

Zippering Your GreenTech Patent Application Down the Line

By Joe Mencher¹ and Jeff Wolfson²

Accelerated examination of patent applications has typically required an applicant to either: (1) satisfy a handful of very specific requirements, or (2) submit to a potentially risky and time-consuming procedure. But a select group of applicants who have previously filed applications in specific technology areas may have just won the equivalent of the lottery.

The U.S. Patent & Trademark Office (“USPTO”) has announced that it is implementing a “Green Technology Pilot Program” (GTPP) in which a patent applicant may advance “green technology” applications to the head of the line for examination, but without meeting the cumbersome requirements of the accelerated examination program (*i.e.*, the examination support document). For now, “green technologies” are meant to refer to patent applications directed to environmental quality, energy conservation, and development of renewable energy resources or greenhouse gas emission reduction. The USPTO will accept the first 3,000 petitions to make special in previously filed new applications pending with no office action, and upon receipt of more than 3,000 petitions, the USPTO may reevaluate the workload and resources needed to extend the program.

Traditionally, new patent applications are taken up for examination in the order of their U.S. filing date. The USPTO’s accelerated examination procedure, however, can be activated by filing a petition to make special along with an appropriate showing, and the granting of such a petition results in the patent application being advanced out of turn for examination. Applications that are accorded special status are generally placed on the examiner’s special docket throughout its entire prosecution, and have special status in the timing of any appeal to the Board of Patent Appeals and Interferences and in the patent publication process. In June 2006, the USPTO instituted a requirement that a majority of petitions to make special comply with the requirements of the accelerated examination program. Many in the innovative community, both practitioners and patent applicants, consider the requirements of the accelerated examination program burdensome and risky. This has likely contributed to the program’s low participation rate. In particular, many in the inventive community are concerned that the accelerated examination support document, which is required along with a conventional petition to accelerate examination, in many cases creates a burden of searching and a record of admissions and prior art characterizations that may serve as a basis for limiting the scope of the claims if the resulting patent is enforced. Others worry that the examination support document may lead to an inadvertent mischaracterization of the prior art references that can be used as a basis for future allegations of inequitable conduct to render a subsequent patent unenforceable. Furthermore, from the patent applicants’ perspective, attorney costs for complying with the accelerated examination requirements are high and the risk of damaging the patent value is increased relative to letting an application proceed through normal examination.

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In considering which patent applications qualify for the GTPP, the claims must be directed to a single invention that materially enhances the quality of the environment, or that materially contributes to (1) the discovery or development of renewable energy resources; (2) the more efficient utilization and conservation of energy resources; or (3) greenhouse gas emission reduction.

For applications that materially enhance the quality of the environment, the petition to make special must state that the special status is sought because “the invention materially enhances the quality of the environment by contributing to the restoration or maintenance of the basic life-sustaining natural elements.” If the application as a whole does not clearly disclose this, the petition must be accompanied by a signed statement explaining how this standard is met. The statement will not suffice if it only includes mere speculation as to how a hypothetical end-user might specially apply the invention to materially enhance the quality of the environment, and applications will not be expedited merely because some minor aspect of the claimed invention may enhance the quality of the environment.

As for applications that materially contribute to renewable energy resources, energy use and conservation, or greenhouse gas emission reduction, the USPTO has provided several examples of qualifying technology. “Renewable energy resources” includes hydroelectric, solar, wind, renewable biomass, landfill gas, ocean (including tidal, wave, current, and thermal), geothermal, and municipal solid waste, as well as the transmission, distribution, or other services directly used in providing electrical energy from those sources. “More efficient utilization and conservation of energy resources” includes reduction of energy consumption in combustion systems, industrial equipment, and household appliances. “Reduction of greenhouse gas emissions” includes inventions that contribute to (1) advances in nuclear power generation technology, or (2) fossil fuel power generation or industrial processes with greenhouse gas-abatement technology (e.g., inventions that significantly improve safety and reliability of such technologies.) The petition for such green applications must state the green category that applies, along with a signed explanatory statement if the application does not clearly disclose and claim the green invention. Again for these categories, the statement will not suffice if it only includes mere speculation as to how a hypothetical end-user might specially apply the invention to materially meet the category, and applications will not be expedited merely because some minor aspect of the claimed invention may satisfy the basis for special status.

The application must also satisfy a few other requirements:

1. The application must be a non-reissue, non-provisional utility application (filed under 35 U.S.C. § 111(a)), or an international application (“PCT”) that has entered the national stage. The application must have been filed before December 8, 2009. Reexamination proceedings are excluded from the program.
2. The application must be classified in one of a number of classifications that are listed under broader categories that include Alternative Energy Production, Energy Conservation, Environmentally Friendly Farming, and Environmental Purification, Protection, or Remediation. After the 12-month duration of the GTPP, the USPTO may extend the GTPP to include more classifications depending on the effectiveness of the GTPP and the resources availability.
3. The application must contain 3 or fewer independent claims, 20 or fewer total claims, and may not contain any multiple dependent claims. Applicants may file a preliminary amendment to cancel the excess claims and/or multiple dependent claims along with the petition to expedite examination.

4. The petition must include a statement that, if the USPTO determines that the claims are directed to multiple inventions, the applicant will agree to make an election without traverse in a telephone interview.
5. The petition must be filed at least one day before a first Office Action appears in the PAIR system.
6. The petition must be accompanied by a request for early publication.

The GTPP will run for 12 months beginning on December 8, 2009, and petitions to expedite examination under the GTPP must be filed electronically before December 8, 2010 using the USPTO electronic filing system ("EFS"). No fee is required for the petition, and the \$130 fee for a petition is expressly waived. Applications that are awarded special status under the GTPP will be expedited through placement on an examiner's special docket before a first Office Action and will have special status in appeals and publication, but subsequent to the first Office Action will be placed on the examiner's amended docket and will not receive any significant benefit from being expedited unless an appeal is made.

Thus, for applications directed to "green technologies" that were filed before December 8, 2009 and have yet to receive a first Office Action, the GTPP provides an opportunity to accelerate examination at a very low cost and, more importantly, with low risk: qualifying applicants need only file a petition, potentially with an accompanying signed statement as to how the invention that the application is directed to is "green." As the program will initially be limited to the first 3,000 qualifying applications, companies with "green" inventions should evaluate their unexamined patent applications promptly to see if any qualify for expedited examination.

If you have any questions about strategic intellectual property needs, this Alert, or how the GTPP program affects your particular circumstances, please contact one of the patent lawyers at Haynes and Boone, LLP.