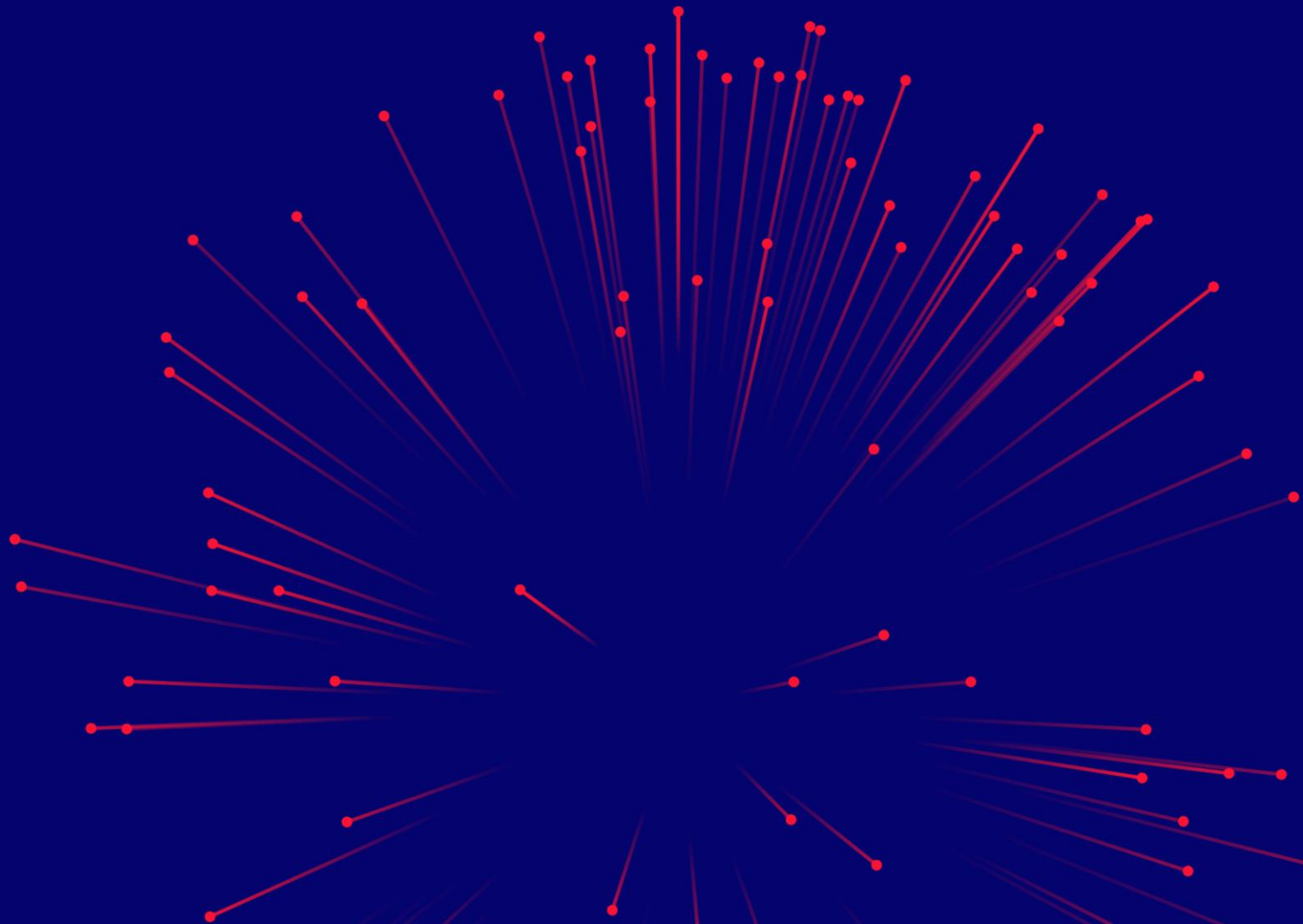
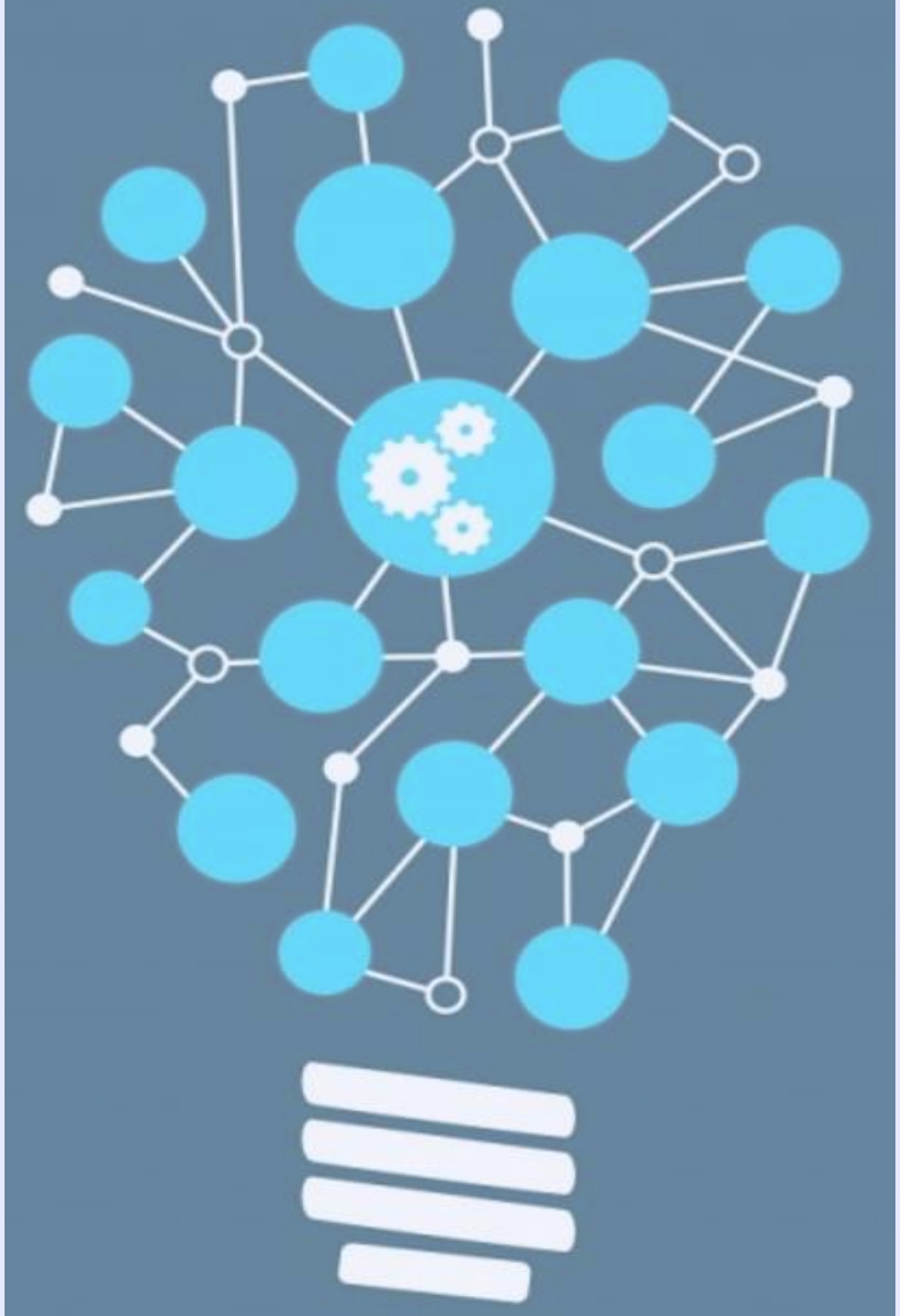
AI Patents Get the Green Light: *Enfish* Sets the Standard for Patent Eligibility

