REMARKS

Claims 1-23 are pending in the application.

Claims 1-23 have been rejected.

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, even if the precondition value is defined in "State 1," there is no disclosure in the figure or the associated text that either of the precondition values is assumed by "State 2" or that "State 2" requires either precondition value, as provided by

the claims. According, to the cited text, any 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. *See* Office Action, p.2. 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," as would be required by the claims. 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.

The Office Action further states that:

> Koyfman's attributes, edges, and addresses are each functions set by the upstream state (¶59; i.e., node). Applicant's recited methods are, in view of the instant specification at ¶53, functions. Therefore, it is maintained that Koyfman's attributes, edges, or addresses are anticipatory of Applicant's method(s). Furthermore, Koyfman teaches that depending upon which edge is transitioned a corresponding function is inherited from the upstream state (¶59).

Office Action, p.4 (responding to discussion raised in Response to previous Office Action). Applicants respectfully submit that this position of the Office Action

misinterprets the clear meaning of the claims and Koyfman. The claims provide that "a first parent goal ... comprises a first definition of one or more of a slot and a method." *See*, *e.g.*, Claim 1. The Office Action states that Koyfman's "attributes, edges and addresses" are "set by the upstream state." This is a tacit acknowledgement that Koyfman's "upstream state" does not comprise those elements but instead merely "sets" them. Since the Office Action correlates these "attributes, edges and addresses" to the claimed "method," the Office Action admits that Koyfman cannot anticipate a limitation requiring a goal to comprise the method. Applicants further note that the Office Action provides no citation within Koyfman to the purported "setting" of the "attributes, edges and addresses."

Further, the cited sections provide no mechanism for passing a slot value or a method from a parent goal to a child goal, as claimed. The cited sections of Koyfman fail to describe Koyfman's nodes in terms of a hierarchy as claimed. Instead, they are described as a "directed acyclic graph (DAG), in which nodes represent possible intermediate stages, and directed edges represent the possible transformations that occur between the stages." Koyfman, ¶ [0051]. There is no parent-child relationship provided for Koyfman's "directed acyclic graph." Koyfman further provides that "[a] stage may have several possible outgoing edges, each associated with a different traversal condition. Each node and edge has a list of attributes, to which the transformations and the traversal conditions relate." *Id.* But there is no disclosure of any passing of slot definitions or methods from a first to a second node or from a parent to a child goal. The attributes and the transformations appear to be related solely to the node itself and the traversed edge. Koyfman does not provide for assuming of a slot definition or a method by the second node, as claimed.

To the extent that the Examiner continues to maintain the rejection of the independent claims in light of the presently cited art, Applicants respectfully request the Examiner provide specific citation within Koyfman that illustrates the elements of the claim limitations discussed above. *See*, *e.g.*, 37 C.F.R. § 1.104(c)(2).

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 final 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,

/Jonathan N. Geld/

Jonathan N. Geld
Attorney for Applicants
Reg. No. 44,702
(512) 439-5090 [Phone]
(512) 439-5099 [Fax]