

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.

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

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

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CERTIFICATE OF INTEREST

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

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.

Wilson Sonsini Goodrich & Rosati, P.C.: Dale R. Bish; Christopher D. Mays; Erik Carlson; Neil N. Desai; Ty Callahan; Ian Liston.

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., No. 18-1550 (Fed. Cir.) (decided Apr. 19, 2019; Appellant Hologic, Inc.'s petition for Panel rehearing and rehearing en banc regarding U.S. Patent No. 6,872,183 ("the '183 Patent") was

pending at the time this cross-appeal was filed and was denied on July 16, 2019).

June 18, 2020

/s/ Robert N. Hochman
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INTRODUCTION

The parties agree that this Court should grant *en banc* review “to reconcile its divergent assignor estoppel precedents,” under which an assignor may assert invalidity in an *inter partes* review, but may be barred from asserting invalidity in district court. Hologic Pet. 3. As Judge Stoll explained in her “additional views,” there are two potential paths: the Court could (1) “change the application of the doctrine in district court,” or (2) “reevaluate [its] interpretation of the [America Invents Act] as prohibiting the doctrine of assignor estoppel” in *inter partes* reviews. Panel Op. 29-30 (Stoll, J., additional views). As *Minerva* explained in its Petition, the Court can and should take the first path and eliminate the court-made doctrine of assignor estoppel in district court, while maintaining its precedent that statutory text and congressional intent make clear that assignor estoppel has no place in *inter partes* review.

Hologic, however, asks the Court to take the second path and reverse its decision that there is “no room for assignor estoppel in the IPR context.” *Arista Networks, Inc. v. Cisco Sys., Inc.*, 908 F.3d 792, 803 (Fed. Cir. 2018). But that option is not available in this case.

Whether *Arista* was rightly decided has never been an issue in this case and *is not before the Court*. If the Court wants to reconcile its assignor estoppel precedents by reversing course in the *inter partes* review context, it must await a case presenting an invalidity ruling in an *inter partes* review initiated by an assignor of the patent. This is not an appeal from an *inter partes* review. In 2018, Hologic appealed from the *inter partes* review that invalidated the '183 patent. But in 2019, this Court affirmed, so that decision is final and no longer reviewable. And while Hologic could have challenged *Arista* in its appeal from the *inter partes* review proceedings, it did not. Instead, it waited until the present petition for *en banc* rehearing to raise it for the first time in *either* case. A more clear case of forfeiture is hard to imagine.

Hologic, perhaps aware of the impossibility of reconsidering *Arista* in this case, retreats to an alternative. Hologic invites the Court to create a novel equitable doctrine that would allow Hologic to enforce against only Minerva a patent already conclusively determined to be invalid. As Hologic would have it, although the '183 patent no longer exists, courts should pretend that it is still a patent *only* when Hologic asserts it against the assignor and those in privity with the assignor

and only if that assignor or those in privity with the assignor initiated the *inter partes* review that resulted in the invalidation of the patent. Hologic Pet. 14-16. This proposal would contort long settled principles well beyond assignor estoppel for no purpose other than to serve Hologic's narrow interests. It is contrary to the Patent Act, well-established precedents of the Supreme Court and this Court, and sound patent policy.

Under the Patent Act, a judgment of patent infringement requires proof that a patent exists. Thus, “when a [patent] claim is cancelled, the patentee loses any cause of action based on that claim, and any pending litigation in which the claims are asserted becomes moot.” *Fresenius USA, Inc. v. Baxter Int’l, Inc.*, 721 F.3d 1330, 1340 (Fed. Cir. 2013); *XY, LLC v. Trans Ova Genetics*, 890 F.3d 1282, 1294 (Fed. Cir. 2018). This Court, consistent with Supreme Court precedent, has correctly held that there is no exception to this settled rule—that patent claims immediately fail upon the determination that the patent is invalid—for claims asserted against assignors of the patent. *Mentor Graphics Corp. v. Quickturn Design Sys., Inc.*, 150 F.3d 1374, 1379 (Fed. Cir. 1998).

