



1 Appellant claims a saddle for horses and the like. Claim 25, reproduced  
2 below, is further illustrative of the claimed subject matter:

3 25. A saddle, comprising:  
4 a tree having a pommel end and a cantle end, the tree including  
5 a bridge and two side panels, the two side panels being conjoined only at the  
6 pommel end, the bridge conjoining the side panels and being adjustable to  
7 vary an angle between the side panels;  
8 a girth mounting provided for each of the side panels, the girth  
9 mounting spreading loading along a length of each of the side panels;  
10 a stirrup mount situated on each of the side panels;  
11 a girth panel secured to each of the side panels; and  
12 a seat supermounting the tree.  
13

14 The references of record relied upon as evidence of obviousness are:

|               |              |               |
|---------------|--------------|---------------|
| 15 Horton     | GB 25,340    | Jan. 19, 1911 |
| 16 Gorenschek | US 3,835,621 | Sep. 17, 1974 |
| 17 Pellew     | US 4,996,827 | Mar. 5, 1991  |
| 18 Gonzales   | US 5,274,986 | Jan. 4, 1994  |

19  
20 Claims 37 and 38 stand rejected under 35 U.S.C. § 112, first paragraph as  
21 failing to comply with the written description requirement.

22 Claims 37 and 38 stand rejected under 35 U.S.C. § 112, second paragraph as  
23 indefinite for failing to particularly point out and distinctly claim the subject matter  
24 Appellant regards as the invention.

25 Claims 25-27 and claims 45 and 46 stand rejected under 35 U.S.C. § 102 as  
26 anticipated by Gorenschek.

27 Claim 37 stands rejected under 35 U.S.C. § 102 as anticipated by Horton.

28 Claims 39-48 stand rejected under 35 U.S. C. § 103 as unpatentable over  
29 Gorenschek.

30 Claims 28-30, 32 and 33 stand rejected under 35 U.S.C. § 103 as  
31 unpatentable over Gorenschek in view of Pellew. The Examiner erroneously

1 includes claim 31, which is objected to rather than rejected, in this group in the  
2 Answer.

3 Claims 34-36 stand rejected under 35 U.S.C. § 103 as unpatentable over  
4 Gorenschek in view of Gonzales.

5 Claim 38 stands rejected under 35 U.S.C. § 103 as unpatentable over  
6 Horton.

### 7 ISSUES

8 The issues for our decision in this appeal are:

9 the rejection of claims 37 and 38 under the first and second paragraph  
10 of 35 U.S.C. § 112;

11 the anticipation rejections based on either of the reference disclosures  
12 of Gorenschek and Horton; and

13 the obviousness rejections based on the combined teachings of the  
14 prior art.

### 15 FINDINGS OF FACT

16 Gorenschek discloses a saddle for a horse or the like. The saddle is  
17 composed of left and right bar members 34, seat member 25, with cutout 26, and  
18 pommel-like means 14. The seat member of Gorenschek has a bridge in the  
19 medial portion formed by the seat cutout 26 and the pommel cutaway portion 13.  
20 Neither the pommel-like means 14 or the bridge formed by the seat cutout and  
21 pommel cutaway portion are disclosed as adjustable.

22 Horton discloses a saddle composed of bars, a, connected by arches b and b'.  
23 The front arch b is connected via hinge joints c to the bars a, allowing a swiveling  
24 movement. (Horton p. 1, ll. 38, 39). The rear arch b' is attached to the side bars, a,  
25 by means of a socket d in which the extremity of bar b' fits and is secured therein  
26 by a set screw e. The rear bridge thus can be adjusted by means of washers e'



1           It is important to note that "[t]he invention is, for purposes of the 'written  
2 description' inquiry, whatever is now claimed." *Vas-Cath* at 1564, 19 USPQ2d at  
3 1117.

4           Section 112, second paragraph, is satisfied if a person skilled in the field of  
5 the invention would reasonably understand the claim when read in the context of  
6 the specification. *Marley Mouldings Limited v. Mikron Industries, Inc.*, 417 F.3d  
7 1356, 1359, 75 USPQ2d 1954, 1956 (Fed. Cir. 2005) (citing *Union Pac. Res. Co.*  
8 *v. Chesapeake Energy Corp.*, 236 F.3d 684, 692, 57 USPQ2d 1293, 1297 (Fed.  
9 Cir. 2001) (the definiteness requirement set forth in § 112, paragraph 2 "focuses on  
10 whether those skilled in the art would understand the scope of the claim when the  
11 claim is read in light of the rest of the specification")); *Miles Labs., Inc. v.*  
12 *Shandon*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993) (if the  
13 claims "reasonably apprise those skilled in the art of the scope of the invention, §  
14 112 demands no more"); *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238  
15 (CCPA 1971) (the indefiniteness inquiry asks whether the claims "circumscribe a  
16 particular area with a reasonable degree of precision and particularity").

