877 F.2d 1575 (1989)

Joseph W. NEWMAN, Plaintiff-Appellant, v. Donald J. QUIGG, Commissioner of Patents and Trademarks, Defendant-Appellee.

No. 88-1312.

United States Court of Appeals, Federal Circuit.

July 5, 1989.

1576*1576 Joseph W. Newman, Lucedale, Miss., argued pro se.

Fred E. McKelvey, Office of the Sol., Arlington, Va., argued for defendant-appellee.

Before MARKEY, Chief Judge, NEWMAN and MAYER, Circuit Judges.

PAULINE NEWMAN, Circuit Judge.

Joseph W. Newman, *pro se,* appeals the judgment of the United States District Court for the District of Columbia, holding 1577*1577 unpatentable the invention claimed in Mr. Newman's patent application Serial No. 179,474 entitled "Energy Generation System Having Higher Energy Output Than Input". *Newman v. Quigg,* 681 F.Supp. 16, 5 USPQ2d 1880 (D.D.C.1988). We affirm.

Background

Mr. Newman's application for patent is described by the district court, and we assume general familiarity with that opinion. Claims 38 and 43 are representative of the claims for which Mr. Newman seeks a patent grant:

38. A device which increases the availability of usable electrical energy or usable motion, or both, from a given mass or masses by a device causing a controlled release of, or reaction to, the gyroscopic type energy particles making up or coming from the atoms of the mass or masses, which in turn, by any properly designed system, causes an energy output greater than the energy input.

43. The method of producing usable energy, comprising the following steps:

a. inputting energy into a device from an external source;

b. having electrical current flow within said device; and

c. utilizing the internal electromagnetic energy of at least some of the matter in the device to add to the energy being inputed [sic] into the device from the external source to produce useful energy for use outside of the device having an amount greater than the energy being inputed to the device.

The Patent and Trademark Office ("PTO") Board of Patent Appeals and Interferences affirmed the examiner's rejection of all the claims, *i.e.,* claims 15 through 43, for failure to comply with 35 U.S.C. § 112, first paragraph. The Board held that there was insufficient disclosure to support the claimed result of producing more usable energy output than input. The Board stated that the claimed device was a "perpetual motion machine", and that perpetual motion is impossible for it

violates either the first or second law of thermodynamics. During oral argument to the Board Mr. Newman presented a model of his device and demonstrated its operation. The Board does not refer to this demonstration.

On appeal to the district court, 35 U.S.C. § 145, the court referred the matter to a special master. The evidence before the master included several reports of tests conducted at universities and elsewhere, showing the apparent output of more electric energy than was input by the battery system. A witness, Dr. Hastings, concluded in a pretrial declaration that "[i]t is clear that measured efficiencies for the Newman motor are far in excess of predicted efficiencies. The predicted input power is in agreement with measured input." The evidence also included an affidavit of Mr. J. Rabinow of the National Bureau of Standards, stating his opinion that Mr. Newman's asserted result was "impossible".

The master reported that the results shown for the Newman device appear to conflict with the laws of thermodynamics, and expressed skepticism concerning Mr. Newman's theory of gyroscopic energy and the conversion of mass to energy. The master stated that "[t]here is no evidence corroborating Newman's scientific theory". However, the master also found that the "[e]vidence before the [PTO] and [the district court] is overwhelming that Newman has built and tested a prototype of his invention in which the output energy exceeds the external input energy; there is no contradictory factual evidence". The master concluded that

Even though the operation of Plaintiff's system seems contrary to recognized scientific principles, Plaintiff has demonstrated the operation of his system by very clear evidence and is therefore entitled to a patent if he otherwise satisfies the requirements of the Patent Statute (35 USC). *In re Chilowsky,* 229 F.2d 457, 43 C.C.P.A. 775 (1956).

Before the district court, the Commissioner strongly objected to the master's report. The district court ordered, as recommended by the master and requested by the Commissioner, that the application be referred back to the PTO for review by a 1578*1578 different patent examiner. The court also ordered, as recommended by the master, that the claims thus reviewed be those in a Rule 116 amendment that had previously been refused entry. This amendment made changes in the claims that had been on appeal to the Board, amending all the claims except claims 38 and 43.

The second examiner entered the Rule 116 amendment and rejected all the claims for failure to comply with 35 U.S.C. §§ 101, 102, 103 and 112. The examiner ordered Mr. Newman, pursuant to 35 U.S.C. § 114, to submit working models of three embodiments of his invention, based on three drawings in the specification, to the National Bureau of Standards ("NBS") for testing, under penalty of abandonment. Mr. Newman sought relief from this requirement and its penalty, which reached this court by mandamus petition. Mr. Newman pointed out that he had demonstrated a working model to the Board, had invited observation by the PTO of additional demonstrations, and that this new demand for working models was burdensome and unnecessary.

This court held the requested relief to be unnecessary:

Newman has pending in the district court a § 145 action from which an appeal to this court will lie, whether the PTO does or does not treat his application as abandoned. Thus, the PTO's threat [of abandonment] does not require issuance of the writ to aid or preserve our prospective appellate jurisdiction, (or the jurisdiction of the district court). *In re Makari,* 708 F.2d 709, 218 USPQ 193 (Fed.Cir.1983).

In re Newman, 763 F.2d 407, 410, 226 USPQ 97, 99 (Fed.Cir.1985). This court thus held that a PTO holding of abandonment under these circumstances could not deprive the courts of jurisdiction. In all events, Mr. Newman did not comply with the examiner's order within the time period set by the examiner, and the examiner declared the patent application abandoned.

The district court had followed, through periodic status conferences, these proceedings before the second examiner. When this phase was ended by the examiner's declaration of abandonment, at the district court's suggestion the Commissioner ordered Mr. Newman under Fed.R.Civ.P. 34 to produce a model of his invention for testing by NBS. The Commissioner's order, as modified by the district court and by this court on petition for writ of mandamus, *In re Newman,* 782 F.2d 971, 228 USPQ 450 (Fed.Cir.1986), *reh'g denied mem.* (Feb. 12, 1986), in essence required that a normal *inter partes* test be conducted at NBS, and that the tests be completed and the report issued within thirty days after the device was produced.

Mr. Newman produced a model of his invention within the fourteen days set by the court. After almost two months the district court, at a status conference, gave Mr. Newman's counsel NBS's proposed protocol for testing the device, ordered the NBS to commence testing, and granted an extension as requested by the Commissioner to allow NBS to complete the testing.

NBS received no response on Mr. Newman's behalf to the proposed test protocol. The record states that there were two observations of tests on behalf of the Commissioner, and none on behalf of Mr. Newman. The NBS report, issued five months after delivery of the device, concluded that the device did not produce more energy output than input, and that it showed efficiency measured at between 27 and 77 percent. At the subsequent trial the district court held the claimed invention unpatentable for noncompliance with 35 U.S.C. §§ 101 and 112.

On this appeal Mr. Newman asserts that the district court clearly erred in rejecting the findings of the special master, and that reversal of that error would moot all subsequent proceedings. He also argues that the NBS did not conduct a proper or fair *inter partes* test, and that patentability is supported by the heavy weight of the evidence.

Jurisdiction

The Commissioner asserts that the judgment of the district court should be vacated for lack of jurisdiction, on the ground that 1579*1579 the patent application became abandoned when, during the referral to the PTO by the district court, Mr. Newman did not produce three working models as the second examiner ordered. The Commissioner argues that the district court lost jurisdiction over Newman's application when the application was held abandoned by the examiner.

We settled this issue in 1985 in *In re Newman,* 763 F.2d at 410, 226 USPQ at 99, wherein we held, as quoted *supra,* that "the PTO's threat [of abandonment] does not require issuance of the writ to aid or preserve our prospective appellate jurisdiction, (or the jurisdiction of the district court)." That holding was and is the law of the case. The examiner's order of abandonment could not unilaterally extinguish the court's jurisdiction over the pending § 145 action, and the district court correctly declined to terminate its proceeding.

