

United States District Court,
S.D. California.

SPEEDPLAY, INC., a California corporation,
Plaintiff.

v.
BEBOP INCORPORATED, a California corporation,
Defendant.

No. Civ.95-00866-BTM

Sept. 25, 1996.

Eleanor Marie Musick, Kathleen Ann Pasulka, Brown Martin Haller and McClain, San Diego, CA, for Speedplay Inc. a California Corporation, plaintiff.

Peter K Hahn, Luce Forward Hamilton and Scripps, San Diego, CA, Cooley Godward, San Diego, CA, Jeffrey L Fillerup, Luce Forward Hamilton and Scripps, San Francisco, CA, for Bebop Incorporated, a California corporation, defendant.

Peter K Hahn, Luce Forward Hamilton and Scripps, San Diego, CA, Cooley Godward, San Diego, CA, for Bebop Incorporated, counter-claimant.

Kathleen Ann Pasulka, Brown Martin Haller and McClain, San Diego, CA, for Speedplay Inc, counter-defendant.

**ORDER CONSTRUING CLAIMS; DENYING DEFENDANT'S MOTION FOR PARTIAL
SUMMARY JUDGMENT; DENYING PLAINTIFF'S MOTION FOR SUMMARY
ADJUDICATION; AND DENYING MOTION TO STRIKE AND FOR ATTORNEY'S FEES**

MOSKOWITZ, J.

And related counterclaims.

INTRODUCTION

Plaintiff/counterdefendant, Speedplay, Inc., ("Speedplay"), filed a complaint on June 13, 1995, alleging a claim for patent infringement, trade dress infringement and unfair competition. Defendant/counterclaimant, Bebop, Incorporated ("Bepob"), answered on July 14, 1995 and asserted counterclaims against Speedplay for declaratory relief, unfair competition and intentional interference with prospective economic advantage. Speedplay has brought a motion, for summary adjudication of issues relating to the alleged infringement of U.S. Patent No. 4,942,778, claims 1-7, 9-11 and 13. Bebop has brought a motion for partial summary judgment seeking an order construing the claims of Speedplay's patents as a matter of law and an order

granting summary judgment on Speedplay's patent infringement claims. Bebop has also filed a motion to strike certain declarations filed in support of Speedplay's motion.

BACKGROUND

This case involves two corporations who produce clipless bicycle pedals. Clipless pedals allow cyclists to attach their feet securely to their pedals without the need for toeclips or straps. Almost all clipless pedal systems consist of a pedal designed to interfit with a cleat mounted in the rider's shoe. In general, all clipless pedal systems have the following elements in common: 1) the rider attaches his foot to the pedal by stepping down onto the pedal with the cleat and 2) releases by twisting the foot to one side.

Speedplay has alleged infringement by Bebop of two patents held by Speedplay for a clipless pedal and cleat. U.S. Patent No. 4,942,778 (the " '778 Patent"), is a utility patent entitled "Clipless Bicycle Pedal System," issued July 24, 1990 to Richard M. Byrne ("Byrne"). (Complaint at Ex. A). Speedplay is the exclusive licensee of the '778 patent. (*Id.* at para. 8). U.S. Patent No. 5,213,009 (the " '009 Patent"), is a utility patent entitled "Cleat For Clipless Pedals", issued May 5, 1993 to Richard M. Byrne. (*Id.* at Ex. B). Speedplay is the exclusive licensee of the '009 Patent. (*Id.* at para. 9). Speedplay alleges that Bebop is engaged in the manufacture, use, sale and/or advertising of clipless bicycle pedal systems and cleats that infringe Speedplay's '778 and '009 Patents. FN1 The composition of the Speedplay bicycle pedal system and cleat for clipless pedals is contained in the specifications and claims at issue for the '778 and '009 Patents. (*See* Complaint, Ex. A at col. 6, lines 14-66 and col. 7., lines 1-16, 24-25; Ex. B at Col. 8, lines 37-62).

FN1. The inventor of the Bebop pedal system is John D. Steinberg ("Steinberg"). A U.S. Patent was issued to Steinberg on September 10, 1991. However, the pedal system described in this patent is different from the Bebop pedal system which speedplay alleges has infringed the '778 Patent.

