

Artificial intelligence IP policy updates

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Patent Public Advisory Committee meeting



UNITED STATES
PATENT AND TRADEMARK OFFICE ®

AI/ET Partnership – AI & biotech event

- Event took place on September 22, 2022, virtually and in person at the USPTO's Silicon Valley Regional Office
- Comprised two panels and a USPTO presentation
- Agenda and event video may be found at www.uspto.gov/about-us/events/aiet-partnership-series-2-ai-biotech



AI/ET Partnership – AI & biotech event (cont.)

- First panel discussed prosecution and drafting strategies for AI/biotech inventions
- Second panel discussed the intersection of biotechnology and AI and its impact on research and innovation.
- USPTO presented data on the diffusion of AI in biotechnology



Thaler v. Vidal - background

- **July 29, 2019** – Thaler files patent applications asserting they were invented by “DABUS.” Thaler petitions the Notices to File Missing Parts.
- **April 22, 2020** – The USPTO issues decisions denying Thaler’s petitions.
- **September 5, 2021** – The Eastern District of Virginia upholds the USPTO petition decisions.
- **August 5, 2022** – The Federal Circuit (CAFC) affirms the USPTO position that an inventor must be a natural person.

***Thaler v. Vidal* - decision**

- Based on Supreme Court precedent, the court finds that an “individual” (35 USC 100(f)) is a natural person unless Congress provides some indication otherwise.
- The court concluded there is no such indication and the Patent Act instead supports the customary meaning that an “individual” is a human.
- The CAFC did not address whether inventions made by human beings with the assistance of AI are eligible for patent protection.

***Thaler v. Vidal* – next steps**

- **October 20, 2020** – CAFC denied Thaler's request for rehearing and *en banc* rehearing
- Petition for Certiorari?
- The USPTO is considering the impact of *Thaler* and determining next steps, especially with respect to inventorship issues where an AI plays a significant role in the invention creation process.



Thank you!

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