

## Intellectual Property ADVISORY

June 9, 2010

### **UPDATED:** Fast Tracking Green Innovation: USPTO Pilot Program Allows Applicants to Request Special Status for Existing Applications in “Green Technologies”

*The United States Patent and Trademark Office (USPTO) recently expanded the Green Technology Pilot Program described in the advisory below, which was originally distributed in December 2009. Previously, only patent applications within a select number of patent classifications were eligible for the program. Under the expansion, the USPTO has eliminated this requirement and opened the program to applications in any classification. Applications must still meet the remaining requirements outlined in the original advisory.*

**Please note that outdated portions have been crossed out.**

*Important considerations related to the new expansion are as follows:*

- While the program remains limited to the first 3,000 granted petitions, only 342 have been granted thus far.*
- Any previously-filed petitions that were dismissed or denied solely for failing to meet the classification requirement may be re-filed as a renewed petition. If the renewed petition is filed within one month of the May 21, 2010, publication date of the official notice, it will be given priority as of the date the initial petition was filed.*
- Due to the removal of the classification requirement, applicants may find it more useful than before to include a statement explaining how the materiality standard is met, particularly in close cases.*

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The United States Patent and Trademark Office (USPTO) recently announced a new pilot program to accelerate the processing time of patent applications in areas recognized by the USPTO as “green technologies.” Under the “Green Technology Pilot Program,” patent applications directed to environmental quality, energy conservation, development of renewable energy, or greenhouse gas emission reduction may be advanced out of turn for expedited examination. According to USPTO Director David Kappos, the goal is to enable green innovations to reach the market sooner, thus stimulating the creation of green jobs and green businesses. Time is of the essence, however, as only the first 3,000 eligible patent applications with properly filed petitions will be allowed to participate in the pilot program, though the program may be extended if successful.

Standard practice at the USPTO dictates that patent applications be processed in the order of their U.S. filing date. Due to high volume, the USPTO estimates that applications in green technologies currently face an average wait time of 30 months for a first Office action and 40 months for a final decision. Even then, the time to an actual allowance may be well in excess of 40 months. Advancing prosecution of green technology patent applications is expected to reduce pendency by an average of one year.

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The following discusses the requirements and possible implications of the new program.

## Requirements for Participation

To participate in the Green Technology Pilot Program, applicants must file a “petition to make special” for an existing patent application. The application must meet a number of requirements regarding substance and form, and applicants must follow a specific petition process. Of initial note, the typical petition processing fee is waived, and the allowance of a petition will not automatically extend to any continuation applications.

## Substance of Eligible Applications

The USPTO describes eligible subject matter as applications pertaining to environmental quality, energy conservation, development of renewable energy resources, or greenhouse gas emission reduction. ~~More specifically, eligible applications must be classified in one of the approximately 80 approved classifications listed in the official notice released by the USPTO.<sup>1</sup> The classifications fall under the broad categories of alternative energy production; energy conservation; environmentally friendly farming; and environmental purification, protection, or remediation.~~ In applications where the eligibility of the claimed subject matter may be unclear, the applicant can file a statement with the petition explaining how the invention materially enhances or contributes to the above objectives.

## Form of Eligible Applications

Eligible patent applications are limited as to the number and type of claims, claimed subject matter, and election requirements. Where applicable, a preliminary amendment may be filed with the petition to bring the application into accord with the requisite form. The specific requirements are outlined below.

1. Eligible applications are those filed prior to December 8, 2009, that have not yet received a first Office action.
2. The application must be a non-reissue, non-provisional utility application or a U.S. national stage filing of an international application. Reexamination proceedings are excluded.
3. ~~The application must be classified in one of the approved classifications noted above.~~
4. The application must contain three or fewer independent claims, 20 or fewer total claims, and no multiple dependent claims.<sup>2</sup>
5. The claims in the application must be directed to a single invention ~~that falls within the eligible classes.~~ Additionally, the petition must include a statement that, if the USPTO determines the application contains multiple claimed inventions, the applicant will elect without traverse an invention that meets the eligibility requirements.

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<sup>1</sup> *Pilot Program for Green Technologies Including Greenhouse Gas Reduction, Department of Commerce: United States Patent and Trademark Office*, Docket No. PTO-P-2009-0038, Federal Register, Vol. 74, No. 234, Tuesday, December 8, 2009, available at <http://www.uspto.gov/patents/law/notices/74fr64666.pdf>

<sup>2</sup> These requirements may be achieved via preliminary amendment.

## Petitioning Process

In addition to matters of application form and substance, the petition itself must meet specific requirements in order to accelerate prosecution of the application. Such requirements are as follows:

1. The petition must be filed electronically before December 8, 2010, using the USPTO electronic filing system and selecting the document description of "Petition for Green Tech Pilot."<sup>3</sup>
2. The petition must be filed at least one day prior to the date that a first Office action<sup>4</sup> appears in the PAIR system, which can differ from dates of mailing and receipt.
3. The petition must be accompanied by a request for early publication, along with the required publication fee. Because of this requirement, cases filed with a non-publication request would not be eligible unless the request was withdrawn.

As previously noted, a separate petition must be filed for each continuing application meeting the substantive requirements. The USPTO will decide on the petition once the application is considered in condition for examination.<sup>5</sup> If the petition does not comply with all requirements, the USPTO will notify the applicant, who will be accorded only one further opportunity to make any necessary corrections within the longer of one month or 30 days.

## Potential Implications

A granted petition under the Green Technology Pilot Program provides benefits similar to those of other applications accorded special status under preexisting USPTO rules. Namely, the application will be placed on the special docket of the examiner prior to the first Office action and enjoy special status during the patent publication process or any appeal to the Board of Patent Appeals and Interferences (BPAI). A key difference, however, is that applications under the new pilot program will be placed on the examiner's amended docket, rather than the examiner's special docket, after the first Office action. In other words, although this new program will accelerate the time to a first substantive action, no further benefit will be derived in relation to timing of subsequent office actions.

To take the greatest advantage of the accelerated first Office action, applicants may consider initially pursuing narrower claims in the hope of receiving an immediate notice of allowance or a first action where only minor amendments are required to achieve an allowance. Subsequently, applicants may file continuation applications to seek broader protection of the invention.

For applicants with qualifying applications, failure to act immediately could result in an inability to obtain the

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<sup>3</sup> The use of form PTO/SB/420 is advised.

<sup>4</sup> For the pilot program, restriction requirements qualify as a first Office action.

<sup>5</sup> As a point of reference, the average petition to make special under preexisting USPTO rules takes 67 days to process (see [http://www.uspto.gov/web/patents/accelerated/ae\\_stat\\_charts.pdf](http://www.uspto.gov/web/patents/accelerated/ae_stat_charts.pdf)).

special status under the program. Smaller organizations or individual inventors should be advised that the relatively small pool of 3,000 applications that will be included in the program may be quickly filled by large patent filers in the field. Should the initiative prove successful, however, the USPTO has hinted that the pilot program may be extended and possibly broadened.

Since the main benefit of the program is accelerated time to a first substantive action, the benefit becomes reduced the closer an application already is to receiving that first action. Thus, prior to filing a petition as described above, it could be useful to obtain a status report regarding the Office's predicted time to a first action for a given application. If the predicted time to a first action already is close, it is possible that the petition processing time may exceed the time for receiving a first Office action without the petition. While the obtained special status still would apply to BPAI appeals, one cannot predict when an appeal will be necessary. The attorneys of record for applicable patent applications can easily determine the USPTO's predicted time to a first action for any pending application.

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