



PATENTS ACT 1977

APPLICANT	Stephen L Thaler
ISSUE	Whether the filing of divisional application GB2206827.4 meets the requirements of section 15(9) of the Act and whether the Form 7 filed on 22 December 2023 meets the requirements of s13(2)
HEARING OFFICER	Andrew Bushell

DECISION

Introduction

- 1 GB2206827.4 was filed with the UKIPO as a divisional application from national phase application GB2105428.3 (the parent application) on 10 May 2022. The parent application entered the UK national phase on 16 April 2021 with a PCT filing date of 17 September 2019 and an earliest priority date of 17 October 2018. The compliance period for both applications expired on 17 April 2023.
- 2 Following the filing of the divisional application, a question was raised as to whether the parent application satisfied the requirements of section 13(2) of the Act. This resulted in office decision [BLO/447/22](#) being issued on 24 May 2022. In his decision, the hearing officer found that whilst the AI “creativity machine” called DABUS had been “accepted” as an inventor in the PCT international phase, this did not preclude the UK IPO from assessing and objecting to this under s13(2) of the Patents Act in the national phase. As the Court of Appeal ruled on two related applications ([\[2021\] EWCA 1374](#)) that AI machines could not be named as inventors under s.13(2), the hearing officer concluded the parent application should be deemed withdrawn for the same reason.
- 3 The Court of Appeal judgment on these related applications was appealed further to the Supreme Court, so any formal action with respect to the withdrawal of parent application GB2105428.3 was stayed until an outcome was reached.
- 4 On 20 December 2023 the Supreme Court dismissed the applicant’s appeal ([\[2023\] UKSC 49](#)), agreeing with the judgment of the Court of Appeal that an AI machine cannot be named as an inventor under section 13(2) of the Patents Act.

- 5 As the judgment reinforced the hearing officer's decision in BLO/447/22 the parent application was retrospectively deemed withdrawn as of 17 June 2021, two months after entry into the national phase, in line with the requirements of section 13(2) and rule 68(2)(b) of the Patents Rules. The retrospective nature of this withdrawal means the parent application was deemed withdrawn before the divisional application was filed. However, this withdrawal was administered incorrectly, meaning the register currently shows the parent application as terminated from 24 May 2022, which is after the divisional application in question was filed.
- 6 Divisional application GB2206827.4 was filed in the name of Stephen L. Thaler however the accompanying Form 7 included a statement that "the applicant identifies no person or person's whom he believes to be an inventor". The derivation of right on the form 7 claimed that Mr Thaler was entitled to file for the patent by virtue of section 7(2)(b) of the Act. The Office objected to this form as it failed to name an inventor, as required by section 13(2) of the Patents Act. The applicant filed a second Form 7 on 8th July 2022, two days prior to the deadline for overcoming the objection. The applicant amended the derivation of right to claim Mr Thaler was entitled to file for the patent under section 7(2)(c) of the Act. Once again, the form contained the same statement that the applicant could not identify any person or persons whom he believes to be an inventor.
- 7 On 22 December 2023, in view of the Supreme Court judgment on the related applications the applicant filed an amended description and replacement Form 7 for divisional application GB2206827.4, this time naming Stephen L. Thaler as the sole inventor. The Office again deemed the Form 7 did not meet the requirements of s.13(2) and that it had been filed out of time, which is why the application came before me at a hearing.
- 8 The hearing was held via Microsoft Teams at 10am on 23 May 2024 and was attended by myself, Robert Jehan the applicant's attorney, and Deputy Director Huw Jones who was present as an observer.

Issues

- 9 In this decision there are several issues I need to decide, many of which are dependent on each other. Nevertheless, I will address each matter separately before reaching my conclusion.
- 10 The issues in question are as follows:
 - Can divisional application GB2206827.4 be deemed to have been filed on time given its parent application GB2105428.3 was retrospectively withdrawn prior to the date on which it was lodged?
 - If GB2206827.4 is taken to have been filed on time, should it be refused given the compliance period for placing the application in order has expired?
 - Can the latest Form 7 filed on the divisional application on 22 December 2023 be deemed to have been filed on time?

- If the Form 7 is taken to be filed on time, does it meet the requirements of s13(2) of the Act?

