Contact Electrocoagulation.” Appx40293. The invention “eliminates the ... problem of steam and liquid buildup at the ablation site.” Appx40318(4:1-3).¹ The application discussed devices impermeable to moisture only to disparage them. Appx40316(2:20-22); Appx40338(23:3-9).

The application uniformly described a component of the invention called the “electrode array” and the “electrode carrying means” on which the array is mounted as moisture permeable. The abstract says the invention “includes” an “electrode array which is substantially absorbent and/or permeable to moisture” and that the “permeability and/or absorbency of the electrode carrying member allows the moisture to leave.” Appx40363. The summary of the invention explains that “[t]he electrode array includes a fluid permeable elastic member” and that “moisture generated during dehydration is actively or passively drawn into the array and away from the tissue.” Appx40318. The description explains that “suction may be applied” causing “water vapor

¹ See also Appx40317(3:3 4:3); Appx40318(4:11-18); Appx40326(12:3-15); Appx40331-32(17:22-18:5); Appx40338(24:4-9, 24:11-18); Appx40343(29:7-10); Appx40356 (42:3-8).

within the uterine cavity to pass through the permeable electrode carrying means.” Appx40331-40332(17:26-18:3).

The figures consistently depict the “electrode array” as permeable.



See Appx40305 (Fig. 23); see also Appx40340(26:13-20) (explaining that “[a]pplicator head 102 includes an external electrode array 102a ... the array 102a ... is formed of a stretchable metallized fabric mesh.”).

The invention’s two embodiments have permeable electrode arrays. The first has “an array of electrodes formed on the surface of [an] electrode carrying means.” It is preferably made of a “non-conductive” material but is necessarily “permeable to moisture” like “cell sponge, foam, cotton, fabric, or cotton-like material.” Alternately it can be composed of a conductive, but still permeable, “metallized fabric.” Appx40326(12:3-11). In the second, the “array” is “formed of a

stretchable metallized fabric mesh” such as a “knit” of yarns.

Appx40340(26:19-25). At no time does the application describe any way for the invention to work with a moisture *impermeable* material, because it cannot.

Truckai assigned the patents he obtained from that specification along with the right to continuation patents, and Hologic ultimately acquired them. *Minerva Surgical*, 141 S. Ct. at 2303.

B. The '348 Patent

“Not through with inventing,” Truckai in the 2000s invented a “new device, relying on a different way to avoid unwanted ablation, [that] is ‘moisture impermeable’: It does not remove any fluid during treatment.” *Id.* It does not have an “electrode array.” Its applicator head has a “fluid-tight,” “sealed silicone membrane” filled with argon gas. Appx12825. An internal electrode ionizes the gas, turning it into plasma, which creates heat for ablation. Appx12825-12826. Thanks to unique characteristics of the plasma-based heat, the new device, unlike the old, *benefits* from moisture trapped at the ablation site.

In fall 2012, Hologic and Minerva signed a non-disclosure agreement after Hologic expressed interested in acquiring Minerva.

Minerva demonstrated Truckai's new invention to Hologic engineering staff. In 2013, Hologic filed the application for U.S. Patent No. 9,095,348 (the '348 patent). "Aware of Truckai's activities, Hologic drafted one of [its] claims [claim 1] to encompass applicator heads generally, without regard to whether they are moisture permeable." *Minerva Surgical*, 141 S. Ct. at 2303. Notably, Hologic did not simply re-assert any prior claims asserted in, but never issued from, Truckai's old application. Instead, Hologic drafted its own new claim. Claim 1 did not require an "electrode array." It claimed an "applicator head" with "one or more electrodes." Appx169(19:14-19:21).

This was the first time a claim issued based on Truckai's assigned specification for a device that had an "applicator head" that was not expressly limited to moisture permeable material. What Hologic did is akin to an assignee of an internal combustion engine patent, years later, obtaining and asserting a new patent claim that purports to cover *any* engine in order to prevent competition from an electric vehicle.

C. Procedural History

Hologic sued Minerva for infringement of the new patent. Minerva alternatively argued that the "applicator head" in claim 1 should be

construed as requiring moisture-permeability, and that, if it were construed to cover moisture impermeable materials, then it was invalid because Truckai's old specification failed to disclose how a "moisture transport" invention could work with such a material.

1. 2020 Panel Opinion

The Panel construed claim 1 to cover "moisture impermeable devices." Panel Op. 12. The Panel concluded that "neither the plain claim language 'applicator head' nor the specification includes a moisture removal requirement *in the applicator head*." Op. at 19-20 (Apr. 22, 2020), ECF No. 56. The Panel noted that "an embodiment of the invention includes an 'electrode carrying means' formed of a material that is 'permeable to moisture,' but" concluded "this appears to be a component of the ablation device *other than* the claimed 'applicator head.'" *Id.* at 20 (emphasis added). Hologic had argued that the "electrode array' isn't the term that's being construed. The term in the claim is 'applicator head.' ... '[E]lectrode array' ... is a different thing, is a different part." (12/4/19 Oral Arg. 24:54-26:12.)

The Panel also decided that assignor estoppel barred Minerva's invalidity defense. According to the Panel, it was "irrelevant" that

Hologic “may have later amended the claims’ without the inventor’s input.” *Minerva Surgical*, 141 S. Ct. at 2304.

2. Supreme Court Opinion

The Supreme Court concluded that this Court had “applied the doctrine [of assignor estoppel] too expansively.” *Id.* at 2307. Assignor estoppel’s scope must be bounded by its “equitable basis.” *Id.* at 2311. Thus, “when the assignor has made neither explicit nor implicit representations in conflict with an invalidity defense” asserted in litigation, “there is no unfairness in its assertion” and “no ground for applying assignor estoppel.” *Id.* at 2310.

