

August 28, 2019

## USPTO REQUESTS PUBLIC COMMENTS ON PATENTING ARTIFICIAL INTELLIGENCE INVENTIONS

To Our Clients and Friends:

Following up on the release of [eligibility guidelines for AI-related inventions](#) earlier this year, the United States Patent and Trademark Office (Patent Office) published yesterday a request for public comments on a series of patent-related issues regarding AI inventions. *Request for Comments on Patenting Artificial Intelligence Inventions*, 84 Fed. Reg. 44889, 44889 (Aug. 27, 2019).

The Patent Office hopes that with the input it receives in response to this request for comments from the innovation community and experts in AI, the Patent Office will be in a strong position to evaluate whether further patent examination guidance is needed to (1) “promote the reliability and predictability of patenting artificial intelligence inventions,” and (2) “ensure that appropriate patent protection incentives are in place to encourage further innovation.” *Id.*

The office’s request poses twelve questions covering “a variety of topics from patent examination policy to whether new forms of intellectual property protection are needed.” *Id.* For example, the questions cover topics such as:

1. **Inventorship** – Should current inventorship laws and regulations be revised to account for entities other than a natural person contributing to the conception of an invention? What are the different ways in which a natural person can contribute to the conception of an AI invention?
2. **Ownership** – Who owns an AI invention? Is it the company who trains the AI process that creates the invention? Should entities other than a natural person or the company to which it is assigned be able to own an AI invention?
3. **And Patent Application Requirements** – Does AI impact the level of a person of ordinary skill in the art? Are there disclosure-related considerations unique to AI inventions, such as written description? Are new forms of intellectual property protections needed for AI inventions?

This is an important opportunity for individuals and companies active in AI technologies to provide their perspective on how U.S. intellectual property law and patent office procedures should address some of the unique issues raised by AI inventions. Written comments may be sent by email to [AIPartnership@uspto.gov](mailto:AIPartnership@uspto.gov), and must be received on or before October 11, 2019.



# GIBSON DUNN

*Gibson Dunn's lawyers are available to assist in addressing any questions you may have regarding these developments. Please contact the Gibson Dunn lawyer with whom you usually work, any member of the firm's Artificial Intelligence and Automated Systems or Intellectual Property practice groups, or the following authors:*

*H. Mark Lyon - Palo Alto (+1 650-849-5307, [mlyon@gibsondunn.com](mailto:mlyon@gibsondunn.com))  
Jessica A. Hudak - Orange County (+1 949-451-3837, [jhudak@gibsondunn.com](mailto:jhudak@gibsondunn.com))*

*Please also feel free to contact any of the following practice group leaders and members:*

***Artificial Intelligence and Automated Systems Group:***

*H. Mark Lyon - Chair, Palo Alto (+1 650-849-5307, [mlyon@gibsondunn.com](mailto:mlyon@gibsondunn.com))  
J. Alan Bannister - New York (+1 212-351-2310, [abannister@gibsondunn.com](mailto:abannister@gibsondunn.com))  
Lisa A. Fontenot - Palo Alto (+1 650-849-5327, [lfontenot@gibsondunn.com](mailto:lfontenot@gibsondunn.com))  
David H. Kennedy - Palo Alto (+1 650-849-5304, [dkennedy@gibsondunn.com](mailto:dkennedy@gibsondunn.com))  
Ari Lanin - Los Angeles (+1 310-552-8581, [alanin@gibsondunn.com](mailto:alanin@gibsondunn.com))  
Robson Lee - Singapore (+65 6507 3684, [rlee@gibsondunn.com](mailto:rlee@gibsondunn.com))  
Carrie M. LeRoy - Palo Alto (+1 650-849-5337, [cleroy@gibsondunn.com](mailto:cleroy@gibsondunn.com))  
Alexander H. Southwell - New York (+1 212-351-3981, [asouthwell@gibsondunn.com](mailto:asouthwell@gibsondunn.com))  
Eric D. Vandeveld - Los Angeles (+1 213-229-7186, [evandeveld@gibsondunn.com](mailto:evandeveld@gibsondunn.com))  
Michael Walther - Munich (+49 89 189 33 180, [mwalther@gibsondunn.com](mailto:mwalther@gibsondunn.com))*

***Intellectual Property Group:***

*Wayne Barsky - Co-Chair, Los Angeles (+1 310-552-8500, [wbarsky@gibsondunn.com](mailto:wbarsky@gibsondunn.com))  
Josh Krevitt - Co-Chair, New York (+1 212-351-4000, [jkrevitt@gibsondunn.com](mailto:jkrevitt@gibsondunn.com))  
Mark Reiter - Co-Chair, Dallas (+1 214-698-3100, [mreiter@gibsondunn.com](mailto:mreiter@gibsondunn.com))*

© 2019 Gibson, Dunn & Crutcher LLP

*Attorney Advertising: The enclosed materials have been prepared for general informational purposes only and are not intended as legal advice.*