

**INTERNATIONAL TRADEMARK ASSOCIATION COMMENTS ON
THE IMPACT OF THE PROLIFERATION OF ARTIFICIAL INTELLIGENCE ON PRIOR ART
(USPTO's Request for Comments)**

July 29, 2024

The International Trademark Association (INTA) would like to thank the United States Patent and Trademark Office (USPTO) for the opportunity to provide comments on the USPTO's Request for Comments Regarding the Impact of the Proliferation of Artificial Intelligence on Prior Art, the Knowledge of a Person Having Ordinary Skill in the Art, and Determinations of Patentability Made in View of the ("RFC").

The following comments were prepared by INTA's Designs Committee and staff.

The International Trademark Association (INTA) is a global association of brand owners and professionals dedicated to supporting trademarks and complementary intellectual property (IP) to foster consumer trust, economic growth, and innovation, and committed to building a better society through brands. Members include nearly 6,500 organizations, representing more than 34,350 individuals (trademark owners, professionals, and academics) from 185 countries, who benefit from the Association's global trademark resources, policy development, education and training, and international network. Founded in 1878, INTA, a not-for-profit organization, is headquartered in New York City, with offices in Beijing, Brussels, Santiago, Singapore, and Washington, D.C., and a representative in New Delhi. For more information, visit [inta.org](https://www.inta.org).

General Comments

INTA continues to develop its position on the various issues posed by Artificial Intelligence (AI) as they arise.

INTA recently provided comments on the USPTO's Inventorship Guidance for AI-Assisted Inventions ("Inventorship Guidance"). See https://www.inta.org/wp-content/uploads/public-files/advocacy/testimony-submissions/20240513_INTA-Comments-on-Inventorship-Guidance-for-AI-Assisted-Inventions.pdf. Before that, INTA provided comments in response to the USPTO's Request for Comments on Intellectual Property Protection for Artificial Intelligence. See <https://www.inta.org/wp-content/uploads/public-files/advocacy/testimony-submissions/INTA-Comments-to-the-USPTO-on-AI-1.9.20.docx>. INTA also provided comments on the United States Copyright Office Notice of Inquiry and Request for Comments on Artificial Intelligence last year. See https://www.inta.org/wp-content/uploads/public-files/advocacy/testimony-submissions/20231030_INTA-Comments-on-US-Copyright-Office-AI-Consultation.pdf.

INTA has also surveyed forty-eight jurisdictions on the availability of copyright or other neighboring rights (a.k.a. “related rights”), like “the rights of performers in respect of their performances, the rights of producers of phonograms in respect of their phonograms, and the rights of broadcasting organizations in respect of their broadcasts,” to protect AI-generated outputs. See https://www.inta.org/wp-content/uploads/public-files/advocacy/committee-reports/20230724_Copyrights-and-Neighboring-Rights-of-Outputs-by-AI-Systems.pdf. That survey did not address whether AI-generated outputs are eligible for (industrial) design protection in the surveyed jurisdictions, or whether the surveyed jurisdictions have provided guidance on how to assess patentability/registrability of an industrial design over AI-generated outputs. To date, INTA has not surveyed any jurisdictions on either topic. However, INTA is aware of several decisions that have declined to recognize AI as an inventor and that have refused to grant an invention (utility) patent on an invention naming AI as the inventor. See the U.S. Federal Circuit (see *Thaler v. Vidal*, 43 F.4th 1207, 1213 (Fed. Cir. 2022), *cert denied*, 143 S. Ct. 1783 (2023)), Brazilian Patent & Trademark Office (see [Legal Opinion nº 00024/2022/CGPI/PFE-INPI/PGF/AGU](#)), and German Federal Court of Justice (see [BGH, order of June 11, 2024 - X ZB 5/22](#)). INTA is also not aware of any jurisdictions that have provided guidance on how to assess patentability/registrability of an industrial design over AI-generated outputs. INTA provides the following comments in response to Questions 1, 3, and 4(a) of the USPTO’s RFC.

Specific Comments

- 1. In what manner, if any, does 35 U.S.C. 102 presume or require that a prior art disclosure be authored and/or published by humans? In what manner, if any, does non-human authorship of a disclosure affect its availability as prior art under 35 U.S.C. 102?**

35 U.S.C. 102(a) of the U.S. Patent Act states:

(a) Novelty; Prior Art.—A person shall be entitled to a patent unless—

(1)

the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or

(2)

the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

35 U.S.C. 100(f) of the Patent Act defines “inventor” as “the **individual** or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention.”

The Federal Circuit has acknowledged that although the Patent Act does not define “individual,” “the Supreme Court has held when used “[a]s a noun, ‘individual’ ordinarily means a human being, a person.” *Thaler v. Vidal*, 43 F.4th 1207, 1211 (Fed. Cir. 2022), cert. denied, 143 S. Ct. 1783, 215 L. Ed. 2d 671 (2023). See *Mohamad v. Palestinian Auth.*, 566 U.S. 449, 454, 132 S.Ct. 1702, 182 L.Ed.2d 720 (2012). Based on that definition, the term “inventor” in the Patent Act must refer to a human being. *Thaler* at 1212.

Taking all the above together, the USPTO may reasonably interpret 35 U.S.C. 102(a) as requiring human authorship of a patent or published application’s claimed invention to be eligible as prior art. This interpretation is also consistent with the logical consequence of Section II of the USPTO’s Inventorship Guidance for AI-Assisted Inventions (“Inventorship Guidance”), which mandates that an inventor or joint inventor named in a U.S. patent or patent application be a natural person, not an AI system. 89 FR 10043, 10045 <<https://www.govinfo.gov/content/pkg/FR-2024-02-13/pdf/2024-02623.pdf>>. Because an AI system cannot currently be a named inventor or joint inventor in a U.S. patent application, inventions (and designs) conceived solely by AI cannot currently be the claim of a U.S. Patent or U.S. Patent Publication that could constitute prior art under 35 U.S.C. 102 (a). INTA encourages the USPTO to confirm this point.

