Cantor Colburn LLP

Cantor Colburn Client Alert:
Precedential *Desjardins* Decision Prompts MPEP Updates on §101 Eligibility

Summary

The United States Patent and Trademark Office (USPTO) recently issued a memo ("Advance notice of change to the MPEP in light of *Ex Parte Desjardins*") to the Patent Examining Corps addressing changes to the Manual of Patent Examining Procedure (MPEP) following the precedential Appeals Review Panel decision in *Ex Parte Desjardins*, Appeal No. 2024-000567 (PTAB September 26, 2025, Appeals Review Panel Decision). The memo, issued on December 5, 2025, provides advance notice of revisions to MPEP § 2106 to formally incorporate the reasoning of *Desjardins* into the subject matter eligibility framework under 35 U.S.C. § 101.

Importantly, the USPTO emphasized that these revisions to MPEP § 2106 do not establish new examination standards. Instead, the changes reaffirm existing Federal Circuit precedent and longstanding USPTO guidance, particularly as applied to software-related, artificial intelligence-related, and machine learning-related inventions.

Brief Overview of the *Desjardins* Decision

The claims in *Desjardins* are directed to a method of training a machine learning model on a series of tasks while preserving performance on prior tasks. The Patent Trial and Appeals Board (PTAB) *sua sponte* rejected the claims as being directed to ineligible subject matter under 35 U.S.C. § 101. USPTO Director John Squires issued an Appeals Review Panel (ARP) decision that vacated the PTAB's ineligibility rejection. In the decision, the ARP determined that the claims integrated the judicial exception into a practical application at Step 2A, Prong Two, of the *Alice*/*Mayo* framework.

Director Squires noted that the PTAB's overly broad reasoning was understandable given the confusion around § 101 jurisprudence, but troubling in light of what is at stake. He also acknowledged the importance of artificial intelligence (AI) to the United States: "Categorically excluding AI innovations from patent protection in the United States jeopardizes America's leadership in this critical emerging technology." Director Squires' decision focused on the disclosed "improvement" to AI training and relied on *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016). Director Squires further stated that the prior art and sufficiency of disclosure standards in 35 U.S.C. §§ 102, 103, and 112 are "the traditional and appropriate tools to limit patent protection to its proper scope" and should be the focus of examination, not § 101.

MPEP Revisions Based on *Desjardins*

The USPTO's memo notes several updates to sections of MPEP § 2106 to expressly incorporate the reasoning of *Desjardins* into the subject matter eligibility framework. The newly added language emphasizes that improvements to machine learning models, software, or other computational technologies can constitute patent-eligible technological improvements, even when such improvements are implemented through mathematical concepts.

The revised MPEP emphasizes that examiners must first evaluate the specification to determine whether it describes an improvement in the functioning of a computer or another technical field. The revised MPEP explains that a claim need not expressly recite the improvement itself, so long as the claim includes the components or steps that provide the disclosed improvement. In *Desjardins*, this requirement was satisfied where claim limitations reflected training a machine learning model to learn new tasks while protecting performance on earlier tasks, thereby addressing the problem of "catastrophic forgetting."

The updated MPEP also reinforces that eligibility determinations must consider claims as a whole and cautions examiners against evaluating claims at an overly high level of generality. Newly added examples specifically recognize improvements in machine learning training techniques, preservation of learned knowledge, reduced storage usage, and reduced system complexity as potential indicators of patent-eligible technological advancements.

Practical Takeaways for Practitioners and Applicants

Applicants pursuing protection for artificial intelligence, machine learning, and software-based inventions should ensure that specifications clearly describe technical problems and how the claimed invention improves system operation or performance. Claims should reflect those improvements, even if the benefits are articulated primarily in the specification. The *Desjardins* decision and the accompanying MPEP updates provide valuable insight into rebutting overbroad subject matter eligibility rejections, particularly in the context of machine learning and other emerging technologies.

For Further Information and Assistance

Attorneys in Cantor Colburn's Computer Science Practice Group and Artificial Intelligence Practice Group have substantial experience representing clients in these types of matters. Primary contacts are:

- David Kincaid, Partner and Artificial Intelligence Practice Co-Chair, dkincaid@cantorcolburn.com
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We welcome your questions regarding this matter and any other regarding your IP in general.

This client alert was written by David Kincaid with contributions from Jeffrey Waters.