

ClientAlert

Intellectual Property

December 2009

USPTO to Speed Up Examination of Green Technologies Applications

The United States Patent and Trademark Office (USPTO) recently introduced the "Pilot Program for Green Technologies," a new pilot program to accelerate the examination of patent applications for "green technologies." In an announcement on December 8, 2009, the USPTO stated that it would grant such applications expedited review. Such expedited review would enable patents to issue within a year on average, as opposed to over three years for non-accelerated applications.

The program applies to pending patent applications that were filed before December 8, 2009, but not to new patent applications filed on or after that date. The USPTO will accept the first 3,000 petitions for accelerated examination under the Green Technology program.

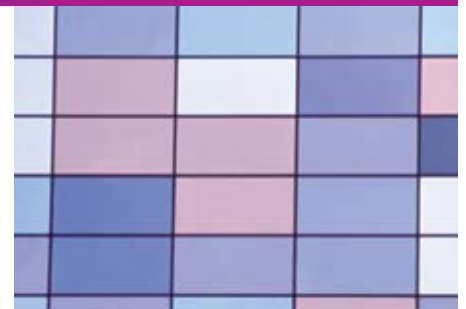
To qualify for the Green Technologies program, the applicant must file a petition "to make special." The USPTO will waive the typical application fee of US\$130 for such petitions. The application must also meet several specific requirements described below such as:

- the relationship to "green technologies;"
- the nature of the application filed prior to December 8, 2009;
- the number of independent and dependant claims in the application; and
- the lack of any Office Actions.

Under the first requirement, the application must be related to "green technologies" such as:

- the discovery or development of renewable energy resources;
- the more efficient utilization of conservation of energy resources; or
- the reduction of greenhouse gas emissions.

The USPTO announcement identified a lengthy list of eligible classifications of "green technology" including solar, hydroelectric, wind and renewable biomass.¹



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Additional information is available on the USPTO website. <http://www.uspto.gov/patents/law/notices/74fr64666.pdf>

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¹ <http://www.uspto.gov/patents/law/notices/74fr64666.pdf>

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In addition, the application must be a pending application filed under §35 U.S.C. 111(a) before December 8, 2009. Divisional and continuation applications that claim priority to earlier applications also qualify for accelerated examination.

Provisional applications, which act as placeholders for inventors as they compose a more complete set of claims, will not qualify unless the non-provisional application was also filed prior to December 8, 2009. Likewise, applications for design patents, which are a different category of shorter duration patents that protect ornamental designs, will also not qualify.

The application must contain three or fewer independent claims and 20 or fewer total claims. Independent claims are claims that do not reference any other claim. The application also cannot have multiple dependant claims. Multiple dependant claims are claims that reference more than one other claim. A preliminary amendment to cancel excess claims or multiple dependant claims can be filed at the same time as the petition "to make special" to comply with this requirement.

Finally, the petition "to make special" must be filed prior to the issuance of the first Office Action. Applications that have already received an Office Action will not be granted special status.

Early issuance can be strategically important in a rapidly developing sector such as renewable energy or consumer electronics, enabling a company to leverage its intellectual property right away instead of waiting for years for the patents to issue. Therefore, companies should examine their patent portfolio to see if any of its patent applications qualify for the accelerated examination program.

The deadline to file the petition is December 7, 2010; however it is anticipated that the 3,000 limit will be reached well in advance of the deadline. If you have any patent applications pending with the USPTO and have questions regarding the Green Technologies program, please contact us as soon as possible to ensure compliance with these procedural rules.

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