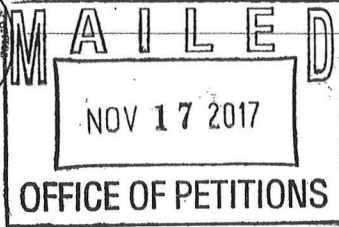




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HAYNES BEFFEL & WOLFELD LLP
P O BOX 366
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In re Application of :
Hubert M. LIPINSKI, et al. :
Application No. 14/892,923 : ON PETITION
Filed: November 20, 2015 :
FOR: HYDROGEN-LITHIUM FUSION :
DEVICE :

This is a decision on the petition under 37 CFR 1.181 filed September 19, 2017, requesting that the Director exercise supervisory authority and overturn the decision of September 13, 2017 by the Director of Technology Center 3600 (Technology Center Director), which refused petitioners' request to withdraw the finality of the Office action issued on March 28, 2017, or in the alternative, enter some or all of the rebuttal evidence submitted with the reply under 37 CFR 1.116 filed June 28, 2017.

The petition to withdraw the finality of the Office action issued on March 28, 2017 is **DENIED**.

The petition to enter the rebuttal evidence submitted with the reply under 37 CFR 1.116 filed June 28, 2017 is **GRANTED**.

RELEVANT BACKGROUND

The above-identified application was filed on November 20, 2015.

A non-final Office action was issued on August 26, 2016. The Office action of August 26, 2016 included, *inter alia*: (1) an objection to the specification for failing to provide an adequate written description and enabling disclosure of the invention; (2) a rejection of claims 1 through 3 and 5 through 27 under 35 U.S.C. § 101 for failing to comply with its utility requirement; (3) a rejection of claims 1 through 3 and 5 through 27 under 35 U.S.C. § 112(a) for failing to comply with its enablement requirement; (4) a rejection of claim 2 under 35 U.S.C. § 112(d) for failing to further limit the subject matter of the claim upon which it depends; and (5) a rejection of claim 1

under 35 U.S.C. § 103 as being unpatentable over Lipinski et al. (U.S. Patent Application Publication No. 2009/0274256).

Petitioners filed a reply on February 27, 2017. The reply on February 27, 2017 included arguments traversing the rejections of claims 1 through 3 and 5 through 27 in the Office action of August 26, 2017, and added claims 28 and 29.

A final Office action was issued on March 28, 2017. The final Office action of March 28, 2017 included, *inter alia*: (1) an objection to the specification for failing to provide an adequate written description and enabling disclosure of the invention; (2) a rejection of claims 1 through 3 and 5 through 29 under 35 U.S.C. § 101 for failing to comply with its utility requirement; (3) a rejection of claims 1 through 3 and 5 through 29 under 35 U.S.C. § 112(a) for failing to comply with its enablement requirement; and (4) a rejection of claim 1 under 35 U.S.C. § 103 as being unpatentable over Lipinski et al.

Petitioners filed a reply under 37 CFR 1.116 on June 28, 2017. The reply under 37 CFR 1.116 of June 28, 2017 included arguments traversing the rejections of claims 1 through 3 and 5 through 29 in the Office action of March 28, 2017, and proposed to add new claims 30 and 31 and evidence in support of petitioners' arguments. The evidence submitted with the reply under 37 CFR 1.116 of June 28, 2017 included a 311 page collection of technical publications.

An advisory action was issued on July 7, 2017. The advisory action of July 7, 2017 denied entry of the proposed amendment submitted June 28, 2017, and indicated that the evidence submitted June 28, 2017 would not be entered because the reply failed to include a showing of good and sufficient reasons why the evidence is necessary and was not earlier presented.

A petition under 37 CFR 1.181 was filed on July 14, 2017, requesting withdrawal of the finality of the Office action issued on March 28, 2017, or in the alternative, entry of some or all of the rebuttal evidence submitted with the reply under 37 CFR 1.116 filed June 28, 2017. The petition of July 14, 2017 was dismissed by the Technology Center Director in a decision issued on September 13, 2017.

