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**Datasheet for the decision
of 21 December 2021**

Case Number: J 0009/20 - 3.1.01

Application Number: 18275174.3

Publication Number: 3563896

IPC: A61M21/00, A61M16/00

Language of the proceedings: EN

Title of invention:

DEVICES AND METHODS FOR ATTRACTING ENHANCED ATTENTION

Applicant:

Thaler, Stephen L.

Headword:

Designation of inventor/DABUS II

Relevant legal provisions:

EPC Art. 81, 60(1), 90(3)

EPC R. 19(1), 19(2)

Keyword:

Designation of inventor - artificial intelligence

Decisions cited:

G 0001/88, G 0001/18, J 0008/82, T 0866/01, T 0315/03,
T 1157/01, T 1051/20, T 0388/12, T 1548/11

Catchword:

A machine is not an inventor within the meaning of the EPC



Juristische Beschwerdekammer

Legal Board of Appeal

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Case Number: J 0009/20 - 3.1.01

D E C I S I O N
of the Legal Board of Appeal 3.1.01
of 21 December 2021

Appellant: Thaler, Stephen L.
(Applicant) 1767 Waterfall Drive
St. Charles MO 63303 (US)

Representative: Williams Powell
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Decision under appeal: **Decision of the Receiving Section of the
European Patent Office posted on 27 January 2020
refusing European patent application No.
18275174.3 pursuant to Article 90(5) EPC.**

Composition of the Board:

Chairman W. Sekretaruk
Members: R. Romandini
A. Jimenez

Summary of Facts and Submissions

The present appeal lies from the Receiving Section's refusal of European patent application No. 18 275 174. The submissions made and the legal issues raised in the present proceedings are identical to those in case J 0008/20 concerning European patent application No. 18 275 163. The same holds true for the submissions before the department of first instance. The decisions appealed in J 0008/20 and in the present proceedings were both issued by the EPO Receiving Section following the same (consolidated) oral proceedings. In substance, they are identical. In turn, the present board summoned for oral proceedings for the same date in both cases. At the end of the oral proceedings, the board announced the same outcome for both appeals. Against this background the present decision is almost identical to that in J 0008/20.

- I. On 17 October 2018 and 7 November 2018 the applicant (henceforth: the appellant) filed two European patent applications with the EPO, the first one, EP 18 275 163, concerning a "Food Container" and the second one, EP 18 275 174, relating to "Devices and Methods for Attracting Enhanced Attention". Neither application designated an inventor in the request for grant, nor did the appellant file a separate document designating the inventor. In both cases, this deficiency led the Receiving Section to send a communication pursuant to Article 90(3) and Rule 60 EPC, inviting the appellant to submit an inventor designation drawn up according to Article 81 and Rule 19(1) EPC within the deadline set out in Rule 60(1) EPC.

II. The appellant responded to this communication on 24 July 2019 by filing two EPO Forms 1002. In both cases the content of the form was the same in that the appellant indicated "DABUS" as inventor, with the comment that "the invention was autonomously generated by an artificial intelligence". Furthermore, he stated that he had acquired the right to the patent as employer. The form was accompanied by an addendum, according to which DABUS, a particular type of connectionist artificial intelligence, had not only generated but had also identified the novelty of the respective inventions. In that document it was also stated that the appellant - as owner of the machine indicated as inventor - was to be acknowledged as the assignee of the requested patent. The relevant passages read as follows:

"Machines should not own patents. They do not have legal personality or independent rights and cannot own property. The machine's owner should be the default owner of any intellectual property it produces and any benefits that would otherwise subsist in a natural person owner. This is most consistent with current ownership norms surrounding personal property (including both machines and patents). In the present application, we submit that DABUS should be acknowledged as the inventor of any resultant patents, with Stephen Thaler, the machine's owner, as the assignee of any such patents."

III. The appellant filed a subsequent EPO Form 1002 on 2 August 2019 stating that he had derived the right to the patent as successor in title. The brief accompanying letter reads as follows:

"With reference to our submission of 23 July 2019, we

enclose a corrected designation of inventor form 1002 indicating that Mr. Thaler derives the rights of the invention by being the successor in title, namely the owner of the AI inventor."

The addendum filed on 24 July 2019 was not amended.

- IV. The Receiving Section considered it expedient to consolidate the proceedings and appoint oral proceedings. In the annex to the summons to oral proceedings the Receiving Section observed that the designation of the inventor filed for the two applications did not meet the requirements laid down in Article 81 and Rule 19 EPC. It noted that the applicant could remedy this deficiency by indicating the family name, given name and full address of the inventor within sixteen months after the date of filing or, at latest, before completion of the technical preparation for the publication of the European patent application, in accordance with Rule 60 EPC. Furthermore, it observed that if the deficiencies were not remedied within that time limit, the application would be refused in accordance with Article 90(5) EPC. In the same communication (point 17), the Receiving Section announced its intention to decide on the inventor designation issue at the oral proceedings.
- V. The oral proceedings took place on 25 November 2019. With decisions sent to the appellant on 27 January 2020, the Receiving Section refused the applications in accordance with Article 90(5) EPC. Both decisions relied on two grounds, namely:
- (a) a designation indicating a machine as inventor did not meet the requirements of Article 81 and Rule 19(1) EPC, because an inventor within the meaning

of the EPC had to be a natural person;

(b) the "statement indicating that the applicant acquired the right to the European patent from DABUS as employer", and "the correction of this statement to indicate succession in title" did not meet the requirements of Articles 60(1) and 81 EPC, because a machine had no legal personality. Therefore, it could neither be an employee of the applicant nor transfer any right to him.

