

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte HAROLD E. PUTHOFF

---

Appeal No. 95-3753  
Application 08/109,983<sup>1</sup>

---

HEARD: December 8, 1997

---

Before HAIRSTON, JERRY SMITH, and CARMICHAEL, Administrative  
Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

---

<sup>1</sup> Application for patent filed August 23, 1993. According to applicant, the application is a continuation of Application 07/708,331, filed May 31, 1991.

Appeal No. 95-3753  
Application No. 08/109,983

This is an appeal from the final rejection of claims 1 through 59. In an Amendment After Final (paper number 17), claim 53 was amended.

The disclosed invention relates to a method and apparatus for transmitting a signal that varies as a function of time. The transmitted signal has scalar and vector potentials, but without an electromagnetic field.

Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A method of communicating information that changes as a function of time from a first site to a second site comprising transmitting a signal that varies as a function of time in accordance with the information from the first site to the second site, the signal having scalar and vector potentials without including an electromagnetic field, receiving the transmitted signal at the second site, and detecting the information from the signal as received at the second site.

No references were relied on by the examiner.

Claims 1 through 59 stand rejected under 35 U.S.C. § 101 because allegedly the invention as disclosed is inoperative and therefore lacks utility.

Claims 1 through 59 stand rejected under the first paragraph of 35 U.S.C. § 112 because allegedly the specification fails to provide an enabling disclosure and, therefore, fails to adequately teach one skilled in the art how to make and/or use the invention without resort to undue experimentation.

Appeal No. 95-3753  
Application No. 08/109,983

Reference is made to the briefs and the answer for the respective positions of the appellant and the examiner.

OPINION

We have carefully considered the entire record before us, and we will reverse all of the rejections.

The grounds for rejecting claims 1 through 59 under 35 U.S.C. § 101 are as follows (Answer, page 3):

Independent claims 1, 14, and 25 all include a recitation of transmitting a "time varying signal comprising vector and scaler [sic, scalar] potentials without including an electromagnetic field". It is unclear how this is done given the disclosed structure of figure 2. Regarding independent claims 34 and 43, it is unclear how the "means for deriving a curl free vector potential" operates or how it is realized in physically operable device. Regarding claim 57, it is unclear how the recited receiver structure for "a scaler [sic, scalar] and vector potential signal" and the "shield for electromagnetic waves" would operate.

It appears claims 1-59 recite a theoretical device in which a physically realizable device is not operable from what has been disclosed.

In the grounds for finding lack of enablement for claims 1 through 59, the examiner refers (Answer, page 4 through 6) once more to claims 1, 14, 25, 34, 43 and 57, and contends that it is "unclear" how the disclosed circuitry and structure accomplish the objectives of the disclosed and claimed invention. The examiner asks (Answer, page 5), "[w]hat conclusive evidence is there that such a structure as disclosed in figures 4 and 5

Appeal No. 95-3753  
Application No. 08/109,983

accomplishes the objectives claimed by appellant," and "how is the A field measured." With respect to the shield 23, the examiner asks (Answer, pages 5 and 6) "[h]ow is it 'permeable to the scalar and vector potential signal' while resisting the electromagnetic field?"

In response to the rejection under 35 U.S.C. § 101, appellant argues (Reply Brief, pages 1 and 2) that:

In a proper rejection based on inoperativeness, it is incumbent upon the Examiner to establish a prima facie case that the device will not work. *In re Langer*, [503 F.2d 1380] 183 USPQ 288 (CCPA, 1974). In other words, the Examiner must introduce evidence to show that the claims define an aspect of technology that is contrary to accepted theory; for example, that the claims are directed to a perpetual motion machine. The Examiner's Answer completely fails in this regard. An inspection of the application as filed, in fact, provides a scientific basis to show the invention does, in fact, operate using standard scientific theories based on Maxwell's Equations; see e.g. the paragraph bridging pages 6 and 7 and the only full paragraph on page 7 of the application as filed.

In response to the lack of enablement rejection under the first paragraph of 35 U.S.C. § 112, appellant argues (Brief, pages 19 and 20) that:

[T]he Examiner has the initial burden of proving that the requirements of 35 USC 112, paragraph 1, are not met. *In re Marzocchi and Horton*, [439 F.2d 220] 169 USPQ 367 ([CCPA] 1971), p. 369. In the present case, no evidence has been presented by the Examiner to

Appeal No. 95-3753  
Application No. 08/109,983

show that the specification does not enable one of ordinary skill in the art to make and use the invention. Appellant respectfully contends that the disclosed embodiments are clearly shown and one of ordinary skill would be able to make and use the invention from the disclosure.

In summary, appellant argues (Brief, pages 24 and 25) that:

In essence, these rejections question whether the disclosed structure will work to produce the desired result. Basically, the Examiner questions whether it is possible to produce vector and scalar potentials without producing an electromagnetic field. The Examiner has produced no evidence to show such a result cannot be produced. Appellant has shown that the prior art Gelinas patents disclose the generation of a curl-free signal including vector and scalar potentials with a electric field. Appellant has modified the Gelinas structure by eliminating the electric field associated therewith. The electric field is eliminated by very conventional structures, such as plates in close proximity to a coil formed as a solenoid or toroid, and by proper excitation of the plates and coil. In the disclosed embodiments, the voltage applied to the plates and the current applied to the coil are adjusted to eliminate the electric field which was produced in the prior art Gelinas structure. Hence, the present invention works on recognized principles of science and there is no evidence to the contrary . . . Appellant has clearly shown there is an adequate disclosure in the specification and drawings to enable one of ordinary skill to make and use the invention. The Examiner has failed to meet the burden of proof required for rejections under 35 USC 101 or 35 USC 112, paragraph 1.

Appeal No. 95-3753  
Application No. 08/109,983

The examiner has the initial burden of making a *prima facie* evidentiary showing that the claims are unpatentable because of lack of enablement or inoperativeness. See *In re Marzocchi*, 439 F.2d 220, 223-224, 169 USPQ 367, 369-370 (CCPA 1971); and *Fregeau v. Mossinghoff*, 776 F.2d 1034, 1038, 227 USPQ 848, 852 (Fed. Cir. 1985). After considering the positions of both the examiner and the appellant, we agree with the appellant that the examiner's rationale for rejecting the claims under the first paragraph of 35 U.S.C. § 112 and 35 U.S.C. § 101 lacks the required evidence to establish a *prima facie* case of lack of enablement, inoperativeness, and lack of utility. In the absence of such a *prima facie* case, the burden never shifted to appellant to present rebuttal evidence. See *In re Brana*, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995). Thus, we see no need to comment on the declaration submitted by appellant. The rejections of claims 1 through 59 are reversed.

Appeal No. 95-3753  
Application No. 08/109,983

DECISION

The decision of the examiner rejecting claims 1 through 59 under the first paragraph of 35 U.S.C. § 112 and 35 U.S.C. § 101 is reversed.

REVERSED

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
	)	
	)	
JERRY SMITH	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
JAMES T. CARMICHAEL	)	
Administrative Patent Judge	)	

Appeal No. 95-3753  
Application No. 08/109,983

LOWE, PRICE, LEBLANC & BECKER  
99 Canal Center Plaza  
Suite 300  
Alexandria, VA 22314