United States District Court,
N.D. California.

BIDCO, INC,
Plaintiff(s).
v.
The PLASTIC LUMBER COMPANY,
Defendant(s).

No. C-02-4429 JCS

Nov. 10, 2004.

Everitt George Beers, McNichols, Randick, O'Dea & Tooliatos, LLP, Pleasanton, CA, for Plaintiff.

Koorosh Afshari, Afshari Law Firm, San Francisco, CA, Alexander D. Bommarito, Mark A. Watkins, R. Eric Gaum, Ross M. Babbitt, Akron, OH, for Defendant.

ORDER CONSTRUING DISPUTED CLAIM TERMS OF U.S. PATENT NO. 6,418,693 **[Docket No. 63]**

JOSEPH C. SPERO**, United States Magistrate Judge.**

I. INTRODUCTION

Plaintiff Bidco, Inc. ("Bidco") alleges that Defendant the Plastic Lumber Company, Inc. ("PLC") is infringing claims 1-2 and 4-10 of United States Patent No. 6,418,693 ("the '693 Patent"). Under Markman v. Westview Instruments, Inc. ("Markman"), 52 F.3d 967 (Fed.Cir.1995), the meaning of disputed claim terms is a question of law that must be resolved by the Court. A claim construction hearing was held on Thursday, November 5, 2004. In this Order, the Court construes the disputed terms of the '693 Patent.

II. BACKGROUND

The '693 Patent is entitled "Flooring Assembly and Fastener Therefor." The invention is described in the specification as "an innovative flooring assembly and method, as well as several embodiments of a unitary fastener clip used to secure the flooring assembly to a plurality of horizontal support members, such as joists, so as to construct a platform, patio or a raised deck." '693 Patent, col. 1, lines 14-18. In their Joint Revised List of Claim Terms and Elements for Construction by the Court, the parties identified ten disputed claim terms. In the course of briefing for the claim construction, however, it became evident that only five of these terms remain in dispute. FN1 The construction of these claims is addressed below.

FN1. Constructions for all of the disputed claim terms are included in the claim construction chart at the end of this Order. With respect to the five terms that are not disputed, the Court adopts the constructions to which the parties have stipulated.

III. ANALYSIS

A. Legal Standard

The most "significant source of the legally operative meaning of disputed claim language" is the intrinsic evidence of record, that is, the claims, the specification and the prosecution history. Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996). The Court begins by looking to the words of the claims to determine the scope of the patented invention. *Id*. There is a strong presumption that a claim term carries the ordinary and customary meaning that would be ascribed to that term by a person of ordinary skill in the field of the invention. *The* Toro Co. v. White Consol. Indus., 199 F.3d 1295, 1299 (Fed.Cir.1999). To determine the ordinary and customary meaning of a term, courts may review dictionaries, encyclopedias, and treatises that were publicly available at the time of the patent. Texas Digital Sys., Inc. v. Telegenix, Inc., 308 F.3d 1193, 1202-1203 (Fed.Cir.2002).

In addition to the words of the claim itself, the specification is also highly relevant to claim construction analysis. Vitronics, 90 F.3d at 1582. If the patentee acts as his own lexicographer by using a term in the specification in a manner that is inconsistent with the ordinary and customary meaning of the term, the presumption that a claim term carries the ordinary and customary meaning may be overcome. *Id*. In particular, "[t]he specification acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication." *Id*.

Finally, arguments and amendments made during the prosecution may establish that a term carries a special meaning. Teleflex, Inc. v. Ficosa N. Am. Corp., 299 F.3d 1313, 1326 (Fed.Cir.2002).

Courts may also use extrinsic evidence in construing claim terms if such evidence is necessary, so long as such evidence is not used to "vary or contradict the terms of the claims." Markman, 52 F.3d at 980. Courts may consider expert testimony, the testimony of the inventor and prior art, whether or not it is referenced in the specification, or the prosecution history. Vitronics, 90 F.3d at 1584. As the court explained in *Markman,* "[extrinsic] evidence may be helpful to explain scientific principles, the meaning of technical terms, and terms of art that appear in the patent and prosecution history." 52 F.3d at 980.

