

UNITED STATES
PATENT AND TRADEMARK OFFICE



Guidance on Use of Artificial Intelligence-Based Tools in Practice Before the USPTO

May 15, 2024

AI/ET Working Group



UNITED STATES
PATENT AND TRADEMARK OFFICE ®

Agenda

- Stakeholder engagement
- Background
- Overview of guidance

Please send any questions to aipartnership@uspto.gov.



Stakeholder engagement

Stakeholder engagement

- **Artificial Intelligence and Emerging Technology (AI/ET) partnership**
 - Formation of AI/ET partnership announced in June 2022 (87 Fed. Reg. 34669)
 - Ongoing cooperative effort between the United States Patent and Trademark Office (USPTO) and the AI/ET community
- **Recent AI/ET partnership events**
 - September 27, 2023 – AI tools and data (Alexandria, VA)
 - March 5, 2024 – Inventorship guidance for AI-assisted inventions webinar
 - March 27, 2024 – Public Symposium on AI and IP (Los Angeles, CA)



Background

Impact of AI proliferation

- Increased integration of AI in variety of sectors
- Growth in the use of AI in legal field and in practice before the Office
 - Examiners conducting AI-enabled prior art searches
 - Practitioners relying on AI-based tools to research prior art, create content for Office filings, gain insights into examiner behavior, etc.
- **Uncertainties faced by practitioners in the use of AI tools**
 - Positive impact: potential lower costs, improved quality and efficiency
 - Negative impact: incomplete or inaccurate information, confidentiality and ethical issues

Recent developments in the legal field

- 2023 Year-End Report on the Federal Judiciary
 - Chief Justice John Roberts addressed use of AI in connection with adjudication
- American Bar Association task force on law and AI
- Standing orders and local rules by several federal and state judges concerning use of AI in proceedings before courts

Guidance overview

USPTO guidance on use of AI-based tools

- Director guidance on party and practitioner misconduct related to the use of AI – memorandum issued February 6, 2024
- USPTO issued “Guidance on Use of Artificial Intelligence-Based Tools in Practice Before the United States Patent and Trademark Office” on April 11, 2024 (89 FR 25609)
- Takeaways
 - Use of AI-based tools by practitioners and parties is not prohibited
 - Practitioners reminded of existing rules that may be relevant to use of AI-based tools
 - Notice educates practitioners on possible risks associated with AI-based tools to promote healthy adoption of AI in practice before the USPTO
 - USPTO’s existing rules and policies help mitigate risks of AI assistance
 - Guidance does not introduce any new rules or duties



Document drafting

- 37 CFR 11.18(b) applies to parties signing and/or presenting papers to the Office
 - Certification under 37 CFR 11.18(b)(1)
 - Duty of reasonable inquiry under 37 CFR 11.18(b)(2)
- All individuals associated with a proceeding before the Office have a duty of candor and good faith
- No obligation to disclose use of specific tools to the USPTO unless specifically requested by the USPTO



Filings with the USPTO

- Papers and filings submitted to the USPTO must be signed by the person submitting the paper
 - AI tool cannot sign for a natural person
- USPTO.gov accounts are limited to natural persons and cannot be obtained by non-natural persons
 - Practitioners may not sponsor AI tools as a support staff individual to obtain an account



Interacting with USPTO's Information Technology (IT) systems and websites

- An AI system is not considered a "user" for filing or accessing documents via USPTO's electronic filing systems
- Use of computer tools including AI systems for data mining information from USPTO databases are subject to Terms of Use for USPTO websites
 - USPTO's bulk data products are available for permitted and appropriate data mining
- Use of AI tools on USPTO websites for unauthorized access, use, etc. may constitute a violation of the Computer Fraud and Abuse Act



Confidentiality and national security

- Risks associated with searching or drafting aspects of an invention using AI systems:
 - Inadvertent disclosure of client-sensitive information to third parties resulting in breach of practitioners' confidentiality obligations to clients
 - National security, export control, and foreign-filing license issues
 - Data breaches that subject user data to disclosure risks
- Practitioners may mitigate risks by:
 - Complying with USPTO Rules of Professional Conduct when relying on AI tools and/or related third-party services
 - Understanding AI tools' terms of use, privacy policies, and cybersecurity practices

Please send any questions to aipartnership@uspto.gov.





Please send any questions to aipartnership@uspto.gov.