

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Artificial intelligence policy

Coke Morgan Stewart

Senior Counsel to the Director

August 13, 2020

Patent Public Advisory Committee quarterly meeting

UNITED STATES
PATENT AND TRADEMARK OFFICE



DABUS – Procedural history

- July 29, 2019: Application filed
- August 8, 2019: Notice to File Missing Parts issued
 - ADS did not identify each inventor by his or her legal name.
- August 29, 2019: Applicant filed a petition under 37 CFR 1.181 requesting the Director to vacate the Notice to File Missing Parts
 - Petitioner stated DABUS, a machine, generated the invention, and recognized the novelty and salience of the invention.
 - Petitioner contended that inventorship should not be limited to natural persons.
- December 17, 2019: USPTO dismissed the petition
- January 20, 2020: Petitioner requested reconsideration
- April 22, 2020: USPTO denied the petition

DABUS – Petitioner's arguments

- Not permitting AI to be an inventor would compel an applicant to name a natural person even where the person does not meet the inventorship criteria.
- Refusing to accept an AI system as an inventor would create an additional test for patentability not provided by the law.
- The USPTO granted patents related to DABUS and, therefore, implicitly legalized the process by which DABUS arrives at an invention.

Inventorship – Legal principles

- Title 35 repeatedly refers to inventors as natural persons (See, e.g., 35 U.S.C. §§ 100(f), 101, 102, and 115).
- 35 U.S.C. § 100(a) defines an “inventor” as “the individual or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention.”
- The Federal Circuit has explained that patent laws require an inventor to be a natural person.
 - “only natural persons can be ‘inventors’” (*Beech Aircraft Corp. v. EDO Corp.*, 990 F.2d 1237, 1248 (Fed. Cir. 1993)).
 - Conception is a “mental act” that must be performed by a natural person (*Burroughs Wellcome Co. v. Barr Labs., Inc.*, 40 F.3d 1223, 1227-28 (Fed. Cir. 1994)).
- USPTO regulations and the MPEP reflect the natural person inventorship requirement.

Policy considerations

- Can a machine invent, or is it merely a tool of a human inventor?
- If a machine can invent, would permitting it to be an inventor encourage or discourage innovation?
- What quantum of contribution is needed for a natural person to be a named inventor when a machine is purportedly contributing the bulk of the invention?
- What impact will a machine, as an inventor (or as a tool), have on the level of ordinary skill in the art?
- Should a machine have legal rights?
- Should a machine be able to own patents?