In particular, an invalidity claim does not conflict with any prior representation when there is a post-assignment “change in patent claims” which “enlarge[s] the patent’s claims.” *Id.* When an assignee obtains a claim that goes “beyond what the assignor intended to claim as patentable,” assignor estoppel does not attach. *Id.* (cleaned up). As the Supreme Court held:

Assuming that the new claims are materially broader than the old claims, the assignor did not warrant to the new claims’ validity. And if he made no such representation, then he can challenge the new claims in litigation: Because there is no inconsistency in his positions, there is no estoppel.

Id. “If Hologic’s new claim is materially broader than the ones Truckai assigned, then Truckai could not have warranted its validity in making the assignment, and without such a prior inconsistent representation, there is no basis for estoppel.” *Id.* at 2311.

The Supreme Court vacated the Panel opinion and remanded for this Court to apply its new, narrowed standard.

3. 2022 Panel Opinion

The Panel understood its task to be “constru[ing] the assigned and issued claims and compar[ing] the properly construed claims, focusing on the material aspects of those claims.” Panel Op. 12. The determination would “rest[] on principles of claim construction.” *Id.* The Panel thus transformed the Supreme Court’s equitable inquiry regarding the scope of an inventor’s prior “representations” into a mechanical process for construing a never-issued claim.

The Panel then construed the never-issued claim with a view to giving it the broadest possible construction. For example, the Panel asserted that the absence of *any* reference to an “applicator head” in application claim 31 meant that application claim 31 should be understood as a representation that the invention covers a device with

any kind of applicator head. *Id.* at 14. When it turned to the relevant language in the application claim, “electrode array,” it ignored that the abstract and the summary of the invention expressly say that that component is moisture permeable, Appx40318, Appx40363, and that the title of the invention requires “moisture transport,” inexplicably asserting that “nothing in the intrinsic record supports limiting [application] claim 31” to moisture permeable material, *id.* The Panel, without mentioning the summary and abstract by name, “acknowledge[d] ... that the written description ‘emphasizes the importance of moisture removal,’ as reflected in Minerva’s citations to descriptions of moisture removal and permeability in ... [the] written description.” Panel Op. 16 (citation omitted). Yet, without further explanation, the Panel “disagree[d] ... that claim 31 is limited to a moisture-permeable device.” *Id.* It leaped over multiple, express statements throughout the abstract and summary of invention to infer a broad scope for the application claim based on claim differentiation. Two other independent claims specified that the “electrode array” “includ[ed] a fluid permeable elastic member.” Appx40357 (application claim 1): Appx40359 (application claim 16). The Panel reasoned that

Truckai “knew how to draft claims that require moisture permeability,” Panel Op. 15, even as it ignored the many instances when Truckai had declared that his invention as a whole required moisture permeability.

ARGUMENT

A. Consistent With the Supreme Court’s Opinion, a Draft Claim that is Silent Regarding a Characteristic Cannot Be a Representation that Contradicts the Specification’s Consistent, Repeated Representations about that Characteristic

1. What an Inventor Represented in an Application as the Scope of the Invention is not a Matter of Mechanical Claim Construction

When an inventor assigns a patent application, it assigns only an “inchoate right” of indefinite scope. *Westinghouse Elec. & Mfg. Co. v. Formica Insulation Co.*, 266 U.S. 342, 352-53 (1924). Courts therefore must exercise special care in determining the scope of the resulting estoppel. *See id.* “The limits of the assignor’s estoppel” may “go only so far as, and not beyond, what [the inventor] represented in assigning the patent application.” *Minerva Surgical*, 141 S. Ct. at 2310. When the meaning of an application claim is at issue, the court’s fundamental task is to discern what has been represented as the invention’s scope. The task is not, as the Panel believed, simply a matter of applying principles of claim construction to the terms of a never-issued claim.

Panel Op. 12. The difference between a primary focus on the inventor/assignor’s *representations* (as the Supreme Court directed) and the mechanics of claim construction (as the Panel purported to apply) is more than semantic.

First, if the inventor did not use a term in a draft claim—and Truckai did not include “applicator head” in application claim 31—any suggestion that the draft claim represents anything about how broadly that term could be used in a future claim should be approached with special caution. The Panel’s decision to the contrary, which reads silence as an implicit representation of boundless scope, directly conflicts with assignor estoppel’s narrow focus on whether the assignor “sa[id] one thing” in assigning a patent “and the opposite” in litigation. *Id.* at 2304. The Panel’s approach puts on the inventor the obligation to affirmatively *negate* in the file history unpredictable future expansions of his invention. That is not the Supreme Court’s rule. It makes no sense to conclude that by not claiming an applicator head at all Truckai *represented* that any type of applicator head an assignee may later claim fell within the scope of what he had invented. Silence is not a “representation” at all.

Second, because the Panel considered the question purely one of (unissued) claim construction, it did not weigh the fact that the specification repeatedly emphasizes how moisture permeability is essential for the patent to work. Moisture *impermeable* materials are mentioned exclusively to disparage them. *See* Appx40316(2:20-22); Appx40338(23:3-9). It is of course true that one does not *construe* claims to avoid invalidity. *See Tate Access Floors, Inc. v. Interface Architectural Res., Inc.*, 279 F.3d 1357, 1371-72 (Fed. Cir. 2002). But if the task is to determine what the inventor *represented* in a never-issued claim, then the fact that the specification declares moisture trapped at the ablation site as the problem the invention solves represents that the device could *not* work if it included moisture impermeable material. An inventor did not represent that his invention is something his own description of the invention makes clear would not work.

