

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 website interface. At the top, it says "uspto.GOV" and "The United States Patent and Trademark Office an agency of the Department of Commerce". Below that is a navigation menu with links for PATENTS, TRADEMARKS, IP LAW & POLICY, PRODUCTS & SERVICES, INVENTORS, NEWS & NOTICES, and FAQs. The main content area is titled "2106 Patent Subject Matter Eligibility [R-10.2019]". Under this title, it says "I. TWO CRITERIA FOR SUBJECT MATTER ELIGIBILITY". The text explains that the claimed invention must be one of the four statutory categories of patentable subject matter: processes, machines, articles of manufacture, and compositions of matter. It also mentions that the invention must be patent-eligible subject matter, i.e., the claim must not be excluded by the judicial exception unless the claim as a whole includes additional limitations amounting to signi...

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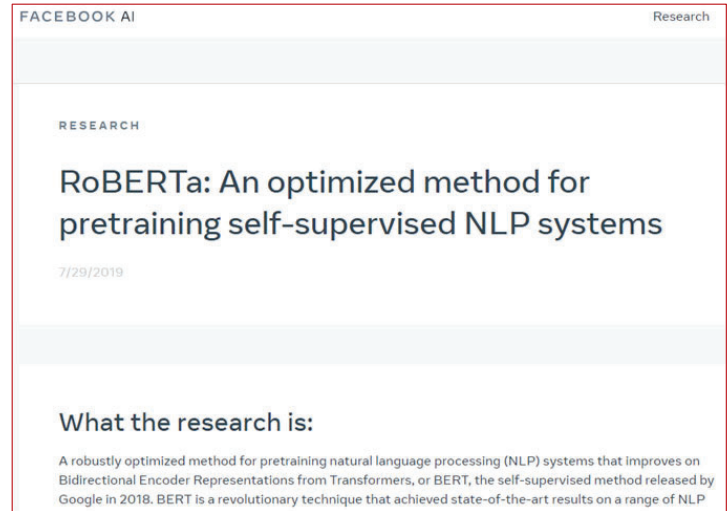
Foundation for the practitioner

- 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

- 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

- 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

Find the full text of this and thousands of other resources from leading experts in dozens of legal practice areas in the [UT Law CLE eLibrary \(utcle.org/elibrary\)](https://utcle.org/elibrary)

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
26th Annual Advanced Patent Law Institute session

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