UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ANDRES CALLEGARI, JAMES STEVENS, MARC HILDEBRAND, and SEAN SPICER

Appeal 2009-001847
Application 10/961,428
Technology Center 2600

Decided: August 28, 2009


HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL
Appeal 2009-001847
Application 10/961,428


We will sustain all of the rejections.

Appellants’ invention relates to rendering of data, and specifically of irregularly shaped volume elements (“voxels”), on a graphical user interface (“GUI”). Appellants’ claims are directed to a GUI having an irregular volume presentation area to display “attributes” associated with irregular volumes that comprise “coordinates” (claims 1-8), a computer-implemented method for compiling attributes comprising “coordinate data” (claims 9-15), and a computer system for presenting attributes comprising “coordinate data” (claims 16-20).

Claim 1, reproduced below, is representative of the subject matter on appeal:

1. A graphical user interface embodied on one or more computer-readable media and executable on a computer, said graphical user interface comprising:
   an irregular volume presentation area which displays a plurality of attributes associated with one or more irregular volumes, said plurality of attributes comprising coordinates for an extracted cell associated with each of the one or more irregular volumes;
   wherein each of said identified irregular volumes is comprised of a plurality of three-dimensional cells; and

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1 See Abs.; Spec. ¶¶ [0002], [0004], [0010]; Figs. 1, 4; claims 1, 9, 16.
wherein at least a portion of said plurality of attributes is derived from a set of irregular volume attribute data associated with each of said plurality of three-dimensional cells. (Claim 1 (emphasis added)).

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

<table>
<thead>
<tr>
<th>Inventor</th>
<th>Patent Number</th>
<th>Date</th>
</tr>
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<tbody>
<tr>
<td>Drebin</td>
<td>US 5,381,518</td>
<td>Jan. 10, 1995</td>
</tr>
<tr>
<td>Argiro (“Argiro ‘662”)</td>
<td>US 5,986,662</td>
<td>Nov. 16, 1999</td>
</tr>
<tr>
<td>Listou</td>
<td>US 6,134,564</td>
<td>Oct. 17, 2000</td>
</tr>
<tr>
<td>Argiro (“Argiro ‘059”)</td>
<td>US 6,219,059 B1</td>
<td>Apr. 17, 2001</td>
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</tbody>
</table>

(i) The Examiner rejected claims 16 to 20 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

(ii) The Examiner rejected claims 1 to 5, 7 to 13, 16, and 17 under 35 U.S.C. § 103(a) based upon the teachings of Argiro ‘059 and Listou.

(iii) The Examiner rejected claim 6 under 35 U.S.C. § 103(a) based upon the teachings of Argiro ‘059, Listou, and Drebin.

(iv) The Examiner rejected claims 14 and 20 under 35 U.S.C. § 103(a) based upon the teachings of Argiro ‘059, Listou, and Argiro ‘662.


(vi) The Examiner rejected claims 18 and 19 under 35 U.S.C. § 103(a) based upon the teachings of Argiro ‘059, Listou, and Willhoit.

Appellants present substantive arguments on the merits with regard to independent claims 1, 9, 16, and separate arguments as to dependent claim 4. Appellants present nominal arguments with regard to claims 2, 3, 5 to 8, 10
to 15, and 17 to 20, stating that these claims stand or fall with respective independent claims 1, 9, and 16 (see App. Br. 19; Reply Br. 10, 13).

Regarding the non-statutory subject matter rejection of claim 16, Appellants argue that the computer system of claim 16 includes a computer readable medium encoded with a data structure that defines a structural and functional interrelationship between the data structure and the computer hardware and software components (see generally Reply Br. 12-13). Appellants contend that “the computer system of claim 16 necessarily includes computer-readable media under the broadest reasonable interpretation of claim 16” (Reply Br. 13).

