

The opinion in support of the decision being entered today is not binding precedent of the Board.

BHS

Paper 27

Filed by: Michael P. Tierney  
Administrative Patent Judge  
Box Interference  
Washington, D.C. 20231  
Tel: 703-308-9797  
Fax: 703-305-0942

Filed  
26 August 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

ROGER L. DAY  
Junior Party  
(U.S. Application 08/741,456),

v.

DAVID A. LARSEN  
Senior Party,  
(U.S. Patents 5,716,419 & 6,042,622).

**FAXED**

**AUG 26 2002**

**PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Patent Interference No. 104,805

Before: GARDNER-LANE, MEDLEY and TIERNEY, Administrative Patent Judges.

TIERNEY, Administrative Patent Judge.

**JUDGMENT**

The involved Larsen patents have been assigned to White River Nahcolite Materials, LLC, the assignee of the involved Day application. As discussed in Paper No. 23, dated June 25, 2002, the Board will not normally maintain an interference where the involved application(s) and patent(s) are commonly assigned. See, 37 C.F.R. §1.602(a). In response to an Order to Show Cause, Day and Larsen have confirmed the assignment of the Larsen patents and have attempted

to:

1. Change the inventorship of the involved '622 Larsen patent from Larsen to "Larsen and Day."
2. Convert the involved '456 Day application to a continuation-in-part application of the involved '622 "Larsen and Day" patent.
3. Amend the involved '456 Day "continuation-in-part" application to cancel the involved claims.
4. File an Information Disclosure Statement in the involved '456 Day application.

Additionally, Day has filed Day Preliminary Motion 1 requesting that we designate Day claims 63-70 and newly amended claims 3, 5-9 and 11-13 as not corresponding to Counts 1 or 2. (Day Motion 1, Paper No. 26, p. 2). According to Day, claims 3, 5-9, 11-13 and 63-70 are patentably distinct from the subject matter of Counts 1 or 2 of Larsen's corresponding claims. Specifically, Day argues that the claims are patentably distinct due to their recitation of various limitations on the pH, levels of dissolved sodium carbonate and bicarbonate salts, the amount of lecithin and/or the specific size of the sodium bicarbonate crystals. (Paper No. 26, p. 3).

In support of Day Motion 1, Day has provided a declaration by Robert C. Warneke. Mr. Warneke testifies that he has a degree in Chemical Engineering and has been employed for over twenty years in the mineral processing industry. (Warneke Dec. ¶¶ 2-3). Mr. Warneke testifies that he is specifically familiar with the processes for the recovery of sodium bicarbonate from the Nahcolite and Trona solutions. (Warneke Dec. ¶ 4). Mr. Warneke also testifies that he has:

[A] good working understanding of the literature and industry practices forming public knowledge concerning the recovery of bicarbonates from aqueous solutions, especially, Nahcolite deposits (a representative teaching is found in another of Roger Day's patents U.S. 4,815,790).

(Warneke Dec. ¶ 7). We conclude that Mr. Warneke is qualified to testify as to the expectations and knowledge that one skilled in this art would possess.

Mr. Warneke has testified that:

20. I have canvassed my recollection of the prior art at the time of the Day application, and know of no teaching or suggestion of the invention recited in the Day claims; nor do I know of any report of the unexpected use of the claimed recitations in the recovery of sodium bicarbonate with controlled classification from pregnant Nahcolite solutions;
21. Specifically I am unaware of any prior art that when taken with the '419 or '622 claims, would render obvious to [one of] ordinary skill in the art the invention of the Day claims.

(Warneke Dec., ¶¶ 20-21).

Mr. Warneke's declaration is unchallenged. Based on Mr. Warneke's declarations, we conclude that Day claims 3, 5-9, 11-13 and 63-70 are patentably distinct from the subject matter of Counts 1 or 2 or the undisputed corresponding claims and Larsen. As such, we *grant* Day Motion 1.

As Junior Party Day has cancelled all of the corresponding claims from the involved '456 Day application, we conclude that Junior Party Day has abandoned the contest. 37 C.F.R.

§1.662. Having abandoned the contest, we terminate this interference and remand the involved '456 Day application to the examiner for further consideration.

The examiner shall review the papers listed above, and if deficient, provide sufficient notice to Day as to the specific deficiencies. Moreover, the examiner shall review the

amendment filed by Day and examine the claims as if the amendment was filed in response to a non-final office action, i.e., the examiner may reject or allow the claims as he/she sees fit.

Moreover, our determination that Day claims 3, 5-9, 11-13 and 63-70 do not correspond to Counts 1 and 2 is based, in part, on Mr. Warneke's declaration that he is unaware of any prior art that when taken with the '419 or '622 claims, would render these claims obvious. As such, should the examiner become aware of art that, when taken in combination with the claims of the '419 or '622 claims, renders Day's claims 3, 5-9, 11-13 and 63-70 obvious, the examiner may reject Day's claims.

**It is:**

**ORDERED** that the interference is terminated.

**FURTHER ORDERED** that priority of invention as to Counts 1 and 2 is awarded against Junior Party Day, U.S. Application No. 08/741,456.

**FURTHER ORDERED** Junior Party Day, U.S. Application No. 08/741,456 is not entitled to a patent containing claims 1-2, 4, 10, 14, 25-62 and unamended claims 3, 5-9 and 11-13 (See Paper No. 5), which correspond to Count 1 and Count 2.

**FURTHER ORDERED** that U.S. Application No. 08/741,456 be returned to the jurisdiction of the examiner for consideration of the: 1) conversion of the application to a continuation-in-part; 2) the Amendment under 37 C.F.R. §1.116; and 3) the Information Disclosure Statement.

**FURTHER ORDERED** that U.S. Patent No. 6,042,622 be returned to Group 1700 for consideration of the change of inventorship from Larsen to Larsen and Day.

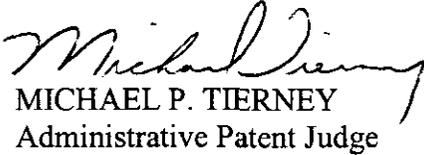
**FURTHER ORDERED** Day Motion No. 1 for a designation that claims 63-70 and newly dependent claims 3, 5-9 and 11-13 do not correspond to Counts 1 or 2 is *granted*.



SALLY GARDNER-LANE )  
Administrative Patent Judge )



SALLY C. MEDLEY )  
Administrative Patent Judge )



MICHAEL P. TIERNEY )  
Administrative Patent Judge )

BOARD OF PATENT  
APPEALS  
AND  
INTERFERENCES

cc: (Via Facsimile)

Counsel for DAY:

Frank S. DiGiglio, Esq.  
Peter I. Bernstein, Esq.  
SCULLY, SCOTT, MURPHY & PRESSER  
400 Garden City Plaza  
Garden City, NY 11530

Tel: (516) 742-4343  
Fax: (516) 742-4366