Dear Office of Enrollment and Discipline,

Thank you for your efforts in updating the rules of professional conduct before the U.S. Patent and Trademark Office. It will be of immense benefit for patent practitioners who are also attorneys, and as such must also know and abide by the ethics rules of the state in which they practice.

One concern, however, is with proposed rule § 11.106 relating to the "Confidentiality of Information." Under the current patent office rules, confidential information is defined either as information protected by the attorney-client or agent privilege ("confidence") or information gained in the professional relationship that the client has requested not to be revealed ("secret"). The proposed rules take the more expansive view of confidential information introduced by the ABA Model Rules, by which any information relating to the representation of a client is considered to be confidential. With such a broad definition, commentators have suggested that even publically available information can be considered "confidential information" according to the ABA rules. If the patent office did not intend such a sweeping definition of "confidential information," it should provide its own guidance regarding the boundaries of what should be considered confidential information.

Of particular concern with this provision, however, is where the patent office deviates from the ABA Model Rules with regard to the confidentiality of information. The ABA Model Rules provide for what a practitioner "shall not" reveal without informed consent, implied authorization, or permission under the rules. Moreover, the Model Rules also provides for what information a practitioner "may" reveal, including such things as information that may prevent death, bodily harm, or fraud. Of note, however, is that even in these cases where death, bodily harm, or fraud may result, the practitioner is not *required* to reveal any information. The proposed Patent Offices Rules diverge from the ABA Model Rules in one important respect: the proposed rules include a type of information that is mandatory to reveal: "A practitioner shall disclose to the Office information necessary to comply with applicable duty of disclosure provisions." (Proposed Rule § 11.106(c)). In other words, under this proposed rule, a finding that relevant information was intentionally withheld by a practitioner involved in the prosecution of an application will not only cause a patent to become unenforceable, it will result in an ethical violation by the practitioner. The purpose behind this provision is clear. The potential problem, however, is that the proposed rule raises the possibility that a patent practitioner could be trapped between two ethical obligations. Importantly, this obligation to disclose information necessary to comply with the duty of disclosure is not limited to the confidential information from that particular prosecution client. Instead, it is possible under this rule that a patent attorney could be aware of confidential information belonging to another client that is nevertheless relevant to the prosecution of an application, and he would therefore be ethically required to submit it with the prosecution client's application. In some cases, such an ethical quandary may already exist, especially for practitioners that are also attorneys practicing in a state that has adopted some form of the ABA Model Rule. Nevertheless, it is essential that any such patent office rule include a provision by which the practitioner can withdraw (even if noisily), thereby allowing the practitioner to avoid potential disciplinary proceedings, and at the same time preserving the enforceability of their client's (or former client's) resulting patent.

Thank you for your consideration of this comment.

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On behalf of Patent Docs
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