Regarding the obviousness rejection of claims 1, 9, and 16, Appellants argue that neither Argiro ‘059 nor Listou, individually or in combination, teaches or suggests attributes comprising “coordinates” or “coordinate data” as recited (App. Br. 14-15; Reply Br. 7-10). Appellants contend that Argiro ‘059 is different from claim 1, which requires that attributes comprise coordinates, because in Argiro ‘059 voxels comprise (i) coordinates that define a position, and (ii) attributes such as transparency or color (Reply Br. 7-10). Appellants also contend that although Argiro ‘059 teaches voxels in a three-dimensional grid positioned at x, y, and z coordinates, Argiro ‘059 teaches away from fixed attributes such as coordinates or coordinate data because Argiro ‘059 instead teaches attributes that are adjusted (App. Br. 15-19).

Regarding the obviousness rejection of claim 4, Appellants argue that Argiro ‘059 and Listou fail to teach or suggest the attributes recited in claim
4 which include data related to the size of an irregular volume (App. Br. 19-21; Reply Br. 10-11). Appellants also argue that Argiro ‘059 teaches away from displaying attributes which include the size of an irregular volume for the same reason Argiro ‘059 teaches away from displaying attributes comprising coordinates and coordinate data (App. Br. 21-22).

ISSUES

(i) Based on Appellants’ arguments, the first issue before us is: Have Appellants demonstrated that the Examiner erred in determining that system claims 16 to 20 are directed to non-statutory subject matter?

(ii) Based on Appellants’ arguments, the second issue before us is: Have Appellants demonstrated that the Examiner erred in determining that the combination of Argiro ‘059 and Listou teaches or suggests a “plurality of attributes comprising coordinates” (claim 1) or “coordinate data” (claims 9, 16), as set forth in claims 1, 9, and 16?

(iii) Based on Appellants’ arguments, the third issue before us is: Have Appellants demonstrated that the Examiner erred in determining that the combination of Argiro ‘059 and Listou teaches or suggests that attributes include data related to “size,” as set forth in claim 4?

FINDINGS OF FACT

1. As indicated supra, Appellants describe and claim a GUI (Fig. 4) having a screen display 400 with an irregular volume presentation area 402 to display attributes (e.g., the attributes “Volume” and
“Area” shown in header 406) associated with irregular volumes (see Abs.; Spec. ¶¶ [0002], [0004], [0010]; Figs. 1, 4; claims 1, 9, 16). The attributes may include “coordinates,” or “coordinate data” (see claims 1, 9, 16), or may include information about size such as volume or area (Spec. ¶ [0067]; see Fig. 4).

2. Appellants’ Specification describes Figure 4 of the drawings as showing a screen display 400 as an example of a GUI, including a presentation area 402 with a tabular format relating to an irregular volume and its attribute (Spec. ¶ [0065]). The Specification discloses that “such a tabular presentation is provided as merely an example and that any number of presentation formats may be acceptable for use with the present invention” (Spec. ¶ [0065] (emphasis added)), and that “any number of IV [(irregular volume)] attributes may be acceptable for presentation” (Spec. ¶ [0067]).

3. Argiro ‘059 describes a computer system (Fig. 1) having a GUI (Fig. 3B) including a display area 314 for displaying information and attributes of voxels in three dimensions (Abs.; col. 1, l. 12 to col. 2, l. 24).

4. Argiro ‘059 describes a window of a set width (i.e., size) and center location for viewing irregular voxels on a display, where the voxels have known numeric parameters associated with them, such as position on a three-dimensional grid having x, y, and z coordinates (col. 3, ll. 36-61). A window (206 in Fig. 2(a)) has a width W in voxel values along an x-axis 200 (col. 6, ll. 26-28).
5. Argiro ‘059 describes displaying voxels and their corresponding attributes (such as transparency, color, etc.) (Abs.; col. 2, ll. 1-7; col. 3, ll. 61-64; Fig. 3B).

6. Listou describes a computer system (Fig. 1) having a display 110 for displaying and presenting data related to irregular volumes in a tabulated format (Figs. 8, 11) with the ability to rearrange and reformat the data displayed (col. 3, ll. 6-25; col. 6, ll. 15-62; see generally Abs.; Figs. 1, 4-6, 8-11).

