



THE CANADIAN  
BAR ASSOCIATION  
L'ASSOCIATION DU  
BARREAU CANADIEN

## **Consultation sur la Modernisation de la communauté de la PI**

**SECTION NATIONALE DU DROIT DE LA PROPRIÉTÉ INTELLECTUELLE  
ASSOCIATION DU BARREAU CANADIEN**

**Décembre 2014**

## **AVANT-PROPOS**

L'Association du Barreau canadien est une association nationale qui représente 36 000 juristes, dont des avocats, des notaires, des professeurs de droit et des étudiants en droit dans l'ensemble du Canada. Les principaux objectifs de l'Association comprennent l'amélioration du droit et de l'administration de la justice.

Le présent mémoire a été préparé par la Section nationale du droit de la propriété intellectuelle de l'Association du Barreau canadien, avec l'aide de la Direction de la législation et de la réforme du droit du bureau national. Ce mémoire a été examiné par le Comité de la législation et de la réforme du droit et approuvé à titre de déclaration publique de la Section nationale du droit de la propriété intellectuelle de l'Association du Barreau canadien.

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# Rapport sur la Modernisation de la communauté de la PI

## I. INTRODUCTION

Ce mémoire est présenté au nom de la Section du droit de la propriété intellectuelle de l'Association du Barreau canadien (la Section de l'ABC) en réponse à la consultation organisée par l'Office de la propriété intellectuelle du Canada (OPIC) sur la *Modernisation de la communauté de la PI* (le Rapport).

L'Association du Barreau canadien est une association nationale qui représente 36 000 juristes, dont des avocats, des notaires, des professeurs de droit et des étudiants en droit dans l'ensemble du Canada. Les principaux objectifs de l'Association comprennent l'amélioration du droit et de l'administration de la justice. La Section de la PI traite de la législation et de la pratique relatives à toutes formes de propriété, octroi de licences, cession et protection de la propriété intellectuelle et des droits qui s'y rattachent, notamment les brevets, les marques de commerce, le droit d'auteur, les dessins industriels, les certificats d'obtentions végétales de même que les secrets industriels.

Les commentaires exprimés dans le présent mémoire représentent un sommaire des opinions des membres de la Section de l'ABC, y compris ceux de son Comité exécutif, de son Comité sur les brevets, de son Comité sur les marques de commerce et d'autres membres de la Section de l'ABC.

Les commentaires de la Section de l'ABC visent à garantir :

1. une plus grande transparence des renseignements fournis sur les listes des agents,
2. l'adoption d'une approche juste, uniforme, durable et solide pour le processus d'examen des compétences des agents et
3. que les agents qui ne sont pas avocats sont qualifiés pour exercer auprès du bureau des brevets et des marques de commerce, mais ne s'engagent d'aucune autre manière dans l'exercice du droit non autorisé dans le cadre de questions qu'ils n'ont pas compétence pour traiter.

## **II. MODERNIZING THE REGISTER OF PATENT AGENTS AND LIST OF TRADEMARK AGENTS**

The CBA Section supports modernizing the listing of registered patent agents and trademark agents (collectively, the Lists). We agree that a public and comprehensive list of registered patent agents and trademark agents should be published.

In addition to the name, contact information and year of registration of the registered agents, the CBA Section recommends that the Lists indicate whether the registered agent is a qualified lawyer and the jurisdiction(s) in which the lawyer is qualified to practice. The Lists should also link to the lawyer's information page on the applicable law society website (for instance, the Law Society of British Columbia and the Law Society of Upper Canada have specific webpages for each qualified lawyer in those provinces). As an example, the United States Patent and Trademark Office (USPTO) Office of Enrollment and Discipline (OED) database specifies whether an individual is a registered patent attorney (a lawyer who has passed the registration examination) or a registered patent agent (an individual who has passed the registration examination but is not a lawyer).

The rationale for identifying whether a registered patent or trademark agent is also a qualified lawyer relates to the provision of legal advice on intellectual property rights. The only individuals who are trained and licensed to give this legal advice are lawyers. Non-lawyer patent and trademark agents are not licensed. The public would be better served from increased transparency to make an informed decision about whether to retain a non-lawyer patent or trademark agent.