Where a claim is amenable to more than one construction, the court should construe the claim to preserve its validity when reasonably possible. Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376, 1384 (Fed.Cir.2001). However, courts are not free to rewrite a claim to preserve its validity where it is clear from the written description and the words of the claim that it is invalid. Rhine v. Casio, Inc., 183 F.3d 1342, 1345 (Fed.Cir.1999).

Some additional rules apply to "means-plus-function" claims, which are governed by 35 U.S.C. s. 112 para. 6. That paragraph provides as follows:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

35 U.S.C. s. 112 para. 6. Construction of a means-plus-function claim involves two steps. Cardiac

Pacemakers, Inc. v. St. Jude Med., Inc., 296 F.3d 1106, 1113 (Fed.Cir.2002). First, the Court must identify the function that is claimed, applying ordinary principles of claim construction to the claim language. *Id*. Second, the Court must determine what structure disclosed in the specification performs the claimed function. *Id*. "In order to qualify as corresponding, the structure must not only perform the claimed function, but the specification must clearly associate the structure with performance of the function." *Id*.

Where a claim uses the word "means," it is presumed that the claim is a means-plus function claim. Personalized Media Communications L.L.C. v. Int'l Trade Comm'n, 161 F.3d 696, 703 (Fed.Cir.1998). This presumption can be overcome, however, in at least three ways: 1) where no corresponding function is specified in the claim;" Sage Prods. v. Devon Indus., Inc., 126 F.3d 1420, 1427-1428 (Fed.Cir.1997), 2) where the claim "elaborates sufficient structure, material or acts ... to perform entirely the recited function;" *id*., or 3) where the term has a "reasonably well understood meaning in the art." Greenberg v. Ethicon Endo-Surgery, Inc., 91 F.3d 1580, 1583 (Fed.Cir.1998).

B. Disputed Claim Terms

1. "Fastening Means"

The parties dispute the proper construction of the words "fastening means," found in claim 1. Claim 1 states as follows:

A clip for fastening planks to a support surface comprising a base, at least one **fastening means** to secure the base to the support surface, said **fastening means** having a recessed protrusion protruding from the base and capable of engaging the support surface, a leg extending from the base, and a free end portion extending from the leg, the free end portion vertically spaced from the base, extending in a single plane and sized to engage a groove of one of adjacently positioned planks to retain the planks against the support surface.

'693 patent, col. 4, lines 43-52. In construing this claim term, the Court must first determine whether it is a means-plus-function element. *See* Cardiac Pacemakers, Inc. v. St. Jude Med., Inc., 296 F.3d at 1113. If it is, the Court must identify the corresponding structure that has been identified in the specification to complete this function. *Id*.

Bidco argues that the term "fastening means" is not a means-plus-function element but rather, simply a "generic way the claim draftsman described the base as secured to the support surface ." Bidco Claim Construction Brief at 7. "In other words, 'fastening means' refers to the structural element of the clip that has the 'recessed protrusion,' not to a screw or nail itself." Bidco's Reply Claim Construction Brief at 5. Thus, Bidco asserts, a "fastening means" includes "all methods of fastening or securing a recessed protrusion device." *Id*. at 3.

PLC, on the other hand, asserts that because the word "means" is used, the term should be construed as a means-plus-function element. Based on language in the specification, PLC asserts that the corresponding structure in the preferred embodiment is a screw, *see* '693 Patent, col. 3, ll. 33-43 and 44-48, and in the alternative embodiment, "two apertures." '693 Patent, col. 3, ll. 64-66 and col. 4, ll. 1-3.