Aside from the fact that Hologic's proposal is entirely incompatible with the statutory text and well-reasoned precedent, it would do precisely the opposite of what patent law is supposed to do: it would prop up a worthless patent as a barrier to innovation—allowing Hologic to deprive the public of the benefit of competition based on technology that has conclusively been determined to provide no public benefit that justifies suppressing competition. *See generally* Br. Amici Curiae of 26 I.P. Professors, Dkt. 68.

In sum, this Court should deny Hologic's Petition. One form of relief it requests is unavailable: the invalidation of *Arista*. The other form of relief it requests would not reconcile this Court's assignor estoppel precedents. Instead, it would further complicate the law by casting doubt on the legal effect of a duly entered final judgment of invalidity, and would do violence to settled law of both this Court and the Supreme Court—all only to serve Hologic's narrow interest in frustrating legitimate competition from an innovative and improved product. This Court can and should reconcile its assignor estoppel law, but it should do so by granting Minerva's Petition and denying Hologic's.

BACKGROUND

Hologic's petition concerns the '183 patent, which covered a specific way of detecting the presence of a uterine perforation prior to performing an endometrial ablation. In 2001, inventor Csaba Truckai assigned his interest in the '183 patent, which Hologic later acquired. Years later, Truckai founded a new company—Minerva—and developed a new technique for detecting perforations in the uterus. *Minerva Pet.* 4-5; Appx12049; Appx13138-39. More than a decade after acquiring the '183 patent, Hologic sued Minerva and alleged that the new technique infringed the '183 patent.

Minerva instituted an *inter partes* review, asserting that the '183 was unpatentable. Hologic fully participated in the *inter partes* review. The Patent Trial and Appeal Board ("PTAB") agreed with Minerva and determined in December 2017 that all claims of the '183 were unpatentable as obvious. In 2019, this Court affirmed the PTAB's decision in an appeal brought by Hologic. Hologic neither asked this Court to reverse *Arista*, nor did it seek Supreme Court review. *Hologic, Inc. v. Minerva Surgical, Inc.*, 764 F. App'x 873 (Fed. Cir. 2019). That

decision is final. The '183 patent has *conclusively* been determined to be invalid.

Even after the '183 patent was invalidated, Hologic argued to the district court in this case that it could still assert a right to damages and a permanent injunction excluding Minerva's novel device from the market as "infringing" the claims of the '183 "patent." The district court refused to award relief on an invalid patent, and its judgment granted Hologic relief only for supposed infringement of the '348 patent at issue in Minerva's Petition.

The Panel affirmed, applying the fundamental principle that "[b]ecause the '183 patent claims are invalid, Hologic cannot assert those claims or seek ongoing monetary or injunctive relief based on infringement." Panel Op. 14. This Court's prior "affirmance of the Board's invalidity decision" in the *inter partes* review "is dispositive ... regardless of how the validity question came to this court, and regardless of whether assignor estoppel bars Minerva from challenging the patent's validity in this district court case." Panel Op. 14.

The Panel’s decision followed from a straightforward application of this Court’s precedents, including *Mentor Graphics Corp.*, 150 F.3d 1374, *Fresenius USA, Inc.*, 721 F.3d 1330, and *XY, LLC*, 890 F.3d 1282.

ARGUMENT

I. Whether Assignor Estoppel Is Available in *Inter Partes* Reviews Is Not Before the Court.

Hologic asks the Court to overrule *Arista* in this case. Hologic Pet.

1. But neither the district court nor the Panel in this case applied *Arista* when entering their judgments. This Court’s judgment affirming the PTAB’s invalidity determination, rooted in *Arista*’s rule that assignor estoppel does not apply in *inter partes* review proceedings, was entered in a separate case (No. 2018-1550), and is not before the Court.

So when Hologic asks this Court to reconsider *Arista* in *this* case, it is actually asking this Court to re-open appeal No. 2018-1550, and reconsider the judgment in *that* case. But it is a bedrock principle that a “final judgment on the merits of an action precludes the parties ... from relitigating issues that were or could have been raised in that action.” *Federated Dep’t Stores, Inc. v. Moitie*, 452 U.S. 394, 398–99 (1981). This “is a rule of fundamental and substantial justice, ‘of public policy and of private peace,’ which should be cordially regarded and

enforced by the courts.” *Id.* at 401 (quoting *Hart Steel Co. v. Railroad Supply Co.*, 244 U.S. 294, 299 (1917)). Hologic had a full and fair opportunity to attack *Arista* in the case where it applied (No. 2018-1550). It may not launch a collateral attack against the judgment in that case here.

