August 23, 2023

The Honorable Kathi Vidal
Under Secretary of Commerce for Intellectual Property and
Director of the U.S. Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Dear Director Vidal,

The U.S. Patent and Trademark Office has a critical role to play in unlocking the historic opportunity of innovation in artificial intelligence and expanding America’s technological leadership. The USPTO evaluates hundreds of thousands of claimed inventions each year, with an ever-growing percentage involving claims over new AI technology.

Unfortunately, various new proposals would make it much harder for the agency to correct any errors in the patent examination process, stifling developers and U.S. innovation. To ensure the patent process helps developers rather than improperly constraining them, the USPTO should take three immediate actions:

(1) **Maintain access to the Inter Partes Review (IPR) program.** The growing number of patent applications filed every year means mistakes are inevitable. But mistakenly granting AI-related patents can block and bottleneck innovation for years. The IPR program was carefully constructed to address examination errors, providing expert, efficient, and cost-effective review of the small subset of patents with the greatest impact on our economy. The USPTO has recently proposed a number of very problematic changes to Inter Partes Review, most of which would make it much harder to use the program, create uncertainty, and expand patent trolling and other litigation abuses. The USPTO can prevent this and help America realize AI’s benefits by withdrawing proposed changes that would restrict access to Inter Partes Review. If a patent challenge is timely and has merit, meeting the strict requirements Congress already put in place, it should be heard by the USPTO.

(2) **Implement comprehensive technical training on AI for patent examiners.** Patent claims on AI technology are crossing the desks of ever-increasing numbers of patent examiners. While some examiners are experts in AI, others are experts in the area that the AI technology is being applied, and are less likely to have expertise in AI itself. This technological shift is similar to a trend that started in the 1980s. When software patents were first authorized, America suffered through decades of low-quality and even frivolous software patents. Applicants often filed on ordinary processes being accomplished “on a computer” or “over the internet,” and applications were too often granted by examiners who understandably did not have experience with software or internet technology, and so were not in a good position to evaluate whether those applications met the statutory requirements for patenting. We should not repeat that mistake.

This is why the USPTO must make sure that it has a comprehensive technical training program in place for all of its patent examiners, something we called for during a recent Senate hearing on AI and patents. Doing so will help to ensure that deserving AI-related patents are granted, while those that would hinder further AI innovation – like patents that simply “apply AI” to basic ideas – are not. The best way to get ahead of this trend and prevent the same issues for AI innovation as we saw with early software patents is to make sure that patent examiners have a good understanding of AI technology when evaluating whether to grant a patent.

(3) **Increase patent filing and examination fees for companies like Google.** Putting in place a comprehensive technical training program on AI technology is not possible without more resources for the agency to carry out this important work. This is why we are calling for the USPTO to increase patent filing and examination fees for large companies, including Google. The agency’s fee setting process is under way right now. The USPTO should use this opportunity to make meaningful changes to its fees given their important connection to promoting patent quality and
supporting AI innovation. This is also a legislative opportunity for Congress to make sure that the USPTO has full access to the fees it receives from those applying for patents, rather than having those fees diverted elsewhere.

For years, Google has been focused on developing artificial intelligence to make our products even more helpful for everyone, and to tackle important societal challenges like diagnosing disease and mitigating climate change. We’ve long said that governments play an important role in ensuring AI is responsibly developed. In May, we published a policy agenda for AI innovation, recommending that governments focus on three key pillars – unlocking opportunity, promoting responsibility, and enhancing global security.

Patent policy has an important role to play in promoting AI innovation, as we know from Google’s decade-long emphasis on patenting our AI developments. This long runway of expertise has given us a clear sense for what is needed to promote innovation to further the progress of science and benefit the public. That starts with the USPTO: the government agency at the heart of America’s culture of innovation. With these recommendations and by moving away from the current problematic proposals, we can preserve that culture and further unlock the potential of this emerging technology.

Sincerely,

Halimah DeLaine Prado
General Counsel

cc: The Honorable Dick Durbin, Chairman, Senate Judiciary Committee
    The Honorable Lindsey Graham, Ranking Member, Senate Judiciary Committee
    The Honorable Chris Coons, Chairman, Senate Subcommittee on Intellectual Property
    The Honorable Thom Tillis, Ranking Member, Senate Subcommittee on Intellectual Property
    The Honorable Jim Jordan, Chairman, House Judiciary Committee
    The Honorable Jerrold Nadler, Ranking Member, House Judiciary Committee
    The Honorable Darrell Issa, Chairman, House Subcommittee on Courts, Intellectual Property, and the Internet
    The Honorable Henry C. “Hank” Johnson, Ranking Member, House Subcommittee on Courts, Intellectual Property, and the Internet