

REPORT

NEW PATENT OFFICE PILOT PROGRAM TO ALLOW APPLICANTS TO EXPEDITE PATENTS RELATED TO GREEN TECHNOLOGIES

December 15, 2009

The United States Patent and Trademark Office (USPTO) has recently announced a Green Technology Pilot Program ("Program"). The Program, only available to the first 3,000 applicants to file a petition, is intended to expedite examination of some applications related to green technologies including fuel cell, solar energy, wind energy, electric lamp, electric or hybrid vehicle, energy storage (*e.g.*, battery), refrigerant, recycling and other technologies. As discussed in detail below, the Program allows an applicant to have an application accorded special status for examination if the application meets certain requirements.

Currently, the delay in issuance of a first Office Action can be up to three years or more in some art units. Under the Program, applicants having applications related to green technologies may be able to significantly reduce such delay. Being accorded special status under the Program not only may result in the application receiving a first Office Action more quickly, but also will accord the application special status in any appeal to the Board of Patent Appeals and Interferences (BPAI), and also in the patent issuance process.

I. Duration

The Program is effective as of December 8, 2009, and is only currently available until December 8, 2010. Further, the USPTO will only accept the first 3,000 petitions to make special in previously filed new applications. The USPTO may extend the Program after December 8, 2010. However, because the Program is limited both in duration and the number of petitions that will be accepted, applicants desiring to participate are encouraged to take action as soon as possible.

II. Requirements to Participate in the Program

In order to expedite the examination of a patent application under the Program, applicants must file a Petition to Make Special, meeting the following requirements:

- (1) The application must be a non-reissue, non-provisional utility application or an international application that has entered the U.S. national stage. The application must have been filed before December 8, 2009.
- (2) The application must be classified in one of the U.S. classifications listed in the attached Appendix at the time of examination.
- (3) The application must contain three or fewer independent claims and twenty or fewer total claims. The application must not contain any multiple dependent claims. A preliminary amendment can be filed at the time the Petition to Make Special is filed, in order to cancel excess claims and/or multiple dependent claims.
- (4) The claims in the application must be directed to a single invention that (a) materially enhances the quality of the environment, or (b) materially contributes to: (1) discovery or development of renewable energy resources; (2) more efficient utilization and conservation of energy resources; or (3) greenhouse gas emission reduction. These categories are more fully addressed below.
- (5) The Petition to Make Special must state that, if the USPTO determines that the claims are directed to multiple inventions, the applicant will agree to make an

December 15, 2009

election without traverse in a telephonic interview and elect an invention meeting the petition and classification requirements. If the Examiner cannot reach the applicant after a reasonable effort or if the applicant refuses to make an election, the Examiner will treat the first claimed invention meeting the requirements as constructively elected for examination.

(6) The Petition to Make Special must be filed electronically before December 8, 2010 using the USPTO electronic filing system. There are no government fees for the petition, although the non-refundable publication fee must be paid with the petition.

(7) The Petition to Make Special must be filed at least one day prior to the date that a first Office Action (which may be a Restriction Requirement) appears in the Patent Application Information Retrieval (PAIR) system.

(8) The Petition to Make Special must be accompanied by the \$300 publication fee. If the application has not yet been published, the petition must also be accompanied by a request for early publication.

(9) If the application for which special status is sought is related to environmental quality (item 4(a) above), 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 the basic life-sustaining natural elements. If the application does not specifically disclose the above effect, the Petition to Make Special must be accompanied by a statement explaining how the application meets the "materially enhances" standard.

(10) If the application for which special status is sought is directed to a material contribution to development of renewable energy resources or energy conservation, or greenhouse gas emission reduction (item 4(b)(1)-(3) above), the Petition to Make Special must state the basis for special status. If it is not clear from the disclosure in the application, the Petition to Make Special must be accompanied by a statement explaining how the application meets the "material contribution" standard.

III. Decision On Petition To Make Special Under The Program

The USPTO will decide whether to grant the Petition to Make Special under the Program once application is in condition for examination (*i.e.*, once all of the filing requirements have been met). If the USPTO determines that the petition does not comply with the above requirements, the applicant will be given only one opportunity to correct the deficiency. The time period for correcting a deficiency in a Petition to Make Special under the Program is one month or thirty days, whichever is longer, and is not extendable.

