

Office. *See Kingsland v. Dorsey*, 338 U.S. 318 (1949) (sustaining attorney's exclusion where attorney authored the article that attorney introduced into evidence as an article written by another).

*Paragraph (a) of § 11.303*, like current § 10.89(b)(1), would require that a practitioner reveal to the Office known authority directly adverse to the position of the client unless the authority is cited by an opponent or employee of the Office. All decisions made by the Office in patent and trademark matters affect the public interest. *See Lear v. Adkins*, 395 U.S. 653 (1969). Many of the decisions made by the Office are made ex parte. Accordingly, practitioners must cite to the Office known authority that is contrary, i.e., directly adverse, to the position being taken by the practitioner in good faith. The practitioner could argue that the cited authority should not be followed, or should be overruled or modified.

*Section 11.303 and Representations by a Practitioner.* An advocate is responsible for pleadings and other documents prepared for litigation or prosecution of patent and trademark applications. However, an advocate is usually not required to have personal knowledge of factual matters that are based on information furnished by a client asserted therein, because litigation or prosecution documents ordinarily present assertions by the client, or by someone on the client's behalf, and not assertions by the practitioner. Compare § 11.301. However, an assertion purporting to be based on the practitioner's own knowledge, such as an assertion made by the practitioner in an affidavit, petition, or reply to an Office action, like a statement in open court, may properly be made only when the practitioner knows the assertion is true or believes it to be true on the basis of a reasonably diligent inquiry. The Office has disciplined practitioners for making false statements of fact in an affidavit or declaration. *See In re Dubno*, 1959 Off. Gaz. 25 (June 21, 1977). There may be circumstances where failure to make a disclosure is the equivalent of an affirmative misrepresentation. *See Lipman v. Dickinson*, 174 F.3d 1363, 50 USPQ2d 1490 (Fed. Cir. 1999). The obligation prescribed in § 11.102(e) not to counsel a client to commit or assist the client in committing a fraud applies in litigation and proceedings before the Office, but would be subject to §§ 11.303(a)(4), (b) and (d). Regarding compliance with § 11.102(e), see the comment to that proposed section. *See*

also the comment to proposed § 11.804(b).

*Section 11.303 and Misleading Legal Argument.* Legal argument based on a knowingly false representation of law constitutes dishonesty toward the tribunal. A practitioner is not required to make a disinterested exposition of the law, but must recognize the existence of pertinent legal authorities. Furthermore, as stated in § 11.303(a)(3), an advocate has a duty to disclose directly adverse authority in the controlling jurisdiction that has not been disclosed by the opposing party and that is dispositive of a question at issue. The underlying concept is that a legal argument is a discussion seeking to determine the legal premises properly applicable to the case.

*Section 11.303 and False Evidence.* When evidence that a practitioner knows to be false is provided by a person who is not the client, the practitioner must refuse to offer it regardless of the client's wishes.

When false evidence is offered by the client, however, a conflict may arise between the practitioner's duty to keep the client's disclosure confidential and the duty of candor to the tribunal. Upon ascertaining that material evidence is false, the practitioner should seek to persuade the client that the evidence should not be offered. If the material evidence has already been offered before the practitioner learns that it is false, its false character should immediately be disclosed to the tribunal. If the persuasion is ineffective, the practitioner must take reasonable remedial measures. In patent matters pending before the Office, if a practitioner comes to realize that evidence material to patentability offered before the Office in a patent case is false, the practitioner has a duty to disclose information regarding the falsity with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. This is consistent with current § 1.56.

Except in the defense of a criminally accused, the rule generally recognized is that, if necessary to rectify the situation, an advocate must disclose the existence of the client's deception to the tribunal, Office, and/or to the other party. Such a disclosure can result in grave consequences to the client, including not only a sense of betrayal but also loss of the case and perhaps a prosecution for perjury. But the alternative is that the practitioner, contrary to current § 1.56 or proposed §§ 11.303 and 11.804(c), cooperate in deceiving the tribunal or Office, thereby subverting the truth-finding process, which the

adversary system is designed to implement. *See* § 11.102(d).

Furthermore, unless it is clearly understood that the practitioner will act upon the duty to disclose the existence of false evidence, the client can simply reject the practitioner's advice to reveal the false evidence and insist that the practitioner keep silent. Thus the client could in effect coerce the practitioner into being a party to fraud on the tribunal or Office.

*Paragraph (d) of § 11.303* would provide that if a practitioner learns that a fraud or inequitable conduct has been perpetrated on the Office, the practitioner must reveal the same to the Office. Where notification would require disclosure to the Office of information not protected under §§ 1.56, or 11.106(a), the practitioner has a duty of disclosure to prevent the occurrence or furtherance of the fraud or inequitable conduct by commission or omission.

*Paragraph (b) of § 11.303—Duration of obligation.* A practical time limit on the obligation to rectify the presentation of false evidence has to be established. In the Model Code of Professional Responsibility, the American Bar Association has suggested that the conclusion of the proceeding, through all appeals, is a reasonably definite point for the termination of the obligation.

Patent matters are not necessarily concluded in a single proceeding before the Office with the issuance of a patent. The patent may be subject to examination again in a reissue application, as well as reexamination and interference proceedings. The procedures are available throughout the period for which the patent is granted. Accordingly, in patent matters before the Office, the duty of disclosure continues for the duration of the pendency of the patent application and the period for which the patent is granted.

*Paragraph (c) of § 11.303—Refusing to offer proof believed to be false.* Generally speaking, a practitioner has all authority to refuse to offer testimony or other proof that the practitioner believes is untrustworthy. Offering such proof may reflect adversely on the practitioner's ability to discriminate in the quality of evidence and thus impair the practitioner's effectiveness as an advocate.

*Paragraph (d) of § 11.303—Ex parte proceedings.* Ordinarily, an advocate has the limited responsibility of presenting one side of the matters that a tribunal should consider in reaching a decision; the conflicting position is