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## USPTO Introduces Accelerated Review Pilot Program for “Green” Patent Applications

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*In a timely move in synchronization with the United Nations Climate Change Conference being held at Copenhagen, Denmark, the United States Patent and Trademark Office (USPTO) announced on December 7, 2009, a pilot program, effective immediately, for expediting the examination of certain pending patent applications relating to “Green Technologies.” This announcement came from the U.S. Commerce Secretary Gary Locke, and U.S. Energy Secretary Steven Chu. The detailed Federal Register Notice, setting forth the specific eligibility requirements, was issued on December 8, 2009 (74 FR 64666).*

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According to the USPTO’s press release, the average pendency of patent applications related to “green” technologies is currently about 30 months before receiving a first Office Action, and about 40 months to issuance. This long timeframe is often discouraging to patent applicants, who wish to bring their technology quickly to the market, particularly where significant capital investment is involved. An expedited patent examination procedure can be effective both from the innovators’ and consumers’ perspectives, as it can potentially address multiple key issues—such as, climate protection, economic recovery, job creation, and global competitiveness—simultaneously. In the proposed expedited patent examination pilot program, certain green-technology-related patent applications will have a chance to be advanced out of turn, i.e., be accorded “special” status to be examined in the fast lane, **if a proper “Petition to Make Special” is timely filed.**

### Eligibility

**Number of Applications and Date:** An eligible application must have been filed before December 8, 2009, and must not have received a first Office Action yet. The program will remain open until December 8, 2010, or upon reaching 3,000 utility applications with properly filed petitions, whichever occurs earlier. The USPTO may consider extending the program, but currently it is a limited pilot program.

**Type of Application:** The application for which a petition is being filed must be a non-reissue, non-provisional utility application filed in the United States, or an international application that has entered the National Stage in the United States.

**Subject Matter of the Application:** In addition to the above eligibility requirements, the application must be directed to an invention that enhances the quality of the environment or that materially contributes to certain pre-specified “green” functionalities.

The USPTO’s Federal Register Notice, entitled “Pilot Program for Green Technologies Including Greenhouse Gas Reduction,” lists 79 existing U.S. patent classifications under which the pending patent applications can be placed. The official categories (and example sub-categories) are:

- A. Alternative Energy Production** (total 29 sub-categories, including: Biofuel; Passive space heating; Geothermal energy; Hydroelectric energy; Energy from municipal waste; Nuclear power; Solar Cells; Solar thermal energy; Wind energy, etc.)
- B. Energy Conservation** (total 23 sub-categories, including: Alternative power vehicle (e.g., hydrogen-powered vehicle); Electric vehicle; Energy storage and distribution; Human-powered vehicle; Light Emitting Diode structures (LED); Wave-powered boat motors; Wind-powered ships, etc.)
- C. Environmentally Friendly Farming** (total 6 sub-categories, including: Alternative irrigation technique; Fertilizer alternative; Water conservation, etc.); and
- D. Environmental Purification, Protection, or Remediation** (total 21 sub-categories, including: Biodegradable materials; Carbon capture; Disaster recovery; Environmentally friendly coolants; Toxic waste removal; Plants and plant breeding; Recycling; Soil conservation; Using microbes as enzymes, etc.).

**Procedural Requirements:** The “Petition to Make Special” must be filed using USPTO’s Electronic Filing System using form PTO/SB/420. The patent application number and other identifications, and a clear indication that the petition pertains to the “Green Tech Pilot Program,” are mandatory.

In the petition, the applicants must consent to certain procedural requirements, such as: agreeing to early publication by payment of appropriate publication fee; limiting the number of claims to be examined to no more than three independent claims and 20 total claims; not including any multiple dependent claim; and agreeing to make an election, if required, to choose a single invention that meets eligibility and classification requirements, as discussed above.

The petition clearly and specifically has to indicate that special status is sought because the invention is directed to a technology that meets one of the following materiality requirements:

- Applications pertaining to ‘Environmental Quality’ need to “materially enhance the quality of the environment by contributing to the restoration and/or maintenance of one of the basic life-sustaining natural elements.”
- Applications pertaining to ‘Energy Conservation, Development of Renewable Energy Resources, or Greenhouse Gas Emission’ need to “materially contribute to: (1) [t]he discovery or development of renewable energy resources; (2) more efficient utilization and conservation of energy resources; or (3) the reduction of greenhouse gas emissions.”

