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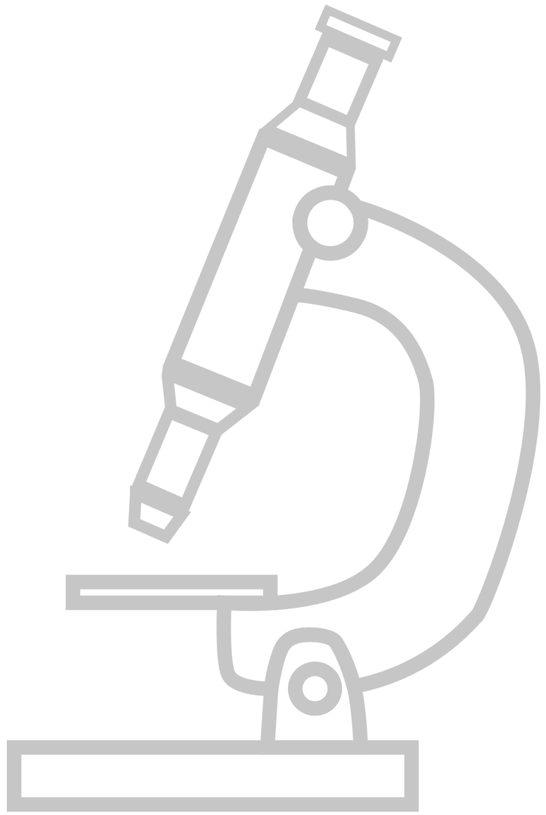
Re-Evaluating Patentability in the Age of AI



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Presented at the WIPO Standing Committee on the Law of Patents, 37
Geneva, Switzerland.
November 5, 2025

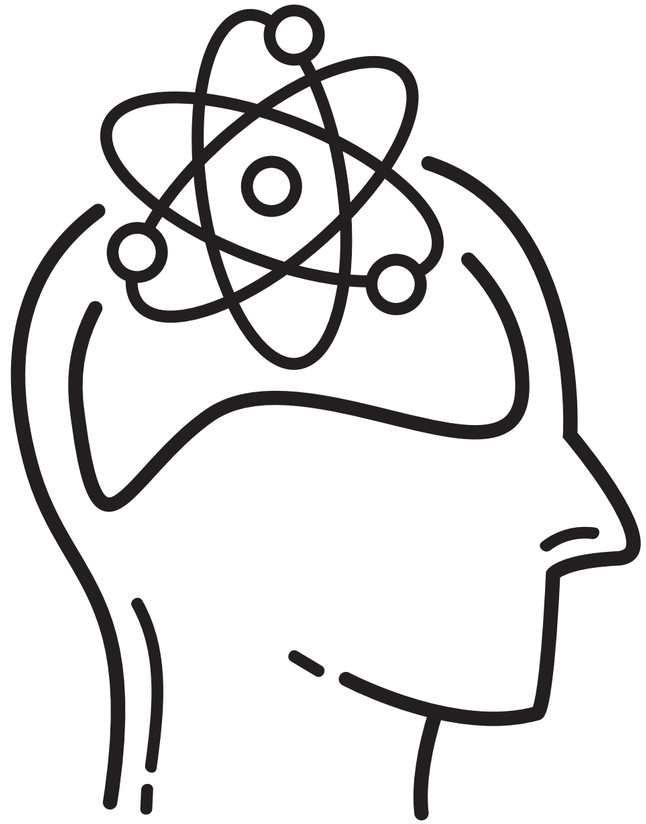
Outline

Re-evaluating Patentability Requirements:

- *Patentable Subject Matter,*
- *Novelty,*
- *Inventiveness*

Socio-Economic & Policy Implications of AI Patentability:

- *Disclosure*
- *Implications for Africa*



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Traditional Patentability Requirements

- European patents shall be granted for any inventions, in all fields of technology, provided that they are **new**, **involve an inventive step** and are susceptible of industrial application.

- **Kenya**: An invention is patentable if it is new, involves an inventive step and, is industrially applicable.

