

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Artificial intelligence IP policy updates

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Patent Public Advisory Committee quarterly meeting

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***Thaler v. Hirshfeld* – background**

- Two U.S. patent applications were filed naming an AI machine, “DABUS,” as the inventor.
- The USPTO issued a Notice to File Missing Parts because the inventor was not identified by his or her legal name.
- A petition under 37 CFR 1.181 was filed requesting the Director to vacate the Notice to File Missing Parts because DABUS purportedly independently created the inventions.
- The USPTO denied the petition finding that current patent statutes, case law, and USPTO regulations and rules limit inventorship to natural persons.
- Petitioner brought an action challenging the USPTO’s decision in the United States District Court for the Eastern District of Virginia. Case No: 1:20cv903.

***Thaler v. Hirshfeld* – EDVA decision: An AI cannot be an inventor**

- Thaler and the USPTO filed cross-motions for summary judgment. The USPTO argued that in the Patent Act, Congress explicitly defined the term “inventor” to be an “individual,” which must be a natural person.
- On September 2, 2021, Judge Brinkema granted the USPTO’s motion for summary judgment and found that the statute is clear that an “inventor” must be a natural person and an AI cannot be an inventor.
- Judge Brinkema also referenced the USPTO’s AI Report and noted that many commentators disagreed with Thaler’s view that AI machines should be recognized as inventors.
- Thaler appealed this decision to the United States Court of Appeals for the Federal Circuit. Case No. 2021-2347.

National AI Advisory Committee

- The National AI Initiative Act of 2020 calls for the Secretary of Commerce (in consultation with Office of Science and Technology Policy, or OSTP, and other agency heads) to establish the National AI Advisory Committee (NAIAC).
- On September 8, 2021, the Department of Commerce published a call for nominations to serve on the NAIAC.
 - Deadline for initial nominations was October 25, 2021.
 - Nominations will be accepted on ongoing basis and will be considered when vacancies arise.

WIPO conversation: “Data – Beyond AI in a Fully Interconnected World”

- Fourth session of WIPO Conversation
 - Held on September 22 and 23, 2021
- Panel discussions on:
 - Background of current data debates
 - Regulatory frameworks for data
 - How data fits into current IP system
 - Use cases of AI

Conference on copyright law and machine learning for AI

- Co-sponsored by the USPTO and US Copyright Office
 - Held on October 26, 2021
- Panel discussions on:
 - Machine learning in practice
 - How existing copyright laws apply to the training of AI
 - What the future may hold in this fast-moving policy space



Thank you!

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