

Joe Matal in Life Sciences IP Review: ‘Minerva: Less Risk for Inventors, More Work for the Courts’

July 20, 2021

PRACTICES Intellectual Property, Patents, Patent Prosecution and Counseling, Patent Litigation, Trademark and Advertising

Life Sciences IP Review interviewed Haynes Boone Partner Joseph Matal about the U.S. Supreme Court opinion in *Minerva v. Hologic*, which narrows the scope for inventors to challenge the validity of their own patents in defense proceedings — a decision that was controversial among the judges.

Here is an excerpt:

While lawyers have welcomed the clarity the ruling brings to assignor estoppel going forward, the vacated judgment complicates the doctrine and how life science companies can manage their IP portfolios.

In a market where building a robust patent portfolio is the key to creating value, and given that *Minerva v. Hologic* centred around a medical device patent, the clarification of the scope of assignor estoppel will be crucial for life science litigators going forward.

The ruling could benefit scientists moving from company to company. With the justices holding that the doctrine’s reach does not extend to employees who assigned patent rights to their employer as a right to employment, this means less risk for the inventor when moving companies.

Haynes Boone Partner Joseph Matal believed this was a good thing.

“Such employees received nothing in exchange for the patent and should not have the doctrine following them around and affecting their future employers’ ability to challenge the patent,” said Matal.

Future Use Cases

With assignor estoppel ruled as valid doctrine, it will likely need future case law to clarify exactly how it can be implemented going forward.

This will also mean more work for the courts when deciding whether assignor estoppel applies, as with the clarification, comes greater scrutiny of the patents in similar disputes.

Matal said: “Courts will now have to analyse the claims that existed at the time of the assignment and determine whether they are substantively the same as the claims being litigated.”

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