HUMAN-MADE INVENTIONS CREATED WITH ASSISTANCE OF AI MAY BE PATENT-ELIGIBLE

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Although the U.S. Court of Appeals for the Federal Circuit held in 2022 that an artificial intelligence (AI) system cannot be named as an inventor, inventions made by human beings with the assistance of an AI system may be patent-eligible according to the U.S. Patent and Trademark Office (USPTO) guidelines that the USPTO issued on February 12, 2024.

Under current Patent law, one of the requirements for a patent application is that the applicant names an "inventor" or "inventors" in an application for the claimed invention. Inventorship, an often-overlooked aspect of the patent process, is instrumental in crediting who is responsible for creating a new and useful process, machine, composition of matter, or other patentable subject matter claimed. Failure to properly list an inventor or correct inventorship is grounds for rejection under 35 U.S.C. 101 and 35 U.S.C. 115, and although the America Invents Act (AIA) now allows inventorship corrections to be made, inventorship issues made from deceptive intent can still provide grounds for invalidation of a patent. Patent stakeholders and inventors when listing inventors should remain mindful of who they list, particularly when listing inventors who have used AI systems to create new things.

The USPTO guidelines generally provide that inventions made with the help of AI systems may be patent-eligible if the facts and evidence indicate that the inventor or joint inventors contributed significantly to the claimed invention. Whether an inventor has made a significant contribution is determined under the *Pannu* factors, which look at whether (1) the inventor contributed in some significant manner to the conception or reduction to practice 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) did more than merely explain to the real inventors well-known concepts and/or the current state of the art. *Pannu v. Iolab Corp.*, 155 F.3d 1344, 1351 (Fed. Cir. 1998).

In other words, assistance by an AI system will not automatically make an invention categorically ineligible unless the inventor, if prompted by the USPTO, cannot demonstrate that the inventor has made significant contributions to the invention that are not insignificant when compared to the entirety of the invention and did more than explain how the invention works. Should any dispute on inventorship arise, the USPTO will handle it on a claim-by-claim and case-by-case basis, with each instance turning on its own facts.

The USPTO guidelines are aligned with the decision the court made in *Thaler*, which confirms that inventorship under 35 U.S.C. 100(f) is limited to a natural person. *Thaler v. Hirshfeld*, 558 F. Supp. 3d 238, 241 (E.D. Va. 2021). Inventors must remain mindful when listing names on a patent application to include those who have significantly contributed to the invention. Those who alternatively rely on AI systems to create for them without making significant contributions themselves could ultimately see their patent claims fail.

It is worth noting that the USPTO guidelines are directed to patent applications only. Other types of intellectual property protection, for instance, copyright for AI-generated content, remain largely unavailable.

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