The Court concludes that the term "fastening means," as used in the '693 patent, reflects an intent on the part of the inventor to invoke s. 112 para. 6, governing means-plus-function claims. First, the use of the word "means" in the claim term creates a presumption that s. 112 para. 6 applies. *See* Personalized Media

Communications L.L.C. v. Int'l Trade Comm'n, 161 F.3d at 703. Second, a function-"to secure the base to the support surface" by "fastening"-is specified in claim 1. *Sage Prods. v. Devon Indus., Inc.,* 126 F.3d at1427-1428 (holding that a term using "means" is not a means-plus-function term if no function is specified). Third, the claim has not recited sufficiently definite structure to avoid the ambit of this section. *See* Sage Prods., 126 F.3d at 1427-1428.

The question of whether claim 1 recites sufficient structure to take the claim term "fastening means" out of the ambit of s. 112 para. 6 is a closer call. It is true that claim 1 appears to recite some structure, in particular, in the following words: "said fastening means having a recessed protrusion protruding from the base and capable of engaging the support surface." Recitation of *some* structure, however, does not preclude the applicability of s. 112 para. 6. Laitram Corp. v. Rexnord, Inc., 939 F.2d 1533, 1536 (Fed.Cir.1991) (holding that where there was "some" structural language in the claim but this language only provided additional description of the function without telling what the structure actually was, claim term using "means" was means-plus-function element). The test is whether the claim includes "sufficient structure to perform entirely the claimed function." Rodime PLC v. Seagate Tech., Inc., 174 F.3d 1294, 1304 (Fed.Cir.1999) (holding that where claim specified "nearly all (if not all) of the structural components" for performing the described function, claim term was not a means-plus-function element"); *see also* Cole v. Kimberly-Clark Corp., 102 F.3d 524, 530 (Fed.Cir.1996) (holding that claim terms "perforation means for tearing" was not a means-plus-function element because the word "perforation" describes the structure supporting the tearing function). The Court concludes that it does not.

The claim language indicates that the function specified by the term "fastening means" is to secure the base to the support surface by "fastening." Nothing in the specification or prosecution history suggests that the structure specified in claim 1-"having a recessed protrusion protruding from the base and capable of engaging the support surface" accomplishes this function. The only discussion of the recessed protrusion feature in the specification indicates that it was meant to allow a screw or nail to lie "flush and level with the upper surface of the base." '693 Patent, Col. 3, ll. 59-62; *see also* April 1, 2001 Amendment at 3 (stating that "[t]he recessed protrusion has a recess so that when a screw or nail is placed in the recessed protrusion, the head of the screw or nail will lay flush on the base of the clip. This will enable another tongue and groove board to be slid of the clip easily without damaging the board"). At best, the prosecution history provides evidence that the recessed protrusion might "prevent the clip from moving around" when "a screw or a nail is placed in the recessed protrusion to engage the support surface." It is evident from this statement, though, that the recessed protrusion does not itself secure the clip to the support surface.

This conclusion is supported by the fact that the engagement of the support surface by the recessed protrusion does not describe a "fastening" device as the term "fastening" is ordinarily understood. Generally, "fastening" implies some form of attachment. *See* The Merriam-Webster's Collegiate Dictionary, Tenth Edition (1998) at 423 (defining "fasten" as "to attach especially by pinning, tying, or nailing"). The recessed protrusion described in the '693 patent does not "fasten" in this sense. Thus, the Court concludes that the structural language in claim 1 does not recite sufficient structure to accomplish the function of the "fastening means." Therefore, the Court concludes that the term "fastening means" is governed by s. 112 para. 6.

