United States District Court,
C.D. California.

SHIMANO, INC., a Japanese corporation,
Plaintiff.
v.
CAMPAGNOLO S.R.L., an Italian corp, and Campagnolo USA Inc., a California corporation,
Defendants.

No. CV 00-7710(GAF)(SHx)

July 2, 2001.

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ORDER RE: PATENT CONSTRUCTION

GARY ALLEN FEESS**, District Judge.**

I.

INTRODUCTION

Shimano, Inc., owns the rights to a patent for an integrated brake and gear shifting device for use on bicycles. Campagnolo S.R.L. and Campagnolo USA Inc. (collectively "Campagnolo"), Defendants in the present action, stand accused of infringing on that patent with their own similar device. Before resolving the issue of infringement, the Court must construct the terms of the patent's claims.

Here, the parties agree on the construction of nearly every term of the claim language. What remains are five terms, all in the first claim, which form the subject for this order. The first claim describes a device composed of two parts, a level for braking and a lever for shifting. The brake lever itself is composed of three parts, and it is over the definition of each of these three parts that the parties first disagree. In particular, the parties dispute whether the brake wire must attach to the brake lever, and if so, where it must attach. The parties further dispute where the boundaries separating the three portions of the brake lever lie.

With respect to the shifting lever, the parties dispute the meaning of two terms, but the dispute essentially raise the same question: must the shifting lever attach directly to the brake lever, or may it attach to some other structure?

Having considered the presentations of the parties, the Court concludes that Campagnolo's interpretation of the disputed terms violates numerous canons of patent construction. Most notably, Campagnolo relies on language from the patent specification in support of its effort to circumscribe the broader language of the patent's claims. Absent some clear indication that the patentee intended that the specification limit the scope of the claimed invention, patent jurisprudence commands that the Court reject such reasoning. Blocked from this approach to claim construction, Campagnolo offers no cogent arguments in support of its efforts to limit the claim language. On the other hand, Shimano's construction of the terms is consistent with both the prosecution history and the specification, and more importantly, the claim language. Accordingly, the Court adopts Shimano's construction of each of the five disputed terms in issue.

II.

FACTUAL BACKGROUND

A. BICYCLE CONSTRUCTION

United States Patent No. 5,400,675, entitled Bicycle Control Device (hereinafter the patent), discloses an integrated device for controlling the brakes and gears of a bicycle. (Col 1:13-14). Modern bicycles typically feature a complex drive train, composed of two or more chainrings that rotate at the same speed as the pedals, and 5 or more sprockets, which rotate at the same speed as the rear tire. (van der Plas Dec. Ex. B). The chainrings are connected to the sprockets by a chain, which can be moved among the sprockets by use of the rear derailleur or among the chainrings by use of the front derailleur. (Id. at para. 10, Ex. C). By manipulating the chain, numerous combinations of chainring and sprocket may be obtained. The number of available combinations, also called "gears" or "speeds," is equal to the product of the number of chainrings and the number of sprockets. So, for example, a bicycle with two chainrings and five sprockets is a "10 speed" bicycle. (Id. at 11).

The radius of each sprocket and chainring differs from its fellows. (Id. at para. 10). Thus, when the rider causes the chain to switch from one sprocket to another, or from one chainring to another, the ratio of pedal rotation to bicycle speed changes, assuming all other factors remain constant. For instance, if the rider moves the chain from a larger sprocket to a smaller sprocket, each rotation of the pedals impart greater rotational force on the rear wheel. Put another way, assuming a constant pedal speed or cadence, the bicycle moves at a faster rate when the chain is switched to a smaller sprocket. (Id. at para. 12). The same result would occur if the rider moved the chain from a smaller to larger chainring.

