FEDERAL CIRCUIT PATENT LAW CASE UPDATE

Nystrom v. Trex Co., Inc., 03-1092 (Fed. Cir. Sept. 14, 2005) (Linn, J.)

Under an order directing the original panel to reconsider Nystrom v. Trex Co., Inc., 374 F.3d 1105 (Fed. Cir. 2004), in light of Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005) (en banc), the court revised two of three claim interpretations in Nystrom's patent for deck planks shaped to shed water. The claim limitations at issue included "board," "manufactured to have," and "convex top surface," where the court affirmed the district court's construction of the first two, limiting the claims to boards made of wood. It reversed the construction of "convex top surface" as incorrectly narrowed based on misinterpreted prosecution history. Finally, the court reversed an invalidity judgment because anticipation was based on a patent reference's drawings under the assumption that the drawings were to scale.

Nystrom owns U.S. Pat. No. 5,474,831, claiming decking of a certain shape so that they will shed water yet provide a usable surface and be easily stackable. The shape has a slight contour on the top outer edge of the planks.

Trek manufactures decking materials. Its accused infringing products are "made from composites of wood fibers and recycled plastic."

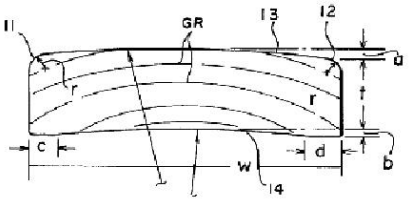
> Nystrom argues that the district court misconstrued three patent claim limitations: "board," "manufactured to have," and "convex top surface."

The court affirmed the construction of "board" as being limited to boards made of wood.

> 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. . . . Throughout the written description, Nystrom consistently used the term "board" to describe wood decking material cut from a log.

The construction of "board" influenced the next term.

> The district court construed the expression "manufactured to have" as used in claim 1 of the '831 patent to be "a manufacturing process utilizing woodworking techniques." . . .
>
> In light of our construction of "board" as encompassing only materials made from wood cut from a log, we see no error in the district court's limitation of the phrase "manufactured to have" in claim 1 to woodworking techniques. The use of the phrase "manufactured to have" in reference to the top surface of the board is necessarily limited to manufacturing techniques related to wood.



The court found the district court's approach for the last claim term overly narrowing.

> The district court construed "convex top surface" to mean "an upper surface with an outward curve that has a ratio of its radius of curvature to width of the board between 4:1 to 6:1." . . . The district court relied on statements the applicant made in the prosecution history that "the preferred [radius of curvature] ration [sic, ratio] is about 5:1." . . .
>
> The district court erred in its analysis of the prosecution history. Nystrom's statements were expressly directed to issued claim 16. There is no indication that Nystrom intended the term "convex top surface" in all of the pending patent claims to be limited to a specific radius of curvature ratio. The district court ignored the fact that the language of claim 16 at the time Nystrom made the disputed statements included . . . claim language expressly providing for a radius of curvature ratio of approximately 5:1.

The court also overturned the invalidity judgment because the "district court erred in not properly applying the principles set forth in our prior precedents that arguments based on drawings not explicitly made to scale in issued patents are unavailing." The allegedly anticipating reference could not be shown by clear and convincing evidence to disclose claimed ranges defining the convex top surface because patent drawings are not necessarily to scale.

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