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D E C I S I O N
of 9 January 2004

Case Number: W 0001/03 - 3.2.1

Application Number: PCT/GB 02/00902

Publication Number: WO 02/070400

IPC: B68C 1/04, B68C 1/02, B68C 1/16

Language of the proceedings: EN

Title of invention:
Adjustable Saddle

Patentee:
Quay Equestrian Limited

Opponent:
-

Headword:
-

Relevant legal provisions:
PCT R. 40.1, 40.2(c) and (e)

Keyword:
"Novelty of claim 1 (yes)"
"Non-unity *a posteriori* (no)"
"Additional search fees - refund (yes)"
"Protest fee - refund - (yes)"

Decisions cited:
-

Catchword:
-



Case Number: W 0001/03 - 3.2.1

D E C I S I O N
of the Technical Board of Appeal 3.2.1
of 9 January 2004

Applicant: Quay Equestrian Limited

Representative: Butler, Lance
Barker Brettell
10-12 Priests Bridge
London SW15 5JE (GB)

Decision under appeal: Protest according to Rule 40.2(c) of the Patent Cooperation Treaty made by the applicants against the invitation (payment of additional fees) of the European Patent Office (International Searching Authority) dated 2 July 2002.

Composition of the Board:

Chairman: S. Crane
Members: J. Osborne
B. Schachenmann

Summary of Facts and Submissions

I. The applicant filed an international patent application PCT/GB 02/00902 having 24 claims. The only independent claim reads as follows:

"1. A saddle including a tree (2) having a pommel end (4) and a cantle end (6) characterised in that the tree (2) includes two side panels (8) conjoined at the pommel end (4) by a bridge (12) capable of adjustment to vary the included angle between the two side panels (8), a girth mounting (19) provided for each of the side panels (8) and adapted in use to spread the loading along the length of the side panels, a stirrup mount (14) on each of the side panels (8), a girth panel (40) adapted for securement to each of the side panels (8), and a seat (50, 60) for supermounting the tree (2)."

II. The EPO acting as an International Searching Authority (ISA) invited the applicant to pay five additional search fees. In an annex to the invitation to pay additional search fees the ISA communicated the results of the search established on claims 1 to 3, cited GB-A-25340 (D1) as a category "X" document for claim 1 and indicated page 1, lines 36 to 39 of D1 as being relevant. In the invitation the ISA stated that "all technical features common to independent claim 1 can be found from document GB25340. The remaining potentially special technical features of the six inventions solve different problems, namely: ...".

- III. The applicant paid five additional search fees under protest and reasoned that it considered the finding of lack of unity of invention to be incorrect because the general subject-matter of the invention constitutes an improvement in all aspects of the saddle construction, whereby all parts interact to make the whole and are unable to stand alone.
- IV. The Review Panel of the ISA noted that the applicant did not challenge the finding that the subject-matter of claim 1 lacked novelty and informed the applicant of its opinion that the finding of lack of unity of invention was correct. The applicant paid the required protest fee.

Reasons for the Decision

1. According to Rule 40.1 PCT the invitation to pay additional search fees shall "specify the reasons" for the finding of a lack of unity of invention. In the present case the ISA begins its reasoning of the invitation to pay additional fees with a statement that all features of claim 1 can be found from D1. The Board understands this as a statement that the subject-matter of the claim was considered to lack novelty with respect to D1 and the subsequent reasoning therefore relates to an objection of lack of unity of invention *a posteriori*. In this situation it is necessary for the Board to first consider whether the subject-matter of the claim is in fact known from D1. Only if the subject-matter of claim 1 does lack novelty need the question of unity of invention be considered further.

2. The present application relates to a saddle for a horse. The saddle comprises a saddle tree having two side panels which rest on the body of the horse and which are connected together at the front ("pommel") end by a bridge. According to claim 1 there is provided at the pommel end "a bridge capable of adjustment to vary the included angle between the two side panels". This feature of an adjustable bridge is critical in the correct determination of novelty of the subject-matter of the claim.

2.1 In the described embodiment in the application the two side panels 8 are pivotally connected with the bridge 12 by hinges 10. Each side panel has an abutment 11 which when the tree is assembled faces an abutment 13 on the bridge. A spacer 30 may be inserted into a slot 15 between the abutments and so can limit the degree to which the side panels can pivot outwards (figures 4, 5). According to the description the angular adjustment of the bridge is achieved by the use of variable width spacers engaging the abutments (page 4, lines 6, 7). It follows from the foregoing considerations that the feature in claim 1 that the bridge is "adjustable" is not intended merely to relate to the possibility of relative pivoting between the bridge and the side panels. It is intended to define the possibility of limiting the included angle between the side panels.

2.2 D1 relates to a saddle in which the side panels "a" are connected to the bridge "b" at the pommel end by hinged joints "c". The pivot axes of the hinged joints are aligned with the end portions of a bridge "b¹" at the cantle end, which end portions enter into sockets "d" on the side panels in order to provide a common axis

"x" about which each side panel can pivot relative to the bridges. However, there is no disclosure of any abutment or other feature on the bridge at the pommel end for limiting the included angle between the side panels. Moreover, the passage in D1 which is indicated in the partial search report as being of relevance to the citation of D1 as an "X" category document (page 1, lines 36 to 39) merely relates to the alignment of the axes of the pivots such that easy pivotal movement between the bridge and the side panels is possible. There is no disclosure in D1 of the bridge at the pommel end being "capable of adjustment" as defined in claim 1.

3. The Board concludes from the foregoing that the subject-matter of claim 1 is novel with respect to the disclosure of D1 and the ISA was not justified in inviting the applicant to pay any additional search fees. Thus, the total reimbursement to the applicant of the additional search fees is ordered under Rule 40.2(c) PCT. Since the applicant's protest was entirely justified the protest fee is to be refunded (Rule 40.2(e) PCT).

Order

For these reasons it is decided that:

1. The refund of all additional search fees is ordered.
2. The protest fee shall be refunded.

The Registrar:

The Chairman:

S. Fabiani

S. Crane