

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte HARTMUT KAESGEN and DENNIS FOWLER

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Appeal No. 2004-2193  
Application No. 09/737,781

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ON BRIEF

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Before ABRAMS, STAAB, and BAHR, Administrative Patent Judges.  
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-12, which are all of the claims pending in this application.

We REVERSE.

### BACKGROUND

The appellants' invention relates to an air filtering means (claims 1-7, 10 and 11) and a method for filtering air (claims 8, 9 and 12). An understanding of the invention can be derived from a reading of exemplary claim 5, which appears in the appendix to the Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Kobayashi <u>et al.</u> (Kobayashi)	5,046,976	Sep. 10, 1991
Uhl	5,522,355	Jun. 4, 1996
Lenczuk	5,826,414	Oct. 27, 1998
Busboom <u>et al.</u> (Busboom)	6,105,349	Aug. 22, 2000

The following rejections stand under 35 U.S.C. § 103(a):

- (1) Claims 5, 6, 8 and 9 on the basis of Busboom in view of Kobayashi.
- (2) Claims 1-3 and 7 on the basis of Busboom in view of Kobayashi and Uhl.
- (3) Claims 4 and 10 on the basis of Busboom in view of Kobayashi, Uhl and Lenczuk.
- (4) Claims 11 and 12 on the basis of Busboom in view of Kobayashi and Lenczuk.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the Answer (Paper No. 17 [sic, 18]) for the examiner's reasoning in support of the rejections, and to the Brief (Paper No. 16) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The objective of the appellants' invention is to provide an air filter assembly for an apparatus for cutting vegetation which is less prone than prior art filters to clog with debris during use. In furtherance of this goal, the invention comprises, inter alia, an air filter having an intake that, in the language of independent claim 5, "generally faces away" from the front end of the apparatus and "is positioned downwardly." These limitations also are present in independent apparatus claim 1 ("positioned downwardly with respect to a plane normal to said forward direction of travel" of the apparatus) and independent method claim 8 ("said filtering air intake being positioned downwardly . . . [and] generally faces away from said front end" of the apparatus).

Independent claim 5 stands rejected as being obvious<sup>1</sup> in view of the combined teachings of Busboom and Kobayashi. In arriving at this conclusion, the examiner finds all of the subject matter recited in claim 5 to be disclosed or taught by Busboom, except for positioning the air filter intake so it is oriented downwardly. However, the examiner is of the view that it would have been obvious to modify Busboom in this manner in view of the teachings of Kobayashi “in order to prevent particles from getting into the engine air system.” (See Answer, page 3). The appellants argue that Kobayashi is not analogous art and therefore is improperly applied in the rejection, and that even if it is considered to be analogous art, there exists no suggestion to combine the references in the manner proposed by the examiner.

Busboom discloses a riding lawn mower of the type having a water cooled engine. The problem to which Busboom’s invention is directed is preventing the engine radiator from becoming clogged by debris carried by the air drawn therethrough. To

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<sup>1</sup>The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness under 35 U.S.C. §103, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant’s disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

accomplish this goal, Busboom teaches two features. The first is placing the radiator “above the engine behind the operators’ station” because “that . . . location is an area containing less debris to clog the radiator” (column 3, lines 55-59). The second is providing a grille (32) having a perforated screen member (56) over the radiator (26) at the point where the cooling air enters, with the screen member comprising a series of alternating grooves (62) and ridges (64) which extend downwardly and rearwardly from the upper to the lower ends thereof. According to Busboom, the alternating grooves and ridges of the air filter “provide[ ] a self-cleaning feature” (column 3, lines 51 and 52) by enabling accumulated debris to fall therefrom “by gravity and vibration,” as well as allowing the operator to run his fingers downwardly through the grooves to remove excessive debris (column 3, lines 24-28). While the Busboom air intake faces away from the front end of the apparatus, as is required by claim 5, it faces upwardly, rather than downwardly, and thus the reference fails to teach this limitation of the claim.

Kobayashi is directed to an air intake system for an outboard motor. To prevent water from reaching the engine, Kobayashi provides an air intake (28) comprising a downwardly oriented opening (36). The problem solved by Kobayashi is that of water entrained in the air being sucked into the engine air intake. “Debris” is not mentioned. No air filter is disclosed. The patent explains that “[g]ravity precludes the entrained water from entering the air inlet duct” and also “stops water which adheres to the bottom surface” of the duct from entering (column 3, line 42 et seq.).

The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Even considering, arguendo, Kobayashi to be analogous art, we fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to modify the Busboom apparatus in the manner proposed by the examiner. In this regard, we first point out that one of the features of the Busboom invention is locating the radiator on top of the engine, and to modify this system so that the air intake is oriented downwardly would necessitate a wholesale reconstruction of the machine, which in and of itself we consider to be a disincentive to the artisan to do so. In addition, the only teaching for orienting an air intake downwardly is found in Kobayashi, and it is for the purpose of utilizing gravity to prevent the passage of water into the engine air intake in an environment where water spray and condensation are present. Such a situation is not normally present in the environment in which the Busboom apparatus is operated, and it therefore is our view that the artisan would not have been motivated by Kobayashi to relocate the Busboom air intake in such a manner as to meet the terms of the claim.

In the final analysis, it is our view that the only suggestion for modifying the Busboom apparatus in the manner proposed by the examiner is found in the luxury of the hindsight afforded one who first viewed the appellants' disclosure. This, of course, is not a proper basis for a rejection. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). We therefore conclude that the combined teachings of Busboom and Kobayashi fail to establish a prima facie case of obviousness with regard to the subject matter recited in independent claim 5, and we will not sustain the rejection of claim 5 or of independent claim 8, which contains the same limitations and against which the same rejection has been applied. It follows that we also will not sustain the like rejection of dependent claims 6 and 9.

Independent claim 1 and dependent claims 2, 3 and 7 stand rejected as being unpatentable over Busboom and Kobayashi, taken further with Uhl, which was applied for teaching that it was known in the art at the time of the appellants' invention to provide an air flow velocity through an air filter intake that is less than the air flow velocity through the engine air intake. Be that as it may, Uhl fails to overcome the problem cited above regarding the lack of suggestion to combine Busboom and Kobayashi in the manner proposed by the examiner. This being the case, this rejection also is not sustained.

The addition of Lenczuk to the other references in the two rejections of claims 4 and 10, and claims 11 and 12, also does not overcome the problems in combining Busboom and Kobayashi, and the rejections of these claims cannot be sustained.

CONCLUSION

None of the four rejections is sustained.

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
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	)	
JENNIFER D BAHR	)	
Administrative Patent Judge	)	

NEA:psb

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WEGMAN, HESSLER & VANDERBURG  
6055 ROCKSIDE WOODS BOULEVARD  
SUITE 200  
CLEVELAND, OH 44131