



Borden Ladner Gervais LLP
 Lawyers - Patent & Trade-mark Agents
 World Exchange Plaza
 100 Queen Street, Suite 1100
 Ottawa ON K1P 1J9
 tel.: (613) 237-5160 fax: (613) 787-3558
 toll free: (800) 661-4237
 ipinfo@blgcanada.com
 www.blgcanada.com

TO THE ATTENTION OF: Ms. Krista Pearce
COMPANY: Canadian Intellectual Property Office Patent Branch
CITY: Gatineau, QC
FAX NUMBER: (819) 994-1989
DATE / TIME: October 23, 2009
FROM: Mary Jane Lemenchick
DIRECT DIAL: (613) 237-5160
OUR FAX NUMBER: (613) 787-3558

Please see the attached correspondence.

NUMBER OF PAGES INCLUDING THIS PAGE: 7

CONFIRMATION TO FOLLOW: None

TBC No.: 720840

NOTICE: THIS COMMUNICATION IS INTENDED TO BE RECEIVED BY THE INDIVIDUAL OR ENTITY TO WHOM OR TO WHICH IT IS ADDRESSED AND CONTAINS INFORMATION THAT IS PRIVILEGED, CONFIDENTIAL AND SUBJECT TO COPYRIGHT. ANY UNAUTHORIZED USE, COPYING, REVIEW OR DISCLOSURE IS PROHIBITED. PLEASE NOTIFY THE SENDER IMMEDIATELY IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR BY CALLING (COLLECT, IF NECESSARY), SO THAT WE CAN ARRANGE FOR ITS RETURN AT OUR EXPENSE. THANK YOU FOR YOUR CO-OPERATION.

IF THERE IS A PROBLEM WITH TRANSMISSION OR IF ALL PAGES ARE NOT RECEIVED, PLEASE CALL Liz Wells AT (613) 237-5160 ext. 197.

F A X / T É L É C



BORDEN
LADNER
GERVAIS

VIA FACSIMILE

October 23, 2009

Ms. Krista Pearce
Senior Legislation and Patent Policy Analyst
Canadian Intellectual Property Office
Patent Branch
50 Victoria Street,
Place du Portage I
Gatineau, QC K1A 0C9

Dear Ms. Pearce

We write on behalf of our firm in respect of the Proposed Amendments to the Patent Rules and Trade-marks Regulations: Patent and Trade-mark Agents set out in the consultation document published August 25, 2009 and hereinafter referred to as the "Proposed Amendments".

We thank the Commissioner of Patents, Registrar of Trade-marks and Chief Executive Officer and her staff at the Canadian Intellectual Property Office (CIPO) for providing the opportunity make this submission.

Our comments are as follows:

1. Eligibility to sit for the Patent Agent Qualifying Examinations

We offer our encouragement, without reservation, for the proposed increase, from 12 to 24 months, of the level of experience required to sit for the Patent Agent Examination. The proposed increase in experience from 12 to 24 months prior to sitting the Patent Agent Examinations reflects the most realistic minimum time for training made necessary by the complexity of patent law.

We are in agreement with the proposed language amending Section 12 of the Patent Rules, as set out in the Proposed Amendments.

2. Eligibility to sit for the Trade-mark Agent Qualifying Examinations

We agree with the recommendations that persons who have been employed in the Office of the Registrar of Trade-marks on the examining staff or as a delegate of the Registrar's authority under Section 38 or 45 of the Act, and "who have the required experience" be eligible to sit for the Trade-mark Agent Qualifying Examinations provided the reference to "required experience" is a reference to the 24 months of work experience in the area of Canadian trade-mark law currently prescribed in Rule 18(b) of the Regulations which accompany the Trade-marks Act.

Borden Ladner Gervais LLP
Lawyers - Patent & Trade-mark Agents
World Exchange Plaza
100 Queen Street, Suite 1100
Ottawa ON K1P 1J9
tel.: (613) 237-5160 fax: (613) 787-3558
toll free: (800) 661-4237
ipinfo@blgcanada.com
www.blgcanada.com

Mary Jane Lemenchick
direct dial: (613) 787-3547
email: mlemenchick@blgcanada.com

CALGARY • MONTREAL • OTTAWA • TORONTO • VANCOUVER



BORDEN
LADNER
GERVAIS

The further proposed requirement that all individuals, including barristers and solicitors, that seek to have their name entered on the list of trade-mark agents must first pass the trade-mark agent qualifying examinations. This proposal includes making mandatory 24 months of experience for all candidates to sit for the Trade-mark Examinations.

