

College of Patent Agents and Trademark Agents

Registration Committee

Applicant: [REDACTED] (herein “the Applicant”)

Panel Members: Tina McKay (Chair), Mark Pioro (Vice-Chair), Hilary Rose, Jeffrey Orser, Martin Béliveau

Hearing Date: May 30, 2022

Decision of Panel

The decision

1. The Panel conducted a written hearing in accordance with section 6(c) of the By-laws of the College of Patent Agents and Trademark Agents (College) (the “By-Laws”)¹ and determined that the decision(s) of the Registrar² was reasonable and that: (1) the CPATA rules apply to the Applicant’s application; (2) the Applicant’s self-taught training does not satisfy the twenty-four month training requirement and therefore the Applicant is not eligible for the Trademark Agent and Patent Agent Qualifying Examinations (QE); and (3) it is not in the public interest to waive the twenty-four month training under supervision requirement for Applicants wishing to write the QE.

Background

2. On or around August 9, 2021, the Applicant submitted an application to the College to write the QE.
3. The Applicant submitted that:

¹ SOR/2021-167.

² September 25, 2021 Registrar’s Decision and October 5, 2021 Revised Registrar’s Decision.

- a. The *Patent Rules*³ applied to his application because he began his training approximately three years ago, in 2018; and
 - b. He met the twenty-four month training requirement as a result of his self-directed training.
4. The College advised the Applicant on August 27, 2021, prior to making its decision, that self-directed training was not accepted toward the 24-month training requirement.
5. The Applicant responded that his training spanned from mid-2018 to mid-2020 and took the position that his self-directed training would have qualified him to write the QE under the former *Patent Rules*.

The Proceedings

6. In the September 25, 2021 Registrar's Decision on the application, the Registrar held that

Because the Applicant's experience has not involved working under the supervision of a licenced patent or trademark agent or within CIPO, or as a licensed patent or trademark agent in another jurisdiction, the College does not accept the Applicant has demonstrated that prior experience provided him with the competencies required to prepare, present and prosecute patent or trademark applications before the Canadian Intellectual Property Office. Further, the described experience is not equivalent to what a trainee would receive working under supervision and in accordance with an approved training agreement. For that reason, no credit towards the required training period is being allowed.

7. The Applicant wrote in response to the September 25, 2021 decision that the Registrar had erroneously considered his application under the current regulatory regime, when the previous regime (the *Patent Rules*) should apply.
8. On October 5, 2021 the Registrar issued the Revised Registrar's Decision, which contemplated the previous *Patent Rules*⁴, cited by the Applicant:

³ *Patent Rules* (SOR/2019-251), Repealed, SOR/2021-131, s. 19, effective June 27, 2021.

⁴ *Patent Rules* (SOR/2019-251), Repealed, SOR/2021-131, s. 19.

19(a)(ii) has worked in Canada in Canadian patent law and practice, **including the preparation and prosecution of applications for a patent**, for at least 24 months, or (iii) has worked in patent law and practice, **including the preparation and prosecution of applications for a patent**, for at least 24 months, at least 12 of which were worked in Canada and the rest of which were worked in another country where the person was authorized to act as a patent agent under the law of that country [emphasis in original].

9. The Registrar wrote that the Applicant did not submit evidence that he “employed a licensed agent to assist with the presentation and prosecution of applications during his self-directed training period” and therefore, “the Applicant’s self-directed training would not have qualified the Applicant to write the [QE when they were administered by CIPO in accordance with the *Patent Rules*].”
10. The Registrar wrote that “the College does not recognize self-taught training to satisfy the 24-month training requirement of sections 9(f) and 12(f) of the College Bylaws” and held that “Twenty-four months’ training are to be completed under the supervision of an approved Training Supervisor to establish eligibility for the [QE].”
11. The Registrar stated in the Revised Registrar’s Decision that in order

[t]o protect the public, the College must ensure licensees are appropriately trained, which includes ensuring there is an objective oversight mechanism within the training program, and that the overseer has proven themselves by meeting the registration requirements. If a person is self-training, there is no real oversight and no confidence that what they were doing was in compliance with the processes and procedures. Therefore, individuals must obtain training experience from a registered agent or a representative from the Canadian Intellectual Property Office (CIPO), to obtain the entry-to-practice competencies required to practise the professions ethically and competently.
12. On November 18, 2021, the Applicant submitted a Request for Review of the Registrar’s decision(s).
13. The Registration Committee met on November 26, 2021 and on January 25, 2022 to consider the Applicant’s request for review and determined that, pursuant to its

authority under 6(a) of the By-Laws,⁵ it would request more information from the Registrar, namely for the Registrar to confirm whether the Applicant applied in 2019 to write the 2020 QE.

