



BOARD CERTIFIED-PROVEN, TESTED EXCELLENCE®

The National Board of Trial Advocacy to Offer New Board Certification in Patent Litigation

Wrentham, MA April 11, 2021

The National Board of Trial Advocacy (NBTA) has announced a new attorney board certification in the legal specialty area of Patent Litigation which was recently awarded national accreditation. The NBTA will offer board certification in this practice area soon.

The committed work of a new division of the NBTA, the National Board of Patent Litigation Lawyers (NBPLL), created the new board certification, which requires strict requirements of relevant experience, passing a rigorous examination, meeting high ethical standards, continuing legal education, and peer review. "The National Board of Trial Advocacy, the country's largest and oldest national board certifying organization, is committed to ensuring that consumers of legal services get the representation they need and deserve," said NBTA President Jim Richardson. He added, "those consumers will know and appreciate that an NBTA lawyer's credentials have been fully vetted, and their knowledge thoroughly tested."

According to Jim Wren, an NBTA past president, "Patent Litigation is highly technical and detailed, requiring a high degree of specialization and understanding." He added, "There is now an objective and verifiable way to assure the patent litigation qualifications of attorneys in this unique legal area."

Chief Judge Rodney Gilstrap of the U.S. District Court for the Eastern District of Texas, a founding member of the NBPLL, said: "This provides a tangible means of identifying and properly recognizing those lawyers of both proven knowledge and established skill in the development and trial of patent cases." "There has been a need for this certification for some time. I believe this new level of recognition will serve both the Bar and the Bench very effectively."

The NBPLL is comprised of leading experts in this legal specialty, including nationally recognized attorneys and a distinguished law professor. The NBPLL was led by its President, The Honorable Rodney Gilstrap, Chief Judge, United States District Court for the Eastern District of Texas.

The National Board of Trial Advocacy is a not-for-profit organization founded in 1977 to guide consumers of legal services through a robust program of legal specialization and board certification. With this new certification, NBTA now offers board certification in the following legal specialties: Complex Litigation, Civil Trial Law, Civil Practice Advocacy, Criminal Trial Law, Family Trial Law, Patent Litigation, Social Security Disability, and Truck Accident Law.

For more information, contact Melissa Sternbach, Executive Director, at (508)384-6565 or info@nbtalawyers.org.

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General Principles for Certification of Patent Litigation Advocates

- (A)** No standards shall in any way limit the right of a certified Patent Litigation specialist to practice law in all fields.
- (B)** No lawyer shall be required to obtain a board certification in Patent Litigation before he or she can practice in this field.
- (C)** Certification is individual and voluntary. Certification is open to all who qualify.
- (D)** A lawyer may have more than one certification from various divisions of the National Board of Trial Advocacy.
- (E)** Certification shall be for five (5) years, after which time the certificate cannot be used unless the lawyer is recertified. Certification may be revoked at any time for violations of the General Principles or Standards of the National Board of Trial Advocacy.
- (F)** Application will be made to the National Board of Trial Advocacy, on the forms supplied by the Board, and accompanied by the appropriate fee.
- (G)** An applicant must complete all requirements, including the examination, within two (2) years of application. If the certification process is not satisfactorily completed within the two (2) year period, the applicant will need to reapply and re-submit all required fees. An application can be denied at any time within the two (2) year application period for failure to successfully meet the requirements for certification.
- (H)** Board certification will be issued upon a showing by the applicant, confirmed by the Board's own investigation, that the applicant complies with the qualifying standards for certification.
- (I)** All applications and other information submitted to the National Board of Trial Advocacy shall be privileged and confidential, other than as compelled by law, except that the Board may reveal the fact of an application for the purpose of verifying information submitted by the applicant and for the purpose of making such inquiries with respect to the character and professional reputation of the applicant as may be authorized by its rules.
- (J)** The National Board of Trial Advocacy does not discriminate against any lawyer seeking certification on the basis of race, religion, gender, sexual orientation, disability, or age.

Standards for Certification

(A) Good Standing and Period of Practice

- (1) The applicant shall furnish evidence of his or her good standing in the state of his or her admission, or if admitted in more than one state, in the state of his or her principal practice.’
- (2) Immediately preceding application, the applicant must have been licensed for at least ten (10) years to practice law and have spent the last five (5) years in the actual practice of Patent Litigation. For purposes of this certification, “Patent Litigation” refers generally to issues related to the Patent Act, the America Invents Act and related statutes in civil litigation – and including how the Federal Rules of Civil Procedure, relevant portions of U.S. Code Title 35, and judicially- created doctrines are employed when dealing with these Patent matters.