Regarding the proposal that requires all individuals, including barristers and solicitors to successfully write the qualifying examinations prior to being recorded as trade-mark agents, we do not have enough background information to comment at this time but would be open to further consultation once further information is received. However if this proposal is implemented, we believe that there should be a relatively brief phase-in period to allow for those who had already notified CIPO of their intention to sit for the examinations within 12 months or less, to sit the examinations as planned. Given that CIPO has made the Proposed Amendments public by way of publishing them August 25, 2009 it can be said that any prospective candidate is effectively on notice of the proposed change and so any phase-in period should, with due fairness, likely need not exceed 12 months and should be published at the time the Proposed Amendments may be brought into effect.

Finally, the wording of the Proposed Amendments in this respect should grandfather lawyers already on record so that they cannot be removed from the Register of Trade-mark Agents simply on the basis that they did not write the Trade-mark Agent examinations prior to being recorded as Trade-mark Agents.

3. Date of Qualifying Examinations

While we do not disagree in principle with CIPO's suggestion that the Examination Boards be given flexibility in designating dates for holding the respective patent and trade-mark agent examinations, we are concerned that the Proposed Amendment do not required CIPO to give fair warning of the date. For example, as the Proposed Amendment currently reads, CIPO could announce on December 1 of any given year that examinations are to be held in a week of that same month and year.

Further, there is nothing in the Proposed Amendments which would prevent CIPO from holding the patent agent examinations and the trade-mark agent examinations concurrently. Given that, historically, the patent agent and trade-mark agent examinations were held approximately 6 months apart, those engaged in training prospective candidates could organize their resources accordingly. In larger firms, such as ours, it is the norm and not the exception, that more than one person will be studying for either the patent agent or trade-mark agent examinations and those candidates quite often require the attention of the same individuals of work in both disciplines.

We submit, therefore, that any additional flexibility granted to CIPO in respect of setting examinations should not lead to quixotic scheduling or delayed announcements of examination dates, of the overlapping of the patent and trade-mark agent examinations.

Also, the different examinations should not be divided up over the course of a year. That is, currently, there are 4 patent examinations held over 4 successive days and 2 trade-mark examinations held over two successive days. There is nothing in the Proposed Amendments which prevents the examinations from being divided up over the course of a year which, we

Page 3



submit, would lead to undue stress and hardship for those seeking to write the examinations.

There should also be an adequate period of time between the examination date of one year to the next. Currently, the examinations for both patent and trade-mark agents are held almost exactly one year after the previous year. Allowing this maximum period between the examinations on an annual basis is practical in that it allows someone who must rewrite the examinations the maximum study time since writing the year before. It would be all but unmanageable if, for example, the patent agent examinations were held in November of 2010 and then again in January of 2011, instead of November 2011.

Given the above, we would suggest amendments to the Proposed Amendments, as follows:

For the Patent examination, this would be implemented by amending Rule 14 of the Patent Rules, as follows:

14. (1) The Examining Board shall set and administer a qualifying examination for patent agents at least once in each year, with notice of the date of commencement of the examinations given 6 months in advance of the date of the commencement of the examinations, with all examinations in that year to be held on successive days, and the examinations in any given year not being held less than 6 months since the examinations held the previous year.

For the Trade-Mark Agent examination, this change would be implemented by amending section 20 of the Trade-Marks Regulations along the lines of the following:

20. (1) The examining board shall set and administer a qualifying examination for trade-mark agents at least once in each year, with notice of the date of commencement of the examinations given 6 months in advance of the date of the commencement of the examinations, with all examinations in that year to be held on successive days, and the examinations in any given year not being held less than 6 months since the examinations held the previous year.

4. Communications with candidates.

We see no detriment to future examination candidates if the Patent Rules and Trade-Marks Regulations be amended to remove the requirement that the CoP/Registrar notify persons proposing to sit for the qualifying exam of the date of the exam by registered mail. It would largely be the responsibility of the candidate him or herself to ensure the CIPO has current contact information from the candidate.

5. Refund of the Patent Agent Qualifying Examination Fee

We are in agreement with the proposed revision in respect of Rule 4(11) as proposed:

- 4(11)



BORDEN
LADNER
GERVAIS

A fee paid pursuant to subsection 14(2) by a person for the purpose of sitting for a particular qualifying examination for patent agents shall be refunded if after payment the Commissioner notifies the person that they passed a previously administered qualifying examination and, within one month after that notice, the person notifies the Commissioner in writing that they no longer propose to sit for the examination.

