

Memo: Patent Litigation Examination Information

From: Elizabeth Collins, Director of Examinations and State Accreditations

OVERVIEW:

The Legal Specialization program was created to provide a method for attorneys to earn the designation of certified legal specialist in particular areas of law for the purposes of increasing public protection and encouraging attorney competence. As part of the certification process, an applicant must pass a written examination in the specialization area. Board Certification is the process that is designed to identify the highly qualified attorneys in the practice area.

FORMAT:

The examination consists of a combination of multiple choice and short answer essay questions and is a total of 6 hours: A Morning Section (8:30 a.m. – 11:30 a.m.) with a one-hour break and an Afternoon Section (12:30 p.m. – 3:30 p.m.) given on a Saturday. The 3-hour morning section is entirely multiple choice and the 3-hour afternoon section is made up of short answer essays that contain subparts of hypothetical cases and fact patterns which contain a series of questions that require knowledge of civil procedure, evidence, trial practice, substantive patent law and ethics. The questions test knowledge of the current law and are geared to evaluate basic knowledge of the usual legal procedures, core substantive law and trial ability that is common to specialists in the area of patent litigation law. **NBTA's examination is nationally administered. Questions are to be answered by applying the permitted reference materials below:**

- **Federal Rules of Evidence**
- **Federal Rules of Civil Procedure**
- **ABA Model Rules of Professional Conduct - FOR MULTIPLE CHOICE & ESSAYS OR**
- **ONLY FOR THE ESSAY SECTION OF THE EXAMINATION - If an applicant's state laws differ from Federal Law, an applicant may indicate the state and the applicable state law but is to respond using Federal Law as it applies to a given set of facts in the outcome of the issues presented**
- **Title 35 of the U.S. Code**
- **Title 21 and 28 of the U.S. Code**

It is not designed to be a bar or law school type of examination.

- **Multiple Choice Questions**
The Multiple-Choice questions test an applicant's knowledge of federal law. Individual state law is not tested on the Multiple-Choice section of the examination.

- **Essay Questions**

The examination's essay questions are also designed to be answered under federal law. However, if an applicant's state laws differ from federal law an applicant may indicate the state and the applicable state law but is to respond using federal law as it applies to a given set of facts in the outcome of the issues presented.

- **A passing score is 75%.**

Multiple Choice questions are 40% of the score and Essays are 60%. A combined score of 75% must be achieved in order to pass the examination. There are 60 multiple choice questions. A failing score in the Multiple-Choice ETHICS portion of the examination results in a failure of the entire examination. However, only the ETHICS portion of the examination must be retaken and passed.

TIMING:

The examination is given twice a year. Registration material for an examination is sent two months prior to the examination date. You will automatically receive registration material before every examination until you have actually taken and passed one (contingent upon file eligibility). There is no need to contact our office if you cannot take a particular examination.

LOCATION:

The NBTA Board Certification Examination in all areas of law will be offered only as an online examination that can be taken from your home or office using software from Examsoft called Examplify. You must sign up at least 30 days prior to the date of the administration of the examination and NO EXCEPTIONS can be made.

COST:

The application fee is \$400. The Examination fee is \$400. Please click [here](#) for the entire NBTA Fee Schedule.

CONTACT:

If you have any additional questions, please call me at **386.986.7590** or email me at **ecollins@nbtalawyers.org**. I look forward to helping you complete our examination requirement.

Specifications for the National Board of Trial Advocacy Patent Litigation Certification Examination

Purpose of the Examination: The Patent Litigation Examination is designed to verify the applicant's basic knowledge of the usual legal procedure, core substantive law, and trial ability commonly possessed by specialists in this area. In addition to the pre-trial and the trial process, patent litigation includes evaluating, handling, and resolving patent matters prior to the initiation of a lawsuit as well as the appellate processes.

An applicant is expected to demonstrate the ability to identify the issues, state and apply the applicable law, and analyze the law to the facts. It is recognized that the subject areas below may overlap, which may require incorporation of more than one substantive or procedural area in an answer. The order of the subject areas does not reflect their relative importance, nor does the sequence represent an implied order of their application in practice.