The CBA Section agrees with the recommendation that information about the temporary suspension or permanent removal of an agent should be published as part of the Lists. The CBA Section recommends that the Lists also indicate whether the agent is actively practicing.

For agents who have been temporarily suspended or permanently removed from the Lists, the Lists should link to particulars indicating why the agent has been suspended or removed. For instance, the Law Society of British Columbia website publishes information on disciplinary actions and orders issued by the Benchers. Again, this gives the public greater transparency and confidence.

### **RECOMMENDATIONS**

**The CBA Section recommends that:**

- 1. the Lists should indicate whether the registered agent is a qualified lawyer and the jurisdiction(s) in which the lawyer is qualified to practice.**

2. **the List should also indicate whether an agent is actively practicing.**

### **III. QUALIFICATIONS FOR PATENT AND TRADEMARK AGENTS**

The CBA Section strongly urges CIPO to perform further research and consultation before adopting all the Report's recommended changes. The Report narrowly focuses on refining the current examination methodology, but, as discussed below, this narrow focus is at odds with some of CIPO's stated goals for IP modernization. Instead, the CBA Section suggests that CIPO consider the examination regime as a whole from a principled perspective, looking at examination and licensing regimes for other professionals in Canada and IP agent qualification examination processes in other jurisdictions, before agreeing to refine the current process.

#### **RECOMMENDATIONS**

3. **The CBA Section recommends that CIPO should perform further research and consultation before adopting all of the Report's recommended changes.**

#### **A. Underlying Principles; Other Models**

The CBA Section, as a principle, agrees that the process for qualifying patent and trademark agents, including the examination process, has to be changed, seeing the low pass rate for the patent agent exams. However, we disagree with some points raised by the Report, especially on the patent agent exams. Some portions of the Report on qualifications appear to be at odds with CIPO's goals of reduced gaps and barriers to IP, including addressing speed, complexity, cost and awareness, to provide greater access to users of the IP system in Canada (as described in CIPO's October 20, 2014 presentation to the CBA Section entitled Intellectual Property Modernization). The qualifications for patent agents described in the report are at odds with CIPO's stated goals because they will increase cost, reduce speed and reduce opportunities for awareness by unnecessarily restricting the number of individuals able to act as agents for obtaining registered intellectual property rights, namely patents and trademarks.

The CBA Section urges CIPO to consider models of other jurisdictions as possible alternatives to the Canadian system, which may continue to objectively maintain a high standard for patent agent trainees while reducing gaps and barriers to clients seeking registered protection in Canada.

**RECOMMENDATION**

- 4. The CBA Section recommends that CIPO should consider models of other jurisdictions as possible alternatives to the Canadian system, which may continue to objectively maintain a high standard for patent agent trainees while reducing gaps and barriers to clients seeking registered protection in Canada.**

**B. Concerns with the Report; Suggestions to Improve the Current Model**

If CIPO is to continue with the current model, the CBA Section has several specific recommendations.

The CBA Section disagrees with the statement at Article 3.2.1 of the Report that “there are a large number of candidates who are not prepared for the exams, use the exam as a practice test and, therefore, do not pass.” This statement is made without any supporting data or evidence. By comparison, the US has significantly more candidates writing the registration exams, and the pass rates are significantly higher than that in Canada. Yet it does not appear that the level of patent practice in the US is any less than Canada.

The CBA Section believes many candidates, especially those practicing at law firms, spend an extraordinary amount of time preparing for the patent agent exams and are still unable to pass. Many of these candidates learn and do great work under supervision at a law firm, but still fail the exam after many tries.

We are very surprised at the statement in the Report at Article 3.2 that “much of the present format for the exams was found to be effective and not in need of change”. Given the low pass rate for the patent agent exams every year (especially for first time writers), the CBA Section recommends the actual examination process and marking process be reviewed. For example, there are discrepancies in the published marking guides from year to year. This affects how marks are allocated and whether the marks are fairly and consistently allocated from one year to the next. In some past years, the answer key for marking the patent agent exams contained incorrect answers or answers which were not sufficiently comprehensive. For instance, a candidate may answer a question correctly but get no marks for the answer because the answer wasn’t listed in the answer key.



