United States Court of Appeals for the Federal Circuit

STEPHEN THALER,
Plaintiff-Appellant

v.

KATHERINE K. VIDAL, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE, UNITED STATES PATENT AND TRADEMARK OFFICE,
Defendants-Appellees

2021-2347

Appeal from the United States District Court for the Eastern District of Virginia in No. 1:20-cv-00903-LMB-TCB, Judge Leonie M. Brinkema.

Decided: August 5, 2022

RYAN BENJAMIN ABBOTT, Brown, Neri, Smith & Khan, LLP, Los Angeles, CA, argued for plaintiff-appellant.

DENNIS BARGHAAN, JR., Office of the United States Attorney for the Eastern District of Virginia, United States Department of Justice, Alexandria, VA, argued for defendants-appellees. Also represented by JESSICA D. ABER; FARHEENA YASMEEN RASHEED, PETER JOHN SAWERT,

MEREDITH HOPE SCHOENFELD, Office of the Solicitor, United States Patent and Trademark Office, Alexandria, VA.

MITCHELL APPER, Jerusalem, Israel, amicus curiae, pro se.

Before MOORE, *Chief Judge*, TARANTO and STARK, *Circuit Judges*.

STARK, *Circuit Judge*.

This case presents the question of who, or what, can be an inventor. Specifically, we are asked to decide if an artificial intelligence (AI) software system can be listed as the inventor on a patent application. At first, it might seem that resolving this issue would involve an abstract inquiry into the nature of invention or the rights, if any, of AI systems. In fact, however, we do not need to ponder these metaphysical matters. Instead, our task begins – and ends – with consideration of the applicable definition in the relevant statute.

The United States Patent and Trademark Office (PTO) undertook the same analysis and concluded that the Patent Act defines "inventor" as limited to natural persons; that is, human beings. Accordingly, the PTO denied Stephen Thaler's patent applications, which failed to list any human as an inventor. Thaler challenged that conclusion in the U.S. District Court for the Eastern District of Virginia, which agreed with the PTO and granted it summary judgment. We, too, conclude that the Patent Act requires an "inventor" to be a natural person and, therefore, affirm.

I

Thaler represents that he develops and runs AI systems that generate patentable inventions. One such system is his "Device for the Autonomous Bootstrapping of

Unified Science," which Thaler calls "DABUS." Thaler has described DABUS as "a collection of source code or programming and a software program." Supp. App. at 781.

In July 2019, Thaler sought patent protection for two of DABUS' putative inventions by filing two patent applications with the PTO: U.S. Application Nos. 16/524,350 (teaching a "Neural Flame") and 16/524,532 (teaching a "Fractal Container").[1] He listed DABUS as the sole inventor on both applications. Thaler maintains that he did not contribute to the conception of these inventions and that any person having skill in the art could have taken DABUS' output and reduced the ideas in the applications to practice.[2]

In lieu of an inventor's last name, Thaler wrote on the applications that "the invention [was] generated by artificial intelligence." App. at 28, 69. He also attached several documents relevant to inventorship. First, to satisfy 35 U.S.C. § 115's requirement that inventors submit a sworn oath or declaration when applying for a patent, Thaler

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[1] The administrative records for both applications are materially identical.

[2] While inventorship involves underlying questions of fact, *see Dana-Farber Cancer Inst., Inc. v. Ono Pharm. Co.*, 964 F.3d 1365, 1370 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2691 (2021), for purposes of this litigation the PTO has not challenged Thaler's representations, *see* D. Ct. Dkt. No. 25, at 11. Accordingly, our analysis must be consistent with the undisputed facts in the administrative record, drawing inferences in favor of the non-moving party. *See Safeguard Base Operations, LLC v. United States*, 989 F.3d 1326, 1349 (Fed. Cir. 2021) (discussing when it is appropriate to supplement administrative record and noting "[t]he focal point for judicial review should be the administrative record already in existence") (quoting *Camp v. Pitts*, 411 U.S. 138, 142 (1973)).

submitted a statement on DABUS' behalf. Second, Thaler provided a supplemental "Statement on Inventorship" explaining that DABUS was "a particular type of connectionist artificial intelligence" called a "Creativity Machine." App. at 198-203, 483-88. Third, Thaler filed a document purporting to assign himself all of DABUS' rights as an inventor.

The PTO concluded both applications lacked a valid inventor and were, hence, incomplete. Accordingly, it sent Thaler a "Notice to File Missing Parts of Nonprovisional Application" for each application and requested that Thaler identify valid inventors. In response, Thaler petitioned the PTO director to vacate the Notices based on his Statements of Inventorship. The PTO denied Thaler's petitions on the ground that "a machine does not qualify as an inventor." App. at 269-71, 548-50. Thaler sought reconsideration, which the PTO denied, explaining again that inventors on a patent application must be natural persons.

Thaler then pursued judicial review of the PTO's final decisions on his petitions, under the Administrative Procedure Act (APA). *See* 5 U.S.C. §§ 702-704, 706.[3] The parties agreed to have the District Court adjudicate the challenge based on the administrative record made before the PTO and filed cross-motions for summary judgment. After briefing and oral argument, the Court granted the PTO's motion for summary judgment and denied Thaler's request to reinstate his applications. The District Court concluded that an "inventor" under the Patent Act must be an "individual"

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[3] The District Court had jurisdiction under 28 U.S.C. § 1331. *See also* 5 U.S.C. § 702 ("A person suffering legal wrong because of agency action, or adversely affected or aggrieved by agency action within the meaning of a relevant statute, is entitled to judicial review thereof.").

and the plain meaning of "individual" as used in the statute is a natural person.

Thaler appealed. We have jurisdiction under 28 U.S.C. § 1295. *See Odyssey Logistics & Tech. Corp. v. Iancu*, 959 F.3d 1104, 1108 (Fed. Cir. 2020) (explaining that Federal Circuit has jurisdiction over appeals from district court decisions raising APA claims against PTO regarding patents).

II

We review grants of summary judgment according to the law of the regional circuit, in this case the Fourth Circuit. *See Supernus Pharms., Inc. v. Iancu*, 913 F.3d 1351, 1356 (Fed. Cir. 2019). In the Fourth Circuit, a district court's grant of summary judgment is reviewed *de novo*. *See id.* (citing *Gallagher v. Reliance Standard Life Ins. Co.*, 305 F.3d 264, 268 (4th Cir. 2002)). Challenges to PTO petition decisions are governed by the APA and pertinent administrative law standards. Thus, we may set aside the judgment resulting from an administrative adjudication only if the agency's decision is "arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law" or if the agency's actions are "in excess of statutory jurisdiction, authority, or limitations." 5 U.S.C. § 706. "Statutory interpretation is an issue of law that we review de novo." *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1330 (Fed. Cir. 2020).

A

The sole issue on appeal is whether an AI software system can be an "inventor" under the Patent Act. In resolving disputes of statutory interpretation, we "begin[] with the statutory text, and end[] there as well if the text is unambiguous." *BedRoc Ltd. v. United States*, 541 U.S. 176, 183 (2004). Here, there is no ambiguity: the Patent Act requires that inventors must be natural persons; that is, human beings.

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