

MEXTRATEGY[®]

lighten your way

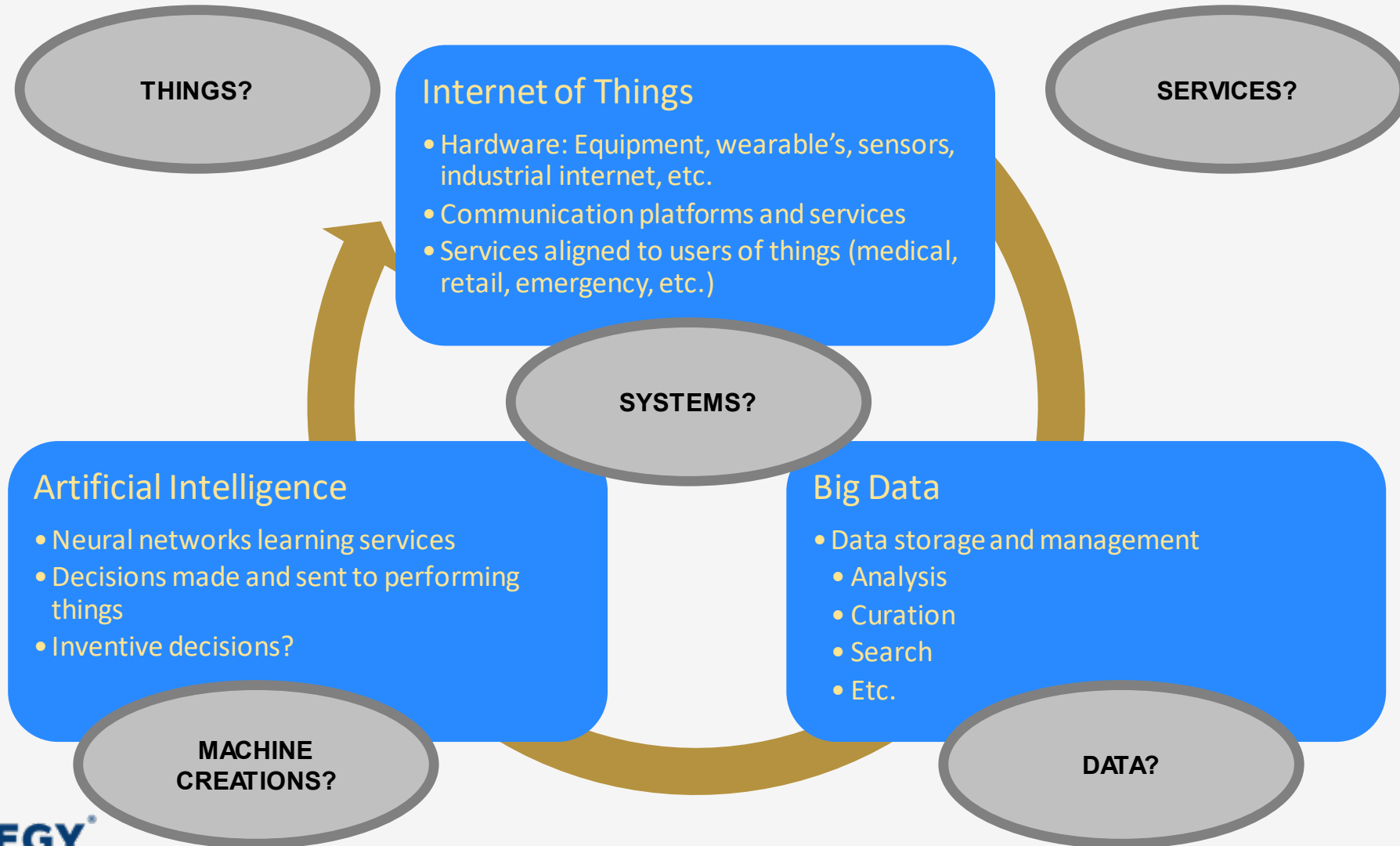
AI inventions, patent prosecution and the person skilled in the art

HECTOR E. CHAGOYA-CORTES

The WIPO Conversation on Intellectual Property and Frontier Technologies

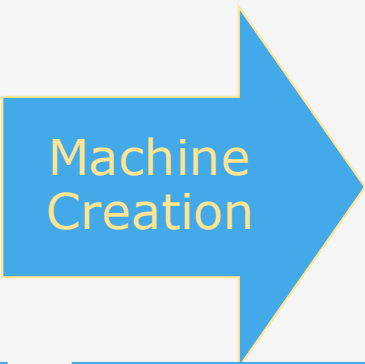
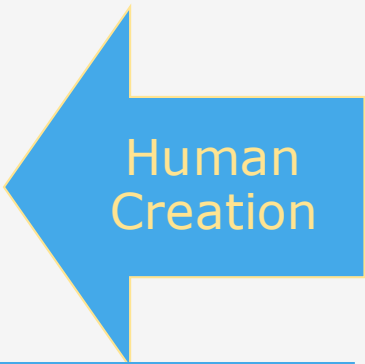
September 22nd, 2022

The IT Continuum - What is the role of persons?



Person skilled in the art

- Different definition for each country law. Some laws lack of definition
- Some common attributes of the person skilled in the art:
 - Hypothetical person
 - Has “common general knowledge in the art” to interpret the description
 - Can use ordinary means to perform R&D
 - Can interpret technically the prior art and make deductions based on it
- Can AI provide a machine skilled in the art? How hypothetical?



