Disclaimer

The following presentation reflects the personal opinions of its authors and does not necessarily represent the views of their respective clients, partners, employers or of Amster, Rothstein & Ebenstein LLP, the New York Intellectual Property Law Association, the PTAB Committee, or their members.

Additionally, the following content is presented solely for the purposes of discussion and illustration, and does not comprise, nor is to be considered, as legal advice.

Agenda – 101 at the PTAB Under Stewart

Federal Circuit Decisions in 2025 Finding Claims Eligible

PTAB Decisions in 2025 Finding Claims Eligible (organized by Alice Steps)

Update on Federal Circuit Decisions 2025 finding claims eligible

Recentive Analytics, Inc. v. Fox Corp, No. 2023-02437 (Fed. Cir. April 18, 2025)

"**Machine learning** is a burgeoning and increasingly important field and **may lead to patent-eligible improvements in technology.** Today, we hold only that patents that do no more than claim the **App. of generic machine learning to new data environments**, without disclosing improvements to the machine learning models to be applied, **are patent ineligible under § 101**."

Slip-op. at 18.

"Claim 1 of the '367 patent is representative of the Machine Learning Training patents and recites a method containing:
(i) **a collecting step** (receiving event parameters and target features);
(ii) **an iterative training step for the machine learning model** (identifying relationships within the data);
(iii) **an output step** (generating an optimized schedule); and
(iv) **an updating step** (detecting changes to the data inputs and iteratively generating new, further optimized schedules)."

Slip-op. at 3.

Powerblock Holdings, Inc., v. IFit, Inc., No. 2024-1177 (Fed. Cir. August 11, 2025)

Indeed, we have "**cautioned that courts 'must be careful to avoid oversimplifying the claims**' by looking at them generally and f**ailing to account for the specific requirements** of the claims." *McRO*, 837 F.3d at 1313 (*quoting In re TLI Commc'ns LLC Pat. Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016)); see Alice, 573 U.S. at 217 ("**At some level, 'all inventions . . . embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas**.'" (omission in original) (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 71 (2012))).

Slip-op. at 11.

Claim 1 is limited to a **particular type of dumbbell**: a **selectorized dumbbell** with a **stack of nested left weight plates**, a **stack of nested right weight plates**, a **handle**, and a **movable selector** with different adjustment positions, where **moving the selector** to different adjustment positions **changes** the number of left and right **weight plates coupled to the dumbbell**. In addition, the claim recites that a**n electric motor is "operatively connected to the selector"** and **physically moves** the selector into the different adjustment positions corresponding to the desired weight selected by a user. '771 patent col. 12 ll. 4–5. ==**Claim 1** is thus "**limited to a specific implementation** of a **technological improvement** to" selectorized dumbbells.== *Chamberlain Grp., Inc. v. Techtronic Indus. Co.*, 935 F.3d 1341, 1347 (Fed. Cir. 2019). ==We hold that t**he limitations in this claim provide enough specificity and structure to satisfy § 101**.==

Slip-op. at 8.