Careful attention to the Supreme Court's focus on determining what the inventor represented also reflects the practical realities of patent prosecution. It is common for patent applications to include broadly-drafted claims which the inventor understands will be refined through prosecution. Focusing specifically on the broad "plain language"

of a claim, as the Panel did here, Panel Op. 14, thus undermines the effort to narrow the doctrine and accurately assess what the inventor represented as the scope of his invention. Indeed, long ago, the Supreme Court rejected the idea that assignor estoppel attached based on an inventor's inclusion of a broad catchall claim in an application, when the patent *as a whole* made clear that the invention was narrower. *Westinghouse*, 266 U.S. at 354-55 (finding inclusion of a draft claim which on its face “was so absurdly broad and all inclusive as almost to indicate that it was made to be rejected” created no estoppel).

2. Even as a Matter of “Claim Construction,” the Panel Ruling Cannot be Squared With the Supreme Court’s Mandate

Even if this Court concludes that assignor estoppel turns on construction of terms in an application claim, the Panel still erred. Its approach grants the application claim the broadest possible construction, rather than one appropriately limited by the inventor's clear representations in the specification.

Application claim 31 included an “electrode array.” Relying heavily on that “plain claim language,” the Panel found it meant the electrode array could be any material, whether permeable or

impermeable. Panel Op. 14. Of course, claims “do not stand alone” and “must be read in view of the specification.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-13, 1315 (Fed. Cir. 2005) (en banc). The Panel obliquely recognized that “the written description ‘emphasizes the importance of moisture removal,’” but ignored how absolute and unequivocal the emphasis is.

The Panel did not discuss that the abstract and summary of invention state, repeatedly and without qualification, that the claimed “electrode array” “*is* substantially absorbent and/or permeable to moisture,” Appx40363 (emphasis added), and that the title expressly states that the device must transport moisture, Appx40293. Statements in the abstract and summary are entitled to particular weight because they generally “describe the invention as a whole,” *C.R. Bard, Inc. v. U.S. Surgical Corp.*, 388 F.3d 858, 864-65 (Fed. Cir. 2004); *TriStrata, Inc. v. Microsoft Corp.*, 594 F. App’x 653, 656-57 (Fed. Cir. 2014), especially when, as here, they include statements such as “the present invention is” or “the present invention includes.” *David Netzer Consulting Eng’r LLC v. Shell Oil Co.*, 824 F.3d 989, 994 (Fed. Cir. 2016) (cleaned up); *Campbell Soup Co. v. Gamon Plus, Inc.*, 2020-2322,

2021 WL 3671366, at *4 (Fed. Cir. Aug. 19, 2021); *see* Appx40318 (permeability of the “electrode array” is part of “[t]he present invention”); Appx40363 (the invention “includes [an] array which is substantially absorbent and/or permeable.”). And this Court routinely gives careful consideration to the patent’s title. *See UltimatePointer, L.L.C. v. Nintendo Co.*, 816 F.3d 816, 823 (Fed. Cir. 2016); *Ruckus Wireless, Inc. v. Innovative Wireless Sols., LLC*, 824 F.3d 999, 1003 (Fed. Cir. 2016).

The Panel ignored that all references to moisture impermeable materials only disparage them. When the specification repeatedly discusses a feature, the fact that, as here, “every embodiment” uses that feature strongly suggests that the feature should be read as part of the claim. *Ruckus Wireless*, 824 F.3d at 1003; *Virnetx, Inc. v. Cisco Sys., Inc.*, 767 F.3d 1308, 1317-19 (Fed. Cir. 2014).

Indeed, the Panel’s effort to read the application claim as broadly as possible led it to distort one critical passage in the specification. The inventor explained that the material is

preferably a sack formed of a material [1] which is non-conductive, [2] which is permeable to moisture and/or which has a tendency to absorb moisture, and [3] which may be

compressed to a smaller volume and subsequently released to its natural size upon elimination of compression.

Appx40326(12:3-7.) This passage, as a matter of grammar and the logic of the invention, must mean that only the first feature, non-conductivity, is merely preferable. The other two features, moisture permeability and ability to be compressed, cannot be merely preferable; they are required. If the modifier “preferably” were carried beyond non-conductivity, it would have to also modify *both* permeability and compressibility. But nobody could believe a device made to be inserted into the uterus is merely “preferably” compressible. Yet the Panel, straining for *any* support for its broad reading, concluded that this passage declares that moisture permeability, like non-conductivity, was merely preferable. Panel Op. 15. Even if the Panel’s reading were not contrary to the grammar of the passage and logic of the invention, the specification later eliminates any lingering doubt. It describes the second embodiment as “[a]lternatively ... formed of a metallized fabric”—a material which is conductive, but which is still plainly moisture-permeable (and compressible). Appx40326(12:3-11).

The Panel then turned to claim differentiation. Panel Op. 14-15. But “[t]he doctrine of claim differentiation is not a hard and fast rule,

and does not serve to broaden claims beyond their meaning in light of the specification.” *Campbell Soup*, 2021 WL 3671366, at *4 (cleaned up); *Intell. Ventures I LLC v. Motorola Mobility LLC*, 870 F.3d 1320, 1326 (Fed. Cir. 2017). “When faced with clear and unambiguous language in the specification and a claim differentiation argument, the specification must prevail.” *Campbell Soup*, 2021 WL 3671366, at *4; *InterDigital Commc’ns, LLC v. Int’l Trade Comm’n*, 690 F.3d 1318, 1324 (Fed. Cir. 2012). Indeed, the Court has “declined to apply the doctrine of claim differentiation where, as here, the claims are not otherwise identical in scope.” *Uniloc 2017 LLC v. Apple Inc.*, 843 F. App’x 305, 312 n.6 (Fed. Cir. 2021).