The instant petition was filed on September 19, 2017, and again requests withdrawal of the finality of the Office action issued on March 28, 2017, or in the alternative, entry of some or all of the rebuttal evidence submitted with the reply under 37 CFR 1.116 filed June 28, 2017.

A notice of appeal to the Patent Trial and Appeal Board was filed on September 22, 2017.

STATUTE AND REGULATION

35 U.S.C. § 132(a) provides that:

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

37 CFR 1.113 provides that:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an *inter partes* reexamination filed under § 1.913, see § 1.953.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR 1.116 provides that:

(a) An amendment after final action must comply with § 1.114 or this section.

(b) After a final rejection or other final action (§ 1.113) in an application or in an *ex parte* reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an *inter partes* reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;

(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or

(3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

(c) The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or reexamination proceeding from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination prosecution from termination under § 1.550(d) or § 1.957(b) or limitation of further prosecution under § 1.957(c).

(d)(1) Notwithstanding the provisions of paragraph (b) of this section, no amendment other than canceling claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, can be made in an *inter partes* reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

(2) Notwithstanding the provisions of paragraph (b) of this section, an amendment made after a final rejection or other final action (§ 1.113) in an *ex parte* reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an *inter partes* reexamination filed under § 1.913 may not cancel claims where such cancellation affects the scope of any other pending claim in the reexamination proceeding except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

(e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) in an application or in an *ex parte* reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an *inter partes* reexamination filed under § 1.913 but before or on the same date of filing an appeal ((§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

(f) Notwithstanding the provisions of paragraph (e) of this section, no affidavit or other evidence can be made in an *inter partes* reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

(g) After decision on appeal, amendments, affidavits and other evidence can only be made as provided in §§ 1.198 and 1.981, or to carry into effect a recommendation under § 41.50(c) of this title.

OPINION

Petitioners argue that the final Office action of March 28, 2017 significantly changed the thrust of the rejection, including relying on new prior art that did not overlap in rationale or energy range with anything in the non-final Office action of August 26, 2016. Petitioners specifically assert that the final Office action of March 28, 2017 (page 4) introduces two curves for the first time in the record of the above-identified application. Petitioners further argue that the rebuttal

evidence included with reply under 37 CFR 1.116 of June 28, 2017 should be entered because it is directly responsive to points raised in the final Office action of March 28, 2017. Petitioners specifically allege that the rebuttal includes evidence regarding hydrogen lithium reaction rates at low energies in response to the discussion of quantum tunneling that was introduced for the first time in the final Office action of March 28, 2017. Petitioners request withdrawal of the finality of the Office action issued on March 28, 2017, or in the alternative, entry of some or all of the rebuttal evidence submitted with the reply under 37 CFR 1.116 filed June 28, 2017.

With respect to petitioners' arguments that the examiner's final Office action of March 28, 2017 contains a new ground of rejection:

In seeking a withdrawal of the finality of the Office action of March 28, 2017, petitioners allege that the examiner introduced new art and/or evidence in the form of two curves, a table, and four articles to support the rejection of claim 1 in the final Office action, and that this new art and/or evidence was not necessitated by an amendment of the claims, thereby rendering the finality of the Office action to be improper in light of section 706.07(a) of the Manual of Patent Examining Procedure (MPEP).

MPEP § 706.07(a) sets out the USPTO's second action final practice and provides as follows—

Second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). Where information is submitted in an information disclosure statement during the period set forth in 37 CFR 1.97(c) with a fee, the examiner may use the information submitted, e.g., a printed publication or evidence of public use, and make the next Office action final whether or not the claims have been amended, provided that no other new ground of rejection which was not necessitated by amendment to the claims is introduced by the examiner. See MPEP § 609.04(b). Furthermore, a second or any subsequent action on the merits in any application will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art. Where information is submitted in a reply to a requirement under 37 CFR 1.105, the examiner may NOT make the next Office action relying on that art final unless all instances of the application of such art are necessitated by amendment.

