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Patent litigator and Silicon Valley Office Managing Partner Kathi Vidal shares her perspective on AI and patents in *The Recorder's* article titled "[Can AIs Hold Patents? Experts Answer USPTO's Questions About Artificial Intelligence.](#)" The article focuses on four questions the USPTO needs to address as more inventions are created by artificial intelligence (AI).

**1: Do current patent laws and regulations regarding inventorship need to be revised to take into account inventions where an entity or entities other than a natural person contributed to the conception of an AI invention or any other invention?**

Kathi: The PTO's questions hit some of the hot issues percolating around AI and our patent system. Though any proposals or changes to the law will have to withstand, at some point, Constitutional level scrutiny including on what our Founding Fathers meant by empowering Congress to secure for limited times exclusive rights to "inventors," the bigger issue in my view is whether expanding the definition of "inventor" to include AI would advance the constitutional objective of "promot[ing] the progress of ... [the] useful arts."

Or, on the other hand, would allowing for the patenting of inventions conceived by AI (which AI could do with relative speed and ease and little expense) threaten to preempt fields and lock-up technology in such a way that stunts progress? There is enough of a divide between the incentives needed to encourage innovation in the bio and pharma space (just read the Federal Circuit's recent *Athena v. Mayo* decision) compared to the electrical, computer, and mechanical arts. Adding AI to the mix may stretch our "one-size-fits-all" patent system to its breaking point.

**2: Are there any patent eligibility considerations unique to AI inventions?**

Kathi: The judicially-created exceptions to patentability are premised in some respects on a fear of locking up technology or preempting a field. We don't allow for the patenting of mathematical formulas, because doing so would preempt every use of that formula. The issue with AI inventions is not that any RECORDER given invention would preempt a field, but that the speed with which AI could invent raises similar concerns. For this reason, patent eligibility, like other aspects of our patent system, needs to be carefully rethought.

**3: Does AI impact the level of a person of ordinary skill in the art?**

Kathi: If the level of ordinary skill in the art is revised to the level of AI, then the exercise of determining obviousness could become circular. If operating on a data set, AI combines two references, then one could say that, under an AI standard, those concepts were obvious to combine. If AI invents based on a given data set, then one could argue that it would have been obvious from the perspective of AI to come up with that invention. Because AI can readily analyze the results of each combination and adjust its next combination, the whole hindsight analysis collapses. In a way, AI has hindsight from the get go. (My partner Chuck Klein adds: “Using AI might also affect reasonable expectation of success, and redefine “finite” number of potential solutions in the obvious-to-try context.”)

#### **4: Do the disclosure rules (enablement, specification, etc.) need to be altered for AI-related patent applications?**

Kathi: Every rule needs to be rethought when it comes to AI and all the data the AI analyzed to come up with the invention, including not only enablement and the specification, but also which pieces of prior art must be disclosed to the PTO and whether AI must not only disclose that art (which could be impossibly voluminous), but also must rate the art based on how it weighed the references during its design process. If we are going to reward AI inventions, we need to make sure the public receives the appropriate quid pro quo.

View the full article [here](#).

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