Adopting a parlance similar to that used in automobiles, cyclists commonly refer to such transfers as "shifting to a higher gear." (Id. at para. 12). The opposite maneuver, i.e., shifting the chain to a larger sprocket or smaller chainring, is "shifting into a lower gear," which decreases the bicycles speed per pedal rotation, but makes pedaling easier. Thus, as in an automobile, low gears are used for initial acceleration and climbing hills, while high gears are used for downhill riding, flat level cruising, and acceleration to higher speeds. (Id.)

B. TYPES OF HANDLEBARS

Bicycles typically come in one of two varieties: road bicycles and "mountain" or off-road bicycles. (Id. at 8). Typically, the latter are heavier, with thicker knobbier tires and suspension systems to handle the

vagaries of off-road routes. The former are typically distinguished from mountain bikes by their lighter weight, smooth tires, and handlebars that permit two hand positions. The handlebars of road bicycles appear to curve like the letter "C" when viewed from the left side of the bicycle, and permit the rider to rest his hands in one of two positions: at the top of the C or at the bottom of the C. (Id. at para. 9).

The brake mechanism on a road bicycle typically attaches to the front of the C shaped handlebars and assume a shape similar to an inverted "L", when viewed from the left side. (*See also,* van der Plas Dec. Ex. B). The top, horizontal aspect, or "support member" of the brake mechanism defines the uppermost hand position, and the vertical portion of the "L" acts as the "brake lever." (*See, generally,* Col. 3:14-16). FN1 While riding the bicycle, pulling the brake lever rearward operates the brakes-the left hand brake device operates the brakes attached to the front wheel, while the right hand brake device operates the rear wheel brakes. (van der Plas Dec. Ex. B).

FN1. Shimano's expert, Robert van der Plas, states in his declaration that the present invention is limited to road bicycles. (van der Plas Dec. para. 8). However, neither the claim language nor the specification limit the invention to the C-shaped handlebars of a road bicycle. (*Compare* van der Plas Dec. para. 8 *with* Col. 13:65 ("The control device according to the present invention may be mounted on a flat handlebar or other handlebars than the dropped handlebar.").

In the past, gear shifting devices have typically been mounted on the frame of the bicycle, away from the handlebars, and therefore required the rider to remove his or her hands from the handlebars to shift. (van der Plas Dec. Ex. B). FN2 The present invention modifies that design by adding a second lever to the inverted L shaped brake levers to actuate shifting.

FN2. Notwithstanding Shimano's expert's testimony to the contrary, Shimano's attorneys conceded at oral argument that Shimano's invention is not the first system to incorporate shifting devices on the handlebars. (*See* van der Plas Dec. para. 13).

C. THE PRESENT PATENT

The patent includes six claims and four embodiments. FN3 The parties dispute the construction of only the first claim, which reads as follows:

FN3. In its opening brief, Campagnolo devotes great attention to the history of patent number 5,241,878, of which the present patent is a divisional. From that history, Campagnolo discerns that only the fourth embodiment, and those portions of the specification that describe it, are properly before the Court. Yet, both the Court and Shimano were puzzled by this allegation, since Campagnolo ignores that history in its construction of the patent's claims. When questioned on this allegation's relevance at the hearing, counsel conceded that it has no bearing on claim construction of the claims, but stated Campagnolo's intention to repeat those allegations in a future attack on the validity of the patent. Accordingly, the Court offers no comment on the patent history as it is immaterial to the matters now at issue.

1. A control device for mounting on a bicycle handlebar, said control device comprising: 14:42
(A) brake lever means including: 45

(a) a support member adapted to be fixed to the handlebar and having a lateral side face defining a grip portion,

(b) a first pivot axis located at an upper end region of said support member, and

(c) a brake lever having a base portion pivotably connected to said support member through said first pivot axis, a curved intermediate portion extending from said base portion, and a control grip portion extending from said intermediate portion, said lever also having a brake lever face for opposing the handlebar; and

(B) speed change lever means mounted in proximity to said brake lever means, said speed change lever means including:

(a) a second pivot axis extending in a direction substantially perpendicular to said first pivot axis, and

(b) a speed change control lever pivotably connected to said second pivot axis and having at least first and second speed change control positions, said speed change control lever having a speed change lever body extending along said face of said brake lever, said speed change lever body having a first face for opposing the handlebar and a second face opposite to said first face, and wherein said speed change lever body in cludes a control portion; and wherein said second face of said speed change lever body is overlapped by said brake lever face.