The Bebop pedal system consists of two components: a hollow tubular cage which acts as the bicycle pedal and a cleat which is attached to the rider's shoe for engaging the tubular cage. The tubular cage is designed to interfit with the cleat and defines a pair of apertures for receiving laterally projecting pins when the shoe member and the tubular cage have been interfitted. (Declaration of John Steinberg ("Steinberg Decl.") at para. 4). Bebop asserts that its pedal system is especially suited for rugged, off-road use because the tubular cage is hollow and any dirt and mud contaminants carried by the lateral pins will fall away from the pedal system upon interfitting of the cage and shoe members. Bebop also claims that its cleat is designed to be compatible solely with shoes employing the SPD or 2-bolt industry standard. They assert that their cleat is not compatible with the 3-bolt TIME and 4-bolt LOOK standards which Speedplay's cleat was designed to use. FN2

FN2. SPD, LOOK and TIME standards refer to the method used to attach the cleat to the sole of the rider's shoe. The LOOK standard means that three screws are used to attach the cleat to the sole, the TIME standard uses four screws, the SPD standard uses two screws.

DISCUSSION

I. STANDARD FOR GRANTING SUMMARY JUDGMENT

Summary Judgement is appropriate where "the pleadings, depositions, answers to interrogatories and

admissions on file, together with affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." *Celotex Corp. v. Catrett*, 477 U.S. 317, 324, 106 S.Ct. 2548, 91 L.Ed.2d 265 (1986). "Material facts are those necessary to the proof or defense of a claim, and are determined by reference to the substantive law." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255, 106 S.Ct. 2505, 91 L.Ed.2d 202 (1986)). The "mere existence of some alleged factual dispute between the parties will not defeat an otherwise properly supported motion for summary judgment; the requirement is that there be no genuine issue of material fact." *Id.*, 477 U.S. at 247-48. "... Summary judgment will not lie if the dispute about a material fact is 'genuine,' that is, if the evidence is such that a reasonable jury could return a verdict for the nonmoving party." *Id.* at 248.

Summary judgment is appropriate in patent cases where no genuine issue of material fact exists and the movant is entitled to judgment as a matter of law. *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1576-77 (Fed.Cir.1989). A motion of an accused infringer for judgment on the ground of non-infringement of a patent may be granted where the patentee's proof is deficient in meeting an essential part of the legal standard for infringement. *Id.* "The burden is always on the patentee to show infringement." *Envirotech Corp. v. Al George, Inc.*, 730 F.2d 753, 758 (Fed.Cir.1984).

To show infringement, the plaintiff must establish that the accused device includes every limitation of the claim or an equivalent of each limitation. *Id.*; *Zygo Corp. v. Wyko Corp.*, 79 F.3d 1563, 1568 (Fed.Cir.1996); *Dolly, Inc. v. Spalding & Evenflo Companies, Inc.*, 16 F.3d 394, 397 (Fed.Cir.1994); *Johnston*, 885 F.2d at 1577. To determine whether an accused device infringes a valid patent, the court must look first at the words of the claims. "If the accused matter falls clearly within the claim, infringement is made out and that is the end of it." *Graver Tank & Mfg. Co. v. Linde Air Prod. Co.*, 339 U.S. 605, 607, 70 S.Ct. 854, 94 L.Ed. 1097 (1950). Under the doctrine of equivalents, an accused product or process will infringe even if it does not literally infringe the claim, if insubstantial differences exist between the claims and the accused products. *Sofamor Danek Group, Inc. v. DePuy-Motech, Inc.*, 74 F.3d 1216, 1221 (Fed.Cir.1996)("Absent finding of literal infringement, the trial court can find that an accused device infringes by applying the doctrine of equivalents."); *Hilton Davis Chemical v. Warner-Jenkinson Co.*, 62 F.3d 1512 (Fed.Cir.1995)(*en banc*), *opinion supplemented by Hilton Davis Chemical v. Warner-Jenkinson Co.*, 64 F.3d 675 (Fed.Cir.), *cert. granted*, 516 U.S. 1145, 116 S.Ct. 1014, 134 L.Ed.2d 95 (1996).