The more challenging question is whether 35 U.S.C. 102(a) requires human authorship of an invention previously described in a “printed publication,” “in public use,” “on sale,” or “otherwise available to the public” to be prior art. As currently written, 35 U.S.C. 102(a) arguably does not limit prior art to *human-conceived* inventions previously described in a printed publication, in public use, on sale, or otherwise available to the public. However, if adopted, this interpretation seems to conflict with the USPTO’s Inventorship Guidance, which adopts the Federal Circuit’s view on inventorship, which is “unwilling to extend conception to non-natural persons” (including AI) because “conception is an act...only performed by natural persons.” 89 FR 10043, 10046. INTA therefore encourages the UPSTO to provide guidance on whether 35 U.S.C. 102(a) limits prior art to human-conceived inventions based on the legislative history and the goals of the Patent Act, which the USPTO’s prior guidance acknowledges “is designed to encourage *human* ingenuity.” *Id.*

3. If a party submits to the Office a printed publication or other evidence that the party knows was AI-generated, should that party notify the USPTO of this fact, and if so, how? What duty, if any, should the party have to determine whether a disclosure was AI-generated?

37 C.F.R. 1.56 requires applicants and patent owners to submit information material to patentability in an Information Disclosure Statement according to 37 C.F.R. 1.98. 37 C.F.R. 1.98 (b)(5) provides that “[e]ach publication listed in an information disclosure statement must be identified by publisher, **author** (if any), title, relevant pages of the publication, date, and place of publication.” *Id.* (Emphasis added).

The Supreme Court in *Burrow-Giles Lithographic Co. v. Sarony* defined “author” (in the context of U.S. copyright law) as “he to whom anything owes its origin; originator; maker; one who completes a work of science or literature.” 111 U.S. 53, 58 (1884). In that decision, the Court also described beneficiaries of the congressional acts intended to “promote the progress of science and useful arts”

as “persons...—authors and inventors.” *Id.* at 56 (emphasis added).

Applying the Supreme Court’s definition of “author” to 37 CFR 1.98 (b)(5), that rule could arguably be interpreted as not requiring a party to disclose that a publication generated solely by AI is AI-generated. Therefore, INTA encourages the USPTO to consider whether 37 CFR 1.98 should be amended to clarify whether a party must inform the USPTO that a printed publication is AI-generated.

Further complicating this issue is the fact that in some jurisdictions, there is no requirement to provide the name of any individuals that invented a design. For example, providing the names of designers for a design claimed in an EUIPO application is optional. See EUIPO Design guidelines 6.2.4 (“The citation...regarding the designer(s) are merely optional and are not subject to examination.”) <<https://guidelines.euipo.europa.eu/1934976/1926662/designs-guidelines/6-2-4-citation-of-the-designer-s->>. Similarly, providing the names of designers for a design claimed in an UKIPO application is not necessary if the owner of the design is a company. See UKIPO Designs Form DF2A – Guidance Notes. <<https://assets.publishing.service.gov.uk/media/643f863d6dda69000d11e02f/DF2A-and-guidance.pdf>>. Requiring a party to determine whether a disclosure is the product of an AI tool or a human may therefore be difficult. INTA therefore encourages the UPSTO to account for these difficulties.

4(a). Should an AI-generated disclosure be treated differently than a non-AI-generated disclosure for prior art purposes? For example:

a. Should the treatment of an AI-generated disclosure as prior art depend on the extent of human contribution to the AI-generated disclosure?

INTA encourages the USPTO to elaborate on whether inventions (or designs) conceived *solely* by AI and described in a foreign patent (issued by an Intellectual Property Office whose patent laws do not restrict inventorship to human beings¹), printed publication, or in public use, on sale, or otherwise available to the public could be prior art under 35 U.S.C. 102. This is of particular importance, given that companies may use AI for generating inventions that, if not included in a patent application, “can be used as ‘defensive publications’...Defensive publications are details distributed into the public domain to stop others [from] obtaining a patent on the same invention.” *AI Helps Pharma Find New Drugs But Imperils Lucrative Patents*, Gilbert *et al.* <>. While there are workarounds to obstacles posed by AI-generated defensive publications in the context of utility applications (e.g., arguing lack of enablement), INTA anticipates that the same might not be true for autonomously generated AI designs applied as prior art in the context of design applications. If AI-generated designs can legally preclude a human-created design from obtaining patent protection, this could impede protecting and commercializing human-created designs. This outcome would also contradict the purpose of the intellectual property clause of the U.S. Constitution, which aims “to promote the progress of science

¹ INTA is currently aware of one country—South Africa—that has granted a patent identifying an AI system as the sole inventor. See <https://www.managingip.com/article/2a5czh91g6c8zwxjcpla8/dabus-south-africa-issues-first-ever-patent-with-ai-inventor>.



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and useful Arts by securing for limited Times to authors and inventors the exclusive Right to their respective Writings and Discoveries”.

INTA would be pleased to answer any questions that the USPTO may have and is available to discuss our recommendations in more detail. Please contact Jenny Simmons (jsimmons@inta.org) or Erica Vaccarello (evaccarello@gmail.com).

Thank you in advance for considering the views of INTA.

Yours sincerely,

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International Trademark Association