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Latest Options for Fast-Tracking Clean Technology Patent Applications

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The grant of a patent can be delayed by years due to backlogs at patent offices around the world. However, recognizing the urgent need to address climate change, certain patent offices have established programs to expedite the examination of patent applications related to clean technologies. These programs significantly shorten the time to grant and promote development and commercialization of clean technology inventions. Programs were recently extended in Brazil and created in Taiwan, further expanding the options to obtain international patents more quickly. A summary of the latest programs for fast-tracking clean technology applications follows:

Australia

On September 15, 2009, IP Australia announced a fast-track examination program for patent applications directed to environmentally friendly technologies. Examination of applications under the program is expected to begin within four to eight weeks after filing a request for expedited examination, and no additional fee is required.

Brazil

The National Institute of Industrial Property (INPI) launched the "Green Patent" pilot program on April 17, 2012 to accelerate the patenting of green technologies in alternative energy, transportation, energy conservation, waste management and agriculture. The program has been extended until April 16, 2016, and is limited to the first 500 petitions granted. Applications can contain up to 15 claims, with a maximum of three independent claims, and must be published.

In November 2015, the U.S. Patent and Trademark Office (USPTO) and INPI signed a Memorandum of Understanding establishing a Patent Prosecution Highway (PPH) program. Under the PPH program, each country may use the search and examination results prepared by other, which should reduce examination time. The INPI will only accept applications under the program that are directed to oil, gas or petrochemical inventions, while the USPTO will accept applications directed to any subject matter. The program will begin on January 11, 2016 and will end on January 10, 2018, or sooner if each patent office has accepted 150 applications.

Canada

The Canadian Intellectual Property Office issued an initiative on March 3, 2011 to accelerate the examination of applications pertaining to green technology. Under the initiative, applicants can request accelerated examination by submitting a declaration stating that the application relates to a technology that could help to resolve or mitigate environmental impacts or conserve the natural environment and resources if commercialized. No additional fee is required. Under the program, the applicant should receive a first office action within about two months.

China

Since August 1, 2012, prioritized examination of applications relating to energy conservation, environmental protection or green technologies has been available in China. Applicants must submit a search report by a qualified entity or a translation of a search report issued by another country. Once a request for prioritized examination is granted, a first office action is expected to

issue within 30 days, and prioritized examination is expected to be completed within one year.

Israel

A new category of applications eligible for priority examination was created for “green patents” by the Israeli Patent Office on December 27, 2009. To request priority examination, applicants must provide an explanation as to why the invention helps advance environmental protection; however, the declaration and extra fees normally required for priority examination are not required. Additionally, a request for priority examination can be made after an application has been filed if examination has not started. Applications will be examined within three months after qualifying for priority examination.

Japan

On November 1, 2009, the Japanese Patent Office implemented a program allowing for the accelerated examination of “green inventions” having a beneficial effect on the environment through low energy consumption or reduction of carbon dioxide emissions. Under the program, applicants can receive a first office action in about two months, but must conduct a prior art search and comparison of the invention to the closest prior art.

South Korea

The Korean Intellectual Property Office (KIPO) launched a fast-track examination program on October 1, 2009 for applications related to certain green technologies. Green technologies eligible under the program include noise prevention, water quality, air pollution prevention, waste disposal, livestock waste management, recycling and sewage. Other green technologies are also eligible if the invention received financial support or certification from the government. Applicants must also submit results of a prior art search to participate in the program. KIPO states that a first office action will be issued within one month of requesting fast-track examination.

Taiwan

On January 1, 2014, the Taiwan Intellectual Property Office began expedited examination of green technology applications. Applications must be an invention patent and published prior to requesting expedited examination. In order to qualify as a green technology, the technology must be related to energy saving, new energies, automobiles powered by new engines or carbon reduction. The fee for this program is NT\$4,000 (approximately \$121 USD) and applicants must submit explanatory documents illustrating that the application is green technology related. It is expected that a first office action will be issued under expedited examination within about 9 months, compared to about 29 months under regular examination.

United Kingdom

On May 12, 2009, the United Kingdom Intellectual Property Office created a “Green Channel” program whereby applicants can request accelerated processing of an application by indicating (1) that the invention relates to a “green” or environmentally friendly technology, and (2) which actions to accelerate (i.e., search, combined search and examination, publication, and/or examination). The program applies to existing applications and applications filed after May 12, 2009. A searchable public database of published applications in the Green Channel program is available. As of December 17, 2015, the database contains over 1,300 applications.

United States

The Green Technology Pilot Program for expediting examination of clean technology applications closed in 2012, with over 1,050 patents issued under the program. However, other accelerated examination options applicable to all technologies are still available for clean technology applications.

One option is the USPTO's Prioritized Examination Program (Track One). Under the Track One program, an application is advanced out of turn for examination upon payment of a \$4,000 petition fee and a \$140 processing fee, reduced for qualifying small entity and micro entity applicants. A maximum of 10,000 requests are granted under Track One per fiscal year, and over 7,700 requests were filed between January 2015 and October 2015. The current average time until issuance of a first office action is 2.4 months under Track One, and the average time until allowance is 5.2 months.

Other programs for expediting examination include the Patent Prosecution Highway, Full First Action Interview Pilot, After Final Consideration Pilot 2.0, Pre-Appeal Brief Conference, Expedited Patent Appeal Pilot, Quick Path Information Disclosure Statement Pilot, Collaborative Search Pilot, Petition to Make Special, Ombudsman Pilot, and Accelerated Examination.

In view of the numerous international opportunities for accelerated examination and the growing importance of clean technologies, patent applicants should carefully consider these expedited options as part of a global IP strategy to patent their environmental innovations and bring them quickly to market.

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