



Patent Update: Green Technology and the Patent Prosecution Highway

Sandra P. Thompson, Ph.D.

The USPTO has extended and expanded what was to be a one-year pilot program to expedite green technology-based patent applications by advancing them to examination out of turn. These types of applications include technologies directed to improvement of environmental quality, energy conservation, and development of renewable energy resources or greenhouse gas emission reduction.

This program was originally available to those applications filed before December 8, 2009, and was limited to the first 3000 petitions for current pending applications. The USPTO expanded the number of green technology groups who could take advantage of this program in May 2010. Later in October, the USPTO extended the program for another year (until December 31, 2011) and also allowed new applications (applications filed after December 8, 2009) to apply for the Green Technology Superhighway. This program is still only limited to the first 3000 granted petitions.

Therefore, it is important for a company to review its patent portfolio immediately to determine whether any of your current patent applications meets these criteria. Future applications must be filed by December 31, 2011 in order to take advantage of this pilot program.

Additional requirements include:

- The patent application must be a non-reissue, non-provisional utility application or an international application that has entered the national stage,
- The patent application must be classified in one of the green technologies considered acceptable by the USPTO,
- The patent application must contain three or fewer independent claims and 20 or fewer total claims,
- The patent claims must be directed to a single invention,
- The petition must be electronically filed,
- The petition must be filed before the first office action on the merits is issued, and
- The petition must be accompanied by a request for early publication and a fee of \$300.

This program is important for green-based businesses, especially those that are not in a position to file foreign patent applications or for those that have just filed foreign patent

applications. These businesses cannot take advantage of the PPH, and therefore, this program will allow them to expedite these important applications without waiting for a notice of allowance in a foreign country.

The USPTO indicated that it will reevaluate the program at the end of 2011 to determine if it should be renewed for another year or enacted permanently. Please consult counsel to determine whether it fits within the requirements.

Patent Prosecution Highway (PPH)

The PPH is now open on a permanent or trial basis between several countries, including the U.S. and Korea, European Patent Office, Australia, Austria, Canada, Denmark, Finland, Germany, Hungary, Spain, United Kingdom, Japan, Russia and Singapore. For many of the "U.S. to Foreign Country" PPHs, the trial periods have been or should be extended into 2011. The PPHs run both ways, meaning that if a company has an allowed or issued U.S. application, that company can petition one of these foreign patent offices to expedite the application there.

Most patent budgets—whether large or small—can no longer fund every new discovery by research and development teams. The demand for research or patent managers to efficiently utilize the budget is high. Therefore, it's important to thoughtfully review the inventions, tie them together where that makes business sense, expedite those that qualify, and determine early in the process where you want that patent to fit within your portfolio in the long-term (>five years). A patent committee that meets regularly is useful, where the committee includes key inventors, research managers and patent professionals.

Patent portfolios that contain both U.S. and foreign patent applications, or those portfolios that have foreign patent applications calendared for future filing, should be reviewed for the possibility of utilizing the PPH in the United States or another participating country. The PPH is a cooperative strategy by several world-wide patent offices, including the United States, to expedite examination and allowance of patent applications, while at the same time pooling resources and lowering costs by relying on the examination proceedings of one of the cooperating patent offices.

In many chemical, pharmaceutical and biotechnology examination groups at the USPTO, applications can be backlogged for two or three years before a first office action on the merits occurs. These same applications can sometimes advance to allowance through a foreign patent office, such as Japan, China, Europe or Korea, in less time than at the USPTO, which makes the use of the PPH an attractive option. The Patent Prosecution Highway is expected to expand in the next few years, as patent offices in the U.S. and other countries are coming online with the program and are looking to cut into the backlog of patent applications awaiting examination.

The PPH may be an ideal and cost-effective route to expedite allowance of qualifying applications, instead of utilizing the more-costly and risky accelerated examination process. In addition, companies can save thousands of dollars in prosecution costs by utilizing examination materials and allowances from one country in other countries. Accelerated examination, for example, requires the patent applicant to conduct an extensive prior art search, along with submitting detailed statements as to how the patent application differs from that prior art. This route effectively doubles the initial cost of filing the application, along with opening the patent applicant up for patent challenges by third parties.

As an example, the U.S. and Korea have set up a PPH that travels both ways for qualifying patent applications. According to the USPTO:

"...an applicant receiving a ruling from either the Korean Intellectual Property Office (KIPO) or the USPTO that at least one claim in an application is patentable may request that the other office fast track the examination of corresponding claims in corresponding applications. The Patent Prosecution Highway will leverage fast-track patent examination procedures already available in both offices to allow applicants in both countries to obtain corresponding patents faster and more efficiently...By basing the prosecution in the second office on patentable results from the first office, applicants can expect to obtain patents in both offices faster."

The process generally involves getting at least one claim allowed in one of the PPH countries. If the allowed claims are then submitted to the other PPH country before substantive examination begins, then that country may expedite allowance. The process requires filing a petition, an information disclosure statement, a claim chart and certified translations of a portion of the prosecution history to the PPH country of interest. Obviously, if the application has been allowed in Europe and/or Great Britain, it may be more cost effective since these

documents don't need to be translated before being filed in the US. All documents must be submitted electronically. If the petition is granted, the application is taken out of line and examination is expedited. There is no longer a fee required for a petition to enter the PPH.

Continuation applications are not automatically brought on to the PPH, but instead, the applicant must submit a petition for each one, if they qualify. Therefore, potential continuation patent applications should be reviewed to determine if they could be incorporated into the parent application instead or should be filed separately.



Sandra P. Thompson, Ph.D., is a Shareholder and Co-Chair of the firm's Intellectual Property Practice Group. Dr. Thompson can be reached at (949) 224-6282 or sthompson@buchalter.com.