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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte HUBERT M. LIPINSKI and STEPHEN A. LIPINSKI

Appeal 2019-004924
Application 14/892,923
Technology Center 3600

Before MICHAEL C. ASTORINO, ANNETTE R. REIMERS, and
PHILIP J. HOFFMANN, *Administrative Patent Judges*.

HOFFMANN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's rejection of claims 1–3 and 5–29.² We have jurisdiction under 35 U.S.C. § 6(b). Appellant argued before the Board on August 10, 2020.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. According to Appellant, Unified Gravity Corporation is the real party in interest. Appeal Br. 1.

² We note the Examiner includes claims 28 and 29 in the rejection. Final Action 1 (Office Action Summary), 2, 22, 24; *see also* Appeal Br. 1. We further note, for the purposes of the subject appeal, the Examiner did not enter claims 30 and 31 as proposed by Appellant in the Response to the Final Office Action. Advisory Action 1 (dated July 7, 2017); *see also* Response to Final Office Action 5, 6 (filed June 28, 2017).

We AFFIRM IN PART.

Appellant’s disclosure relates to a “Hydrogen-Lithium Fusion Device (HLFD) . . . [that] enables high efficiency proton-lithium fusion within a reaction chamber, producing energetic helium ion fusion byproducts.”

Spec ¶ 2. Claim 1 is the sole independent claim. Below, we reproduce claim 1 as representative of the appealed claims.

1. A method for creating energetic helium ions, said method comprising:
 - imparting energy to protons in a reaction chamber so as to generate at least a portion of protons with a kinetic energy in a range of 100 eV to 5,000 eV; and
 - combining said portion of protons with lithium from a lithium-containing species in a proton-lithium plasma to cause nuclear fusion reactions resulting in production of energetic helium ion fusion byproductswherein said portion of protons with kinetic energy in the range of 100 eV to 5,000 eV is effective to produce the helium ion fusion byproducts with a power ratio $Q > 1$ and $Q < 64,840$, the power ratio describing output power of the said helium ion fusion byproducts divided by input power used in forming the said proton-lithium plasma and the said protons.

REJECTIONS AND PRIOR ART³

The Examiner rejects the claims as follows:

³ The Examiner also purports to object to the Specification under 35 U.S.C. § 112(a) “as failing to provide an adequate written description of the invention and . . . for failing to provide an enabling disclosure.” Final Action 13; *see also id.* at 13–14. Appellant argues against this objection. *See, e.g.,* Appeal Br. 56 (“The reversible errors discussed above respond to objection[s] to the [S]pecification on grounds of written description and enablement.”) (citation omitted) (formatting omitted). This matter is reviewable by petitioning the Director in accordance with 37 C.F.R. § 1.181, and may not be within the jurisdiction of the Board. *See* MPEP § 1201 (the Board ordinarily will not hear a question that is reviewable by petition); *In*

- I. Claims 1–3 and 5–29 under 35 U.S.C. § 101 because the claimed invention is inoperative and therefore lacks utility;
- II. Claims 1–3 and 5–29 under 35 U.S.C. § 112(a) as failing to comply with the enablement requirement; and
- III. Claim 1 is rejected under 35 U.S.C. § 103 as obvious based on Lipinski et al. (US 2009/0274256 A1, published Nov. 5, 2009) (“Lipinski”).

ANALYSIS

Rejection I—Utility rejection of claims 1–3 and 5–29

As we state above, the Examiner rejects claims 1–3 and 5–29 under 35 U.S.C. § 101 “because the . . . [claimed] invention is inoperative and therefore lacks utility.”⁴ Final Action 22. According to the Examiner, Appellant’s claimed “invention . . . is considered as based on the ‘cold fusion’ concept set forth by Fleischmann and Pons. . . . [T]his ‘cold fusion’ concept is still no more than just an unproven concept.” Final Action 14 (footnote omitted). Further,

re Berger, 279 F.3d 975, 984 (Fed. Cir. 2002) (stating that there are many kinds of decisions made by examiners which are not appealable to the Board when they are not directly connected with the merits of issues involving rejections of claims) (citing *In re Hengehold*, 440 F.2d 1395, 1403 (CCPA 1971)). Accordingly, we do not expressly review the Examiner’s objections to the Specification. Nevertheless, to the extent that these objections turn on the same issues, or are premised on the same reasoning, as the §§ 101 and 112 rejections of the claims, our analysis and conclusions with respect to the rejections are equally applicable to the objections.

