

AI Inventors—UK Court of Appeal Judgment on DABUS (Thaler v Comptroller)

IP analysis: On 21 September 2021, the UK Court of Appeal handed down its judgment on patent applications in the UK that are said to have been devised by DABUS, an artificial intelligence (AI) ‘creativity machine’ built by Dr Stephen Thaler—these are to be denied on the basis that an AI machine does not qualify as an inventor within the meaning of current UK legislation. The Court of Appeal was split in its judgment (two judges to one) and it is possible that an appeal to the Supreme Court will follow. The current UK position is broadly in line with similar litigation evolving in the US, but at odds with other territories such as Australia and South Africa. It remains to be seen how the globe will be divided on patent rights for inventions said to have been made by a machine. Written by Alex Korenberg, partner, and James Snaith, associate, at Kilburn & Strode LLP.

Thaler v Comptroller General of Patents Trade Marks and Designs [2021] EWCA Civ 1374

This analysis was first published on Lexis®PSL on 30 September 2021 and can be found [here](#) (subscription required)

What are the practical implications of this case?

The judgment confirms the existing UK position that:

- an ‘inventor’ must be a natural person, and
- inventions devised solely by a non-natural person (eg AI) cannot be granted a patent

The practical implications of this are clear—patents will not currently be granted in the UK for inventions said to be devised solely by AI.

The judgment included a dissenting opinion from Lord Justice Birss, indicating that there may be grounds to explore, should Dr Thaler chose to seek leave to appeal to the UK Supreme Court. However, it seems unlikely that patents will be granted in the UK for AI-devised inventions any time soon. Ultimately, new legislation may be needed to enable patenting of AI-devised inventions in the UK (if Parliament finds this to be desirable).

This case highlights again the need for clarity around legal protections for AI-generated inventions, as the UK launches its National AI Strategy with the stated intention ‘to build the most pro-innovation regulatory environment in the world’.

What was the background?

By way of background, two UK patent applications are at issue. The first was for an emergency warning light and the second was for a food container based on fractal geometry that improves grip and heat transfer. In respect of both, the DABUS AI reportedly had the only input in the relevant technological developments. There was said to be no person-led effort that accompanied DABUS’ input to devise the specific inventions and the output derived solely from DABUS. The legal argument does not focus on the novelty or inventiveness of DABUS’ new technologies as the application fell at a prior hurdle; failing to comply with formal requirements of a patent application. Instead, the arguments generally focus on two key issues:

- whether the AI machine (DABUS) itself qualifies as an ‘inventor’, and
- whether Dr Thaler owns the rights in any invention deriving from DABUS

Specifically, the present case turned on whether, given the statements made by Dr Thaler in the application process, the formal requirements relating to the mention of the inventor had been complied with. The patent office found this not to be the case so that the application was deemed withdrawn. This was confirmed by the High Court in *Thaler v Comptroller-General of Patents, Designs and Trade Marks* [2020] EWHC 2412 (Pat).

The main sections of the UK Patents Act 1977 (PA 1977) at issue were PA 1977, s 7 right to apply for and obtain a patent and PA 1977, s 13, concerning the mention of inventor. It was under PA 1977, s 13 that the UKIPO deemed the patent applications withdrawn in the first instance. The Comptroller considered that an inventor had to be a natural person. Since Dr Thaler had identified a non-natural person as an inventor, he had failed to identify any legally-recognised inventor within the scope of PA 1977. Moreover, since no natural person was qualifying as an inventor, there was no one to transfer rights to Dr Thaler to entitle him to apply for and obtain a patent. These positions were essentially upheld on appeal to the UK High Court.

What did the court decide?

In the split judgment, the majority of the Court of Appeal upheld the High Court decision and dismissed the appeal. The split (Lady Justice Elisabeth Laing and Lord Justice Arnold on the one hand and Birss LJ on the other) did not dispute the points set out above. All three judges agreed that an inventor must be a natural person. This logically means that:

- since DABUS is not a natural person, it cannot qualify as an inventor (within the meaning of PA 1977, s 13), and
- since the inventions were (allegedly) devised solely by DABUS, they cannot be owned and Dr Thaler is not entitled to grant of a patent for them (following PA 1977, s 7)

Instead, the split focused on a third element—does the PA 1977 provide a mechanism for denying a patent because an inventor is not a natural person and/or because there is an incorrect derivation of ownership?

Birss LJ considered that the PA 1977 requires merely that the applicant must identify who they believe is the inventor and indicate their derivation of the right to grant of a patent. This is not the same as requiring the identification of a natural person as an inventor or a legally-correct derivation of the right to grant of a patent.

Birss LJ essentially considers the role of the PA 1977 (PA 1977, s 13 in particular) as being merely to provide information to the public on who the applicant believes the inventors might be and how their rights might vest with the applicant. The role is not actually to check the legal veracity of these facts. The PA 1977, he contends, therefore is somewhat toothless in providing any mechanism to deny grant of a patent (eg for AI-devised inventions).

Birss LJ relied heavily on the history and evolution of the PA 1977 (and changes since the 1949 version as recommended by the Banks Committee in July 1970). Here, it was highlighted that many changes in the 1977 version of the Patents Act intended to relieve the Patent Office of obligations to examine submissions from the applicant regarding their PA 1977, s 13 requirements. This is satisfied as long as the applicant provides information they believe to be true.

Elisabeth Laing LJ and Arnold LJ disagreed. They considered that the PA 1977, s 13 will only be satisfied if:

- the inventor identified by the applicant is, in fact, a person, and
- the indication on derivation does represent a legally possible vesting of rights (although without an enquiry as to whether the facts support it)

The role of PA 1977, s 13 is not just to provide any information to the public. For the provisions of PA 1977, s 14 to be meaningful, it is necessary that the assertions made by the applicant could be legally correct if taken at face value and would indeed transfer the rights to the applicant if the stated facts are correct. On this basis, the patent applications should be denied (deemed withdrawn).

Case details

- Court: Court of Appeal
- Judges: Lord Justice Arnold, Lady Justice Elisabeth Laing LJ, and Lord Justice Birss
- Date of judgment: 21 September 2021