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d.c. federal court says copyright office properly denied registration to artwork claimed to be generated by artificial intelligence

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On August 18, 2023, a U.S. federal court for the first time addressed the copyright registrability of works claimed to be generated by computer-based artificial intelligence ("AI"). In *Thaler v. Perlmutter*, No. 22-1564 (D.D.C. August 18, 2023), Judge Beryl A. Howell **ruled** that the United States Copyright office had properly denied copyright registration to plaintiff Stephen Thaler, a scientist and technology entrepreneur from Missouri, for a work of visual art titled "A Recent Entrance to Paradise," which he claimed was created by a computer system he owned called the "Creativity Machine." The court's opinion is important because it comports with the Copyright Office's **guidance** issued earlier this year concerning the use of AI to create works in which copyright protection is sought. The opinion also underscores the risks of challenging a federal-agency decision based on a slim factual record.

By way of background, Thaler had previously sought to receive ***patent*** registrations for inventions Thaler likewise credited not to himself but to a "Creativity Machine." The U.S. Patent and Trademark Office refused to issue patent registrations, and Thaler sued. Both the district court and the Federal Circuit upheld the USPTO's decisions. *See Thaler v. Vidal*, 43 F. 4th 1207 (Fed Cir. 2022). In that case, the court held that patents require a human inventor under the U.S. Patent Act, and that therefore, patent registrations cannot be granted for inventions claimed to be generated by a machine.

Thaler's application for registration to the U.S. Copyright Office similarly stated that the author of the artwork "A Recent Entrance to Paradise" was the "Creativity Machine," which he claimed "autonomously created" the work using a computer algorithm. While Thaler asserted the work was "computer-generated," he

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claimed that because he owned the machine, he was also the owner of the work, and thus the rightful registrant, under the Copyright Act's "work-made-for-hire" doctrine. However, Thaler did ***not*** assert that he personally contributed to the machine's creation of the work.

The Copyright Office initially refused registration to Thaler in August 2019, stating the work lacked "the human authorship necessary to support a copyright claim." Thaler then twice sought reconsideration of this refusal within the Copyright Office, and the Office each time affirmed the denial. As permitted under the Administrative Procedure Act ("APA"), Thaler then challenged the denial in federal court, where both sides brought motions for summary judgment.

Faced with the cross-motions, Judge Howell had little trouble upholding the Copyright Office's denial of registration. In the court's view, Thaler's claims for how copyright ***ownership*** vested in him as a work for hire, or was otherwise transferred to him, "put the cart before the horse," since these claims ignored the threshold issue of the how the work came into being in the first place. Since Thaler alleged the work was created without any human involvement at all, there was no proper work of authorship in which a copyright could arise.

Surveying the leading cases on the subject, the court agreed that "through its long history, copyright law has proven malleable enough to cover works created with or involving [newly developed] technologies," and noted that even the language of the Copyright Act provides that copyright law is "designed to adapt with the times." Thus, the famous case of *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884), involving a photograph of Oscar Wilde, recognized that a work created using photography was still eligible for copyright protection because it embodied creative decisions of the photographer.

As Judge Howell pointed out, however, despite such adaptability, there has been "a consistent understanding that human creativity is the *sine qua non* at the core of copyrightability." Thus, courts have refused copyright registrations to works where the "author" is wholly non-human – such as a monkey taking a selfie, or a garden growing under natural forces – but have permitted registration where at least some element of human authorship enters the work's final expression (such as books claimed to be based on divine or otherworldly revelation that have been edited or arranged). In sum, the court concluded, "***[h]uman authorship is a bedrock requirement of copyright***," a principle the court found to be embodied in the meaning of "author" both in the Copyright Act and the U.S. Constitution.

Significantly, the court recognized the existence of "new frontiers in copyright as artists put AI in their toolbox," and of "challenging questions regarding how much human input is necessary to qualify the user of an AI system as an 'author' of a generated work." This is in line with the Copyright Office's March 2023 guidance, by which the Office will evaluate applications for registration including AI-generated materials under a "case-by-case inquiry." In this inquiry, the litmus test is the degree of human contribution to the work's "traditional elements of authorship." A work entirely generated by AI, devoid of such human contribution, would not be capable of registration at all.

Thaler's claims, the court held, existed at this latter extreme, and did not involve challenging questions or new frontiers. This was because in his filings with the Copyright Office, Thaler asserted the work had been "created autonomously by machine," without any contribution from him at all. Thaler attempted to supplement this assertion in the district court, claiming that he had "provided instructions and directed his AI to create the Work," and that he "entirely controlled" his so-called "Creativity Machine." But under the Administrative Procedure Act, the court noted, these arguments cane too late: judicial review could be based only on the facts in the Copyright Office record. That record dictated that since the machine purportedly created the work "autonomously," its creation did not give rise to any valid copyright at all.

As an aside, the court pointed out that even if Thaler's novel "work for hire" theory were entertained, the argument would have failed for a similar reason: namely, that under the Copyright Act the preparer of a "work for hire" must also be a human author. As the court noted, under the Copyright Act's definitions, the preparer of a work for hire must either be an "employee" who is acting "within the scope of *his or her* employment," or else the "parties" must expressly agree to work-for-hire status "*in a written instrument signed by them.*" Noting the use of personal pronouns and language denoting a contractual meeting of minds, the court found these categories to be limited to human persons.

Thaler might still appeal the district court's decision to the D.C. Circuit, as he did to the Federal Circuit in his patent case. MSK will continue to provide updates in this rapidly developing area of law.