

authorized to, and cannot accept representation in trademark and other non-patent law. This applies as well to a practitioner who is appointed as counsel for an unrepresented person. *See also* § 11.602.

*Thoroughness and preparation.* Competent handling of a particular patent, trademark, or other non-patent matter includes inquiry into and analysis of the factual and legal elements of the problem, and use of methods and procedures meeting the standards of competent practitioners. It also includes adequate preparation, and continuing attention to the needs of the representation to assure that there is no neglect of such needs. The required attention and preparation are determined in part by what is at stake; like major litigation, complex transactions or inventions ordinarily require more elaborate treatment than matters of lesser consequence.

*Maintaining competence.* To maintain the requisite knowledge and skill, a practitioner should engage in such continuing study and education as may be necessary to maintain competence, taking into account that the learning acquired through a practitioner's practical experience in actual representations may reduce or eliminate the need for special continuing study or education. If a system of peer review has been established, the practitioner should consider making use of it in appropriate circumstances.

*Paragraph (c) of § 11.101* would define some, but not all, acts that would constitute violations of paragraphs (a) or (b) of this section. The USPTO believes that it would be helpful to practitioners if some specific prohibitions were set out in the rules. The prohibitions set out in paragraphs (1) through (8) of § 11.101(c) represent violations that have occurred in the past or that the Office specifically seeks to prevent. The specific acts set out in paragraph (c) would not constitute a complete description of all acts in violation of paragraphs (a) or (b).

*Paragraph (1) of § 11.101(c)* would include as misconduct knowingly withholding from the Office information identifying a patent or patent application of another from which one or more claims have been copied. *See* §§ 1.604(b) and 1.607(c) of this subpart.

*Section 11.102* would address the scope of representation. Both practitioner and client have authority and responsibility in the objectives and means of representation. The client has ultimate authority to determine the purposes to be served by legal representation, within the limits imposed by law and the practitioner's

professional obligations. Within those limits, a client also has a right to consult with the practitioner about the means to be used in pursuing those objectives. At the same time, a practitioner is not required to pursue objectives or employ certain means simply because the client may wish that a practitioner do so. A clear distinction between objectives and means sometimes cannot be drawn, and in many cases the client-practitioner (including client-lawyer or client-agent) relationship partakes of a joint undertaking. In questions of means, the practitioner should assume responsibility for technical and legal tactical issues, but should defer to the client regarding such questions as the expense to be incurred and concern for third persons who might be adversely affected. Law defining a lawyer's scope of authority in litigation varies among jurisdictions.

An agreement concerning the scope of representation must accord with the Rules of Professional Conduct and other law. Thus, the client may not be asked to agree to representation so limited in scope as to violate proposed § 11.101, to surrender the client's right to terminate the practitioner's services, or the client's right to settle litigation that the practitioner might wish to continue.

Unlike Rule 1.2(a) of the Model Rules of Professional Conduct, paragraph (a) of § 11.102 would not address an attorney's duty in a criminal case to abide by the client's decision. Inasmuch as practice before the Office does not involve criminal proceedings, the portion of Model Rule 1.2(a) addressing a criminal case is not being proposed. Nevertheless, an attorney who practices both before the Office and in criminal cases would be subject to both the Office and State professional conduct rules. If, in the course of a criminal proceeding, the attorney violates the state's professional conduct rules and is disciplined by the state authorities, the attorney could be subject to discipline under the proposed rules. *See* §§ 11.24 and 11.803(f)(5).

*Paragraph (e) of § 11.102* would continue a practitioner's responsibility to give an honest opinion about the actual consequences that appear likely to result from a client's conduct. The fact that a client uses advice in a course of action that is criminal or fraudulent does not, of itself, make a practitioner a party to the course of action. However, as in current § 10.85(a)(8), a practitioner may not knowingly assist a client in criminal or fraudulent conduct. There is a critical distinction between presenting an analysis of legal aspects of questionable conduct, and recommending the means by which a

crime or fraud might be committed with impunity.

When the client's course of action has already begun and is continuing, the practitioner's responsibility is especially delicate. The practitioner is not permitted to reveal the client's wrongdoing, except where permitted by proposed § 11.102(g) and proposed § 11.106. Moreover, the practitioner is required to avoid furthering the purpose, for example, by suggesting how it might be concealed. A practitioner may not continue assisting a client in conduct that the practitioner originally supposes is legally proper, but then discovers is criminal or fraudulent. Withdrawal from the representation, therefore, may be required.

Where the client is a fiduciary, the practitioner may be charged with special obligations in dealings with a beneficiary.

*Paragraph (e) of § 11.102* would apply whether or not the defrauded party is a party to the transaction. Hence, a practitioner should not participate in a sham transaction; for example, a transaction to effectuate fraudulent acquisition of a patent or trademark. Paragraph (e) would not preclude undertaking a defense incident to a general retainer for legal services to a lawful enterprise. The last clause of paragraph (e) recognizes that determining the validity or interpretation of a statute or regulation may require a course of action involving disobedience of the statute or regulation or of the interpretation placed upon it by governmental authorities.

In a case in which the client appears to be suffering mental disability, the practitioner's duty to abide by the client's decisions is to be guided by reference to proposed rule 11.114.

*Paragraph (b) of § 11.102* would provide that representing a client does not constitute approval of the client's views or activities. By the same token, legal representation should not be denied to people, including applicants, who are unable to afford legal services, or whose cause is controversial or the subject of popular disapproval. Unlike Rule 1.2(b) of the Model Rules of Professional Conduct, proposed § 11.102(b) would not provide for practitioner's being appointed to represent any party. Inasmuch as the Office does not appoint practitioners to represent persons having business before the Office, the provision is believed to be unwarranted.

*Paragraph (c) of § 11.102*, would provide that the objectives or scope of services provided by the practitioner may be limited by agreement with the