May a Practitioner Both Act as a Counsel in an Interference and Testify as to His or Her Diligence In Preparing an Application?[1]

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The Rules

Section 10.62 of the PTO Code of Professional Responsibility generally prohibits PTO practitioners from accepting employment by clients in two circumstances: (1) when the practitioner may be called as a witness; and (2) when the practitioner's "professional" and "independent" judgment may be impaired by his or her own self-interests. 37 CFR 10.62 reads as follows:

> **Refusing employment when the interest of the practitioner may impair the practitioner's independent professional judgment.**
>
> (a) Except with the consent of a client after full

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disclosure, a practitioner shall not accept employment if the exercise of the practitioner's professional judgment on behalf of the client will be or reasonably may be affected by the practitioner's own financial, business, property, or personal interest.

(b) A practitioner shall not accept employment in a proceeding before the Office if the practitioner knows or it is obvious that the practitioner or another practitioner in the practitioner's firm ought to sign an affidavit to be filed in the Office or be called as a witness, except that the practitioner may undertake the employment and the practitioner or another practitioner in the practitioner's firm may testify:

(1) If the testimony will relate solely to an uncontested matter.

(2) If the testimony will relate solely to a matter of formality and there is no reason to believe that substantial evidence will be offered in opposition to the testimony.

(3) If the testimony will relate solely to the nature and value of legal services rendered in the case by the practitioner or the practitioner's firm to the client.

(4) As to any matter, if refusal would work a substantial hardship on the client because of the distinctive value of the practitioner or the practitioner's firm as counsel in the particular case.

By its terms, the standard set forth in PTO Rule 10.62 applies at the very beginning of, or just prior to, the commencement of the representation. What happens when there was no reason to believe at the time he or she accepted the representation that the practitioner might need to testify, but later on the practitioner learns that he or she, or someone else in his or her law firm, likely will need to testify on the issue of attorney diligence? This fact pattern is governed by 37 CFR 10.63, which provides as follows:

Withdrawal when the practitioner becomes a witness

(a) If, after undertaking employment in a proceeding in the Office, a practitioner learns or it is obvious that the practitioner or another practitioner in the practitioner's firm ought to sign an affidavit to be filed in the Office or be called as a witness on behalf of a practitioner's client, the practitioner shall withdraw from the conduct of the proceeding and the practitioner's firm, if any, shall not continue representation in the proceeding, except that the practitioner may continue the representation and the practitioner or another practitioner in the practitioner's firm may testify in the circumstances enumerated in paragraphs (1) through (4) of § 10.62(b).

The Practitioner as a Witness on the Issue of Attorney Diligence

Not infrequently, the "attorney diligence" of a practitioner (attorney or agent) becomes an issue in an interference. Less frequently, that practitioner seeks both to serve as counsel in the interference and to testify as to his or her diligence in preparing the application in interference, an ancestor of such an application, or a patent that matured from such an application. Is that practice, in which the attorney is essentially asked to serve in two capacities (as both an advocate and as a material fact witness) ethical? Even if it is not ethical, will the practitioner still be allowed to so testify? And, if he or she does serve in both capacities despite the fact that it may be unethical to do so, what, if anything, are likely to be the consequences?

Under PTO Rules 10.62(b) and 10.63(a), commonly referred to as the "lawyer-witness" rule, none of the exceptions to the general prohibition against counsel serving as both advocate and witness would seem to apply when the subject of interference counsel's testimony concerns the testifying attorney's own diligence.

(1) The existence of attorney diligence is seldom if ever "an uncontested matter."

(2) Attorney diligence is not "a matter of formality."

(3) There is usually "reason to believe that substantial evidence [or, at least, substantial argument] will be offered in opposition to the testimony."

