

Protecting Clean Technologies and Green Brands: Strategies for Getting your Eco-Patents and Eco-Marks Through the U.S. Patent & Trademark Office

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ABSTRACT

From PV manufacturing to geothermal drilling tools and from gasification equipment to wind turbines, many of the most promising clean technologies were previously developed in other industries and only later adapted for use in the clean tech boom. In addition, much of the innovation in the clean tech space consists of incremental improvements on established core technologies that have been off-patent for some time. While these valuable innovations may be worthy of patent protection, patenting such new uses of known processes and incremental improvements poses challenges in view of recent developments in patent law. In addition, clean technology companies and sustainable businesses may need to consider various strategies for protecting green brands. This manuscript presents some considerations for clean tech companies seeking patent protection for their innovations and trademark protection for their green brands.

Keywords: patent, trademark, intellectual property, branding

1 PROSECUTING CLEAN TECH PATENTS

1.1 New Uses Of Known Processes Are Patentable

It is a fundamental tenet of U.S. patent law that new uses of known processes are patentable. However, this doctrine is limited by another basic patent law principle that one cannot obtain a patent for merely discovering a new result of an old process and exploiting that new result for the same purpose. A new use must be more than “simply the application by the patentee of an old process to a new subject, without any exercise of the inventive faculty...” [1] Rather, a newly-discovered result of a known process must be directed to a different purpose to be patentable. [2]

1.1.1 Draft Process Patents And Articulate A New And Different Purpose

The courts have held that this “different purpose” criterion applies only to patents directed to processes. Thus, an applicant seeking patent protection for a new use of a known manufacturing process should consider directing the patent application to a process, that is, drafting as many process claims as possible to cover all embodiments of the invention. More importantly, the applicant should explain

in the patent application how and why the use of a production method that was used to manufacture semiconductors or hard disks, for example, constitutes a materially different purpose when used to make solar cells.

1.2 Obviousness After *KSR v. Teleflex*

To be patentable, an invention must not only be novel, but also must be a “non-obvious” variation of the what came before. In *KSR v. Teleflex*, [3] the Supreme Court instituted a more flexible obviousness test that allows the U.S. Patent & Trademark Office (“PTO”) and the courts to consider a much broader array of technology to render a patent applicant’s invention obvious. Manufacturing processes in PV or geothermal, as well as incremental improvements to known wind turbines are just a few of the technologies that are affected by the *KSR* decision.

Taking PV as an example, previously, the applicant could argue that elements of known manufacturing methods could not be combined to render a solar technology manufacturing process application obvious because the solar process solves a different problem and is in a different technical field. Now the PTO theoretically can rely on manufacturing techniques used in the semiconductor or data storage industries to reject patent applications in the solar technology field. An applicant seeking patent protection for improved solar technology manufacturing processes needs to carefully employ patent drafting and prosecution strategies in view of the revised obviousness test.

1.2.1 Emphasize An Unpredictable Use

Under *KSR*, the “predictable use of prior art elements according to their established functions” that makes a combination of elements obvious. [4] Therefore, in patent applications relating to solar cell production it may be effective to argue that using chip manufacturing processes for solar technology is either not a predictable use of such processes or tweaks or expands upon their known and established functions.

1.2.2 Emphasize Teachings Away

The *KSR* opinion confirmed that combining known elements in different prior art references is less likely to be obvious if the prior art “teaches away” from combining those elements. [5] Teaching away means that there is a known reason articulated in the references why combining one element with another would be unlikely to achieve the inventor’s objective. If, for instance, a hard disk coating process used to manufacture thin-film PV cells was thought to be able to provide only rigid encapsulants, yet PV cells need to be flexibly encapsulated, then it could be argued that the prior art process would have taught away from using it in PV cell production.

1.2.3 Argue Surprising Results Or Commercial Success

A patent applicant may also rely on the so-called “secondary considerations” of non-obviousness, the most important of which are surprising results and commercial success of the inventive combination. The same hypothetical facts about encapsulants discussed above provide an example here. The patent applicant could argue that, because scientists in the field of hard disk production believed that the coating technique could provide only rigid encapsulants, production of flexibly encapsulated PV cells by this process was a surprising result. In addition, the applicant might submit a declaration to the PTO detailing the commercial success of a new manufacturing process. The idea is that if such a combination is so profitable, somebody would have employed it before if it were, in fact, obvious.