7. Listou describes a simplified and interactive way for assigning categories, parameters, and attributes associated with data objects and providing a sort order for display so that a user can quickly manipulate the data and arrange the parameters for viewing (Abs.; col. 2, ll. 49-67; col. 9, ll. 29-45).

8. Listou additionally describes that the display 110 (Fig. 4) displays parameters such as “numeric parameters” (col. 6, ll. 46-62).

PRINCIPLES OF LAW

Computer-Related Non-Statutory Subject Matter

Section 101 of the Title 35 of the United States Code states:

“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.” 35 U.S.C. § 101 (2002).
“[A] machine is a concrete thing, consisting of parts, or of certain devices and combination of devices.” In re Ferguson, 558 F.3d 1359, 1364 (Fed. Cir. 2009) (quoting In re Nuijten, 500 F.3d 1346, 1355 (Fed. Cir. 2007) (internal quotation marks omitted), reh’g denied en banc, 515 F.3d 1361 (Fed. Cir. 2008), cert. denied, 129 S. Ct. 70 (2008)).

Claim Construction

“During examination, ‘claims . . . are to be given their broadest reasonable interpretation consistent with the specification, and . . . claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.’” In re Am. Acad. of Sci. Tech Ctr., 367 F.3d 1359, 1364 (Fed. Cir. 2004) (citation omitted); In re Morris, 127 F.3d 1048, 1053-54 (Fed. Cir. 1997).

The Examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See In re Ngai, 367 F.3d 1336, 1338 (Fed. Cir. 2004); In re Lowry, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994); Ex parte Curry, 84 USPQ2d 1272 (BPAI 2005), aff’d, slip op. 06-1003 (Fed. Cir. June 2006) (Rule 36).

Obviousness

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073 (Fed. Cir. 1988). The
Examiner’s articulated reasoning in the rejection must possess a rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

The Examiner bears the initial burden of presenting a prima facie case of obviousness, and Appellants have the burden of presenting a rebuttal to the prima facie case. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See Kahn*, 441 F.3d at 985-86.

**ANALYSIS**

We will sustain the Examiner’s rejections with respect to claims 16 to 20 (i.e., the first issue), claims 1 to 3 and 5 to 20 (i.e., the second issue), and claim 4 (i.e., the third issue), for the reasons that follow.

**First Issue: § 101 Rejection of Claims 16 to 20**

Appellants’ claim 16 recites a “computer system” for presenting attributes to a user, the computer system comprising “an irregular volume attribute presentation component for presenting” attributes to the user. The

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2 Claim 16 reads as follows:

16. A computer system for presenting attributes associated with one or more irregular volumes to a user, the system comprising:

   a plurality of attributes associated with each of the one or more irregular volumes, wherein said one or more irregular volumes are composed of a plurality of three-dimensional cells having associated cell-attribute data, and wherein at least a portion of said attributes is derived from said cell-attribute data; and
preamble of claim 16 merely recites a computer system for presenting attributes, as opposed to a combination of elements constituting a machine, and thus recites a mere field-of-use label having no significance. *But cf. In re Alappat,* 33 F.3d 1526, 1544 (Fed. Cir. 1994) (en banc) (noting that a claim preamble’s recitation of a rasterizer for converting waveform data into output data for display defined “a combination of elements constituting a machine” and thus “is not a mere field-of-use label having no significance”). In other words, claim 16 is not limited to any particular machine, parts, device, or combination of devices. *See Ferguson,* 558 F.3d at 1364.