11 I will deal with each issue below.

Issue 1 - Was application GB2206827.4 filed on time?

12 Section 15(9) of the Patents Act prescribes the following conditions for filing a divisional application:

15 (9) Where, after an application for a patent has been filed and before the patent is granted -

- *(a) a new application is filed by the original applicant or his successor in title in accordance with rules in respect of any part of the matter contained in the earlier application, and*
- *(b) the conditions mentioned in subsection (1) above are satisfied in relation to the new application (without the new application contravening section 76 below), the new application shall be treated as having, as its date of filing, the date of filing the earlier application.*

13 Further conditions, including the time periods, for making such a filing are set out in rule 19 of the Patents Rules:

New applications filed as mentioned in section 15(9)

19. (1) For the purposes of section 15(9) a new application may only be filed in accordance with this rule.

(2) A new application may be filed as mentioned in section 15(9) if—

(a) the earlier application has not been terminated or withdrawn; and

(b) the period ending three months before the compliance date of the earlier application has not expired.

(3) A new application must include a statement that it is filed as mentioned in section 15(9).

14 GB2206827.4 was filed on 10 May 2022 at which time it's parent application GB2105428.3 was still "live", pending the decision subsequently issued on 24 May 2022.

15 As stated above the decision concluded the parent application should be deemed withdrawn for failure to meet the requirements of s.13(2) of the Patents Act. However, the actioning of this withdrawal was stayed pending the outcome of related proceedings in the Supreme Court on whether an AI machine could be listed as an inventor.

16 The Supreme Court judgment on 20 December 2023 supported the comptroller's position that an AI machine could not be named as an inventor for a UK patent

application, which meant that GB2105428.3 could now be deemed withdrawn for failing to meet the requirements of s13(2) of the Patents Act set out below.

Section 13(2)

Unless he has already given the Patent Office the information hereinafter mentioned, an applicant for a patent shall within the prescribed period file with the Patent Office a statement

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- *(a) identifying the person or persons whom he believes to be the inventor or inventors; and*
- *(b) where the applicant is not the sole inventor or the applicants are not the joint inventors, indicating the derivation of his or their right to be granted the patent; and, if he fails to do so, the application shall be taken to be withdrawn.*

- 17 Rule 10(3) in conjunction with rule 68(2)(b) sets the period in which an applicant must supply the comptroller with the details of any inventor(s):

Rule 10(3)

Subject to rules 21, 58(4), 59(3) and 68(2), the period prescribed for the purposes of section 13(2) is sixteen months beginning immediately after—

(a) where there is no declared priority date, the date of filing of the application; or

(b) where there is a declared priority date, that date.

Rule 68 (2)

The period prescribed for the purposes of section 13(2) is—

(a) the period prescribed by rule 10(3); or

(b) if it expires later, the period of two months beginning immediately after the date on which the national phase begins.

- 18 As the parent application was a national phase application with an earliest date of 17 October 2018, the deadline for meeting the requirements of s.13(2) was 16 June 2021, two months after the date it entered the national phase.
- 19 It is IPO practice that decisions regarding the withdrawal/termination of an application are applicable ex tunc, meaning in this case GB2105428.3 must be taken to be withdrawn as of 17 June 2021, the day after the last day it was possible to meet the requirements of s13(2). This approach is supported by the hearing officer's decision in [Siemens Medical Systems Inc., \(BL063/00\)](#), which whilst slightly different to the circumstances in this case confirms IPO practice is to apply the date of withdrawal ex tunc, rather than ex nunc.
- 20 Both in their skeleton arguments and at the hearing the attorney presented evidence that the register currently displays the not in force date of the parent application as 25 May 2022, rather than 17 June 2021. It appears this is an internal error caused by the date of the office decision being incorrectly entered into the register as the date

of termination. Whilst this is unfortunate, it is clearly incorrect, therefore I must use the vires available to me under rule 107 to correct the register to reflect the date of termination as 17 June 2021.

