

Frequently Asked Questions about the Pilot Program for Green Technologies Including Greenhouse Gas Reduction

I. List of Questions:

1. If the application has published already, is a publication fee still required to be filed with the petition to make special under the Green Technology Pilot Program?
2. Is the \$130.00 fee for a petition under 37 CFR 1.102 required?
3. Is an international application filed before December 8, 2009, but which entered the national stage under 35 U.S.C. 371 on or after December 8, 2009, eligible for the Green Technology Pilot Program?
4. If my patent application has been assigned to an art classification that is not one of those listed in section VI of the Notice, is it eligible for the Green Technology Pilot Program?
5. If my patent application has been assigned to an art classification that is not one of those listed in section VI of the Notice, can I file a preliminary amendment changing the scope of the claims such that the application is properly classified within one of the listed eligible classifications, and then file a petition for entry of the application into the Green Technology Pilot Program?
6. If my patent application has not yet been assigned to an art classification, may I submit a petition for the Green Technology Pilot Program?
7. What type of statement is required for the petition for the Green Technology Pilot Program?
8. If my petition is dismissed, do I have an opportunity to resubmit a corrected petition?
9. Where can I find the petition form PTO/SB/420?
10. The Green Technology Pilot Program states that only the first 3,000 petitions will be accepted; is the USPTO still accepting new petitions?
11. If applicant filed a defective petition and then timely filed a corrected petition after the Office has accepted 3,000 petitions, will the USPTO grant such a corrected petition?
12. Do I need to be a registered EFS-Web user to file the petition electronically?
13. If my application has been accepted under the Green Technology Pilot Program and the examiner decides that the claims are directed to multiple inventions, will the examiner enter a first Office action that contains only a written restriction without an action on the merits?
14. Could applicant file a petition to make special under the Green Technology Pilot Program with a request for early publication in an application in which the applicant previously filed a nonpublication request?
15. Since the USPTO has eliminated the classification requirement as of May 21, 2010, can applicant file a renewed petition if the petition was previously dismissed solely on the basis that the application did not meet the classification requirement (it was not classified in one of the eligible classifications listed in the original Notice)?
16. Can I file a petition to make special under the Green Technology Pilot Program with my application?
17. If my patent application has more than three independent claims or more than twenty total claims, can I file a preliminary amendment to the claims so that the application contains no more than three independent claim and no more than twenty total claims together with a petition for entry of the application into the Green Technology Pilot Program?
18. Once an application has been accepted into the Green Technology Pilot Program, can the applicant amend the application to contain more than three (3) independent claims or more than twenty (20) total claims?

19. (new) Would an application that contains some claims that are drawn to a green invention and a few other claims that are drawn to a non-green invention be eligible for advanced examination under the Green Technology Pilot Program?

II. Questions and Answers:

1. **If the application has published already, is a publication fee still required to be filed with the petition to make special under the Green Technology Pilot Program? (Posted on 12-23-2009)**

A. Yes. As set forth at numeral 7 in the Requirements section of the Notice, the petition to make special must be accompanied by a request for early publication and the publication fee set forth in 37 CFR 1.18(d). The publication of an application does not eliminate the requirement for applicant to pay the publication fee with the petition to make special. Note that this fee will not be assessed again when the application is allowed. If the application has been published, however, a request for early publication is not warranted and need not be filed.

2. **Is the \$130.00 fee for a petition under 37 CFR 1.102 required? (Posted on 12-23-2009)**

A. No. As stated in the Supplementary Information section of the Notice, no such fee is required as the petition fee has been waived.

3. **Is an international application filed before December 8, 2009, but which entered the national stage under 35 U.S.C. 371 on or after December 8, 2009, eligible for the Green Technology Pilot Program? (Posted on 12-23-2009; Modified 11-18-2010)**

A. Yes. As of November 10, 2010, the USPTO has expanded the eligibility for the pilot program to include applications filed on or after December 8, 2009, in addition to applications filed before December 8, 2009.

