

### **REMARKS**

In the January 22, 2009 Office Action, all of the claims stand rejected in view of prior art. No other objections or rejections were made in the Office Action.

#### ***Status of Claims and Amendments***

In response to the Office Action, Applicant has amended claims 1, 14 and 15 as indicated above. Applicant wishes to thank the Examiner for the thorough examination of this application. In summary, claims 1-15 are pending, with claims 1, 14 and 15 being the only independent claims. Reexamination and reconsideration of the pending claims are respectfully requested in view of the above amendments and the following comments.

#### ***Rejections - 35 U.S.C. § 102***

On page 2 of the Office Action, claims 1-4, 6 and 8-14 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,357,177 (Fey et al.). In response, Applicant has amended independent claims 1 and 14 to clearly distinguish the prior art of record.

In particular, independent claims 1 and 14 have been amended to indicate that two or more shifting data corresponding to two or more drive trains are stored in the control system of the present application. More specifically, claim 1 requires at least ***first and second data*** pertaining to ***first and second gear configurations*** of ***first and second drive trains***, the first and second drive trains being ***different***. Claim 14 now requires a ***plurality*** of data corresponding to a ***plurality*** of drive trains with ***different*** axial gear spacings. Clearly, this structure is ***not*** disclosed or suggested by Fey et al. or any other prior art of record.

Fey et al. discloses a memory device which stores “permissible” target gears. When the rider enters a command to shift to a desired gear, the comparator 38 looks at the permissible target gears stored in the memory device 34/52. If the desired gear is a

permissible gear, the rider's shift command is executed (see column 3.) However, Fey et al. does **not** teach storing information regarding different drive trains. On the contrary, Fey et al. is directed to a single drive train. It is well settled under U.S. patent law that for a reference to anticipate a claim, the reference must disclose **each and every element** of the claim within the reference. Fey et al. does not disclose a storage device containing first and second shifting data pertaining to first and second drive train gear configurations. Therefore, Applicant respectfully submits that claims 1 and 14, as now amended, are not anticipated by the prior art of record. Withdrawal of this rejection is respectfully requested.

Moreover, Applicant believes that dependent claims 2-4, 6 and 8-13 are also allowable over the prior art of record in that they depend from independent claim 1, and therefore are allowable for the reasons stated above. Also, these dependent claims are further allowable because they include additional limitations. Thus, Applicant believes that since the prior art of record does not anticipate independent claim 1, neither does the prior art anticipate the dependent claims. Applicant respectfully requests withdrawal of the rejection.

***Rejections - 35 U.S.C. § 103***

On pages 7-14 of the Office Action, claims 1-4, 8-13, 15 and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fey et al. in view of U.S. Patent No. 6,467,786 (Horiuchi), and claims 5 and 7 are rejected as being unpatentable over Fey et al. in view of U.S. Patent No. 6,564,661 (DeJonge), as well as being unpatentable over Fey et al. in view of Horiuchi and further in view of DeJonge. In response, Applicant has amended independent claims 1 and 15 as shown above.

Independent claims 1 and 15 have been amended to indicate that two or more shifting data corresponding to two or more drive trains are stored in the control system of the present application. More specifically, claim 1 requires at least ***first and second data*** pertaining to

*first and second gear configurations of first and second drive trains*, the first and second drive trains being *different*. Claim 15 now requires a *plurality* of gear spacing configurations corresponding to a *plurality* of drive trains with *different* axial gear spacings to be stored in a memory.

Clearly this arrangement is *not* disclosed or suggested by the combination of Fey et al. and Horiuchi. As explained above, Fey et al. does *not* teach storing information regarding different drive trains. On the contrary, Fey et al. is directed to a single drive train. Horiuchi fails to remedy this deficiency. Horiuchi teaches having preset gear ranges to shift to during automatic shifting, yet Horiuchi does *not* teach or suggest preset gear ranges for *different* drive trains (see column 2). In other words, both Fey et al. and Horiuchi fail to even remotely suggest storing data for different gear configurations corresponding to different drive trains.

Under U.S. patent law, the mere fact that the prior art can be modified does *not* make the modification obvious, unless an *apparent reason* exists based on evidence in the record or scientific reasoning for one of ordinary skill in the art to make the modification. See, KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1741 (2007). The KSR Court noted that obviousness cannot be proven merely by showing that the elements of a claimed device were known in the prior art; it must be shown that those of ordinary skill in the art would have had some "apparent reason to combine the known elements in the fashion claimed." Id. at 1741. The current record lacks any apparent reason, suggestion or expectation of success for combining the patents to create Applicant's unique arrangement of an electronic derailleur control system/method.

Moreover, Applicant believes that dependent claims 2-4 and 8-13 are also allowable over the prior art of record in that they depend from independent claims 1 and 15, respectively, and therefore are allowable for the reasons stated above. Also, these dependent

claims are further allowable because they include additional limitations. Thus, Applicant believes that since the prior art of record does not disclose or suggest the invention as set forth in independent claim 1, the prior art of record also fails to disclose or suggest the inventions as set forth in the dependent claims.

Therefore, Applicant respectfully requests that these rejections be withdrawn in view of the above comments and amendments.

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In view of the foregoing amendment and comments, Applicant respectfully asserts that claims 1-15 are now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested.

Respectfully submitted,

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