



May 13, 2024

The Honorable Katherine K. Vidal  
Under Secretary of Commerce for Intellectual Property  
and Director of the United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Submitted via: <https://www.regulations.gov>

**Re: Comments in Response to Inventorship Guidance for AI-Assisted Inventions; Docket Number PTO–P–2023–0043**

Dear Director Vidal:

Intellectual Property Owners Association (“IPO”) appreciates this opportunity to submit the following comments in response to the USPTO’s Inventorship Guidance for AI-Assisted Inventions (docket number PTO–P–2023–0043), published in Vol. 89, No. 30 *Federal Register* on Tuesday, February 13, 2024 (“the Guidance”).

IPO is an international trade association representing companies and individuals in all industries and fields of technology who own, or are interested in, intellectual property rights. IPO’s membership includes 175 companies and close to 12,000 individuals who are involved in the association either through their companies or as inventor, author, law firm, or attorney members. IPO advocates for effective and affordable IP ownership rights and provides a wide array of services to members, including supporting member interests relating to legislative and international issues; analyzing current intellectual property issues; information and educational services; and disseminating information to the general public on the importance of intellectual property rights.

IPO’s vision is the global acceleration of innovation, creativity, and investment necessary to improve lives. The Board of Directors has adopted a strategic objective to foster diverse engagement in the innovation ecosystem and to integrate diversity, equity, and inclusion in all its work to complement IPO’s mission of promoting high quality and enforceable IP rights and predictable legal systems for all industries and technologies.

IPO thanks the USPTO for issuance of this important and timely guidance. As innovators both large and small are increasingly using AI tools in their work, clarity as to inventorship – and thus patentability – is paramount. Uncertainty surrounding inventorship and patentability of AI-assisted inventions could impede innovation, hindering the development and application of new technologies. As AI technology becomes further integrated into everyday business operations, innovators must be able to confidently leverage AI tools in good faith without fear of inventions being deemed unpatentable due to new and complex inventorship considerations.

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IPO supports the position taken in the Guidance to maintain the status quo for inventorship determinations even in the case of AI-assisted inventions. An invention made by a natural person should not be rendered unpatentable merely because an AI tool was used as part of the inventive process. As succinctly stated in Guiding Principle 1 of the Guidance:

*A natural person's use of an AI system in creating an AI-assisted invention does not negate the person's contributions as an inventor. The natural person can be listed as the inventor or joint inventor if the natural person contributes significantly to the AI-assisted invention.*

89 FR 10043 at 10048 (Section IV(B)) (citations omitted).

IPO also agrees with the position taken in the Guidance that inventorship is proper so long as a natural person has made a significant contribution to each claim of a patent:

*There is no requirement for a named inventor to contribute to every claim in an application or patent; a contribution to a single claim is sufficient. However, each claim must have been invented by at least one named inventor. In other words, a natural person must have significantly contributed to each claim in a patent application or patent. In the event of a single person using an AI system to create an invention, that single person must make a significant contribution to every claim in the patent or patent application.*

89 FR 10043 at 10048 (Section IV(A)) (citations omitted).

These positions in the Guidance properly focus the inquiry on the contribution of the natural person to the invention rather than on whatever may be done by an AI system being used as a tool of innovation. This is consistent with existing U.S. law on inventorship, is sound policy, and avoids establishing different standards of inventorship for different types of technology. Overall, this supports certainty and predictability of the patent system.

IPO also notes with appreciation that the Guidance does not attempt to introduce a new disclosure requirement directed to use of AI tools during the inventive process. IPO agrees with the Guidance that, because improper inventorship is a statutory basis for rejection of a patent application, and because there is an existing duty of candor and good faith, there is no basis for requiring any additional disclosures. IPO believes avoiding different standards for different types of technologies is sound policy.

Guiding Principle 3 of the Guidance includes the following statement:

*Reducing an invention to practice alone is not a significant contribution that rises to the level of inventorship. Therefore, a natural person who merely recognizes and appreciates the output of an AI system as an invention, particularly when the properties and utility of the output are apparent to those of ordinary skill, is not necessarily an inventor.*

89 FR 10043 at 10048 (Section IV(B)) (citations omitted).

IPO believes that the determination of whether a natural person is an inventor in this situation should rest on the same conception criteria as in all other situations, namely, “whether the inventor had an idea that was definite and permanent enough that one skilled in the art could understand the invention.” *Burroughs Wellcome Co. v. Barr Laboratories, Inc.*, 40 F.3d 1223, 1228 (Fed. Cir. 1994). The manner by which the inventor arrived at that idea should not be a factor and, in fact, is expressly excluded by statute: “Patentability shall not be negated by the manner in which the invention was made.” 35 U.S.C. §103.

IPO thanks the USPTO for the significant effort that went into preparing this important Guidance and for this opportunity to provide our comments. Our organization welcomes further dialogue and opportunity to provide additional information.

Sincerely,

A handwritten signature in black ink that reads "Krish Gupta". The signature is written in a cursive, slightly slanted style.

Krish Gupta  
President