The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte DAVID FITZGERALD

Appeal No. 2005-1275
Application No. 10/121,211

ON BRIEF

Before JERRY SMITH, DIXON, and GROSS, Administrative Patent Judges.
SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-17, which constitute all the claims pending in the application.

The disclosed invention pertains to a device for producing a propulsive force using an energy density altering means.

Representative claim 1 is reproduced as follows:

1. A device for producing a propulsive force, comprising:
   a. a moving material, which changes its direction of travel,

b. an energy density altering means, which alters the energy density of said moving material in such a way that the mass of said moving material is altered in conjunction with changes in the direction of travel of said moving material whereby a propulsive force is created that acts on said moving material.

The examiner does not rely on any references.

Claims 1-17 stand rejected under 35 U.S.C. § 101 as being inoperative and, therefore, lacking in utility. Claims 1-17 also stand rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification that lacks enablement for the claimed energy density altering means that alters the energy of the moving material to thereby create a propulsive force.

Rather than repeat the arguments of appellant or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal and the rejections advanced by the examiner. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant’s arguments set forth in the brief along with the examiner’s rationale in support of the rejections and arguments in rebuttal set forth in the examiner’s answer.

It is our view, after consideration of the record before us, that the disclosure of this application meets the utility

requirements of 35 U.S.C. § 101. We are also of the view that the specification of this application fails to provide an enabling disclosure as required by 35 U.S.C. § 112. Accordingly, we affirm.

We consider first the rejection of claims 1-17 under 35 U.S.C. § 101 as lacking utility. In support of this rejection, the examiner simply asserts that the phrase “in such a way” is vague and lacks specificity as to exactly how the material is altered to create a propulsive force. The examiner also seems to question the theory underlying appellant’s invention [final rejection, pages 2-3, incorporated into answer at page 3].

Appellant argues that the phrase “in such a way” describes the timing of the application of an energy density altering means so that a propulsive force is developed. Appellant asserts that the phrase should be considered part of an “act in support thereof” under the sixth paragraph of 35 U.S.C. § 112. Appellant also argues that the invention is operable based on the experimental work of Dr. James Woodward [brief, pages 7-9].

The examiner responds that the phrase “in such a way” is vague and indefinite. The examiner also responds that the sixth paragraph of 35 U.S.C. § 112 does not apply because the phrase “in such a way” modifies the altering means by a further act [answer, pages 4-5].

We will not sustain the examiner's rejection of the appealed claims under 35 U.S.C. § 101 as lacking utility. First, we do not understand what the phrase "in such a way" possibly being vague and indefinite has to do with utility under 35 U.S.C. § 101. The examiner's reasons for the rejection seem to be addressed to whether the claims are vague and indefinite rather than to whether the invention has utility. The utility disclosed for the claimed invention is that a propulsive force can be created by an energy density altering means. This by itself is normally sufficient to establish utility under 35 U.S.C. § 101. Second, if the examiner's rejection is based upon the examiner's view that the underlying theory is flawed, then the examiner has failed to provide any evidence in support of that position. The evidence submitted by appellant during prosecution of this application at least shows that there is some scientific support behind the underlying theory of the claimed invention. Therefore, when the record before us is viewed as a whole, there is no support for the examiner's position that the invention lacks utility.

We now consider the rejection of claims 1-17 under 35 U.S.C. § 112, first paragraph, as being based on a non-enabling

disclosure. The examiner observes that the specification fails to describe, inter alia, critical dimensions, voltage and power magnitudes, and component compositions which would be necessary for the artisan to make and use the claimed invention [final rejection, page 3, incorporated into answer at page 3].

Appellant argues that the examiner is holding the instant specification to an unreasonably high standard because the examiner infers that the claimed invention promises a technical leap forward. Appellant argues that the level of detail required by the examiner is not required by the first paragraph of 35 U.S.C. § 112 [brief, page 10].

The examiner responds that one skilled in the art could not replicate appellant's invention as critical masses, schematics, voltages, dimensions, and other quantities and characterizations are absent from the disclosure. The examiner again questions the soundness of the scientific theory upon which appellant's invention is based [answer, pages 5-6].

We will sustain the examiner's rejection of claims 1-17 as being based on a non-enabling disclosure. Appellant's invention is based upon a theory that was, at the time this application was filed, questionable at best. Appellant relies on two papers published by Dr. James Woodward as evidence that the theory is

sound. These papers by Dr. Woodward, however, indicate that the results achieved therein were of laboratory interest only and that additional experimentation was necessary to arrive at a practical application of the theory. Independent claim 1 recites “whereby a propulsive force is created that acts on said moving material.” A propulsive force, by definition, is a force that results in propelling an object. There is no evidence on this record that appellant has been able to achieve propulsion of a moving material of the type described in appellant’s specification based on the theory disclosed therein. Therefore, we agree with the examiner that appellant must disclose specific experiments that resulted in the creation of a propulsive force as claimed. Without a disclosure of the specific parameters that resulted in the creation of a propulsive force as claimed, we agree with the examiner that the skilled artisan would not be able to make and use the invention of independent claim 1, that is, the creation of a propulsive force based only on an energy density altering means.

In summary, we have not sustained the examiner’s rejection of the appealed claims under 35 U.S.C. § 101, but we have sustained the examiner’s rejection of the appealed claims under 35 U.S.C. § 112. Therefore, the decision of the examiner rejecting claims 1-17 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

JERRY SMITH Administrative Patent Judge	)	
JOSEPH L. DIXON Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
ANITA PELLMAN GROSS Administrative Patent Judge	)	

JS/lp

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