For guidance in determining what constitutes a new ground of rejection, see MPEP § 1207.03(a).

A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed. See MPEP § 904 *et seq.* However, note that an examiner cannot be expected to foresee whether or how an applicant will amend a claim to overcome a rejection except in very limited circumstances (e.g., where the examiner suggests how applicant can overcome a rejection under 35 U.S.C. 112(b) or pre-AIA 35 U.S.C. 112, second paragraph).

A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings may not be made final if it contains a new ground of rejection necessitated by the amendments to pre-AIA 35 U.S.C. 102(e) by the Intellectual Property and High Technology Technical Amendments Act of 2002 (Public Law 107-273, 116 Stat. 1758 (2002)), unless the new ground of rejection was necessitated by an amendment to the claims or as a result of information submitted in an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

When applying any 35 U.S.C. 102(a)(2) or pre-AIA 35 U.S.C. 102(e)/103 references against the claims of an application the examiner should anticipate that a statement averring common ownership may qualify the applicant for the exemption under 35 U.S.C. 102(b)(2)(C) or a statement of common ownership at the time the invention was made may disqualify any patent or application applied in a rejection under 35 U.S.C. 103 based on 35 U.S.C. 102(e). If such a statement is filed in reply to the 35 U.S.C. 102(a)(2) or pre-AIA 35 U.S.C. 102(e)/103 rejection and the claims are not amended, the examiner may not make the next Office action final if a new rejection is made. See MPEP §§ 706.02(I)(3) and 2154.02(c). If a reference is disqualified under the joint research agreement provision of 35 U.S.C. 102(c) or pre-AIA 35 U.S.C. 103(c) and a new subsequent double patenting rejection based upon the disqualified reference is applied, the next Office action, which contains the new double patenting rejection, may be made final even if applicant did not amend the claims (provided that the examiner introduces no other new ground of rejection that was not necessitated by either amendment or an information disclosure statement filed during the time period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)). The Office action is properly made final because the new double patenting rejection was necessitated by amendment of the application by applicant.

Where the only changes in a rejection are based on treating the application to be subject to current 35 U.S.C. 102 rather than the version of 35 U.S.C. 102 in effect on March 15, 2013, (the pre-AIA version) or the reverse, and any prior art relied

upon in the subsequent action was prior art under both versions of 35 U.S.C. 102, then the action may be made final. For example, if a first action relied upon a reference as being available under pre-AIA 35 U.S.C. 102(e) and the subsequent action relied only on the same reference under 35 U.S.C. 102(a)(2), then the subsequent action may be made final assuming no new requirements or non-prior art rejections were made. See MPEP §809.02(a) for actions which indicate generic claims as not allowable.

In the consideration of claims in an amended case where no attempt is made to point out the patentable novelty, the examiner should be on guard not to allow such claims. See MPEP § 714.04. The claims may be finally rejected if, in the opinion of the examiner, they are clearly open to rejection on grounds of record.

With respect to petitioners' argument that the final Office action of March 28, 2017 contains a new ground of rejection, there is no new ground of rejection if the basic thrust of the rejection has remained the same from the non-final Office action of August 26, 2016 to the final Office action of March 28, 2017, such that the applicant has been given an opportunity to react to the thrust of the rejection. *See, e.g., In re Adler*, 723 F.3d 1322, 1327 (Fed. Cir. 2013), and *In re Kronig*, 539 F.2d 1300, 1303 (CCPA 1976). A new ground of rejection may be present when a rejection relies upon new facts or a new rationale not previously raised to the applicant. *See In re Biedermann*, 733 F.3d 329, 337 (Fed. Cir. 2013) (quoting *In re Leithem*, 661 F.3d 1316, 1319 (Fed. Cir. 2011)). The prior rejection, however, need not be repeated *in haec verba* to avoid being considered a new ground of rejection. *See id.* In addition, further explaining and elaboration upon a rejection, and thoroughness in responding to an applicant's arguments, are not considered a new ground of rejection. *See In re Jung*, 637 F.3d 1356, 1364–65 (Fed. Cir. 2001).

