

ARTIFICIAL INTELLIGENCE (AI) AND INVENTORSHIP (UPDATE OF SCP/35/7)

(SCP/37/5)

Presentation by the Secretariat

Standing Committee on the Law of Patents
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Background

- ❑ **At SCP/34 the committee agreed that:**

- ❑ compilation on how jurisdictions around the world address the issue of artificial intelligence (AI) inventorship, through jurisprudence, legislation and practice to be updated on a regular basis, and present it at the thirty-fifth session of the SCP

- ❑ **At SCP/35 the Annex to the AI and Inventorship document SCP 35/7:**

- (i) Artificial Intelligence: 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; **(v) National/regional legal frameworks relating to inventorship; (vi) The “DABUS case”;** (vii) Concept of inventorship in relation to AI inventions.

- ❑ **At SCP/36 the committee agreed to update document SCP/35/7 by updating **Section V and VI** of that document**

Scope of the Updates- Outline of (Section V &VI)

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Section V:

A. INVENTOR'S RIGHT TO A PATENT

- ❑ Reflects on the point of origin, conception of the invention and symbolizes the personality dimension- a static concept; i.e., “the right to a patent shall belong to the inventor or his successor in title” (widely reported among national/regional legal frameworks)
- ❑ **Updates in SCP 37/5** received from the **Russian Federation, Republic of Moldova and France**

B. MORAL RIGHTS

- ❑ In implementing Article 4ter of the Paris Convention, i.e., **the right to be mentioned in a patent. Many laws specifically mention about non-transferability and non-waiver of such a right (Updates received for SCP 37/5 (Republic of Moldova and the Russian Federation))**

Section V: (Contd.)

C. “INVENTOR” = NATURAL PERSON?

- ❑ the term “inventor” – found in **statutory provision** of the applicable law and/or **secondary legislation** (e.g., explanatory/implementing rules for the patent law), or **case law development** (the term “inventor” has to be a natural person)
- ❑ **El Salvador, Article 3(45) of the Intellectual Property Act (requires human inventorship) and the Syrian Arab Republic** reporting **incompatibility** between inventions generated by AI systems as the “inventor” and the current law
- ❑ **Brazil** reported that authorship (inventorship) of patents by AI has been the target of legislative proposals (none enacted) - Bill No. 303, of 2024 (Bill 303/2024), proposes amendment to Art. 6 (IP Law) allowing application of patent in the name of AI system to be treated as an inventor.
 - ❑ The Rapporteur of the Science, Technology and Innovation Commission of the Brazilian Congress, proposed modifications to Bill 303/2024, presented in the form of a **substitute text presenting alternative option**.

Section V: (Contd.)

D. DETERMINATION OF AN “INVENTOR”

- ❑ In general, an inventor makes a creative contribution to technological advancement, which results in an invention. **(updates received- China and the Russian Federation)**

E. ESTABLISHING JOINT INVENTORSHIP

- ❑ considerations surrounding the determination of inventorship in general: who made what contribution to the invention, although there are diverging approaches **(one update- the Russian Federation)**

F. EMPLOYEE INVENTORS: Detailed provisions to create balance between original inventor claiming inventorship, and the legitimate interest of the employer (provides infrastructure, funding the collective experience and direction, on which the invention was built). **(updates from France and the Russian Federation)**

Section V: (Contd.)

G. LEGAL CONSEQUENCES OF INACCURATE DESIGNATION OF INVENTORS

- ❑ If the applicant fails to provide the names of the inventors or indicates the wrong inventors (either in good faith or intentionally),
 - ❑ different consequences to the application;
 - ❑ different kinds of remedies may be available depending on the applicable law.
- ❑ many jurisdictions do not appear to have requirements to validate at the point of filing (i.e., there is only a check to see that someone is named)
- ❑ **Failure to Indicate Inventors (Update from Isreal)** in **contrast** to many other jurisdictions, there is no legal requirement for the inventor(s) to be named.

Section V: (Contd.)

Corrections to the Designation of Inventors: Many patent laws do allow for the correction of a wrongfully designated inventor.

- ❑ **Russian Federation:** changes may be made to the list of authors, specified in a patent application, prior to the State registration of the invention- requires documentary evidence of consent
- ❑ **Australia, Canada, Japan, the Republic of Korea, Singapore, Switzerland, and the United Kingdom** reported provisions for the applicant to correct details of a patent application, including the inventor(s).
- ❑ **Finland-** provisions that allow the patentee to remove themselves as a designated inventor.
- ❑ **Canada,** the patentee is able to disclaim part of a patent specification for which they claimed was the inventor but was not the actual inventor.

Section V: (Contd.)