14. On January 27, 2022, the Registration Committee informed the Applicant of its request for the Registrar to confirm whether the Applicant applied in 2019 to write the 2020 QE.
15. The Applicant wrote on January 28, 2022 to advise that he did not apply in 2019 to write the 2020 examinations.
16. The Registrar confirmed by way of memo dated January 31, 2022 that there is no record that the Applicant submitted an application in 2019 to attempt the 2020 qualifying examinations.
17. On February 8, 2022 the Applicant was issued a Notice of Hearing from the Registration Committee pursuant to the Committee's authority under s. 6(c) of the By-Laws⁶ to conduct a hearing and make a decision with reasons. The Applicant was invited to make written submissions for the Panel to consider.

The Applicant's submissions

Which rules apply to the Applicant's application?

18. The Applicant maintained in his submissions that the "old" Patent rules apply and submitted that he meets the requirements under section

19 (a) (ii) because [he has] worked in Canada in the area of Canadian patent law and practice, including the preparation and prosecution of applications for a patent, for at least 24 months.
19. The Applicant submitted that the old rules do not require him to hire a licensed agent to assist with the presentation and prosecution of patents and do not require that the training be completed under a licensed agent.

⁵ By-laws of the College of Patent Agents and Trademark Agents (College), SOR/2021-167, s. 6.

⁶ By-laws of the College of Patent Agents and Trademark Agents (College), SOR/2021-167, s. 6(c).

20. The Applicant submitted that the Registrar erred in using “the new CPATA by-laws that only came into force in June 2021 when my 24-month training period was completed one year ago.”
21. The Applicant submitted that the Registrar’s decision of September 25, 2021 did not address his issues, nor did it mention the old *Patent Rules* “or at least provide an explanation of why the old Rules were not relevant.”
22. The Applicant submitted that the Revised Registrar’s decision of October 5, 2021 “seemingly tried to acknowledge the old Patent Rules section 19(a) in item 15 of the Registrar’s Decision but continued to not explain directly why [the Applicant] did not meet the requirements.”

Does self-directed training satisfy the 24-month training requirement?

23. The Applicant submitted that he does, in fact, meet the 24-month training requirement:

Also, if my work in the preparation and prosecution of applications for a patent was NOT in compliance with the processes and procedures of the patent office, then how could I complete the tasks and get the patents and trademarks granted for my customers? The answer is obvious: if I did not know the processes, I had to learn. And I have been trained for 16 (part-time) + 3 (full-time) years now. This is exactly the purpose of the 24-month training requirement.

24. The Applicant submitted that the use of the word “opinion” in the passage below, excerpted from the Revised Registrar’s decision, demonstrates that the decision was based on “personal opinion”, rather than law:

The Applicant submitted no evidence to support that he employed a licensed agent to assist with the presentation and prosecution of applications during his self-directed training period. Therefore, under the 2018 rules, in the College’s opinion, the Applicant’s self-directed training would not have qualified the Applicant to write the CIPO administered exams [emphasis added].

25. The Applicant also submitted that the Registrar did not clearly explain why it made the decision it made and that, in order for the decision to be reasonable, it must “NOT be their own opinions.”

Is it in the public interest to waive the 24-month training requirement?

26. The Applicant submitted that if the only issue with his application for the QE is the 24-month training requirement, he asks that the Panel waive the 24-month training requirement for his application.

The Registrar’s submissions

Which rules apply to the Applicant’s application?

27. The Registrar submitted that:

- a. the Applicant is incorrect in his view that the current CPATA requirements for the QE do not apply; and
- b. even if the revoked requirements applied, the Applicant would not meet those requirements.

28. The Registrar submitted that CPATA came into force on June 28, 2021 and

[a]s of that date, CPATA became responsible for maintaining the registers of patent agents and trademark agents, administering patent and trademark agent qualifying examinations, collecting associated College fees, and maintaining an agent code of conduct.

