

Government agencies, and the private sector.

Several of the proposed Office Rules of Professional Conduct do not conform to the Model Rules of Professional Conduct of the American Bar Association. For example, the Rules of Professional Conduct of the Bar of the District of Columbia would be the source of proposed §§ 1.101(b), 11.102(f), 11.104(c), 11.105(e)(2)–(4), 11.106(a)(2)–(3), 11.106(d)–(g), 11.601, and 11.701(b)(1)–(4) and (c). The Rules of Professional Responsibility of the Virginia State Bar would be the source of proposed §§ 11.115(a), and (c) through (g). The source of the provisions in proposed § 1.806 are the Court Rules of the New York Appellate Division, Second Department. Other proposed rules, addressing relations with invention promoters, would be original. Still other proposed rules would conform to disciplinary rules previously adopted by the USPTO or other Federal agencies, such as § 11.804(h). It is necessary to diverge from the Model Rules of Professional Conduct of the American Bar Association. The Rules of Professional Conduct of the District of Columbia tend to address responsibilities of Government attorneys in greater depth than the Model Rules of Professional Conduct of the American Bar Association, particularly in connection with “revolving door” issues. This is appropriate inasmuch as numerous registered practitioners are employees of the United States Government and are admitted to practice law in the District of Columbia. Upon practicing before the Office, they are subject to the USPTO Rules of Professional Conduct adopted by the Office, as well as the Rules of Professional Conduct of the Bar of the District of Columbia. A detailed concordance between the proposed rules and the divergent sources can be found in Table 3, “Principal Source of Sections 11.100 through 11.806,” *infra*. Further, unlike the Model Rules that require consent of a client following consultation, the proposed rules would require the client give informed consent in writing after full disclosure. Compare, for example, Model Rule 1.6(a) with proposed rule 11.106(a). This departure is intended to provide both the client and practitioner with certainty regarding communication, and a stronger record.

Section 11.100 would provide interpretive guidance of the proposed Rules of Professional Conduct. Some of the Rules are imperatives, cast in the terms “shall” or “shall not.” These define proper conduct for purposes of professional discipline. Other Rules,

generally cast in the term “may,” are permissive and define areas under the Rules in which the practitioner has professional discretion. No disciplinary action should be taken when the practitioner chooses not to act, or acts, within the bounds of such discretion. Inasmuch as the Rules of Professional Conduct in many jurisdictions have the same or similar Rules, it is appropriate for the Office to adopt the same standards where such acts or conduct, in practice before the Office, would not be inconsistent with the protection of the public interest.

Other Rules define the nature of relationships between the practitioner and others. The latter Rules are partly obligatory and disciplinary, and partly constitutive and descriptive in that they define a lawyer’s professional role.

Inasmuch as the rules pertain to practice before the Office, they do not address criminal or domestic relations practices addressed in the Rules of Professional Conduct adopted by the states. A practitioner engaging in criminal or domestic relations practice is subject to the state ethics rules. A practitioner disqualified from practicing elsewhere for misconduct should not be trusted or permitted to practice before the Office. Misconduct elsewhere should also be misconduct for purposes of practicing before the Office. *See* §§ 11.25 and 11.803(f)(1). Practitioners have been disciplined by the Office for conduct arising in the practice of law other than intellectual property. For example, the USPTO Director excluded an attorney after disbarment in Virginia following a criminal conviction for conduct arising from representing a client in a domestic relations matter. *See In re Hodgson*, 1023 Off. Gaz. 13 (Oct. 12, 1982).

Section 11.101 would continue the present practice of 37 CFR 10.77(a) and (b) requiring a practitioner to provide competent representation to a client. Paragraph (a) of § 11.101 would specify that such competence requires the legal knowledge, skill, thoroughness and preparation reasonably necessary for the representation. The Office has disciplined practitioners lacking competence. *See In re Wyden*, 973 Off. Gaz. 40 (Aug. 22 1978) (suspending agent for general incompetence in handling patent applications); and *In re Paley*, 961 Off. Gaz. 48 (Aug. 30, 1977) (suspending agent for improper handling of application).

*Legal knowledge and skill.* In determining whether a practitioner employs the requisite knowledge and skill in a particular matter, relevant factors include the relative complexity and specialized nature of the matter, the

practitioner’s general experience, the practitioner’s training and experience in the field in question, the preparation and study the practitioner is able to give the matter, and whether it is feasible to refer the matter to, or associate or consult with, a practitioner of established competence in the field in question. In some instances, the required proficiency is that of a general patent practitioner. Expertise in a particular field of patent law, science, engineering, or technology may be required in some circumstances. One such circumstance would be where the practitioner, by representations made to the client, has led the client reasonably to expect a special level of expertise in the matter undertaken by the practitioner.

A practitioner need not necessarily have special legal training or prior legal experience to handle legal problems of a type with which the practitioner is unfamiliar. However, basic training in scientific and technical matters is required for registration as a patent attorney or agent to provide a client with valuable service, advice and assistance in the presentation and prosecution of their patent applications before the Office. 35 U.S.C. 2(b)(2)(D). A newly admitted practitioner can be as competent as a practitioner with long experience. Some important legal skills, such as the analysis of precedent, the evaluation of evidence, and legal drafting, are required in all legal problems. Perhaps the most fundamental legal skill consists of determining what kind of legal problems a situation may involve, a skill that necessarily transcends any particular specialized knowledge. A practitioner can provide adequate representation in a wholly novel field through necessary study. Competent representation can also be provided through the association of a practitioner of established competence in the field in question.

In an emergency a practitioner may give advice or assistance in a matter in which the practitioner does not have the skill ordinarily required where referral to or consultation or association with another practitioner would be impractical. Even in an emergency, however, assistance should be limited to that reasonably necessary in the circumstances, for ill-considered action under emergency conditions could jeopardize the client’s interest.

A practitioner may accept representation where the requisite level of competence can be achieved by reasonable preparation. A registered patent agent registered after January 1, 1957, who is not an attorney is not