In short, the Panel searched for *any* reason to interpret the claim broadly, and set aside every weighty contrary reason. This is not ordinary claim construction, but rather a focused effort to favor the broadest possible reading. That would be merely erroneous as a matter of claim construction. But it is more than that here: it is a distortion of the Supreme Court’s mandate, which requires a court to determine the scope of the inventor’s representation. A broadest-possible-construction approach *misrepresents* the inventor, and wrongly deprives the

inventor of the right to demonstrate that the assignee's later-drafted and prosecuted claim is invalid because it was not supported by the original application.

B. Allowing the Panel Decision to Stand Will Lead To Overly Broad Applications of Assignor Estoppel In Lower Courts.

The Panel opinion is the first attempt by this Court to apply the Supreme Court's new rule. Unless the full Court acts to "guard[] the doctrine's boundaries," lower courts looking to the Panel opinion will interpret draft claims broadly, once again giving assignor estoppel an improperly expansive scope. *Minerva Surgical*, 141 S. Ct. at 2309. That is especially troubling in the context at issue here, where assignor estoppel is being asserted to preclude a challenge to validity based on Section 112. The Panel has never suggested that the specification describes how the invention could work with moisture impermeable material. That fact has been treated as irrelevant to what the inventor represented about the scope of his invention in his assigned application. The Supreme Court's mandate requires more.

CONCLUSION

The *en banc* Court should reconsider the Panel decision.

September 9, 2022

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ADDENDUM

**United States Court of Appeals
for the Federal Circuit**

**HOLOGIC, INC., CYTYC SURGICAL PRODUCTS,
LLC,**
Plaintiffs-Appellants

v.

MINERVA SURGICAL, INC.,
Defendant-Cross-Appellant

2019-2054, 2019-2081

Appeals from the United States District Court for the District of Delaware in No. 1:15-cv-01031-JFB-SRF, Senior Judge Joseph F. Bataillon.

Decided: August 11, 2022

MATTHEW WOLF, Arnold & Porter Kaye Scholer LLP, Washington, DC, argued for plaintiffs-appellants. Also represented by MARC A. COHN, JENNIFER SKLENAR.

ROBERT N. HOCHMAN, Sidley Austin LLP, Chicago, IL, argued for defendant-cross-appellant. Also represented by CAROLINE A. WONG; JILLIAN STONECIPHER, Washington, DC; VERA ELSON, Wilson Sonsini Goodrich & Rosati, PC, Palo Alto, CA; OLIVIA M. KIM, EDWARD POPLAWSKI, Los Angeles, CA.

Before STOLL, CLEVINGER, and WALLACH, *Circuit Judges*.
STOLL, *Circuit Judge*.

This case comes to us on remand from the Supreme Court. The Court vacated our judgment affirming the district court’s summary judgment of no invalidity for claim 1 of U.S. Patent No. 9,095,348 in favor of Hologic, Inc. and Cytoc Surgical Products, LLC (collectively, “Hologic”) based on the doctrine of assignor estoppel. The Supreme Court held that assignor estoppel remains a valid doctrine, but that it comes with limits. The Court remanded for us to consider whether assignor estoppel, as limited, precludes Minerva Surgical, Inc. from challenging the validity of claim 1. Specifically, we must determine whether claim 1 is “materially broader” than the claims assigned to Hologic such that assignor estoppel should not apply.

For the reasons below, we hold that claim 1 is not “materially broader” than the claims assigned to Hologic. Accordingly, Minerva is estopped from challenging the validity of claim 1 of the ’348 patent. We therefore affirm the district court’s summary judgment that claim 1 is not invalid. We also reinstate our earlier judgment in all other respects.

BACKGROUND

I

The facts igniting the parties’ dispute go back nearly thirty years. In 1993, Csaba Truckai (one of the named inventors of the ’348 patent) co-founded a company called NovaCept, Inc. Mr. Truckai and his team at NovaCept invented the NovaSure system, an endometrial ablation device used to treat abnormal uterine bleeding (menorrhagia) by destroying targeted cells in the lining of the uterus.

A

On June 23, 1998, Mr. Truckai filed U.S. Patent Application No. 09/103,072, titled “A Moisture Transport System for Contact Electrocoagulation,” which included 31 claims of varying breadth. Of particular relevance here, some claims recited a “fluid permeable elastic member” to pass moisture away from the tissue, while one claim—claim 31—did not. *Compare* J.A. 40357 (claim 1) *and* J.A. 40359–60 (claim 16), *with* J.A. 40362 (claim 31).

Mr. Truckai assigned his interest in the '072 application to NovaCept in August 1998. While the '072 application was pending at the U.S. Patent and Trademark Office, Cytoc Corporation acquired NovaCept for \$325 million in March 2004. As part of this acquisition, NovaCept assigned its intellectual property rights to Cytoc, including rights to its patents and any continuation, continuation-in-part, or divisional patent applications (which included the '072 application). In the agreement, NovaCept warranted the validity and enforceability of the intellectual property rights it assigned. Relevant here, NovaCept warranted that it had “no present knowledge from which it could reasonably conclude” that the assigned intellectual property rights were invalid or unenforceable. J.A. 36367 ¶ 3.9(e). The '072 application issued as U.S. Patent No. 6,813,520 in November 2004.

Mr. Truckai eventually left NovaCept and, in 2008, founded Minerva, serving as its President, Chief Executive Officer, and a member of its Board of Directors. Mr. Truckai and others at Minerva developed the Endometrial Ablation System (EAS), which received FDA approval in 2015. Minerva began commercial distribution of the EAS in August 2015.

B

Hologic acquired Cytoc in 2007 and is the current assignee of the '348 patent at issue in this litigation. The

'348 patent issued in 2015 and claims priority to the '072 application through a series of continuation and divisional applications.