II. BEBOP'S MOTION FOR SUMMARY JUDGMENT

Bebop's motion raises essentially two issues. First, Bebob requests that the court construe, as a matter of law, the language of the claims contained in the '778 Patent and '009 Patent in order to ascertain the scope of the inventions embodied in the patents. Second, Bebob requests the court to apply the claims, as construed, to Bebob's allegedly infringing clipless bicycle pedal system and rule that Bebob is entitled to a judgment of non-infringement.

"The determination of infringement is a two-step process: First, the court interprets the claim to determine its scope and meaning, second, the court determines whether the accused device is within the scope of the properly construed claim." *Dolly, Inc.*, 16 F.3d at 397 (Fed.Cir.1993)(citing *Becton Dickinson & Co. v. C.R. Bard, Inc.*, 922 F.2d 792, 796 (Fed.Cir.1990); *Rotu Barrier, Inc. v. Stanley Works*, 79 F.3d 1112, 1125 (Fed.Cir.1996). Pursuant to the Supreme Court's decision in *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996), "the construction of a patent, including terms of art within its claim, is exclusively within the province of the court." *Id.* at 1356. "To ascertain the meaning of claims, [the court should] consider three sources: The claims, the specification and the prosecution history."

Markman v. Westview Instruments, Inc., 52 F.3d 967, 979 (Fed.Cir.1995), *aff'd.*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (quoting Unique Concepts, Inc. v. Brown, 939 F.2d 1558, 1561 (Fed.Cir.1991)). "Expert testimony, including evidence of how those skilled in the art would interpret the claims, may also be used." *Id.* (quoting Fornar Corp. v. Johnson & Johnson, 821 F.2d 627, 631 (Fed.Cir.1987), *cert. denied*, 484 U.S. 1027, 108 S.Ct. 751, 98 L.Ed.2d 764 (1988)). The court may also consider extrinsic evidence such as treatises or dictionaries when required to assist in arriving at a proper claim construction. Terms in a claim are given their ordinary meaning unless it appears based on the above-mentioned factors that the terms were used differently by their inventors. *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387 (Fed.Cir.1992). Even though the parties may disagree on the meaning of a term within a claim, this does not necessarily create a genuine issue of fact." *Id.*

A. Construction of the Claim for the '778 Patent

The evidence is not so disputed that the terms in the claim cannot be construed by the court at the present time. Pursuant to *Markman* and based on the language of the claims, the specifications, the file history and other evidence, the court construes the claims below. The critical language in this case is set forth in claim 1 of the '778 Patent:

a pedal comprising:

"a block rotably mounted on said axle, said block having a top and bottom each being a generally convex surface....

...

a cleat comprising:

a plate member to be fixed to said sole of said rider's shoe and projecting downwardly therefrom, said plate member having a concave recess therein which generally corresponds to a portion of said convex surface of said pedal block....

(Complaint, Ex A at col. 6, In. 17-24 and 35-40). Bebob requests the court to construe these claims and define the following terms contained in the '778 Patent: "block," "surface," "convex" and "concave." In addition, at oral argument, the court confirmed that the meaning of the term "grooves" was also at issue.

The standard definition of block is "a compact *usually* solid piece of substantial material." Webster's Third International Dictionary at 235 (emphasis added). FN3 In addition, according to Figure 5 contained in the '778 Patent, the "pedal block" is not a solid because it contains space for the spindle mechanism. Thus, the term "block" is not construed as a "solid" and includes a partially hollow component in regard to the pedal in this case.

FN3. For instance, as stated by Speedplay's counsel, an "engine block" is not a solid.

The term "surface" is construed using the common definition of this term: "the exterior or outside of an object or body." Webster's Third New International Dictionary at 2300.

The terms concave and convex are the most difficult terms. The court must construe the claim based on the literal definition unless the specification, prosecution history or extrinsic evidence suggests otherwise. In the specifications, the pedal is described as having a symmetrically curved surface. Therefore, the court also construes the terms convex and concave, using the common definition, as follows: 1) convex-generally curved or rounded as the exterior or a section of a spherical or circular form; and 2) concave-a hollow within a mass or in a surface. Webster's Third New International Dictionary at 469 and 499. The term concave recess is construed as a hollow recess in a surface not limited to a certain shape.

The term grooves is construed as meaning a narrow or hollow channel or indentation made artificially in a surface. Webster's Third New International Dictionary at 1001.