2 PROTECTING GREEN BRANDS AND “ECO-MARKS”

How do businesses protect their green brands? Federal registration in the PTO of eco-marks – trademarks, service marks and certification marks that communicate environmentally friendly products or services – is one important way.

For example, PNC Financial Services (PNC) recently got a federal registration for the service mark GREEN BRANCH for its environmentally friendly bank branches. The biggest hurdle for PNC, and for any business that seeks federal trademark protection for a green brand name, was that the mark is arguably “merely descriptive” of the services PNC offers, i.e., financial services in environmentally-friendly facilities.

This is because U.S. trademark law prohibits federal registration for a trademark that is a generic term or descriptive of goods or services. The rationale is that it would unduly restrict competitors from conveying information about their goods or services.

By asking some questions about the business and the green brands before filing a trademark application and implementing certain strategies during prosecution of the application, companies that wish to protect their eco-marks can improve their chances of success in the PTO.

2.1 Determine Whether The Green Ways Are Part Of The Core Business

In the case of PNC Bank’s eco-mark application, the PTO’s Trademark Trial & Appeal Board (“Board”) Board ultimately ruled that PNC could have the registration for GREEN BRANCH because financial services are not typically associated with environmentally-friendly characteristics.

This decision suggests that it may be difficult for a firm whose core business is affected by environmentally-friendly practices to obtain federal registrations for their eco-marks. A business operating in a sector in which green characteristics are tangential to the goods or services provided has a stronger argument that its green trademark is not merely descriptive of its goods or services than a business whose green practices contribute to the production of its goods or the performance of its services.

If a company’s core business is affected by green characteristics, or involves environmentally friendly products, the company might consider using a certification mark (discussed below) instead of an ordinary trademark.

2.2 Draft The Listing Of Goods Or Services Without The Environmental Aspect If Possible

One eco-mark prosecution strategy is to omit any reference in the trademark application to the environmental aspect of the goods or services if possible. The PTO’s determination of whether a mark is merely descriptive is guided primarily by the applicant’s identification, or listing, of goods or services. A well-drafted listing could help an applicant avoid a descriptiveness rejection.

For example, a listing of services in an application to register the mark GREEN CLEANERS might read “cleaning services, namely, providing dry cleaning and laundry services for clothing, linens, bedding and the like.” This listing accurately describes the services and makes no mention of the environmentally friendly equipment or recyclable cleaning chemicals the business is using.

2.3 Add A Non-Descriptive Element To The Mark

If the desired mark contains an environmentally descriptive term such as “green” or “clean” or “eco” then adding a non-descriptive or arbitrary element to the mark could improve the applicant’s chances of obtaining a federal registration. When a mark contains multiple terms, both the combination of terms as well as the individual terms are examined to make a descriptiveness determination.

2.4 Consider Certification Marks

If a firm’s core business is affected by green characteristics, or involves environmentally-friendly products, processes or services, using a certification mark may be a good strategy.

Instead of indicating the commercial source of a product or service, certification marks communicate that goods or services meet certain quality or manufacturing standards. They are owned not by the individual businesses, but by the organizations that set the standards.

It is the certifying organization, not the ultimate user, that applies to the PTO for federal registration of a certification mark. A business, in turn, contacts the certifying organization to request evaluation of its goods, services or practices if the business wants to use the certification mark.

The organization is free to set the standards for its certification mark as it sees fit; there is no government control over the standards the certifier uses. The certifying organizations permit businesses to use the certification marks only if they satisfy the appropriate standards.

A business interested in using a certification mark to market its goods or services should research the reputation of the certification mark and the certifying organization to determine whether the mark would be beneficial to its business.

Two examples of well known and reputable green certification marks are the U.S. Environmental Protection Agency’s (EPA) Energy Star certification and the U.S. Green Building Council Leadership in Energy and Environmental Design (LEED) certification.

3 CONCLUSION

Consideration of some of the patent and trademark prosecution strategies discussed above should help clean tech companies protect their innovations and green brands.

REFERENCES

- [1] *Brown v. Piper*, 91 U.S. 37, 41 (1875).
- [2] *See Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1376 (Fed. Cir. 2001) (“[n]ewly discovered results of known processes directed to the same purpose are not patentable because such results are inherent”).
- [3] 127 S. Ct. 1727; 167 L. Ed. 2d 705 (2007).
- [4] *See id.* at 712.
- [5] *See id.* at 721.