As Hologic recognizes, it is well-established that a “final judgment in the [*inter partes* review] context has an ‘issue-preclusive effect on any pending or co-pending actions involving the patent,’ including an action pending in a district court.” Hologic Pet. 8-9 (quoting *XY, LLC*, 890 F.3d at 1294); *see also B & B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 148 (2015); *MaxLinear, Inc. v. CF CRESPE LLC*, 880 F.3d 1373, 1377 (Fed. Cir. 2018). Thus, as Hologic has never contested, the PTAB’s invalidation of the ’183’s claims, as affirmed by this Court, is a final judgment entitled to preclusive effect. *MaxLinear, Inc.*, 880 F.3d at 1377. This Court cannot reverse *Arista* here without reopening that prior judgment and violating bedrock preclusion principles. If Hologic wanted to see *Arista* reversed so that it could prevent Minerva from asserting invalidity in an *inter partes* review, the time and place for Hologic to raise that argument was in the *inter partes* review. Hologic

failed to do so. *See, e.g.,* Hologic’s Response, *Minerva Surgical Inc. v. Hologic, Inc.*, No. IPR2016-00868, 2017 WL 3090850 n.1 (P.T.A.B. Jan. 11, 2017) (“[Hologic] will not assert the defense [of assignor estoppel] here in view of decisions concerning the inapplicability of such arguments before the Board.”)

Hologic also never challenged *Arista* in this case until its petition. To the contrary, it argued before the panel that “*Arista* has *nothing to do with* the application of assignor estoppel in a district court.” Hologic Br. 35-36 (emphasis added). When Judge Stoll observed that the Court could reconcile its precedents by revisiting *Arista*’s holding *at some point*, Hologic revised its position in its rehearing petition in an attempt to get the Court to revisit the decision now. Hologic now suggests *Arista* has much “to do with the application of assignor estoppel in district court” and baselessly asserts that this Court can somehow revisit *Arista* in an appeal from a district court. That argument has been forfeited. *See Customedia Techs., LLC v. Dish Network Corp.*, 941 F.3d 1174, 1175 (Fed. Cir. 2019).

Even if this case provided an opportunity for this Court to reconsider *Arista*, there is no reason for the Court to do so. *Arista*

applied clear statutory text, precisely as the Supreme Court has held is required. As *Arista* recognized, assignor estoppel cannot bar an assignor from instituting an *inter partes* review because the governing statute allows “a person who is not the owner of a patent” to institute an *inter partes* review. *Arista*, 908 F.3d at 803-04 (quoting 35 U.S.C. § 311(a)). And an assignor, by definition, is “a person who is not the owner of a patent.” *Id.* Reversing *Arista* and importing assignor estoppel into *inter partes* reviews would fly in the face of the Supreme Court’s repeated admonitions that “courts should not read into the patent laws limitations and conditions which the legislature has not expressed.” *Bilski v. Kappos*, 561 U.S. 593, 602-04 (2010) (citations and quotation marks omitted).

Further, while Hologic blames *Arista* for concurrent *inter partes* reviews and litigation, it is widely recognized that the America Invents Act (“AIA”) itself was crafted to incentivize defendants in patent infringement litigation to file *inter partes* reviews, and that, in fact, Congress *fully intended for them to do so*. *Fresenius USA, Inc.*, 721 F.3d at 1339 (“Congress expected reexamination to take place concurrent with litigation, and that cancellation of claims during reexamination

would be binding in concurrent infringement litigation.”); Michael S. Greve, *Exceptional, After All and After Oil States: Judicial Review and the Patent System*, 26 B.U. J. Sci. & Tech. L. 1, 36 (2020) (“[A] demand for *inter partes* review ... is the predictable and usual response to a judicial infringement proceeding. Congress in the AIA fully intended that result, and it clearly meant to facilitate administrative patent invalidation.”). Indeed, prior to *Arista*, in 2017, eighty percent of *inter partes* reviews had been filed while the challenged patent was already in an active district court case. Pedram Sameni, *Patexia Insight 44: Eighty Percent of IPR Filings are for Defensive Purposes*, Patexia, Nov. 8, 2017, available at <https://perma.cc/22ZE-8296>. There is no reason to believe that any meaningful proportion of those cases involving parallel proceedings stem from differential treatment of assignor estoppel in district court and *inter partes* review proceedings. Parallel *inter partes* reviews and district court proceedings will persist, whether this Court reconciles its assignor estoppel precedents or maintains them.

