

# Kluwer Patent Blog

## Patenting AI inventions in the UK

Nick Michelmore, Katie Cambrook (Bristows) · Tuesday, September 28th, 2021

Can an artificial intelligence (“AI”) machine be an inventor and can the machine’s owner apply for a patent? These were two of the key questions which the Court of Appeal grappled with in *Thaler v Comptroller General of Patents* [2021] EWCA Civ 1374. The Court, by a 2-1 majority, answered both these questions, as well a third question, in the negative. The result was that the appeal was dismissed. The appeal, however, leaves unanswered question as to whether the UK law, in its current state, is fit for purpose when it comes to protecting AI inventions.

### Background

Dr Thaler is the owner of an AI machine called DABUS which was said to have devised two inventions. Dr Thaler sought patents for these two inventions in his name. He submitted a statement to the UK IPO that named DABUS as the inventor and which claimed he was entitled to apply for the patents on the basis that inventions devised by a machine should be assigned to its owner.

Dr Thaler’s applications were rejected by the UK IPO on the basis that only a natural person, not a machine, could be an inventor. DABUS could therefore not own anything capable of transfer (or if it did own rights, it had no power to transfer them) and so Dr Thaler did not show that he was entitled to apply for a patent. As such, the patent applications were taken as withdrawn. On appeal to the High Court, Mr Justice Marcus Smith essentially agreed with the UK IPO that only a natural person can be an inventor of a patent within the meaning of the Patents Act and dismissed the appeal. Dr Thaler appealed this decision to the Court of Appeal.

Despite rejecting the appeal, Mr Justice Marcus Smith commented that “*the owner of a thing is the owner of the fruits of that thing*” and as such a person who owns an AI machine that devises an invention may be the owner of an invention. This part of the reasoning formed the basis of a Respondent’s notice by the Comptroller in the Court of Appeal. The Comptroller sought clarity that there was no rule in this regard in relation to intangible property such as patents.

This case requires an interpretation of the UK Patents Act 1977. The two sections are s7 and s13 of that Act. For information, these are set out below.

### Section 7:

- Any person may make an application for a patent either alone or jointly with another.
- A patent for an invention may be granted –

- primarily to the inventor or joint inventors;
- in preference to the foregoing, to any person or persons who, by virtue of any enactment or rule of law, or any foreign law or treaty or international convention, or by virtue of an enforceable term of any agreement entered into with the inventor before the making of the invention, was or were at the time of the making of the invention entitled to the whole of the property in it (other than equitable interests) in the United Kingdom;
- in any event, to the successor or successors in title of any person or persons mentioned in paragraph (a) or (b) above or any person so mentioned and the successor or successors in title of another person so mentioned;

and to no other person.

- In this Act “inventor” in relation to an invention means the actual deviser of the invention and “joint inventor” shall be construed accordingly.
- Except so far as the contrary is established, a person who makes an application for a patent shall be taken to be the person who is entitled under subsection (2) above to be granted a patent and two or more persons who make such an application jointly shall be taken to be the persons so entitled.

### Section 13:

- The inventor or joint inventors of an invention shall have a right to be mentioned as such in any patent granted for the invention and shall also have a right to be so mentioned if possible in any published application for a patent for the invention and, if not so mentioned, a right to be so mentioned in accordance with rules in a prescribed document.
- Unless he has already given the Patent Office the information hereinafter mentioned, an applicant for a patent shall within the prescribed period file with the Patent Office a statement –

(a) identifying the person or persons whom he believes to be the inventor or inventors; and

(b) where the applicant is not the sole inventor or the applicants are not the joint inventors, indicating the derivation of his or their right to be granted the patent;

and, if he fails to do so, the application shall be taken to be withdrawn.

- Where a person has been mentioned as sole or joint inventor in pursuance of this section, any other person who alleges that the former ought not to have been so mentioned may at any time apply to the comptroller for a certificate to that effect, and the comptroller may issue such a certificate; and if he does so, he shall accordingly rectify any undistributed copies of the patent and of any documents prescribed for the purposes of subsection (1) above.

