

# Client Alert.

September 16, 2011

## Patent Reform Effective Dates Cheat Sheet

By James J. Mullen, III and Colette R. Verkuil

Today President Obama signed the Leahy-Smith America Invents Act (“AIA”) into law, thus completing the first major overhaul to the patent act in almost 60 years. You can read our prior alerts, which provide an overview of the revisions [here](#) and [here](#). In the upcoming weeks we will issue additional in-depth client alerts concerning the new post-grant review procedures. Morrison & Foerster LLP will be hosting client seminars in [San Diego](#), [Palo Alto](#), and [San Francisco](#) to discuss how to best navigate these changes. Click on the cities above to find out more information and register for these seminars.

We have included a table below for ease of reference in deciphering when the various provisions of the AIA go into effect. The default effective date of the AIA is set in Section 35, which provides that “Except as otherwise provided in this Act, the provisions of this Act shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and shall apply to any patent issued on or after that effective date.” Since the bill was enacted upon President Obama’s signature today, the effective date of the AIA will be the expiration of the one-year period starting September 16, 2011. There are, however, many exceptions within the AIA. We have included a table below for ease of reference in deciphering when the various provisions of the AIA go into effect.

Issue (§ of AIA)	Effective as of...
Transition from first to invent to first to file (§3)	The expiration of the 18-month period starting September 16, 2011 Applies to any patent application that has an effective filing date on or after this effective date.
Assignee of invention may file a patent application (§4)	The expiration of the one-year period starting September 16, 2011 Applies to any patent application filed on or after this effective date.
Defense to infringement based on prior commercial use (§5)	Available as a defense to all patents issued on or after September 16, 2011.
Post-grant review (§6)	The expiration of the one-year period starting September 16, 2011 Applies to any patent issued before, on, or after the effective date. Within one year of enactment the Patent Office must establish a system for post-grant review.

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Pre-issuance submissions by third parties (§8)	The expiration of the one-year period starting September 16, 2011 Applies to any patent application filed before, on, or after the effective date.
PTO's fee setting authority (§10)	September 16, 2011, except for the electronic filing incentive provision, which goes into effect upon the expiration of the 60-day period beginning September 16, 2011.
New Fees (§11)	A 15% surcharge will be added to all patent-related fees as of September 26, 2011.
Supplemental examination (§12)	The expiration of the one-year period starting September 16, 2011 Applies to any patent issued before, on, or after the effective date.
Elimination of tax-strategy patents (§14)	September 16, 2011 Applies to any patent application pending on, or filed after September 16, 2011 and to any patent that is issued on or after September 16, 2011.
Elimination of best mode defense (§15)	September 16, 2011 Applies to any proceedings commenced on or after September 16, 2011.
Virtual marking and Elimination of <i>qui tam</i> false marking cases (§16)	September 16, 2011 Applies to all cases that are pending on, or commenced on or after September 16, 2011.
Transitional program for business method patents relating to financial products (§18)	The expiration of the one-year period starting September 16, 2011 Applies to any covered business method patent issued before, on, or after the effective date (with limited exceptions). Within one year of enactment, the Patent Office must establish a system for post-grant review.
Joinder of parties (§19)	Applies to any civil action commenced on or after September 16, 2011.
End of fee diversion: USPTO's fees directed to reserve account (§22)	October 1, 2011
Prohibition against patents "directed to or encompassing a human organism" (§33)	Applies to any patent application pending on, or filed on or after September 16, 2011.

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*Because of the generality of this update, the information provided herein may not be applicable in all situations and should not be acted upon without specific legal advice based on particular situations.*