Ethical Use of AI: Patents

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A Practice Note exploring the ethical use, integration, and implications of generative AI (GenAI) in intellectual property (IP) law practice. It highlights the evolving role of GenAI in tasks such as patent drafting, invention harvesting, and legal research. This Note also discusses duties of disclosure under 37 C.F.R. § 1.56, the need for practitioners to perform reasonable inquiries when using GenAI tools, specialized obligations under the USPTO Rules of Professional Conduct, and best practices for integrating GenAI into IP practice, including the need for firm-wide policies, informed client consent, and careful monitoring of AI use.

AI, including **generative AI** (GenAI), is a broad term that is used (often imprecisely) to describe new-age computer technology that can simulate human intelligence. GenAI is a subset of AI that focuses on creating content, such as text, images, music, and more. GenAI, and the **large language models** (LLMs) behind it, learn patterns from datasets and generate new outputs (answers), typically responding to a user's prompt. For information on prompting considerations, see Practice Note, Generative AI Prompting Considerations for Lawyers: Overview.

These AI tools, such as ChatGPT by OpenAI, Microsoft Copilot, or Google Gemini, interact conversationally and exhibit human-like intelligence, such as learning, problem-solving, and decision-making. These tools perform using a wide range of technologies, from simple rule-based systems to complex deep-learning models to:

- Analyze data to identify patterns, draw conclusions, and predict future behavior.
- Learn from data and improve performance over time by adapting based on experience.

The legal industry has integrated various forms of AI into its operations for many years. For instance, law firms have routinely used:

- AI-driven spam filters to enhance email security.
- AI-powered banking and fraud detection systems to safeguard financial transactions.
- AI-based email rules to automate simple administrative tasks.

These examples illustrate that while GenAI tools have recently gained prominence in legal practice, it is generally not a novel phenomenon but a dynamic evolution of existing tools. Law firms continue to explore using GenAI, and many have already started using it for contract drafting and negotiation, patent drafting, invention harvesting, legal research, and more. This Note explores how and why **intellectual property** (IP) law firms are integrating GenAI into their practices.

For key legal issues in AI, see Practice Note, AI Key Legal Issues: Overview (US).

For general information on GenAI, see Practice Note, IT Basics: Generative AI and Large Language Models: Overview.

For information on how law departments use AI and other types of technology to increase efficiency, see:

- Practice Note, Using AI in Law Departments.
- Practice Note, Using Technology to Increase Law Department Efficiency.
- Standard Document, Using Generative AI Tools in the Workplace: Presentation Materials.

For a collection of AI resources across practice areas, see AI Toolkit (US).

Overview of GenAI in IP Practice

Law firm use of GenAI varies based on practice areas. They typically adopt GenAI technology to augment, but not replace, legal work performed by lawyers, including:

- Analyzing **US Patent and Trademark Office** (USPTO) Office Actions. For information on responding to office actions, see Practice Note, USPTO Patent Office Action Responses.
- Preparing draft patent applications. For information on drafting patent applications, see Practice Notes, Patent Drafting: The Specification and Patent Drafting: Preparing Formal Drawings.

- Invention harvesting. For information on harvesting, see Practice Note, Invention Disclosure Meetings: Software Inventions.
- Legal Research.
- Analyzing success on the merits of procedural and legal arguments.
- Reviewing specimens.
- Predictive analysis regarding USPTO refusals.
- Analyzing conflicts of interest. For information on conflicts of interest in patents, see Practice Note, Conflicts of Interest in Patent Practice: Overview.

For information on AI patent practice tools, see Article, Expert Q&A on Using AI Patent Prosecution Tools.

Whether in IP practice or any other field, the primary value of using GenAI lies in its ability to enhance efficiency, freeing up time for users to focus on more meaningful and high-value tasks. As GenAI tools become more integrated into workflows, the distribution of time spent on various tasks will shift accordingly.

In patent prosecution, for instance, some high-value tasks, such as interviewing inventors or drafting independent claims, can require strategic thinking, experience, and creativity. These are less amenable to automation. In contrast, lower-value tasks like adjusting figures or managing claim numbering are more repetitive and can often be automated. For information on interviewing inventors, see Practice Note, Invention Disclosure Meetings: Software Inventions. For information on claim drafting, see Practice Notes, Patent Drafting: Chemical and Pharmaceutical Claims and Patent Drafting: Claiming for Proper Interpretation in Computer-Implemented Inventions.

