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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/730,870	12/29/2012	Vesselin C. Noninski		9283

111804 7590 12/18/2018  
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EXAMINER
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FLEMING, FRITZ M

ART UNIT	PAPER NUMBER
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2836

MAIL DATE	DELIVERY MODE
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12/18/2018

PAPER

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* VESSELIN C. NONINSKI

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Appeal 2018-002116  
Application 13/730,870  
Technology Center 2800

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Before KAREN M. HASTINGS, JAMES C. HOUSEL, and  
JEFFREY R. SNAY, *Administrative Patent Judges*.

HOUSEL, *Administrative Patent Judge*.

DECISION ON APPEAL

A. STATEMENT OF THE CASE

Appellant<sup>1</sup> filed an appeal under 35 U.S.C. § 134(a) from the Examiner's final decision rejecting claims 1 and 4.

We have jurisdiction under 35 U.S.C. § 6(b).<sup>2</sup>

We AFFIRM.

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<sup>1</sup> Appellant is the inventor and represents himself as a *pro se* applicant.

<sup>2</sup> Our Decision refers to the Specification (Spec.) filed December 29, 2012, the Final Office Action (Final Act.) dated June 23, 2015, the Appeal Brief filed December 21, 2015 (Appeal Br.), the Examiner's Answer (Ans.) dated November 15, 2017, and the Reply Brief (Reply Br.) filed December 15, 2017.

The subject matter on appeal relates to an apparatus and a method that produce more power than power spent (*see* Appeal Br. 94, claims 1 and 4). The claimed invention involves a circuit including a reactive element, such as a capacitor or inductor, and applying an alternating voltage with a constant voltage offset to the circuit that, according to Appellant, results in the production of more power than power spent. *Id.* As stated in paragraph 1 of the Specification, “[t]he present invention relates generally to a method and a device which find application for the production of more energy than the input energy and/or for the production of energy without spending energy, in genuine violation of the principle of conservation of energy (CoE).”

Independent claim 1 and 4<sup>3</sup> are the only pending claims and are reproduced below from the Claims Appendix of the Appeal Brief.

1. An apparatus for producing energy comprising an electric circuit containing at the same time:
  - a) at least one reactive element, such as, capacitor or inductor
  - b) having alternating voltage with constant voltage offset applied to said electric circuit, all these elements and conditions, in their togetherness always leading to CoE violation specifically, leading to production of more power than power spent, if any.
  
4. A method of producing more power than the power spent, if any, requiring the application of alternating voltage with constant voltage offset to an electric circuit containing at least one reactive element such as, capacitor or inductor.

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<sup>3</sup> Due to issues with claim amendments and the renumbering of claims, the claims were listed as claims 1 and 2 in the rejections of the Final Office Action. The claims have been renumbered as claims 1 and 4 in the Appeal Brief with claims 2 and 3 canceled. Appeal Br. 94. Therefore, we refer to the claims as 1 and 4 herein.

## REJECTIONS ON APPEAL

- I. Claims 1 and 4 under 35 U.S.C. § 101 as lacking patentable utility and being inoperative and under 35 U.S.C. § 112, first paragraph, because the claimed invention is not supported by a credible asserted utility or a well-established utility;
- II. Claims 1 and 4 under 35 U.S.C. § 101 as being directed to patent ineligible subject matter; and
- III. Claims 1 and 4 under 35 U.S.C. § 112, second paragraph, as being indefinite.

## B. DISCUSSION

### *Objection to the Specification*

The Final Office Action includes an objection to the Specification for including new matter via amendment. Final Act. 5. Appellant argues there is no new matter in the Specification. Appeal Br. 10–11. However, as indicated by the Examiner (Ans. 7–8), this is a matter that should have been raised by a timely-filed petition under 37 C.F.R. § 1.181. *See* 37 C.F.R. § 1.113. Petitionable matters are not appealable to the Patent Trial and Appeal Board. *In re Berger*, 279 F.3d 975, 984–985 (Fed. Cir. 2002) (citing *In re Hengehold*, 440 F.2d 1395, 1403 (CCPA 1971)); *see also* MPEP § 1201. Therefore, we do not address this objection.

