

**Keywords:** claim construction; written description requirement; intrinsic evidence; dictionary

**General:** Absent some indication in written description and/or prosecution history that inventor intended claim term to cover more than ordinary and customary meaning revealed by context of intrinsic record, it is improper to read term to encompass broader definition found in dictionary; in action for infringement of claims directed to board used in constructing floors, intrinsic record limits scope of term “board” to wood cut from log.

*Nystrom v. TREX Co.*

76 U.S.P.Q.2d 1481 (Fed. Cir. 2005)

Decided September 14, 2005

## I. Facts

Plaintiff Ron Nystrom is the inventor and owner of U.S. Patent No. 5,474,831 (“the ‘831 patent”), which is entitled “Board for Use in Constructing A Flooring Surface.” The ‘831 patent, which issued on December 12, 1995, relates to boards for use in constructing an exterior floor, such as a deck. The decking material described in the ‘831 patent is shaped so that it sheds water from its upper surface while providing a comfortable surface on which to walk or stand. The patent specification describes decking boards that yield “a superior product when cut from a log, reducing the amount of scrap in the outermost boards cut from a log.” ‘831 patent at col. 2, ll. 20-24.

The embodiment shown in FIG. 2 is described in the patent specification as follows:

The board specifically shown and described herein has generally the size and shape of a so-called 5/4 decking board, with rounded top side edges 11 and 12 each having a radius of curvature R of about 1/4 of an inch. The board 10 differs slightly in width W and thickness T from a standard decking board, however, in that it has a width of only about five inches and a thickness of about 1-3/8 inches.

‘831 patent, col. 3, ll. 1-9.

Claim 1 of the ‘831 patent recites “[a] *board* for use in constructing a flooring surface...defining a *convex top surface*.” Independent claim 18 recites “[a] decking board for use in constructing a flooring surface.” Claim 18 goes on to recite detailed requirements relating to a radius of curvature of the decking board.

On December 5, 2001, Nystrom filed a patent infringement suite against defendant TREX. TREX counterclaimed, seeking a declaratory judgment of non-infringement, invalidity, and unenforceability. The district court held a *Markman* hearing and issued a claim construction order on August 19, 2002. Based on the claim construction, Nystrom conceded that he would not be able to prove infringement against TREX. Accordingly, Nystrom requested the district court to enter judgment of non-infringement and to dismiss TREX’s counterclaims based on invalidity and unenforceability. Instead, the district court entered judgment in favor of TREX for non-infringement with respect to claims 1-15 and 18-20, and for invalidity of claims 18-20. Nystrom appealed to the Federal Circuit.

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In an interesting procedural turn, the Federal Circuit at first issued an opinion reversing the district court's grants of summary judgment of non-infringement and invalidity. TREX, however, petitioned for panel rehearing and rehearing *en banc*. While the rehearing motion was pending, long-awaited opinion in the case of *Phillips v. AWH Corp.* was handed down. In the wake of *Phillips*, the Federal Circuit withdrew the previous opinion and agreed to rehear Nystrom's appeal. The instant case is the Federal Circuit's decision on rehearing.

## II. Issues

- A. Did the district court correctly construe the claim term in "board" in claim 1?
- B. Did the district court correctly construe the claim term "convex top surface" in claim 1?
- C. Did the district court correctly rely on models made to scale based on figures in a prior art patent in holding claim 18 invalid?

## III. Discussion

- A. Yes. The district court construed the word "board" in independent claim 1 to mean "a piece of elongated construction material made from wood cut from a log." This construction was based on statements in the written description of the '831 patent as well as comments made by Nystrom during prosecution when arguing against an obviousness rejection.

On appeal, Nystrom contended that the term "board" is not limited to conventional wood boards because the claim makes no reference to the material from which the board is constructed. Nystrom contended that it was error for the district court to rely on statements in the specification to limit the claim because the statements did not represent a clear disavowal of claim scope.

