



The Good, the Bad, and the Ugly: Learning  
Lessons from the Fast Track and Building the  
Global Green Patent Highway

**12th Annual Intellectual Property Scholars  
Conference**

**Stanford Law School**

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## Agenda

- The Green Patent Fast Track Programs
    - Overview
    - Green Patent Fast Track Program Details, Comparative Analysis, and Critiques
  - A Proposal for a Harmonized Global Green Patent Highway
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## Green Patent Fast Track Programs: Overview

- Green patent applications jump the queue in IP offices around the globe:
  - United Kingdom (~ 9 mos)
  - Israel (< 3 mos)
  - Korea (< 1 mo)
  - Australia
  - Canada
  - Japan
  - Brazil



# USPTO Green Patent Fast Track - Closed

- Closed February 2012
- 3533 applications processed
- 1062 patents granted





# Critical Analysis of the Green Patent Fast Track Programs: The Good, the Bad, and the Ugly

## Types of Program Rules

- Eligibility requirements:
  - Subject matter, i.e. eligible green technologies
  - Status, i.e. new/unfiled and/or filed and pending
- Process requirements:
  - Permissible number/type of claims
  - Restriction/election
  - Search requirement?





## The Good: UKIPO, Canada IP Office, IP Australia

Key features: expansive subject matter eligibility rules, deference to applicants, and permanence

- UKIPO Green Channel

- Open to any applicant who makes a “reasonable assertion” that the invention in the patent application “materially enhances” the environment
- Gives deference to applicants’ written assertions
- Applicant can select for acceleration (a) search, (b) examination, (c) combined search and examination, and/or (d) publication

- Canadian Intellectual Property Office

- IP Australia





## The Bad: Israel Patent Office and USPTO

Key features: restrictive subject matter eligibility rules, mechanical and/or non-deferential subject matter review, and/or temporary

- IPO enumerated classification requirement:
  - “shoehorning” claims drafting (and perhaps re-drafting)
  - very specific arguments in explanation to fit into a class
- USPTO had classification requirement; then mechanical implementation of subject matter eligibility based only on claim analysis:
  - “shoehorning” claims drafting (and perhaps re-drafting)
- USPTO Pilot Program was temporary:
  - limited enrollment while in operation and now closed





## The Ugly: Korea IP Office, Japan Patent Office, and INPI (Brazil)

Key Features: restrictive (and/or absurd) subject matter eligibility rules, protectionist policies, and/or burdensome search requirement

- KIPO: Esoteric enumerated eligibility categories for automatic admission
  - Eighth category eligible only if invention got funding or certification (Korean corp. & local office) from the Korean government
    - Renewable energy technologies (e.g., solar, wind, geothermal, tidal, bioenergy, advanced batteries), carbon reduction technologies, LEDs, green transportation, green cities, reduction of greenhouse gases
- INPI: Limited to “National” applications
- JPO: Prior art search and explanation requirement





## Variability and Inefficiency: Collective Critique of All Fast Track Programs

- A disparate patchwork of program requirements
  - Need to research each program
  - Need to prepare different sets of documents
- Variability in subject matter eligibility rules
  - Much work to determine if application is eligible
  - Several different write-ups each tailored for specific program
  - Uncertainty, will it fall into proper classification?
- Variability in process requirements
  - Need to draft several different claim sets



## Solution: Build the Global Green Patent Highway

- A harmonized international system for accelerated examination of green patent applications
  - Single standardized set of rules; same submission works everywhere
    - efficient, lower cost for applicants
  - Optimal set of program rules based on experience with individual fast track programs





## Building the Global Green Patent Highway

<b>Goal:</b>	<b>Recommendation:</b>
Boost participation by green tech applicants (but keep out non-green technologies, no free riders)	Expansive eligibility rules, particularly subject matter eligibility, but some eligibility check or review
Keep it fast / manage office and examiner workload	Reasonable process restrictions for participating applications



## Eligibility Rules: Boosting Participation

- Status eligibility:
  - Program should be permanent
- Subject matter eligibility:
  - Expansive
  - Not restricted by enumerated classes

“[B]ecause inventions which have an environmental benefit can arise in any area of technology. For example, we would accept an acceleration request for a manufacturing process which uses less energy, in the same way as we would accept an acceleration request for a wind turbine or a recycling process.”