The '348 patent written description states that the inventors developed an ablation device that eliminates the problem of “steam and liquid buildup at the ablation site,” which occurred with prior art ablation devices. '348 patent col. 2 ll. 25–30. According to the written description, moisture buildup in prior art devices “create[d] a path of conductivity through which current traveling through the electrodes” flowed, “prevent[ing] the current from traveling into the tissue to be ablated.” *Id.* at col. 2 ll. 9–12. As the written description explains, the current then heated the water drawn from the tissue, “turn[ing] the ablation process into a passive heating method in which the heated liquid around the electrodes cause[d] thermal ablation to continue well beyond the desired ablation depths.” *Id.* at col. 2 ll. 15–18. To overcome this moisture problem, the written description explains that the claimed devices can be constructed so “moisture generated during dehydration is actively or passively drawn . . . away from the tissue.” *Id.* at col. 2 ll. 40–45.

An exemplary ablation device comprises three major components: (1) an applicator head, (2) a main body, and (3) a handle. *Id.* at col. 4 ll. 55–58. The applicator head “includes an electrode carrying means” with “an array of electrodes” on the surface of the electrode carrying means. *Id.* at col. 4 ll. 58–61. The written description explains that the electrode carrying means “is preferably a sack formed of a material which is non-conductive” and “permeable to moisture and/or . . . has a tendency to absorb moisture.” *Id.* at col. 5 ll. 52–57. Enclosed within the electrode array is a deflecting mechanism and its deployment structure. *Id.* at col. 13 ll. 8–12. According to the written description, the deflecting mechanism is “used to expand and tension the [electrode] array for positioning into contact with the tissue,” *id.* at col. 12 ll. 5–8, “form[ing] the [electrode] array

into the substantially triangular shape” that “is particularly adaptable to most uterine shapes,” *id.* at col. 14 ll. 21–24.

Claim 1 is the only asserted claim of the ’348 patent. Because claim 1’s relevance relates to whether it is materially broader than claim 31 of the ’072 application, we reproduce claim 1 and claim 31 side-by-side in our analysis of that question below. *See infra* p. 14.

II

In November 2015, Hologic sued Minerva in the U.S. District Court for the District of Delaware, alleging that Minerva’s EAS and the use thereof infringed certain claims of the ’348 patent. Minerva, in response, asserted various invalidity defenses, including lack of enablement and written description. Hologic moved for summary judgment, arguing that the doctrine of assignor estoppel bars Minerva from challenging the validity of the ’348 patent claims in district court. The district court agreed, entering summary judgment of no invalidity in Hologic’s favor. *See Hologic, Inc. v. Minerva Surgical, Inc.*, 325 F. Supp. 3d 507, 523–25 (D. Del. 2018) (*Hologic I*). It also granted summary judgment of infringement of claim 1 of the ’348 patent. *See id.* at 529–32.

After a jury trial on the issues of willful infringement, damages, and certain state-law counterclaims, both parties appealed, raising numerous issues in this court. In its cross-appeal, Minerva challenged (among other things) the district court’s determination that assignor estoppel precluded Minerva from challenging the validity of claim 1 of the ’348 patent. It also challenged the district court’s claim constructions of two terms in claim 1—“applicator head” and “indicator mechanism”—relevant to infringement. We concluded that the district court did not abuse its discretion in applying the doctrine of assignor estoppel and accordingly affirmed its summary judgment of no invalidity. *Hologic, Inc. v. Minerva Surgical, Inc.*, 957 F.3d 1256,

1267–69 (Fed. Cir. 2020) (*Hologic II*). We also adopted the district court’s constructions of the terms that Minerva challenged, thus affirming the district court’s summary judgment of infringement. *See id.* at 1269–70.

Minerva petitioned the Supreme Court for a writ of certiorari, arguing that the doctrine of assignor estoppel “finds no support in the statute, [the Supreme] Court’s decisions, or the policies the Patent Act serves.” Pet. for Writ of Cert. at 14, *Minerva Surgical, Inc. v. Hologic, Inc.*, 141 S. Ct. 2298 (2021) (No. 20-440). To Minerva, its case provided “a uniquely valuable opportunity” for the Court to consider “not only whether to abandon the doctrine entirely, but also whether to retain the doctrine with clearly defined, narrow limits.” *Id.* at 28–29.

The Supreme Court granted certiorari and declined Minerva’s request to “discard this century-old form of estoppel,” but in doing so clarified that assignor estoppel “comes with limits.” *Minerva Surgical, Inc. v. Hologic, Inc.*, 141 S. Ct. 2298, 2302, 2309 (2021) (*Hologic III*). It explained that the doctrine “reaches only so far as the equitable principle long understood to lie at its core.” *Id.* at 2302. The Court thus held that assignor estoppel “applies only when an inventor says one thing (explicitly or implicitly) in assigning a patent and the opposite in litigating against the patent’s owner.” *Id.* at 2304. Put another way, the Court explained that “there is no ground for applying assignor estoppel” “when the assignor has made neither explicit nor implicit representations in conflict with an invalidity defense.” *Id.* at 2310.

The Supreme Court then considered Minerva’s contention that “estoppel should not apply because it was challenging a claim that was materially broader than the ones [Mr.] Truckai had assigned,” *id.* at 2310, a contention that our precedent had deemed irrelevant, *Hologic II*, 957 F.3d at 1268. The Court disagreed with our conclusion, explaining that Minerva’s contention was important to whether

estoppel should apply: “If Hologic’s new claim is materially broader than the ones [Mr.] Truckai assigned, then [Mr.] Truckai could not have warranted its validity in making the assignment. And without such a prior inconsistent representation, there is no basis for estoppel.” *Hologic III*, 141 S. Ct. at 2311. The Court thus vacated our judgment and remanded for us to address “whether Hologic’s new claim is materially broader than the ones [Mr.] Truckai assigned.” *Id.*

We therefore reconsider whether the district court abused its discretion in determining that assignor estoppel barred Minerva’s invalidity defenses in light of the Supreme Court’s guidance.

