

REMARKS

Claims 1-23 are pending in the application.

Claims 1-23 have been rejected.

Claims 1, 8, 15 and 22 have been amended.

Unless otherwise specified in the below discussion, Applicants have amended the above-referenced claims in order to provide clarity or to correct informalities in the claims. Applicants further submit that, unless discussed below, these amendments are not intended to narrow the scope of the claims. By these amendments, Applicants do not concede that the cited art is prior to any invention now or previously claimed. Applicants further reserve the right to pursue the original versions of the claims in the future, for example, in a continuing application.

Applicants note that the preambles of independent Claims 1, 8, 15 and 22 have been amended to address the objection raised by the Office Action related to associating a setting or context for the claim limitations. Applicants respectfully submit that the objections have been addressed by these amendments.

Rejection of Claims Under 35 U.S.C. §101

Claims 1-7 stand rejected under 35 U.S.C. §101 on the grounds that the claims are purportedly directed to non-statutory subject matter. Applicants respectfully traverse this rejection.

Without conceding to the validity of the rejection's implication that independent Claim 1 is directed to non-statutory subject matter, but instead to advance prosecution,

Applicants have amended independent Claim 1 to incorporate reference to a particular apparatus performing the claimed “generating.” Applicants respectfully submit that support for this amendment can be found throughout the originally-filed Application and at least at originally-filed Claim 8.

For at least these reasons, Applicants submit that independent Claim 1, as amended, and all claims depending therefrom reflect statutory subject matter under 35 U.S.C. § 101. Applicants therefore respectfully request the Examiner’s reconsideration and withdrawal of the rejections to these claims and an indication of the allowability of same.

Rejection of Claims Under 35 U.S.C. §102

Claims 1-23 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Publication No. 2005/0278702 naming Koyfman et al. as inventors (“Koyfman”). Applicants respectfully traverse this rejection.

Independent Claims 1, 8, 15 and 22 have been rejected using substantially the same reasoning. Without conceding to the validity of treating each of the independent claims in this manner, Applicants respond to the rejections using the limitations of independent Claim 1 as an example. Applicants submit that the following discussion applies to the rejections directed toward all the independent claims.

Independent Claim 1 provides the following limitations:

generating ... a first test case for a design under test (DUT), said
generating the first test case comprising

traversing a first path through a hierarchy of goals from a start goal to
an end goal, wherein

a first parent goal traversed in a first level of the hierarchy of goals comprises a first definition of one or more of a slot and a method, and

assuming the first definition of the slot or the method by a child goal in a second level of the hierarchy of goals, if the child goal requires the slot or the method.

See Claim 1 (amended). Applicants respectfully submit that Koyfman fails to provide disclosure of all these limitations.

As purported disclosure of the above limitations, the Office Action cites to sections of Koyfman that are related to Koyfman Figure 2. Koyfman Figure 2 is described as follows:

Reference is now made to FIG. 2, which is a simple directed acyclic graph that illustrates a model of a portion of an address translation mechanism in accordance with a disclosed embodiment of the invention. Two edges 38, 40 connect a first state 42 with a second state 44. A transition from the state 42 to the state 44 occurs if either of two preconditions, $MSR[SF]=0$ OR $MSR[SF]=1$ is met. One of two possible actions occurs in the state 44, depending on whether the transition occurred along the edge 38 or the edge 40. In the former case, an output address $Address_{out}$ is assigned to be identical to an input address $Address_{in}$. In the latter case, the output address $Address_{out}$ is assigned a value $Address_{in} \& 0x00000000FFFFFFFF$.