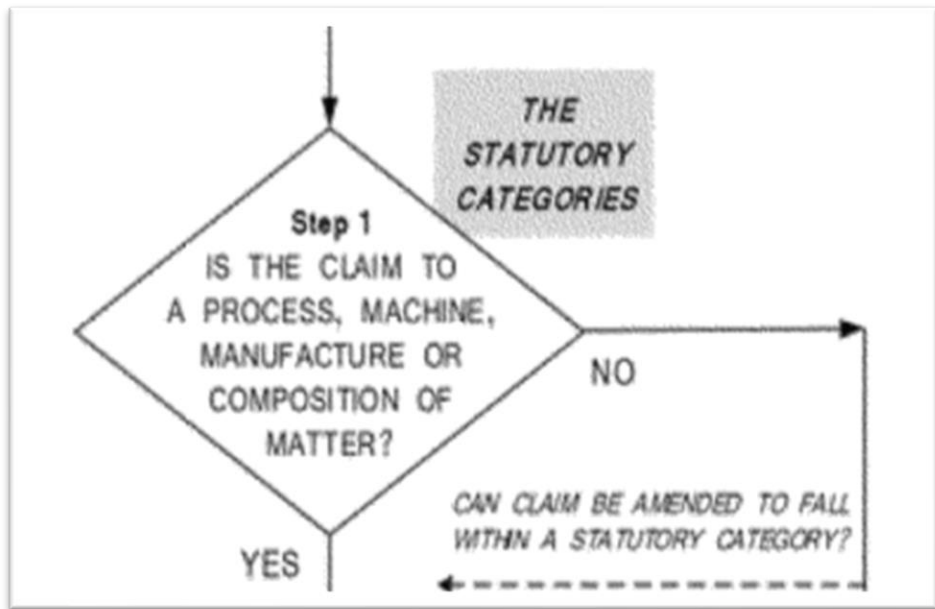# Current USPTO Guidance

USPTO Flow Chart for Patent Eligibility
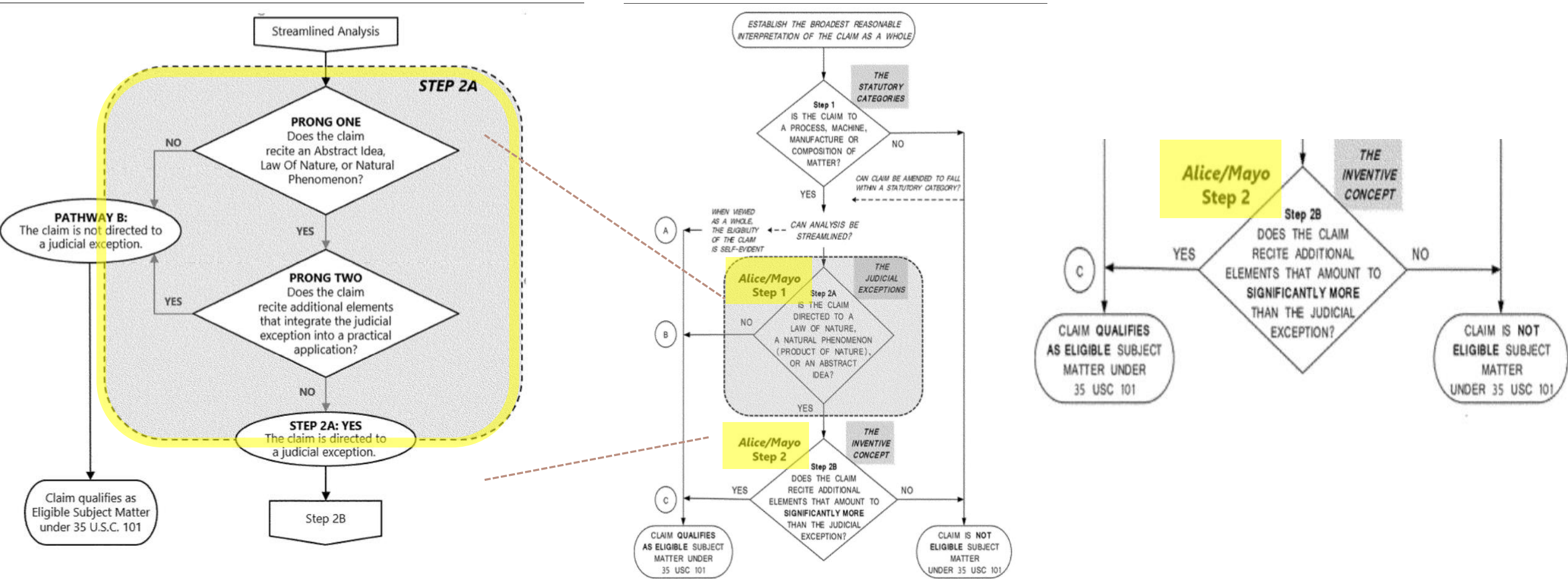
PTAB's new Approach to Applying Guidance

# Step 1: Is the Claim to a process, machine, manufacture or composition of matter

"transitory" signals

Tech Center 2100:

- ***Ex parte* Dev,** Appeal 2024-001942, App. 17/682,332 (PTAB Jun. 18, 2025) (Strauss, APJ) (the inclusion of **transient memory** (e.g., RAM) in the specifications definition of "non transitory computer readable media" does **not** make it cover "signals")

- ***Ex parte* JHA,** Appeal 2024-003734, App. 16/937,708 (PTAB Aug. 15, 2025) (MacDonald, APJ) (Recitation of "**non-transitory**" is **not** required when claim uses term "device")

Step 2A (Prong One): Does the claim recite an Abstract Idea, Law of Nature or Natural Phenomenon?
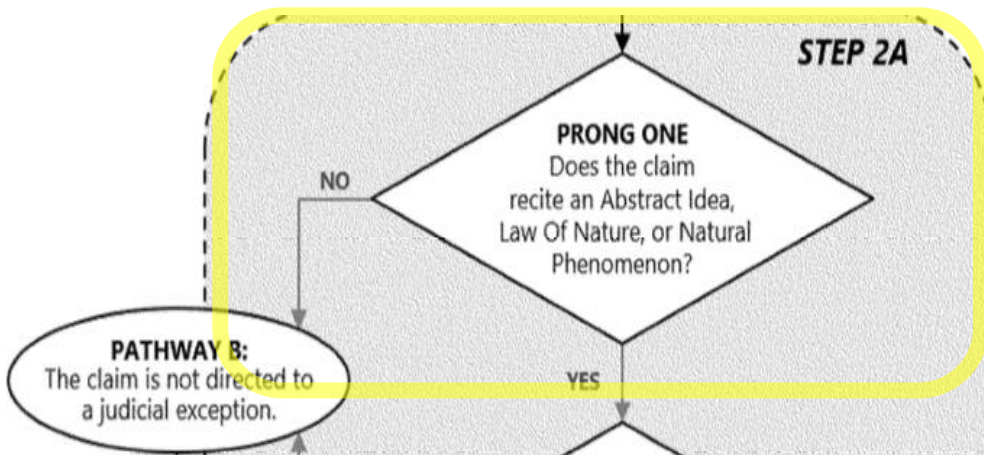
**"Natural Phenomenon"**

Tech Center 1700:

- *Ex parte* **LAURENT**, Appeal 2024-000085, USSN 16/473,945, (PTAB Jun. 3, 2025) (Wilson, APJ) (claim directed to crushed insect particles with parts separated had **different characteristics** than found in nature and thus **"markedly different"**)

- *Ex parte* **JAFFE**, Appeal 2024-003423, App. 16/651,737, Technology Center 1700 (PTAB Jul. 29, 2025) (Owens, APJ) (a medium comprising an "ammonium-containing contaminant" and bacteria that can oxidize ammonium is **not a natural phenomenon because** (a) a contaminant containing ammonium is not natural phenomenon because **ammonium is human made, even if such contaminants are found in nature**; and (b) the recited components are claimed in a medium, so it is **not sufficient for them to exist individually in nature** to invalidate under 101)

Step 2A (Prong One): Does the claim recite an Abstract Idea, Law of Nature or Natural Phenomenon?
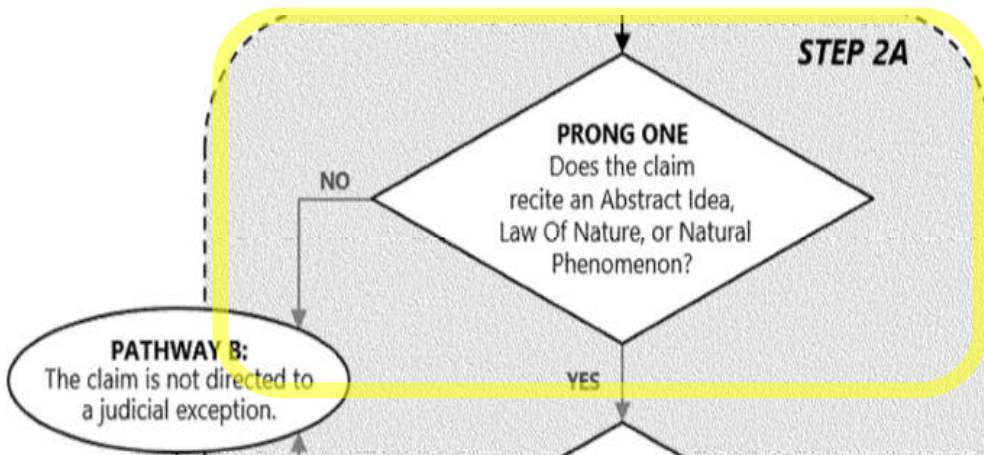