### *Rejection I*

Claims 1 and 4 are rejected under 35 U.S.C. § 101 as lacking patentable utility and being inoperative and under 35 U.S.C. § 112, first

paragraph, because the claimed invention is not supported by a credible asserted utility or a well-established utility.

As explained by the guidance set forth in MPEP § 2107.01 II, cases in which an invention lacks utility due to the utility being incredible and thus inoperative are rare, fact specific, and should not be applied as a per se rule. Specifically, MPEP § 2107.01 II cautions “in view of the rare nature of such cases, Office personnel should not label an asserted utility ‘incredible,’ ‘speculative’ or otherwise unless it is clear that a rejection based on ‘lack of utility’ is proper.”

The record for this application, however, clearly supports a finding that the claimed inventions are directed to an incredible utility. As stated by the Examiner (Final Act. 7), claims 1 and 4 respectively recite an apparatus and method that, according to the claims, violate the law of the conservation of energy (i.e., produce more power than power spent). In other words, the utility for the claimed invention is inconsistent with a known scientific principle and contemporary knowledge (i.e., that energy can neither be created nor destroyed). *See Newman v. Quigg*, 877 F.2d 1575, 1580 (Fed. Cir. 1989) (“This court . . . believes that the laws of thermodynamics do not brook contradiction.”) Appellant repeatedly asserts this utility (Spec. ¶ 1; Appeal Br. 15–42, 63–64) and acknowledges the asserted utility of the claimed invention violates a known scientific principle. Reply Br. 9–10 (“Appellant has indeed claimed subject matter that could only be true if it violated a thus far known scientific principle (i.e. the conservation of energy) and that is indeed wholly inconsistent with contemporary knowledge in the art”).

Therefore, the Examiner has set forth a prima facie case that claims 1 and 4 lack a patentable utility and are inoperative under § 101. This deficiency also creates one under 35 U.S.C. § 112, first paragraph:

The how to use prong of section 112 incorporates as a matter of law the requirement of 35 U.S.C. § 101 that the specification disclose as a matter of fact a practical utility for the invention . . . If the application fails as a matter of fact to satisfy 35 U.S.C. § 101, then the application also fails as a matter of law to enable one of ordinary skill in the art to use the invention under 35 U.S.C. § 112.

*In re Ziegler*, 992 F.2d 1197, 1200–01 (Fed. Cir. 1993).

Because a prima facie case has been set forth, the burden has been shifted to Appellant to identify a reversible error in the Examiner’s rejection. “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). “[W]here an applicant predicates utility for the claimed invention on allegations of the sort here which are or border on the incredible in light of contemporary knowledge of the particular art, those allegations must be substantiated by acceptable evidence.” *In re Ferens*, 417 F.2d 1072, 1074 (CCPA 1969).

We have considered Appellant’s numerous arguments in both the Appeal Brief and Reply Brief but find them unpersuasive.<sup>4</sup> Appellant

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<sup>4</sup> Curiously, in response to the Examiner’s comments on whether a structure disclosed by a prior art reference (Gallavan, US 2008/0129279 A1, published June 5, 2008 (“Gallavan”)) would also produce more energy than spent (Ans. 4–5, 10), Appellant states “Gallavan’s experiment also produces excess energy and violates CoE.” Reply Br. 12. Due to the incredible

contends his calculations of power, based upon experimentally obtained values for voltage and current, demonstrate that the claimed invention produces more power than spent and thus violates the law of conservation of energy. Appeal Br. 20–26, 33–34, 38–43; Reply Br. 16–19. We appreciate Appellant’s explanations that power is calculated from values such as voltage and current. However, such calculations alone are insufficient to demonstrate that the scientific principle for the conservation of energy is incorrect. As noted by the Examiner (Ans. 7), experimental evidence<sup>5</sup> definitively showing that more energy is produced than spent is required, not calculations, which may contain an error or be based upon an incorrect premise. *Ferens*, 417 F.2d at 1074 (“The amount of evidence which is acceptable and the character of such evidence required will obviously vary depending on the facts of each case . . .”); *In re Gazave*, 379 F.2d 973, 978 (CCPA 1967) (“[I]f the alleged operation seems clearly to conflict with a recognized scientific principle as, for example, where an applicant purports to have discovered a machine producing perpetual motion, the presumption of inoperativeness is so strong that very clear evidence is required to overcome it.”). Though Appellant asserts it would have been unreasonable to expect such evidence (Reply Br. 21), that type of evidence is necessary in this case to demonstrate that a widely accepted, contemporary knowledge

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nature of the utility asserted for the claimed invention, however, we decide not to exercise our discretion to make a new ground of rejection over Gallavan.