Given this disparity, practitioners should thoughtfully determine which tasks can be assigned to GenAI, support staff, or junior colleagues. This maximizes efficiency and ensures compliance with ethical responsibilities to clients and the USPTO.

How GenAI is Different from Other Technology

Initially, law firms discouraged (or prohibited) attorneys from using email and cloud technology due to security concerns. However, firms began permitting email use over time, provided that users followed best practices. For example, the American Bar Association (ABA) standing committee on ethics and professional responsibility addressed the protection of confidentiality of unencrypted email, stating:

> "Although earlier state bar ethics opinions on the use of Internet email tended to find a violation of the state analogues of Rule 1.6 because of the susceptibility to interception by unauthorized persons and, therefore, required express client consent to the use of email, more recent opinions reflecting lawyers' greater understanding of the technology involved approve the use of unencrypted Internet email without express client consent."

(ABA Standing Committee on Ethics and Professional Responsibility, Formal Ethics Op. 99-413.)

Today, there is a strong shift toward adopting cloud-based services, and GenAI should be viewed through a similar lens. While GenAI is not yet universally adopted, practitioners have a duty to investigate how this technology may impact their practice and clients. For example, the duty of competence requires practitioners to understand how the technology works and take steps to ensure client information is kept confidential. The extent of review and oversight may change over time, depending on how widely the technology is adopted and the client's level of sophistication.

Practitioner Oversight of GenAI

As the capabilities and reliability of GenAI improve, the range of tasks that can be automated is likely to expand. For example, when drafting an independent claim, current GenAI capabilities include searching databases for claim language used in successful patents within similar technical fields. This is beneficial for clients and enhances efficiency at the USPTO. However, this does not imply that drafting an independent claim should become fully automated by default. Instead, the practitioner's role in drafting may evolve, incorporating a new human element to the drafting process: making judgment calls on whether to use claim language generated by GenAI.

Practitioner input and oversight therefore remain essential, particularly to monitor issues such as hallucinations, deepfakes, and mistakes. For example, if a practitioner instructs GenAI to generate an **information disclosure statement** (IDS) and also directs it to factor in cost (in line with USPTO guidelines under 37 C.F.R. § 1.17(v) regarding fees for large IDSs), there is a risk that the GenAI might exclude relevant material from the IDS. This could occur due to the tool's lack of understanding or training, or because the ethical implications of excluding material to reduce costs have not been adequately instilled in the GenAI. For information on IDSs, see Practice Note, Patent Prosecution: USPTO Duty of Candor and Information Disclosure: Preparing and Filing Information Disclosure Statements and Information Disclosure Statement Checklist.

However, duties of disclosure, such as those under 37 C.F.R. § 1.56 (see Specialized Obligations in IP Practice), cannot be transferred to software or a software system. Therefore, omitting relevant material is ultimately the practitioner's responsibility (see Practice Note, Patent Prosecution: USPTO Duty of Candor and Information Disclosure: Preparing and Filing Information Disclosure Statements). Alternatively, if the practitioner did not direct the GenAI to factor in cost, the generated IDS might be prohibitively large, resulting in time spent searching through the references to determine which ones need to be included, and defeating the purpose of using the GenAI in the first place.

Using GenAI in IP practice is still an evolving paradigm. When done correctly, automating certain tasks can enable practitioners to spend less time on applications without compromising the quality of the work product. This can enhance turnover and overall efficiency, potentially leading to better client outcomes. By allocating more time to high-skill tasks, practitioners can provide greater value to their clients. However, it is crucial for practitioners using these tools to minimize the inherent risks (see Competence and Confidentiality).

Specialized Obligations in IP Practice

With recent disciplinary cases, sanctions, orders, and guidance from courts and the USPTO regarding AI (see Specific Obligations When Using GenAI Tools and Practical Guidance), practitioners should consider the implications of using GenAI, especially under the USPTO Rules of Professional Conduct (37 C.F.R. Part 11, Subpart D (37 C.F.R. §§ 11.100 to 11.901); see the USPTO's Ethics Rules, USPTO Rules of Professional Conduct webpage). On first impression, many practitioners might assume that issues associated with GenAI, such as hallucinations in legal briefs, are not particularly relevant to patent practice, especially prosecution. However, the principles of confidentiality, competence, unauthorized practice of law, supervision, and even candor and representations to a court are relevant to practice before the USPTO.

