Can AI Be Considered an Inventor? USPTO, EPO Say No

Both the United States Patent & Trademark Office (USPTO) and the European Patent Office (EPO) have confirmed that patent law on both sides of the Atlantic Ocean does not permit artificial intelligence (AI) to be identified as an inventor because AI is not a “natural person” or a “legal person.” The EPO published its decision in late January 2020, and the USPTO issued its decision in late April 2020.

The EPO Case

The EPO decision involved two patent applications directed to inventions that were allegedly developed by an AI system called DABUS (Device for the Autonomous Bootstrapping of Unified Sentience). Upon filing the EPO patent applications, the applicant did not identify an inventor as required by EPO procedure, and the EPO sent the applicant invitations to correct those deficiencies. The applicant responded by stating that DABUS was the inventor. In addition, the applicant argued that (i) inventorship should not be restricted to natural persons, (ii) patent law policy allows for identifying machines as inventors as long as the inventorship criteria are
met, and (iii) an invention made by a machine should be assignable to the machine’s owner. The EPO disagreed. In its decision, the EPO explained that certain articles and rules of the European Patent Convention safeguard the inventor’s rights (e.g., Articles 60, 62, 81 EPC and Rule 19 EPC), including vesting to the inventor the initial right to a European Patent. The EPO clearly articulated that “AI systems or machines have at present no rights because they have no legal personality comparable to natural or legal persons.” A legal person, such as a corporation, is a creature of law, and because no legislative or court issued law categorizes AI as a legal person, AI cannot be an inventor. As such, the patent application was refused because the formal requirement of designation of inventorship could not be satisfied. The EPO case is currently under appeal.

The USPTO Case

Similar to the EPO case, a patent application directed to an invention allegedly invented by DABUS was filed listing DABUS as the single inventor. Moreover, a substitute statement (in lieu of an inventor declaration) was included and listed DABUS as the inventor, the applicant and the legal representative of DABUS. The USPTO sent the applicant a Notice to File Missing Parts to correct inventorship. The applicant petitioned that inventorship was correctly listed, and the USPTO dismissed the petition. The applicant subsequently requested reconsideration and the USPTO again denied the petition. In issuing its latest denial, the USPTO explained as follows:

To the extent the petitioner argues that an "inventor" could be construed to cover machines, the patent statutes preclude such a broad interpretation. Title 35 of the United States Code consistently refers to inventors as natural persons. For example, 35 U.S.C. § 101 states "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter... may obtain a patent therefore, subject to the conditions and requirements of this title" (emphasis added). "Whoever" suggests a natural person. 35 U.S.C. § 115 similarly refers to individuals and uses pronouns specific to natural persons—"himself" and "herself"—when referring to the "individual" who believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application. It further states that the inventor who executes an oath or declaration must be a "person." Other sections of Title 35 take the same approach. Therefore, interpreting "inventor" broadly to encompass machines would contradict the plain reading of the patent statutes that refer to persons and individuals.

The USPTO also relied on Federal Circuit precedent, which states that “[t]he inventors of a patent are ‘the individual or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention.’” Univ. of Utah v. Max-Planck-Gesellschaft zur Forderung der Wissenschaften e.V., 734 F.3d 1315 (Fed. Cir. 2013) (citing 35 U.S.C. § 100(f)). “[B]ecause current statutes, case law, and USPTO regulations and rules limit inventorship to natural persons, the [] application [failed to] comply with 35 U.S.C. § 115(a)” and the petition was denied.

General Comments
It appears that both the EPO and USPTO decisions are well-reasoned, since they rely on their respective laws and regulations. As such, absent a change in U.S. or European patent law that designates AI as a legal person, there is no basis on which to file a patent application for an invention, created solely by AI. The IP5, which is the forum of the five largest intellectual property offices, has discussed the topic of AI, but no consensus has been reached. Further, it is likely any recommendation by the IP5 relating to AI would also need to address patent eligibility, sufficiency of disclosure and inventive step (in addition to inventorship and ownership).

In the meantime, applicants can continue to file patent applications in both geographic regions covering inventions that are either an implementation of AI or an implementation by AI, because those inventions are likely invented by natural persons. For example, a patent application directed to how the AI system is arranged and operates or a patent application directed to the output resulting from human interaction with the AI system may fall into these categories. Furthermore, applicants may consider including support for inventions created solely by AI when drafting AI applications, with the hope that the legislatures codify changes to the patent laws to catch up with technological advancements, particularly in view of the increasing number of AI related patent applications being filed.

© 2020 Faegre Drinker Biddle & Reath LLP. All Rights Reserved.

Source URL: https://www.natlawreview.com/article/can-ai-be-considered-inventor-uspto-epo-say-no