

***Elekta Limited v. Zap Surgical Systems, Inc.* 81 F.4th 1368 (Fed. Cir. 2023) (Reyna, Stoll, Stark)**

BY TREY POWERS

Zap filed an IPR petition alleging obviousness of a patent owned by Elekta. The petition relied on a combination of two references. The Board found a reason to combine the references and ultimately found obviousness of the challenged claims. Elekta appealed, arguing that the Board's analysis of motivation to combine was unsupported by substantial evidence and that it failed to make any findings related to reasonable expectation of success. The Federal Circuit rejected these arguments and affirmed.

First, the court found that the Board's motivation-to-combine findings were supported by substantial evidence, including the prosecution history, the teachings of the asserted references, and the expert testimony of record.

Next, the court turned to the Board's reasonable expectation of success findings. The court noted that, unlike a motivation-to-combine determination, which requires explicit analysis, a finding of reasonable expectation of success can be implicit. And the court held that permitting implicit consideration of expectation of success in a Board decision is not in tension with the Administrative Procedure Act's requirement that agencies explain their decisions with "sufficient precision" and articulated reasoning—at least where,

as in this case, the Board's findings on reasonable expectation of success were sufficiently related to a thorough motivation-to-combine analysis. The court noted that Elekta itself made "blended" arguments, dealing with reasonable expectation of success in the same way as and citing the same arguments that it made in support of its no-motivation-to-combine arguments. The Federal Circuit cautioned that a finding of a reason to combine does not necessarily lead to a finding of expectation of success. But, when the underlying evidence and arguments are closely related, there can be an implicit finding of expectation of success when that inquiry is sufficiently intertwined with a reason to combine.

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