B. Doctrine of Equivalents

As set forth below, Speedplay contends that the Bebop pedal system infringes upon the '778 Patent as construed based on the doctrine of equivalents. "... [A]pplication of the doctrine of equivalents rests on the substantiality of the differences between the claimed and accused products or processes, assessed according to an objective standard." Hilton Davis Chemical Co., 62 F.3d at 1518; *see* Sofamor Danek Group, Inc., 74 F.3d at 1222; *Zygo Corp. v. Wuko Corp.*, 79 F.3d 1563, 170 (Fed.Cir.1996)(for purposes of infringement under the doctrine of equivalents, the differences between the claimed device and the accused device must be insubstantial); *Perkin-Elmer Corp. v. Westinghouse Elec. Corp.*, 822 F.2d 1528, 1532 (Fed.Cir.1987)(doctrine of equivalents is designed to do equity and relieve inventor from a semantic straight jacket when equity requires, does not permit a claim expansion that would encompass more than an insubstantial change). However, the party alleging infringement still needs to prove equivalency on a limitation-by-limitation basis. *Texas Instruments, Inc. v. Cypress Semiconductor Corp.*, 90 F.3d 1558, 1566 (Fed.Cir.1996) (*Hilton Davis Chemical Co.*, did not eliminate proof of equivalency on a limitation-by-limitation basis); *Perkin-Elmer Corp.*, 822 F.2d at 1533. "Generalized testimony as to the overall similarity between the claims and the accused infringer's product or process will not suffice." *Id.* at 1567.

The court can often determine whether the claimed and accused products or processes infringe under the doctrine of equivalents if the products perform substantially the same function in substantially the same way to accomplish substantially the same result. *See* Sofamor Danek Group, Inc., 74 F.3d at 1222. However, the "function-way-result" test is not "the test" for determining whether substantial differences between the claims and accused device exist. *Id.*; *Hilton Davis Chemical Co.*, 62 F.3d at 1518. Evidence beyond the function-way-result test is relevant to the doctrine of equivalents. The court may consider whether persons reasonably skilled in the art would find substantial differences between the claims and the accused device. *Id.* Evidence of copying is also relevant to infringement under the doctrine of equivalents because evidence of copying would support the inference that only insubstantial differences in the inventions exist. *Hilton Davis Chemical Co.*, 62 F.3d at 1519. Furthermore, evidence of known interchangeability is also relevant to the doctrine of equivalents. Nonetheless, even when evidence supports the finding that the differences between the accused product and the claims are insubstantial, the court can not ignore the limitations in the patent itself. "A device which does not satisfy a limitation at least equivalently and does not function in substantially the same way as the claimed invention" cannot be found to infringe." *Intellicall, Inc.*, 952 F.2d at 1359. "... [I]nfringement under the doctrine of equivalents is an of issue of fact to be submitted to the jury in a jury trial with proper instructions..." *Hilton Davis Chemical Co.*, 62 F.3d at 1522.

C. Doctrine of Equivalents and the '778 Patent

As stated above, Speedplay must establish that only insubstantial differences exist between the '778 Patent

and the accused device to prove infringement. Bebop argues that there are no disputed issues of fact regarding the substantial nature of the differences between the '778 Patent and the Bebop pedal system and that summary judgment should be granted in their favor. Bebop claims that the following substantial differences exist:

1. The "hollow tubular cage" of Bebop's pedal is substantially different from the pedal block claimed by Speedplay because the pedal block must be "solid." The court has construed this term as not requiring a "solid." Thus, the difference may not be substantial. FN4

FN4. Bebop cites to *Hoganas AB v. Dresser Industries, Inc.* 9 F.3d 948, 954-55 (Fed.Cir.1993), for the proposition that a solid object cannot be the equivalent of a hollow object. *Hoganas AB*, concerned an action brought for patent infringement of monolithic refractory linings for industrial furnaces. The functional portion of the claim described straw-shaped channel forming elements while the functional portion of the accused product was a solid acetate fiber. In *Hoganas AB*, the court found that the claimed elements and the accused fiber did not function in the same manner and thus could not be equivalent to the claimed element. The court did not rely solely on the fact that the element was hollow while the fiber in the accused produce was solid. However, in this case, even though the Bebop pedal is hollow and the Speedplay pedal is a "solid," the pedals appear to perform a similar function to achieve the same results. Whether this difference is insubstantial is a disputed issue of fact as discussed below.

