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The End of the Road for DABUS and Dr Thaler at the UK Supreme Court

Eden Winlow (Bristows) · Tuesday, January 16th, 2024

On 20 December 2023, the UK Supreme Court handed down its highly anticipated judgment in the case of *Thaler v Comptroller-General of Patents, Designs and Trademarks* [2023] UKSC 49, unanimously ruling that only a natural person can be named as an inventor on a patent application. In doing so, the Supreme Court upheld the decisions of the lower courts.

This case concerns two patent applications filed in 2018 by Dr Thaler at the UKIPO, where he asserted that the inventions were created by an AI machine called DABUS without the involvement of a human inventor. The request for grant forms that accompanied the applications explicitly stated that Dr Thaler was not an inventor. After filing, Dr Thaler was notified that he would need to file a statement of inventorship and an indication of the derivation of his right to the grant of the patents within 16 months of the filing date of the applications under section 13(2) of the UK Patents Act 1977 (the “1977 Act”) and rule 10(3) of the Patent Rules 2007. Dr Thaler responded by stating that the inventor was DABUS, acting autonomously and powered by AI, and that he acquired the right to the grant of the patents because he owned DABUS.

The case then proceeded to a hearing at Dr Thaler’s request, at which he argued that the information he had provided met the requirements of the 1977 Act and the Rules. On 4 December 2019, the Hearing Officer issued a decision that DABUS could not be regarded as an inventor under the 1977 Act, and further, that Dr Thaler was not entitled to apply for the patents simply because he owned DABUS. The decision also indicated that the applications would be deemed withdrawn at the expiry of the sixteen-month period specified by rule 10(3) of the Rules for filing the statement of inventorship.

Dr Thaler’s appeal against the Comptroller’s decision and order was dismissed in the High Court and by a majority in the Court of Appeal (as reported in last year’s review). Dr Thaler then appealed to the Supreme Court.

The Supreme Court unanimously dismissed the appeal. It held that the Comptroller was right to find that the applications would be taken to be withdrawn at the expiry of the sixteen-month period in rule 10(3) of the Rules.

The Court emphasised that the appeal was not concerned with the broader question of whether technical advances generated by machines acting autonomously and powered by AI should be patentable. Rather, it deals with the interpretation and application of the relevant provisions of the

1977 Act. Dr Thaler had made clear that he is not an inventor; that the inventions were made by DABUS and that his right to the grant of patents for those inventions arises from his ownership of DABUS. Therefore, the outcome of the appeal turned on three issues:

1. The scope and meaning of the term “inventor” in the 1977 Act.

The first issue concerned whether the term “inventor” in the 1977 Act extends to a machine such as DABUS under sections 7 and 13 of the 1977 Act. The Supreme Court held that an inventor under the 1977 Act must be a natural person. Although the law does not directly state that the inventor must be a human, the Court relied on multiple statutory provisions to conclude an inventor must be a natural person and cannot be an AI system like DABUS.

Specifically, section 7(3) defines inventor as “*the actual deviser of the invention.*” As Lord Kitchin stated, “*‘deviser’ here has nothing other than its ordinary meaning, that is to say, a person who devises a new and non-obvious product or process.*” Furthermore, he noted section 7(2)’s hierarchy granting patent rights are “*necessarily references to an invention devised by a person*” and contemplates legal entities like corporations claiming through a human inventor. He noted that Section 13(1), which guarantees the inventor’s right to be mentioned, also demonstrates “*the Act contemplates that the inventor is a natural person.*” and so contains no suggestion that an inventor may be a machine.

In the circumstances, the Court found that the Comptroller was right to decide that DABUS is not and was not the inventor of any new product or process described in the applications. Further, it is not and never was an “inventor” under section 7 or section 13 of the 1977 Act.

2. Whether Dr Thaler nevertheless was the owner of any invention made by DABUS and entitled to apply for and obtain a patent in respect of it

Dr Thaler argued that he was nevertheless entitled to file applications for and obtain the grant of patents for the invention due to his ownership of DABUS. He contended that as the owner of DABUS and by analogy with or upon application of the doctrine of accession, he derived the right to apply for and be granted patents for the inventions described in the applications.

The court rejected these arguments and found that under the Act, non-inventors only have derivative rights that have an original source, claimed through a qualifying human inventor under sections 7(2)(b) or (c). As Lord Kitchin stated, Dr. Thaler “*has not identified any basis in law on which he acquired such a right through his ownership of DABUS.*” Thaler’s reliance on the accession doctrine fails because “*[w]e are not concerned here with a new item of tangible property produced by an existing item of tangible property.*” Simply owning an invention-generating machine does not confer legal rights in the machine’s creations absent some other recognized legal principle. Further, DABUS is not even a legal person (such as a corporation) and therefore cannot transfer rights. “*It is not a person, let alone a natural person and it did not devise any relevant invention.*”

3. Whether the Hearing Officer entitled to hold that the applications would be taken to be withdrawn

The Court found that the Hearing Officer was entitled to hold that Dr Thaler did not satisfy either of the requirements in section 13(2) of the 1977 Act: he failed to identify any person(s) whom he believed to be the inventor or inventors of the inventions described in the applications and his

ownership of DABUS did not provide a proper basis for accepting his claim to be entitled to the grant of the patents for which he had applied.

