

Key Takeaways From the Latest USPTO Guidance on AI

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On April 11, 2024, the U.S. Patent and Trademark Office issued Guidance on Use of Artificial Intelligence-Based Tools in Practice Before the U.S. Patent and Trademark Office (April Guidance). The April Guidance, which supplements prior guidance issued Feb. 13, 2024, seeks to remind practitioners of existing rules and to educate them on potential risks associated with artificial intelligence tool use, allowing practitioners to mitigate these risks.

AI, now a reality rather than a possibility, has the potential to reshape the legal landscape. AI's ability to parse through extensive legal data, anticipate outcomes based on legal precedents, and even draft legal documents may revolutionize the way lawyers practice.

Integrating AI into legal practices may bring enhancements in efficiency, quality, and the ability to manage complex tasks. However, AI presents both opportunities and challenges for legal practitioners and those practicing before the U.S. Patent and Trademark Office (USPTO). As the use of AI continues to grow in the intellectual property (IP) community, so do its ethical and legal considerations.

Patent practitioners have acknowledged AI's potential to streamline tasks such as prior art searches and document reviews. AI tools may also facilitate the drafting of patent applications or responses to USPTO actions, but practitioners must ensure the accuracy of all statements and that the arguments are legally warranted. Large language models have demonstrated the ability to draft legal documents that can save time and resources, but this convenience carries risk. For instance, AI-generated documents may contain inaccuracies or "algorithmic artifacts" that, if unchecked, could mislead or misrepresent legal arguments.

Given AI's capabilities, the legal community recognizes the need to explore AI risks in legal proceedings. U.S. Supreme Court Chief Justice John Roberts, in the 2023 Year-End Report on the Federal Judiciary, noted the potential for AI to improve access to information but also highlighted privacy and dehumanization risks. The American Bar Association (ABA) created a task force to provide insights on developing and using AI in a responsible manner.

President Joe Biden's executive order on the Safe, Secure, and Trustworthy Development and Use of Artificial Intelligence, issued Oct. 30, 2023, underscores the importance of responsible AI deployment across various sectors, including law. The legal community is called upon to balance the transformative potential of AI with the ethical and practical challenges it brings, particularly in the realm of IP. The order emphasizes the need for protections against AI-related harms while promoting the technology's responsible use. This directive aligns with the USPTO's efforts to address AI considerations at the intersection of innovation and IP.

Several judges have issued standing orders requiring filers to certify that AI-generated court filings or citations are verified for accuracy. Courts are beginning to propose local rules addressing these issues. In the wake of these prior regulations, the USPTO issued its April Guidance, reminding practitioners to ensure that any AI-generated content is reviewed and verified, and that they are responsible for the contents of their submissions. Inadequate verification may lead to critical misstatements or omissions with severe consequences, including sanctions. Additionally, the use of AI systems often requires sharing sensitive and confidential client information with third-party AI systems, potentially located outside the U.S., raising concerns about confidentiality and ethical issues. Thus, practitioners should comply with foreign filing license requirements and export regulations as well as ensuring data is not improperly exported when using AI systems. Furthermore, if the use of an AI tool is material to patentability, it must be disclosed to the USPTO. Practitioners must also refrain from filing or prosecuting patent claims known to be unpatentable, even if such claims are generated by AI.

When using AI tools, practitioners should consider the risks and take steps to ensure confidential information is not inadvertently disclosed. In the context of USPTO electronic systems, access is subject to terms and conditions, and violations may result in criminal or civil liability. Practitioners are required to provide competent and diligent representation to clients and must be familiar with the benefits and risks associated with the technology used to handle client matters.

The USPTO's existing rules and policies apply broadly, regardless of AI assistance in preparing submissions. The duty of candor and good faith, signature requirements, and confidentiality of information are key elements that ensure integrity in USPTO practice, and the use of AI presents new considerations for practitioners to bear in mind in complying with these existing rules of professional conduct. Lawyers must ensure that their use of AI complies with their duties of candor, good faith, and confidentiality as set forth by the USPTO and professional conduct rules.

Practice Considerations

Thoroughly review and verify all AI-generated documents before submission. This includes checking factual accuracy, legal arguments, and citations.

While there is no general obligation to disclose the use of AI tools to the USPTO, any material information, including the involvement of AI that may affect patentability, must be disclosed.

Be vigilant about client confidentiality when using AI tools. Ensure that no sensitive information is inadvertently disclosed and implement robust data protection measures.

Recognize that AI may not fully comprehend nuanced legal arguments or the specific context of a case and thus human oversight may be needed.

Keep abreast of technological advancements and legal developments concerning AI. Participate in continuing legal education (CLE) focused on AI and law.

Discuss the use of AI tools with clients and obtain their informed consent where necessary. Explain the advantages and potential risks associated with AI use in their legal matters.

When using AI tools that require the transfer of data internationally, ensure compliance with export control laws and foreign filing license requirements.

Only use AI as a starting point. Apply critical thinking to AI-generated content and supplement it with human legal reasoning and knowledge.

Looking Ahead

The USPTO's guidance is a step toward addressing the challenges AI poses in the legal field. It serves as a resource for practitioners to responsibly harness AI's potential while mitigating associated risks. By adhering to these guidelines and remaining vigilant in their ethical obligations, lawyers can leverage the power of AI to enhance their practice while working to uphold the integrity of the legal system.

As AI technologies continue to evolve, the legal frameworks and ethical guidelines that govern their use may also change. Lawyers should be proactive in understanding the potential impacts of AI on their practice and on the justice system. Engaging with interdisciplinary experts in AI, ethics, and technology law may provide valuable insights and guide responsible AI integration into legal practice.

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