

# Client Alert

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## Can a Computer Be an Inventor? The PTO Wants to Know What You Think

Artificial intelligence (AI) issues in intellectual property are becoming increasingly ubiquitous.

For example, the US Patent and Trademark Office (PTO) has issued “thousands of patents on AI technologies.”<sup>1</sup> The Persado Message Machine, which creates written content by way of data science and AI and is used by “[o]ver 250 of the world’s most valuable brands,” can generate marketing messages in 25 languages.<sup>2</sup> And the University of Surrey in the UK just filed two patent applications—one that claims a “beverage container based on fractal geometry” and one that claims a device “that may help with search and rescue operations”—alleged to be the first inventions “created autonomously by artificial intelligence (AI) without a human inventor.”<sup>3</sup>

Perhaps given these developments, the PTO has decided that the time is now to begin asking questions that broadly address how AI shifts our basic understanding of patent law concepts like inventorship, eligibility, enablement, and the level of ordinary skill in the art. Importantly, the PTO is inviting written comments from the public on patenting AI inventions.

On August 27, 2019, a request for comments published in the Federal Register, seeking information on patent-related issues regarding AI inventions.<sup>4</sup> Specifically, the PTO invites written comments to assist it in “evaluating whether further examination guidance is needed to promote the reliability and predictability of patenting artificial intelligence inventions.” While the PTO welcomes comments “on any issues” the public believes are relevant to patenting AI inventions, it provided a list of 12 questions\*, the answers to which it is particularly interested in. “The questions are designed to cover a variety of topics from patent examination policy to whether new forms of intellectual property are needed.”

Directions for submission of comments (by October 11, 2019) may be found in the Federal Register notice.

Laura Peter, Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the PTO, has indicated that this is merely the first step in the PTO’s consideration of AI in the context of intellectual property. She stated that soon the PTO “will examine the full spectrum of intellectual property policy issues that have arisen, or may arise, as AI technologies become more advanced,” including AI’s impact on copyright and trademarks.<sup>5</sup>

The PTO almost certainly will not have the last word on these issues; Congress and the courts will have to decide what the law requires and what changes may be needed to meet these modern challenges. However, PTO conclusions regarding AI technology in the intellectual property space are very likely to guide future discussion among lawmakers and stakeholders.

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<sup>1</sup> L. Peter, “USPTO announces Federal Register Notice on artificial intelligence patent issues” (Aug. 26, 2019), at <https://www.uspto.gov/blog/>.

<sup>2</sup> See <https://www.persado.com/product/> and <https://www.persado.com/how-it-works/>.

<sup>3</sup> L. Butler, “World first patent applications filed for inventions generated solely by artificial intelligence” (Aug. 1, 2019), at <https://www.surrey.ac.uk/news/world-first-patent-applications-filed-inventions-generated-solely-artificial-intelligence>.

<sup>4</sup> PTO Request for Comments on Patenting Artificial Intelligence Inventions, 84 Fed. Reg. 44889 (Aug. 27, 2019).

<sup>5</sup> L. Peter, “USPTO announces Federal Register Notice on artificial intelligence patent issues.”

## \*Full List of Issues for Comment:

1. Inventions that utilize AI, as well as inventions that are developed by AI, have commonly been referred to as “AI inventions.” What are the elements of an AI invention?
2. What are the different ways that a natural person can contribute to conception of an AI invention and be eligible to be a named inventor?
3. Do current patent laws and regulations regarding inventorship need to be revised to take into account inventions where an entity or entities other than a natural person contributed to the conception of an invention?
4. Should an entity or entities other than a natural person, or company to which a natural person assigns an invention, be able to own a patent on the AI invention?
5. Are there any patent eligibility considerations unique to AI inventions?
6. Are there any disclosure-related considerations unique to AI inventions?
7. How can patent applications for AI inventions best comply with the enablement requirement, particularly given the degree of unpredictability of certain AI systems?
8. Does AI impact the level of a person of ordinary skill in the art? If so, how?
9. Are there any prior art considerations unique to AI inventions?
10. Are there any new forms of intellectual property protections that are needed for AI inventions, such as data protection?
11. Are there any other issues pertinent to patenting AI inventions that we should examine?
12. Are there any relevant policies or practices from other major patent agencies that may help inform USPTO’s policies and practices regarding patenting of AI inventions?

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