(Col.14:42-15:7).

By its terms, the patent envisions a device composed of two parts: a brake lever means (BLM) and a speed change lever means (SCLM). The BLM is composed of three portions: (1) the "support member" (the horizontal aspect of the inverted "L" described above); (2) the brake lever (BL) (which is the vertical aspect of the inverted "L" shape); and (3) the pivot point that connects the two. The BL itself manifests three portions: the base, the central intermediate portion (CIP) and the control grip portion (CGP). Finally, the SCLM has two parts, a pivot point and a speed change control lever (SCCL) which rotates to change the gears.

The parties dispute the construction of only five terms. At issue are the definitions of all three portions of the BL, as well as the terms "in proximity to" and "pivotably connected to." (Col.14:58, 64-65). Framed most logically, the dispute raises three questions. First, must the brake wire attach to the base portion of the BL? Second, how can the CIP and CGP be differentiated from each other? Third, to what, if anything, must the SCCL be connected (through its pivot point)? The different answers the parties offer to these questions form the heart of the present construction dispute.

III.

ANALYSIS

A. STANDARD FOR CONSTRUCTING THE PATENT

A patent infringement action proceeds in two steps: first the Court construes the patent to determine its meaning, and second, a jury determines whether an accused device infringes on the patent so construed. Electro Medical Sys. v. Cooper Life Sci. Inc., 34 F.3d 1048, 1052 (Fed.Cir.1994). The Court stands poised

on the threshold of the first step of this analysis, which is determining the scope and meaning of the patent's claims. *Id*.

When constructing a patent claim, the court may turn to numerous sources for guidance. Vitronic Corp. v. Conceptronic, Inc., 90 F.3d 1576 (Fed.Cir.1996). "These sources ... include both intrinsic evidence (e.g., the patent specification and file history) and extrinsic evidence (e.g., expert testimony)." Id. at 1582.

1. Intrinsic evidence

"It is well-settled that, in interpreting an asserted claim, the court should look first to the intrinsic evidence of record, i.e., the patent itself, including the claims, the specification and, if in evidence, the prosecution history." *Id.;* Markman v. Westview Instruments, Inc., 52 F.3d 967, 979 (Fed.Cir.1995). Intrinsic evidence is superior because "it is the person of ordinary skill in the field of the invention through whose eyes the claims are construed. Such a person is deemed to read the words used in the patent documents with an understanding of their meaning in the field, and to have knowledge of any special meaning and usage in the field." *Multiform Desiccants, Inc. v. Medzam, Ltd.,* 13 F.3d 1473, 1477 (Fed.Cir.1998).

a. Claim language and specification language

"First, we look to the words of the claims themselves, both asserted and nonasserted, to define the scope of the patented invention." *Id.;* Bell Communications Research, Inc. v. Vitalink Communications Corp., 55 F.3d 615, 620 (Fed.Cir.1995). Although words in a claim are generally given their ordinary and customary meaning, recourse to the specification may be had under two circumstances: (1) "when the meaning of the words in a claim are in dispute," Electro Medical Systems, 34 F.3d at 1053; and (2) when the patentee exercises his right to "be his own lexicographer and use terms in a manner other than their ordinary meaning," Vitronics, 90 F.3d at 1582; Hoechst Celanese Corp. v. BP Chems. Ltd., 78 F.3d 1575, 1578 (Fed.Cir.1996). Thus the specification acts as a reference when it defines, explicitly or implicitly, the terms used in the claims. Vitronics, 90 F.3d at 1582, Markman, 52 F.3d at 979. Its utility has prompted courts to consider the specification "the single best guide to the meaning of a disputed term." Vitronics, 90 F.3d at 1582.

