



The Changing Landscape of US AI Patent Protection at the USPTO

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AI-related events in 2024-2025

Timelines

- ▶ **Feb. 2024** *Inventorship Guidance on AI-assisted Inventions (Inventors)- Revised in Nov 2025*
- ▶ **Feb. 2024** *Director guidance on party and practitioner misconduct related to use of AI (Practitioners)*
- ▶ **Apr. 2024** *Guidance: Use of Artificial Intelligence-Based Tools in Practice (Practitioners, Inventors)*
- ▶ **Jul. 2024** *Guidance Update on Patent Subject Matter Eligibility including Artificial Intelligence (Examination)*
- ▶ **Jan. 2025** *USPTO announcement of AI Strategy (USPTO)*
- ▶ **Aug. 2025** *Reminders on evaluating subject matter eligibility of claims under 35 U.S.C. 101 (Examination)*
- ▶ **Sept. 2025** *First Day as Director - Ceremonial Patent Signing – distributed ledger/crypto technology and medical diagnostics (Director Squires – “USPTO is open for business, especially for the technologies of tomorrow”)*

AI-related events in 2024-2025

Timelines

- ▶ **Sept. 2025** *Ex Parte Desjardins* – Appeals Review Panel reverses a rejection in an AI patent application. Decision specifically noted the policy importance of not unduly constraining the patentability of AI patents: “Categorically excluding AI innovations from patent protection in the United States jeopardizes America’s leadership in this critical emerging technology.”
- ▶ **Oct. 2025** *Automated Search Pilot Program (USPTO)*
- ▶ **Nov. 2025** *Revised Inventorship Guidance on AI-assisted Inventions (101) (Examination)*
- ▶ **Dec. 2025** – *Subject Matter Eligibility Declarations*
- ▶ **Dec. 2025** – *Manual of Patent Examining Procedure (MPEP) Updates*

Changes in...

- ▶ USPTO
- ▶ Practitioners
- ▶ Inventors
- ▶ Examination

AI-Related Activities for USPTO

- ▶ **Jan. 2025** USPTO announcement of AI Strategy (appeared to have been withdrawn)
- ▶ **Oct. 2025** Automated Search Pilot Program

Automated Search Pilot Program (Oct. 2025)

- ▶ The USPTO started a pilot program for automated search results.
- ▶ For up to 1,600 non-provisional, non-continuing applications filed between Oct. 2025-Apr. 2026 (petition required)
- ▶ The USPTO performs an AI-assisted search and sends an Automated Search Results Notice (ASRN) to the applicant identifying potential prior art.
- ▶ Applicant need not to respond to the ASRN but may file a Preliminary Amendment to avoid potential rejections.
- ▶ The pilot program ends Apr. 2026 (but could be extended)



PRACTITIONERS

AI-Related Activities for Practitioners

- ▶ **Feb. 2024** Director guidance on party and practitioner misconduct related to use of AI
- ▶ **Apr. 2024** Guidance: Use of Artificial Intelligence-Based Tools in Practice

Guidance on Use of AI-Based Tools in Practice

- ▶ Although use of AI provides opportunities to expand access and lower costs, it poses significant concerns that AI will be misused or left unchecked in submissions.
- ▶ The current rules requires practitioners to ascertain how the paper was prepared, determine whether errors or omissions may have been introduced as a result of how the submission was prepared, and verify the accuracy of all factual and legal representations.
- ▶ If an AI tool is used in drafting or editing a document, the practitioners must still review its contents and ensure the paper is in accordance with the certifications being made.
- ▶ The practitioners may be subject to sanctions or disciplinary actions when the rules are violated.

Guidance on Use of AI-Based Tools in Practice (cont.)

- ▶ The USPTO Rules of Professional Conduct require that a practitioner provide competent and diligent representation to a client.
- ▶ When using AI tools, the practitioners must ensure they are representing their clients with requisite legal, scientific, and technical knowledge.
- ▶ Use of AI also raises an issue of sharing sensitive and confidential client information to third-party AI systems, including those potentially located outside of the US.

→ Practitioners should be careful when using AI tools.