2025 – 2026 Legal Insights: A CLE Webinar Series



AI is everywhere...



AI is everywhere…

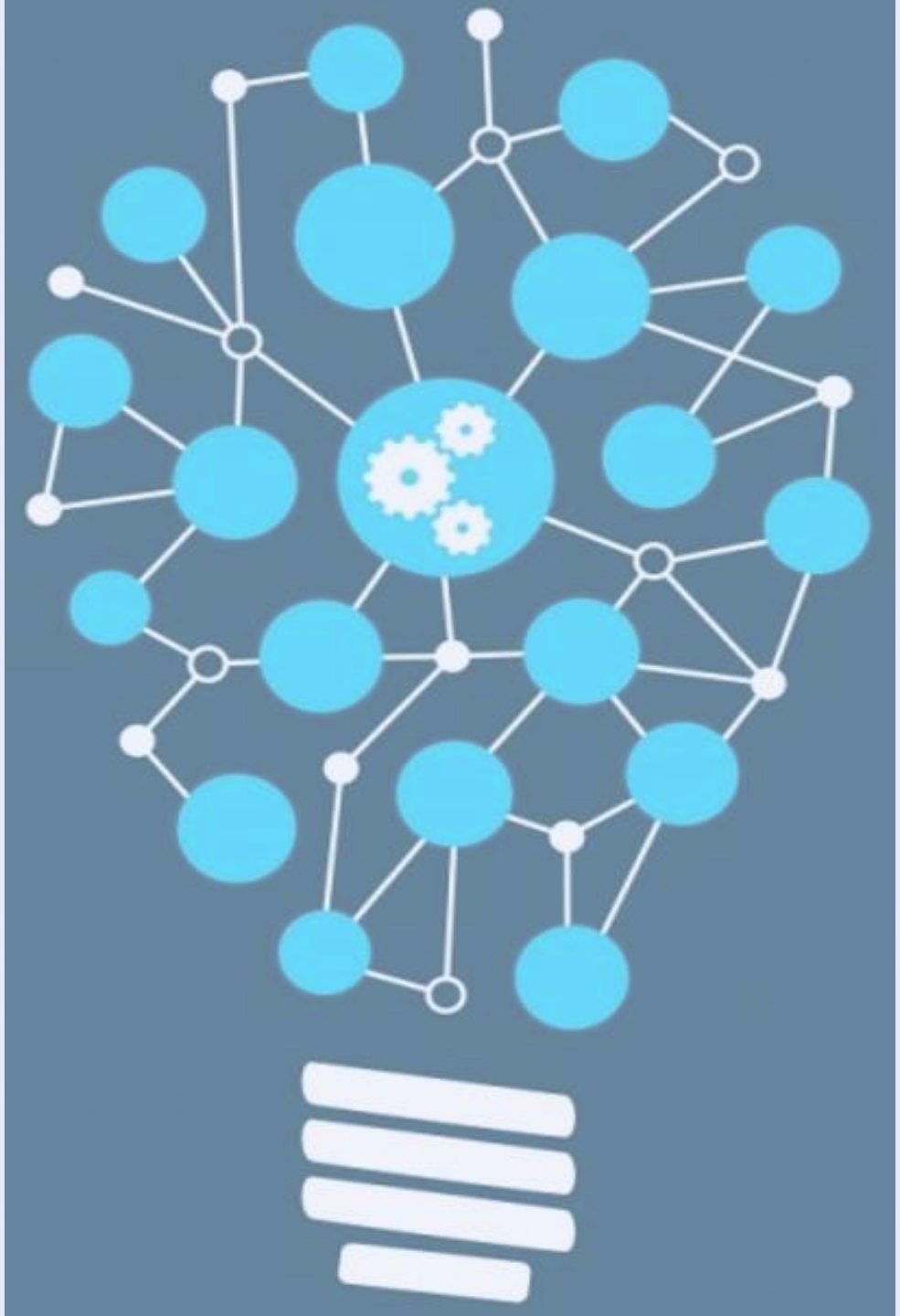
Agentic

Analytical

Generative

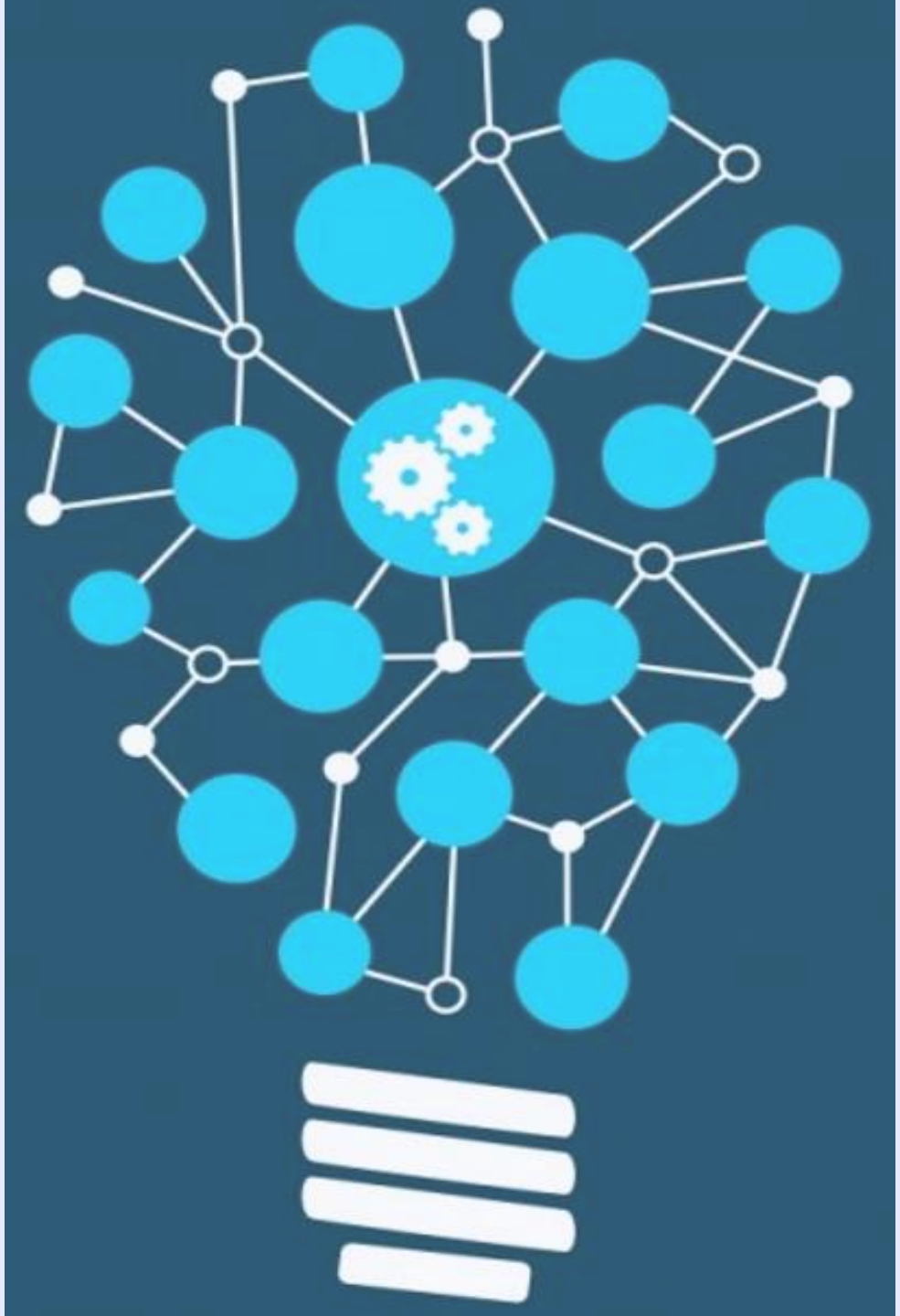
AI Factories

Assistants



AI is everywhere…

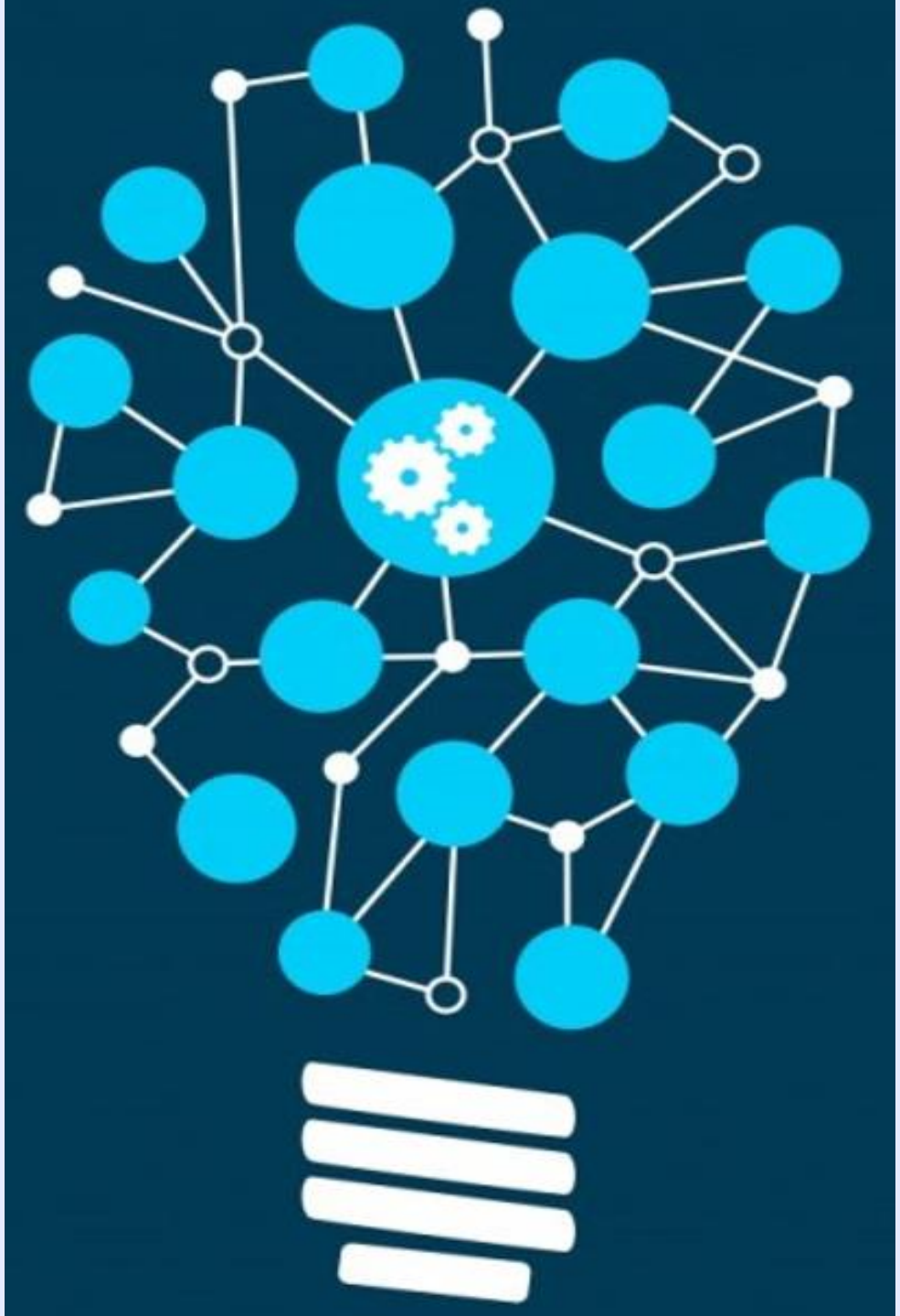
and it is increasingly patentable…



AI is everywhere...

and it is increasingly patentable...