2. The Speedplay pedal system claim describes generally convex top and bottom surfaces. Bebop contends that its pedal system is substantially different because it does not contain a generally convex top and bottom or any surface which performs the same function as these convex surfaces.

3. Bebop contends that a number of functional advantages not included in the Speedplay pedal system exist in its pedal system including resistance to dirt accumulation and contamination because particulates can escape through the hollow structure in the Bebop pedal system. The same self-cleaning is not available on the Speedplay pedal system.

4. Bebop states that its pedal system lacks a groove with a bottom as contained in the Speedplay pedal system. It claims that because its tubular cage is hollow rather than solid, the openings or slots which engage the cleat are structurally and functionally different from those in the Bebop pedal system.

Speedplay asserts that in this case "[g]enuine issues of material fact exist relating to whether or not substantial differences exist between the Speedplay Pedal System claimed in the '778 ... Patent[] and the Bebop Pedal System." (Speedplay Inc.'s Opposition To Bebop's Motion For Summary Judgment at 2). Speedplay contends that each of the above-mentioned "substantial differences" are actually insubstantial. Speedplay has also set forth evidence that Bebop utilized parts from the Speedplay pedal system in the earlier designs of the Bebop pedal system and that this is evidence of copying. (Declaration of Kathleen Pasulka ("Pasulka Decl."), Exs. A and B; Declaration of Richard Byrne ("Byrne Decl.") para.9 and 11). Bebop responds that the only parts used from the Speedplay pedal system in the Bebop pedal system were the spindles and that the use of these parts is only an inference of copying. However, the fact that Bebop purchased the Speedplay pedal supports Speedplay's claim that the differences between the two pedal systems are insubstantial because copying is evidence to be considered in determining equivalency.

Speedplay also submitted the Declaration of Edward Giard ("Giard Decl."), who was designated by

Speedplay as an expert, as evidence that the doctrine of equivalents applies. Giard states that a person reasonably skilled in the relevant art would find that the "similarity of their [the Speedplay and Bebop] functions complimented by nearly identical dimensions make the pedals and cleats of the Speedplay and Bebop system interchangeable with few modifications." (Giard Decl. at para. 9). Giard sets forth the following analysis in his declaration:

Based upon my analysis of the elements of the Bebop pedal system and the pedal system disclosed and claimed in the Bryne '778 patent, in all important aspects, the two pedal systems perform the same function in the same way to obtain the same result:

- a) In both systems the engagement means consist of spring-loaded pins, plates or tongues which project into a recessed area in the cleat;
- b) The substantially convex or curved surface of the '778 patent provides a means for gradually forcing the pins or plates outward as the pedal is inserted into the recess in the cleat. In the Bebop pedal system, the combined beveled surfaces on the pedal edge and the edges of pins perform the same function, providing the means for gradually forcing the pins outward as the pedal is inserted into the recess in the cleat;
- c) In both systems, once the pins or plates are fully recessed in the groove or slot in the pedal they spring back to their original position;
- d) In both systems, the engaged cleat and pedal can be separated only by rotating the cleat with respect to the pedal. The rotation causes the end of the slot or groove to force the pins or plates outward to release the pedal;
- e) In both systems, the top and bottom of the pedal are symmetrical and equally capable of engaging with the cleat.

(Giard Decl. at para. 5). The fact that one reasonably skilled in the relevant art finds the Bebop pedal and the Speedplay pedal system interchangeable is further evidence that they are not substantially different.

The fact that the Bebop pedal may perform additional functions, such as self-cleaning, also does not mean that the two systems are not functionally equivalent. The addition of a new feature on an otherwise infringing device does not make the device non-infringing. *Texas Instruments, Inc. v. United States Int'l. Trade Com'n.*, 805 F.2d 1558, 1563 (Fed.Cir.1986)(modification of accused device does not negate infringement when that device has adequate features of the claims or their equivalent); *Atlas Powder v. E.I du Pont de Nemours & Co.*, 750 F.2d 1569, 1580 (Fed.Cir.1984). Thus, the self-cleaning function on the Bebop pedal created by the hollow cage does not make the Bebop pedal system non-infringing if it still performs the same function of engaging and disengaging the cleat in a substantially similar fashion.

