

**Elekta Ltd. v. Zap Surgical Systems, Inc.:**  
**Analyzing the Relevance of Cited**  
**References in an IDS**  
**Case Study**

**Innoastra**

# Elekta Ltd. v. Zap Surgical Systems, Inc.: Analyzing the Relevance of Cited References in an IDS

## Background

Elekta Limited (hereinafter "Elekta") was granted US patent 7,295,648 B2, '648– titled "Method and Apparatus for Ionizing Radiation Treatment". Elekta appealed to the Federal Circuit [Elekta Ltd. v. Zap Surgical Systems, Inc., F.4th - (Fed. Cir. Sept 21, 2023)] after the Patent Trial and Appeal Board (PTAB) found the patent '648 obvious and not patentable.

'648 discloses a radiation therapy/surgery device for treating a patient with radiation therapy. At the time of filing the patent application, Elekta submitted an IDS, which is needed to be submitted by the applicant to fulfil the duty to disclose. However, Elekta filed a few references directed towards radiation imagery.

When a third party challenged the patent, the Patent Trial and Appeal Board (PTAB), in an inter partes review (IPR) proceeding, determined that the claims at issue were obvious in view of the combination of two references:

- Firstly, Grady reference, which detailed an X-ray imaging apparatus pertaining to an imaging device.
- Secondly, the Ruchala reference described a radiation therapy apparatus utilizing a linear accelerator (linac) to emit radiation pertained to a therapy device.

Elekta appealed to CAFC and contended that an individual skilled in the relevant technical field would not have found a reason to integrate an imaging apparatus such as the one described in Grady with a therapeutic apparatus like that in Ruchala. Nonetheless, the Federal Circuit upheld the Board's decision, citing that there was ample evidence indicating there was indeed a motivation to combine the two, a finding that was further substantiated by the historical records of the patent prosecution.

## Relevance of References cited in IDS

While it is essential to satisfy the duty of candor and disclose all known references that are material to patentability, patent applicants and their attorneys need to be mindful of how these references are perceived in future proceedings.

The Elekta case underlines the importance of careful communication by patent prosecutors when dealing with references throughout the patent prosecution to prevent creating a prosecution history that unintentionally suggests a willingness to combine unrelated references.

## Key takeaways from Elekta

1. **Strategic Disclosure:** Patent applicants must consider which references to disclose strategically in their IDS. While over-disclosure may seem a safe route to avoid allegations of inequitable conduct, it could also lead to unintended consequences, as seen in Elekta.
2. **Relevance Clarification:** When disclosing references in an IDS, it may be beneficial to include explanations clarifying the relevance or irrelevance of references, particularly if they are from

fields that could be deemed unrelated to the claimed invention. This could help mitigate risks associated with the patent tribunal's independent relevance determination. If the references are from unrelated technical fields, there is no need to mention them in the IDS, as Elekta did.

3. **Prosecution Strategy:** Patent practitioners may need to balance the risk of making statements about the relevance of the cited art against the risk of not making such statements. Although robust assertions about the relevance of each reference may not always be advisable, a generic statement regarding compliance with the duty of disclosure without admission to the relevance of the references might be a conservative approach.
4. **Response to Examiner's Rejection:** The Patentee should actively respond to an examiner's rejection based on a reference from a different technology area by explaining on record why the reference is not applicable or combinable, highlighting the significant differences. This is the biggest mistake made by Elekta as they never mentioned that the cited art is directed to an imagery device and is a non-analogous art, either in response to the office actions or at the time of notice of allowance, when the examiner cited a reference directed towards an imagery device.
5. **IPR Strategy for Petitioners:** Petitioners in IPR proceedings can potentially use the broad relevance inferred from an IDS to their advantage, leveraging the absence of patentee assertions to argue for a broader field of prior art and a greater chance of showing obviousness.
6. **IPR Strategy for Patent Owners:** Conversely, patent owners should be ready to contest the relevance of prior art references cited during prosecution and argue against any broad interpretation that could harm the patent's validity.
7. **Record-Keeping:** The patentee should maintain clear records during prosecution that can serve as evidence of the applicant's reasoning behind the relevance of cited references. This documentation may be valuable if the patent is challenged.
8. **Litigation Preparedness:** In light of Elekta, patent litigators should be prepared to argue the relevance or irrelevance of the references cited in IDSs and examine how those references were treated during the prosecution phase.

Ultimately, the Elekta decision illustrates that the IDS is not merely a procedural formality but a document that can have significant implications for the patent's robustness against future challenges. Therefore, careful consideration must be given to its preparation and the accompanying statements made during prosecution.

## About InnoAstra

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