



American Intellectual Property Law Association

February 14, 2020

Mr. Francis Gurry
Director General
World Intellectual Property Organization (WIPO)
34, chemin des Colombettes
1211 Geneva 20, Switzerland

Via email: ai2ip@wipo.int

**Re: AIPLA Submission on WIPO/IP/AI/2/GE/20/1 (Impact of AI on IP Policy:
“Draft Issues Paper on Intellectual Property Policy and Artificial Intelligence”)**

Dear Director General Francis Gurry:

The American Intellectual Property Law Association (“AIPLA”) welcomes the opportunity to submit comments in response to the World Intellectual Property Organization (“WIPO”) request for written comments on a list of issues concerning the impact of artificial intelligence (“AI”) on intellectual property (“IP”) policy that might form the basis of future structured discussions (WIPO/IP/AI/2/GE/20/1: Impact of AI on IP Policy: “Draft Issues Paper on Intellectual Property Policy and Artificial Intelligence” December 13, 2019) [Hereinafter “Call for Comments on the Impact of AI on IP Policy”].

Founded in 1897, AIPLA is a national bar association of approximately 12,000 members engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public’s interest in healthy competition, reasonable costs, and basic fairness.

Below, AIPLA respectfully submits comments on WIPO’s thirteen (13) identified issues in its Call for Comments on the Impact of AI on IP Policy. As instructed, AIPLA has carefully considered whether each issue has been correctly identified and has pondered whether any additional issues are missing in order to contribute to WIPO’s formulation of a shared understanding of the main questions to be discussed in the planned May 2020 Second Session of the WIPO Conversation on IP and AI.

AIPLA understands that WIPO has identified thirteen (13) issues that have been divided into six (6) areas of concern (e.g., patents, copyright, data, designs, technology gap and capacity building and accountability for administrative decisions) to *narrow* the focus of WIPO’s

conversation on IP and AI.¹ AIPLA respectfully encourages WIPO and/or Member States as well as other relevant stakeholders to consider whether trademark and trade secret should be included as areas of concern in WIPO’s conversation on IP and AI.² Alternatively, AIPLA respectfully encourages a separate discussion to address issues pertaining to the impact of AI on trade secret and trademark as recently addressed by the USPTO.³

Issue 1: Inventorship and Ownership [Patents]

AIPLA generally agrees with WIPO’s formulation of the issue described herein. However, with respect to question formulation No. 6, it might be prudent to also consider that if an AI system can be considered as an inventor, what might be the ramifications of that characterization. For example, how might the characterization affect related issues such as infringement and liability? And if AI is an “owner” then how does the AI system enforce, assign, hire counsel, sign court documents, as well as how might an AI system defend and respond to a lawsuit, etc.?⁴

With respect to the phrase “[h]owever, it would not seem clear that inventions can be *autonomously generated* by AI,” (emphasis added) as well as question formulation No. 7 which further addresses the concept “autonomously”, AIPLA respectfully submits that WIPO should consider redefining the term “autonomously generated” in view of two recent decisions to refuse patenting of so-called DABUS patent applications⁵ by the European Patent Office (EPO)⁶ and the United Kingdom Intellectual Property Office (UKIPO).⁷ In particular, WIPO might consider the *temporal effect* of pre-AI and post-AI human author contribution / intervention in the redefinition of “autonomously generated” which is “produced” in the context of software development. That is, the dictionary defines the term “autonomous” as something to be “undertaken or carried on without control;”⁸ however, software development and software execution requires human contribution / intervention. The fact that there is a temporal lag

¹ According to WIPO/IP/AI/GE/19/INF2 (“Background Note), March 12, 2019, the objective of WIPO’s Conversation on IP and AI is to “. . . provide Member States with an opportunity to hold conversations and exchange views on various topics regarding AI for didactic purposes and formulating the right questions with respect to the possible impact on AI on the IP system [within WIPO’s mandate].” The expected results of WIPO’s Conversation on IP and AI is described as enabling Member States to have a (a) “[b]etter understanding of the impact of AI on IP;” (b) “[b]etter understanding of the potential of AI in enhancing IP administration;” (c) “[f]ormulation of the right questions that should continue to be discussed in the future; and (d) “[i]dentifying issues that need the urgent attention of Member States.” Page 3, (9-11)