4. **If my patent application has been assigned to an art classification that is not one of those listed in section VI of the Notice, is it eligible for the Green Technology Pilot Program? (Posted on 12-23-2009; Modified 5-24-2010)**

A. Yes. As of May 21, 2010 the classification requirement has been eliminated. See "Elimination of Classification Requirement in the Green Technology Pilot Program," 75 Federal Register 28554 (May 21, 2010).

5. **If my patent application has been assigned to an art classification that is not one of those listed in section VI of the Notice, can I file a preliminary amendment changing the scope of the claims such that the application is properly classified within one of the listed eligible classifications, and then file a petition for entry of the application into the Green Technology Pilot Program? (Posted on 12-23-2009; Modified May 24, 2010)**

A. As of May 21, 2010 the classification requirement has been eliminated. Therefore, such a preliminary amendment is not necessary. See “Elimination of Classification Requirement in the Green Technology Pilot Program,” 75 Federal Register 28554 (May 21, 2010).

6. If my patent application has not yet been assigned an art classification, may I submit a petition for the Green Technology Pilot Program? (Posted on 12-23-2009; Modified 5-24-2010)

A. Yes. As of May 21, 2010 the classification requirement has been eliminated. See “Elimination of Classification Requirement in the Green Technology Pilot Program,” 75 Federal Register 28554 (May 21, 2010).

7. What type of statement is required for the petition for the Green Technology Pilot Program? (Posted on 12-23-2009)

A. Applicant must state the basis for the special status (*e.g.*, whether (1) development of renewable energy resources or energy conservation, or (2) greenhouse gas reduction). As stated in section III of the Notice, applicant must also provide a statement pertaining to the materiality standard if the application disclosure is not clear on its face as to the basis for the special status of the invention. It is strongly recommended that applicant provide such a statement, since what may seem “clear on its face” to applicant who has full appreciation of the invention may not be clear to the official deciding the petition.

8. If my petition is dismissed, do I have an opportunity to resubmit a corrected petition? (Posted on 12-23-2009)

A. Yes. As stated in section IV of the Notice, petitioner has one opportunity to file a corrected petition within one month or thirty days, whichever is longer, from the mailing or notification date of the decision dismissing the petition.

9. Where can I find the petition form PTO/SB/420? (Posted on 12-23-2009)

A. This form is available through EFS-Web, and is also located at <http://www.uspto.gov/forms/sb0420.pdf>.

10. The Green Technology Pilot Program states that only the first 3,000 petitions will be accepted; is the USPTO still accepting new petitions? (Posted on 12-23-2009)

A. The Pilot Program is limited to the first 3,000 petitions granted by the USPTO. The USPTO will provide a notification on the USPTO Web site once that threshold has been reached.

11. If applicant filed a defective petition and then timely filed a corrected petition after the Office has accepted 3,000 petitions, will the USPTO grant such a corrected petition? (Posted on 12-23-2009)

A. No. The USPTO will accept only the first 3,000 properly-filed petitions to make special under the Green Technology Pilot Program. After the Pilot Program, the USPTO may extend the pilot program (with modifications if necessary) depending on the feedback from the participants, the effectiveness of the pilot program, and the resources availability.

12. Do I need to be a registered EFS-Web user to file the petition electronically? (Posted on 12-23-2009)

A. Yes. Applicant must file the petition electronically using the USPTO electronic filing system EFS-Web, and selecting the document description of "Petition for Green Tech Pilot" as a follow-on document rather than a new application. In order to file a follow-on document in an application via EFS-Web, applicant must be a registered EFS-Web user who has a public key infrastructure certificate and the application must be associated with a customer number. Applicant may call the Patent Electronic Business Center at 1-866-217-9197 (toll-free) on any question regarding EFS-Web.