Claim 16, under the broadest reasonable interpretation, *could* require the use of a computer as part of the system for presenting attribute data, and *could* be understood to comprise display 22 or screen display 400. *See Am. Acad. of Sci. Tech Ctr.,* 367 F.3d at 1364. Claim 16 *could also* read on a human presenting the attribute data to the user, thus, requiring no computer. *See Ex parte Gutta,* App. No. 2008-4366, at 20-22 (BPAI Aug. 10, 2009) (per curiam) (available at http://des.uspto.gov/Foia/BPAIReadingRoom.jsp) (concluding that although “system” claim 14 recited a “memory” and a “processor,” claim 14 was not limited by the specification’s disclosed examples of a RAM, ROM, and/or CPU for a personal computer, and could encompass substantially all practical applications); *cf. In re Comiskey,* 499 F.3d 1365, 1379 (Fed. Cir. 2007) (considering claim 17, a “system” having an irregular volume attribute presentation component for presenting at least a portion of said attributes to the user, wherein the at least a portion of said attributes are arranged by associated irregular volume and comprise coordinate data.
“modules,” as broadly requiring the use of a computer having hardware or software). Accordingly, the recitation in the body of claim 16 of a “component” for presenting attribute data to a user does not necessarily include the elements of a computer-readable media found in Appellants’ Specification as Appellants contend (see Reply Br. 12 (arguing that claim 16 requires the computer system of Figure 1, including memory 12, processor 26, data 28, post processor 31, and renderer 32)). See Am. Acad. of Sci. Tech Ctr., 367 F.3d at 1364.

Notably, Appellants do not point out in the Briefs which specific element(s) from the Specification or Figures correspond to the “component” recited in claim 16 (see App. Br. 10; Reply Br. 12). In fact, Appellants’ Specification states that “any number of presentation formats may be acceptable for use with the present invention” (FF 2), and thus the “component” for presenting attributes is not limited to a computer or display. For the foregoing reasons, Appellants’ argument (Reply Br. 12-13) that the computer system of claim 16 “includes a computer readable medium encoded with the data structure to define the structural and functional interrelationships between the data structure and the computer software and hardware components” is unpersuasive.

Claim 16 therefore does not recite statutory subject matter and is not directed to an eligible “machine” or “manufacture” under § 101. Appellants have not demonstrated that the Examiner erred in rejecting claim 16 as being directed to non-statutory subject matter, and we will sustain the rejection.
Dependent claims 17 to 20 fail to cure the deficiencies of independent claim 16, and we will sustain the § 101 rejection of these claims for the same reasons.

Second Issue: § 103 Rejections of Claims 1 to 3 and 5 to 20

Turning next to the obviousness rejections of claims 1 to 3 and 5 to 20, we agree with Appellants that claims 2, 3, 5 to 8, 10 to 15, and 17 to 20 stand or fall with respective independent claims 1, 9, and 16 (App. Br. 12).

Regarding the obviousness rejection of claims 1, 9, and 16, Appellants’ contention that neither Argiro ‘059 nor Listou, individually or in combination, teaches or suggests attributes comprising “coordinates” or “coordinate data” is not persuasive for the reasons that follow.

A proper patentability analysis under § 103 includes beginning with (i) a construction of the relevant claim terms, including (ii) determining the patentable weight to be given those relevant claim terms, and then (iii) making a comparison with the prior art.3 After properly determining the scope of the claims in light of the specification, including determining the patentable weight to be given to individual claim terms, a comparison is made between the claims and the prior art. In accordance with recent guidance provided by the Supreme Court in KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398 (2007), the comparison between the claims and the prior art is

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3 “Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims . . . . The second step in the analyses requires a comparison of the properly construed claim to the prior art.” Medichem, S.A. v. Rolabo, S.L., 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).
to be made in light of the level of ordinary skill and common sense in the art (see KSR, 550 U.S. at 418), and “tak[ing] account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

One of ordinary skill in the art would have understood data such as *attributes, coordinates, and coordinate data* to be any data about a voxel. The ordinarily skilled artisan would infer that any type of attribute, whether color, transparency, coordinates, coordinate data, size, or volume would be beneficially displayed on a GUI to allow user manipulation and control as taught by Listou (see FF 6, 7). In fact, Appellants recognize in the Specification that “any number of IV [(irregular volume)] attributes may be acceptable for presentation” (FF 2).