DISCUSSION

The dispute on remand focuses on whether claim 1 of the ’348 patent is materially broader than claim 31 of the ’072 application, a claim that was canceled two years before NovaCept assigned its intellectual property rights to Cytoc (Hologic’s predecessor).

Minerva argues that every claim pending at the time of the 2004 assignment “included an *express* limitation that the applicator head be moisture permeable.” Cross-Appellant’s Suppl. Br. 4. Minerva concedes that claim 31 did not have such a limitation but asserts that claim 31 was canceled in 2002, well before the 2004 assignment, and therefore it was not assigned. Minerva thus argues that Hologic cannot assert that Mr. Truckai¹ represented claim 31 was valid at the time of the 2004 assignment. Minerva further argues that even if Hologic can properly rely on claim 31, that claim did not cover a device with a moisture-impermeable applicator head because it did not use the term “applicator head.” And it argues that the written description

¹ We use “NovaCept” and “Mr. Truckai” interchangeably when referencing the 2004 assignment.

makes clear that the term “electrode array,” as used in claim 31, requires a moisture-permeable electrode array. Thus, per Minerva, claim 1 of the ’348 patent—which covers both moisture-permeable and moisture-impermeable devices—is materially broader than claim 31, which is limited to moisture-permeable devices.

Hologic, for its part, responds first that Mr. Truckai warranted claim 31’s validity at the time of the assignment. Hologic acknowledges that claim 31 was canceled prior to the 2004 assignment. It argues, however, that the context in which this cancellation arose matters: the cancellation was “without prejudice” complying with a restriction requirement entered by the Examiner. According to Hologic, under standard patent prosecution practice, the expectation is that a patent practitioner could have re-introduced the canceled claim in a continuation or divisional application. And further, Hologic notes the Examiner allowed claim 31 on the merits prior to cancellation. Continuing, Hologic argues that claim 1 is not materially broader than claim 31 because neither claim has any moisture-permeability limitation.

The questions before us are therefore: (1) whether Mr. Truckai warranted claim 31’s validity at the time of assignment, considering the parties’ arguments regarding the implications of the 2002 cancellation; and (2) whether claim 31 is materially broader than claim 1 of the ’348 patent—specifically, whether claim 31 is broad enough to cover moisture-impermeable devices, or if instead it is limited to moisture-permeable devices. We address each argument in turn.

I

We begin our analysis by considering whether claim 31 was assigned in the 2004 assignment such that Mr. Truckai warranted claim 31’s validity as part of that assignment. The answer to this question turns on the

'072 application's prosecution history and what it tells an objective assignee about why claim 31 was canceled.

As noted above, Mr. Truckai and his co-inventors filed the '072 application on June 23, 1998, with 31 claims. J.A. 40293, 40357–62. On June 21, 1999, the Examiner issued an office action rejecting claim 31 as anticipated under 35 U.S.C. § 102. *See* J.A. 40382–84. Mr. Truckai disagreed, arguing in his December 21, 1999 office action response that claim 31 was not anticipated by the prior art of record. J.A. 40398. Mr. Truckai convinced the Examiner, who allowed claim 31 on October 3, 2000 (while maintaining rejections of other pending claims). J.A. 40416.

On May 21, 2001, the Examiner issued a restriction requirement for claim 31 under 35 U.S.C. § 121. Section 121² governs divisional applications and provides that where “two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions.” In the restriction requirement, the Examiner explained that certain pending claims (including claim 31) were drawn to an apparatus for ablating and that other pending claims were drawn to a method of ablating. J.A. 40442–43. That is, the Examiner concluded that the apparatus claims (including claim 31) were distinct inventions from the method claims. The Examiner thus required Mr. Truckai to elect which claims he wanted to further prosecute in the '072 application. *See* 37 C.F.R. § 1.142(a) (“If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant

² Congress amended § 121 when it enacted the Leahy–Smith America Invents Act (AIA). Pub. L. No. 112–29, § 4(a)(2), 125 Stat. 284, 295 (2011). We use the version of § 121 that was in effect at the time of the May 21, 2001 office action.

in the reply to that action to elect an invention to which the claims will be restricted . . .”).

On June 5, 2001, Mr. Truckai requested that the Examiner withdraw the restriction requirement because the Examiner had already allowed claim 31. In the alternative, he elected the method claims for further prosecution on the merits. The Examiner maintained the restriction requirement and noted Mr. Truckai’s election of the method claims for further prosecution. In response, on February 28, 2002, Mr. Truckai requested that the Examiner cancel the apparatus claims (including claim 31) “without prejudice.” J.A. 40453.

Looking at the prosecution history as a whole, we agree with Hologic that this 2002 cancelation in response to the Examiner’s restriction requirement says nothing, implicitly or explicitly, about the patentability of claim 31. Put another way, Mr. Truckai canceled claim 31 for reasons other than patentability. Indeed, an assignee would have understood that the restriction requirement and subsequent cancelation in response to the restriction requirement meant that the patent applicant could later prosecute claim 31’s subject matter. This is because non-elected claims are “withdrawn from further consideration by the examiner,” 37 C.F.R. § 1.142(b), and there is no final patentability determination for those withdrawn claims (even if the restriction requirement comes after an office action on the merits), *see id.* § 1.142(a); *see also* Manual of Patent Examining Procedure (MPEP) § 810 (explaining that a restriction requirement is distinct from an office action on the merits). Rather, an applicant who has canceled a claim in response to a restriction requirement can file a divisional application with the non-elected claims and proceed separately with prosecution on the merits of those claims. *See* 35 U.S.C. § 121 (explaining that “the other invention [can be] made the subject of a divisional application”); MPEP § 201.06 (“A divisional application is often filed as a result of a restriction requirement made by the examiner.”). A

claim canceled in response to a restriction requirement thus travels with the application.

