

SLW COFFEE BREAK WEBINARS

Patenting AI, Using AI: Espresso Edition

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Panel



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Agenda

Making AI patents stronger, faster, and more defensible:

- From Invention Disclosure to AI-Focused Drafting (Nathan)
- Prosecution Strategy for AI Patents (Lucas)
- AI Analysis and Quality Checks (Andre)

Section One: From Invention Disclosure to AI-Focused Drafting



The New Reality: AI Moves at a Pace Unlike Anything We've Seen



The Company

4 people. 10 days.

AI wrote every line of code

Claude Cowork — Anthropic, Jan 2026



The Individual

**1 developer.
Weekend project.**

200K+ stars. 10+ clones.

OpenClaw — Peter Steinberger, Nov 2025

The Market Impact



-\$31 BILLION

in one day

*IBM, Feb 23, 2026 — triggered by a single
Anthropic blog post about COBOL*

A major company ships in 10 days. One person goes viral in a weekend. A blog post erases \$31B. This is the pace of AI.



No Time

Idea to release in 10 days — traditional IP workflow assumes months



Instant Clones

10+ knockoffs of OpenClaw within weeks — Nanobot replicated it in 4,000 lines



The Bar Date

35 U.S.C. § 102 — one year from public disclosure, or Day 0 internationally

THE CLOCK IS TICKING

Product Released



GitHub push



Conference demo



Beta launch



Blog post



Bar Date — Rights Lost



⚠ Most countries: NO grace period — public disclosure = immediate bar



Document as You Build

Prompt your AI: “Document anything novel so I can hand it to a patent attorney”



Rolling Provisionals

File provisional → iterate → file again → tie together within 12 months

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Three Categories of AI Invention

IMPROVING AI ITSELF

Improvement to the computer



- Model architectures
- Training algorithms
- Inference optimization

§ 101: Safest Harbor

AI AS A COMPONENT

Solving another problem



- Fraud detection
- Recommendation engines
- Predictive maintenance

§ 101: Must Show Technical Improvement

AI AS INVENTOR

AI doing the inventing



- Drug discovery
- Protein folding
- Materials science

Inventorship: Tread Carefully

	§ 101 Eligibility	Prior Art Risk	Drafting Complexity
Improving AI Itself	Easiest	Moderate	High
AI as a Component	Harder	Variable	Moderate
AI as Inventor	Uncertain	High	Very High

Cat 1: Lean **INTO** the AI
Cat 2: Lean **AWAY** — toward the system it improves
Cat 3: Prove the human was in the loop

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The § 101 Trap: When AI Sounds like Human Thinking

WHAT A PERSON DOES		WHAT AN ML SYSTEM DOES
Learns		Learns
Trains		Trains
Reasons	≠	Reasons
Recognizes		Recognizes
Predicts		Predicts

Same words. Different processes.

