

Prior art problems: counsel mull AI-generated disclosures

Rani Mehta May 03, 2024



Lawyers weigh in on the USPTO's request for comment on the effects of AI on prior art analysis and obviousness determinations

The USPTO may need to take the limitations of artificial intelligence into account when considering the technology's effect on prior art, according to sources.

The patent office published a **request for comment** on April 30 about the effects of AI on prior art, obviousness, and demonstrations of patentability. The office said responses will help it determine whether there's a need for guidance on these issues.

Prior art, which refers to evidence that an invention is already known, can be used to invalidate a patent or prevent one from being granted. The evidence is traditionally produced by humans.

However, according to the office, some commentators have argued that AI systems have the potential to generate vast amounts of prior art.

The USPTO asked stakeholders to consider whether prior art disclosures must be authored by humans and whether AI-generated content should be treated differently.

The request for comment also looked into whether AI could have implications for how examiners assessed the knowledge of a person having ordinary skill in the art (PHOSITA).

Inventions are deemed obvious (and not patentable) if it would have been obvious for a PHOSITA to come up with the invention themselves having seen the prior art.

Huge disruptor

According to counsel, many of the USPTO's questions are hypothetical. However, they say it's good that the office is considering them.

Todd Hopfinger, director at **Sterne Kessler** in Washington DC, says stakeholders are monitoring whether an influx of AI-generated prior art could increase litigation and prosecution costs because counsel would have to sort through more results.

"A lot of people are raising concerns about the value of patent portfolios because of AI-generated prior art," he says.

He adds that his firm is working closely with its clients to navigate these issues.

"This has been a huge disruptor, so clients are grappling with some of these issues. Many clients are interested in doing more prior art searches up front," he says.

Michael Borella, co-chair of **McDonnell Boehnen Hulbert & Berghoff's** AI practice group in Chicago, says prior art searching is already like looking for a needle in a haystack.

"Now, it's somewhat manageable. But if there are millions or billions of these documents out there [that are generated by AI], how do you know which ones are worthy of your attention and which ones aren't?" he says.

"The irony is that AI is being sold as a way of saving everyone time, but it could cause us and the patent office to spend more time going through prior art and trying to figure out what's real and what's fake."

Borella notes that these questions are still hypothetical.

“But it’s certainly within the realm of possibility that we’ll start seeing [AI’s impact on prior art] within a couple of years,” he says.

Robert Hulse, partner at **Fenwick & West** in California, agrees that an influx of AI-generated prior art isn’t a huge issue yet.

“We’re really at the very beginning,” he says. “A lot of issues they’ve raised are interesting and aren’t yet being felt by patent applicants. I have never received a piece of prior art cited against my patent applications that was written by AI.”

Having hallucinations

The USPTO also asked whether AI’s tendency to produce incorrect information should affect whether it can rely on AI-generated results to use against patent applications.

Counsel emphasised that it would make sense for the USPTO to consider AI’s limitations.

They note that the potential for AI to hallucinate, meaning to spew out false information, could end up causing more work for practitioners if AI-generated content was to be frequently cited against patent applications.

The technology might also not necessarily generate prior art with enough technical detail to explain how inventions work.

Borella at McDonnell Boehnen Hulbert & Berghoff notes that practitioners would have some recourse if an examiner cited erroneous or problematic AI content against their applications.

Prior art cited against applicants currently has a presumption of operability, meaning that it describes an innovation in a way that could be understood and replicated.

Borella notes, however, that applicants can rebut that presumption. So, they could present evidence showing that AI-generated prior art didn’t actually contain enough detail about the innovation – and therefore shouldn’t be cited against their patent applications.

“But the problem is the amount of time to determine if you can make that rebuttal. It’s a matter of extra work,” he says.

He adds, however, that it could be difficult to create a different standard for AI-generated prior art because people may not know that the content was AI-generated.

Others agree that the potential for erroneous or poorly developed AI-generated prior art could create extra complications.

Mauricio Uribe, co-chair of the software and electrical practice groups at **Knobbe Martens** in Seattle, says he doesn't know whether there should be the same presumption of enablement if there's a huge body of AI-generated prior art.

"A lot of the generated work product from AI ends up being nonsensical or has some fundamental flaws," he says. "Now the question's going to be, what's going to be the procedure for challenging something like that? Have we increased the cost of interactions with the patent office?"

The USPTO also asked stakeholders if and how it should determine which AI tools are in common use and whether these tools are presumed to be known and used by a PHOSITA.

Tom Rozylowicz, principal at **Fish & Richardson** in Washington DC, says experts could weigh in on which tools are in common use during proceedings at the Patent Trial and Appeal Board.

But he notes that this question could take longer to resolve when the USPTO is examining a patent because most examinations don't involve experts.

He adds that examiners might want to rely on preexisting patents and applications to find prior art references, rather than citing AI-generated content.

It may still be a little early to give any definite answers to these questions – especially when we don't know quite how AI is going to evolve.

But by considering them now, hopefully the USPTO and other decision-makers can be well poised to minimise the burden on applicants if AI-generated prior art becomes significantly more common.

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