VI. The appellant lodged an appeal against both decisions. The present decision concerns the second of these two appeals and relates to the application No. 18 275 174.

VII. With the statement of grounds of appeal, the appellant requested that the decision of the Receiving Section be set aside, that the application be reinstated and that DABUS, the actual deviser of the invention, be named as inventor in accordance with the provisions of Articles 62, 81 and Rule 20 EPC. This request relies on the designation of inventor filed on 2 August 2019 (see Notice of Appeal of 13 March 2020).

VIII. In the statement of grounds of appeal, the appellant also identified a number of procedural violations which in his view had occurred in the proceedings before the Receiving Section. He argued in particular that:

(a) the decision was based on facts and evidence not previously presented to the appellant (section 1.2 of the grounds of appeal);

(b) the Receiving Section went beyond its competence in deciding the case (section 1.3 of the grounds of

appeal);

(c) the application had been refused before the 16-month term prescribed by Rule 60(1) EPC expired (section 1.1 of the grounds of appeal);

(d) the Receiving Section had refused to name the inventor on the published application, in breach of Rule 20 EPC (section 1.3 of the grounds of appeal);

(e) the Receiving Section had issued two separately appealable decisions although the proceedings were consolidated, thereby forcing the appellant to file two identical appeals and pay two appeal fees.

However, the statement of grounds did not include any specific requests based on these allegations.

IX. Following the appeal, by letter of 29 September 2020, the President of the European Patent Office (EPO) requested under Article 18 RPBA 2020 to comment on questions of general interest which in his view had arisen in both proceedings. The Board granted the request. The submissions were timely filed on 11 May 2021.

X. The Board issued a communication under Article 15(1) RPBA on 21 June 2021. In reaction to this communication the appellant filed an auxiliary request with letter of 14 September 2021. This auxiliary request was based on:

- an amended description ("providing information as to the conception of the invention by the AI system DABUS");

- an amended designation of the inventor (EPO Form

1002) stating that no person was identified as inventor as "the invention was conceived autonomously by DABUS", and that the appellant had derived the right to the European patent "by virtue of being the owner and creator of DABUS".

The appellant also submitted an amended version of the addendum filed on 24 July 2019 in the proceedings before the Receiving Section for the "sake of completeness".

- XI. During the oral proceedings before the Board, the appellant confirmed that his final requests were:
- that the decision of the Receiving Section be set aside and the case be remitted to the Receiving Section for further prosecution for reason that the declaration of inventor filed on 2 August 2019 (main request) or the declaration of inventor filed on 14 September 2021 (auxiliary request) and the accompanying statements indicating the origin of the right to the European Patent met the requirements of the EPC.

Furthermore, in case none of the above requests were found allowable, the appellant asked that the following questions be referred to the Enlarged Board of Appeal:

- 1. In case of an invention made by an artificial intelligence in the absence of a traditional human inventor (AI generated invention) do Article 81, first sentence, and Rule 19 EPC remain applicable?*
- 2. If so, in what way should an applicant indicate the designated inventor in order to satisfy the requirements of Article 81, first sentence, and Rule 19 EPC?*

The appellant confirmed that he had no requests relating to the alleged procedural violations.

XII. The Board announced its decision at the end of the oral proceedings. After the oral proceedings, the European Patent Office informed the registrar of the Legal Board of Appeal that the appellant had not paid the examination fee and the designation fee in due time. A notice of loss of rights according to Rule 112(1) EPC was issued on 31 January 2022. The appellant filed a request for further processing on 29 March 2022. The Examining Division granted the request on 6 April 2022.

XIII. *Documents and decisions submitted during the appeal proceedings*

The appellant has submitted and referred to the following documents or decisions during the appeal proceedings:

- Decision of the UK IPO of 4 December 2019 (Attachment II);
- USPTO Request for Comments (Attachment III);
- WIPO Conversation on AI (Attachment IV);
- WO2020/079499 (Attachment V);
- Judgement dated 21 September 2021 of the Court of Appeal of England and Wales in *Thaler v Comptroller General of Patents Trade Marks And Designs* [2021] EWCA Civ 1374;
- Judgement dated 30 July 2021 of the Federal Court of Australia, *Thaler v Commissioner of Patents* [2021] FCA 879.

XIV. *The appellant's arguments*

The appellant has not presented his arguments as to why the decision under appeal was wrong in a structured and hierarchical way. Instead, he has criticised single paragraphs of the decision under appeal and supplemented this analysis with some general remarks and a separate Annex.

