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GLOBAL IP COUNSELORS, LLP			DIAZ, THOMAS C	
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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* KENTARO KOSAKA, KAZUNORI OOKUBO, and  
YOSHIMITSU MIKI

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Appeal 2018-005502  
Application 14/878,207  
Technology Center 3600

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Before JOHN C. KERINS, WILLIAM A. CAPP and  
BRANDON J. WARNER, *Administrative Patent Judges*.

KERINS, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner's decision to reject claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing was conducted on January 16, 2020, with David Vaughn appearing on behalf of Appellant.

We AFFIRM, and designate our affirmance as a NEW GROUND OF REJECTION under 37 C.F.R. § 41.50(b).

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<sup>1</sup> The term “Appellant” is used herein to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Shimano Inc. Appeal Br. 4.

### THE CLAIMED SUBJECT MATTER

Appellant's invention relates to a bicycle operating device. Claim 1 is illustrative, and is reproduced below:

1. A bicycle operating device comprising:

a support structure;

a first release member movably supported on the support structure between a first non-releasing position and a first releasing position;

a second release member movably supported on the support structure between a second non-releasing position and a second releasing position; and

a select member movably supported on the support structure between at least a first select position and a second select position, the select member permitting movement of the first release member and preventing movement of the second release member while the select member is in the first select position, and the select member permitting movement of the second release member and preventing movement of the first release member while the select member is in the second select position.

### THE REJECTIONS

The Examiner rejects:

(i) claims 1–20 under 35 U.S.C. § 112(a), as failing to comply with the written description requirement;

(ii) claims 1–20 under 35 U.S.C. § 112(b), as being indefinite; and

(iii) claims 1–3 and 8–11 under 35 U.S.C. § 102(a)(1) as being anticipated by Miki (US 8,746,106 B2, issued June 10, 2014).

## ANALYSIS

### *Claims 1–20--35 U.S.C. § 112(a)--Written Description*

The Examiner takes the position that the claims fail to recite particular structure that accomplishes the functions and results set forth in the claims, and that the Specification does not provide adequate support for the claims. Final Act. 3. The Examiner additionally notes that “[i]t is not solely the ‘selector member’” that makes possible the functions recited, “but rather the combination thereof [and] the particular interconnections thereof with other elements which allow this functionality.” *Id.*

Appellant argues that claim 1 has never been amended, and thus forms part of the original disclosure. Appeal Br. 11. Appellant further maintains that the Specification includes a detailed disclosure as to the functioning of the “select member” at issue, and that, because the mechanical arts are predictable and the particular field of the present invention is mature, “a single embodiment is sufficient to show that the inventors possessed the currently claimed bicycle operating device.” *Id.* at 11–12.

Appellant is correct, in general, that in mature, predictable arts, the disclosure of a single embodiment may well be sufficient to provide written descriptive support for a claim encompassing that embodiment. However, the Examiner was on the right track in observing, as set forth above, that it is the interconnection(s) and interaction(s) of the claimed “select member” with other components that dictate the functionality of the select member. Final Act. 3. Indeed, we do not find in the disclosure of the functioning of the claimed “select member” any description as to how the select member operates to “prevent[] movement of the second release member while the select member is in the first select position,” nor to “prevent[] movement of

the first release member while the select member is in the second select position,” as set forth in all claims on appeal.

We appreciate and understand the disclosure presented in the excerpts from the Specification appearing in the Appeal Brief, which Appellant avers describe in detail “the functions and structures of select member 67.” Appeal Br. 11–12. That discussion explains how select member 67 operates to allow engagement one or the other of the first and second release members, depending upon the select member being in one or the other of the first and second release positions. *Id.* A disclosure of allowing engagement of only one of the release members at a time to move the engaged release member does not, however, describe in any manner how the non-engaged release member is prevented from being moved, which is a function recited in the claims as being performed by the select member. Neither the Specification nor the claims include any explanation as to how the select member operates to prevent movement of the non-engaged release member. As such, the Specification lacks evidence that Appellant was in possession of a device having a select member that performs this function.

