

CANADIAN PATENT AGENT QUALIFYING EXAMINATION

GUIDE TO WRITING THE PATENT AGENT EXAM

PAPER A – PATENT DRAFTING

These guidelines describe in a general manner the contents and criteria for the Patent Agent Qualifying Examination - Paper A. Specific content and rating is the responsibility of the Board of Examiners, based on their considered judgement.

The actual contents of the Examination may change without notice and may differ from the contents of this general guidance document.

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1.0 Introduction

The purpose of Paper A (Patent Drafting) of the Patent Agent Qualifying Examination is to measure the basic competencies necessary for a patent agent to draft a patent application for filing in Canada.

Paper A evaluates a candidate's ability to:

- understand a hypothetical invention disclosure by an inventor;
- analyze prior art relevant to the invention;
- identify the point(s) of invention; and
- prepare a patent specification and drawings reflecting the foregoing, including a sufficient description and claims that are patentable over the provided prior art.

2.0 Examination Content

Paper A will always include Part A. It may include an additional Part B.

Part A will consist of a “long answer question” and will evaluate the abilities set out above. The expected answer to Part A is all or part of a patent application (and in particular, all or part of a specification), as required by the instructions accompanying the examination.

Part B, if included, will consist of one or more “short answer questions”. This question may require the candidate to write further claims or other parts of a patent application, or provide written commentary on Canadian law or practice and/or their answer to Part A. The short answer question may put additional hypothetical facts that the candidate must consider when providing their answer.

2.1 Part A

Part A will require the candidate to prepare all or part of a patent application in accordance with a hypothetical scenario involving an inventor's description of an invention and prior art. Generally, this includes a set of claims and a description. It may include other parts of a typical patent application, such as labelled drawings.

The hypothetical scenario and the instructions may be set out in the context of a letter, interview transcript, or invention disclosure form in which a hypothetical inventor describes their invention, and possibly the development of their invention, in their own words. The inventor's narrative will generally include drawings to illustrate the invention, and will likely indicate the technical problem solved by the invention, advantages of the invention, and features that the inventor considers important. The narrative may also describe alternative embodiments.

The hypothetical scenario also includes information about the prior art. The prior art may be provided in separate documents (e.g., sales literature, patents, patent applications) or integrated into the inventor's narrative.

2.1.1 Claims

Based on the hypothetical scenario, the candidate is expected to identify the broadest inventive feature of commercial value and draft a set of claims that covers the invention with the broadest scope possible. All claims should be patentable under Canadian law, and should comply with the *Patent Act* and *Patent Rules*. The candidate should use the identified feature to validly distinguish over the prior art. The candidate should not use an obscure feature that may be inventive but does not appear to have much commercial value according to the hypothetical scenario. Candidates should consider whether all the prior art is applicable because some prior art in the hypothetical scenario may not be citable under Canadian law.

Candidates should not import their own knowledge of the subject matter into their answer. Generally, the subject matter of Paper A is such that there is no need for

specialized knowledge of the relevant technology, and any necessary common general knowledge may be identified in the narrative.

The instructions accompanying Part A will direct the candidate to draft a specific number of independent claims. The instructions may direct the candidate to draft claims of a certain type or category (e.g., apparatus, method, use, kit). If no such instruction is given, or if the choice is left to the candidate, the candidate should choose the type or category that best achieves the inventor's commercial objectives as may be discerned from the hypothetical scenario.

Should the candidate's analysis reveal more than one point of invention that the candidate considers commercially useful and the instructions do not provide guidance on choosing one over the others, the best inventive feature should be selected for the independent claim(s).

Marks for an independent claim may depend, in part, on the commercial value of the subject matter or inventive features selected for the claim. Marks are also generally awarded for including necessary essential elements. Marks are withheld or deducted for subject matter that is anticipated or obvious, unnecessary limitations, and lack of clarity (including antecedent errors).

The instructions will typically direct the candidate to draft a specific number of dependent claims. The selection of limitations for these dependent claims is usually left to the candidate. The candidate should choose relevant features of legal, commercial or strategic value to further define the subject matter of the independent claim. Typically, dependent claims are expected to further distinguish the subject matter of the independent over prior art, or to otherwise further reinforce validity of the claimed subject matter.

Marks for a dependent claim may depend, in part, on the value of the limitations selected for the claim (e.g., the degree to which they further distinguish the claimed subject matter over the prior art). Marks are withheld or deducted for subject matter that is anticipated or obvious, improper dependencies, and lack of clarity (including antecedent errors).

