

The Trademark

Issue 3 2024

GLOBAL REACH, LOCAL KNOWLEDGE

www.trademarklawyermagazine.com

Lawyer

Echoes of ethics: protecting voices and likeness in the era of AI



Ian DiBernardo, Partner and Chair of the Intellectual Property Litigation Practice Group, and Marcus Strong, Associate, of Brown Rudnick evaluate the infringement of voice and likeness in AI-generated works by reflecting on the recent case between Scarlett Johansson and OpenAI and the *Lovo* case.

An interview with Tencent
Page 12

UKIPO: 3-year strategy 2024 -2027
Page 17

AI-generated copyright guidelines
Page 53

Jurisdictional Briefing, US: exploring the impact of artificial intelligence on your everyday trademark practice before the USPTO

Michelle Ciotola and David Kincaid of Cantor Colburn discuss considerations of using artificial intelligence-based tools when practicing before the USPTO.

Artificial intelligence (AI) is infiltrating all aspects of our lives and is on course to impact our daily practice in the field of intellectual property law. According to the World Intellectual Property Organization (WIPO) there are approximately 80 AI initiatives in IP offices around the world, including in the United States.

Recently, the United States Patent and Trademark Office (USPTO) issued guidance on the use of artificial intelligence (AI)-based tools in practice before the USPTO (the "Guidance"). 89 Fed. Reg. 25609 (Apr. 11, 2024)¹. The Guidance informs those practicing before the USPTO of the rules and policies that apply when AI-based tools are used in proceedings before the USPTO. The Guidance also alerts such individuals of the risks associated with the use of AI and provides some suggestions for mitigating those risks. For example, the Guidance advises that practitioners must confirm that facts and statements provided in submissions to the USPTO are true and have appropriate evidentiary support. This aims to avoid submissions that contain AI-introduced errors or hallucinations.

In the case of trademarks, the Guidance cautions against submitting specimens that not show actual use: "Particular care should be taken to avoid submitting any AI-generated specimens, which do not show actual use of the trademark in commerce, or any other evidence created by AI that does not actually exist in the marketplace." (Guidance p. 25616). In an extreme case, it is



Michelle Ciotola



David Kincaid

foreseeable that an ill-intentioned party may willfully use AI to create a specimen that does not show actual use of the trademark in commerce. Such specimens do not satisfy the specimen requirements for trademark filing in the USPTO. In a less extreme case, a practitioner may submit a specimen not known to be AI-generated. For example, a company's marketing department might use AI to generate images or videos of a potential product, which include trademark markings. It is possible that these images or videos are then passed to the company's legal counsel as a "specimen" when legal counsel is preparing to file trademark applications. This could result in legal counsel submitting a trademark application with a non-conforming AI-generated specimen that does not show actual use of the trademark in commerce. It is imperative then that practitioners inquire as to the origin of specimens before submitting to the USPTO.

In addition to the Guidance provided by the USPTO and the various initiatives being considered and implemented by the USPTO and various IP offices around the world, the cautious use of AI can enhance the day-to-day practice of trademark practitioners. AI systems can be used to prepare the identification of goods and services to by practitioners in the preparation of acceptable identifications of goods and services. For example, AI systems can be used to classify goods and services according to the Nice Classification system. Through Natural Language

¹ <https://www.federalregister.gov/documents/2024/04/11/2024-07629/guidance-on-use-of-artificial-intelligence-based-tools-in-practice-before-the-united-states-patent>

Processing (NLP), AI can be used to generate acceptable identifications of goods or services, even where the products or services are more complex or novel. But caution must always be taken to ensure accuracy and relevancy of the identification generated by AI. There are nuances and strategies to preparing the identification for filing. While accurate, an overly specific and nuanced identification may result in a narrower scope of protection for the rights holder. An overly broad identification may leave the application open to refusal based on likelihood of confusion or more vulnerable to a third-party objection. An AI-generated identification of goods or services should always be treated as a draft and carefully reviewed by an experienced practitioner for accuracy and to ensure the identification aligns with the filing strategy.

The integration of AI by the USPTO and the careful use of AI tools by practitioners is already impacting the way we practice. These tools have the power to enhance the practice by streamlining the preparation process, improving accuracy, and increasing efficiency.

Contact

Cantor Colburn LLP

20 Church Street, 22nd Floor, Hartford,
CT 06103-3207 USA

Tel: +1 860 286 2929

contact@cantorcolburn.com

www.cantorcolburn.com

Résumés

Michelle Ciotola, Partner & Chair, Trademarks & Copyright Practice, Cantor Colburn

Michelle counsels clients on protecting and enforcing their trademark, trade dress, copyright, and related IP rights, including unfair competition, Internet, advertising, and promotions law. She counsels clients in developing and exploiting their trademark and copyright portfolios, including clearance; prosecution; and identifying important overseas jurisdiction and filing or coordinating with local counsel overseas. Michelle develops strategies for the enforcement of her clients' IP rights. She also develops strategies for enforcement of her clients' intellectual property rights online, including handling Uniform Domain Name Dispute Resolution Policy proceedings. Michelle attends and speaks at International Trademark Association (INTA), MARQUES, European Communities Trade Mark Association (ECTA), and the Asociacion InterAmericana de la Propiedad Intelectual (ASIPI).

Author email: mciotola@cantorcolburn.com

David Kincaid, Partner & Co-Chair, Artificial Intelligence Practice, Cantor Colburn

David concentrates on assisting clients in solving IP problems and protecting their investments in product development and has significant experience protecting inventions related to or incorporating artificial intelligence (AI), augmented reality (AR), virtual reality (VR), cloud computing, and other emerging technologies. David has prepared and prosecuted patent applications about: artificial neural network architectures and algorithms for image processing, natural language processing, and the like across various industries; reinforcement learning for autonomous driving; AR for 3D data visualization; VR user feedback systems; and cloud architecture and infrastructure management systems. David is a thought leader in the AI technology space being active in the Intellectual Property Owners Association committees on Software Related Inventions and AI & New Emerging Technologies.

Author email: dkincaid@cantorcolburn.com