The Commissioner argues, alternatively, that even if the district court had that jurisdiction it extended only to claims 38 and 43, and judgment should be vacated as to all the other claims, on the theory that all the other claims were not properly before the court.

Claims 38 and 43 were the only claims that were not amended in the Rule 116 amendment that was ordered by the district court to be the basis of examination by the second examiner. The second examiner having rejected these claims and held them abandoned, the Commissioner argues that Mr. Newman was required to proceed by certain internal PTO procedures in order to preserve these amended claims for judicial review, such as the filing of a petition to the Commissioner protesting the examiner's ruling of abandonment, followed by an appeal to the court if that petition were denied.

The Commissioner further states that the prior claims, the Board's rejection of which was the basis for the appeal as filed under 35 U.S.C. § 145, also were no longer before the district court except for claims 38 and 43, because all the other claims were amended when the district court ordered further examination after the master's report. That is, the claims in their forms both before and after entry of this Rule 116 amendment had lost the right or opportunity for judicial review, according to the Commissioner.

We do not agree with this creative theory. The district court had authority to refer the application to the PTO for designated purposes, including that a second examiner review the claims in certain amended form. As we held in 1985, see *In re Newman, supra,* the Commissioner has no authority unilaterally to remove claims from the jurisdiction of the court.

While the Board will normally have decided every issue that is raised before the district court, as discussed in *Rendleman v. Ladd,* 197 F.Supp. 304, 309, 130 USPQ 300, 304 (D.D.C.1961), the court is not required to obtain, or suspend all proceedings while the applicant obtains a full administrative Board decision for every fresh aspect that arises during the course of the judicial proceeding. Otherwise, the Commissioner could not have added a ground of rejection, 35 U.S.C. § 101, that was not before the Board. *See generally* *DeSeversky v. Brenner,* 424 F.2d 857, 858, 164 USPQ 495, 496-97 (D.C.Cir.1970) (It is generally improper to raise new issues in a § 145 action, on the principle of exhaustion of administrative remedies).

A district court action under 35 U.S.C. § 145 is a *de novo* determination of patentability. It is not limited to the record before the PTO. *Gould v. Quigg,* 822 F.2d 1074, 1076-77, 3 USPQ2d 1302, 1303 (Fed.Cir.1987); *Fregeau v. Mossinghoff,* 776 F.2d 1034, 1037, 227 USPQ 848, 850 (Fed.Cir.1985). Unless a party is prejudiced thereby or due process is denied, expeditious justice is better served by avoiding artificial restrictions on the district court's authority to resolve all issues reasonably raised in the proceeding. *See generally* *Burlington Industries, Inc. v. Quigg,* 822 F.2d 1581, 1584, 3 USPQ2d 1436, 1439 (Fed.Cir.1987).

The Report of the Special Master

Mr. Newman argues that the district court should not have rejected the 1580*1580 recommended findings and conclusions of the special master. Appellate review of the correctness of the district court's action in turn requires determination of whether the master's findings are or are not clearly erroneous. Fed.R.Civ.P. 53(e)(2); *Milliken Research Corp. v. Dan River, Inc.,* 739 F.2d 587, 593, 222 USPQ 571, 576 (Fed.Cir.1984).

The district court held the master's report to be "clearly erroneous in that it apparently contradicts the first law of thermodynamics" — an apparent contradiction that had been referred to by the master. This court, like the master and the district court, believes that the laws of thermodynamics do not brook contradiction. However, the laws of thermodynamics do not require closing of either the scientific or the judicial mind to the possibility that the phenomena manifested can be explained by theories that do not violate inviolable scientific principles. The master so recognized, even as he expressed strong skepticism about Mr. Newman's scientific theory of harnessing gyroscopic or electromagnetic energy. But when the court-ordered test did not verify the results claimed by Mr. Newman, the matter of the scientific explanation of the claimed results became moot.

Taking notice of the unusual nature of Mr. Newman's asserted technological results and proffered explanation, we discern no error in the district court's decision to decline to adopt the recommended conclusion of the special master, and instead to order further examination by the PTO, followed by the order that a test of performance of the Newman device be conducted by the NBS.

The NBS Tests

Mr. Newman asserts that the NBS testing procedure was flawed and generally unfair, and that the district court did not adhere to the conditions set in *In re Newman,* 782 F.2d at 975, 228 USPQ at 453. Mr. Newman points out that NBS took five months after he delivered the device, and that NBS routinely failed to provide sufficient notice to enable him to attend the tests.

This court had declined to intervene in the district court's grants, at the Commissioner's request, of extensions of time for the NBS tests. *In re Newman,* Misc. No. 105 (Fed.Cir. March 19, 1986). However, the record shows none of the usual comity of *inter partes*[*] test procedures. Neither the NBS nor the PTO is shown to have made reasonable efforts to consider the convenience of Newman or his counsel.

Mr. Newman argues that the NBS evaluation was fatally defective because all tests were conducted with the device grounded. He states that it is essential that his device not be grounded during operation. He points to two reports from Mississippi State University which were provided to NBS; one report showed efficiencies below 100% when the device was grounded, and the other contained comments by one of the Mississippi State engineers that efficiencies greater than 100% appeared to be obtained when the device was not grounded. It is undisputed that NBS had copies of these reports prior to designing its tests. Mr. Newman argues that had NBS sought to duplicate or verify any of these test results reported by others, NBS would have discovered its errors. Newman argues that NBS should have done this in order to confirm or deny his claims.

The Commissioner defends the NBS procedure, arguing that grounding the device did not account for the lower efficiencies observed by NBS. The NBS engineer who designed and conducted the tests testified that his ground would not have affected radio frequency, referring to a theory of one of Mr. Newman's witnesses of how the device worked. But no witness for the NBS or the PTO testified as to performance with all grounding removed. The district court, hearing testimony and argument 1581*1581 on these points, held that the NBS test procedures were appropriate, and their results dispositive.

We need not decide whether the NBS tests were conducted by a flawed procedure, for any flaw could have been, and was not, corrected by Mr. Newman at the time of the tests. The test protocol designed by NBS contained electrical schematics showing plainly that the device was grounded. Mr. Newman does not dispute that he had a copy of the test protocol before testing began. The record shows no communication or objection. The Commissioner further points out that the patent specification does not mention the need to avoid grounding the device.

Similarly, Mr. Newman now objects to the use by NBS of load resistors connected in parallel with the coil to measure the output. This too was shown in the pre-test plan, and was not objected to.

We conclude that Mr. Newman had a duty to raise objection, before or during testing, to any defects in the test protocol that he knew or believed would impair the results. He had a clear chance to obtain a definitive test, and to the extent that he did not take it, he can not now impeach the results that were conducted by procedures of which he had advance knowledge. If there were flaws in the NBS protocol, we do not now give controlling weight to objections that could have been raised at a time when any errors could have readily been corrected. We conclude that Mr. Newman waived or acquiesced in any purported defect in the test procedure by remaining silent throughout the test period.

The Trial

The district court, on trial of the merits, held Mr. Newman's invention unpatentable under 35 U.S.C. § 101 because "Newman's device lacks utility (in that it does not operate to produce what he claims it does)". Utility under 35 U.S.C. § 101 is a question of fact. *Raytheon Co. v. Roper*

Corp., 724 F.2d 951, 956, 220 USPQ 592, 596 (Fed.Cir.1983), *cert. denied,* 469 U.S. 835, 105 S.Ct. 127, 83 L.Ed.2d 69 (1984).

Mr. Newman argues that the district court gave undue weight to the NBS test results, and failed to accord proper and overriding weight to the testimony and affidavits supporting the claimed increase in energy output. The district court acknowledged that it must consider all of the evidence presented at the *de novo* proceeding in reaching an independent conclusion. *Newman,* 681 F.Supp. at 22-23, 5 USPQ2d at 1885.

