



# Intellectual Property Law Information Memo

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## USPTO ANNOUNCES PILOT PROGRAM TO EXPEDITE EXAMINATION OF GREEN TECHNOLOGY PATENT APPLICATIONS

On December 7, 2009, the USPTO announced a pilot program aimed at accelerating the examination of green technology patent applications. Together with U.S. Energy Secretary Steven Chu, U.S. Commerce Secretary Gary Locke announced the Green Technology Pilot Program at a press conference held at the Commerce Department's headquarters.

Applications that are accepted into the pilot program will be accorded special status and will see examination times reduced by an average of one year. Currently, the average pendency for applications in areas of green technology is 30 months to a first office action and 40 months until a final decision.

Under Secretary of Commerce for Intellectual Property and Director of the USPTO David Kappos, a proponent of the pilot program, noted that the reduced pendency "will help bring green innovations to market more quickly."

### Program Details

The USPTO estimates that approximately 25,000 pending patent applications qualify for the pilot program. Of those applications, only the first 3,000 with a properly submitted petition will be accepted into the program, and the USPTO will stop accepting petitions as of December 8, 2010.

Once an application is accepted into the pilot program, it will be accorded special status and will be placed on the examiner's special docket prior to the first Office action. However, after the first Office action – which could be something as simple as a restriction requirement – the application will be placed on the examiner's amended docket rather than the special docket. The application would later be given special status in any appeal before the BPAI as well as in the patent publication process.

To qualify for the Green Technology Pilot Program, a pending application must satisfy the following criteria:

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- The application must be a non-reissue, non-provisional utility application filed under 35 U.S.C. 111(a) or 35 U.S.C. 371;
- The application must fall within one of the approximately 80 patent classifications enumerated in the program guidelines, although an applicant may apply for the program if there is not yet any known classification;
- The application must contain no more than three independent claims and 20 total claims, although the applicant can submit a preliminary amendment to the claims with the petition;
- The petition must be accompanied by a request for early publication and the requisite publication fee;
- The applicant must make an election without traverse in a telephonic interview if the PTO determines that more than one invention is being claimed;
- The petition must be filed at least one day prior to a first Office action; and
- The claims must be directed to an invention that “materially enhances the quality of the environment,” or that materially contributes to one of the following:
  - a. the discovery or development of renewable energy resources;
  - b. the more efficient utilization and conservation of energy resources; or
  - c. greenhouse gas emission reduction.

If a petition to make special under the Pilot Program does not satisfy one or more of the requirements, the USPTO will notify the applicant and that applicant will have one opportunity to correct the deficiency.

In addition to reducing the pendency of accepted applications, the Green Technology Pilot Program offers several advantages over the current statutory program which provides accelerated examination of inventions that will materially “enhance the quality of the environment” or “contribute to the development or conservation of energy resources.” Under the Pilot Program, the applicant is not required to submit any further documentation in support of patentability or pay any additional fees other than the \$300.00 publication fee.

Further details can be found in the Federal Register of December 8, 2009 (Vol. 74, No. 234) as well as on the USPTO website. The USPTO also offers form SB420 “Petition To Make Special Under The Green Technology Pilot Program” for applicants.

If you have any questions about the Green Technology Pilot Program, please contact George R. McGuire, Chair, Intellectual Property Practice Group, at 315-218-8515 or [gmcguire@bsk.com](mailto:gmcguire@bsk.com).