Even assuming the accuracy of the statement about a large number of candidates being unprepared for the exams, the CBA Section agrees that the introduction of the pre-screening exam would remove many of these candidates from writing the actual papers. The CBA Section supports introducing a pre-screening exam.

To reduce the cost associated with the pre-screening exam, it should be administered online. If it is in multiple choice format, the form and content of the pre-screening exam should be carefully considered, given that multiple choice exams need to be set appropriately. CIPO should work with agencies with experience preparing these exams, and the questions and answers should be vetted by multiple practitioners. For example, CIPO could engage a university or college in Canada to assist with the preparation and administration of the agent exams.

For actual changes to the papers, if a pre-screening exam is introduced, the CBA Section recommends that the papers should be shortened to take into account that some of the same questions would be included in the pre-screening exam.

The appeal process should revert to a system under which the candidate can challenge the scope of the published marking guide. However, to the extent changes are made to the exam processes to reduce ambiguity and unfairness, it may be possible to simplify the appeals process or do away with it altogether.

The CBA Section recommends that CIPO consider the feasibility of writing the agent exams on a computer. Most law schools have adopted typed exam formats with little administrative cost. The law schools may be able to assist with implementing this format for agent exams. The Exam Board can grade typed exams more easily than handwritten ones. In addition, a candidate's exhaustion from handwriting (which the CBA Section believes to be one factor skewing down the exam results) will not be a factor. This recommendation may also have the effect of shortening the time to mark and provide candidates with their results.

The CBA Section recommends that CIPO consider making the entire exam a multiple-choice format, similar to the US. Consideration should be given to subject specific exams (i.e., chemical/biology and mechanical/electrical) as in the European patent office. CIPO may also consider offering Papers B and D (validity and infringement, respectively) in multiple-choice format and Papers A and C (drafting and office action procedure, respectively) in typed exam format.

The CBA Section recommends that a comprehensive syllabus be established for the agent examinations. Currently, other than the Candidate Guide to Writing the Canadian Patent Agent and Trademark Agent Examination (the Candidate Guides), there is a lack of structure for preparing for the agent exams. The Candidate Guide itself only speaks in terms of general topics that would be covered by the agent exams and fails to provide specific information on the material being tested. Beyond exam tutorials held by organizations like IPIC and FICPI, which are costly to participants, no document (other than the Candidate Guides) provides an overview of best practices to approach the exams and to assist candidates in understanding how to write and pass the exams. Law societies provide this kind of guidance to bar admission candidates for bar admission exams and the CBA Section recommends that CIPO adopt a similar approach.

In addition to a pre-screening exam to deter unprepared candidates from sitting the exams, increasing the cost of rewriting may be warranted. The CBA Section generally agrees with this additional deterrent to weed out unprepared candidates. However, a restriction on the number of times a candidate may write the exams may have discriminatory effect and should not be adopted. From a candidate's perspective, the motivation, for writing exams year after year is that, at some point, they may get "lucky", and pass. This is sustained by the perception among candidates that the exams and marking process are arbitrary. If CIPO addresses the perception of arbitrariness of the examinations, fewer candidates will be tempted to write them on the chance they get them right.

On limiting the number of years for carrying-forward a passed exam, the CBA Section does not agree that a candidate would not necessarily keep up with the state of patent law and practice in the intervening period. The proposed CPD requirement for agents could ensure that examinees keep up-to-date on patent and trademark developments. For example, persons wishing to carry forward exams and write in any year could be required to furnish evidence that they have fulfilled CPD requirements to the same extent as registered agents. To prevent an individual from carrying over a passed exam simply because they might not keep up with the state of the law appears to be draconian and can be easily overcome.

Depending on whether the exams are moved to a full or partial multiple choice format, the CBA Section recommends more than one sitting of the exams each year.

The CBA Section also recommends mandatory retesting for agents looking to resume practice after being listed as "non-practicing" for a certain appropriate number of years.

