

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SMITH INTERNATIONAL, INC.,
J. JEFFREY GUNN, and TRASKBRITT, P.C.¹

Appeal 2015-008323
Reexamination Control 90/012,912
Patent US 6,732,817 B2²
Technology Center 3900

Before DANIEL S. SONG, MICHAEL L. HOELTER, and
BRETT C. MARTIN, *Administrative Patent Judges*.

MARTIN, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Smith International, Inc. is the real party in interest. App. Br. 2.

² Issued to Dewey et al. on May 11, 2004 (hereinafter the '817 patent).

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STATEMENT OF THE CASE

The Patent Owner appeals under 35 U.S.C. §§ 134(b) and 306 from the Examiner's final rejection of claims 28–36, 39–46, 50, 79–81, and 93–99, which are the only claims subject to this appeal, of which claims 28, 43, and 93 are the independent claims. We have jurisdiction under 35 U.S.C. §§ 134(b) and 306.

We are informed that the '817 patent is involved in pending litigation styled *Schlumberger Technology Corp., Smith International, Inc. and Specialised Petroleum Services Group, Ltd. v. Baker Hughes Inc.*, Case No. 4:12-cv-3573 in the Southern District of Texas. App. Br. 2.

We AFFIRM.

THE INVENTION

The Patent Owner's invention is directed generally to “underreamers used for enlarging a borehole below a restriction to result in a borehole that is larger than the restriction.” Spec. col. 1, ll. 16–18. Claim 28, reproduced below, is illustrative of the claimed subject matter:

28. An expandable downhole tool for use in a drilling assembly positioned within a wellbore having an original diameter borehole and an enlarged diameter borehole, comprising: a body; and at least one non-pivotable, moveable arm having at least one borehole engaging pad adapted to accommodate cutting structures or wear structures or a combination thereof and having angled surfaces that engage said body to prevent said arm from vibrating in said second position; wherein said at least one arm is moveable between a first position defining a collapsed diameter, and a second position defining an expanded diameter approximately equal to said enlarged diameter borehole.

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REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Jewkes	US 6,059,051	May 9, 2000
Eddison	WO 00/31371	June 2, 2000
Wardley	EP 0 246 789	Nov. 25, 1987

THE REJECTIONS ON APPEAL

The Examiner made the following rejections:

1. Claims 28–36, 39, 40, 42, 79, 80, and 93–98 stand rejected under 35 U.S.C §102(b) as being anticipated by Eddison. Ans. 2.
2. Claims 43–46 and 49 stand rejected under 35 U.S.C §103(a) as being unpatentable over Eddison and Jewkes. Ans. 6.
3. Claims 28, 40, 41, 43, 50, 80, 81, 93, and 99 stand rejected under 35 U.S.C §103(a) as being unpatentable over Eddison, Wardley, and Jewkes. Ans. 9.

ANALYSIS

According to the Patent Owner, the Examiner’s rejections, all of which rely upon Eddison as the sole or base reference, are improper because they use an incorrect construction of the term “body” as used in the claims. App. Br. 12. The Patent Owner provides two main arguments against the Examiner’s construction: 1) that it “overlooks the fact that a downhole tool’s ‘body’ is distinct from other parts of the downhole tool” and 2) that it “overlooks the understanding of a person of skill in the art as evidenced by various references of record as to the meaning of the term ‘body’ in the relevant field.” App. Br. 13–14.

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As to the first argument, the Patent Owner appears merely to argue that its nomenclature should control because it describes in the patent an item called a “body,” whereas other components, such as a “mandrel,” have different names and are distinct elements. App. Br. 14. While it may be true that the ’817 patent *describes* a body as a discrete element separate from other elements when discussing various embodiments, such does not in and of itself proscribe the Examiner’s construction. Nor has the Patent Owner acted as its own lexicographer and *defined* the term “body” so as to preclude the Examiner’s interpretation. We agree with the Examiner that the term “body” as used in the claims is essentially a generic term such as “member” or “element” that by itself provides no structural specificity. *See* Ans. 14.

As to the Patent Owner’s argument regarding how those of skill in the art would understand “body,” the only evidence provided is that other patents also sometimes describe a “body” as a discrete element as compared to other elements not called a body. *See* App. Br. 19–20. Similar to the Patent Owner’s own Specification, the fact that these other patents label something a “body” does not define body within the art. Further, the Patent Owner 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. Each of the elements in the prior art identified as a “body” by the Patent Owner has a different structure and purpose within that specific tool. For example, we note that Eddison describes a main body 60, while also referring to specific elements such as body 18, mandrel 16, etc. *See* Eddison p. 11, ll. 15–18 and p. 12, l. 10. Neither the main body 60 nor the body 18 is the same as that disclosed in the ’817 patent. It would appear from the various descriptions

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that there can be various elements referred to as a “body” and that something can also be a “main body,” which is akin to the Examiner’s broad, but reasonable construction of the term.