Plaintiff's reliance on Greenberg v. Ethicon Endo-Surgery, Inc., 91 F.3d 1580, 1583 (Fed.Cir.1996) in support of its position that the term "fastening means" should not be construed as a means-plusfunction element is misplaced. *See* Reply at 4. In *Greenberg,* the court addressed whether use of the terms "detente" or "detente mechanism" indicated a claim was in means-plus-function form. *Id.* at 1583. The Court noted that "detent" and "detente mechanism" are like "[m]any devices [in that they] take their names from the

functions they perform." *Id* . The Court cited as examples the terms "filter," "brake," "clamp," "screwdriver," and "lock." *Id*. The Court went on to hold that these terms do not indicate that a claim is a means-plus-function claim because the terms have a "reasonably well-understood meaning in the art." *Id*. Here, Plaintiff does not cite any evidence that the term "fastening means" has a reasonably understood meaning in the art. Accordingly, *Greenberg* is not on point.

Because the claim term "fastening means" is a means-plus-function element, the Court must next determine what structures described in the specification constitute corresponding structure for performing the described function. FN2 Asyst Techs ., Inc. v. Empak, Inc., 268 F.3d 1364, 1369 (Fed.Cir.2001). The Court finds that the specification clearly identifies the following corresponding structures as "fastening means": 1) a screw and an aperture; 2) two screws and two apertures; or 3) two prongs. First, in describing the preferred embodiment, the Patent refers to a "fastening means 8b" which it later identifies as "screw 8b, which is inserted through a single aperture 8 *e* in the base." ' 693 Patent, col. 3, ll. 37, 45. Second, in describing an alternative embodiment, the specification refers to a "fastening means comprised of two apertures ... and through which two screws ... engage the support surface." ' 693 Patent, col. 3, l. 65-col. 4, l. 2. FN3 Third, the specification identifies "an additional fastening means comprised of two prongs 10d." ' 693 Patent, col. 3, l. 10.

FN2. Plaintiff asserts that if the Court concludes that "fastening means' is a means-plus-function term, it should end its analysis because the question of infringement will turn on whether the accused device infringes literally *or* under the doctrine of equivalents and the applicability of the doctrine of equivalents is a question of fact. Plaintiff is incorrect. Although the question of equivalents is a question of fact, there can be no doctrine of equivalents analysis without first identifying the corresponding structures to which the accused device is alleged to be equivalent. Corresponding structure, in turn, is a question to be addressed in claim construction. *See* Asyst Techs., 268 F.3d at 1369.

FN3. The Court rejects PLC's assertion that the structure described for the alternative embodiment includes only the two apertures and not the screws described in the same claim. As PLC concedes, the apertures alone clearly could not perform the function of the fastening means, and the Court finds no authority requiring that it read the claim so narrowly as to exclude the screws.

2. "Recessed Protrusion"

The parties dispute the proper construction of the words "recessed protrusion," in claim 1. In particular, claim 1 recites a "fastening means having a **recessed protrusion** protruding from the base...." '693 Patent, col. 4, ll. 45-47. PLC asserts that the words "recessed protrusion" should be construed as an "annular projection downwardly extending from the base." PLC Brief at 7. Bidco asserts that PLC is reading additional limitations into the claim and that the words "recessed protrusion" should be construed according to their plain meaning. *See* Joint Claim Construction and Prehearing Statement at 4. The Court concludes that the words "recessed protrusion" carry their plain meaning, with the caveat that the recessed protrusion must protrude toward the support surface.

In support of the assertion that the recessed protrusion must be "annular" and extend "downwardly," PLC points to the specification and the prosecution history. First, PLC points out that the specification states that "[t]he single aperture 8 *e* may be countersunk 8 *f* in order to allow the head of the screw 8 *b* to rest flush

and level with the upper surface of the base 8 *a*." PLC Brief at 8 (quoting '693 patent, col. 3, ll. 59-61). PLC notes that the definition of "countersink" is a "hole with the top part elongated so a screw or bolthead will lie flush with or below the surface." Id. (quoting Webster's II New Riverside University Dictionary, 1994 at 319). PLC goes on to quote the specification as explaining that the countersink "allows the elongated flooring planks, 2, 3 and 4 [in figures 2, 4 and 5] to lie flat on the supporting members." Id. (quoting '693 patent, col. 4, ll. 3-8). According to PLC, the recessed protrusion could only achieve this function if it were both annular and downwardly extending.

