

**REMARKS**

After the foregoing amendment, claims 9-14, 16, 17, 30-42, and 44-55 are currently pending in this application. Claims 1-8, 15, 18-29, and 43, which were canceled during reexamination, have been presented with the previous claim language in strike-through in accordance with MPEP § 1453[VI][D].

Claim 51 has been amended to recite that the control lever is “attached to a support body, mounted on a bicycle handlebar adjacent to a brake lever” and that rotation of the control lever about a first axis brings the lever into “operating contact” with at least one switch. These amendments to claim 51 are supported by at least col. 2, lines 10-14, col. 3, lines 40-45, and Figs. 1-4 and 7-10 of the published U.S. Patent 6,698,567, and by the language of claim 51 as issued in the Inter Partes Reexamination Certificate for U.S. Patent 6,698,567.

Claim 52 has been amended to recite that the gear change lever can shift between a rest position and an operating position of “said at least one of said pair of switches,” instead of “said first switch,” since the term “said first switch” lacks antecedent basis in the claim. Claim 52 has also been amended to recite that the gear change lever can be operated to control at least one of “said pair of switches” to ensure consistency. (emphasis added). These amendments to claim 52 are supported by at least col. 2, lines 20-24, col. 3, lines 40-54, and Figs. 3-4 and 7-10 of

the published U.S. Patent 6,698,567, and by the language of claim 52 as issued in the Inter Partes Reexamination Certificate for U.S. Patent 6,698,567.

Claim 53 has been amended to recite that the control lever operates “a first switch” of a bicycle electric device, thus providing antecedent basis for this term, and to recite that movement of the lever in a first direction brings it into operating contact with “said first switch” and movement in a second direction has no operating influence on “said first switch.” These amendments to claim 53 are supported by at least col. 2, lines 20-24, col. 3, lines 33-54, and Figs. 3-4 and 7-10 of the published U.S. Patent 6,698,457, and by the language of claim 53 as issued in the Inter Partes Reexamination Certificate for U.S. Patent 6,698,567.

Previously presented new claim 54 has been amended to recite a “control lever attached to a support body mounted on a bicycle handlebar, said support body including a brake lever arranged adjacent to said control lever,” and that rotation of the control lever about one axis brings it “into operating contact with said at least one switch,” while rotation of the control lever about another axis “has no operating influence” on the switch. (emphasis added). These amendments to claim 54 are supported by at least col. 2, line 66 – col. 3, line 2, col. 3, lines 33-54, and Figs. 1-4 and 7-10 of the published U.S. Patent 6,698,457.

Previously presented new claim 55 has been amended to recite that the control lever is “attached to a support body mounted on a bicycle handlebar adjacent

to a brake lever,” and that rotation about a first axis brings the control lever “into operating contact with said at least one switch,” while rotation of the control lever about a second axis “has no operating influence” on the switch. (emphasis added). These amendments to claim 54 are supported by at least col. 2, line 66 – col. 3, line 2, col. 3, lines 33-54, and Figs. 1-4 and 7-10 of the published U.S. Patent 6,698,457.

### **Telephonic Interview**

Applicant thanks the Examiner for the courtesy extended towards Applicant’s representative during the telephone interview conducted on June 28, 2011. During the interview, the rejection of the reissue declaration and the claims under 35 U.S.C. § 251 was discussed. Applicant’s representative and the Examiner also discussed the rejection of claims 51, 54, and 55 as being an improper recapture of broadened claimed subject matter, and the exception for broadening amendments under MPEP § 1449.01[I][B][3].

### **Oath/Declaration**

The Action found the reissue oath/declaration to be defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. Specifically, the Action stated that because claim 1 was amended during prosecution of the original patent application to require that

**Applicant:** Giuseppe Dal Pra'  
**Application No.:** 11/366,984

the control lever come into “operating contact” with the switch, removing the term “operating” would constitute an improper recapture of subject matter surrendered in the patent application. Applicant respectfully traverses this rejection, but in order to expedite prosecution, hereby submits a Corrected Reissue Declaration and a Supplemental Reissue Declaration to identify a different error upon which the reissue is based.

The Corrected Reissue Declaration states that claims 52 and 53 as issued in the Inter Parte Reexamination Certificate for U.S. 6,698,567 are believed to be defective by each reciting “said first switch,” which lacks antecedent basis in the claims. To correct this 35 U.S.C. § 112 issue, claims 52 has been amended to recite that the gear change lever shifts between a position at rest and an operating position of “said at least one of said pair of switches.” (emphasis added). Claim 53 has been amended to recite that the control lever operates “a first switch of a bicycle electric device” to provide antecedent basis for the term, and that movement in a first direction brings the lever into contact with “said first switch” and movement in a second direction has no operating influence on “said first switch.” (emphasis added).

Applicant respectfully requests that the objection to the reissue oath/declaration be withdrawn.

**Claim Rejections - 35 USC § 251**

Claims 9-14, 16-17, 30-42 and 44-55 were rejected as being based upon a defective reissue declaration under 35 U.S.C. § 251. As noted above, Applicant has submitted a Corrected Reissue Declaration to correct the defect and amended claims 52 and 53 to remedy the 35 U.S.C. § 112 error identified in the declaration.

Claims 51, 54, and 55 were also rejected under 35 U.S.C § 251 as being an improper recapture of subject matter surrendered in the application for the patent upon which the present reissue is based. Applicant respectfully traverses this rejection.

