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Locke Lord QuickStudy: U.S. Patent Office Provides Guidance ?for Patenting Artificial Intelligence Inventions ?

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Introduction

On July 17, 2024, the U.S. Patent and Trademark Office (USPTO) released its 2024 guidance update on patent subject matter eligibility, making significant revisions to its prior guidance on subject matter eligibility determinations. This update specifically addresses the eligibility of inventions involving artificial intelligence (AI). The update aims to provide clearer guidelines and foster innovation for AI inventions while maintaining robust standards for patentability.

In releasing this guidance, the USPTO appears to be actively supporting AI inventions by continuing to implement several key initiatives. The guidelines were developed by soliciting input from stakeholders and monitoring patent subject matter eligibility developments in the courts. These initiatives should provide assurance to Applicants that AI-related or AI-assisted inventions will not be unequivocally patent ineligible solely due to the use or implementation of AI.

Key Changes in the 2024 Guidance

1. Clarified Interpretations and Examples – The update provides more detailed interpretations of key terms related to AI and other emerging technologies. It provides new examples illustrating what constitutes patent-eligible subject matter, especially in AI-related inventions.

2. Focus on Practical Application – The update emphasizes the practical application of AI technologies. Even when an AI-related abstract idea is used in an invention, the invention can be patent eligible if it demonstrates a concrete and tangible application of the abstract idea, and thus reflects an improvement to a computer or another technology. Applicants should clearly outline how their AI invention applies in a real-world scenario, ensuring that the invention goes beyond theoretical concepts.

3. Enhanced Examination Procedures – Patent examiners are instructed to apply a more nuanced analysis when evaluating AI-related patent applications. The update introduces a structured approach for determining whether AI inventions meet the criteria for patent eligibility under the revised guidelines.

4. Interdisciplinary Collaboration – The USPTO guidelines are based on extensive collaboration across disciplines to provide a better understanding and evaluation of complexities of AI inventions. This approach aims to ensure that examiners have access to the necessary expertise when assessing the patentability of AI-related inventions.

Implications for Patent Applicants

1. Detailed Disclosures – Applicants should provide comprehensive disclosures that clearly describe the practical application of their AI inventions. It is crucial to include specific examples and use examples/scenarios demonstrating how the invention operates in real-world scenarios.

2. Focus on Technical Improvements – The update provides favor to inventions that offer technical improvements or solve technical problems using AI technology. These AI technology improvements may be to a computer device itself or to a certain technological field or application. Applicants should emphasize the technical advancements and benefits of their AI inventions in their patent applications.

Conclusion

The 2024 guidance update on patent subject matter eligibility represents a significant step forward in addressing the complexities of AI-related inventions. By focusing on practical applications and technical improvements, the USPTO aims to encourage AI innovation while maintaining high standards for patentability. Applicants should carefully review the updated guidelines and prepare their AI applications accordingly to successfully navigate the patent examination process.

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