"Abstract Idea"

Tech Center 3600:
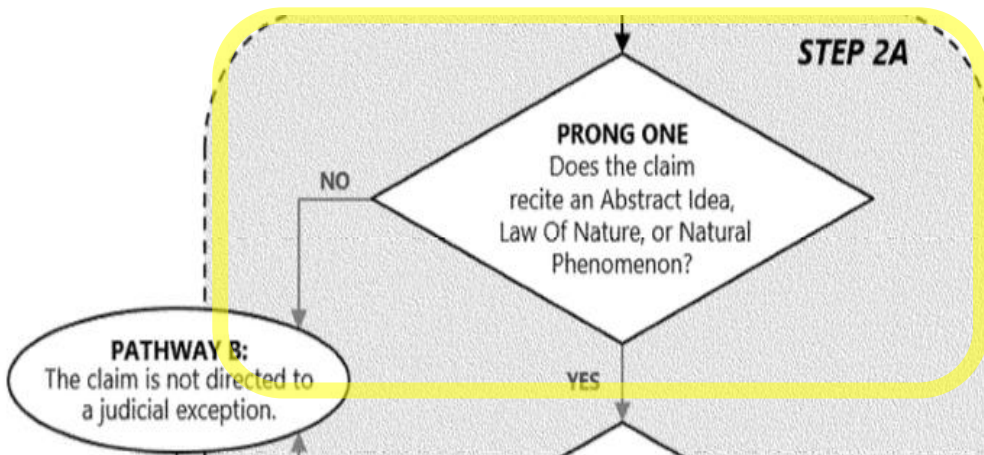
- *Ex parte* **LAM**, Appeal 2024-001647, App. 16/429,8201 (April 1, 2025) (Hoff, APJ) (rejected argument claim directed to "sales" when it was directed to using depth sensors and image sensors for a camera in **a non-conventional way** that reduces false positive product determinations is NOT directed to an abstract idea; analogized to *Thales* and *Diehr*)

- *Ex parte* **GALLAGER,** Appeal 2024-003776, App. 16/837,854 (April Feb 13, 2025) (Mohanty, APJ) (claims directed to secure content delivery validation keys were **mischaracterized** by claim as requiring "initiating a transaction" and "processing a contract"; also **mischaracterizing** "mental process" as a subgroup of "certain method of organizing human activity")

Step 2A (Prong One): Does the claim recite an Abstract Idea, Law of Nature or Natural Phenomenon?

"Abstract Idea"

Tech Center 2100:

- ***Ex parte* KALE,** Appeal 2024-004119, App. 16/458,924, (PTAB Aug.26, 2025) (Shaw, APJ) (claim is directed to an adaptive control machine learning method which is a specific improvement in the software arts, not an abstract idea; distinguish *Recentive* as "conventional" machine learning, while invention here modifies machine learning technique by being "**tuned during training**" and adjusting "**number of hidden layers**" or "**kernel calculation**" to implement a support vector machine; also claims delineated steps through which results were achieved)
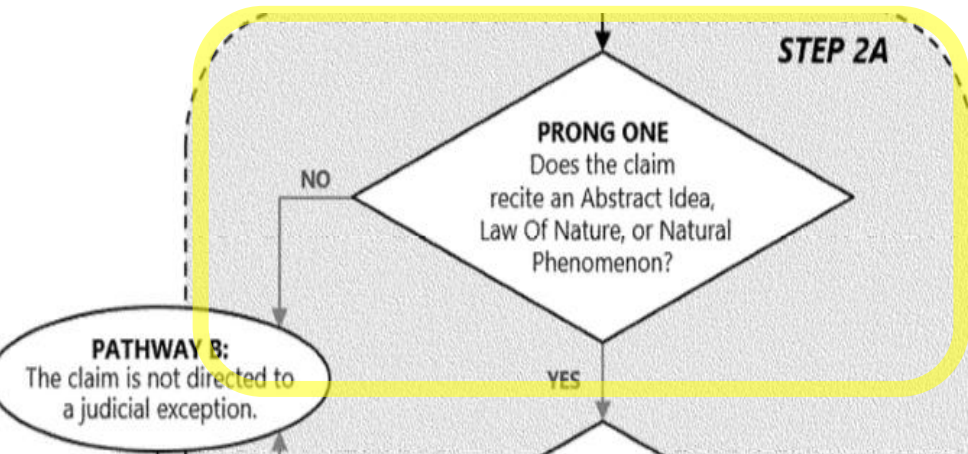
Step 2A (Prong One): Does the claim recite an Abstract Idea, Law of Nature or Natural Phenomenon?

"Abstract Idea"

Tech Center 3700:

- **_Ex parte_ MILLAHN**, Appeal 2024-001756, App. 16/837,486**, Appeal 2024-004119 (PTAB Aug. 22, 2025) (Jurgovan, APJ) (rejecting argument that claim for a medical navigation system that uses a camera with tracking arrays to track a bone and corresponding surgical instrument" merely covers a mental process**: concluding "computations required go beyond human mind"**)

July 24, 2025 Memo:

The mental process grouping is not without limits. **Examiners are reminded not to expand this grouping in a manner that encompasses claim limitations that cannot practically be performed in the human mind. The MPEP and the AI-SME Update provide examples of claim limitations that cannot be practically performed in the human mind.8 Claim limitations that encompass AI in a way that cannot be practically performed in the human mind do not fall within this grouping.**

Step 2A (Prong One): Does the claim recite an Abstract Idea, Law of Nature or Natural Phenomenon?

