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PAPER No. 27

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this application should give the
serial number, date of filing,
and name of the applicant.Please find below a communication from the EXAMINER
in charge of this application.*John A. Marshall*Henry B. Stauffer
Army Security Agency
The Pentagon Bldg.
Washington 25, D.C.

GPO 16-27315-2

Commissioner of Patents.

Division 3 - Room 3624

Applicant: William F. Friedman
et al

Ser. No.

70,412

March 23, 1936

CRYPTOGRAPHY

Filed

For

JAN 18 1950

Responsive to amendment filed Oct. 11, 1948.

The drawing and the first six lines on page 10 of the specification are not clear as to the operation of the apparatus described. Applicants have cancelled lines 6 to 10, but the disclosure should be complete as to how the commutators upon rotation close contacts 32 and 34. According to the circuit as now shown, contact 32 after it is once closed appears to operate commutator 7 every time a key is depressed to move bar 44.

With regard to page 11, the specification should clearly set out the structural relationship whereby the depression of the "A" key bar will also cause bar 44 to move.

On Figure 3 of the drawing, end plate 301 should show connections to the outer ring of contacts, or at least make clear the connections in a manner similar to that shown in Figure 1. This same criticism applies also to Figures 5 and 7.

The insertion in line 2 of claim 40 is improper, since the words "electrical paths" already occur there.

Serial No. 70,412

- 2 -

In order to avoid ambiguity, each dependent claim should include the number of the claim from which it depends. For instance, numeral - 13 - should appear after "claim" in line 1 of claim 14. Note also claim 20.

Claims 34, 35, 41 to 44 are again rejected as being drawn to unpatentable methods.

In the first place these method claims are unstatutory. They do not recite subject matter that may be patented. Methods of coding and decoding messages have been held to be unpatentable in *Berardini v. Tocchi* 190 Fed. 329. Furthermore, the method steps involved are simply the functions of the apparatus disclosed and applicants have not shown how the method can be performed in any manner other than with the apparatus that is recited in the article claims. This view is well supported by *In re Ernst* 71 Fed. (2) 169, and *In re Nichols* 80 USPQ 143.

In the second place, the method claims set out no process that presents any patentable distinction over the patents to Korn. These two patents clearly show a method of ciphering which involves the controlling of variable paths through a cryptographic maze by introducing further successive signals to the maze and using the output. The method steps recited would not be patentable whether done electrically or by hand. If a certain type of apparatus is essential to the method, then method claims are not patentable because a method type of claim cannot depend on structure or apparatus for patentability. There is no limit to the number of times any plain message may be coded and

Serial No. 70,412

- 3 -

further coded and decoded. If certain apparatus is used to perform these steps, then the invention is in the apparatus.

Claims 14 and 20 would be allowable if amended.

Claims 1 to 13, 15 to 19, 21 to 33, 36 to 40 appear allowable.

Claims 34, 35 and 41 to 44 stand rejected.

The above rejection is made FINAL.

Examiner

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