# Drafting Tech Patents After USPTO's Eligibility Memos

By **Nina Borders and Mitesh Patel** (February 13, 2026)

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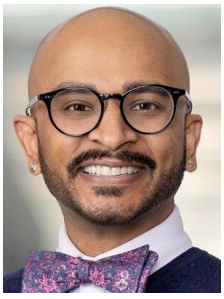

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The U.S. Patent and Trademark Office closed 2025 by **issuing** two practice-shaping memoranda on subject matter eligibility declarations, or SMEDs: one to the examining corps detailing examiner obligations, and a companion to applicants and practitioners setting out best practices for submitting SMEDs as separate, eligibility-focused declarations under Title 37 of the Code of Federal Regulations, Section 1.132.

The examiner memo reinforces that SMEDs are voluntary, must demonstrate a clear nexus to the pending claims, cannot introduce new matter and are assessed under a preponderance of the evidence; examiners are expected to articulate how they weighed SMED evidence in the next USPTO action.

The USPTO's applicant memo urges separate, stand-alone SMEDs, rather than combining with Section 103 evidence, for example, to prevent doctrinal cross-contamination and to streamline eligibility analysis.

The USPTO situates this guidance alongside the USPTO's precedential Ex parte Desjardins **decision**, which confirmed last year that concrete improvements in computational performance, learning efficacy, storage utilization and data-structure design can support eligibility when included in the patent claims.

**Section 101 and SMED Mechanics**

A U.S. patent secures a time-limited right to exclude others from making, using or selling the claimed invention in exchange for public disclosure.

Examination tests multiple statutory gates: subject matter eligibility, novelty, nonobviousness and adequate disclosure.

Section 101 is the threshold eligibility gate. Before the office asks whether an invention is new and nonobvious, it asks whether the claims are directed to patent-eligible subject matter.

Office guidance and case law make clear that properly supported claims that improve computer technology or apply a judicial exception in a specific, practical and technological manner can satisfy this gate — which is often referred to as providing something more, beyond an abstract idea.

For technology companies, this means that an AI system or software product must do more than simply automate a known process; it should improve the functioning of the computer itself or solve a technical problem in a novel way and not be just an abstract idea.

A SMED is a sworn declaration from an inventor or qualified expert that supplies objective, claim-tied facts relevant to patent eligibility. Well-constructed SMEDs marshal reproducible metrics and technical explanations.

For example, demonstrating that a claimed model architecture reduces training instability, improves inference latency at a fixed accuracy, compresses memory footprints without loss in performance, or integrates an abstract processing step into a concrete control system may tip the balance in favor of patent eligibility.

In business terms, if your AI innovation makes computers run faster, use less memory, train more reliably or perform tasks that were previously impractical, a SMED can help document those advantages in a way that supports patentability.

Critically, SMEDs are not vehicles for new matter; they must rest on what the specification teaches and what a skilled artisan would understand. Examiners must consider them on the totality of the record under a preponderance standard and explain how the evidence affected the outcome.

**Why This Matters for AI and Software Claims**

For AI-related and software claims, Section 101 outcomes frequently turn on whether the record demonstrates a technological improvement to computer functionality or a meaningful application of an abstract concept.

The SMED framework offers a disciplined way to put that story into evidence. Positioning a separate, eligibility-only declaration helps the examiner map specific claim elements to measured technical effects, reducing the risk that eligibility analysis drifts into obviousness

or enablement.

Where the record includes well-described benchmarks, ablation studies and side-by-side comparisons tied to the claim language, the preponderance standard can be decisive in close cases.

Conversely, because a SMED cannot cure thin specifications, applicants should draft with eligibility in mind: Describe the mechanism of improvement, the operational context and the computer-centric consequences, and then claim those features as much as possible so that the declaration can connect the dots.

From a practical perspective, persuasive SMEDs tend to do three things. They speak the language of the claims, they quantify the asserted improvement with transparent methodology, and they situate the improvement effect within the architecture of a computer system or model pipeline.

Avoid conclusory statements, generic benefits untethered to claim limitations, and mixed declarations that commingle Section 101 and Section 103 contentions.

Timing also matters. Applicants should consider promptly submitting a SMED once an eligibility refusal is providing difficult to overcome, so that the record develops in parallel with claim amendments, rather than as a last-minute gambit.

It's also important for applicants and practitioners to note that statements made in a SMED still become part of the record, which can create estoppel risks in future litigation.

The balance between drafting arguments for the USPTO and managing risks in potential future litigation still exists. However, the SMED appears to be a useful patentee-friendly tool to assist with eligibility determinations before the USPTO in what has been a challenging technology area for many years.

**What to Watch in Prosecution**

Expect closer attention in USPTO actions to how examiners articulate the weighing of SMED evidence, including whether they credit metrics and experimental controls and how they assess the nexus to specific claim limitations. Watch for additional training, job aids or form paragraphs that operationalize this weighing.

Practitioners should also track how Desjardins is invoked across art units handling AI and data-centric inventions, and whether examiners increasingly recognize improvements in data handling, model training dynamics, and memory or computer efficiency as computer technology improvements, rather than field-of-use gloss.

Finally, anticipate more dialog around the boundaries between eligibility-relevant improvements in computer functionality and performance gains that may sound in obviousness; keeping the record clean with a separate SMED will help cabin those debates.

**Bottom Line for Practitioners**

Targeted, stand-alone SMEDs that present objective, claim-anchored facts can meaningfully improve Section 101 outcomes for AI and software inventions, provided they build on robust specification support and crisp claim drafting.

The 2025 guidance effectively supplies an evidentiary playbook for AI and software patent applications. Draft to the improvement, claim the mechanism that delivers it and use a SMED to document measurable, reproducible and computer-centric effects.

Done well, that alignment turns eligibility from an abstraction debate into a technical showing, and can move close cases across the line to patentability.

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