29. The Registrar submitted that the revoked *Patent Rules*⁷ were not in effect when the Applicant applied to sit the QE in August of 2021.

30. The Registrar submitted that applying the revoked rules to the Applicant’s application to write the QE “would not be in the public interest and would run contrary to Parliament’s intent.”

⁷ SOR/2019-251, SOR/2021-131, s. 19 – repealed.

Does self-directed training satisfy the 24-month training requirement?

31. The Registrar submitted that the current CPATA rules require that Applicants enter into a training agreement with a supervisor.

32. The Registrar wrote that the requirements

clearly impl[y] that a requisite level of character is required to discharge [the] important role [of supervisor]. In addition to substantive skills, CPATA requires supervisors to model the necessary integrity and ethics to applicants so they can learn and be mindful of their responsibilities as licensees.

33. The Registrar further submitted that the Applicant's self-directed training "does not meet the criteria set out in s. 19(a) of the *Patent Rules*."

34. The Registrar submitted that s. 19(a)(ii) of the *Patent Rules* intended that Applicants would have been trained in a way that had "structure" and could be "verified" and that a self-directed training does not align with that intent.

35. The Registrar submitted that s. 19(a)(ii) required that the Applicant be trained in the "preparation and prosecution of applications for a patent" (which could only be performed by [a] person authorized to do so [i.e. a licensee])."

36. The Registrar submitted that the Applicant's self-directed training does not meet the requirements for a Class 3 licence, nor does it meet the requirements to write the QE.

Is it in the public interest to waive the 24-month training requirement?

37. The Registrar submitted that "[t]o permit applicants to self-declare their training (that would not only involve substantive skills but also lessons on ethics and integrity), any semblance of objectivity has been lost."

38. The Registrar wrote that it is "proper that CPATA not accept [REDACTED] self-directed training, without any form of supervision, as meeting the intent of the training requirement in order to sit the [QE]."

39. The Registrar submitted that it is not in the public interest to waive the 24-month supervised training requirement because

Self-training does not permit applicants to be exposed to the standards of the profession by licensees who are required to maintain said standards and display requisite good character. It is important to remember that supervisors not only assist applicants to learn the professions but appreciate the fiduciary responsibilities and privileges of the professions.

Analysis and Reasons

Which rules apply to the Applicant's application?

40. The *College of Patent Agents and Trademark Agents Act*,⁸ (the "Act") which established the College of Patent Agents and Trademark Agents (the "College") was assented to in December of 2018.
41. The passage of the Act was a matter of public record and there was a consultation process that occurred over 18 months.
42. There was a public interest rationale for the Government of Canada in establishing the College. The Government of Canada states that the government established the College as an independent regulator because "an independent regulator is responsive to stakeholder input and will guarantee professional regulation in the public interest." The Government of Canada states that "[i]mplementing a modern regulatory framework [for Patent Agents and Trademark Agents] will ensure that businesses can trust the advice they receive from these important professionals."⁹
43. As the Registrar noted in the Registrar's Revised Decision of October 5, 2021, it is part of the College's Regulatory Objectives to "[e]nsure Licensees deliver patent and trademark services ethically and competently. "
44. At the time of the Applicant's application, on or around August 9, 2021, CPATA had been established as the regulator for Patent Agents and Trademark Agents.

⁸ S.C. 2018, c. 27, s. 247.

⁹ "Frequently asked questions: College of Patent Agents and Trademark Agents", Government of Canada, accessed June 8, 2022 at <https://www.ic.gc.ca/eic/site/693.nsf/eng/00167.html>.

45. The former rules, which the Applicant wishes to rely on, were revoked on June 27, 2021 and, as of June 28, 2021, the Registrar of the College became the authority for issuing patent/trademark agent in training licences.¹⁰

46. The legislative framework does contemplate a transitional period for the CPATA regime coming into force.¹¹ The CPATA rules have Transitional Provisions, which contemplate when an individual may be determined to be a “deemed holder of a patent/trademark agent in training licence”.¹²

47. At the time of the Applicant’s application, he did not qualify to be a “deemed holder of a patent/trademark agent in training licence” in accordance with the Transitional Provisions of the Regulations, as the Regulations required that an individual be, for the applicable period¹³,

supervised, in respect of that work,

(i) by an individual who holds a patent agent licence or who, before the day on which these Regulations come into force, is a patent agent, or

(ii) by an individual who is responsible for a legal clinic associated with a Canadian faculty of law.¹⁴

48. Given the rationale and explanations above, the CPATA rules that came into force on June 28, 2021 apply to any application after that date. Therefore the CPATA rules are what apply to the applicant in this case.

