



Archetype IP

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In re Smith International (Sept. 26) reversed the Board's anticipation and obviousness determinations because of a faulty claim construction under the broadest reasonable interpretation ("BRI") standard that applies in Patent Office proceedings. This case helps clarify the slight and often hard-to-find difference between BRI and *Phillips*-style district court claim construction.

The Board construed the word "body" as a generic structural feature that could be met by an interconnected combination of several discrete structures (*i.e.*, a body, a mandrel, and a cam sleeve) in the prior art. The Federal Circuit held that construction impermissibly broad because the specification "consistently describes and refers to the body as a component distinct from others, such as the mandrel, piston, and drive ring." Properly (and more narrowly) construed under BRI, the prior art did not describe the "body" of the claimed invention.

The Federal Circuit explained that the "correct" BRI inquiry "is not whether the specification proscribes or precludes some broad reading of the claim term," and that BRI is "not simply an interpretation that is not inconsistent with the specification." Instead, the correct BRI 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."

We know from prior cases that BRI is based on how a person of ordinary skill would understand the claims in light of the specification, *e.g.*, *Trivascular v. Samuels* (Fed. Cir. 2016), and *In re Smith* affirms the use of standard *Phillips*-style interpretive tools for making that determination (*e.g.*, reliance on repeated and consistent usage of a term or phrase in the specification). The rules relating to lexicography and disclaimer must apply to ensure that the BRI is consistent with the specification. The prosecution history is relevant to BRI in the same manner as in *Phillips*-style claim construction. *E.g.*, *Microsoft v. Proxycorr* (Fed. Cir. 2015). And dictionaries may be used in determining BRI. *E.g.*, *Trivascular v. Samuels* (Fed. Cir. 2016); *but see PPC Broadband v. Corning Optical Comms.* (Fed. Cir. 2016)(Nos. 2015-1361 et al.)(citing dictionary definition to illustrate how claim construction would be different under *Phillips*).

So, where does that leave us -- what is the "daylight" between Patent Office BRI and *Phillips*-style district court claim construction? The only *Phillips*-style interpretive concepts that appear to be **not** applicable to BRI are:

- Seeking what the inventors actually invented and intended to encompass within the claim. *See, e.g., Phillips v. AWH* (Fed. Cir. 2005)(en banc)(the "interpretation to be given a term can only be determined and confirmed with a full understanding of what the inventors actually invented and intended to envelop with the claim.").
- Use of extrinsic evidence (other than dictionaries?).

It's not clear to me that there is a real difference (except where the decision-maker wants a particular result), but, based on the cases, BRI analyzes the claims, specification, and prosecution history using *Phillips*-style district court interpretive rules and cannons **but** the Board is permitted to resolve any ambiguity or doubt in favor of breadth as opposed to in favor of what was actually invented.

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