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## USPTO Announces Extension and Expansion of Program for Fast Reviews of "Green" Patent Applications

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*Encouraged by positive responses from patent applicants with green technology innovations, the United States Patent and Trademark Office ("USPTO") is giving a new lease on life to the existing Green Technology Pilot Program, which was originally set to expire on December 8, 2010.*

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The pilot program came into effect on December 8, 2009, to promote the development and successful commercialization of certain environment-friendly categories of inventions, as defined by the USPTO. The program allows qualifying "green" utility patent applications for prioritized examination ahead of other regular patent applications if a petition is granted to accord a "special" status to the applications. This process is separate and different from the "Accelerated Examination" process available to any new utility and design patent application, if certain procedural requirements are met, as discussed further below.

To qualify for the Green Technology program, the application must disclose an invention that potentially enhances the quality of the environment, or materially contributes to certain pre-specified "green" purposes such as energy conservation, development of renewable energy resources, or reduction of greenhouse gas emissions. The program was originally scheduled to end on December 8, 2010, or upon reaching 3,000 unexamined utility patent applications with properly filed petitions, whichever occurs earlier, as was announced in the Federal Register Notice (74 FR 64666). In addition, eligibility for the pilot program was originally restricted to patent applications filed before December 8, 2009. Details of the original program can be found in our previous advisory, "USPTO Introduces Accelerated Review Pilot Program for 'Green' Patent Applications," dated December 28, 2009.

The USPTO's original announcement had indicated the possibility of extension of the program (with or without modifications) upon reevaluation of the response from applicants and the effectiveness of the program. In the recent Federal Register Notice (75 FR 69049) published on November 10, 2010, the USPTO formally announced that the pilot program is being extended until December 31, 2011, and expanded to include patent applications filed on or after December 8, 2009. However, the number restriction for qualifying patent applications remains unchanged, i.e. the USPTO will only accelerate the examination of the first 3,000 "green" patent applications with grantable petitions filed before December 31,

2011. Also, the Federal Notice indicates no further extension of the program beyond that date, even if fewer than 3,000 petitions are granted.

The most recent changes announced on November 10, 2010, are not the only modifications to the pilot program since its inception. On May 21, 2010, in a follow-up Federal Register Notice (75 FR 28554), the USPTO announced expansion of the program by eliminating the stringent classification requirement from the eligibility criteria. Originally, only 79 existing class/subclass combinations were eligible for the pilot program. The USPTO determined that the classification requirement was unnecessary because the workload at the USPTO was internally manageable, and the classification requirement was causing the denial of petitions for green technology applications that would have otherwise qualified for the program.

According to a USPTO press release, approximately 950 petitions were filed under the program through May 21, 2010, but only 342 were granted. After the elimination of the classification requirement, more applications were eligible to participate. According to the most recent statistics made public by the USPTO, a total of 1595 petitions have been filed since December 8, 2009, of which 790 have been granted.

We expect that the "Petition to Make Special under the Green Technology Pilot Program" paperwork (the PTO/SB/420 form that needs to be electronically filed) will be updated to reflect the recent modifications.

### Merits and Limitations of the Pilot Program, As Modified

The USPTO has been trying to encourage patent applications in green technology by progressively simplifying the eligibility and procedural requirements. As of this writing, 94 patents with granted petitions have been issued under the pilot program. According to a USPTO press release, the current average time between approval of a green technology petition and the issuance of a first Office Action is just 49 days. In several cases, patent applications in the green technology "fast lane" have been issued within one year of filing, which is comparable to the pendency period of patent applications under the regular Accelerated Examination procedure available to all new utility and design patent applications (both "green" and "non-green"). In contrast, the average pendency for non-accelerated patent filings is more than 35 months.

However, expedited examination under the Green Technology Pilot Program has significant advantages over the Accelerated Examination process. The Accelerated Examination requires a pre-examination search by the applicants to find the most relevant prior art. An elaborate Accelerated Examination Support Document (AESD) must be filed with the application and the petition forces applicants to characterize and distinguish their inventions from identified prior art, which might include patents owned by the applicants. Overall, qualifying for the process of Accelerated Examination not only becomes tedious and expensive, but it is also susceptible to potential risk of creating undesired estoppel that may be used to limit the claims during litigation. Therefore, applicants are often reluctant to take advantage of the quicker examination offered under the regular Accelerated Examination procedure. Compared to that procedure, filing a petition for the Green Technology Pilot Program requires minimal effort (no prior art search or AESD requirement), and does not give rise to any significant litigation risks of self-admission. Further advantages compared to the regular Accelerated Examination procedure include elimination of the requirement of conceding in advance that dependent claims will stand or fall together with the independent claims during the appeals process, and complete waiver of the petition fee requirement (other than the early publication fee).

In short, the Green Technology Pilot Program offers substantial flexibility and cost benefits to qualifying applicants when compared to the stringent requirements of the Accelerated Examination procedure.

Applicants should, however, be aware that the Green Patent Pilot Program does have certain procedural constraints which remain unchanged from the original program and which may limit the applicants' control over the patent prosecution process, particularly if the applicant wishes to pursue a wide variety of claims in a single application. For example, by filing the petition, applicants automatically agree to early publication of the application, can only pursue three or fewer independent claims and twenty or fewer total claims per application, and have to make an election of claims without traverse in a telephonic interview. Most of these procedural constraints are comparable to the regular Accelerated Examination program.

### What Can Interested Parties Do Immediately and in The Near Future

The extension and expansion of the Green Technology Pilot Program provides interested parties with additional opportunities to take advantage of the new provisions of the program. For instance, applicants whose petitions were dismissed or denied solely because their applications were not filed before December 8, 2009 may file a renewed petition. If the renewed petition is filed by December 10, 2010, it will be given priority as of the date the applicant filed the initial petition.

Interested parties now have an opportunity to file a petition at the time of filing a new application. They can also take advantage of the extended timeframe and the additional flexibility in eligibility requirements to evaluate their currently pending unexamined patent application portfolio to identify more applications that can qualify for the renewed pilot program.

Moreover, since early publication is a requirement for all the patent application examined under the pilot program, interested parties can use published patent applications and/or issued patents with granted petitions as guidelines to prepare future patent applications and associated petitions to enhance their chances of qualifying.

Finally, we believe that with other foreign jurisdictions (such as the Japanese Patent Office and the European Patent Office) adopting similar programs to boost green innovations, the USPTO will find newer ways to continue to incentivize green technology-related patent applications even after the current Green Patent Pilot Program expires on December 31, 2011. A recent report published by the European Patent Office shows that Japan has far surpassed the U.S. in the number of its clean energy technology patent filings, and other countries are aggressively catching up to the U.S. Therefore, interested parties can expect future announcements in the green patent filing area from the USPTO, and are advised to closely follow the USPTO's press releases.

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If you have any questions about the content of this publication, please contact the Pillsbury attorney with whom you regularly work or the authors listed here.

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