Invalidation and Revocation of a Patent : (Updates from Australia, Canada, Chile, Finland, Germany, Israel, Japan, Morocco, Republic of Korea, Singapore, Switzerland, the United Arab Emirates, and the United Kingdom)

- ❑ an inaccurate designation of the inventor may result in invalidation or revocation, particularly where it may indicate a defect in entitlement
- ❑ misnaming an inventor as such is not a standalone ground for revocation; rather, consequences typically flow through entitlement/usurpation doctrines.
- ❑ expressly state that a patent is not invalid merely because it was granted to a person not entitled, revocation may still be available on broader entitlement, fraud, misrepresentation, or non-disclosure grounds.
- ❑ a patent may be invalidated where the grant issues to a person lacking the right to the patent.
- ❑ failure to name the correct inventor could theoretically be a ground for invalidity

Section V: (Contd.)

Transfer of Rights: (Updates from Australia, Canada, Chile, Finland, France, Germany, Israel, Japan, Morocco, Republic of Korea, Singapore, Switzerland, the United Arab Emirates, and the United Kingdom)

- ❑ Either an invention taken from the inventor or his successors in title, or in breach of a legal or contractual obligation, the injured party may claim ownership of the application or the title issued
- ❑ stage of proceedings, remedies may include assignment of the application, transfer of the granted patent, rectification of the register, or a judicial declaration clarifying entitlement.
- ❑ available pre-grant and post-grant, may operate alongside revocation/nullity actions, and may be subject to limitation periods and, in some instances, bad-faith exceptions.
- ❑ both administrative and judicial channels. Declaratory remedy available; assignment actions sit alongside nullity as options for the entitled person
- ❑ Damages are provided in connection with usurpation, in addition to vesting title in the person entitled

Section V: (Contd.)

Persons Entitled to Challenge the Designation of Inventor: (Updates from Australia, Canada, Chile, Finland, Germany, Israel, Japan, Morocco, Republic of Korea, Singapore, Switzerland, the United Arab Emirates, and the United Kingdom)

- (i) applicant-initiated correction routes;
 - (ii) actions by the true inventor;
 - (iii) proceedings by persons with a proprietary interest; and
 - (iv) challenges by any person or any person interested. Additionally, in a number of frameworks, public authorities may initiate or entertain challenges, including via third-party submissions during examination.
- ❑ Standing may differ pre-grant versus post-grant

Section V: (Contd.)

Timing of Challenges to the Designation of Inventor: (Updates from Australia, Canada, Chile, Finland, Germany, Israel, Japan, Morocco, Republic of Korea, Singapore, Switzerland, the United Arab Emirates, and the United Kingdom)

- ❑ Some allow the possibility to challenge is confined to a defined time period during the lifetime of the application or patent. Others- challenges may be initiated at any point throughout the duration of the application or patent
- ❑ most cases where the time available to challenge is limited, there may be exceptions allowed for instances where the inaccurate designation was a result of the applicant acting in bad faith.

Section VI: DABUS Case Updates

- ❑ **DABUS** made two separate inventions, namely: (i) a flashing light beacon for attracting enhanced attention in emergency situations; and (ii) a fractal food container
 - ❑ patent applications were filed in multiple jurisdictions for AI as the inventor
- ❑ **IP OFFICE DECISIONS AND JUDGEMENTS OF COURTS (Updates)**
 - ❑ **Australia:** The DABUS decision is discussed in IP Australia’s Patent Manual of Practice and Procedure, making it clear that a human inventor is required. The principles for considering human inventorship are also summarized in the manual
 - ❑ **Germany-** In June 2024, in an appeal- a natural person can be designated as inventor in a patent application according to Section 37 para 1 of the German Patent Act.
 - ❑ **Japan-** In January 2025, the Intellectual Property High Court dismissed the appellant's claims, reasoning that “it is appropriate to interpret that an "invention" eligible for a patent under Patent Act is limited to those for which a natural person is the inventor”.

Section VI: DABUS Case Updates (Contd.)

- ❑ **Republic of Korea-** in May 2024, Seoul High Court noted: that it was obvious that inventor refers to a natural person and that “it is beyond the limitations of legitimate legal interpretation to incorporate AI into the inventor under their current regulations of the Act”
- ❑ **United Kingdom:** Supreme Court of the UK(December 2023)- an inventor, for the purposes of the Patent Act 1977, must be a natural person. Furthermore, the court held that under the Act, ownership of an AI system does not confer a right for the owner to apply for or obtain a patent relating to inventions generated by that AI system
- ❑ **EPO-** As an AI does not enjoy rights, it can thus not be designated as an inventor under the EPC. As per Article 81 EPC, the designated inventor has to be a person with legal capacity (legal board of appeal)

Thank you for your attention.