with the right strategy!



Strategic Counseling Takeaways

Based on the USPTO's latest guidance and our practical experience

- The Time is Ripe to Patent Your AI
- Think Big… But Protect Incrementally
- Beware of AI Slop
- Do More Than Merely Automate a Manual Process
- Link Claim Language to *Improvements* in Specification
- Avoid "Conventional" Machine Learning Models
- Describe Specific Machine Learning Models
- Avoid Claiming both Inferencing and Training
- Select Claim Terms Carefully
- Consider Using Subject Matter Eligibility Declarations ("SMEDs")

USPTO Guidance

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The Landscape Has Shifted to Permissive

Key Insight

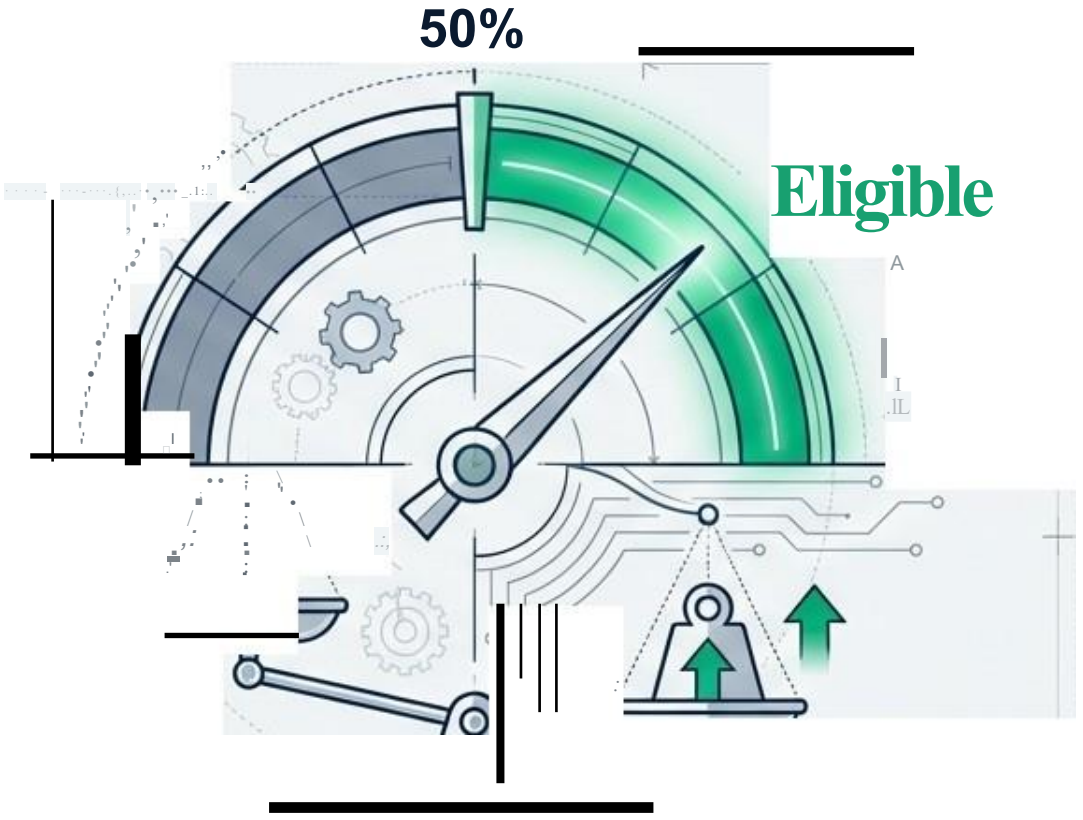
The USPTO seeks to ensure the US maintains leadership in emerging technology.