Finally, the CBA Section strongly recommends against including foreign law as subject matter in the agent examinations. Only lawyers are permitted to provide legal advice. The extent of this advice is restricted to the jurisdiction(s) in which they are qualified. On the other hand, Canadian non-lawyer registered patent agents and trademark agents are only permitted to practice in front of the Canadian Patent Office and the Trade-marks Office. While Canadian patent and trademark agents are afforded reciprocity from the USPTO, the reason for an emphasis on foreign practice in the Report is unclear. Canadian non-lawyer patent agents and trademark agents cannot provide advice relating to foreign laws and foreign systems and should be using foreign associates for that work. While the exams should contain questions directed to PCT practice, they should not contain substantive content on foreign law and practice unless there is some direct relationship to Canadian patent practice.

In summary, the portions of the Report on qualification exams put an undue emphasis on the candidate, rather than seeking ways to enhance the current exam structure to ensure a more robust, efficient and consistent approach. A more comprehensive review of the exam process should be undertaken.

## **RECOMMENDATIONS**

**The CBA Section recommends that:**

- 5. the actual examination process and the marking process should be reviewed.**
- 6. papers should be shortened to take into account that some of the same questions would have been included in the pre-screening exam.**
- 7. CIPO should consider the feasibility of allowing the candidates to write the agent exams on a computer.**
- 8. CIPO should consider whether to move the entire exam to a multiple-choice format, similar to that used in the U.S.**
- 9. a comprehensive syllabus be established for the agent examinations.**
- 10. more than one sitting of the exams should be offered each year.**
- 11. there should be mandatory retesting for agents who are looking to resume practice after being listed as "non-practicing" for a certain appropriate number of years.**

**12. foreign law should not be included as subject matter in the agent examinations.**

#### **IV. CONTINUING PROFESSIONAL DEVELOPMENT FOR PATENT AND TRADEMARK AGENTS**

The CBA Section supports a CPD framework for registered patent and trademark agents, including adverse consequences for non-compliance with CPD requirements which may include removal from the register of patent agents and trademark agents.

The CBA Section recommends that CIPO looks to the CPD requirements of Canadian law societies when developing the framework for registered patent and trademark agents. For instance, consideration should be given to:

1. Self-reporting of accredited CPD hours;
2. CPD requirements assessed on an annual basis;
3. Multiple service providers may provide programming to fulfil the CPD requirement;
4. The administrator for CIPO CPD program should have an accreditation process in place to recognize qualified programming;
5. Agents should get notice if they have not fulfilled their CPD requirements by a certain time each year (i.e., six months); and
6. Where an agent fails to complete CPD requirements for a particular year, there should be a grace period to complete additional hours to fulfil their CPD requirements.

A significant concern for the CBA Section is the reference to “trade secret law and topics in contract law, administrative law, and civil procedure related to IP matters” when the Report discusses the substantive topics in the purview of the CPD framework. Non-lawyer patent and trademark agents are not permitted to practice law or provide legal advice. Non-lawyer patent and trademark agents are granted authority by statute to practice in front of the Patent Office and the Trade-marks Office. But they cannot provide legal advice relating to contracts, civil procedure, or administrative law and are not qualified by a Canadian law society to do so. Even if these topics relate to patents and trademarks, they constitute legal issues, and only lawyers can provide advice in these areas. We recommend clarifying this distinction on the scope of practice between agents who are lawyers and those who are not in the context of the CPD requirements.

The Report is not clear on whether registered patent or trademark agent who is also a lawyer would be required to complete CIPO's CPD requirements in addition to those already required by the law society. The CBA Section recommends that registered patent or trademark agents who are also lawyers be able to apply law society CPD credits towards CIPO's CPD accrediting system to avoid unnecessary duplication and expense.

By extension, the CBA Section recommends that additional CPD hours on ethics not be required if the individual has more than one qualification (as lawyer, patent agent or trademark agent). For example, a person who is both a trademark agent and a patent agent should require the same ethics CPD requirements as a person that is only a patent agent. Similarly, CPD relevant to both the practice of law and the practice of agency should apply to individuals holding both designations.

## **RECOMMENDATIONS**

**The CBA Section recommends that:**

- 13. CIPO should look to the CPD requirements implemented by Canadian law societies when developing the framework for registered patent and trademark agents.**
- 14. registered patent or trademark agents who are also lawyers be able to apply law society CPD credits towards CIPO's CPD accrediting system.**
- 15. additional CPD hours on ethics should not be required if the individual has more than one qualification (as lawyer, patent agent or trademark agent).**

## **V. VALUES AND ETHICS FRAMEWORK FOR PATENT AND TRADEMARK AGENTS**

The CBA Section supports implementing a values and ethics framework for registered patent and trademark agents. While lawyers are bound by ethical obligations imposed by their governing law societies, non-lawyer patent and trademark agents are not bound by any code of conduct, and the CBA Section is pleased that this deficiency will be addressed.

