

whether a practitioner should undertake representation is more complicated. There are several competing considerations. The client previously represented by the former firm must be reasonably assured that the principle of loyalty to the client is not compromised. The rule should not be so broadly cast as to preclude other persons from having reasonable choice of legal counsel. The rule also should not unreasonably hamper practitioners from forming new associations and taking on new clients after having left a previous association. In this connection, it should be recognized that today many practitioners practice in firms, that many practitioners to some degree limit their practice to one field or another, and that many move from one association to another several times in their careers. If the concept of imputation were applied with unqualified rigor, the result would be radical curtailment of the opportunity of practitioners to move from one practice setting to another and of the opportunity of clients to change counsel.

Reconciliation of these competing principles in the past has been attempted under two rubrics. One approach has been to seek *per se* rules of disqualification. For example, it has been held that a partner in a law firm is conclusively presumed to have access to all confidences concerning all clients of the firm. Under this analysis, if a practitioner has been a partner in one law firm and then becomes a partner in another law firm, there may be a presumption that all confidences known by the partner in the first firm are known to all partners in the second firm. This presumption might properly be applied in some circumstances, especially where the client has been extensively represented, but may be unrealistic where the client was represented only for limited purposes. Furthermore, such a rigid rule exaggerates the difference between a partner and an associate in modern law firms.

The other rubric formerly used for dealing with disqualification is the appearance of impropriety proscribed in Canon 9 of the ABA Model Code of Professional Responsibility. This rubric has a two-fold problem. First, the appearance of impropriety can be taken to include any new client-lawyer or agent-client relationship that might make a former client feel anxious. If that meaning were adopted, disqualification would become little more than a question of subjective judgment by the former client. Second, since "impropriety" is undefined, the term "appearance of impropriety" is

question-begging. It therefore has to be recognized that the problem of disqualification cannot be properly resolved either by simple analogy to a practitioner practicing alone or by the very general concept of appearance of impropriety.

The standard that would be followed by the Office is addressed in the following paragraphs styled Confidentiality and Adverse positions.

Confidentiality. Preserving confidentiality is a question of access to information. Access to information, in turn, is essentially a question of fact in particular circumstances, aided by inferences, deductions or working presumptions that reasonably may be made about the way in which practitioners work together. A practitioner may have general access to files of all clients of a law firm and may regularly participate in discussions of their affairs; it should be inferred that such a practitioner in fact is privy to all information about all the firm's clients. In contrast, another practitioner may have access to the files of only a limited number of clients and participate in discussions of the affairs of no other clients; in the absence of information to the contrary, it should be inferred that such a practitioner in fact is privy to information about the clients actually served but not confidences of other clients.

Paragraph (b) of § 11.109. Application of paragraph (b) of § 11.109 would depend on a situation's particular facts. In such an inquiry the burden of proof should rest upon the firm whose disqualification is sought.

Paragraph (b) of § 11.109 would operate to disqualify the practitioner only when the practitioner involved has actual knowledge of information protected by §§ 11.106 and 11.109(b). Thus, if a practitioner while with one firm acquired no confidential knowledge or information relating to a particular client of the firm, and that practitioner later joined another firm, neither the practitioner individually nor the second firm is disqualified from representing another client in the same or a related matter even though the interests of the two clients conflict. See § 11.110(b) for the restrictions on a firm once a practitioner has terminated association with the firm.

Independent of the question of disqualification of a firm, a practitioner changing professional association has a continuing duty to preserve confidentiality of information about a client formerly represented. See §§ 11.106 and 11.109.

Adverse positions. The second aspect of loyalty to a client is the practitioner's

obligation to decline subsequent representations involving positions adverse to a former client arising in substantially related matters. This obligation requires abstention from adverse representation by the individual practitioner involved, but does not properly entail abstention of other practitioners through imputed disqualification. Hence, this aspect of the problem is governed by § 11.109(a). Thus, if a practitioner left one firm for another, the new affiliation would not preclude the firms involved from continuing to represent clients with adverse interests in the same or related matters, so long as the conditions of paragraphs (b) and (c) concerning confidentiality have been met.

Confidential information acquired by the practitioner in the course of representing a client may not subsequently be used or revealed by the practitioner to the disadvantage of the client. However, the fact that a practitioner has once served a client does not preclude the practitioner from using generally known information about that client when later representing another client.

Disqualification from subsequent representation is for the protection of former clients and can be waived by them. A waiver is effective only if there is full disclosure of the circumstances, including the practitioner's intended role in behalf of the new client.

With regard to an opposing party's raising a question of conflict of interest, see comment to § 11.107. With regard to disqualification of a firm with which a practitioner is or was formerly associated, see § 11.110.

Section 11.110 would provide a general rule for disqualification. For purposes of the USPTO Rules of Professional Conduct, the term "firm" includes practitioners in a private firm, and practitioners employed in the legal department of a corporation or other organization, or in a legal services organization, but does not include a Government agency or other Government entity. Whether two or more practitioners constitute a firm within this definition can depend on the specific facts. For example, two practitioners who share office space and occasionally consult or assist each other ordinarily would not be regarded as constituting a firm. However, if they present themselves to the public in a way suggesting that they are a firm or conduct themselves as a firm, they should be regarded as a firm for purposes of the Rules. The terms of any formal agreement between associated practitioners are relevant in determining whether they are a firm, as is the fact