

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 TAKESHI TAKACHI

Appeal No. 2006-1452
Application No. 10/117,026
Technology Center 3600

ON BRIEF

Before OWENS, BAHR and HORNER, *Administrative Patent Judges*.
HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the examiner's final rejection of claims 1-24 and 51, all of the claims pending in the application. Claims 25-50 have been canceled.

We reverse.

BACKGROUND

The appellant's invention relates to a bicycle shift control device. Claims 1 and 51 are representative of the subject matter on appeal, and a copy of these claims can be found in the appendix to the appellant's brief.

The examiner relies upon the following as evidence of unpatentability:

Yamane 5,921,139 Jul. 13, 1999

The appellant seeks our review of the examiner's rejection of claims 1-24 and 51 under 35 U.S.C. § 102(b) as being anticipated by Yamane.

Rather than reiterate in detail the conflicting viewpoints advanced by the examiner and the appellant regarding this appeal, we make reference to the examiner's answer (mailed November 10, 2005) for the examiner's complete reasoning in support of the rejection and to the appellant's brief (filed September 12, 2005) and reply brief (filed December 21, 2005) for the appellant's arguments.

OPINION

In reaching our decision in this appeal, we have carefully considered the appellant's specification and claims, the applied prior art, and the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations that follow. It is our view that, after consideration of the record before us, Yamane does not anticipate the claimed invention.

In the rejection of independent claim 1, the examiner has determined that Yamane teaches a bicycle shift control device including all of the elements of the claim. (Final

Office Action, p. 3).¹ The examiner has also determined that the structure of Yamane's device is capable of performing the intended use as recited in the claim. (Final Office Action, p. 3). Regarding claim 51, the examiner has determined that the gear portion 160 and the second gear portion 171 of Yamane correspond to the structure in the appellant's specification for allowing the operating member to rotate the transmission control member for a selected rotational distance without the second position setting member moving toward the disengagement position. (Final Office Action, p. 8).

The appellant contends that Yamane fails to disclose a device structured so that when operating member (16) rotates, it causes rotation of the transmission control member for a selected rotational distance without moving intermediate element (17) to the left toward the disengagement position. (Appellant's Brief, p. 5). The appellant explains,

Since drive surfaces (160a) of operating member (16) *always* press against driven surfaces (171a) of intermediate element (17) when operating member (16) rotates in the wire winding direction shown in Figs. 6(B)-6(D), operating member (16) and intermediate element (17) always rotate together during that time. Since takeup member (18) *always* moves as a unit with intermediate element (17), and since intermediate element (17) *always* rotates together with operating member (16) when operating member (16) rotates as shown in Figs. 6(B)-6(D), *all three* elements (16, 17, 18) rotate together during the movements shown in Figs. 6(B)-6(D). There is *never* a time

¹ The Examiner in his answer to the Appellant's Brief merely incorporated by reference the examiner's response to the Appellant's arguments in the final rejection on March 14, 2005. The Examiner is admonished not to rely on such incorporation by reference in future answers. See M.P.E.P. § 1207.02 (Rev. 3 August 2005) ("If there is a complete and thorough development of the issues at the time of final rejection, it is possible to save time in preparing the examiner's answer required by 37 CFR 41.39 by copying a rejection from a prior Office action and then pasting the copied rejection into the answer. *An examiner's answer should not refer, either directly or indirectly, to any prior Office action without fully restating the point relied on in the answer.*"') (emphasis added)

during the operation shown in Figs. 6(B)-6(D) that takeup member (18) rotates without a corresponding rotation of intermediate element (17). Furthermore, as operating member (16), intermediate element (17) and takeup member (18) rotate relative to fixed member (15), cam surfaces (170b) and (151b) slide relative to each other as shown in the right side of Figs. 6(B)-6(D), and intermediate element (17) moves axially to the left toward the disengagement position. Since cam surfaces (170b) of intermediate element (17) always press against cam surfaces (151b) of fixed member (15), there is never a time during operation shown in Figs. 6(B)-6(D) when operating member (16) rotates without moving intermediate element (17) to the left toward the disengagement position. (Appellant's Brief, p. 5).

Similarly, with respect to the operation of the device of Yamane in the wire unwinding direction, as shown in Figs. 7(A)-7(D), the appellant contends, "There is never a time during the operation shown in Figs. 7(B)-7(D) (Fig. 7(A) shows the idle state) when operating member (16) rotates without moving intermediate element (17) to the left toward the disengagement position." (Appellant's Brief, p. 5).

We agree with the appellant's position. The structure of the Yamane device is not configured to allow rotation of operating member (16) to rotate the transmission control member (18) for a selected rotational distance without moving intermediate element (17) toward the disengagement position. The teeth on the second gear portion (171) of the intermediate element (17) of Yamane are structured so that their surfaces engage with the surfaces of the teeth on gear portion (160) of operating member (16) as soon as a user rotates operating member (16). There is no space (S) provided in the device of Yamane, as in the appellant's invention, that would allow operating member (16) to rotate

transmission control member (18) for a selected rotation distance without moving intermediate element (17) towards the disengagement position.

This is evident from Figures 6A-6D and 7A-7D of Yamane. As shown, once the gears move from an idle state (shown in Figures 6A and 7A) to a state in which operating member (16) is being rotated, the surface (171a in Figure 6B, 171b in Figure 7B) of second gear portion (171) engages the surface (160a in Figure 6B, 160b in Figure 7B) of gear portion (160) and second gear portion (171) immediately starts to move to the left toward the disengagement position (shown in Figures 6B and 7B).

The device of Yamane is also structured so that “intermediate element 17 is in constant engagement with the takeup member 18.” (Yamane, col. 6, lines 18-20). Further, the tooth measurement (171h) of the second gear portion (171) is sized so that “the gear teeth of the second gear portion 171 of the intermediate element do not move over the teeth of the gear portion 160 of the operating element 16 and *remain captured by the same mating teeth. ...*” (Yamane, col. 6, lines 33-36) (emphasis added). As such, when the user rotates operating member (16), the gear portion (160) of operating member (16) engages second gear portion (171) of intermediate element (17) causing immediate rotation thereof, which in turn causes immediate rotation of takeup member (18) by virtue of its constant engagement with intermediate element (17).

We find that Yamane fails to disclose a bicycle shift control device “wherein the first coupling member and the second coupling member are structured so that rotation of the operating member rotates the transmission control member for a selected rotational distance without moving the second position setting member toward the disengagement position,” as recited in claim 1. We also find that Yamane fails to disclose any structure that would perform the recited function of “allowing the operating member to rotate the transmission control member for a selected rotational distance without the second

position setting member moving toward the disengagement position,” as recited in claim 51. Accordingly, we reverse the examiner’s rejection of claims 1 and 51.

With regard to remaining rejected dependent claims 2-24, because these claim rejections rely upon the underlying rejection of independent claim 1, we also reverse the examiner’s rejection of these claims.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-24 and 51 is reversed.

REVERSED

TERRY J. OWENS)
Administrative Patent Judge)
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) BOARD OF PATENT

JENNIFER D. BAHR) APPEALS
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