"Abstract Idea"

Tech Center 3700:

- ***Ex parte* SHIMUTA**, Appeal 2024-001746, App. 16/278,879 (PTAB Jun. 26, 2025) (Bui, APJ) (**Admonishes examiners to distinguish between reciting an exception vs. involving an exception;** claim reciting structure components (e.g. electro card, electrode, photoplethymographic sensor, blood pressure estimator) that interact with each other involving using additional applications which do not recite one or more judicial exceptions;)
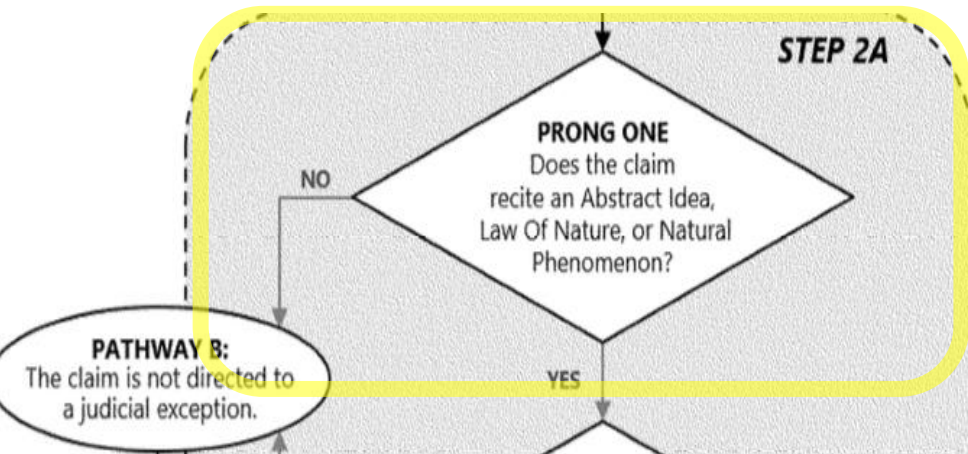
July 24, 2025 Memo:

Distinguishing claims that recite a judicial exception from claims that merely involve a judicial exception: Examiners should be careful to distinguish claims that recite an exception (which require further eligibility analysis) from claims that merely involve an exception (which are eligible and do not require further eligibility analysis).

Step 2A (Prong One): Does the claim recite an Abstract Idea, Law of Nature or Natural Phenomenon?

"Abstract Idea"

Tech Center 3700:

- ***Ex parte* PRONOVICI ,** Appeal 2024-003576, App. 17/142,420 (PTAB Jun. 26, 2025) (Bui, APJ) (claim to medical system that identify "events from mechanical motion data" in an improved patient specific way that controls delivery and timing of cardiac pacing delivery is **more than mere "mental concept"**)
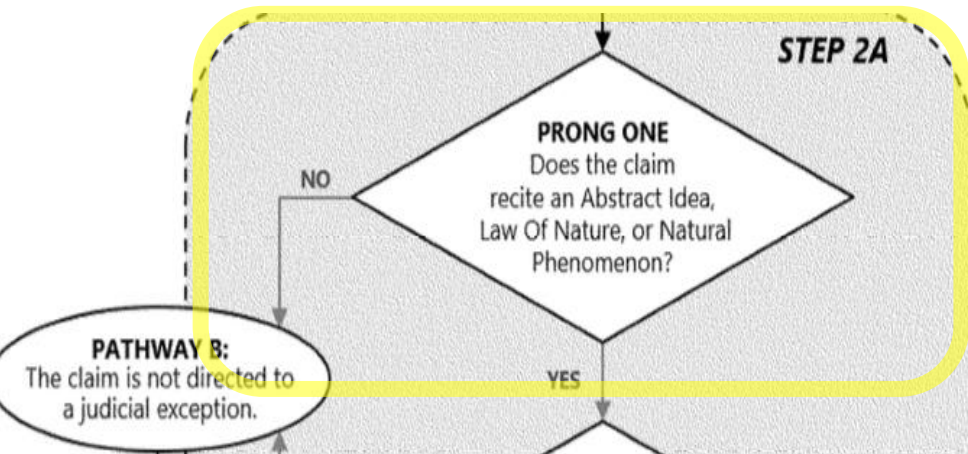
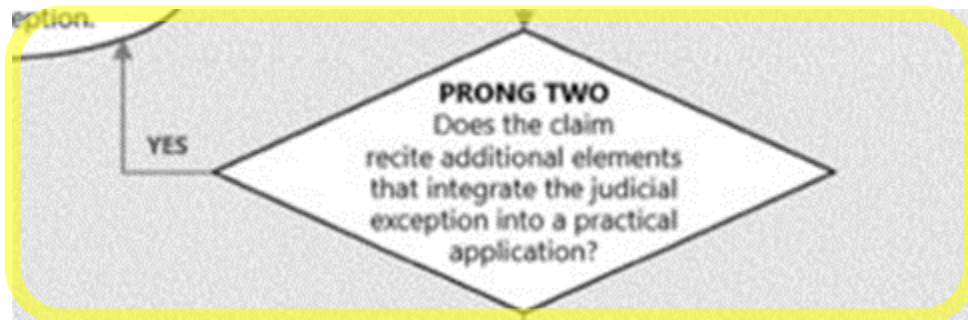# Step 2A (Prong Two): Does the claim recite a practical application?

PRONG TWO
Does the claim recite additional elements that integrate the judicial exception into a practical application?

"Abstract Idea"

Tech Center 3600:

- *Ex parte* **McENTEE**, Appeal 2025-000171, App. 14,680,391 (PTAB Aug. 18, 2025) (Shiang, APJ) (a data management and validation system that automatically normalizes data into a standard format is focused on a **"specific means or method that improves the relevant technology"**)

- *Ex parte* **BARRY**, Appeal 2024-002203, App. 16/921,595 (PTAB May 19, 2025) (Frahm, APJ) (a method which helps avoid self-trading by highlighting trades made within the same company improves user interfaces by displaying information even when in a collapsed view and thus **improves the "field of computer user interfaces"**)

> *July 24, 2025 Memo:*
>
> *Computer Improvements are practical applications:* In computer-related technologies, examiners can conclude that claims are eligible in Step 2A Prong Two by finding that a claim reflects an improvement to the functioning of a computer or to another technology or technical field, integrating a recited judicial exception into a practical App. of the exception.

