

person the practitioner knows or reasonably should know would be affected substantially by the representation or lack of representation of the inventor-client.

**§ 11.109 Conflict of interest: Former client.**

(a) A practitioner who, in practice before the Office, has formerly represented a client shall not thereafter represent another person in the same or a substantially related matter in which that person's interests are materially adverse to the interests of the former client unless the former client gives informed consent, confirmed in writing, after consultation.

(b) A practitioner, in regard to practice before the Office, shall not knowingly represent a person in the same or substantially related matter in which a firm or a member of the firm, with which the practitioner formerly was associated, had previously represented a client,

(1) Whose interests are materially adverse to that person; and

(2) About whom the practitioner has acquired information protected by §§ 11.106 and 11.109(c) that is material to the matter; unless the former client gives informed consent, confirmed in writing, after full disclosure by the practitioner;

(c) A practitioner who has formerly represented a client in a matter before the Office, or whose present or former firm, or a practitioner in the firm, has formerly represented a client in a matter before the Office shall not thereafter:

(1) Use information relating to the representation to the disadvantage of the former client except as §§ 11.106 or 11.303 would permit or require with respect to a client, or when the information has become generally known; or

(2) Reveal information relating to the representation except as §§ 11.106 or 11.303 would permit or require with respect to a client.

**§ 11.110 Imputed disqualification: General rule.**

(a) While practitioners are associated in a firm, or are associated on a continuing basis with an invention promoter, none of them shall knowingly represent a client having immediate or prospective business before the Office when any one of them practicing alone would be prohibited from doing so by §§ 11.107, 11.108(b), 11.109, or 11.202.

(b) In regard to practice before the Office, when a practitioner has terminated an association with a firm, the firm is not prohibited from thereafter representing a person with interests materially adverse to those of

a client represented by the formerly associated practitioner, and not currently represented by the firm, unless:

(1) The matter is the same or substantially related to that in which the formerly associated practitioner represented the client; and

(2) Any practitioner remaining in the firm has information protected by §§ 11.106 and 11.109(c) that is material to the matter.

(c) A disqualification prescribed by this section may be waived by the affected client under the conditions stated in § 11.107.

**§ 11.111 Successive Government and private employment.**

(a) A practitioner shall not accept private employment in connection with a matter that is the same as, or substantially related to, a matter in which the practitioner participated personally and substantially as an employee of the Office. Such participation includes, but is not limited to, acting on the merits of a matter in an administrative or adjudicative capacity.

(b) If a practitioner is required to decline or to withdraw from employment under paragraph (a) of this section on account of personal and substantial participation in a matter, no partner or associate of that practitioner, or practitioner with an of counsel relationship to that practitioner, may accept or continue such employment except as provided in paragraph (c) of this section. The disqualification of such other practitioners does not apply if the sole form of participation was as a judicial or administrative law clerk, including a law clerk at the Board of Patent Appeals and Interferences, or at the Trademark Trial and Appeal Board.

(c) The prohibition stated in paragraph (b) of this section shall not apply if the personally disqualified practitioner is screened from any form of participation in the matter or representation as the case may be, and from sharing in any fees resulting therefrom, and if the requirements of paragraphs (d) and (e) of this section are satisfied.

(d) Except as law may otherwise expressly permit, a practitioner having information that the practitioner knows is confidential Government information about a person that was acquired when the practitioner was an employee of the Office, may not represent a private client whose interests are adverse to that person in a matter in which the information could be used to the material disadvantage of that person. A firm with which that practitioner is associated may undertake or continue

representation in the matter only if the disqualified practitioner is screened from any participation in the matter and is apportioned no part of the fee therefrom.

(e) Except as law may otherwise expressly permit, a practitioner serving as an employee of the Office shall not:

(1) Participate in a matter in which the practitioner participated personally and substantially while in private practice or nongovernmental employment, unless under applicable law no one is, or by lawful delegation may be, authorized to act in the practitioner's stead in the matter; or

(2) Negotiate for private employment with any person who is involved as a party or as practitioner for a party in a matter in which the practitioner is participating personally or substantially, except:

(i) A practitioner serving as a law clerk to a judge, administrative law judge, administrative patent judge, or administrative trademark judge may negotiate for private employment as permitted by § 11.112(b) and subject to the conditions stated in § 11.112(b); and

(ii) A practitioner serving in the Office may negotiate for employment with a party or practitioner involved in a matter in which the practitioner is participating personally and substantially, but only after the practitioner has notified his or her supervisor, and the matter is withdrawn from the practitioner's scope of authority.

(f) A practitioner serving in the Office shall not in any manner assist his or her former client, or another practitioner in the presentation or prosecution of said former client's patent application before the Office, including, but not limited to, providing assistance regarding the presentation or amendment of the specification, claims, or drawings, a translation of any foreign document, or provision of funds.

(g) As used in this section, the terms *matter*, *participated*, *personally*, and *substantially* are described in § 11.10(b)(3).

(h) As used in this section, the term *confidential Government information* means information that has been obtained under governmental authority and which, at the time this section is applied, the Government is prohibited by law from disclosing to the public or has a legal privilege not to disclose, and which is not otherwise available to the public.

(i) Conduct that constitutes a violation of paragraph (a) of this section includes, but is not limited to:

(1) A practitioner preparing or prosecuting or providing assistance in