

COMMONWEALTH OF MASSACHUSETTS

# Supreme Judicial Court

SJC-11800

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CHRIS E. MALING,  
PLAINTIFF-APPELLANT,

v.

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, LLP,  
DEFENDANT-APPELLEES.

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On Appeal from a Judgment of the Superior Court for Suffolk County

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**BRIEF OF BOSTON PATENT LAW ASSOCIATION AS  
*AMICUS CURIAE* IN SUPPORT OF APPELLEES**

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**STATEMENT OF INTEREST OF AMICUS CURIAE**

Founded in 1924, the Boston Patent Law Association ("BPLA") is a nonprofit association of over 900 intellectual property attorneys and professionals that offers programs and forums for the exchange of ideas and information about patents and other intellectual property rights.<sup>1</sup> Its members serve a broad range of clients, such as inventors, corporations, universities, and research hospitals. One of the many legal services that BPLA members provide to their clients is the filing and prosecution of patents. In fact, BPLA members file and prosecute thousands of patents every year on behalf of hundreds of clients here in the Commonwealth.

The BPLA has an interest in ensuring that the conflict of interest rules as applied to patent prosecution are clear and appropriately-tailored. In particular, the BPLA is concerned that a broad

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<sup>1</sup> Although attorneys and patent professionals from Finnegan, Henderson, Farabow, Garrett & Dunner LLP are members of the BPLA, no party or its counsel authored or were involved in any part of this brief. All legal work to prepare and submit this brief was contributed *pro bono* by Heather B. Repicky, a co-chair of the amicus committee of the BPLA, and Nutter McClennen & Fish LLP. This brief represents the consensus view of the BPLA and the stated arguments and positions do not necessarily reflect the views of any individual BPLA member, associated firm, or client of a member.

pronouncement regarding the conflict of interest rules under Mass. R. Prof. Conduct 1.7 and the imposition of a disclosure and consent requirement in all cases will hinder the ability of BPLA members to continue to provide exceptional legal services to the community of businesses and individuals who rely on intellectual property as an integral part of their businesses and operations.

#### **ISSUE PRESENTED**

Whether, under Mass. R. Prof. Conduct 1.7, an actionable conflict of interest arose when, according to the allegations in the complaint, attorneys in different offices of the same law firm simultaneously represented the plaintiffs and a competitor in prosecuting patents on similar inventions, without informing the plaintiffs or obtaining their consent to the simultaneous representation.

#### **SUMMARY OF THE ARGUMENT**

The existing Massachusetts Rules of Professional Conduct, and specifically Rule 1.7, adequately protect the interests of competing inventors and patent applicants. The imposition of a new and different conflict-of-interest rule that uses the proposed and amorphous "similar inventions" standard will prove to

be nearly impossible to implement and, in any event, would unnecessarily disqualify patent attorneys when there is no real conflict. In addition, such a rule will inevitably create problems that could prove a barrier to obtaining patent protection, and thus innovation, here in the Commonwealth. Indeed, a rule that is too broad will make it more difficult for inventors and applicants to hire qualified patent attorneys.

#### **PATENT APPLICATION AND PROSECUTION BACKGROUND**

To fully appreciate the issues presented in this appeal, it is essential first to review the practical steps that are taken to prepare a patent application. It is also important to understand the process for securing patents, commonly referred to as "patent prosecution."

#### **I. THE ANATOMY OF A PATENT APPLICATION**

The first step in obtaining a patent is filing an application with the United States Patent and Trademark Office ("USPTO"). Although there is no form for a patent application, it must include at least two components—the specification and the claims. See *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1437 (Fed. Cir. 1984) (citations omitted). The

specification, which includes drawings, the background of the invention, a summary of the invention, a brief description of the drawings, and a detailed description, provides the most thorough and complete explanation of the invention. See 35 U.S.C. § 111; see also Manual of Patent Examining Procedure ("MPEP") § 601(I) (9th ed. 2014). The specification is intended to teach the public, and particularly persons skilled in the art related to the invention, how to make and use the invention. 37 C.F.R. § 1.71.

While the specification forms a narrative that explains the invention, the "claims" define the invention itself. It is these claims that define the metes and bounds of the scope of the patent and that give the patentee the right to exclude others. See, e.g., *Johnson & Johnston Assoc. Inc. v. R.E. Serv. Co.*, 285 F.3d 1046, 1052 (Fed. Cir. 2002) (*en banc*). The claims are located at the end of the specification and are identified numerically. MPEP at § 608.01(M). At bottom, the claims identify the novel and nonobvious invention protected by the patent. Jeffrey G. Sheldon, *How to Write a Patent Application*, Practising Law Institute § 7:1 (2d ed. 2015).



## **II. THE PROCESS OF DRAFTING, FILING, AND PROSECUTING A PATENT APPLICATION**

A patent application is not the result of a mere clerical or ministerial process but rather results from the art and craft of a qualified patent attorney. The patent application is born from discussions between the patent attorney (or patent agent) and the inventor(s) together with the patent practitioner's review of any invention disclosure and underlying relevant documents or prototypes. *Id.* at § 4:4-6. Through this process, which may be (and often is) iterative, the practitioner learns the scope of the invention, how the invention works, any supporting theories, and acquires all of the information necessary to begin drafting the application. *Id.* at § 4:4-6. Often times, the number and scope of the claims from a single inventive concept cannot be fully realized until the draft application is complete. And some patent applications will take several rounds of revisions before they are ready for filing with the USPTO.

Once the patent application is drafted and filed, the application will be assigned to an art unit at the USPTO based on the technology covered by the claims.

MPEP at § 903.08(b). For example, a patent application for a new drug to treat cancer would be assigned to an art unit covering pharmaceutical inventions, while an application for a new process of manufacturing semiconductors would be assigned to a different art unit. A patent examiner experienced in the technology of the given art unit reviews the application to determine whether it satisfies the statutory requirements for obtaining a patent. In particular, the examiner conducts a prior art search to determine whether the claims are novel and non-obvious. 35 U.S.C. § 131; MPEP at §§ 704.01, 706. The universe of what is already known in the so-called "prior art" can consist of patents, patent applications, products in public use or on sale in the United States, and non-patent publications, such as books or scientific articles in print or online. 35 U.S.C. § 102 (a)-(e) (pre-America Invents Act).

Importantly, the USPTO examines each patent application independently, and the patent application competes against the prior art rather than against other pending applications. Pending patent applications remain confidential and do not typically qualify as prior art until 18 months after their

respective filing date, when the application publishes and becomes publicly available. 35 U.S.C. § 122. Prosecution of competing inventions occurs in parallel with the applicant on one side and the USPTO examiner on the other. While the applicant may need to characterize and distinguish his or her claims from the "prior art" cited during prosecution, the applicant is directly adverse to the USPTO rather than to other applicants.<sup>2</sup>

If the examiner determines that any statutory requirement for patentability has not been met, he or she issues an "office action" identifying the requirement(s) and citing pertinent prior art that precludes issuance of the application as a patent. MPEP at § 706. The patent practitioner may respond by either arguing against the rejections (e.g., by arguing that the claims define inventions that are new

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<sup>2</sup> Before the America Invents Act ("AIA") came into effect on March 16, 2013, the United States patent system was a first-to-invent system and, therefore, the right to exclude others was bestowed on whoever first invented—rather than whoever first filed a patent application on—the invention. If two patent applications had claims to the same invention, the only means of determining which party was the earlier inventor was for the parties or the USPTO to invoke an interference proceeding. 35 U.S.C. § 135 (pre-AIA). The patents at issue in this appeal are governed by pre-AIA law based on their filing dates.

and different from the prior art) or by amending the claims so as to narrow the scope of the invention and thus distinguish the prior art in that way. 37 C.F.R. § 1.121. Depending on the applicant's response, the examiner may issue another office action to which the patent practitioner can again respond. *Id.*; see also MPEP at § 706.07(A). This back-and-forth continues until the examiner determines that the claims are allowable or that the rejection cannot be overcome, or the applicant gives up and abandons the application. 37 C.F.R. §§ 1.311, 1.135, and 1.138.

If the examiner rejects the application during prosecution, an applicant may file an *ex parte* appeal to the Patent Trial and Appeal Board ("PTAB") to review the examiner's rejections. The PTAB may sustain or reverse the rejections. 35 U.S.C. § 134. On average, it will take a patent application filed at the USPTO 27.4 months to issue.<sup>3</sup>

Although a large amount of time may be devoted to drafting the original claims filed with the application, the applicant and the patent practitioner cannot know what the patented claims ultimately will

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<sup>3</sup> <http://www.uspto.gov/about/stratplan/ar/USPTOFY2014PAR.pdf>.

look like until the patent application is allowed and will subsequently issue as a patent. The issued claims result from this back-and-forth with the USPTO, during which the patent practitioner and the examiner negotiate the proper scope of the invention until agreement or an impasse is reached.