- 21 It is clear from rule 19(2)(a) above that a divisional application under s15(9) can only be filed if the parent application has not been terminated or withdrawn. As the retrospective withdrawal of its parent application occurred prior to this application being filed, divisional status cannot be attributed to GB2206827.4
- 22 Whilst the agent did not cite any UK case law to dispute this point, at the hearing they referred to decision G1/09 of the EPO Enlarged Board of Appeal to demonstrate that under the EPC substantive rights in a patent application remain pending until the outcome of any appeal is known. They argue this is a well-established rule of law and the same should be true of UK applications awaiting a decision. The attorney claimed that, if at the time of filing GB2206827.4 the parent application was still pending, this is enough to meet the requirements of rule 19(2)(a).
- 23 In this decision of the Enlarged Board of Appeal it was concluded that a patent application refused by the Examining Division remains pending until the expiry of the period for filing an appeal. The decision deals with the effective date of a refusal by the Examining Division as opposed to the effective date when an application should be deemed withdrawn for its failure to meet formal requirements, and so does not assist in the present case.
- 24 Whilst I have some sympathy with the applicant's position, rule 19(2)(a) is clear that for a divisional application to be filed the parent application cannot be terminated or withdrawn. It does not go so far as to suggest this only applies at the time of filing, presumably to cover the fact that all terminations/withdrawals take effect ex tunc, which as in this case could affect the filing of any divisional application retrospectively.
- 25 I must therefore rely on the facts before me which show that parent application GB2105428.3 was deemed to be withdrawn some 11 months prior to GB2206827.4 being filed. As filing a divisional application from a withdrawn application is clearly prohibited under rule 19(2)(a), GB2206827.4 must now proceed without divisional status.
- 26 The consequences of this have already been set out in an e-mail to the attorney dated 30 April 2024. As the parent application and corresponding international application have both been published it is highly likely GB2206827.4 will be anticipated by these earlier publications and would be refused for failing to comply with the requirements of section 1(1)(a) of the Patents Act. However, there is no need for me to consider this issue further as I believe the application fails on several other points set out below.

Issue 2 – Should GB2206827.4 be refused for not being in order when the compliance period expired?

- 27 As GB2206827.4 cannot be granted divisional status I no longer need to decide on this point.
- 28 With GB2206827.4 no longer proceeding as a divisional application it has an effective filing date of 10 May 2022, meaning its compliance period does not expire until 10 November 2026.

Issue 3 – Was the third Form 7 filed on 22 December 2023 submitted on time?

- 29 As referred to in paragraph 13, the period for filing a Form 7, set out in rule 10(3) of the Patents Rules, is 16 months from the earliest date of an application. As GB2206827.4 is no longer afforded divisional status this 16-month period runs from 10 May 2022, the new filing date of the application. Therefore, on the face of things, it appears the third Form 7 filed on 22 December 2023 has been filed late, as the deadline for submitting this information expired on 10 September 2023.
- 30 However, at the hearing the agent argued the latest Form 7 was merely a request to correct the existing Form 7 following the decision by the Supreme Court in related applications GB1816909.4 and GB1818161.0, and therefore no firm deadline applies. I must therefore look at the law regarding corrections to consider this further.

Section 117

Correction of errors in patents and applications

Section 117.-(1) The comptroller may, subject to any provision of rules, correct any error of translation or transcription, clerical error or mistake in any specification of a patent or application for a patent or any document filed in connection with a patent or such an application.

Rule 49

Correction or change of name or address; correction of address for service

Rule 49.—(1) Any person may request that a correction be entered in the register or made to any application or other document filed at the Patent Office in respect of any of the following— (a) his name; (b) his address; (c) his address for service.

(2) A request under paragraph (1)(a) to correct a name must be made on Patents Form 20.

(3) Any other request under paragraph (1) must be made in writing.

(4) If the comptroller has reasonable doubts about whether he should make the correction— (a) he must inform the person making the request of the reason for his doubts; and (b) he may require that person to file evidence in support of the request.

(5) If the comptroller has no doubts (or no longer has doubts) about whether he should make the correction, he must enter the correction in the register or make it to the application or document.

(6) For the purposes of this rule a request for a correction includes— (a) a correction made for the purposes of section 117; and (b) a change to any of the matters listed in paragraph

(1)(a) or (b) in respect of an entry recorded in the register or made to any application or other document filed at the Patent Office.

- 31 Section 117 of the Manual of Patent Practice provides further guidance in relation to correcting a Form 7.

