



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/507,120	06/06/2012	John Kissane		8482

7590 11/21/2018  
John Kissane  
18-B Ashington Club Rd.  
Far Hills, NJ 07931

EXAMINER
----------

AMAYA, CARLOS DAVID

ART UNIT	PAPER NUMBER
----------	--------------

2836

MAIL DATE	DELIVERY MODE
-----------	---------------

11/21/2018

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* JOHN KISSANE

---

Appeal 2018-003469  
Application 13/507,120  
Technology Center 2800

---

Before JEFFREY B. ROBERTSON, JAMES C. HOUSEL, and  
N. WHITNEY WILSON, *Administrative Patent Judges*.

HOUSEL, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

Appellant<sup>2</sup> appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claim 1<sup>3</sup> under 35 U.S.C. § 112, first paragraph for lack

---

<sup>1</sup> Our decision refers to the Specification ("Spec.") filed June 6, 2012, the Examiner's Non-Final Office Action ("Non-Final Act.") dated May 27, 2016, Appellant' Appeal Brief ("Appeal Br.") filed January 26, 2017, the Examiner's Answer ("Ans.") dated February 1, 2018, and Appellant's Reply Brief ("Reply Br.") filed February 5, 2018.

<sup>2</sup> Appellant is the Applicant and Inventor, John Kissane, which we presume is the real party in interest because the Appeal Brief does not identify another entity.

<sup>3</sup> Because Appellant presents only a single claim during prosecution, the Examiner referred to this single claim as claim 1. We likewise do so here.

ofenablement, and second paragraph for indefiniteness, and § 101 as inoperable. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

### STATEMENT OF THE CASE

The invention relates to a capacitive transformer for powering an electric car, wherein a capacitor is powered with a coil of wire receiving inductance by the capacitor, such that electricity induced in the coil of wire powers the electric car (Spec. ¶¶ 1, 9). Appellant discloses that an electric car would have long range capabilities because the only load on the battery would be that of a capacitor (*id.* ¶ 8). Appellant's invention is illustrated in Figure 1, reproduced below.

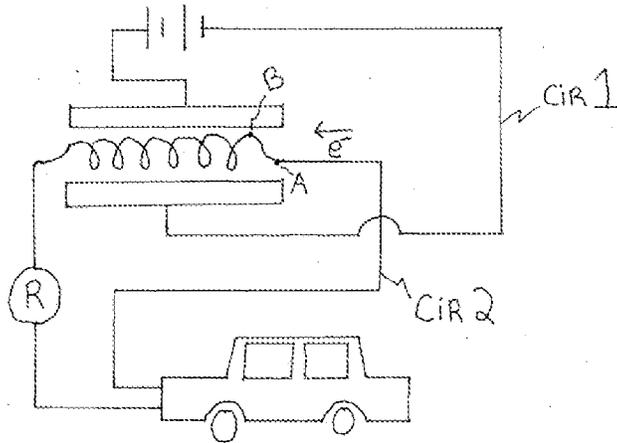


Fig. 1, showing the capacitive transformer of the invention

Figure 1 shows two circuits, CiR 1 and CiR 2, wherein CiR 1 comprises a battery and a capacitor, and CiR 2 comprises a coil of wire disposed between the plates of the capacitor, a rheostat, and an electric car (Spec. ¶ 10). According to Appellant, CiR 1 induces current in CiR 2 through inductance when the capacitor is charged by the battery so as to power the electric car (*id.* ¶ 11).

Claim 1, reproduced below from the Claims Appendix to the Appeal Brief, is the sole claim before us in this appeal and is illustrative of the subject matter on appeal.

1. Unique circuitry composed of two circuits that allows for current to be induced in a coil of wire by a capacitor that surrounds it that is charged by a battery, this current then goes on to power an electric car through a rheostat, because the only load on the battery is that of a capacitor its duration of life is much longer and is thereby maximized, this battery technology shows how to get the most out of a battery, and is done by indirectly inducing current in a coil of wire that is surrounded by a capacitor, this current then goes on to power an electric car, furthermore I claim that the use of this technology as applied to an electric car is new and unique.

#### ANALYSIS

We review the appealed rejections for error based upon the issues identified by Appellant and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) *cited with approval in In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) (“[I]t has long been the Board’s practice to require an applicant to identify the alleged error in the examiner’s rejections.”)). Failing to raise any argument with respect to a rejection amounts to a waiver with regard to that rejection. *See In re Lovin*, 652 F.3d 1349, 1356–57 (Fed. Cir. 2011) (“a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art” waives any argument with respect to those claim elements).

*Rejection under 35 U.S.C. § 112, second paragraph*

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 (Fed. Cir. 2009) (quoting M.P.E.P. § 2173.02).

The Examiner determines that the claim is narrative in form and replete with indefinite language, and notes that the subject of the claim must be clearly and positively recited, as well as organized and correlated so as to present a complete operative device (Ans. 3–4). For assistance, the Examiner directed Appellant’s attention to claims set forth in a number of patents cited in the record (*id.* at 4).

During prosecution before the Examiner, Appellant did not attempt to amend the claim in response to this rejection. Nor does Appellant argue or otherwise address this rejection in this appeal. 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, we affirm the Examiner’s rejection of claim 1 under 35 U.S.C. § 112, second paragraph.

