EIP

Protecting Artificial Intelligence Inventions in the UK

Last year, the UK IPO called for views on the relationship between Artificial Intelligence (AI) and the intellectual property (IP) system. On 23 March 2021, the UK IPO published their response to the views that were submitted by the respondents. This update briefly summarises the findings affecting patents. The responses on the other areas of IP can be viewed here.

Ambition

As recognised in the UK IPO's summary of the consultation outcome, AI is becoming increasingly significant in many areas of our lives. The UK is ambitiously striving to become a leader in AI technology and wants to be at the forefront of IP matters relating to AI. However, in jostling with the challenges brought on by new technologies such as AI, the IP system is likely to require adaptation and the recent consultation is part of the process of looking ahead at the potential issues with the current UK legal framework.

The Questions

The consultation included a raft of questions across all areas of IP. In terms of the patent issues, the questions covered the aims of the patent system, inventorship, entitlement, the conditions for granting a patent, and infringement. Respondents were not just IP professionals but also businesses, and academics, for example.

With regard to the aims of the patent system, the UK IPO identified that even for respondents expressing the overall view that the patent system was good for AI

development, there was a general theme that the patent system needs to be fair and balanced. Positive points identified for the patent system include the publication of research and also the important role patents can play in securing investment. These positive points need, however, to be balanced against the ability of patents to deny access to technology.

When looking at inventorship issues, the recent DABUS (Device for the Autonomous Bootstrapping of Unified Sentience) decisions from the UK IPO, EPO and US PTO were brought to the fore by many respondents. The DABUS decisions address the issues of naming AI as an inventor and represent one example of where the patent system is perhaps ill-suited to cope with inventions from AI. For a detailed discussion on the DABUS decisions, please see this recent article in the Robotics Law Journal.

Around inventorship, it was noted that there were differing opinions in the submissions regarding whether AI can generate an invention or only play an assistive role. However, there was widespread agreement in the responses to the consultation that entitlement to any patent should be given to the AI's owner, user, or developer, rather than to the AI system itself. This is unsurprising given the practical difficulties that would arise, for example in relation to assigning or licensing, if an AI system itself owned a patent.

The majority of respondents indicated that the difficulty in getting patents was a problem for the AI sector. The impact of the patent exclusions was a main concern, although the general view was that there was no need to change UK law. Many respondents did, however, feel that the UK IPO should change its practice on patent exclusion, particularly to bring it more in line with the EPO.

A specific gripe related to the UK IPO's practice of refusing search requests for AI inventions, in contrast to the more permissive approach adopted by the EPO. The importance of search results in assessing filing strategies for other countries was emphasised.

In terms of infringement, there was agreement that legal persons (individual or legal entity) should be liable when AI infringes a patent, which is in keeping with current practice. However, the challenges in establishing infringement by AI was considered as problematic as when trying to do so with other technologies. The UK IPO intends to let the courts use their flexibility to make decisions based on the facts of the case and therefore does not intend to intervene in this area.

Next Steps

The outcome of the patent consultation has led to several immediate future actions by the UK IPO. One action is to further consult, later in 2021, on future legal framework changes for protecting AI-generated inventions, which would otherwise not meet inventorship criteria. Another action is to review any differences in assessing AI inventions compared with the European Patent Office (EPO) so that the Manual of Patent Practice (MOPP) can be specifically enhanced on patent exclusion practice for AI inventions to make the outcomes more transparent. As usual, EIP will endeavour to keep abreast of these future actions from the UK IPO to ensure technical innovations created in AI are best protected by the available legal framework at the time.

For expert advice on the role of IP in AI inventions, please speak to a member of our Digital team.

Written by Ritchie Daniel and David Brinck.