The '50% Rule' (August 2025 USPTO Memo)

If patent eligibility is a "close call" (if the likelihood of eligibility is greater than 50%), examiners must find eligibility.

"Categorically excluding AI innovations from patent protection in the United States jeopardizes America's leadership in this critical emerging technology."

(Ex Parte Desjardins, page 9)



Enfish is the Standard

“Enfish ranks among the Federal Circuit's leading cases on the eligibility of technological improvements.”

“[E]ligibility determinations should turn on whether ‘the claims are directed to an improvement to computer functionality versus being directed to an abstract idea.’”

(Ex Parte Desjardins, page 8).

Ex parte Desjardins

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Ex parte Desjardins
USPGP 2019/0236482 (Google / DeepMind Technologies Limited)

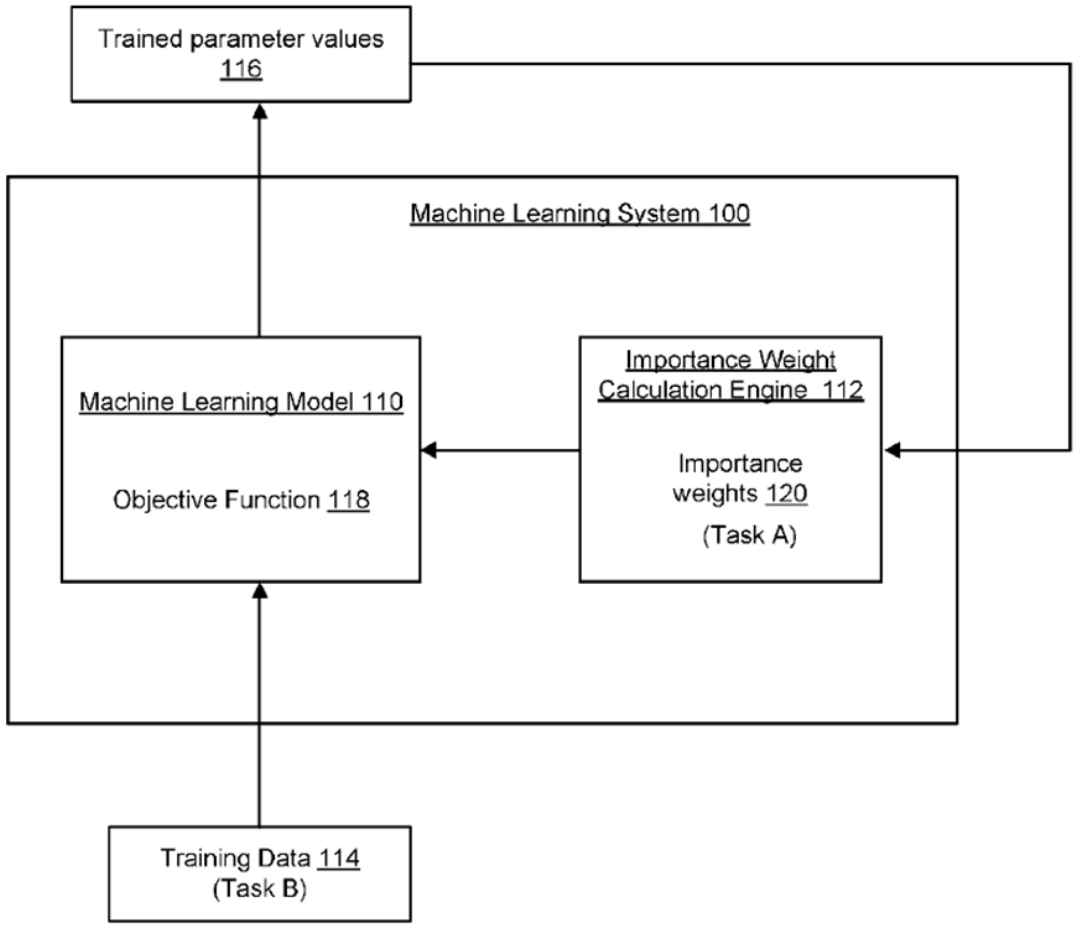
“Training Machine Learning Models on Multiple Machine Learning Tasks”

The Problem: Catastrophic Forgetting

When an ML model learns a new task, it often overwrites weights needed for the old task.

The Solution: Strategic Preservation

An architecture that 'protects' specific parameters during training, allowing sequential learning without data loss.



Ex parte Desjardins
USPGP 2019/0236482 (Google / DeepMind Technologies Limited)

“Training Machine Learning Models on Multiple Machine Learning Tasks”

Why It Won:

It improved the tool itself. It enabled the AI to use less storage and reduced system complexity.