Step 2A (Prong Two): Does the claim recite a practical application?

PRONG TWO
Does the claim recite additional elements that integrate the judicial exception into a practical application?

YES

==**"Abstract Idea"**==

Tech Center 3600:
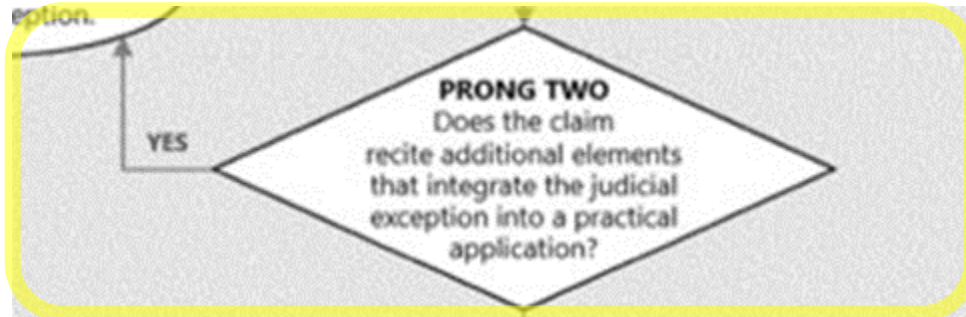
- ***Ex parte* MIRZA**, Appeal 2024-003559, App. 17/218,757 (PTAB May 7, 2025) (Howard, APJ) (minimizing computer demands through reduced data consumption in a trading system ==**"solves a problem that uniquely arises in the fields of computer technology"**==)

- ***Ex parte* NEWMAN,** Appeal 2024-002188, App. 16/411,389 (PTAB Jun. 06, 2025) (Reagan, APJ) (a blockchain based method of secure data storage that generates a multi-dimensional slidechain is ==**"a technical improvement in secure data storage across a network in a multi-dimensional distributed database"**== because thousands of contracts can be consumed simultaneously across the multi-dimensional slidechain)

- ***Ex parte* GROSSMAN**, Appeal 2024-003196, App. 16/705,140 (PTAB May 19, 2025) (Anderson, APJ) (automatically analyzing, comparing, and optimizing workflows through a trained autoencoder to improve efficiency and accuracy ==**overcomes a problem in the field of user design workflows**==)
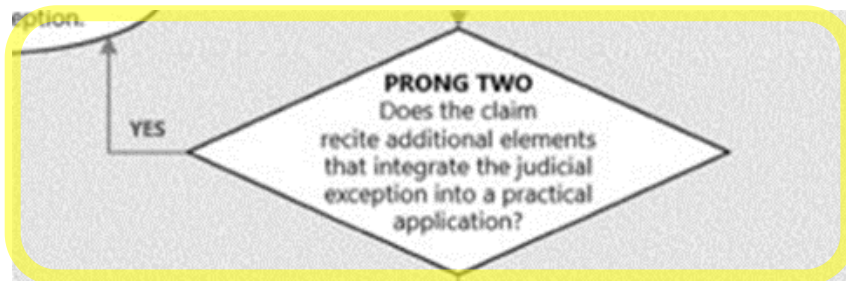
*See July 24, 2025 Memo: Computer improvements

Step 2A (Prong Two): Does the claim recite a practical application?
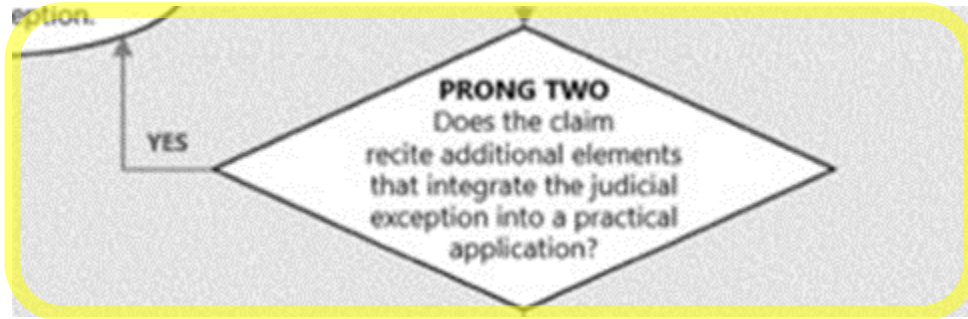

"Abstract Idea"

Tech Center 3600:

- **Ex parte LIS**, Appeal 2024-002090, App. 13/952,866 (PTAB Mar. 24, 2025) (Hughes, APJ) (a method of executing trades which handles various communication interfaces, across multiple devices, through a server associated API **"is a specific improvement in computer capabilities beyond simply claiming a desirable result"; relying upon** *Gemalto***, PTAB found claim recites "a sufficiently specific implementation" to integrate the abstract idea into a practical application directed to the abstract idea**)

- **Ex parte ROGAN**, Appeal 2024-001619, App. 17/786,116 (PTAB Jun.06, 2025) (Dang, APJ) (an airport airside advertising system that senses and displays an advertisement when an aircraft is detected **"specific improvement in a practical application"** because it is more "energy sufficient than previously known systems")

- **Ex parte GUAY**, Appeal 2024-001513, App. 16/948,938 (PTAB Apr.08, 2025) (Cutitta, APJ) (the reduction of trading data latency by prioritizing incoming data and sending high priority data over a fiber optic link is a **"technical improvement because the claim is directed to 'a novel technique for 'optimiz[ing] the utilization of bandwidth constrained links.'"**)

*See July 24, 2025 Memo: Computer improvements

Step 2A (Prong Two): Does the claim recite a practical application?

PRONG TWO
Does the claim recite additional elements that integrate the judicial exception into a practical application?

