



## **PRESS SUMMARY**

**20 December 2023**

**Thaler (Appellant) v Comptroller-General of Patents, Designs and Trade Marks (Respondent)**

**2023 UKSC 49**

**On Appeal From: [2021] EWCA 1374**

**JUSTICES:** Lord Hodge, Lord Kitchin, Lord Hamblen, Lord Leggatt, Lord Richards

**BACKGROUND TO THE APPEAL** In October and November 2018, Dr Stephen Thaler, the Appellant, filed two applications (GB18116909.4 and GB1818161.0) (“**the applications**”) for the grant of patents for what were said to be inventions for new and useful devices and methods.

The applications were filed by Dr Thaler under the Patents Act 1977 (“**the 1977 Act**”). The request for grant forms which accompanied them stated that Dr Thaler was not an inventor.

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 in accordance with section 13(2) of the 1977 Act and rule 10(3) of the Patent Rules 2007 (“**the Rules**”). Dr Thaler responded and has maintained that the inventor was in each case a machine called DABUS, acting autonomously and powered by artificial intelligence (“**AI**”), and that he acquired the right to the grant of the patents by his ownership of that machine.

Dr Thaler requested a hearing 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 for the Comptroller, the Respondent, issued a decision that DABUS could not be regarded as an inventor for the purposes of the 1977 Act, and further, that Dr Thaler was not entitled to apply for the patents simply by

his ownership of DABUS. The Comptroller also indicated that the applications would be taken to be withdrawn at the expiry of the sixteen-month period specified by rule 10(3) of the Rules.

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.

Dr Thaler now appeals to the Supreme Court.

## **JUDGMENT**

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dismisses the appeal, holding that the Comptroller was right to find that the applications would be taken to be withdrawn at the expiry of the sixteen-month period specified in rule 10(3) of the Rules.

Lord Kitchin gives the judgment, with which all the other Justices agree.

## **REASONS FOR THE JUDGMENT**

As a preliminary matter, this appeal is not concerned with the broader question whether technical advances generated by machines acting autonomously and powered by AI should be patentable. It is concerned instead with the interpretation and application of the relevant provisions of the 1977 Act [50].

Dr Thaler has made clear that he is not an inventor; that his case is that the inventions described in the applications were made by DABUS; and that his right to the grant of patents for those inventions arises from his ownership of DABUS. For the purposes of these proceedings, the Comptroller could not and did not go behind Dr Thaler's assertions of fact. The outcome of the appeal therefore turns on three issues.

### **Issue 1: the scope and meaning of the term "inventor" in the 1977 Act.**

The first issue concerns the scope and meaning of the term "inventor" in the 1977 Act and whether it extends to a machine such as DABUS. This turns on the interpretation of sections 7 and 13 of the Act. The Supreme Court holds that an inventor within the meaning of the 1977 Act must be a natural person [56-59].

Confirmation of the correctness of this interpretation is found in *Rhone-Poulenc Rorer International Holdings Inc v Yeda Research and Development Co Ltd* [2007] UKHL 43 [60-61]. There Lord Hoffmann explained, in the context of a dispute over entitlement, that the inventor is the natural person who came up with the inventive concept. Further, section 7(2) and section 7(3) provide an exhaustive code for deciding who is entitled to the grant of a patent [62]. The inventor must be a natural person and any other person to whom the patent may be granted must claim through the inventor [63].

Yet further confirmation that an inventor must be a natural person is to be found in the terms of section 13, which contain no suggestion that an inventor may be a machine [65].

In all the circumstances, 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” for the purposes of section 7 or section 13 of the 1977 Act [73].

**Issue 2: Was Dr Thaler nevertheless the owner of any invention in any technical advance made by DABUS and entitled to apply for and obtain a patent in respect of it?**

Dr Thaler contends that he was nevertheless entitled to file applications for and obtain the grant of patents for the inventions described and disclosed in each of the applications on the basis of his ownership of DABUS [76].

This contention must be rejected. First, section 7 of the 1977 Act confers the right to apply for and obtain a patent and it provides a complete code for that purpose. The section requires there to be an inventor and an inventor must be a person. DABUS is not a person [77]. Secondly, the applicant, if not the inventor, must be a person falling within one of the limbs of section 7(2)(b) or alternatively, within section 7(2)(c) [78]. Dr Thaler does not satisfy any part of this carefully structured code [79].

Dr Thaler submits that this analysis is incomplete because the 1977 Act recognises that there is property in an invention at the time it is made [80]. He also contends 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 [82].

These submissions cannot be accepted. First, they assume, wrongly, that DABUS can be and is an inventor [84]. Secondly, they mischaracterise an invention as being or amounting to tangible property such that title to it can pass, as a matter of law, to the owner of the machine which, on this assumption, generated it [85]. There is no basis for applying the doctrine of accession in these circumstances. The Court of Appeal was right to hold that the doctrine of accession does not, as a matter of law, operate to confer on Dr Thaler the property in or the right to apply for and obtain a patent for any technical development made by DABUS acting autonomously [89].

**Issue 3: was the Hearing Officer entitled to hold that the applications would be taken to be withdrawn?**

In all these circumstances the Hearing Officer for the Comptroller 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 or persons whom he believed to be the inventor or inventors of the inventions described in the applications [93]; 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 [98].

The Comptroller was 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 [99]. The judge and the Court of Appeal made no error in affirming that decision and in finding that the applications are now deemed to have been withdrawn.

*References in square brackets are to paragraphs in the judgment*

#### **NOTE**

**This summary is provided to assist in understanding the Court's decision. It does not form part of the reasons for the decision. The full judgment of the Court is the only authoritative document. Judgments are public documents and are available at:**

<https://www.supremecourt.uk/decided-cases/index.html>