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Patenting AI innovations

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What to protect with respect to artificial intelligence (AI) / machine learning (ML)

- Patent protection around machine learning (ML)
 - New ML algorithm
 - Ways of training ML
 - Applications of ML
- Patent protection around AI/ML outputs
 - For example, you may have a discovery platform in the therapeutics space and your AI may help identify therapeutics targets
- Trade secret coverage around the specifics
 - For example, scaling factors/weights around features that are identified by ML

Challenges around protecting AI/ML

- Subject matter (Section 101)
 - Claims may be seen as being directed to a judicial exception (an abstract idea, a law of nature or a natural phenomenon)
 - Argue that the JE is integrated into a practical application (e.g., improvement to a technology or treatment operation) (Alice Step 2A) and/or that the claim recites elements that are not routine or conventional (Alice Step 2B)
- Prior art (sections 102/103)
 - Make sure the claims recite differences over the art
- Written description and enablement (Section 112)
 - Balancing act between details to disclose around the AI/ML versus what to keep as a trade secret

Challenges around protecting AI/ML (continued)

- Be cautious of divided infringement
 - Avoid claims that require both (1) training and (2) application of ML given different actors may be involved
 - Adding a treatment/treating operation may not be a problem for a diagnostics claim (per the Limelight standard)
- Be cautious of inventorship if the “invention” is solely made by AI/ML
 - Add a claim that includes a feature that has been contributed by a human (e.g., a formulation, a particular side group, etc.)



Questions?

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