If the instructions specify a certain number of independent or dependent claims, the candidate should restrict themselves to that number and present the best claims possible. Additional claims beyond the number specified in the instructions may not count towards the final mark.

2.1.2 Description

The instructions accompanying Part A will likely direct the candidate to prepare the remainder of the specification, i.e., the description. The candidate should draft a complete description compliant with the *Patent Act* and *Patent Rules*. Note that depending on the examination format, it may not be possible to comply with certain requirements (e.g., page numbering, starting claims on a new page). In the absence of any specific instructions on this point, the candidate should attempt to comply with all relevant laws to the extent that it is technically feasible.

As set out in subsection 56(1) of the *Patent Rules*, a description is expected to include the following elements, in the following manner:

- (a) the title of the invention must be stated in a short and precise manner and must not include a trademark, coined word or personal name;
- (b) the technical field to which the invention relates must be specified;
- (c) the background art that, as far as is known to the applicant, is important for the understanding, searching and examination of the invention must be described;
- (d) a description of the invention must be set out in terms that permit the technical problem and its solution to be understood, even if that problem is not expressly stated;
- (e) the figures in the drawings, if any, must be concisely described;
- (f) at least one mode contemplated by the inventor for carrying out the invention must be set out using examples, if appropriate, and with reference to the drawings, if any; and
- (g) a sequence listing, if required by subsection 58(1), must be included.

The subject matter of Paper A will not involve a sequence listing. As noted in subsection 56(2), the elements listed above may be presented in a different manner or order if it would result in a better understanding or more economical presentation of the invention. However, candidates should note that an unconventional ordering of the elements of the description may cause a lack of clarity that could result in mark deductions.

The elements of subsection 56(1) should be applied in accordance with the conventional rules of legal interpretation and Canadian patent practice. For example, candidates should not assume that a proper background of the invention in accordance with paragraph 56(1)(c) should always include a recitation of the prior art documents identified by the inventor. An informative background should provide a brief explanation of the prior art or state of the art to frame the technical problem addressed by the invention so that the reader has a starting point for understanding the purpose of the invention and searching for relevant prior art. As another example, paragraph 56(1)(d) requires that the description explain the invention in a manner that permits the problem solved by the invention, and solution provided by the invention, to be understood. It is often assumed that this is met by providing a set of consistory clauses as a “summary” of the invention. In fact, consistory clauses by themselves may not provide enough information to the reader to appreciate the technical problem that is solved. This requirement is better met by a paragraph that summarizes the purpose and/or result of the invention and its salient features rather than simply copying the claim language. While consistory clauses are considered by many to be a best practice in patent drafting, they are not actually a legal requirement. Therefore, consistory clauses are not required for full marks on Paper A.

In preparing the description, candidates will rely on the inventor’s understanding of the technology to prepare a sufficient disclosure in accordance with subsection 27(3) of the *Patent Act*. However, the inventor is unlikely to have provided language, structure, or organization appropriate for a patent application. Therefore, full marks will not be awarded for the description if the candidate merely copies the inventor’s words. Historically, lower marks have been awarded for exclusively cutting and pasting portions from the examination itself.

Alternative embodiments identified by the inventor should also be discussed in the description.

2.1.3 Drawings

Part A may include a set of drawings that the candidate is expected to label in accordance with subsection 27(5.2) of the *Patent Act*, consistent with section 59 of the *Patent Rules* (although the candidate will have no control over the quality of the drawings).

Depending on the capabilities of the examination platform, the drawings may already be marked with lead lines. The instructions will indicate whether the candidate may choose to ignore lead lines to parts that the candidate does not wish to label, and/or entire figures.

Also depending on the capabilities of the examination platform, the drawings may already be labelled with reference numerals, in which case the candidate will be expected to conform to that numbering in their description.

2.1.4 Other parts of the patent application

The instructions may require preparation of other parts of a patent application (e.g., abstract, petition, information and statement required by section 54 of the *Patent Rules*).

2.2 Part B

Part B, if included, will contain very few questions (typically, only one question) relating to a specific claim drafting issue or hypothetical scenario. The question may rely on the same hypothetical scenario as Part A, or may provide additional or alternative hypothetical facts.

For example, Part B may require the candidate to draft further claims to address a particular commercial issue, or newly discovered prior art. It may require the candidate to prepare other parts of a patent application that were not required in Part A. It may

require the candidate to explain a drafting strategy, or provide written commentary on Canadian law or practice.

If Part B requires the preparation of further claims, the same considerations about selecting the best inventive features and limitations discussed above apply, subject to any specific instructions provided in Part B.

