

April 2, 2010

The Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Comments on “Pilot Program for Green Technologies Including Greenhouse Gas Reduction,” 74 Federal Register 64666 (December 8, 2009)

Dear Under Secretary Kappos:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to offer comments regarding the USPTO’s Pilot Program for Green Technologies Including Greenhouse Gas Reduction as set out in the Federal Register notice of December 8, 2009.

AIPLA is a national bar association whose more than 16,000 members are primarily lawyers in private and corporate practice, in government service, and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

Our thoughts and comments on the Pilot Program as it stands today appear below. Please contact us if you would like us to further consider the Program and/or provide more details on any issue.

AIPLA recognizes and supports the Administration’s efforts to promote green technology, as evidenced for example in the President’s State of the Union address, through funding of green technology projects in the Recovery Act, and in the White House Strategy for American Innovation. Strong intellectual property protection is an essential part of any strategy that will be successful in promoting the development of new and innovative technologies.

As we understand it, the Pilot Program is intended to advance the Administration’s goal of promoting the development of green technologies by benefiting existing patent applications in predetermined green technologies that are caught in the U.S. Patent Office backlog. By relaxing the usual requirements for Petitions to Make Special, the Program may be viewed favorably by applicants. And, by taking up qualifying applications out of turn and reviewing them earlier, it is possible that the owners can develop and commercialize the green technologies more rapidly.

Thus, AIPLA supports the goals of the Pilot Program for Greenhouse Technologies, and would like to see the program be successful and grow. In this spirit, the Association would like to highlight several issues which are raised by the Program's details:

- The Pilot Program applies only to applications filed prior to the December 8, 2009 Pilot Program publication date. Because of this requirement, the Program benefits existing cases, but does not encourage the filing of additional applications on green technologies, thereby promoting additional innovation. In order to encourage additional filings, newly filed applications should be included. It is possible, however, that the resources of the PTO do not allow newly filed applications to be included at this time (this is consistent with the Program being limited to the first 3000 filed petitions to make special). Nevertheless, AIPLA would like to see the program extended to newly filed applications.
- The Pilot Program applies only to applications classified in a limited number of predetermined U.S. classifications. Due to the limited number of eligible classes, valuable technologies may be excluded. It is thus possible that an "outside the box" new green technology would be excluded – e.g., because it does not adequately fit within the existing classification scheme. Further, the existing classification system is often inaccurate in classifying claims completely. Having said this, the classification criterion is recognized as a fairly objective tool for selecting appropriate cases and for avoiding additional strain on existing Patent Office resources.
- An application identified under the Pilot Program is limited to three or fewer independent claims and twenty or fewer total claims, and the claims must be directed to a single invention (the applicant must be willing to agree to a telephone restriction without traverse). These limitations may be problematic for some technologies and applications, particularly if a new invention is groundbreaking. In addition, the continuations and divisionals will not automatically be accorded special status under the Pilot Program. AIPLA would like to see these restrictions eased. However, the Pilot Program will still be beneficial, in that development and commercialization of the technology may be aided by advancing at least one claim set.
- General Comment on Special Status Docket. Under the Pilot Program as designed, it is difficult to determine the benefit of filing the Petition for Special status because it is not clear how quickly this would advance the application as opposed to remaining in the regular docketing queue. Particularly with existing cases, an applicant may give up an earlier place in line for a worse position in a "better" line. Thus, AIPLA would like to see the Patent Office provide guidance on the number of months that will be shaved from the date of the first Office Action.

Thank you again for the opportunity to comment on this important issue.

Sincerely,



Alan J. Kasper
President, AIPLA