Subject Area 1: Professional Responsibility

- 1.1 Ethical duties to client, opposing counsel and the Court / attorney as witness
- 1.2 Basis of sanctions
- 1.3 Fee agreements / bases for fees / declining terminating representation
- 1.4 Prohibited referrals and inducements / contact with prospective clients
- 1.5 Dual representation / conflicts of interest / independent professional judgment
- 1.6 Unauthorized practice of law / restrictions on right to practice law
- 1.7 Dealing with paralegals and other non-attorney staff
- 1.8 Trial publicity
- 1.9 Disciplinary actions and reporting requirements

Subject Area 2: Evaluation, Remedies and Defenses

- 2.1 Patentability requirements
- 2.2 The patent specification and claims
- 2.3 Inventorship
- 2.4 Double patenting
- 2.5 Infringement
- 2.6 Claim interpretation
- 2.7 Unenforceability
- 2.8 Defenses to infringement
- 2.9 Remedies
- 2.10 The Hatch-Waxman Act
- 2.11 Design patents
- 2.12 Patent Trial and Appeal Board Proceedings
- 2.13 Assignments and licenses
- 2.14 Time limits

Subject Area 3: Jurisdiction, Venue and Joinder

- 3.1 Subject matter jurisdiction
- 3.2 Jurisdiction over parties
- 3.3 Service of process and notice
- 3.4 Venue and transfer
- 3.5 Joinder of parties and claims
- 3.6 Remand

Subject Area 4: Practice and Procedures

- 4.1 Pleading requirements and deadlines
- 4.2 Discovery (see Subject Area 6 below)
- 4.3 Federal Rules of Civil Procedure
- 4.4 Federal procedure for pretrial discovery plan, scheduling conference and order
- 4.5 Rules governing motions and briefs
- 4.6 Rule 12, F.R.Civ.P motions
- 4.7 Judicial findings and conclusions
- 4.8 Directed verdicts and dismissal of cases
- 4.9 Summary judgments and other dispositive adjudication without trial
- 4.10 Settlements / judgments / subrogation / collateral source
- 4.11 Emergency and injunctive relief
- 4.12 Voir dire
- 4.13 Opening statements / closing arguments
- 4.14 Jury instructions
- 4.15 Post-trial motions
- 4.16 Appealability and review / making a record

Subject Area 5: Evidence

- 5.1 Authentication and introduction of evidence / mode and order / relevance and probative value
- 5.2 Relevance exclusions, including subsequent remedial measures, settlement offers and compromise
- 5.3 Proper use of demonstrative and other trial exhibits / writings, recordings, photographs, experimental evidence and the optional completeness rule
- 5.4 Qualification of expert and lay witnesses / expert and lay testimony and opinions / scientific evidence
- 5.5 Judicial notice
- 5.6 Privileges and other exclusionary policies, including attorney-client and work product
- 5.7 Refreshing recollection and impeachment of witnesses
- 5.8 Hearsay and exceptions to the hearsay rule

Subject Area 6: Discovery

- 6.1 Scope of discovery and federal automatic disclosure requirements
- 6.2 Timing of and limitations on discovery
- 6.3 Expert designations, reports and privileges
- 6.4 Deposition practice and procedure
- 6.5 Interrogatories, requests for production and requests for admission.
- 6.6 Sanctions
- 6.7 Non-party subpoena practice
- 6.8 Federal rules governing electronic discovery

PATENT LITIGATION EXAMINATION MANUAL (Revised 7/2021)

Please note: your demonstration of knowledge of EVIDENCE and ETHICS are important.

Failure of the ETHICS portion will result in failure of the examination.

The following are samples of the multiple choice portion of the examination:

1. Garcia filed a patent application at the USPTO on February 12, 2013, fully describing and clearly claiming his new levitating light bulb. Garcia claimed international priority from a patent application he had previously filed at the European Patent Office on March 10, 2012. During the course of prosecution at the USPTO, Garcia filed a continuation application on November 3, 2015. The USPTO allowed Garcia's application to issue as a granted patent on August 4, 2016. Garcia's patent was not subject to Patent Term Adjustment. Garcia never paid any maintenance fees with respect to his patent.

What is the expiration date of Garcia's patent?