PLC points further to the prosecution history, in which the patentee amended claim 1 to add the "recessed protrusion" in response to the patent examiner's rejection of claim 1 on the ground of anticipation. *See* PLC Brief, Ex. B, August 24, 2001 Response Under 37 C.F.R. s. 1.111 at 3-4. In discussing the recessed protrusion, the patentee stated as follows:

The recessed protrusion has a recess so that when a screw or nail is placed in the recessed protrusion, the head of the screw or nail will lay flush on the base of the clip. This will enable another tongue and groove board to be slid over the clip easily without damaging the board. If there were no recess the screw or nail will scratch and damage the board and will also make it harder for installation.

Another advantage of the recessed protrusion is that when a screw or nail is placed in the recessed protrusion to engage a support surface, the protruding part of the recessed protrusion extending from the bottom of the clip (see FIG. 7 of the present application), the protruding part can also engage the support surface to prevent the clip from moving around.

Id.

The Court is not persuaded that the use of the word "countersink" in the specification requires that the "recessed protrusion" must be either "annular" or "extend downwardly from the base." First, nothing in the dictionary definition of "countersink" requires a downward orientation. Moreover, even if it did, the word "countersink" is not used in claim 1 and the words that are used-"recessed protrusion"-do not indicate a downward direction or orientation. It is improper for the Court to import limitations from the specification that are not found in the claims themselves. *See* Comark Communications v. Harris Corp., 156 F.3d 1182, 1186 (Fed.Cir.1998) (holding that "[i]t is axiomatic that limitations from the specification should not be read into the claims"). Second, the reference to countersinking in the specification also does not provide a basis for concluding that the protrusion must be annular. As PLC conceded at oral argument, a protrusion of any shape can accomplish the function of allowing the flooring planks to lie flat, so long as the protrusion is sufficiently large.

The Court also does not find anything in the prosecution history that supports the conclusion that the "recessed protrusion" must be annular or extend downwardly. First, PLC has not pointed to any specific reference to the shape of the protrusion in the prosecution history or anything else in the prosecution history that would require an "annular" protrusion.

Nor does the amendment cited by Defendant persuade the Court that the recessed protrusion must be "downwardly extending from the base ." Such a construction would impose a limitation with respect to the orientation of the entire assemblage that the Court does not find in the prosecution history.

It is true that the inventor described the recessed protrusion as being in the "bottom" of the clip such that a

board can slide easily "over a clip." *See* PLC Brief, Ex. B, August 24, 2001 Response Under 37 C.F.R. s. 1.111 at 3-4. This language indicates that the recessed protrusion extends toward the support surface. Otherwise, a board could not slide "over" the clip as described in the patent prosecution. Therefore, the Court concludes that the words "recessed protrusion" carry their ordinary meaning, with the additional requirement that the recessed protrusion must protrude toward the support surface.

3. "Having a Recessed Protrusion"

The parties dispute the meaning of the words, "having a recessed protrusion," in claim 1. *See* '693 patent, col. 4, ll. 45-46. PLC asserts that this term must be construed to mean that "the recessed protrusion is *preexistent* to application of the fastening means." PLC Claim Construction Brief at 9. Bidco, on the other hand, argues that PLC's construction adds an improper temporal limitation and should be rejected. The Court concludes that PLC is correct.

PLC argues that the language in this term must be construed to limit the claim to a device with a preexisting recessed protrusion because otherwise, the claim will be invalid as anticipated by prior art, namely, United States Patent No. 2,317, 428 ("the '428 patent" or "the Anderson clip"). In particular, PLC points to an embodiment of the Anderson clip which it argues has all of the elements of claim 1 of the '693 patent. Id. (citing '428 patent, col. 1, ll. 1-5 and Figures 1 and 2). PLC asserts that the only differences between the clip shown in Figures 1 and 2 of the '428 patent and the accused device are: 1) the Anderson clip contains additional parts 16 and 19; and 2) the aperture of the Anderson clip is round instead of oblong. According to PLC, these differences do not, however, place the accused device outside the scope of claim 1 of the '693 patent because an "aperture" can be either round or oblong, and because claim 1 of the '693 patent uses the open-ended term "comprising"-thus signifying that the claim will read on devices with additional elements.