117.22 An error in Form 7 may be corrected after the end of the period allowed for filing this form following a request in writing, except for correction of a name which must be made on Patents Form 20. (For effecting a change in Form 7 before the end of this period, see 13.14). If there are reasonable doubts about whether the correction should be made, the comptroller should inform the person making the request of the reason for their doubts and ask that person to file evidence in support of the request. A copy of the corrected Form 7 should be sent to each inventor. The decision in *Payne's Application* (see 117.19) means that s.117 cannot be invoked to overcome the mandatory requirements of s.13(2) (see 13.14).

- 32 Paragraph 13.14 states:

13.14 A defect in the form may be rectified by filing a fresh form, provided that the prescribed period has not expired or, if it has, an extension has been allowed (see 13.11). (If the application is one where copies of Form 7 are sent to the inventors (see 13.15), they should be sent copies of the replacement form). No evidence is needed to substantiate this alteration, but if the prescribed period and any extension has expired the only way in which the information on the form can be changed is (in an appropriate case) by submitting a written request to correct an error (see 117.22). However if any discrepancies are minor, so that the requirements of r.10(3) can be regarded as having been complied with, they can be rectified, within a period specified by the Office. An insufficient indication of the derivation of title (see 13.09) is not regarded as a minor discrepancy, and if the prescribed period has expired an extension of the period would need to be sought under r.108 to enable the required information to be supplied. The decision in *Payne's Application* [1985] RPC 193 means that s.117 cannot be invoked to overcome the mandatory requirements of s.13(2) (see 13.13).

- 33 It is the final sentence in both the above paragraphs which is of interest here as the attorney is attempting to use a correction under s.117 to overcome the mandatory requirements of s.13(2). The mandatory requirements of s.13(2) are that the applicant should notify us of any inventors and how the applicant derived the right to apply for the patent within 16 months of the earliest date of the patent. As this deadline had expired prior to the most recent Form 7 being filed, I must conclude that *Payne's* application prevents s.117 from being used to correct the original Form 7 to identify a different inventor and provide an accompanying derivation of right.

- 34 Whilst the attorney did not specifically request the use of rule 107 to extend the period for filing their Form 7, they questioned whether the Office made a procedural error by not objecting to the second replacement Form 7 filed on 08 July 2022.

- 35 I have consulted the file and I can see no reason as to why an objection was not made considering the form contained a defective derivation of right and failed to name any inventors attributed to the invention within the application. I can only assume the Office decided to stay the assessment of this Form 7 until the Supreme Court judgment in related applications GB1816909.4 and GB1818161.0 was passed down, much in the same way as the applicant waited themselves before submitting a corrected Form 7.

- 36 Therefore, the question is, was failing to object to the second Form 7 filed on 08 July 2022 a procedural error by the Office, and if so, can r.107 be used to extend the period for filing a replacement.

Rule 107

Correction of irregularities

107.—(1) Subject to paragraph (3), the comptroller may, if he thinks fit, authorise the rectification of any irregularity of procedure connected with any proceeding or other matter before the comptroller, an examiner or the Patent Office.

(2) Any rectification made under paragraph (1) shall be made— (a) after giving the parties such notice; and (b) subject to such conditions, as the comptroller may direct.

(3) A period of time specified in the Act or listed in Parts 1 to 3 of Schedule 4 (whether it has already expired or not) may be extended under paragraph (1) if, and only if— (a) the irregularity or prospective irregularity is attributable, wholly or in part, to a default, omission or other error by the comptroller, an examiner or the Patent Office; and (b) it appears to the comptroller that the irregularity should be rectified.

- 37 In my opinion the comptroller has erred by not objecting to the Form 7 filed on 08 July 2022 as there is no precedent for staying a preliminary examination to await the outcome of an appeal on related proceedings. However, my eye is drawn to rule 107(3)(b) which states “a period of time” should only be extended if it appears to the comptroller that the irregularity should be rectified. In deciding this it is prudent for me to consider whether the third form 7 filed on 22 December 2023 meets the requirements of s.13(2) of the Patents Act, as there seems little point extending the deadline if it fails to do so.

Issue 4 – Does the third Form 7 filed on 22 December 2023 meet the requirements of s.13(2) of the Act?