### **III. PATENT PROSECUTORS**

Patent attorneys are highly-specialized and must not only be admitted to practice law here in Massachusetts, but also must be registered to practice before the USPTO. First, a patent attorney must have a science or engineering degree to qualify for the patent bar. Second, many patent prosecutors tend to focus on a niche area of expertise. For example, attorneys with Ph.D's in molecular biology may represent biotech and pharmaceutical companies in Kendall Square and to specialize in biotech/pharmaceutical inventions. They know the USPTO examiners who work in those art units, the prior art, and the unwritten rules, if there are any, for prosecuting biotech and pharmaceutical patents. Likewise, patent attorneys with electrical engineering degrees, for example, may represent computer companies on Rt. 128 and specialize in electro-mechanical

inventions, software, etc. Clients choose patent attorneys based, in part, on their technical or scientific backgrounds. They want to know that the attorney speaks the same language as the engineers or scientists in the R&D lab and know the lay of the land in ushering applications for a given technology through the maze of the USPTO examination process.

#### **BACKGROUND FACTS**

This appeal stems from a legal malpractice claim filed by the plaintiffs, Chris E. Maling and his company, The Formula, LLC, (collectively, "Maling") against the law firm of Finnegan, Henderson, Farabow, Garrett, and Dunner, LLP and some of its employees ("Finnegan"). Appx. at 14-15. In April 2003, Maling allegedly retained Finnegan's attorneys in the Boston office to provide various legal services, including the filing and prosecution of patent applications. *Id.* at 8. Finnegan also allegedly agreed to obtain a prior-art search which would inform Maling as to known prior art (e.g., issued patents, published patent applications, and other publicly disclosed inventions) related to his screwless eyeglass hinge invention. *Id.* In September 2003, Maling allegedly gave Finnegan a prototype of his invention and a sample of prior

art. *Id.* In May 2004, attorneys in Finnegan's Boston office allegedly began preparing a patent application on Maling's inventions. *Id.*

Throughout Finnegan's representation of Maling, attorneys at Finnegan's Washington, DC office represented Masunaga Optical Manufacturing Company Limited ("Masunaga"). *Id.* at 9-10. Finnegan ultimately obtained four patents for Maling and one patent for Masunaga. *Id.* at 9. Maling later discovered the Masunaga patent and that Finnegan had been concurrently representing and securing patents for both him and Masunaga. *Id.* at 12.

In the complaint filed in the Superior Court, Maling alleged that Finnegan's concurrent representation created a conflict of interest under the Massachusetts Rules of Professional Conduct because Maling and Masunaga were "direct competitors" in the "same patent space." *Id.* at 14, 16. Maling further alleged that if Finnegan disclosed the conflict of interest or if he were aware of the Masunaga application that resulted in the issued patent, then Maling would not have invested a substantial amount of money to "develop his invention." *Id.* at 11.

Finnegan moved to dismiss the complaint under Mass. R. Civ. P. 12(b)(6), and the Superior Court granted this motion. *Id.* at 17-20, 21-24. The Superior Court cited to Massachusetts Rule of Professional Conduct 1.7(a), which prohibits a lawyer from representing clients who are "directly adverse" to one another. Appx. at 22. The Superior Court held that Maling and Masunaga were not directly adverse and that the Complaint did not suggest that the concurrent representation negatively affected Maling because Finnegan obtained multiple patents for Maling as it was hired to do. *Id.* The Superior Court also held that Maling failed to allege that Finnegan's representation of Maling was "materially limited" by its concurrent representation of Masunaga. Appx. at 23. Therefore, Massachusetts Rule of Professional Conduct 1.7(b) also was not violated.

Maling appealed this decision to the Court of Appeals and the case is now before this Court on direct appellate review.

#### **ARGUMENT**

The unintended consequences of adopting a new rule prohibiting law firms from concurrently representing clients with "similar inventions" are



real. As explained in Section IV below, those consequences include the stifling of innovation, especially among smaller business and solo inventors, and the potential monopolization of patent prosecution services by larger companies. Before addressing those issues, however, it is important to establish that the existing conflict of interest rules suffice to protect the interests of patentees and inventors. In addition, the new rule proposed by Appellant with respect to "similar inventions" is practically unworkable and brings no clarity to or advantage over Mass. R. Prof. Conduct 1.7.

I. **MASSACHUSETTS RULE OF PROFESSIONAL CONDUCT 1.7  
ADEQUATELY PROTECTS PATENT PROSECUTION CLIENTS.**

Massachusetts Rule of Professional Conduct 1.7 is as applicable to patent prosecution as to any other aspect or form of the attorney-client relationship. The Rule prohibits a lawyer from representing a client if representation of that client will be (1) "directly adverse" to another client or (2) "materially limited" by the lawyer's obligations to another. Mass. R. Prof. C. 1.7.<sup>4</sup> As the lower court held, neither of

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<sup>4</sup>The BPLA refers to Massachusetts Rule of Professional Conduct 1.7 as adopted on March 26, 2015 and as effective July 1, 2015. The BPLA, however, believes

these conflict situations arose as a result of Finnegan's simultaneous representation of Maling and Masunaga and, thus, no prohibition or disclosure requirements were triggered.

**A. Finnegan's Representation of Masunaga Was Not Directly Adverse to Maling.**

No conflict of interest under Rule 1.7(a) existed as a result of Finnegan's parallel prosecution of patent applications for Maling and Masunaga because its clients' interests were never "directly adverse." As detailed above, Finnegan ultimately secured patents for both Maling and Masunaga. And during the firm's prosecution of the patent applications for Maling, the USPTO never cited or referenced Masunaga's pending patent applications, and Masunaga's pending applications never served as a basis of any prior art rejection against Maling. Rather, because of the very nature of patent prosecution, separate and distinct negotiations occurred between Finnegan and the USPTO with regard to each client's respective rights vis-à-vis the prior art, not each other. The firm's success in securing a patent for Masunaga had no effect on Maling, and *vice versa*.

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that the same result would occur under application under the prior conflict-of-interest rule.

This is not to suggest that direct adversity between clients cannot arise in the patent prosecution context. For example, for patent filings before the America Invents Act, such as the patents in this case, a party or the USPTO could invoke an interference proceeding. Such a proceeding is a zero-sum game, meaning that ultimately only one applicant will be awarded the claims as the first inventor. Here, neither the USPTO, Maling, nor Masunaga ever sought to have an interference declared. Prosecution of Maling's applications therefore was not directly adverse to Masunaga, and prosecution of Masunaga's application was not directly adverse to Maling.

Maling's frustration that Finnegan represented a competitor cannot transform the fact that Maling and Masunaga compete in the business arena into a legal conflict. Comment 3 to Rule 1.7 confirms that the existence of competing economic interests between or among clients does not trigger the conflict of interest rules.

On the other hand, simultaneous representation in unrelated matters of clients whose interests are only economically adverse, such as representation of competing economic enterprises in unrelated litigation, does not ordinarily constitute a conflict of interest and thus

may not require consent of the respective clients.

Mass. R. Prof. Conduct 1.7, Cmt. 3.

**B. Maling's Representation Was Not "Materially Limited" By Finnegan's Obligations to Masunaga.**

The "materially limited" prong of Rule 1.7 seeks to ensure that a lawyer's obligations or responsibilities to another do not "materially interfere with the lawyer's independent professional judgment in considering alternatives or foreclose causes of action that reasonably should be pursued on behalf of the client." Mass. R. Prof. Conduct 1.7, Cmt. 4. *See also In re Driscoll*, 447 Mass. 678, 686 (2006). A firm's pursuit of different patents for different inventions in the same area of technology does not *ipso facto* create such material interference or cause such foreclosure.

As discussed above, Masunaga's pending patent application was never cited against Maling's application during prosecution. In fact, Finnegan's attorneys never commented on and never needed to characterize the scope of Maling's inventions as compared to Masunaga's application. The mere existence of Masunaga's application—and Finnegan's

prosecution of the same—neither limited nor negatively impacted the scope of Maling's patents.

Rule 1.7 provides a framework under which conflicts of interest can be identified and potentially resolved with regard to all aspects of the attorney-client relationship. There is no basis now to conclude that this framework is inadequate or inappropriate with regard to the services performed by patent attorneys in drafting, filing, and prosecuting applications on behalf of their clients.

**II. THIS COURT SHOULD NOT CREATE A SPECIAL, ILL-DEFINED CONFLICT OF INTEREST RULE FOR THE CONCURRENT PROSECUTION OF "SIMILAR INVENTIONS."**

The Appellant's arguments suggest that this Court create a third conflict of interest rule whereby the simultaneous prosecution of "similar inventions" would require disclosure and client consent. But adoption of such a new rule fails to bring any clarity; in fact, it poses more questions than it provides answers.

