

Nineteen Hundred and Twenty-two

NYIPLA

100

YEARS

The New York Intellectual Property Law Association

AI IP GUIDELINES

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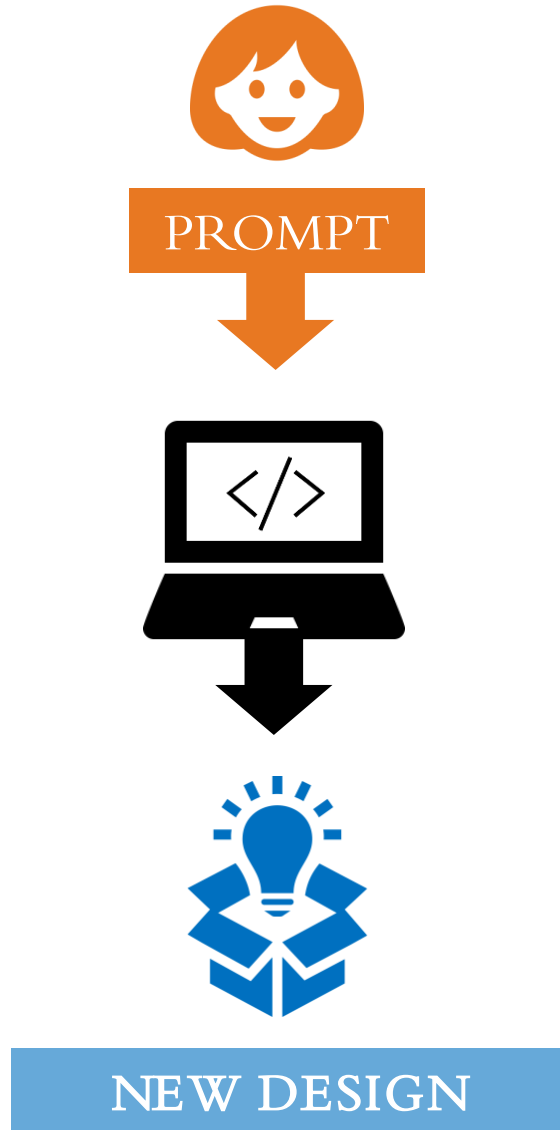
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This presentation was prepared with the assistance of AI.