- IP as a human right
- Identifying the *creator*
- Impact of protection to innovation
- Regulatory impact to innovation
- Legal definition of invention?

IP – Human Rights

- Can machines have human rights and/or be recognized as inventors?
- Are there other human rights above any rights on/of such *creative machines* (i.e. health & privacy)?

Creator

- Who owns the AI training data?
- How many creators are there?
- Are AI products derivative or collaborative work?
- How many pairs work/creator are there or might be there?

Innovation & Protection

- AI needs algorithms and data to learn.
- Algorithms and learning data are mostly confidential, particularly in health care.
- Increasing complexity needs mechanisms to protect investment.

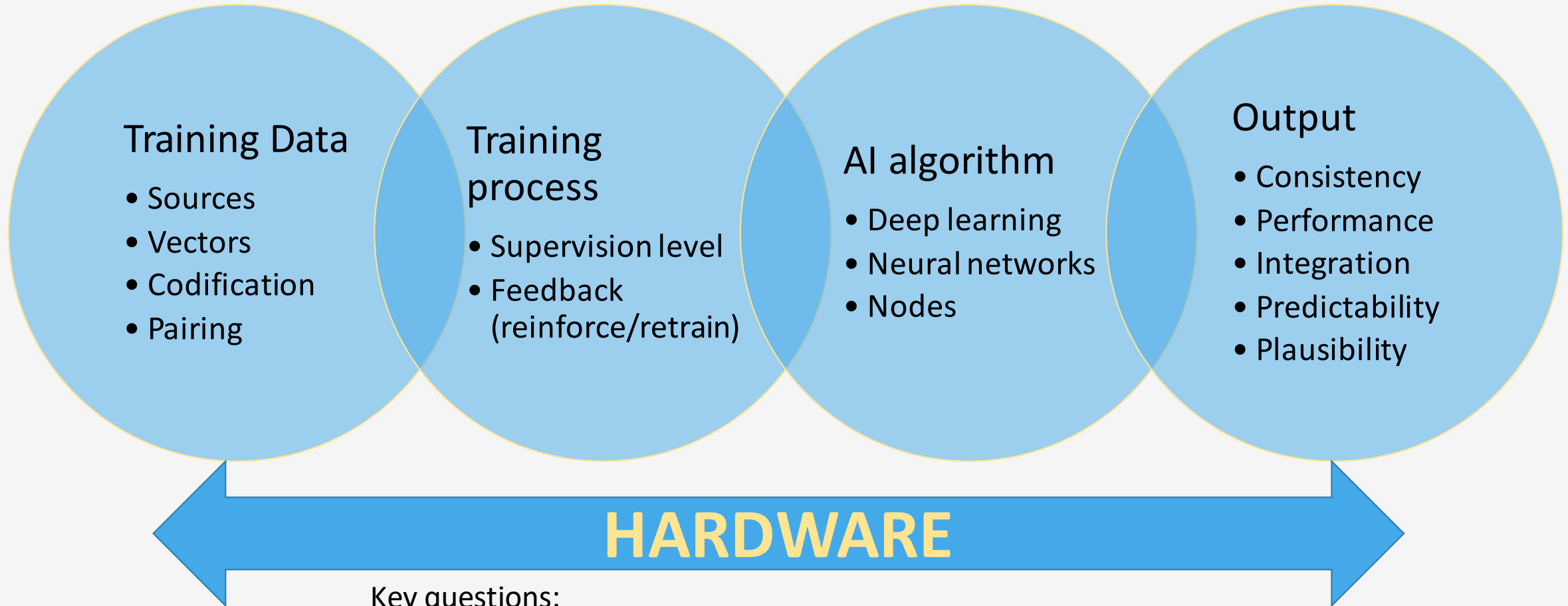
Regulation & innovation

- Transparency is an atypical obligation for innovators. Pharma has dealt with under data exclusivity rights in the past, but the AI component is not comprised.
- Users risks management.
- Regulatory burdens must provide certainty to investment

Inventive machines and machines skilled in the art?

IP ownership for AI machines needs deeper changes in the whole legal system to include: liability, legal standing and ownership

The role of AI in reducing to practice the invention



Key questions:

1. Are all AI components available to natural persons to reproduce the invention?
2. How needed is human intervention to reduce to practice?
3. Is the output plausible straightforwardly? For who?
4. How dependent is the training on human intervention?

Key guidelines and conclusions

- For now, AI systems cannot be inventors but are available tools.
- AI systems are now also prior art, available to natural persons skilled in the art.
- Obviousness needs to be assessed in the context of AI as an available tool to natural persons.
- Enablement and plausibility should be also assessed in the context of AI as a tool regarding its predictability and according to the availability or ability to reproduce all the AI elements.
- It is not the same if the assessed invention is an AI element of system than if the invention is the output.

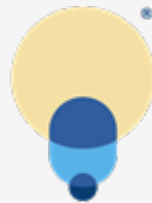
AI systems are currently a tool that is available to those skilled in the art. How instrumental and predictable are their results determine their impact in assessing inventive step and the sufficiency of a description

HECTOR E. CHAGOYA-CORTES

hchagoya@mexstrategy.com.mx

Twitter: @hchagoya

LinkedIn: www.linkedin.com/in/hchagoya



<http://www.mexstrategy.com>
contacto@mexstrategy.com.mx