First, there is no test in patent law directed to defining "similar inventions." Indeed, a patent can survive a validity challenge and coexist with prior art regardless of the "similarity" of the two claimed inventions; all that is required is that the claims

not be anticipated or rendered obvious by the prior art. See, e.g., *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989) ("The identical invention must be shown in as complete detail as is contained in the . . . claim."); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 415-21 (2007) (discussing objective analysis for determining obviousness under 35 U.S.C. § 103).

Second, without a means for defining "similar inventions," patent attorneys will be forced to draw arbitrary lines during their daily practice. One of the Maling patents, itself, emphasizes the potential problem. U.S. Patent No. 7,101,039 (filed on June 24, 2004) issued to Maling for a "novel eyeglass frame allowing sizing, assembly and disassembly without the need for special training, screws, bolts, pins or special tools." U.S. Patent No. 7,101,039 at Abstract. There is no dispute that this invention relates to eyeglass hinges, but it is unclear where the subject matter of the invention begins and ends. Would Finnegan find itself in a conflict if it represented Maling and another client who has a patent application directed to eyeglasses? Any magnification devices? Could representing a client related to the

sizing and assembly of any framed lens give rise to a conflict? What about the sizing and assembly of a window frame?

In this relatively straightforward example of a simple device of eyeglasses and inventions related to hinges, one must still ponder where and how to draw the "similarity" line. Depending on the complexity of the technology and the number of competitors in or around the field, this analysis can become exponentially more difficult. As a result, a test of "similar inventions" proves no more than what Rule 1.7 already provides. In fact, Rule 1.7 focuses directly on the problems caused as a result of a conflict of interest; the "similarity" test appears to focus on a lawyer's ability to litigate the meaning of "similar."

Third, the only formal classification of patent applications by subject matter occurs upon filing the patent application with the USPTO. For example, the U.S. Patent Classification System ("USPC") organizes patent applications and issued patents into classes and subclasses.<sup>5</sup> A class is a general delineation between technologies; a subclass delineates processes,

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<sup>5</sup> <http://www.uspto.gov/sites/default/files/patents/resources/classification/overview.pdf>

structural features, and functional features of the subject matter within the class. There are more than 450 classes and more than 150,000 subclasses. Although a patent class in the USPC system attempts to arrange like technology areas together, a single class can encompass a broad range of subjects and a large number of patent applications and issued patents. For example, in class 340 for electrical communications, almost 3,000 patents were granted in 2014 alone.<sup>6</sup> And patents and patent applications in the electrical communications class include a host of devices, ranging from a fire alarm control to an apparatus for producing an electro sensory sensation to a body member. Using USPC as an indicator for conflict of interest purposes, therefore, would be both misguided and unworkable.

Fourth, the protracted and iterative process of patenting an invention strongly disfavors imposing a "similar invention" standard. As a practical matter, the timing of when practitioners must determine the subject matter of the application for conflict of interest purposes may prove problematic. As explained

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<sup>6</sup> <http://www.uspto.gov/web/offices/ac/ido/oeip/taf/cbcb y.pdf>



above, an inventive concept continuously evolves—from application drafting through patent issuance. As a result, there is no clear optimal time for a practitioner to determine the subject matter of the invention for similarity purposes. For example, it may be especially hard for the prosecutor to grasp the full scope of any given invention at the beginning of prosecution. This will necessarily lead to some amount of speculation as to whether the two cases will converge and put an attorney in conflict with his or her client, or will diverge, as in the present case, with prosecution of one case not impacting the other.

**III. IMPOSITION OF A DISCLOSURE OBLIGATION WITH REGARD TO "SIMILAR INVENTIONS" IS PROBLEMATIC.**

Any conflict-of-interest rule based on similarity and requiring consent may also impinge on the prosecuting attorney's duty to maintain client confidences. For this reason, too, such a rule should be rejected.

Massachusetts Rule of Professional Conduct 1.6 provides that a "lawyer shall not reveal confidential information relating to the representation of a client . . . ." Mass. R. Prof. Conduct 1.6(a). And even after an application is filed, its contents remain

proprietary and highly confidential for a distinct period of time. The USPTO—given the sensitivity and detail of the required disclosure—withholds publication of the patent application for eighteen months post-filing. 35 U.S.C. § 122(b)(1)(A). The USPTO also allows applicants to file a non-publication request if the application will not be filed in another country to prevent the USPTO from publishing the application until it ultimately issues. 35 U.S.C. § 122(b)(2)(B). These practices allow applicants to maintain secrecy over their inventions until that date. During this time period, therefore, a prosecuting attorney's obligation to maintain the disclosure as confidential is in effect.

Should this Court require disclosure and consent with regard to the concurrent prosecution of similar inventions, a prosecuting attorney would not only have to decide how to define "similar," but would also have to answer thorny questions as to how much to disclose in order to obtain informed consent without breaching client confidentiality. This would in effect pit the attorney's obligations under Rules 1.6 and 1.7 against each other.

**IV. THE ADOPTION OF A NEW CONFLICT RULE FOR PATENT PROSECUTION WILL IMPEDE PATENT PROSECUTION AND, THUS, INNOVATION IN THE COMMONWEALTH.**

Even if the ambiguity surrounding the meaning of "similar inventions" were resolved and concerns over confidentiality could be alleviated, any proposed rule prohibiting simultaneous representation of clients with "similar inventions" could have unintended consequences for inventors and patentees.<sup>7</sup>

A primary concern is the impact a new rule could have upon the ability of inventors and patent applicants to engage a patent prosecutor with specific technological expertise. Were this Court to prohibit attorneys and firms from representing multiple clients in the same field—regardless of how broad or narrow that field is defined—the number of available patent prosecutors (especially in both very crowded and niche technology areas) would become dramatically reduced. There are only so many patent attorneys with, for example, Ph.D's in molecular biology. Imposing a restrictive rule that would prevent a patent attorney

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<sup>7</sup>The BPLA does not assume that consent will be readily given by both clients given the concerns addressed above with regard to Mass. R. Prof. Conduct 1.6. Moreover, some clients may be motivated to withhold consent with regard to representation for competitive purposes.

or firm from representing competing companies would limit the pool of available and qualified patent attorneys dramatically. This likely would result in a trend toward patent attorneys and agents acting more as prosecution generalists, without regard to technology area. That is, if a patent attorney were limited to representing just one or a small number of inventors in a given field, the attorney would be forced to seek new clients in other fields, outside of the attorney's technical or scientific competence. Three foreseeable problems arise with respect to this trend.

First, patent practitioners who prosecute applications at the USPTO typically specialize in particular technical areas. Specialization can help patent prosecutors become experts in the particular technical area and more readily understand an inventive concept and why it represents a technical advancement over what is known in the prior art. A prosecuting attorney's lack of existing knowledge of the relevant technology may result in significant uncertainty at the outset of patent application drafting and prosecution. For example, for very complex inventions a non-specialized attorney may

struggle to translate an invention into a patent application. At best, this struggle could result in less efficiency and longer lead time in getting the application on file, increasing the already high cost of obtaining a patent. At worst, the attorney may fail to understand the nuances of the technology, impacting his or her ability to properly negotiate the scope of the invention during prosecution at the USPTO.

In addition, attorneys who lack experience within a technological field cannot be expected to be familiar with the prior art in that particular field. This inexperience would handicap attorneys from advising clients regarding patentability and could increase the number of patent applications filed at the USPTO, burdening an already-taxed system with a backlog of unexamined patent applications having a low probability of issuing into a patent.

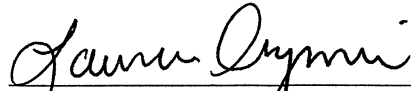
Another unintended result of adopting a "similar inventions" rule is that savvy patent clients could potentially monopolize the marketplace for lawyers who do have specific technological expertise to gain a competitive advantage. For example, larger, sophisticated clients could strategically send small

amounts of work to many different firms throughout Massachusetts so that no competitor could employ the same caliber of firm/attorney. Such a practice would restrict the availability of experienced patent counsel in the Commonwealth to represent a variety of businesses in patent prosecution matters and is another undesirable consequence of adopting the new "similar inventions" rule proposed by the Appellant. Competitors would be forced to find counsel out of state, significantly disadvantaging Massachusetts counsel and Massachusetts based patent applicants.

#### **CONCLUSION**

The prosecution of two merely "similar" applications in parallel at the USPTO does not, by itself, create a conflict of interest under Rule 1.7. Because of the complexities in patent drafting and prosecution, this Court should allow attorneys and firms the flexibility to take on patent prosecution cases from competitors and to use the applicable and existing conflict-of-interest rules to determine if there is "direct adversity" or the representation would be "materially limited."

BOSTON PATENT LAW ASSOCIATION,



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**ADDENDUM**

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Title 35. Patents ([Refs & Annos](#))

Part II. Patentability of Inventions and Grant of Patents ([Refs & Annos](#))

Chapter 10. Patentability of Inventions ([Refs & Annos](#))

This section has been updated. Click [here](#) for the updated version.