Bidco counters that the Anderson clip does not anticipate the device claimed in the '693 patent because the design of the Anderson clip is "so fundamentally different that it accomplishes the exact opposite of the purpose of the '693 patent." Bidco Reply Brief at 10. In particular, Bidco argues that an important feature of the claimed device is the "open-ended extension of the free-end of the clip into the tongue and groove of the planking," id., which allows planks to "expand and contract longitudinally according to weather and atmospheric condition." Id. (quoting '693 patent, col. 1, ll. 65-67). In contrast, Bidco asserts, the additional planes 16 and 19, shown in Figures 1 and 2 of the '428 patent, "restrict[ ] movement of the tongue and groove planking." Id. at 11. Moreover, Bidco argues, because of these additional elements, the Anderson clip does not meet the limitation in claim 1 requiring a free end "extending in a single plane and sized to engage a groove." Id. (quoting '693 patent, col. 4, ll. 48-51).

"A prior art reference anticipates a patent claim if the reference discloses ... all of the limitations of the claim." EMI Group N. Am., Inc. v. Cypress Semiconductor Corp., 268 F.3d 1342, 1350 (Fed.Cir.2001). A device which would "literally infringe if later anticipates if earlier." Bristol-Myers Squibb Co. v. Ben Venue Labs., 246 F.3d 1368, 1378 (Fed.Cir.2001). Here, the Court must determine whether the Anderson clip would anticipate the device claimed in claim 1 of the '693 patent if claim 1 were construed to read on devices in which the recessed protrusion is creating during assembly rather than when the clip is manufactured. If so, the Court must address whether this conclusion justifies adopting PLC's proposed construction to preserve the validity of the claim.

The critical issue in determining the significance of the Anderson clip is whether the additional elements 16 and 19 take the device outside of the scope of claim 1 of the '693 patent. If they do, the Anderson clip does

not anticipate the '693 patent regardless of how the Court construes the claim term "having a recessed protrusion." In addressing this issue, the Court finds instructive cases in which the Federal Circuit has held that statements made in the specification may disclaim embodiments found in the prior art and limit the scope of a claim. *See* Scimed Life Sys., Inc. v. Advanced Cardio. Sys., 242 F.3d 1337, 1340-1342 (Fed.Cir.2001). In these cases, the Federal Circuit has explained that "[w]here the specification makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in question." *Id.*

The specification of the '693 patent emphasizes the ability of the claimed device to keep the planks secure "while permitting the planks to expand and contract at rates different than the joists themselves." '693 patent, Abstract. This is described as one of the objects of the invention and is recognized as an important feature of prior art by Erwin. *See* '693 patent, col. 4, ll. 40-44, 62-67. The Court concludes that these statements in the specification effect a disclaimer of embodiments that do not allow the planks to expand and contract longitudinally, such as the Anderson clip, even though the open-ended term "comprising" in claim 1 might otherwise encompass the Anderson clip. *See* Cultor Corp. v. A.E. Staley Mfg. Co., 224 F.3d 1328 (Fed.Cir.2000) (holding that written description implicitly limited subject matter of patent and therefore, that asserted claims did not read on accused device even though claim by itself might otherwise have been read to encompass accused device).

