

March 11, 2015

Global Initiatives to Accelerate Examination of Cleantech Patent Applications



In an effort to promote the development and commercialization of technologies that conserve natural resources or reduce negative environmental impact, patent offices around the world have adopted programs to expedite the examination of patent applications pertaining to clean technologies.

In 2013, the International Centre for Trade and Sustainable Development published an empirical analysis of seven of these programs. They concluded fast-track programs for clean technology applications were effective, reducing the average time to grant of a patent by up to 75%. They also concluded there was demand for fast-track programs, especially from small but fast-growing startup companies, and that fast-track patents were of higher commercial value. Thus, fast-track programs have clearly become an important tool for advancing clean technology inventions.

A summary of the 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 the request for expedited examination and no additional fee is required.

BRAZIL

The National Institute of Industrial Property (INPI) launched a program on April 17, 2012 to accelerate the patenting of green technologies in alternative energy, transportation, energy conservation, waste management, and agriculture. The goal of the program is to reduce the average prosecution time of an application from over five years to less than two years. The program is limited to the first 500 petitions granted and to applications originally filed on or after January 2, 2011 in the INPI or filed as a Paris Convention application in the INPI within one year of a priority application. As of February 3, 2015, 41 patents have been granted under the program, 46 applications have been rejected, 99 applications have received unfavorable opinions, and 53 applications have received office actions.

CANADA

The Canadian Intellectual Property Office issued an initiative on March 3, 2011 to accelerate the examination of patent applications pertaining to green technology. Under the initiative, a patent applicant 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, with no additional fee required.

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 that could receive priority examination was created for "green patents" by the Israel Patent Office on December 27, 2009. To request priority examination, the applicant 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. After qualifying under the program, these "green" patent applications will be examined within three months.

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, an applicant can receive a first office action in about two months.

SOUTH KOREA

The Korean Intellectual Property Office launched a fast-track examination program on October 1, 2009 for patent applications related to certain categories of green technologies. Under this program, an applicant must submit results of a prior art search along with a request for fast-track examination, and a first office action will be issued within one month of the request.

UNITED KINGDOM

On May 12, 2009, the United Kingdom Intellectual Property Office created a "Green Channel" program whereby an applicant 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 the applicant wishes 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 March 11, 2015, the database contains over 1,100 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 U.S. Patent and Trademark Office's (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, 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 8,000 requests were granted between January 2014 and October 2014. The average time until issuance of a first office action on the merits for a Track One application is 2.4 months, and the average time until issuance of a final decision in a Track One application is 6 months.

Other options for expediting examination include the Accelerated Examination Program, Petition to Make Special, Full First Action Interview Pilot, and After Final Consideration Pilot 2.0.

PATENT PROSECUTION HIGHWAY

Under the Patent Prosecution Highway (PPH), an applicant receiving a ruling from a first participating patent office that at least one claim is allowed can request fast-track examination of a corresponding patent application in a second participating patent office. Positive examination results in an international application can also serve as the basis for a PPH request. No fee is required to file a PPH request.

Data from 2013 show that PPH applications have a high allowance rate (at least 75%) compared to non-PPH applications, an average time until issuance of a first office action on the merits of 1-5 months, and an average time until issuance of a final decision of 2-14 months. Further, on January 6, 2014, the USPTO announced the launch of the Global PPH and IP5 PPH pilot programs to simplify the PPH process.

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.

For more information, please contact;

Peter A. Jackman, Director
pjackman@skgf.com

Lori M. Brandes, Ph.D., Of Counsel
lbrandes@skgf.com

© 2015 Sterne, Kessler, Goldstein & Fox P.L.L.C.

MIND + MUSCLE