Reference to the specification requires caution, however, because a fine line separates "reading a claim in light of the specification, and reading a limitation into the claim from the specification." Comark Communications, Inc. v. Harris Corp., 156 F.3d 1182, 1186 (Fed.Cir.1998). It is well settled that the former is permitted, while the latter is expressly forbidden. *Id.,* Renishaw v. Marposs Societa'per Azioni, 158 F.3d 1243, 1248 (Fed.Cir.1998). Thus, "it is manifest that a claim must explicitly recite a term in need of definition before a definition may enter the claim from the written description." Id. at 1248. Accordingly, a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, at the very least, point to a term or terms in the claim with which to draw in those statements. *Id*. "[W]ithout any claim term that is susceptible of clarification by the written description, there is no legitimate way to narrow the property right." *Id*. As a result, "when a claim term is expressed in general descriptive words ... [the Court shall not] add a narrowing modifier before an otherwise general term that stands unmodified in the claim." *Id*. at 1249.

b. SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc.

Patent Defendants, like Campagnolo, often confuse the relationship between the specification and the claim language. The confusion owes its genesis, in no small part, to a line of cases most recently summarized in

SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc., 242 F.3d 1337 (Fed.Cir. Mar.14, 2001) (hereinafter "*SciMed*"); (*see, e.g.,* Campagnolo's Opening Brief, p. 21). That line of cases, however, pertains to an unusual factual scenario: where the specification explicitly disclaims a broad construction and thereby expressly limits the claimed invention.

In *SciMed,* the patent at issue described a balloon dilation catheter, a device used to widen clogged arteries. 242 F.3d at 1337. All such devices are composed of two lumens, or tubes: a guide wire tube used to guide the device through the arteries, and an inflation tube, used to inflate a balloon, which expands the patient's arteries. *Id*. Only two arrangements of these tubes are possible: side-by-side or with one inside the other (coaxial). *Id*. Although the claims of the disputed patent were worded broadly enough to cover both arrangements, each and every specification in the patent described the coaxial configuration. *Id*. More importantly, however, is that "the language contained in SciMed's specifications *expressly* limits all embodiments of the claimed invention to a coaxial structure." *Id*. at 1339 (emphasis in original). In other words, the language "leaves no doubt that a person skilled in the art would conclude that the inventor envisioned only one design for the catheters taught in SciMed's patents." *Id*. at 1339-1340. Since the patentee was obviously aware of the side-by-side arrangement when it limited its claims, the court found that "this is therefore a clear case of disclaimer of subject matter." *Id*. at 1344. Accordingly, the Federal Circuit concluded,

where 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. at 1340.

Thus, a careful reading of *SciMed,* and its accompanying authority, reveals that its reach is rather limited. Each of the cases cited by *SciMed* to support its conclusion that the specification may limit the claim language in very limited circumstances features the same unusual characteristics of the *SciMed* patent; that is, each featured a specification that, by its own terms, expressly and specifically limited the claim language in one of three ways: (1) the specification revealed that the embodiment *is* the invention; i.e. the specification limits the invention with express language to that effect, Watts v. XL Sys., Inc., 232 F.3d 877, 882 (Fed.Cir.2000); Wang Labs., Inc. v. America Online, Inc., 197 F.3d 1377 (Fed.Cir.1999); Cultor Corp. v. A.E. Staley Manufacturing Co., 224 F.3d 1328 (Fed.Cir.2000); (2) the specification distinguishes prior art in a way that limits the claims, *Q*. I. Corp. v. Tekmar Co., 115 F.3d 1576, 1581 (Fed.Cir.1997); or (3) the specification expressly identifies certain features without which the invention would be meaningless, Toro Co. v. White Consolidated Industries, Inc., 199 F.3d 1295 (Fed.Cir.1999). The patent in *SciMed* displayed each of those characteristics. 242 F.3d at 1342-44.

