NEWSLETTER

Japan: IP High Court Says “AI cannot be an inventor” under the current patent act

IP Newsletter April 23, 2025

Author:
Noriya Ishikawa
n.ishikawa@nishimura.com
Kei Hattori
k.hattori@nishimura.com

Contents

Ⅰ Introduction

A patent application for “food container and devices and methods for attracting enhanced attention,” which named “DABUS” (the name of the AI system) as the inventor was dismissed by the Japan Patent Office on October 13, 2021. Thereafter, the plaintiff filed a lawsuit with the Tokyo District Court seeking revocation of the dismissal. The plaintiff’s challenge to the decision argued that the term “invention” in the Japan’s Patent Act should include AI-generated inventions created without the involvement of natural persons, and that it should not be mandatory to list a natural person as the inventor on a patent application. The Tokyo District Court ruled that inventors should be limited to natural persons, and therefore the dismissal was lawful. The plaintiff appealed, and the Intellectual Property High Court upheld the District Court ruling, affirming that the Japan’s Patent Act only recognizes natural persons as inventors.

Ⅱ Issues and Court Decision

1. Issues

The following issues were contested before the Intellectual Property High Court in Japan:

(1) Are the "inventions" protected by patent rights limited to those made by natural persons? (Issue (1))

(2) In national procedures related to an international patent application, is the "name of the inventor" a mandatory item in the domestic documents? (Issue (2))

2. Court Decision

(1) Ruling on Issue (1)

The Intellectual Property High Court ruled that the inventions protected by patent rights are limited to those made by natural persons, for the following reasons.
The Japan’s Patent Act (Act No. 121 of April 13, 1959) states that patent rights are granted through the

registration establishing patent rights, which occurs after a filing and examination process; for this reason, the Patent Act has the characteristics of a procedural law, which establishes a framework for the granting of patent rights, as well as those of a substantive law, which defines the requirements for obtaining and the effects of patent rights and the rights to obtain patents. As described below, any of the wording of the Patent Act assumes that the "inventor" is a natural person.

The Patent Act provides that, in principle, a person who makes an invention with industrial applicability can obtain a patent for the relevant invention. In the articles relating to employee inventions, the references to persons who make inventions only describe employees, officers, and other natural persons. Furthermore, comparing the terminology "*Shimei*" (for natural persons) with "*Meisho*" (typically for non-natural entities), only natural persons can be inventors because "*Shimei*" of the inventor must be stated in various patent application documents.

Under the Patent Act, in principle, when a natural person makes an invention, the right to obtain a patent on that invention originally is vested in that natural person. As an exception, the right to obtain a patent on employee inventions may originally vest in the employer under certain conditions; however, there are no provisions in the Patent Act that grant the right to obtain a patent to other subjects, and there are no provisions which describe procedures for granting a patent based on rights other than the right to obtain a patent or for granting a patent on the assumption that a subject other than a natural person could be or become an inventor. Therefore, it is considerable that the current version of the Patent Act grants patents on inventions for which the inventor is a natural person.

(2) Ruling on Issue (2)

The Intellectual Property High Court ruled that it is clear that the Patent Act requires that the "name of the inventor" be stated in the national application phase documents for international patent applications, for the following reason.

Article 184-5 of the Patent Act requires an applicant filing an international patent application to submit a document stating the name of the inventor to the Commissioner of the Japan Patent Office within the time limit for submitting national documents. The Commissioner of the Japan Patent Office may order an amendment to the procedure within an adequate, specified period if the national application phase documents, and related procedures, do not comply with the formal requirements set forth in Article 38-5(1) of the Ordinance for Enforcement of the Patent Act, which states that certain items, including the name of the inventor, must be set forth in the national phase documents. Then, the Commissioner of the Patent Office may dismiss the international patent application if the requested amendment is not made within the designated period (Article 184-5(3)). Therefore, it is clear that the "name of the inventor" must be stated in the national application phase documents for international patent applications.

(3) Further implications

The Intellectual Property High Court focused on the technical side on who can be an inventor of an invention under the current Patent Act and it appeared to avoid diving into substantial discussions on whether AI-generated inventions should be protected under the current Patent Act.

The Intellectual Property High Court pointed out that whether to grant patent rights for AI-generated inventions, including whether to grant the same rights as those granted for inventions made by natural persons, should be considered through broad and cautious discussions on the potential impact of AI-generated inventions in the legislative process, and cannot be resolved through judicial interpretation of the current version of the Patent

Act. This is because patent rights are not inherent natural rights, but rights granted under the Patent Act, which aims to facilitate inventions and the development of industry, and the design of the patent system should be discussed in light of national industrial policy making, including aspects of international cooperation.

III Supplementary comments

As indicated in decisions of the courts and/or patent offices in many other countries, such as the U.S., UK, and Germany, and as referenced in the decision of the Intellectual Property High Court, AI systems are not eligible to be an "inventor" for purposes of patent rights under the current patent system. Whether or not to grant patent rights to AI-generated inventions is an issue that will require policymaking and legislative level discussions. Nevertheless, there is a possibility that a natural person who contributes to the creation of an invention to a certain extent, while using AI systems as tools, can obtain patent rights, though the level of contribution a natural person must make also is being discussed.

In January, Japan's Minister of State for Special Missions of the Cabinet Office mentioned that the government had launched a policy-level discussion on issues relating to AI-generated inventions, including whether or not developers of AI systems can be inventors to whom patent rights are granted, and the government plans to establish a policy direction on this issue in Intellectual Property Strategic Program 2025, in or around June[1]. We should keep an eye on the progress of discussions at the policy level.

Public Relations Section, Nishimura & Asahi newsletter@nishimura.com

[1] https://www.cao.go.jp/minister/2411_m_kiuchi/kaiken/20250117kaiken.html (Japanese)