- A. August 4, 2020**
- B. March 10, 2032**
- C. February 12, 2033**
- D. November 3, 2035**

ANSWER: A

2. Goldberg developed the idea of a lawnmower robot on November 1, 2019, and constructed a prototype of the robot on December 14, 2019. On January 15, 2020, while on a business trip in Canada, Goldberg displayed the prototype and distributed detailed technical specifications of the robot to participants in a convention for lawn care professionals. Goldberg filed a patent application at the USPTO fully describing and clearly claiming the robot on October 15, 2020.

Park independently conceived of the identical robot on August 23, 2019. Park did not devote further time towards the project until January 1, 2020. At this point Park worked continuously on the project until she developed a prototype on January 13, 2020. Park filed a patent application at the USPTO fully describing and clearly claiming the robot on May 4, 2020.

Which party is entitled to priority of invention with respect to the lawnmower robot?

- A. Goldberg, because he was the first to reduce the invention to practice.**
- B. Goldberg, because he was the first to disclose the robot to the public, and he filed an application at the USPTO within a year of that disclosure.**
- C. Park, because she was first to conceive of the robot, and diligent prior to Goldberg's conception until her own reduction to practice.**
- D. Park, because she was first to file an application at the USPTO.**

ANSWER: B.

The additional sample questions that we provide below are designed for our Civil Trial Examinees. While they are not specific to Patent Litigation, they are designed to give examinees an idea of the format of the questions that will appear on the Patent Litigation examination.

CIVIL EVIDENCE

1. During a break in settlement negotiations in a negligence case, the plaintiff and defendant, not in the presence of their attorneys, are having a cordial conversation. The defendant says to the plaintiff, "I'm sorry about the accident. I should have been more careful." Settlement negotiations are not successful and the case is on trial. During the plaintiff's direct testimony, his attorney asks him about the conversation he had with the defendant while the parties were engaged in settlement negotiations. Defendant's counsel objects.

Which of the following best reflects the proper ruling on the objection?
Objection-

- A. sustained because statements made during settlement negotiations are not admissible.**
- B. sustained because the statements made by plaintiff are irrelevant to the case.**
- C. overruled because defendant's statement was an admission against interest.**
- D. overruled because neither party's attorney was present during the conversation.**

ANSWER: A

2. This is a product liability case on trial in federal district court. Plaintiff is suing for property damage and economic loss because of the malfunction of computer equipment sold to it by defendant. Defendant claims that plaintiff expressly assumed the risk. During its case-in-chief defendant offers into evidence a shipping invoice, signed by plaintiff's receiving agent, which contains the following language:

"BUYER agrees to buy said goods with the full understanding that it will be solely responsible for any losses or consequential damages caused by said goods. BUYER ACKNOWLEDGES THAT IT HAS FULLY EXAMINED THE GOODS AND IS FULLY AWARE OF ANY DEFECTS IN WORKMANSHIP."

Is the exhibit admissible?

- A. No, because the invoice is hearsay.**
- B. Yes, because the invoice has independent legal significance.**
- C. No, because the invoice is not a business record.**
- D. Yes, because the invoice is a business record.**

ANSWER: B

CIVIL ETHICS

1. Attorney Jones represented Jack, who was injured in a bar-room brawl with Albert. After a pre-trial hearing, Attorney Jones talked to a local news reporter and stated, "We feel good about our chances. My client defended himself that night. He was hit with a pool cue by Albert, who was drunk. Albert failed his breathalyzer test. Go look it up. It's all in the police report. This isn't the first time Albert has done stuff like this. It's time for people in this community to hold him accountable." **Can Attorney Jones make these statements in his media interview?**
- A. Yes. All statements of Attorney Jones quote or make reference to a public record, or are Jones's personal opinions about Jack and Albert.**
 - B. Yes. Breathalyzer results are inadmissible and will not be considered by the jury.**
 - C. No. An attorney cannot make general, public comments on the character, credibility or criminal record of a party or witness.**
 - D. No. Ethical rules presume that comments from an attorney within 30 days of trial are prejudicial and improper.**

ANSWER C

2. You have been informed by a large national insurance company that they would like to retain your services to represent their insured in relation to a car wreck in which their insured was involved and in which a lawsuit has been filed against their insured. The insurance company has informed you that they will pay your attorney's fees and all costs associated with defending this lawsuit and otherwise representing their insured.

QUESTION: Under what circumstances, if any, can you represent the insured?

