



Artificial Intelligence (AI) and Inventorship (SCP/35/7)

Standing Committee on the Law of Patents (SCP)
Thirty-Fifth Session, October 16 to 20, 2023

Presentation by the Secretariat

Issues addressed in SCP/35/7

- I. A brief overview and underlying technology
- II. Human-AI Interaction in the Invention Process
- III. History of inventorship
- IV. International legal framework relating to inventorship
Paris Convention, TRIPS Agreement, PCT, PLT
- V. National/Regional frameworks regarding the concept of inventorship
- VI. The “Dabus case”
 - Overview of the DABUS Applications
 - IP offices decisions and judgements of courts
- VII. Concept of Inventorship in relation to AI inventions

Human-AI Interaction in the Invention Process

Human

❑ Invention by human inventor(s) – No AI involvement

❑ Invention by human inventor(s), assisted by AI

❑ Joint human-AI inventions

❑ AI-invention, assisted by human

❑ Invention by AI – No human involvement

What is the notion behind the term “inventor” and how it is determined under the current patent law?

AI

History and international legal framework

- From royal privilege to the Statute of Monopolies (1623)
Patents for the first and true inventor of a new manufacture.

- Inventors' right to be mentioned as such in the patent (moral rights)
 - Article 4^{ter} of the Paris Convention
 - Incorporated in the TRIPS Agreement by virtue of TRIPS Article 2.1 (obligation of the WTO members to implement Art, 1-12 and 19 of the Paris Convention)
 - Only the Contracting States of the Paris Convention can become PCT members.

- Indication of the inventor in a patent application (formality requirement)
 - PCT for international applications
 - Patent Law Treaty (PLT) incorporates by reference the form or contents a PCT international application.

National/Regional frameworks regarding the concept of inventorship

- A. Inventor's right to obtain a patent
Inventor's oath or entitlement; Once the right is transferred, assignee-applicant's entitlement to apply for a patent
- B. Moral rights and indication of the inventor in a patent application
- C. Personhood of inventors (statutory definition, established case law, contextual reading)
- D. Determination of an "inventor"
Case law developed in some countries: in general, an inventor makes a creative contribution to technological advancement, which results in an invention.
- E. Establishing joint inventorship
Case law developed in some countries. Joint ownership
- F. Employee inventors
- G. Legal consequences of inaccurate designation of inventors
 - No indication of inventors
 - Wrongful designation of an inventor and usurpation

The DABUS Case

- Two applications filed by Stephen Thaler indicating the AI system “Device for the Autonomous Bootstrapping of Unified Science (DABUS)” as the name of the inventor
- EPO, UKIPO and reportedly 15 other jurisdictions received one or more applications. In addition, one PCT application was filed.
- Document SCP/35/7 summarizes decisions of some IP Offices and judgements of courts.

Concept of inventorship in relation to AI inventions

- Overview of scholarly literatures relating to patent protection of inventions created by AI.
- Areas in patent law that were discussed by IP Offices and courts regarding the DABUS case.
- Initiatives of some IP Offices exploring the issues.

Thank You