United States District Court,
C.D. California.

SHIMANO, INC,
v.
CAMPAGNOLO S.R.L.

No. CV 00-7710-GAF (SHx)

May 25, 2001.

Attorneys Present for Plaintiffs: None Present.

Attorneys Present for Defendants: None Present.

TENTATIVE RULING

GARY ALLEN FEESS**, Judge.**

Marilynn Morris Courtroom Deputy Clerk

None Present Court Reporter

PROCEEDINGS: (In Chambers)

The Court has received and reviewed the parties' opening and responsive briefs regarding claim construction, the parties' joint claim construction statement, and their respective motions regarding the use of expert witnesses and equipment at the *Markman* claim construction hearing, currently scheduled for **Wednesday, May 30, 2001.** In response to these submissions, the Court issues the following tentative rulings:

1. Tentative Order Regarding Claim Construction of "Base Portion," "In Proximity To" and "Pivotably Connected "

The Court has reviewed the constructions for these terms offered by the parties, and concludes that the relevant intrinsic evidence does not support Campagnolo's proposed constructions. In each construction, Campagnolo seeks to limit the scope of the claims by importing limitations from the specification. Yet, it is a fundamental canon of patent construction that an otherwise broad claim cannot ordinarily be limited by the specification or embodiments disclosed in the patent. "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." Renshaw v. Marposs Societa'per Azioni, 158 F.3d 1243, 1248 (Fed.Cir.1998)("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"); SciMed Life Systems, Inc. v. Advanced

Cardiovascular Systems, Inc., 242 F.3d 1337 (Fed.Cir. Mar. 14, 2001); Comark Communications, Inc. v. Harris Corporation, 156 F.3d 1182, 1186 (Fed.Cir.1998).

Accordingly, the Court tentatively adopts the construction offered by Shimano, and will not entertain extensive argument on the construction of these terms at the hearing

2. Use of Expert Testimony for Construction of Remaining Claim Terms

The Court has reviewed the parties' construction of the terms "curved intermediate portion" and "control grip portion." The Court questions Campagnolo's construction because it suggests that the brake lever is composed of *four* distinct regions: the base portion, the "curved intermediate portion" (which is the "curved portion" of the "intermediate portion"), the "intermediate portion" and the "control grip portion". This construction is inconsistent with the face of the claim which discloses only *three* distinct regions. Further, Campagnolo's construction is inconsistent with the use of the term "intermediate" in the phrase "curved intermediate portion," and it further ignores the prosecution history which reveals that the "curved intermediate portion" encompasses more than the "curved portion" identified as area 23d in Figure 15. Shimano's construction of the term "control grip portion" also appears flawed, since it points to no support in the specification that the broad bulge 22 composes the entirety of the "control grip portion".

Because both parties' constructions of the patent claims have proven unpersuasive, the Court will entertain the testimony of the expert witnesses at the hearing. However, the testimony will be confined to issues that bear on the meaning of the phrases "curved intermediate portion" and "control grip portion."

3. The Prosecution History

The Court notes that Campagnolo contends that only the parts of the specification accompanying the fourth embodiment may be considered by the Court in constructing the patent's terms. However, Campagnolo presents no authority supporting its contention that an election of species in a parent patent limits construction of a subsequent divisional patent. Campagnolo should be prepared to present such authority at the upcoming hearing.

4. Use of Electronic and Demonstrative Equipment

Both parties have moved the Court for leave to bring three laptop computers, two projectors, two visual presenters, two projection screens and various cables, demonstrative boards and a complete working bicycle. The parties are ordered, to the extent possible, to avoid bringing duplicate equipment to the courtroom. The parties should also be aware that the Courtroom lights cannot be dimmed or turned off, and should take that into account in preparing their presentations.

5. Summary

To summarize, the court issues a tentative order in favor of Shimano's construction of the claim language "base portion," "in proximity to," and "pivotably connected." Campagnolo is granted leave to file a five page responsive brief, outlining any additional argument it wishes to make with respect to these claims. In addition, the parties are permitted to present expert testimony regarding construction of the terms "curved intermediate portion" and "control grip portion". No additional expert testimony will be permitted.

IT IS SO ORDERED.

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