The court described the evidence on Newman's behalf as "largely qualitative rather than quantified by measured data", *id.* at 20, 5 USPQ2d at 1883, while "credit[ing] in full the meticulously thorough and well-documented testing done by NBS". *Id.* at 23, 5 USPQ2d at 1886. The court remarked that at best Mr. Newman's evidence showed prolonged operation on dry cell batteries, but that "such a device is not the one for which Newman seeks a patent." *Id.* We discern no error in the district court's analysis, and conclude that the court did not clearly err in giving controlling weight to the NBS report and in concluding that the utility claimed for Newman's device had not been demonstrated.

Mr. Newman also argues that the district court incorrectly held that his application was not enabling under 35 U.S.C. § 112, first paragraph. He asserts that his claims are adequately supported by, and the invention enabled by, the disclosure. Enablement under 35 U.S.C. § 112 is deemed to be a question of law, *Allen Organ Co. v. Kimball Int'l, Inc.,* 839 F.2d 1556, 1566, 5 USPQ2d 1769, 1777 (Fed.Cir.), *cert. denied,* 488 U.S. 850, 109 S.Ct. 132, 102 L.Ed.2d 104 (1988); although it is apparent that lack of utility because of inoperativeness, and absence of enablement, are closely related grounds of unpatentability. *Raytheon Co.,* 724 F.2d at 956, 220 USPQ at 596.

While it is not a requirement of patentability that an inventor correctly set forth, or even know, how or why the invention works, *Diamond Rubber Co. v. Consolidated Rubber Tire Co.,* 220 U.S. 428, 435-36, 31 S.Ct. 444, 447-48, 55 L.Ed. 527 (1911); *Fromson v. Advance Offset Plate, Inc.,* 720 F.2d 1565, 1570, 219 USPQ 1137, 1140 (Fed.Cir.1983), neither is the patent 1582*1582 applicant relieved of the requirement of teaching how to achieve the claimed result, even if the theory of operation is not correctly explained or even understood. *In re Isaacs,* 347 F.2d 887, 892, 146 USPQ 193, 197 (CCPA 1965); *In re Chilowsky,* 229 F.2d 457, 463, 43 C.C.P.A. 775, 108 USPQ 321, 326 (1956).

The district court held that Mr. Newman's claimed device and method do not produce the claimed result, following the teachings of the specification. We affirm the conclusion that the requirements of 35 U.S.C. § 112, first paragraph, are not met.

Conclusion

The decision of the district court that the claimed invention is unpatentable because it fails to comply with 35 U.S.C. § 101 for lack of utility, and with 35 U.S.C. § 112, first paragraph, for lack of enablement, is affirmed.

Costs

Each party shall bear its own costs.

AFFIRMED.

[*] For example, the NBS wrote to the PTO Solicitor: "We will not deal directly with the inventor or his representatives. We are referring all contacts to you in the PTO". Nor was Mr. Newman cooperative. When a NBS engineer asked

Newman, who was installing the device at NBS, to identify the output, Newman's counsel directed him not to answer, instead directing the NBS to certain pages in Newman's book.

681 F.Supp. 16 (1988)

Joseph W. NEWMAN, Plaintiff,
v.
Donald J. QUIGG, Commissioner of Patents and Trademarks, Defendant.

Civ. A. No. 83-0001.

United States District Court, District of Columbia.

February 17, 1988.

As Amended February 26, 1988.

17*17 John P. Flannery, II, Leesburg, Va., for plaintiff.

Fred E. McKelvey, Office of the Solicitor, Arlington, Va., for defendant.

DECISION AND ORDER

JACKSON, District Judge.

Plaintiff Joseph W. Newman, of Lucedale, Mississippi, an inventor, sues Donald J. Quigg, U.S. Commissioner of Patents and Trademarks, in his official capacity as head of the U.S. Patent and Trademark Office ("Patent Office" or "PTO") pursuant to 35 U.S.C. § 145. Newman is an "applicant dissatisfied" with the decision of the Board of Appeals affirming an examiner's rejection in Newman's application for a patent for an invention he entitles: "Energy Generation System Having Higher Energy Output Than Input."[1] Upon the following facts, as found by the Court in accordance with Fed.R.Civ.P. 52(a), upon trial without a jury, the Court concludes, for the reasons stated, that judgment must be given for defendant and the complaint dismissed with prejudice.

I.

On August 18, 1980, Newman filed the instant application with the PTO for a U.S. patent for his invention. In the "abstract" section of his application he describes it, in pertinent part, as:

A system for generating obvious work motion, or electromagnetic energy (fields of force) or electric current, utilizing the electromagnetic energy which makes up all matter and results in a greater output of energy, than the initial input of conventional energy means and teachings. This is accomplished by arranging one or a variety of mechanical situations, whereby matter is converted into usable and controllable electrical or magnetic energy in an extremely efficient manner which mechanically achieves the degree of energy releaseable from matter in accordance with Einstein's equation of E = MC2. [sic]

The system utilizes the gyroscopic actions of the electromagnetic field particles in which the structural elements of the generator place a force at an angle to the gyroscopic particles causing the particles to follow paths having a net directional effect, producing electric current flow.

Copy of the Contents of U.S. Patent Application, Serial No. 179, 474, filed August 18, 1980, by Joseph Westley Newman (hereinafter "Joint Exhibit") Vol. I., p. 7.

In his discussion of the "prior art" he observes that all other systems for the production of electrical energy (e.g. mechanical friction, thermo-electricity, photoelectricity, piezoelectricity, electrochemistry, and electromagnetic induction)

are designed accordingly [sic] to rigid mathematical laws taught both in physics and electrical engineering which coincide with the hypothesis rigidly accepted by the industrial and scientific communities concerning the Second Law of Thermodynamics (1850) .. [viz.], that the electric current flowing in a closed circuit from a battery, electric generator, etc., is used up in the mechanical device being operated ...; that all such ... systems would only put out at most work equal to the work initially put into the system ... [and] that a particular electrical generating system was only capable of a given output of energy and no more.

Id. at 9-10.

"The prior art," he asserts, "has failed to understand certain physical aspects of matter and the makeup of electromagnetic fields, which failure is corrected by the present invention." His many years of research, 18*18 consideration, evaluation and inventing have revealed to him certain "principles or guidelines," namely, that "all matter is made up of electromagnetic energy; ... that electromagnetic energy comprises quanta or particles of energy moving at the speed of light and having spin characteristics ... [and] that these electromagnetic energy quanta behave in accordance with the normal laws of mechanics and, in particular, in accordance with the principles of gyroscopic action." Utilizing these principles, he says, his invention will produce "more efficient" electrical motors and generators from "materials and designs heretofore considered ... impractical, if not impossible." *Id.* at 11-12.

Newman then describes the six drawings representing various "embodiments" of his invention (Figs. 1-6 to his application)[2] and continues with an explanation of "related principles" he has discovered: contrary to contemporary teaching that the magnetic field associated with an electric current-carrying conductor results from the electric current itself,

the gyroscopic particles making up the electric current ... interact with the electromagnetic makeup of the atoms of the conductor, causing them to align extremely rapidly, thereby then releasing some of their electromagnetic make-up in the form of a magnetic field....

* * * * * *

The magnetic field is the result of the atom alignment of the conductor. The more atoms in a conductor (up to a point), the stronger the magnetic field produced from a given amount of electric current input.... The reasons for this is that there are more conducting atoms to interact with the gyroscopic particles of the electric current moving through the conductor, which results in a greater number of conducting atoms being aligned, thereby then releasing some of their electromagnetic make-up....

Id. at 22-24.

