Assignor Estoppel:
An Historical Square Peg
In a Modern Round Hole?

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The Baseline Principles

- It's affirmative defense, not an offensive claim; and it's equitable in nature

- A party who assigns a patent to another can't later challenge in district court the validity of the assigned patent(s)

    - The assignment is thought to contain an implicit representation that the patent rights are not worthless

    - The doctrine is thought to prevent the asserted injustice and unfairness of permitting a party to sell something and later say that it is worthless

- The doctrine applies to those in privity with an estopped accused infringer

Semiconductor Energy Laboratory Co. v. Nagata, 706 F.3d 1365, 1269 (Fed. Cir. 2013);
Mentor Graphics Corp. v. Quickturn Design Sys., Inc., 150 F.3d 1374, 1378 (Fed. Cir. 1998);
Diamond Scientific Co. v. Ambico, Inc., 848 F.2d 1220, 1224 (Fed. Cir. 1988)

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The Narrow Factual Foundation

DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION USING AN APPLICATION DATA SHEET (37 CFR 1.76)

Title of Invention

As the below named inventor(s), I/we declare that:

This declaration is directed to:

☐ The attached application, or

☐ Application No. _____ filed on _____

☐ As amended on _____ . (if applicable);

I/we believe that I/we am/are the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought;

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The Expansive Application:
The Seed Becomes An Oak Tree

"I/We believe"

⇓

"I/We are certain"

⇓

"I/We agree to an irrefutable presumption"

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The Expansive Application:
The Oak Tree Becomes a Forest

"I/We"

⇩

"I/We and those in privity with me/us, now or in the future, whether presently known or not"

⇩

"Any entity, of any kind, for which I work in the future, whether presently known or not, before the patents expire or before that entity could be accused of infringement, whichever is later"

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Other Fundamental Conflicts?

- The Supreme Court has held that a patent licensee that has treated the license as valid can still challenge the patent's validity

  MedImmune, Inc. v. Genentech, Inc., 549 U.S. 118 (2007)
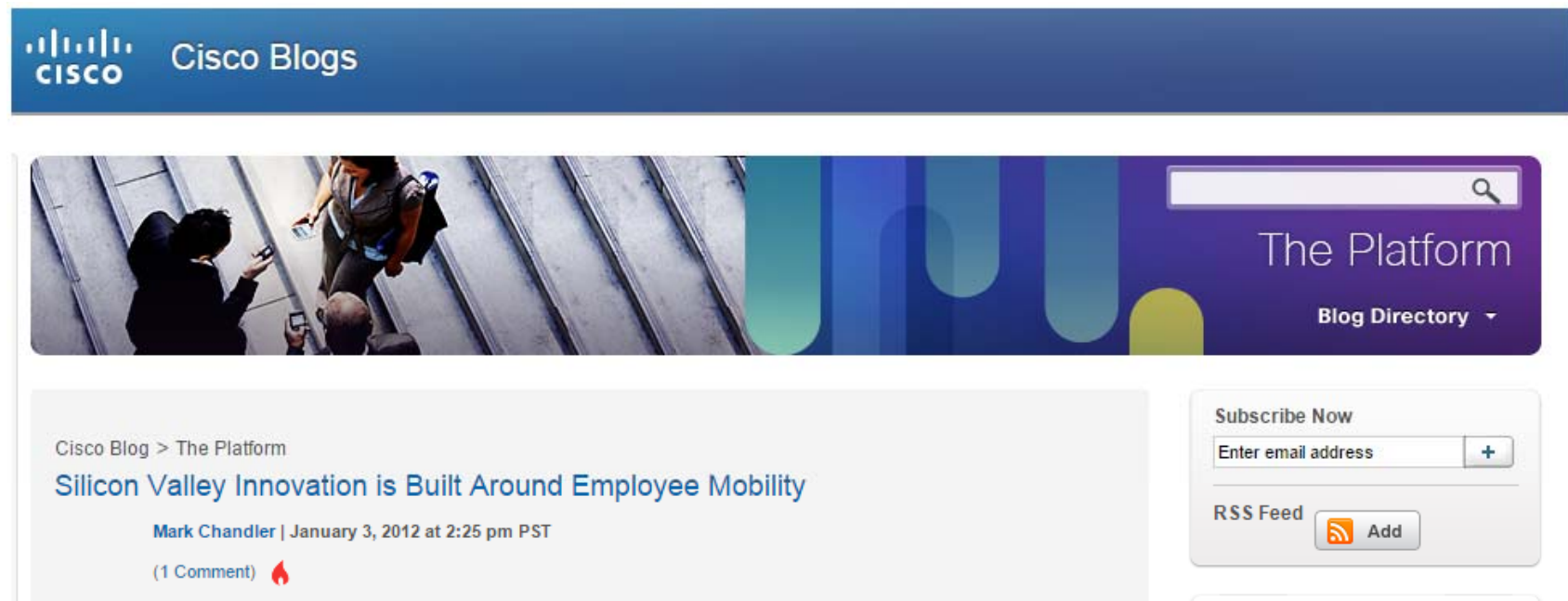
- The Supreme Court has reasoned that the technical demands of contract doctrine must give way to the public interest in not having to pay tribute for invalid patents

  Lear, Inc. v. Adkins, 395 U.S. 653 (1969)

- The doctrine applies to validity challenges in district court and §337 proceedings; but doesn't apply to validity challenges in IPRs

  Redline Detection LLC v. Star Envirotech, Inc., IPR2013-00106, Paper 66 (June 30, 2014)

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Why Should You Care?

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