To understand the importance of USPTO guidance, it is helpful to frame how the USPTO considers itself a court or tribunal, with examiners as quasi-judicial functionaries. The term tribunal means, in relevant part:

> "[T]he Office, a court, an arbitrator in a binding arbitration proceeding or a legislative body, administrative agency or other body acting in an adjudicative capacity."

(37 C.F.R. § 11.1.)

Additionally, the Federal Register states:

> "Government employees and officers such as administrative patent judges, administrative trademark judges, patent examiners, trademark examining attorneys, and petitions examiners, perform judicial and quasi-judicial functions."

(78 Fed. Reg. 20187 (April 3, 2013).)

Practitioners have also been disciplined for undignified or discourteous conduct towards patent examiners (see In *In re Schroeder,* Proceeding No. D2014-08 (May 18, 2015)).

Duty of Candor

Anyone submitting documents to the USPTO should treat the process as equivalent to submitting them in a court and subject to the duty of candor toward tribunals under 37 C.F.R. § 11.303. For example, anyone practicing before the USPTO has a duty to perform a reasonable inquiry:

> "The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any paper by a party, whether a practitioner or non-practitioner, constitutes a certification under § 11.18(b) of this subchapter."

(37 C.F.R. § 1.4(d)(4)(i).)

Under 37 C.F.R. § 11.18(b), and like Rule 11 of Federal Rule of Civil Procedure (FRCP), practitioners have several responsibilities when submitting documents to the USPTO. They must ensure that the submission is not made for any improper purpose, legal arguments are supported by existing law, factual claims have evidentiary support, and denials of factual claims are based on evidence. As a result, practicing before the USPTO closely resembles appearing in court, often more so than other areas of legal practice, and practitioners should exercise caution in what they present or represent to the USPTO.

Reasonable Inquiry Duty

Practitioners also have a duty to perform a reasonable inquiry under the circumstances when filing documents before the USPTO (see *GS Cleantech Corp. v. Adkins Energy LLC*, 951 F.3d 1310, 1323 (Fed. Cir. 2020)). Failing to inquire when the circumstances warrant a reasonable inquiry could result in sanctions or other action, which may include:

- Striking the filing.
- Referral to the Office of Enrollment and Discipline (OED) for investigation or discipline.
- Precluding a party or practitioner from submitting a filing or presenting an issue.
- Affecting the weight given to the offending filing.
- Terminating the proceedings.

(37 C.F.R. § 11.18(c); see Practice Notes, Patent Prosecution: USPTO Duty of Candor and Information Disclosure: Compliant Patent Prosecution and USPTO Patent Prosecution Professional Responsibility: Overview: Duty of Candor and the Affirmative Duty of Disclosure and Office of Enrollment and Discipline and Practitioner Disciplinary Proceedings.)

Irrespective of the nature of the submission to the USPTO, or how it was prepared, whether by a junior associate, through the use of GenAI, or as a result of inadvertent error, practitioners bear the responsibility to review the document thoroughly before filing. The USPTO retains the authority to initiate, on its own accord, any of the actions outlined in Rule 11.18(c), provided such actions comply with the procedural safeguards of the **Administrative Procedure Act** (APA), including the requirements for notice and an opportunity to respond.

Specific Obligations When Using GenAI Tools and Practical Guidance

The USPTO Rules of Professional Conduct impose various obligations on USPTO practitioners (see Specialized Obligations in IP Practice). For information on the rules, see Practice Notes, USPTO Patent Prosecution Professional Responsibility: Overview: USPTO Registration and Rules of Professional Conduct and Conflicts of Interest in Patent Practice: Overview: USPTO Rules.

In at least some cases, the USPTO has interpreted its rules to address GenAI-related conduct. In *In re Matos,* Proceeding No. D2025-13 (March 6, 2025), the **Trademark Trial and Appeal Board** (TTAB) addressed a practitioner who filed a trial brief citing cases for holdings or statements not present in the decisions. The order stated it was:

> "[P]redicated on submitting a brief to the Trademark Trial and Appeal Board containing inaccurate citations and non-existent quotes to existing case law and citation to non-existent case law. In violation of 37 C.F.R. § 11.18, Mr. Matos failed to read case citations he found using internet searches revealing discussion of the cases on blog posts and articles before incorporating them into his brief and presenting the brief to the TTAB."

Although the disciplinary order did not explicitly state that the practitioner used GenAI in the filing, the TTAB issued a public reprimand. It also required the practitioner to complete continuing legal education on GenAI, suggesting that an internet search tool powered by GenAI had been used.

