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3624	7590	06/02/2011	EXAMINER	
VOLPE AND KOENIG, P.C. UNITED PLAZA 30 SOUTH 17TH STREET PHILADELPHIA, PA 19103			BONCK, RODNEY H	
			ART UNIT	PAPER NUMBER
			3655	
			NOTIFICATION DATE	DELIVERY MODE
			06/02/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

eoffice@volpe-koenig.com

DETAILED ACTION

The following action is in response to the amendment received May 4, 2011.

Claims 9-14, 16-17, 30-42 and 44-55 are pending.

The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414. In an earlier proceeding, namely the prosecution of the original patent application, claim 1 was amended to require that the control lever come into “operating contact” with the switch. The claim was then allowed. Removing the term “operating” now would constitute an improper recapture of subject matter surrendered in the application for patent. Accordingly the presence of the term “operating contact” cannot be considered an appropriate error upon which reissue can be based.

Claims 9-14, 16-17, 30-42 and 44-55 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Claims 51, 54 and 55 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*,

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258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application.

Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Claim 51 constitutes improper recapture of subject matter previously surrendered for the reason set forth above with respect to the oath/declaration. In addition claim 51 no longer requires that the control lever is mounted on a bicycle handlebar, which applicant argues was part of the language added to distinguish over the prior art during prosecution of the original patent. Claim 54 is broader than the claims of the patent/reexamination certificate in that it is directed to a support body rather than to a control lever or electric control device and does not require the control lever be adjacent the brake lever. Under MPEP 1449.01, claims "which are equal in scope to claims canceled by the reexamination certificate, or are broader than the scope of the claims canceled by the reexamination certificate, will generally be deemed as surrendered based on the patent owner's failure to prosecute claims of equal scope, and to present

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claims of broader scope in the reexamination proceeding.” Accordingly, claim 54 is directed to subject matter surrendered in earlier proceedings. Claim 55 substantially corresponds in scope to claim 1 that was cancelled during the reexamination proceeding and thus also constitutes surrendered subject matter.

Response to Arguments

Applicant argues that “operating contact” was added to claim 1 during prosecution of the original patent application merely to “correct minor issues of grammar and usage”, not to distinguish over the prior art. Rather claim 1 was amended to add that the lever is “attached to a support body, mounted on a bicycle handlebar adjacent to a brake lever” was added to distinguish over Fukuda(‘036). Thus, applicant maintains that broadening claim 51 by changing “operating contact” to “contact” would not constitute recapture and should be permitted. This is not convincing, however, since lever 15 in Fukuda is attached to a support body mounted on a bicycle handlebar. The lever, however, is not rotated into operating contact with the switch because the switch is actually on the lever. Thus it would appear that the “operating contact” limitation was necessary to distinguish over the prior art and that its removal from the claim would constitute an improper recapture of surrendered subject matter.

Claim 51 is also broadened by eliminating the limitation that the control lever is mounted on a bicycle handlebar. Claim 51, along with claims 54 and 55, are seen equal in scope to claims canceled by the reexamination certificate, or are broader than the scope of the claims canceled by the reexamination certificate and thus would be

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surrendered subject matter. Applicant argues that this should fall under the exception provided for in MPEP 1449.01, since the claims could not be broadened in the reexamination proceeding. The exception under MPEP 1449.01 states that broader claims can be presented if:

“(a) The broader claims in the reissue application can be patentable, despite the fact that the claims in the reexamination are not; and

(b) The broader claims in the reissue application could not have been presented in the reexamination proceeding.”

Both criteria (a) and (b) must be met, and applicant does not appear to establish criterion (a) is met. MPEP 1449.01 states, “Criterion (a) can occur if the broadened claims in the reissue application have an earlier effective date than those canceled by the reexamination certificate (as where the claims in the reissue application are supported by a parent application, and the reexamination claims are not). Criterion (a) can also occur if the subject matter of the broadened claims in the reissue application can be sworn behind, and the more specific subject matter of the reexamination claims cannot be sworn behind.” Thus it would not appear that the exception applies in this case. It is still believed that the claims are properly rejected.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RODNEY BONCK whose telephone number is (571)272-7089. The examiner can normally be reached on Monday-Friday 7:00AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David D. Le can be reached on (571) 272-7092. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rodney H. Bonck/
Primary Examiner, Art Unit 3655

rhb
May 27, 2011