35 U.S.C.A. § 102

§ 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless--

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in (1) an application for patent, published under [section 122\(b\)](#), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in [section 351\(a\)](#) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;<sup>1</sup> or

(f) he did not himself invent the subject matter sought to be patented, or

(g)(1) during the course of an interference conducted under [section 135](#) or [section 291](#), another inventor involved therein establishes, to the extent permitted in [section 104](#), that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

**CREDIT(S)**

(July 19, 1952, c. 950, 66 Stat. 797; July 28, 1972, Pub.L. 92-358, § 2, 86 Stat. 502; Nov. 14, 1975, Pub.L. 94-131, § 5, 89 Stat. 691; Nov. 29, 1999, Pub.L. 106-113, Div. B, § 1000(a)(9) [Title IV, §§ 4505, 4806], 113 Stat. 1536, 1501A-565, 1501A-590; Nov. 2, 2002, Pub.L. 107-273, Div. C, Title III, § 13205(1), 116 Stat. 1903.)

**AMENDMENT OF SECTION**

<Pub.L. 112-29, § 3(b)(1), (n), Sept. 16, 2011, 125 Stat. 285, 293, provided that effective upon expiration of the 18-month period beginning Sept. 16, 2011, and applicable to certain applications for patent, and to certain patents issued thereon, section is amended to read:>

<§ 102. **Conditions for patentability; novelty**>

<(a) **Novelty; prior art.**--A person shall be entitled to a patent unless-->

<(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or>

<(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.>

<(b) **Exceptions.**-->

<(1) **Disclosures made 1 year or less before the effective filing date of the claimed invention.**--A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if-->

<(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or>

<(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.>

<(2) **Disclosures appearing in applications and patents.**--A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if-->

<(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;>

<(B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or>

<(C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.>

<(c) **Common ownership under joint research agreements.**--Subject matter disclosed and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person in applying the provisions of subsection (b)(2)(C) if-->

<(1) the subject matter disclosed was developed and the claimed invention was made by, or on behalf of, 1 or more parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention;>

<(2) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and>

<(3) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.>

<(d) **Patents and published applications effective as prior art.**--For purposes of determining whether a patent or application for patent is prior art to a claimed invention under subsection (a)(2), such patent or application shall be considered to have been effectively filed, with respect to any subject matter described in the patent or application-->

<(1) if paragraph (2) does not apply, as of the actual filing date of the patent or the application for patent; or>

<(2) if the patent or application for patent is entitled to claim a right of priority under section 119, 365(a), or 365(b), or to claim the benefit of an earlier filing date under section 120, 121, or 365(c), based upon 1 or more prior filed applications for patent, as of the filing date of the earliest such application that describes the subject matter.>

#### AMENDMENT OF SUBSECTION (D)(2)

<Pub.L. 112-211, Title I, §§ 102(2), 103(a), Dec. 18, 2012, 126 Stat. 1531, 1532, provided that effective on the later of the date that is 1 year after Dec. 18, 2012, or the date of entry into force of the treaty with respect to the United States, subsec. (d)(2) (as amended by the Leahy-Smith America Invents Act (Public Law 112-29; 125 Stat. 284)) is amended by striking “to claim a right of priority under section 119, 365(a), or 365(b), or to claim the benefit of an earlier filing date under section 120, 121, or 365(c)” and inserting “to claim a right of priority under section 119, 365(a), 365(b), 386(a), or 386(b), or to claim the benefit of an earlier filing date under section 120, 121, 365(c), or 386(c)”.>

#### Footnotes

1 So in original. The semicolon probably should be a comma.

35 U.S.C.A. § 102, 35 USCA § 102

Current through P.L. 114-49 approved 8-7-2015

United States Code Annotated  
Title 35. Patents (Refs & Annos)  
Part II. Patentability of Inventions and Grant of Patents (Refs & Annos)  
Chapter 11. Application for Patent (Refs & Annos)

35 U.S.C.A. § 111

§ 111. Application

Effective: May 13, 2015

[Currentness](#)

**(a) In general.--**

**(1) Written application.--**An application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Director.

**(2) Contents.--**Such application shall include--

**(A)** a specification as prescribed by [section 112](#);

**(B)** a drawing as prescribed by [section 113](#); and

**(C)** an oath or declaration as prescribed by [section 115](#).

**(3) Fee, oath or declaration, and claims.--**The application shall be accompanied by the fee required by law. The fee, oath or declaration, and 1 or more claims may be submitted after the filing date of the application, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director. Upon failure to submit the fee, oath or declaration, and 1 or more claims within such prescribed period, the application shall be regarded as abandoned.

**(4) Filing date.--**The filing date of an application shall be the date on which a specification, with or without claims, is received in the United States Patent and Trademark Office.

**(b) Provisional application.--**

**(1) Authorization.--**A provisional application for patent shall be made or authorized to be made by the inventor, except as otherwise provided in this title, in writing to the Director. Such application shall include--

**(A)** a specification as prescribed by [section 112\(a\)](#); and

(B) a drawing as prescribed by [section 113](#).

(2) **Claim.**--A claim, as required by [subsections \(b\) through \(e\) of section 112](#), shall not be required in a provisional application.

(3) **Fee.**--The application shall be accompanied by the fee required by law. The fee may be submitted after the filing date of the application, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director. Upon failure to submit the fee within such prescribed period, the application shall be regarded as abandoned.

(4) **Filing date.**--The filing date of a provisional application shall be the date on which a specification, with or without claims, is received in the United States Patent and Trademark Office.

(5) **Abandonment.**--Notwithstanding the absence of a claim, upon timely request and as prescribed by the Director, a provisional application may be treated as an application filed under subsection (a). Subject to [section 119\(e\)\(3\)](#), if no such request is made, the provisional application shall be regarded as abandoned 12 months after the filing date of such application and shall not be subject to revival after such 12-month period.

(6) **Other basis for provisional application.**--Subject to all the conditions in this subsection and [section 119\(e\)](#), and as prescribed by the Director, an application for patent filed under subsection (a) may be treated as a provisional application for patent.

(7) **No right of priority or benefit of earliest filing date.**--A provisional application shall not be entitled to the right of priority of any other application under [section 119](#), [365\(a\)](#), or [386\(a\)](#) or to the benefit of an earlier filing date in the United States under [section 120](#), [121](#), [365\(c\)](#), or [386\(c\)](#).

(8) **Applicable provisions.**--The provisions of this title relating to applications for patent shall apply to provisional applications for patent, except as otherwise provided, and except that provisional applications for patent shall not be subject to [sections 131](#) and [135](#).

(c) **Prior filed application.**--Notwithstanding the provisions of subsection (a), the Director may prescribe the conditions, including the payment of a surcharge, under which a reference made upon the filing of an application under subsection (a) to a previously filed application, specifying the previously filed application by application number and the intellectual property authority or country in which the application was filed, shall constitute the specification and any drawings of the subsequent application for purposes of a filing date. A copy of the specification and any drawings of the previously filed application shall be submitted within such period and under such conditions as may be prescribed by the Director. A failure to submit the copy of the specification and any drawings of the previously filed application within the prescribed period shall result in the application being regarded as abandoned. Such application shall be treated as having never been filed, unless--

(1) the application is revived under [section 27](#); and

(2) a copy of the specification and any drawings of the previously filed application are submitted to the Director.

**CREDIT(S)**

(July 19, 1952, c. 950, 66 Stat. 798; [Pub.L. 97-247](#), § 5, Aug. 27, 1982, 96 Stat. 319; [Pub.L. 103-465, Title V, §532\(b\)\(3\)](#), Dec. 8, 1994, 108 Stat. 4986; [Pub.L. 106-113](#), Div. B, § 1000(a)(9) [Title IV, §§ 4732(a)(10)(A), 4801(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A-582, 1501A-588; [Pub.L. 107-273](#), Div. C, Title III, § 13206(b)(1)(B), Nov. 2, 2002, 116 Stat. 1906; [Pub.L. 112-29](#), §§ 3(e)(2), 4(a)(3), (d), 20(j)(1), (2)(D), Sept. 16, 2011, 125 Stat. 287, 295, 296, 335; [Pub.L. 112-211, Title I, § 102\(3\), Title II, § 201\(a\)](#), Dec. 18, 2012, 126 Stat. 1531, 1533.)


35 U.S.C.A. § 111, 35 USCA § 111

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 KeyCite Yellow Flag - Negative Treatment  
Proposed Legislation

United States Code Annotated  
Title 35. Patents (Refs & Annos)  
Part II. Patentability of Inventions and Grant of Patents (Refs & Annos)  
Chapter 11. Application for Patent (Refs & Annos)

35 U.S.C.A. § 122

§ 122. Confidential status of applications; publication of patent applications

Effective: December 18, 2013

[Currentness](#)

**(a) Confidentiality.**--Except as provided in subsection (b), applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of an Act of Congress or in such special circumstances as may be determined by the Director.