Competence

The *Matos* case highlights the importance of practitioners ensuring they are competent to provide representation. According to 37 C.F.R. § 11.101,

> "A practitioner shall provide competent representation to a client. Competent representation requires the legal, scientific, and technical knowledge, skill, thoroughness and preparation reasonably necessary for the representation."

While this definition may be open to interpretation, the level of competence necessary for the effective use of GenAI strongly suggests that a practitioner should carefully review and understand how to use and operate any GenAI tool, including how the tool works and its limitations. In other words, practitioners should assume that the competence rule requires them to perform due diligence before using or implementing GenAI (or any other technology or resource). The ABA's Standing Committee on Ethics and Professional Responsibility issued an instructive opinion supporting this interpretation, stating in part:

> "This means that lawyers should either acquire a reasonable understanding of the benefits and risks of the [GenAI] tools that they employ in their practices or draw on the expertise of others who can provide guidance about the relevant GAI tool's capabilities and limitations."

(Formal Ethics Op. 512 (Jul. 29, 2024), page 3.)

Due diligence may also require a thorough inquiry into the handling of client data. Beyond confidentiality concerns (see Confidentiality), sharing client data with a GenAI vendor or third-party contractor raises several potential issues (see Practice Note, Generative AI: Working with Legal Vendors and AI Tool Vendor Due Diligence Checklist). If the data is used for training or becomes publicly available, it could affect the **prior art** related to a client's patent application. Foreign filing license and export control issues might also arise if the vendor or third party's servers are located abroad (see Patent Prosecution: Foreign Filing License Checklist).

Practitioners planning to use GenAI should be ready to ask vendors the right questions and respond to client inquiries. They should also proactively inform clients about potential risks related to the clients' own internal use of GenAI. For information on legal issues and GenAI, see Practice Note, AI Key Legal Issues: Overview (US): Data Protection and Privacy Issues When Using AI.

To maintain competence, many practitioners must improve their proficiency with GenAI and understand key concepts such as hallucinations, alignment, and data storage. As these issues gain importance, continuing legal education (CLE) courses focused on GenAI are becoming increasingly valuable. Just as CLE requirements have evolved to include technology competence, practitioners should consider whether specialized GenAI courses, particularly those tailored for patent law, would enhance their practice.

Confidentiality

Practitioners are responsible for safeguarding client confidentiality and ensuring that anyone they supervise, whether individuals or tools, also upholds this duty (37 C.F.R. §§ 11.106 and 11.503). This includes making reasonable efforts to protect client information when using GenAI tools and supervising support staff. It is essential that the tools (GenAI or otherwise) used by practitioners safeguard client-sensitive information. In line with their obligation to maintain competence, practitioners should work to understand how GenAI tools handle confidential information, including whether such data is used to train LLMs, and be familiar with the tool's data retention and security policies.

Understanding confidentiality requires evaluating whether the practitioner's GenAI tool shares input or output data with third-party LLM providers. In these cases, practitioners should review the agreements between the GenAI tool and the LLM provider to ensure confidentiality obligations are upheld. It is common practice to request and examine these agreements when accessing the security and compliance of GenAI tools.

For information on data protection, see AI: Initial Compliance Considerations: Checklist: Data Protection, Security, and Privacy.

Specific Regulations in Intellectual Property

The USPTO issued a memorandum that expresses that the existing framework of procedural and ethics rules applies to conduct before the USPTO with respect to GenAI (see USPTO Director's Memo on the Applicability of Existing Regulations Related to the use of Artificial Intelligence (February 6, 2024)). The memo highlights existing rules at the USPTO, including the USPTO Rules of Professional Conduct and 37 C.F.R. § 11.18, and notes that these existing rules and procedures are sufficient to address the potential risks of using AI-based tools.

Practitioners, including those involved in the preparation and prosecution of a patent application, should also understand that they are subject to specialized duty of disclosure obligations due to the ex parte nature of these proceedings (37 C.F.R. §§ 1.56, 1.555(a), 1.740(a)(13), 1.765(c) and (d), and 1.933(a)). The USPTO has stated that this duty of disclosure emphasizes a duty of candor and good faith that applies to positions taken for a matter (MPEP § 2001.03; see Practice Note, Patent Prosecution: USPTO Duty of Candor and Information Disclosure: Duty of Candor and Good Faith to the USPTO).

