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## Mastering the Patentability of AI

### Client Updates

### Overview:

As AI technologies become increasingly integral to the invention process, understanding the legal implications of this integration is crucial for inventors, designers and your business. While AI cannot be considered an inventor under the current IP system, it raises important questions about patentability when used as a sophisticated tool in the inventor's toolkit.

The guidelines issued by the United States Patent and Trademark Office (USPTO) earlier this year clarify the criteria for recognizing inventors in the context of AI-assisted inventions.

### 5 Key Takeaways:

#### **a. AI-Assisted Inventions are Not Categorically Unpatentable:**

If the human contribution to the conception of the invention is significant, AI-assisted inventions can be patentable.

#### **b. Conception Requires Significant Contribution:**

Merely recognizing a problem or having a general goal or research plan does not rise to the level of conception. Making a significant contribution to the output of an AI system to create an invention may make you an inventor.

#### **c. Reduction to Practice Is Insufficient:**

Reducing an invention to practice alone does not constitute a significant contribution that rises to the level of inventorship. To be considered an inventor for the reduction to practice of the output of the AI system, significant contribution should be made by the natural person.

#### **d. Essential Building Blocks Count:**

While overseeing the AI or owning it does not make you an inventor, developing an essential building block that gives rise to the invention is considered a significant contribution to the invention created with the AI system.

#### **e. Evaluating the Significance of Contribution:**

The determinations will follow well-established and commonly used Pannu test (Pannu v. Iolab Corp.), which evaluates whether a person has significantly contributed to the conception or the reduction to practice of an invention, made a non-trivial contribution, and done more than just explain well-known concepts.

In the case of current AI systems, it all starts with the prompt. A significant contribution could be shown in how the inventor constructs the prompt for the AI system in view of a specific problem to elicit a particular solution from this AI system. Making a significant contribution to the output, such as tweaking the prompt, rewriting it, providing more details, or adjusting the output using other tools, will help avoid the trap of mere reduction to practice of the output of an AI system.

## Why is the Matter of Inventorship Important?

While the Israel Patent Law allows for filing a patent application without naming the inventors, in most other countries, including the US, incorrect inventorship listing can lead to legal challenges and potential invalidation of patents.

## Our tips for good practice:

- Clearly differentiate between AI-generated and human-generated contributions.
- Meticulously document all human contributions, from recognizing the problem to developing the solution.
- Keep a clear record of all prompts created and used with the AI system.
- Document any changes made to the AI system's output and track the evolution of the output.
- Mark each version of the AI system output with the date, the prompt used, and the AI system type and version.

## Conclusion:

By ensuring that human contributions are properly recognized and documented, inventors, designers, and entrepreneurs can protect their intellectual property and navigate the complexities of AI-assisted inventorship effectively. Such documentation might become essential for establishing inventor status, for now at least, at the USPTO.

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**This update is intended to provide general and concise information only. It does not constitute a complete analysis of the issues discussed, does not constitute a legal opinion or legal advice, and should not be relied upon.**

For more information or assistance with specific cases involving AI-assisted inventions, please feel free to reach out to Dr. Maya Shmailov.

## **Key Contacts**



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