In spite of this, the Board understood the appellant's arguments in favour of setting aside the decision under appeal to be as follows:

- (a) At the time the EPC was drafted, artificial intelligence was not a reality and had not even been contemplated as a possibility. The EPC was drafted with human inventors in mind. However, human inventorship was not a condition for granting a patent. In refusing the application, the Receiving Section based its decision "on the substantive point that the EPC allegedly does not permit and was not intended to permit the patenting of inventions by any inventor other than an human inventor". In this way, the Receiving Section not only overstepped its competence; by referring to the formal requirement for a designation of an inventor, it had made "inventorship a substantive condition for the granting of a patent by the EPO".

- (b) It was not necessary to be a natural person in order to make an invention within the meaning of Article 52 EPC. Inventorship was a matter of fact: it was based on the technical contribution made to an invention. The entity which comes up with the inventive concept was the deviser of the invention and should be recognised as such.

- (c) Allowing AI to be designated as inventor also responded to an interest of the public and to fairness. The public had a right to know how the invention was made. Patents would incentivise the development of AI systems. Acknowledging machines as inventors would acknowledge the work of machine's creators (see addendum filed on 24 July 2019).
- (d) Designation of the inventor was a formal matter. As was apparent from the travaux préparatoires, the drafters of the EPC had intended that the applicant should indicate the true deviser of the invention. This was exactly what happened in the present proceedings. The approach of the Receiving Section would force applicants to mask the identity of the actual inventor and name a human as inventor in place of the AI system. Compelling an applicant to take such measures in order to satisfy a formal requirement would "undermine the very principle of designating and making public the identity of the actual deviser of the invention".
- (e) There was no international standard according to which an inventor had to be a natural person. A large number of EPC Contracting States did not state in their national patent laws that the inventor must be a natural person.
- (f) AI generated inventions were patentable under Article 52 EPC. They were also patentable under Article 27 TRIPS Agreement. The EPO should not deny patent protection for such inventions on the basis of designation rules, or for lack of entitlement, because breach of the former was only a procedural

violation, and the latter was a matter for national courts.

- (g) Article 60 EPC defined the right to the patent and attributed it to the inventor and the successor in title. This could neither be an obstacle to the application being granted, nor provide a basis for restricting patents to human-made inventions for three reasons. Firstly, Article 60 EPC was not an exhaustive provision on the right to an invention in a European patent or patent application. National laws provided other mechanisms by which a third party could obtain the rights to an invention, which did not require any transfer of rights from an inventor or for the third party to be a successor in title (see for instance Section 7 of the UK Patents Act). Secondly, the concept of succession was broad enough to cover scenarios other than assignment. Finally, the EPO was not competent to verify the accuracy of the statement on the origin of the right to the invention and had no competence to assess entitlement. This was a matter left to national courts, which applied national law. The EPO was bound by the Protocol on Jurisdiction and the Recognition of Decisions in respect of the Right to the Grant of a European Patent to accept a derivation of title based upon the law of any Contracting State having jurisdiction to decide the matter.
- (h) Refusing an application for a patentable invention because it did not designate a natural person as inventor was not only in conflict with the principles set out in Article 52 EPC, but it also had undesirable policy ramifications: it meant that all investments which resulted in inventions

developed by AI would not be eligible for patent protection, because even if the result were patentable, it would not belong to anybody.

The arguments above were made in respect of the main request in written submissions and at the oral proceedings. With respect to the auxiliary request, the appellant submitted that he agreed with the Board's preliminary view that the rules governing the designation of the inventor were not applicable "where the invention is deemed to be the autonomous output of an AI device" (see letter dated 14 September 2021).

XV. *EPO President's comments*

Insofar as relevant for the present proceedings the EPO President's submissions of 11 May 2021 are as follows:

(a) The designation of inventor filed by the applicant did not comply with the EPC, because the EPC required the inventor to be a natural person. This conclusion followed from:

- (i) the wording of Rule 19 EPC, which required the indication of the name of the inventor;
- (ii) the fact that the EPC did not provide for non-persons, but only for legal or natural persons as applicant, inventor or in any other role in the patent grant proceedings; in matters of inventorship, in the EPC reference was made only to natural persons (e.g., Article 60(1), second sentence, EPC)

- (iii) the travaux préparatoires, which referred to the inventor as a natural person;
 - (iv) international applicable standards.
- (b) The applicant's statement as to the origin of the right to the invention did not comply with Article 81 EPC because the applicant could not be considered the successor in title of an AI system. AI systems had no legal personality and could not transfer any rights. The applicant's statements were also contradictory. On the one hand, he stated that he was the inventor's successor in title. On the other hand, he admitted (in the addendum) that AI systems have no rights that they could transfer.
- (c) The EPO had competence to examine whether the designation filed by an applicant complies with Article 81 and Rule 19(1) EPC (Article 90(3) and Article 16 EPC). An obviously deficient statement resulted in the refusal of the application under Art 90(5) EPC.
- (d) Concerning the alleged procedural violations raised by the appellant the President contended that the Receiving Section was competent to issue the decision. Indeed, the examination of the formal requirements of an application was within its exclusive competence under Article 16 EPC. The Legal Division was only competent for decisions in respect of entries in the Register of the European Patents. The decision under appeal did not concern a correction after the publication of the application, nor an entry in the Register. The

