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PATENT PROTECTION FOR HIGH TECHNOLOGY

Accelerated Patent Examination: Green Technology

**A Summary of Global Initiatives, with
specific discussion of the US**

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Preparation help from Nicholas Lanzatella

Background

- Governments recognize a need to develop and commercialize technologies that conserve natural resources or reduce environmental harm.
- To address this need, patent offices around the world are implementing special procedures to expedite the examination and grant of applications related to “green” technologies (“GreenTech”).
- In some cases, time to grant is much quicker.

USPTO Pilot Program - Initially

- December 2009, the U.S. Patent and Trademark Office (USPTO) implemented a one-year pilot program to accelerate the examination of some GreenTech patent applications.
- Under the program, an Applicant can petition to advance the application out of turn, which can shorten time to grant.
- By patenting green technology innovations sooner, it is believed that entrepreneurs can secure funding, create businesses (and jobs), and bring technologies to market more quickly.

USPTO Pilot Program – Initially (cont.)

- The application has to be a non-provisional, non-reissue patent application filed before December 8, 2009.
 - PCT applications entering US National Phase are accepted.
- The application has to be classified in a qualified class.
- The claims have to contain or be amended to contain no more than three independent claims and no more than 20 claims in total.
- The claims have to be directed to a single invention.
 - Applicant may still pursue other non-elected inventions stemming from that application in future divisional applications.
 - Must state that Applicant will elect a qualified restricted group.

USPTO Pilot Program – Initially (cont.)

- The claims have to be directed to an invention that materially enhances the environment or contributes to renewable energy, energy conservation or greenhouse gas reduction.
- The petition has to be filed electronically before December 8, 2010. The petition itself is available at
 - <http://www.uspto.gov/forms/sb0420.pdf>.
- The petition has to be filed before the PTO issues a first office action in the application.
- The petition has to include a request for early publication.
- Only the first 3,000 petitions qualify.

USPTO Pilot Program – Initially (cont.)

- Personal Experience:
 - One rejection because the application was reclassified.
 - Postcard classification was used to determine eligibility.
 - One rejection because the matter did not reach the materiality standard. Later granted.
 - One granted and allowed <1 month later.
 - Approx. 13 months filing to allowance.
 - One of 71 issued after petition grant.

USPTO GreenTech Pilot Program *Revised*

- Elimination of Classification Requirement was signed May 12, 2010, published May 21, 2010, at 75 Fed. Reg. 28554.
 - <http://www.uspto.gov/patents/law/notices/75fr28554.pdf>
- Applicants whose previous petitions were dismissed solely on the basis of not meeting the classification requirement may file a renewed petition.
 - If the renewed petition is filed within one month of the Federal Register notice publication, it will be given priority as of the date the applicant filed the initial petition.
- Other restrictions and eligibility requirements still apply.
- More details:
 - <http://edocket.access.gpo.gov/2010/pdf/2010-12328.pdf>

USPTO Program Status and Future

- David Kappos, Director USPTO 20 Sept 2010 blog:
 - *As of August 31, 2010, 1,477 Green Technology petitions have been received into our Green Tech Pilot Program. This number represents very strong applicant uptake – nearly 50 percent of the upper limit originally set for the program. We anticipate further expansion of this program in the coming months.*

- Utilization:

Green Petition Report Summary

Report date: 10/04/2010

Petition Summary

Petitions awaiting decision	56
Petitions granted	764
Petitions dismissed	597
Petitions denied	146
Total Petitions	1563
Issued US Patents having granted Green Pet	71

http://www.uspto.gov/patents/init_events/green_report_summary20101004.pdf

USPTO Program Status and Future (cont.)

- Extending the program (post 2009 filings)?
- Jennifer Rankin Byrne, director of public affairs at the USPTO, said the USPTO is pleased with the pilot program, is considering whether to extend it another year, and would like to see more participation.
- Additional information on the Green Technology Pilot Program can be found on the USPTO's Web site.
 - http://www.uspto.gov/patents/init_events/green_tech.jsp
 - <http://edocket.access.gpo.gov/2010/pdf/2010-12328.pdf>

Australia Accelerated Examination

- On September 15, 2009, IP Australia announced a fast-track examination program for patent applications directed to environmentally friendly technologies.
- Examination of applications under the program is expected to begin within four to eight weeks after filing the request for expedited examination and no additional fee is required.
 - http://www.ipaustralia.gov.au/pdfs/news/MR_150909_fast_track_green_patents.pdf
 - http://www.ipaustralia.gov.au/patents/process_expedited.shtml
 - Not sure how this differs from normal fast-track status.

Canada Accelerated Examination

- A patent applicant can request accelerated examination by submitting a declaration stating that the application relates to a technology that could help to resolve or mitigate environmental impacts or conserve the natural environment and resources if commercialized, with no additional fee required.
 - <http://www.cipo.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr02462.html>

Israel Accelerated Examination

- A new category of applications that can receive priority examination was created for “green patents” by the Israel Patent Office on December 27, 2009.
- To request priority examination, the applicant must provide an explanation as to why the invention helps advance environmental protection; however, the declaration and extra fees normally required for priority examination are not required.
 - http://www.israel-patents.co.il/index.php?page_id=272

Japan

Accelerated Examination

- On November 1, 2009, the Japanese Patent Office implemented a program allowing for the accelerated examination of “green inventions” having a beneficial effect on the environment through low energy consumption or reduction of carbon dioxide emissions.
 - <http://www.ondatechno.com/English/ip/patent/report/20091130.html>
 - <http://eastmeetswest.european-patent-office.org/news/stories/513/>

South Korea Accelerated Examination

- The Korean Intellectual Property Office launched a fast-track examination program on October 1, 2009 for patent applications related to green technologies such as renewable energy, carbon reduction, and green transportation.
- Under this program, an applicant must submit results of a prior art search along with a request for fast-track examination, and a first office action will be issued within one month of the request.
 - <http://www.kipo.go.kr/kpo/eng/>
 - http://www.hanyanglaw.com/eng/news/newsletter_preview.asp?curPage=1&ca=116

United Kingdom Accelerated Examination

- On May 12, 2009, the United Kingdom Intellectual Property Office created a “Green Channel” program whereby an applicant can request accelerated processing of an application by indicating:
 - (1) that the invention relates to a “green” or environmentally friendly technology; and
 - (2) which actions the applicant wishes to accelerate (i.e., search, combined search and examination, publication, and/or examination).
- The program applies to existing applications and applications filed after May 12, 2009.
 - <http://www.ipo.gov.uk/p-pn-green.htm>



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Thank you for your participation.

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