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AI-Assisted Innovation: Navigating the USPTO's Latest Guidelines

Promoting Innovation While Honoring Human Ingenuity

The United States Patent and Trademark Office (“USPTO”) has issued comprehensive [guidance](#) on inventorship for AI-assisted inventions, reflecting the growing role of artificial intelligence (“AI”) in the innovation process. This guidance provides much-needed clarity for inventors and practitioners and is indicative of the Office’s dedication to maintaining relevant examination standards in a rapidly changing technical landscape. Those wishing to protect their AI-related innovations should thoroughly review the guidance to ensure patentability of their inventions.

The USPTO underscores that while AI can contribute to the development of inventions, patents will only be granted for work where humans have made a substantial contribution. The guidance clarifies that AI systems themselves cannot be named as inventors; only natural persons can. This principle is rooted in the desire to incentivize human ingenuity, a foundational aspect of patent law.

The USPTO provides five guiding principles for determining whether a natural person contributed to an invention. These guidelines reflect the USPTO’s view of the *Pannu* factors related to inventorship in the modern world. The guidelines include, generally, the following considerations:

1. A natural person’s significant contribution to the AI-assisted invention, regardless of use of the AI system.
2. A natural person contributing more than merely recognizing a problem, such as by specific prompting of the AI system for a particular outcome.
3. A natural person transforming the output of an AI system to create an invention.
4. A natural person who develops an essential building block from which the claimed invention is derived such as designing, building, or training an AI system in view of a specific problem to elicit a particular solution.
5. A natural person contributing significantly more than merely owning or overseeing an AI system.

Notably, [as we saw post-Alice](#), the USPTO has provided a set of [resources](#) for considering AI-related inventions, including example scenarios and analysis,

similar to those which became a lifeline for practitioners navigating software-related patent protection.

The key takeaway is the importance of identifying and teasing out the distinction of human contribution and the resulting or contributing algorithm. Skilled patent practitioners should be able to “tell the story” of AI-assisted innovation through the lens of human contribution, while accurately detailing the technical aspects and improvements of the AI systems involved in the process.

This guidance represents a balancing act by the USPTO, seeking to foster innovation through AI while ensuring that the patent system continues to reward human creativity. It is a clear message to the tech world that while AI can enhance innovation, the essence of patentability remains human intellect and creativity.

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