Receiving Section was also entitled to refuse the application before the time limit under Rule 60(1) EPC expired. At the oral proceedings the Receiving Section had informed the applicant that it intended to interrupt the proceedings with the purpose of coming to a decision and asked the applicant whether he had anything to add. Since the applicant stated that he had no further comments, he had waived the right to file a designation within the remaining time limit set out in Rule 20(1) EPC. The applicant had subsequent possibilities to file a designation of inventor. But in the statement of grounds of appeal, he maintained the statements filed before the first instance. These circumstances indicated that the applicant made a deliberate choice not to file any designation of inventor and had waived his right to take advantage of the time limit set out in Rule 60(1) EPC. According to the President, indeed, an applicant could waive rights under the EPC not only explicitly, but also implicitly. In support of this, the President cited some Boards of Appeal decisions, in particular T 144/09, T 936/09 and T 289/84.

XVI. *Third party submissions*

During the proceedings third parties made submissions under Article 115 EPC. While one of them questioned the admissibility of the appeal, others mostly discussed the allowability of the requests. For reasons explained below the Board did not take these submissions into account.

Reasons for the Decision

1. Admissibility of the appeal

The appeal is admissible. The appellant has filed an application which the Receiving Section has rejected. He is therefore adversely affected by the decision under review. Whether he is entitled to the requested patent or not does not matter for the admissibility of the appeal, contrary to the position set out in one of the third-party submissions.

2. Granting the appellant's request filed under Article 121 EPC and impact on the appeal proceedings

When the Board decided on the appeal the appellant had paid neither the examination fee (Article 94(1) EPC) nor the designation fee (Article 79(2) EPC). Since the time limit set out in Rule 70(1) and 39(1) EPC respectively had already passed on the day of the oral proceedings before the Board, the European application was deemed to be withdrawn at the time. Hence, the decision announced at the end of the oral proceedings was without any effect and object. Providing reasons on the merits was not only unnecessary: it would also have been a waste of limited judicial resources. After the Board's decision, the Receiving Section sent a notice of loss of rights. The appellant, in turn, requested further prosecution, which the Examining division has granted on 6 April 2022. The latter decision lies within the competence of the department that should have also decided on the omitted act. It must therefore be respected by the Board. The assessment of its effect for the appeal proceedings lies, by contrast, with the Board. They are as follows:

Where a request filed under Article 121(1) EPC is granted, the legal consequence of the failure to observe the time limit is deemed not to have ensued (Article 121(3) EPC). The application is to be treated as if the failure to observe the time limit had not occurred. For the appeal proceedings this means that the application is to be deemed as still pending at the date the oral proceedings took place. In accordance herewith the decision to dismiss the appeal has a legal effect, and the Board must provide reasons for it.

3. *Submissions of third parties*

Under Article 115 EPC the observations filed by third parties in proceedings before the EPO should concern the patentability of the invention. The present proceedings do not concern the question of whether the invention disclosed in the application is patentable under Articles 52-57 EPC. Nor do they relate to the general issue of whether an AI system is able to develop an invention without human direction and contribution. Thus, the Board does not need to consider any of the submissions made by third parties.

4. *Assessment on the merits*

4.1 *Introduction*

The requests filed by the appellant raise three issues.

The first is whether an applicant can designate an entity which is not a natural person as the inventor and thereby satisfy the requirements set out in Article 81, first sentence, EPC. This question is relevant for the main request.

The second question concerns the statement on the origin of the right to the European patent pursuant to Article 81, second sentence, EPC: to comply with the EPC is it enough for an applicant to file any declaration irrespective of its content, or does the latter need to satisfy specific requirements? This issue is relevant for the auxiliary request.

The last and related question concerns the role of the EPO, and more precisely whether and to what extent the EPO can examine and object to statements filed under Article 81, first and second sentence, EPC. This question is relevant for both requests.

In dealing with these matters, the Board considers it useful to first explain how it interprets the relevant provisions of the EPC. After this, the requests on file will be addressed. A third section deals briefly with possible objections to the Board's conclusions.

4.2 *Legal framework*

The application has been rejected because the inventor's designation did not comply with Article 81, first and second sentence, and Rule 19 EPC. However, further provisions are relevant for the assessment of the appeal as well as for the reasoning of the decision under review. These are discussed below.

4.2.1 *Article 81 EPC*

According to Article 81 EPC "[t]he European patent application shall designate the inventor" (first sentence); where the applicant is not the inventor or is not the sole inventor "[t]he designation shall

contain a statement indicating the origin of the right to the European patent" (second sentence). This obligation for the applicant is complementary to the right of the inventor, set out in Article 62 EPC, to be mentioned as such before the EPO.

