

Locke Lord QuickStudy: Inventorship Guidance From the USPTO ?for AI-Assisted Inventions

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On February 13, 2024, the USPTO posted Inventorship Guidance for AI-Assisted Inventions to the Federal Register to provide clarity for stakeholders and personnel. This guidance applies to all patents resulting from applications, filed before, on, or after February 13, 2024. The public may submit written comments to these guidelines, which must be received on or before May 13, 2024. The posted guidance is in furtherance to the “Executive Order on the Safe, Secure, and Trustworthy Development and Use of Artificial Intelligence” dated October 30, 2023, and requests for public comment and listening sessions regarding patenting AI-assisted inventions in August 2019, February 2023, April, 2023, and May 2023.

The guidance provides that AI-assisted inventions are not categorically unpatentable, but the inventorship analysis should focus on human contributions. Accordingly, patent protection “may be sought for inventions for which a natural person provided a significant contribution to the invention,” and more particularly, a significant contribution to each claim. The guidance aims to assist in determining whether a natural person provided a significant contribution to the invention. Along with the guidance, the USPTO has published two examples of how the guidance may be applied to an AI-assisted invention. Further, the guidance makes clear that it applies to all types of patents — utility, design, and plant patents.

Under the current statutory framework, a named inventor on a patent application must be a natural person (i.e. a human being), see, *Thaler v. Vidal*, 43 F.4th 1207, 1213 (Fed. Cir. 2022), *cert. denied*, 143 S. Ct. 1783 (2023)). However, this does not preclude patent applications claiming inventions where AI is used by said natural person. Inventorship is proper in any patent or patent application that includes a claim in which AI assistance was used as long as a natural person significantly contributed to the claim as specified by the *Pannu* factors set forth in *Pannu v. Iolab Corp.*, 155 F.3d 1344, 1351 (Fed. Cir. 1998).

The published guidance includes a non-exhaustive list of principles that can help inform the application of the *Pannu* factors in AI-assisted inventions. Among other things, the guidance provides that a natural person’s use of AI does not negate that person’s contributions to a patent so long as the natural person contributed significantly to the AI-assisted invention. The guidance further specifies that merely recognizing a problem or having a general goal or research plan does not rise to conception, however, a significant contribution can be shown by the way the natural person constructs a prompt in view of a specific problem to elicit a particular solution from an AI system. Reducing an invention to practice alone is not a significant contribution, however, a natural person who takes

output from AI and makes a significant contribution can be an inventor. A natural person who designs, builds, or trains an AI system in view of a specific problem to elicit a particular solution could be an inventor, if the designing, building, or training of the AI system is a significant contribution to the invention created with the AI system. Finally, maintaining “intellectual domination” (owning or overseeing) over an AI system does not, on its own, make a person an inventor of any inventions created through the use of the AI system.

The guidance provides that no changes are made to the duty of disclosure relating to inventorship, or the duty of reasonable inquiry. However, the guidance cautions applicants to ensure a natural person contributed to each and every claim. Therefore, if there is any claim in which an AI-system is the sole inventor, the claim must be either cancelled or amended.

Finally, given the difference in approach to patent applications for AI-assisted inventions across jurisdictions, applicants should be aware that any U.S. patent application for an AI-assisted invention must still name a natural person, regardless of foreign priority inventorship. Moreover, because an AI system cannot be a named inventor, it has no rights to assign; therefore, assignments from AI systems should not be recorded with the USPTO. Therefore, a patent application listing only an AI system as the inventor will not be accepted by the USPTO, even if claiming priority to a foreign patent application that names only the AI system. If a foreign priority application lists both a natural person and an AI system, the U.S. application should list only the natural person as the sole inventor.

The USPTO has established a webpage for AI resources, which includes, among other things, the full guidance discussed above, the example scenarios for understanding the application of the new guidance, and a database of U.S. patents and patent application publications that include AI. The AI webpage can be accessed here.

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