Client Alert

November 2019

Can An Algorithm Be An Author? (And Other AI Questions The PTO Is Now Asking)

First the machines came for our inventors; today they come for our authors and artists.

An AI-created portrait sold for more than $400,000 in late 2018.[1] Music producers (and even consumers) are using AI platforms to craft music.[2] You can visit https://talktotransformer.com/ and it will generate sentences based on a custom prompt or a "snippet" of text that you provide.

We previously wrote about the US Patent and Trademark Office's (PTO) call for comments on artificial intelligence (AI) issues in patent law. (For those yet to respond to that notice, but who desire to do so, the comment period was extended to November 8, 2019.)

Now the PTO is gathering information on AI concerns relating to copyright, trademark, and other non-patent intellectual property rights.[3]

As before, the PTO welcomes comments on any issues the public believes are relevant, but also provided a list of 13 questions***** in which it is "particularly interested" as "a preliminary guide to aid the USPTO" in collecting information, evaluating whether further guidance is needed, and developing any such guidance.

The PTO's questions specifically address topics regarding "intellectual property policy and its relationship with AI" for copyrights, trademarks, databases, and trade secrets, and then open up consideration of any other AI-related issues pertinent to intellectual property rights.

> Would a work produced by an AI algorithm qualify as a work of authorship?
>
> Does copyright law properly address the use of copyrighted works by an AI algorithm?
>
> Does AI impact the need to protect databases and data sets?

These (and more) are all important questions and we look forward to hearing what the public has to say, as well as to future policy recommendations by the PTO, legislation by Congress, and opinions of the courts.

Directions for submission of comments (this time, by December 16, 2019) may be found in the Federal Register notice.

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[1] *See* https://www.cnbc.com/2018/10/25/portrait-made-by-artificial-intelligence-sold-for-432k-at-christies.html.

[2] *See, e.g.,* https://www.theverge.com/2018/8/31/17777008/artificial-intelligence-taryn-southern-amper-music.

[3] PTO Request for Comments on Intellectual Property Protection for Artificial Intelligence Innovation, 84 Fed. Reg. 58141 (Oct. 30, 2019); *see also* A. Iancu and L. Peter, "USPTO issues second Federal Register Notice on artificial intelligence and innovation," at https://www.uspto.gov/blog/director/entry/uspto_issues_second_federal_register (Oct. 30, 2019).

***Full List of Issues for Comment:**

1. Should a work produced by an AI algorithm or process, without the involvement of a natural person contributing expression to the resulting work, qualify as a work of authorship protectable under US copyright law? Why or why not?
2. Assuming involvement by a natural person is or should be required, what kind of involvement would or should be sufficient so that the work qualifies for copyright protection? For example, should it be sufficient if a person (i) designed the AI algorithm or process that created the work; (ii) contributed to the design of the algorithm or process; (iii) chose data used by the algorithm for training or otherwise; (iv) caused the AI algorithm or process to be used to yield the work; or (v) engaged in some specific combination of the foregoing activities? Are there other contributions a person could make in a potentially copyrightable AI-generated work in order to be considered an ‘‘author’’?
3. To the extent an AI algorithm or process learns its function(s) by ingesting large volumes of copyrighted material, does the existing statutory language (e.g., the fair use doctrine) and related case law adequately address the legality of making such use? Should authors be recognized for this type of use of their works? If so, how?
4. Are current laws for assigning liability for copyright infringement adequate to address a situation in which an AI process creates a work that infringes a copyrighted work?
5. Should an entity or entities other than a natural person, or company to which a natural person assigns a copyrighted work, be able to own the copyright on the AI work? For example: Should a company who trains the artificial intelligence process that creates the work be able to be an owner?
6. Are there other copyright issues that need to be addressed to promote the goals of copyright law in connection with the use of AI?
7. Would the use of AI in trademark searching impact the registrability of trademarks? If so, how?
8. How, if at all, does AI impact trademark law? Is the existing statutory language in the Lanham Act adequate to address the use of AI in the marketplace?
9. How, if at all, does AI impact the need to protect databases and data sets? Are existing laws adequate to protect such data?
10. How, if at all, does AI impact trade secret law? Is the Defend Trade Secrets Act (DTSA), 18 U.S.C. 1836 *et seq*., adequate to address the use of AI in the marketplace?
11. Do any laws, policies, or practices need to change in order to ensure an appropriate balance between maintaining trade secrets on the one hand and obtaining patents, copyrights, or other forms of intellectual property protection related to AI on the other?
12. Are there any other AI-related issues pertinent to intellectual property rights (other than those related to patent rights) that the USPTO should examine?
13. Are there any relevant policies or practices from intellectual property agencies or legal systems in other countries that may help inform USPTO’s policies and practices regarding intellectual property rights (other than those related to patent rights)?

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