IV. The Effect of Being Accorded Special Status

Once an application is accorded special status, the application is placed on the Examiner's special docket. At least once every four weeks, the Examiner must act on the application on his or her special docket that has the oldest effective filing date. Therefore, how quickly an Examiner takes up the application for examination as a result of the Program depends upon (1) when the application was filed and (2) the number of applications on the Examiner's special docket. The average number of applications currently on an Examiner's special docket varies, but is generally small. The general policy at the USPTO is that once an application is granted special status, the application should be taken up for examination within a few weeks of receiving special status, according to the U.S. Manual of Patent Examining Procedure (MPEP) §708.02(a)III. However, this program may significantly expand the special dockets of some examiners.

Under the Program, an application is only placed on the Examiner's special docket before the first Office Action, in any appeal to the BPAI, and in the patent issuance process. After the first Office Action, the application is placed on the Examiner's amended docket instead of the Examiner's special docket. As such, the effect of the Program is primarily to expedite the issuance of a first Office Action. Once a response has been filed, the next Office Action should issue within about two to four months after the response is filed.

December 15, 2009

V. Recommendations

At present, there are substantial delays in the issuance of first Office Actions due to the backlog at the USPTO. The Program may be useful where an applicant has an application related to a green technology and desires to obtain patent protection more quickly. To take advantage of the Program, we recommend acting quickly, as the Program is only available to the first 3,000 applicants to file a petition. When considering whether to participate in the Program, please consider the following steps:

- (a) Review the patent portfolio for applications related to green technologies;
- (b) Consider any disadvantages of expediting examination of an application;
- (c) Determine the USPTO's predicted date for taking action;
- (d) Consider the advantages and disadvantages of limiting the number of claims to be examined;
- (e) Consider the advantages and disadvantages of responding to a Restriction and Election of Species Requirement without traverse;
- (f) Consider the advantages and disadvantages of the required request and fee for early publication; and

(g) Keep in mind that the Program does not guarantee success in the expedited application.

Please let us know if you desire any additional information regarding the Green Technology Pilot Program, or if you have any questions about other ways to expedite applications.

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Appendix

Eligible Classifications

The following is a list of the eligible classifications:

A. Alternative Energy Production

1. Agricultural waste (USPC 44/589).
2. Biofuel (USPC 44/605; 44/589).
3. Chemical waste (USPC 110/235–259, 346).
4. For domestic hot water systems (USPC 126/634–680).
5. For passive space heating (USPC 52/173.3).
6. For swimming pools (USPC 126/561–568).
7. Fuel cell (USPC 429/12–46).
8. Fuel from animal waste and crop residues (USPC 44/605).
9. Gasification (USPC 48/197R, 197A).
10. Genetically engineered organism (USPC 435/252.3–252.35, 254.11–254.9, 257.2, 325–408, 410–431).
11. Geothermal (USPC 60/641.2–641.5; 436/25–33).
12. Harnessing energy from man-made waste (USPC 75/958; 431/5).
13. Hospital waste (USPC 110/235–259, 346).
14. Hydroelectric (USPC 405/76–78; 60/495–507; 415/25).
15. Industrial waste (USPC 110/235–259, 346).
16. Industrial waste anaerobic digestion (USPC 210/605).
17. Industrial wood waste (USPC 44/589; 44/606).
18. Inertial (*e.g.*, turbine) (USPC 290/51, 54; 60/495–507).
19. Landfill gas (USPC 431/5).
20. Municipal waste (USPC 44/552).
21. Nuclear power—induced nuclear reactions: processes, systems, and elements (USPC 376/all).
22. Nuclear power—reaction motor with electric, nuclear, or radiated energy fluid heating means (USPC 60/203.1).
23. Nuclear power—heating motive fluid by nuclear energy (USPC 60/644.1) Photovoltaic (USPC 136/243–265).
24. Refuse-derived fuel (USPC 44/552).
25. Solar cells (USPC 438/57, 82, 84, 85, 86, 90, 93, 94, 96, 97).
26. Solar energy (USPC 126/561–714; 320/101).
27. Solar thermal energy (USPC 126/561–713; 60/641.8–641.15).
28. Water level (*e.g.*, wave or tide) (USPC 405/76–78; 60/495–507).
29. Wind (USPC 290/44, 55; 307/64–66, 82–87; 415/2.1).

