The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL SWIFT

Appeal No. 2004-2239
Application No. 09/975,417

ON BRIEF

Before KRATZ, DELMENDO, and PAWLIKOWSKI, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 (2003) from the examiner's final rejection of claims 5 through 8 (final Office action mailed Aug. 5, 2003), which are all of the claims pending in the above-identified application.[1]

[1] In the appeal brief filed Dec. 24, 2003 (p. 3), the appellant states:

> No amendment has been filed after the Examiner's final Office Action...[T]he appellant is proposing some very minor wording changes to Claims 5, 6, and 7

The subject matter on appeal relates to a “flip-flop bicycle pedal.” Further details of this appealed subject matter are recited in representative claim 5 reproduced below:

> 5. A flip-flop bicycle pedal, comprising:
> a. a main body pivotable about a transverse axis and having a spindle bolt for connecting to a bicycle, a top side and a bottom side;
> b. said top side having a first top toe cleat clamp which conforms to a bottom of a road type bicycle shoe cleat, the first top toe cleat clamp having a front recess for receiving a front tongue of the road type bicycle shoe cleat, said top side also having a first top rear spring-loaded retaining plate pivotable on said main body, the first top rear spring-loaded retaining plate having a recess for receiving a rear tongue of the road type bicycle shoe cleat and when a force is applied to the first top rear spring-loaded retaining plate, the first top rear spring-loaded retaining plate moves away from said main body such that the rear tongue engages the recess of the first top rear spring-loaded retaining plate, where the first top rear spring-loaded

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> which if the Patent Office Board of Appeals will accept them based on the Applicant’s arguments, should certainly bring the present invention into condition for allowance...

Regarding the appellant’s proposed amendment, the examiner held that the proposed changes to the claims raise new issues requiring further consideration and/or search and thus would not be entered for purposes of this appeal. (Examiner’s answer mailed Apr. 5, 2004, p. 2.) The appellant did not file a timely petition to challenge the examiner’s decision regarding this proposed amendment.

retaining plate springs back into a locking position, and thereby locks the rear tongue of the road type bicycle shoe cleat thereto; and

c. said bottom side having a second bottom toe cleat clamp which is smaller than said first top toe cleat clamp of said top side and conforms to a bottom of a mountain bicycle type shoe cleat, the second bottom toe cleat clamp of said bottom side having a front locking member located adjacent to said front top rear spring-loaded retaining plate of said top side for receiving a front tongue of the mountain bicycle type shoe cleat, said bottom side also having a second bottom rear spring-loaded retaining member pivotable on said main body such that a rear tongue of the mountain bicycle type shoe cleat engages inside a recess of the second bottom rear spring-loaded retaining plate of said bottom side, where the second bottom rear spring-loaded plate of said bottom side springs back into a locking position, and thereby locks the rear tongue of the mountain bicycle type shoe cleat thereto.

The examiner relies on the following prior art references as evidence of unpatentability:

Gapinski et al. (Gapinski)	6,035,743	Mar. 14, 2000 (filed Mar. 18, 1998)

Claims 5 through 8 on appeal stand rejected under 35 U.S.C. § 102(e) as anticipated by Gapinksi. (Answer at 3-6; final Office action at 2-13.)

Because the examiner has not provided an adequate basis for denying the appellant’s claim for benefit of an earlier filing

date under 35 U.S.C. § 120 as to the appealed claims, we reverse.

A principal question in this appeal is whether the examiner has adequately established that the subject matter of the appealed claims is not entitled to benefit of an earlier filing date under 35 U.S.C. § 120 such that Gapinski is available as prior art under 35 U.S.C. § 102(e). We do not think that the examiner's position is supported by substantial evidence.

The present application is a continuation-in-part (CIP) application of prior application 09/360,561 ('561 application) filed on May 26, 1999, now abandoned, which in turn is a CIP of prior application 08/923,022 ('022 application) filed on Sep. 3, 1997, now abandoned. (Present specification at 1; "Combined Declaration and Power of Attorney" filed on Oct. 10, 2001.) Gapinski's application, on the other hand, was filed more than six months after the filing date of the '022 application, i.e., on Mar. 18, 1998.