On August 24, 1981, and again on January 6, 1982, the first patent examiner rejected Newman's application under 35 U.S. C. § 112, first paragraph.[3] Newman appealed to the Board of Appeals, comprised of three examiners-in-chief, who unanimously affirmed the first examiner's rejection on November 5, 1982. The Board said:

We do not doubt that a worker in this art with appellant's specification before him could construct a motor ... as shown in Fig. 6 of the drawing. Such a motor would not and could not be made to operate at an efficiency level of greater than 100%.... Such a machine is impossible. If it were possible ... some of the output energy developed could be fed back into the input and the machine would work forever without any external source of energy. Such machines are known as

perpetual motion machines.... [M]achines of this type will not work. They violate either the first or the second law of thermodynamics.

* * * * * *

When a patent applicant presents an application describing an invention that contradicts known scientific principles the burden is on the examiner simply to point out this fact to appellant.... [T]he burden shifts to appellant to demonstrate either that his invention, as claimed, does not violate basic scientific principles or that those basic scientific principles are incorrect. In this case, appellant has attempted to do the first[;] he has invoked the mass-energy equivalence doctrine of Albert Einstein.

* * * * * *

There have been limited applications of the doctrine of mass energy equivalence. The scientific community has managed to obtain what is commonly known as atomic 19*19 power.... The relationship between ... atom splitting technique and appellant's invention is unclear from the description.

* * * * * *

[Certain of appellant's claims] embrace within their confines ... appellant's theory that he is somehow converting mass into energy in accordance with Einstein's equation E = mC2. There is *no evidence* before us that appellant has done that[,] nor is there any disclosure which would enable anyone having ordinary skill in the art to do it. (Emphasis in original).

* * * * * *

The only independent claim before us which does not directly embrace appellant's theory ... has the basic infirmity that it recites that appellant obtains more energy out of his apparatus than he puts in. This is impossible unless some of the mass of the device is converted to energy in accordance with appellant's theory. Therefore, appellant's theory is also claimed by implication. No evidence before us of any nature or description establishes that appellant's apparatus achieves a mass-energy conversion.

Joint Exhibit, Vol. IV, pp. 715-18.

Newman's complaint in this Court was filed January 3, 1983, and prayed for trial *de novo,* reversal of the "judgment" of the Board of Appeals, and an order directing the Commissioner to issue letters patent to him. Newman alleged that he was "the original and first inventor" of an energy generation system having higher energy output than input, a result he achieved "by producing an internal conversion of matter into energy in a way heretofore never achieved." Defendant answered with a general denial, and asserted that the examiners had correctly rejected plaintiff's application on the ground of 35 U.S.C. § 112, first paragraph.

After a protracted, and acrimonious, period of pretrial motions, appeals, and discovery disputes lasting until late 1986, The case came on for trial on December 6, 1986.[4]

II.

Newman called three witnesses in support of his claim that a patent should issue: a physicist (with a doctoral degree), presently the manager of a superconductive electronics technical center for Unisys Corporation in St. Paul, Minnesota; a mechanical engineer (with a bachelor's degree) now working for the State of Mississippi's Bureau of Geology; and a maintenance engineer (*sans* degree) for a New Orleans television station.[5] All three, originally skeptics, are now converts to Newman's faith in his device as a truly revolutionary mechanism. The latter two have

invested with him. They have each observed a "Newman device" in operation on several occasions, speak knowledgeably about what they observed (and in some cases measured) on those occasions, and are not inherently incredible. The "Newman device" of which they testify has been given several incarnations, but each resembles an unremarkable conventional electrically powered motor/generator in most particulars, differing 20*20 primarily only in the extraordinary length of its copper wire coil. It is in the powers Newman's witnesses ascribe to the device that it becomes remarkable indeed.

A Newman device, it appears, consists of a rotary (or reciprocating) magnet (weighing, depending upon the model, from 90 to 500 pounds), situated either within or without an air-cored copper wire coil (comprised of No. 5 and No. 14 gauge wire, weighing from 500 to 9200 pounds, and, by one report as to one model, up to 55 miles in length). Attached to the magnet is a plastic commutator, with a periphery, i.e., its circumferential edge, at intervals conductive and non-conductive, which, as it rotates, makes contact with brushes connected to the coil terminals. The power source, connected to electrical contacts on the commutator, is the direct current provided by a battery pack of multiple alkaline (viz., nonrechargeable dry cell) batteries arranged in series.[6]

Only Dr. Roger Hastings, the physicist, was asked directly to define a Newman device's "input" and "output" for purposes of ascertaining whether the latter exceeds the former. The "input," he said, consisted of the power supplied by the batteries. The "output," however, should be deemed to include not only mechanical work done (when configured as a motor) or the current generated in an adjoining coil (as a generator) — conventionally considered to be any motor/generator's "useful" output — but also certain other "outputs," e.g., the current-generated heat emanating from the coil, or the friction heat developed in the bearings upon which the magnet/commutator rotates. By far the most significant increment to "output" in a Newman device, however, according to Dr. Hastings, is to be found in certain anomalous "back spikes" of current it generates in the megaHerz range, which Dr. Hastings asserts he has perceived on an oscilloscope, listened to on (and used to power) a transistor radio, and observed to heat a beaker of water when channeled through a resistor immersed in it.

Dr. Hastings advanced no explanation for the presence of the "back spike" current. He hypothesized that it originates in the coil, although the configuration of the commutator could affect it. These "back spikes" can be detected in the circuit between the battery pack and the commutator, he said, and they may somehow be responsible for the phenomenon all three of plaintiff's witnesses said they had observed on several occasions: a virtually indefinite extension of the work life (in effect, a "recharging") of ostensibly non-rechargeable batteries used to power a Newman motor which would, while in operation, perform work at least equal to that performed by commercially available electric motors, using (when measured by ammeter) a minuscule fraction of the current they had drawn in doing so.[7]

The accounts given by plaintiff's witnesses are anecdotal, and largely qualitative rather than quantified by measured data. But they all relate instances in which they personally watched while new (and used) batteries exhausted themselves in brief spans while powering conventional motors (with and without loads), and were then apparently rejuvenated upon connection to a Newman motor, so much so that the Newman motor would operate for hours without a sign of battery depletion (or at least for a much longer period than its conventional counterpart had worked). Then, when reconnected to the conventional motor on which they had originally been expended, the batteries appeared to have been restored to a point at which they 21*21 could drive it once more, on two occasions for periods longer than it had taken to exhaust them initially.

III.

Defendant's case consisted almost entirely of the NBS team leader's presentation of the circumstances and the results of the Bureau's tests on the Newman device. *See* n. 4, *supra.*[8] Dr. Robert Hebner, the supervisory physicist in charge of NBS' applied electrical

measurements group assigned to conduct the tests, testified that a Newman device (unaccompanied by a power source) arrived at the NBS laboratory in Gaithersburg, Maryland, on January 24, 1986, shortly after the U.S. Court of Appeals for the Federal Circuit had denied Newman's petition for a writ of mandamus to prohibit the tests. It was accompanied by a letter (Defendant's Exhibit 7) from Newman's attorney—not Newman himself —giving detailed instructions on how to unpack it, cautioning against rotating the magnet in the wrong direction or using excessive voltage to power it, and declaring it to be Newman's intent to have all NBS' testing observed by his representatives. The letter said nothing, however, about operation of the device.

Upon uncrating the device Dr. Hebner noted several conditions about it which appeared to him to be shipping damage, and he accordingly wrote the attorney to inform him of it. He also requested operating instructions for the device, including, specifically, the locus of energy output. The attorney's reply, for the most part, simply accused NBS of compromising the "security" of the device and delaying the testing. It acknowledged the shipping damage but dismissed it as inconsequential. And in response to Dr. Hebner's request for operating instructions, the letter insolently referred him to a four-page excerpt from Newman's self-published book, "The Energy Machine of Joseph Newman." The first page of the excerpt was a photograph of a Newman device superficially similar to the device delivered to NBS. The final three pages were a reprint of an affidavit of Dr. Roger Hastings, dated June, 1984, the only pertinent portion of which was a paragraph headed "Useful Output" which read, in its entirety:

Mr. Newman placed a 75 Watt, eight foot, flourescent [sic] tube across the motor coil, and the bulb lit to perhaps 10% of full brightness. Interestingly, when the bulb was inserted, the rotary gained speed, and the motor drew less current from the batteries! The lit 75 watt tube demonstrates useful output of several watts, with a fractional watt input power.