Attributes are described by Appellants in the Specification as data about a voxel such as size, volume, or area (FF 1). The terms *attributes, coordinates, and coordinate data* are descriptive material which are not due patentable weight absent a new and unobvious functional relationship between the descriptive material and the substrate. *See Ngai, 367 F.3d at 1338; Lowry, 32 F.3d at 1583-84; Curry, 84 USPQ2d at 1272.* Appellants’ Specification fails to describe any new or unobvious functional relationship between *attributes, coordinates, and coordinate data* and the displays 22 and 400 shown in respective Figures 1 and 4. Therefore, the terms *attributes, coordinates, and coordinate data* are non-functional descriptive material terms, which are not due patentable weight.

In view of the foregoing, the term “attribute” as set forth in the claims broadly encompasses the x, y, and z coordinate data, width, and center
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position data described by Argiro ‘059. Thus, the x, y, and z coordinate
data, window width, and position data of Argiro ‘059 as modified by the
table format display of numeric parameters of Listou are attributes which are
encompassed by the broad recitation of non-functional descriptive material
(i.e., coordinates and coordinate data) in Appellants’ claims. Appellants
have not shown that the Examiner erred in interpreting the terms attributes,
coordinates, and coordinate data as broadly encompassing the coordinate
data, window width, and position data disclosed by Argiro ‘059 and
displayed as numeric parameters in table format by Listou.

We agree with Appellants (App. Br. 16) that Argiro ‘059 teaches
voxels in a three-dimensional grid positioned at x, y, and z coordinates (FF
4), thus Argiro ‘059 teaches the concept of coordinates and coordinate data.
Argiro ‘059 also teaches displaying a size or width W in voxel values (FF 4),
as well as displaying and presenting voxel attributes on a GUI (FF 3, 5).
Listou teaches displaying attributes such as numeric parameters in a tabular
format on a GUI (FF 7, 8).

It would have been obvious to one of ordinary skill in the art to
modify the GUI for displaying attributes of Argiro ‘059 to display
coordinate data (such as x, y, and z data, center position, and/or width as
taught by Argiro ‘059) as a numeric parameter in table format as taught by
Listou in order to provide the ability to sort and rapidly draw conclusions
from the data in an interactive fashion. Thus, the Examiner has provided a
factual basis with articulated reasoning and a rational underpinning to
support the legal conclusion of obviousness (Ans. 4-13, 19-21). *Kahn*, 441 F.3d at 988; *Fine*, 837 F.2d at 1073.

With regard to Appellants’ argument (App. Br. 15-19) that Argiro ‘059 teaches away from *fixed* attributes such as coordinates or coordinate data because Argiro ‘059 instead teaches attributes that are *adjusted*, this line of reasoning is not persuasive since it is not commensurate in scope with what is claimed. Specifically, claims 1, 9, and 16 on appeal merely recite “a plurality of attributes” and do not require that the attributes be *fixed* or *adjusted*. Therefore, claims 1, 9, and 16 broadly encompass attributes that are either fixed or adjusted. *Am. Acad. of Sci. Tech Ctr.*, 367 F.3d at 1364. Furthermore, the Examiner is correct that one of ordinary skill in the art would understand that the modification of Argiro ‘059 with the teachings of Listou would not render Argiro ‘059 inoperable, but would instead provide the benefit of allowing a user to determine coordinate positions where values are being adjusted, thus allowing the user to better identify specific regions where an object is being adjusted (see Ans. 21).