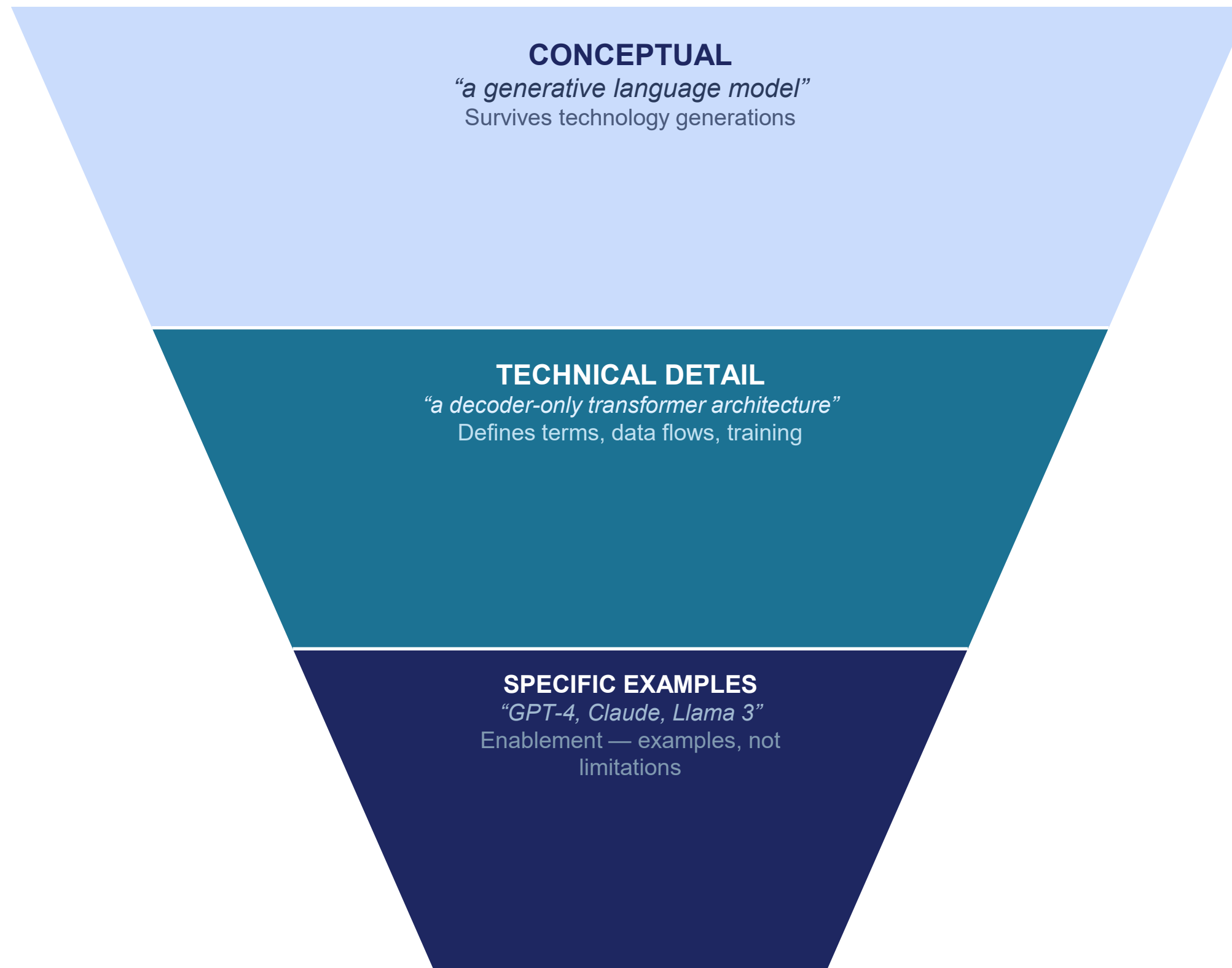
PRONG 1: USE THE TERMS OF ART

These are technical terms, not mental processes. No human performs SGD on 70B parameters.
Kim Memo (Aug 2025): mental process exclusion limited to what a person can realistically do

PRONG 2: TECHNICAL PROBLEM → TECHNICAL SOLUTION

-  Adaptability without reprogramming
-  Handles complexity beyond rules
-  Improved accuracy
-  Resource efficiency

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← **Each layer = a fallback claim scope**
Pre-built into the spec from day one

AI TIP: Prompt your tool to generate detailed real-world use cases at each level



Lessons from Prosecution

The Transformer Problem



Examiner mapped “transformer” to generic “transformation”
Prior art predated the technology itself

✓ REJECTION OVERCOME

The Blog Post Declaration



Independent validation of the technical problem
Inventor’s solution distinct from all alternatives in article

⌚ PENDING

NEW TOOL: Subject Matter Eligibility Declarations (SMEDs)
USPTO Dec 2025 — Director Squires: “These are underused.”
Examiners must consider on the merits. Must explain reasoning in light of the declaration.

Section Two: Prosecution Strategy for AI Patents



Recent USPTO Clarifications for AI Prosecution

- AI invention eligibility remains examiner-driven and fact specific
- Recent shifts in AI invention eligibility:
 - The mental-process analysis has been constrained
 - Increased emphasis on improvement analysis under Step 2A Prong Two
- Practical takeaway:
 - Overcoming § 101 rejections often depends on improvement narrative in the specification and corresponding claim architecture



Updated § 101 Landscape: Step 2A, Prong One

- Common Examiner § 101 rejection pattern for AI claims:
 - Mathematical concepts (e.g., gradient descent, backpropagation)
 - Mental processes (e.g., detecting, analyzing, evaluating)
- Two constraints from August 2025 USPTO memo:
 - Do not expand “mental process” to cover limitations that cannot practically be performed in the human mind
 - Distinguish claims that do not recite a judicial exception
- § 101 rejection amendment tactics:
 - Amend independent claims to avoid mathematical algorithms
 - Clarify any alleged mental process cannot be performed practically in the human mind
 - Argue claims do not recite a judicial exception

Step 2A, Prong Two: Integration Into a Practical Application

- *Ex Parte Desjardins* is particularly important:
 - Training ML model to mitigate “catastrophic forgetting” held to integrate abstract idea into practical application
- *Desjardins* included specific improvements
 - Specification detailed reduced storage, reduced complexity, preservation of performance across tasks (model-operational, not result-oriented)
 - Claims recited features that enabled those improvements
- *Desjardins* clarified that Examiners must evaluate both:
 - Improvement described in specification
 - Claim limitations reflecting that improvement