35 U.S.C. § 120 reads as follows:

> An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same

> effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section.

For a claim in a later filed application to be entitled to the benefit of an earlier filing date of a previously filed application under 35 U.S.C. § 120, the previously filed application must comply with the written description requirement of 35 U.S.C. § 112, ¶1. In re Curtis, 354 F.3d 1347, 1351-52, 69 USPQ2d 1274, 1278 (Fed. Cir. 2004); In re Huston, 308 F.3d 1267, 1276, 64 USPQ2d 1801, 1806-07 (Fed. Cir. 2002); Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1571, 41 USPQ2d 1961, 1965-66 (Fed. Cir. 1997). "This requires the disclosure in the earlier application to reasonably convey to one of ordinary skill in the art that the inventors possessed the later-claimed subject matter when they filed the earlier application." In re

Curtis, 354 F.3d at 1351, 69 USPQ2d at 1278. Where there is a chain of applications, each application in the chain leading back to the earlier application must comply with the written description requirement of 35 U.S.C. § 112, ¶1. Lockwood, 107 F.3d at 1571, 41 USPQ2d at 1965-66.

The examiner's position is that the appealed claims recite, e.g., "a first top rear spring-loaded retaining plate," which is not "shown and adequately disclosed in SN'022." (Final Office action at 2.) According to the examiner, "the claims in this application are drawn to new Figs. 18-22 of this application as described on page 30..." (Id.) The examiner further contends (answer at 3-4):

> In the instant case, "a rear spring-loaded retaining plate" was not adequately disclosed in '022 application. In fact, Figs. 5a-5c of SN'022 fail to show the biased spring that makes the plate 204 to be pivotable. More important, the plate 204 shown in Figs. 5a-5c of SN'022 appears to be fixedly or not pivotably attached to the pedal body 206. Appellant's description of Figs. 5a-5c on page 9 of SN'022 was inadequate because it was unclear as to how Appellant made/use the un-illustrated spring such that the spring biases the plate 204.

We cannot agree. Nothing substantiates the examiner's allegation that the appealed claims "are drawn to new Figs. 18-22" of the present application. Thus, contrary to the examiner's viewpoint (final Office action at 2), the question is

not whether Figures 18-22 are described in the earlier applications. Rather, the issue is whether each of the earlier applications complies with the written description requirement of 35 U.S.C. § 112, ¶1, as to the subject matter of the appealed claims.

As pointed out by the appellant (appeal brief at 17-18), the disclosure of the ’022 application including Figures 5a, 5b and 5c and the description at page 9 reasonably conveys to one of ordinary skill in the art that the inventor possessed the subject matter of the appealed claims at the time the ’022 application was filed. (Appeal brief at 17-21; reply brief filed on May 28, 2004, pages 3-4.) In this regard, the ’022 application at page 9 describes a spring plate 204 that “moves back when the [LOOK compatible] cleat is inserted and snaps forward to lock the cleat on the pedal” as well as a spring loaded heel clamp 208 that “is pushed back under the downward movement of the cleat and finally springs forward to lock the SPD compatible cleat onto the pedal (213).”[2]

The examiner also argues (answer at 4-5):

[2] The examiner does not allege that the ’561 application lacks adequate written description for the now claimed subject matter.

> Appellant's failure to contest the rejection under 35 USC 112, first paragraph, in SN'561 is considered to be a de facto acquiescence to the validity of the Examiner's rejection under 35 USC 112, first paragraph, regarding the inadequate disclosure of the spring-loaded retaining plate/member in the parent application SN'561 and grand parent application SN'022.

We note, however, that the examiner provides no legal authority for this perceived "de facto acquiescence" on the part of the appellant to the rejection.

For these reasons, we reverse the examiner's rejection under 35 U.S.C. § 102(e) of appealed claims 5 through 8 as anticipated by Gapinski.

The decision of the examiner is reversed.

REVERSED

Peter F. Kratz Administrative Patent Judge	)	
Romulo H. Delmendo Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Beverly A. Pawlikowski Administrative Patent Judge	)	

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