

# Subject matter eligibility in two domains I: Success with the US-based disclosure

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## Foundation for the practitioner

- MPEP 2106
- Examples 1 to 42
- Summary of Federal Circuit case developments, e.g., <https://bitlaw.com/patent/section-101-cases.html>

The screenshot shows the uspto.gov website. The header includes the uspto.GOV logo and the text "The United States Patent and Trademark Office an agency of the Department of Commerce". A search bar is visible in the top right corner. The main navigation bar lists: PATENTS | TRADEMARKS | IP LAW & POLICY | PRODUCTS & SERVICES | INVENTORS | NEWS & NOTICES | FAQs | A. The breadcrumb trail reads: Home Page » Patents » Patent Laws, Regulations, Policies & Procedures » Manual of Patent Examining Procedure » Chapter 2100 » Section 2106. The left sidebar contains a list of links: 2101-2102-[Reserved], 2103-Patent Examination Process, 2104-Requirements of 35 U.S.C. 101 (with a sub-link for 2104.01-Barred by Atomic Energy Act), 2105-Patent Eligible Subject Matter — Living Subject Matter, and 2106-Patent Subject Matter Eligibility. The main content area is titled "2106 Patent Subject Matter Eligibility [R-10.2019]" and begins with the heading "I. TWO CRITERIA FOR SUBJECT MATTER ELIGIBILITY". The text states: "First, the claimed invention must be to one of the four statutory categories. 35 U.S.C. 101 defines invention that Congress deemed to be the appropriate subject matter of a patent: processes, machines, and compositions of matter. The latter three categories define 'things' or 'products' while the 'actions' (i.e., inventions that consist of a series of steps or acts to be performed). See 35 U.S.C. 'process' means process, art, or method, and includes a new use of a known process, machine, of matter, or material."). See MPEP 5.2106.03 for detailed information on the four categories. Second, the claimed invention also must qualify as patent-eligible subject matter, i.e., the claim judicial exception unless the claim as a whole includes additional limitations amounting to signi".

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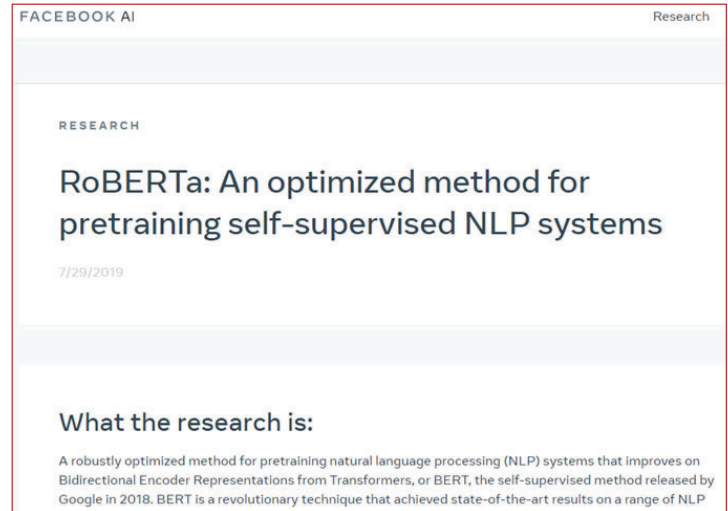
# Foundation for the practitioner

- Continuing technical education relevant to the domain of the applicant

RoBERTa ML models

Writing ERC-721 tokens to the Ethereum blockchain using HardHat, Metamask & Alchemy

Facebook's Presto query engine and Apache's Hive data warehouse software



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# Begin at the beginning

- Inventor interview
- Case definition, ideation

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## **“Conscious” claims, drawings, specification**

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- How are the claims not “directed to” an abstract idea, or integrate, or recite significantly more?
- How does the specification disclose an integrated practical application or significantly more?

## **“Conscious” claims, drawings, specification**

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- Everything in the specification should be a physical or technical element that interacts with others.
- Drastically reduce or eliminate references to users, user actions, or manual actions.
- Weave in statements of technical effect
- Consider concluding paragraphs to summarize the technical solution

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## Title search: Eligible Subject Matter in Two Realms: Practical Tips for U.S. and EPO Filings

Also available as part of the eCourse

[2021 Advanced Patent Law \(Austin\) eConference](#)

First appeared as part of the conference materials for the  
26<sup>th</sup> Annual Advanced Patent Law Institute session

"Eligible Subject Matter in Two Realms: Practical Tips for U.S. and EPO Filings"