“This case demonstrates that §§102, 103 and 112 are the traditional and appropriate tools to limit patent protection to its proper scope. These statutory provisions should be the focus of examination.”

Ex parte Desjardins
USPGP 2019/0236482 (Google / DeepMind Technologies Limited)

Appeal 2024-000567 (Sept. 26, 2025) precedential Nov. 4, 2025

1. A computer-implemented method of training a machine learning model,

wherein the machine learning model has at least a plurality of parameters and has been trained on a first machine learning task using first training data to determine first values of the plurality of parameters of the machine learning model, and

wherein the method comprises:

determining, for each of the plurality of parameters, a respective measure of an importance of the parameter to the first machine learning task, comprising:

computing, based on the first values of the plurality of parameters determined by training the machine learning model on the first machine learning task, an approximation of a posterior distribution over possible values of the plurality of parameters,

assigning, using the approximation, a value to each of the plurality of parameters, the value being the respective measure of the importance of the parameter to the first machine learning task and approximating a probability that the first value of the parameter after the training on the first machine learning task is a correct value of the parameter given the first training data used to train the machine learning model on the first machine learning task;

obtaining second training data for training the machine learning model on a second, different machine learning task; and

training the machine learning model on the second machine learning task by training the machine learning model on the second training data to adjust the first values of the plurality of parameters to optimize performance of the machine learning model on the second machine learning task while protecting performance of the machine learning model on the first machine learning task,

wherein adjusting the first values of the plurality of parameters comprises adjusting the first values of the plurality of parameters to optimize an objective function that depends in part on a penalty term that is based on the determined measures of importance of the plurality of parameters to the first machine learning task.

Recentive Analytics, Inc. v. Fox Corp.

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Recentive v. Fox

The Invention

Automatic Generation of Network Maps

Using generic machine learning to generate network maps and TV schedules based on ticket sales and weather.

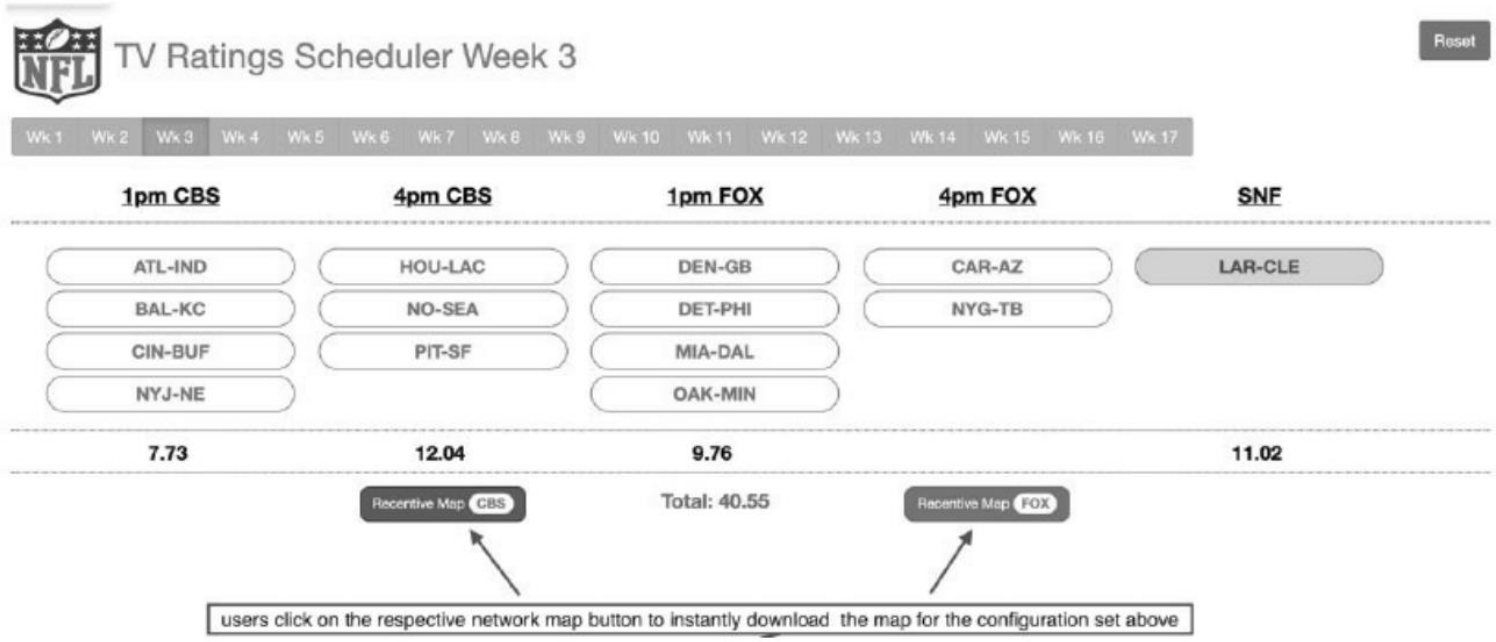
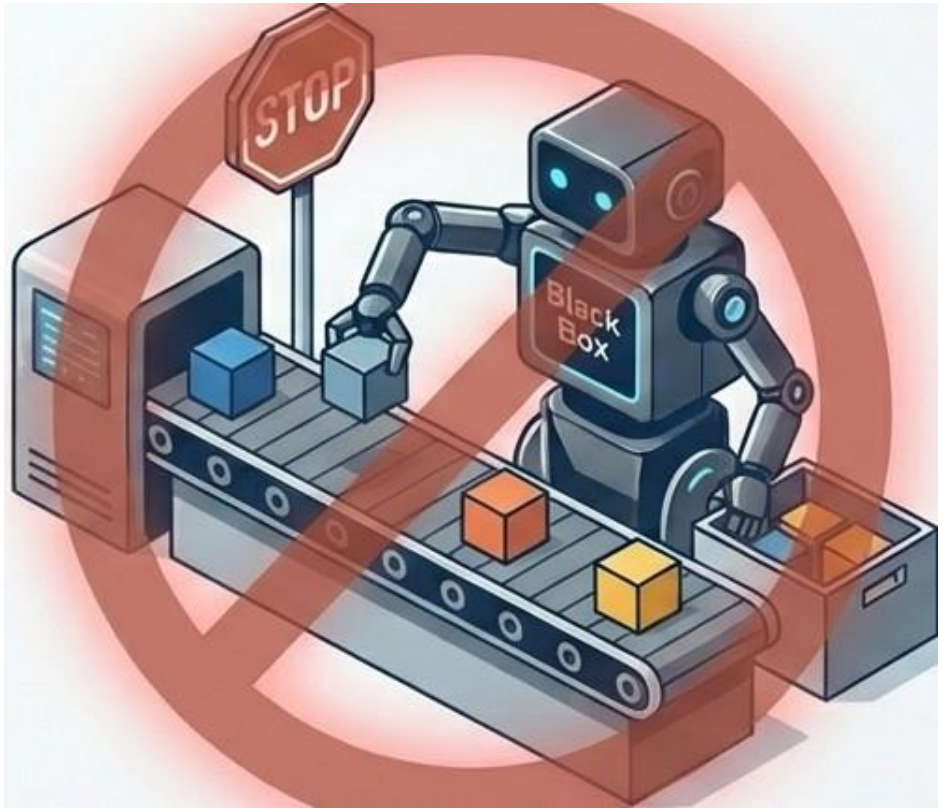