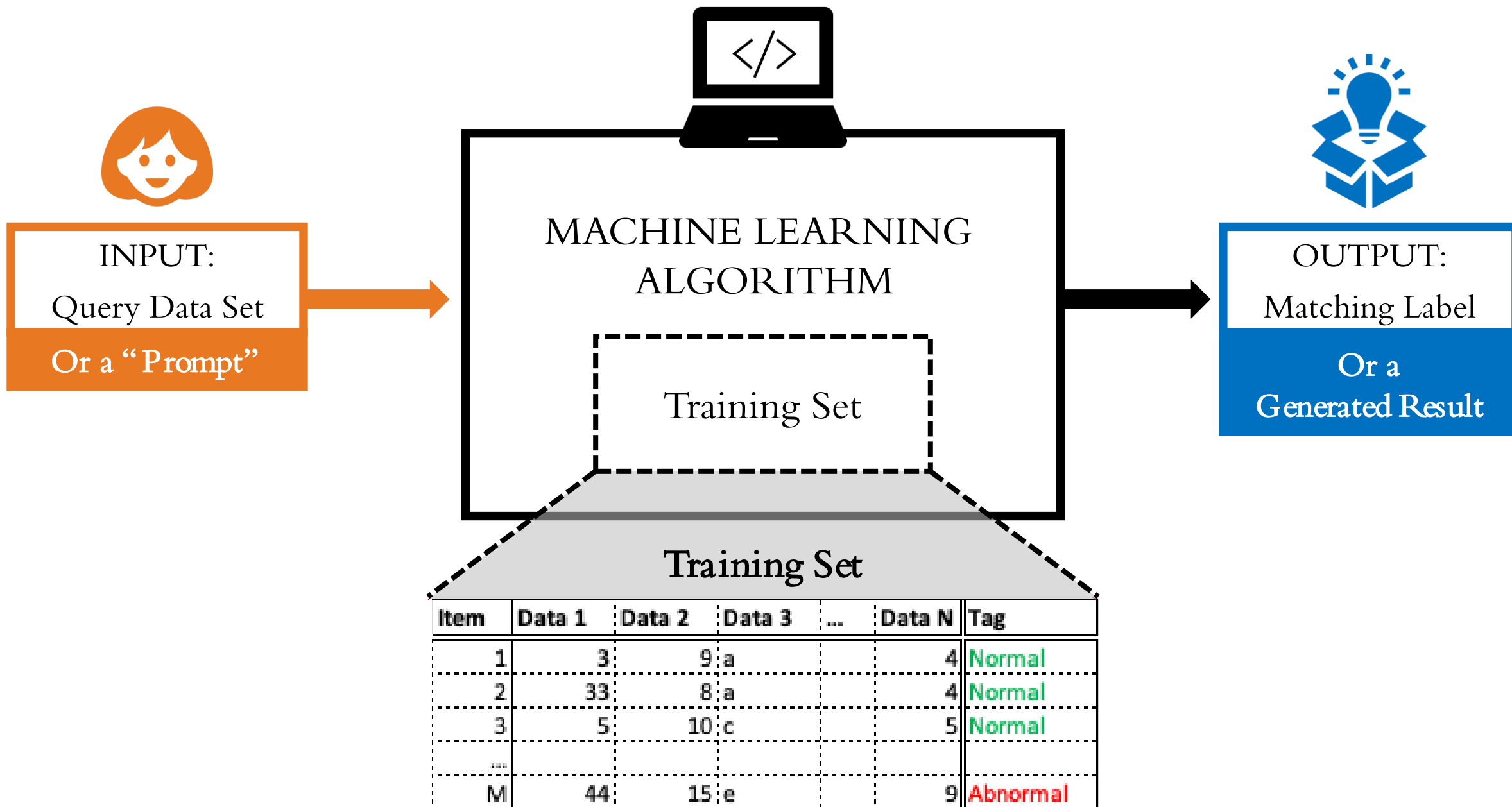
TODAY WE ARE GOING TO
DISCUSS GENERATIVE AI,
CURRENT GUIDANCE,
AND DEEPPFAKES






Generative artificial intelligence or “generative AI” is a type of artificial intelligence system capable of *generating text, images, or other media in response to prompts*. Generative AI models learn the patterns and structure of their input training data, and then generate new data that has similar characteristics.





The background of the slide features a photograph of a grand, classical building facade. In the upper portion, several large, fluted columns made of light-colored stone are visible. Below the columns, a wide set of stone steps leads up towards the building. The steps are made of rectangular stone blocks and recede into the distance, creating a sense of depth. The overall lighting is warm and natural, suggesting daylight.

CURRENT GUIDANCE AT THE USPTO AND COPYRIGHT OFFICE





A COMPUTER IS NOT
AN INVENTOR
(PATENT) OR AUTHOR
(COPYRIGHT) UNDER
U.S. LAW TODAY



That means neither the USPTO nor the Copyright Office will accept applications naming a computer as an inventor or author

USPTO



COPYRIGHT OFFICE



BUT



Inventorship Guidance for AI-Assisted Inventions, Docket No. PTO-P-2023-0043, 89 FR 10043

(Feb. 13, 2024)

Must have “**significantly contributed**”



“While AI systems and other non-natural persons cannot be listed as inventors on patent applications or patents, the use of an AI system by a natural person(s) does not preclude a natural person(s) from qualifying as an inventor (or joint inventors) if the natural person(s) **significantly contributed** to the claimed invention, as explained in section IV of this notice.”

"[T]he Office will not register works produced by a machine or mere mechanical process that operates randomly or automatically without any creative input or intervention from a human author."

"The crucial question is “whether the ‘work’ is basically one of human authorship, with the computer [or other device] merely being an assisting instrument, or whether the traditional elements of authorship in the work (literary, artistic, or musical expression or elements of selection, arrangement, etc.) were actually conceived and executed not by man but by a machine.”

Compendium of the U.S. Copyright Office Practices, Ch. 313.2

Must have “**human creative input** or **intervention**”



"In the case of works containing AI-generated material, the Office will consider whether the AI contributions are the result of “*mechanical reproduction*” or instead of an *author’s “own original mental conception*” to which [the author] gave visible form. The answer will depend on the circumstances, particularly how the AI tool operates and how it was used to create the final work. This is necessarily a case-by-case inquiry."