Accordingly, we disagree with Minerva's suggestion that claim 31, once canceled, could not be assigned, and that cancellation of claim 31 was some sort of concession that the claim was unpatentable. Although claim 31 was canceled for purposes of further prosecution of the '072 application, cancellation did not nullify the claim, as it remained viable for further prosecution in a divisional application filed by whomsoever owned the '072 application. A claim canceled in response to a restriction requirement is no less a viable claim just because of its cancellation in response to a restriction requirement. The 2004 assignment assigned not just the rights to the '072 application, but also the rights to any continuation, continuation-in-part, or divisional patent applications not yet filed. For certain, canceled claim 31 traveled with the '072 application and its assignment to Hologic. Mr. Truckai signed an oath when presenting the '072 application, in which he stated his implicit good-faith belief that the claims in the application are patentable and would result in a valid patent. *See Hologic III*, 141 S. Ct. at 2309 n.3. The representations in that oath were further reaffirmed twice: First, by Mr. Truckai successfully defending claim 31 from the Examiner's anticipation rejection before its cancellation, and second, by the 2004 assignment, in which the assignor warranted that it had "no present knowledge from which it could reasonably conclude" that these assigned intellectual property rights were invalid or unenforceable. J.A. 36367 ¶ 3.9(e). Therefore, Mr. Truckai represented (whether implicitly or explicitly) that the subject matter of claim 31 was not invalid.³

³ Our holding in this regard is limited to the facts of this case. We do not address whether a claim canceled for

II

Having determined that the 2004 assignment included a warranty as to claim 31's validity, we turn now to the question of whether claim 1 of the '348 patent is "materially broader" than claim 31 of the '072 application. This requires us to construe the assigned and issued claims and compare the properly construed claims, focusing on the material aspects of those claims. Because this determination rests on principles of claim construction, it is ultimately a question of law we review de novo where, as here, it is decided only on the intrinsic evidence. *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318, 331 (2015).

The parties have significantly narrowed the question before us on remand, agreeing on which assigned and new claims to compare and also agreeing on what would make the new claim "materially broader" than the assigned claim. Specifically, the parties agree: (1) that we need only compare claim 1 of the '348 patent to claim 31 of the '072 application (the parties did not identify any other assigned claims relevant to this question); and (2) that whether claim 1 is "materially broader" (rather than just broader) than claim 31 depends on the difference between moisture-permeable and moisture-impermeable devices.⁴ We previously held that claim 1 broadly covers moisture-impermeable devices. *See Hologic II*, 957 F.3d at 1269–70 (adopting district court's construction of "applicator head" and rejecting Minerva's construction requiring the claimed applicator head be moisture permeable); Cross-Appellant's Suppl. Br. 3 (conceding that claim 1 has been construed "to cover devices with moisture impermeable applicator

reasons other than to comply with a restriction requirement would be part of the 2004 assignment.

⁴ Given this agreement, we need not in this case define the line between broader claims and materially broader claims.

heads”). Thus, if claim 31 is limited to moisture-permeable devices, the parties agree that claim 1 is “materially broader” and assignor estoppel would not bar Minerva from asserting its invalidity defenses. Claims 1 and 31 are reproduced in relevant part below:

<i>'348 patent claim 1</i>	<i>'072 application claim 31</i>
<p>1. A device for treating a uterus comprising:</p> <p>an elongate member having a proximal portion and a distal portion, the elongate member comprising an outer sleeve and an inner sleeve slidably and coaxially disposed within the outer sleeve;</p> <p>an applicator head coupled to the distal portion, the applicator head defining an interior volume and having a contracted state and an expanded state, the contracted state being configured for transcervical insertion and the expanded state being configured to conform to the shape of the uterus, the applicator head including one or more electrodes for ablating endometrial lining tissue of the uterus; . . .</p>	<p>31. An ablation and/or coagulation apparatus for use in delivering energy to tissue for ablation, the apparatus comprising:</p> <p>an elongate member;</p> <p>a deployment mechanism carried by the elongate member, the deployment mechanism moveable between a retracted position and a plurality of laterally expanded positions;</p> <p><i>an electrode array</i> carried by the deployment mechanism;</p> <p>a sheath slidably disposed over the electrode array; . . .</p>

'348 patent col. 19 ll. 9–42; J.A. 40362 (emphasis added to disputed limitation).

At the outset, Minerva and Hologic agree that claim 31 does not have an express moisture-permeability limitation. Cross-Appellant’s Suppl. Br. 4; Appellants’ Suppl. Resp. Br. 2. Thus, there is no dispute that the plain claim language—the starting point of any claim construction analysis, *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–14 (Fed. Cir. 2005)—suggests that claim 31 is not limited to moisture-permeable devices. Rather, the plain claim language is broad enough to encompass moisture-impermeable devices as well.

Minerva nevertheless argues that claim 31 cannot cover a moisture-impermeable device. First, Minerva focuses on the lack of an “applicator head” limitation in claim 31, arguing that the claim therefore does “not cover a device with a moisture impermeable applicator head.” Cross-Appellant’s Suppl. Br. 6. We disagree. Claim 31 is an open-ended “comprising” claim. That claim 31 does not have an applicator head limitation supports the opposite conclusion: that the claim broadly covers both moisture-permeable and -impermeable applicator heads.

