

First name: _____

Last name: _____

Prior Experience Assessment Form

Patent Agent (Technical)

Overview

CPATA recognizes specific competencies as vital for safe, effective, and sustainable practice by IP agents. These competencies are organized into Patent Agent (Technical) competencies and Trademark Agent (Technical) competencies:

A Canadian Patent Agent can:

- A. Demonstrate foundational knowledge
- B. Develop a client-centred patent strategy
- C. Draft a patent application
- D. Prosecute a patent application
- E. Assess validity
- F. Assess infringement

For more information on CPATA's competency initiative and the Technical Competency Profiles for Patent Agents and Trademark Agents, including additional explanatory information on some of the sources, knowledge concepts, and performance criteria, please click [here](#).

Please complete this form and include it with your class 3 agent in training application package. Submissions should be made electronically to registration-inscription@cpata-cabamc.ca. For additional details on supporting documentation, please review the [Prior Experience Assessment Policy](#).

A. Demonstrate foundational knowledge [Knowledge]

Competencies	I have received training and/or education in this competency	Sources (i.e transcript courses, letter of attestation...)	Please indicate if any areas were partially, and not completely, covered
1) Sources Demonstrate familiarity with the following sources:			
a) Primary sources			
<ul style="list-style-type: none"> <i>Patent Act, RSC 1985, c P-4 [Patent Act]</i> 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <i>Patent Rules, SOR/2019-251 [Patent Rules]</i> 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <i>Manual of Patent Office Practice [MOPOP]</i> 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <i>Patent Cooperation Treaty, June 19, 1970, [1990] Can. T.S. No. 22 [PCT] and Regulations SOR/89-453</i> 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <i>PCT Applicant's Guide: The PCT Applicant's Guide (wipo.int)</i> 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <i>Leading Canadian cases and seminal international cases in patent law</i> 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
b) Secondary sources			
<ul style="list-style-type: none"> <i>Paris Convention for the Protection of Industrial Property, as amended September 28, 1979</i> 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <i>Patent Law Treaty (PLT), as adopted by the Diplomatic Conference on June 1, 2000</i> 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <i>Patent Cooperation Treaty (PCT) PCT International Search and Preliminary Examination Guidelines (Guidelines for the Processing by International Searching and Preliminary Examining Authorities of International Applications Under the Patent Cooperation Treaty) as in force July 1, 2022</i> 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <i>PCT Receiving Office Guidelines (wipo.int) (wipo.int)</i> 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <i>CIPO Patent Practice Notices, available online</i> 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <i>United Nations Declaration on the Rights of Indigenous Peoples, Articles 24 and 31</i> 	<input type="checkbox"/> Training <input type="checkbox"/> Education		

c) Professional sources			
<ul style="list-style-type: none"> College of Patent Agents and Trademark Agents Act, SC 2018, c27, s 247 [CPATA Act] 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> College of Patent Agents and Trademark Agents Regulations, SOR/2021-129 [CPATA Regulations] 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> By-laws of the College of Patent Agents and Trademark Agents, SOR/2021-167 [CPATA Bylaws] 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> Code of Professional Conduct for Patent Agents and Trademark Agents [Code of Professional Conduct] 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
2) Knowledge concepts			
Understand the following foundational concepts:			
<ul style="list-style-type: none"> Types of intellectual property protection 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> Scope of the monopoly granted under a patent, i.e., exclusive rights granted to a patentee 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> Patent claims, namely: <ul style="list-style-type: none"> Claim types Claim construction principles 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> Patent requirements, namely: <ul style="list-style-type: none"> Statutory patent subject matter eligibility Anticipation / novelty Obviousness / inventive step Entitlement to priority Utility Double patenting, unity of invention, and divisional applications Patent Act, s. 53 Disclosure and enablement requirements 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> Patent process, namely: <ul style="list-style-type: none"> Inventorship and ownership Claim construction (including Improver criteria) Patent application requirements for Canada and Patent Cooperation Treaty (PCT) practice Key patent office activities and statutory deadlines for Canadian and PCT practice Effect of key patent treaties and international programs Applicable courts and appeal routes 	<input type="checkbox"/> Training <input type="checkbox"/> Education		

• Registration and recording of documents and events affecting title	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Professional responsibilities	<input type="checkbox"/> Training <input type="checkbox"/> Education		

B. Élaborer une stratégie en matière de brevets axée sur le client [Stratégie]

Competencies	I have received training and/or education in this competency	Sources (i.e transcript courses, letter of attestation...)	Please indicate if any areas were partially, and not completely, covered
1) Performance criteria			
• Identify a client's needs and goals	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Assess the innovation context	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Identify, given a set of facts, available types of intellectual property protection	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Plan a patent search	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Interpret search results	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Define the scope and breadth of protection available in view of the prior art	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Outline, given a set of facts, the costs, and benefits of patent protection	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Outline, given a set of facts, practical and strategic timelines	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Plan strategies for protection outside of Canada	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Identify, given a set of facts, limits on patent agent privilege	<input type="checkbox"/> Training <input type="checkbox"/> Education		
2) Knowledge concepts In addition to the foundational knowledge concepts, understand the following:			

• Issues in patentability requirements in different countries (especially in the United States)	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Commercially valuable claims	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Actor analysis	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Detectability of innovation	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Benefits of available protection	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Costs, including patent application and maintenance fees	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Searches, including search result limitations	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Risks of patent protection	<input type="checkbox"/> Training <input type="checkbox"/> Education		