Copyright Registration Guidance: Works Containing Material Generated by Artificial Intelligence

37 C.F.R. Part 202, March 16, 2023



Example of unprotected AI-generated work:

“if a user instructs a text-generating technology to “write a poem about copyright law in the style of William Shakespeare,” she can expect the system to generate text that is recognizable as a poem, mentions copyright, and resembles Shakespeare’s style. But the technology will decide the rhyming pattern, the words in each line, and the structure of the text.”

Copyright Registration Guidance: Works Containing Material Generated by Artificial Intelligence

37 C.F.R. Part 202, March 16, 2023



AI-generated works may be subject to copyright protection, however, if:

1. A human selects or arranges AI-generated material in a sufficiently creative way that “the resulting works as a whole constitutes an original work of authorship,” OR
2. A human may modify material originally generated by AI technology to such a degree that the modifications meet the standard for copyright protection.

Copyright Registration Guidance: Works Containing Material Generated by Artificial Intelligence

37 C.F.R. Part 202, March 16, 2023



Copyright Office identifies “an **urgent need** for a robust nationwide remedy” for the problem of digital replicas (also called “deep fakes”). Deep fakes can be damaging to:

- (1) performers and artists,
- (2) individuals whose images are used without permission to create sexually explicit imagery;
- (3) victims of scams and fraud;
- (4) US political system, through the spread of misinformation and disinformation.

Report: Copyright and Artificial Intelligence

Part 1: Digital Replicas

July, 2024



Proposed Contours for New Law:

1. Should apply only to replicas that are “so realistic that they are difficult to distinguish from authentic depictions;
2. Should protect all individuals, not just likenesses that have commercial value
3. No post-mortem duration
4. Liability should arise from distribution, transmission or creation. Actual knowledge is necessary.
5. Secondary liability should apply; there should be a safe-harbor provision
6. Individuals should be able to license rights, but not assign them.

Report: Copyright and Artificial Intelligence Part 1: Digital Replicas July, 2024



Proposed Contours for New Law (Cont.)

7. Free speech concerns should be considered via a balancing test, instead of categorical exemptions.
8. Statute should include statutory damages and fee-shifting.
9. No full pre-emption: “Federal law should provide a floor of consistent protection nationwide, with states continuing to be able to provide additional protections.”

Report: Copyright and Artificial Intelligence Part 1: Digital Replicas July, 2024





EXAMPLES OF
WHERE COPYRIGHT
LAW HAS DRAWN
THE LINE





Copyright Review Board Decision On “A Recent Entrance To Paradise” (Feb. 14, 2022)

Rejected: No human contribution.

“Thaler must either provide evidence that the Work is the product of human authorship or convince the Office to depart from a century of copyright jurisprudence. He has done neither.”

Copyright Review Board Decision On “Théâtre D’opéra Spatial” (Sept. 5, 2023)

**Rejected: Must disclaim content
generated by AI.**

“[T]he process of prompting can involve creativity—after all, ‘some prompts may be sufficiently creative to be protected by copyright’ as literary works.”

“To the extent Mr. Allen argues by analogy that his visual edits are ‘transformative,’ and thus, copyrightable, the Board agrees that **human-authored modifications of AI-generated material may protected by copyright.**” (**subject to disclaimer**)





Copyright Review Board Decision On “Suryast” (Dec. 11, 2023)

Rejected: lacked requisite human authorship

“The Board is not convinced by Mr. Sahni’s description of RAGHAV as ‘an assistive tool’ that works similarly to ‘a camera, digital tablet, or a photo-editing software program.’”

“Here, RAGHAV’s interpretation of Mr. Sahni’s photograph in the style of another painting is a function of how the model works and the images on which it was trained on—not specific contributions or instructions received from Mr. Sahni.”

