

(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 (3) of § 11.103(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).

Section 11.103 is a rule of general applicability, and it is not meant to enlarge or restrict any specific rule. In particular, § 11.103 is not meant to govern conflicts of interest, which are addressed by proposed §§ 11.107, 11.108, and 11.109.

Section 11.104 would provide in paragraph (a) that a practitioner shall communicate with a client regarding the status of a matter, respond to a client's reasonable requests for information, sufficiently explain matters to permit the client to make informed decisions, and inform the client of settlement offers.

The client should have sufficient information to participate intelligently in decisions concerning the objectives of the representation before the Office, and the means by which they are to be pursued, to the extent the client is willing and able to do so. For example, a practitioner prosecuting an application should provide the client with facts relevant to the matter, promptly inform the client of communications received from and sent to the Office and take other reasonable steps that permit the client to make a decision regarding the course of prosecution. Thus, a registered practitioner failing to timely communicate with one or more clients could be subject to discipline under this section. See *In re Barndt*, 27 USPQ2d 1749 (Comm'r Pat. 1993); *Weiffenbach v. Logan*, 27 USPQ2d 1870 (Comm'r Pat. 1993), *aff'd. sub nom.*, *Logan v. Comer*, No. 93-0335 (D.D.C. 1994), *aff'd. sub nom.*, *Logan v. Lehman*, No. 95-1216 (Fed. Cir. 1995). A practitioner who receives from opposing counsel an offer of settlement in an interference is required to inform the client promptly of its substance. See proposed rule 11.101(a). Even when a client delegates authority to the practitioner, the client should be kept advised of the status of the matter.

A client is entitled to whatever information the client wishes about all aspects of the subject matter of the representation unless the client expressly consents not to have certain information passed on. The practitioner must be particularly careful to ensure

that decisions of the client are made only after the client has been informed of all relevant considerations. The practitioner must initiate and maintain the consultative and decision-making process if the client does not do so, and must ensure that the ongoing process is thorough and complete.

Adequacy of communication depends in part on the kind of advice or assistance involved. The guiding principle is that the practitioner should fulfill reasonable client expectations for information consistent with (1) the duty to act in the client's best interests, and (2) the client's overall requirements and objectives as to the character of representation.

*Maintenance Fees, and Section 8 and Section 15 Affidavits.* Some practitioners maintain a long-term docket and periodically send communications to parties they may view as being former clients, regarding possible need for further action regarding a completed matter, such as payment of maintenance fees for patents. Whether, absent a specific agreement, the practitioners continue to have an attorney-client or agent-client relationship with the parties depends on the facts, such as the reasonable expectations or intent of the putative clients, evidence of objective facts supporting the existence of the expectation or intent, and evidence placing the practitioner on notice of the putative client's expectation or intent. A formal agreement to pay fees is not necessary. A recipient of a periodic notice, absent any other facts, may well have the subjective belief, supported by objective evidence they are receiving legal advice from the practitioner, that the practitioner and recipient continue to be in an attorney-client or agent-client relationship. A practitioner desiring to terminate an attorney-client or agent-client relationship upon completion of legal services should make the termination clear to the client, e.g., by sending a termination letter to the client upon issuance of a patent or registration of a mark, and advising the recipient of the notices, and that the communication is not for the offering of advice, but as a reminder. See Formal Opinion No. 1996-146, Legal Ethics Committee of the Oregon State Bar. The practitioner should also withdraw from representation in accordance with 37 CFR 1.36 and proposed rule 11.116.

*Responsibility to a Former Client.* Even though a practitioner may have terminated any attorney-client or agent-client relationship with a client, the practitioner nevertheless would continue to have certain obligations to a former client. The proposed rules

would continue the practice of placing certain obligations on the practitioner. For example, a practitioner's obligation to preserve in confidence information relating to representation of a client would continue after termination of the practitioner's employment. Section 11.106(g). Under § 11.804(i)(8), practitioners would have a duty to inform a former client or timely notify the Office of an inability to notify a former client of certain correspondence received from the Office. The obligation is necessarily imposed for the proper conduct of proceedings before the Office, such as receipt of notices regarding maintenance fees, reexamination proceedings, and institution of inter partes patent and trademark proceedings.

Practitioners not wishing to receive notices regarding maintenance fees may file a change of correspondence address under 37 CFR 1.33 without filing a request to withdraw, or provide a fee address pursuant to 37 CFR 1.363 to which maintenance fee correspondence should be sent. Since § 1.33(c) requires that all notices, official letters, and other communications for the patent owner(s) in reexamination proceedings will be directed to the attorney or agent of record in a patent file, a request for permission to withdraw under §§ 1.36 and 11.116 would have to be filed if a practitioner does not wish to receive correspondence regarding reexaminations.

*Invention promoters.* A Commissioner published two notices in the Official Gazette, 1086 OG 457 (December 10, 1987), and 1091 OG 26 regarding the "Responsibilities of Practitioners Representing Clients in Proceedings Before The Patent and Trademark Office" (Notices). The Notices address agency relationships between practitioners and intermediaries. For example, the Notices, *inter alia*, address the use of corporate liaisons to obtain instructions. The notices do not specifically refer to invention promoters. Nevertheless, some practitioners associated with invention promoters have relied upon the Notices to accept the invention promoter as the inventor's agent, take instructions from the agent, and conduct all communications through the agent. There are numerous ethics opinions and cases where attorneys have been warned or found to have aided the unauthorized practice of law by permitting a marketer to communicate directly with the client. For example, Formal Opinion 87, Ethics Committee of the Colorado Bar Association (1995), advises that an attorney aids the unauthorized practice of law where a non-lawyer markets a