(Defendant's Exhibit 10, attachment, p. 4). Dr. Hebner thus concluded that energy output was to be measured "across the coil," and he has never been advised by Newman or anyone else to the contrary.

Dr. Hebner's superiors at NBS, however, refused to allow him to begin the tests until Newman himself put his machine in working order. Newman, his attorney, and other companions, therefore, came to NBS' laboratory on February 10, 1986, bringing a pack of 116 9-volt batteries to serve as the power source. Without commentary Newman personally made various adjustments to the device, connecting the battery pack, and reattaching a brush apparently dislodged in shipping. Next he grounded the device to a wall outlet. Finally he "turned it on" by manually rotating the magnet. Dr. Hebner then asked Newman directly where he intended that the power output be measured. His attorney advised Newman not to answer, and Newman and his coterie departed without further comment.

A few weeks later Dr. Hebner and his colleagues published their proposed test protocol under date of March 20, 1986. (Defendant's Exhibit 16). It described the device delivered to NBS as an electrical "generator," since it was not equipped with a mechanical takeoff, and stated clearly 22*22 that its output power would be measured by resistors connected to the terminals of the coil. *Id.* at 3. The test schematic also clearly disclosed that the device, both free-standing and as it would be connected to the electrical diagnostic equipment, was attached to ground. *Id.* at 5. Newman made no objection to the test protocol, and offered no criticism, advice or instruction. He complained only in court, through his attorney, and then only as to the length of time NBS was taking to complete the testing.

NBS' final report (Defendant's Exhibit 3) was filed with the Court on June 26, 1986. Its conclusion was unequivocal:

"At all conditions tested, the input power exceeded the output power. That is, the device did not deliver more energy than it used."

Id. at i. Over the preceding three months Dr. Hebner and his colleagues had measured power input from the battery pack (configured to supply either 800 or 1000 volts) using a sampling watt meter and an analog multiplier watt meter. They measured power output across resistive loads, ranging between 50,000 and 400,000 ohms connected in parallel with the coil, with a differential active attenuator and a thermal voltage convertor. Measurements were made simultaneously with two instruments as a cross-check, and input and output measuring equipment was switched for further verification. In the 77 measurements they recorded (both uncorrected, and corrected for instrumentation-induced errors) they found internal power losses between input and output of between 2.2 watts and 4.9 watts, and calculated the efficiency of the device at between 27 per cent and 77 per cent. No measurement made reflected, at any setting, a power gain, or an efficiency greater than 100 per cent.[9]

The NBS investigators, too, detected, but made no attempt to measure, the radio-frequency power "spikes" Dr. Hastings thought might be so significant. They attributed them to the sparks emitted by the commutator as it rotated through a cycle (causing deterioration of the non-conductive spacers on its periphery), regarded them as artifacts which interfered with accurate measurements of power input, and filtered them out with a low-pass filter on the input side of the device. Consequently, they made no attempt to ascertain their effect, if any, upon the batteries. Nor did they make any measurements of battery life.[10] They were given no reason to do so.

Newman presented no rebuttal. The cross-examination of Dr. Hebner sought only to point out that Newman's own wiring diagrams show no grounds or filters, and that by grounding the device and endeavoring to eliminate all RF "noise," NBS omitted from its calculus of "output" the most significant of its byproducts, namely, the electromagnetic energy by which it may possibly be rejuvenating its power supply.

IV.

A decision of the PTO Board of Patent Appeals, whether reviewed by way of a direct appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. § 141 or a civil action to set it aside before the U.S. District Court for the District of Columbia pursuant to 35 U.S.C. § 145, is presumptively correct. *Fregeau v. Mossinghoff,* 776 F.2d 1034 (Fed.Cir. 1985). It may be overturned only if "clearly erroneous," by which is meant that the reviewing court must be of the "`definite and firm conviction' that a mistake has been made." *Id.* at 1038 (quoting *Anderson v. City of Bessemer City,* 470 U.S. 564, 573, 105 S.Ct. 1504, 1511, 84 L.Ed.2d 518 (1985)). Review by the court of appeals is confined to the PTO record and the Board's decision. When new evidence is presented in a *"de novo"* proceedin 23*23 a civil action in district court, the record before the PTO is nevertheless the "evidentiary nucleus," *id.* at 1037, which the court must consider in conjunction with the evidence adduced at trial in making its independent findings of fact. *Id.* at 1038. This Court, having made such a consideration, concludes, as did the Board, that Newman's device lacks utility (in that it does not operate to produce what he claims it does), and the Board's decision is not clearly erroneous. Hence, it must conclude that Newman's patent application was properly rejected under 35 U.S.C. § 101.

The Court finds, further, as did the two examiners, that the application should likewise fail for insufficient disclosure under 35 U.S.C. § 112, first paragraph. Plaintiff's Claims Nos. 38 and 43—the only claims the PTO believes to be properly before this Court—are representative.[11] Claim No. 38 asserts that the device

... increases the availability of useable electrical energy or useable motion, or both, from a given mass or masses by a device causing a controlled release of, or reaction to, the gyroscopic type energy particles making up or coming from the atoms of the mass or masses, which in turn, by any properly designed system, causes an energy output greater than the energy input.

Claim No. 43 describes a

... method of producing useable energy, comprising the following steps:

a. imputing [inputting?] energy into a device from an external source;

b. having electric[a]l current flow within said device; and

c. utilizing the internal electromagnetic energy of at least some of the matter in the device to add to the energy being inputed [sic] into the device from the external source to produce useful energy for use outside of the device having an amount greater than the energy being inputed [sic] to the device.

Aside from Newman's own somewhat metaphysical writings which appear at multiple points throughout his patent application, there is no evidence whatsoever, in the PTO record or the trial record, from which to find the existence of such "gyroscopic particles," their observable (or measurable) "release" or "reaction" within the device, or any manifestation of their enhancement, in a recoverable form, of its "energy output" as that term is customarily used. Similarly, there is no evidence of an extraction of "internal electromagnetic energy" from the "matter" of the device. At best, for plaintiff's purposes, the evidence supports a finding that Newman's device will operate, for reasons not explained at all but must be merely guessed at, on dry cell batteries for longer periods of time than others which may or may not be comparable. But such a device is not the one for which Newman seeks a patent. He is unequivocal in his insistence that the device he has tendered as patentworthy produces more useable energy output than the energy required to power it. The Court finds the evidence of it insufficient.

The Court credits in full the meticulously thorough and well-documented testing done by NBS, and finds that it measured accurately what it set out to measure, and that it had no reason to measure anything else. It regards plaintiff's efforts to discredit the NBS tests after the fact as specious. Newman has always been unwilling, and has resisted every effort, to subject a working model of his device to third-party testing which might convince either the PTO or the Court. He refused the patent examiner's call for a working model, opposed the PTO's request for Fed.R.Civ.P. 34 discovery in court, and appealed the Court's order that the tests be done. He successfully confounded NBS' request to be allowed to disassemble the device, if necessary, to comprehend its operation. He attempted 24*24 to retrieve the device from NBS' possession when he concluded the tests were behind schedule. And he declined to cooperate with NBS' team leader in identifying the point (or points) at which he intended "energy output" to be ascertained —the most critical measurement for his purposes—cooperation which would have been eagerly extended had Newman then a genuine desire to establish the veracity of his claims. He made no protest of the test protocol shown to him in advance of the tests. And, having insisted upon, and secured, the right to be present (with expert assistance, if he needed) throughout the tests, Newman ignored the tests altogether, never attending any of them in person or by proxy in the course of three months.

