

Evolution of Patentable Subject Matter

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Over the past 200 years, the Supreme Court has grappled with challenging issues in areas where advanced technology and patent law collide. In recent years, the Supreme Court has issued opinions aimed at further defining the scope of patent eligible subject matter. Despite this guidance, significant questions remain; the rapid expansion of certain software inventions, particularly those related to Artificial Intelligence (AI), has created a fertile area ripe for further policy and judicial guidance.

Recently, the USPTO requested comments from the public on the patenting of technologies using AI. Many organizations and individuals have invested significant financial resources to develop new and innovative AI technologies. To protect these investments, many of these organizations and individuals have expressed their interest in patenting inventions involving AI. While the USPTO has offered patentable subject matter eligibility guidance and examples about AI-related patents in the past, it can still be difficult to predict a prosecution outcome for a given AI-related patent application.

A noticeable trend within the USPTO is that different examiners and/or different art units hold different views on the issue of patentable subject matter. By way of explanation, an Art Unit is a group within the USPTO that is assigned to examine applications based on the type of technologies described and claimed. The USPTO has a large number of Art Units that span wide varieties of technology. Thus, when one files a patent application, a first step in examination is for the USPTO to assign the patent to a particular Art Unit that is competent or otherwise assigned to examine the given technology. Unfortunately, the Art Unit a patent application is assigned to can have a significant impact on the amount of time and effort needed to prosecute the application before the USPTO, and even whether the patent application is ultimately allowed at all. For example, the Art Units designated as 3620 and 3680 have allowance rates that are significantly lower than other Art Units within their same technology center and within the USPTO. As such, the Art Unit to which your patent application is assigned can make a big difference in the likelihood of the application being allowed.

A skilled patent attorney can assist inventors in drafting a patent application in ways that increase the chances of getting an application examined by the appropriate Art Unit, ensuring the highest quality of examination. For example, a skilled drafter can carefully describe an invention in a way that increases the chances of the patent application being assigned to the Art Unit that is best suited for that invention. An Examiner that is experienced in a particular technology area is more likely to provide constructive guidance due to a better understanding of prior inventions in that space. This constructive guidance can make for a better overall patent experience with the USPTO and a higher level of resulting patent quality. A skilled patent attorney will employ drafting techniques that can help bridge the gap between technology, the law, and the examination process.



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