

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILSON GREATBATCH

Appeal 2009-010812
Application 10/998,188
Technology Center 3600

Before: WILLIAM F. PATE III, KEN B. BARRETT, and
FRED A. SILVERBERG, Administrative Patent Judges.

PATE III, Administrative Patent Judge.

DECISION ON APPEAL

STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from a rejection of claims 14-22. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

The claims are directed to a ^3He fusion reactor with direct electrical conversion. Claim 14, reproduced below, is illustrative of the claimed subject matter:

14. An electrostatic fusion device, comprising:
 - a vacuum chamber;
 - a potential well disposed in said vacuum chamber;
 - a partial vacuum environment in said vacuum chamber containing fusion reaction ions;
 - plural concentrically arranged collector cages surrounding said potential well, said collector cages being generally spherical in shape and of progressively increasing size from an innermost collector cage to an outermost collector cage and having progressively increasing voltage levels from said innermost collector cage to said outermost collector cage, said voltage levels corresponding to energy levels of protons emitted from a fusion reaction occurring within said potential well, and being connected to deliver an electrical current output at said collector cage voltage levels;
 - plural electron source pathways respectively connected to said collector cages to deliver said electrical current output;
 - a diverter wire associated with each of said collector cages;
 - each diverter wire being of higher potential than its associated collector cage and being adjacent thereto at a location that is between said associated collector cage and said potential well;
 - plural voltage sources respectively connected to said diverter wires, said voltage sources being of progressively increasing voltage from an innermost diverter wire to an outermost diverter wire and each being of higher potential than said collector cage associated with said diverter wire to which said voltage source is connected.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Moir	US 3,816,771	Jun. 11, 1974
Anderson	US 5,365,070	Nov. 15, 1994
Miley	US 6,121,569	Sep. 19, 2000
Janssen	US 2002/0186195 A1	Dec. 12, 2002
Sapozhnikov	SU-1823761 A3	Dec. 17, 1990

REJECTIONS

Claims 14-22 stand rejected under 35 U.S.C. § 112 first paragraph as based on a disclosure which is not enabling. Ans. 4.

Claims 14-22 stand rejected under 35 U.S.C. § 112 first paragraph as failing to comply with the enablement requirement. Ans. 5.

Claims 14-22 stand rejected under 35 U.S.C. § 101 because the claimed invention is not supported by either a credible asserted utility or a well-established utility. Ans. 5.

Claims 14-22 stand rejected under 35 U.S.C. § 112, first paragraph, as because the claimed invention is not supported by either a credible asserted utility or a well-established utility. Ans. 6.

Claims 14 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Miley, Moir, Sapozhnikov, and Anderson. Ans. 8.

Claims 15-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Miley, Sapozhnikov, Anderson, and Janssen. Ans. 8.

OPINION

We have carefully reviewed the rejections on appeal in light of the arguments of the Appellant and the Examiner. As a result of this review we have reached the conclusion that the claimed subject matter is not properly rejected under 35 U.S.C. § 112, first paragraph, for lack of an enabling disclosure. Furthermore, we reverse the rejection under 35 U.S.C. § 101 for lack of an asserted utility. We have also reached the conclusion that the claimed subject matter is not *prima facie* obvious from the cited prior art. Therefore the rejections of all claims on appeal are reversed. Our reasons follow.

Turning first to the rejections under 35 U.S.C. § 112, first paragraph, for lack of an enabling disclosure, we note that it is not necessary for the Examiner to subdivide his enablement rejection into three parts. A single enablement rejection on several grounds or several rationales is perfectly acceptable.

Be that as it may, the Examiner's rejections under 35 U.S.C. § 112, first paragraph, for lack of enablement are legally and logically flawed. With respect to the legal requirements under 35 U.S.C. § 112, first paragraph, for lack of enabling disclosure, the touchstone of this rejection is undue experimentation. The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Minerals Separation v. Hyde*, 242 U.S. 261, 270 (1916), which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. In *re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988).

The Examiner must establish that the disclosure relied on would not have enabled one of ordinary skill to make and use the invention without

undue experimentation. Undue experimentation is proven with regard to the so called “Wands factors.” See *Id.* The Examiner’s rejection neither discusses undue experimentation nor applies the Wands factors in any of the three enablement rejections related in the Examiner’s Answer. As such, the Examiner’s rejection is legally insufficient and cannot be sustained.

With respect to the logic of the Examiner’s rejection, we note that the claims are the measure of the invention. Thus we are in agreement with the Appellant, that Appellant’s claimed subject matter, which does not recite a net power gain, nor any other synonym for a net power gain, cannot be held by the Examiner to be claiming such a feature.

Accordingly, with respect to the rejection under 35 U.S.C. § 101, we note from the record that plasma energy devices are well known in the art and such devices are well known for scientific research purposes. Therefore there is no logical basis for the rejection under 35 U.S.C. § 101, for lack of utility, nor is there a justification for rejecting the subject matter under 35 U.S.C. § 112, first paragraph for lack of enablement based on an asserted lack of utility.

Turning to the obviousness rejections on appeal, we are in agreement with the Appellant that the Examiner has failed to articulate reasoning with rational underpinnings that will support such rejections. Specifically, we note that the Examiner relies on Sapozhnikov for teaching the diverter wire associated with each collector cage. Ans. 9. Sapozhnikov, as translated, is directed to a high temperature plasma device which teaches a suppressor 2 that separates the electrons from the plasma flow. The Examiner has not established how the use of a suppressor for separating electrons from a plasma flow, teaches the use of diverter wires of higher potential than an associated collector cage in a plasma device such as Miley or Miley as

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modified by Moir. The collection of electrons seems to be so disparate from the diversion of protons in the claimed subject matter that it would not have lead one of ordinary skill to combine these devices. Based on the failure of the Examiner to establish the prima facie obviousness of the independent claims, we must reverse the obviousness rejections of all claims on appeal.

SUMMARY

The rejections of claims 14-22 under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not enabling are reversed.

The rejection of claims 14-22 under 35 U.S.C. § 101 is reversed.

The obviousness rejections of claims 14-17 and 22 are reversed.

REVERSED

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