Of course, to the extent the Court shares Hologic’s concerns that differences in the application of assignor estoppel in district court and in *inter partes* reviews prompt unnecessary concurrent proceedings,

these concerns would be fully addressed by eliminating assignor estoppel in district court—an option Minerva urged both before the Panel and in its Petition, and which, as Minerva has explained, would promote rather than undermine Congress’s objective: the efficient invalidation of bad patents through *inter partes* reviews. Minerva Pet. 11-12.

In sum, this case presents an ideal vehicle for bringing consistency to the Court’s assignor estoppel precedents, but only if the Court wishes to do so by revising the doctrine’s application *in district court*.

II. The Court Should Not Create A New Equitable Exception to Collateral Estoppel to Allow Plaintiffs to Obtain Patent Judgments On Invalidated Patent Claims.

Hologic proposes what it considers an alternative to overruling *Arista* in this case. Hologic seeks *en banc* review so that this Court could invent a new equitable “exception” to collateral estoppel. Hologic Pet. 16. That proposed exception would allow a holder of a patent duly determined to be invalid in a full and fair *inter partes* review proceeding to assert that non-patent against an assignor if the assignor initiated the *inter partes* proceeding that resulted in the judgment of invalidity. Hologic Pet. 15. This is actually a proposal about *collateral* estoppel,

not *assignor* estoppel. Hologic does not pretend that it would be anything other than an unprecedented departure from long settled collateral estoppel law. Hologic cites no case, concurrence or dissent, or other authority that adopts or encourages its proposed exception—which is not surprising given that it appears to be a rule devised for Hologic’s convenience rather than in pursuit of any sound patent law policy.

As an initial matter, Hologic’s proposed “equitable” exception has little to do with assignor estoppel. Assignor estoppel prevents one who assigned the rights to a patent from later obtaining from a *court* a judgment of “invalidity . . . based on novelty, utility, patentable invention, anticipatory matter, and the state of the art.” *Diamond Sci. Co. v. Ambico, Inc.*, 848 F.2d 1220, 1224 (Fed. Cir. 1988) (quotation marks omitted). Hologic’s claim against Minerva regarding the ’183 patent failed *without* the court entering a judgment of invalidity. Minerva prevailed regarding the ’183 patent because, in light of *another* proceeding, the patent ceased to exist while the trial court litigation was pending.

It is fundamental that a patent infringement claim fails if the patent does not exist. *See* 35 U.S.C. § 271. “[U]nless a patent exists, and is in force at the time of trial and judgment, [patent infringement] suits fail” because the plaintiff “no longer has a viable cause of action in the pending case.” *Fresenius USA, Inc.*, 721 F.3d at 1344–45 (citation and alterations omitted). This Court has held for decades that invalidation of patent claims “will require a dismissal of” a suit for infringement of those claims “since a necessary condition for such an action is the existence of . . . valid and interfering patents.” *Id.* at 1340 (quoting *Slip Track Systems, Inc. v. Metal Lite, Inc.*, 159 F.3d 1337, 1340 (Fed. Cir. 1998)). Under the plain terms of the Patent Act, therefore, Hologic cannot obtain a judgment against Minerva on invalidated patent claims.

In light of this bedrock premise upon which all patent litigation rests, and given the indisputable fact that Hologic’s patent has been finally determined to be invalid, Hologic cannot prevail on its ’183 patent claim against Minerva unless it convinces this Court to adopt a legal doctrine that *revives* the patent. Any such doctrine would surely not be a species of “assignor estoppel.” Assignor estoppel operates to

prevent assignors from obtaining certain invalidity judgments from courts. That is altogether different from giving a patent already determined to be invalid the legal effect of a valid patent.

