



Tech Tuesdays

With Musa.

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CAN AN ARTIFICIAL INTELLIGENCE MACHINE OWN THE RIGHTS TO AN INVENTION?

- ✓ The scope & meaning of the term "Inventor" in the Patents Act of 1977
- ✓ 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.

Just before Christmas last year, the UK Supreme Court made quite the groundbreaking finding on the question of whether an artificial intelligence machine could be named as an inventor and consequently enjoy patent rights.

The case of **Thaler v Comptroller General of Patents, Designs and Trademarks [2023] UKSC 49** concerns two patent applications filed in 2018 by Dr Thaler at the UK Intellectual Property Office (UKIPO) where he claimed that the inventions

were created by an AI machine called DABUS, acting autonomously and powered by AI. He argued that as the owner of DABUS, he had the right to the grant of the patents.

The UKIPO issued a decision that DABUS could not be regarded as an inventor and that Dr. Thaler was not entitled to apply for the patents simply because he owned DABUS. The decision further stated that the applications would be deemed withdrawn within 16 months. Dr Thaler's appeals to the High Court and Court of Appeal were unsuccessful, hence the appeal to the Supreme Court.

At the Supreme Court, the outcome of the appeal turned on **2 main issues:**

1. The scope and meaning of the term "inventor" in the Patents Act of 1977.

The first issue was whether the term "inventor" in the 1977 Act encompasses a system like DABUS, as per sections 7 and 13 of the Act. The Supreme Court clarified that, according to the 1977 Act, an inventor must be a natural person. Although the law does not directly state that the inventor must be a human, the Court relied on several authorities to conclude that an inventor must be a natural person and cannot be an AI system like DABUS. One such authority was the earlier case of *Yeda Research v Rhone Poulenc Rorer [2007] UKHL 43*, where Lord Hoffman held that an inventor as defined in the Act is the natural person who came up with the inventive concept.

In the circumstances, the Supreme Court found that DABUS was not the inventor of any new product or processes described in the patent applications and consequently, not an inventor for purposes of sections 7 and 13 of the Act.



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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 as the owner of DABUS, he was entitled to apply for and obtain a patent under the property law doctrine of accession. The Court dismissed these contentions and determined that, according to the Act, individuals who are not inventors possess only derivative rights that trace back to an original source, asserted through a qualifying human inventor under sections 7(2)(b) or (c).

The court found that simply owning an invention-generating machine does not confer legal rights in the machine's creations absent some other recognized legal principle. Further, DABUS was not even a legal person (such as a corporation) and therefore could not transfer rights.

Takeaway

The question of whether an AI machine can own patent rights is, insofar as this case is concerned, yet to be determined. The Court emphasised that this 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 confined itself to the interpretation and application of the relevant provisions of the 1977 Act.

In Botswana, a similar provision would be Section 11 of the Industrial Property Act. Should a similar issue arise in Botswana, we opine a similar conclusion would be reached. However, it is yet to be legally tested whether an Artificial Intelligence Machine can own any Rights to an invention and for such exploration, GLP is your go-to legal team.

If you have interest in an in-depth discussion on this subject matter or any AI or Intellectual Property issues, feel free to contact us at

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