We are cognizant that Appellant may have intended that the claimed function of “preventing movement” was to mean something along the lines of “not engaging so as to not effectuate movement,” which appears to be consistent with the operation of the device and select member as disclosed in the Specification. However, in claims such as those on appeal, which rely almost solely on functional recitations involving highly-generically recited structural components, with little to no recitation of the relative positions and interactions among the recited components, an accurate recitation as to the functions that are actually performed is essential.

Accordingly, we find that the “preventing movement” language attributed to the select member in all of the claims lacks adequate written descriptive support under 35 U.S.C. § 112(a). The rejection of claims 1–20 on this basis is sustained. Because our reasons for affirming differ to some extent from those presented by the Examiner, it might be considered that Appellant has not had a fair opportunity to react to the thrust of the rejection as it presently stands. *In re Kronig*, 539 F.2d 1300, 1302–03 (CCPA 1976); *see also In re Kumar*, 418 F.3d 1361, 1368 (Fed. Cir. 2005). As such, we designate our affirmance of the rejection as a new ground of rejection pursuant to 37 C.F.R. §41.50(b).

*Claims 1–20--35 U.S.C. § 112(b)--Indefiniteness*

The Examiner’s position appears to be that claims 1–20 are indefinite in that it is unclear whether the limitation(s) involving the recited “select member” should or should not be treated as invoking 35 U.S.C. § 112(f) and interpreted as a “means plus function” limitation. Final Act. 4–5; Ans. 13–14. The Examiner asserts that, even after proper analysis of the claim language is performed, the result of the analysis is inconclusive. Ans. 13–14 (citing Form Paragraph 7.34.24).

We do not find the Examiner’s analysis to be sufficiently clear and focused in determining how the claimed “select member” should be construed. The Examiner treats the term as not invoking § 112(f), and sees fit to apply the cited prior art accordingly. The indefiniteness rejection is therefore not sustained.

*Claims 1–3 and 8–11--35 U.S.C. § 102(a)(1)--Miki*

The Examiner finds that Miki discloses a select member (element 90) that functions in the manner claimed, based on a first select position characterized by spring 110 being compressed, and a second select position characterized by spring 110 being uncompressed. Final Act. 6. Appellant maintains that “there is no correlation between the compression state of the biasing element 110” and “whether or not the pulling pawl 54a and the release pawl 56a are permitted to move.” Appeal Br. 23.

Ultimately, it appears that, although first and second release members in the form of pawls 54a and 56a are movable or moved in certain positions of the bicycle operating device of Miki, and not moved in other positions, the Examiner has not adequately shown that spring/biasing element 110 being in compressed and uncompressed positions is responsible for effecting the different movement functions.

Accordingly, we do not sustain the rejection of claims 1–3 and 8–11 as being anticipated by Miki.

#### DECISION

The rejection of claims 1–20 under 35 U.S.C. § 112(a), as failing to comply with the written description requirement, is affirmed, with the affirmance designated as a New Ground of Rejection under 37 C.F.R. § 41.50(b).

The rejection of claims 1–20 under 35 U.S.C. § 112(b), as being indefinite, is reversed.

The rejection of claims 1–3 and 8–11 under 35 U.S.C. § 102(a)(1) as being anticipated by Miki is reversed.

CONCLUSION

In summary:

<b>Claim(s) Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/ Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1–20	§ 112(a)	Written description	1–20 (new ground)	
1–20	§ 112(b)	Indefiniteness		1–20
1–3, 8– 11	§ 102(a)(1)	Miki		1–3, 8–11
<b>Overall Outcome</b>			1–20	

TIME PERIOD FOR RESPONSE

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

Appeal 2018-005502  
Application 14/878,207

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. . . .

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

AFFIRMED; 37 C.F.R. §41.50(b)