The Comptroller was therefore right to find the applications would be taken to be withdrawn at the expiry of the sixteen-month period specified by rule 10(3) of the Rules.

Policy

This decision raises some difficult questions as to the current state of UK patent law, which some say puts the UK at a disadvantage in relation to supporting industries that use AI in the generation of new technologies. Advances in AI technology are increasingly giving rise to works or inventions generated largely through automatic means, sparking discussions on the nature of authorship and inventorship, and challenging traditional legal concepts and definitions. In a worst case scenario, the decision could mean that inventions that are wholly devised by AI systems in the future cannot be protected by patents in the UK. This could be an imaginable scenario, given the rapid advances we are seeing in the field of AI.

Such a scenario would be at odds with the stated aim of the UK government to make “*the UK a global centre for the development, commercialisation and adoption of responsible AI*”, in the hope of “*securing the UK’s position among the global AI superpowers.*”^[1] However, as noted above, the Court emphasised that this case was not concerned with the broader question whether technical advances generated by machines acting autonomously and powered by AI should be patentable, it was limited to the meaning of the 1977 Act and Rules. Clearly, legislation drafted almost five decades ago did not anticipate the situation we are seeing today with AI inventions and, as reflected in the statement of Elisabeth Laing LJ in the Court of Appeal decision, “*Whether or not thinking machines were capable of devising inventions in 1977, it is clear to me that that Parliament did not have them in mind when enacting this scheme. If patents are to be granted in respect of inventions made by machines, the 1977 Act will have to be amended.*” . This was also reflected in the original decision rejecting the application, in which the hearing officer commented that whilst the current law may not be suitable for inventions devised autonomously by AI systems, it was not the IPO’s role to modify the law, only to apply it.

The UKIPO has also picked up on these issues, stating “*There is no evidence that UK patent law is currently inappropriate to protect inventions made using AI. We are also sensitive to concerns that unilateral change now, risks being counterproductive. So, we will advance international discussion so that inventions devised by AI are appropriately protected in the future.*” and further emphasised that “*we are concerned that the recent publicity about naming an AI system as an inventor risks the incorrect conclusion that UK patent law does not protect AI-assisted inventions. A patent may in fact be granted for an AI-assisted invention provided the application satisfies the legal requirements set out in the UK Patents Act 1977.*”^[1]

Whilst a public consultation has been held in the UK, resulting in no immediate recommendations for changes in the current patent legislation, with these interesting policy issues seemingly unresolved and the continued advancement of AI, we expect this will not be the last we hear on this topic.

Other jurisdictions

This case is part of a project involving parallel applications by Dr Thaler to patent offices around the world, intended to challenge the limits of patent law in relation to the rapid advances we are

seeing in the field of Artificial Intelligence. As noted by Birss LJ in the Court of Appeal decision, “*There is more than a hint in this case of the idea that if only Dr Thaler was not such an obsessive and, instead of calling DABUS the inventor, he named himself and then none of these problems would arise. However, since inventors can waive their right to be mentioned under s24(3), even if the Comptroller suspects that Dr Thaler is really the inventor, Dr Thaler has clearly waived whatever right he may have had to be mentioned and that should be the end of that.*”

So far, the UK is the only country in which a DABUS case has reached the highest judicial instance. A similar decision was reached in the United States by the Federal Circuit Court of Appeals in *Thaler v Vidal* 43 F.4th 1207 (2022), where it was ruled that Section 271 of the Patent Act requires that an inventor be a human being; permission to appeal to the Supreme Court was denied *Thaler v. Vidal* (No. 22-919). The European Patent Office reached the same conclusion in J 0008/20 (Designation of inventor/DABUS) of 21.12.2021, as did Australia’s Full Court in *Commissioner of Patents v Thaler ?* [2022] FCAFC 62. Germany, Israel, New Zealand, Taiwan and South Korea have made similar findings.

At the time of writing, Saudi Arabia and South Africa are the only jurisdictions to have accepted applications from Thaler that identify DABUS alone as the creator of the inventions. However, it should be noted that the patent office in South Africa only checks for basic formal requirements. South Africa’s Patent Act 1978 provides several grounds for patent revocation and it remains to be seen whether Thaler’s patent will be challenged.

A copy of the judgment can be found [here](#).

[1] [68] of 29 October 2021 Government response to the open consultation on Artificial Intelligence and IP: copyright and patents.

[1] Introduction to the 29 October 2021 Government response to the open consultation on Artificial Intelligence and IP: copyright and patents.

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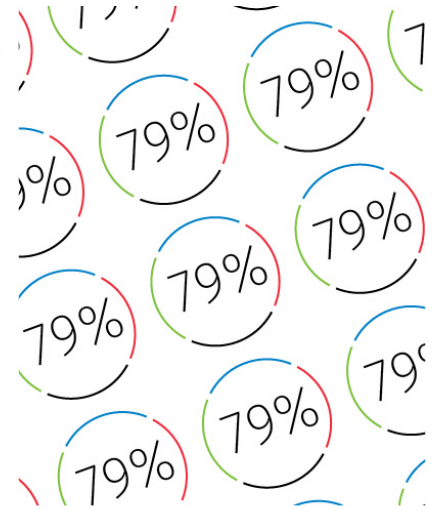
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