In short, while a superficial reading of *SciMed* could lead to the conclusion that an implied limitation disclosed in a specification may circumscribe the claim language, *SciMed* does not overrule well-established precedent. Rather, *SciMed* provides that, in limited circumstances, an express disclaimer that clearly reveals what the invention *is not* may limit claim language. But, *SciMed* does not support the proposition that an accused infringer may bind the claims with features or characteristics implied from the specification.

c. Prosecution history

Beyond the language of the claim and the specification, the Court examines the prosecution history "to see whether the patentee defined any of the pertinent terms of the claim or whether such terms would have the meaning to one skilled in the art." Burke, Inc. v. Bruno Independent Living Aids, Inc., 183 F.3d 1334, 1340 (Fed.Cir.1999). This history contains the complete record of alt the proceedings before the Patent and Trademark Office, including any express representations made by the applicant regarding the scope of the claims. Vitronics, 90 F.3d at 1582.

2. Extrinsic evidence

In "most instances," the claim language may be properly constructed by reference to the intrinsic evidence outlined above. *Id*. If, and only if, ambiguity persists after analyzing the intrinsic evidence, the Court may turn to extrinsic evidence, such as expert testimony and dictionaries. *Id*. at 1583.

B. THE BASE PORTION AND THE BRAKE WIRE

The first term requiring construction is found in the description of the brake lever (BL). The BL has three portions, described as "[1] a base portion pivotably connected to said support member through said first pivot axis, [2] a curved intermediate portion [CIP] extending from said base portion, and [3] a control grip portion [CGP] extending from said intermediate portion." (Col.14:50-55). Shimano construes the language to mean simply that the base portion is that part of the brake lever that connects it, through the pivot point, to the support member, and rotates around the pivot to operate the brakes. Campagnolo proposes an essentially similar definition, adding only the requirement that the base portion "form a structure for the attachment of the brake wire," as revealed in the specification. (Second Amended Joint Claim Construction Statement p. 8).

Because the claim makes no reference to a brake wire, and does not limit where the brake wire may attach, Campagnolo's construction seeks to circumscribe an otherwise broad patent claim with restrictions implied by the specification. To justify this limitation, Campagnolo merely contends that the specification is more detailed than the claim. For instance, it cites figure 13, which displays a "wire hook 21b [which] engages one end of a brake wire W1." (Col.3:35-36). While Campagnolo is correct that the specification reveals that the base portion *may* connect to the brake wire, it can point to no specification language expressly requiring brake wire attachment at the base portion. Thus, Campagnolo has failed to satisfy *SciMed*' s requirement that the specification expressly disclaim an alternate arrangement before the specification may limit the claim language.

Likewise, Campagnolo's argument that the base portion would be rendered non-functional if not connected to the brake wire is both inaccurate and irrelevant. Even if not connected to the brake wire, the base portion would still have a function: connecting the brake lever to the support member. Further, even assuming Campagnolo could find support for this functional limitation in the specification, that limitation cannot be imported into the claims absent an express disclaimer such as that described in *SciMed*. FN4

FN4. Campagnolo also alleges that Shimano attempted to change the definition of "base portion" after initially applying for the patent by moving the base portion forward on the BL (as it is mounted to the bicycle) during its prosecution. In so arguing, Campagnolo assumes that the base portion was defined in the specification prior to the prosecution. However, nowhere in the specification does the term "base portion" appear, and therefore, Shimano's correspondence with the patent examiner is hardly inconsistent with the specification. Furthermore, this allegation is irrelevant to the construction of the term "base portion," since the only dispute between the parties is whether the brake wire must attach to the base portion.