6. Names entered on the List of Trade-mark Agents.

We do not disagree in substance with the proposed amendment to Rule 21 of the Trade-marks Regulations, however, the language of the proposed amendment should be clarified to ensure that a trade-mark agent already on record who fails to pay a fee or otherwise undertake a required task in order to renew their presence on the List of Trade-mark Agents is not forced to write the trade-mark examination in order to be relisted. To that end, we suggest adding additional language to the proposed amendment, namely:

21. The Registrar shall, on written request and payment of the fee set out in item 19. of the schedule, enter on the list of trade-mark agents the name of

(a) any resident of Canada who has passed the qualifying examination for trade-mark agents. The requirement of passing the qualifying examination does not apply to the late renewal of a listing of a Trade-mark Agent.

7. Transitional provision.

We agree with the proposed transition provision in the Proposed Amendments to ensure that the name of trade-mark agents entered on the list before the coming into force of the amended Regulations must be maintained and should be added along the line of the following,:

For greater certainty, the name of a resident of Canada that is properly on the list of trade-mark agents immediately before these Regulations come into force shall be maintained on the list if the resident complies with the requirements of paragraph 22(1)(a) even if the requirements of paragraph 21(a) to be entered on the list are not complied with.

8. Patent Rules amended in order to harmonize language with Trade-marks Regulations.

The proposed replacement of the portion of Section 15 of the Patent Rules before paragraph (a) and paragraph 15(a) of the Rules along the line of the following, is acceptable to us:

15. The Commissioner shall, on written request and payment of the fee set out in item 33 of Schedule II, enter on the register of patent agents the name of

(a) any resident of Canada who has passed the qualifying examination for patent agents;



9. Patent Agents Register and Trade-marks Agents list to be publicly available.

We support CIPPO's proposal to publish the names and contact details of agents on the Patent Register or Trade-Marks List

Item 6 of the consultation document published August 25, 2009 states the following:

"Only agents on the Patent Register or Trade-Marks List are entitled to practice before the Patent or Trade-Marks Offices." We submit that this statement should be placed on the list(s) of Patent and Trade-marks Agents published by CIPPO.

10. 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.

We have concern with the portion of the proposed amendment which would import language from the Rules which accompany the Patent Act into the Rules which accompany the Trade-marks Act that appear, under the Patent Rules, to address possible loss of entitlement to practice as an agent for reasons which require disciplinary redress.

For the purposes of clarity, the entirety of the proposed amendment is set out below but our concern specifically addresses the proposed amendment to Rule 22(3)(b).

- 22.(2) The Registrar shall send to every trade-mark agent who fails to comply with subsection (1) a notice requiring compliance within the three-month period after the date of the notice.
- 22.(3) The Registrar shall remove from the list of trade-mark agents the name of any trade-mark agent who
 - (a) fails to comply with a notice sent under subsection (2); or
 - (b) no longer meets the requirements by virtue of which the name of the trade-mark agent was entered on the list.

There is no precedent in respect of the losing status as a Canadian Trade-mark Agent that suggests what causes a Trade-mark Agent to cease to meet requirements by virtue of which the name of the trade-mark agent was originally entered on the List. Without appropriate explanation of such factors, the presence of this Rule leaves Trade-mark Agents with no prior warning of what could cause them to no longer meet prior requirements.

11. Reinstatement on the list of Trade-mark Agents.

We do not disagree with the substance of the proposed amendment to Rule 23 of the Regulations which accompany the Trade-marks Act, however, it is essential that proposed Rule 23(b) be reworded such that it cannot be construed as requiring a person who has previously been of record as a Trade-mark Agent, having regard to the one-year period

Page 6



BORDEN
LADNER
GERVAIS

referred to in Rule 23(a), to write the Trade-mark Agents qualifying examination in order to be relisted.

It is our understanding that the equivalent provision under the Patent Rules is not interpreted as being a means to force a Patent Agent who has neglected to renew his or her recordal on the List to rewrite the Patent Agent examinations.

12. Definition of "trade-mark agent".

We concur in the proposed amendment to the definition in Section 2 of the Trade-marks Act, as set out in the consultation document published August 25, 2009.

In conclusion, we once again thank CIP0 for the opportunity to comment on these proposed Amendments. This has been a collaborative effort by members of our firm. Should you wish to contact me please do so. You may also contact Tracey Mosley (613) 787-3548, Geneviève Bergeron (514) 954-3142 and/or Anne Kinsman (613) 787-3519 as well.

Yours very truly

Borden Ladner Gervais LLP

Mary Jane Lemenchick
Partner, Trade-mark Agent

OTT0138485061