17           The prior art may anticipate a claimed invention, and thereby render it  
18 non-novel, either expressly or inherently. *In re Cruciferous Sprout Litig.*, 301 F.3d  
19 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002), *cert. denied*, 538 U.S. 907  
20 (2003). Express anticipation occurs when the prior art expressly discloses each  
21 limitation (i.e., each element) of a claim. *Id.* In addition, "[i]t is well settled that a  
22 prior art reference may anticipate when the claim limitations not expressly found in  
23 that reference are nonetheless inherent in it." *Id.*

24           In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial  
25 burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d  
26 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745

1 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). It is incumbent upon the  
2 examiner to establish a factual basis to support the legal conclusion of obviousness.  
3 *See id.* at 1073, 5 USPQ2d at 1598. In so doing, the examiner is expected to make  
4 the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17,  
5 148 USPQ 459, 467 (1966), *viz.*, (1) the scope and content of the prior art; (2) the  
6 differences between the prior art and the claims at issue; and (3) the level of  
7 ordinary skill in the art. In addition to these factual determinations, the examiner  
8 must also provide “some articulated reasoning with some rational underpinning to  
9 support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988, 78  
10 USPQ2d 1329, 1336 (Fed. Cir. 2006) (*cited with approval in KSR Int’l. Co. v.*  
11 *Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)). Only if this  
12 initial burden is met does the burden of coming forward with evidence or argument  
13 shift to the appellant. *See Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. *Id.* at  
14 1445, 24 USPQ2d at 1444. *See also Piasecki*, 745 F.2d at 1472, 223 USPQ at 788.  
15 Obviousness is then determined on the basis of the evidence as a whole and the  
16 relative persuasiveness of the arguments. *See Oetiker*, 977 F.2d at 1445, 24  
17 USPQ2d at 1444; *Piasecki*, 745 F.2d at 1472, 223 USPQ at 788.

18 The Court recently expounded on the obviousness determination in *KSR*, stating:

19           The question is not whether the combination was obvious  
20           to the patentee but whether the combination was obvious  
21           to a person with ordinary skill in the art. Under the  
22           correct analysis, any need or problem known in the field  
23           of endeavor at the time of invention and addressed by the  
24           patent can provide a reason for combining the elements  
25           in the manner claimed.

26 *KSR*, 127 S.Ct. at 1742, 82 USPQ2d at 1397.



1 a bridge portion at the cantle end. Furthermore, the bridges in Gorenschek, while  
2 flexible, are not seen as adjustable.

3 However, we will affirm the § 102 rejection of claim 37 as lacking novelty  
4 over Horton. In our view, the provision of the screw and adjusting washers teaches  
5 that the rear connection in Horton is at least somewhat adjustable. This satisfies  
6 the limitations of claim 37. However, we reverse the rejection of claim 38 as  
7 unpatentable over Horton, inasmuch as a fabric bridge is not shown in Horton.

8 We reverse the rejections of claims 39-42 as unpatentable over Gorenschek  
9 inasmuch as Gorenschek does not satisfy the limitation of the base claim 25, as we  
10 pointed out, supra. Likewise with respect to claims 28-33 and claims 34-36  
11 rejected on based on Gorenschek and the additional teachings of Pellew and  
12 Gonzales, respectively, none of the references teaches an adjustable bridge at only  
13 the pommel end of the saddle as claimed in the independent claim.

#### 14 CONCLUSION

15 The rejection of claims 37 and 38 under 35 U.S.C. § 112, first paragraph, is  
16 affirmed.

17 The rejection of claims 37 and 38 under 35 U.S.C. § 112, second paragraph,  
18 is reversed.

19 The rejection of claim 37 as lacking novelty over Horton is affirmed.

20 The rejection of claim 38 as unpatentable over Horton is reversed.

21 The rejection of claims 25-27 and 45-46 under 35 U.S.C. § 102 as  
22 anticipated by Gorenschek is reversed.

23 The rejections of claims 39-48, 28-30, 32 and 33, and 33-46 as unpatentable  
24 over Gorenschek, Gorenschek in view of Pellew, and Gorenschek in view of  
25 Gonzalez, respectively, are reversed.

1                   No time period for taking any subsequent action in connection with  
2 this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.  
3 § 1.136(a)(1)(iv) (2006).

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AFFIRMED-IN-PART

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