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USPTO AI Guidance: Human vs. Machine – Humans Win … For Now

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On February 13, 2024, the USPTO published a Federal Register notice on Inventorship Guidance for Artificial Intelligence (AI)-assisted Inventions ("Guidance") in response to President Biden's October 2023 Executive Order on the Safe, Secure, and Trustworthy Development and Use of Artificial Intelligence (EO 14110). The USPTO has been grappling with the interplay of artificial intelligence and the patent system since August 2019, when it first issued a request for public commentary on the patentability of AI-assisted inventions. The guidance largely tracks the holding of a 2022 Federal Circuit decision, *Thaler v. Vidal*, which affirmed the district court and PTO decisions that individuals, as defined in the Patent Act, plainly mean humans and affirmed the denial of the USPTO application listing only an AI software system as an inventor. Despite this decision, the reality is that AI is being increasingly used during primary research. Because there is no legislation expressly addressing the role of AI in development of patentable inventions, practitioners look to agency guidance, such as this, for some answers. In the age-old battle of Human vs. Machine, this Guidance unequivocally shows that inventorship requires a human.

In this Guidance, the USPTO states that the use of AI does not preclude patentability, so long as at least one natural person ***significantly contributed*** to the claimed invention and can be named as the inventor(s). It is clear that this standard will entail some line drawing in the future, but the USPTO has directed courts to consider the *Pannu* factors, which is a three-part test for naming inventors that requires the inventor(s) to have: "(1) contributed in some significant manner to the conception of the invention; (2) made 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) [done] more than merely explain to the real inventors well-known concepts and/or the current state of the art." Example 1

indicates that simply providing a query or prompt to an AI algorithm and utilizing the output as-is, does not equate to human inventorship. The person, to become an inventor, must contribute to the claims in some way, other than merely entering a query or prompt.

Although the Guidance is helpful to know where the USPTO stands on the issue (with humans), there is now a new layer of complexity. Determining inventorship will still involve determining what a named (human) inventor contributed to a particular claim set, regardless of whether AI was utilized or not. However, any use of AI serves only to complicate that process. When inventive processes are interwoven with AI processes, applicants and their legal counsel will need to ensure that the inventor ***substantially contributed*** to the invention. Tracking inventorship is always recommended but will be particularly important moving forward for AI-assisted inventions. Despite speculation of a possible disclosure requirement, the USPTO confirmed it is not requiring affirmative disclosure that AI contributed to an invention. This differs from the U.S. Copyright Office's policy which does require disclosure. However, applicants are still required under 35 U.S.C. 115(b) to submit an oath or declaration of proper inventorship. In addition to the above, the Guidance provides five guiding principles to practitioners to further assist with the AI v. human inventorship analysis. Overall, this Guidance helps fill the void relating to AI and inventorship for now. However, as AI continues to seep into our daily lives, Congressional action may not be far off.

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