Second, Minerva argues that the term “electrode array” requires a material that is moisture permeable”—i.e., the claimed ablation device is moisture-permeable because it has a moisture-permeable electrode array. Cross-Appellant’s Suppl. Br. 8. We disagree, as nothing in the intrinsic record supports limiting claim 31 in the way Minerva urges. In fact, the principle of claim differentiation supports the opposite conclusion. Claim 1 of the ’072 application, for example, recited “an ablation device including an electrode array,” with “the electrode array including a fluid permeable elastic member.” J.A. 40357. It also recited “permitting moisture generated during the dehydration . . . to pass into the electrode carrying member.” *Id.* In other words, it expressly recited moisture permeability. Claim 16 likewise recited a fluid-permeable electrode array. *See* J.A. 40359–60 (“an electrode array carried by an elongate member, the array including a fluid permeable

elastic member”). This shows that Mr. Truckai and the other inventors knew how to draft claims that require moisture permeability. The fact that they chose not to include this limitation in claim 31, unlike claims 1 and 16, indicates that they did not intend to so limit that claim. *See Phillips*, 415 F.3d at 1314 (“Differences among claims can also be a useful guide in understanding the meaning of particular claim terms.”).

Minerva also emphasizes the written description’s disclosure of an embodiment that has “an array of electrodes formed on the surface of [an] electrode carrying means” that is “permeable to moisture,” arguing that claim 31 is therefore limited to a moisture-permeable device. Cross-Appellant’s Suppl. Br. 7 (quoting ’348 patent⁵ col. 4 ll. 58–61, col. 5 ll. 52–61). To be sure, the cited portion of the written description does reference a moisture-permeable electrode array. But this description of the “electrode carrying means” refers merely to “preferabl[e]” characteristics, including permeability “and/or a tendency to absorb moisture.” ’348 patent col. 5 ll. 52–61. It is not described as a required or mandatory characteristic. Accordingly, it is improper to restrict claim 31 to this “preferable” characteristic. *See Comaper Corp. v. Antec, Inc.*, 596 F.3d 1343, 1348 (Fed. Cir. 2010) (explaining that we do not “limit[] claims to a preferred embodiment”); *InterDigital Commc’ns, LLC v. Int’l Trade Comm’n*, 690 F.3d 1318, 1328 (Fed. Cir. 2012) (“Because we conclude that the claim language is broad enough to include both embodiments, the inventors’ failure to include a reference to the alternative

⁵ Neither party has cited or relied on the ’072 application’s written description as filed, nor have they identified any material differences between the ’072 application’s and ’348 patent’s written description. For simplicity, we, like the parties, rely on the ’348 patent’s written description in construing claim 31.

embodiment in the specification does not justify excluding that embodiment from the coverage of the claims.”).

We acknowledge here, as we did in *Hologic II*, that the written description “emphasizes the importance of moisture removal,” 957 F.3d at 1269, as reflected in Minerva’s citations to descriptions of moisture removal and permeability in the ’348 patent written description, Cross-Appellant’s Suppl. Br. 7–8. After considering the intrinsic record as a whole, however, we disagree with Minerva’s assertion that claim 31 is limited to a moisture-permeable device. Accordingly, we hold that claim 1 of the ’348 patent is not materially broader than claim 31 of the ’072 application.

* * *

As we explained in *Hologic II*, “Minerva disputed none of the pertinent facts” concerning assignor estoppel at the district court or on appeal, including: (1) that Mr. Truckai executed a broad assignment of his patent rights to NovaCept and later sold NovaCept to Hologic’s predecessor; (2) that NovaCept received appreciable value for those patent rights; (3) that Mr. Truckai founded Minerva and used his expertise to research, develop, and obtain FDA approval for Minerva’s EAS; (4) that his job responsibilities included bringing the EAS to market to compete with Hologic; and (5) that he is in privity with Minerva. 957 F.3d at 1268. Thus, in view of our determination that claim 1 of the ’348 patent is not materially broader than claim 31 of the ’072 application, we conclude that the district court did not abuse its discretion in applying the doctrine of assignor estoppel. We thus affirm the district court’s summary judgment of no invalidity as to claim 1 of the ’348 patent.

CONCLUSION

We have considered Minerva’s remaining arguments and find them unpersuasive. For the foregoing reasons, we hold that Minerva is estopped from challenging the validity of the ’348 patent claims based on the doctrine of assignor

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estoppel. We therefore affirm the district court's summary judgment that claim 1 of the '348 patent is not invalid.

Many portions of our earlier judgment were unaffected by the Supreme Court's vacate and remand. We therefore reinstate our earlier judgment (1) affirming the district court's denial of Hologic's motions for a permanent injunction, enhanced damages, and ongoing royalties for infringement of the asserted claims of U.S. Patent No. 6,827,183; (2) affirming the district court's summary judgment of infringement of claim 1 of the '348 patent; (3) affirming the district court's denial of Hologic's requests for supplemental damages and for increased and enhanced supplemental damages; and (4) vacating the district court's award of pre-and post-judgment interest on the supplemental-damages award and remanding with instructions to calculate the interest award in accordance with *Hologic II*.

**AFFIRMED-IN-PART, VACATED-IN-PART, AND
REMANDED**

COSTS

No costs.

CERTIFICATE OF SERVICE

I hereby certify that I filed the foregoing with the Clerk of the United States Court of Appeals for the Federal Circuit using the CM/ECF system this 9th day of September, 2022, and that a copy was served on all counsel of record by the CM/ECF system.

September 9, 2022

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CERTIFICATE OF COMPLIANCE WITH RULE 32(a)

This brief complies with the type-volume limitation of Federal Rule of Appellate Procedure 35(b)(2). The brief contains 3897 words, excluding the parts of the brief exempted by Federal Circuit Rule 35(c)(2).

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