IN THE UNITED STATES PATENT OFFICE

Dec 1944

In Re Application of,
WILLIAM F. FRIEDMAN
Serial No. 682,096
Filed July 25, 1933
Title: CRYPTOGRAPHIC SYSTEM

Div. 53
Room 6897

R E S P O N S E

In response to the Official Letter of 31 January 1942 the applicant desires that reconsideration be given to the rejection of the method claims on the ground that they are improper in form.

Decisions cited:

In re Ernst (CCPA) 71 Fed (2d) 169,
Carnegie Steel Co. v Cambria Iron Works 185 US 403, 424
Hall v Montgomery Ward and Co. 63 USPQ 114, 122.

The Examiner evidently objects particularly to the introductory clause of the method claim on the ground it sets forth the structure at some length on which the method is performed.

The Patent Office Board of Appeals had occasion to pass on that situation, and the method claim quoted in the last cited case recites an igniter and burner and the type of igniter on which the method is performed. The claim quoted by the court is said in the decision to have been allowed by the Board of Appeals.

The examiner cites Cochrane v Deener, 94 U.S. 780. However, the Court of Customs and Patent Appeals has had occasion to mention that this decision is not to be construed literally; See In re Ernst (CCPA) 71 Fed (2d) 169:

> "Insofar as the language quoted (from Cochrane v Deener) implies that a valid method claim relate to a treatment of some material, we are not in accord therewith. While the decision in the case of Cochrane v Deener, 94 U.S. 780, 24 L. Ed. 139, may seem to support such a holding, later decisions of the Supreme Court are not so limited."

Decisions of the Court of Customs and Patent Appeals are controlling so far as the Patent Office is concerned, and implications in other decisions that "materials" must be acted upon before there is a valid process cannot prevail.

In Carnegie Steel Co v Cambria Iron Works, supra, the Supreme Court approved of process claims and made the notation that a process could not be anticipated by structure merely capable of practicing the process. However, it was mentioned that some processes could be carried out merely with a pair of human hands. Such a process must be in the nature of the intangible such as signaling, ciphering a message, taking aim, etc., if it can be performed merely with human hands alone.

The rejection for undue multiplicity has apparently been abandoned but if not it is traversed for the reasons of record.

Claim 40 was rejected on the ground the amendment did not set forth the reasons supporting allowance of the claim.

The argument did state, however, that claim 40 was submitted as patentable for the same reasons as the many other allowed apparatus claims. This was sufficient, see Ex parte Beard, 178 O.G. 319. It is clear that the prior

art does not include all of the apparatus of this claim, particularly the combination of the wheels and keyboard arranged to cipher which are disposed as to uncipher a message repeated back.

Claim 40 is retained in the case which is and will continue to be prosecuted under the three-year rule.

Respectfully submitted,

W.D.H.

William D. Hall,
Attorney for Applicant.