### **The Court of Appeal’s decision**

As mentioned above the decision was a 2-1 majority decision. Lord Justice Birss and Lord Justice Arnold coming to opposing views, with Lord Justice Birss holding he would have allowed the appeal and Lord Justice Arnold holding the appeal should be dismissed. However, they agreed on several aspects of the law and its application but reached fundamentally different conclusions on one key aspect. The appeal, as the case before the High Court had, focused on s13 and s7 of the Patents Act and the 3 essential questions:

1. Can DABUS be an inventor within the meaning of the Patents Act 1977?
2. Can Dr Thaler apply for patents in respect of DABUS' inventions?
3. Was the UK IPO right to consider the applications were withdrawn under s 13 of the Patents Act?

On the first of these questions, all three judges were in agreement. DABUS cannot be an inventor within the meaning of the Patents Act. Only a person can be an inventor.

On the second question, Lord Justice Birss and Lord Justice Arnold agreed as to some of boundaries of s13 of the Patents Act. In particular, they agreed that in making a statement under s13(2) of the Act, an applicant need only indicate who they believe to be the inventor and an application for a patent will not be rejected for unknown errors. Further, they agreed that the UK IPO is not required to take a substantive review of the accuracy of any s13 statement. However, this is where the agreement ended. Lord Justice Birss considered that given Dr Thaler had submitted a statement to the UK IPO identifying to the best of his belief who the inventor was and how he himself came to be entitled to apply for the invention he was entitled to the applications and therefore, on considering question 3, the applications should not have been withdrawn. For Lord Justice Birss, the mere fact the information provided by Dr Thaler to the UK IPO was honest and could provide the public with enough information to clearly understand who was the inventor and who was applicant of the patents was sufficient to allow the applications to proceed. Nothing more was required as this enabled someone who considered they may be more entitled to the rights under the patent to lodge a challenge to the ownership. It was not lost on Lord Justice Birss though that given only a person who claims to have the rights to the invention can make such a challenge it may never be possible to test this.

Lord Justice Arnold and Lady Justice Laing, however, considered that while a substantive review of the accuracy of any submission of information under s13(2) is not necessary that is quite different to allowing a statement to pass which is clearly not accurate on its face. As Dr Thaler did not identify a person as the inventor in the information he supplied to the UK IPO under s13(2)(a) Patents Act it was an exercise of looking at the document at face value and knowing it would not meet the requirements of the Act. In addition, Lord Justice Arnold considered there was no rule of law which meant that Dr Thaler owned the rights in the invention simply because he owned DABUS. Dr Thaler had argued he was entitled to make the applications as he was entitled to "the whole of the property" in them. He considered this to be the case based on a UK common law doctrine of accession, which effectively holds where tangible property is owned by a person new tangible property arising from it will be owned by the same person. However, Lord Justice Arnold held that this rule did not hold good for intangible property and the example of a person A taking a photo on person B's digital camera was given. In that instance person A would own the copyright in the photo (if any existed) and not B. Lord Justice Arnold considered that Dr Thaler's reliance on this doctrine was an argument about where the law should be and not where it currently is. Dr Thaler did therefore not have the right to apply for patents in relation to inventions devised by DABUS. Given this, the UK IPO were therefore right to consider the applications withdrawn. Lord Justice Arnold considered this gives effect to the statutory provisions already in place and does not introduce any new ground for refusing patent applications.

## Comments

Given the diverging views from two of the bench's leading patent judges it is clear to see this is an important area of law which is unsettled in the UK. The decisions from the UK also diverge from

those in other countries. In July this year [South Africa](#) granted the world's first patent which named an artificial intelligence machine (DABUS) as the inventor and the [Australian Federal Court](#) recently held that AI systems can indeed be inventors under Australian patent law ([discussed in this post](#)). These decisions were referred to by the Court of Appeal but the Court did not consider either of them of importance to this case given it was about interpretation of the UK law as it stands.

Dr Thaler may seek to appeal his case to the Supreme Court. However, this would be a third appeal and the question remains as whether such an appeal would afford him, and other AI inventors, the certainty needed. As was pointed out by Lord Justice Arnold, and the other judges, several arguments in the case were geared toward a statement of what the law should be and not what it is. The judges can only work within the confines of the statute as it stands.

The UK Government consulted on AI and IP last year and published its findings earlier this year. That call for views highlighted a need to look further at protecting AI inventions and a further consultation is planned for later this year which promises to look at policy options including legislative change. Watch this space for developments in area of AI and IP in the UK.

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