

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte TAKASHI ETOH and MAMORU TAKAHASHI

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Appeal No. 2003-1060  
Application No. 09/101,695<sup>1</sup>

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ON BRIEF

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Before SCHEINER, ADAMS and GREEN, Administrative Patent Judges.

SCHEINER, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 2-7 and 15, the only claims remaining in the application.

Claim 15 is representative:

15. A method for assaying ammonia and/or ammonium ions in a liquid sample, said method comprising:

a) performing a main reaction comprising incubating said sample with NAD synthetase, ATP, desamido-NAD and at least one of Mg<sup>2+</sup> and Mn<sup>2+</sup> ions, thereby to generate oxidized NAD;

b) converting said oxidized NAD to reduced NAD in a secondary reaction system comprising an amine substrate and a dehydrogenase that catalyzes a reaction (i) generating ammonia molecules from said amine substrate and (ii) generating said reduced NAD from said oxidized NAD;

wherein said ammonia molecules generated in step b) then participate in continuing said main reaction of step a), thereby to effect cycling of ammonia molecules

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<sup>1</sup> Application for patent filed September 17, 1998.

from step b) to step a); and

c) determining ammonia and/or ammonium ion content of said liquid sample from an amount of a component generated or consumed by said secondary reaction system.

No references are relied on by the examiner, and the sole issue for our review is the propriety of the examiner's rejection of claims 2-7 and 15 under the second paragraph of 35 U.S.C. § 112 as indefinite.

We reverse.

### DISCUSSION

In view of its brevity, we reproduce the examiner's rejection in its entirety (Answer, page 4):

In claim 15(a) "incubating" is queried and reacting may be intended. Further, claim 15 is directed to assaying ammonia but no such steps to perform that function are found. Standard assay steps may include contacting or reacting, determining and correlating. Newly amending claim 15(c) is indefinite regarding what component is determined to determine ammonia. Claim 5 should begin with a capitalized letter.

"[T]he definiteness of the language employed [in a claim] must be analyzed - - not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art." In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

Having reviewed the claims in light of the specification, we are in complete agreement with appellants that "[w]hen each of the [e]xaminer's criticisms as to the wording of the claims is scrutinized, it is apparent that none merits affirming the rejection of the claims for indefiniteness" (Brief, page 5).

Appellants' reasoning is set forth on pages 5-9 of the Brief, and pages 1-3 of the Reply Brief. We adopt appellant's position as our own (with the exception of appellants'

comments regarding the inappropriateness of “criticiz[ing] the use of [a] term . . . in light of the same term having been used in the same context in the claims of an issued U.S. patent”) and find it unnecessary to burden the record by reiterating that position here.

The rejection is reversed.

REVERSED

	)	
Toni R. Scheiner	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
	)	
Donald E. Adams	)	APPEALS AND
Administrative Patent Judge	)	
	)	INTERFERENCES
	)	
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	)	
Lora M. Green	)	
Administrative Patent Judge	)	

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