The statement should explain how the materiality standard is met. But an applicant is not permitted to “speculate as to how a hypothetical end-user might specially apply the invention in a manner” that could meet the applicable materiality requirement. Thus, the USPTO appears to be looking for concrete, identifiable “green” benefits, rather than inventions that are only tangentially “green.” Moreover, although an application must be classified in one of the specified classes/sub-classes, that does not automatically establish the materiality standard—the two are separate requirements.

**Cost of the Petition:** No official petition fee is required by the USPTO to participate in the pilot program. Therefore, the main cost for the applicant is evaluating whether his/her application qualifies for the pilot program, and the cost of preparing a petition. However, an early publication consent and the required publication fee may need to accompany the petition.

**Coverage of the Petition:** Once granted, the “special” status will remain in effect during the regular prosecution of the patent application up to the point when a first Office Action (which may be a restriction requirement) is issued, as well as during the appeals process before the Board of Patent Appeals and Interferences. After the first Office Action, the application will be placed on the Examiner’s normal docket, rather than on his/her special docket. Thus, the acceleration benefit is limited to the time up to the first Office Action, and during the appeals process. Continuing applications will not automatically inherit a parent application’s “special” status, and will have to re-establish their eligibility to qualify.

### Pros and Cons of the Pilot Program

The pilot program aims to incentivize development and quick deployment of “green technologies,” while protecting the innovators’ rights through the patent grant process. The pilot program simplifies the currently available accelerated examination procedure at least by: (1) narrowing the focus of eligibility to environmental protection and renewable/efficient energy technologies; (2) eliminating the requirement of a tedious and expensive Examination Support Document that requires a pre-examination search be conducted by the applicant as in the existing “Accelerated Examination” procedure; (3) eliminating the requirement of conceding in advance that dependent claims will stand or fall together with the independent claims during the appeals process; and (4) waiving the petition fee requirement altogether (other than the early publication fee).

In other words, the pilot program offers significant flexibility and cost benefit to the qualifying applicants when compared to stringent requirements of the existing “Accelerated Examination” provision.

However, the program has some significant limitations as well.

First of all, given the number of pending patent applications that can qualify as “green,” restricting the program to only the first 3,000 qualifying applications may not be inclusive enough. It is speculated that bigger players might completely commandeer the advantages offered by the pilot program by “glutting” the system with a great number of petitions turned in quickly, effectively shutting out the other smaller companies that do not have the resources to act as quickly. The Federal Register Notice indicates, however, that the number of applications and time window of the pilot program may be revised by the USPTO to accommodate a more meaningful number of patent applications upon re-evaluation of the response from the applicants.

One of the other concerns is that resourceful applicants may unfairly use the “green” façade to push technologies that are commercially more relevant to them, but are less “green” in reality. The USPTO’s guidelines are not specific enough to preclude confusion and ambiguity in defining what is “green.” However,

overly specific regulations could have had the opposite effect and been too narrow. Thus, the USPTO has retained a fair amount of discretion to decide what “green” is.

Another concern is that certain very useful technologies that are related to the “green” technology space will inadvertently be excluded, because they might not fall under any of the pre-specified “green” categories, as discussed above. For example, battery technologies are widely regarded as necessary for improving the effectiveness of solar and wind power, as well as electric vehicles. Batteries are primarily classified in Class 320 and in sub-classes of Class 429, but those class/sub-classes are almost entirely excluded from the program.

Additionally, there are many procedural constraints that applicants have to abide to automatically by the mere act of filing the petition, such as, agreeing to early publication of the patent application, agreeing to have three or fewer independent claims and 20 or fewer total claims to be examined in the application, agreeing to make an election of claims without traverse in a telephonic interview such that the elected claims meet the classification requirement set forth by the USPTO, etc. These constraints 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.

### What Can Interested Parties Do Immediately and In Future

Interested parties are encouraged to evaluate their patent application portfolio to determine if they can take advantage of the current pilot program, or at the least, be more prepared to take advantage of possible extension of the current pilot program or future similar programs that may be offered down the line.

Interested parties should also prepare future patent applications in a way that makes it easier for the application to fall under one or more of the pre-specified classifications that qualify for the current “green” pilot program, in anticipation of it possibly being extended. For example, adding embodiments in an application specific to green technology may more easily support grant of such a petition.

Lastly, parties who are inclined towards global patent filing are encouraged to make themselves aware of similar “green” pilot programs offered by patent offices in other countries. For example, the Japanese Patent Office has launched a “green” patent initiative effective November 1, 2009.

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If you have any questions about the content of this advisory, please contact the Pillsbury attorney with whom you regularly work or the attorney below.

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