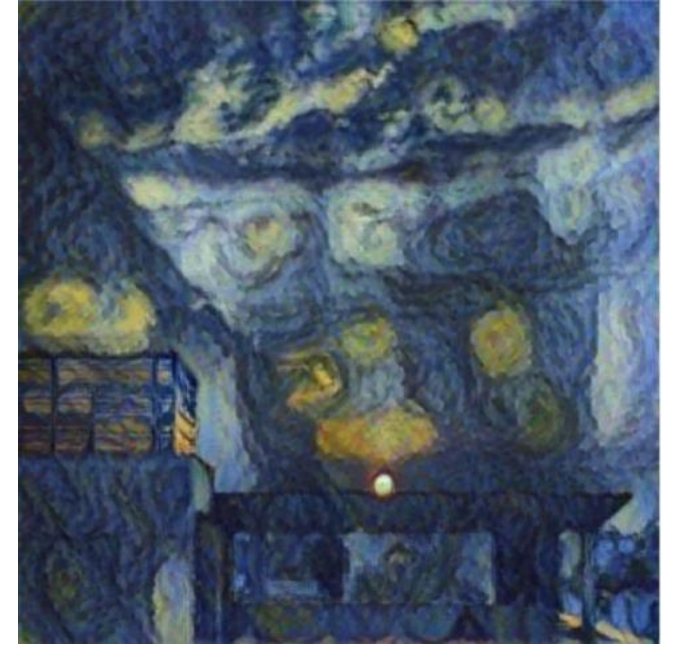
SURYAST



+



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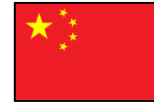
Global Perspectives – Can a person claim authorship for an AI-Generated work?



UK: **Yes.** For “computer-generated” works, “the author shall be taken to be the person by whom the arrangements necessary for the creation of the work are undertaken.” Copyright Designs and Patent Act 1988, Sec. 9(3).



Czech Republic: **No.** Caselaw suggests that AI-Generated works are not generated by natural persons and therefore fail to satisfy authorship problem. *S.S. v. Taubel Legal*, No. 10 C 13/2023-16 (Prague Mun. Ct. Oct. 11, 2023)



China: **Maybe.** While AI cannot be an “author”, a natural person can be an author of an AI generated work by selecting and finetuning prompts and parameters, as well as refining a final output. *See Li v. Liu*, 0491 No. 11279, Beijing Internet Court (Nov. 27, 2023)



(Figure 3)

Original
Output



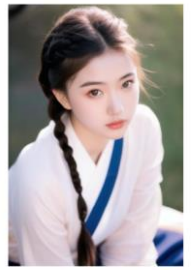
(Figure 4)