This conclusion finds further support in the use of the term "*free* end portion" in claim 1 to describe the part of the clip labeled 8d in Figure 1 of the '693 patent. '693 patent, col. 4, ll. 48-49. Based on the plain meaning of the word "free," the Court construes this term as limiting the claim to include only a device that does not have additional surfaces attached to element 8d, such as elements 16 and 19 in the Anderson clip, that prevent expansion and contraction of the planks that are secured by the clip. Although the word "comprising" does not exclude additional, unrecited elements, it is not "a weasel word with which to abrogate claim limitations." Spectrum Int'l, Inc. v. Sterelite Corp., 164 F.3d 1372, 1379 (Fed.Cir.1998). As a result, the Court finds that the Anderson clip does not anticipate the claimed device.

The Court, however, concludes nonetheless that the words "having a recessed protrusion" mean that the recessed protrusion exists prior to installation. First, the word "having" is a static term. It does not encompass a clip that does not "have" a recessed protrusion in its unassembled state. Nor is there any suggestion in the specification that the inventor intended to claim a device in which the "recessed protrusion" was not present in the unassembled device but rather, was created only at installation. Had the inventor wished to claim such a device, he could have used method claims to do so. However, as Bidco correctly points out, there are no method claims in the '693 patent. Further, statements made by the inventor in the prosecution make clear that the recessed protrusion exists *before* installation rather than being created *by* installation. In particular, in the amendment quoted above, the inventor stated, that "[t]he recessed protrusion *has* a recess so that when a screw or nail is placed in the recessed protrusion, the head of the screw or nail *will* lay flush on the base of the clip.... *See* PLC Brief, Ex. B, August 24, 2001 Response Under 37 C.F.R. s. 1.111 at 3-4 (emphasis added). Thus, both the words of the claim and the prosecution history support the conclusion that the recessed protrusion is preexistent to application of the fastening means.

4. "Capable of Engaging the Support Surface"

PLC asserts that the words "capable of engaging the support surface," ' 693 patent, col. 4, ll. 46-47, mean that the recessed protrusion is "able to penetrate the support structure." Joint Claim Construction Statement,

Attachment A at 4. Bidco, on the other hand, asserts that while the word "engaging" includes penetration, it does not require penetration and therefore, PLC's proposed construction improperly limits the scope of claim 1. The Court concludes that Bidco is correct.

In support of its proposed construction, PLC cites a dictionary definition of "engage" as meaning "to become meshed or interlocked." PLC Brief at 14 (quoting Webster's II New Riverside University Dictionary, 1994, at 433). PLC cites further to the written description, in which the word "engage" is used to connote penetration on at least two occasions. Id. (quoting '693 patent, col. 3, ll. 44-48 (describing a screw as "engaging" the supporting surface) and col. 3, ll. 9-13 (describing prongs as "engaging" the support surface). Finally, PLC cites the prosecution history, quoting the following statement by the inventor in response to the PTO's rejection of original claim 1:

Another advantage of the recessed protrusion is that when a screw or nail is placed in the recessed protrusion to engage a support surface, the protruding part of the support surface extending from the bottom of the clip ... the protruding part can also engage the support surface to prevent the clip from moving around.

PLC Brief, Ex. B, August 24, 2001 Response Under 37 C.F.R. s. 1.111 at 3-4.

The Court is not persuaded that the word "engaging" is limited to penetration. First, the dictionary definition of "engagement" encompasses *any* kind of intermeshing or interlocking. Although penetration is one type of intermeshing or interlocking, it is not the only type of engagement. Second, although the inventor used the term "engage" in the specification to signify penetration by screws and prongs, the Court does not find a clear intent on the part of the inventor to limit the word "engagement" exclusively to penetration. *See* Texas Digital Sys., Inc. v. Telegenix, 308 F.3d 1193, 1202 (Fed.Cir.2002) (holding that "unless compelled otherwise, a court will give a claim term the full range of its ordinary meaning as understood by persons skilled in the relevant art"). Finally, the statements made in the prosecution history on which PLC relies simply do not address whether engagement is limited to penetration. Therefore, the Court rejects PLC's proposed construction in favor of the plain meaning of the words.

