Claim Construction After *Phillips*

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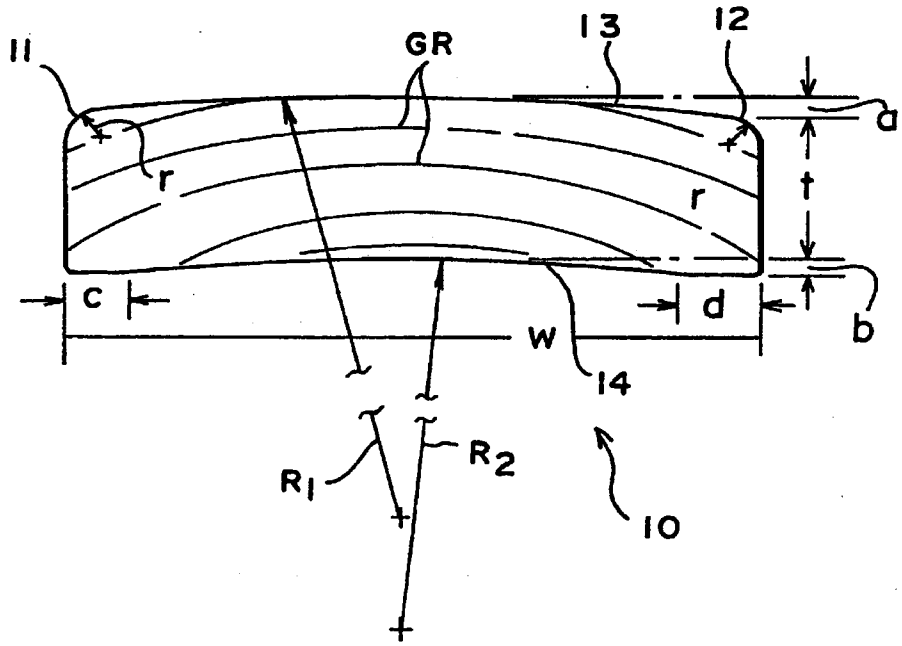
Nystrom v. Trex Co., Inc., 374 F.3d 1105, 71 USPQ2d 1241 (Fed. Cir. 2004) (by Judge Linn, joined by Judge Mayer, dissent in part filed by Judge Gajarsa) (decided before *Phillips* on June 28, 2004 and withdrawn on September 14, 2005)

Patent: Boards for decks.



Specification:	Wooden boards cut from a log.
Claim 1:	"board"
Accused Product:	Planks made from composites of wood fibers and recycled plastic.
District Court:	"Board" means a piece of elongated construction material made from wood cut from a log. Summary judgment of noninfringement granted.

CAFC: Reversed. Dictionary definitions show that the ordinary meaning of the word "board" encompasses both a piece of cut wood or sawn timber and a similarly shaped item made of a rigid material. The written description does not disclaim boards made from materials other than logs, and claim 16 covers a wood decking board. By contrast, claim 1 simply claims a "board," without restricting the term to a particular materials or describing characteristics of wooden boards cut from logs

Nystrom v. Trex Co., Inc., --- F.3d ---, 2005 WL 2281632 (Fed. Cir. 2005) (by Judge Linn, joined by Judges Meyer and Gajarsa) (after *Phillips*)

CAFC: "Board" in claim 1 is limited to wood cut from a log. Summary judgment of noninfringement affirmed.

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. Claim 16 is limited to wood decking boards, but claim 1 is not. 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 leads to the conclusion that the term "board" must be limited to wood cut from a log. Among other things, the Background of the Invention frames the invention in the context of wood decking materials cut from logs, even though it acknowledges that other materials exist.

What *Phillips* now counsels is that in 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.

Nystrom consistently used the term "board" to refer to wood cut from a log. Although there was no clear disavowal of claim scope, there was nothing in the intrinsic record to support the conclusion that a skilled artisan would have construed the term "board" more broadly than a piece of construction material made from wood cut from a log.