**(b) Publication.**--

**(1) In general.**--**(A)** Subject to paragraph (2), each application for a patent shall be published, in accordance with procedures determined by the Director, promptly after the expiration of a period of 18 months from the earliest filing date for which a benefit is sought under this title. At the request of the applicant, an application may be published earlier than the end of such 18-month period.

**(B)** No information concerning published patent applications shall be made available to the public except as the Director determines.

**(C)** Notwithstanding any other provision of law, a determination by the Director to release or not to release information concerning a published patent application shall be final and nonreviewable.

**(2) Exceptions.**--**(A)** An application shall not be published if that application is--

**(i)** no longer pending;

**(ii)** subject to a secrecy order under [section 181](#);

**(iii)** a provisional application filed under [section 111\(b\)](#); or

**(iv)** an application for a design patent filed under chapter 16.

**(B)(i)** If an applicant makes a request upon filing, certifying that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing, the application shall not be published as provided in paragraph (1).

**(ii)** An applicant may rescind a request made under clause (i) at any time.

**(iii)** An applicant who has made a request under clause (i) but who subsequently files, in a foreign country or under a multilateral international agreement specified in clause (i), an application directed to the invention disclosed in the application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days after the date of the filing of such foreign or international application. A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned.

**(iv)** If an applicant rescinds a request made under clause (i) or notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in clause (i), the application shall be published in accordance with the provisions of paragraph (1) on or as soon as is practical after the date that is specified in clause (i).

**(v)** If an applicant has filed applications in one or more foreign countries, directly or through a multilateral international agreement, and such foreign filed applications corresponding to an application filed in the Patent and Trademark Office or the description of the invention in such foreign filed applications is less extensive than the application or description of the invention in the application filed in the Patent and Trademark Office, the applicant may submit a redacted copy of the application filed in the Patent and Trademark Office eliminating any part or description of the invention in such application that is not also contained in any of the corresponding applications filed in a foreign country. The Director may only publish the redacted copy of the application unless the redacted copy of the application is not received within 16 months after the earliest effective filing date for which a benefit is sought under this title. The provisions of [section 154\(d\)](#) shall not apply to a claim if the description of the invention published in the redacted application filed under this clause with respect to the claim does not enable a person skilled in the art to make and use the subject matter of the claim.

**(c) Protest and pre-issuance opposition.**--The Director shall establish appropriate procedures to ensure that no protest or other form of pre-issuance opposition to the grant of a patent on an application may be initiated after publication of the application without the express written consent of the applicant.

**(d) National security.**--No application for patent shall be published under subsection (b)(1) if the publication or disclosure of such invention would be detrimental to the national security. The Director shall establish appropriate procedures to ensure that such applications are promptly identified and the secrecy of such inventions is maintained in accordance with chapter 17.

**(e) Preissuance submissions by third parties.**--

**(1) In general.**--Any third party may submit for consideration and inclusion in the record of a patent application, any patent, published patent application, or other printed publication of potential relevance to the examination of the application, if such submission is made in writing before the earlier of--

**(A)** the date a notice of allowance under [section 151](#) is given or mailed in the application for patent; or



(B) the later of--

(i) 6 months after the date on which the application for patent is first published under section 122 by the Office, or

(ii) the date of the first rejection under [section 132](#) of any claim by the examiner during the examination of the application for patent.

(2) **Other requirements.**--Any submission under paragraph (1) shall--

(A) set forth a concise description of the asserted relevance of each submitted document;

(B) be accompanied by such fee as the Director may prescribe; and

(C) include a statement by the person making such submission affirming that the submission was made in compliance with this section.

**CREDIT(S)**

(July 19, 1952, c. 950, 66 Stat. 801; [Pub.L. 93-596](#), § 1, Jan. 2, 1975, 88 Stat. 1949; [Pub.L. 106-113](#), Div. B, § 1000(a)(9) [Title IV, § 4502(a)], Nov. 29, 1999, 113 Stat. 1536, 1501A-561; [Pub.L. 112-29](#), §§ 8(a), 20(j)(1), Sept. 16, 2011, 125 Stat. 315, 335; [Pub.L. 112-211](#), [Title II](#), § 202(b)(4), Dec. 18, 2012, 126 Stat. 1536.)

35 U.S.C.A. § 122, 35 USCA § 122

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United States Code Annotated  
Title 35. Patents (Refs & Annos)  
Part II. Patentability of Inventions and Grant of Patents (Refs & Annos)  
Chapter 12. Examination of Application

35 U.S.C.A. § 131

§ 131. Examination of application

Effective: November 2, 2002

[Currentness](#)

The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor.

**CREDIT(S)**

(July 19, 1952, c. 950, 66 Stat. 801; [Pub.L. 106-113](#), Div. B, § 1000(a)(9) [Title IV, § 4732(a)(10)(A)], Nov. 29, 1999, 113 Stat. 1536, 1501A-582; [Pub.L. 107-273](#), Div. C, Title III, § 13206(b)(1)(B), Nov. 2, 2002, 116 Stat. 1906.)

35 U.S.C.A. § 131, 35 USCA § 131

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United States Code Annotated  
Title 35. Patents (Refs & Annos)  
Part II. Patentability of Inventions and Grant of Patents (Refs & Annos)  
Chapter 12. Examination of Application

35 U.S.C.A. § 134

§ 134. Appeal to the Patent Trial and Appeal Board

Currentness

**(a) Patent applicant.**--An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Patent Trial and Appeal Board, having once paid the fee for such appeal.

**(b) Patent owner.**--A patent owner in a reexamination may appeal from the final rejection of any claim by the primary examiner to the Patent Trial and Appeal Board, having once paid the fee for such appeal.

**CREDIT(S)**

(July 19, 1952, c. 950, 66 Stat. 801; [Pub.L. 98-622, Title II, § 204\(b\)\(1\)](#), Nov. 8, 1984, 98 Stat. 3388; [Pub.L. 106-113](#), Div. B, § 1000(a)(9) [Title IV, § 4605(b)], Nov. 29, 1999, 113 Stat. 1536, 1501A-571; [Pub.L. 107-273](#), Div. C, Title III, §§ 13106(b), 13202(b)(1), Nov. 2, 2002, 116 Stat. 1901; [Pub.L. 112-29](#), § 3(j)(1), (3), 7(b), Sept. 16, 2011, 125 Stat. 290, 313.)

35 U.S.C.A. § 134, 35 USCA § 134

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Part II. Patentability of Inventions and Grant of Patents ([Refs & Annos](#))

Chapter 12. Examination of Application

This section has been updated. Click [here](#) for the updated version.

35 U.S.C.A. § 135

§ 135. Interferences

Effective: September 16, 2012

**(a)** Whenever an application is made for a patent which, in the opinion of the Director, would interfere with any pending application, or with any unexpired patent, an interference may be declared and the Director shall give notice of such declaration to the applicants, or applicant and patentee, as the case may be. The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and may determine questions of patentability. Any final decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent and Trademark Office of the claims involved, and the Director may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved in the patent, and notice of such cancellation shall be endorsed on copies of the patent distributed after such cancellation by the Patent and Trademark Office.

**(b)(1)** A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

**(2)** A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an application published under [section 122\(b\)](#) may be made in an application filed after the application is published only if the claim is made before 1 year after the date on which the application is published.

**(c)** Any agreement or understanding between parties to an interference, including any collateral agreements referred to therein, made in connection with or in contemplation of the termination of the interference, shall be in writing and a true copy thereof filed in the Patent and Trademark Office before the termination of the interference as between the said parties to the agreement or understanding. If any party filing the same so requests, the copy shall be kept separate from the file of the interference, and made available only to Government agencies on written request, or to any person on a showing of good cause. Failure to file the copy of such agreement or understanding shall render permanently unenforceable such agreement or understanding and any patent of such parties involved in the interference or any patent subsequently issued on any application of such parties so involved. The Director may, however, on a showing of good cause for failure to file within the time prescribed, permit the filing of the agreement or understanding during the six-month period subsequent to the termination of the interference as between the parties to the agreement or understanding.

The Director shall give notice to the parties or their attorneys of record, a reasonable time prior to said termination, of the filing requirement of this section. If the Director gives such notice at a later time, irrespective of the right to file such agreement or understanding within the six-month period on a showing of good cause, the parties may file such agreement or understanding within sixty days of the receipt of such notice.

Any discretionary action of the Director under this subsection shall be reviewable under section 10 of the Administrative Procedure Act.

(d) Parties to a patent interference, within such time as may be specified by the Director by regulation, may determine such contest or any aspect thereof by arbitration. Such arbitration shall be governed by the provisions of title 9 to the extent such title is not inconsistent with this section. The parties shall give notice of any arbitration award to the Director, and such award shall, as between the parties to the arbitration, be dispositive of the issues to which it relates. The arbitration award shall be unenforceable until such notice is given. Nothing in this subsection shall preclude the Director from determining patentability of the invention involved in the interference.