(B) Substantial Involvement

- (1) The applicant must make a satisfactory showing of substantial involvement relevant to specialty certification in Patent Litigation, with at least thirty-five (35) percent of his or her time spent practicing Patent Litigation during the three (3) years preceding the filing of the application.
- (2) Within the applicant’s career, the applicant must have actively participated in at least one hundred (100) contested matters involving the taking of testimony or motion practice. This may include non-jury trials; evidentiary hearings or depositions; motions heard before or after trial; and arbitration hearings.
- (3) Within the applicant’s career, an applicant must have accumulated a total of 1500 points, in accordance with the following: Qualifying Activities, no more than 600 points may be accumulated under the pretrial activity category, and no more than 1000 points may be accumulated

Qualifying Trial Activities (No limit on cumulative points in this category)	Points	Max. Pts
Tried federal patent infringement jury trial to verdict or hung jury as lead counsel.	300	Unlimited
Tried federal patent infringement jury to verdict or hung jury as associate counsel.	150	450
Tried federal patent infringement bench trial to decision as lead counsel.	200	Unlimited
Tried federal patent infringement bench trial to decision as associate counsel.	100	300

Qualifying Appellate/Agency Activities (Maximum 300 cumulative points in this category)	Points	Max. Pts.
Lead counsel in a Federal Circuit appeal as a party at interest (not amici)	150	300

Associate counsel in a Federal Circuit appeal as a party at interest (not amici)	75	150
Counsel in a Federal Circuit appeal for amici	50	100
Lead counsel in ITC sec. 337 investigation (predicated on patent infringement) through hearing and initial determination.	150	300
Associate counsel in ITC sec. 337 investigation (predicated on patent infringement) through hearing and initial determination	75	150
Lead counsel in PTAB <i>inter partes</i> review proceeding	100	200
Associate counsel in PTAB <i>inter partes</i> review proceeding	50	100

Other Qualifying Activities (Maximum 1,000 cumulative points in this category)	Points	Max. Pts.
Conducted Claim Construction argument	50	250
Argued dispositive motions, <i>Daubert</i> motions, or motions in limine in a patent pretrial hearing	50	250
Appointment as lead (100 points) or to steering committee (60 points) for a defendant in a federal patent infringement joint defense group	100 or 60	200
Argued for/against motion to enhance willful infringement damages in a patent post-trial hearing	50	250
Argued for/against JMOLs regarding infringement, validity or damages in a patent post-trial hearing	50	250
Argued for/against injunction or compulsory royalty in a patent post-trial hearing	50	250
Appointment as mediator or special master in a patent infringement case	100	600
Taught law school patent litigation course (infringement, validity, patentability et al topics)	50	200
Authored legal article, book, or treatise chapter on patent litigation (such as: infringement, validity, 101, 285, etc.)	60	250

Lead Counsel

Lead counsel is an attorney substantially responsible for the personal representation of the client during the trial and includes, at a minimum:

- (1) Selecting a jury, opening, or closing, and;
- (2) Presentation of live witnesses through direct and cross examinations.

Associate Counsel

Associate counsel is attorney trying the case with lead counsel and taking an active role at trial including the presentation of live witnesses.

Former Judges

Former Article III and Article I judges may obtain the benefit of their experience presiding over patent infringement cases. A judge who has presided over proceedings in patent infringement cases may accumulate points for any qualifying activities at the same point level, with concomitant caps, as the lawyers who participated in the case (e.g., presiding over a patent infringement trial would result in 300 points, and presiding over a claim construction argument would result in 50 points).

(C) Educational Experience

- (1) The applicant must demonstrate substantial participation in continuing legal education and the development of the law with respect to Patent Litigation in the three (3) year period immediately preceding application, either:
 - (a) By attendance and/or electronic participation in not less than forty-five (45) hours of continuing legal education in Patent Litigation or ethics, approved by the Standards Committee, or
 - (b) By equivalent participation through, but not limited to, the following means, approved by the Standards Committee:
 - (I) Teaching courses or seminars in Patent Litigation or ethics;
 - (II) Participation as a panelist, speaker, or workshop leader, at educational or professional conferences where the participation primarily relates to Patent Litigation, or
 - (III) Authorship of books or articles published in professional journals, on topics of Patent Litigation.

Please note: Florida, South Carolina and Ohio require a higher number of CLE credit hours in order to advertise or communicate the NBTA certification. Check with your local rules or the NBTA for more details. NBTA does not recognize an exemption from CLE requirements based on age or years in practice.

(D) Peer Review

- (1) The applicant shall submit with the application the names and addresses of ten references, not present partners, associates, or relatives of the applicant (except as noted below). These references should be from persons involved in the relevant field of Patent Litigation, or substantially so, and be familiar with the applicant's practice in that field. References may include judges, attorneys, special masters and settlement masters.
- (2) The NBTA will solicit confidential statements from all persons listed as references and may solicit confidential statements of reference from other persons familiar with the applicant's practice though not specifically named by the applicant. The reference forms shall inquire into the respondent's areas of practice, the respondent's familiarity with both Patent Litigation and with the lawyer seeking certification, and the length of time that the respondent has been practicing law and has known the applicant. The form shall inquire about the qualifications of the lawyer seeking certification in various aspects of the practice and, as appropriate, the lawyer's dealings with judges and opposing counsel. All reference statements received will be reviewed by the NBTA to assess whether the applicant has demonstrated an enhanced level of skill and expertise in Patent Litigation, and has demonstrated integrity, professionalism, and appropriate dedication to the interests of clients.
- (3) After inquiries are directed to these references by the NBTA, responses satisfactory to the NBTA must be received from at least five references, none of whom shall be from persons related to or engaged in legal practice with the applicant. At least three of these five satisfactory references must be from either judges before whom the applicant has appeared on a Patent Litigation matter or from lawyers against whom the applicant has handled a Patent Litigation matter, or from a combination of these two categories. At least two satisfactory references (either from the five references above or from additional references) must be received from National Board of Trial Advocates or from a member of the bar licensed for at least ten (10) years, only one of whom may be a partner, co-shareholder, senior attorney, etc. of the applicant.

