DABUS Case in Japan

- Inventorship of AI Inventions -

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Agenda

1. Outline of the case
2. Judgment
3. Discussions in AI / AI-related inventions in Japan
4. Summary

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1-1. Worldwide Situation

- USA: (Supreme Court) Did not take the case / (CAFC) Inventors are limited to natural persons
- Europe: (EPO Boards of Appeal) AI cannot be designated as an inventor
- UK: (Supreme Court) Inventors are limited to natural persons
- South Africa: Registered (no examination)

1-2. Case Information

- Tokyo District Court decision on May 16, 2024 (40th Dept., Nakajima, J.)
- Case Number: 2023 (Gyo-U) No. 5001
- Plaintiff: Dr. Stephen Thaler
- Defendant: The JPO
- Holding: AI cannot be an inventor because “inventor” as defined in the Patent Act is limited to a natural person.

1-3. Case Summary

Sep 17, 2019	**PCT** International Application
Aug 5, 2020	**National Entry**. The name of the inventor as "Dabas, Artificial Intelligence who invented this invention autonomously".
Jul 30, 2021	The JPO **objected** the Application. **The name in the Inventor column should specify a natural person.**
Sep 30, 2021	The **Applicant filed an appeal** with the JPO, stating that the objection had no legal basis.
Oct 13, 2021	The JPO **dismissed** the application.
Jan 17, 2022	The **Applicant** requested an administrative review of dismissal of application.
Oct 12, 2022	The JPO **dismissed** the request for such review.

1-4. Issue in the Case

- The Plaintiff filed this lawsuit under Article 3, Paragraph 3 of the Administrative Litigation Act, seeking to rescind the dismissal of the application, arguing that the JPO's disposition to dismiss the application was illegal.
- The issue in this case is whether an "invention" as defined in the Article 2(1) of the Japanese Patent Act is limited to those made by natural persons.

1-5. Plaintiff's Arguments

Plaintiff's arguments

Argument 1) The Patent Act does not deny protection to AI Inventions.

- The definition of "invention" in Article 2(1) of the Patent Act is "a high-level creation of a technical idea that makes use of natural laws," and this does not provide a basis for excluding AI inventions from the definition of "invention".
- The substantive patentability requirements for a patent are eligibility (Article 29, Para. 1, introductory clause), novelty (Article 29, Para. 1), inventive step (Article 29, Para 2), and unpatentable inventions (Article 32), and they are not limited to those made by natural persons.

1-5. Plaintiff's Arguments

(Cont'd)

Argument 2) The name of the inventor shall not be a requirement in an application for an AI invention.

- Making the name of the inventor, a natural person, a mandatory requirement would result in patents that cannot be invalidated.
  - The Patent Act limits the persons who may request a trial for invalidation on the grounds that the application constitutes a misappropriated (usurped) application to those who have the right to obtain a patent.
  - If a patent is mistakenly granted for an AI invention, there will be no person who has the standing to argue misappropriated (usurped) application.

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2. Tokyo District Court Decision

- Article 2(1) of the IP Basic Act defines “IP” as inventions, devices, new varieties of plants, designs, works, and other things produced by human creative activity … trademark, trade name, or any other indication of goods or services used in business activities, and trade secrets and other technical or business information useful for business activities.
- According to the above provision, it is reasonable to conclude that the Basic Act stipulates that inventions are those created by natural persons as the basis for the creation of patents and other IP.

2. Tokyo District Court Decision

(Cont'd)

- Article 36(1)(ii) of the Patent Act stipulates that the name of the inventor must be described, while Article 36(1)(i) of the Patent Act stipulates that the name or corporate-name of the applicant for the patent must be described.
- Thus, the name mentioned above literally means the name of a natural person.
- It can be said that the above provision naturally assumes that the inventor is a natural person.

2. Tokyo District Court Decision

(Cont'd)

- Article 66 of the Patent Act provides that a patent right shall arise upon registration, and Article 29(1) of the Patent Act provides that a person who has made an invention may obtain a patent for that invention.
- Since an AI is not a legal person, it is reasonable to conclude that the above-mentioned "person who has made the invention" refers to a natural person and not to an AI, which cannot be the entity to which the right to obtain a patent is attributed.

2. Tokyo District Court Decision

(Cont'd)

- It is appropriate that the design of the system for AI inventions should be left to a democratic process based on public debate, taking into account the changes in the socio-economic structure brought about by AI, and that a systematic and reasonable system should be decided through a broad examination of legal theory in the light of harmonization with other AI-related systems.