13. If my application has been accepted under the Green Technology Pilot Program and the examiner decides that the claims are directed to multiple inventions, will the examiner enter a first Office action that contains only a written restriction without an action on the merits? (Posted on 01-06-2010)

A. If the claims in the application are directed to multiple inventions, the examiner will contact the applicant and follow the procedure for the telephone restriction practice set forth in MPEP § 812.01. If the examiner cannot reach the applicant after a reasonable effort or applicant refuses to make an election in compliance with item 4 of section I of the notice, the examiner will treat the first claimed invention that meets the requirements in the notice as constructively elected without traverse for examination. See section V of the notice for more information. Therefore, the first Office action will contain an action on the merits of the elected invention.

14. Could applicant file a petition to make special under the Green Technology Pilot Program with a request for early publication in an application in which the applicant previously filed a nonpublication request? (Posted on 01-06-2010)

A. Yes. Applicant must file a rescission of a nonpublication request before the Office decides on the petition to make special if applicant previously filed a nonpublication request in the application. Applicant may use form PTO/SB/36 to rescind the nonpublication request, or use the revised form PTO/SB/420 when filing the petition to make special under the Green Technology Pilot Program. The Office has revised the form PTO/SB/420 to include a request for a rescission of any previously filed nonpublication request.

15. Since the USPTO has eliminated the classification requirement as of May 21, 2010, can applicant file a renewed petition if the petition was previously dismissed solely on the basis that the application did not meet the classification requirement (it was not classified in one of the eligible classifications listed in the original Notice)? (Posted on 5-24-2010)

A. Yes. Applicants whose petitions were dismissed or denied solely on the basis that their applications did not meet the classification requirement may file a renewed petition. If the renewed petition is filed before June 21, 2010, it will be given priority as of the date applicant filed the initial petition.

16. Can I file a petition to make special under the Green Technology Pilot Program with my application? (Posted on 11-18-2010)

A. Yes. The USPTO has expanded the eligibility for the pilot program to include applications filed on or after December 8, 2009, in addition to applications filed before December 8, 2009. The program has also been extended until December 31, 2011.

17. If my application has more than three independent claims or more than twenty total claims, can I file a preliminary amendment to the claims so that the application contains no more than three independent claim and no more than twenty total claims together with a petition for entry of the application into the Green Technology Pilot Program? (Posted on 01-20-2011)

A. Yes. Section I "Requirements" of the original Notice states: "For an application that contains more than three independent claims or twenty total claims, or multiple dependent claims, applicants must file a preliminary amendment in compliance with 37 CFR 1.121 to cancel the excess claims and/or the multiple dependent claims at the time the petition to make special is filed."

18. Once an application has been accepted into the Green Technology Pilot Program, can the applicant amend the application to contain more than three independent claims or more than twenty total claims? (Posted on 01-20-2011)

A. No. An application under the Green Technology Pilot Program must contain no more than three independent claims and no more than twenty total claims throughout the entire pendency of the application. Any amendment that amends the application to contain more than three independent claims or more than twenty total claims will be considered as a non-compliant amendment. Applicant would be required to file an amendment that does not amend the application to contain more than three independent claims or more than twenty total claims.

19. (new) Would an application that contains some claims that are drawn to a green invention and a few other claims that are drawn to a non-green invention be eligible for advanced examination under the Green Technology Pilot Program? (Posted on 05-17-2011)

A. The claims in the application must be directed to a single invention that meets the "green" subject matter criteria. If the application is directed to two inventions - one that meets the "green" subject matter criteria one that does not, then we would not grant the petition unless the applicant provided an amendment limiting the claims to a single invention that meets the "green" subject matter criteria. On the other hand, if the claims are directed to a single invention that meets the "green" subject matter criteria, then we would grant the petition and

examine all of the claims (subject to the 3/20 limit), even if the "green" subject matter is not manifest in every claim. Note however that "[t]he materiality standard does not permit an applicant to enjoy the benefit of advanced examination merely because some minor aspect of the claimed invention" may be directed to a green technology.