

**ALERT**

# Federal Circuit Patent Bulletin: *In re Smith Int'l, Inc.*

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October 11, 2017

*"The correct inquiry in giving a claim term its broadest reasonable interpretation in light of the specification is not whether the specification proscribes or precludes some broad reading of the claim term adopted by the examiner. And it is not simply an interpretation that is not inconsistent with the specification. It is an interpretation that corresponds with what and how the inventor describes his invention in the specification, i.e., an interpretation that is 'consistent with the specification.'"*

On September 26, 2017, in *In re Smith Int'l, Inc.*, the U.S. Court of Appeals for the Federal Circuit (Lourie,\* Reyna, Hughes) reversed the U.S. Patent and Trademark Office Patent and Trial Appeal Board ex parte reexamination decision that upheld the examiner's rejections of certain claims of U.S. Patent No. 6,732,817, which related to a downhole drilling tool for oil and gas operations. The Federal Circuit stated:

A patent claim is anticipated "only if each and every element is found within a single prior art reference, arranged as claimed." Obviousness is a question of law based on underlying factual findings. On appeal Smith challenges the Board's construction of "body" and anticipation and obviousness determinations. We first discuss the Board's claim construction.

In affirming the examiner's rejections, the Board determined that the term "body" is a "generic term such as 'member' or 'element' that by itself provides no structural specificity." The Board reasoned that although "the specification describes the body as a discrete element separate from other elements," the specification does not "define[] the term 'body'" or "preclude the Examiner's interpretation." The Board

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## Practice Areas

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also rejected Smith's argument that the person of ordinary skill in the art would understand the term "body" as a distinct element from other components, reasoning that Smith "has not shown that the parts identified in the prior art as bodies are so similar as to create a specific identity of what a body is." The Board noted that the claims "essentially recite only a body and the movable cutting arms," and other components, such as "a mandrel," are not recited in the claims. Thus, the Board reasoned that it was "perfectly reasonable" to understand the term "body," given its broadest reasonable interpretation, as "the overall portion or portions of the downhole tool that define the bore and may include one or more other elements." . . .

We conclude that the Board's construction of "body" was unreasonably broad. Even when giving claim terms their broadest reasonable interpretation, the Board cannot construe the claims "so broadly that its constructions are unreasonable under general claim construction principles." "[T]he protocol of giving claims their broadest reasonable interpretation . . . does not include giving claims a legally incorrect interpretation" "divorced from the specification and the record evidence."

It is true that some of the claims at issue recite a broad term "body" without further elaboration on what the term "body" encompasses. However, the remainder of the specification does not use the term as a generic body. There is no dispute that the '817 patent specification consistently describes and refers to the body as a component distinct from others, such as the mandrel, piston, and drive ring. Therefore, the Board's reasoning that because the specification does not "in and of itself proscribe the Examiner's construction," the examiner's interpretation was reasonable was erroneous.

The correct inquiry in giving a claim term its broadest reasonable interpretation in light of the specification is not whether the specification proscribes or precludes some broad reading of the claim term adopted by the examiner. And it is not simply an interpretation that is not inconsistent with the specification. It is an interpretation that corresponds with what and how the inventor describes his invention in the specification, i.e., an interpretation that is "consistent with the specification." The Board emphasized that the patentee here did not act as a lexicographer, and that the specification neither defines nor precludes the examiner's reading of the term "body." Accordingly, the Board found that nothing in the specification would disallow the examiner's interpretation, rendering it "reasonable." However, following such logic, any description short of an express definition or disclaimer in the specification would result in an adoption of a broadest possible interpretation of a claim term, irrespective of repeated and consistent descriptions in the specification that indicate otherwise. That is not properly giving the claim term its broadest reasonable interpretation in light of the specification.

Relying on the incorrect interpretation of the term "body" as a generic term in the claims, the Board affirmed the examiner's arbitrary inclusion and exclusion of separately described components to and from the term "body." It reasoned that although a body, a mandrel, and moveable arms are all consistently identified and described separately in the specification, the generic claim term "body" includes some of the separately described components, such as a mandrel, but not others, such as moveable arms, solely because the "moveable arm" is recited in the claims and the "mandrel" is not. But, giving the term "body" such a strained breadth in the face of the otherwise different description in the specification was unreasonable. . . .

The Board's findings regarding Eddison's teachings rest on its broad construction of "body," which the parties do not dispute. . . . Because such findings depended on an incorrect claim construction, the Board's findings of anticipation are not supported by substantial evidence. Similarly, the Board's factual findings underlying its obviousness determination relating to the Eddison reference are also not supported by substantial evidence. It is undisputed that Jewkes and Wardley do not teach or render obvious the missing elements discussed above. We therefore conclude that the challenged claims of the '817 patent are not unpatentable as obvious over the combination of Eddison and the additional references. The rejections of all of the appealed claims are therefore reversed.