

MEMORANDUM

To: All Patent Applicants and Patent Practitioners

From: John A. Squires 
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

CC: Barry J. Schindler, Deputy Commissioner for Patents 

Subject: Best Practices for Submission of Rule 132 Subject Matter Eligibility Declarations (SMEDs)

Date: April 30, 2026
(superseding the December 4, 2025 Director’s “Best Practices” Memo)

I. Introduction

In the approximately five months since the release of our December 4, 2025 “Best Practices for Submission of Rule 132 Subject Matter Eligibility Declarations (SMEDs)” Office Memorandum, we have received positive feedback. Practitioner responses have been particularly helpful in providing the Office with both “market information” and documented evidence of real-world application of inventive ideas to assess eligibility under 35 U.S.C. § 101.

The USPTO has created the position of Deputy Commissioner for Patents focused on AI Policy, Practice, and Operations, and we welcome longtime practitioner and private-sector AI expert Barry Schindler to assume this role. One of Deputy Commissioner Schindler’s first suggestions was, “Why don’t we make the SMED memorandum for practitioners and applicants a living document and provide periodic updates based on practitioner experience and the knowledge we gather?” I agree.

In general, guidance memos such as this are intended to add color and context to my official memoranda directed to the Examining Corps—who are our best in the world at what they do—as well as to MPEP updates. These missives also provide an opportunity from time to time to update and elevate our guidance based upon feedback we have received. Applicant and practitioner feedback is particularly important when it comes to SMEDs, and we strive to make attendant memos as relevant, useful, and current as possible. Your engagement and feedback are

greatly encouraged and appreciated, and it is in that spirit, and upon our Deputy Commissioner's recommendation, we provide this update.

To begin with, the idea and motivation for the voluntary SMED program is based upon the long-ago dispensed "working model" requirement submitted with an application for letters patent. The modern frontiers of innovation however - particularly, software, AI, quantum, and diagnostics - do not readily lend themselves to such modeling. But the notion of providing the office with a "constructive model" to describe less visible or tangible nuances of innovation has force. Thus, we developed this concept by folding it into existing declarations practice and describing such declarations as "SMEDs"—think of it as a "constructive model" that any applicant can voluntarily submit to the Office.

Turning to SMEDs, we sought to provide a vehicle for communicating real-world application of claimed inventions, and to pattern such submissions after well-established 35 U.S.C. § 103 or 112 "objective indicia" Rule 132 submissions as a convenient and accepted way to convey commercial information to the Office so it can be captured and, as appropriate, notice taken. Practitioners often say, "§ 103 is the other side of the coin from § 101". In that spirit, this memo suggests following what you know and have found useful about Rule 132 practice when preparing SMED submissions.

As to content, form follows function and you can be guided by precedent, by way of example, and without limitation, *Ex Parte Desjardins*, Appeal No. 2024-000567 PTAB September 26, 2025, Appeals Review Panel (ARP) Decision or *Enfish, LLC v. Microsoft*, 822 F.3d 1327 (Fed. Cir. 2016). A SMED may demonstrate how one of ordinary skill in the art would interpret a specification that describes a technological improvement—plainly how your claimed invention (supported by the specification) is better, cheaper, faster, and/or more efficient—and thus patent-eligible. It is in this regard a SMED may be useful. Literally.

Again, early feedback indicates that voluntary submitters are having success. We therefore want to provide, periodically, additional insights to help guide your considerations. We thus provide this superseding memo, as a first step in our efforts to foster continued and ongoing engagement and best practices learnings.

In sum, the additional updates, annotations and comments provided herein are intended to be best-practice suggestions and references based on practitioner feedback; no substantive changes to the December 4, 2025 memo are intended, including to the SMED Examiner Memo

or our updated MPEP guidance. We are planning periodic updates and will keep you advised accordingly. Your continued suggestions and feedback regarding SMEDs are appreciated and welcome.

II. USPTO Guidance and Rationale

A. SMEDs and Subject Matter Eligibility

The SMED Examiner Memo highlights the unique evidentiary role of SMEDs in addressing SME rejections. SMEDs are intended to clarify the record and provide objective evidence specifically relevant to the eligibility of the claimed invention under 35 U.S.C. § 101.

The SMED Examiner Memo states:

"For an evidentiary declaration to be relevant, there must be a nexus between the invention as claimed and the evidence provided in the declaration. ... [A] SMED may demonstrate how one of ordinary skill in the art would interpret a specification that describes a technological improvement to show that the claimed invention is patent-eligible subject matter."

The SMED Examiner Memo further emphasizes that SMEDs must not improperly supplement the specification and must be timely filed, with a clear nexus to the claimed inventions. Claims always define the invention.

B. Potential Pitfalls of Combining SMEDs with Other Testimony

Though it is permissible to file a single declaration under 37 CFR 1.132 addressing rejections under multiple statutory requirements, applicants are encouraged to submit a *separate* SMED to address subject matter eligibility. By providing testimony and objective evidence directed solely to the SME of the claimed invention, the applicant may avoid the risk of intertwining issues of enablement, written description, novelty and non-obviousness with those of subject matter eligibility and practical application of the claimed invention.

In addition, insofar as evidentiary considerations, feedback received has helpfully pointed out that examiners bear the initial burden upon review of *all grounds* presented under 132 affidavits, which would include SMED submissions, however filed.

