

§ 1.56 by submitting all information known to be material to the patentability of any existing claim. The USPTO has disciplined practitioners for failing to reveal evidence required by law to be disclosed. *See In re Milmore*, 196 USPQ 628 (Comm'r Pat. 1977) (suspending practitioner for not calling a reference to the examiner's attention). To address situations wherein practitioners are found by a court of record to have engaged in inequitable conduct, the proposed rules would provide that such a finding is cause for concluding that the practitioner violated the Rules of Professional Conduct. *See* § 11.804(h)(7).

The obligation to protect confidences and secrets obviously does not preclude a practitioner from revealing information when the client consents after full disclosure, when necessary to perform the professional employment, when permitted or required by these proposed rules (e.g., to comply with § 1.56), or when required by law. Unless the client otherwise directs, a practitioner may disclose the affairs of the client to partners or associates of the practitioner's firm.

It is a matter of common knowledge that the normal operation of a law office exposes confidential professional information to non-practitioner employees of the office, particularly secretaries and those having access to the files; and this obligates a practitioner to exercise care in selecting and training employees so that the sanctity of all confidences and secrets of clients may be preserved. If the obligation extends to two or more clients as to the same information, a practitioner should obtain the permission of all before revealing the information. A practitioner must always be sensitive to the rights and wishes of the client and act scrupulously in the making of decisions that may involve the disclosure of information obtained in the course of the professional relationship. Thus, in the absence of consent of the client after full disclosure, a practitioner should not associate another practitioner in the handling of a matter; nor should the practitioner, in the absence of consent, seek counsel from another practitioner if there is a reasonable possibility that the identity of the client or the client's confidences or secrets would be revealed to such practitioner. Proper concern for professional duty should cause a practitioner to shun indiscreet conversations concerning clients.

*Invention promoter—Full Disclosure—Informed Consent.* Likewise, a practitioner should not communicate a confidence from the

inventor-client to an invention promoter without first obtaining the inventor-client's consent to disclose the confidences after full disclosure. Full disclosure is defined in § 11.1(n). Confidence can include patentability opinions, patent applications, Office actions, amendments, appeal briefs, and notices of allowance or abandonment. Information communicated between the practitioner and inventor-client through an invention promoter may not be privileged. *Denver Tramway Co. v. Owens*, 36 P. 848 (Colo. 1894) (information gathered from client in presence of third party is not privileged). Consent of an inventor-client would necessitate full disclosure that the client would be waiving any attorney-client or agent-client privilege attached to the confidence by permitting the confidence to be communicated to the promoter, as well as waiving confidential status for the information.

*Paragraph (c)(3)(B) and paragraph (d) of § 11.106* would address the unique circumstances raised by attorney-client relationships within the Government.

Paragraph (c)(3)(B) of proposed § 11.106 would apply only to practitioners employed by the Government who are representing Government interests when appearing before the USPTO. It is designed to permit disclosures that are not required by law or court order under proposed § 11.106(c)(3)(A), but which the Government authorizes its attorneys to make in connection with their professional services on behalf of the Government. Such disclosures may be authorized or required by statute, executive order, or regulation, depending on the constitutional or statutory powers of the authorizing entity. If so authorized or required, paragraph (c)(3)(B) of proposed § 11.106 governs.

The term "agency" in paragraph (d) includes, *inter alia*, executive and independent departments and agencies, special commissions, committees of the legislature, agencies of the legislative branch such as the Office, General Accounting Office, and the courts to the extent that they employ practitioners (e.g., staff counsel) to counsel them. The employing agency has been designated the client under this rule to provide a commonly understood and easily determinable point for identifying the Government client.

Government practitioners may also be assigned to provide an individual with counsel or representation in circumstances that make clear that an obligation of confidentiality runs directly to that individual and that paragraph (d)(2)(A), not (d)(2)(B), of

proposed § 11.106 applies. It is, of course, acceptable in this circumstance for a Government practitioner to make disclosures about the individual representation to supervisors or others within the employing governmental agency so long as such disclosures are made in the context of, and consistent with, the agency's representation program. *See, e.g.*, 28 CFR 50.15 and 50.16. The relevant circumstances, including the agreement to represent the individual, may also indicate the extent to which the individual client to whom the Government practitioner is assigned will be deemed to have granted or denied consent to disclosures to the practitioner's employing agency. Examples of such representation include representation by a public defender, a Government practitioner representing a defendant sued for damages arising out of the performance of the defendant's Government employment, and a military practitioner representing a court-martial defendant.

*Paragraph (g) of § 11.106—Former client.* The duty of confidentiality would continue after the client-lawyer or client-agent relationship has terminated.

*Paragraph (h) of § 11.106.* There are circumstances in which a person who ultimately becomes a practitioner provides assistance to a practitioner while serving in a nonpractitioner capacity. The typical situation is that of the law clerk or summer associate in a law firm or Government agency. Paragraph (h) of proposed § 11.106 would address the confidentiality obligations of such a person after becoming a member of a Bar or becoming registered; the same confidentiality obligations are imposed as would apply if the person had been a member of a Bar at the time confidences or secrets were received. For a related provision dealing with the imputation of disqualifications arising from prior participation as a law clerk, summer associate, or in a similar position, *see* proposed § 11.110(b).

*Section 11.107* is intended to provide clear notice of circumstances that may constitute a conflict of interest. Loyalty to a client is an essential element in the practitioner's relationship to a client. An impermissible conflict of interest may exist before representation is undertaken, in which event the representation should be declined. The practitioner should adopt reasonable procedures, appropriate for the size and type of firm and practice, to determine in both litigation and non-litigation matters, including patent and trademark matters before the Office, the parties and issues involved and to determine