

Department of the Army
OFFICE OF THE CHIEF SIGNAL OFFICER
Washington 25, D. C.

SIGLG-3-HMS

17 November 1947

SUBJECT: Infringement Claim of Edward H. Hebern and Hebern Code, Inc.

TO: Chief, Army Security Agency
The Pentagon
Washington 25, D. C.
Attention: Mr. Stauffer

1. Mr. Edward H. Hebern, of 485 - 40th Street, Oakland California, through his attorneys, Barnard & Henry of Washington, D. C., has asserted a claim against the Department of the Army, Department of the Navy, and Department of the Air Force for infringement of the following U. S. Patents:

1,683,072 granted 4 September 1928 - Hebern
1,861,857 granted 7 June 1932 - " "
2,267,196 granted 23 December 1941 - Fanning
2,269,341 granted 6 January 1942 - Hebern
2,373,890 granted 17 April 1945 - Hebern

2. This Office will investigate such claim as far as it concerns the Department of the Army and the Department of the Air Force. Close liaison will be had with the Department of the Navy to obviate any duplication of effort.

3. Since the subject matter of the claim is one within the jurisdiction of the Army Security Agency, it is requested that the following information be supplied this Office:

a. The nomenclature or designation of each type of Army and Air Force equipment which is covered by or may possibly be covered by the claims of the patents listed above.

b. The total quantity procured and the unit cost of each of the equipments listed in a.

c. The manufacturer of the items listed in a.

d. Technical manuals or other literature describing each of the equipments listed in a.

e. Any information concerning the validity of the patents involved, such as public use or sale, publication etc., which information is readily available to the Army Security Agency.

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4. Inclosed herewith is a copy of each of the patents involved as well as a copy of second indorsement from JAG Patents Group dated 7 November 1947 granting clearance to this Office on subject claim, and a letter from the law firm of Barnard & Henry dated 31 October 1947.

FOR THE CHIEF SIGNAL OFFICER:

3 Incls:

1. Ltr to JAG, 1 Oct 47,
w/1st Ind, 7 Nov 47
2. Ltr fm Barnard &
Henry, 31 Oct 47
3. Copies of Patents -
2,267,196
1,861,857
2,269,341
2,373,890
1,683,072

/s/ Harry M. Saragovitz
HARRY M. SARAGOVITZ
Patent Counsel
Legal Division

JAGP (1 Oct 47)

1st Ind

JAGO, Dept of the Army, Washington 25, D.C. 7 NOV 1947

TO: Chief Signal Officer, ATTN: Director, Legal Division

1. The clearance requested in basic communication is hereby granted under the provisions of Army Procurement Regulation 8-305.4, 1 November 1947, in so far as the claim may pertain to the Departments of the Army and the Air Force.

2. A search of the Government Register of Patent Rights has failed to reveal any instrument of record affecting Hebern patents Nos. 1,683,072, 1,861,857, 2,269,341 or 2,373,890, or Fanning patent No. 2,267,196.

3. The files of this office contain no information pertinent to the present claim.

4. In response to an inquiry from this office to the Department of Justice as to whether its files contain any information pertinent to the present claim, that Department in a communication dated 23 October 1947, signed by Mr. Herbert A. Bergson, Acting Assistant Attorney General, made the following report and request:

"No other department or agency of the government has investigated, settled, or transmitted a report concerning the above patents to this department so far as the records reveal.

"This department has been advised informally that on September 3, 1947 the Secretary of National Defense and the Secretaries for the Army, Navy and Air Forces received substantially identical communications from the law firm of Bonnard and Henry, 1422 F Street, N.W., Washington, D. C., setting forth at length a claim for alleged patent infringement. This firm stated that it was representing Edward H. Hebern, 485 Fortieth Street, Oakland, California, and his assignee, International Code Machine Co., 139 North Virginia Street, Reno, Nevada.

"Press reports appearing in the New York Sun and the Philadelphia Bulletin on September 10 and in the Times Herald of Washington, D. C. for September 11,

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have been called to the attention of this department. This bulletin indicated that a Vallejo, California law firm including Ellis Randall had announced to the press that claims totaling at least \$50,000,000 had been filed with the United States Armed Forces alleging infringement of his patents.