The USPTO's Manual of Patent Examining Procedure (MPEP) provides separate guidance for declarations addressing SME (§ 101) and those addressing obviousness (§ 103):

- **MPEP 716:** Declarations under Rule 132 must be relevant to the specific rejection traversed.
- **MPEP 2106:** Declarations can be submitted to provide evidence traversing a subject matter eligibility rejection under 35 U.S.C. § 101. *See* MPEP 2106.07(b). For example, in response to a subject matter eligibility rejection, a declaration can be submitted to provide testimony on how one of ordinary skill in the art would interpret the disclosed invention as improving technology and the underlying factual basis for that conclusion. *See* MPEP 2106.05(a).
- **MPEP 2145:** Declarations for obviousness may address secondary considerations and motivation to combine, which may be distinct from SME issues and practical application of the claimed invention.

Combining these can lead to confusion regarding the evidentiary effect of the testimony, and may complicate the examiner's analysis and the applicant's record.

C. Examiner Consideration

The SMED Examiner Memo instructs examiners to:

"carefully consider all of the applicant's arguments and the evidence rebutting the subject matter eligibility rejection when evaluating the applicant's response."

As noted above, if a SMED is combined with other, non-SME testimony, the examiner may have difficulty isolating the evidence relevant to SME, potentially diminishing the probative value of the SMED and complicating the office action. Moreover, MPEP 716.01(d) provides additional information relating to examiner consideration when an applicant timely submits evidence traversing a rejection. Note, SMED submissions are intended to provide insight as how one of ordinary skill in the art would interpret the specification as to the real-world technological application, effect and benefit of the proffered claims.

III. Third-Party and USPTO Guidance

A. USPTO Training Materials

USPTO training materials and job aids treat declarations for SME and obviousness as distinct submissions. For example:

- **USPTO Entry Level and Training for Experienced Examiner (TEE) Training: Declaration Practice Under 37 CFR 1.132:** Recommends declarations be tailored to the specific rejection traversed.
- **TC 1600 Job Aid on Evidence of Unexpected Results Under 37 CFR 1.132:** Focuses solely on obviousness, not SME.

B. Federal Circuit Case Law

Federal Circuit decisions reinforce the need for clear, focused evidentiary records:

- *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992): The burden of proof shifts depending on the rejection, and evidence must be relevant to the specific issue. Note that the examiner “bears the initial burden upon review of the prior art *or on any other ground* of presenting a prima-face case of unpatentability.” (emphasis added)
- *In re Sullivan*, 498 F.3d 1345 (Fed. Cir. 2007): The Board must consider *all evidence* submitted, including multiple declarations, and may not disregard any simply because they address different aspects of patentability.

C. Practitioner Guidance

Submitting separate declarations for SME and obviousness is a best practice. A reference that has been a practitioner mainstay cited by both the Office and the AIPLA appears below.

- **Declaration Practice Under 37 CFR 1.132 (Rule 132)** (web addresses are provided below to copy/paste; the USPTO is unable to provide click-through links at this time, but is updating its systems to be able to in the future). Practitioners have responded that the below is their ‘go to’ Rule 132 ‘best practices’ deck for objective indicia declarations. The USPTO suggests, as above, when addressing multiple statutory issues (now SMEDs

directed to § 101 eligibility and traditionally § 103 obviousness or related issues as discussed in the decks), a best practice remains to use separate Rule 132 declarations to avoid confusion and improve clarity. In this way each separately filed declaration is discretely focused on the specific rejection being traversed (and/or addresses any burden shifting as may be applicable) as well as the practical application and/or benefits from the claimed invention supported by the specification.

AIPLA: https://www.aipla.org/docs/default-source/committee-documents/bcp-files/2023/2023-03-28-declaration-practice.pdf?sfvrsn=e5bb191b_1

USPTO: https://www.uspto.gov/sites/default/files/documents/declaration_practice_under_37_cfr_1_132_.pdf

- **MPEP § 716.01(c)(III).** We have received several suggestions of a technical nature that longstanding MPEP 716.01(c)(III) may not describe the full import of a declaration as evidence. As such, commentators have suggested declarations do not have to ‘persuade’ and unless the examiner finds contrary evidence, are not per se ‘weighed.’ We are taking this feedback under advisement and reviewing whether this MPEP section would benefit by an update. For SMED Declarations, note that SMEDs are intended to provide a ‘window’ as to how a person of ordinary skill in the art would interpret the specification as to the practical application of the inventions claimed. We will keep you advised.

IV. Conclusion

Based on USPTO guidance, Federal Circuit precedent, practitioner best practices, and feedback on their experience, SMEDs addressing subject matter eligibility under Rule 132 should be submitted as separate documents and not combined with testimony on other issues such as obviousness. This approach:

- Ensures clarity and discrete relevance of the evidentiary record.
- Facilitates examiner review and decision-making.
- Enhances the clarity and may bolster probative value of the SMED.
- Reduces risk of procedural or substantive confusion.

- Concentrates the focus on the practical application of the claimed invention – providing a ‘constructive model’ relating to new fields of innovation.

References:

- USPTO SMED Memorandum to the Examining Corps, December 4, 2025
- MPEP 716, 2106.05(a), 2145
- MPEP 716.01(c)(III)
- *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992)
- *In re Sullivan*, 498 F.3d 1345 (Fed. Cir. 2007)
- *Enfish, LLC v. Microsoft*, 822 F.3d 1327 (Fed. Cir. 2016).
- *Ex Parte Desjardins*, Appeal No. 2024-000567 PTAB September 26, 2025, Appeals Review Panel (ARP) Decision).
- Declaration Practice Under 37 CFR 1.132 (Rule 132) (web locations above)
- USPTO TEE Training Materials

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