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MEMORANDUM

DATE: February 12, 2024
TO: Patent Examining Corps
FROM: Brian E. Hanlon *Brian E. Hanlon*
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SUBJECT: Inventorship Guidance for AI-Assisted Inventions

Today, the USPTO announced the [Inventorship Guidance for AI-Assisted Inventions \(Inventorship Guidance\)](#) in the Federal Register. This Inventorship Guidance, which is effective tomorrow, provides instructions to examiners and applicants on determining the correct inventor(s) to be named in a patent or patent application for inventions created by natural persons with the assistance of one or more artificial intelligence systems (AI-assisted inventions). The guidance and a set of examples on applying the guidance in specific situations are available on the [Examiner Training and Resource Materials page](#).

I. Background

On August 5, 2022, the Court of Appeals for the Federal Circuit (Federal Circuit) held in *Thaler v. Vidal (Thaler)* that an inventor named in a patent application must be a natural person.¹ The issue began when an applicant, Stephen Thaler, filed two patent applications naming Device for Autonomous Bootstrapping of Unified Sentience (DABUS), an AI system, as the sole inventor. During pre-examination processing, the USPTO denied a pair of petitions by Thaler to name DABUS as the inventor because inventorship is limited to natural persons. These decisions were upheld by the U.S. District Court for the Eastern District of Virginia and, subsequently, by the Federal Circuit. Accordingly, an inventor or joint inventor in a patent application must be a natural person.² Importantly, however, the Federal Circuit did not address whether AI-assisted inventions are eligible for patent protection.

In order to provide clarity to examiners and applicants on the issue of AI-assisted inventions, the USPTO issued the Inventorship Guidance. Specifically, the guidance takes the position that AI-assisted inventions are not categorically unpatentable. Patent protection may be sought for inventions in which a natural person provided a significant contribution to the invention. The guidance provides a framework for determining whether a person could be named as an inventor for a claimed AI-assisted invention.

¹ *Thaler v. Vidal*, 43 F.4th 1207 (Fed. Cir. 2022).

² MPEP § 2109, subsection VII.

The guidance is grounded in the significant contribution test that has been applied for decades since the 1998 *Pannu v. Iolab* Federal Circuit case. While the AI Inventorship Guidance provides new instructions regarding inventorship and AI-assisted inventions, we do not expect a significant change in how examiners evaluate inventorship during examination as discussed below.

II. Examination Impact

While the AI Inventorship Guidance provides new instructions regarding inventorship and AI-assisted inventions, the USPTO expects the impact on patent examination to be minimal. The Office continues to presume that the named inventor or joint inventors in an application are the actual inventor or joint inventors.³ Only in the rare instance where an examiner determines from the file record or extrinsic evidence that one or more of the named inventors may not have invented the claimed subject matter, would questions of inventorship be raised during examination. From an examiner's perspective, it will not matter if AI, or other advanced computer system, performed actions that would rise to the level of inventorship. What matters is, under the guidance, whether at least one human can be (and is) listed as an inventor and no non-humans are listed.

Although inventorship issues are not common during patent examination, failure to name the correct inventor(s) is a ground of rejection under 35 U.S.C. §§ 101 and 115.⁴ Therefore, in the situation where there is sufficient evidence that the application does not identify the correct inventorship, a rejection must be made by the examiner. In the context of AI-assisted inventions, this could occur in several ways. For example, if the applicant lists a non-person as an inventor (e.g. an AI system), the claims of the application must be rejected by the examiner under 35 U.S.C. § 101 and § 115 since an inventor may only be a natural person.⁵ In the situation where the file record or extrinsic evidence relating to the AI-assisted invention calls into question whether the named inventor or joint inventors are proper, the examiner should consult a Technology Center Point of Contact (TC POC) on applying the Inventorship Guidance to determine the correct inventorship of the claimed invention.

Examiners are reminded that when further information is reasonably necessary to properly examine or treat a matter in an application, examiners may require information from the applicant under 37 CFR 1.105.⁶ Therefore, where the file record or other evidence suggests that the inventorship in the application may be incorrect, the examiner may require further information from the applicant on the issue. For example, this could include information regarding the contributions each named inventor made to the claimed invention and how an AI system was used in the creation of the invention. Before making such a requirement, examiners should consult with their TC POCs to ensure the requirement is consistent with the policies of their Technology Center.⁷

³ MPEP § 2157.

⁴ *Id.*

⁵ MPEP § 2109, subsection VII.

⁶ MPEP § 704.10.

⁷ *Id.* (“An examiner or other Office employee may make a requirement for information reasonably necessary to the examination or treatment of a matter in accordance with the policies and practices set forth by the Director(s) of the Technology Center or other administrative unit to which that examiner or other Office employee reports.”).

Generally, inventorship is correctable during examination under 37 CFR 1.48. In most cases, requests to correct inventorship are processed by the Office of Patent Application Processing (OPAP).⁸ A request for correction of inventorship that has been approved may be grounds to withdraw an inventorship rejection under 35 U.S.C. § 101 and § 115 or a requirement for information under 37 CFR 1.105.

Recognizing that as AI becomes ubiquitous and as people build on each other's AI-assisted inventions, it will become increasingly difficult to identify the ways in which AI plays a role in the inventive process. At this time, however, we are not implementing any new requirement to disclose the use of AI beyond that which might be required in rare circumstances by rules 1.56 if material to patentability, or 1.105 if reasonably necessary to properly examine or treat a matter in an application, as discussed above.

To the extent that earlier guidance from the Office, including certain sections of the Manual of Patent Examining Procedure (MPEP) (R-07.2022), is inconsistent with the AI Inventorship Guidance, Office personnel are to follow the AI Inventorship Guidance. The MPEP will be updated in due course.

⁸ MPEP § 602.01(c)(1).