(E) Examination

The applicant must pass a written examination to test his or her proficiency, knowledge, and experience in Patent Litigation, so that the applicant may justify his or her representation of specialization to the public.

(F) Legal Writing Document

The applicant shall submit a copy of a legal writing document which he or she has prepared, authored no more than three (3) years before the date of application, but not necessarily published. This must be a substantial document in the area for which the applicant seeks certification, containing concise and accurate writing, stating facts (either actual or hypothetical), stating applicable law, and analyzing how the law applies to the facts. It must be written in an appropriately argumentative manner and be well-constructed (i.e. organized, grammatical, demonstrative of good syntax and usage). Acceptable documents include, but are not limited to: briefs, motions for summary judgment, *Daubert* motions, motions in limine, and bar journal or law review or legal magazine articles. The quality of the legal document will be an important factor in determining whether the applicant is qualified for certification.

(G) Disclosure of Conduct

- (1) In order to assist the NBTA's evaluation of whether the applicant possesses an enhanced level of skill and expertise in Patent Litigation and has demonstrated integrity and dedication to the interest of clients, the applicant shall, to the extent known, disclose to the National Board of Trial Advocacy as soon as permitted by law:
 - (a) The filing of any criminal charges against the applicant together with all details called for by the Disclosure of Conduct Form;
 - (b) The filing or submission of any allegation of unethical or inappropriate professional conduct with any court, grievance committee or disciplinary board or body together with all details called for by the Disclosure of Conduct Form.
 - (c) The assertion of any claim of professional negligence or professional liability, whether or not suit has been filed, which is based in an part on alleged acts or omissions of the applicant or on the acts or omissions of any other attorney over whom the applicant had any responsibility together with all details called for by the Disclosure on Conduct Form.
 - (d) Any order from any court disqualifying the applicant from appearing in any forum or sanctioning the applicant personally.
- (2) The National Board of Trial Advocacy shall determine, in accordance with its standards and procedures, whether the conduct is such that certification should be granted, denied, suspended or revoked, or whether action should be deferred pending receipt of additional information. The NBTA will take into consideration any findings made by other bodies concerning such conduct, but is not bound by any such findings and will make its own independent assessment concerning how such conduct bears on whether an attorney is qualified to obtain or maintain certification.

- (3) The failure of an applicant to disclose such conduct is a material misrepresentation and may be cause for rejecting an application or refusing to grant certification, or for suspending or revoking a certificate.
- (4) The applicant shall have a continuing duty to disclose such matters to the Board, including after obtaining certification, throughout the time that the member attorney continues to be certified in Patent Litigation.

Annual Reporting

Annually, members will be required to submit a Disclosure of Conduct form and annual dues. The member's annual dues and Disclosure of Conduct (Part G of the Certification Standards) must be current before an application for recertification will be granted. Disclosures of Conduct/Liability shall be submitted to the Standards Committee to determine if certification should be continued.

Denial of Revocation of Certification

- (A) An application for certification may be denied for failure to comply with any of the requirements relating to good standing, substantial involvement, educational experience, peer review, examination, legal writing document, disclosure of conduct, financial responsibility, or any other failure to demonstrate possession of an enhanced level of skill and expertise in Patent Litigation and the necessary level of integrity, professionalism, and dedication to the interests of clients.
- (B) An application for recertification may be denied for failure to comply with any of the requirements relating to good standing, substantial involvement, educational experience, peer review, disclosure of conduct or any other failure to demonstrate possession of an enhanced level of skill and expertise in Patent Litigation and the necessary level of integrity, professionalism, and dedication to the interests of clients.
- (C) An existing certification may be revoked for failure to demonstrate maintenance of an enhanced level of skill and experience in Patent Litigation and the necessary level of integrity, professionalism, and dedication to the interests of clients as required for certification or for failure to maintain compliance with the financial responsibility requirements.
- (D) Decisions of the examination Committee and the Legal Writing Review Committee are final and not subject to further review or appeal. An attorney who is refused certification for any other reason, or who is refused recertification or whose certification is revoked, may pursue review under the Appeal Procedures of the NBTA. Exhaustion of this right shall be a condition precedent to judicial review.
- (E) A lawyer who is denied certification or recertification, or whose certification is revoked, may not apply for certification until one year after the date of such denial or revocation.
- (F) Suspension of the license to practice law shall operate as an automatic revocation of certification.

- (G)** A lawyer who publicizes a certification or application for certification prior to its being granted, or who continues to publish a certification after it has been revoked or suspended, may be barred from certification.