In sum, Campagnolo ignores controlling patent claim construction law by seeking to narrow the claim language of the patent by referencing the specification. Because the patent contains no language that expressly disclaims embodiments that do not include a brake wire attachment in the "base portion, SciMed provides no support for the proposed construction of the term. Accordingly, the Court adopts Shimano's construction and defines "*base portion*" as "*a section of the brake lever that is connected to the support member though the first pivot axis, so that the brake lever rotates around such pivot axis as the brake lever is pulled to operate the brake*."

C. THE CURVED INTERMEDIATE PORTION (CIP) & THE CONTROL GRIP PORTION (CGP)

As described above, the brake lever is composed of three portions: the base portion, the curved intermediate portion (CIP) and the control grip portion (CGP). (Col.14:52-55). Although the claim language clearly envisions some distinction between the latter two portions, the language provides little guidance on how to draw the boundary between the two regions. Instead, it merely describes the areas as "a curved intermediate portion extending from said base portion, and a control grip portion extending from said intermediate portion." (*Id*.) The terms CIP and CGP do not appear in the specification.

1. Shimano's proposed construction

Shimano seeks to distinguish the two portions by reference to the two positions a rider's hands may take when braking, a distinction echoed in the patent language. Thus, the patent indicates that the rider may place his or her hands "holding the lower extreme position of the curved portion of the dropped handlebar [and] the cyclist may extend the index and middle fingers ... of the hand holding the curved portion, hook the lever" to operate the brakes. (Col.5:62-66). In the alternative, the rider may place his or hands "holding the bracket ... fixed to the handlebar ... [and] extend the index, middle and ring fingers of the hand holding the bracket ... along the brake lever assembly and hook the lever member" to operate the brakes. (Col 6:20-25). Based on this distinction, Shimano argues that the structure which the rider can reach when his or her hands rest on the support member is the CIP, while the structure the rider can reach with hands on the bottom portion of the handlebar is the CGP, the latter appropriately named because it affords the rider a more "controlling grip" of the brake lever.

In addition, Shimano points to the prosecution history of the patent. Therein, the patent examiner issued an Office Action seeking clarification of the CIP's boundaries. (Lee Dec. Ex. C). Shimano responded with a hand-labeled rendering of figure 15, which reveals the CIP to be much broader in scope than Campagnolo's limiting definition. (*Id*.) The Patent Examiner apparently accepted this response, because it issued the patent thereafter.

2. Campagnolo's proposed construction

In contrast, Campagnolo seeks to define the CIP and CGP by reference to the specification alone, notwithstanding the absence of these terms from the specification. Thus, Campagnolo argues that the specification provides for a "curved portion 23d" (*see, e.g.,* Col. 12:46) and an "intermediate portion 23," (*see, e.g.,* Col. 12:49) and therefore concludes that the CIP consists of the "curved portion 23d." In addition, Campagnolo defines the CGP as that portion which *extends from* the intermediate portion. That is, Campagnolo distinguishes between the intermediate portion and the CIP on the one hand, and the CGP and the intermediate portion on the other hand. Thus, under Campagnolo's construction, the brake lever is

composed of four structures: the base portion, the CIP, the intermediate portion and the CGP.

For all that, this construction is unsatisfactory for two reasons. First, it is inconsistent with the claim language, which provides for three, and not four, parts of the BL. Therefore, Campagnolo's construction, to the extent it articulates a four-part BL, must be rejected. Second, the claim language requires the CIP to be "intermediate" between the base portion and the CGP. Yet, Campagnolo defines the CIP as only an "aspect" or face of the BL, that is, as one small part of the BL's front surface. It hardly seems accurate to describe an aspect as "intermediate," since a face cannot lie between the base portion and the CGP. Thus, adopting Campagnolo's construction would effectively read the adjective "intermediate" out of the claim language.