To implement these provisions, Rule 20 EPC provides that "[t]he designated inventor shall be mentioned in the published patent application and the European patent specification, unless the inventor informs the European Patent Office in writing that he has waived his right to be mentioned". Under Rule 21 EPC, "[a]n incorrect designation of an inventor shall be rectified upon request and only with the consent of the wrongly designated person". Where such a request is filed by a third party, the consent of the applicant or the proprietor of the patent is required. Provisions to the same effect were already included in the implementing regulations to the EPC 1973.

It follows from the wording of Article 81 and the aforementioned secondary legislation that the designation of the inventor is a mandatory requirement of the application. However, the inventor is not mentioned in the publication if they ask not to be. The statement on the origin of the right to the invention is in turn an integral part of the designation of inventor, but only where applicant and inventor are not the same person.

Article 81, second sentence, EPC does not require a generic explanation as to why an applicant, who is not the inventor, is entitled to file a European patent application. The provision is more specific: it refers to the "origin of the right to the European patent". In this way, by its very wording, Article 81 EPC

establishes a link to Article 60 EPC, where the right to a European patent is mentioned and provided for.

4.2.2 *Article 60(1) EPC*

Under Article 60(1), first sentence, EPC, "[t]he right to a European patent shall belong to the inventor or his successor in title". According to Article 60(1), second sentence, EPC, "[i]f the inventor is an employee, the right shall be determined in accordance with the law of the State in which the employee is mainly employed". Default rules are provided in Article 60(1), third sentence, EPC, for the case where this State cannot be determined.

Article 60(1) EPC is a stand-alone substantive provision of the EPC and fulfils three functions. Firstly, it creates the right to the European patent; secondly, it vests this right in the inventor; finally, it provides for the separate transferability of the right even before a European application is filed.

Article 60(1) EPC envisages two ways to acquire the right to a European patent: the first is to develop the invention ("inventor"), and the second is to derive the right from the inventor after an invention has been made ("successor in title").

Both the concepts of inventor and successor in title are notions of the EPC; they must be interpreted uniformly and autonomously. While the concept of inventor does not require any support from domestic legislation, the concept of successor in title implies an interaction with national law. Indeed, the EPC has not established a comprehensive, self-sufficient legal

order and private law. This does not mean that Article 60(1) EPC constitutes a pure reference to national legislation devoid of any content. "Successor in title" has an ordinary meaning under Article 31(1) of the Vienna Convention on the Law of Treaties (1969) ("VCLT"): it refers to a situation where a *pre-existing* right goes from one subject (the legal predecessor; see also Article 55(1)(a) EPC) into the sphere of another (the legal successor, Article 60(1) EPC). National law governs the question of whether the transfer is valid or has occurred by operation of a contract, inheritance or other rules of law. Since the EPC is silent on the matter with the exception of employment relationships, a national court seized with the issue will identify the applicable rules according to their domestic conflict of laws-provisions (van Empel, *The Granting of European Patents*, Leiden 1975, 81; Ubertazzi, *Profili soggettivi del brevetto*, Milano 1985, 281; Cronauer, *Das Recht auf das Europäische Patent*, 1988, Köln et al, 105).

However, when national courts decide on entitlement under the Protocol on Jurisdiction and the Recognition of Decisions in respect of the Right to the Grant of a European Patent, they must apply Article 60(1) EPC and not the provisions governing entitlement to national patents. Therefore, even if, e.g., UK or Australian law provided for other forms of acquiring originally or deriving the right to the patent (such as possession) and these forms went beyond the scope of Article 60(1) EPC, as suggested by the appellant, these rules would apply to domestic applications, but not to European patents, the right to which is attributed to the subjects listed in Article 60(1) EPC and no one else.

In view of the normative link between Article 60(1) and

Article 81 EPC, not just any declaration, irrespective of its content, can be considered to comply with the EPC. It must be one which identifies the origin of the right in a manner consistent with Article 60(1) EPC. This is the case where the declaration identifies the applicant as the employer or the successor in title of the inventor.

4.2.3 *Role of the EPO*

Under Article 60(3) EPC "the applicant shall be deemed to be entitled to exercise the right to a European patent". Under Rule 19(2) EPC "[t]he EPO shall not verify the accuracy of the designation of the inventor". Finally, the EPC contains no rules which the EPO could apply in assessing whether or not the statement required by Article 81, second sentence, EPC, plausibly explains the origin of the right to the European patent. In view of this background, it is arguable - and it has been argued by the appellant - that the EPO should not and cannot examine the designation of the inventor, including the statement on the origin of the right to the patent. The Board disagrees with this contention. Indeed, under Article 90(3) EPC, "the European Patent Office shall examine (...) whether the requirements in Articles 14, 78 and 81 (...) have been satisfied". In the Board's view, this means that in the case of the designation of the inventor the EPO must check whether the request for grant or the separate statement identifies an inventor within the meaning of the EPC. Where the applicant is not the inventor, it must also examine whether the statement filed under Article 81, second sentence, EPC identifies an origin for the right to the patent which falls within the scope of Article 60(1) EPC. The EPO must only examine whether the statement filed

under Article 81, second sentence, EPC, assuming that it is correct, refers to a situation encompassed by Article 60(1) EPC. It does not need to assess whether, according to the relevant law, the applicant was *de jure* entitled to file the application, or if the relevant transaction or relationship was valid and really occurred. The examination is only a formal assessment: it does not require the EPO to identify any applicable law, assess evidence, or examine whether a designation is accurate or true entitlement exists. For this reason, the Board deems such an examination to be consistent with the principles set out in Article 60(3) EPC and Rule 19(2) EPC.

