

Esin DigiDiary

Monthly tech litigation digest:

AI machines cannot be an inventor according to UK Court of Appeal

UK Court of Appeal ("**Court**") evaluated whether an AI machine can be an inventor with its decision *Thaler v Comptroller General of Patents Trade Marks and Designs* [2021] EWCA Civ 1374 ("**Decision**"). In the Decision, the Court decided that an inventor must be a "person" and AI machines cannot be inventors. The Decision is available [here](#).

Background information

Dr. Thaler is the creator of the AI machine DABUS. The AI machine DABUS has created two inventions called "Food Container" and "Devices and Methods for Attracting Enhanced Attention."

Dr. Thaler filed two patent applications to the UK Intellectual Property Office (UK IPO) for these inventions. Similar applications were made by Dr. Thaler in the US, Europe and Australia as well. In both of the patent applications, Dr. Thaler indicated DABUS as the inventor and stated that he had the right to be granted a patent due to his ownership of the creativity machine DABUS.

As stated, it is undisputed that Dr. Thaler is the owner and creator of DABUS and that he produced DABUS to make inventions. The UK IPO evaluated the application based on 1977 Act ("**Act**") and pointed out that a person must be identified as an inventor and the applicant must indicate how they derive their rights from that person. Accordingly, the UK IPO deemed the applications withdrawn.

Evaluation of the Court

The Court evaluated in its decision whether (i) the Act requires an inventor to be a person and (ii) Dr. Thaler is entitled to file a patent application for an invention that is created by an AI. The evaluations of the Court were mainly based on the Section 7 and Section 13 of the Act. Section 7 of the Act regulates the right to apply for and obtain a patent and Section 13 of the Act stipulates how an inventor is mentioned.

All the judges of the Court were in consensus that the Act requires an inventor to be a person. Judge Birss took into account several provisions of the Act and stated that the "rest of the 1977 Act is drafted on the footing that the inventor is a person." Accordingly, he decided that an inventor is the person who devised the invention within the scope of the Act. He further pointed out that machines are not persons and even though they can create inventions now does not define them as inventors within the meaning of the Act. Judge Arnold supported this argument by stating that the systematic interpretation of the Act only allows a person to be an inventor.

As for the evaluation of whether Dr. Thaler is entitled to file a patent application for the AI's invention, the judges of the Court shared different point of views. Judge Arnold and Judge Laing argued that a person is not entitled to file a patent application for an invention created by a machine. Both judges stated that as per Article 13/2(a) of the Act, the applicant must specify

a person as the inventor. Judge Arnold further stated that there is no rule of law that allows the owner of a tangible property to own the intangible property created by that tangible property. Accordingly, as Dr. Thaler failed to indicate how he derived that right from the AI machine and only based his claim to his ownership of the DABUS, such justification was not acceptable according to Judge Arnold and Judge Laing.

On the other hand, Judge Birss held a different approach on the matter. Judge Birss argued that it is sufficient to specify the person the applicant deems as the inventor in order to comply with the requirements under Article 13/2(a) and (b). Thus, according to Judge Birss, the honest approach of Dr. Thaler was enough for him to make the application and bona fide errors while identifying the inventor did not infringe his application. Accordingly, Judge Birss concluded his arguments with the following: "The fact that the creator of the inventions in this case was a machine is no impediment to patents being granted to this applicant."

Status in other jurisdictions

The status of the inventions of DABUS have been also evaluated in different jurisdictions. The applications were rejected in the EU and US as well, as both did not allow an AI machine to be an inventor. However, the Federal Court of Australia approved the case of Dr. Thaler and granted patent to an invention created by an AI machine, holding that an AI machine can be an inventor but cannot be an applicant nor grantee of a patent. The South African Patent Journal also granted a patent to an application of Dr. Thaler.

The question of who will own the invention made by AI has been attempted to be resolved according to the traditional regulations. Although the dominant view for the time being is that AI cannot be an inventor, when the different evaluations of the countries are taken into account, it can be said that there is no common view yet. These decisions may be subject to change when the effects of their results are better observed.

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