

REMARKS

After the foregoing Amendment, claims 9-14, 16-17, 30-42, and 44-56 are currently pending in this application. Original claim 51 and new claims 54-56 have been amended. Applicant submits that no new matter has been introduced into the application by these amendments.

Allowable Subject Matter

Applicant thanks the Examiner for indicating that claims 9, 11-14, 16-17, 30-31, 33-35, 37, 39-41, 45-46, 48, and 52-53 are allowed. Applicant respectfully submits that claims 10, 32, 36, 38, 42, 44, 47, 49, and 50 are dependent from the allowed claims and are allowable and a notice to that effect is respectfully solicited.

Claim Rejections - 35 USC § 112

Claim 54 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 54 has been amended to clarify that it is only the “at least one control lever” that operates “at least one switch associated with a bicycle electric device.” The amendment also eliminates the ambiguity regarding what the “at least one switch” in line 5 of the claim refers to.

Accordingly, withdrawal of the 35 U.S.C. § 112 rejection of claim 54 is respectfully requested.

Claim Rejections - 35 USC § 102

Claim 55 was rejected under 35 U.S.C. § 102(a and e) as being anticipated by Jinbo et al. (U.S. Patent No. 6,216,078). Applicant respectfully traverses this rejection.

Claim 55, as currently amended, is directed to a control lever for operating at least one switch of a bicycle electric device, the control lever being mounted in a support body adjacent to a brake lever. The control lever is rotatable about at least two separate axes, independently of the brake lever, and positioned so that rotation about a first axis brings the control lever into contact with the at least one switch and rotation about a second axis has no influence on the at least one switch. Jinbo et al. fails to disclose or suggest every element of currently amended claim 55 for several reasons. First, Jinbo et al. lacks a “control lever” that “independently of the brake lever, is rotatable about at least two separate axes.” (emphasis added). The Action points to Jinbo et al.’s second operating lever 43 as the “control lever” movable about an axis defined by bolt 31 and about an axis defined by pivot 27. However, Fig. 5 of Jinbo et al. shows that the brake lever 33 and control lever 43 are secured together by the stepped sleeve 45 and must rotate as a unit about the

first rotary shaft 27. Therefore, Jinbo et al.'s control lever 43 can only rotate “independently of the brake lever” about the single axis of bolt 31 either in a clockwise direction or in a counterclockwise direction, but not “about at least two separate axes” as recited by the claim.

Jinbo et al. further fails to disclose or suggest a control lever “positioned so that rotation about a first axis brings said control lever into contact” with the at least one switch of the bicycle electronic device. The Action asserts that movement of the control lever 43 about bolt 31 brings the lever into contact with switch 51 via contact 47L. However, as seen in Jinbo et al.'s Figs. 5-6B, the control lever 43 rotates a separate stepped sleeve 45, which supports a third rotary body 36 that contains the downshift switch contact 47L. (*See also* col. 7, lines 8-12 and 51-56). Therefore, when the control lever 43 is rotated in direction “a” for downshifting, it is the third rotary body 36 having the contact 47L that comes “into contact” with the fixed-side electric connector 54 to close the drive circuit and send a downshift signal. Jinbo et al.'s control lever 43 never comes “into contact” with at least one switch of the bicycle electronic device, as the downshift switch contact 47L and fixed-side electric connector 54 are separated from the lever 43 by multiple intervening components, including the stepped sleeve 45, the third rotary body 36, and the first rotary body 29.

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Because Jinbo et al. contains no teaching or suggestion of a control lever that “independently of the brake lever, is rotatable about at least two separate axes” and is “positioned so that rotation about a first axis brings said control lever into contact with” at least one switch of a bicycle electric device, this reference cannot anticipate claim 55 or render the claim obvious. Accordingly, withdrawal of the § 102 rejection of claim 55 is respectfully requested.

Claims 51 and 54-56 were rejected under 35 USC § 102(b) as being anticipated by Watarai (U.S. Patent No. 5,577,969). Applicants respectfully traverse this rejection.

Claims 51 and 54-56 have all been amended to include the limitation that the control lever must be rotatable about at least two separate axes, independently of the brake lever. Watarai fails to disclose or suggest every element of currently amended claims 51 and 54-56, as Watarai’s control lever 10 is not “rotatable about at least two separate axes,” as recited by each of the claims. The Action states that Watarai’s control lever 10 is movable in at least two directions, i.e., from the neutral position (N) towards the switch upshift position (U), or from the neutral position (N) towards the downshift position (D). However, Watarai’s control lever 10 moves in those directions by rotating about a single pivot axis 11, not “at least two separate axes.”

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Based on the amendments and arguments presented above, withdrawal of the § 102(b) rejection of claims 51 and 54-56 is respectfully requested.

Claim Rejections - 35 USC § 103

Claim 56 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Romano (U.S. Patent No. 5,470,277) in view of Jinbo et al. (U.S. Patent No. 6,216,078). Applicant respectfully traverses this rejection.

As discussed above with respect to claim 55, Jinbo et al. fails to disclose or suggest a control lever that is “rotatable about at least two separate axes, independently of the brake lever,” which is also recited by claim 56. At any given time, Jinbo et al.’s control lever 43 can only rotate about a single axis independently of the brake lever, either clockwise or counterclockwise about the bolt 31. The Action concedes that “it is unclear from Romano in what directions lever 44 can move.” As Romano fails to remedy the fundamental deficiency of Jinbo et al., the combination of references cannot render claim 56 obvious.

Based on the amendments and arguments presented above, withdrawal of the § 103(a) rejection of claim 56 is respectfully requested.

