

Cantor Colburn Client Alert: USPTO Guidance on the Use of Artificial Intelligence-Based Tools in Practice Before the USPTO

Summary

On April 11, 2024, the United States Patent and Trademark Office (“USPTO”) issued guidance on the use of artificial intelligence (AI)-based tools in practice before the USPTO (the “Guidance”). [89 Fed. Reg. 25609 \(Apr. 11, 2024\)](#). The Guidance informs those practicing before the USPTO of the rules and policies that apply when AI-based tools are used in proceedings before the USPTO. The Guidance also alerts such individuals of the risks associated with the use of AI and provides some suggestions for mitigating those risks. The USPTO issued the Guidance in response to the Biden administration’s [“Executive Order on the Safe, Secure, and Trustworthy Development and Use of Artificial Intelligence”](#) (October 30, 2023).

The Rise in the Use of AI-Based Tools and the Risks Associated Therewith

The Guidance recognizes that many AI-based tools are at the fingertips of practitioners and others practicing before the USPTO due to the rise in AI development. For example, the USPTO recognizes that those practicing before the USPTO are increasingly using “AI-based tools to research prior art, automate the patent application review process, and to gain insights into examiner behavior.” (Guidance p. 25610). Although such AI-based tools “lower the barriers and costs of practicing before the [USPTO]” as well as enable practitioners to provide their clients with improved quality and efficiency, the Guidance recognizes that the use of such AI tools carry legal and ethical considerations. (Guidance p. 25610). For example, AI-based tools may generate incomplete or inaccurate outputs that can result in misstatements or omissions when practicing before the USPTO or can disclose sensitive and confidential client information to third-party AI systems. These types of critical errors have been seen by fictitious citations and quotations in legal briefs. See OPINION AND ORDER ON SANCTIONS at 2, *Mata v. Avianca Inc.*, Case No. 22-CV-1461 (S.D.N.Y., June 22, 2023) (lawyers sanctioned for filing a brief that included non-existent citations and quotations that were output by a generative AI system).

With these considerations in mind, the Guidance reviews existing rules and policies for practicing before the USPTO and how those rules and policies apply when AI-based tools are used. The Guidance is clear that it does not provide an exhaustive list of possible rules, policies, or issues that may arise with the use of AI-based tools in matters before the USPTO.

Applying the USPTO’s Existing Rules and Policies to the Use of AI-Based Tools

The Guidance addresses certain existing USPTO rules and policies in consideration of how those rules and policies apply when AI-based tools were used in practicing before the USPTO.

The Guidance reminds practitioners of their duty of candor and good faith in dealing with the USPTO. Particularly, the Guidance cites 37 C.F.R. 1.56(a), which requires disclosure of all information material to patentability. Regarding the use of AI-based tools, the Guidance states: “those involved in patent proceedings have a duty to disclose all information—including on the use of AI tools by inventors, parties, and practitioners—that is material to patentability.”

The Guidance acknowledges that there is no prohibition against using AI-based tools when drafting documents for submission to the USPTO nor is there a general obligation to disclose to the USPTO the use of such tools. For example, a practitioner can use AI-based tools to draft portions of patent applications, responses to patent or trademark office actions, petitions, appeal briefs, and the like. However, the Guidance makes clear that, where information about the use of AI-based tools is material to patentability, disclosure is required to satisfy the duty of candor and good faith.

The Guidance advises practitioners to carefully review papers before submission where AI-based tools were used to create the papers or information in the papers. Specifically, the Guidance advises that practitioners must make reasonable inquiry “confirming all facts presented in the paper have or are likely to have evidentiary support and confirming the accuracy of all citations to case law and other references.” (Guidance p. 25614). The Guidance expressly cautions against relying on the accuracy of an AI-based tool and provides that such reliance is not a reasonable inquiry. If any errors or omissions are discovered, the errors or omissions should be corrected before submission to the USPTO. By signing a submission, the practitioner is acknowledging that “all statements to the party's own knowledge are true and that the party performed an inquiry reasonable under the circumstances.” (Guidance p. 25614).

Regarding the submission of prior art documents in an Information Disclosure Statement (IDS), the Guidance recognizes that AI-based tools can be used to automatically populate the USPTO’s form PTO/SB/08. The Guidance advises practitioners to use caution when using AI-based tools for IDS submissions. Particularly, the Guidance indicates that prior art references included in an IDS form must be reviewed by the submitter and that review of only the IDS form itself is insufficient.

For trademarks, the Guidance advises that the practitioner must confirm that facts and statements provided in submissions to the USPTO are true and have appropriate evidentiary support. “Particular care should be taken to avoid submitting any AI-generated specimens, which do not show actual use of the trademark in commerce, or any other evidence created by AI that does not actually exist in the marketplace.” (Guidance p. 25616).

The Guidance acknowledges that AI-based tools may be used to assist or automate the mechanical aspects of filing documents, such as using autocomplete forms, accessing information on USPTO websites, and uploading documents to USPTO servers. Again, the Guidance cautions that each form must be signed by a person, not an AI-based tool, even if under the direction of the practitioner. The Guidance also indicates that AI systems may not obtain a USPTO.gov account for submitting papers with the USPTO, nor may a practitioner sponsor an AI-based tool as a support staff. As such, AI-based tools are not authorized to file papers with the USPTO because papers may only be filed by the applicant, registrant, party to a proceeding, inventor, third party, a practitioner of record, a practitioner acting in a representative capacity, or a sponsored support person.

The Guidance cautions that the use of AI-based tools in practice before the USPTO may cause the inadvertent disclosure of sensitive or confidential information to third parties. “[P]ractitioners must be especially vigilant to ensure that confidentiality of client data is maintained.” (Guidance p. 25617). The Guidance makes clear that this duty extends to those supervised by the practitioner, such as other practitioners and non-practitioner assistants. Where AI-based tools are located outside the United States, use of such tools can implicate national security, export control, and foreign filing license issues. Practitioners are cautioned to understand the terms of use, privacy policies, and cybersecurity practices of any AI-based tools that are used.

Finally, the Guidance addresses fraud and intentional misconduct. “The USPTO does not tolerate fraud or intentional misconduct in any manner in a proceeding before the Office or in connection with accessing USPTO IT systems.” (Guidance p. 25617). Fraud or intentional misconduct regarding the use of AI-based tools when practicing before the USPTO could be a breach of the duty of candor and good faith and/or a violation of the Computer Fraud and Abuse Act.

Takeaways

Practitioners can use AI-based tools when practicing before the USPTO, such as to draft documents, prepare forms, analyze USPTO data, and the like. However, practitioners must not run afoul of USPTO policies and procedures when using such AI-based tools. Practitioners should remain mindful of their duty of candor and good faith in dealings with the USPTO, especially where AI-based tools are used. Particularly, practitioners must review all papers prepared in whole or in part using AI-based tools to ensure that the papers are true and accurate before submission to the USPTO and must personally sign all submissions.

For Further Information and Assistance

Attorneys in Cantor Colburn’s [Artificial Intelligence Practice Group](#) have substantial experience representing clients in these types of matters. Primary contacts are:

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We welcome your questions regarding this matter and any other regarding your IP in general.

This client alert was written by David Kincaid with contributions from Eric Baron.

Please note that each situation has its own unique circumstances and ramifications. This Client Alert is for informational purposes only and is not legal advice.