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U.S. Patent Act takes on AI invention

Welcome to the Intellectual Property News Challenge, where we pose a question and you guess the answer.

Question: Can an artificial intelligence machine be an inventor under the U.S. Patent Act?

Discussion: Stephen Thaler, Ph.D., owns a “Device for the Autonomous Bootstrapping of Unified Sentience” (DABUS). Thaler identifies DABUS as an artificial intelligence (AI) machine. He listed DABUS as the inventor on two patent applications, one for a light beacon and one for a beverage container. The applications included a document through which DABUS had allegedly assigned all intellectual property rights in the inventions to Thaler.

The USPTO issued a “Notice to File Missing Parts”: the identification of a human inventor. Thaler filed a petition seeking to vacate. The USPTO dismissed the petition, explaining that only a natural person can be an inventor. Thaler’s request for reconsideration was denied, and he brought suit against the USPTO in federal district court.

In ruling on cross-motions for summary judgment, the district court judge focused on the statutory definitions of “inventor” and “joint in-



IP NEWS CHALLENGE

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inventor” in the Patent Act. The act defines them as “individuals.” So the question was whether AI is an individual.

Looking to the Supreme Court’s interpretation of “individual” in another statute, as well as dictionary definitions, the court found that “inventor” must mean “natural person.”

This was reinforced by the Patent Act’s use of personal pronouns such as ‘himself or herself’ in connection with the word “individual.”

The court also looked at two Federal Circuit decisions

that discussed who could be an inventor. In *Univ. of Utah v. Max-Planck-Gesellschaft*, No. 12-1540 (Fed. Cir. 2013), the court held a state could not be an inventor. In *Beech Aircraft Corp. v. EDO Corp.*, 990 F.2d 1237 (Fed. Cir. 1993), the court held a corporation could not be an inventor.

Thaler also made policy arguments about why AI should be considered an inventor. The court rejected those arguments, saying there may come a time when AI can be an inventor, but it is up to Congress to make that change.

Answer: An AI machine cannot be an inventor under US Patent law. The court granted the USPTO’s motion for summary judgment affirming the USPTO’s refusal to issue the patent and denied Stephen’s motion for summary judgment.

Case Cite: *Thaler v. Hirshfeld*, No. 1:20-cv-903 (E.D. Va. Sep. 2, 2021).

Sur-Reply: Thaler also filed patent applications on behalf of DABUS in Australia, South Africa and the United Kingdom. Australia and South Africa accepted the applications. The U.K. did not. The United Kingdom Court of Appeals suggested a way around the problem would be to identify the inventor as the individual who used a machine to create an invention.