The Court infers from such circumstances that Newman knew in advance that the test results would be adverse, and, thus, finds his *ex post facto* disparagements of them to be no more than rationalizations intended to diminish their evidentiary impact at trial. The Court rejects the implication that NBS was partisan, or somehow biased in favor of the PTO. The record reflects that NBS had from the first been reluctant to commit itself to do the testing, acceding only when personally importuned by the Commissioner after the Court had ordered the tests. It had no interest in the controversy, no purpose of its own to be served in devoting the time and resources the tests would require, and no motive to test in any manner except in accordance with its own high standards. To the extent it may initially have been dubious of Newman's claims, the Court finds it to have been an altogether appropriate scientific skepticism in light of their rather startling character.

For the foregoing reasons, therefore, it is, this 17th day of February, 1988,

ORDERED, that judgment is given for defendant, and the complaint is dismissed with prejudice.

25*25 # APPENDIX 1

26*26 # APPENDIX 2

MEMORANDUM AND ORDER

Upon consideration of defendant's "Motion Under Rule 59" and the Court's re-examination of the trial record, the motion will be granted, and the Decision and Order of February 17, 1988, amended in the particulars noted, but the amendation will be 27*27 made pursuant to Fed.R.Civ.P. 60(a) rather than Rule 59.

The Court agrees that it erred in believing that Newman had likewise appealed the second examiner's decision to the Board. It concurs in the observation that its reference to a "thermal voltage invertor" is incorrect, being attributable to a typographical error in the transcript (Page 437, line 5), and that the correct term is a "thermal voltage converter." And it stands corrected as well as to the use of a low pass filter's being limited to the input side, its error having been induced by its misinterpretation of Figure 4, page 7, of Defendant's Exhibit 3, but revealed to be error by its re-reading of pages 6-11 thereof and of the testimony of Dr. Hebner, pages 443-49.

Accordingly, it is, this 26th day of February, 1988,

ORDERED, that the Decision and Order of February 17, 1988, is amended as prayed.

[1] The original title — "Electrical Energy Generating System Utilizing the Gyroscopic Actions of Electromagnetic Field Particles"—was changed by Newman by an amendment of his patent application a year after filing it.

[2] Figs. 5 and 6 illustrate, he says, "rough working prototypes" of his invention. Joint Exhibit, Vol. I, p. 50. (Appendix 1 hereto).

[3] 35 U.S.C. § 112, first paragraph, requires that the "written description of the invention, and the manner and process of making and using it [shall be] in such full, clear, concise, and exact terms as to enable any person skilled in the art ... to make and use the same...."

[4] Cross-motions for summary judgment were referred by the Court to a special master, pursuant to Fed.R.Civ.P. 53, whose report of September, 1984, although rejected in part by the Court, prompted a remand to the PTO for reconsideration of the application by a new examiner. On November 30, 1984, the second examiner preliminarily rejected the application on the same ground as his predecessor, but ordered Newman to submit working models of his "embodiments" of his device to the National Bureau of Standards ("NBS") for testing by May 30, 1985, pursuant to 35 U.S.C. § 114. Newman declined to do so, whereupon the PTO took the position that the application had been abandoned.

On October 2, 1985, however, the Court ordered Newman to produce "one (1) working model of each device" for which he was seeking patent protection to NBS for testing pursuant to Fed.R.Civ.P. 34. After his appeal of that order was denied, Newman did produce one prototype of his machine to NBS which completed its tests in June, 1986. (Defendant's Exhibit 4, Appendix 2 hereto).

The PTO added lack of utility, 35 U.S.C. § 101, as an additional ground of defense at Pretrial Conference on December 4, 1986.

[5] Newman himself did not testify; he did not even attend the trial. Nor was a "Newman device" ever present in, or demonstrated to, the Court.

[6] Plaintiff's witnesses testified that the device "destroys" "power packs" (transformers of household AC current to DC), and "scratches away" the active material on the plates of rechargeable (wet cell) batteries, rendering them nonrechargeable. The explanation for these effects *may* be the "back spikes" it produces, *see infra.*

[7] Newman's patent application makes no express mention to the device's emission of "back spikes" of radio-frequency current, nor does it expressly claim a battery-recharging capability for it. Two brief mentions of a current which "get[s]

back into the battery" attribute a destructive effect to it. *See* Joint Exhibit, Vol. I, pp. 33-34. "Back spikes" and extended battery life were, thus, first postulated as being related by Dr. Hastings' testimony at trial.

[8] PTO concluded its evidence with testimony defining the first and second laws of thermodynamics by which it claims the Newman device is (as are all machines) constrained: the difference between the energy introduced into a system and its useful work output is accounted for internally, and there are always losses in the conversion of energy to work.

[9] NBS ran its tests weekdays, 8:30 a.m. to 5:00 p.m., between March and June, 1986. Despite having insisted on having his own observers present at all tests, neither Newman, his attorney, nor any representative attended any of them. PTO observers were present twice.

[10] NBS did determine that the low-pass filter reduced measured power input by three per cent, thus causing the device's efficiency to be overstated when it was in use. *See* Defendant's Exhibit 3, p. 21.

[11] The PTO has moved to dismiss as to all other claims, on the ground that plaintiff's claims have been subject to so many amendments, deletions, substitutions, and additions that only Claims 38 and 43 remain unaltered of those before the Board at the time of its decision, and it is only those upon which the Board has had occasion to pass that this Court has jurisdiction to review.

In view of its disposition of the entire case the Court finds it unnecessary to decide the motion to dismiss.

782 F.2d 971 (1986)

In re Joseph W. NEWMAN.

Misc. No. 89.

United States Court of Appeals, Federal Circuit.

January 13, 1986.

972*972 John P. Flannery, II, Washington, D.C., for petitioner.

Joseph F. Nakamura, Sol., Fred E. McKelvey, Deputy Sol., and Thomas E. Lynch, Associate Sol., Office of the Sol., Arlington, Va., for respondent.

Before MARKEY, Chief Judge, and NEWMAN and BISSELL, Circuit Judges.

ORDER

NEWMAN, Circuit Judge:

Joseph W. Newman petitions for writ of mandamus ordering the United States District Court for the District of Columbia to vacate or modify its orders dated October 2 and 9, 1985, which authorized the United States Patent and Trademark Office (PTO), through the National Bureau of Standards (NBS), to conduct tests of the device for which Newman seeks a United States patent. We grant the petition in part.

Background

Petitioner Newman applied for a patent on an invention that he entitled "Energy Generation System Having Higher Energy Output Than Input". The PTO rejected the application, on the basis that the device was a "perpetual motion machine" and thus "impossible", (i.e., not useful within the meaning of 35 U.S.C. § 101). Petitioner denies this label, and asserts that his device works as described in his patent application.

A civil action was brought in the district court under 35 U.S.C. § 145. In view of the conflicting representations before it, the district court appointed a Special Master, former Commissioner of Patents William E. Schuyler, Jr., who concluded that the claimed invention met all of the requirements for patentability. The PTO criticized the Master's report, the court held some of the Master's findings to be clearly erroneous, and at the PTO's request the district court remanded petitioner's patent application for a new examination. The patent examiner then rejected the application under 35 U.S.C. §§ 101, 102, 103, and 112, and ordered that a working model be delivered within 30 days to the NBS for testing.

Meanwhile petitioner had sought relief from this remand by writ of mandamus, which this court denied on May 29, 1985 on the basis that interlocutory review was unnecessary because the asserted errors were of a nature that could be corrected on appeal from the district court's final decision. *In re Newman,* 763 F.2d 407, 226 USPQ 97 (Fed.Cir.1985).

On June 18, 1985, at the suggestion of the district court, the Commissioner served on petitioner a request under Rule 34 of the Federal Rules of Civil Procedure. Rule 34 provides in relevant part:

973*973 Any party may serve on any other party a request ... to inspect and copy, test, or sample any tangible things which constitute or contain matters within the scope of Rule 26(b) and which are in the possession, custody or control of the party upon whom the request is served....