4.3 *Main Request*

4.3.1 The main request is not allowable because the designation of the inventor does not comply with Article 81, first sentence, EPC. Under the EPC the designated inventor has to be a person with legal capacity. This is not merely an assumption on which the EPC was drafted. It is the ordinary meaning of the term inventor (see, for instance, Oxford Dictionary of English: "a person who invented a particular process or device or who invents things as an occupation"; Collins Dictionary of the English language: "a person who invents, esp. as a profession").

4.3.2 There is no reason to assume that the EPC uses the term in a special way departing from its ordinary meaning. When a provision of the EPC 2000 refers to or includes the inventor(s), it uses the terms person or legal predecessor (e.g., Article 60(2) EPC or Article 55(1) EPC). So did the EPC 1973 in the corresponding legal provisions. Article 60(1) EPC vests the rights to the European patent in the inventor; thus, it postulates a

person with legal capacity. In this context, with the secondary legislation (Rule 19 EPC) invoked by the Receiving Section supporting this interpretative outcome, it is not necessary to resort to the travaux for the analysis. There is no lexical or contextual ambiguity which the Board needs to dispel.

- 4.3.3 It is possible under the Vienna Convention to adopt an interpretative approach which relies on the purpose of Article 81 EPC (G 1/18, Reasons, point 3), or an evolutive reading which considers subsequent practices or agreements of the Contracting States (Article 31(3) VCLT; on these concepts see Metzger, *Interpretation of IP Treaties in Accordance with Art 31-33 VCLT: A Case Study on the Practice of the European Patent Office* (July 14, 2020), forthcoming, Henning Große Ruse-Khan, Axel Metzger (eds.), *Intellectual Property Beyond Borders* (tbc), 2020/2021, available at SSRN: <https://ssrn.com/abstract=3650364> or <http://dx.doi.org/10.2139/ssrn.3650364>). However, neither of these methods would help the appellant's case. The purpose of the provisions dealing with the inventor and its designation is primarily to confer and to protect rights of the inventor (J 8/82, Reasons, points 12-13), to facilitate the enforcement of potential compensation claims provided under domestic law, and to identify a legal basis for entitlement to the application (on this see also the EPO President's comments, points 5-9). Designating a machine without legal capacity can serve neither of these purposes.

- 4.3.4 The existence of a subsequent practice or agreement which could allow the Board to overcome the language of the treaty was neither argued nor shown in these proceedings. The decision from the UK Court of Appeal (Facts and Submissions, XIII) supports the opposite

theory: the term inventor was not interpreted as covering an apparatus or a device. In any event, this ruling concerns domestic provisions which govern national applications, and not Article 60 EPC. The judgement of the Federal Court of Australia of 30 July 2021 (Facts and Submissions, XIII) is not from an EPC Contracting State.

- 4.3.5 The further policy arguments made by the appellant, based on the right of the public to know how the invention was made or fairness concerns, cannot change an interpretation based on the plain language of the EPC. They are also not convincing.
- 4.3.6 There is no normative basis for the alleged right of the public to know who the inventor is and how the invention was made. This aspect is not relevant under Article 83 EPC. Neither is it relevant for the rules governing the designation of the inventor. Whether the latter is published depends only on a unilateral decision of the inventor. The same holds true for the correction of wrong designations. Third parties have no rights in this regard. These rules are hardly reconcilable with the theory that the public has a right under the EPC to know who the inventor is (see also the analysis in Stierle, GRUR Int. 2020, 918, 923; this article was referred to in the EPO President's comments, fn. 8).
- 4.3.7 As to the argument of fairness, even if it was relevant under the EPC, it does not require allowing an applicant to designate a machine as inventor. Applicants can explain how the invention was made elsewhere, and in particular in the description. This is not required, but also not prohibited by the EPC.

4.3.8 In view of the above considerations the Receiving Section was right to raise an objection under Article 90(3) EPC. The EPO is entitled to verify that the designation identifies an inventor within the meaning of the EPC.

4.3.9 In summary, the main request does not comply with the EPC, because a machine is not an inventor within the meaning of the EPC. For this reason alone it is not allowable. There was no need to consider the requirements set out in Article 81, second sentence, EPC.

4.4 *Auxiliary request*

4.4.1 The auxiliary request relies on the argument that Article 81, first sentence, EPC does not apply where the application does not relate to a human-made invention. The Board agrees with this approach. The provisions concerning the designation were drafted to confer specific rights on the inventor. It is arguable that where no human inventor can be identified, then the ratio legis of Article 81, first sentence, EPC does not apply.