YES

"Abstract Idea"

Tech Center 3600:

- **Ex parte ROYERE**, Appeal 2023-002048, App. 16/634,365 (PTAB Feb. 20, 2025) (Hutchings, APJ) (a method of operating a nuclear reactor according to the threshold linear power from the relaxing step is an "**improvement in the technical field of nuclear reactor operation"**)

- **Ex parte SENGER**, Appeal 2024-000583, App. 17/099,477 (PTAB Mar. 11, 2025) (Hume, APJ) (a mobile App. which facilitates compliance with drug and alcohol recovery is "**an improvement in the technical field of patient monitoring and compliance"** because it sends rewards to the user's mobile device based on user proximity)
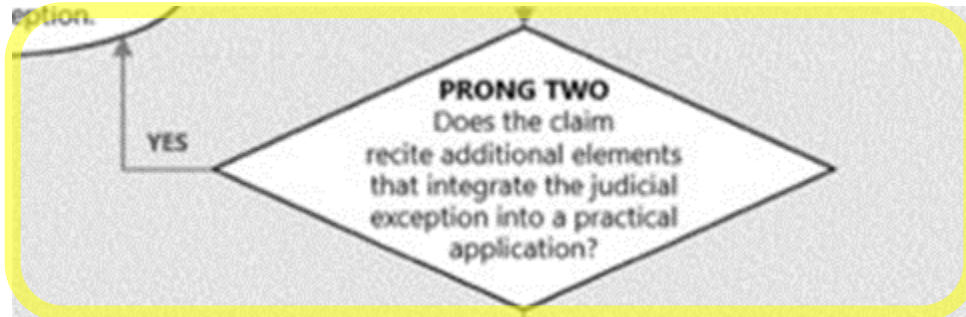
   See July 24, 2025 Memo: Computer improvements

Step 2A (Prong Two): Does the claim recite a practical application?

"Abstract Idea"

Tech Center 2100:

- *Ex parte* **BAKER**, Appeal 2025-003213, App. 17/753,727 (PTAB Aug. 29, 2025) (Beamer, APJ) (accelerating iterative training of a neural network by using data calculated in a previous iterations is "**an improvement to a technical problem"**)

- *Ex parte* **ZHANG**, Appeal 2024-001035, App. 12/762,298 (PTAB May 22, 2025) (McNeill, APJ) (a method of conditional commands which provides context relevant help to users when conditions are not met is "**an improvement to the function of a computer or other electronic appliance"**)

- *Ex parte* **KOGAN** , Appeal 2024-004123, App. 16/817,836 (PTAB Jul. 8, 2025) (Frahm, APJ) (a method of sensory parameter adjustment that prompts users to apply preconfigured sensory settings is a "**specific improvement in the computer technology of modifying user interfaces"** because it prevents sensory sensitive users from having to manually update and tune App. settings)
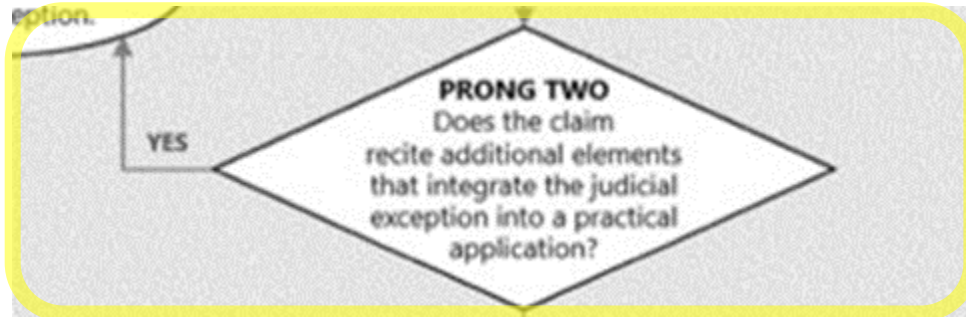
See July 24, 2025 Memo: Computer improvements

Step 2A (Prong Two): Does the claim recite a practical application?

"Abstract Idea"

Tech Center 2100:

- **Ex parte CAO**, Appeal 2024-002159, App. 16/591,239 (PTAB Feb.13, 2025) (Shiang, APJ) (a hybrid quantum-classical computer which "splits the linear system to be solved into subsystems that are small enough to be solved by the quantum computer" and then uses the classical computer to complete the linear calculation, enables "noisy quantum computers, which have limited circuit depth, to practically solve linear systems—**a technology improvement**.")

- **Ex parte TATAVU,** Appeal 2024-002847, App. 16/675,483 (PTAB Jul.10, 2025) (Fredman, APJ) (a method of creating a database hierarchy which combines both static and dynamic groups is an **"improved method of database management"** because it allows a user to retrieve members of both groups in a single query)

See July 24, 2025 Memo: Computer improvements

Step 2A (Prong Two): Does the claim recite a practical application?

YES — PRONG TWO: Does the claim recite additional elements that integrate the judicial exception into a practical application?

See July 24, 2025 Memo: Computer improvements

"Abstract Idea"

Tech Center 2800:

- *Ex parte* **JEANNE**. Appeal 2025-000119, App. 16/465,637 (PTAB Aug.13, 2025) (McNeill, APJ) (a method of gyroscope calibration in an electronic toothbrush that collects sensor data and adjusts the calibration settings "**improves the technology for calibrating a gyroscope of a toothbrush**")

- *Ex parte* **PARK**, Appeal 2024-000459, App. 16/773,604 (PTAB Feb.20, 2025) (McGee, APJ) (a geophysical prospecting method that estimates residual moveout (RMO) errors by running multiple RMO error picking algorithms and comparing the results is "**improved methodology for choosing among multiple [residual moveout (RMO)] error correction techniques**" because it improves information quality of a subsurface region)