While a code of conduct is important, communication of the code of conduct to all agents and its enforcement are imperative to protect the public as users of the IP system.

The Report fails to adequately address the issue of unauthorized practice. The Report discusses the issue of “unauthorized practice” only in the context of an individual who purports to practice without being registered with CIPO. The bigger concern, from the CBA Section’s perspective, is the unauthorized practice of law by non-lawyer patent and trademark agents.

While the unauthorized practice of law generally falls in the scope of governance of the law societies, the CBA Section recommends that the code of conduct include a prohibition against the unauthorized practice of law. The current statutory framework permits registered patent and trademark agents to practice before the Patent Office and Trade-marks Office. Section 15 of the *Patent Act* states “A register of patent agents shall be kept in the Patent Office on which shall be entered the names of all persons and firms entitled to represent applicants in the presentation and prosecution of applications for patents or in other business before the Patent Office.” Section 29(2) of the *Trade-marks Act* states “The list of trade-mark agents shall include the names of all persons and firms entitled to represent applicants in the presentation and prosecution of applications for the registration of a trade-mark or in other business before the Trade-marks Office.” No actual permission, under statute or common law, allows non-lawyer patent and trademark agents to practice beyond what is permitted under the *Patent Act* and *Trade-marks Act*. The CBA Section is of the view that this distinction should be made explicit in a code of conduct for agents.

The CBA Section has, on occasion, received comments from its members that non-lawyer patent and trademark agents purport to provide legal advice and legal services beyond permissible activity granted under statute. For instance, some non-lawyer patent and trademark agents send cease-and-desist letters on behalf of clients when they have no legal qualification to do so. Other non-lawyer patent and trademark agents draft and negotiate intellectual property license agreements and participate in legal due diligence review. While lawyers have not so far reported these activities as unauthorized practices of law to the law societies, this unauthorized practice of law should not be condoned or permitted to continue. It should be addressed and resolved.

With a view of being cooperative rather than adversarial, for the benefit of the public as users of the IP system, the CBA Section recommends that, as part of the code of conduct or statutory amendments, the specific activities that non-lawyer patent and trademark agents are permitted to practice and those they are not should be itemized to give much-needed clarity. For instance, non-lawyer patent and trademark agents may be allowed to record assignment

documents with CIPO but not actually prepare those documents without being supervised by a lawyer (since assignment documents are contractual documents).

The CBA Section recommends that CIPO consider the framework adopted by the USPTO OED on defining the scope of practice in front of the Patent and Trade-mark Offices. Part 11 of Title 37 of the Code of Federal Regulations describes the regulatory framework adopted by the USPTO. 37 C.F.R. 11.5 prescribes the nature of work that registered agents and attorneys are permitted to perform in the US:

§11.5 Register of attorneys and agents in patent matters; practice before the Office.

(a) A register of attorneys and agents is kept in the Office on which are entered the names of all individuals recognized as entitled to represent applicants having prospective or immediate business before the Office in the preparation and prosecution of patent applications. Registration in the Office under the provisions of this part shall entitle the individuals so registered to practice before the Office only in patent matters.

(b) *Practice before the Office.* Practice before the Office includes, but is not limited to, law-related service that comprehends any matter connected with the presentation to the Office or any of its officers or employees relating to a client's rights, privileges, duties, or responsibilities under the laws or regulations administered by the Office for the grant of a patent or registration of a trademark, or for enrollment or disciplinary matters. Such presentations include preparing necessary documents in contemplation of filing the documents with the Office, corresponding and communicating with the Office, and representing a client through documents or at interviews, hearings, and meetings, as well as communicating with and advising a client concerning matters pending or contemplated to be presented before the Office. Nothing in this section proscribes a practitioner from employing or retaining non-practitioner assistants under the supervision of the practitioner to assist the practitioner in matters pending or contemplated to be presented before the Office.