UKIPO Green Channel Program FAQs

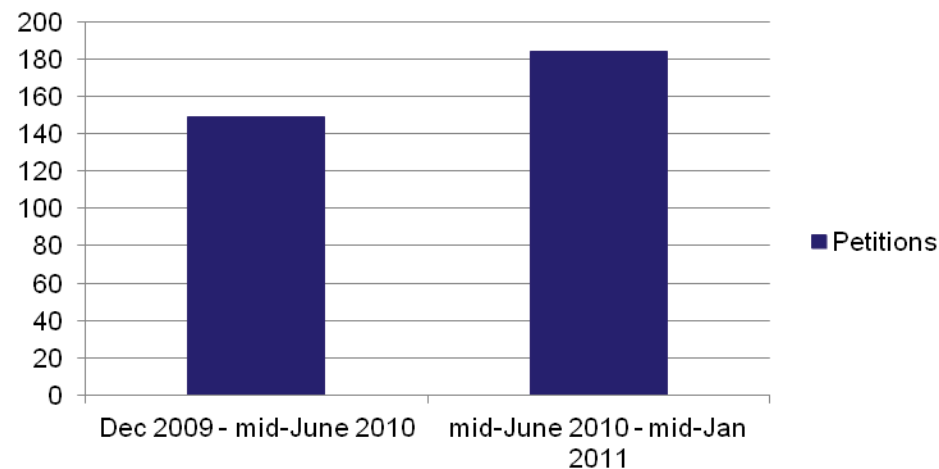
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## Eligibility Rules: Boosting Participation

Expansive subject matter eligibility boosts filings

- May 21, 2010: USPTO relaxed the subject matter eligibility rule (i.e., dropped technology classification requirement)
  - Number of petitions filed rose 26%

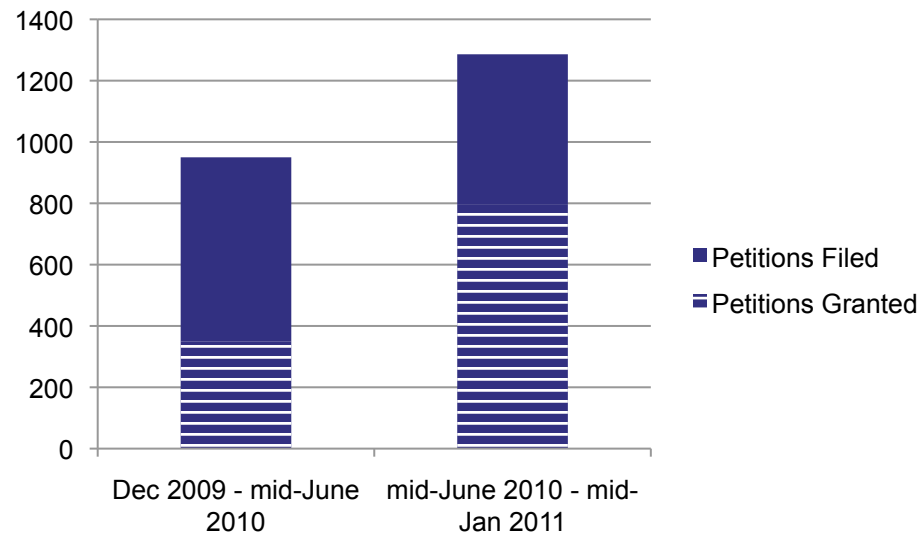
**Petitions**



## Eligibility Rules: Boosting Participation

Expansive subject matter eligibility boosts acceptance rate

- Number of petitions granted increased by 25 percentage points





## Eligibility Rules: Only Beneficial Green Technologies; No Free Riders

- “material environmental benefit” standard

“[T]he materiality standard serves as a policing mechanism to ensure that inventions that have only tangential or speculative effects on the environment cannot avail themselves of special status.”