⁴ Whether an application discloses a utility for a claimed invention is a question of fact. *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 956 (Fed. Cir. 1983).

[certain references of record in the application] demonstrate[] that not only has the claimed method been attempted, it has been categorically proven to be inoperable. There exists nothing in the literature to demonstrate an energetically positive result at the claimed energies. Given the overwhelming evidence against the claims and the persistent history of fraud in the art, one of ordinary skill would have cause to doubt the operability of the claimed method.

. . . All claims are independently rejected as inoperable because the alleged reaction rates are substantially greater than allowed by the presently accepted theories of nuclear science.

Id. at 22–23.

Based on our review of the record, the Examiner does not support adequately that Appellant’s claimed method is a method of performing a cold fusion concept. For example, Appellant’s Specification itself describes how Appellant’s claimed method differs from cold fusion. Spec. ¶ 94. The Examiner does not otherwise adequately support that the claimed method is analogous to cold fusion. Instead, to summarize, it appears that the Examiner equates Appellant’s method to cold fusion based on an inadequately-supported conclusion that “a[ny] device . . . [is a] ‘cold fusion’ [device] when it is alleged that the energy of the reactant is significantly lower than the energy threshold required to fuse two nuclei.” Final Action 2.

We assume *arguendo* that certain references of record “demonstrate[] that not only has the claimed method been attempted[, but that those references disclose that the claimed method is] . . . inoperable.” Final Action 22. Regardless, Appellant’s Specification itself provides sufficient evidence of operability. Briefly, in more than forty pages of the Specification, Appellant reports on twenty-fives series of tests, conducted over approximately seven years, at four different facilities. Spec. ¶¶ 124–

303. Some tests “failed to produce the desired levels of fusion,” while other tests were successful. *Id.* ¶ 124. Notwithstanding that there exists no “peer-reviewed discussion of the device, much less a review of any other device capable of maintaining a lithium-proton fusion reaction at energies far below the fusion threshold,” in view of the evidence Appellant provides, the Examiner does not support adequately that Appellant’s claimed method is inoperative. Final Action 6.

Consequently, we do not sustain the Examiner’s § 101 rejection of claims 1–3 and 5–29.

Rejection II—Enablement rejection of claims 1–3 and 5–29

The Examiner’s rejects claims 1–3 and 5–29 under 35 U.S.C. § 112(a), as failing to comply with the enablement requirement, because “any invention found to be inoperable is also legally non-enabled.” Final Action 24–25 (citation omitted). For the reasons discussed above, however, the Examiner does not support adequately that the claims are inoperative (i.e., that the claims lack utility). Accordingly, we do not sustain the Examiner’s enablement rejection of claims 1–3 and 5–29.

Rejection III—Obviousness rejection of claim 1

In the Final Office Action, the Examiner rejects Appellant’s claim 1 as obvious based on Lipinski. Final Action 27. In response to Appellant’s arguments in the Appeal Brief, the Examiner further relies on Lipinski’s paragraphs 39–55 to support the rejection of Appellant’s claim 1. Appeal Br. 61–62; Answer 16. Not unexpectedly, Appellant’s arguments in the Appeal Brief do not argue against the cited paragraphs from Lipinski. However, Appellant does not submit further arguments regarding the

nonobviousness of claim 1 in the Reply Brief. Inasmuch as Appellant does not persuade us that the Examiner errs by relying on Lipinski's paragraphs 39–55 to render claim 1 obvious, we sustain the Examiner's obviousness rejection of claim 1.

CONCLUSION

We REVERSE the Examiner's §§ 101 and 112 rejections.

We AFFIRM the Examiner's § 103 rejection.

In summary:

Claims Rejected	35 U.S.C. §	Basis/Reference(s)	Affirmed	Reversed
1–3, 5–29	101	Utility		1–3, 5–29
1–3, 5–29	112(a)	Enablement		1–3, 5–29
1	103	Lipinski	1	
Overall Outcome:			1	2, 3, 5–29

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

AFFIRMED IN PART