* * * * * *

The request shall specify a reasonable time, place, and manner of making the inspection and performing the related acts.

The Commissioner's Rule 34 request required that petitioner promptly transport working models of his device to the Bureau of Standards in Maryland; that the device be relinquished to the NBS for at least seven months; that the device be delivered before the tests and test methods were designed; that only the PTO would be advised in advance of the testing program and who would conduct the tests; that the inventor and his counsel could observe but no expert could be present on petitioner's behalf; that the PTO would control disposition of the working models after the tests, contemplated to be returned to petitioner four days after the trial date; and that the NBS on reasonable notice to petitioner could dismantle or destroy the device.

Upon petitioner's objections, the district court modified the PTO's Rule 34 request in that the NBS was ordered to complete its evaluation and make its report in thirty days rather than seven months; and Newman, his counsel, and one other person would be allowed to observe "any final tests". The NBS was "expressly permitted to render any or all of the devices inoperable in part or in whole if necessary to make its determinations aforesaid", and the requirement that prior notice of dismantling or destruction be given to petitioner was not included in the court's order.

Analysis

Because this court, and only this court, has jurisdiction over any appeal from a final decision in this case, it has jurisdiction to hear and decide this petition. *In re Mark Industries,* 751 F.2d 1219, 224 USPQ 521 (Fed.Cir.1984); *Mississippi Chemical Corp. v. Swift Agricultural Chemicals Corp.,* 717 F.2d 1374, 219 USPQ 577 (Fed.Cir.1983).

Petitioner asserts that the test conditions authorized by the district court are unreasonable, and thus that the order exceeds the district court's discretionary authority. The petitioner alleges irreparable harm if this court does not intervene. We conclude that a prima facie case of irreparable harm has been made by the district court's authorization that the NBS may destroy petitioner's machine, and is supported by other irregularities in the proposed procedures. Mandamus is appropriate because no subsequent appeal will necessarily redress any damage. *See* 9 J. Moore, B. Ward & J. Lucas, Moore's Federal Practice ¶ 110.28 (2d ed. 1985). *See also* *Schlagenhauf v. Holder,* 379 U.S. 104, 110, 85 S.Ct. 234, 238, 13 L.Ed.2d 152 (1964) (review by mandamus is appropriate in view of the "undecided question" of the appellate court's power in these "unusual circumstances").

Petitioner states that during the course of patent prosecution he had offered the machine to the PTO for testing. The examiner refused these offers, and the deputy solicitor refused to view the machine when he was in Mississippi for depositions in this action. Petitioner asserts that this history shows his past readiness and willingness to produce his machine for testing, and that the PTO having refused these opportunities can not now insist on such tests. Petitioner also states his willingness now to produce the machine, under reasonable conditions.

We have recently held that the PTO is entitled to reject an application for insufficient proof when a device by its nature occasions reasonable skepticism as to its operativeness under §

101. *Fregeau v. Mossinghoff,* 776 F.2d 1034, 227 USPQ 848 (Fed.Cir.1985). *See also In re Langar,* 503 F.2d 1380, 183 USPQ 288 (CCPA 1974). We discern no abuse of discretion in the holding of the district court that additional 974*974 tests of petitioner's device should be conducted.

When petitioner had objected to the "extraordinary burden" imposed by the test conditions authorized by the district court, the court responded that this "unprecedented" device "needs precedented [*sic:* unprecedented?] procedural adaptations of the Federal Rules". However, the Federal Rules of Civil Procedure are more than guidelines for orderly litigation; they ensure that the proceedings are conducted fairly, with the objective of uncovering the truth, and in accordance with fundamental principles of due process.

We are not told why routine Rule 34 safeguards must in this case be denied, nor why it is essential that the NBS have authority to destroy the machine in order to determine if it operates as described. The record before us contains no allegation that the machine does not correspond with the specification, and we do not here deal with any basis for rejection other than the asserted lack of utility under § 101.

The PTO represents in its brief that the NBS will not dismantle or destroy the device until it has first determined that the device works in accordance with the specification. From this, we assume that the purpose of the destruction would be to determine not if, but how, it works. The PTO is not a guarantor of scientific theory and, although the record shows that the laws of thermodynamics were debated before the district court, it is not the province of the PTO to ascertain the scientific explanation. *See In re Anfhauser,* 399 F.2d 275, 283, 158 USPQ 351, 357 (CCPA 1968) (applicant "is not legally required to comprehend the scientific principles on which the practical effectiveness of his invention rests.") Thus, although we encourage petitioner to cooperate in the testing program, at the risk of adverse inferences as mentioned by the district court, we agree with petitioner that his device should not be dismantled or destroyed without his consent.

Rule 34 discovery is a common procedure, as is inter partes testing in general, arising in actions where there is a need to conduct inspections and tests for evidentiary purposes. Such tests routinely are made in the presence of the opposing party, and the test data are routinely provided to all parties. *Wagoner v. Barger,* 463 F.2d 1377, 1382, 175 USPQ 85, 88 (CCPA 1972) ("the results of tests made by one party ... without notice to, and in the absence of, the other party ... [are] for that reason alone entitled to little or no weight"); *Congoleum Industries, Inc. v. Armstrong Cork Co.,* 319 F.Supp. 714, 716, 168 USPQ 263, 264 (E.D.Pa.1970) ("the established doctrine that evidence of experiments conducted by an interested party, in the absence of his adversary, is always received with suspicion and given only negligible probative value").

The objectivity of the tester is a fundamental rule not only of evidence but of conscience. The Bureau of Standards enters this arena with the aura of a national laboratory of scientific distinction, untainted by partisan obligation. Yet the record relates that a spokesman of the NBS criticized to the press the machine that the NBS had not yet tested. Petitioner advises that there was submitted by the PTO to the district court the affidavit of an employee of the NBS, criticizing the machine that he had neither seen nor tested. These events support petitioner's argument that the safeguards of inter partes representation should not be denied.

Petitioner also complains that the PTO has not undertaken, or been ordered, to be bound by the findings of the NBS. However, it is not the PTO but the district court that must decide this case under 35 U.S.C. § 145. The court has not abused its discretion by declining to decide in advance how the test results will be treated.

We conclude that the district court exceeded its discretionary authority in departing from standard procedures and safeguards implementing Rule 34, to the extent that fundamental fairness is absent from the tests as authorized. The court presented no reason for barring petitioner from

observing all the tests on his device, or from knowing in advance what tests are to 975*975 be conducted. Such procedures are highly irregular, and taint the evidentiary value of the test results. We have been directed to no instance where they have been condoned.

Therefore, IT IS ORDERED THAT:

The stay of the district court's order of October 2 as modified on October 9 is lifted, and compliance therewith is ordered, subject to the following modifications:

(a) Petitioner is to produce his device for testing at the NBS within fourteen days after notification of this order.

(b) Prior to said production date, the PTO shall request the NBS to design a testing program that tests the utility set forth in the specification but does not require dismantling or destruction of the device; the NBS shall notify the parties of that program before testing begins.

(c) Both parties shall have the right to observe all tests.

(d) Upon issuance of the NBS' test report, copies of which shall be supplied to both parties, petitioner's device shall forthwith be returned to petitioner.

In all other respects the district court's order is affirmed. Attention is directed to the requirement that the tests be completed and the report issued within 30 days after delivery of the device.

763 F.2d 407 (1985)

In re Joseph W. NEWMAN, Petitioner.

Misc. No. 60.

United States Court of Appeals, Federal Circuit.

May 29, 1985.

408*408 John P. Flannery, II, Washington, D.C., for petitioner.

Fred E. McKelvey, Office of the Sol., U.S. Patent and Trademark Office, Arlington, Va., for respondent.

Joseph F. Nakamura and Thomas E. Lynch, U.S. Patent and Trademark Office, Arlington, Va., of counsel.

Before RICH, DAVIS and BALDWIN, Circuit Judges.

ORDER

DAVIS, Circuit Judge.

