Managing IP

Lawyers anticipate ‘heightened obligation’ to probe clients over AI use

Rani Mehta February 13, 2024

Counsel say they will have to be more inquisitive about the level of AI involvement in clients’ patent applications in the wake of newly released USPTO guidance

The USPTO’s guidance on inventorship for artificial intelligence-assisted innovations could prompt counsel to have more conversations with clients about the nature of their patent applications.

The USPTO released new guidance yesterday, February 12, which clarified how the office would analyse inventorship issues related to AI.

It stated that although AI systems couldn't be listed as inventors, AI-assisted inventions weren't categorically unpatentable. A human being must provide a significant contribution to the invention, however.

The guidance also highlighted the duty of reasonable inquiry, which refers to the parties' requirement to ensure all information supplied to the USPTO is supported by evidence and is not being presented for improper purposes.

The document stated that the USPTO was not changing its duty of reasonable inquiry. However, the guidance noted that the inventorship inquiry could include questions about whether and how AI was used in the invention process.

It also highlighted the duty of individuals associated with patent applications to disclose all known information related to patentability. The office said it wasn't modifying this duty of disclosure and didn't expect the guidance to have a major impact on applicants' disclosure requirements.

But this duty could be relevant if a named inventor didn't significantly contribute to an invention because their supposed contribution was made by AI, the guidance stated.

Alarm bells

Michael Word, member at Dykema in Chicago, says the USPTO's reference to these duties should "sound alarm bells" for all practitioners.

"To the extent that practitioners haven't started asking these questions, this now almost seems to heighten the obligation to talk to applicants and ask them if AI is involved and how it was involved," he says.

"We're sitting up and taking notice and are going to start asking more questions of our clients."

Word argues that companies should also start taking note of this.

In-house counsel might want to put procedures in place to make sure that inventors are disclosing how and whether AI was used in the invention process, he suggests.

Jonathan Thielbar, partner at Loeb & Loeb in Chicago, expects that he will also talk more about inventorship issues with clients as a result of the guidance. He notes that this is especially true for industries that are close to AI, such as software.

"But as the use of AI grows more ubiquitous in every industry, it will come up more often," he says.

The guidance also emphasised that USPTO examiners can probe into inventorship issues.

Examiners, according to the guidance, can request information related to inventorship if they have a reasonable basis to conclude that an inventor might not have contributed significantly to the claimed subject matter. That is true even if the information isn't material to patentability.

Maria Laccotripe Zacharakis, managing partner of McCarter & English's Boston office, says she's never seen a rejection from the USPTO that questioned who the inventors were.

"That may give rise to a slight change in practice where examiners may determine that AI was involved and ask the applicant to clarify who the inventors are," she says.

"We [as practitioners] need to analyse the record and the facts – and if there's any indication that AI was involved to push a little bit further [to clients] on that issue."

Word argues, however, that it's more likely that examiners will learn about AI contribution when practitioners disclose it rather than by the examiners raising their inquiries.

Giving guidance

The guidance also provides some clarity on what constitutes a significant contribution from a human being.

For example, someone who only presents a problem to an AI system may not be a proper inventor.

But if someone constructs a prompt "in view of a specific problem to elicit a particular solution from the AI system" – that person could have made a significant contribution and therefore could be an inventor.

The guidance added that a human who conducts a successful experiment using AI's output could be an inventor too. And someone who designs, builds, or trains an AI system to get a particular solution could also potentially be an inventor.

Figuring out what constitutes a significant contribution may still be complicated going forward, however.

Laccotripe Zacharakis notes that regardless of AI, determining inventorship can be a very difficult and very involved investigation.

"That remains the same and becomes even more complicated with the addition of AI. The examples they provide are great and they give some guidance, but it's not a straightforward inquiry," she says.

Thielbar at Loeb & Loeb adds that it's helpful to have the guidance.

"Inevitably, there's going to be an issue that may be on the border," he notes.

But he adds that this guidance helps determine what type of contributions are enough for humans to be listed as inventors and what aren't.

It’s uncertain when, or if, there will be more detail about what constitutes a significant contribution from a human when AI has assisted in the inventorship process.

In the meantime, and in the absence of that information, practitioners should prepare to start grilling their clients about the part that AI played.

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