1. **Patentable Subject Matter**
2. **Novelty**
3. **Inventiveness**

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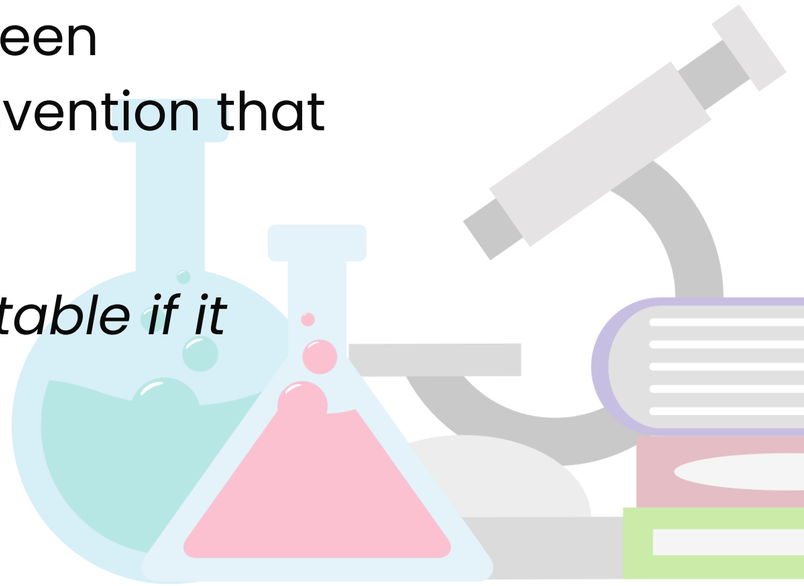
Patentable Subject Matter:
Software v. AI Patent

- **UK Patent Act:** It *is hereby declared that the following (among other things) are not inventions for the purposes of this Act, that is to say, anything which consists of - (a) a discovery, scientific theory or* ***mathematical method****; (c)… a* ***program for a computer.***
  Similar exclusions are contained in many patent legilsations: EPC, South African Patent Act, Ghana Patents Act,

- ***Diamond v. Diehr****:* US Supreme Court - distinction between inventions mathematical algorithm and a patentable invention that contains a mathematical algorithm.

- ***Vicom Application*** *- EPO - computer program is patentable if it makes a technical contribtutions.*



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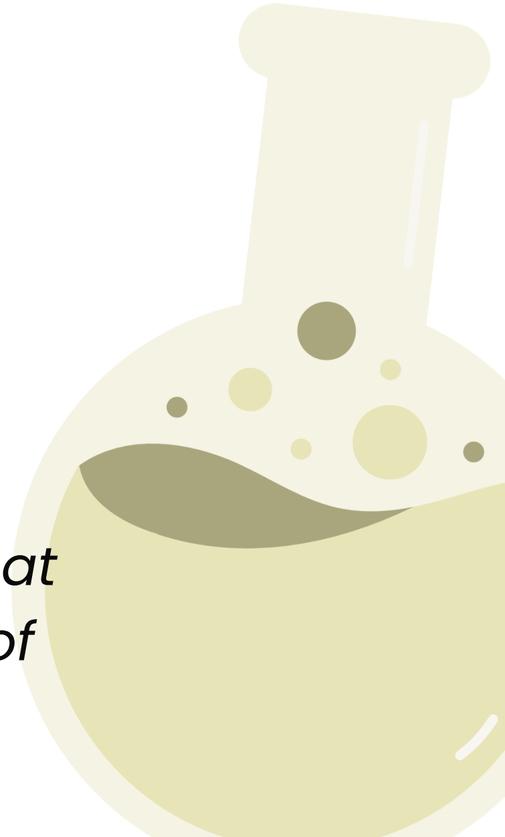
Patentable Subject Matter:
Software v. AI Patent

- **USPTO**: AI Invention must clearly define the technical problem and how the AI addresses the problem.

- ***EPO:*** AI and machine learning are based on computational models and algorithms... and are per se of an abstract mathematical nature, irrespective of whether they can be "trained" using training data. ***However, if they contribute to a technical solution to a technical problem, they are patentable.***

- ***Recentive Analytics v. Fox:***
The court held that Recentive's patents merely applied generic machine learning techniques to the fields of event scheduling and network map creation, and thus were directed to abstract ideas that lacked an inventive concept sufficient to satisfy the requirements of 35 U.S.C. § 101.



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Novelty

- An invention is considered new if it does not form **part of the state of the art or prior art**.

- United States: [35USC102] A person shall be entitled to a patent unless…the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise **available to the public before the effective filing date** of the claimed invention; or

- Nigeria Patent Act: “the state of the art" means everything concerning that art or field of knowledge which has been made a**vailable to the public anywhere and at any time whatever (by means of a written or oral description, by use or in any other way)** before the date of the filing of the patent application”

