Patenting artificial intelligence (AI)-related inventions

- 18th Annual Advanced Patent Law Institute
- March 23, 2023

- Nalini Mummalaneni, Office of Patent Legal Administration, USPTO
- Susan Krumplitsch, Partner, DLA Piper LLP
- Jeanette Berberich, Corporate Counsel, Salesforce

Agenda

- USPTO AI and intellectual property (IP) policy updates
  - AI/emerging technology (ET) partnership events
  - *Thaler v. Vidal*
  - Request for comments regarding artificial intelligence and inventorship
- Patents: AI-related issues
  - Inventorship
  - Subject matter eligibility
  - Disclosure requirements

Stakeholder engagement

- Artificial intelligence and emerging technology (AI/ET) partnership
  - Formation of AI/ET partnership announced in 87 Fed. Reg. 34669 (June 2022)
  - Ongoing cooperative effort between the USPTO and the AI/ET community
  - Platform to:
    - Engage AI/ET community on ongoing and future USPTO AI/ET efforts
    - Understand public's views on the IP policy issues that uniquely affect the AI/ET community
    - Help inform USPTO's future work in the AI/ET IP policy space

- AI/ET Partnership Series
  - June 2022 – AI/ET Partnership Series #1 Kickoff - USPTO AI/ET activities and patent policy
  - September 2022 – AI/ET Partnership Series #2 AI & biotech
  - February 2023 – AI/ET Partnership Series #3 AI-driven innovation
  - May-December 2022 – Blockchain & IP series

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Thaler v. Vidal — background

- **July 29, 2019** – Thaler files patent applications asserting they were invented by "DABUS"

- **August 1 and August 8, 2019** – Pre-examination notice to file missing parts issued: Application data sheet (ADS) did not identify inventor

- **August 29, 2019** – Thaler petitions the notices to file missing parts

- **April 22, 2020** – USPTO issues decisions denying Thaler's petitions

- **September 5, 2021** – EDVA upholds USPTO petition decisions

- **August 5, 2022** – Fed Cir. affirms the USPTO position that an inventor must be a natural person

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Title search: Patenting Issues Applicable to AI Inventions

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First appeared as part of the conference materials for the
18th Annual Advanced Patent Law Institute session
"Patenting Issues Applicable to AI Inventions"