<sup>5</sup> We note that such evidence would need to be in the correct form (i.e., in the form of a declaration or affidavit under 37 C.F.R. § 1.132). Arguments set forth in a brief cannot take the place of evidence. See *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974).

regarding a law of nature is incorrect and the claimed invention has a credible utility. *See In re Newman*, 782 F.2d 971, 973 (Fed. Cir. 1986) (“the PTO is entitled to reject an application for insufficient proof when a device by its nature occasions reasonable skepticism as to its operativeness under § 101”).

Furthermore, the Examiner proposes a source of error in Appellant’s calculations that could cause an indication that conservation of energy is violated, citing several references for support. Final Act. 7–8. Appellant responds by arguing the calculations cited by the Examiner are incorrect but again relies upon calculations that result in more power produced than spent to prove the law of conservation of energy is violated. Appeal Br. 44–51; Reply Br. 24–25, 62. As discussed above, such calculations alone are insufficient to prove that this scientific principle, the law of conservation of energy, is false. As a result, Appellant has not identified a reversible error in the Examiner’s rejection.

A preponderance of the evidence in the record supports the Examiner’s finding that claims 1 and 4 lack utility because the asserted utility is of an incredible nature. For these reasons and those set forth in the Examiner’s Answer, we sustain the Examiner’s § 101 rejection of claims 1 and 4 as lacking patentable utility and being inoperative and the Examiner’s § 112, ¶ 1, rejection of claims 1 and 4 because the claimed invention is not supported by a credible asserted utility or a well-established utility.

### *Rejection II*

Claims 1 and 4 are also rejected under 35 U.S.C. § 101 as being directed to patent ineligible subject matter. In view of the incredible nature of the utility for the claimed invention, we do not reach the Examiner’s

rejection under § 101 for lack of patent eligible subject matter.

*Rejection III*

Claims 1 and 4 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

The Examiner concludes claims 1 and 4 are indefinite because they recite that conservation of energy is violated but this cannot be possible given what is accepted as known science. Final Act. 9. Appellant's arguments do not persuasively identify a reversible error in the § 101 rejection based on an incredible utility or this rejection under § 112. Therefore, we sustain this rejection for the reasons discussed above with regard to the lack of utility rejection under § 101.

The Examiner also rejects claims 1 and 4 as indefinite because the terms “such as,” “specifically,” “if any,” and “and conditions” render the scope of the claims unclear. *Id.* This rejection presents a different matter than the utility issue discussed above. During prosecution, a claim is examined for compliance with 35 U.S.C. § 112, ¶ 2 by determining whether the claim meets threshold requirements of clarity and precision. *In re Skvorecz*, 580 F.3d 1262, 1268–69 (Fed. Cir. 2009) (quoting MPEP § 2173.02). The issue here is whether one skilled in the art would understand the scope of what is claimed. In other words, would the public be provided with adequate notice about what the claimed inventions encompass?

For example, would one of ordinary skill in the art understand that the apparatus of claim 1 encompasses all reactive elements or would such a person understand that the reactive element is limited to a capacitor or an inductor? The term “such as” renders the answer to this inquiry unclear.

Appeal 2018-002116  
Application 13/730,870

The terms “specifically” and “if any” cause similar problems and it is unclear what the term “and conditions” refers to. As a result, claims 1 and 4 are indefinite under § 112, ¶ 2.

While a *pro se* applicant is generally afforded more latitude than an applicant represented by counsel, even *pro se* applicants must state their claims in an understandable and precise manner so as to provide adequate notice to the public of the scope of protection sought by those claims. Therefore, for these reasons and those set forth in the Examiner’s Answer, we sustain the rejection of claims 1 and 4 under 35 U.S.C. § 112, second paragraph.

C. DECISION

The decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED