

## Artificial Intelligence Cannot Be An Inventor. At Least, Not Yet.

*Thaler v. Hirshfeld*, 2021 WL 3934803 (E.D. Va. 2021)

By: Joseph Saltiel & Daniel Sokoloff | September 13, 2021

Artificial Intelligence (“AI”) has come a long way in recent years and has allowed people to automate many tasks, but one task AI cannot do is be a named inventor on a patent, at least not yet. Stephen Thaler tried to file a patent application naming his AI machine as an inventor, but the United States Patent and Trademark Office (“USPTO”) would not let him. In filing his patent application, Thaler identified the inventor’s “given name” as the name of his AI machine “DABUS” and under “family name” wrote “[i]nvention generated by artificial intelligence.” The USPTO required Thaler to amend the inventorship to a natural person, explaining that the statutory language that Congress has used to define the term “individual” and “himself or herself” was reserved for human beings. Because the USPTO failed to process the patent application as long as Thaler kept his AI machine as the named inventor, Thaler filed suit against the USPTO in the Eastern District of Virginia seeking a reversal of that decision and a declaration from the court that a patent application for an AI-generated invention should not be rejected on the basis that no natural person is identified as the inventor.

The USPTO moved for summary judgment, arguing that its interpretation of the Patent Act is entitled to deference under the Supreme Court precedent. Thaler argued that the USPTO was not entitled to deference because the USPTO did not perform certain actions, such as consider alternative interpretations or provide any evidence that Congress intended to exclude AI-generated inventions from patentability. The court rejected Thaler’s argument because it would add requirements that were counter to past precedence, and subsequently gave the USPTO’s interpretation, that an “inventor” must be a natural person, deference.

Even without deference, the court found that the USPTO’s conclusion was correct under the law of statutory construction, wherein the plain language of the statute controls. 35 U.S.C. § 100(f) provides that “[t]he term ‘inventor’ means the individual . . . who invented or discovered the subject matter of the invention.” Thaler did not present any evidence that Congress intended to deviate from the typical use of the term “individual.” Thaler attempted to argue that policy considerations of encouraging innovation dictate that AI-based inventions should be patentable, but the court denied this argument because Thaler did not provide support that these policy considerations should override the plain meaning of a statutory term.

Thus, the court granted the USPTO’s motion for summary judgment, answering the core issue of whether AI can be named as an “inventor” by stating that, “[b]ased on the plain statutory language of the Patent Act and Federal Circuit authority, the clear answer is no.” The court, however, acknowledged that, “[a]s technology evolves, there may come a time when artificial intelligence reaches a level of sophistication such that it might satisfy accepted meanings of inventorship.” So, while an AI machine cannot be named as an inventor under the current statutory framework, the debate continues as to whether the Patent Act should be amended to allow inventions by AI machines.