

Produced by the United States Patent and Trademark Office; no copyright is claimed by the United States in this presentation or associated materials.

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

1

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

2

2

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

3

3

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

4

4

Find the full text of this and thousands of other resources from leading experts in dozens of legal practice areas in the [UT Law CLE eLibrary \(utcle.org/elibrary\)](https://utcle.org/elibrary)

Title search: Patenting Issues Applicable to AI Inventions

Also available as part of the eCourse

[2023 Advanced Patent Law \(USPTO\) eConference](#)

First appeared as part of the conference materials for the

18th Annual Advanced Patent Law Institute session

"Patenting Issues Applicable to AI Inventions"