- A. There are no restrictions on an attorney's ability to be able to represent the insured/client under these circumstances.**
- B. Provided that you obtain the insured/client's informed consent, you are ethically permitted to represent the insured/client.**
- C. You can only represent the insured/client under these circumstances if you obtain his informed consent, it does not interfere with your independent professional judgment, and communications with the insured/client are protected as privileged.**
- D. You can only represent the insured/client under these circumstances if you obtain, in writing, his consent.**

ANSWER: C

The following are samples of the essay portion of the examination:

SAMPLE 1:

CIVIL ETHICS AND CIVIL LITIGATION

Adam, an African-American employee of Reliable Towing Company (Reliable Towing), was terminated by Joe, the white owner of the company, for allegedly stealing equipment. Anticipating the firing, Adam secretly carried a tape recorder in his jacket pocket and recorded the firing without Joe's knowledge. Adam had previously seen Attorney Russell, because he felt that Joe was treating him unfairly. His attorney advised him to obtain "concrete" evidence of discrimination if he wanted to pursue a case. Adam returned to see his attorney with a tape recording. Adam filed a wrongful termination suit against Joe and Reliable Towing alleging that the firing violated his civil rights. Joe's attorney sent discovery requests that sought any and all recorded statements related to the events described in the plaintiff's complaint. Adam's attorney, Russell, did not provide or identify the recording in discovery responses. He replied "none" to the request.

Attorney Russell deposed Joe and asked Joe “Did you ever tell my client ‘Brother, get off of my property’ after you fired him?” Joe responded “no.” The next day Attorney Russell sent Joe’s attorney and the attorney for Reliable Towing a copy of the tape recording of the firing where the statement “Brother, get off of my property” may be heard. Attorney Russell sent a letter with the tape arguing that the statement is evidence that Joe fired Adam in violation of his civil rights and demanded an immediate financial settlement.

Pursuant to a local statute it is a criminal violation to “willfully intercept, endeavor to intercept, or procure any other person to intercept or endeavor to intercept, any oral communication.” The statute further prohibits one to “willfully disclose, or endeavor to disclose, to any other person the contents of any oral communication, knowing or having reason to know that the information was obtained through the interception of an oral communication in violation of the subtitle.” It is also a violation to “willfully use, or endeavor to use the contents of any wire, oral, or electronics communication, knowing or having reason to know that the information was obtained through the interception of a wire, oral, or electronic communication violation of the subtitle.” The statute provides for the recovery of damages and attorney’s fees in a civil action.

1. The wrongful termination case proceeds to trial and the plaintiff intends to introduce into evidence the recording that his client secretly made of his firing. **What pre-trial motion(s) should be filed? List the arguments in support and in opposition to the motion(s). Explain how the Court should rule as to each motion and why?**
2. Joe is furious over the attempted use of a recording that he believes was illegally made in a civil trial and he has hired you to file a grievance against Attorney Russell. **What rules of professional conduct, if any, did Attorney Russell violate and explain how the local grievance committee should rule and why?**
3. Joe’s attorney does not wish to pursue a grievance against the other attorney. **May he decline his client’s request to report this misconduct? Explain.**
4. After the wrongful termination suit is concluded, Joe files suit against Adam and his attorney, Russell for violating the local wiretap statute. Attorney Russell files a motion for Summary Judgment on his own behalf, **what should Attorney Russell argue and how should the Court rule?** Adam retains Attorney Russell to represent him in this action. **May Attorney Russell take this case? Explain.**

SAMPLE 2:

CIVIL TRIAL

On August 15, 2010, Alex, a 16-year-old living with his parents in Fake County, was planning to attend a Back to School party. The party was being hosted by Becky,

another minor, at the home of her parents in Fictitious County. Before loaning the family car to Alex, his parents shared cocktails with their son in the backyard by the pool around 6:00 p.m.

At 7:30 p.m., Alex pulled out of his driveway and headed to the house party. When he arrived at 7:50 p.m., he phoned his parents to tell them he had arrived safely and would call when he was leaving. There was no parental supervision at the party and Becky had coaxed her older brother, who had lived in Delaware for nearly four years and was only in town visiting, into supplying alcohol for the party. At 11:00 p.m., Alex called his parents to let them know he was leaving the party and would be home shortly. The next call from Alex to his parents came at 11:16 p.m. to tell them he had been involved in a car accident in Faux County.