*Rejections under 35 U.S.C. § 112, first paragraph and § 101*

“A claimed invention having an inoperable or impossible claim limitation may lack utility under 35 U.S.C. § 101 and certainly lacks an enabling disclosure under 35 U.S.C. § 112.” *EMI Group North America, Inc. v. Cypress Semiconductor Corp.*, 268 F.3d 1342, 1348 (Fed. Cir. 2001)

(citing *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 956 (Fed. Cir. 1983)). “When a claim itself recites incorrect science in one limitation, the entire claim is invalid, regardless of the combinations of the other limitations recited in the claim.” *EMI*, 268 F.3d at 1349.

We start with claim construction. *Raytheon*, 724 F.2d at 956 (“Utility is a fact question . . . . In determining utility, however, the claims must first be interpreted to define the invention to be tested for utility”) (citations omitted).

Appellant discloses a pair of circuits, CiR 1 and CiR 2, which interact via a coil of wire in CiR 2 which is disposed between the capacitor plates of a capacitor of CiR 1 (*see* Fig. 1). The capacitor of CiR 1 is charged by a battery in CiR 1 (*id.*). CiR 2 includes a rheostat, R, and an electric car (*id.*). Appellant discloses that CiR 2 powers the electric car via inductance from CiR 1 because of the placement of the coil within the capacitor (Spec. ¶ 10–11). Appellant further discloses that electricity in CiR 2 at point A is attracted to point B, which sets up current in the coil (*id.*).

Claim 1 recites circuitry composed of two circuits that allow for current to be induced in a coil of wire by a capacitor that is charged by a battery. This recitation does not specifically require that the circuits include the coil of wire, the capacitor, or the battery. For purposes of our review, we construe the invention to be two circuits as disclosed wherein the first circuit includes a battery and capacitor and the second circuit includes a coil of wire disposed within the capacitor and electrically connected to an electric car.

The Examiner determines that claim 1 both fails to comply with the enablement requirement of 35 U.S.C. § 112, first paragraph, and fails to comply with the utility requirement of 35 U.S.C. § 101 for essentially the

same reason—that the invention, as disclosed and claimed, will not induce a current into the coil and, therefore, will not work (Ans. 2–3). Specifically, the Examiner determines that claim 1 recites “a current to be induced in a coil by a capacitor that surrounds it” (*id.*). The Examiner finds, however, that 1) in order for current to be induced in a coil, it must be within a varying electric field; and 2) once a capacitor is fully charged, it produces a fixed, rather than a varying, electric field between the capacitor plates (*id.*). The Examiner concludes, therefore, that the capacitor cannot induce a current in the coil once the capacitor is fully charged (*id.*).

Appellant argues that an electric car has an electric motor having a magnet (Appeal Br. 3). Appellant, as an example, contends that when the electric motor is an alternating current (AC) motor, “[a]s the battery increases in charge the motor begins to spin” (*id.*). Appellant asserts that the spinning of the magnet in this motor will induce a “Sine wave current in the wire that goes back to the coil of wire surrounded by the capacitor” (*id.* at 3–4). According to Appellant, it is this sine wave current produced by the motor that produces a varying magnetic field which interacts with the electric field produced by the capacitor (*id.* at 4). Appellant argues that this field to field interaction weakens the capacitor slightly, which recharges quickly from the battery, and drives the current (*id.*). Also, Appellant urges that magnets today are stronger than when the “‘fixed field’ science was discovered,” and that even stronger magnets might make the invention possible (*id.* at 5).

Appellant’s arguments are not persuasive of reversible error in the Examiner’s enablement and inoperability rejections. *Jung*, 637 F.3d at 1365. Initially, we note, as the Examiner correctly finds (Ans. 2),

Appellant's arguments regarding the motor of the electric car and a sine wave current produced by spinning magnets therein lack support in Appellant's Specification and as we further observe, are not directed to limitations appearing in the claim.<sup>4</sup> We also note that Appellant does not challenge the validity of the Examiner's findings that induction in a coil requires a varying electric field and that a capacitor produces a fixed field when fully charged. As such, Appellant's arguments lack persuasive merit.

In addition, we note that because the battery charges the capacitor, not the motor, Appellant fails to explain how an increase in charge of the battery will cause the motor to begin to spin. Also, Appellant fails to explain how the battery and capacitor induce current in the coil of wire if it is the motor that generates the sine wave current to the coil of wire, as Appellant contends. Moreover, Appellant fails to explain how the strength of the magnets in the motor affect the operability of Appellant's invention, especially with regard to producing induced current in the second circuit using the battery and capacitor.

Appellant contends that there is somehow a field to field interaction between the current in the coil of wire produced by the motor and the electric field produced in the capacitor by the battery that "drives the current." However, Appellant fails to account for the fact that, in this contention, the current in the coil of wire allegedly is produced by the motor, not the battery or capacitor. As such, the current produced by the motor is not the induced current Appellant desires to create from the battery and

---

<sup>4</sup> Appellant also argues that the battery may be a battery and oscillator combination (Reply Br. 2). Appellant fails to direct attention to written descriptive support in the Specification for such an oscillating battery, nor do we find any.

capacitor. Indeed, a motor, in contrast with a generator, consumes current, rather than generates current.

Accordingly, for the reasons given above and in the Examiner's Answer, we are not persuaded that the Examiner reversibly erred in concluding that the claimed invention is inoperable and that the disclosure fails to enable those skilled in the art to make and use the invention.

#### DECISION

Upon consideration of the record, and for the reasons given above and in the Examiner's Answer, the decision of the Examiner rejecting claim 1 under 35 U.S.C. § 112, first paragraph for lack of enablement and second paragraph for indefiniteness, and § 101 as inoperable, 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)(1).

AFFIRMED