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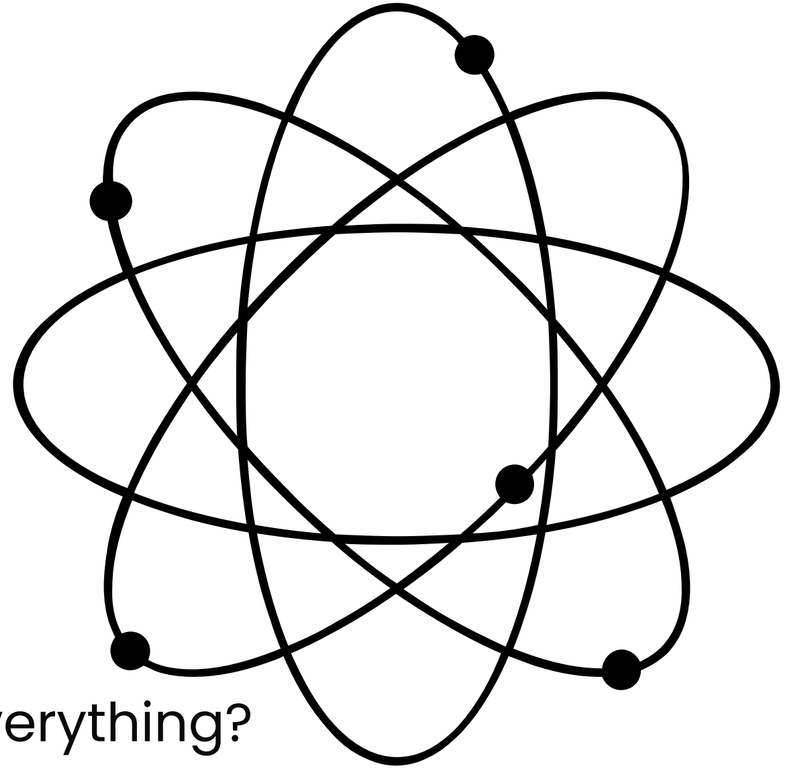
Novelty



- **Standard for Determining Novelty**

  A factual enquiry, with a strong reference to prior art.

  Prior Art =

  - everything made available to the public" (EPC),
  - … anywhere in the world (Ghana, Nigeria)

- What is "new" in an age where AI systems have seen everything?
  - Judged against human ability, nearly all AI inventions look inventive; judged against AI's ability, what could be inventive?
  - Risk of "artificial novelty"… especially with process patents
  - What happens when AI-generated prior searches include proprietary AI systems?

Inventiveness / Obviousness

- Identifiable difference between the stae of the art and the claimed invention
- “the differences between the claimed invention and the prior art” must not be obvious to a **person having ordinary skill in the art** to which the claimed invention pertains
- •Would the invention have been obvious to a ” person skilled in the art”?
  •If AI systems invent, who is “a person” skilled in the art? A human? A human assisted by AI?
  •Algorithmic obviousness: If an AI system could have generated the solution easily, does this amount to obviousness?

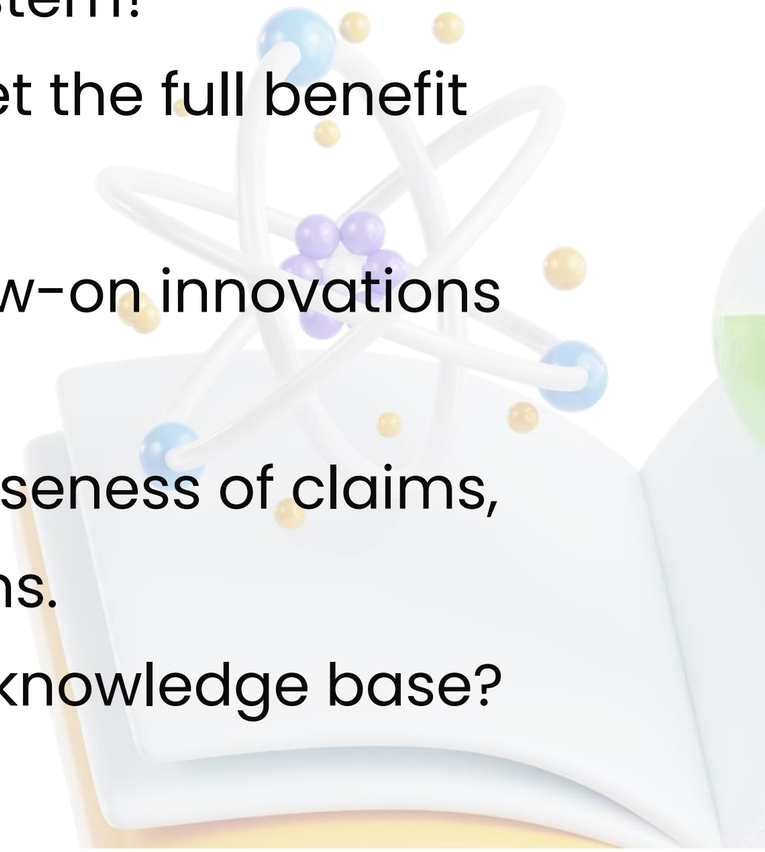
Socio-Economic Considerations: Patent Disclosures

