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Intellectual Property Developments from the U.S. Executive Order on Artificial Intelligence

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The Executive Order on the Safe, Secure, and Trustworthy Development and Use of Artificial Intelligence (the "EO"), issued on October 30, 2023, includes many initiatives relating to the development and use of artificial intelligence ("AI"). This alert focuses on key aspects of the EO with respect to intellectual property ("IP") and may help inform an organization's AI-related IP risk mitigation efforts as well as development of relevant internal protocols and guardrails. Notably, one of the EO's eight guiding policies and principles (promoting responsible innovation, competition, and collaboration) specifically includes tackling novel IP questions and other problems to protect inventors and creators.[1] Entities either directly or indirectly impacted by AI should be cognizant of agency timelines specified in the EO and expect agencies to solicit public input on IP-related AI regulatory development through requests for comment.

Forthcoming Guidance on AI Patentability

A key IP-related aspect of the EO involves clarifying issues with respect to the patentability of AI and AI-generated content.[2] The EO requires[3] the Under Secretary of Commerce for Intellectual Property and the Director of the U.S. Patent and Trademark Office ("USPTO") to undertake several related initiatives. Within 120 days of the date of the EO, these parties must publish guidance to USPTO examiners and applicants addressing inventorship and the use of AI, including generative AI, in the inventive process. The guidance should include illustrative examples in which AI systems play different roles in the inventive processes and how, in each example, inventorship issues ought to be analyzed. In addition, within 270 days of the date of the EO, these agencies must issue additional guidance to USPTO patent examiners and applicants to address other considerations at the intersection of AI and IP, which could include updating guidance on patent eligibility to address innovation in AI and critical emerging technologies. This guidance under the EO will likely clarify issues surrounding the patentability of AI and AI-generated content and inform the private sector's AI-related patent strategies.

Copyright Study from the U.S. Copyright Office

Another key IP component of the EO addresses the copyright issues raised by AI, such as the scope of protection for AI-generated content and the treatment of copyrighted works in AI training. The U.S. Copyright Office is actively conducting a related study, which will analyze the current state of copyright law, identify unresolved issues with respect to AI, and evaluate potential areas for Congressional action. Under the EO[4],

within 180 days of publication of this study or 270 days of the EO, whichever comes later, the Under Secretary of Commerce for Intellectual Property and the Director of the USPTO are also charged with consulting with the Director of the United States Copyright Office and issuing recommendations to the President on potential executive actions relating to copyright and AI to address such issues.

Assisting the Private Sector in Mitigating AI-related IP Risks

The EO seeks to assist developers of AI in combatting AI-related risks and provide related forthcoming guidance for the private sector. The EO requires[5] the Secretary of Homeland Security, acting through the Director of the National Intellectual Property Rights Coordination Center, and in consultation with the Attorney General, to develop a program to mitigate AI-related IP risks within 180 days. The EO sets out five requirements for this program, which include: (1) obtaining appropriate personnel dedicated to collecting and analyzing reports of AI-related theft and investigating and pursuing enforcement concerning such incidents; (2) implementing information and work-sharing policies with applicable federal, state, and local agencies; (3) developing guidance and other appropriate resources to assist the private sector with mitigating risks of AI-related IP theft; (4) sharing information and best practices with AI developers and law enforcement personnel to identify incidents, inform stakeholders of current legal requirements, and evaluate AI systems for IP violations, as well as developing mitigation strategies and resources; and (5) assisting the Intellectual Property Enforcement Coordinator in updating the Administration's Joint Strategic Plan for IP to address AI-related issues. The private sector should pay close attention to the forthcoming guidance to assist with mitigating risks of AI-related IP theft and how the Joint Strategic plan is updated to address AI-related issues, which could help inform an organization's AI governance strategy with respect to IP.

Next Steps

As relevant AI Executive Orders, legislation, and regulation continue to develop and shift, those utilizing or affected by AI should be cognizant of necessary compliance frameworks, applicable existing regulations, and the creation of new AI- specific regulations, drafting and efforts to pass relevant legislation, solicited federal comments and rulemakings, enforcement concerns, and expanding use cases.

Kilpatrick – AI Regulatory and Legislative Insights

Alexander J. Borovsky, Joshua S. Ganz, and Meghan K. Farmer – The U.S. Executive Order on Artificial Intelligence Is Not Only for Uncle Sam: Key Components of the Executive Order and Potential Impact on the Private Sector

Stephen M. Anstey – Artificial Intelligence – White House Issues Sweeping Executive Order on AI as Congress and Executive Agencies Continue to Take Action

Stephen M. Anstey – Artificial Intelligence – Congress, Federal Agencies, and the White House Solicit Information and Take Action

Stephen M. Anstey – Bipartisan Framework for U.S. AI (Sens. Blumenthal and Hawley) and Senate Hearing on Oversight of AI: Legislating on Artificial Intelligence

Jennie L. Cunningham – NYC Tackles AI and Automated Decision-making in Employment and Recruiting

Footnotes

[1] *See* Section 2(b) of the EO.

[2] Last year, the U.S. Court of Appeals for the Federal Circuit released a decision in *Thaler v. Vidal*, No. 21-2347 (Fed. Cir.), which addressed whether AI software can be listed as the inventor on a patent application. In *Thaler*, the United States Patent and Trademark Office ("USPTO") refused to allow two patent applications where the AI system was listed as the sole inventor, rationalizing that the U.S. Patent Act limits inventorship to natural persons.

[3] Section 5.2(c) of the EO.

[4] Section 5(c)(iii) of the EO.

[5] Section 5.3(d) of EO.