

Newsalert

IP, TMT and Data Protection Department

EPO refuses to recognise an AI as inventor of a patent application

On January 27th, 2020, the European Patent Office (EPO) provided the grounds for rejection of two European patent applications, (respectively no. 18275174 and no. 18275163), in which the inventor's field was filled by the applicants with indication of an artificial intelligence, named "DABUS". The EPO stated that, under current patent law, the inventor designated must be a human being, not a machine.

According to Article 81 and Rule 19 of the EPC (European Patent Convention), a patent application shall contain the designation of the inventor, which shall specify, *inter alia*, the family name, given names and full address of the inventor. Moreover, if the applicant is not the inventor, the patent application should contain a statement indicating the origin of the right to the European patent.

Given that both technologies underlying the patent applications at issue were conceived by DABUS, a generative machine intelligence, the applicant filed the patents indicating DABUS as the inventor. According to the argumentations of the applicant, patent law requires to indicate the actual deviser of the invention and that accepting an AI system as inventor "*would be in line with the function of patent law to incentivise innovation and to disclose inventions to the public*". Moreover, the applicant asserted to be the "employer" of the AI machine, and, consequently, to be the assignee of any IPR created by DABUS, also acquiring the right to the European patent.

As DABUS' designation as inventor does not meet the EPC requirements, EPO did not agree with the arguments of the applicant for the following reasons:

- Under EPC's legal framework and case law, the inventor is granted various rights and rights can be recognised only to persons that have legal personality and, to present date, only natural and legal persons have. Moreover, the inventor of an EU patent must be a natural person. It follows that, since at present AI machines do not have legal personality comparable to natural persons, they cannot be recognised any rights, including the right to be indicated as the inventor.
- The understanding that the inventor is a natural person appears to be an internationally applicable standard. National courts of various countries have issued decisions to that effect, as well as the patent offices of China, Japan, Chorea and USA have followed this approach. No national law has been determined which would recognize a thing, in particular an AI system or a machine, as an inventor.
- The applicant cannot acquire the right to EU patent from DABUS. The designation of an inventor bears certain legal consequences and, since AI systems do not have legal personality, they cannot exercise any rights, neither be employed, nor own any invention and transfer any rights related thereto.

The refusal decisions issued by EPO can be appealed by the applicant within two months from the notification of the first instance decisions before the Board of Appeal. Such decisions are remarkable since are the first of EPO regarding patent applications where an AI has been indicated as the inventor and it will be interesting to follow the evolutions of the matter.

Below are the links to the decisions at issue:

- <https://register.epo.org/application?documentId=E4B63SD62191498&number=EP18275163&lng=en&npl=false>
- <https://register.epo.org/application?documentId=E4B63OBI2076498&number=EP18275174&lng=en&npl=false>

Contacts

Paolo Bertoni

Of Counsel - Chiomenti
IP, TMT and Data Protection Department
T+39.02.72157.679
paolo.bertoni@chiomenti.net

Gilberto Nava

Partner - Chiomenti
IP, TMT and Data Protection Department
T. +39.06.46622.719
gilberto.nava@chiomenti.net