Joseph W. Newman petitions for a writ of mandamus ordering the United States District Court, District of Columbia, to vacate that part of its order of October 31, 1984 which remanded his patent application to the Patent and Trademark Office (PTO) for expedited consideration. We deny the petition.

BACKGROUND

On August 18, 1980, Newman filed an application for patent on an invention which he claims produces more electrical and other energy than the energy required to operate it. The application was assigned Serial No. 79,474 and was originally entitled "Electrical Energy Generating System Utilizing the Gyroscopic Actions of Electromagnetic Field Particles." The title was amended to "Energy Generation System Having Higher Energy Output than Input." Newman's application was initially rejected by the examiner on August 24, 1981.

Newman deleted and substituted various claims and submitted affidavits on the operability of his device. He also requested that the examiner come and view the device, which offer was refused.

On January 6, 1982, the examiner again rejected Newman's application as based upon a misdescriptive, insufficient and misleading disclosure under the provisions of 35 U.S.C. § 112 (first paragraph). The examiner's rejection was reaffirmed on July 1, 1982.

Newman appealed to the Board of Patent Appeals (Board). He requested that the Board permit him to demonstrate his machine, and that the Board reverse the examiner's decision (1) that he had not sufficiently described the device so that one skilled in the art could make or use it and (2) that his machine did not operate.

The Board found that Newman's disclosures were adequate to enable one skilled in the art to make or use the device, but ultimately rejected the application because it found the asserted function of his device was "impossible."

On January 3, 1984, Newman sued the Commissioner of Patents and Trademarks (Commissioner) in federal district court for the District of Columbia pursuant to 35 409*409 U.S.C. § 145 seeking *de novo* review of his application.

Following discovery, both parties moved for summary judgment. The district court appointed a special master, citing the substantial and contradictory submissions of record and the complicated issues of scientific and technical fact.

Newman's objections to appointment of a special master were overruled and the court appointed William Schuyler, a former Commissioner of Patents and Trademarks.

On September 28, 1984 the master filed his report, recommending, *inter alia,* a finding that the Board's rejection based on impossibility was clearly erroneous and a conclusion that Newman was entitled to a patent.

Both parties filed objections to the master's report and the Commissioner moved for an order rejecting the report. On October 31, 1984, the district court entered an order which (a) accepted in part the master's report; (b) remanded Newman's application to the Patent Office for expedited reconsideration, in light of the master's recommended finding and conclusion, before a different examiner; (c) directed the Commissioner to consider a requested amendment to Newman's application; (d) denied the Commissioner's motion for summary judgment without prejudice; (e) held Newman's cross motion in abeyance; (f) suspended proceedings in district court for 90 days; (g) scheduled a status conference for January 31, 1985; and (h) ordered Newman to pay the fees of the special master. Newman's motion to reconsider that part of the order remanding his application was denied on December 6, 1984.

On November 30, 1984, a new examiner rejected Newman's claims for: insufficiency of disclosure under 35 U.S.C. § 112(1); indefinitiveness under 35 U.S.C. § 112(2); inoperativeness under 35 U.S.C. § 101, and as unpatentable over the prior art, 35 U.S.C. §§ 102 and 103. The examiner also required that Newman construct working models and submit them to the National Bureau of Standards (NBS) for testing. In requesting the models, the new examiner indicated that Newman's previous models had been tested by individuals interested in the device, and that tests by disinterested parties were required.

At a January 31, 1985 status conference, Newman advised the district court that he would not comply with the requirement to submit a model to NBS for testing, and moved that the district court either accept or reject the report of the special master. Newman also moved for a ruling on his motion for summary judgment. Newman's motions were denied.

On February 28, 1985, Newman filed in the PTO a *pro se* response to the examiner's action strenuously contesting the conclusion that previous models had been tested by interested parties. He challenged the PTO's jurisdiction to order tests by NBS and contended that the requirement at this time constituted an abuse of discretion. On March 11, 1985, the PTO advised Newman that his response was non-responsive to its action of November 30, 1984. The PTO set May 30, 1985 as the date on which Newman must either submit the models or have his application considered abandoned.

At a March 14, 1985 status conference, the district court again held Newman's summary judgment motion in abeyance because there was a genuine issue of fact on whether Newman's machine was operable, an issue that might be resolved by the demonstration required by the PTO. The court further indicated that if Newman failed to make the requested demonstration, it would draw such inferences as would be permissible.

Newman moved for certification to this court of the propriety of its remand to the PTO, which motion the district court denied. The court set June 11, 1985 for a further status conference and final determination of pending motions, and Newman filed the present petition for writ of mandamus in this court.

DISCUSSION

Writs of mandamus are to be used only in extraordinary circumstances 410*410 and when no meaningful alternatives are available. *Kerr v. United States District Court,* 426 U.S. 394, 403, 96 S.Ct. 2119, 2124, 48 L.Ed.2d 725 (1976). This court has the authority to issue the requested writ under the All Writs Act, 28 U.S.C. § 1651(a) (1976), where "necessary or appropriate in aid of" our jurisdiction. *Mississippi Chemical Corp. v. Swift Agricultural Chemicals Corp.,* 717 F.2d 1374, 219 USPQ 577 (Fed.Cir.1983). Under 28 U.S.C. § 1295(a)(4)(C), we have exclusive jurisdiction of an appeal from a decision of a district court in a case filed pursuant to 35 U.S.C. § 145.

The writ is not restricted to instances in which failure to issue it would preclude an appeal to the issuing court. *In re Mark Industries,* 751 F.2d 1219, 224 USPQ 521 (Fed.Cir.1984). Mandamus may be employed in exceptional circumstances to correct a "clear abuse of discretion or `usurpation of judicial power'" by the trial court. *Banker's Life & Casualty Co. v. Holland,* 346 U.S. 379, 382, 74 S.Ct. 145, 147, 98 L.Ed. 106 (1953) (quoting *De Beer Consolidated Mines v. United States,* 325 U.S. 212, 217, 65 S.Ct. 1130, 1132, 89 L.Ed. 1566 (1945).

Before this court Newman contends that in remanding his application to the PTO for reconsideration, the district court has denied him the right to have an Article III court adjudicate his claims. The argument is without merit. The district court has set June 11, 1985 for a status conference and has indicated that it now expects to determine the motions pending before it at that time. Thus, Newman will not be deprived an adjudication of his claims by an Article III court. Any appeal from that court's final decision whenever it occurs, will lie in this court, another Article III court, and the writ is therefore not required in aid of this court's jurisdiction.

Newman further urges that the PTO's threat to treat his application as abandoned if he fails to submit models by May 30th will frustrate this court's appellate jurisdiction, citing *Margolis v. Banner,* 599 F.2d 435, 202 USPQ 365 (CCPA 1979).

In *Banner,* our predecessor court issued a writ of mandamus requiring the Commissioner to vacate a ruling of abandonment because the effect of that ruling would have been to preclude an appeal to the PTO's Board of Appeals and ultimately an appeal to the Court of Customs and Patent Appeals.

In the case at bar, however, Newman has pending in district court a § 145 action from which an appeal to this court will lie, whether the PTO does or does not treat his application as abandoned. Thus, the PTO's threat does not require issuance of the writ to aid or preserve our prospective appellate jurisdiction, (or the jurisdiction of the district court). *In re Makari,* 708 F.2d 709, 218 USPQ 193 (Fed.Cir.1983).

Newman has not demonstrated that the district court's remand of his application to the PTO constituted a clear abuse of discretion or usurpation of judicial power such as would warrant issuance of the extraordinary remedy requested. That matter can be considered, if appropriate or necessary, on appeal from the district court to this court.

Accordingly, it is ORDERED:

(1) Petitioner's request for oral argument is denied.

(2) The petition for mandamus is denied.

(3) The petition for hearing of the petition *in banc* is denied, no active judge of this court having asked for a vote whether that petition should be considered *in banc.*