

Committee Opinion
April 12, 1993

LEGAL ETHICS OPINION 1520

APPEARANCE OF IMPROPRIETY -
PUBLIC LAWYER: PATENT
ATTORNEY/FORMER PATENT
EXAMINER SERVING AS EXPERT
WITNESS.

You have presented a hypothetical situation in which an attorney, as a supervisory patent examiner in the U.S. Patent and Trademark Office, signed a restriction requirement (after reading it) in an application for a patent prepared by an assistant examiner. No prior art was cited or searched and no rejection was made.

You indicate that the application was then expressly abandoned in favor of a continuation-in-part application with identical claims. The attorney/supervisory patent examiner signed a letter acknowledging the express abandonment. An identical restriction requirement was made in the second application, which the attorney/supervisory patent examiner signed.

Thereafter, the attorney/supervisory patent examiner never handled the application. The patent was eventually issued by the patent examiner after he achieved primary examiner status. As compared to those initially filed, the claims contained in the issued patent were very narrow.

You indicate that twenty years later while in private practice, the attorney/former supervisory patent examiner was retained as a potential expert witness by a defendant in litigation filed by the patentee plaintiff. The attorney's deposition was taken, but the case was settled before trial. You indicate that the attorney's testimony at trial would have related to patentability issues not before the examiner, such as fraud on the Patent Office and public use by the inventor in violation of the patent statute.

You have asked the committee to opine whether, under the facts of the inquiry, the attorney/former supervisory patent examiner had "substantial responsibility" in the "matter" before the patent office, so as to preclude his employment, under DR:9-101(B), as an expert witness for the defendant in litigation.

As you noted, the appropriate and controlling Disciplinary Rule related to your inquiry is DR:9-101(B), which states that a lawyer shall not accept private employment in a matter in which he had substantial responsibility while he was a public employee.

Since the attorney was retained as a potential expert witness, and the attorney-client relationship may not have been created, the committee opines that the Code of Professional Responsibility may be inapplicable to the situation. The Code does not preclude an individual from serving as an expert witness in an action. See LE Op. 1184.

As to the construction of "matter" under DR:9-101(B), the committee has previously opined that the term is broad enough to encompass rule-making See LE Op. 1299. In the facts you provide, the committee opines that a supervisory patent examiner's duties, in

Committee Opinion

April 12, 1993

conducting a review of applications prepared by an assistant examiner, are included within the definition of "matter".

Under the specific facts of your inquiry, however, the committee is of the opinion that the attorney/former supervisory patent examiner's substantial responsibility in the matter of the patent application ended when he signed the restriction requirement in the second application, which contained much broader claims than the patent which was eventually issued by the primary examiner.

Thus, under the facts provided, it is the opinion of the committee that it would not be improper for the attorney to accept employment, as an expert witness, by a private party/defendant regarding patentability issues which had not been before the examiner during his earlier employment, provided that the testimony would not relate to issues on the applications on which the attorney/former supervisory patent examiner had worked and for which he had substantial responsibility.