

expected to be presented by the opposing party.

However, in any *ex parte* proceeding, such as prosecution of a patent application, or an application for a temporary restraining order, there is no balance of presentation by opposing advocates. The object of an *ex parte* proceeding is nevertheless to yield a substantially just result. The patent examiner or judge has an affirmative responsibility to accord the absent party just consideration. The practitioner for the represented party has the correlative duty to make disclosures of material facts known to the practitioner and that the practitioner reasonably believes are necessary to an informed decision. In an *ex parte* proceeding before the Office in a patent case, a practitioner's duty of disclosure would remain the same as in § 1.56. The practitioner would be required to inform the Office of all information material to patentability known to the practitioner in accordance with § 1.56, whether or not the facts are adverse.

Paragraph (e) of § 11.303 would define some, but not all, acts that would constitute violations of paragraphs (a) through (d) 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 (5) of § 11.303(e) represent violations that have occurred in the past or that the Office specifically seeks to prevent. The specific acts set out in paragraph (e) would not constitute a complete description of all acts in violation of paragraphs (a) through (d).

Paragraph (1) of § 11.303(e) would put practitioners on notice that misconduct includes knowingly misusing a "Certificate of Mailing or Transmission" under § 1.8 of this subchapter. See *In re Dula*, 1030 Off. Gaz. 20 (May 17 1983); *In re Klein*, 6 USPQ2d 1547 (Comm'r Pat. 1987), *aff'd sub nom.*, *Klein v. Peterson*, 696 F. Supp. 695, 8 USPQ2d 1434 (D.D.C. 1988), *aff'd*, 866 F.2d 412, 9 USPQ 2d 1558 (Fed. Cir. 1989); *Small v. Weiffenbach*, 10 USPQ 2d 1898 (Comm'r Pat. 1989).

Paragraph (2) of § 11.303(e) would include as misconduct knowingly violating or causing to be violated the duty of candor requirements of §§ 1.56 or 1.555. See *In re Milmore*, 196 USPQ 628 (Comm'r Pat. 1977); *Kingsland v. Dorsey*, 338 U.S. 318 (1949); *Hatch v. Ooms*, 72 USPQ 406 (D.D.C. 1947).

Paragraph (4) of § 11.303(e) would include as misconduct knowingly signing a paper filed in the Office in violation of the provisions of § 11.18 or making a scandalous or indecent

statement in a paper filed in the Office. The provision is based on Rule 11 of the Federal Rules of Civil Procedure. See *Weiffenbach v. Gilden*, 1160 Off. Gaz. 39 (Mar. 8, 1994).

Section 11.304 would contemplate that the evidence in a case be marshaled fairly in *ex parte* and *inter partes* proceedings. Prohibitions against destruction or concealment of evidence, improperly influencing witnesses, obstructive tactics in discovery procedure, and the like secure fair competition in adversary and *ex parte* systems.

Paragraph (a) of § 11.304, like current § 10.85(a)(7), would prohibit a practitioner from obstructing another party's access to evidence, and from altering, destroying, or concealing evidence. Documents and other items of evidence are often essential to establish a claim or defense. Subject to evidentiary privileges, the right of an opposing party, including the Government, to obtain evidence through discovery or subpoena is an important procedural right. The exercise of that right can be frustrated if relevant material is altered, concealed, or destroyed. To the extent clients are involved in the effort to comply with discovery requests, the practitioner's obligations are to pursue reasonable efforts to assure that documents and other information subject to proper discovery requests are produced. Applicable law in many jurisdictions makes it an offense to destroy material for the purpose of impairing its availability in a pending proceeding or a proceeding whose commencement can be foreseen. Falsifying evidence is also generally a criminal offense. Section 11.304(a) applies to evidentiary material generally, including computerized information.

A practitioner should ascertain that the practitioner's handling of documents or other physical objects does not violate any other law. Federal criminal law may forbid the destruction of documents or other physical objects in circumstances not covered by the ethical rule set forth in § 11.304(a). See, e.g., 18 U.S.C. 1503 (obstruction of justice); 18 U.S.C. 1505 (obstruction of proceedings before departments, agencies, and committees); 18 U.S.C. 1510 (obstruction of criminal investigations). Finally, some discovery rules having the force of law may prohibit the destruction of documents and other material even if litigation is not pending or imminent. Section 11.304 would not set forth the scope of a practitioner's responsibilities under all applicable laws. It would merely impose on the practitioner an ethical duty to

make reasonable efforts to comply fully with those laws. The prohibitions of § 11.304(a) may overlap with criminal obstruction provisions and civil discovery rules, but they apply whether or not the prohibited conduct violates criminal provisions or court rules. Thus, the alteration of evidence by a practitioner, whether or not such conduct violates criminal law or court rules, constitutes a violation of § 11.304(a). See *Weiffenbach v. Logan*, 27 USPQ 2d 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).

Because of the duty of confidentiality under § 11.106, the practitioner would be generally forbidden to volunteer information about physical evidence received from a client without the client's consent after consultation. An exception would arise in the case of volunteering information required under § 1.56 to be disclosed.

If the evidence, not required to be disclosed under § 1.56, is received from the client and is subpoenaed or otherwise requested through the discovery process while held by the practitioner, the practitioner will be obligated to deliver the evidence directly to the appropriate persons, unless there is a basis for objecting to the discovery request or moving to quash the subpoena. A practitioner should, therefore, advise the client of the risk that evidence may be subject to subpoena or discovery, and of the practitioner's duty to turn the evidence over in that event, before accepting it from the client.

If the practitioner has received physical evidence belonging to the client and the evidence is not required to be disclosed under § 1.56, for purposes of examination or testing, the practitioner may later return the property to the client pursuant to § 11.115, provided that the evidence has not been requested by discovery or subpoenaed. The practitioner may not be justified in returning to a client physical evidence, the possession of which by the client would be *per se* illegal, such as certain drugs and weapons. And, if it is reasonably apparent that the evidence is not the client's property, the practitioner may not retain the evidence or return it to the client. Instead, the practitioner would, under § 11.304(a), have to make a good-faith effort to return the evidence to its owner.

Paragraph (b) of § 11.304 would provide that it is not improper to pay a witness's expenses or to compensate a witness for time taken in preparing to