

CLIENT ALERT

USPTO Launches Two Pilot Programs for Accelerating Examination of Patent Applications

December 11, 2009

Executive Summary

The United States Patent and Trademark Office (USPTO) has just launched two new pilot programs for accelerating the examination of certain types of patent applications.

The first program allows applicants to accelerate examination of patent applications relating to “green technologies,” including environmental quality, energy conservation, renewable energy resources, and greenhouse gas emission reduction. The announcement of this program was timed to coincide with the United Nations Climate Change Conference currently taking place in Copenhagen. The program is open only to the first 3,000 applications which qualify and will end no later than December 8, 2010.

The second program allows “small entity” applicants to accelerate examination of a patent application provided the entity abandons a second, unexamined application, in effect “sacrificing” an abandonment of one application for faster examination of another. A small entity is defined by regulations of the Small Business Administration and includes non-profit organizations (such as a university) and businesses having less than 500 employees. The goal of this program is to offer small entities the opportunity to expedite examination of patent applications, while concurrently reducing the backlog of unexamined applications at the USPTO, which is estimated at between 700,000 to 1.2 million applications.

Requirements for the Green Technologies Program

Entering this program requires filing a “no-fee” petition that indicates why the claimed invention qualifies as a green technology. The petition may state that the invention is one that materially contributes to one of the following: environmental quality, the discovery or development of renewable energy resources, more efficient utilization and conservation of energy resources, or greenhouse gas emission reduction. Applications pending as of December 8, 2009 are eligible for the program.

The application must include, or be amended to include, three or fewer independent claims and twenty or fewer total claims. In addition, the claims must be directed to a single invention, and the petition must include a statement that if the USPTO determines the claims are directed to multiple inventions (e.g., a restriction requirement,) the applicant will agree to make an election of a single invention for examination in a telephone interview.

Requirements for the Small Entity Program

Entering this program requires one application to be abandoned in exchange for accelerating examination of another application. Additional requirements include:

- (1) The application to be accelerated must have a filing date before October 1, 2009, and small entity status must have been claimed in this application before this date.
- (2) The application to be abandoned must be an unexamined, non-provisional application with an actual filing date before October 1, 2009, and it must have no outstanding filing requirements (e.g., executed declaration, filing fees.)
- (3) Both applications must be owned by the same small entity as of October 1, 2009, or they must name at least one inventor in common.
- (4) Various papers must be filed in both applications expressly abandoning one and requesting accelerated status in the other. In addition, the applicant must agree not to file any new applications claiming priority to the application to be abandoned and may not request a refund of any filing fees.

Commentary

While these programs may not be applicable to or desirable for all applicants, those having applications relating to green technologies and/or small entities may potentially benefit from these programs. The USPTO estimates that the time to issuance for applications in these programs may be shortened by about one year.

Any applicant potentially interested in expediting applications in fields relating to green technologies should immediately review its patent portfolio and consider filing petition(s) in important applications. It is worth noting that the submission requirement for participation in this program is minimal and only involves filing of the appropriate petition. The USPTO estimates there are potentially about 25,000 pending applications that are eligible, so the 3,000-application limit for joining the program may be reached relatively quickly. Therefore, petitions to participate in this program should be filed as soon as possible.

For a small entity, a review of pending, unexamined applications in its portfolio may be useful in determining whether to participate in this program. The premise is that, with the passage of time, some applications lose value, and a small entity might be willing to sacrifice such an application,

and the financial investment it has made in that application, for the benefit of speeding up examination of another application it believes to be of greater importance. The question to answer is whether there is another, qualified application worth sacrificing to shorten the wait time for examination of the other application by about one year. However, since the application to be abandoned must be one in which the USPTO has not yet conducted a search or issued an Office Action, there may not be much information available regarding the potential patentability of the claims or of any other unclaimed subject matter from that application.

Care should be taken before expressly abandoning the application (and the related investment) since, once abandoned, all rights in the application will have been permanently lost. Typical candidates for abandonment might include: (1) applications directed to products that have been cancelled or modified so that the applications no longer have great commercial value, and (2) applications of lesser value and/or those directed to non-core technologies.

In addition to these programs, there are several other programs available at the USPTO for accelerating examination of patent applications. These include using “Patent Prosecution Highway” agreements, which involve use of examination results done by other national patent offices, and requesting Accelerated Examination, which involves submitting pre-examination search results as well as meeting other requirements ([click here](#) to read our Client Alert dated 8/1/06 on accelerated examinations.) Other USPTO programs also can afford an application “special” status and accelerated examination.

For Further Information

Please contact your Wolf Greenfield attorney if you would like more information on these pilot programs and/or if you would like us to review your patent portfolio to determine whether it would be advantageous to participate in one of these programs to accelerate examination of important patent applications.