- 38 The third Form 7 filed on 22 December 2023 names Stephen Thaler as the inventor of the invention disclosed in application GB2206827.4, whilst the accompanying derivation of right states Dr Thaler is allowed to apply for the patent due to him being both applicant and inventor.
- 39 This information differs from the previous two Form 7s in which the applicant claimed they were “unable to identify any person or persons whom he believes to be an inventor”. The derivation of right is also different on these earlier forms, the first claiming that Mr Thaler was allowed to apply for the patent by virtue of an agreement and the second by virtue of being the successor in title to the inventor.
- 40 What I need to decide is whether this form meets the requirements of s.13(2)(b), i.e., does the naming of Stephen Thaler identify the person whom the applicant believes to be the inventor?
- 41 The Office position is that the naming of Mr Thaler as an inventor does not meet the requirements of s.13(2)(b) as it is clear from the previous Form 7s that Mr Thaler did not believe any person should be listed as an inventor on this application. In fact, the letter accompanying the second Form 7 dated 8 July 2022 specifically states that Dr Thaler “does not believe that he is the inventor in accordance with the requirements of the Act”.

42 The attorney argued at the hearing that the subsequent naming of Dr Thaler as inventor meets the requirements of s13(2), due to comments made by the comptroller's counsel at the Supreme Court appeal on related applications GB1816909.4 and GB1818161.0. These comments were included in the skeleton arguments submitted prior to the hearing and I have reproduced them below for ease of reference.

Lord Kitchin: Again, the last question on this, if I may. Knowing what we know now about this application and Dr Thaler's involvement so far as it's been described in the papers, *the Comptroller would not have had an objection, or perhaps would not have had the power to object, to this application proceeding in the name of Dr Thaler.*

(Time stamp: 19:34)

Stuart Baran: *Proceeding with Dr Thaler as the inventor? That's absolutely right. What would have happened if that form landed on the Comptrollers desk is nothing. Because, it ... nothing in the sense that there would have been no objection, we wouldn't be here today. Because a person would have been nominated, and the Comptroller won't say "well was it really him?" any more than they do in any other case where it's absolutely clear that it's entirely human involvement. We don't say "well, was it him, or was it his colleague Miss Bloggs" and we don't look to see if the person exists. We don't check the electoral roll. We are not empowered to do any of those things.*

- 43 The attorney has argued that this admission from comptroller's counsel (Stuart Barran), overrides the comptroller's previous position and allows for Dr Thaler to be named as an inventor on this application, with reference to the role of DABUS also allowed to be added into the specification.
- 44 However, on closer inspection I believe that counsel's comments have been taken out of context by the attorney. What counsel is referring to in these comments is the contents of box 7 on the Form 1 of these earlier related applications. He is merely clarifying that if these earlier applications had upon filing identified Dr Thaler as both applicant and inventor the Office would have accepted this on face value and no further investigations would have taken place.
- 45 I do not believe the comments of comptroller's counsel in any way imply that we can disregard what we already know regarding the declarations of inventorship on this divisional application. We have clear evidence on file that Dr Thaler has never believed he is the inventor of this application, therefore I cannot accept this latest change of mind.

- 46 I must therefore conclude the inventorship details provided on the latest Form 7 filed 22 December 2023 do not meet the requirements of s13(2) of the Act in identifying whom the applicant believes to be the inventor. Therefore, returning to issue three, there is little point in using the provisions within rule 107 to extend the 16-month period to allow this form to be filed on time.

Conclusion

- 47 Firstly, as the parent application GB2105428.3 was deemed withdrawn prior to the filing of GB2206827.4 I must conclude that the latter does not meet the requirements of section 15(9) of the Act and therefore cannot be awarded divisional status. As stated in paragraph 20 of this decision the withdrawal date of the parent application GB2105428.3 should be corrected on the patent register, so it correctly shows as 17 June 2021
- 48 As the applicant has failed to file a Form 7 which meets the requirements of s.13(2), application GB2206827.4 is now deemed to be withdrawn. As no work has begun on the search and examination requested on this application it will be remitted back to the examiner to provide a refund of these fees.

Appeal

- 49 Any appeal must be lodged within 28 days after the date of this decision.

ANDREW BUSHELL

Patent Examination Group Head