

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ROBERT A. PARROTT

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Appeal No. 96-3355  
Application 08/004,024<sup>1</sup>

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ON BRIEF

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Before HAIRSTON, JERRY SMITH, and BARRETT, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

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<sup>1</sup> Application for patent filed January 15, 1993.

Appeal No. 96-3355  
Application 08/004,024

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-4 and 10-18. Claims 6-9 have been cancelled. Claims 5 and 19 have been indicated as containing allowable subject matter.

The disclosed invention pertains to a method for securing the outer case of a shaped charge to the loading tube of a perforating gun. Specifically, the case of the charge and the loading tube are designed so that the charge can be secured to the tube by simply inserting the case into a hole of the tube and twisting the case a predetermined distance.

Representative claim 1 is reproduced as follows:

1. A method of securing a case of a shaped charge to a loading tube of a perforating gun, comprising:

inserting said case of said shaped charge into a hole disposed through a wall of said loading tube; and

twisting said case a predetermined distance.

The examiner relies on the following reference:

Regalbuto                      4,681,037                      July 21, 1987

Claims 1-4 and 10-18 were finally rejected under 35 U.S.C. § 102(b) as anticipated by Regalbuto, or in the alternative, under 35 U.S.C. § 103 as obvious over Regalbuto.

Appeal No. 96-3355  
Application 08/004,024

The examiner's answer only repeats the rejection under § 103 so it is presumed that the rejection under § 102 has been withdrawn.

Rather than repeat the arguments of appellant or the examiner, we make reference to the brief and the answer for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-4 and 10-18. Accordingly, we reverse.

Appeal No. 96-3355  
Application 08/004,024

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Sys., Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Appeal No. 96-3355  
Application 08/004,024

With respect to independent claims 1, 10 and 15, the answer incorporates the rejection from the final rejection [Paper # 8]. The examiner asserts that flanges 52 and 54 shown in figure 3 of Regalbuto are part of the charge casing. It is apparently the examiner's view that these flanges are inserted into the openings of Regalbuto's strip and twisted to be secured therein. Appellant argues that the flanges 52 and 54 are not part of the charge case 60, but rather, are part of the loading strip and, therefore, are not inserted into the openings of the strip [brief, pages 7-8].

Appellant is clearly correct on this point. Figure 3 of Regalbuto is a cross-sectional view of figure 1 taken along line 3-3 of figure 1. Figure 1 shows both the charge cases and the loading strip and the manner in which the charge cases are attached to the strip. Regalbuto clearly discloses that flanges 52 and 54 extend from opposite sides of strip portion 50 [column 3, lines 32-34]. Thus, the flanges 52 and 54 clearly are not part of the charge case 60. This being the case, the examiner's view that these flanges are inserted into the loading strip and twisted is clearly erroneous. In fact, there is no disclosure anywhere in Regalbuto that the charge cases are

Appeal No. 96-3355  
Application 08/004,024

twisted after being inserted into the openings of the loading strip.

In the answer, the examiner may have recognized the futility of his previous position because he presents a new fallback position for unpatentability. Specifically, the examiner relies on the fact that Regalbuto's use of four tabs in each strip opening permits the elimination of the threaded type outer surface on the charge case used in the prior art [column 5, lines 35-39]. The examiner concludes that this reference to threads on the prior art charge case suggests that the charge case was inserted and then twisted in the claimed manner. There is no evidence on this record that the examiner ever actually considered the application cited in Regalbuto as prior art.

The Regalbuto patent relied on by the examiner makes reference to an earlier application identified as Serial Number 651,201 filed on September 17, 1984. This application issued as U. S. Patent Number 4,655,138 ('138) (a copy of which is attached). This patent shows the threaded charge case which is referred to in the applied Regalbuto patent. A careful review of the '138 patent reveals no twisting of the charge case due to the presence of the threads. The two tabs of the charge opening are simply bent back when the charge case is inserted and the tabs

Appeal No. 96-3355  
Application 08/004,024

anchor themselves into one of the threaded grooves. There is not the slightest hint in the '138 patent that a charge case should be twisted after it is inserted into the opening.

Since the examiner relies on the Regalbuto suggestion of a threaded charge case to conclude that the step of twisting would have been obvious, and since the prior art cited by Regalbuto does not use the threaded charge case for twisting, we find that the record in this case does not support the position staked out by the examiner. The examiner has clearly misread the references in an attempt to find the claimed invention unpatentable. Although we cannot say if there is prior art which would have suggested the obviousness of the claimed invention on appeal, we can say that such obviousness is not demonstrated by the prior art cited by the examiner.

Therefore, we do not sustain the examiner's rejection of independent claims 1, 10 and 15. It follows that the rejection of dependent claims 2-4, 11-14 and 16-18 is also improper. Thus, the decision of the examiner rejecting claims 1-4 and 10-18 is reversed.

REVERSED



Appeal No. 96-3355  
Application 08/004,024

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