C. Draft a patent application [Drafting]

Competencies	I have received training and/or education in this competency	Sources (i.e transcript courses, letter of attestation...)	Please indicate if any areas were partially, and not completely, covered
1) Performance criteria			
• Identify, given a set of facts, claim drafting objectives	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Draft claims, of multiple claim types, with proper scope, characteristics, and structure	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Describe an invention, including its embodiments and alternatives	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Plan the drawings that illustrate the features of an invention	<input type="checkbox"/> Training <input type="checkbox"/> Education		
2) Knowledge concepts In addition to the foundational knowledge concepts, understand the following:			

• Application of actor and jurisdictional analysis to draft claims	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Cascading claim scope	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Disclosure elements, including title, background, summary, brief description of the drawings, detailed description, and abstracts	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Formal rules of claim drafting	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Mirroring of claim language in disclosure	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Practice for drafting claims of multiple claim types	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• International drafting requirements	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Procedural rules respecting acceptable drawings and labels	<input type="checkbox"/> Training <input type="checkbox"/> Education		

D. Prosecute a patent application [Prosecution]

Competencies	I have received training and/or education in this competency	Sources (i.e transcript courses, letter of attestation...)	Please indicate if any areas were partially, and not completely, covered
1) Performance criteria			
• Analyze a patent family file history	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Assess the citability of prior art for anticipation and obviousness	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Respond to an office action	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Prepare substantive submissions to CIPO other than in response to an office action	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Amend independent or dependent claims, as appropriate	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Manage Canadian prosecution in the context of a global portfolio	<input type="checkbox"/> Training <input type="checkbox"/> Education		

2) Knowledge concepts In addition to the foundational knowledge concepts, understand the following:			
• Abandonment and reinstatement	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Affidavit practice	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Allowance, final fee, and issuance	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Appeals, including Patent Appeal Board	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Authorized representative and common representative	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Best practice in making submissions to CIPO	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Deemed expiry and reversal	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Disclosure of prior art	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Divisional practice	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Due care	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Examiner interview process	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Expediting or advancing examination	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Fee payment requirements, including small entity, claims, and maintenance	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Filing electronically with CIPO and WIPO	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Final action practice	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Patent prosecution process	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Patent Register listing requirements	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• PCT filing and prosecution procedure	<input type="checkbox"/> Training <input type="checkbox"/> Education		

• Post grant prosecution	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Priority	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Protests and filings of prior art prior to grant	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Registration of documents	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Request for examination	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Requirements for CIPO communications	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Requirements to obtain a filing date	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Third party rights	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Transfers and changes of name	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Verification of the administrative status of a patent application or a patent	<input type="checkbox"/> Training <input type="checkbox"/> Education		

E. Assess validity [Validity]

Competencies	I have received training and/or education in this competency	Sources (i.e transcript courses, letter of attestation...)	Please indicate if any areas were partially, and not completely, covered
1) Performance criteria			
• Identify, given a set of facts, validity issues beyond claim validity issues	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Construe claim terms for the purpose of assessing validity	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Assess the citability of a document or disclosure event for anticipation and obviousness	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Assess whether a claim is anticipated, given the prior art	<input type="checkbox"/> Training <input type="checkbox"/> Education		

<ul style="list-style-type: none"> Assess whether a claim is obvious, given the prior art 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> Assess the validity of a claim, for reasons other than anticipation or obviousness 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
2) Knowledge concepts In addition to the foundational knowledge concepts, understand the following:			
<ul style="list-style-type: none"> Claim dates 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> Effect of representations in prosecution or in the petition 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> Proper forums for impeaching a patent 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> Re-examination, disclaimer, and reissue 	<input type="checkbox"/> Training <input type="checkbox"/> Education		

F. Assess Infringement [Infringement]

Competencies	I have received training and/or education in this competency	Sources (i.e transcript courses, letter of attestation...)	Please indicate if any areas were partially, and not completely, covered
1) Performance criteria			
<ul style="list-style-type: none"> Construe claim terms for the purpose of assessing infringement 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> Identify, given a set of facts, potential acts of infringement 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> Analyze a claim to determine infringement 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> Identify, given a set of facts, who can or must assert infringement 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> Assess whether one or more parties are liable for infringement 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> Assess whether a party is liable for inducing infringement 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> Identify, given a set of facts, defenses to an allegation of infringement 	<input type="checkbox"/> Training <input type="checkbox"/> Education		

• Outline potentially available remedies for infringement	<input type="checkbox"/> Training <input type="checkbox"/> Education		
2) Knowledge concepts In addition to the foundational knowledge concepts, understand the following:			
<ul style="list-style-type: none"> Acts of infringement, including: <ul style="list-style-type: none"> Making, using, or selling Importation, Saccharin doctrine Repair or remanufacture Contributory infringement Inducing infringement 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> Exceptions and defenses to infringement, including: <ul style="list-style-type: none"> Experimental use and regulatory use Prior use, Gillette defense Dedication to the public Third-party rights Exhaustion (e.g., licensed supplier) Abuse of patent rights Compulsory licence 	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Proper plaintiff(s), potential defendants, and onus of proof	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Patent term and extension	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Patented medicines regime	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Remedies	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Limitation periods	<input type="checkbox"/> Training <input type="checkbox"/> Education		

Date:

Signature: