

MEMORANDUM

To: Patent Examining Corps

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

Subject: Subject Matter Eligibility Declarations

Date: December 4, 2025

As you know, on the first full day confirmed as Under Secretary of Commerce and the 60th Director of the USPTO, my first official act was to sign into issuance two patents—one in the field of distributed ledger/crypto technologies and another in medical diagnostics. Both patents reside in technical fields that have far too often faced conflicting (and confusing) questions about patent subject matter eligibility.

Three days later, I issued a rare Appeals Review Panel (ARP) decision *In re Desjardins*, Appeal No. 2024-000567 (PTAB September 26, 2025, Appeals Review Panel Decision) vacating a PTAB *sua sponte* Section 101 rejection. The PTAB rejection was vacated because the claims were directed to training a machine learning model on multiple tasks, while preserving prior tasks performed, which properly integrated an otherwise abstract idea into a practical application; therefore, the claim satisfied Step 2 of the framework set forth in *Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208 (2014). We specifically credited the claims for improving the functioning of the machine learning model itself, citing reduced storage requirements, lowered system complexity, and the prevention of “catastrophic forgetting.”

Critically, the ARP warned against overbroad Section 101 rejections because “[c]ategorically excluding AI innovations from patent protection in the United States jeopardized America’s leadership in [] critical emerging technolog[ies].” (*Desjardins*, p. 9).

On November 4, 2025, I designated the *Desjardins* decision as precedential to 1) ensure the case reasoning binds all examination and appeals activity, and 2) underscore that improvements in computational performance, learning, storage, data sets and structures, for example, can constitute patent-eligible technological advancements under the *Alice* framework.

Additionally, *Desjardin*’s reaffirmed that 35 U.S.C. §§ 102, 103, and 112—rather than § 101—are the proper inquiries for defining the scope of patent protection. To be sure, § 101 remains a subject matter gatekeeper but must be applied properly, as set forth in *Desjardins*.

Eligibility determinations can be difficult. I’ve noted in several stakeholder addresses that *Desjardins* is the framework for the “something more” that *Alice* instructs us to look for in evaluating Section 101. Especially with new and emerging technologies, the “something more” may be particularly challenging to divine so we need to evaluate, for example, how the invention is applied, how it operates and/or what it accomplished. For instance, when the claimed system

changes the architecture itself—e.g., how information flows, not just what it does—that may satisfy eligibility.¹

For our part, I have promised assistance and guidance. To deliver on these promises, I’ve tasked our USPTO Section 101 Working Group for their assistance on both fronts, and they have responded with clarity and precision.

We reminded applicants and practitioners of the existing voluntary option to supply their own evidentiary submission to attempt to overcome Section 101 rejections. We refer to this simply as a Subject Matter Eligibility Declaration (or SMED). Applicants and practitioners may file SMEDs under existing Rule 132 declaration practice, and, for those choosing to file, we urge them to file a SMED *separate* from any other declarations, e.g., those addressing non-101 rejections, such as under 102, 103, or 112.

Accordingly, this memo is being issued to raise examiner awareness about the existing option for applicants to submit a declaration under 37 CFR 1.132, an underutilized path to proffer evidence to establish subject matter eligibility of the claimed invention. The submission of such an evidentiary declaration may be helpful in demonstrating patent eligibility that may not be readily apparent. While the submission of a SMED is entirely optional for applicants, it can be used to clarify the record and lead to stronger issued patents.

This memorandum is consistent with existing USPTO guidance and does not announce any new USPTO practice or procedure.

USPTO Rules and Policies

MPEP 716 provides the USPTO’s guidance on affidavits² or declarations under 37 CFR 1.132.³ Section 1.132 gives applicants a way to submit evidence during prosecution of a patent application or a patent under reexamination. The USPTO’s subject matter eligibility guidance⁴ explains that in response to a rejection based on failure to claim patent-eligible subject matter, the applicant may submit evidence traversing the rejection according to the procedures set forth in MPEP 716.01 and 37 CFR 1.132.⁵

The general rules for evidentiary declarations as discussed in MPEP 716 apply to declarations addressing subject matter eligibility. Any person who has knowledge of the facts being asserted in the declaration may sign the declaration (e.g., an inventor, an inventor’s co-worker, an independent expert, or others). No special qualification other than knowledge of the facts is required. As

¹ It is noteworthy that the statutory definition of process set forth in 35 USC 100(b) recites that the “term ‘process’ means process, art or method, and *includes a new use of a known process, machine, manufacture, composition of matter, or material.*” (emphasis added).

² An affidavit is a statement in writing made under oath made before a notary public, magistrate, or officer authorized to administer oaths. A declaration may be used in place of an affidavit. *See* MPEP 602. Affidavits are rare, so the term “declaration” will be used throughout the remainder of this Memorandum.

³ The regulation provides that “[w]hen any claim of an application or a patent under reexamination is rejected or objected to, any evidence submitted to traverse the rejection or objection on a basis not otherwise provided for must be by way of an oath or declaration under this section.”

⁴ The USPTO’s subject matter eligibility guidance is found in MPEP sections 2103–2106.07, the [2024 Guidance Update on Patent Subject Matter Eligibility, Including on Artificial Intelligence](#) published on July 17, 2024 (89 FR 58128) (AI-SME Update), and the memorandum entitled [Reminders on evaluating subject matter eligibility of claims under 35 U.S.C. 101](#) published on August 4, 2025 (“101 Reminder Memo”).

⁵ *See* MPEP 2106.05(a) and 2106.07(b).

explained in MPEP 716.01, the declaration must be timely filed to be entered and entitled to consideration.⁶ In addition, the declaration must comply with other formalities.⁷ Applicants **are not required** to submit an evidentiary declaration in an application, and applicants cannot be penalized for not submitting a declaration.

For an evidentiary declaration to be relevant, there must be a nexus between the invention as claimed and the evidence provided in the declaration.⁸ For example, 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.⁹ To be of probative value, any objective evidence should be supported by actual proof.¹⁰

Further, the declaration **cannot be used** to supply information that was required to be present in the original disclosure upon filing.¹¹ In other words, while a declaration cannot be used to improperly supplement the original disclosure,¹² a declaration may be used to establish facts as of the filing date of the claimed invention. For example, in the context of subject matter eligibility, a claimed invention may be an eligible improvement in technology when the specification provides sufficient details such that one of ordinary skill in the art would recognize the claimed invention as providing a technological improvement and the claims reflect the disclosed improvement. The specification need not explicitly set forth the improvement, so long as the specification describes the invention such that the improvement would be apparent to one of ordinary skill in the art.¹³ In such a situation, a SMED may provide facts that describe the state of the art at the time of filing, provide objective evidence as to how the invention improved upon the state of the art, or provide a factual basis for determining that one of ordinary skill in the art would have concluded that the invention improved the underlying technology. When applicants are aware at the time of filing that certain evidence would be favorable to eligibility, they are strongly encouraged to include the evidence in the specification. While an opinion as to the legal conclusion itself (i.e., eligibility or ineligibility) is not entitled to any weight, the underlying factual basis for the opinion may be persuasive.¹⁴

Examiners should refer to MPEP 716 for guidance on handling declarations under 37 CFR 1.132. When the examiner determines that the declaration meets the formal requirements (i.e., timeliness, proper signature, willful false statements clause, etc.), the examiner must consider it on the merits. The examiner must carefully consider all of the applicant's arguments and the evidence rebutting the subject matter eligibility rejection when evaluating the applicant's response.¹⁵ The evidence provided in the declaration must be taken into account whenever properly presented; however, such evidence alone would not necessarily control the eligibility determination because the

⁶ MPEP 716.01 discusses timeliness requirements for declarations and other evidence traversing rejections.

⁷ See MPEP 716, for example, stating the requirement that a declaration must include the statutory language of 18 U.S.C. 1001 recognizing penalties for willful false statements and must state that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true.

⁸ See MPEP 716.01(b).

⁹ See MPEP 2106.05(a).

¹⁰ See MPEP 716.01(c); *see also* MPEP 2106.05(a).

¹¹ MPEP 2106.05(a) (citing, e.g., MPEP 716.09 on 37 CFR 1.132 practice with respect to rejections under 35 U.S.C. 112(a)).

¹² See MPEP 716.09.

¹³ See MPEP 2106.05(a).

¹⁴ See MPEP 716.01(c), subsection III.

¹⁵ See MPEP 2106.07(b).

examiner must weigh all relevant evidence of record and then determine whether the claims are eligible based on the preponderance of the evidence (i.e., more likely than not) standard.¹⁶ If the rejection is maintained in the next Office action, the examiner must explain, based on all evidence of record including the declaration, why the subject matter eligibility rejection has not been overcome.¹⁷ If the rejection is withdrawn in the next Office action, the examiner must explain, based on all evidence of record including the declaration, why the subject matter eligibility rejection has been overcome.¹⁸ The examiner should use Form Paragraphs 7.65 or 7.66 to comment on the declaration.¹⁹

Examples

An applicant submits a SMED to establish, for example, that, under *Alice* Step 2, a claim does not recite a judicial exception,²⁰ to identify when a judicial exception is integrated into a practical application,²¹ or to demonstrate that a claim amounts to significantly more than a judicial exception.²² The following examples show how a SMED may be useful to address issues pertaining to subject matter eligibility during patent examination.

Step 2 – Mental Processes

- The examiner determines that claim limitations to detecting suspicious activity and analyzing network packets using distributed processes spanning multiple machines having network monitors fall within the mental process grouping of abstract ideas at Step 2. The applicant responds by submitting arguments and a SMED containing evidence explaining that the claim limitations cannot practically be performed in the human mind. The SMED provides expert testimony on how one of ordinary skill in the art would interpret the claim limitations, in view of the specification, as being unable to practically be performed in the human mind and the underlying factual basis for that conclusion. In particular, the SMED includes testimony on how one of ordinary skill in the art would interpret the specification's teaching that the network monitors are installed on multiple machines and each perform a different analysis of network packets (i.e., distributed processes), and provides objective evidence showing that these teachings cannot be practically performed in the human mind. If the examiner determines that the SMED does not improperly supplement the specification, and that there is a nexus between the claimed invention and the evidence provided, the examiner should weigh all relevant evidence of record to determine if this objective evidence of eligibility, when taken together with any other evidence of record, overcomes the *prima facie* case of ineligibility set forth in the previous Office action based on the preponderance of the evidence standard.²³ The examiner should document the findings and conclusions in the next Office action.

¹⁶ See MPEP 716.01(d); 2106.07(b). See also the 101 Reminder Memo for a discussion of the preponderance of the evidence standard.

¹⁷ See MPEP 716 et seq.

¹⁸ *Id.*

¹⁹ See MPEP 716.

²⁰ See MPEP 2106.04(a)(2), subsection III.

²¹ See MPEP 2106.04(d).

²² See MPEP 2106.05.

²³ This hypothetical example is modeled after the technology in *SRI Int'l, Inc. v. Cisco Sys.*, 930 F.3d 1295, 1304 (Fed. Cir. 2019).

Step 2 – Improvements to the Functioning of a Computer or to Any Other Technology or Technical Field

- An examiner rejects a claim as directed to an abstract idea without additional elements that amount to an inventive concept. In response, the applicant argues that the claimed invention to a self-referential table for a computer database provides an improvement to the functioning of a computer under Step 2. A SMED provides expert testimony to establish the state of the art at the time of filing and how one of ordinary skill in the art would interpret the disclosed invention as improving the functioning of a computer, and the underlying factual basis for that conclusion (i.e., the specification's discussion of the prior art and how the invention improved the way the computer stores and retrieves data in memory in combination with the specific data structure recited in the claims). The declaration also explains where the improvement is reflected in the claim. If the examiner determines that the SMED does not improperly supplement the specification and that there is a nexus between the claimed invention and the evidence of improvement to functioning of a computer alleged by the applicant, the examiner should weigh all relevant evidence of record to determine if this objective evidence of eligibility, when taken together with any other evidence of record, overcomes the *prima facie* case of ineligibility set forth in the previous Office action, and document the findings and conclusions in the next Office action.²⁴
- An examiner rejects a claim as directed to an abstract idea without additional elements that amount to an inventive concept. In response, applicant argues that the claimed invention provides an improvement to neural network (NN) technology by addressing certain specific NN structural constraints of prior NN systems. The specification describes the claimed NN architecture and states that it offers superior performance over these prior art NN systems, but the specification fails to describe the specific performance improvements. A SMED, made by the inventor, accompanies the applicant's response. The SMED presents results of objective comparative testing showing that the claimed NN architecture provides superior regression performance over the prior NN systems identified in the specification. If the examiner determines that the SMED does not improperly supplement the specification and that there is a nexus between the claimed invention and the evidence of improvement to the neural network (NN) technology alleged by the applicant, the examiner should weigh all relevant evidence of record to determine if this objective evidence of eligibility, when taken together with any other evidence of record, overcomes the *prima facie* case of ineligibility set forth in the previous Office action and document the examiner's findings and conclusions in the next Office action.
- An examiner rejects a claim as directed to an abstract idea without additional elements that amount to an inventive concept. In response, the applicant argues that the claimed invention provides an improvement to computer animation technology by enabling the automation of specific animation tasks that previously could only be performed subjectively by

²⁴ This hypothetical example is modeled after the technology in *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016).

humans. A SMED provides expert testimony along with trade magazine articles to establish the state of the art at the time of filing, how one of ordinary skill in the art would interpret the disclosed invention as improving the functioning of a computer, and the underlying factual basis for that conclusion (i.e., the specification's discussion of the prior art and how the invention improved the computer by allowing it to perform a task that previously could only be performed subjectively by humans *via* a control flow based on morph weight sets). The SMED also points out how the improvement is reflected in the claim and provides objective evidence that, prior to the invention, animators used computers to interpolate between "keyframes" (important points or frames in an animated sequence) rather than adjusting every frame of the sequence. The SMED further demonstrates that the particular rules recited in the claim enable the automation of this process, which was not able to be automated previously. If the examiner determines that the SMED does not improperly supplement the specification and that there is a nexus between the claimed invention and the evidence of improvement to computer animation technology, the examiner should determine if this objective evidence of eligibility, when taken together with any other evidence of record, overcomes the *prima facie* case of ineligibility set forth in the previous Office action based on a preponderance of the evidence standard. The examiner should document the findings and conclusions in the next Office action.²⁵