Modified
Weights



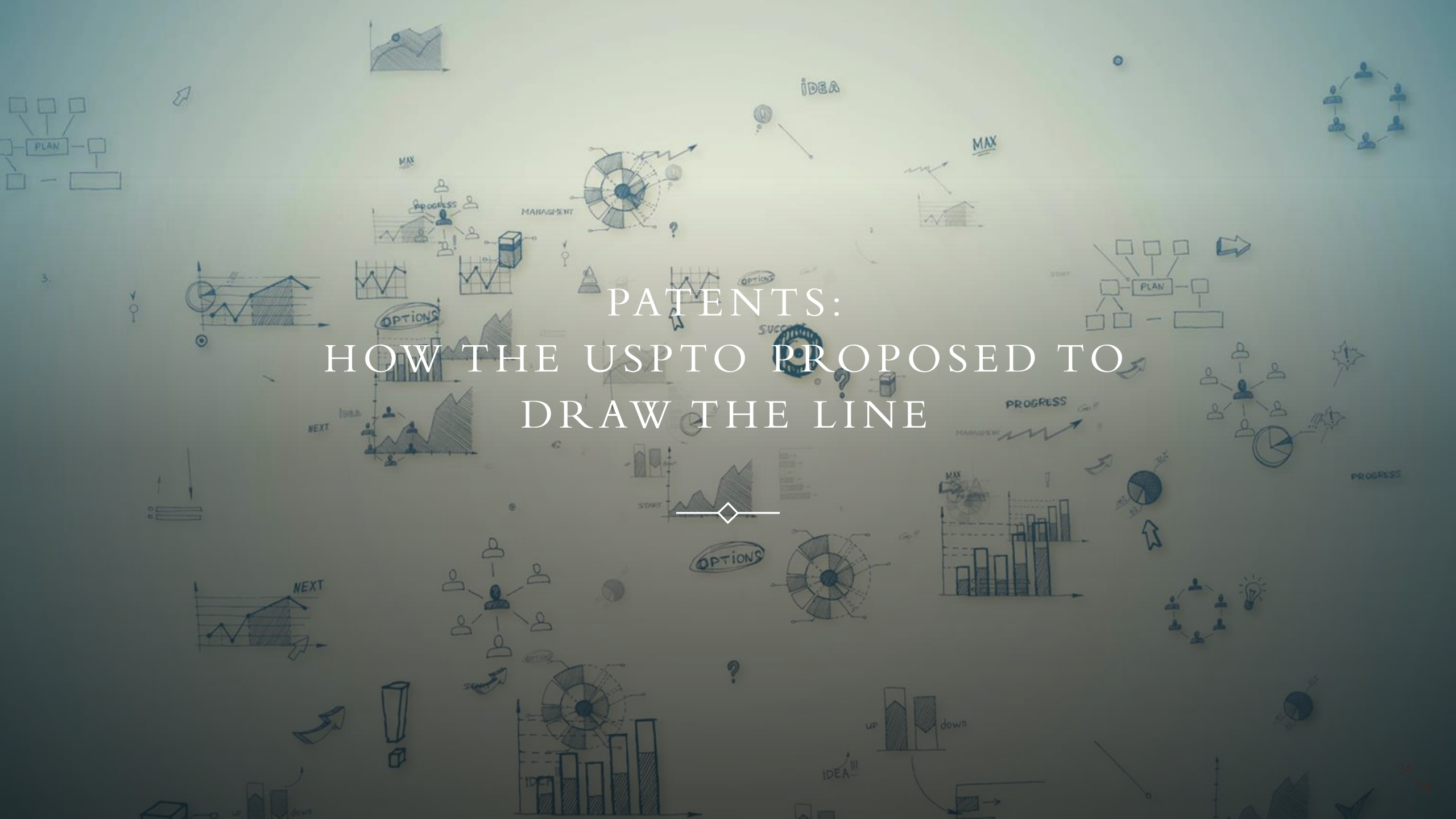
(Figure 5)

Modified
Seed



(Figure 6)

Modified
Prompt



PATENTS: HOW THE USPTO PROPOSED TO DRAW THE LINE

SIGNIFICANT CONTRIBUTION

When evaluating the contributions made by natural persons in the invention creation process, it is important to keep in mind they **may apply for a patent jointly**, “even though

- (1) they did not physically work together or at the same time,
- (2) each did not make the same type or amount of contribution, or
- (3) each did not make a contribution to the subject matter of every claim of the patent.”



Instead, each inventor must contribute in **some significant manner** to the invention. In making this determination, the courts have looked to several factors, such that each inventor must: ‘

- ‘(1) *contribute in some significant manner* to the conception or reduction to practice of the invention,
- (2) *make a contribution to the claimed invention that is not insignificant* in quality, when that contribution is measured against the dimension of the full invention, and
- (3) do more than merely explain to the real inventors well-known concepts and/or the current state of the art”

(Pannu factors)

GUIDING PRINCIPLE NO. 1

1. A natural person's use of an AI system in creating an AI-assisted invention does not negate the person's contributions as an **inventor**. The natural person can be listed as the inventor or joint inventor if the natural person *contributes significantly* to the AI-assisted invention.

AI + Human = OK!



GUIDING PRINCIPLE NO. 2



2. Merely recognizing a problem or having a general goal or research plan to pursue does not rise to the level of conception. A natural person who only presents a problem to an AI system may not be a proper inventor or joint inventor of an invention identified from the output of the AI system. However, a **significant contribution** could be shown by the way the person constructs the prompt in view of a specific problem to elicit a particular solution from the AI system.



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Problem + No SC = No Good

GUIDING PRINCIPLE NO. 3



RTP (alone) = No Good

3. Reducing an invention to practice alone is not a significant contribution that rises to the level of inventorship. Therefore, a natural person who merely recognizes and appreciates the output of an AI system as an invention, particularly when the properties and utility of the output are apparent to those of ordinary skill, is not necessarily an inventor. However, a person who takes the output of an AI system and makes a significant contribution to the output to create an invention may be a proper inventor. Alternatively, in certain situations, a person who conducts a successful experiment using the AI system's output could demonstrate that the person provided a significant contribution to the invention even if that person is unable to establish conception until the invention has been reduced to practice.

