

# AI and Inventorship in the U.S.

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# Inventorship: U.S. laws

- The term “inventor” is defined in 35 U.S.C. 100(f) as “the *individual* or, if a joint invention, the *individuals* collectively who invented or discovered the subject matter of the invention.”
- Under 35 U.S.C. 115(b), the oath or declaration must state, among other things, that “such individual believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application.”
- 35 U.S.C. 101 states in part – “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, and any new and useful improvement thereof, may obtain a patent therefor . . .”
- Failure by the applicant to name the proper “inventor(s)” is a ground for rejection under 35 U.S.C. 101 and 35 U.S.C. 115.

# Who is an inventor?

- The threshold question in determining inventorship is **who conceived the claimed invention**.
  - One must contribute to the conception to be an inventor.
  - A person who shares in the conception of a claimed invention is a joint inventor of that invention.
- The USPTO presumes the natural persons named on the application data sheet or oath/declaration are the actual inventor or joint inventors of the patent application.



# *Thaler v. Vidal*

- The Federal Circuit upheld the USPTO’s decisions to deny two petitions seeking to name an AI system as an inventor.
- Decision hinged on the interpretation of the definition of “inventor” in 35 U.S.C. 100(f) “the individual or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention.”
- Court concluded that an inventor must be a natural person.
- Court further explained that it was **not** confronted with “the question of whether inventions made by human beings with the assistance of AI are eligible for patent protection.”

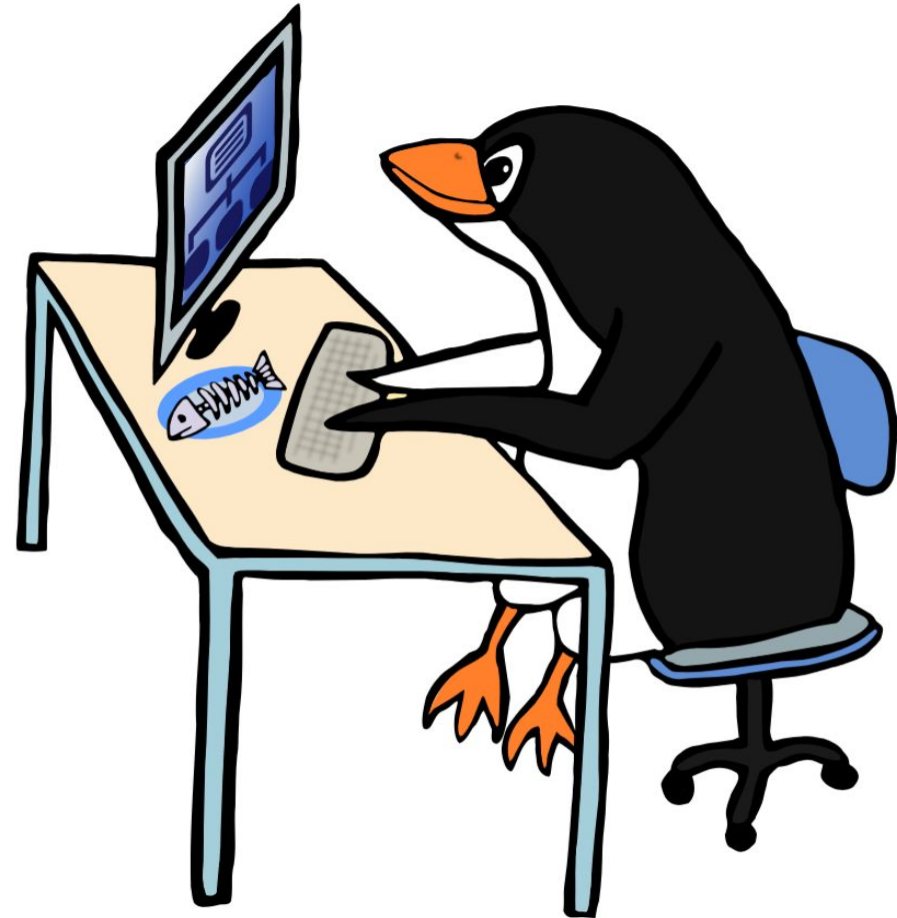
*Thaler v. Vidal*, 43 F.4th 1207 (Fed. Cir. 2022)



# MPEP updates after *Thaler*

- R-07.2022 revision of the MPEP published February 2023\*
  - MPEP 2109
    - An inventor or joint inventor must be a natural person
- Patent applications naming a machine as an inventor or a joint inventor will be considered by the USPTO to have improper inventorship.

\* Current MPEP revision: E9\_R-01.2024



# Inventorship guidance for AI-assisted inventions

- USPTO issued inventorship guidance for AI-assisted inventions and Request for comments (89 FR 10043) on February 13, 2024\*
- AI-assisted inventions are not categorically unpatentable for improper inventorship
- Provides a framework based on existing Federal Circuit precedent (*Pannu v. Iolab Corp.*, 155 F.3d 1344, 1351 (Fed. Cir. 1998)) to determine whether a human's contribution is sufficient for proper inventorship
- Includes 5 guiding principles for applying the *Pannu* factors to AI-assisted inventions

\* *Currently under review*



# References

- MPEP 2109: Inventorship
- MPEP 2138.04: “Conception”
- Inventorship Guidance for AI-Assisted Inventions, [89](#)  
[FR 10043](#) (Feb 13, 2024)