Sarah Tran, *Expediting Innovation*, 36 Harv. Envtl. L.R. (forthcoming 2012)

- Case-by-case review (deferential but no rubber stamp)
  - Review of full submission (not just claims)
  - Review by a small number of trained reviewers (SPEs or equivalent) to maintain uniform standards





## Process Rules: Manage Examiner Workload and Keep it Fast

- Reasonable Process Restrictions
    - Limit on number of claims (12, 15, maybe 20)
    - Limit on independents (2, maybe 3)
    - Limited to single invention
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## Welcome to the Global Green Patent Highway

### Global Green Patent Highway Rules

- The applicant submits a written request containing a reasonable assertion that invention confers a material environmental benefit
  - The application contains no more than 2 independent claims, no more than 15 total claims, and no multiple dependent claims
  - The application claims a single invention (telephonic election required if not)
  - The application is newly-filed with the written request or is pending but has not yet received a first Office Action
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## Welcome to the Global Green Patent Highway

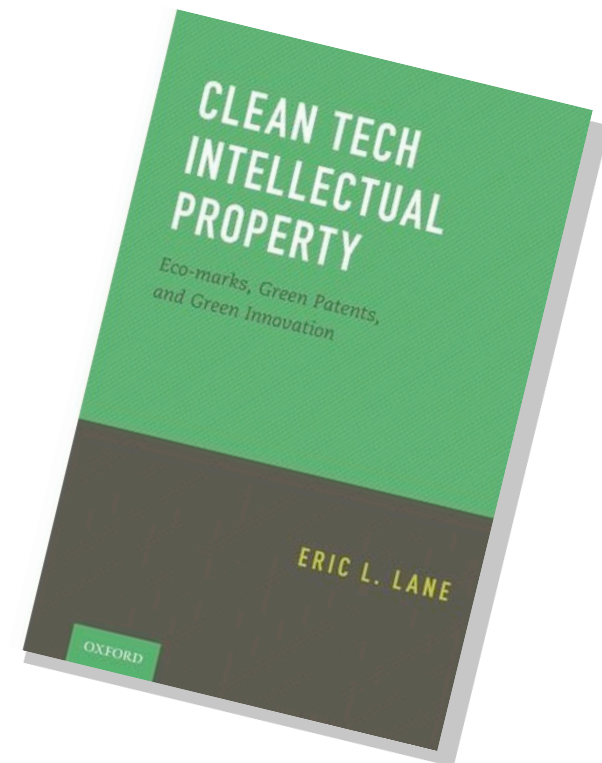
### Global Green Patent Highway Rules (continued)

- Submissions are reviewed on a case-by-case basis by a small number of trained Supervisory Patent Examiners
  - Issuance of a first Office Action will vary by jurisdiction but will not exceed three months from the filing date of the initial submission
  - The same submission (written request and conforming application) can be filed in each participating national intellectual property office
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Thank you! Questions?

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Green Patent Blog



## Presenter



Eric Lane is an adjunct professor at Thomas Jefferson School of Law and Of Counsel at McKenna Long & Aldridge in San Diego. Lane is the founder and author of Green Patent Blog – [www.greenpatentblog.com](http://www.greenpatentblog.com) – an award-winning website dedicated to discussion and analysis of intellectual property issues in clean technology. His book, *Clean Tech Intellectual Property: Eco-Marks, Green Patents, and Green Innovation*, published by Oxford University Press, is available for purchase through Oxford’s web site at [www.oup.com](http://www.oup.com), Amazon.com and select retailers.



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