



OCT 28 2014

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In re Application of :
JONES et al. :
Application No. 13/908,604 : DECISION ON PETITION
Filed: June 3, 2013 : UNDER 37 CFR 1.181
Attorney Docket No.: 107745.43US :
For: DIAGNOSTIC ASSISTANCE :

This is in response to applicants' petition under 37 CFR 1.181, received October 17, 2014 requesting withdrawal of finality of the Office action mailed September 5, 2014.

The petition is **GRANTED**.

A review of the prosecution history shows that a non-final Office action was mailed on July 2, 2014 rejecting claims 1-20. An amendment to claims 1 and 7-14 was filed on August 5, 2014. In a final Office action mailed September 5, 2014, all claims were rejected under 35 USC 101 in view of the Supreme Court decision in *Alice Corporation Pty. Ltd v. CLS Bank International, et al.*

Petitioner argues that "this new grounds of rejection (i.e., 35 USC 101) would apply with equal force to the subject claims in both unamended and amended forms." Although the claims were amended, the rejection under 35 USC 101 was not due to the change in scope of the claims. Petitioner's arguments are persuasive.

MPEP 706.07(a) sets forth that the second or any subsequent action on the merits shall be made final except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). Although Applicants' amendment to claims 1 and 7-14 introduced features into the claims which were not taught by the references applied by the examiner in the non-final Office action, they did not necessitate the rejection under 35 USC 101. Accordingly, the finality of the Office action is premature.

The finality of the Office action, **but not the action itself**, is hereby withdrawn. The Office action mailed September 5, 2014 is now considered to be non-final and the shortened statutory period for response continues to run THREE (3) MONTHS from the date of the mailing of the Office action. A reply to the September 5, 2014 Office action