"One or more of these press releases also came to the attention of Mr. A. Robert Noll of the Patent Department of the International Business Machines Co., 590 Madison Avenue, New York 20, N. Y., for Mr. Noll visited this department a few days after the press release and stated that he was willing to assist the Government in any way that he might be called upon in the defense of any suit filed under these patents. Mr. Noll was connected with the Air Corps during the recent war and his patents Nos. 2,116,731 - 2 and -3 were in three interferences numbered 77,445, 77,446 and 77,716, with applications resulting in certain of the Hebern patents. Mr. Noll states that he has no interest in trying to set up his patents, that he is perfectly willing for the Government to use them. Mr. Noll also provided copies of the interference records in connection with the above interferences and probably has since contacted the Patent Sections of one or more other Government departments with a view to providing them with copies of these records. Mr. Noll further stated that Captain Safford of the Navy is familiar with the Hebern patents and with the alleged infringing machines made probably by Teletype.

"It is requested that this department be kept advised concerning the proceedings in connection with this matter."

5. It is understood from Mr. Lawrence Glasman, of your office, and Mr. Edgar J. Brower, of the Office of Naval Research, Department of the Navy, that your office, the Army Security Agency and the Office of Naval Research, will collaborate in the investigation and consideration of the claim as it affects the Departments of the Army, Navy and Air Force with a view to facilitating consideration of the claim and avoiding duplication of effort in connection therewith to the maximum extent possible in the circumstances.

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6. In view of the Department of Justice request, above mentioned, this office is notifying Justice that, in so far as the claim affects the Departments of the Army and the Air Force, the matter has been assigned to your office for investigation, and settlement if deemed advisable; also that your office and the Army Security Agency will collaborate in this connection with the Office of Naval Research in its investigation and consideration of the claim in so far as it affects the Department of the Navy. In order that this office may keep the Department of Justice advised concerning Department of the Army and Department of the Air Force proceedings in connection with this matter, it is requested that this office be kept informed as to the progress of the investigation and any settlement negotiations that may be undertaken.

7. A copy of basic communication and of this indorsement have this date been forwarded to each of the offices listed below, for information and necessary action as required by Army Procurement Regulation 8-305.4.

8. Each of the offices noted below is requested to investigate promptly the bearing of the present claim upon the procurement of its respective service and to notify the Delegate to whom clearance is herein granted not only of the interest, if any, or that service in the matter, but also of any pertinent information contained in its files as required by Army Procurement Regulation 8-305.4.

FOR THE JUDGE ADVOCATE GENERAL:

Signed

GEORGE W. GARDES
Colonel, JAGD
Chief, Patents Division

Incl w/d

Copies furnished;

Air Judge Advocate, USAF (Attn: Chief, Patents Branch)
Commanding General, AMC (Attn: Chairman, Royalty Adjustment Bd.)
Chief of Transportation (Attn: Chief, Legal Division)
Chief of Chemical Corps (Attn: Chief, Patents Section, Legal Br.)
Chief of Ordnance (Attn: ORDGL, Patent Section)
Quartermaster General (Attn: Chief, Patent Section, Legal Br.)
Chief of Engineers (Attn: Chief, Contracts Br., Legal Div.)
Surgeon General (Attn: Legal Division)

BARNARD & HENRY
Suite 300 Kellogg Building
1422 F Street
Washington 4, D. C.

October 31, 1947

Office of Air Judge Advocate
Washington, D. C.
Attn: Chief, Patents Branch

Attention: Mr. John E. Pernice

Dear Sirs:

We duly received your letter of September 30, 1947, replying to our letter to the Adjutant General, United States Army of September 3, concerning United States Letters Patents No. 1,683,072 granted September 4, 1928 to Edward H. Hebern; No. 1,861,857 granted June 7, 1932 to Edward H. Hebern; No. 2,267,196 granted December 23, 1941 to Walter N. Fanning; No. 2,269,341 granted January 6, 1942 to Edward H. Hebern; and No. 2,373,890 granted April 17, 1945 to Edward H. Hebern.

We have communicated with our clients with a view to assembling data and information to comply with the request contained in the third paragraph of your letter and shall write you again as soon as possible giving any such data within the possession of our clients.

Enclosed are copies of the patents in question.

No licensees were issued so there are no copies of license agreements. We understand that there has been no litigation with the exception of two interference proceedings before the United States Patent Office, Numbers 77445 and 77716. As to this we expect to have further information shortly to send you, which, if available, will include, in compliance with your request, a list of all notices of infringement sent alleged infringers (except the allege infringers included in the statement of litigation). Most of this information is embodied in the file wrapper history of the cases at the Patent Office, but it may well be that our clients have it so as to preclude the necessity for delay incident to securing it from the Patent Office.

Sincerely,

/s/ Jerome F. Barnard

JFB-m
Enclosure