Early adopters of GenAI in patent practice faced challenges related to the USPTO's interpretation of Rule 56 concerning using GenAI during patent prosecution. The central question was whether all the information generated by LLMs is attributed to the practitioner using the model, therefore requiring disclosure to the USPTO.

In April 2024, the USPTO issued further guidance on the use of AI-based tools that provided clarity as to GenAI and the duty of disclosure:

> "The duty of disclosure applies to the individuals identified in 37 CFR 1.56(c). This duty cannot be transferred to another person or a computer system such as an AI tool. Therefore, it is the § 1.56(c) individuals who must ensure that all material information is submitted to the USPTO. Therefore, IDSs should also be reviewed to ensure that all material information is disclosed to prevent material information from being unknowingly omitted."

(89 Fed. Reg. 25609.)

According to USPTO guidance, GenAI tools do not have an independent duty of disclosure under 37 C.F.R. § 1.56. This means that while practitioners must disclose any material information related to patentability, they cannot delegate this responsibility to a GenAI tool. Furthermore, the knowledge in an LLM that powers the GenAI tool does not automatically get imputed to the practitioner. Nevertheless, if a practitioner becomes aware of information material to patentability, even if it comes from GenAI, they must disclose it to the USPTO in an IDS. For information on duty to disclose and IDSs, see Practice Note, Patent Prosecution: USPTO Duty of Candor and Information Disclosure: Preparing and Filing Information Disclosure Statements.

The April 2024 guidance on the use of AI-based tools makes clear that the USPTO does not prohibit the use of GenAI, nor does it specifically require disclosure of the use of GenAI by practitioners in matters before the USPTO. The guidance also states that:

> "Simply relying on the accuracy of an AI tool is not a reasonable inquiry."

(89 Fed. Reg. at 26514.)

The guidance also addresses issues related to patent practice before the USPTO. For example, the USPTO reminds practitioners that the duties of candor and good faith, especially in patent prosecution, require special attention even if a practitioner uses GenAI (89 Fed. Reg. at 25611). While there does not appear to be anything extraordinary about the duty for GenAI, practitioners should be mindful of the requirement. The guidance also suggests that using GenAI may also implicate other issues, such as export control or various policies regarding the computer systems at the USPTO (89 Fed. Reg. at 25613). Practitioners should therefore keep current with USPTO guidance regarding GenAI.

Best Practices for Using GenAI

Until the USPTO provides further guidance, one of the best ways for patent practitioners and law firms to evaluate their use of GenAI effectively is by documenting their analysis of the platforms or tools they intend to utilize. This should include answering the following questions:

- Is there a firm-wide policy regarding the use of AI? For information on AI policies, see Standard Document, Generative AI Use in the Workplace Policy.
- What AI tools has the firm approved for use?
- What steps has the firm taken to understand and evaluate this technology?
- Has the firm informed clients about the use of GenAI? Is informed consent required? For information on informed consent, see Practice Note, Navigating the Complex World of Conflicts: Informed Consent.
- Is a practitioner reviewing the work product before its submission to the client or USPTO?
- How does the firm monitor compliance while maintaining client confidence?
- Who is supervising the use of AI within the firm?

Use of GenAI in Intellectual Property Litigation

Courts outside of the USPTO may also impose restrictions on AI use. For example, some courts or judges in Montana (see *Belenzon v. Paws Up Ranch, LLC*, 2023 WL 4540433 (D. Mont. Jun. 22, 2023)), Illinois (see Memorandum of Law Requirements (N.D. Ill.)), Ohio (see Standing Order Governing Civil Cases, Artificial Intelligence ("AI") Provision, (S.D. Ohio Jul. 14, 2023)), and North Carolina (see Use of Artificial Intelligence (W.D.N.C. Jun. 18, 2024)) specifically forbid practitioners from using AI in certain pleadings. Additionally, several other courts or judges require practitioners to certify their use of AI, asking them to confirm whether they used AI in their work. Practitioners should be mindful of these requirements and may need to ask clients whether AI was used in any documents submitted to the court. For an example certification, see Standard Clause, Certification Regarding Generative AI for Court Filings. For more on using GenAI in litigation, see Practice Note, Generative AI in Litigation: Overview.

As the use of AI continues to evolve, practitioners should actively monitor how peers are adopting this technology and any emerging issues. It is also likely that the USPTO will continue to provide guidance regarding practitioners' use of AI as it becomes more prevalent. For now, AI is permitted in practice before the USPTO, but practitioners must approach its use with careful planning and diligence regarding the tools they employ.