#### CREDIT(S)

(July 19, 1952, c. 950, 66 Stat. 801; Oct. 15, 1962, Pub.L. 87-831, 76 Stat. 958; Jan. 2, 1975, Pub.L. 93-596, § 1, 88 Stat. 1949; Nov. 8, 1984, Pub.L. 98-622, Title I, § 105, Title II, § 202, 98 Stat. 3385, 3386; Nov. 29, 1999, Pub.L. 106-113, Div. B, § 1000(a)(9) [Title IV, §§ 4507(11), 4732(a)(10)(A)], 113 Stat. 1536, 1501A-566, 1501A-582; Nov. 2, 2002, Pub.L. 107-273, Div. C, Title III, § 13206(b)(1)(B), 116 Stat. 1906; Pub.L. 112-29, § 20(j)(1) Sept. 16, 2011, 125 Stat. 335.)

#### AMENDMENT OF SECTION

<Pub.L. 112-29, § 3(i), (n), Sept. 16, 2011, 125 Stat. 289, 293, as amended by Pub.L. 112-274, § 1(e), (k), Jan. 14, 2013, 126 Stat. 2456, 2457, provided that effective upon expiration of the 18-month period beginning Sept. 16, 2011, and applicable to certain applications for patent, and to certain patents issued thereon, section is amended to read:>  
<§ 135. Derivation proceedings>

#### <(a) Institution of proceeding.-->

<(1) In general.--An applicant for patent may file a petition with respect to an invention to institute a derivation proceeding in the Office. The petition shall set forth with particularity the basis for finding that an individual named in an earlier application as the inventor or a joint inventor derived such invention from an individual named in the petitioner's application as the inventor or a joint inventor and, without authorization, the earlier application claiming such invention was filed. Whenever the Director determines that a petition filed under this subsection demonstrates that the standards for instituting a derivation proceeding are met, the Director may institute a derivation proceeding.>

<(2) Time for filing.--A petition under this section with respect to an invention that is the same or substantially the same invention as a claim contained in a patent issued on an earlier application, or contained in an earlier application when published or deemed published under section 122(b), may not be filed unless such petition is filed during the 1-year period following the date on which the patent containing such claim was granted or the earlier application containing such claim was published, whichever is earlier.>

<(3) Earlier application.--For purposes of this section, an application shall not be deemed to be an earlier application with respect to an invention, relative to another application, unless a claim to the invention was or could have been made in such application having an effective filing date that is earlier than the effective filing date of any claim to the invention that was or could have been made in such other application.>

<(4) No appeal.--A determination by the Director whether to institute a derivation proceeding under paragraph (1) shall be final and not appealable.>

<(b) Determination by Patent Trial and Appeal Board.--In a derivation proceeding instituted under subsection (a), the Patent Trial and Appeal Board shall determine whether an inventor named in the earlier application derived

the claimed invention from an inventor named in the petitioner's application and, without authorization, the earlier application claiming such invention was filed. In appropriate circumstances, the Patent Trial and Appeal Board may correct the naming of the inventor in any application or patent at issue. The Director shall prescribe regulations setting forth standards for the conduct of derivation proceedings, including requiring parties to provide sufficient evidence to prove and rebut a claim of derivation.>

<(c) **Deferral of decision.**--The Patent Trial and Appeal Board may defer action on a petition for a derivation proceeding until the expiration of the 3-month period beginning on the date on which the Director issues a patent that includes the claimed invention that is the subject of the petition. The Patent Trial and Appeal Board also may defer action on a petition for a derivation proceeding, or stay the proceeding after it has been instituted, until the termination of a proceeding under chapter 30, 31, or 32 involving the patent of the earlier applicant.>

<(d) **Effect of final decision.**--The final decision of the Patent Trial and Appeal Board, if adverse to claims in an application for patent, shall constitute the final refusal by the Office on those claims. The final decision of the Patent Trial and Appeal Board, if adverse to claims in a patent, shall, if no appeal or other review of the decision has been or can be taken or had, constitute cancellation of those claims, and notice of such cancellation shall be endorsed on copies of the patent distributed after such cancellation.>

<(e) **Settlement.**--Parties to a proceeding instituted under subsection (a) may terminate the proceeding by filing a written statement reflecting the agreement of the parties as to the correct inventor of the claimed invention in dispute. Unless the Patent Trial and Appeal Board finds the agreement to be inconsistent with the evidence of record, if any, it shall take action consistent with the agreement. Any written settlement or understanding of the parties shall be filed with the Director. At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents or applications, and shall be made available only to Government agencies on written request, or to any person on a showing of good cause.>

<(f) **Arbitration.**--Parties to a proceeding instituted under subsection (a) may, within such time as may be specified by the Director by regulation, determine such contest or any aspect thereof by arbitration. Such arbitration shall be governed by the provisions of title 9, to the extent such title is not inconsistent with this section. The parties shall give notice of any arbitration award to the Director, and such award shall, as between the parties to the arbitration, be dispositive of the issues to which it relates. The arbitration award shall be unenforceable until such notice is given. Nothing in this subsection shall preclude the Director from determining the patentability of the claimed inventions involved in the proceeding.>

35 U.S.C.A. § 135, 35 USCA § 135  
Current through P.L. 114-49 approved 8-7-2015

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Subpart B. National Processing Provisions

Specification (Refs & Annos)

37 C.F.R. § 1.71

§ 1.71 Detailed description and specification of the invention.

Effective: March 16, 2013

Currentness

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

(d) A copyright or mask work notice may be placed in a design or utility patent application adjacent to copyright and mask work material contained therein. The notice may appear at any appropriate portion of the patent application disclosure. For notices in drawings, see § 1.84(s). The content of the notice must be limited to only those elements provided for by law. For example, “© 1983 John Doe” (17 U.S.C. 401) and “\*M\* John Doe” (17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the authorization language set forth in paragraph (e) of this section is included at the beginning (preferably as the first paragraph) of the specification.

(e) The authorization shall read as follows:

A portion of the disclosure of this patent document contains material which is subject to (copyright or mask work) protection. The (copyright or mask work) owner has no objection to the facsimile reproduction by anyone of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent file or records, but otherwise reserves all (copyright or mask work) rights whatsoever.

(f) The specification must commence on a separate sheet. Each sheet including part of the specification may not include other parts of the application or other information. The claim(s), abstract and sequence listing (if any) should not be included on a sheet including any other part of the application.

(g)(1) The specification may disclose or be amended to disclose the names of the parties to a joint research agreement as defined in § 1.9(e).

(2) An amendment under paragraph (g)(1) of this section must be accompanied by the processing fee set forth in § 1.17(i) if not filed within one of the following time periods:

(i) Within three months of the filing date of a national application;

(ii) Within three months of the date of entry of the national stage as set forth in § 1.491 in an international application;

(iii) Before the mailing of a first Office action on the merits; or

(iv) Before the mailing of a first Office action after the filing of a request for continued examination under § 1.114.

(3) If an amendment under paragraph (g)(1) of this section is filed after the date the issue fee is paid, the patent as issued may not necessarily include the names of the parties to the joint research agreement. If the patent as issued does not include the names of the parties to the joint research agreement, the patent must be corrected to include the names of the parties to the joint research agreement by a certificate of correction under 35 U.S.C. 255 and § 1.323 for the amendment to be effective.

#### Credits

[53 FR 47808, Nov. 28, 1988; 58 FR 38723, July 20, 1993; 68 FR 38628, June 30, 2003; 70 FR 1823, Jan. 11, 2005; 70 FR 54266, Sept. 14, 2005; 78 FR 11055, Feb. 14, 2013]

SOURCE: 24 FR 10332, Dec. 22, 1959; 60 FR 14518, March 17, 1995; 65 FR 14871, March 20, 2000; 65 FR 33455, May 24, 2000; 65 FR 50103, Aug. 16, 2000; 65 FR 56793, Sept. 20, 2000; 65 FR 70490, Nov. 24, 2000; 80 FR 17952, April 2, 2015, unless otherwise noted.

AUTHORITY: 35 U.S.C. 2(b)(2), unless otherwise noted.; §§ 1.71 to 1.79 also issued under 35 U.S.C. 112.

#### Notes of Decisions (1394)

Current through Aug. 20, 2015; 80 FR 50586.



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Amendments (Refs & Annos)

37 C.F.R. § 1.121

§ 1.121 Manner of making amendments in applications.

Effective: May 13, 2015

Currentness

(a) Amendments in applications, other than reissue applications. Amendments in applications, other than reissue applications, are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made.

(b) Specification. Amendments to the specification, other than the claims, computer listings (§ 1.96) and sequence listings (§ 1.825), must be made by adding, deleting or replacing a paragraph, by replacing a section, or by a substitute specification, in the manner specified in this section.