Hologic is really asking this Court to create an exception to settled collateral estoppel law. The Supreme Court and this Court have rightly rejected general equitable exceptions to collateral estoppel like the one Hologic proposes. Because collateral estoppel “serves vital public interests beyond any individual judge’s ad hoc determination of the equities in a particular case,” there “is simply ‘no principle of law or equity which sanctions the rejection by a federal court of the salutary principle of *res judicata*.’” *Federated Dep’t Stores, Inc.*, 452 U.S. at 401 (citation omitted).

The Supreme Court has found it especially important to rigorously enforce collateral estoppel in the patent law context, where a final judgment of invalidity serves the public interest. For example, in *Blonder-Tongue Labs., Inc. v. Univ. of Illinois Found.*, 402 U.S. 313 (1971), the Supreme Court rejected a rule that the holder of a patent determined to be invalid in a prior proceeding was collaterally estopped from asserting the patent against *only* the defendant in that prior

proceeding. *Id.* at 349–50. Limiting the preclusive effect of a judgment of invalidity was inconsistent with the public interests the patent law serves. *Id.* at 343 (“The far-reaching social and economic consequences of a patent . . . give the public a paramount interest in seeing that patent monopolies . . . are kept within their legitimate scope.”) Pointing to *Lear, Inc. v. Adkins*, 395 U.S. 653 (1969), and its abolition of licensee estoppel, the Court reiterated the public interest in “eliminating obstacles to suit by those disposed to challenge the validity of a patent.” *Id.* at 345. Because a narrow view of collateral estoppel allowed holders of invalid patents to continue to reap supracompetitive benefits, it could not stand: “federal law requires[] that all ideas in general circulation be dedicated to the common good unless they are protected by a valid patent,” so “the holder of a patent should not be insulated from the assertion of defenses and thus allowed to [benefit from] the use of an idea that is not in fact patentable.” *Id.* at 349-50.

In light of this precedent, this Court has consistently held that a final judgment of invalidity prevents the holder of a bad patent from “asserting the patent in *any* further proceedings.” *XY, LLC*, 890 F.3d at 1294 (emphasis added); *id.* (“[A]n affirmance of an invalidity finding,

whether from a district court or the Board, has a collateral estoppel effect on all pending or co-pending actions.”) This reflects so fundamental a principle of patent law that the Court may raise the bar to further assertion of the patent *sua sponte*. *Id.* at 1294-95. And this rule holds whether or not the defendant previously assigned the patent: “assignor estoppel does not limit [assignors’] ability to defend themselves” by “arguing that the patentee is itself collaterally estopped from asserting a patent found invalid in a prior proceeding.” *Mentor Graphics*, 150 F.3d at 1379. This longstanding precedent promotes clarity and finality and prevents suppression of innovation by patents that should never have issued.

On the other hand, it is hard to imagine an approach more inconsistent with sound patent policy than Hologic’s. Hologic’s proposal would create uncertainty and undermine the finality of patent judgments. It would reduce incentives for defendants to use *inter partes* review proceedings in precisely the way Congress intended—to eliminate patents that do not provide the value necessary to support the patent holder’s monopoly. And, most importantly, it would prop up bad patents as barriers to innovation, despite conclusive findings that they

are not patents and are not worthy of delivering such supracompetitive benefits. Indeed, in this case Hologic asks the Court to sanction use of an invalid patent to obtain a permanent injunction excluding a competitor from the market.

The Court should not reverse its well-settled law in favor of Hologic's bizarre proposal.

CONCLUSION

While the Court should grant *en banc* review of the issues raised in Minerva's petition for rehearing, the *en banc* Court should not reconsider the portion of the Panel's decision affirming the district court's decision not to award judgment or relief on the '183 patent.

June 18, 2020

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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 18th day of June, 2020, and that a copy was served on all counsel of record by the CM/ECF system.

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CERTIFICATE OF COMPLIANCE WITH RULE 35

This brief complies with the type-volume limitation of Federal Rule of Appellate Procedure 35(e)(4). The brief contains 3,486 words, excluding the parts of the brief exempted by Federal Circuit Rule 35(c)(2).

This brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rule of Appellate Procedure 32(a)(6). The brief has been prepared in a proportionally spaced typeface using Microsoft Word 2016 in 14-point Century Schoolbook font.

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