GUIDING PRINCIPLE NO. 4

4. A natural person who develops an essential building block from which the claimed invention is derived may be considered to have provided a significant contribution to the conception of the claimed invention even though the person was not present for or a participant in each activity that led to the conception of the claimed invention. In some situations, the natural person(s) who designs, builds, or trains an AI system in view of a specific problem to elicit a particular solution could be an inventor, where the designing, building, or training of the AI system is a significant contribution to the invention created with the AI system.



Provide essential building block = OK!

GUIDING PRINCIPLE NO. 5



Owning or Overseeing an AI system = No Good

5. Maintaining “intellectual domination” over an AI system does not, on its own, make a person an inventor of any inventions created through the use of the AI system. Therefore, a person simply owning or overseeing an AI system that is used in the creation of an invention, without providing a significant contribution to the conception of the invention, does not make that person an inventor.



THE USE OF AI DURING LITIGATION



THE USE OF AI IN LITIGATION



AI tools are being marketed for numerous litigation tasks, including:

- Case analysis to determine potential causes of action and litigation strategy
- Document review
- Privilege log generation
- Analyzing documents and deposition transcripts to find threads, admissions, and inconsistencies
- Generating or tweaking language in briefs



THE USE OF AI IN LITIGATION

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All of these implicate or involve the use of confidential information:

- From clients
- From discovery (including third-party discovery)

ETHICAL CONSIDERATIONS – DUTIES TO CLIENTS

Rule 1.1 – Competence

A lawyer shall provide competent representation to a client. Competent representation requires the legal knowledge, skill, thoroughness and preparation reasonably necessary for the representation.



Rule 1.6 – Confidentiality of Information

(a) A lawyer shall not reveal information relating to the representation of a client unless the client gives informed consent, the disclosure is impliedly authorized in order to carry out the representation or the disclosure is permitted by paragraph (b).

(b) [Exceptions].

(c) A lawyer shall make reasonable efforts to prevent the inadvertent or unauthorized disclosure of, or unauthorized access to, information relating to the representation of a client.

ETHICAL CONSIDERATIONS – PROTECTIVE ORDERS



IT IS HEREBY ORDERED that any person subject to this Stipulation and Protective Order (“Protective Order”)—including without limitation the Parties to this action, their representatives, agents, experts and consultants, all third parties providing discovery in this action, and all other interested persons with actual or constructive notice of this Protective Order—shall adhere to the following terms:

★ ★ ★

16. This Protective Order shall survive the termination of the litigation. Within 30 days of the final disposition of this action, all Discovery Material designated as “Confidential,” and all copies thereof, shall be promptly returned to the producing person, or, upon permission of the producing person, destroyed.

17. All persons subject to this Protective Order acknowledge that willful violation of this Protective Order could subject them to punishment for contempt of Court. . . .

ETHICAL CONSIDERATIONS – PROTECTIVE ORDERS

6. No person subject to this Protective Order other than the producing person shall disclose any of the Discovery Material designated by the producing person as Confidential to any other person whomsoever, except to:

★ ★ ★

(c) outside vendors or service providers (such as copy-service providers and document-management consultants, graphic production services or other litigation support services) that counsel hire and assign to this matter, including computer service personnel performing duties in relation to a computerized litigation system;



ETHICAL CONSIDERATIONS – PROTECTIVE ORDERS



—◆—
9. Recipients of Confidential Discovery Material under this Protective Order may use such material solely for the prosecution and defense of this action, and specifically (and by way of example and not limitation) may not use Confidential Discovery Material for any business, commercial or competitive purpose. . . .

ETHICAL CONSIDERATIONS – PROTECTIVE ORDERS



14. Each person who has access to Discovery Material that has been designated as Confidential shall take all due precautions to prevent the unauthorized or inadvertent disclosure of such material.

15. Any Personally Identifying Information (“PII”) (e.g., social security numbers, financial account numbers, passwords, and information that may be used for identity theft) exchanged in discovery shall be maintained by the persons who receive such information and are bound by this Protective Order in a manner that is secure and confidential. In the event that the person receiving PII experiences a data breach, she, he or it immediately shall notify the producing person of the same and cooperate with the producing person to address and remedy the breach. . . .

QUESTIONS

