In the case of Seabed Geosolutions v. Magseis FF, the Federal Circuit determined it's what you don't say that matters. Magseis's predecessor sued Seabed for infringement of U.S. Reissue Patent No. RE45,268, and Seabed petitioned for *inter partes* review. Although the Board instituted IPR, it ultimately determined that Seabed failed to prove the challenged claims were unpatentable. The Federal Circuit vacated and remanded because the Board erred in construing the '268 patent claims. Specifically, the Board improperly narrowed the construction of "geophone internally fixed with [the] housing" to require a non-gimbaled geophone.

The '268 patent is directed to seismometers for use in seismic exploration, which involves sending an acoustic signal into the earth using seismic receivers called geophones to detect seismic reflections from subsurface structures. Every independent claim recited a "geophone internally fixed within" either a "housing" or an "internal compartment" of a seismometer. Based solely on extrinsic evidence, the Board found that "fixed" had a special meaning: "not gimbaled." Looking to intrinsic evidence—that, grammatically, the word "fixed" as used in the claim indicates that it specifies the geophone's relationship with the housing, not the type of geophone—the Federal Circuit concluded that "internally fixed within" means "mounted" or "fastened inside." This was consistent with the specification, which says nothing about the geophone being gimbaled or non-gimbaled. "Silence about gimbals does not evidence the absence of gimbals." This was underscored by the figures depicting the geophone as a black box inside a compartment.

Though it remains to be seen what the Board will ultimately conclude, the prior art presented in the IPR utilized gimbaled geophones. Thus, it appears in this case that the broad construction resulting from the applicant's silence will likely result in a finding that the challenged claims are unpatentable. In other words, silence is golden for this petitioner – and costly for the patent applicant.