Another argument made by Speedplay is that the '778 Patent is a pioneer invention which is entitled to a broader range of equivalents. *See Perkin-Elmer Corp.*, 822 F.2d at 1532. If the '778 Patent is a pioneer invention, Speedplay would have a broader range of equivalents and it would be more unlikely that no disputed issues of fact would exist. However, Bebop has presented evidence that substantial prior art in the field of clipless pedals exists. (Declaration of Christopher Jackzo "Jackzo Decl." at Exs. D-N). Speedplay's claim that the '778 Patent is a pioneer invention is repudiated by the existence of this prior art. *See Perkin-Elmer Corp.*, 822 F.2d at 1532. In addition, an examination of the specification reveals that the Speedplay

'778 Patent is merely an improvement on previously existing clipless pedal systems. "That an improvement enjoys commercial success and has some industry impact, as many do, cannot compel a finding that an improvement falls within a pioneer category." *Id.*

The court finds that disputed issues of material fact exist regarding whether or not there are substantial differences between the accused product and patented claim. *See* Hilton Davis Chemical Co., 62 F.3d at 1522. FN5 Therefore, Bebop's motion for partial summary judgment on the issue of infringement of the '778 Patent is DENIED.

FN5. There is substantial evidence that Bebop intended to "design around" the '778 Patent. "Evidence of designing around ... weighs against finding infringement under the doctrine of equivalents." *Hilton Davis Chemical Co.*, 62 F.2d at 1520. Although there is evidence of designing around, the final question of whether the differences between the two pedal systems are insubstantial is an issue of fact which must be determined by the jury.

D. Doctrine of Equivalents and the '009 Patent

The only claim relating to the '009 Patent at issue in the case is claim 17. FN6 (Complaint, Ex. B, at Col 8, lines 37-62). Speedplay does not contend that the Bebop cleat literally infringes on claim 17 of the '009 Patent. The court has determined that each of the limitations contained in claim 17 of the '009 Patent are present under the doctrine of equivalents in the Bebop pedal and that there are disputed issues of material fact regarding the substantiality of differences between the Bebop cleat and the Speedplay cleat for clipless pedals as embodied in claim 17 of the '009 Patent.

FN6. At oral argument it was agreed that there are no disputed terms in claim 17 of the '009 Patent which must be construed by the court pursuant to the *Markman*.

Bebop relies on the deposition testimony of Edward Henry Giard ("Giard"), who testified that claim 17 of the '009 Patent describes a means for connecting the cleat to an industry standard shoe. (Supplemental Declaration of Michael G. Rhodes in Support of Bebop's Motion for Partial Summary Judgment ("Rhodes Supp. Decl."), Ex. A, p. 147). Girard also testified as follows regarding claim 17 of the '009 Patent:

Q. And does the Bebop cleat achieve that same function in the same way as the taught patent?

A. No.

(*Id.*). Speedplay's expert admitted that the Bebop cleat does not achieve the same function as claim 17 of the '009 Patent. FN7 However, the court finds that Giard's testimony confirms only that the Bebop cleat and the Speedplay cleat do not perform the same function in the same way as taught in the '009 Patent of connecting the cleat to an industry standard shoe. Giard's testimony does not state whether this difference is substantial and Bebop has not provided any expert testimony concerning whether a substantial difference exists regarding the way the cleat connects to an industry standard shoe. Material issues of fact also exist regarding whether the differences between the limitations described in claim 17 of the '009 Patent and the Bebop cleat are substantial. Finally, even though the specifications also indicate that the '009 Patent was intended to encompass a cleat which is compatible with both the Look and Time industry standards for the

mounting of a cleat to a shoe, the court finds that this function is not contained in claim 17 of the '009 Patent. Claim 17 of the '009 Patent does not contain the limitation that the cleat can attach to either the LOOK or TIME industry standard.

FN7. Giard did state in his declaration that:

... [B]ased upon my analysis, the Bebop cleat functions in the same way as the cleat claimed in the Byrne '009 patent to achieve the same result, i.e. that of attaching a cleat consisting of two layers to a shoe using an industry standard mounting pattern, where the cleat has one or more spring mechanisms which extend into a cavity for retaining a clipless pedal.

