

Get your green technology to the head of the line

A growing number of IP offices are offering to speed up the granting of patents over so-called green, clean technology. This is what the rules mean in practice in five key markets

US

1 Technology

The application must be directed to inventions that materially contribute to one of the following: 1) environmental quality, 2) the discovery or development of renewable energy resources, 3) more efficient utilisation and conservation of energy resources, or 4) greenhouse gas emission reduction. The USPTO published an exemplary listing of about 80 categories of inventions that would qualify, including those directed to alternative energy production (for example, from biofuels, geothermal, solar, wind or water), energy conservation (such as emission trading, energy storage or distribution and transportation devices), and environmental remediation inventions resulting in greenhouse gas emission reduction (such as carbon capture or sequestration, recycling and advances in nuclear or fossil fuel power generation). It is important to note that the programme is only open to applications that were filed before December 8 2009 and, for the time being, is limited to the first 3,000 requests for applications that qualify.

2 Procedure

The application must include (or be amended to include) three or fewer independent claims and twenty or fewer total claims which are directed to a single invention. A separate petition must be filed asserting that the invention materially contributes to one of the categories listed above. The materiality standard that will be applied will not be satisfied merely by speculative or hypothetical uses that could benefit the environment, nor if only some minor aspect of the claimed invention may enhance the quality of the environment. If the material contribution is not apparent from the application itself, the petition must include a statement explaining how the materiality standard is met. The petition

must also include a statement that if the USPTO determines that the claims are directed to multiple inventions, the applicant will agree to make an election of a single invention in a telephonic interview. The Office of Petitions will review the petition for compliance with the criteria. If compliant, the petition will be granted and the application will be placed on the examiner's special docket and given expedited treatment. If the petition is not granted, the USPTO will provide notice to the applicant who will be given only one opportunity to correct the deficiency.

3 Fast track

While the time frame for completing the patent examination process is highly variable, a typical examination takes roughly three years from application filing to patent issuance. An application granted expedited status could expect to reduce this time period by as much as one year or more.

4 Advice

As there does not appear to be any substantial downsides to this programme (such as petition fees or onerous disclosure or submission requirements), the programme could benefit any applicant with pending applications in the cleantech space interested in reducing the time to obtain a patent. There will be some modest costs to prepare the necessary submission for the petition that should be weighed against the benefit of obtaining expedited examination.

For certain applicants, especially those whose applications are directed to early stage technology that is unlikely to be commercialised within one to three years and/or who have need to defer costs associated with examination, this programme would provide no benefit and should be avoided.



Michael Pomianek (left) and Tani Chen, Wolf Greenfield & Sacks, Boston

One-minute read



Governments are lining up to offer evidence of their green credentials. One way they can do that is to grant patents more quickly over technology that claims to have some kind of environmental benefit. This raises a number of questions: what kind of technology will qualify for the expedited treatment and what do applicants need to do to prove that their innovation meets the criteria? In this month's Q&A guide, lawyers from Japan, Australia, the US, UK and Korea explain how their country's IP Offices are answering those questions and comment on the commercial issues that applicants must consider before requesting expedited treatment.

Questions on green patents

- 1 What kind of applications qualify for expedited treatment under the fast track for "green inventions"?
- 2 What is the process for applying for expedited treatment?
- 3 How does the fast-track system work?
- 4 In what circumstances would you advise clients to apply for expedited treatment? Are there circumstances in which you would advise them not to?