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[Ruggiero 236
08/06/75 602,463
James R. Dierh II, et al]

Paper No. 3

▼ Robert E. Wickersham
Owen, Wickersham, et al
433 Calif. St., 11th Floor
San Francisco, Calif. 94104

Mailed

12878

This is a communication from the Examiner in
charge of your application.

Commissioner of Patents
and Trademarks

☒ This application has been examined.

☐ Responsive to communication filed _____

☐ This action is made final.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE

3 MONTH(S) _____ DAYS FROM THE DATE OF THIS LETTER.

PART I

The following attachment(s) are part of this action:

a. ☒ Notice of References Cited, Form PTO-892.

b. ☐ Notice of Informal Patent Drawing, PTO-948.

c. ☐ Notice of Informal Patent Application,
Form PTO-152.

d. ☐

PART II

Summary of Action

1. ☒ Claims 1-10 are presented for examination.

2. ☐ Claims _____ are allowed.

3. ☐ Claims _____ would be allowable if amended as indicated.

4. ☒ Claims 1-10 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ Claims _____ are withdrawn from consideration.

8. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 OG. 213

9. ☐ Since it appears that a discussion with applicant's representative may result in agreements whereby the application may be placed in condition for allowance, the examiner will telephone the representative within about 2 weeks from the date of this letter.

10. ☐ Receipt is acknowledged of papers under 35 USC 119, which papers have been placed of record in the file.

11. ☐ Applicant's claim for priority based on an application filed in _____ on _____ is acknowledged. It is noted, however, that a certified copy as required by 35 USC 119 has not been received.

12. ☐ Other

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1. This application has been examined and this action is responsive to applicant's preliminary amendment filed along with the application.

2. The specification is objected to as containing insufficient disclosure under 35 USC 112. The instant invention is disclosed and claimed to be one involving a general purpose digital computer properly programmed to calculate the correct cure time for a rubber-molding press and to open such press accordingly. A general purpose computer by itself would be incapable of carrying out any operation until its sequence of internal interconnections has been added thereto by the preparation and loading of a program into the internal memory of the computer. The instant disclosure does not identify any program which will cause the computer to carry out the necessary functions. Although applicants have provided a flow chart, it is noted that such flow chart is not a program and only suggests operations from the point of view of desired results.

3. Claims 1-10 are now in this case.

4. Claims 1-10 are rejected as being drawn to insufficient disclosure as discussed in paragraph 2, above.

5. Claims 1-10 are further rejected under 35 USC 101 as being drawn to non-statutory subject matter. Claims 1-6 recite a series of steps for operating a rubber molding press in conjunction with a digital computer. A close inspection of the claims reveals that all of the claimed method steps involve either the inputting^{of} data to the computer, the operation of the computer on such data, and the provision of an output signal by the computer in response to such operation. All of these steps are carried out by the computer under control of a stored program. New claims 7-10 recite the additional "physical"

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steps of installing rubber in the press and the subsequent closing of the press; however, these steps are conventional and necessary to the process and cannot be the basis of patentability. It remains the Examiner's position therefore, that applicants' claims define and seek protection on a computer program for operating a rubber molding press. Such has been held to be non-statutory subject matter by the Supreme Court in *Gottschalk v. Benson*, 175 USPQ 673.

6. Applicants' arguments have been considered but are not convincing to overcome the above rejections. In parent application S. N. 472,595, applicants submitted a Rule 132 affidavit which detailed a factory installation of the invention involving 60 presses and concluded that the time required to achieve production would be 7 months. In response to the Examiner's position that such a time span for implementation of the invention was outside the bounds of "undue experimentation", the applicants have filed an additional Rule 132 affidavit. This affidavit includes an estimate of a 6 man week time span for implementation of the invention if only a single press were involved. However, it must be pointed out that such an estimate is merely an opinion and few if any facts have been presented to support such a conclusion. The Examiner remains of the position that such evidence is not sufficient to overcome the rejection on insufficient disclosure.

7. Patents A-E are cited of interest but are not applied against the claims.

Ruggiero/dmcb
557-2871
12/2/75

Joseph E. Ruggiero
JOSEPH E. RUGGIERO
EXAMINER
GROUP ART UNIT 236

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FORM PO-892 (REV. 4-74)		U.S. DEPARTMENT OF COMMERCE PATENT OFFICE		GROUP ART UNIT		ATTACHMENT TO PAPER NUMBER			
NOTICE OF REFERENCES CITED				472,595		236			
<input type="checkbox"/> Check here if this is a supplemental citation. (Do not prepare an additional folder.)				APPLICANT(S) J. R. DIEHR ET AL					
U.S. PATENTS									
*		PATENT NO.		DATE	PATENTEE	CLASS	SUB- CLASS	FILING DATE IF APPROPRIATE	
A		3659974	5-1972	NEUGROSCHL	264	40	X		
B		3718721	2-1973	GOULD ET AL	264	40			
C		3819915	6-1974	SMITH	235	151	X	8-17-1973	
D		3579626	5-1971	BRITTAIN	264	315	X		
E		3649729	3-1972	DAVIS ET AL	264	40			
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FOREIGN PATENTS OR PUBLISHED APPLICATIONS									
*		PATENT NO.		DATE	COUNTRY	NAME	CLASS	SUB- CLASS	PERTINENT SHTS. PP. DWG SPEC.
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OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)									
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