(1) Amendment to delete, replace, or add a paragraph. Amendments to the specification, including amendment to a section heading or the title of the invention which are considered for amendment purposes to be an amendment of a paragraph, must be made by submitting:

(i) An instruction, which unambiguously identifies the location, to delete one or more paragraphs of the specification, replace a paragraph with one or more replacement paragraphs, or add one or more paragraphs;

(ii) The full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived;

(iii) The full text of any added paragraphs without any underlining; and

(iv) The text of a paragraph to be deleted must not be presented with strike-through or placed within double brackets. The instruction to delete may identify a paragraph by its paragraph number or include a few words from the beginning, and end, of the paragraph, if needed for paragraph identification purposes.

(2) Amendment by replacement section. If the sections of the specification contain section headings as provided in § 1.77(b), § 1.154(b), or § 1.163(c), amendments to the specification, other than the claims, may be made by submitting:

(i) A reference to the section heading along with an instruction, which unambiguously identifies the location, to delete that section of the specification and to replace such deleted section with a replacement section; and

(ii) A replacement section with markings to show all changes relative to the previous version of the section. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived.

(3) Amendment by substitute specification. The specification, other than the claims, may also be amended by submitting:

(i) An instruction to replace the specification; and

(ii) A substitute specification in compliance with §§ 1.125(b) and (c).

(4) Reinstatement of previously deleted paragraph or section. A previously deleted paragraph or section may be reinstated only by a subsequent amendment adding the previously deleted paragraph or section.

(5) Presentation in subsequent amendment document. Once a paragraph or section is amended in a first amendment document, the paragraph or section shall not be re-presented in a subsequent amendment document unless it is amended again or a substitute specification is provided.

(c) Claims. Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) Claim listing. All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of “canceled” or “not entered” may be aggregated into one statement (e.g., Claims 1–5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) When claim text with markings is required. All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of “currently amended,” and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter

must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of “currently amended,” or “withdrawn” if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as “withdrawn—currently amended.”

(3) When claim text in clean version is required. The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, i.e., without any markings in the presentation of text. The presentation of a clean version of any claim having the status of “original,” “withdrawn” or “previously presented” will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of “withdrawn” or “previously presented.” Any claim added by amendment must be indicated with the status of “new” and presented in clean version, i.e., without any underlining.

(4) When claim text shall not be presented; canceling a claim.

(i) No claim text shall be presented for any claim in the claim listing with the status of “canceled” or “not entered.”

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as “canceled” will constitute an instruction to cancel the claim.

(5) Reinstatement of previously canceled claim. A claim which was previously canceled may be reinstated only by adding the claim as a “new” claim with a new claim number.

(d) Drawings. One or more application drawings shall be amended in the following manner: Any changes to an application drawing must be in compliance with § 1.84 or, for a nonprovisional international design application, in compliance with §§ 1.84(c) and 1.1026 and must be submitted on a replacement sheet of drawings which shall be an attachment to the amendment document and, in the top margin, labeled “Replacement Sheet.” Any replacement sheet of drawings shall include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is amended. Any new sheet of drawings containing an additional figure must be labeled in the top margin as “New Sheet.” All changes to the drawings shall be explained, in detail, in either the drawing amendment or remarks section of the amendment paper.

(1) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be included. The marked-up copy must be clearly labeled as “Annotated Sheet” and must be presented in the amendment or remarks section that explains the change to the drawings.

(2) A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

(e) Disclosure consistency. The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(f) No new matter. No amendment may introduce new matter into the disclosure of an application.

(g) Exception for examiner's amendments. Changes to the specification, including the claims, of an application made by the Office in an examiner's amendment may be made by specific instructions to insert or delete subject matter set forth in the examiner's amendment by identifying the precise point in the specification or the claim(s) where the insertion or deletion is to be made. Compliance with paragraphs (b)(1), (b)(2), or (c) of this section is not required.

(h) Amendment sections. Each section of an amendment document (e.g., amendment to the claims, amendment to the specification, replacement drawings, and remarks) must begin on a separate sheet.

(i) Amendments in reissue applications. Any amendment to the description and claims in reissue applications must be made in accordance with § 1.173.

(j) Amendments in reexamination proceedings. Any proposed amendment to the description and claims in patents involved in reexamination proceedings must be made in accordance with § 1.530.

(k) Amendments in provisional applications. Amendments in provisional applications are not usually made. If an amendment is made to a provisional application, however, it must comply with the provisions of this section. Any amendments to a provisional application shall be placed in the provisional application file but may not be entered.

#### Credits

[[32 FR 13583](#), Sept. 28, 1967 and [46 FR 29183](#), May 29, 1981; [49 FR 555](#), Jan. 4, 1984; [62 FR 53192](#), Oct. 10, 1997; [62 FR 61235](#), Nov. 17, 1997; [65 FR 54672](#), Sept. 8, 2000; [65 FR 76773](#), Dec. 7, 2000; [68 FR 38628](#), June 30, 2003; [69 FR 56543](#), Sept. 21, 2004; [80 FR 17963](#), April 2, 2015]

SOURCE: [24 FR 10332](#), Dec. 22, 1959; [60 FR 14518](#), March 17, 1995; [65 FR 14871](#), March 20, 2000; [65 FR 33455](#), May 24, 2000; [65 FR 50103](#), Aug. 16, 2000; [65 FR 56793](#), Sept. 20, 2000; [65 FR 70490](#), Nov. 24, 2000; [80 FR 17952](#), April 2, 2015, unless otherwise noted.

AUTHORITY: [35 U.S.C. 2\(b\)\(2\)](#), unless otherwise noted.; §§ 1.115 to 1.127 also issued under [35 U.S.C. 132](#).

#### Notes of Decisions (105)

Current through Aug. 20, 2015; [80 FR 50586](#).

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Subpart B. National Processing Provisions

Allowance and Issue of Patent

37 C.F.R. § 1.311

§ 1.311 Notice of allowance.

Effective: December 18, 2013

Currentness

(a) If, on examination, it appears that the applicant is entitled to a patent under the law, a notice of allowance will be sent to the applicant at the correspondence address indicated in § 1.33. The notice of allowance shall specify a sum constituting the issue fee and any required publication fee (§ 1.211(e)), which issue fee and any required publication fee must both be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. This three-month period is not extendable.

(b) An authorization to charge the issue fee or other post-allowance fees set forth in § 1.18 to a deposit account may be filed in an individual application only after mailing of the notice of allowance. The submission of either of the following after the mailing of a notice of allowance will operate as a request to charge the correct issue fee or any publication fee due to any deposit account identified in a previously filed authorization to charge such fees:

- (1) An incorrect issue fee or publication fee; or
- (2) A fee transmittal form (or letter) for payment of issue fee or publication fee.

**Credits**

[30 FR 12844, Oct. 8, 1965, as amended at 47 FR 41279, Sept. 17, 1982; 65 FR 54676, Sept. 8, 2000; 65 FR 57060, Sept. 20, 2000; 66 FR 67096, Dec. 28, 2001; 69 FR 56545, Sept. 21, 2004; 78 FR 62406, Oct. 21, 2013]

SOURCE: 24 FR 10332, Dec. 22, 1959; 60 FR 14518, March 17, 1995; 65 FR 14871, March 20, 2000; 65 FR 33455, May 24, 2000; 65 FR 50103, Aug. 16, 2000; 65 FR 56793, Sept. 20, 2000; 65 FR 70490, Nov. 24, 2000; 80 FR 17952, April 2, 2015, unless otherwise noted.

AUTHORITY: 35 U.S.C. 2(b)(2), unless otherwise noted.

Current through Aug. 20, 2015; 80 FR 50586.

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Subpart B. National Processing Provisions

Time for Reply by Applicant; Abandonment of Application (Refs & Annos)

37 C.F.R. § 1.135

§ 1.135 Abandonment for failure to reply within time period.

Currentness

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

**Credits**

[62 FR 53194, Oct. 10, 1997]

SOURCE: 24 FR 10332, Dec. 22, 1959; 60 FR 14518, March 17, 1995; 65 FR 14871, March 20, 2000; 65 FR 33455, May 24, 2000; 65 FR 50103, Aug. 16, 2000; 65 FR 56793, Sept. 20, 2000; 65 FR 70490, Nov. 24, 2000; 80 FR 17952, April 2, 2015, unless otherwise noted.

AUTHORITY: 35 U.S.C. 2(b)(2), unless otherwise noted.; §§ 1.135 to 1.138 also issued under 35 U.S.C. 133.

Notes of Decisions (21)

Current through Aug. 20, 2015; 80 FR 50586.

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Time for Reply by Applicant; Abandonment of Application (Refs & Annos)

37 C.F.R. § 1.138

§ 1.138 Express abandonment.

Effective: December 18, 2013

Currentness

(a) An application may be expressly abandoned by filing a written declaration of abandonment identifying the application in the United States Patent and Trademark Office. Express abandonment of the application may not be recognized by the Office before the date of issue or publication unless it is actually received by appropriate officials in time to act.

