

# THE DAILY RECORD

WESTERN NEW YORK'S SOURCE FOR LAW, REAL ESTATE, FINANCE AND GENERAL INTELLIGENCE SINCE 1908

## IP FRONTIERS

### Cleantech patents can be accelerated

As reported in earlier editions of this column, 2009 trends in clean or "green" technology patents revealed that innovations in clean technologies had reached an all-time high.

The Clean Energy Patent Growth Index, published quarterly by the Cleantech Group at Heslin Rothenberg Farley & Mesiti PC, tracks the number of U.S. patents granted since 2002 in nine clean energy categories: solar, wind, hybrid/electric vehicles, fuel cells, hydroelectric, tidal/wave, geothermal, biomass/biofuels and other renewable energy. By monitoring patent trends, the CEPGI provides valuable insight into innovative activity in the clean energy sector.

In 2009, U.S. patents for clean-energy technologies were at an all-time high, with 200 more cleantech patents granted compared to 2008. The CEPGI value for the fourth quarter of 2009 was the highest ever seen (337 granted patents), up more than 25 percent from the previous quarter. Patents in fuel cells and hybrid/electric vehicles were each up more than 20 percent over 2008, while solar patents were up 60 percent and biomass/biofuel energy patents were up 260 percent.

A recent incentive program from the U.S. Patent and Trademark Office could greatly impact this upward trend and, if successful, will result in an even greater number of granted cleantech patents in the coming years. In December 2009, the USPTO announced a new pilot program for handling patent applications related to green technologies. Under the "Green Technology Pilot Program," a patent application directed to qualified green technologies may be granted special status. Typically, the USPTO processes patent applications in the order in which they are filed and it often takes at least three years for the USPTO to complete its review of patent applications related to clean energy.

Under the pilot program for green technologies, qualified patent applications will receive priority processing and expedited examination, with the goal of shaving off about 12 months from the review process.

Prior to the pilot, the only avenue to expedite examination of a patent application directed to green technology was to file a Petition to Make Special with the USPTO. The expedited procedure involved a number of cumbersome requirements and was costly. Under the new program, a number of additional requirements have been eliminated. Perhaps most significantly, the pilot does not require the applicant to file an "Examination Support Docu-

ment," which many practitioners consider onerous, expensive and dangerous as it requires an applicant to make certain admissions on the record.

To be eligible for the new accelerated program, applicants must file a petition and meet the following criteria:

- A patent application must have been filed as of the program's start date, Dec. 8, 2009.
- A patent application must relate to green technologies and fall under one of the "accepted" U.S. patent classifications.
- Applications must be limited to three independent claims and 20 total claims.
- The petition must be filed before receipt of a first Office Action.
- The petition must be accompanied by a request for early publication (and \$300 publication fee).

There is no separate fee to enter the program and the USPTO has waived the usual petition fee. If an application is accepted, it is placed into an examiner's special examination docket, and is advanced out of turn, therefore the examination process begins earlier.

As a pilot, the accelerated program is limited to the first 3,000 applicants who file a petition and is scheduled to end on Dec. 8, 2010. The goal is for the USPTO to extend the program, however, depending on feedback from participants and its effectiveness. By allowing green technology patents to issue faster, the pilot program seeks to allow inventors and small businesses to secure funding more quickly in order to launch cleantech businesses and new ventures based on proprietary technologies. As stated by USPTO Director and Undersecretary for Commerce for Intellectual Property David Kappos, "Every day an important green tech innovation is hindered from coming to market is another day we harm our planet and another day lost in creating green businesses and green jobs."

The program is limited to technologies where the underlying invention has a beneficial environmental impact. Generally stated, the program applies to applications directed to the development of renewable energy resources, more efficient utilization and conservation of energy resources, greenhouse gas emission reduction, and environmental quality.



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## **Energy-related applications**

Applications pertaining to energy include applications related to the discovery or development of renewable energy resources, the more efficient use of resources and the reduction of greenhouse gas emissions.

The "renewable energy resources" category includes hydroelectric, solar, wind, renewable biomass, landfill gas, ocean, geothermal and municipal solid waste. The category also includes the transmission, distribution of other services directly used in providing electrical energy from these sources.

"Efficient energy utilization" relates to reduction of energy consumption in combustion systems, industrial equipment and household appliances.

The "reduction of greenhouse gas emissions" category includes any inventions that contribute to nuclear power generation technology, fossil fuel power generation, or industrial processes with greenhouse gas-abatement technology.

## **Environmental quality applications**

For applications relating to environmental quality, the invention must materially enhance the quality of the environment by contributing to the restoration or maintenance of the basic life-sustaining natural elements. A petition to enter the program will not be accepted if only a minor aspect of the claimed invention relates to maintaining the quality of the environment.

The USPTO pilot is not the first program to fast track green technology patent applications. A number of international patent offices currently are giving preferential treatment to applications relating to environmentally-friendly technologies. Under the UK's "Green Channel" initiative, which launched May 12, 2009, any applicant who makes a reasonable assertion that the proposed invention relates to environmentally-friendly technology will qualify for expedited examination. According to a press release announcing the program, applications could issue in as few as nine months under the "Green Channel" initiative, com-

pared to the current average period of two to three years. The accelerated program is available both to pending applications and new applications.

The Korean Intellectual Property Office announced a new "Super Speed" program beginning Oct. 1, 2009, for green technologies that relate to "low-carbon green growth."

According to a KIPO press release, the Super Speed program will reduce the average patent review period to 30 days or less, "the fastest examination period in the world."

China and Australia have passed similar initiatives. Prompted by the global proliferation of acceleration programs, the World Intellectual Property Organization also will review the potential for preferential treatment of international applications relating to "green" technologies during a Patent Cooperation Treaty meeting this month. Such preferential treatment not only on a national scale, but also internationally, could prove even more beneficial to U.S. cleantech businesses seeking to expand their market and funding, and could result in an even greater influx of patented, proprietary technology entering the market in the coming years.

As of Feb. 5, the USPTO confirmed the maximum number of petitions under the U.S. pilot program had not yet been reached, but would not confirm how many petitions have been filed. Other commentators have suggested that about 1,000 petitions were filed as of Jan. 26, which leaves about two-thirds of the available slots open. In view of the limited number of petitions that will be accepted, green technology-based companies should promptly review pending patent applications to determine whether they may qualify. An earlier patent grant could enable those businesses to secure financing and grow more quickly, as well as promote U.S. competitiveness in the green tech market and bring important green technologies to market much sooner.

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