FIG. 1A

Recentive v. Fox

The Flaw…

"Today, we hold only that patents that do no more than claim the application of generic machine learning to new data environments, without disclosing improvements to the machine learning models to be applied, are patent ineligible under § 101."



Recentive v. Fox

The Takeaways…

Improving the Model - *Eligible*

Internal architecture, training methods, memory management.

Using the Model – *Not Eligible*

Output results, scheduling, applying generic ML to new data.

Best Practices in light of *Desjardins* and *Recentive*

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Patent-Eligible Aspects of AI

- Arrangements of layers or nodes
- Activation functions
- Loss functions
- Training frameworks
- Data cleansing techniques
- Methods for defining feature vectors
- Methods of using hardware to execute an AI model more efficiently

How Best to Protect AI IP

Trade secret protection

- Your AI model is not publicly identifiable via your commercial product
  - e.g., part of a SaaS offering that is not reverse-engineerable
- Your AI model is kept secret / protocols in place
- Competitor infringement cannot be detected
- Novelty lies in data rather than the model itself

vs.

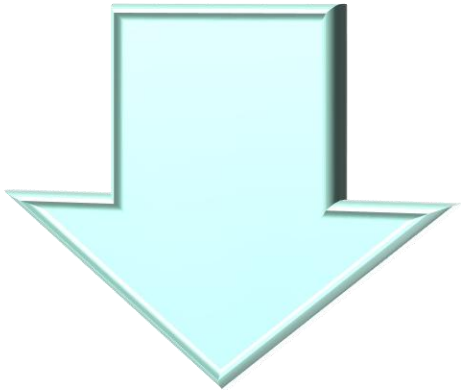
Patent protection

- Your AI model **is** publicly identifiable
- Your innovation relates to the architecture/structure of the AI model
- You are comfortable publicly disclosing

Patenting AI – When to File?

As early as possible after the invention is conceived?

- Priority date
- Prior art
- Before potential barring activity
- Constructive reduction to practice



Wait until invention is “ready” for patenting?

- Enablement
- Written Description
- Patent eligibility

Describing AI in a Patent Application

Technical details

- *Data used*
- *Implemented pipelines*
- *Model infrastructure*
- *Training framework*
- *Combinations thereof*

Relationships:

Between AI model inputs and AI model outputs

Data flows between AI model components

Computer Hardware Interactions with AI Model

- *e.g., a novel loss function that can be used by hardware to perform optimizations*

Alternative:

- *Architectures*
- *Use cases*
- *Scenarios*
- *Models*
- *Normalization Algorithms*
- *Activation Functions*
- *Feature Vectors*

Not Merely Automating a Manual Process

Argue that the automated process involves different steps than what a human would do in a manual process

"*It is the incorporation of the claimed rules, not the use of the computer, that 'improved [the] existing technological process' by allowing the automation of further tasks*..."

McRO, Inc. v. Bandai Namco Games America, Inc. (Fed. Cir. 2016)

Link Claim Language to Improvements

"*Moreover, our conclusion that the claims are directed to an improvement of an existing technology is **bolstered by the specification's teachings**.*" (*Enfish*)

*"The specification does not need to explicitly set forth the improvement, but it must describe the invention such that the **improvement would be apparent to one of ordinary skill in the art**."*

(August 2025 USPTO Memo)

"The claim itself does not need to explicitly recite the improvement described in the specification."