The Patent Owner also takes issue with the Examiner noting that the Patent Owner has not included other elements such as a mandrel or cam or other such elements in the claim and asserts that “the fact that the disclosed mandrel is unclaimed [does not] have any bearing on the proper construction of the term ‘body.’” Reply Br. 12. The Patent Owner misses the point of the Examiner’s statement. Had the Patent Owner included other specific elements in the claims to differentiate what is and is not a body *in the claims* (i.e., if the claim also included a mandrel as a separate element from the claimed body, then obviously a mandrel cannot be a body), then it would be more clear that a body is merely an element of the overall tool rather than a generic, all-encompassing term. The claims, however, essentially recite only a body and the movable cutting arms, such that it is perfectly reasonable to conclude, as the Examiner has done, that the term “body,” when given its broadest reasonable construction in the claims, merely refers to the overall portion or portions of the downhole tool that define the bore and may include one or more other elements.

We also disagree with the Patent Owner that the Examiner abandoned the apt analogy of a human body, simply because it was not restated in the Answer. *See* Reply Br. 7. As the Examiner previously stated, a human body includes arms, legs, and many other components that are simply part of the body. *See* Advisory Action 2. The term “body” is simply a generic placeholder to encompass all of those various body parts. It is not at all

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unreasonable for the “body” as used in the claims, without reference to any of the other specific components of the downhole tool, to be a generic term used to encompass all of the various structures included in the downhole tool other than those also specifically recited. Accordingly, we see no error in the Examiner’s broad, but reasonable construction.

The Patent Owner next asserts that, even if the Examiner’s construction were proper, Eddison still does not anticipate because the Examiner has stated that the body is a housing and that the cam sleeve of Eddison is not a housing. Again, the Examiner’s interpretation of “body” is merely that it is the overall generic term referring to the various components of the downhole tool that form the bore hole as discussed *supra*. The Examiner clearly states that the cam sleeve is merely a part of the generic “body” of Eddison and otherwise meets the claim limitations: “the cam works in conjunction with the other components structurally and functionally as the body of the ’817 patent.” Ans. 15. Nor does it matter that the cam sleeve may move within Eddison’s tool. The fact that a component moves relative to other components does not make it no longer part of the overall generic body as construed by the Examiner.

The Patent Owner purports to separately argue claims 93–99, but this argument only partially addresses the Examiner’s rejection. App. Br. 27–28. The Patent Owner focuses only on the Examiner’s description of Eddison’s port 32 as providing the “surface that engages the body.” *Id.* It is clear from the Examiner’s rejection, however that engagement with the body as recited in claims 28 and 93 is met by the cutter arms engagement with the cam sleeve, which is part of the body as construed by the Examiner. Ans. 3–4.

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The Examiner's reference to the port 32 is merely further to point out how the claimed guiding in claim 93 is accomplished. *Id.*

As to claim 96, we find no error in the Examiner's interpretation. The Patent Owner's reproduction of the Examiner's marked-up version of Figure 6 clearly shows how the Examiner is interpreting "opposite sides." *See App. Br. 29.* The fact that the opposing sides as interpreted by the Examiner are both on the backside/dovetail of the cutting arm does not take them outside the language of the claims. The Examiner has clearly pointed to two opposing sides that are angled surfaces that meet the claim language at issue.

In general, the Patent Owner argues in this case for a narrower construction of various claim terms than the claims actually require. It does not appear that the Examiner would dispute that Eddison and the other references are different than the disclosed embodiments of the '817 patent. The claims, however, do not recite these differences and the broad claim language used therein allows the Examiner to maintain proper rejections of the claims over the cited art. It appears that the Examiner has provided a path to overcome the rejections at issue, but rather than adjust the claims accordingly, the Patent Owner has merely argued for narrower constructions. Because we conclude that the Examiner's constructions are not unreasonably broad, we are not persuaded of any error in the Examiner's anticipation rejections.

Regarding the remaining combinations of references with Eddison, the Patent Owner relies on the arguments provided with respect to the alleged deficiencies in Eddison and the Examiner's claim constructions but does not argue that the combinations are improper. Accordingly, for the

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reasons stated above, we sustain the Examiner's obviousness rejections as well.

DECISION

For the above reasons, we AFFIRM the Examiner's decision to reject claims 28–36, 39–46, 50, 79–81, and 93–99.

Requests for extensions of time in this *ex parte* reexamination proceeding are governed by 37 C.F.R. § 1.550(c). *See* 37 C.F.R. § 41.50(f).

AFFIRMED