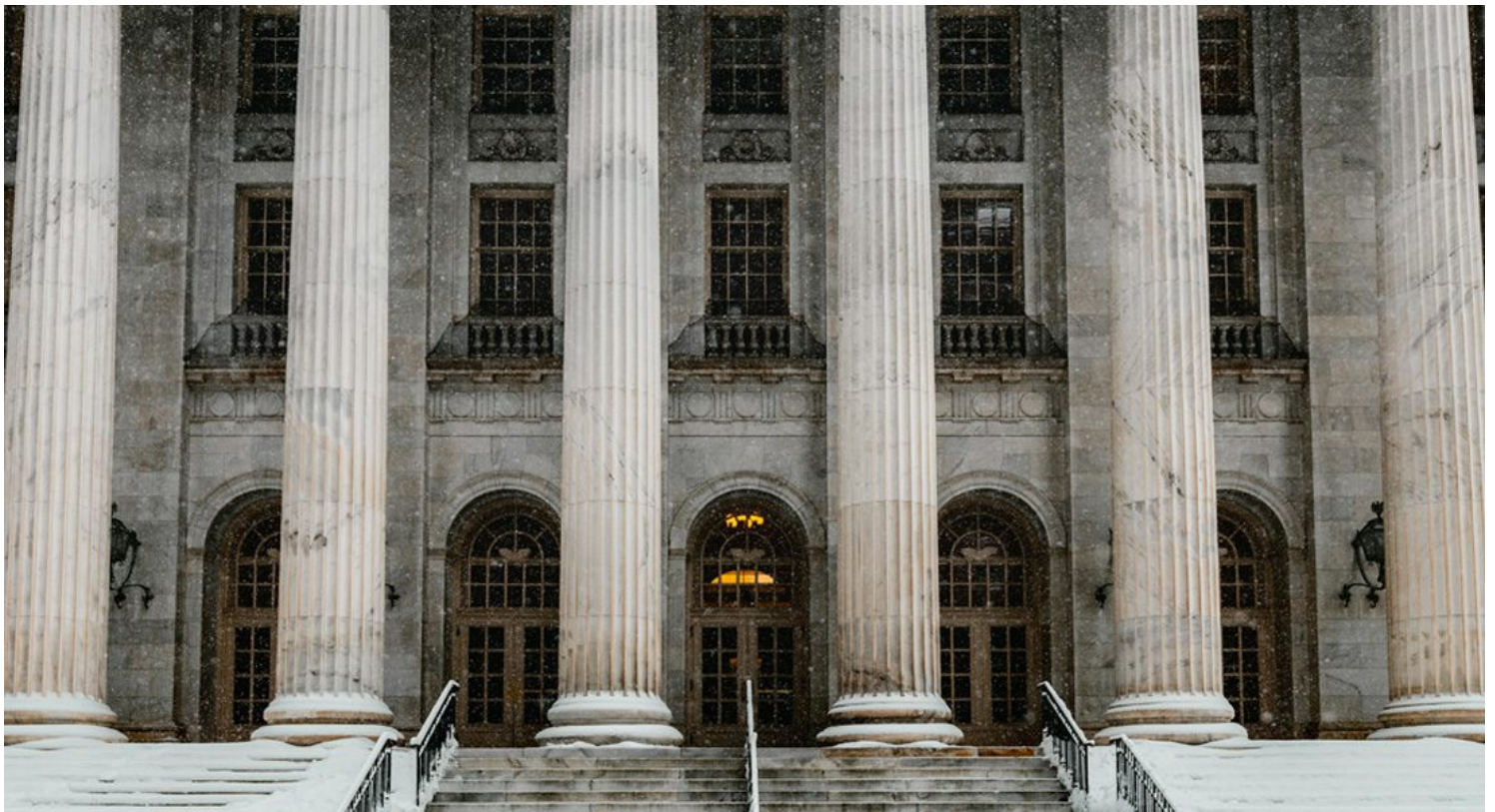


NEWS & INSIGHTS

USPTO guidance on AI and patents

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FEBRUARY 15, 2024



The U.S. Patent and Trademark Office issued important guidance this week on patents for inventions developed using artificial intelligence. The core issue is how inventorship is determined for claims related to AI-assisted inventions.

The guidance remains that only a natural person is qualified for inventorship. The guidance embraces the position that AI-assisted inventions are NOT categorically unpatentable for improper inventorship. The use of an AI system by a natural person(s) does not preclude a natural person(s) from qualifying as an inventor (or joint inventors) if the natural person(s) **significantly contributed** to the claimed invention.

Defining “significant contribution”

In summary, a natural person can be listed as the inventor or joint inventor if the natural person **contributes significantly** to the AI-assisted invention. The guidance provided a five-principal test and two examples to clarify the determination for the “significant contribution.” The analysis borrowed the Pannu factor’s framework and applied it to a few AI assistance examples to illustrate what constitutes “significant contribution.” In applying the Pannu factor, the guidance requires a minimum level of conception from the natural person when deploying AI assistance. Reduction to practice using AI output alone is not significant contribution. Significant contribution to the conception does not require the person or a participant present for each activity that led to the conception of the claimed invention. The USPTO offered some examples of what does and does not constitute significant contribution:

“Significant Contribution”

Construct the prompt to an AI system in view of a specific problem to elicit a particular solution.

Take the AI output to conduct a successful experiment.

Develop an essential building block, design, builds, or train an AI system in view of a specific problem to elicit a particular solution.

NOT

“Significant Contribution”

Present a problem to an AI system.

Merely recognize and appreciates the output of the AI system when the output’s properties and utilities are obvious.

Simply owning or overseeing an AI system.

What else is in the guidance?

The USPTO further clarified that the guidance also applies to design patents and requires the patent practitioners, applicants and anyone with a duty to disclose the AI assistance to the USPTO. They must also include evidence that demonstrates a named inventor did not significantly contribute to the invention because the person’s purported contribution(s) was made by an AI system. Patent practitioners who are preparing and prosecuting an application should inquire about the proper inventorship and include questions about whether and how AI is being used in the invention-creation process. They should also assess whether the contributions made by natural persons arise to the level of inventorship.

The guidance is good news for patent inventors and applicants who are ready to take advantage of the AI technology revolution. However, the five-principal “significant contribution” test likely will be reviewed and further interpreted in USPTO and court in the coming years.

The guidance further emphasized the importance for patent practitioners, inventors, and applicants to document the interactions between a human participant and an AI system. The paperwork is necessary for disclosure to the USPTO and will also be important when the applicant and the patent practitioner want to eliminate a named inventor based on not significant contributions to the invention with AI assistance.

If you have any questions on the new guidance or any AI-related IP issues, please contact a member of our

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