Alex had been texting Becky to thank her for the invitation to the party and the free drinks when he crossed the centerline and collided head on with Jane. Due to the damage to his car in the collision, Alex was forced to leave his car on the passenger side. As he stumbled out of the car, Alex muttered, "Oh no! I hope I'm not asked to take a Breathalyzer!" Eve, an eyewitness to the accident, had stopped and ran upon the scene just in time to hear Alex's mumbled statement. Eve then proceeded to Jane's car to check on her. Fortunately, no one suffered fatal injuries in the crash, but Jane did suffer a broken neck and damage to her spine.

When police arrived on the scene, Eve pulled an officer to the side and reported what she had overheard Alex said as he left his car. Based on this alone, an officer approached Alex and asked Alex to submit to a Breathalyzer. Alex complied and his BAC (Blood Alcohol Content) was determined to be 0.07, just under the legal limit of 0.08. Alex was arrested and charged for underage drinking and driving, texting while driving, careless operation of a vehicle and crossing the centerline.

Jane contacted an attorney decided to file a civil suit against Alex, his parents for respondeat superior liability, Becky, her parents, and her brother. Pursuant to a local statute which allows filing by fax, Jane's attorney fax filed the petition in Fictitious County on August 15, 2011 at 5:01 p.m. The statute provides "the filing shall be deemed complete at the time that the fax transmission is received and a receipt of transmission has been transmitted to the sender by the clerk of court." Generally, the fax would have been received by the Clerk's office the following morning and date stamped according to the transmission time (Aug. 15, 2011 5:01P.M.). However, on August 15, 2011, the regular clerk was out sick and a temporary worker was hired to fill in. The temporary clerk, not familiar with the normal business operations, turned the fax machine off when she left at the close of business on August 15, 2011 at 4:30 p.m. Therefore, Jane's petition for damages was not received by the clerk's office until August 16, 2011 at 8:30 a.m.

Alex's attorney is preparing to answer Jane's petition for damages. He knows that if he does not raise all the exceptions and affirmative defenses in answer, those exceptions and defenses are waived.

1. What exceptions and/or affirmative defenses should Alex's attorney raise in answering Jane's petition for damages? List arguments in support of and in opposition to the exceptions and defenses.

Jane's attorney wishes to amend the original petition in order to add claims against Alex's parents for negligent lending of the vehicle based on information and belief that Alex's parents knowingly allowed him to drink and drive the family vehicle. In order to do so, however, he requires Alex's deposition. Jane's attorney has noticed Alex to appear for deposition. Jane's attorney wants to question Alex about his parents' knowledge that he was drinking and driving their car. Alex is involved in criminal prosecution for his criminal charges as a result of the accident. His attorney seeks a motion for protective order to delay the taking of his deposition pending the outcome of his criminal trial. Jane's attorney thinks it best to depose him now and knows there is a presumption in favor the questioning party (Jane) when the answering party (Alex) pleads the Fifth or remains silent in a deposition.

2. How should the Jane's attorney oppose the motion for protective order and on what grounds? How should the judge rule?

Jane's attorney also seeks to subpoena Alex's cell phone records to demonstrate he was texting at the time of the accident, the content of the texts indicated he had been drinking prior to driving, and that Becky was responsible for his drinking too. Becky's attorney wishes to suppress this evidence.

3. How may Becky's attorney achieve this goal?

The case proceeds to trial. The court did not grant Alex's motion for protective order to prevent the taking of his deposition while his criminal litigation was simultaneously underway. However, the court permitted Alex to answer questions with "I plead the Fifth" or "I choose to invoke my Fifth Amendment right against self-incrimination" or simply remain silent and decline to answer. Alex was found guilty of underage drinking and driving, texting while driving, careless operation of a vehicle and crossing the centerline in his criminal litigation. Jane's attorney would like to enter Alex's deposition into evidence and his criminal charges. Jane's attorney would also like to call Eve as a witness to testify that she heard Alex make the comment about the Breathalyzer before the police arrived on the scene.

4. How should Alex's attorney oppose both the criminal charges evidence and his deposition and the testimony of Eve on the stand?