2. Tokyo District Court Decision

(Cont'd)

- From a global perspective, although there are differences in the legal systems and specific provisions concerning the concept of invention in each country, it is clear from the evidence submitted to the Court that many countries are cautious in interpreting that the "inventor" referred to in the patent laws of each country directly includes AI.
- Considering all these circumstances, it is reasonable to conclude that the "inventor" as defined in the Patent Act is limited to natural persons.

2. Tokyo District Court Decision

(Cont'd)

- In conclusion, we would like to reiterate that it is especially expected that Japan should consider AI inventions as a legislative issue and reach a conclusion as soon as possible in view of the importance of AI inventions to industrial policy.

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3. Discussions in Japan

(1) Addition of examination cases as to AI-related inventions (JPO)

Specific examination cases are explained

(2) Study Group on IP Rights in the AI Era (IP Strategy Headquarters, **Cabinet Office**)

- On May 28, 2024, approximately two weeks after this decision, the "Study Group on IP Rights in the AI Era" of the IP Strategy Headquarters established by the Cabinet released an “Interim Summary Report” that summarizes the views of experts.
- The report is not legally binding, but may serve as a reference for future legislative and other policy developments.

3. Discussions in the Cabinet Office

- The summary report identified “how inventions should be protected in light of the progress of AI technology” as an issue, and discussed the concept of how to treat AI inventions and issues in patent examination in view of the expansion of AI utilization.
- In the report, it is anticipated that the use of AI in the invention-creation process will further advance in the future, and examples of the use of AI in the invention-creation process are discussed.

Below is the summary of the report.

3. Discussions in the Cabinet Office

Court decision holding on the inventor requirement

- Article 2(1) of the Patent Act defines “invention” as “a highly developed creation of a technical idea using natural laws,” and
- Article 70(1) of the Patent Act provides that "the technical scope of a patented invention shall be determined based on the statement of claims attached to the application.”
- According to these provisions, “the technical scope of the patented invention” shall be determined based on the description of claims attached to the application.

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*See Tokyo District Court decision dated September 13, 2005 (Heisei 16 (wa) No. 14321) [Film-coated split tablets], and other court cases such as Tokyo District Court decision dated January 26, 2006 (Heisei 14 (wa) No. 8496) [Laminated films and photographic supports], IP High Court decision dated July 30, 2007 (Heisei 18 (wa) No. 10048) [Transfer device for plastic food], [Laminated films and photographic supports], IP High Court decision dated July 30, 2007 (2006 (Gyo-ke) No. 10048) [Plastic food transfer device]

3. Discussions in the Cabinet Office

(Cont'd) Court decision holding on the inventor requirement

- According to these provisions, it is reasonable to conclude that in order to be considered an "inventor" of a patented invention, the inventor must have conceived the technical idea of the patented invention (technical problem and its solution) embodied in the description of claims, or must have been creatively involved in giving concrete form to such idea.
- Even if a person is actually involved as a researcher in experiments in the process of giving concrete form to the idea, he/she cannot be considered to be an inventor if his/her involvement is not considered to constitute creative involvement in relation to the technical feature of the invention.

3. Discussions in the Cabinet Office

(Cont'd) Report by the Cabinet Office

- At present, we have not confirmed the fact that AI engages in creative activities by itself, apart from human involvement, and it is still considered common that AI is used to support natural persons in the process of invention creation.
- Thus, it is considered that the natural person inventor should be recognized in accordance with the conventional idea that the inventor is the person who creatively contributed to the completion of the essential part of the invention.
- In other words, even for inventions using AI, natural persons are expected to be involved in the selection of models and training data, input into learned models, etc., and those who are recognized to have creatively contributed to the completion of the essential part of the invention, including such persons, should be recognized as inventors.

3. Discussions in the Cabinet Office

(Cont'd) Report by the Cabinet Office

- On the other hand, it is desirable to continue to consider the treatment of cases in which an AI is able to complete an essential part of an invention autonomously as a result of the further development of AI technology, in light of technological progress and international trends, as necessary.
- In addition, it is desirable to continue to examine, as necessary, the rights capacity of AI itself (whether AI itself can be the subject of rights to obtain patents), considering international trends, as the issue is not limited to inventions.

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- The Court made its decision based on the wording of the articles of the Patent Act and Basic Act, and put the rest as a matter for the legislature. A very Japanese-style decision.
- Under the current Japanese Patent Act, AI cannot be an inventor in Japan.
- This district court decision was upheld by the IP High Court on January 30, 2025.

4. Summary

- The treatment in each country may differ regarding the extent to which a natural person can be considered an inventor if he/she contributes to the invention when AI is used. The Japanese government believes that such decision should be based on “whether or not the natural person made a creative contribution to the completion of the essential part of the invention”.
- We are looking forward to future legislative discussions.

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Thank you for your attention.

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Any Questions?