(1) *Practice before the Office in patent matters.* Practice before the Office in patent matters includes, but is not limited to, preparing and prosecuting any patent application, consulting with or giving advice to a client in contemplation of filing a patent application or other document with the Office, drafting the specification or claims of a patent application; drafting an amendment or reply to a communication from the Office that may require written argument to establish the patentability of a claimed invention; drafting a reply to a communication from the Office regarding a patent application; and drafting a communication for a public use, interference, reexamination proceeding, petition, appeal to or any other proceeding before the Patent Trial and Appeal Board, or other proceeding. Registration to practice before the Office in patent cases sanctions the performance of those services which are reasonably necessary and incident to the preparation and prosecution of patent applications or other proceeding before the Office involving a patent application or patent in which the practitioner is authorized to participate. The services include:

(i) Considering the advisability of relying upon alternative forms of protection which may be available under state law, and

(ii) Drafting an assignment or causing an assignment to be executed for the patent owner in contemplation of filing or prosecution of a patent application for the patent owner, where the practitioner represents the patent owner after a patent issues in a proceeding before the Office, and when drafting the assignment the practitioner does no more than replicate the terms of a previously existing oral or written obligation of assignment from one person or party to another person or party.

(2) *Practice before the Office in trademark matters.* Practice before the Office in trademark matters includes, but is not limited to, consulting with or giving advice to a client in contemplation of filing a trademark application or other document with the Office; preparing and prosecuting an application for trademark registration; preparing an amendment which may require written argument to establish the registrability of the mark; and conducting an opposition, cancellation, or concurrent use proceeding; or conducting an appeal to the Trademark Trial and Appeal Board.

Title 11 also specifies that an agent is not permitted to practice law as 37 C.F.R. 11.505 states:

§11.505 Unauthorized practice of law.

A practitioner shall not practice law in a jurisdiction in violation of the regulation of the legal profession in that jurisdiction, or assist another in doing so.

The CBA Section recommends codifying permitted practice in front of the Patent Office and the Trade-marks Office either in the *Patent Act* and *Trade-marks Act*, or at least in the proposed code of conduct. The rationale is protection of the public.

The USPTO's rationale for setting a boundary on what registered agents are permitted to do can be seen in the USPTO's response to comments on revisions to 37 C.F.R. Part 11 in 2008 (published at 73 FR 47650 and enclosed with this letter). On the issue of non-lawyers preparing assignment and license agreements, the USPTO noted:

First, there is no requirement that patent agents be trained in contract law to be registered to practice before the Office in patent cases. Absent adequate training, the client may not receive the legal advice and service the client has every right to expect. The possible temporary "convenience" of having a practitioner inadequately trained in the legal service the practitioner provides does not outweigh the need for competence. A practitioner is prohibited from handling a legal matter which the practitioner knows or should know that the practitioner is not competent to handle, without associating with another practitioner who is competent to handle it. See 37 CFR 10.77(b). Therefore, clients represented by a practitioner would be disserved by that practitioner if the practitioner is not competent to provide advice whether multiple inventors living in different states are subject to the contract laws of all the states or one state, whether the inventors are obligated to assign the invention, whether the inventors should assign as opposed to license the invention absent a legal obligation to assign, and other legal implications of any agreement. Burdens may arise for practitioners and clients when the clients are not competently advised about available legal options, such as licensure or assignment, as well as the benefits, terms and costs of each option. The convenience of having a registered practitioner



provide a legal service for which no training is required for registration does not outweigh the benefits of obtaining competent legal advice and assistance.

On the issue of rendering opinions, the USPTO is clearly of the view that non-lawyer agents could only render opinions in very limited circumstances. The USPTO noted:

