

Intellectual Property ALERT

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ACCELERATING PROTECTION OF GREEN TECHNOLOGY INVENTIONS

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The rate of innovation in the green technology field is increasing and the introduction of inventions into the marketplace is sure to follow the same rapid pace. Early protection of green technology inventions will be of paramount importance to companies interested in successfully commercializing and capitalizing on their inventions.

On December 7, 2009, the United States Patent and Trademark Office (USPTO) responded to this emerging need for protection by announcing a new pilot program to accelerate the examination of certain green technology patent applications. The initiative is designed to expedite the development and deployment to marketplace of green technology, facilitate creation of green jobs, and promote U.S. competitiveness in green technology fields. The USPTO intends to examine the first 3,000 green technology applications on a fast-tracked basis for which a proper petition to make special is filed.

It is expected that the program will reduce the pendency of green technology patent applications by one year on average. This is significant since, under normal examination, patent applications in these fields do not receive a first action from the USPTO until about thirty months after filing, and final decisions as to patentability are generally not rendered until forty months after the application is filed.

A petition to make special under the Green Technology Pilot Program must satisfy the following conditions:

- The application must be classified in one of the following U.S. classifications: Alternative Energy Production; Energy Conservation; Environmentally Friendly Farming; or Environmental Purification, Protection, or Remediation.
- 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;

- The application filing date must be prior to December 8, 2009;
- The Petition must be filed at least one day prior to the date of a first office action;
- The application must be a non-reissue, non-provisional utility application filed under 35 U.S.C. 111(a), or an international application;
- The application must contain three or fewer independent claims and twenty or fewer total claims and no multiple dependent claims. Applications not satisfying these claim requirements can be amended to comply;
- The Petition must be accompanied by a request for early publication;
- Petitions to make special must be filed electronically before December 8, 2010

An applicant will be notified if a petition to make special does not comply with the USPTO requirements under the Pilot Program, and will have one opportunity to correct any deficiencies.

An additional benefit of the new pilot program is that green technology patent applications filed according to the provisions detailed above will not need to meet all of the requirements of the conventional accelerated examination program, some of which are often overly burdensome. For example, the Green Technology Pilot Program does not require an examination support document, which typically must include among other items, a list of existing technology generated from a patentability search, a detailed explanation of how each of the application claims is patentable over the listed references, and identification of where in the references

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each claim element is found. The more lenient Green Technology Pilot Program requirements will reduce the cost of petitioning for special status of green technology applications as compared to the standard accelerated examination process.

Key to acceptance of an application into the Green Technology Pilot Program is the nature of the claimed invention. The invention must be within the scope of at least one of the following categories:

1) Environmental Quality

If the application falls under the “environmental quality” category the petition to make special must state that special status is sought because “the invention materially enhances the quality of the environment by contributing to the restoration or maintenance of one of the basic life-sustaining natural elements.”

2) Contributions to the Discovery or Development of Renewable Energy Sources

The term “renewable energy resources” as used in this category, 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 these sources.

3) Contributions to More Efficient Utilization and Conservation of Energy Resources

Inventions in the category of “contributing to more efficient utilization and conservation of energy resources,” include those relating to the reduction of energy consumption in combustion systems, industrial equipment, and household appliances.

4) Contributions to Greenhouse Gas Emission Reduction

Inventions in the “greenhouse gas emission reduction” category include, but are not limited to, technology that contributes to (1) advances in nuclear power-generation technology, or (2) fossil fuel power generation or industrial processes with material greenhouse gas-abatement technology.

The petition to make special must state as the basis for the special status that the invention materially contributes to or enhances one of the four above-mentioned technological fields. If materiality of the

invention is not apparent from the application, the applicant seeking accelerated examination under the Green Technology Pilot Program must submit a statement explaining how the materiality standard is met. A statement of mere speculation as to how the invention may be used to satisfy the materiality standard will not suffice. Additionally, more than just a minor characteristic of the invention must be directed to contributing to or enhancing one of the included fields.

Applications accepted into the Green Technology Pilot Program will enjoy an expedited initial examination procedure, and will receive special status in any appeal to the Board of Patent Appeals and Interferences. Applications will also be published sooner than the normal eighteen months from filing.

For a company that is developing green technology, the advantages of obtaining special status under the Green Technology Pilot Program include earlier protection of inventions and the potential ability to shape the applicant’s position in the marketplace. It also will support the development and deployment of green technology, which will likely lead to the creation of green jobs and the promotion of U.S. competitiveness in the global marketplace. Overall, it is a positive step towards supporting new and innovative environmental technologies.

If you are interested in learning more about the Green Technology Pilot Program, or would like to discuss the possibility of participating in this program, Schnader Harrison Segal & Lewis LLP can assist. ♦

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