

The Supreme Court - June 29, 2021

Today, the Supreme Court of the United States issued the following three decisions:

Minerva Surgical, Inc. v. Hologic, Inc., No. 20-440: In the late 1990s, Csaba Truckai invented and patented a device to treat abnormal uterine bleeding. Truckai assigned his interest to his company, Novacept, which in turn sold its portfolio of patents, which are now held by respondent Hologic. In 2008, Truckai founded a new company, petitioner Minerva Surgical, and developed a purportedly improved device to treat the same medical condition. Around the same time the patent was issued for Minerva Surgical's device, Hologic filed a continuation application to add claims to the original patent, which the Patent and Trademark Office granted. Hologic then sued Minerva for patent infringement, and Minerva responded, in part, by asserting that Hologic's amended patent is invalid. Hologic then invoked the doctrine of assignor estoppel, first recognized by the Court in *Westinghouse Elec. & Mfg. Co. v. Formica Insulation Co.*, 266 U.S. 342 (1924), claiming that because Truckai assigned the original patent, he could not now impeach that patent's validity. The District Court agreed with Hologic, and the Federal Circuit affirmed, confirming the assignor estoppel doctrine's continued vitality, and considering it irrelevant that Hologic's claims may have later been amended without Truckai's input. Today, the Court vacated and remanded, upholding the assignor estoppel doctrine, but clarifying that it applies only when the assignor's claim of invalidity contradicts explicit or implicit representations he or she made in assigning the patent. As applied here, 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 there would be no basis for estoppel. Justice Kagan issued the Court's opinion, joined by Chief Justice Roberts, and Justices Breyer, Sotomayor, and Kavanaugh. Justice Alito dissented, criticizing the Court for not deciding whether *Westinghouse* should be overruled. Justice Barrett also filed a dissenting opinion, joined by Justices Thomas and Gorsuch, concluding instead that the assignor estoppel doctrine is no longer valid because it was not incorporated into the Patent Act of 1952.

Related Capabilities

- Appellate
- Intellectual Property Litigation
- Patent Prosecution & Strategy
- Energy & Natural Resources
- Oil & Gas
- Immigration

View the Court's [decision](#).

PennEast Pipeline Co. v. New Jersey, No. 19-1039: The Natural Gas Act provides that companies must obtain a certificate from the Federal Energy Regulatory Commission (“FERC”) in order to build an interstate pipeline, and that such certificate holders are authorized to exercise the federal eminent domain power. Here, Petitioner PennEast Pipeline was granted a certificate by FERC, and brought an action in federal court to exercise its federal eminent domain power to build a pipeline. Among the parcels PennEast sought to condemn were properties over which the State of New Jersey held a property interest. New Jersey moved to dismiss on sovereign immunity grounds, which the District Court denied. The Third Circuit, however, found that the Federal Government’s authority to condemn state-owned property did not extend to private parties to which the Federal Government had delegated that authority, and thus ordered all claims against the State to be dismissed. Today, the Court reversed, holding that the Federal Government can constitutionally confer on pipeline companies the authority to condemn necessary rights-of-way in which a State has an interest. Chief Justice Roberts issued the Court’s opinion, joined by Justices Breyer, Alito, Sotomayor, and Kavanaugh. Justice Barrett filed a dissenting opinion, joined by Justices Thomas, Kagan, and Gorsuch, on the basis that Congress passed the Natural Gas Act in reliance on its power to regulate interstate commerce, and the Commerce Clause does not permit Congress to strip States of their sovereign immunity. Justice Gorsuch also filed a separate dissenting opinion, joined by Justice Thomas.

View the Court's [decision](#).

Johnson v. Guzman Chavez, No. 19-897: The respondents here were removed from the United States, but later reentered the country without authorization. The Department of Homeland Security (“DHS”) reinstated their prior removal orders, and the respondents sought withholding of removal based on fear of persecution if removed. DHS detained the respondents, who sought release on bond while their withholding-only proceedings were pending. The Government instead maintained that the respondents were not entitled to bond hearings. Whether the respondents are entitled to a bond hearing depends upon whether 8 U.S.C. §1226 or 8 U.S.C. §1231 applies. Section 1226 applies “pending a decision on whether the alien is to be removed from the United States,” and allows for a bond hearing before an immigration judge. Section 1331 instead applies after the alien is “ordered removed,” during which an alien must be removed during a 90-day “removal period” that is subject to extension under certain circumstances, and during which time detention is mandatory. The District Court concluded §1226 governed the respondents’ detention, and the Fourth Circuit affirmed. The Court today reversed, concluding that §1231, not §1226, governs the detention of aliens subject to reinstated orders of removal, meaning those aliens are not entitled to a bond hearing while they pursue withholding of removal. Justice Alito issued the Court’s opinion, joined in full by Chief Justice Roberts, and Justices Kavanaugh and Barrett. Justice Thomas concurred, joined by Justice Gorsuch, maintaining that the Court lacked jurisdiction to hear the case, but otherwise joining the Court’s opinion. Justice Breyer dissented, in an opinion joined by Justices Sotomayor and Kagan, concluding instead that the respondents’

circumstances are governed by §1226, and that they are thus entitled to bond hearings.

View the Court's [decision](#).