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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/853,501	09/11/2007	Adnan A. Hamid	AAH0005US	3142

7590 01/26/2009  
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EXAMINER
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MEMULA, SURESH

ART UNIT	PAPER NUMBER
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2825

MAIL DATE	DELIVERY MODE
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01/26/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 11/853,501	<b>Applicant(s)</b> HAMID ET AL.	
	<b>Examiner</b> SURESH MEMULA	<b>Art Unit</b> 2825	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 September 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is 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 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 September 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/11/07</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Objections*

1. In claim 1, at line 1, the preamble, "A method comprising:", is objected to for not providing an adequate introductory clause associating a setting or context in which the elements and steps of the method claim appear; e.g., "A method for generating a test case, comprising:" would be sufficient.
2. The preamble of claim 8, 15, and 22 are each objected to under the same rationale as claim 1's preamble objection.
3. Appropriate correction is required.

### *Claim Rejections - 35 USC § 101*

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
5. **Claims 1-7 are rejected under 35 U.S.C. 101** because the claimed invention is directed to non-statutory subject matter. A patent eligible process under § 101 **must** (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.
6. Specifically, claim 1 recites a series of method steps directed to generating a test case; however, the method step(s):
  - (a) are not tied to a particular apparatus utilized to perform step(s) of the method, or, for that matter, tied to any "another" statutory class, and
  - (b) do not positively recite the subject matter that is being transformed as a result of performing the prescriptive steps recited in claim 1.
7. Therefore, since method claim 1 fails to meet either of the above two requirements, claims 1-7 do not qualify as a statutory process.
8. This rejection is based on and supported by: MPEP § 2106.IV.B; *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. **Claims 1-23 are rejected under 35 U.S.C. 102(e)** as being anticipated by US Pub. No. 2005/0278702 to Koyfman et al. (Hereinafter: Koyfman).

11. As to claim 1 and similarly recited claims 8, 15, and 22,

generating a first test case for a DUT (§15), said generating the first test case (§27) comprising

traversing a first path through a hierarchy of goals (§51, 54. Koyfman's DAG is a case analysis graph comprising a hierarchy of nodes, i.e., goals. Applicant further limits a hierarchy of goals to be comprised by a case analysis graphs, see claims 4, 11, 18) from a start goal (e.g., FIG. 2: element “STATE 1”) to an end goal (e.g., FIG. 2: element “STATE 2”),

wherein a first parent goal traversed (§54) in a first level of the hierarchy of goals (e.g., FIG. 2 has two levels with “STATE 1” being in a first level.) comprises a first definition of one or more of a slot (§51, 59, i.e., condition values such as 0 or 1) and a method (§51, 59, e.g., attribute, edge, or address), and

assuming the first definition of the slot or the method (§46, 59) by a child goal (e.g., FIG. 2: element “STATE 2”) in a second level of the hierarchy of goals (§59), if the child goal requires the slot or the method (§46, 59).

12. As to claim 2 and similarly recited claims 9, 16 and 23, generating a second test case for the DUT (§43, 78), said generating the second test case (§78, 83) comprising traversing a second path through the hierarchy of goals from the start goal to a second end goal (§54, 59, 78), wherein a second parent goal traversed in the first level of the

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hierarchy of goals comprises a second definition of one or more of the slot and the method (§51, 59, 78), and assuming the second definition of the slot or the method by the child goal in the second level of the hierarchy of goals if the child goal requires the slot or the method (§59, 78).

13. As to claim 3 and similarly recited claims 10 and 17, wherein the second level of the hierarchy is below the first level of the hierarchy in the hierarchy (§51, 59).

14. As to claim 4 and similarly recited claims 11 and 18, wherein a case analysis graph comprises the hierarchy of goals (§51, 54).

15. As to claim 5 and similarly recited claims 12 and 19, linking the first parent goal to a plurality of goals in a next lower level of the hierarchy (§46, 59) wherein the first parent goal is configured to select one goal of the plurality of goals in the next lower level as the next goal to traverse in said traversing (§59).

16. As to claim 6 and similarly recited claims 13 and 20, linking the first parent goal (§46, 59) to a plurality of goals in a next lower level of the hierarchy of goals (FIG. 3-5), wherein the first parent goal is configured to select each goal of the plurality of goals in the next lower level in a defined order as the next goal to traverse in said traversing (§54, 59-60).

17. As to claim 7 and similarly recited claims 14 and 21, assembling all slots and methods associated with the goals traversed along the first path in the hierarchy of goals (§24, 54, 59).

***Conclusion***

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SURESH MEMULA whose telephone number is (571)272-8046. The examiner can normally be reached on Monday-Friday 8:00-4:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Chiang can be reached on 571-272-7483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Suresh Memula/

Art Unit 2825  
January 24, 2009

/Phallaka Kik/

Primary Examiner, Art Unit 2825