



A Faster Track to a Greener Future: The USPTO's New Pilot Program

By Michael Ward and Anita Choi

In December 2009, the United States Patent and Trademark Office (USPTO) announced a pilot program to accelerate the processing time of “green” patent applications. As part of the Obama Administration’s efforts to fuel cleantech innovation in the United States, this Green Technology Pilot Program aims to bring green technologies to market faster, thereby stimulating green businesses and green jobs.

According to the USPTO, the current pendency time for green technology patent applications is on average thirty months to a first Office action and forty months to a final decision; but under this new program, the USPTO aims to reduce the pendency time by an average of a year.¹ Applications that satisfy the requirements of this pilot program are accorded special status and examined on an accelerated basis. Specifically, this program places the application on the examiner’s special docket prior to the first Office action. Note that the program accelerates the time to a first Office action, but no further timing benefit will be derived from subsequent Office actions since the application will then be placed on the examiner’s amended docket.

This pilot program targets green technology applications filed before December 8, 2009, that have not yet received a first Office action. To participate, the technology must fall within the scope of the program, the application must meet specific requirements set forth by the USPTO, and the applicant must file a “petition to make special” for the existing patent application. The USPTO has waived the petition fee for this pilot program. Applicants seeking to take advantage of this program should act quickly, since the USPTO will only consider the first 3,000 petitions properly filed before December 8, 2010. The USPTO may extend the program after reevaluating the program’s effectiveness and the availability of the department’s resources.

“GREEN TECHNOLOGIES” DEFINED

Green technologies eligible under this program must either (1) materially enhance the quality of the environment, or (2) materially contribute to the discovery or development of renewable energy resources, the more efficient utilization and conservation of energy resources, or the reduction of greenhouse gas emissions. More specifically, the application must be classified in one of the U.S. patent classifications listed in the official notice released by the USPTO,² which broadly includes alternative energy production, energy conservation, environmentally friendly farming, and environmental purification, protection, or remediation. In the event that the application disclosure does not adequately make clear the eligibility of the claimed subject matter, the applicant can file a statement that explains how the materiality standard is met. To meet this standard, the applicant must go beyond speculating how a hypothetical end-user might apply the technology to achieve the environmental objectives of the program, and more than a minor aspect of the claimed invention must meet these objectives

REQUIREMENTS FOR THE GREEN APPLICATION AND PETITION TO MAKE SPECIAL

A patent application seeking special status under the pilot program must adhere to the following requirements:

1. The application must be a non-reissue, non-provisional utility application, or an international application that has entered the national stage. The application must have been filed before December 8, 2009. The pilot program excludes reexamination proceedings.
 2. The application must be classified in one of the U.S. classifications discussed above.
 3. The application must contain three or fewer independent claims, twenty or fewer total claims, and no multiple dependent claims.
 4. The claims must be directed to a single invention that meets the environmental objectives of the program. Moreover, the petition must include a statement that, if the USPTO determines that the claims are directed to multiple inventions, the applicant will elect without traverse an invention that meets the eligibility requirements.
- Moreover, the petition to make special under this program must also meet the following requirements:
5. The petition must be filed electronically before December 8, 2010. Applicants should use the USPTO electronic filing system, and select the document description “Petition for Green Tech Pilot.”
 6. The petition must be filed at least one day prior to the date that a first Office action appears in the Patent Application Information Retrieval (PAIR) system.
 7. The petition must be accompanied by a request for early publication, along with the required publication fee.

CONCLUSION

While the USPTO normally examines patent applications in the order of their U.S. filing date, this pilot program affords green technology applications special status, pushing these applications to the front of the line for initial review. The notion of accelerating application examination, however, is not new to the USPTO. In June 2006, the USPTO revised its procedures to advance applications out of turn under the “accelerated examination program,” a more general program with the

goal of completing examination within twelve months of the application filing date.³ An application granted special status as a result of a petition to make special under MPEP § 708.02 is placed on the examiner's special docket throughout its entire course of prosecution before the examiner.⁴

Now, applicants who cannot meet all the current requirements of the existing accelerated examination program can still achieve a special status under this Green Technology Pilot Program. For example, applicants seeking to benefit from the pilot program do not need to provide the examination search report required under item VIII of MPEP § 708.02.⁵ However, applicants seeking to benefit from accelerated review under the pilot program must recognize one key difference from the general accelerated examination program—the pilot program only accelerates time to the first substantive Office action, which may contain only a restriction requirement. As such, only applicants who have not yet received that first action will benefit. Moreover, if the first action is about to issue, the petition to make special confers little benefit, and may even exceed the time for receiving a first Office action without the petition.

With the launch of this pilot program, innovators of green technologies now have another option to expedite the patent prosecution process. An expedited patenting process will hopefully allow innovators to develop and deploy green technologies more quickly, creating new jobs and making the U.S. more competitive in the cleantech sector. ■

1 http://www.uspto.gov/news/pr/2009/09_33.jsp

2 <http://www.uspto.gov/patents/law/notices/74fr64666.pdf>

3 <http://www.uspto.gov/web/offices/com/sol/notices/71fr36323.pdf>

4 http://www.uspto.gov/web/offices/pac/mpep/documents/0700_708_01.htm

5 http://www.uspto.gov/web/offices/pac/mpep/documents/0700_708_02.htm

Because of the generality of this update, the information provided herein may not be applicable in all situations and should not be acted upon without specific legal advice based on particular situations.