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Publication

05.04.20

Client Alert: Does Artificial Intelligence Dream of Patent Applications?

The United States Patent and Trademark Office ("USPTO") recently held that machines may not be named as inventors on a U.S. patent application, and affirmed that patent application inventorship is limited to only natural persons.

In 2005, physicist Stephen L. Thaler created a patented artificial intelligence system and a "creativity machine" programmed as a series of neural networks known as the Device for Autonomous Bootstrapping of Unified Sentience ("DABUS"). Through a first system of networks, DABUS generates new ideas. A second system of networks then evaluates the consequences of those ideas. Following the creation of DABUS, Thaler filed U.S. Patent Application 16/524,350 ("the '350 Application"), titled "Devices and Methods for Attracting Enhanced Attention" and naming DABUS as the sole inventor. According to Thaler, DABUS was not created to solve any particular problem and DABUS recognized the novelty of the invention described in the '350 Application.

The USPTO objected to the '350 Application for failing to "identify each inventor by his or her legal name," and Applicant petitioned for the objection to be vacated as unwarranted and/or void.

In denying the Applicant's petition, the USPTO found that inventors could not be machines because, under the patent statutes, the term "inventors" is interpreted as

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meaning natural persons. In its analysis, the USPTO emphasized the word "whoever" in 35 U.S.C. § 101 and cited Merriam-Webster's Dictionary to support the word "whoever" applying to natural persons. The USPTO also cited to 35 U.S.C. § 115(b), which uses the personal pronouns "himself" or "herself" to refer to inventors, to support this proposition. As a result, the USPTO found the plain meaning of the patent statutes applies to people, not machines.

Next turning to various Federal Circuit decisions (albeit in the context of states and corporations being incapable of qualifying as inventors), the USPTO discussed conception, which is "the touchstone of inventorship," and "a mental act."[1] With this in mind, the USPTO found that machines, similar to states and corporations, are not capable of performing the mental act of conception. The USPTO thus held that "only natural persons can be inventors,"[2] and found that the application did not comply with 35 U.S.C. 115(a), which requires the inventor's name to be included in the application.

The USPTO also rejected Applicant's argument that since the USPTO granted patents related to DABUS itself, it had therefore implicitly legalized the process DABUS used to create the invention. The USPTO reasoned that just because a machine can be patented[3] does not mean a machine can be the inventor in another patent application. For example, while a patent can be obtained for a camera, the camera itself cannot own copyrights for the photos it takes.

The attorneys for the '350 Application indicated that they plan to appeal this ruling. The Federal Circuit has recently made it clear that it is not bound by the USPTO's guidance and will apply only its own law and the relevant Supreme Court precedent.[4] For the time being,

however, inventorship of patent applications remains limited to natural people.

Therefore, while artificial intelligence is still in its relatively early stage, and additional issues are certain to arise regarding artificial intelligence's role in obtaining U.S. patents, for the time being natural person inventors who utilize artificial intelligence in the creation of their inventions should file any corresponding patent applications in their own names.

If you have any questions regarding how artificial intelligence interfaces with patent inventorship or other intellectual property issues, please contact Holby Abern, Kenneth Matuszewski or your Neal Gerber Eisenberg attorney.

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[1] *Univ. of Utah v. Max-Planck-Gesellschaft zur Forderung der Wissenschaften e.V.*, 734 F.3d 1315 (Fed. Cir. 2013) (quoting *Burroughs Wellcome Co. v. Barr Labs, Inc.*, 40 F.3d 1223, 1227-28 (Fed. Cir. 1994)).

[2] *Beech Aircraft Corp. v. EDO Corp.*, 990 F.2d 1237, 1248 (Fed. Cir. 1993).

[3] 35 U.S.C. § 151.

[4] *In re Rudy*, 19-2301, 5-6 (Fed. Cir. Apr. 24, 2020)