

## Federal Circuit Reigns in PTAB on Broadest Reasonable Interpretation

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For patent owners, the PTAB's use of the "broadest reasonable interpretation" or "BRI" is often frustrating and sometimes fatal. That appeared to be the case for the patent owner Smith International, Inc., the owner of U.S. Patent No. 6,732,817. Fortunately for Smith, the Federal Circuit put the brakes on the PTAB's application of BRI and, in a rare precedential reversal, confirmed Smith's patent rights.

This case arose in the context of an *ex parte* reexamination. Smith's corporate parent, Schlumberger, sued Baker Hughes on the '817 patent in 2012. Baker Hughes requested *ex partere*examination. Interestingly, once IPR proceedings became available, Baker Hughes also petitioned for inter partes review of the '817 patent, but the PTAB denied institution in favor of the *ex parte* reexamination.

The '817 patent is directed to a down hole drilling tool for oil and gas operations. The case primarily concerns what the word "body" means in the context of the '817 patent. Each of the independent claims recites, among other things, "a body" and a non-pivotable, moveable arm that "engages" the claimed body. The PTAB affirmed the examiner's interpretation of the term "body" as a broad term that may encompass other components such as a "mandrel" and "cam sleeve." The Examiner reasoned that "only the term 'body' is recited in the claims without further limiting features and that the specification neither defines the term 'body' nor prohibits the examiner's broad reading of it." The PTAB agreed, noting that the term "body" is a "generic term such as 'member' or 'element' that by itself provides no structural specificity." That bit about "generic terms" and the specification "not prohibiting" the construction is an unwelcome yet familiar refrain for patent owners. The Federal Circuit has finally pushed back.

In a precedential decision by Judge Lourie, the Court concluded that the PTAB's construction of "body" was unreasonably broad. The Court cited to its prior decision in *Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir. 2015) for the proposition that the Board cannot construe claims so broadly as to be unreasonable under general claim construction principles. It also found that the '817 patent consistently describes and refers to the "body" as a component distinct from others, such as the mandrel, piston, and drive ring. So the PTAB erred in reasoning that the specification does not proscribe the Examiner's construction. The Court then instructed the PTAB that:

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 Court went on to criticize the Board’s reasoning that because the patentee did not act as his own lexicographer, and because the specification “neither defines nor precludes the examiner’s reading of the term,” that the examiner’s construction was reasonable. Under that logic, the Court stated, “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.” And that, stated the Court “is not properly giving the term its broadest reasonable interpretation *in light* of the specification.” The improper result was the “arbitrary inclusion and exclusion of separately described components to and from the term ‘body.’” In view of the facts, the Court reversed the Board.

For patent owners, Judge Lourie’s admonitions are most welcome. They should provide some ammunition against the most egregious applications of the broadest reasonable interpretation paradigm.

The case is *In re: Smith International, Inc.*, Case No. 2016-2303 (Fed. Cir. 2017)

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National Law Review, Volume VII, Number 291

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