(Giard Decl. at para. 10). However, although Giard provided different testimony in his declaration, the court finds his admissions at the deposition, which was taken after the declaration was filed, persuasive.

Material disputed issues of fact exist as to whether the '009 Patent and the Bebop cleat perform equivalent functions. FN8 Thus, the motion for summary judgment as to claim 17 of the '009 Patent is DENIED.

FN8. The court also finds that the '009 Patent is not a pioneer invention due to the existence of numerous close prior art references and that fact that the only real evidence of pioneering status is the fact that the Speedplay pedal system is simpler than other previous clipless pedal systems. The '009 Patent is not entitled to pioneer status and therefore, the scope of equivalency should not be expanded.

III. Speedplay's Motion For Summary Judgment

Speedplay has moved for partial summary judgment on the claim that Bebop's pedal system infringes claims 1-7, 9-11 and 13 of the '778 Patent. Of the claims in the '778 Patent in issue the only independent claim is claim 1, with claims 2-7, 9-11 and 13 dependent on Claim 1. As set forth above, this means that in order to grant summary judgment on the claim for infringement, the allegedly infringing Bebop pedal system must contain all the limitations set forth in claims 1, 2-7, 9-11 and 13 of the '778 Patent. Speedplay contends that Bebop's pedal system infringes the '778 Patent under the doctrine of equivalents. Speedplay alleges that the differences in the devices are insubstantial and that there is no genuine issue of material fact as to Bebop's infringement. FN9

FN9. Speedplay's assertion that there are no genuine issues of fact regarding the doctrine of equivalents appears disingenuous when viewed in light of its opposition to Bebop's motion wherein it was stated that in this case "[g]enuine issues of material fact exist relating to whether or not substantial differences exist between the Speedplay Pedal System claimed in the '778 ... Patent[] and the Bebop Pedal System." (Speedplay Inc.'s Opposition To Bebop's Motion For Summary Judgment at 2).

Speedplay relies upon the declarations of two of its experts, Edward Giard and Edward Callan, in support of its motion. FN10 The underlying premise of each of these declarations is that although the language of the claims is not literally infringed by the Bebop pedal system, the Bebop pedal system performs the same function in substantially the same way to achieve substantially the same result as '778 Patent. The Callan Decl. reviews each limitation on claim 1 in the '778 Patent and sets forth the corresponding equivalent function in the Bebop pedal system. (Callan Decl. para. 16). The relevant parts of the Giard Decl. have already been discussed. Although these declarations do establish equivalency at some level, the court cannot

rely on the conclusory findings of experts to determine whether differences are substantial or insubstantial for the purposes of determining equivalency. An examination of the language of the claims and limitations in conjunction with the construction of these claims as made by the court leaves many disputed genuine issues of material fact relating to whether the differences in the accused item are substantial. Disputed issues of fact also exist as to the validity of '778 Patent and whether the '778 Patent was obtained through inequitable conduct. FN11 Therefore, Speedplay's motion for summary adjudication of the issue of infringement of the '778 Patent is DENIED.

FN10. Bebop has moved to strike the Callan Decl. in its entirety pursuant to Fed.R.Civ.P. 56(g) and requested sanctions in connection with taking Callan's deposition. These motions are discussed below. Bebop has also filed evidentiary objections to the Giard Decl.

FN11. Bebop has failed to satisfy their burden of proof at this time as to its claim of invalidity or inequitable conduct. *See Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1375 (Fed.Cir.1986), *cert. denied*, 408 U.S. 947 (1987)("Notwithstanding that the introduction of prior art not before the examiner may facilitate the challenger's burden of proof on invalidity, the presumption remains intact and on the challenger throughout the litigation, and the clear and convincing standard does not change."); *see Litton Systems, Inc. v. Honeywell, Inc.*, 87 F.3d 1559, 1570 (Fed.Cir.1996); *Nordberg, Inc. v. Telesmith, Inc.*, 82 F.3d 394, 395 (Fed.Cir.1996)("A party may show inequitable conduct by producing clear and convincing evidence of: (1) material prior art; (2) knowledge chargeable to the patent applicant of prior art and its materiality; and (3) applicant's failure to disclose the prior art to the PTO with intent to mislead."); *FMC Corp. v. Manitowoc Co., Inc.*, 835 F.2d 1411, 1415 (Fed.Cir.1987)(inequitable conduct not a magic incantation to be asserted against every patentee).

