

## Patenting Cold Fusion Inventions before the US Patent and Trademark Office

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The United States Patent Office - US PTO has developed a reputation for refusing applications directed to "Cold Fusion" technology. Past practices of the US PTO, which will be reviewed based on a published employee grievance hearing, have shown that some staff members have been hostile to granting patents in this field. However personal exchanges held with the US PTO in the fall of 2012 indicated that the US PTO *will issue* properly drafted patents which are directed to new technology in the field of Cold Fusion/generation-of-unexplained-excess-energy if accompanied by a proper disclosure and a demonstration that the asserted procedures will work as represented.

With the US PTO receiving over one half million applications a year, Examiners do not customarily require applicants to file proof that their alleged invention will work as represented. However, the US PTO has classified Cold Fusion and LENR technology in the same category as "perpetual motion". These are considered to be cases where there is doubt that the alleged invention will work. In these fields Examiners are expected to require applicants to demonstrate that the alleged invention actually works. To impose this requirement the Examiner must establish a basis for a legitimate doubt in a communication to the applicant before requiring applicants to provide proof of operability. Unfortunately, Examiners faced with Cold Fusion applications have in many instances used excessively negative and inflammatory language regarding the history of Cold Fusion science in attempting to place such a doubt on record.

Persons filing patent applications in this field have to be prepared to face a prove-it-works requirement. They do not have to prove that Cold Fusion works *per se*; they only have to prove that what they represent in their application is true. The disclosure accompanying their patent application must be sufficient to enable ordinary but knowledgeable workers in the field to reproduce what is promised in the patent application. This is not an area where a patent can be obtained on the basis of a prediction or prophetic insight.

The best procedure to follow in answering such a requirement from a US Examiner is to place the original patent disclosure in the hands of an independent agency that will follow the instructions in that document and report-back, hopefully, that they obtained the results as predicted in the patent filing. Such evidence may not rely on after-developed understandings or procedures but must be based on the original document as filed, together with publicly available knowledge existing as of that date. To address this limitation, applicants are advised to make multiple patent filings every time they develop new information that is important to exploiting the technology.

Before embarking on the considerable expense of filing patent applications, applicants should appreciate that their right to obtain patent protection is seriously constrained by what has already been done before. Under the new patent law in the United States, anything ever made "available to the public" anywhere in the world at any time before an applicant has filed their first patent application will count against that application and limit the scope of potential exclusive rights. Additionally, even if a patent is obtained, it may have to be limited to a novel feature that may not have commercial relevance. Care should therefore be taken to understand patenting procedures before spending unnecessary sums of money that will not prove worthwhile.