- *Ex parte* **CIRULIS**, Appeal 2024-004139, App. 15/541,787 (PTAB Jul.1, 2025) (McNeill, APJ) (a cyclone monitoring apparatus that measures the acoustic noise profile of a cyclone is an **improvement in the "technical field of material separation"** because it focuses on a specific means that improve the relevant technology "**instead of being directed to a result or effect**")
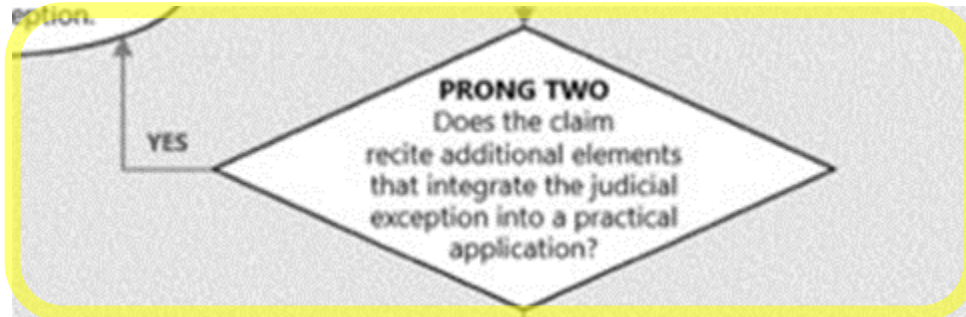
Step 2A (Prong Two): Does the claim recite a practical application?

"Abstract Idea"

Tech Center 2400:

- *Ex parte* **ZHOU**, Appeal 2025-000871, App. 17/557,989 (PTAB Aug.21, 2025) (Murray, APJ) (a cloud firewall resource management method that trains a machine learning model on network traffic logs to generate cloud network scaling recommendations is **"a technical solution . . . to the problem of determining how to scale firewalls appropriate for the network traffic being observed"** because it determines a predicted usage cost and provides a corresponding recommendation)
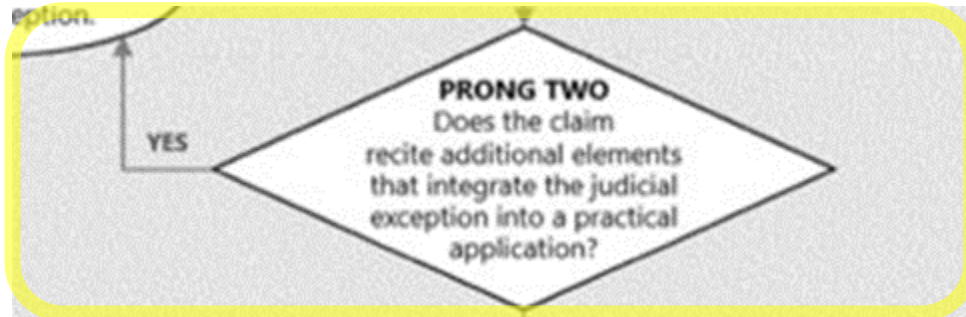
  *See July 24, 2025 Memo: Computer improvements

Step 2A (Prong Two): Does the claim recite a practical application?

**"Abstract Idea"**

Tech Center 1700:

- *Ex parte* **VERNON**, Appeal 2024-001628, App. 17/874,874 (PTAB Jun. 02, 2025) (Gupta, APJ) (a computer modeling and additive manufacturing system which creates internal lattice formations that conform to the curvature of tubular structures, is an **improvement** to "a system for creating an internal formation of a tubular structure")

- *Ex parte* **BEATY**, Appeal 2024-000120, App. 16/388,623 (PTAB Feb. 14, 2025) (Cashion, APJ) (a biosensor which adjusts its calculation of blood glucose for uncompensated resistance is an **improvement in the field of glucose monitoring**)

*See July 24, 2025 Memo: Computer improvements

CLE Code

Step 2B: Does the claim recite additional elements that amount to significantly more than the judicial exception?
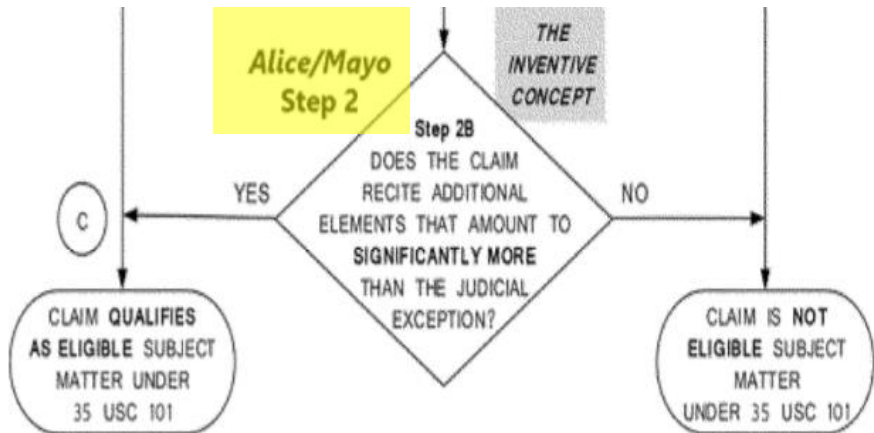

Technology Center 3700

Ex parte **NISHIYAMA,** Appeal 2023-003152, App. 16/575,967(PTAB Feb. 03, 2025) (Song, APJ) **(**As such, we find that the Examiner's determination that claim 1 does not transform the nature of the claim, i.e., that it "simply appends well- understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception," **is not fully supported in the record**. Guidance 56. At least based on the limited evidence before us, the recited "**controller that is configured to control the detector to selectively detect the 2-ethylhexanoic acid from a mixture containing two or more kinds of substance" is not well-known or understood and is of a configuration that performs an activity that is neither routine or conventional in the field, thereby indicating the presence of an inventive concept**. Guidance 56.)

Step 2B: Does the claim recite additional elements that amount to significantly more than the judicial exception?

