

# Can AI Be an Inventor? USPTO Guidance Seeks to Address Questions on AI- Assisted Inventions

Article

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The United States Patent and Trademark Office (USPTO) has released inventorship guidance related to AI-assisted inventions, seeking to address some of the questions that have arisen with the rapid development of AI. Here are the highlights.

## **Inventors Must Be Natural Persons**

Preliminarily, the USPTO points out that, in 2021, the Federal Circuit affirmed two USPTO decisions that had rejected petitions to name an AI system an inventor in a patent application in *Thaler v. Hirshfeld*. The court found that, under U.S. patent laws, an inventor must be a natural person. However, according to the USPTO, this does not categorically prohibit AI-assisted inventions themselves, making innovators and legal professionals question what role AI could practically play in the patent system.

## **Making "Significant Contributions"**

Under its recent guidance, the USPTO explains that, for an AI-assisted invention to be patentable, a natural person, serving as the inventor, must make a significant contribution to each claim of the patent. Determining whether a "significant contribution" has been made is not a new inquiry — the USPTO, attorneys and courts have been undergoing this analysis for years when considering joint inventorship. However, adding AI into the equation muddies the waters and poses the question — how can an inventor make a significant contribution if their invention relies on the output of the AI system?

The USPTO guidance recognizes that such analysis will present obstacles and that there is "no bright-line test" to apply. However, a list of informative principles may serve as a guide:

- The fact that an AI system is used in creating an invention does not negate a natural person's contributions.

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- Conception is more than recognizing a problem, setting a general goal, or developing a research plan. In other words, an inventor who presents a problem to an AI system has not made a significant contribution to an invention identified from the output of such system.
- Recognizing, appreciating, and reducing AI output into an invention does not constitute inventorship.
- Developing "an essential building block from which the claimed invention is derived" may, however, constitute a significant contribution. For example, an individual who designs, builds or trains an AI system to find a particular solution to a specific problem may be an inventor.
- Ownership or the act of overseeing an AI system does not, in and of itself, make an inventor.

### **Staying True to the Purpose of the Patent System**

While unanswered questions remain, the recent USPTO guidance has made one thing clear: the true purpose of the patent system, which was designed "to encourage *human* ingenuity" (emphasis in the original), will prevail. As it applies to AI, the current goal is to incentivize AI-assisted inventions without "hindering future human innovation by locking up innovation created without human ingenuity."

### **What's Next?**

There will undoubtedly be a flurry of litigation in the future regarding this new guidance and its impact on the inventorship analysis, stemming from questions as to whether certain steps constitute a significant contribution to the amount of credit the developers of AI systems should be given in relation to an AI-assisted invention. In the meantime, inventors should stay abreast of any and all guidance coming out of the USPTO and keep their attorneys well-informed as to the role AI plays in their inventive process.

You can read the full guidance from the USPTO on the Federal Register website.

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