(b) A written declaration of abandonment must be signed by a party authorized under § 1.33(b)(1) or (b)(3) to sign a paper in the application, except as otherwise provided in this paragraph. A registered attorney or agent, not of record, who acts in a representative capacity under the provisions of § 1.34 when filing a continuing application, may expressly abandon the prior application as of the filing date granted to the continuing application.

(c) An applicant seeking to abandon an application to avoid publication of the application (see § 1.211(a)(1)) must submit a declaration of express abandonment by way of a petition under this paragraph including the fee set forth in § 1.17(h) in sufficient time to permit the appropriate officials to recognize the abandonment and remove the application from the publication process. Applicants should expect that the petition will not be granted and the application will be published in regular course unless such declaration of express abandonment and petition are received by the appropriate officials more than four weeks prior to the projected date of publication.

(d) An applicant seeking to abandon an application filed under 35 U.S.C. 111(a) and § 1.53(b) on or after December 8, 2004, to obtain a refund of the search fee and excess claims fee paid in the application, must submit a declaration of express abandonment by way of a petition under this paragraph before an examination has been made of the application. The date indicated on any certificate of mailing or transmission under § 1.8 will not be taken into account in determining whether a petition under § 1.138(d) was filed before an examination has been made of the application. If a request for refund of the search fee and excess claims fee paid in the application is not filed with the declaration of express abandonment under this paragraph or within two months from the date on which the declaration of express abandonment under this paragraph was filed, the Office may retain the entire search fee and excess claims fee paid in the application. This two-month period is not extendable. If a petition and declaration of express abandonment under this paragraph are not filed before an examination has been made of the application, the Office will not refund any part of the search fee and excess claims fee paid in the application except as provided in § 1.26.

**Credits**

[[34 FR 18857](#), Nov. 26, 1969, as amended at [47 FR 47244](#), Oct. 25, 1982; [49 FR 48452](#), Dec. 12, 1984; [65 FR 54674](#), Sept. 8, 2000; [65 FR 57058](#), Sept. 20, 2000; [71 FR 12284](#), March 10, 2006; [78 FR 62406](#), Oct. 21, 2013]

SOURCE: [24 FR 10332](#), Dec. 22, 1959; [60 FR 14518](#), March 17, 1995; [65 FR 14871](#), March 20, 2000; [65 FR 33455](#), May 24, 2000; [65 FR 50103](#), Aug. 16, 2000; [65 FR 56793](#), Sept. 20, 2000; [65 FR 70490](#), Nov. 24, 2000; [80 FR 17952](#), April 2, 2015, unless otherwise noted.

AUTHORITY: [35 U.S.C. 2\(b\)\(2\)](#), unless otherwise noted.; §§ 1.135 to 1.138 also issued under [35 U.S.C. 133](#).

Current through Aug. 20, 2015; 80 FR 50586.

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End of Document

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## **RULE 1.6 CONFIDENTIALITY OF INFORMATION**

(a) A lawyer shall not reveal confidential information relating to representation of a client unless the client consents after consultation, except for disclosures that are impliedly authorized in order to carry out the representation, and except as stated in paragraph (b).

(b) A lawyer may reveal, and to the extent required by Rule 3.3, Rule 4.1(b), or Rule 8.3 must reveal, such information:

(1) to prevent the commission of a criminal or fraudulent act that the lawyer reasonably believes is likely to result in death or substantial bodily harm, or in substantial injury to the financial interests or property of another, or to prevent the wrongful execution or incarceration of another;

(2) to the extent the lawyer reasonably believes necessary to establish a claim or defense on behalf of the lawyer in a controversy between the lawyer and the client, to establish a defense to a criminal charge or civil claim against the lawyer based upon conduct in which the client was involved, or to respond to allegations in any proceeding concerning the lawyer's representation of the client;

(3) to the extent the lawyer reasonably believes necessary to rectify client fraud in which the lawyer's services have been used, subject to Rule 3.3 (e);

(4) when permitted under these rules or required by law or court order.

(c) A lawyer participating in a lawyer assistance program, as hereinafter defined, shall treat the person so assisted as a client for the purposes of this rule. Lawyer assistance means assistance provided to a lawyer, judge, other legal professional, or law student by a lawyer participating in an organized nonprofit effort to provide assistance in the form of (a) counseling as to practice matters (which shall not include counseling a law student in a law school clinical program) or (b) education as to personal health matters, such as the treatment and rehabilitation from a mental, emotional, or psychological disorder, alcoholism, substance abuse, or other addiction, or both. A lawyer named in an order of the Supreme Judicial Court or the Board of Bar Overseers concerning the monitoring or terms of probation of another attorney shall treat that other attorney as a client for the purposes of this rule. Any lawyer participating in a lawyer assistance program may require a person acting under the lawyer's supervision or control to sign a nondisclosure form approved by the Supreme Judicial Court. Nothing in this paragraph (c) shall require a bar association-sponsored ethics advisory committee, the Office of Bar Counsel, or any other governmental

agency advising on questions of professional responsibility to treat persons so assisted as clients for the purpose of this rule.

## **RULE 1.7 CONFLICT OF INTEREST: GENERAL RULE**

(a) A lawyer shall not represent a client if the representation of that client will be directly adverse to another client, unless:

(1) the lawyer reasonably believes the representation will not adversely affect the relationship with the other client; and

(2) each client consents after consultation.

(b) A lawyer shall not represent a client if the representation of that client may be materially limited by the lawyer's responsibilities to another client or to a third person, or by the lawyer's own interests, unless:

(1) the lawyer reasonably believes the representation will not be adversely affected; and

(2) the client consents after consultation. When representation of multiple clients in a single matter is undertaken, the consultation shall include explanation of the implications of the common representation and the advantages and risks involved.

*(Adopted June 9, 1997, effective January 1, 1998. Amended December 9, 1998, effective January 1, 1999. Amended June 30, 1999, effective September 1, 1999.)*

## Comment

### *Loyalty to a Client*

[1] Loyalty is an essential element in the lawyer's relationship to a client. An impermissible conflict of interest may exist before representation is undertaken, in which event the representation should be declined. The lawyer should adopt reasonable procedures, appropriate for the size and type of firm and practice, to determine in both litigation and non-litigation matters the parties and issues involved and to determine whether there are actual or potential conflicts of interest.

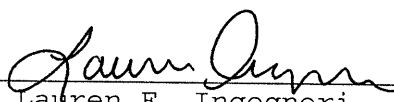
[2] If such a conflict arises after representation has been undertaken, the lawyer should withdraw from the representation. See Rule 1.16. Where more than one client is involved and the lawyer withdraws because a conflict arises after representation, whether the lawyer may continue to represent any of the clients is determined by Rule 1.9. As to whether a client-lawyer relationship exists or, having once been established, is continuing, see Comment to Rule 1.3 and Scope.

[3] As a general proposition, loyalty to a client prohibits undertaking representation directly adverse to that client without that client's consent. Paragraph (a) expresses that general rule. Thus, a lawyer ordinarily may not act as advocate against a person the lawyer represents in some other matter, even if it is wholly unrelated. On the other hand, simultaneous representation in unrelated matters of clients whose interests are only generally adverse, such as competing economic enterprises, does not require consent of the respective clients. Paragraph (a) applies only when the representation of one client would be directly adverse to the other.

[4] Loyalty to a client is also impaired when a lawyer cannot consider, recommend or carry out an appropriate course of action for the client because of the lawyer's other responsibilities or interests. The conflict in effect forecloses alternatives that would otherwise be available to the client. Paragraph (b) addresses such situations. A possible conflict does not itself preclude the representation. The critical questions are the likelihood that a conflict will eventuate and, if it does, whether it will materially interfere with the lawyer's independent professional judgment in considering alternatives or foreclose courses of action that reasonably should be pursued on behalf of the client. Consideration should be given to whether the client wishes to accommodate the other interest involved.

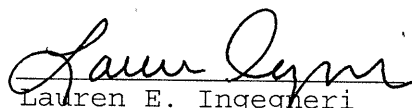
MASS. R. A. P. 16 (k) COMPLIANCE CERTIFICATION

I, Lauren E. Ingegneri, hereby certify that the foregoing Brief of the *Amici Curiae* complies with the rules of court that pertain to the filing of briefs, including but not limited to: Mass. R. A. P. 16(a) (contents of briefs); Mass. R. A. P. 16(e) (references to the record); Mass. R. A. P. 16(f) (reproduction of statutes, rules, regulations); Mass. R. A. P. 16(h) (length of briefs); Mass. R. A. P. 17 (amicus briefs); Mass. R. A. P. 18 (appendix to briefs); and Mass. R. A. P. 20 (form of briefs, appendices, and other papers).

  
Lauren E. Ingegneri  
(BBO# 678880)

CERTIFICATE OF SERVICE

I, Lauren E. Ingegneri, hereby certify that on August 25, 2015, I caused two copies of the foregoing Brief of the *Amici Curiae* to be delivered via first-class U.S. Mail, postage prepaid, to counsel for the parties of record in this case.

  
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(BBO# 678880)

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