² AIPLA recently submitted comments on the impact of AI on copyright, trademarks and trade secrets in response to the USPTO’s Request for Comments regarding issues related to copyright, trademark, and other intellectual property rights impacted by artificial intelligence innovation raised in the October 30, 2019 Federal Register Notice (84 Fed. Reg. 58141). https://www.aipla.org/docs/default-source/advocacy/documents/aipla-response-to-fed-reg-notice-on-ai-2020january10.pdf?sfvrsn=50128396_0 January 10, 2020 (See trademark searching concerns, page 8 and trade secret concerns page 9-16 and 23-27).

³ Id.

⁴ Creative lawyering could result in a response by an adverse party to a lawsuit claiming the moving party has no standing, or in defense of such a lawsuit that the responding party is not the liable party (“go sue the box”).

⁵ See, e.g., Tina G. Yin Sowatzke, Meet DABUS: An Artificial Intelligence Machine Hoping to Maintain Two Patent Applications in its own Name, (Aug. 22, 2019) (<https://www.filewrapper.com/filewrapper/meet-dabus-artificial-intelligence-machine-hoping-to-maintain-two-patent-applications-in-its-own-?filewrapper=true>).

⁶ See <https://www.epo.org/news-issues/news/2019/20191220.html> (visited January 20, 2020)

⁷ See <https://www.ipo.gov.uk/p-challenge-decision-results/o74119.pdf> (visited January 20, 2020)

⁸ See <https://www.merriam-webster.com/dictionary/autonomous> (visited January 8, 2020)

between cause and effect in the context of contribution / intervention as well as the subsequent production of output should not lead to a conclusion that the AI system contributes to the “conceptualization” of an invention under patent laws.

Issue 2: Patentable Subject Matter and Patentability Guidelines

AIPLA generally agrees with WIPO’s formulation of the issue described herein. However, AIPLA respectfully incorporates its comments above with respect to the definition of “autonomous” in response to the Issue No. 1. Further, WIPO might consider clarifying how much assistance is required to alter patentability and how to quantify “assistance.”

WIPO might also consider public policy in deciding whether to include or exclude AI-generated inventions from patent eligible subject matter. For example, inclusion might provide an incentive for innovation, while exclusion might provide a disincentive. Further, disharmony of national patent laws is already a concern with respect to computer-implemented inventions and might be further exacerbated.

Issue 3: Inventive Step or Non-Obviousness

AIPLA generally agrees with WIPO’s formulation of the issue described herein.

Issue 4: Disclosure

AIPLA generally agrees with WIPO’s formulation of the issue described herein. However, AIPLA recommends the following clarifications:

“Patent laws require that the disclosure of an invention be sufficient to enable one skilled in the relevant art to practice ~~reproduce~~ the invention.”

Further, AIPLA recommends the inclusion of another question formulation similar to subpart (iii) under this issue, as follows:

[New Question] Would a system of deposit for algorithms and their data (initial and final), similar to the deposit of microorganisms, be useful?

Issue 5: General Policy Considerations for the Patent System

AIPLA agrees with WIPO’s formulation of the issue described herein. As discussed above, WIPO might also consider public policy in deciding whether to include or exclude AI-generated inventions from patent eligible subject matter. For example, inclusion might provide an incentive for innovation, while exclusion might provide a disincentive. Further, disharmony of national patent laws is already a concern with respect to computer-implemented inventions and might be further exacerbated.

Issue 6: Authorship and Ownership [Copyright and Related Rights]

AIPLA generally agrees with WIPO’s formulation of the issue described herein. However, AIPLA respectfully points out that there is an inherent copyright issue relating to the identification of the work itself. Assuming an AI system will continue to generate variations,⁹ one approach might be to accord merits to the human being who identifies a given work. This concept may be added to subpart (i) as shown below as underlined text:

(i) Should copyright be attributed to original literary and artistic works that are autonomously generated by AI or should a human creator or a human being who identifies the work be required?