Does self-directed training satisfy the 24-month training requirement?

49. The current regulatory framework requires

¹⁰ *College of Patent Agents and Trademark Agents Act*, S.C. 2018, c. 27, ss. 26(2), 29(2).

¹¹ *College of Patent Agents and Trademark Agents Act*, S.C. 2018, c. 27, s. 86.

¹² *College of Patent Agents and Trademark Agents Regulations*, SOR/2021-129, ss. 21, 22.

¹³ The applicable period is defined in the Regulations as beginning either the day on which the Regulations come into force or the day the Applicant gives notice to the College that they meet the requirements set out in ss. 21(1) and/or 22(1) and end on the day the Applicant is issued a licence, the day their licence is surrendered or revoked or the day that is one year after the Regulations come into force.

¹⁴ *College of Patent Agents and Trademark Agents Regulations*, SOR/2021-129, ss. 21, 22.

- a. a Class 3 licence to have a training agreement executed by the applicant and the supervisor or a representative of the Patent Office.¹⁵
- b. that prior to writing the QE, an Applicant must “(a) work under a training agreement for a period of 24 months”.¹⁶

50. The Registrar’s Policy on Prior Experience Assessment became effective June 28, 2021. It, like the Regulations and the By-law, requires prior experience to have been completed under supervision and states that the Registrar will consider “the degree of supervision” when determining whether the prior experience is given credit towards or recognized as meeting the 24-month training requirement.¹⁷

51. All of the applicable legislation, regulations and by-laws state that the 24-month training period is to be supervised and that this supervised training period must be completed for an Applicant to qualify to write the QE.

52. The Registrar’s decision that the Applicant does not meet the requirements to write the QE under the CPATA rules because he did not complete a 24-month supervised training period was reasonable.

Is it in the public interest to waive the 24-month training requirement?

53. The Registrar has the authority under the By-laws to waive a requirement if it is in the public interest to do so.¹⁸

54. The Cambridge Dictionary defines “supervision” as “the act of watching a person or activity and making certain that everything is done correctly, safely, etc.”.

55. Supervision is intended to provide appropriate oversight for applicants so that they receive training not only in substantive aspects of patent/trademark preparation and prosecution, but also appropriate guidance with respect to the ethical obligations of patent agents and trademark agents. This is of particular import with the relatively new establishment of the Code of Professional Conduct by the College.

¹⁵ By-laws of the College of Patent Agents and Trademark Agents (College) SOR/2021-167, ss. 9(f) and 12(f).

¹⁶ By-laws of the College of Patent Agents and Trademark Agents (College), SOR/2021-167, s. 15.

¹⁷ Registrar’s Policy on Prior Experience Assessment.

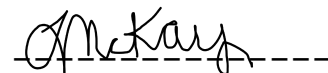
¹⁸ By-laws of the College of Patent Agents and Trademark Agents (College) SOR/2021-167, s. 3(3).

56. It is not in the public interest to waive the 24-month training under supervision requirement where the Applicant did not have training that adequately substituted the structure and oversight from an experienced professional that a supervised training period would have.
57. Without appropriate supervision during training, the College cannot be satisfied that in his work the Applicant has appropriately secured the full monopoly rights the patent was meant to.
58. It is not in the public interest to allow an Applicant to, in effect, create their own regulatory oversight by acting as their own supervisor.
59. The Registrar's decision that the Applicant's self-directed training "does not equal what a trainee would receive working under supervision and under an approved training agreement" and that "[f]or that reason, no credit towards the required training period is being allowed" was reasonable.

Conclusion

60. In view of the above, pursuant to the authority of the Registration Committee under section 6(c) of the By-Law, the Panel concludes that the decision of the Registrar was reasonable.

Dated July 7, 2022

A handwritten signature in cursive script, appearing to read 'Tina McKay', followed by a dashed line.

Tina McKay
Chair, Registration Committee