3.0 Mark Distribution

If only Part A is included, then it represents 100% of the overall grade in Paper A.

If Part B is included, then Part A and Part B together represent 100% of the overall grade. Marks are generally allocated between Parts A and B proportionally to the relative time required to answer each part. Part B is typically worth only a small amount of the overall grade.

Marks in Part A are allocated between the claims, description, and any other required parts of the patent application. Historically, more than half of the marks of Part A are allocated to the claims, with the first independent claim being allocated at least 30% of the overall grade.

4.0 Examination Rules

The link to access the examination will be sent to you via e-mail at the date and time specified in the Admission e-mail. Unless you specify an alternate e-mail address, the exam will be sent electronically to the e-mail address provided on your Class 3 Licence Agent Application Form.

It is your responsibility to ensure that your environment is adequate for testing (see below). The exam will be provided in both official languages. The exam will be administered in the official language as selected by you on the exam registration form.

You are responsible for managing your time accordingly when answering the questions. Any time missed due to late start will be deducted from the total examination time.

As this is an individual exam, you are strictly forbidden from consulting any other individuals. It is strongly recommended that you isolate yourself to complete your exam. **Your exam will be remotely proctored by a live proctor through the MonitorEDU exam platform (see below).**

The **only resources allowed** while completing the written exam are:

- the [Patent Act](#);
- the [Patent Rules](#); and
- a hardcopy dictionary (English, French, English/French).

You are NOT allowed to consult any other resource. A secure browser will prevent you from accessing other resources on your computer.

All information and data disclosed to you by the College of Patent Agents and Trademark Agents in this written examination shall be treated as confidential and shall not be disclosed or made known to any other person or entity. All written or recorded materials provided to you or prepared by you pursuant to this written examination are deemed the property of the College of Patent Agents and Trademark Agents of Canada.

Logistics

The 2021 Patent Agent Qualifying Examination will be electronically administered and remotely proctored by MonitorEDU/Paradigm Testing. Please review the following information to ensure that your computer systems meet the requirements. Additional detailed information regarding the protocol for logging in will be provided to exam candidates closer to the exam dates. Exam candidates will also be able to login prior to the exam and practise with a few previous exam questions to become familiar with the system.

To become familiar with the process please watch this video below:

<https://youtu.be/cInMjEaH1q0>

To test your equipment and to see frequently asked questions please visit:

<https://monitoredu.com/faq>

A few additional notes:

For your exam we recommend you use the internet browser Google Chrome for the best experience. If your computer does not already have this browser, you may download it here: <https://www.google.com/chrome/>

Please make sure you have disabled all popup blockers.

Chrome Mac

- 1) Click on the 3 Dots in the Upper-Right Hand Corner
- 2) Click on "Settings" on the dropdown menu
- 3) Click on "Privacy and security" on the left side menu
- 4) Click on "Site Settings" in the center menu
- 5) Click on "Pop-ups and redirects" in the center menu (May need to scroll)
- 6) Ensure the first radial button is selected "Sites can send pop-ups and redirects"
- 7) Click on "Add"
- 8) Copy this URL: <https://paradigmtesting.excelindia.com/> and paste it into the box

Chrome PC

- 1) Click on the 3 Dots in the Upper-Right Hand Corner
- 2) Click on "Settings" on the dropdown menu
- 3) Click on "Privacy and security" on the left side menu
- 4) Click on "Site Settings" in the center menu
- 5) Click on "Pop-ups and redirects" in the center menu (May need to scroll)
- 6) Ensure the first radial button is selected "Sites can send pop-ups and redirects"

If you are testing on a Mac computer, please have the most up to date OS operating system on your device. We require High Sierra 10.13 or higher for your exam.

If you have tested with them before please delete and reinstall the newest version of the secure browser:

<https://clients.paradigmtesting.com/remote-proctoring-files/>

Before connecting with your proctor please make sure the following programs are not running in the background on your computer.

- 1) Skype
- 2) Microsoft Teams
- 3) Slack
- 4) GoToMeeting
- 5) Zoom Meeting
- 6) Cisco Webex
- 7) Team Viewer

Appendix A – Competencies tested in Paper A

The following table sets out a list of competencies that may be tested in Paper A. This list is provided only as a guide, and is not exhaustive.