[suggested revisions shown]

An example of this issue is an AI recursively generating music based on snippets of Mozart’s compositions. At some point, a human being is making a judgment call on whether a generated work (the output of the AI) is interesting. The suggested modification of (i) as shown above relates to the identification of the interesting work over less interesting works.

As discussed above with respect to patents, WIPO should consider refining the use of the word “autonomously” under this issue. Further, the phrase “or should a human creator be required,” might be further clarified / quantified by discussing the level of contributions that should be required by a human creator as indicated under the “lion’s share of the work” theory.

Issue 7: Infringement and Exceptions [Copyright and Related Rights]

AIPLA agrees with WIPO’s formulation of the issue described herein.

Issue 8: Deep Fakes [Copyright and Related Rights]

AIPLA agrees with WIPO’s formulation of the issue described herein. However, AIPLA recommends that an additional subpart be added under question formulation No. 15, as follows:

[Added Subpart] (ii) Should a mechanism¹⁰ be provided to enable the seizure and destruction of any unauthorized deep fake at the behest of the person depicted in the deep fake?

⁹ More specifically, computers excel in producing items in mass quantities, that can be small derivatives from each other, in an *ad nauseam* fashion.

¹⁰ AIPLA submits that the funding of such a mechanism (e.g., staffing and infrastructure) as well as providing due process may be challenging.

Issue 9: General Policy Issues [Copyright and Related Rights]

AIPLA agrees with WIPO’s formulation of the issue described herein.

Issue 10: Further Rights in Relation to Data

AIPLA agrees with WIPO’s formulation of the issue described herein.

Issue 11: Authorship and Ownership - Designs

AIPLA generally agrees with WIPO’s formulation of the issue described herein. As discussed above with respect to patents and copyrights, WIPO should consider refining the use of the word “autonomously” as it pertains to this issue. AIPLA further recommends the following clarifications:

As to Question (i), the phrase "permit or require" in the first sentence may be vague. AIPLA respectfully submits that the decision to seek protection of a design application has to be made by an applicant. Perhaps the question might be rephrased as: "Should the law accord design protection to an original design..." Further, the phrase "with existing laws" might be clarified by adding a reference to "copyright" or other relevant laws that WIPO has in mind. Suggested revisions are shown below as underlined or ~~strikeout~~ text.

(i) Should the law ~~permit or require that~~ design protection ~~be accorded to~~ an original design that has been produced autonomously by an AI application? If a human designer is required, should the law give indications of the way in which the human designer should be determined, or should this decision be left to private arrangements, such as corporate policy, with the possibility of judicial review by appeal in accordance with existing copyright laws concerning disputes over authorship?

[suggested revision shown]

As to Question (ii), the repetition of the terms "ownership" and "authorship" in the question may be vague. Perhaps the final phrase "concerning attribution of authorship and ownership" can simply be omitted to provide clarity. Suggested revisions are shown below as ~~strikeout~~ text.

(ii) Do specific legal provisions need to be introduced to govern the ownership of autonomously generated AI designs, or should ownership follow from authorship and any relevant private arrangements, such as corporate policy, ~~concerning attribution of authorship and ownership?~~

[suggested revision shown]

Issue 12: Capacity Building (*Technology Gap and Capacity Building*)

AIPLA agrees with WIPO’s formulation of the issues described herein. AIPLA further notes that, as described above, our association’s vision, mission and values¹¹ are aligned with the envisaged goal of this particular issue.

Issue 13: Accountability for Decisions in IP Administration

AIPLA agrees with WIPO’s formulation of the issue described herein. AIPLA also notes that additional resources on this issue include various standards bodies such as representatives from IEEE’s P7001 Program,¹² which together with IEEE-SA is exploring the feasibility of explainable AI as well as the possibility of formulating standards for the transparency of backbox algorithms.

We thank you for the opportunity to provide these comments. AIPLA supports the WIPO’s efforts to improve the IP system, welcomes the opportunity to answer any questions these comments may raise, and looks forward to a continuing dialogue on this very important subject.

Sincerely,



Barbara A. Fiacco
President
American Intellectual Property Law Association

¹¹ See <https://www.aipla.org/about/about-us> (Visited January 22, 2020).

¹² https://standards.ieee.org/news/2016/ieee_p7001.html (Visited January 22, 2020)