Hazzard does not show a filtering element which includes a porous air-filtering central section with two side portions as called for in claims 8 and 10. Moreover, Hazzard does not show such a construction wherein a pair of silencing pipes are either integral with these side portions of the filtering element or which support the upper ends of such silencer pipes.

Moreover, the passage 90 of Hazzard does not project downwardly into an air inlet chamber because it is indeed itself an air inlet chamber (this in addition to its not being a silencer pipe). It is not proper or correct to reconstruct a reference as if it were a nose of wax, utilizing hindsight knowledge obtained from an applicant's own specification.

Regarding the West German patent which the Examiner relies on as a secondary reference, it in no way suggests a filter element having extended or side portions which support one or more tubes of any kind (whether silencing tubes or other tubes). In the German reference, the "short lengths of pipe (11) are mounted in the flange of the inner housing and admit air from atmosphere to the outside of the filter" 6, such filter 6 being "a cylindrical filter element. . . placed in the inner housing".

How does a skilled worker reasonably (without hindsight) combine or attempt to combine a structure such as that shown by Hazzard with one such as shown by the West German reference? One has a cylindrical filter element and the other has a flat filter element. Neither has a filter element having integral side portions for supporting downwardly projecting silencer pipes. Given the Hazzard construction, there is no way to adopt anything from the West German reference and meaningfully incorporate it into the Hazzard construction without a radical reconstruction of Hazzard, no such radical reconstruction being taught.

It is therefore clear that the construction (structures) of the devices of these two references are so different from one another that their combination could not have been obvious. There is no reason, no basis, no purpose, no teaching, no suggestion, no motive, no incentive set forth in either of these citations which serves to lead to any possible combination of their structures.

Such a combination comes only after the retrospective inspection of applicant's device, but not as of the time the instant invention was made (prior to the time which would permit hindsight).

Moreover, the pipes 11 of the West German reference extend upwardly into the annular chamber 11, and this is contrary to the instant invention. A person having normal skill in the art, attempting to follow the West German reference, would not only use a cylindrical filter element 6 as taught by such reference, but would also use upwardly extending pipes 11, both contrary to the instant invention. Any reliance on the West German reference would result in a structure contrary to the present invention. Therefore, if the two references were combinable (contrary to applicant's position), it is clear that the result of such combination would be inconsistent with and contrary to the presently claimed subject matter.

The Examiner now relies on yet another (third) reference, making any proposed combination even more difficult and unlikely. What the Examiner has done is look at applicant's construction and then go out "using the claims as a guide" and look through a series of references to see if he could find missing elements. The fact that the tubes 90 and 94 of Schonberger have flanges on their ends is totally irrelevant to anything having to do with the present invention. These are flow smoothing pipes 90 and 94, and there is no indication whatsoever that they provide any silencing function at all. Certainly, there is nothing in the prior art which would have made it obvious to use such pipes in place of the pipes 11 of the West German reference or in place of the inlet chamber 90 of Hazzard.

Furthermore, the pipes 90 and 94 of Schonberger et al are in the wrong location, i.e. they are downstream of the filter. These pipes additionally do not conform to the requirements of applicant's independent claims 2, 8 and 10, for example they do not extend downwardly from an upper supported end into an air inlet chamber nor do they have an upper end terminating at

approximately the level of the filter element so that the pipe does not extend substantially into an upper air chamber.

An attempt to combine the three references as the Examiner has attempted in this case is exactly contrary to the requirements of Ex parte Clapp, 227 U.S.P.Q. 972. In that case the Board of Appeals stated:

> Presuming arguendo that the references show the elements or concepts urged by the Examiner, the Examiner has presented no line of reasoning, and we know of none, as to why the artisan viewing only the collective teachings of the references would have found it obvious to selectively pick and choose various elements and/or concepts from the several references relied on to arrive at the claimed invention. In the instant application, the Examiner has done little more than cite references to show that one or more elements or subcombinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to a combination.

The same is true in the present case. Applicant here also has presented claims to a new combination of elements.

> To support the conclusion that the claimed combination is directed to obvious subject matter either the references must expressly or impliedly suggest the claimed combination or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. ... Based on the record before us, we are convinced that the artisan would not have found it obvious to selectively pick and choose elements or concepts from the various references so as to arrive at the claimed invention without using the claims as a guide. It is to be noted that simplicity and hindsight are not proper criteria for

> resolving the issue of obviousness. Note In re Horn, 203 U.S.P.Q. 969, 971 (CCPA 1979). Accordingly, we will not sustain any of the rejections presented.

The Honorable Assistant Commissioner of Patents, Rene Tegtmeyer, commented on this very line of cases during an address to the AIPLA on October 10, 1986. Mr. Tegtmeyer stated:

> Looking at how references have to be modified to apply them primarily under Section 103, but not exclusively there, looking at how the references have to be modified to make the rejection, looking at whether the differences between claims and what's in the references is clearly identified, and looking at whether or not the teaching or motivation is suggested or expressly taught in the references or in the prior art in the explanation of the rejection are all areas we identified as having serious lack of compliance with what we regard as a clear case law requirement in that area, and clearly part of the office policy.
>
> And if you look back at cases that go way back, you'll find that's the case. Bergel and Stock, back in 1961, a CCPA decision, says that. More recent cases and very recently, a Board decision, Ex parte Clapp says that very pointedly to the Examiners. And so there is a very clear line of cases all the way in between.

The references are diverse from one another even though they are all in the same general art. Not only is there no express teaching in any of the references for their combination, but the structures involved are so different from one another that there is not even any implication (outside of applicant's own disclosure) or any reason or purpose (let alone a motive or incentive) for bringing the references together in combination as proposed by the Examiner. The reconstructed combination of the references as proposed by the Examiner simply would not have been obvious and indeed was not obvious.