



TECHNOLOGY LAW UPDATE

Nystrom
v.
TREX Co.

No. 03-1092

Federal Circuit
Sept. 14, 2005

[Absent] something in the written description and/or prosecution history to provide explicit or implicit notice to the public [that] the inventor intended a disputed term to cover more than the ordinary and customary meaning revealed by the context of the intrinsic record, it is improper to read the term to encompass a broader definition simply because it may be found in a dictionary, treatise, or other extrinsic source.

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On September 14 2005, the Federal Circuit granted TREX’s petition for panel rehearing and replaced its June 28, 2004 opinion. The Federal Circuit reversed and remanded the district court’s summary judgment that TREX did not infringe U.S. Patent No. 5,474,831, which related to deck boards, and that claims 18-20 were invalid as anticipated. The Federal Circuit affirmed the district court’s denial of Nystrom motion for sanctions under 28 U.S.C. § 1927. The Federal Circuit stated:

The ordinary and customary meaning of a claim term “is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention.” The person of ordinary skill in the art views the claim term in the light of the entire intrinsic record. Thus, the claims “must be read in view of the specification, of which they are a part.” the words of the claim. ““The construction that stays true to the claim language and most naturally aligns with the patent’s description of the invention will be, in the end, the correct construction.”” In addition to the written description, “the prosecution history can often inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be.” In discerning the meaning of claim terms, resort to dictionaries and treatises also may be helpful. However, “undue reliance on extrinsic evidence poses the risk that it will be used to change the meaning of claims in derogation of the ‘indisputable public records consisting of the claims, the specification and the prosecution history,’ thereby undermining the public notice function of patents.” . . .

When different words or phrases are used in separate claims, a difference in meaning is presumed. This principle of claim construction would suggest that the difference in the use of terms has significance and that “board” should not be limited to wood that is cut from a log. However, simply noting the difference in the use of claim language does not end the matter. Different terms or phrases in separate claims may be construed to cover the same subject matter where the written description and prosecution history indicate that such a reading of the terms or phrases is proper. An examination of the term “board” in the context of the written description and prosecution history of the ‘831 patent leads to the conclusion that the term “board” must be limited to wood cut from a log. . . .

Nystrom contends that although some dictionaries define “board” solely in reference to its material composition, not all dictionaries are so constrained. [But] Nystrom is not entitled to a claim construction divorced from the context of the written description and prosecution history. The written description and prosecution history consistently use the term “board” to refer to wood decking materials cut from a log. Nystrom argues repeatedly that there is no disavowal of scope in the written description or prosecution history. Nystrom’s argument is misplaced. [I]n the absence of something in the written description and/or prosecution history to provide explicit or implicit notice to the public – i.e., those of ordinary skill in the art – that the inventor intended a disputed term to cover more than the ordinary and customary meaning revealed by the context of the intrinsic record, it is improper to read the term to encompass a broader definition simply because it may be found in a dictionary, treatise, or other extrinsic source.