(4) "[T]he testimony will relate … to the nature … of legal services rendered in the case by the practitioner or the practitioner's firm to the client," but it normally will not relate to "the nature and value of [his or her] legal services" (emphasis supplied), except in the *de minimis* sense that the practitioner's billing records are often relied upon

to prove the number of hours that he or she worked on the matter on any given day and, if there is more than one count in the interference or if there are claims in the patent or application in question that have not been designated as corresponding to the count, on what aspect of the application the practitioner was working on any given day. Moreover, how can one say that this testimony relates "solely" to the nature and value of the legal services, as required expressly by Rule 10.62(b)(3)? Doesn't the proposed testimony obviously also relate to the underlying issue for which it is being offered--i.e., to prove attorney diligence?[4]

(5) It would be a rare case indeed in which one could plausibly argue that the practitioner's unavailability to serve as counsel in the interference "would work a substantial hardship on the client because of the distinctive value of the practitioner's or the practitioner's firm in the particular case."

Three additional aspects of the lawyer-witness rules are noteworthy.

First, the fact that the client consents to his or her attorney's serving as both advocate and witness is not relevant – consent is not a factor in either PTO Rules 10.62(b) or 10.63(a).

[4] Interestingly, notwithstanding the language of Rule 10.62(b)(3), the PTO's own comments during the proposed rulemaking that preceded its adoption of that Rule indicated that the PTO believed that this exception to the general rule prohibiting counsel from serving as a witness ordinarily would apply when interference counsel sought to testify on his or her own attorney diligence. This issue is discussed more fully below.

Second, the proscription against a lawyer's serving as both advocate and witness is not limited only to testimony given by the advocate – the rule also applies when another practitioner in the advocate's law firm will likely be called as a witness.

Third, even if interference counsel does not subjectively believe that he or she, or another practitioner in his or her firm, will be called as a witness, such a subjective belief is likely not relevant (and it certainly is not dispositive of the issue). PTO Rules 10.62(b) and 10.63(a) apply an objective standard. Thus, personal beliefs aside, the issue is whether it is "obvious that the practitioner or another practitioner in interference counsel's firm ought to . . . be called as a witness."

Apart from the lawyer-witness rule in PTO Rules 10.62(b) and 10.63(a), PTO Code of Professional Responsibility Rule 10.62(a) defines another, more general, situation in which a practitioner "shall not accept employment" in a matter before the PTO – when the practitioner's professional judgment reasonably may be affected by the practitioner's self-interests, be they financial, business, property, or personal interests. While PTO Rule 10.62(a) does not, on its face, expressly address the situation in which the lawyer serves in a dual capacity as both an advocate and a witness, it is easy to see how the principles of this rule also could apply. All attorneys and agents have an ethical duty to exercise independent, professional judgment. Whether an attorney who is serving as both an advocate in an interference and as a material witness on the issue of attorney diligence (or any other important issue, for that matter) has the ability independently to evaluate himself or herself as a witness, is questionable. His or her judgment may be clouded in a number of different ways.

For example, whether it is a result of pride or professionalism, a practitioner who is considering having himself or herself testify on the issue of diligence presumably believes that he or she would make a compelling witness and that he or she is thereby going to do more harm than good. But is that assessment necessarily accurate?[5] Clearly, if other evidence is available, but the practitioner offers his or her own testimony instead, and if that testimony is heavily discounted or disregarded altogether for the reasons developed subsequently in this article, the practitioner will have done a lot more harm than good.

It would take an exceptional practitioner to see objectively the flaws and limitations in his or her own testimony. Furthermore, because the advocate who serves as a witness has a built-in bias toward his client, as discussed below, the panel may accord little or no weight to the advocate's testimony. How then does counsel's self-serving testimony help the client? Moreover, is it an exercise of good judgment for a practitioner to offer his or her own testimony when he or she reasonably ought to know that, because of apparent bias, his or her testimony may be accorded little or no weight on a potentially very important issue? In any of these circumstances, one can appreciate why the advocate's professional judgment could be impacted adversely by his or her personal or vested financial interests in his or her own testimony.