Technology Center 3600
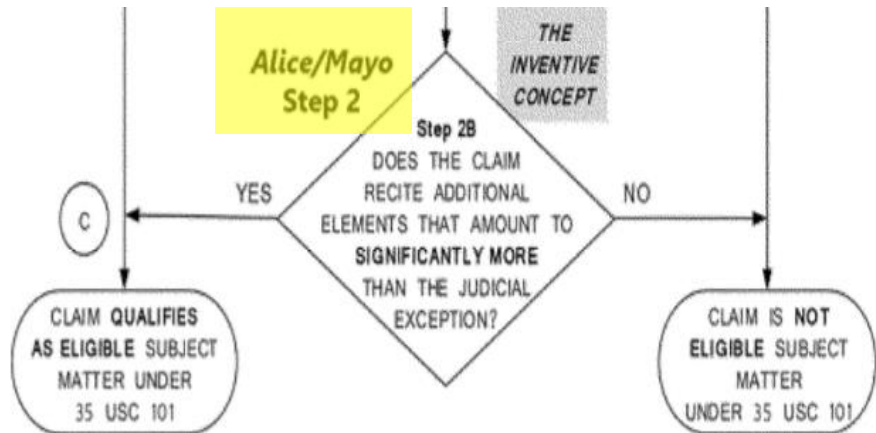
Ex parte **SUN**, Appeal 2025-000099, App. 16/822,592 (PTAB Sep. 02, 2025) (Hutchings, APJ) ("Because there is no indication **that the Examiner re-evaluated the combination of additional elements to determine whether the combination more than what is well-understood, routine, conventional activity in the field or provided support for such a determination**, we are constrained on the record before us to reverse the rejection of claims 1 and 12 at Step 2B.")

Step 2B: Does the claim recite additional elements that amount to significantly more than the judicial exception?

Technology Center 3600
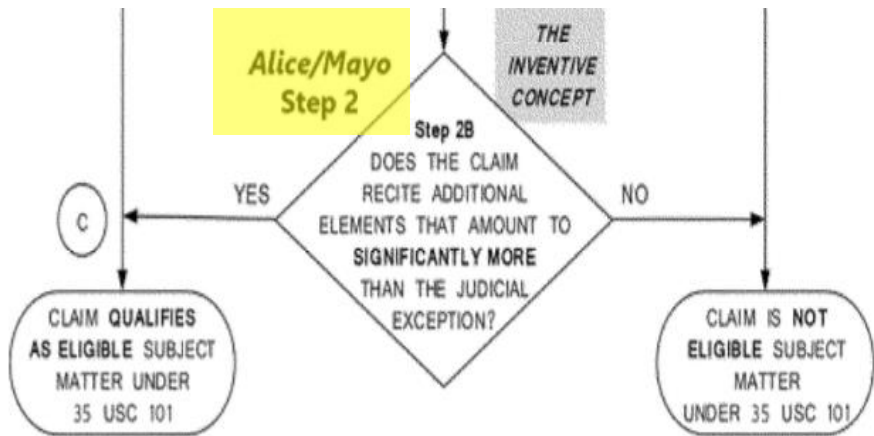
Ex parte **LANFRANCHI**, Appeal 2024-001895, App. 16/895,696 (PTAB Jul. 29, 2025) (Moore, APJ)(Even if, as the Examiner contends, the use and training of deep neural networks with LSTM cells was well-known, **the Final Action does not establish that it was well-known, routine, or conventional to train the network in the specific manner claimed**. We accordingly conclude that the Examiner has not established that the claims are ineligible under Section 101 and, therefore, do not sustain the rejection.")

Ex parte **SULTAN**, Appeal 2024-001030, App. 17/106,400 (PTAB Feb. 06, 2025) (Woods, APJ)("Although the Examiner cites evidence (i.e., the "Treadmill reference") that it was well-known for exercise machines to be automatically adjusted to simulate a hill, for example (see Ans. 5; see also Final Act. 5), **the Examiner has not shown that it was well-known, routine, or conventional for exercise machines to receive information via and be controlled by a remote host server. Indeed, the claims require transmitting information via a host server to control an exercise machine, such as by executing a requested competition program.** See Claims App. 21 (claim 21), 24 (claim 30), 26–27 (claim 41).")

Step 2B: Evidence is needed under Berkheimer Memo

Further, according to the USPTO Memorandum, dated April 19, 2018, of Changes in Examination Procedure Pertaining to Subject Matter Eligibility, noting subject matter eligibility decision (Berkheimer v. HP, Inc.) (i.e., the "Berkheimer Memorandum"),

[i]n a step 2B analysis, an additional element (or combination of elements) is not well-understood, routine or conventional unless the examiner finds, and expressly supports a rejection in writing with, one or more of the following:

1. A citation to an express statement in the specification or to a statement made by an applicant during prosecution that demonstrates the well-understood, routine, conventional nature of the additional element(s) . . . .

2. A citation to one or more of the court decisions discussed in MPEP § 2106.05(d)(II) as noting the well-understood, routine, conventional nature of the additional element(s).

3. A citation to a publication that demonstrates the well-understood, routine, conventional nature of the additional element(s) . . . .

4. A statement that the examiner is taking official notice of the well-understood, routine, conventional nature of the additional element(s) . . . .

Berkheimer Memorandum at 3–4.

Reversing Examiners who do not meet Berkheimer Memo requirements:

Technology Center 3600

- *Ex parte* **UPADHYE** Appeal 2024-003798, App. 17/067,165 (PTAB Jun. 26,2025) (Medlock, APJ)

- *Ex parte* **DUNJIC**, Appeal 2024-004133, App. 17/095,024 (PTAB May 21,2025) (Courtenay, APJ)

- *Ex parte* **SCHEKALL**, Appeal 2024-002289, App. 17/085,322 (PTAB May. 01,2025) (Hughes, APJ)

- *Ex parte* **MATULA**, Appeal 2024-002629, App. 17/115,157 (PTAB Mar. 27,2025) (Courtenay, APJ)

Technology Center 1700

- *Ex parte* **SCHMIT**T, Appeal 2024-001047, App. 17/014,619 (PTAB Mar. 12,2025) (McGee, APJ)

Next Month (October PTAB Committee)

On Tuesday, October 21, 2025, the next PTAB Committee Meeting for the NYIPLA will return to discussing its monthly update on Director Review and Discretionary Denials at the PTAB.

Please make sure to join us every month on the third Tuesday of each month, at 4:00 p.m. ET for our virtual PTAB Committee meetings.

Also, please join the NYIPLA at the One-Day CLE on November 5, 2025.