The suggestion to define practice before the Office as rendering opinions on validity and infringement for clients has not been adopted. Whether a validity opinion involves practice before the Office depends on the circumstances in which the opinion is sought and furnished. For example, an opinion of the validity of another party's patent when the client is contemplating litigation and not seeking reexamination of the other party's patent could not be reasonably necessary and incident to the preparation and prosecution of patent applications or other proceedings before the Office involving a patent application or patent. In such situations, the opinion may constitute unauthorized practice of law. See *Mahoning Cty. Bar Assn. v. Harpman*, 608 N.E.2d 872 (Ohio Bd.Unauth.Prac. 1993). Similarly, a validity opinion for the sale or purchase of the patent is neither the preparation nor the prosecution of a patent application. Likewise, the opinion is not a proceeding before the Office involving a patent application or patent. Registration to practice before the Office in patent cases does not authorize a person to provide a validity opinion that is not reasonably necessary and incident to representing parties before the Office. In contrast, a validity opinion issued in contemplation of filing a request for reexamination would be in contemplation of a proceeding before the Office involving a patent. Due to registration to practice before the Office in patent cases, a practitioner may issue a validity opinion in contemplation of filing a request for reexamination.

In no circumstance would practice before the Office include the rendering of opinions on infringement. Under the law, the Office has no authority to resolve infringement cases. Thus, registration to practice before the Office in patent cases does not include authority to render infringement opinions. See *Mahoning Cty. Bar Assn. v. Harpman*, *supra*.

In summary, the Canadian system of lawyer and non-lawyer patent agents is similar to the US system of patent attorneys and patent agents. The USPTO commentary provides useful insights on the reasons for clearly defining the type of work registered agents are permitted to do. The CBA Section recommends that CIPO incorporate the USPTO framework into Canadian practice, as part of the code of conduct or through amendments to the legislation.

## **RECOMMENDATIONS**

**The CBA Section recommends that:**

**16. the code of conduct should include a prohibition against the unauthorized practice of law.**

- 17. as part of the code of conduct or statutory amendments, specific activities that non-lawyer patent and trademark agents are permitted to practice and those they are not, should be itemized.**
- 18. permitted practice in front of the Patent Office and the Trade-marks Office should be codified in the Patent Act and the Trade-marks Act, or at least in the proposed code of conduct.**
- 19. CIPO incorporate the USPTO framework into Canadian practice, as part of the code of conduct or through amendments to the legislation.**

## **VI. CONCLUSION**

The CBA Section is pleased to have the opportunity to contribute to this consultation and would like to continue to engage with CIPO in an ongoing dialogue on ways to improve the IP system. We would be pleased to meet to address any questions you may have about this submission.

## **VII. SUMMARY OF RECOMMENDATIONS**

1. The Lists should indicate whether the registered agent is a qualified lawyer and the jurisdiction(s) in which the lawyer is qualified to practice.
2. The List should also indicate whether an agent is actively practicing.
3. The CBA Section recommends that CIPO should perform further research and consultation before adopting all of the Report's recommended changes.
4. The CBA Section recommends that CIPO should consider models of other jurisdictions as possible alternatives to the Canadian system, which may continue to objectively maintain a high standard for patent agent trainees while reducing gaps and barriers to clients seeking registered protection in Canada.
5. The actual examination process and the marking process should be reviewed.
6. Papers should be shortened to take into account that some of the same questions would have been included in the pre-screening exam.
7. CIPO should consider the feasibility of allowing the candidates to write the agent exams on a computer.
8. CIPO should consider whether to move the entire exam to a multiple-choice format, similar to that used in the U.S.
9. A comprehensive syllabus be established for the agent examinations.
10. More than one sitting of the exams should be offered each year.

11. There should be mandatory retesting for agents who are looking to resume practice after being listed as "non-practicing" for a certain appropriate number of years.
12. Foreign law should not be included as subject matter in the agent examinations.
13. CIPO should look to the CPD requirements implemented by Canadian law societies when developing the framework for registered patent and trademark agents.
14. Registered patent or trademark agents who are also lawyers be able to apply law society CPD credits towards CIPO's CPD accrediting system.
15. Additional CPD hours on ethics should not be required if the individual has more than one qualification (as lawyer, patent agent or trademark agent).
16. The code of conduct should include a prohibition against the unauthorized practice of law.
17. As part of the code of conduct or statutory amendments, specific activities that non-lawyer patent and trademark agents are permitted to practice and those they are not, should be itemized.
18. Permitted practice in front of the Patent Office and the Trade-marks Office should be codified in the Patent Act and the Trade-marks Act, or at least in the proposed code of conduct.
19. CIPO incorporate the USPTO framework into Canadian practice, as part of the code of conduct or through amendments to the legislation.