USPTO Outlines Possible Pitfalls For Attorneys Using AI

By **Ryan Davis**

Law360 (April 10, 2024, 9:51 PM EDT) -- The U.S. Patent and Trademark Office on Wednesday detailed risks facing attorneys using artificial intelligence, warning that they must ensure that filings are accurate and humans played a role in inventions, which attorneys say illustrates that ethical rules are unchanged in the AI era.

In guidance to attorneys, the USPTO said it's possible that employing AI tools to prepare patent and trademark applications and other filings could lead to increased efficiency and quality, but "it is essential to address the legal and ethical considerations that arise with the use of these technologies."

The guidance said the office "has determined that existing rules protect the USPTO's ecosystem against such potential perils" and explained how attorneys should follow them to mitigate the risks from using AI in their work.

Attorneys must protect client confidentiality when using AI tools and vet any filings prepared with AI assistance to avoid submitting inaccurate information, the USPTO said. It also stressed the importance of following February guidance that patent protection is only available when a human has made a "significant contribution" to an invention created with assistance from AI.

Rather than creating new policies, the USPTO restated current rules that could come into play when AI tools are part of patent and trademark practice, and it "basically confirmed that they are applicable even if you use AI," said Raghav Bajaj of Haynes and Boone LLP.

That is consistent with what most people are doing, he said, but given the potential for misuse of the technology, the USPTO is getting out in front and telling attorneys "don't try to flout the rules just because you use AI," he said.

The USPTO made clear that ethical obligations for attorneys have not changed even though AI can make some tasks easier, and "practitioners need to use common sense and not rely on AI without checking it, which everyone should have been doing anyhow," said Dion Bregman of Morgan Lewis & Bockius LLP.

The guidance is "a reminder not to go off and just have some generative AI tool be the one that's running the show," said Ben Volk of Thompson Coburn LLP. "The attorney is still the one who's ultimately responsible for what gets submitted to the patent office."

Applying Rules To AI

The guidance goes through numerous existing rules and policies and explains how they "require practitioners and others to exercise special care when using AI as a tool" in USPTO practice.

The patent office told attorneys to be "especially vigilant to ensure that confidentiality of client data is maintained" when working with AI. It noted that sensitive data entered into an AI tool to draft patent claims or search for prior patents could be retained or used to train the system, "in breach of practitioners' confidentiality obligations to their clients."

Much of the guidance is tied to the duty of candor that attorneys have in patent office proceedings, which includes disclosing all the information they know that could be material to whether an invention is patentable, and the requirement to sign all filings and certify that they are accurate.

When an attorney signs a document and submits it to the USPTO, the guidance makes clear that "everything revolves around the duty of candor," said Mauricio Uribe of Knobbe Martens.

The patent said there is no prohibition on using AI tools to draft documents submitted to the USPTO, and there is no rule that the use of AI must be disclosed. However, given the technology's potential to omit or make up information, attorneys must review filings to ensure all the statements are true and that there are no fictional case citations, the guidance said.

There is also no per se requirement to disclose when AI tools were used to create an invention, but the office said that information may be needed if it is material to whether the invention can be patented. Citing guidance it issued in February, the USPTO said "material information could include evidence that a named inventor did not significantly contribute to the invention because the person's purported contributions were made by an AI system."

Similarly, if AI is used to draft or modify a patent application, attorneys must ensure that the wording used by the AI does not introduce any new information that was not contemplated by the inventors, the guidance said.

That presents a somewhat distinct concern from the idea that patented inventions must have a human contribution, Uribe said, since "even if you are careful about what the human inventor created, the act of drafting could inject that issue."

The guidance said that if AI is used to create an Information Disclosure Statement, which details information about earlier inventions relevant to a patent application, attorneys must review and remove "clearly irrelevant and marginally pertinent cumulative information." The USPTO expressed concern that "the unchecked use of AI poses the danger of increasing the number and size" of such submissions, which could burden patent examiners.

Uribe noted that means that while AI could quickly generate a large volume of seemingly relevant pieces of information about a patent, "a human should not sign that form without having looked at all those references."

For trademark applications, the USPTO warned against submitting AI-generated use of the trademark "or any other evidence created by AI that does not actually exist in the marketplace."

Finally, the guidance warns that attorneys should take care not to violate rules or policies when using AI to access USPTO systems. For instance, AI systems cannot obtain accounts to access the office's databases and must not be used to access data in the systems that a person doesn't have access to, it said.

Preparing For The Future

Attorneys said the guidance is helpful to have in place as AI rapidly evolves and new tools emerge that are specifically designed to be used by patent attorneys. They also said that they are not currently seeing widespread use of it in their practices.

"At this point, I don't think the tools are really advanced enough where it's a really big segment of actual use," Volk said, though he noted that AI is improving all the time, so that could change before long.

For now, he said that high-profile instances of attorneys being disciplined for citing cases generated by AI that did not actually exist have made people wary of using the technology for legal research, while editing and revising documents drafted by AI could potentially be more work than doing it yourself from the start.

Bajaj said that AI currently has potential for analyzing documents, but using generative AI to write patent applications and similar tasks is "still a little bit too new, and a little bit too unknown, and there have been too many horror stories that have come out early, to fully go down that path."

Uribe said that all the efficiencies of AI tools come with caveats to being an early adopter, so "my general position is that perhaps it's never best to be on the leading edge of these things."

"I'd say the guidance is more precautionary, but if you haven't evaluated tools like this yet, you soon will be," he said.

--Editing by Andrew Cohen.