



Proposed Amendments
to the *Patent Rules* and
to the *Trade-marks Regulations*
- Patent and Trade-mark Agents -

Submission to the
Canadian Intellectual Property Office
by the
Intellectual Property Institute of Canada

October 23, 2009

The Self-governance Committee of the Intellectual Property Institute of Canada (IPIC), with assistance from the IPIC Chair of the Trade-mark Agent Examining Board and from the Patent Agent Examination Revision Committee, has reviewed the Proposed Amendments to the *Patent Rules* and *Trade-marks Regulations: Patent and Trade-mark Agents* (the “Amendments”) and has the following comments approved by IPIC Council.

1.1 Experience required to sit for the patent agent exam

IPIC is pleased to see that the Amendments are similar to the requirements proposed by IPIC in its proposal for self-regulation. IPIC agrees with CIPO that with increased experience, prospective agents will be equipped with a more substantive foundation of the patent system. Furthermore, the additional period of training will assist in preparing candidates before writing the patent agents’ exams and consequently reduce the amount of effort spent by CIPO employees and IPIC members in marking the exams of candidates who were not ready to write the exams.

To that end, IPIC also strongly recommends that the Amendments include a requirement that the person not only work in Canada in the area of Canadian patent law and practice, but that he or she do so under the supervision of a patent agent registered before CIPO. Apprenticeship under the supervision of a registered patent agent is a critical component of the training required to become a patent agent. It is a matter of apprenticing under someone who is qualified and able to train the candidate. In order to protect the public and ensure that the examination process is one used to qualify agents, rather than as a training tool, IPIC proposes that section 12(b) be amended to add the requirement of supervision. Note that in IPIC’s view, a “supervisor” in this context would not necessarily be an employer. For example, someone training within a corporation or a university technology transfer office may be supervised by an external patent agent.

In addition, IPIC suggests that CIPO study, for patent and trade-mark agents, the possibility of recognizing certain experience outside of Canada to reduce the requirement of 24 months of experience in Canada. For example, an agent who is registered as a patent agent in the United Kingdom and moves to Canada could perhaps be asked to work only 12 months in Canada to be eligible to write the exams. Of course, this would depend on the qualifications necessary to become registered in the country of origin (i.e. these exceptions should not become shortcuts to becoming an agent).

1.2 Experience required to sit for the trade-mark agent exam

IPIC takes the same position with respect to the candidates sitting the trade-mark agent exam. While requiring that all individuals must pass the exams is laudable, supervision is similarly required for candidates writing the trade-mark agent exam. Given the proposal that lawyers will now be required to write the exams, it is anticipated that the number of candidates will increase. Again, to ensure that such candidates are properly trained and ready to write the exams, IPIC proposes that section 18(b) add the requirement that the candidate’s practice be “under the supervision of a trade-mark agent registered before CIPO”. While trade-mark law is taught in some law schools, the specific practices of the Trade-marks Office (e.g. opposition proceedings,

section 45 proceedings) typically are not. This is an area where apprenticing under a qualified practitioner will ensure that the candidates are ready to write the exams.

2. Date of the agent qualifying examinations

IPIC is pleased to see that there will now be some flexibility in the timing of the exams. In addition to the flexibility in timing, this change can also allow the study of a possible two-step process with, for example, a preliminary exam to screen candidates before they write the more substantive examination papers. IPIC looks forward to working with CIPO on these ideas.

3.1 and 3.2 Notification as to when the patent agent and trade-mark agent exam will be conducted

IPIC would very much appreciate being involved in the preparation of a practice notice or other instrument to implement the changes to the exams. For example, some of the issues that should be analyzed and jointly considered are:

- What should be the “evidence” required under proposed sections 14(2)(c) of the *Patent Rules* and 20(2)(c) in the case of the *Trade-marks Regulations*?
- Should any of this evidence be provided by the supervisor?
- Should the practice of a signed affidavit continue?
- What should be the proper amount of time between the notice of the exams and the date of the exams?
- Should trainees be asked to register with CIPO at the beginning of their training period?

6. Patent agents register and trade-marks agents list to be publicly available

IPIC supports CIPO’s intention to make information about registered agents and firms available on its website. However, IPIC would appreciate being involved in the determination of the nature of the information that would be available. For example, providing the date of registration can have an influence on the selection of an agent by a client; is this influence appropriate? Another example is that providing the contact information for in-house agents, as is currently the case, has the undesired effect that they receive calls from individuals looking for an agent. Should there be an “opt-out” provision?

7. Removal from the list of trade-mark agents when they fail to pay the renewal fee or they no longer meet the requirements to be entered on the list

IPIC understands that this provision is meant to bring the *Trade-marks Regulations* in line with the *Patent Rules*. It is, however, difficult to understand what is meant to be covered by “they no longer meet the requirements to be entered on the list”.

7.1 Reinstatement on the list of trade-mark agents

IPIC is concerned that the wording of section 23(b) could have the result that a lawyer who mistakenly fails to pay a renewal fee will be unable to be reinstated as he or she will no longer meet the requirements of section 21 if he or she did not write the trade-mark agent exam. We would expect that this is an unintended consequence; however, IPIC strongly recommends that the Amendments be clarified to ensure that this does not happen. It would appear that this could be achieved by providing in section 23(b) that the agent need only have met the requirements applicable at the time the agent was first added to the list of trade-mark agents.

8. Definition of trade-mark agent

IPIC agrees with the change proposed by CIPO.

IPIC understands that, following discussions between IPIC and CIPO on this topic, CIPO has begun studying the possibility that the definition of firm be changed to include corporations that employ a registered agent, both for the patent agent register and for the trade-mark agent list. IPIC remains available to provide assistance in the analysis of this issue.

IPIC is grateful for the opportunity to comment on the proposed changes to the *Patent Rules* and to the *Trade-marks Regulations* and remains available to discuss the above comments and provide further assistance.