***Nigeria Patent Act*: "**The description referred to in … shall **<u>disclose the relevant invention in a manner sufficiently clear and complete for the invention to be put into effect</u>** by a person skilled in the art or field of knowledge to which the invention relates

- The patent system is built on a *quid pro quo* principle:
  - Public disclosure must precede patent exclusivity
  - Public disclosure enables further technology development

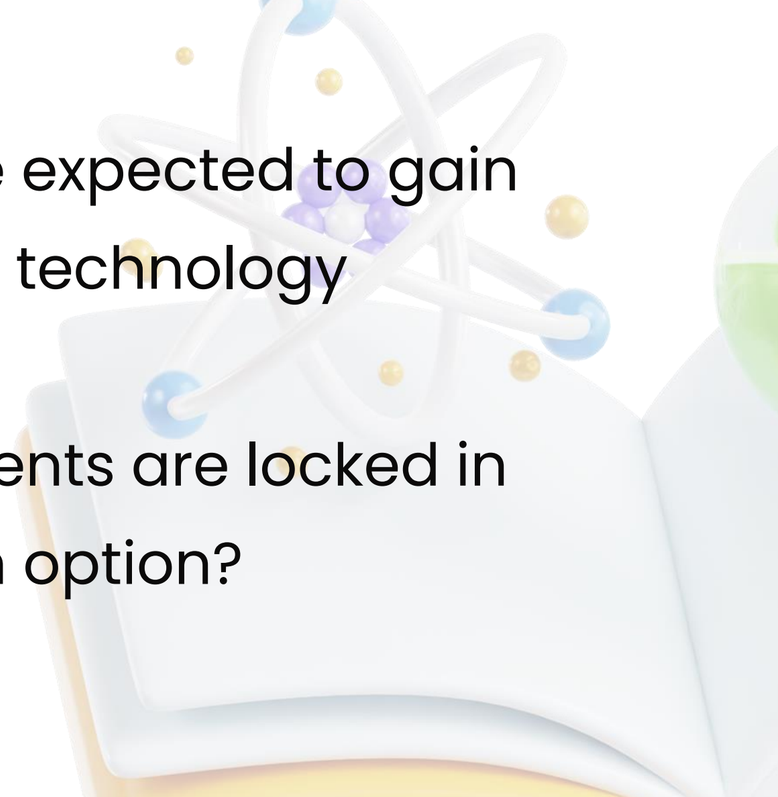
Socio-Economic Considerations: Patent Disclosures

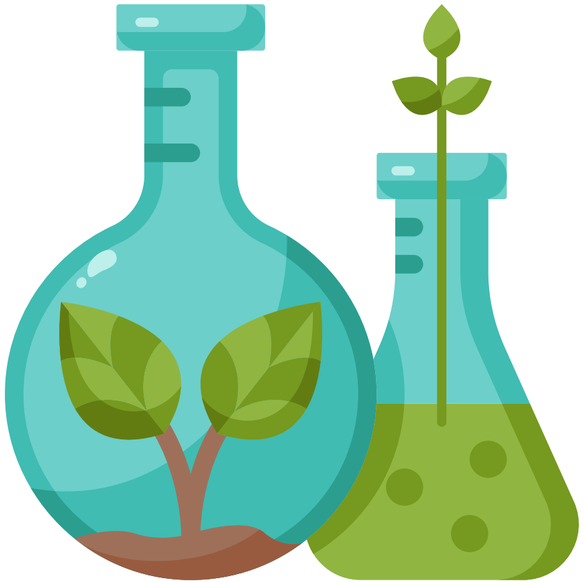
- Do opaque AI inventions really further the patent system?
  - If disclosure is inadequate the public does not get the full benefit of the patent system.
  - ”Black box” nature reduces the possibility of follow-on innovations or cumulative research.
  - Undermines the possibility of assessing the preciseness of claims, leading to wide claims built on vague descriptions.
  - Will the patentee have contributed to the public knowledge base?



AI-Patents: Implications for African Countries

- In 2023, Africa accounted for only 0.6% of global patent applications, with Africans submitting less than 20% of these applications. (*Source: IP Rights and Industrialisation Factsheet, United Nationals Office of the Special Adviser on Africa)*
- Under classic patent theory, countries in Africa were expected to gain from the disclosures of patented inventions, or from technology transfers.
- With AI Inventions, the underlying know-how for patents are locked in complex data sets and AI black box. Is disclosure an option?





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Thank You