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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/513,450	08/30/2006	Babette van Antwerpen	015114-063920US	2433
26059 7590 05/26/2009 TOWNSEND AND TOWNSEND AND CREW LLP/ 015114 TWO EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER DINH, PAUL	
			ART UNIT 2825	PAPER NUMBER
			MAIL DATE 05/26/2009	DELIVERY MODE 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.

Office Action Summary	Application No. 11/513,450	Applicant(s) VAN ANTWERPEN ET AL.	
	Examiner Paul Dinh	Art Unit 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 2 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 27 April 2009.
- 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) 77-96 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- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.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) _____ is/are rejected.
- 7) ☒ Claim(s) 77-96 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 _____ 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:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ 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 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 type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is a response to the amendment and remarks filed on 4/27/09.

Claims 77-96 are pending.

This application is in condition for allowance except for the following formal matters:

Claim Objections

Claims 77, 87 and 93 are objected to because the claimed invention is directed to non-statutory subject matter.

A § 101 process claim must (1) be tied to another statutory class (a particular machine or apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing; see *In Re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008). If neither of these requirements are met by the claims, the process claim is not a patent eligible process under § 101.

A method claim that would not qualify as a statutory process would be a claim that recites purely mental steps that can be performed manually or steps that merely manipulating an abstract idea without the use of a specific structure. Thus, to qualify as a § 101 statutory process, the claimed step(s) must explicitly recite the other statutory class such as the computer, computer-aided design (CAD) system, the electronic design automation (EDA) system, the thing to which it is tied, for example by identifying the specific structure that accomplishes the step(s) and providing transformation underlying subject matter to a different state or thing.

Claims 77, 87 and 93 recite a series of process steps for method for designing logic circuitry implemented by a programmable logic device but the steps in the method neither positively recite a specific structure (i.e., computer) that implements the claimed steps nor identify transformation of underlying subject matter to a different state or thing.

The examiner noticed that claims 77, 87 and 93 recite the limitation “providing a design file incorporating the logic design circuitry in computer readable format”.

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However, providing a design file incorporating the logic design circuitry in computer readable format does not tie this step and/or other steps (generating, applying, and retiming in claims 77, 87 and 93) to a computer. This limitation can be interpreted as a user/designer/engineer inputting/providing a logic design file (into a computer). None of the steps: generating, applying, and retiming are tied to a computer and/or implemented by a computer.

Thus, the subject matter of claims 77, 87 and 93 is non-statutory and not patent eligible.

In order to comply with the 35 USC § 101 statutory requirement, a limitation, i.e., “by using a computer”, as disclosed in figure 1 of the Application disclosure, must be inserted in at least one of the claimed steps (generating, applying, and retiming) of each of claims 77, 87 and 93. This would be a tie and could overcome the 35 USC § 101 non-statutory issue.

Conclusion

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter

Any inquiry concerning this communication from the examiner should be directed to Paul Dinh whose telephone number is 571-272-1890. 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 number for the organization handling this application is 571-273-8300.

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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).

/Paul Dinh/

Primary Examiner, Art Unit 2825