

A Cautionary Tale: Lessons from *Elekta Ltd. V. ZAP Surgical Systems, Inc.* March 2024



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Elekta Ltd. v. ZAP Surgical Systems, Inc., 81 F.4th 1368 (Fed. Cir. 2023) offers a warning to patent applicants who choose not to put a particular argument on record during prosecution: applicant’s silence as to the particular argument may be evidence of applicant’s agreement with the basis underlying the rejection the argument would address.

Elekta is an appeal from a decision of the Patent Trial and Appeal Board (PTAB). The claim at issue was directed to a device for treating a patient with ionizing radiation produced by a linear accelerator mounted to a particular structure. In the *inter partes* review leading to *Elekta*, the PTAB relied on two prior art references to invalidate Elekta’s device claim. The first reference disclosed an x-ray imaging machine having the structure of Elekta’s device. The second reference disclosed the linear accelerator of Elekta’s device.

During prosecution of the patent at issue in *Elekta*, Elekta cited a reference disclosing another imaging device to the US Patent & Trademark Office (Office), and the examiner used the reference in an obviousness rejection of the claims. When rebutting the rejection, Elekta did not argue that *imaging* art was not analogous to its *therapeutic* device.

The Court found that the prosecution history, the content of the asserted references, and expert testimony, taken together, provided substantial evidence to support a motivation to combine in *Elekta*. In elaborating on the relevance of the prosecution history, the Court stated, “during prosecution, the patentee notably did not argue that prior art references directed to imaging devices were not relevant art.” *Elekta* at 1375.

The Court also reiterated that a finding of a reasonable expectation of success need not be explicit, particularly where, as here, arguments relating to a reasonable expectation of success were intertwined with arguments related to motivation to combine.

On its face, *Elekta* stands for the relatively uncontroversial proposition that prosecution history may support a motivation to combine. The nuance in *Elekta* that may give some pause is that it was the patentee’s silence, and not its statement, during prosecution that provided the relevant support. Taken to its extreme, *Elekta* could be

used to support an argument that art cited to the Office in fulfillment of the duty of disclosure is an admission that the art is analogous.

In response to *Elekta*, patent practitioners should consider the following steps:

- Update Information Disclosure Statements to include a statement that the submission does not constitute an admission that the listed documents are analogous to the claimed invention, and reserves the right to present a contrary argument.
- Do not allow potential arguments to a rejection to go unaddressed during prosecution.
- Consider a statement that silence as to a particular argument should not be construed as agreement with the underlying proposition and reserves the right to present the argument.

Whether subsequent decisions further elaborate on the role of the implicit prosecution history in patent proceedings remains to be seen. In the meantime, applicants should take care to address on the written record those suppositions with which they do not agree so that silence does not later mean consent to those suppositions.