

# Patent Office Disbands Warning System; Defenses Still in Place

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Earlier this month, the U.S. Patent and Trademark Office canceled an internal program that had been designed to flag patent applications of questionable subject matter. The Sensitive Application Warning System (SAWS) had existed for many years as a way for the patent office to try to prevent the issuance of patents that were "controversial and noteworthy." Although the program no longer exists, there are still mechanisms in place to prevent such patents from issuing.

The SAWS program had been shrouded in mystery for many years. The program initially was disclosed to the public through an internal patent office memo leaked to the Internet in 2006. When I found the memo early in 2014, I (and almost all patent practitioners) had never heard of the program, but when I contacted the patent office and inquired, I was told that it was still in operation. Toward the end of 2014, a law firm filed a request under the Freedom of Information Act for information about SAWS. The patent office subsequently released a 50-page document with detailed information about the program. Several weeks ago, the office announced that it had reviewed the program, and decided that it should be canceled.

Some of the types of patent applications that were flagged under the SAWS program as being "questionable" covered very unusual subjects. Indeed, a few of those applications describe inventions that violate the laws of physics. Subject matter of those applications includes:

- Perpetual motion machines (machines, typically in science fiction, that produce more energy than they consume).
- Anti-gravity devices.
- Moving faster than the speed of light.

None of the above concepts are possible to achieve (under current scientific knowledge). That, however, has not stopped people from attempting to patent machines that can allegedly perform those functions. Below are some of the very few examples where people have been successful:

- U.S. Patent No. 6,734,574: Buoyancy-driven electric power generator (perpetual motion machine).
- U.S. Patent No. 6,694,844: Apparatus to recover energy through gravitational force (perpetual motion machine).

- U.S. Patent No. 6,362,718: Motionless electromagnetic generator (perpetual motion machine).
- U.S. Patent No. 6,347,766: Method and apparatus for the generation of propulsive forces without the ejection of propellant (a rocket that moves without expelling matter).

It should be remembered that the patent office is an exceptionally large organization processing thousands of patent applications each year. Like any other organization, mistakes occasionally occur. To its credit, the patent office has safety mechanisms to try to minimize errors. Nevertheless, odd situations occasionally occur and unusual patents make their way through the system.

Now that the patent office has decided to discontinue SAWS, what happens when a patent applicant attempts to patent an invention that violates the laws of physics?

The first line of defense is the training that all patent examiners receive. Patent claims that recite impossible inventions are initially rejected under 35 U.S.C. 101, which states: "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any useful improvement thereof may obtain a patent therefor."

Thus, a patent will only be granted for a claimed invention that is "useful." This requirement is based on the U.S. Constitution; Article I, Section 8 authorizes Congress to provide exclusive rights to inventors to promote the "useful arts." In situations when an examiner believes that an applicant is trying to patent an idea that is not credible, the patent application is rejected under 35 U.S.C. 101.

Several years ago, I met a group of patent office examiners who were designated to examine patent applications for perpetual motion machines (which, thankfully, comprised only a very small percentage of their dockets). Those examiners explained to me that not only did they have 35 U.S.C. 101 at their disposal, but they could also require a patent applicant to comply with 37 CFR 1.91 (a rule that patent attorneys almost never see invoked), which states: "A model, working model, or other physical exhibit may be required by the office if deemed necessary for any purpose in examination of the application."

If a patent office examiner believes that a patent application is claiming an invention that violates the laws of physics, then he or she can require the applicant to provide a working model of the invention that the applicant is trying to patent. Examiners can meet with the applicant and observe the operation of the model. If the examiners are uncertain as to how the model is able to operate, then significant scientific analysis of the model can be conducted. For example, in past situations, the National Institute of Standards and Technology (previously known as the National Bureau of Standards) was used to examine patent application models of questionable credibility.

An applicant twice rejected before a patent office examiner can appeal to the Patent Trial and Appeal Board. If the board is unconvinced of the patentability of an invention,

then 35 U.S.C. 145 provides for further review in the federal courts. Probably the most well-known case involving a perpetual motion machine is *In re Newman*, 782 F. 2d 971 (Fed. Cir. 1986). Joseph W. Newman's patent application for a perpetual motion machine was rejected by the patent office. Newman then filed a civil action in the U.S. District Court for the District of Columbia. The district court appointed a special master who (remarkably) found the invention to be patentable. The patent office criticized the special master's findings, and the court remanded the application to the patent office for a new examination. After the patent office issued further rejections, the commissioner required Newman to deliver a model of his invention to the National Bureau of Standards (NBS) for testing. NBS tested the model, and determined that the invention was not a perpetual motion machine. Newman's patent was never issued.

A few other cases have also examined the issue of perpetual motion machines. *Ex parte Payne*, 108 Off. Gaz. Pat. Office 1049 (1903), held that an examiner may reject a patent claim for a perpetual motion machine based on inoperativeness; no prior art need be cited. In *Application of Chilowsky*, 229 F. 2d 457 (C.C.P.A.1956), the court said that when operativeness "seems clearly to conflict with a recognized scientific principle, as, for example, where an applicant purports to have discovered a machine producing perpetual motion, the presumption of inoperativeness is so strong that very clear evidence is required to overcome it."

Although SAWS has been dismantled, other mechanisms exist within the patent office to identify questionable patent applications. The systems evidently work; virtually no patents have been issued that violate the laws of physics. Even if one such patent were to be granted in the future, such a patent would not survive a challenge in court. For now, at least, perpetual motion machines will need to remain delegated to the realm of science fiction.

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