MPEP § 1207.03(III) specifically provides that:

A position or rationale that changes the “basic thrust of the rejection” will also give rise to a new ground of rejection. *In re Kronig*, 539 F.2d 1300, 1303 (CCPA 1976). However, the examiner need not use identical language in both the examiner's answer and the Office action from which the appeal is taken to avoid triggering a new ground of rejection. It is not a new ground of rejection, for example, if the examiner's answer responds to appellant's arguments using different language, or restates the reasoning of the rejection in a different way, so long as the “basic thrust of the rejection” is the same. *In re Kronig*, 539 F.2d at 1303; see also *In re Jung*, 637 F.3d 1356, 1364–65 (Fed. Cir. 2001) (additional explanation responding to arguments offered for the first time “did not change the rejection” and appellant had fair opportunity to respond); *In re Noznick*, 391 F.2d 946, 949 (CCPA 1968) (no new ground of rejection made when “explaining to appellants why their arguments were ineffective to overcome the rejection made by the examiner”); *In re Krammes*, 314 F.2d 813, 817 (CCPA 1963) (“It is well established that mere difference in form of expression of the reasons for finding claims unpatentable or unobvious over the references does not amount to reliance

on a different ground of rejection.” (citations omitted)); *In re Cowles*, 156 F.2d 551, 1241 (CCPA 1946) (holding that the use of “different language” does not necessarily trigger a new ground of rejection).

The basic thrust of the rejection of the pending claims¹ has remained the same from the non-final Office action of August 26, 2016 to the final Office action of March 28, 2017. The legal bases for the rejection of all of the pending claims in both the non-final Office action of August 26, 2016 and the final Office action of March 28, 2017 are 35 U.S.C. § 101 for a lack of utility and 35 U.S.C. § 112 (a) for lack of enablement.² The rationale for the rejection of the pending claims in both the non-final Office action of August 26, 2016 and the final Office action of March 28, 2017 under 35 U.S.C. § 101 and 35 U.S.C. § 112 (a) is that the claims purport to violate fundamental laws of physics and that the applicant’s claimed reaction rate violates the predicted reaction rate derived from measured experimental evidence. The experimental data point relied upon by the examiner in explaining the rejection under 35 U.S.C. § 101 on the basis of the inoperability of the claimed device and method is the nuclear cross sectional area corresponding to a 5 keV proton beam (representing the upper end of the claimed range) colliding with ⁷Li target. The same data point has been relied upon in both the non-final Office action of August 26, 2016 and the final Office action of March 28, 2017. The data point is derived from the same reference listed in the form of a web-page link (see footnote 37 on page 24 of the final Office action) which was also provided in the non-final Office action of August 26, 2016 (listed in footnote 34 on page 16) and the relevant data set therefrom was reproduced in both graphical and digital form in the final Office action of March 28, 2017. Therefore, the basic thrust of the examiner’s position in rejecting the pending claims under 35 U.S.C. §§ 101 and § 112(a) has remained the same from the non-final Office action of August 26, 2016 to the final Office action of March 28, 2017, and petitioners have been given an opportunity to react to the thrust of the rejection of the pending claims under 35 U.S.C. § 101 and 35 U.S.C. § 112 (a) and 35 U.S.C. § 103.

In citing the two curves (page 4 of the final Office action) and the table (listed in Appendix 2 of the final Office action) the examiner was responding to applicant’s arguments (for example, page 15) filed February 27, 2017. The four articles were cited by the examiner in paragraph 13 of the final Office action as exemplars of existing peer-reviewed research in support of the examiner’s position concerning the operability of the claimed device and method, which position has remained the same from the non-final Office action of August 26, 2016 to the final Office action

¹ Claims 1 through 3 and 5 through 27 were pending and rejected under 35 U.S.C. § 101 in the non-final Office action issued on August 26, 2016. Claims 28 and 29 were added in the amendment filed February 27, 2017. Claims 1 through 3 and 5 through 29 were rejected under 35 U.S.C. § 101 in the final Office action issued on March 28, 2017. New claims 30 and 31 were added in an after-final amendment filed on June 28, 2017. However, the examiner did not approve their entry for the reasons set forth in the advisory action issued on July 7, 2017.