(August 2025 USPTO Memo)

Avoid Conventional Machine Learning Models

- Avoid merely applying off-the-shelf machine learning models in new applications
- Increased speed alone is not enough…

Describe Specific Models

- Be judicious and strategic when describing the types of machine learning models that are applicable to your invention.
- Avoid reciting “any suitable machine learning technology.”
- But… avoid reciting specific calculations by name

Avoid Claiming Inferencing and Training

- Often, one entity (e.g., the developer) trains a model, while a second entity (e.g., an end user) uses the trained model for inferencing
- If claiming a training process, claim inferencing passively
- If claiming an inferencing process, claim training passively

Terms to Consider when Claiming AI

"Algorithm" vs. "Model"

"Score" vs. "Metric"

"Module" vs. Specific Structure

Subject Matter Eligibility Declarations ("SMEDs")

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
- Provide a factual basis for determining that one of ordinary skill would have concluded that the invention improved the underlying technology
- Provide expert testimony on how one of ordinary skill would interpret the claim limitations, in view of the specification, as being unable to practically be performed in the human mins
- Present results of objective comparative testing, showing superior performance over prior art

A SMED must:

- Meet the formal requirements (timeliness, proper signature, willful false statements clause)
- Show a nexus between claimed invention and evidence provided
- NOT improperly supplement the specification

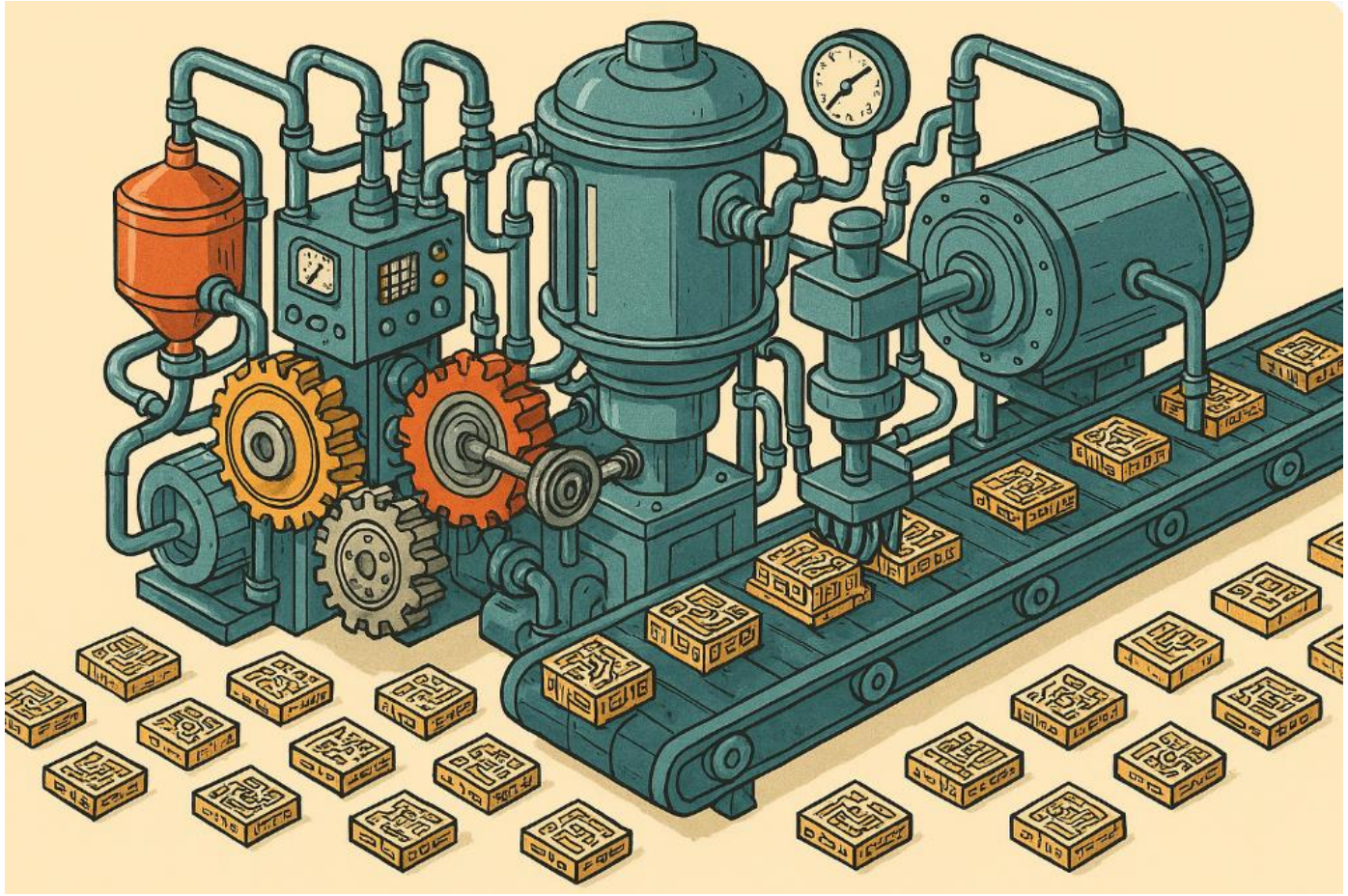
Perspectives from Enfish's lead counsel

Cooley

A Litigator's Perspective on Prosecution Strategy

§ 101 jurisprudence was developed in reaction to an epidemic of overclaiming software inventions

- § 101 in a nutshell for software inventions:
  - You can patent a particular, improved machine for making a widget (not the widget itself)
  - You cannot patent all machines for making the widget
- Is there a business case for obtaining patent protection commensurate with the scope of your invention?



A Litigator's Perspective on Prosecution Strategy

Thoughts on how to obtain patent claims that withstand federal court scrutiny

Good

Disclose structure in the specification

Remember source code appendices?

The value of dependent claims with lots of structure

Describe how the invention improves the operation of the computer

Provide examples and data

The halo effect from §112(f) claiming

Bad

Genus claims – bad for 101 & 112

Purely functional claiming

Overreaching claiming strategies

Admitting functional components are "well-known in the art"

Believing that persuading the examiner to allow = patent eligibility

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Thank you.