Where inventor and applicant differ, however, a statement on the origin of the right to the European patent is necessary under Article 81, second sentence, EPC. This provision remains applicable whether an invention was made by a person or by a device.

4.4.2 According to the statement accompanying the auxiliary request, the appellant has derived the right to the European patent as owner and creator of the machine. This statement does not bring the appellant within the scope of Article 60(1) EPC. Indeed, it does not refer

to a legal situation or transaction which would have made him successor in title of an inventor within the meaning of the EPC. For this reason, the auxiliary request does not comply with Article 81, second sentence, EPC in conjunction with Article 60(1) EPC, and is not allowable.

4.5 *Referral to the Enlarged Board of Appeal*

4.5.1 The appellant asked that the Board refer two questions to the Enlarged Board of Appeal, both relating to the applicability of Article 81, first sentence, EPC (see above, Facts and Submissions, XI).

Under Article 112 EPC the Board has to refer questions when the answer to them is necessary to decide on the appeal. This requirement was not met for the questions concerned.

4.5.2 As far as the auxiliary request is concerned, whatever the answer given to the referral questions, it would not change the outcome. The auxiliary request is not allowable because of Article 81, second sentence, EPC, and not because of Article 81, first sentence, EPC.

4.5.3 The main request, in turn, does not rely on the contention that the requirement set out in Article 81, first sentence, EPC does not apply to the present case. Instead, it relies on the argument that the appellant has the right to satisfy that requirement by indicating a machine as inventor. The only question which would be relevant for this request is therefore whether an entity without legal capacity can be an inventor within the meaning of the EPC. For the reasons set out above the answer to this question follows from the plain wording of the EPC and the function of the designation

requirements. There is no subsequent practice or agreement which could be invoked to challenge this answer. For this reason, a referral did not appear necessary to dispose of this request as well.

4.6 *Objections*

4.6.1 There are two conceivable objections to the Board's conclusions on the auxiliary request and the request for a referral. These are in part based on submissions of the appellant, in part reformulated or supplemented by the Board for the sake of clarity.

4.6.2 Firstly, under Article 52(1) EPC any invention which is novel, industrially applicable and involves an inventive step is patentable. The appellant has argued that the scope of this provision is not limited to human-made inventions. The Board agrees. How the invention was made apparently plays no role in the European patent system. This is true even for the morality clause of Article 53(a) EPC: an invention is excluded where its future exploitation would be offensive. Whether its making, namely "the inventor's activities during making or development of his invention" might be regarded as contrary to "ordre public" or morality, is irrelevant for the plain letter of Article 53(a) EPC (see T 0866/01, Reasons, point 5.6; T 315/03, Reasons, point 4.2). Therefore, it is arguable that AI-generated inventions too are patentable under Article 52(1) EPC. If national courts were to follow this interpretation, the scope of Article 52(1) EPC and Article 60(1) EPC would not be coextensive: there would be inventions patentable under Article 52(1) EPC, for which no right to a patent is provided under Article 60(1) EPC.

- 4.6.3 Secondly, filing a statement on the origin of the right to the European patent is a requirement under the EPC where inventor and applicant differ. It is only a formal requirement. Its function can reasonably be seen only as informing the public on the possible origin of the right, so that determined third parties, who may be entitled to the subject-matter disclosed in the application, can react and start proceedings in national courts (see also the observations made in the ruling *Nippon Piston Ring Co's Application* [1987] RPC 120, 131, to which the judgement of the UK Court of Appeal submitted by the appellant refers). It would be disproportionate to deny protection to patentable subject-matter for failing to fulfil such a formal requirement. This is because of the limited additional utility which this statement may have for the public or the individual parties and in view of the absence of a full examination on the actual merits by the EPO.
- 4.6.4 Therefore, as for the designation of the inventor under Article 81, first sentence, EPC, here too the Board could consider that the lawmakers had in mind only human-made inventions in drafting Article 60 EPC and Article 81, second sentence, EPC. Consequently, the Board could provide that no statement on the origin of the right is required where the application concerns an invention developed by a machine or accept any statement irrespective of its content. Where the Board would not be ready to go that far, it would at least have to *ex officio* refer questions relating to Article 81, second sentence, EPC to the Enlarged Board of Appeal.
- 4.6.5 In the Board's view these objections share a weakness: in order to consider them and set aside the decision under appeal it would be necessary to fully ignore a

formal requirement of the EPC. The Board believes that it should refrain from this step in this case for at least three reasons.