3. Summary

In sum, Campagnolo's construction of these terms must be rejected, since it runs counter to the claim language. Moreover, Shimano's construction harmonizes the claim language, the specification and the prosecution history. Accordingly, the Court adopts it, and constructs these terms as follows: (1) "*curved intermediate portion*" means "*a curved portion of the brake lever that lies between the base portion and the control grip portion, where the rider's hand position permits application of only slight pressure to the brake lever; on a bicycle with dropped handlebars, this hand position corresponds with the rider's hands resting on the support member;* (2) "*control grip portion*" means "*the distal end of the brake lever, where the rider's hand position permits application of greater pressure to the brake lever; on a bicycle with dropped handlebars, this hand position corresponds with the rider's hands resting on the lower portion of the handlebars*."

D. THE CONNECTION BETWEEN THE SCLM, SCCL, AND BLM

The claim provides for a "speed change lever means [SCLM] mounted in proximity to said brake lever means [BLM], said [SCLM] including: [para.] (a) a second pivot axis extending in a direction substantially perpendicular to said first pivot axis, and [para.] (b) a speed change control [SCCL] lever pivotably connected to said second pivot axis and having at least first and second speed change control positions ..." (Col.14:57-68). The disputed terms herein are "in proximity to" and "pivotably connected." but the only question raised by the parties is whether the claim requires that the SCLM be mounted to the BL, or more accurately, that the SCCL be connected to the second pivot, which in turn is mounted to the BL. Campagnolo answers this question in the affirmative, while Shimano answers in the negative.

As with its argument regarding construction of the term "base portion," Campagnolo seeks to circumscribe the claim language with limitations it infers from the specification. It justifies this limitation by pointing out that the claims are silent as to where the SCLM is mounted, thereby rasing questions as to its possible invalidity, due to indefiniteness. (*See generally,* Figs. 13-16). Accordingly, Campagnolo argues that the Court must re-write the claims, by importing limitations expressed in the specification, to preserve the validity of the patent. (*See, e.g.,* Opening Brief p. 20 ("the rules governing patent claim drafting expressly reject claims which simply set forth an assemblage of elements that do not interrelate to produce a cooperative result"); Resp. Brief p. 15 (failure to indicate what structure the SCLM is attached to "renders the claim 1[sic] of the '675 patent indefinite")). Campagnolo concludes that "it is common sense that the [SCLM] must be connected to something, and as shown by the specification, that something is the brake lever." (Resp. p. 17; Col 10: 26-29).

Although Campagnolo claims that the very validity of the patent may be compromised by Shimano's failure to articulate the attachment point of the SCLM, Campagnolo cites no authority to support the proposition

that the Court is required, or even permitted, to re-write the claim language to preserve the patent's validity. Likewise, Campagnolo has provided no authority to support its contention that use of the phrase "in proximity to" is so indefinite as to render a patent invalid. To the contrary, Shimano provides authority for the exact opposite proposition. *See, e.g.,* Rosemount, Inc. v. Beckman Instruments, Inc., 727 F.2d 1540, 1547 (Fed.Cir.1984) (in patent for pH monitors, "close proximity" is as precise as the subject matter permits); Andrew Corporation v. Gabriel Electronics, inc., 847 F.2d 819, 822 (Fed.Cir.1988) ("neither the record nor the law support [Defendant's] position that one of ordinary skill in the art would not know when the RPEs were "substantially equal" or "closely approximate"). Likewise, the claim language imposes other requirements upon the location of the SCLM that provide the patent with considerable definition. For instance, the SCLM must "extend along" the face of the brake lever, and the brake lever must "overlap" the SCLM. (Col. 14:67-68; 15:7-8).

Having failed to prove either that the patent is indefinite or that the Court may re-write it, Campagnolo again confronts the maxim that a party wishing to use statements in the written description to confine or otherwise effect a patent's scope must, at the very least, point to a term or terms in the claim with which to draw in those statements. Renishaw, 158 F.3d at 1248. Here, Campagnolo is unable to point to any such terms. Moreover, although Campagnolo relies on *SciMed* in an attempt to evade this rule, it points to no language in the specification that expressly limits where the SCLM might attach.FN5 Accordingly, the specifications cannot limit this claim.