TREX countered Nystrom's arguments, contending that the ordinary meaning of the term "board" is a piece of sawn lumber. This construction, TREX contended, was supported by the specification, which only disclosed and referred to boards made from wood and cut from a log.

In its previously withdrawn opinion, the Federal Circuit sided with Nystrom, finding that the term "board" was not limited to boards made from logs. This finding was, in part, based on a broader dictionary definition of the term "board." In the new opinion, however, the Court reversed its thinking, noting that reference to extrinsic evidence such as dictionaries and treatises should be avoided if such reference was "in derogation of 'indisputable public records consisting of the claims, the specification and the prosecution history,' thereby undermining the public notice function of patents." [citation omitted].

In spite of the fact that some claims of the '831 patent specifically recited boards made from wood, the Court nonetheless concluded that the intrinsic evidence of the claims, specification and prosecution history militated in favor of a narrower interpretation. The Court notes that the Background of the '831 patent makes reference to other types of flooring material but specifically gives an example of wood material cut from logs. The Court stated that "[t]his context is maintained throughout the written description." As evidence of the proposition, the Court noted that in a preliminary amendment, Nystrom stated that "the particular configuration and dimensions of the board result in a uniformly superior product and reduction in waste or rejects due to bark or other flaws along the edges of the board when it is cut from near the outer circumference of a log." Nystrom also makes reference to the fact that

wood floors had not changed in “hundreds of years,” implying, in the Court’s view, a desire to limit the scope of the invention.

During prosecution, Nystrom also stated that one of the prior art references used in a 103 rejection “is clearly not concerned with materials made from wood.” Before the Federal Circuit, Nystrom contended that this argument was intended only as evidence that the combination of the reference with another reference showing wood flooring was improper. The Federal Circuit disagreed, noting that the context of Nystrom’s statements indicated that he was discussing his invention rather than the other prior art reference.

In support of its reasoning, the Federal Circuit analogized Nystrom’s predicament to the recent case of *AquaTex Industries*. The *AquaTex* case involved the claim construction of the term “fiberfill.” The Court noted that repeated references to fiberfill as a synthetic material in the specification limited the breadth of the claims, even though they were not on their face limited to synthetic materials. This conclusion was reached while acknowledging that no disavowal of the broader construction existed. Accordingly, the Federal Circuit upheld the district court’s construction of the term “board.”

The Court next briefly considered the term “manufactured to have” and affirmed the lower court construction of that term as “a manufacturing process utilizing woodworking techniques” under similar reasoning. This resulted in affirmance of the summary judgment of non-infringement of claim 1 in favor of TREX.

- B. No. With respect to the construction of the term “convex top surface,” Nystrom contended that the district court erred in finding he restricted the scope of claim 1 to a range of radii of curvatures not expressly recited in the claim. In this case (unlike the construction of the term “board”), Nystrom was saved by the use of specific radii of curvature in a dependent claim. The Federal Circuit accepted Nystrom’s arguments in spite of the fact that, during prosecution, Nystrom had contended that radii of curvature “much outside [the specific radii of curvature] is not acceptable.” Nystrom’s position was supported by other portions of the prosecution history. Notably, that Nystrom’s arguments were directed only to claims that included the specific radii of curvature.
- C. No. With respect to the invalidity of claim 18, the Federal Circuit reversed the district court’s conclusion that the scale of a drawing in a prior art patent was properly used to invalidate the claim. At trial, the district court had relied on renderings made by a TREX employee of hypothetical boards based on the respective drawings in the prior art patent. In siding with Nystrom, the Federal Circuit upheld the principal that “patent drawings do not define the precise proportions of the elements and may not be relied upon to show particular sizes if the specification is completely silent on the issue.” [citation omitted].

#### **IV. Conclusion**

The *Phillips* decision seems to have spawned a wave of confusing Federal Circuit opinions on claim interpretation. These cases muddle the distinction between the patent applicant’s obligation to support the claimed invention in the written description of the specification and the prohibition against importing limitations from the specification into the claims. The result is another round of confusion as to when reference to extrinsic evidence such as dictionaries is permissible.