After *Desjardins*

- MPEP updated to clarify analysis for Examiners:
 - Specification provides sufficient detail for POSITA to recognize improvement
 - Claim recites components or steps that provide that improvement
- Prosecution (and Drafting) strategy:
 - Specification must articulate model operation or improvement in model operation
 - Quantify improvements provided by articulated model operation (e.g., memory, latency, training stability)
 - Tie improvements to model architecture or ML training parameter update logic
 - Claims must recite mechanism producing improvement
 - Avoid aspirational language (accuracy, efficiency) without structural support
 - Conclusory improvement statements risk both § 101 and § 112 rejection
 - Clear improvement statements strengthen responses under § 101/102/103

Lessons from Example 47: When AI Claims Fail

- Example 47, Claim 2 (ineligible):
 - Algorithmic training (backpropagation and gradient descent)
 - Mental processes (detection and analysis steps)
 - AI tool usage (ANN)
 - Insignificant extra-solution activity (receiving and outputting)
- Example 47, Claim 3 (eligible):
 - ANN output triggers system control action, improving security
 - Example 47 takeaway: AI architecture must drive technological system behavior and be recited in claim



Summary for Prosecution of AI Inventions

- At Prong One:
 - Avoid mathematical framing in independent claims
 - Recite features that cannot be performed mentally
- At Prong Two:
 - Anchor eligibility in technical improvement to model or system operation
- Analogize to examples and *Desjardins* in OA responses and interviews
- Ensure improvement narrative is aligned across § 101 and § 102/103

Section Three: AI Analysis and Quality Checks

AI and Patent Quality: A New Opportunity

- AI inventions face uniquely elevated legal risk: §101, broad functional claims, distributed system architectures
- **Traditional budgets** were never sized for the drafting and prosecution depth these patents require
- AI-powered tools now make comprehensive quality drafting and review **accessible** at every stage
- Not a **cost-savings story** — an **enablement story**: doing what wasn't previously affordable/possible
- Goal: better applications, stronger enforcement, fewer vulnerable patents in the portfolio

Quality Checks Built Into Drafting

- **§101 / Alice** exposure flagged at the claim level during drafting
 - Abstract idea category detection (Step 1)
 - Inventive concept assessment — does the claim recite more than conventional ML steps? (Step 2)
- **Functional claiming** risks: overly broad "configured to" / "operable to" language without spec support
- **Written description** gaps: genus claims not supported by sufficient species in the disclosure
- **§112(f) means-plus-function**: "module," "engine," "unit" — is corresponding structure in the spec?
- **Divided infringement** risk: AI pipelines split across user device, cloud inference, third-party APIs

Quality Checks Built Into **Prosecution**

- AI applications face repeated §101 rejections — each response shapes the enforcement record
- **Prosecution history estoppel** (PHE): amendment tracking, narrowing identification
- **Argument-based estoppel**: limiting statements in remarks
- **Prosecution disclaimer**: scope-limiting language flagged in real time
- **Priority chain** / continuity analysis
- **IDS** completeness checks
- **OA response quality**: arguments grounded in spec, consistent with claim scope



Post-Allowance: The Enforcement Readiness Checker (ERC)

- Full ERC analysis on issued AI patents (assertion or defense)
- **§101 / Alice**: Step 1/2 re-evaluation in **litigation posture** (not examination posture)
- **Written description**: does the spec support the full functional scope of the issued claims?
- **Enablement**: are all embodiments of the claimed ML method enabled, or just the disclosed architecture?
- **Claim construction**: are "neural network," "classifier," "model" limiting? What does the spec say?
- **Prosecution history estoppel**: full file wrapper analysis — what scope was surrendered during prosecution?
- **Divided infringement**: who performs each step? User? Cloud provider? Third-party model API?
- **Design-around** sensitivity: how easily can a competitor substitute a different model or architecture?
- Output: **SWOT report** with per-claim risk matrix and confidence levels

The Outcome: Enforceable AI Patents, Fewer Vulnerable

- The same enforcement-readiness checks run at drafting, prosecution, and post-allowance
- AI surfaces the issues —> attorney judgment resolves them
 - Reviewing findings carefully **takes real time**; that's by design
- Stronger AI patent applications from the start
- Prosecution records that don't inadvertently surrender scope
- Issued patents with known, managed **risk profiles**
- Fewer low-quality AI patents — problems caught before grant, not litigated after

Thank you





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