While the conflict of interest that is defined in PTO Rule 10.62(a) may be waived by the client (unlike the situation covered by the lawyer-witness rules), for the waiver to be effective, the practitioner must provide "full disclosure" to his or her client. As with

[5] We say "presumably" because there are other, less noble reasons which could conceivably impel such consideration. Professional self-preservation springs to mind.

any other waiver, "full disclosure" ordinarily entails providing the client with enough information such that the client's consent to the waiver request is reasonably informed. For some clients, however, there is simply no way that the client can be brought to understand the full extent to which "the exercise of the practitioner's professional judgment on behalf of the client will be or reasonably may be affected by the practitioner's own … personal interests." Moreover, bringing the client to such an understanding may require more candor than the practitioner is able or willing to summon.

How the Board Has Handled the Issue

There have been several cases in which the Board has been faced with the question of whether to allow an advocate in an interference to also testify on the subject of the advocate's diligence in connection with a patent application.

In Wilder v. Snyder, 201 USPQ 927 (PTOBPI 1977), a case that was decided before the PTO promulgated Rules 10.62 and 10.63, a panel of the Board admitted the attorney diligence testimony of Snyder's counsel, reasoning as follows:

> Initially, Wilder et al. have objected to counsel for Snyder testifying as a fact witness …. They contend that Mr. Trexler's appearance as the first witness for Snyder provided him with the opportunity to fill any "gaps" left in his own testimony with the testimony of subsequent witnesses. With respect to this contention, it is pointed out that Mr. Alster [also counsel for Snyder] could have also filled in the "gaps" had he continued taking the testimony

of the subsequent Snyder witnesses. On pages 19 and 20 of the Snyder record, Mr. Trexler has explained his reasons for appearing as a Snyder witness, and under the circumstances of this case we find no reasons not to accord weight to his testimony, although we are guided by the principles set forth as follows at 97 C.J.S. Witnesses § 71, p. 467 (footnotes omitted):

> In the final analysis the question of whether counsel should testify in a case with which he is professionally connected is one of legal ethics resting largely with his own conscience, although a court rule or code of ethics concerning such testimony should be observed by counsel. While a court looks with great disfavor on the giving of testimony by an attorney who participates in the trial in which he is a witness, it is clearly within the discretion of the trial court to permit counsel to testify, and not prejudicial error to allow it. The professional relationship of the witness affects his credibility and not his competency, and irrespective of whether he withdraws as counsel or of the propriety of his testifying, counsel in a cause is a competent witness, and may testify either for or

against his client.

See also Universal Athletic Sales Co. v. American Gym, Rec. & Ath. Equip. Corp., 546 F.2d 530, 192 USPQ 193 (3d. Cir. 1976), cert. denied, 193 USPQ 570 (1977).[6]

The panel did not set forth Mr. Trexler's explanation of "his reasons for appearing as a Snyder witness."

In overruling the objection to Mr. Trexler's appearance as a witness, the panel drew a distinction between ethics and evidence. The panel did not opine on whether it was ethical for Mr. Trexler to "wear two hats" in the interference. Nor did the panel address whether Mr. Trexler's role was consistent with a lawyer's duty to exercise independent professional judgment. The panel in Wilder simply concluded that, ethical issues aside, as a matter of evidence, it was within the Board's discretion to consider Mr. Trexler's testimony and to accord it whatever weight it deemed to be appropriate.

In Wick v. Zindler, 230 USPQ 241 (PTOBPI 1984), which was also decided before the adoption of PTO Rules 10.62 and 10.63, a panel of the Board held that Zindler's counsel's testimony concerning his own diligence was sufficient to corroborate conception because it was "supported … with documentary evidence in the form of calendar entries … and entries in his law firm's log of invention disclosures … ."[7] However, the panel prefaced its holding by saying:

whatever the ethical considerations may be, an attorney is competent to serve as a witness for or against his client.