In view of the foregoing, we will sustain the obviousness rejection of claims 1, 9, and 16 based upon the teachings of Argiro ‘059 and Listou. The same holds true for claims 2, 3, 5, 7, 8, 10 to 13, and 17, which were argued with claims 1, 9, and 16 (App. Br. 19; Reply Br. 10). The obviousness rejections of claims 2, 3, 5 to 8, 10 to 15, and 17 to 20 are also sustained because Appellants have not presented any patentability arguments for these claims apart from the arguments presented for claims 1, 9, and 16 (see App. Br. 19; Reply Br. 10). As indicated *supra*, Appellants have presented no
arguments with respect to the rejections of claims 6, 14, 15, and 18 to 20 as being obvious under 35 U.S.C. § 103(a) over Argiro ‘059 and Listou in view of various tertiary references. As such, Appellants have not shown that the Examiner erred in rejecting these claims. See 37 C.F.R. § 41.37(c)(1)(vii).

Third Issue: § 103 Rejection of Claim 4

Turning to the obviousness rejection of representative claim 4, we find that Appellants have not persuasively rebutted the Examiner’s prima facie case of obviousness for this claim (see Ans. 4-6, 10, 21-24), but merely contend that Argiro ‘059 and Listou, whether taken singly or in combination, fail to teach or suggest attributes which relate to size as set forth in claim 4 (App. Br. 19-21; Reply Br. 10-11).

Claim 4 recites, “wherein said attributes include data related to the size of said one or more irregular volumes.”

Argiro ‘059 teaches a window of a set width (i.e., size) and center location for viewing irregular voxels on a display, where the voxels have known numeric parameters associated with them, such as position on a three-dimensional grid having x, y, and z coordinates (FF 4). Listou teaches a computer system having a display 110 for displaying and presenting data related to irregular volumes in a tabulated format with the ability to rearrange and reformat the displayed data (FF 6). Listou allows the user to choose a sort order for display so that a user can quickly manipulate the data and arrange the parameters for viewing (FF 7). Listou also teaches, as Appellants point out (App. Br. 21), a display of a GUI which displays parameters such as “numeric parameters” (FF 8). We do not agree with
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Appellants that Argiro ‘059 and Listou neither teach or suggest displaying attributes including data related to the size of an irregular volume (App. Br. 20), or that the Examiner erred in determining that it would have been obvious to modify Argiro ‘059 (App. Br. 21). To the contrary, we conclude that it would have been obvious to modify the display of Argiro ‘059 with the display format of Listou to display known attributes such as size as a numeric parameter.

Appellants’ argument (App. Br. 21-22) that Argiro ‘059 teaches away from displaying attributes which include the size of an irregular volume fails for the same reason as discussed supra with regard to Appellants’ argument that Argiro ‘059 teaches away from displaying attributes comprising coordinates and coordinate data.

Taken in this light, the combination of Argiro ‘059 and Listou teaches or would have suggested the size limitation of claim 4 (see FF 4, 7, 8). Therefore, we will sustain the rejection of claim 4.

Summary

Appellants have not convincingly demonstrated that the Examiner erred in rejecting claims 16 to 20 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Appellants have not convincingly demonstrated that the Examiner erred in rejecting claims 1, 4, 9, and 16 under 35 U.S.C. § 103(a) as being unpatentable over Argiro ‘059 and Listou, or in rejecting claims 2, 3, 5 to 8, 10 to 15, and 17 to 20 under 35 U.S.C. § 103(a). Kahn, 441 F.3d at 985-86. For all the foregoing reasons, we will
sustain the Examiner’s (i) non-statutory subject matter rejection of claims 16 to 20 and (ii) obviousness rejections of claims 1 to 20.

CONCLUSIONS OF LAW

Appellants have not shown that the Examiner erred in determining that system claims 16 to 20 are directed to non-statutory subject matter.

Appellants have not shown that the Examiner erred in determining that the combination of Argiro ‘059 and Listou teaches or suggests a “plurality of attributes comprising coordinates” (claim 1) or “coordinate data” (claims 9, 16), as set forth in claims 1, 9, and 16.

Appellants have not shown that the Examiner erred in determining that the combination of Argiro ‘059 and Listou teaches or suggests that the attributes include data related to “size,” as set forth in claim 4.

ORDER

The decision of the Examiner to reject claims 1 to 20 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED
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babc

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