Koyfman, ¶ [0059]. Thus, Koyfman Figure 2 illustrates two states and two edge transitions from the first state to the second state. Each edge purportedly is associated with a different traversal condition. *See* Koyfman, ¶ [0051]. The traversal conditions are purportedly related to the “preconditions” discussed in the quoted section. The Office Action further relates the claimed “start goal” with Fig. 2 “State 1” and the claimed “end goal” with Fig. 2 “State 2.” *See* Office Action, p.3. The Office Action also relates “State 1” with the claimed “first parent goal” and “State 2” with the claimed “child goal.” *Id.*

The cited sections of Koyfman fail to establish that “State 2” assumes a definition of a slot or method, as claimed. Figure 2 only provides for the precondition values in deciding which of the edge transitions to follow from “State 1” to “State 2.” There is no disclosure in the figure or the text that these precondition values are defined in “State 1,” as claimed. Further, there is no disclosure in the figure that either of the precondition values is assumed by “State 2” or that “State 2” requires either precondition value. According, to the cited text, the action taken in “State 2” depends upon the transition path, and not to any slot values defined by “State 1.”

The Office Action makes reference to an “attribute, edge, or address” as correlating to the claimed “method” that can be defined by the claimed first parent goal and assumed by the child goal. The Office Action is unclear as to how an “attribute, edge, or address” is related to a method. Koyfman states that “[e]ach node and edge has a list of attributes, to which the transformations and traversal conditions relate.” Koyfman, ¶ [0051]. A “list of attributes” does not appear to correspond to a method, as claimed. Nor do the cited sections disclose that “State 2” assumes a “list of attributes” from “State 1.” As for an “address,” the only address mentioned in the cited sections is that illustrated in Koyfman Fig. 2, associated with “State 2.” There is no disclosure that “State 2” assumes this address from “State 1.” In fact, this address is disclosed to be selected based upon the edge transition used. Finally, there is no disclosure that “State 1” defines an edge, as would be required for an “edge” to be considered a “method” within the context of the claims. Nor do the cited sections of Koyfman disclose that an “edge” is a method, as claimed.

For at least these reasons, Applicants submit that the cited sections of Koyfman fail to provide disclosure of all the limitations of independent Claims 1, 8, 15 and 22, and

all claims depending therefrom. Applicants therefore respectfully request the Examiner's reconsideration and withdrawal of the rejections to these claims and an indication of the allowability of same.

Applicants further submit that the cited sections of Koyfman fail to provide disclosure of all the limitations of dependent Claims 2, 9, 16 and 23. These dependent claims provide for "traversing a second path through the hierarchy of goals from the start goal to a second end goal, wherein a second parent goal traversed in the first level of the hierarchy of goals comprises a second definition of one or more of the slot and the method, and assuming the second definition of the slot or method by the child goal...." *See, e.g.*, Claim 2.

As an initial matter, the cited sections of Koyfman (e.g., Koyfman, ¶¶ [0051], [0059], [0078]) do not provide for a second parent goal. Instead, Koyfman Fig. 2 is cited again, which only has two states disclosed, as discussed above, with two edge transitions from "State 1" to "State 2." As discussed above, "State 2" fails to assume either a slot or method definition from "State 1." There is no disclosure of a different slot or method definition being provided by "State 1" to be assumed by "State 2."

Further, the cited sections do not provide for a "second path" to be traversed from the start goal to a second end goal. Instead, the cited sections, by relating to Koyfman Fig. 2, can only relate to the same path as discussed for the independent claims. And, indeed, can only provide for the same end goal as disclosed for the independent claims, and not a second end goal.

For at least these reasons, Applicants submit that the cited sections of Koyfman fail to provide disclosure of all the limitations of dependent Claims 2, 9, 16 and 23, and that these claims are in condition for allowance. Applicants therefore respectfully request

the Examiner's reconsideration and withdrawal of the rejections to these claims and an indication of the allowability of same.

CONCLUSION

In view of the amendments and remarks set forth herein, the application and the claims therein are believed to be in condition for allowance without any further examination and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5090.

If any extensions of time under 37 C.F.R. § 1.136(a) are required in order for this submission to be considered timely, Applicant hereby petitions for such extensions. Applicant also hereby authorizes that any fees due for such extensions or any other fee associated with this submission, as specified in 37 C.F.R. § 1.16 or § 1.17, be charged to Deposit Account 502306.

Respectfully submitted,

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