4.6.6 Firstly, the Board is not convinced that there is a problem of unequal treatment of specific applicants and categories of inventions which is in conflict with the objective purpose of the EPC and calls for an evolutive interpretation of the law. The Board is not aware of any case law which would prevent the user or the owner of a device involved in an inventive activity to designate himself as inventor under European patent law. The EPC, in turn, does not prevent the applicant from providing information in the application which is not relevant for carrying out the invention but may satisfy the fairness concerns identified by the appellant in the addendum of 24 July 2019 (see above, Facts and Submissions, XIV). Secondly, it is the task of the lawmakers to amend the EPC and to assess whether a real problem exists. Different solutions may be conceivable to the issue raised by the appellant. It is not for the Board to select one of the possible approaches. Finally, the Board is not aware of any other proceedings which concern an unrelated application and where these issues have become relevant.

4.6.7 For these reasons the Board did not consider it necessary either to *ex officio* involve the Enlarged Board of Appeal on the interpretation of Article 81, second sentence, EPC.

5. *Procedural aspects*

- 5.1 The appellant has not requested to set aside the decision under appeal based on the alleged procedural violations (see Facts and Submissions, VIII). Nor has he requested that the appeal fee be refunded. However, in light of the submissions the appellant made both in the statement setting out the grounds of appeal and the letter of 14 September 2021, the Board has to consider *ex officio* whether a procedural violation has taken place.
- 5.2 According to the Board the Receiving section was competent to issue the decision under appeal. The application was rejected because it did not comply with the formal requirements set out in Article 81 EPC. It is the task of the Receiving Section to examine compliance with this provision, as provided by Articles 16 and 90(3) EPC. In the Board's view it is irrelevant that substantive provisions may have or had an impact on the interpretation of the relevant procedural provisions (see above, point 4.2).
- 5.3 Concerning the new evidence on which the decision allegedly relies (see above, Facts and Submissions, VIII, (a)), the allegation was not substantiated. The reasons for the refusals were anticipated in the annex to the summons. The decision includes some references to national law which were not anticipated in that preliminary opinion. However, they only support the conclusions of the Receiving Section. The basis for the decision is that under the EPC the inventor must be a natural person.
- 5.4 The EPO's refusal to publish the designation as filed only implemented the Receiving Section's preliminary opinion that that designation was formally deficient. It cannot constitute a procedural violation. The same

holds true for the issue of two distinct decisions. The Receiving Section consolidated the proceedings, but not the applications, which remain separate and distinct.

- 5.5 The decision to refuse the application before the time limit set out in Rule 60(1) EPC expired was, by contrast, not justified. The EPO President contends that under the EPC and the case law quoted (see above, Facts and Submissions, XV(d)) it was possible to implicitly waive a right, and this occurred in the first instance proceedings. The Board does not share this opinion for two reasons.
- 5.6 Firstly, the decisions referred to are not pertinent to the issue. They all concern the admission of *late* filed requests or submissions. An applicant or a patent proprietor has no right to file new requests on appeal, and he cannot waive any entitlement in this respect. The same holds true for the oral proceedings before an opposition division. Decision T 936/09 (Reasons, point 1.14) also did not deal with the surrender of a right. The Board in T 936/09 considered the appellant's conduct in the first instance proceedings to be of significance only when considering the admissibility of a request or exercising discretion under Article 12(4) RPBA 2007. Therefore, the Board was not referred to any established case law concerning waivers which would support the EPO President's statement. The present Board is not aware of any such case law. To the contrary: several decisions state that in accordance with the maxim "*a jure nemo recedere praesumitur*" (see G 1/88 OJ 1989, 189, Reasons, point 2.4) in the absence of an explicit withdrawal "surrender of a right cannot be simply presumed" (T 1157/01, Reasons, point 6; T 1567/17, Reasons, point 2.3.1 (a); T 1051/20, Reasons,

point 1.4; see also T 1548/11, Reasons, point 1.3).

5.7 Secondly, even if it were possible under the EPC to tacitly waive a right, the Board is of the view that any relevant waiver must be unequivocal (T 0388/12, Reasons, point 4.2). The latter requirement was not met in the present proceedings. The appellant was summoned with a reference to the right to file a designation within sixteen months (see above, Facts and submission, IV). In view of the information provided in the Annex the Receiving Section should have at least explained, before announcing a decision, that it was about to refuse the application unless an EPC-compliant designation was filed *at the oral proceedings themselves*. The minutes do not provide evidence that it did. Against this background, the mere statement that the appellant had no further comments did not represent an unequivocal waiver of the right to file a declaration within the remaining time under Rule 60(1) EPC.

5.8 Nevertheless, the Board neither considers it appropriate to set the decision aside for this reason, nor equitable to refund the appeal fee. The Board is not convinced that there is a causal link between the procedural violation and filing the appeal. The appellant has not filed a designation indicating as inventor a natural person with the statement of grounds of appeal. He has maintained the requests pending before the Receiving Section. While this subsequent behaviour cannot support the theory that the appellant surrendered his right at the oral proceedings, it does support the view that even if the time limit had not been cut, the appellant would have maintained his position and not designated a person as inventor. Thus, the appeal would have been necessary anyway.

Order

For these reasons it is decided that:

The request for referral of questions to the Enlarged Board of Appeal is refused.

The appeal is dismissed.

The Registrar:

The Chairman:



A. Voyé

W. Sekretaruk

Decision electronically authenticated