[6] 201 USPQ at 934.

[7] 230 USPQ at 246.

97 C.J.S. Witnesses Sec. 71, p. 467… [8]

perhaps presaging a referral to the Office of Enrollment and Discipline ("OED").

In Lutzker v. Plet,[9] 7 USPQ2d 1214 (PTOBPAI 1987), aff'd on other grounds, 843 F.2d 1364, 6 USPQ2d 1370 (Fed. Cir. 1987), counsel for Lutzker had prepared the Lutzker application in interference, and his diligence in doing so was very much in issue. Not only that, but he defended his own deposition, using a different voice when he was speaking as a witness and when he was speaking as counsel. (What a comedian!)

Counsel for Plet called Ian Calvert, who was then Vice-Chairman of the Board, and protested vigorously -- citing 37 CFR 10.62. Mr. Calvert thought that the situation was very humorous, but he ruled that counsel for Lutzker was entitled to do what he was doing – citing Wilder v. Snyder.

After final hearing, a panel of the board (consisting of Deputy Commissioner Peterson and EIC Boler, as well as Vice-Chairman Calvert[10]), addressed the issue as follows:

> The activities relied upon by Lutzker are set forth in the declaration of his attorney [John Kurucz] …:
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> ***
>
> Kurucz said he met weekly with Lutzker during August,

[8] 230 USPQ at 246.

[9] Mr. Gholz represented Plet.

[10] The presence of Deputy Commissioner Peterson and Vice-Chairman Calvert on the panel was likely ascribable to the presence of a fraud issue in the case, which issue was unrelated to the issue discussed in this article.

> September, October and November to discuss several drafts of applications. Plet has objected to the testimony of Kurucz on the grounds that he is Lutzker's attorney in this proceeding. It is clear that the position of Kurucz as a purportedly impartial witness is inconsistent with his position as an advocate for Lutzker's cause. Since Kurucz has not supported his testimony with any documentary evidence such as draft applications and/or appointment calendars, we hold that his testimony is insufficient to corroborate reasonably continuous diligence for any portion of the period from March 3, 1980 through Lutzker's November 24, 1980 filing date. Cf. Wick v. Zindler, 230 USPQ 241 (Bd. Pat. Int. 1984).[11, 12]

The PTO's Intent In Adopting Rules 10.62 and 10.63

Even though Wilder and Wick were decided before the PTO had adopted its Code of Professional Responsibility, the PTO's statements concerning the scope and applicability of Rules 10.62 and 10.63 clearly indicate that, in enacting those rules, the

[11] 7 USPQ2d at 1218-1219.

[12] Amazingly, a search for more recent opinions citing either 37 CFR 10.62 or 37 CFR 10.63 yielded only one hit: Little Caesar Enterprises, Inc. v. Domino's Pizza, Inc., 11 USPQ2d 1233, 1234-35 (Comr. Pats. 1989). Not only is that a TTAB case rather than a BPAI case, but it involved an attempt to call an opponent's lawyer as a witness a la the Scopes trial and mentioned 37 CFR 10.63 only in passing.

PTO was not intending to create a mechanism of compulsory disqualification of interference counsel or mandatory striking of interference counsel's testimony whenever interference counsel testified on the issue of attorney diligence. On the contrary, it appears that the PTO's intention was to continue to follow the holding of the Wilder decision, notwithstanding the express language of Rules 10.62 and 10.63.[13]

In fact, on three separate occasions during the rulemaking process that preceded the implementation of Rules 10.62 and 10.63, the PTO specifically addressed the issue of whether those rules necessarily precluded interference counsel from also testifying on the issue of attorney diligence.

