

Publications

New USPTO Guidance on AI-Assisted Inventions and Pleadings

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CLIENT ALERT | 2.14.2024

Just this week, the United States Patent and Trademark Office (USPTO) issued much awaited guidance on both AI-assisted inventions and pleadings filed before the Office, which applies to the Central Reexamination Unit (CRU) and Patent Trial and Appeal Board (PTAB). *Inventorship Guidance for AI-Assisted Inventions*, 89 FR 10043 (USPTO Feb. 13, 2024). See also the *Director's Blog*, Feb. 12, 2024. The guidance is effective immediately and applies to utility, design and plant patents and applications. We've summarized what you need to know below.

AI-Assisted Inventions

Recognizing that many companies use or will use AI tools, the USPTO sheds light on how the Office views the determination of inventorship for AI-assisted inventions. The guidance relies on existing law and rules and provides additional information and examples for USPTO examiners and stakeholders.

Inventorship

Several principles of inventorship apply.

1. **People invent.** Inventors and joint inventors must be *natural persons*. Quoting the Federal Circuit, the Office follows the edict "that only a natural person can be an inventor, so AI cannot be." *Thaler v. Vidal*, 43 F.4th 1207, 1213 (Fed. Cir. 2022), *cert denied*, 143 S. Ct. 1783 (2023); 89 FR at 100045.
2. **But inventors can use AI tools.** AI-assisted inventions are not categorically unpatentable. Human inventors can use AI tools, but despite using those tools, the humans themselves must have made a **significant contribution** to the claimed invention. In particular, each inventor must: "(1) contribute in some significant manner to the conception or reduction to practice of the invention, (2) make a contribution to the claimed invention that is not insignificant in quality, when that contribution is measured against the dimension of the full invention, and (3) do more than merely explain to the real inventors well-known concepts and/or the current state of the art'

(*Pannu* factors)." *Id.* at 100047. See, *Pannu v. Iolab Corp.*, 155 F.3d 1344, 1351 (Fed. Cir. 1998).

3. **"Significant Contribution" is a claim-by-claim determination.** Each claim must have at least one named inventor. Examiners should reject any claim under 35 U.S.C. §§ 101 and 115 where a natural person did not significantly contribute. 89 FR at 100048. This applies to independent and dependent claims.

Immediate Impacts

In addition to laying out inventorship principles that can apply to AI-assisted inventions, the new Office guidance sets out **examples** for both the mechanical and chemical arts in which AI tools are used to different degrees and ways to arrive at a claimed invention.

Companies can expect to see an increased use of Rule 105 by examiners to request information on inventor contribution for particular claims. Rejections on the basis of improper inventorship under 35 U.S.C. §§ 101 and 115 are also likely. Where priority claims are made to a foreign application, the application should be checked for inventor names to an AI system as they may not be accepted by the USPTO.

The USPTO also reminds practitioners and inventors to be mindful that their *duty of disclosure obligations apply to inventorship determination*. Patent application filers may wish to incorporate more safeguards in their filing of original claims and making amendments to ensure inventorship lies properly with named human inventors who have provided a significant contribution to each claim.

During litigation and in due diligence and valuation, patent owners may expect challengers to raise improper inventorship defenses for certain claims relating to AI-assisted invention if they lack a significant contribution from a named inventor.

AI-Assisted Pleadings in the TTAB and PTAB

Director Vidal also issued a separate memorandum with guidance regarding papers filed before the USPTO that may have been generated with the benefit of AI tools. See, "[The Applicability of Existing Regulations as to Party and Practitioner Misconduct Related to the Use of Artificial Intelligence](#)," Memorandum, USPTO, Feb. 6, 2024. This memorandum is aimed at attorneys and agents to safeguard the integrity of filings before the USPTO.

Following Chief Justice Roberts' year-end report that highlighted some benefits and shortcomings in the use of AI, Director Vidal emphasized adherence to the existing rules when utilizing AI in the drafting process for legal submissions to the Trademark Trial and Appeal Board (TTAB) and Patent Trial and Appeal Board (PTAB). Vidal pointed to existing rules that already impose duties on parties to ensure USPTO proceedings are followed ethically, saying the rules "apply regardless of how a submission is generated." See, Memorandum, pp. 1-2.

A person's signature matters when using AI assisted tools. By affixing a signature, a party or practitioner certifies under 37 C.F.R. §11.18(b) that at least:

- all statements made therein of the party's own knowledge are true,

- any legal contentions are warranted by existing law or by a nonfrivolous argument for the extension or reversal of existing law after an inquiry reasonable under the circumstances, and
- factual contentions have evidentiary support or likely will have evidentiary support after a reasonable opportunity for discovery.

The new memorandum makes clear that the USPTO's Rule 11.18 is modeled off of the Federal Rule of Civil Procedure Rule 11. Federal courts have already applied that rule to submissions made with the assistance of AI and were not adequately vetted prior to filing by the petitioner. Attorneys have been punished for submitting briefs citing non-existent cases generated by AI, (AI hallucinations). "Simply assuming the accuracy of an AI tool is not a reasonable inquiry," Vidal notes in the memorandum. See, Memorandum, pp. 3-4. Moreover, Rule 11.18 applies to any paper submitted to the USPTO not just trial proceedings.

Conclusion

We expect this new guidance on AI-assisted inventions and memorandum to impact a range of patent activity. Companies using AI tools will need to sharpen all aspects of their patent filing programs, including their invention disclosure process relative to AI contribution. Additionally, companies will need to be mindful about their strategies and processes for carrying out invention harvesting, filing new AI-related applications, and overcoming potential new examination hurdles stemming from inventorship contribution. New litigation impacts are also likely.

If you have questions or need guidance on addressing AI in your process, please reach out to one of the authors associated with this article or your favorite Vorys attorney.

Stay tuned for future client alerts where we address further use of AI tools by companies and their human inventors.