ISSUES	COMPETENCIES ADDRESSED (EXPECTED RESPONSES)
Clarity and consistency	<p>Consistent use of terminology and reference numbers.</p> <p>All parts of specification consistently directed to the same point(s) of invention.</p> <p>Candidate must respect the different points of invention identified in Part A (where applicable).</p> <p>Text matter entirely in English or French in accordance with section 46 of the <i>Patent Rules</i>.</p> <p>Description presented in order compliant with section 56 of the <i>Patent Rules</i>; any deviation from this order must still be clear and acceptable in conventional Canadian practice.</p>
Title	Short and precise, while being descriptive rather than broad, as required by paragraph 56(1)(a) of the <i>Patent Rules</i> .
Technical Field	Brief identification of technical field to which the invention relates as required by paragraph 56(1)(b) of the <i>Patent Rules</i> , consistent with the remainder of the specification without being unduly limiting.
Background of the invention	Proper identification of relevant background art (e.g., prior art, state of the art, background knowledge) relevant to the invention that is important to understand the invention and to define a search strategy for examining the invention, in accordance with paragraph 56(1)(c) of the <i>Patent Rules</i> . Must be consistent with invention identified in remainder of specification, and must not be misleading (e.g., misdirect the reader to a less relevant field of technology).
Expression of the technical problem and its solution (the “summary” of the invention)	<p>Clear and succinct presentation of the invention and its purpose to permit the reader to understand the purpose of the detailed description. In accordance with paragraph 56(1)(d) of the <i>Patent Rules</i>, does not have to expressly state a technical problem as long as the skilled reader can understand the technical problem solved by the invention.</p> <p>This is likely not met by merely reciting consistory clauses (claim language).</p>
Brief description of the Drawings	Concise (brief, but useful) description of each figure in the drawings in accordance with paragraph 56(1)(e) of the <i>Patent Rules</i> .
Description of preferred Embodiments	Sufficient and accurate description of invention, operation and use as contemplated by inventor in accordance with paragraph 27(3)(a) of the <i>Patent Act</i> and paragraph 56(1)(f) of the <i>Patent Rules</i> .

ISSUES	COMPETENCIES ADDRESSED (EXPECTED RESPONSES)
	<p>Clear identification of steps in any method or process, constructing and operation of a machine, etc. to enable person skilled in the art to make, construct or use it in accordance with paragraph 27(3)(b) of the <i>Patent Act</i>.</p> <p>Explanation of principle of a machine and inventor's best mode of applying that principle in accordance with paragraph 27(3)(c) of the <i>Patent Act</i>.</p> <p>Identification of necessary sequence of steps in a process to distinguish it from other inventions, as necessary in accordance with paragraph 27(3)(d) of the <i>Patent Act</i>.</p> <p>Compliance with <i>Patent Act</i> and <i>Patent Rules</i> concerning description, reference numerals, reference to drawings.</p> <p>Inclusion of variants identified by the inventor.</p> <p>Overall clarity and organization.</p> <p>Consistency with claimed invention terminology.</p> <p>Adequate support for claimed invention in accordance with section 60 of the <i>Patent Rules</i>.</p> <p>Appropriate use of terminology that does not create inappropriate limitations.</p>
Drawings	Appropriate labelling of and reference to drawings consistent with the <i>Patent Act</i> and <i>Patent Rules</i> .
Independent claims	<p>Proper scope, as broad as possible while distinguishing over the prior art with a commercially relevant significant inventive feature.</p> <p>Encompass variants, where applicable.</p> <p>Appropriate selection of type or category (e.g., apparatus, method, kit, use, etc.), when applicable.</p> <p>Clear and unambiguous wording.</p> <p>Sufficient essential elements to comply with requirements of utility, patentable subject matter, novelty, non-obviousness.</p> <p>Sufficient cooperation between elements; not merely aggregation of elements with insufficient interaction.</p> <p>Balance between structural and functional claiming approaches.</p> <p>No inappropriate reliance on desired result or function.</p> <p>Process or method steps distinctly and clearly recited in appropriate order, when necessary.</p> <p>No unnecessary structural or functional limitations.</p> <p>Proper use of words of approximation or tolerance (e.g. substantially, approximately, about, etc.)</p> <p>Logical organization, proper antecedents, consistency in terminology.</p>
Dependent claims	<p>Appropriate selection of limitations that provide narrowing protection, further distinguishing claimed subject matter over prior art.</p> <p>Appropriate selection of limitations with commercial or strategic relevance.</p>

ISSUES	COMPETENCIES ADDRESSED (EXPECTED RESPONSES)
	Proper antecedent references, proper dependencies in accordance with section 63 of the <i>Patent Act</i> . Logical organization, clear and unambiguous wording, consistency in terminology.