INVENTORS

AI-Related Activities for Inventors

- ▶ **Feb. 2024** Inventorship Guidance on AI-assisted Inventions
- ▶ **Apr. 2024** Guidance: Use of Artificial Intelligence-Based Tools in Practice
- ▶ **Nov. 2025** Revised Inventorship Guidance on AI-assisted Inventions (replacing Feb. 2024 Guidance)

Guidance on AI-Assisted Inventions

Who is “inventor”?

- ▶ The USPTO requires that a natural person must be the inventor.
- ▶ Each claim in a patent or patent application must be invented by at least one natural person.
- ▶ A person must contribute to the invention significantly to be named as an inventor.

Guidance on AI-Assisted Inventions

Can AI-system be an inventor?

- ▶ An AI system cannot be listed as an inventor since under the US practice, “invention” refers to the inventor’s conception formed in the inventor’s mind and being applied in practice.
- ▶ The USPTO views AI systems analogous to laboratory equipment, computer software, research database or any other tool that assists in the inventive process.
- ▶ AI systems may provide services and generate ideas, but they remain tools used by the human inventor who conceived the claimed invention.

Guidance on AI-Assisted Inventions

- ▶ No oath, declaration or substitute statement should be filed on behalf of an AI system even if the AI system made contribution to one or more claims in a patent application.
- ▶ Because an AI system cannot be a named inventor, it has no rights to assign rights and should not be recorded in an assignment.
- ▶ A priority claim to a foreign application that names an AI system as the sole inventor will not be accepted in the US.
- ▶ A US application claiming priority to a foreign application that names both a natural person(s) and an AI-system as a joint inventor, the application data sheet (ADS) must list as inventor(s) only the natural person(s) who significantly contributed to the invention.

Guidance on AI-Assisted Inventions

Can a person running AI-system be listed as an inventor?

- ▶ A person must contribute to the invention significantly to be named as an inventor.
- ▶ For example, a person who simply executes an AI program may not be listed as an inventor.

Disclosure of Invention

- ▶ While there is no requirement to notify the USPTO when AI tools are used in the invention creation process or practicing, applicants and practitioners should be mindful of their duty of disclosure. This is, if the use of an AI tool is material to patentability, the use of such AI tool must be disclosed to the USPTO.

EXAMINATION

AI-Related Activities for Examination

- ▶ **Jul. 2024** Guidance Update on Patent Subject Matter Eligibility including Artificial Intelligence
- ▶ **Aug. 2025** Reminders on evaluating subject matter eligibility of claims under 35 U.S.C. 101

Subject Matter Eligibility on AI-Related Applications

To determine that a claim is patent-eligible, the examiner will determine:

- ▶ Step 1: whether the claimed invention falls into at least one of the four categories recited in 35 U.S.C. 101
- ▶ Step 2A-1: whether the claim recites an abstract idea, law of nature or natural phenomenon
- ▶ Step 2A-2: whether the claim recites additional elements that integrate the judicial exception into a practical application
- ▶ Step 2B: whether the additional elements amount to significantly more than the judicial exception.

Subject Matter Eligibility on AI-Related Applications (cont.)

- ▶ No changes in analysis
- ▶ In general, the use of AI itself is not considered to have patentable weight.
- ▶ Key is to recite how the AI is utilized in the inventive concept (to provide improvements).
- ▶ Invention may be directed to improving training of AI.

Subject Matter Eligibility on AI-Related Applications (cont.)

- ▶ In Aug. 2025 Reminders, the USPTO reminded the Examiner that the claim limitations that encompass AI in a way that cannot be practically performed in the human mind do not fall within the grouping of mental processes.
- ▶ The Reminders also stated that the examiners should continue determining whether a claim improves technology or a technical field that overcomes a particular solution to a problem or a particular way to achieve a desired outcome.

→ Bar for the examiners are heightened.

Subject Matter Eligibility Declarations – 37 CFR 1.132

- ▶ In Dec. 4 2025, the USPTO issued memoranda outlined submitting a Subject Matter Eligibility Declaration (SMED) to address a subject matter eligibility rejection
- ▶ Same day, second memoranda directed to Examiners reaffirming *Ex parte Desjardins* and explaining how SMD evidence should be considered
- ▶ Arguments could emphasize technical improvements provided by a claimed invention to demonstrate integration of a judicial exception into a practical application
- ▶ SMED by anyone “who had knowledge of the facts being asserted” can explain, among other things, how a person skilled in the art would interpret the specification and establish facts that describe the state of the art.