The Action found claim 51 to constitute improper recapture because during prosecution of the original patent application, claim 1 was amended to recite that the control lever comes into “operating contact” with the switch, and that the control lever is mounted on a bicycle handlebar. The Action stated that these limitations appear to be necessary to distinguish over the prior art and thus their removal from the claim would constitute an improper recapture of surrendered subject matter. Claim 51 has been amended to recite that the control lever is “attached to a support body, mounted on a bicycle handlebar adjacent to a brake lever,” and that rotation of the control lever about a first axis brings it “into operating contact with said at least one switch.” (emphasis added). Currently amended claim 51 includes the claim limitations added during prosecution of the

original application, and includes additional narrowing claim limitations that were not present in the originally claims.

The Action rejected claim 54 as being impermissibly broadened by being directed to a “support body” instead of a control lever or electric control device, and by not requiring the control lever to be adjacent to the brake lever. Claim 54 has been amended to recite “[a] control lever attached to a support body mounted on a bicycle handlebar, said support body including a brake lever arranged adjacent to said control lever,” in which rotation of the control lever about one axis “brings said control lever into operating contact with said at least one switch” and rotation about another axis “has no operating influence” on the switch. (emphasis added).

The Action also rejected claim 55 as constituting impermissible recapture of surrendered subject matter because the claim “substantially corresponds in scope to claim 1 that was cancelled during the reexamination proceeding.” (June 2, 2011 Action, at p.4). Applicant respectfully disagrees with this characterization of the claim, as claim 55 has been amended to recite that the control lever is “attached to a support body mounted on a bicycle handlebar adjacent to a brake lever” and positioned so that rotation about a first axis brings the control lever into “operating contact with said at least one switch,” while rotation about a second axis “has no operating influence” on the switch. (emphasis added). In addition, claim 55 is narrower than canceled claim 1 in several respects: by reciting that the control

lever is rotatable “independently of the brake lever;” by reciting that the control lever is “rotatable about at least two separate axes” instead of “movable in at least two directions;” by reciting “rotation about a first axis” and “rotation about a second axis” instead of “movement in a first direction” and “movement in a second direction;” and by reciting that rotation of the control lever about the second axis “does not move said at least one switch.” (emphasis added). As none of these claim elements are present in original claim 1 that was canceled during reexamination, claim 55 does not “substantially correspond in scope” to claim 1 and there can be no recapture pursuant to MPEP § 1412.02[I][C][1][b].

As discussed above, claims 51, 54, and 55 have each been amended to recite claim limitations that were added during prosecution of the original application, including the terms “operating contact” and the lever being “attached to a support body, mounted on a bicycle handlebar adjacent to a brake lever.” Claims 51, 54, and 55 are also narrowed as compared with the original patent claims, by reciting that the control lever is “rotatable about at least two separate axes” instead of merely “movable in at least two directions.” To the extent that claims 51, 54, and 55 are broader than the claims of the reexamination certificate or claims canceled during reexamination in other aspects, these broadened aspects are not directed to amendments/arguments made to overcome art rejections in the original prosecution, and thus does not constitute recapture. *See* MPEP § 1412.02[I][C][2].

Furthermore, MPEP § 1449.01 provides for an exception where claims broader than those canceled during reexamination can be presented where: “(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.” (emphasis added). Claims 51, 54, and 55 satisfy both requirements of this exception. The Action states that criterion (a) does not appear to be established because the claims do not fall under one of the examples set forth in MPEP § 1449.01. Applicant respectfully disagrees. While MPEP § 1449.01 states that “[c]riterion (a) can occur if the broadened claims” have an earlier effective date than the canceled claims or if the subject matter of the broadened claims can be sworn behind, these are merely examples and are not the only ways in which criterion (a) can be satisfied. In the present reissue application, claims 51, 54, and 55 are patentable, even though the claims in the reexamination were not, because claims 51, 54, and 55 contain additional claim limitations that were not present in the claims canceled during reexamination. Specifically, the recitation that the control lever is “rotatable about at least two separate axes, independently of the brake lever” differentiate the present claims from the prior art. Claims 51, 54, and 55 thus satisfy criterion (a) of the exception under MPEP § 1449.01. Additionally, these claims could not have been presented in the reexamination proceeding, as

**Applicant:** Giuseppe Dal Pra'  
**Application No.:** 11/366,984

claims in an inter partes reexamination “will not be permitted to enlarge the scope of the claims of the patent.” 37 C.F.R. § 1.906(b); *see also* MPEP § 2658. To the extent that claims 51, 54, and 55 are considered to be broader than the claims of the reexamination certificate, these claims satisfy both prongs of the exception under MPEP § 1449.01.

In view of the Corrected Reissue Declaration and the amendments and arguments presented above, withdrawal of the § 251 rejections of claims 9-14, 16-17, 30-42, and 44-55 is respectfully requested.

**Applicant:** Giuseppe Dal Pra'  
**Application No.:** 11/366,984

**Conclusion**

If the Examiner believes that an interview will advance prosecution of this application, the Examiner is invited to contact the undersigned to arrange an interview at the Examiner's convenience.

In view of the foregoing amendment and remarks, Applicant respectfully submits that the present application, including all of the pending claims, is in condition for allowance and a notice to that effect is respectfully solicited.

Respectfully submitted,

Giuseppe Dal Pra'

By \_\_\_\_\_ /Linda X. Shi/

Linda X. Shi  
Registration No. 64,800  
(215) 255-9148  
LShi@vklaw.com

Volpe and Koenig, P.C.  
United Plaza  
30 South 17th Street  
Philadelphia, PA 19103-4009  
Telephone: (215) 568-6400  
Facsimile: (215) 568-6499

LXS/ASV/lat  
Enclosures