Step 2 – Particular Treatment or Prophylaxis

- The examiner rejects a claim drawn to a method of prophylaxis as directed to an abstract idea without additional elements that amount to an inventive concept. The claim recites the steps of: (a) administering heartworm disease booster shots to a first set of domestic canines based on a series of prophylactic schedules; (b) determining the lowest-risk prophylactic schedule by analyzing data on whether the canines later developed heartworm disease; and (c) administering heartworm disease booster shots to a second set of domestic canines based upon the lowest-risk schedule. The examiner considers step (b) ("determining . . . by analyzing") to fall within the mental process grouping of abstract ideas under Step 2. The examiner considers step (a) ("administering") to be an extra-solution activity because the administration is performed to gather data for the analysis step and is a necessary precursor for all uses of the recited exception. The applicant responds by arguing that the claim recites the additional element (c) such that the invention applies or uses information from the analysis in step (b) to effect a particular prophylaxis for a disease in accordance with MPEP 2106.04(d)(2).²⁶ The applicant points out that the additional element has more than a nominal relationship to the judicial exception because it uses the recited abstract idea in step (b) in a manner that imposes a meaningful limit on the mental process. Namely, information from the mental process is used to alter the timing and order of doses so that the second set of canines have a lower risk of developing the disease. In this way, the applicant argues that step (c) integrates the abstract idea into a practical application under Step 2. The response highlights a portion of the specification that explains how the prophylactic schedule data is evaluated to determine the lowest-risk prophylactic schedule

²⁵ This hypothetical example is modeled after the technology in *McRO, Inc. v. Bandai Namco Games Am., Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016).

²⁶ MPEP 2106.04(d)(2) explains that "[o]ne way to demonstrate such integration is when the additional elements apply or use the recited judicial exception to effect a particular treatment or prophylaxis for a disease or medical condition."

(i.e., lowest likelihood of developing the disease); and how prophylaxis schedules are accordingly adjusted based on that information. In support of this, the applicant points to evidentiary data provided in a SMED to show that a person of ordinary skill in the art would have understood that adjusting the prophylactic schedule as disclosed would lower the susceptibility of the second group of domestic canines to the disease. If the examiner determines that the SMED does not improperly supplement the specification and there is a nexus between the claimed invention and the evidence provided, the examiner should determine if this objective evidence of eligibility, when taken together with any other evidence of record, overcomes the *prima facie* case of ineligibility set forth in the previous Office action based on a preponderance of the evidence standard. The examiner should document the findings and conclusions in the next Office action.²⁷

Step 2 – Amounting to Significantly More

- The examiner asserts in a subject matter eligibility rejection that claim limitations to filtering content on the internet are certain methods of organizing human activity and makes a factual determination that the additional elements of the claimed invention are well-understood, routine, and conventional components as described in the specification. The applicant responds by submitting arguments and a SMED containing evidence explaining that although the additional elements are conventional when considered individually, the claimed unconventional arrangement of additional elements amounts to an inventive concept. The SMED provides expert testimony, supported by objective evidence, as to how the claimed invention carves out a specific location for the filtering system (a remote ISP server) with customizable filtering features specific to each end user. The testimony explains how this specific arrangement of filters provides efficient operations while allowing user-level flexibilities not seen in prior art systems. This claimed unconventional arrangement and the advantages of this arrangement were described in the specification. If the examiner determines that the SMED does not improperly supplement the specification and there is a nexus between the claimed invention and the evidence provided, the examiner should determine if this objective evidence of eligibility, when taken together with any other evidence of record, overcomes the *prima facie* case of ineligibility set forth in the previous Office action based on a preponderance of the evidence standard. The examiner should document the findings and conclusions in the next Office action.²⁸

Training resources

Training resources and current materials on subject matter eligibility are available on the [35 U.S.C. 101 intranet webpage](#).

Training resources on declaration practice under 37 CFR 1.132 can be found here:

²⁷ This hypothetical example is modeled after the technology in *Classen Immunotherapies, Inc. v. Biogen IDEC*, 659 F.3d 1057 (Fed. Cir. 2011). Cf. MPEP 2106.04(d)(2).

²⁸ This hypothetical example is modeled after the technology in *BASCOM Global Internet Servs. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016).

- [Entry Level and Training for Experienced Examiner \(TEE\) Training materials: Declaration Practice Under 37 CFR 1.132;](#)
- [TC 1600 Job Aid on Evidence of Unexpected Results Under 37 CFR 1.132;](#) and
- [Declaration practice under 37 CFR 1.132 \(Rule 132\).](#)

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