

**REMARKS/ARGUMENTS**

After entry of this amendment, claims 77-96 will be pending in this application. New claims 87-96 have been added. Support for the new claims can be found in the specification. No new matter has been added.

Claims 77-78 and 80-86 stand rejected under 35 U.S.C. 102(e) as being anticipated by Suaris, United States patent publication number 2005/0132316. Reconsideration of these rejections and allowance of the pending claims in light of these remarks is respectfully requested. Claim 79 would be allowable if rewritten as an independent claim.

Claim 77

Claim 77 stands rejected under 35 U.S.C. 102(e) as being anticipated by Suaris, United States patent publication number 2005/0132316. Applicant respectfully traverses, on the grounds that the portions of the Suaris publication do not constitute prior art.

The Suaris publication is based on a United States patent application that was filed March 10, 2004, claiming priority to United States provisional patent application numbers 60/524,300, filed November 21, 2003, and 60/456,306, filed March 19, 2003. The present application is a divisional of United States application number 10/446,650, filed May 27, 2003. This date is before the November 21, 2003 provisional and the Suaris publication. Thus, the Suaris publication could only qualify as prior art against the present claims under 35 U.S.C. §102(e) based on its priority claim to the March 19, 2003 provisional application.

However, according to the MPEP:

The 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications...entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application with certain exceptions ***if the provisional application(s) properly supports the subject matter relied upon to make the rejection*** in compliance with 35 U.S.C. 112, first paragraph.

MPEP §2136.03 (III) (emphasis added). Therefore, only the portion of the disclosure of the Suaris publication that is properly supported by the March 19, 2003 provisional can be considered as prior art against the present claims. (Applicant's representative was able to obtain

a copy via PAIR and believes the Examiner will have no trouble doing likewise; accordingly a copy has not been submitted.)

The March 19, 2003 provisional does not teach each and every element of claim 77. For example, claim 77 recites “providing a design file incorporating the logic design circuitry in computer readable format.” The March 19, 2003 provisional does not teach this feature.

The pending office action cites Figure 22 of the Suaris publication as teaching this feature. (See pending office action, page 2, sixth paragraph.)

There is no corresponding figure or written description corresponding to Figure 22 in the March 19, 2003 provisional. Accordingly, the March 19, 2003 provisional does not teach providing a design file incorporating the logic design circuitry in computer readable format, as required by the claim.

Claim 77 further recites “applying constraints to the retiming graph to determine which registers of the retiming graph are capable of being moved forward or backward across a combinational logic element of the logic design circuitry.” The March 19, 2003 provisional does not teach this feature.

The pending office action cites Figure 12 of the Suaris publication as teaching this feature. (See pending office action, page 3, first paragraph.)

There is no corresponding figure or written description corresponding to Figure 12 in the March 19, 2003 provisional. Accordingly, the March 19, 2003 provisional does not teach applying constraints to the retiming graph to determine which registers of the retiming graph are capable of being moved forward or backward across a combinational logic element of the logic design circuitry, as required by the claim.

Because the portions of the Suaris publication relied on in the rejection do not constitute prior art, Applicant has not addressed any distinctions that might be made on the merits. This should not be construed as a concession on the merits.

For at least these reasons, claim 77 should be allowed.

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Other claims

Claims 87 and 93 should be allowed similar reasons as claim 77. The remaining claims depend on one of the above claims and should be allowed for at least the same reasons and the additional limitations they recite.

**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal notice of allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

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