FN5. Campagnolo's confusion stems from a simple misreading of the case. In its Opening Brief, Campagnolo cites language from *SciMed* that states: "where 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 ..." In the next paragraph, Campagnolo argues that the specification shows only one place to mount the SCLM: the BL. However, what Campagnolo must show is not what the specifications *permit,* but what they *prohibit*. That is, if language existed in the specification that revealed that the SCLM could not attach anywhere but to the BL, than it might prevail under *SciMed*. Having failed to do so, however, Campagnolo's construction cannot prevail.

Finally, Campagnolo turns to the prosecution history of the patent. Campagnolo notes that the Patent Examiner initially rejected the application, in part because the term "proximity" was "vague and indefinite because the specification fails to provide a standard for measuring said degree." (McArthur Dec. Ex. C at p. 231). Shimano responded by stating "the phrase should be construed in accordance with its ordinary dictionary definition ... proximity means the state, quality or fact of being near or next to; closeness ." (*Id*. at 237 (internal quotations omitted)). Shimano then went on to provide, "for example, in the embodiment illustrated in Figs. 13-16, the [SCLM] is mounted in proximity to the [BLM]." (*Id*. at 237). Campagnolo then argues that Shimano's response disclaimed, by its reference to Figs. 13-16, any device where the SCLM is not mounted to the BL.

To make this argument, Campagnolo blatantly disregards Shimano's express indication that the specification figures are mere exemplars of, and not limits on, the proposed invention. Moreover, Campagnolo overlooks the real import of this exchange: that Shimano expressly defined proximity as "near or next to" and the Examiner accepted that definition, ultimately issuing the patent without further complaint.

In conclusion, the Court finds Campagnolo's construction to be an impermissible importation of the specification language into the claim. Accordingly, the Court must reject Campagnolo's construction, and

accept Shimano's construction, which is supported by the claim language and the prosecution history. Thus, the term "*mounted in proximity to*" means "*mounted near or next to*." Likewise, the term "*pivotably connected*" means "*connected to* FN6 *and rotating around said second pivot axis*."

FN6. The Court modifies Shimano's definition here to add the phrase "connects to." Although Shimano failed to include this requirement in its proposed construction, at the hearing counsel for Shimano conceded that its omission was a mere oversight.

IV.

CONCLUSION

In sum, Campagnolo's arguments essentially boil down to an attempt to corral an otherwise broad claim with limitations inferred from the specification. Once stripped of this assertion, which runs counter to precedents too numerous to count, Campagnolo's construction of the terms is revealed as inconsistent with both the claim language and the prosecution history. On the other hand, Shimano's constructions, for the most part, comport with the claim language, the specification and the prosecution history. Accordingly, the Court adopts the following constructions:

1. "base portion" means "a section of the brake lever that is connected to the support member though the first pivot axis, so that the brake lever rotates around such pivot axis as the brake lever is pulled to operate the brake."

2. "curved intermediate portion" means "a curved portion of the brake lever that lies between the base portion and the control grip portion, where the rider's hand position permits application of only slight pressure to the brake lever; on a bicycle with dropped handlebars, this hand position corresponds with the rider's hands resting on the support member

3. "control grip portion" means "the distal end of the brake lever, where the rider's hand position permits application of greater pressure to the brake lever; on a bicycle with dropped handlebars, this hand position corresponds with the rider's hands resting on the lower portion of the handlebars."

4. "in proximity to" means "speed change lever means near or next to the brake lever means"

5. "pivotably connected" means "connects to and rotates around said second pivot axis."

IT IS SO ORDERED.

C.D.Cal.,2001.
Shimano, Inc. v. Campagnolo S.R.L.