Subject Matter Eligibility Declarations

- ▶ Information needs to be from originally filed specification and a nexus between the invention as claimed and the evidence provided in the Declaration
- ▶ Director indicated Examiners must consider all evidence of record and determine whether the claims are more likely than not eligible (by a preponderance of the evidence standard) and articulate in next Office Action why the claims are –or are not- eligible
- ▶ EXAMPLE - A claim involving the detection of suspicious network activity using network monitors distributed on multiple machines was rejected as falling within the “mental process” judicial exception. The applicant submitted a SMED explaining that a skilled artisan would interpret the specification as teaching that the network monitors are installed on multiple machines, each providing a different analysis of network packets. Thus, the SMED explains, the claimed invention cannot be practically performed in the human mind.

Subject Matter Eligibility Declarations

- ▶ Suggestions

- ▶ If 101 rejection repeatedly maintained, consider SMED
- ▶ File SMED's separate from other Declaration to avoid Examiner confusion
- ▶ SMED should reference the specification to show support in original disclosure
- ▶ SMED will be part of record so can create file wrapper estoppel
- ▶ When drafting the specification include explicit description of technical advantages

- ▶ USPTO Power Point Presentation about 132 Declarations from March 2023

www.uspto.gov/sites/default/files/documents/declaration_practice_under_37_cfr_1_132.pdf#:~:text=%E2%80%A2%20Recognize%20evidence%20commonly%20submitted,that%20is%20based%20on%20opinion

Allowance Trend in AI-Related Applications (AI service by Patent Bots)

Group	Description	3YGR
2100	UNKNOWN	0%
2110	Computer Error Control, Reliability, & Control Systems	85%
2120-2140	Artificial Intelligence	68%
2130	Memory Access and Control	86%
2150-2160	Data Bases & File Management	78%
2170	GUI, Document Processing, Power and Other	78%
2180	Computer Architecture, I/O, Modeling and Simulation	79%
2190	Interprocess Communications and Software Development	84%
2198	Search and Classification	88%

The allowance rate of applications directed to AI is not significantly lower than applications in other technical areas.

3 Year Grant Date

Allowance Trend in AI-Related Applications (AI service by Patent Bots)

Groups in Tech Center 3600

Group	Description	3YGR
3600	UNKNOWN	0%
3610	Surface Transportation	84%
3619	Search and Classification	73%
3620	Business Methods - Incentive Programs, Coupons; Operations Research; Electronic Shopping; Health Care; Point of Sale, Inventory, Accounting; Cost/Price, Reservations, Shipping and Transportation; Business Processing	46%
3630	Static Structures, Supports and Furniture	78%
3640	Aeronautics, Agriculture, Fishing, Trapping, Vermin Destroying, Plant and Animal Husbandry, Weaponry, Nuclear Systems, and License and Review	77%
3650	Material and Article Handling	85%
3660	VCaR - Robot Control, Vehicle Navigation and Data Processing: Vehicles and Relative Location	80%
3670	Wells, Earth Boring/Moving/Working, Excavating, Mining, Harvesters, Bridges, Roads, Petroleum, Closures, Connections, and Hardware	79%
3680	Business Methods - Electronic Shopping and Health Care	49%
3690	Business Methods - Finance/Banking/ Insurance and Business Cryptography	49%

The allowance rate of applications directed to business method is significantly lower than applications in other technical areas.

3 Year Grant Date

Source: <https://www.patentbots.com/>

Takeaways

- ▶ The USPTO is actively reviewing adaptation of AI tools to improve its internal operations. With AI tools, we will likely expect faster and more efficient examinations in future cases.
- ▶ Practitioners should continue to be careful when using AI tools to prepare documents.
- ▶ Inventors are persons who significantly contribute to the invention even if AI is used. AI cannot be an inventor.
- ▶ AI service shows that examination on AI-related application may still face difficult time despite the USPTO is heightened bars to the examiners.
- ▶ Interviews with Examiner can help address rejections



THANK YOU!

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