First, in the Advance Notice of Proposed Rulemaking concerning the proposed PTO Code of Professional Responsibility, the PTO stated as follows with respect to (what was then) proposed Rules 10.62 and 10.63:

> Sections 10.62 and 10.63 would continue present practice with respect to refusing or continuing employment when the interests of a practitioner may impair his or her independent professional judgment. Under § 10.62(b)(3), a registered practitioner representing an inventor could normally sign and file a Rule 131 . . . affidavit describing his or her attorney diligence. Likewise, the registered practitioner could normally testify in an interference proceeding when his or her attorney diligence is an issue in the

[13] Of course, inconsistencies between the language used in a particular statute and the intent of the legislature as gleaned from the legislative history of that statute are not unknown in other venues.

> interference. The PTO would continue to assess on a case-by-case basis the weight to be given testimony by a registered practitioner who also represents a party in the proceeding in which the registered practitioner gives testimony. See Wilder v. Snyder, 201 USPQ 927, 934 (Bd. Pat. Int. 1979).

49 F.R. 10016, column 3 (March 16, 1984) (emphasis added).

Second, in its Notice of Proposed Rulemaking, the PTO again discussed whether Proposed Rules 10.62 and 10.63 affected the ability of a practitioner to serve as both advocate in an interference and as a fact witness on attorney diligence:

> One comment suggested that proposed § 10.62 should specifically authorize a registered patent practitioner to testify concerning attorney diligence in patent cases. This suggestion is not to be adopted. However, it should be clear that[,] in most cases, the exception of proposed § 10.62(b)(3) would apply.[14] As pointed out in the advance notice, however, the weight to be given testimony by a practitioner on behalf of his or her client would be determined on a case-by-case basis. Wilder v. Snyder, 201 USPQ 927, 934 (Bd. Pat. Int. 1979). The same comment suggested that permission by a client should be made the basis for permitting a practitioner to testify. This suggestion is not being adopted.

[14] The Notice made no attempt to explain why that would be so.

> Virtually all clients would give permission[15] and such permission would obviate the rationale behind the rule.

49 FR 33797, col. 3 (August 24, 1984) (emphasis added).

Third, in its Final Rule, the PTO again addressed the question of whether Rules 10.62 or 10.63 would prohibit interference counsel from also testifying in the interference on the issue of attorney diligence. This time, the PTO (rather tersely) stated that it would not necessarily preclude such a dual role of counsel:

> The comment [concerning §§10.62 and 10.63] went on to suggest that practitioners would not be free to testify concerning attorney diligence in patent interference cases. The PTO has made it plain twice that it disagrees. [Citing Advance Notice and Notice]

50 F.R. 5172 (February 6, 1985) (emphasis added).

Comments

The plain language of PTO Rules 10.62 and 10.63 makes clear that they are compulsory in nature, not merely suggestive. Thus, Rule 10.62(b) mandates that, unless one of four exceptions apply, "a practitioner shall not accept employment" when it appears that the practitioner or a member of his or her firm will be a witness in the proceeding. Likewise, Rule 10.63(a) requires that "a practitioner shall withdraw from the

[15] Exactly. Because virtually all clients would not understand what was at stake--either because they have misplaced confidence in their counsel or because the counsel is unwilling or unable to explain adequately the extreme delicacy of his or her position.

conduct of the proceeding" when it later becomes obvious that the practitioner or a member of his or her firm will be or should be a witness.

Notwithstanding the plain language of Rules 10.62 and 10.63, the PTO has carved out an exception to the letter of the Rules, at least when it comes to whether interference counsel could also be a material fact witness on the disputed issue of attorney diligence. If the PTO had wanted to make an "interference-counsel-testifying on-attorney-diligence" exception to the lawyer-witness Rules 10.62(b) and 10.63(a) (as was explicitly suggested to the PTO during its proposed rulemaking), it could have easily done so. It did not. Not only did the PTO decide not to make that explicit exception, the PTO specifically rejected proposed language to that effect. But then, in the very next breath of its commentary regarding the proposed rulemaking, the PTO stated, without any explanation or analysis, that, "[h]owever, it should be clear that in most cases, the exception of 10.62(b)(3) would apply."

