

ETHICS ADVISORY PANEL
OPINION #93-76 REQUEST #417
Issued October 5, 1993

A and B hired the inquiring attorney to undertake a patentability/infringement search and to pursue patent protection for an invention of A. The inquiring attorney was advised that B would be responsible for paying all legal fees. A and B instructed the inquiring attorney to prepare an assignment transferring a one-half (1/2) undivided interest in the invention and any resulting patent from A to B. The inquiring attorney prepared the assignment. A and B are now disputing the validity of the assignment and both have retained independent counsel. The inquiring attorney asks: (1.) may he/she communicate information concerning the terms of the assignment to B's attorney; (2.) what documents constitute the clients' file; and (3.) to whom should the inquiring attorney send his/her bills for legal services.

As an initial matter, the Panel notes that in this case the inquiring attorney acted as intermediary in helping A and B pursue patent protection. From the facts presented, it is apparent that A and B are disputing the subject of intermediation and have retained independent counsel. As a result, it is the Panel's opinion that the inquiring attorney must withdraw from the representation pursuant to Rule 2.2. That Rule states as follows:

(a) A lawyer may act as intermediary between clients if;

(1) the lawyer consults with each client concerning the implications of the common representation, including the advantages and risks involved, and the effect on the attorney/client privileges, and obtains each client's consents to the common representation;

(2) the lawyer reasonably believes that the matter can be resolved on terms compatible with the clients' best interests, that each client will be able to make adequately informed decisions in the matter and that there is little risk of material prejudice to the interests of any of the clients if the contemplated resolution is unsuccessful; and

(3) the lawyer reasonably believes that the common representation can be undertaken impartially and without improper effect on other responsibilities the lawyer has to any of the clients.

(c) A lawyer shall withdraw as intermediary if any of the clients so requests, or if any of the conditions stated in paragraph (a) is no longer satisfied. Upon withdrawal, the lawyer shall not continue to represent any of the clients in the matter that was the subject of the intermediation.

With respect to whether the inquiring attorney may communicate information regarding the terms of the assignment to B's attorney, the Panel notes that the Comment to Rule 2.2 provides that as between commonly represented clients, the attorney/client privilege does not attach. The Comment further explains that if litigation eventuates between the clients, the privilege will not protect communications. Accordingly, the Panel concludes that if asked, the inquiring attorney may communicate information concerning the subject of the intermediation to B's attorney.

Rule 1.17(d) addresses the inquiring attorney's second query with respect to what documents constitute the clients' file. The Rule states, in part, that upon withdrawal a lawyer should surrender paper and property to which the client is entitled. This Panel has opined "that the client is entitled to the contents of the file excluding the attorney's work product." See, Opinion #92-88 (Issued March 15, 1993). The Panel does not believe the client is entitled to the lawyer's own personal notes that are unrelated to legal analysis such as time records, notes of conversations with the client and other record keeping documents. Nor does the Panel believe that the inquiring attorney's advisory request must be included in the clients' file. Pursuant to Rule 6 of the Rules of the Ethics Advisory Panel, advisory requests are confidential.

As to the inquiring attorney's third query, the Panel believes that the inquiring attorney should bill the clients for past services in accordance with the terms of the retainer agreement as that was the intent and desire of the parties during the period of the intermediation.