² Claim 1 is also additionally rejected under 35 U.S.C. § 103 as being unpatentable over Lipinski et al., US 2009/0274256. Petitioners do not contend that the basic thrust of the rejection of claim 1 under 35 U.S.C. § 103 as being unpatentable over Lipinski et al. has changed from the non-final Office action of August 26, 2016 to the final Office action of March 28, 2017.

of March 28, 2017. An examiner is permitted to explain and elaborate on the rejection, and is expected to respond to the arguments in the reply to an Office action in the succeeding action by the examiner. *See Jung*, 637 F.3d at 1364-65 (further explaining and elaboration upon a rejection, and thoroughness in responding to an applicant's arguments, are not considered a new ground of rejection).

Accordingly, the final Office action of March 28, 2017 did not include a new ground of rejection, and the finality of the Office action of March 28, 2017 will not be withdrawn.

With respect to petitioners' arguments that some or all of the rebuttal evidence should be entered from the reply under 37 CFR 1.116:

The rebuttal evidence in question was submitted by petitioners in the reply under 37 CFR 1.116 of June 28, 2017. As stated in 37 CFR 1.116(e), evidence submitted after a final Office action, but before or on the same date of filing an appeal, may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. The rebuttal evidence filed June 28, 2017 amounts to a collection of technical publications filed in response to the final Office action of March 28, 2017 that included, *inter alia*, the nuclear cross-section data for the reaction ${}^7\text{Li}(p,\alpha){}^4\text{He}$ from the National Nuclear Data Center, a discussion of quantum tunneling, and citations to peer reviewed publications that the examiner held would call into question the operational viability of the claimed device. The rebuttal evidence simply amounts to publicly available literature submitted to counter the examiner's contentions in the final Office action of March 28, 2017 (*i.e.*, the rebuttal evidence simply involves information that is available via a perusal of publicly accessible literature on the subject of hydrogen fusion, and does not involve an affidavit or declaration under 37 CFR 1.132 presenting non-public information for consideration). Therefore, petitioners have presented a showing of good and sufficient reasons for entry of the collection of technical publications filed in response to the final Office action of March 28, 2017.

Accordingly, the collection of technical publications filed by petitioners on June 28, 2017 will be entered and will be acknowledged in the next Office action in the above-identified application.³

DECISION

The petition to withdraw the finality of the Office action issued on March 28, 2017 is **DENIED**.

The petition to enter the rebuttal evidence (collection of technical publications) submitted with the reply under 37 CFR 1.116 filed June 28, 2017 is **GRANTED**.

This constitutes a final decision on the petition. No further requests for reconsideration will be entertained. Judicial review of this decision may be available upon entry of a final agency action

³ It is noted that the rebuttal evidence has also been listed on the Information Disclosure Statement filed July 14, 2017, which will be treated in accordance with MPEP § 609.04(b)(III).

adverse to the petitioners in the instant application (e.g., a final decision by the Patent Trial and Appeal Board). *See* MPEP §1002.02.

A notice of appeal was filed on September 22, 2017. Under the circumstances of the above-identified application, petitioners are given **two (2) months** from the mailing date of this decision to file an appeal brief under 37 CFR 41.37. Failure to timely file an appeal brief the above-identified application will result in dismissal of the appeal. Extensions of time under 37 CFR 1.136 are applicable to this time period. *See* 37 CFR 41.37(e) and MPEP §1205.01.

The application is being referred to Technology Center 3600 for further processing in accordance with this decision.

Telephone inquiries concerning this decision should be directed to Ramesh Krishnamurthy at (571) 272-4914.

A handwritten signature in black ink, appearing to read 'Robert W. Bahr', is positioned above the printed name.

Robert W. Bahr
Deputy Commissioner for
Patent Examination Policy