

Federal Circuit Reverses PTAB on BRI

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In *In RE: Smith International, Inc.*, Slip. Op. 2016-2303 (Fed. Cir. September 26, 2017), the Federal Circuit reversed a Patent Trial and Appeal Board (PTAB) decision upholding an Examiner's rejection because the interpretation of the claim term "body" as a generic term that broadly encompasses multiple components of a cited reference was not reasonable in light of the specification.

In particular, the Federal Circuit found that the specification consistently uses the term "body" with reference to a specific component and separately recites other components such as a "mandrel." The Federal Circuit found that by interpreting the claim term "body" as a generic claim term that encompasses the "mandrel," "cam sleeve," and other components of the cited reference, the claim term "body" was not properly given its broadest reasonable interpretation *in light* of the specification.

As stated by the Federal Circuit, "[t]he 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." *Id.* at 13.

The Federal Circuit concluded that "the "body" in the '817 patent claims is a component distinct from other separately identified components in the specification, such as the mandrel, and cannot be understood to include the "cam sleeve" in Eddison." *Id.* at 14.

This decision by the Federal Circuit provides a limitation on the broadest reasonable interpretation standard that may be leveraged through repeated and consistent use of claim terms in the specification.