

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte GIORGIO PAGANI  
and UMBERTO ZARDI

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Appeal No. 95-2535  
Application 07/987,127<sup>1</sup>

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HEARD: JUNE 8, 1998

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Before WINTERS, GRON and WEIMAR, Administrative Patent Judges.  
WEIMAR, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the examiner's decision finally  
rejecting claims 9-14. Pending claims 15-18 were withdrawn

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<sup>1</sup> Application for patent filed December 8, 1992.

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from consideration in Paper No. 7, the Final Rejection.<sup>2</sup>  
Appealed claim 9 was amended by appellants in Paper No. 14, filed on July 14, 1994. This amendment was entered, as indicated in Paper #19. An additional amendment to claim 9 was proposed by appellants as an attachment to Paper No. 18, a Reply Brief, received December 2, 1994. As indicated in Paper No. 19, a letter from the examiner mailed December 15, 1994, neither the Reply Brief nor the attached amendment has been entered.

Claim 9, as amended on July 14, 1994, is illustrative of the subject matter of the claims on appeal and reads as follows:

9. A method of revamping a pre-existing urea production plant having a first urea synthesis reactor in fluid communication with an ammonia stripping section for separating free ammonia and carbamate from an aqueous urea solution discharged from said first reactor, said method comprising the steps of:

a) providing, upstream of said ammonia stripping section, a second urea synthesis reactor of the once-through type having a higher efficiency yield than said first urea

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<sup>2</sup> We note that a Divisional Application 08/458,123 was filed on June 2, 1995, presenting claims to a urea plant. This application issued on August 26, 1997, as U.S. Patent No. 5,660,801 with claims very similar to pending claims 15-18. Upon further prosecution, we presume claims 15-18 will be canceled from this application.

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synthesis reactor;

b) distributing an overall production capacity that exceeds that of said pre-existing plant to apportion from 60 to 95% of said overall capacity to said first urea synthesis reactor and from 5 to 40% of said capacity to said second urea synthesis reactor.

The reference relied upon by the examiner is:

Pagani  
(European Patent Application)      0 479 103      Apr. 8,  
1992

Claims 9-14 stand rejected under 35 U.S.C. § 103 in view of the teachings of Pagani.

We vacate the examiner's rejections with respect to claims 9-14, and enter new grounds of rejection with respect to these claims under the provisions of 37 CFR § 1.196(b).

#### BACKGROUND

The invention involves urea production on an industrial scale and the upgrading of a pre-existing urea synthesis plant. As disclosed in the specification on page 2, in the last paragraph, the resultant urea production scheme includes an ammonia stripping step following urea synthesis. As indicated on pages 2 and 3 of the specification, the invention

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is a variation on a process described in Pagani. In this specification Pagani is referred to as European Patent Application No. 91116297.2. The application was published as Publication No. 0479103 on April 8, 1992 and constitutes the single reference applied by the examiner.

#### Discussion

Having considered the entire record in this appeal, we have determined that the claims presented are indefinite under 35 U.S.C. § 112, second paragraph. Accordingly, we institute a new ground of rejection of claims 9-14 under this statute infra. Since the metes and bounds of claims 9-14 cannot be readily ascertained, consideration of the issues raised with respect to obviousness under 35 U.S.C. § 103 would be premature with respect to these claims. See In re Geerdes, 491 F.2d 1260, 1262, 180 USPQ 789, 791 (CCPA 1974)(Before considering rejections under 35 U.S.C. 103 and 112, we must first decide the scope of the claims.); In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971)(One is not in position to determine whether a claim is enabled under the

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first paragraph of 35 U.S.C. § 112 until the metes and bounds of that claim are determined under the second paragraph of this section of the statute.); and, In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962)(Analyzing claims based on "speculation as to meaning of the terms employed and assumptions as to the scope of such claims" is legal error.).

New Ground of Rejection Under 37 CFR § 1.196(b)

Claims 9-14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as their invention.

The preamble of claim 9 reads, "a method of revamping a pre-existing urea production plant . . . comprising the steps of." Subsequent to the preamble, claim 9 recites two process steps

a) and b), which read:

a) providing, upstream of said ammonia stripping section, a second urea synthesis reactor of the once-through type

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having a higher efficiency yield than said first urea synthesis reactor;

b) distributing an overall production capacity that exceeds that of said pre-existing plant to apportion from 60 to 95% of said overall capacity to said first urea synthesis reactor and from 5 to 40% of said capacity to said second urea synthesis reactor.

The manipulative step recited in a) of claim 9 is "providing . . . a second urea synthesis reactor", which is consistent with the preamble indication that the claim is drawn to a method of "revamping an existing urea production plant." This part of the claim includes a construction step that results in a modified urea plant.

The manipulative step recited in b) of claim 9 is "distributing an overall production capacity" between the "first urea synthesis reactor", i.e., the pre-existing reactor, and the "second urea synthesis reactor", i.e., the reactor added in step a) of claim 9. The step of "distributing capacity" presumes that reactants are being distributed between and transported to the two reactors. Thus, step b) presumes that urea is being synthesized and the plant is operating. Step b) appears to be inconsistent with the preamble. If the plant is operating, then a method of

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producing urea is being claimed, not a method of re-constructing an existing production plant.

Claims 10-14 are all dependent upon claim 9 and are similarly confusing and indefinite. Claims 10, 11, 12 and 14 each modify claim 9 by adding a "wherein" clause which reads "wherein urea synthesis . . . is carried out . . . ." Claim 13 is dependent on claim 12. These dependent claims do not further limit a method of "revamping a pre-existing urea production plant," rather they limit a method of producing urea.

This panel is unable to ascertain whether the claims are drawn to a method of making urea, or to a method of modifying a production plant. Given this ambiguity, this panel cannot determine whether method step b) further limits the subject matter claimed if the method is merely one of revamping a pre-existing plant by providing a second reactor.

Consequently, we vacate the examiner's rejection of claims 9-14 under 35 U.S.C. § 103. In doing so, we emphasize that we have not decided and cannot decide the merits of the issues raised by the examiner. If prosecution is continued on this subject matter, and claims are presented which satisfy

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the requirements of 35 U.S.C. § 112, second paragraph, the examiner should again compare the scope of the claimed subject matter to the subject matter described and/or reasonably suggested by the prior art.

#### Conclusion

We vacate the rejection of claims 9-14 under 35 U.S.C. § 103.

We newly reject claims 9-14 under 35 U.S.C. § 112, second paragraph, in accordance with 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR

§ 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings

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(§ 1.197(c)) as

to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

VACATED; 37 CFR § 1.196(b)

	SHERMAN D. WINTERS	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	
	TEDDY S. GRON	)	BOARD OF
PATENT	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
		)	
	ELIZABETH C. WEIMAR	)	
	Administrative Patent Judge	)	

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