

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 a search bar. Below the header, there is a navigation bar with links to 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]". It includes a table of contents with links to 2101-2102-[Reserved], 2103-Patent Examination Process, 2104-Requirements of 35 U.S.C. 101, 2105-Patent Eligible Subject Matter — Living Subject Matter, and 2106-Patent Subject Matter Eligibility. The 2106 page is highlighted, showing the text "I. TWO CRITERIA FOR SUBJECT MATTER ELIGIBILITY". The text states that the claimed invention must be one of the four statutory categories of 35 U.S.C. 101 and that it must also qualify as patent-eligible subject matter, i.e., the claim must include additional limitations amounting to signi-

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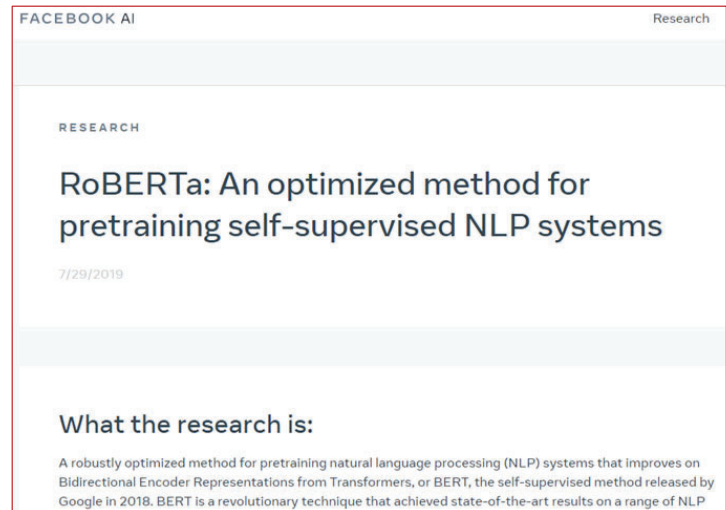
Foundation for the practitioner

- 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

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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
26th Annual Advanced Patent Law Institute session

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