Contrary to what the PTO suggested, however, it is not at all "clear" that, "in most cases, the exception of Rule 10.62(b)(3) would apply." For at least two reasons, the PTO's statement that the exception of Rule 10.62(b)(3) would apply "in most cases" where interference counsel ought to testify on attorney diligence appears to be contrary to the language that the PTO used in the rule itself.

First, PTO Rule 10.62(b)(3) applies only when "the testimony will relate solely to the nature and value of legal services rendered in the case by the practitioner or the practitioner's firm to the client." But when interference counsel is testifying on the issue of attorney diligence, by definition, that testimony is not related solely to the "nature and value" of the legal services, as the exception requires. The testimony is being offered to

prove the advocate-attorney's diligence, or to prove the diligence of another practitioner in the advocate's law firm, either of which is plainly a different issue than simply "the nature and value" of the practitioner's legal services.

Second, the advocate's testimony on diligence is not being offered to prove both the "nature" of, and the "value" of, the practitioner's legal services. While one could generally characterize testimony on attorney diligence as testimony about the "nature" of his or her legal services, the testimony is not really offered to prove the "value" of the practitioner's legal services. For this additional reason, it does not appear that the exception addressed in Rule 10.62(b)(3) should apply when the advocate, or another practitioner in the advocate's law firm, will be testifying about attorney diligence.

In interpreting the exception set forth in PTO Rule 10.62(b)(3), it is instructive to consider how courts interpret Disciplinary Rule ("DR") 5-101(B) of the ABA Model Code of Professional Responsibility (1980) (the "ABA Model Code").[16] DR 5-101(B) prohibits a lawyer from serving as both an advocate and a witness in the same proceeding if the lawyer "knows or it is obvious that he or a lawyer in his firm ought to be called as a witness," unless . . . (2) . . . "the testimony will relate solely to the nature and value of legal services rendered in the case by the lawyer or his firm to the client."[17]

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[16] The PTO stated in its final rulemaking regarding its Code of Professional Responsibility that the "principal source" of PTO Rule 10.62 was DR 5-101 of the ABA Model Code of Professional Responsibility. 50 F.R. 5158 at Table 2.

[17] Likewise, the language of Rule 10.63(a) closely mirrors Disciplinary Rule DR 5-102(A) of the ABA Model Code of Professional Responsibility.

Historically, DR 5-101(B)(2) arose in the context of adversarial matters in which the prevailing party was awarded legal fees. When the merits of the case are over, and assuming that attorneys' fees are awarded, the judge may conduct a hearing or take other evidence to determine the appropriate fee. If the lawyers who tried the case were required to let new counsel handle the attorneys' fees issue, such a rule would result in the possible need for a new trial, and would cause inefficiency and delay. Thus, the exception crafted in DR 5-101(B)(2) was intended to permit the lawyers who worked on the case to testify about the fees earned. See R. Rotunda and J. Dzienkowski, Legal Ethics The Lawyer's Deskbook on Professional Responsibility, American Bar Assoc. Center for Professional Responsibility at § 3.7-1(b), p. 717 (2005).

Given the purpose behind DR 5-101(B)(2), which was adopted, essentially verbatim, in PTO Rule 10.62(b)(3), it seems that PTO Rule 10.62(b)(3) has no application in the context of an advocate in an interference testifying about his or her own attorney diligence. The issue in the interference is not how much were the practitioner's fees, or whether those fees were reasonable. The issue is whether the practitioner or another practitioner in the advocate's firm was diligent in preparing a patent application.

