
From: Wissam Aoun <aounwj@udmercy.edu>
Sent: Tuesday, January 1, 2019 11:26 AM
To: CIPO Consultations / OPIC consultations (IC)
Cc: Martel, Denis (IC)
Subject: PATENT RULES - Consultation Submission

Dear Sir/Madam:

My name is Wissam Aoun- I am currently an Associate Professor of Law at Detroit Mercy Law and Director of the International Intellectual Property Clinical Program, jointly run between Windsor Law and Detroit Mercy Law. I am writing as part of the public consultation process regarding the proposed Patent Rules. Specifically, my submission is focused on the proposed Representation provisions of the draft Patent Rules. My apologies that this submission is past the deadline- I hope that you will still receive and consider these comments.

This submission will be general in nature, providing feedback in broad strokes rather than specific, detailed comments on any draft language or providing specific proposed language for consideration.

My submission can be categorized under two general headings- requirements to appoint a patent agent and IP clinical representation. As you will see, these topics overlap in many ways and both fall generally under the issue of representation requirements. I will set out my comments below.

As this is a general submission in the form of feedback and commentary, it has not benefited from a comprehensive peer review, and as such, please forgive any spelling or grammar errors.

Requirements to Appoint an Agent

The proposed Rules maintain the mandatory requirement under the current Rules to appoint a patent agent in circumstances where the application is filed by anyone other than the inventor(s). From a regulatory perspective, there does not seem to be a strong justification for a mandatory agent appointment requirement. Licensing of professionals (including patent agents) is meant to protect unsuspecting third parties from retaining unqualified or unethical practitioners to represent them. It is unclear why this line of reasoning should be extended to entities that choose to represent themselves. There is a strong argument to be made that foreign applicants, as opposed to domestic entities, should be required to appoint a domestic agent, as this creates a legal nexus to Canada and ensures that a domestic agent is available for purposes of legal service and communication. Accordingly, the Rules should stipulate (similar to other jurisdictions) that foreign applicants must appoint a Canadian agent for representation before the Canadian Patent Office. However, there seems to be no strong regulatory justification for obligating domestic entities other than inventors to appoint an agent to represent them before the Canadian Patent Office.

The Patent Office is the representative of the public's interest in the patent system and upholds the public's end of the patent bargain. In my submissions during previous consultations (namely, IP Agent Governance consultation and IP Strategy consultation), I have detailed how the Patent Office's conception of what its public interest mandate entails is rapidly changing along with the Canadian technology and innovation landscape. CIPO's expanded outreach efforts are only one example of this reality, and evidence CIPO's belief that its public interest mandate requires greater connection and responsiveness to the public's needs. However, it is counterintuitive for an institution that is committed to greater responsiveness to limit, by regulation, the public's ability to directly engage with it through mandatory representation requirements. If there are concerns regarding

the complexity of Patent Office administration processes and self-represented individuals, principles of good administrative governance and access to justice would dictate that the Patent Office should explore innovative new institutional arrangements and initiatives to better support such access and reduce complexity.

From a responsive regulatory perspective, requiring such entities to appoint an agent reinforces an intermediary layer between applicants and the Patent Office. Of course, most sophisticated corporate clients will retain experienced agents to represent their interests, and as such, removing this representation requirement may only have an impact in a limited number of cases. However, in circumstances involving key stakeholders in the Canadian innovation economy including universities and small-to-medium enterprises, requiring the appointment of an agent inhibits direct information flow from these groups to CIPO and limits opportunities for direct engagement between CIPO and these key stakeholders. Representation requirements may stifle new modalities of service provision, including innovative new professional service providers enabled by technology-driven platforms. Furthermore, professional fees associated with representation may prevent SMEs from engaging the patent system and prohibit the ability of clinical programs to play a greater role in representing the interests of such groups. Regulation generally should remain focused on the most vulnerable groups, and should be enacted for the benefit of such groups, and accordingly, current representation requirements may run counter to this fundamental regulatory principle if it adversely effects such groups. Given the documented shortage of agents across Canada, challenges surrounding entry to the profession and challenges with mobility, representation requirements may only exacerbate access problems for Canada's most vulnerable groups.

IP Clinical Representation

Consideration should be given to including, within the Patent Rules, specific guidelines for recognized IP Clinical Programs. This would be similar to the guidelines currently in place in the U.S. under the USPTO's Certified Clinical Program. Financial support of IP clinical programs has been budgeted under the Federal government's National IP Strategy. Several Canadian law schools have already built robust IP clinical programs, with others not far behind. The *College of Patent Agents and Trademark Agents Act*, included as part of Bill C-86 (which recently received Royal Assent), includes specific representation exception carve-outs for "legal counsel who [are] providing legal services as authorized by law". As such, there is currently considerable momentum moving towards law school based IP clinical programs, and this is the opportune time for official recognition of such programs through inclusion in the representational provisions of the Rules.

As set out above, the comments provided herein are general in nature. As always, I would be happy to discuss in greater detail and provide support, citations and specifics for any of the information contained herein.

Thank you for your consideration,

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