B. Energy Conservation

1. Alternative-power vehicle (*e.g.*, hydrogen) (USPC 180/2.1–2.2, 54.1).
2. Cathode ray tube circuits (USPC 315/150, 151, 199).
3. Commuting, *e.g.*, HOV, teleworking (USPC 705/13).
4. Drag reduction (USPC 105/1.1–1.3; 296/180.1–180.5; 296/181.5).
5. Electric lamp and discharge devices (USPC 313/498–512, 567–643).
6. Electric vehicle (USPC 180/65.1; 180/65.21; 320/109; 701/22; 310/1–310).
7. Emission trading, *e.g.*, pollution credits (USPC 705/35–45).
8. Energy storage or distribution (USPC 307/38–41; 700/295–298; 713/300–340).
9. Fuel cell-powered vehicles (USPC 180/65.21; 180/65.31).
10. Human-powered vehicle (USPC 180/205; 280/200–304.5).
11. Hybrid-powered vehicle (USPC 180/65.21–65.29; 73/35.01–35.13, 112–115, 116–119A, 121–132).
12. Incoherent light emitter structure (USPC 257/79, 82, 88–90, 93, 99–103).
13. Land vehicle (USPC 105/49–61 (electric trains); 180/65.1–65.8 (electric cars)).
14. Optical systems and elements (USPC 359/591–598).
15. Roadway, *e.g.*, recycled surface, all-weather bikeways (USPC 404/32–46).
16. Static structures (USPC 52/309.1–309.17, 404.1–404.5, 424–442, 783.1–795.1).
17. Thermal (USPC 702/130–136).
18. Transportation (USPC 361/19, 20, 141, 152, 218).
19. Watercraft drive (electric powered) (USPC 440/6–7).
20. Watercraft drive (human powered) (USPC 440/21–32).
21. Wave-powered boat motors (USPC 440/9).
22. Wind-powered boat motors (USPC 440/8).
23. Wind-powered ships (USPC 114/102.1–115).

C. Environmentally Friendly Farming

1. Alternative irrigation technique (USPC 405/36–51).
2. Animal waste disposal or recycling (USPC 210/610–611; 71/11–30).
3. Fertilizer alternative, *e.g.*, composting (USPC 71/8–30).
4. Pollution abatement, soil conservation (USPC 405/15).
5. Water conservation (USPC 137/78.2–78.3; 137/115.01–115.28).
6. Yield enhancement (USPC 504).

D. Environmental Purification, Protection, or Remediation

1. Biodegradable (USPC 383/1; 523/124–128; 525/938; 526/914).
2. Bio-hazard, Disease (permanent containment of malicious virus, bacteria, prion) (USPC 588/249–249.5).
3. Bio-hazard, Disease (destruction of malicious virus, bacteria, prion) (USPC 588/299).
4. Carbon capture or sequestration (USPC 95/139–140; 405/129.1–129.95; 423/220–234).
5. Disaster (*e.g.*, spill, explosion, containment, or cleanup) (USPC 405/129.1–129.95).
6. Environmentally friendly coolants, refrigerants, etc. (USPC 252/71–79).
7. Genetic contamination (USPC 422/1–43).
8. Hazardous or Toxic waste destruction or containment (USPC 588/1–261).
9. In atmosphere (USPC 95/57–81, 149–240).
10. In water (USPC 210/600–808; 405/60).
11. Landfill (USPC 405/129.95).
12. Nuclear waste containment or disposal (USPC 588/1–20, 400).
13. Plants and plant breeding (USPC 800/260–323.3).
14. Post-consumer material (USPC 264/36.1–36.22, 911–921; 521/40–49.8).
15. Recovery of excess process materials or regeneration from waste stream (USPC 162/29, 189–191; 164/5; 521/40–49.8; 562/513).
16. Recycling (USPC 29/403.1–403.4; 75/401–403; 156/94; 264/37.1–37.33).
17. Smokestack (USPC 110/345; 422/900).
18. Soil (USPC 405/128.1–128.9, 129.1–129.95).
19. Toxic material cleanup (USPC 435/626–282).
20. Toxic material permanent containment or destruction (USPC 588/all).
21. Using microbes or enzymes (USPC 435/262.5).