5. "The Recessed Protrusion Having a Shape So that the Screw Head Will Lay Flush Against the Base and Will Not Protrude from the Base"

PLC argues that this claim term, which is found in dependent claim 2, means that "the protrusion is sized to fully encompass the head of the screw so that the head of the screw does not extend above the base." Bidco Reply Brief at 13. Bidco asserts that the words of the claim term should be "allow[ed] ... to stand by themselves." *Id*. The Court concludes that the words of this claim term carry their ordinary meaning, with the clarification that the "shape" referred to in the claim term must exist prior to installation.

PLC relies on the written description and the prosecution history in support of its proposed construction. In particular, the written description states that:

the single aperture, 8 *e* may be countersunk 8 *f* in order to allow the head of the screw 8 *b* to rest flush and level with the upper surface of the base 8 *a*. This feature allows the elongated flooring planks 2, 3, and 4 to lie flat and level with each other on the supporting members 7, thus enhancing the utility and aesthetic desirability of the flooring assembly 1.

'693 patent, col. 3, ll. Similarly, during prosecution history, the inventor described the recessed protrusion as

follows:

The recessed protrusion has a recess so that when a screw or nail is placed in the recessed protrusion, the head of the screw or nail will lay flush on the base of the clip. This will enable another tongue and groove board to be slid over the clip easily without damaging the board. If there were no recess the screw or nail will scratch and damage the board and will also make is [sic] harder for installation.

PLC Brief, Ex. B, August 24, 2001 Response Under 37 C.F.R. s. 1.111 at 3-4.

The Court concludes that these statements add little to the language of the claim term at issue, which is, for the most part, clear. The statements do, however, indicate that the "shape" referred to in the claim term exists before the screw is inserted to fasten the clip to the support surface. In particular, the inventor states that the clip "*has* a recess so that when a screw or nail is placed in the recessed protrusion, the head of the screw or nail *will* lay flush on the base of the clip." PLC Brief, Ex. B, August 24, 2001 Response Under 37 C.F.R. s. 1.111 at 3-4 (emphasis added). With this clarification, the Court construes this claim term according to the plain and ordinary meaning of the words of the claim term.

IV. CONCLUSION

For the reasons stated above, the Court construes the disputed terms as follows:

CLAIM LANGUAGE	COURT'S CONSTRUCTION	CORRESPONDING STRUCTURE (where applicable)
Fastening means	Specific structure used to secure the base to the support surface by fastening	1) a screw and an aperture; 2) two screws and two apertures; or 3) two prongs.
Recessed protrusion	Plain meaning with additional caveat that recessed protrusion is toward the support structure	n/a
Having a recessed protrusion	Recessed protrusion is preexistent to application of the fastening means	n/a
Capable of engaging the support surface	Plain meaning	n/a
The recessed protrusion having a shape so that the screw head will lay flush against the base and will not protrude from the base	Plain meaning with additional caveat that "shape" described in claim term exists before the screw is inserted to fasten the clip to the support surface	n/a

In addition, based on the agreement of the parties, the Court construes the remaining claim terms that were identified as disputed in the Joint Revised List of Claim Terms and Elements for Construction by the Court as follows:

CLAIM LANGUAGE STIPULATED	CONSTRUCTION	CORRESPONDING STRUCTURE (where applicable)

Tongue-containing	A protruding strip along the edge of a board that fits into a matching groove on the edge of another board	n/a
Groove-containing	A channel along the edge of a board that accepts a matching tongue portion on the edge of another board	n/a
Cooperatively interconnects	Acting or operating jointly to connect with each other	n/a
Extending in a single plane	Plain meaning; phrase modifies "free end portion" in claim 1	n/a
Recessed protrusion is conical in shape	Plain meaning	n/a

IT IS SO ORDERED.

N.D.Cal.,2004.
Bidco, Inc. v. Plastic Lumber Co.

Produced by Sans Paper, LLC.