

*IN RE: SMITH INT'L, INC.*, Appeal No. 2016-2303 (Fed. Cir. September 26, 2017) (Lourie, Reyna, and Hughes). Appealed from the U.S.P.T.O. Patent Trial and Appeal Board.

Background:

Smith International, Inc. ("Smith") owns a patent directed to an expandable drilling tool with a cylindrical body for downhole drilling during oil and gas operations. During *ex parte* reexamination, the claims of Smith's patent were rejected as being anticipated by WO 00/31371 ("Eddison") by broadly interpreting the claim term "body" to encompass multiple structural components described in the specification, such as a "mandrel" and a "cam sleeve," which are disclosed by Eddison.

In affirming the Examiner's rejection, the Board stated that the claim term "body" is a "generic term such as 'member' or 'element' that by itself provides no structural specificity." The Board noted 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 of "body" as a broad term that may encompass other components such as "mandrel" and "cam sleeve," which are specifically defined in the specification. The Board asserted that the term "body" is recited in the claims without further limiting features and that the specification neither defines the term nor prohibits the examiner's broad interpretation. Smith appealed

Issue/Holding:

Was the Board's broad interpretation of the term "body" reasonable in light of the claim language and specification? No, reversed.

Discussion:

The Federal Circuit held that the Board's construction of "body" was unreasonably broad and that the Board gave the claims a "legally incorrect interpretation divorced from the specification and the record evidence." The Federal Circuit agreed with the Board that the claims recite the term "body" without further defining the scope of the term "body" in the claim language. However, contrary to the Board, the Federal Circuit found that the specification consistently describes and refers to the "body" as a distinct component from other structural elements, such as the "mandrel," "piston," and "drive ring." The Federal Circuit noted that Smith's patent separately identifies and describes various components of its drilling tool, such as the "body," "moveable arms," "mandrel," "piston," and "drive ring." Thus, the Board failed to point to any description of the "body" in the specification that would support such a broad construction of the term "body."

The Federal Circuit stated that following the Board's 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. The Federal Circuit stated that the correct inquiry is giving a claim term its broadest *reasonable* interpretation in light of the specification. The interpretation must *correspond* with what and how the inventor describes his invention in the specification, *i.e.*, an interpretation that is "consistent with the specification."