IV. MOTIONS TO STRIKE DECLARATIONS

Bebop has filed evidentiary objections and a motion to strike the Callan Decl. and moved for sanctions pursuant to Fed.R.Civ.P. 56(g) in connection with taking deposition discovery on and opposing the Callan Decl. Bebop has also filed evidentiary objections to the Giard Decl., and the Declaration of Richard M. Bryne ("Bryne Decl.").

A. Callan Decl.

Bebop moves to strike the Callan Decl. on several grounds, in addition, Bebop seeks sanctions under Fed.R.Civ.P. 56(g) for reasonable attorney's fees expended in connection with taking the Callan deposition. Bebop contends that Callan is not qualified as an expert because he is not skilled in the relevant art of bicycle components and has never testified as an expert in a patent case. Thus, they contend that his testimony is not admissible for the purposes of construing the claims or determining infringement. Bebop has also demanded sanctions stating that in his deposition Callan misstates the law relating to patent infringement cases.FN12 Bebop also states that Callan misstated the actual language of the claims in his declaration.

FN12. For instance, he stated that a patentee is not required to prove that every limitation set forth in a claim is found in the accused product to prove infringement. This statement is incorrect. *See Texas Instruments, Inc.*, 90 F.3d at 1567.

The court finds that at this time Callan may be qualified as an expert and will not strike his declaration on this ground. The nature of Bebop's objections go to the weight that should be accorded his testimony. Further testimony may be taken on this issue at trial. In addition, although Callan does make conclusory statements, the court finds that his statements could assist the court in construing the claims and determining whether there was infringement. As an expert, Callan is permitted to reach such conclusions. The court also finds that sanctions under Fed.R.Civ.P. 56(g) are inappropriate because there is no evidence of bad faith or that the declaration was made solely for the purpose of delay. The court is aware of the actual terms of the claim and the fact Callan may have misstated the claims or misstated the law does not require a finding of bad faith. Any misstatements can be used to impeach Callan at trial. Thus, the motion to strike and for sanctions is DENIED.

In regard to the Giard Decl. Bebop's first objection is that it was not sworn to under penalty of perjury and is therefore not admissible under 28 U.S.C. s. 1746. Bebop is correct. However, Giard did state that "I declare that, to the best of my knowledge, the foregoing is true and correct." Plaintiff shall submit a properly verified declaration by Giard within 14 days of the filing of this order or Bebop may bring a motion for appropriate sanctions under Fed.R.Civ.P. 56(g).

Although the court relied on Giard's declaration in denying bebop's motion for summary judgment on the '778 Patent, even without Giard's declaration there are disputed issues of material fact as to the '778 Patent. The court also overrules the objection that Giard is not an expert. Further testimony can be taken on this issue at trial to determine whether Giard is an expert skilled in the relevant art. Because the court finds that Giard qualifies as an expert at this time, he is permitted to make conclusory findings. Giard has stated that he examined the Bebop pedal system and conducted a thorough analysis of claim 1 of the '778 Patent. Thus, he has a foundation for his findings and conclusions. Therefore, the motion to strike portions of the Giard Decl. is DENIED without prejudice. As to the Bryne Decl., the court has not relied on his findings or conclusions in determining the motion, thus the evidentiary objections to his declarations are moot.

CONCLUSIONS

For the reasons stated above, IT IS HEREBY ORDERED that:

1. The claims of the '778 Patent are construed as set forth above;
2. Bebop's motion for partial summary judgment is DENIED;
3. Speedplay's motion for summary adjudication is DENIED;
4. The motion to Strike the Declaration of Edward Callan and for sanctions pursuant to Fed.R.Civ.P. 56(g) is DENIED;
5. The evidentiary objections to the Declaration of Edward Giard and Richard Byrne are overruled; and
6. The parties shall contact Magistrate Judge Stiven to reset all pretrial dates and schedule a settlement conference.

IT IS SO ORDERED.

S.D.Cal.,1996.
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