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## LEGAL UPDATES

# USPTO Issues Strategy Outlining the Goals for AI Usage Within Agency Operations

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Released on January 14, the United States Patent and Trademark Office's Artificial Intelligence Strategy aims to serve as a guide for the challenges and goals the agency navigates while working toward the full capabilities of AI within agency operations and in interactions with domestic stakeholders and international allies.

In the USPTO's discussion of the implementation of AI tools for patent and trademark examination, there are some critical considerations to bear in mind. While the use of AI search tools can enhance the efficiency of prior art searches, there are significant risks associated with over-reliance on these tools, particularly by both experienced and inexperienced examiners. Below is an outline of some concerns, along with recommendations to mitigate potential issues.

## Use of AI Search Tools for Prior Art

The USPTO's AI Strategy indicates that AI search tools will be used to assist examiners in finding prior art. While this can improve the efficiency and thoroughness of searches, it also introduces the risk of examiners relying too heavily on AI-assisted results and less on well-directed personal searches and common sense.

## Mitigating Risks of Over-Reliance on AI Tools

The strategy acknowledges the need to mitigate risks associated with over-dependence on AI tools. Both less- and more-experienced examiners may indiscriminately depend on AI-assisted rejections without fully understanding the facts of each case.

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## Concerns with AI Tool Usage

### Inexperienced and Experienced Examiners and AI-Assisted Rejections

A significant concern is that inexperienced as well as experienced examiners may rely on AI-assisted rejections rather than thoroughly analyzing the actual facts of each case. This could lead to unjustified rejections and increased burdens on applicants to educate examiners about their inventions.

- **Issue:** Examiners, regardless of experience, may accept AI-assisted rejections without critical evaluation.
- **Impact:** Increased likelihood of unjustified rejections and prolonged prosecution processes.

### Bias in AI Tools

AI tools are commonly biased based on the prompts given to them. For example, if an examiner asks the AI tool how to reject a case, the tool may generate a rejection regardless of whether it is warranted.

- **Issue:** AI tools may produce biased outputs based on the examiner's prompts.
- **Impact:** Potential for unwarranted rejections and inconsistent examination outcomes.

### Pressure for Faster Turnaround Times

The USPTO's demand for faster turnaround times may exacerbate the issue, causing even experienced examiners to rely more on AI tools than on their own judgment and common sense.

- **Issue:** Pressure for faster turnaround times may lead to over-reliance on AI tools even by experienced examiners.
- **Impact:** Potential decline in the quality of examination and increased reliance on AI-assisted outputs.

## Recommendations for Patent Preparation and Prosecution

### Engage Directly with Examiners

To mitigate the risks associated with AI-assisted rejections, it is crucial to engage more directly with examiners. Interaction may be achieved through telephonic interviews and other forms of direct communication to ensure that examiners fully understand the nuances of your invention.

- **Recommended Action:** Have practitioners schedule telephonic interviews with examiners to discuss the specifics of your application. This direct engagement can help clarify any misunderstandings and provide an opportunity to address potential rejections proactively.

## Provide Comprehensive and Clear Documentation

Ensure that your patent applications are thoroughly documented with clear and detailed descriptions. Such clarity includes providing comprehensive explanations of the invention, its technical contributions and practical applications.

- **Recommended Action:** Include detailed descriptions, examples and embodiments in your patent applications that may be understood by the general population. Clearly articulate the inventive step and how the invention differs from prior art.

## Next Steps for Effective Patent Prosecution

The following steps are recommended to ensure effective patent prosecution in light of the USPTO's use of AI tools:

- **Engage Proactively:** Maintain proactive communication with examiners through telephonic interviews and written correspondence.
- **Document Thoroughly:** Ensure that your patent applications are well-documented with clear, understandable and comprehensive descriptions.
- **Monitor Closely:** Monitor office actions for AI-assisted rejections and prepare detailed responses to address them.

If you have questions about the impact of the new USPTO AI Strategy on current or future patent prosecution strategy, or need any assistance navigating these changes, please contact Robert Lord or Ben King, or reach out to your regular Lathrop GPM attorney.