In sum, the language of PTO Rule 10.62(b)(3) itself, and the purpose behind the similarly-worded provisions of DR 5-101(B)(2), appear to be inconsistent with the PTO's statement, during its rulemaking procedure, that Rule 10.62(b)(3) would apply "in most cases" (or, indeed, in any case) to the issue of interference counsel testifying on diligence. To the contrary, it appears that, in most interference cases where attorney diligence is a contested issue and the advocate, or another practitioner in the advocate's

law firm, plans to (or should) testify on this issue, the Rule 10.62(b)(3) exception to the lawyer-witness would never (or, at least, rarely ever) apply.

PTO Rules 10.62 and 10.63 aside, it seems that given the PTO's comments during the rulemaking process, the Board will continue to adhere to the principles set forth in the Wilder opinion when it comes to deciding whether to allow interference counsel or another practitioner in counsel's law firm to testify on the issue of attorney diligence. If the Board continues to follow the principles stated in Wilder, then the issue will be not whether to disqualify interference counsel or not allow counsel to testify, but, rather, whether to give any weight to that testimony.

Thus, even if one could convince the Board that the exception in 10.62(b)(3), or any of the other exceptions to Rule 10.62, does not apply, in the final analysis, it does not appear that such a "victory" would make much of a difference insofar as how the Board conducts the interference. The decision in Wilder grants the Board discretion to admit the advocate's testimony; at the very least, according to Wilder, a panel's admission of such testimony is not in itself prejudicial error. If it continues to follow Wilder (and there is no reason to believe that it will deviate from that decision), the Board will likely permit the advocate to testify, and it will give that testimony whatever weight the panel thinks that the testimony deserves--including, as in Lutzker, no weight at all (at least when the advocate's self-serving testimony is not corroborated, as was the case in Lutzker). Of course, regardless of what the Board itself does when it faces this issue in the future, the

OED presumably could always investigate whether the practitioner's conduct during the interference violated PTO Rules 10.62 or 10.63.[18]

In the authors' views, the procedure that has been followed by the Board in permitting such testimony--leaving the ethical fallout for the OED to decide--appears to be contrary both to the plain language of Rules 10.62 and 10.63 and to the important policy behind those rules. One authority has explained the policy behind the lawyer-witness rule as follows:

> When an advocate persists in acting both as witness and advocate, ordinary procedural safeguards designed to give the parties a full and fair hearing become problematic. For example, the familiar mechanics of question-and-answer interrogation become impossible. The rule excluding witnesses from the courtroom may be invoked, yet the advocate-witness obviously must be allowed to remain. The advocate who testifies places himself in the position of being able to argue his own credibility. . . Our belief is that an adversary system works best when the roles of the judge, of the attorneys, and of the witnesses are clearly defined. Any mixing of those roles inevitably diminishes the effectiveness of the entire

[18]See, e.g., C. Gholz, Criminal and Disciplinary Liability for Fraud on the Patent and Trademark Office, 3 APLAQJ 177 (1975); and J. Sears, Disbarment Procedure of the Office and Fraud, 3 APLAQJ 192 (1975). While neither of these articles is directly on point, if the Board ever does refer the type of conduct addressed herein to the OED, then many of the procedures and considerations discussed in these articles would be applicable.

> system . . . The practice not only raises the appearance of impropriety . . . but also disrupts the normal balance of judicial machinery.

ABA/BNA Lawyer's Manual on Professional Conduct, 61:504 (1998) quoting Cottonwood Estates Inc. v. Paradise Builders, Inc., 624 P.2d 296, 300 (Ariz. Sup. Ct. 1981).

Moreover, an attorney whose diligence has been called into question always has such strong personal and financial interests in the case that his or her "professional judgment on behalf of the client will be or reasonably may be affected." All of us could have done better in every case -- particularly if we had only realized that this one, out of the scores of cases that cross our desks, was going to get into litigation. And where one's own diligence has been called into question, one is essentially being accused of being a slacker. That is not a happy situation for any of us.

Recommendation

The rules should be amended to expressly forbid a practitioner to testify about his or her attorney diligence or the attorney diligence of a practitioner in his or her firm.