

For Information

1. CPATA's [Licensee Survey results](#) released
2. CPATA's [approach to consultation](#): CPATA has developed new guidelines for how it will consult on regulatory issues as part of its commitment to transparency and public interest regulation
3. Launch of consultation: [Regulating in the Public Interest paper](#)
4. CPATA's [Annual Fee and Refunds Policy](#) has been updated to include Class 2 and 3 licenses who change to Class 1 (Active) during the year
5. Registration Committee and Investigations Committee and Discipline Committee update:
Discipline Proceeding
 - [Allegations of Professional Misconduct involving Alpesh Patel](#)
 - [Notice of Application](#)
6. [Discipline Committee Policies](#)

Future meetings

2023

April 13/23 Committee of the Whole
May 25-26/23 AGM & Public Meeting Ottawa
July 6/23 – Committee of the Whole
August 17/23 – Board-Public meeting
September 21/23-Committee of the Whole
November 9/23 – Board-Public meeting
December 14/23 – Board Public meeting

2024

January 18/24 – Committee of the Whole
March 7/24 – Board-Public meeting
April 18/24 – Committee of the Whole
May 29-31/24 AGM & Public Meeting Ottawa

Public Board of Directors Meeting
Held via Zoom
December 15, 2022
12 noon ET
Minutes

BOARD MEMBERS:

Tom Conway, Chair
Ruth McHugh
Karima Bawa
Leonora Hoicka
Brigitte Chan
Jeff Astle
Andrew Currier
Darrel Pink, CEO and Registrar

STAFF:

Sean Walker, CFO
Victoria Rees, Manager Professional Responsibility
Jennifer Slabodkin, Director of Registration and Education, Deputy Registrar
Andres Diaz, Operations Mmanager
Anne-Thiphaine Camus, Administration, Registration and Education

1. Introductory Matters/Call to Order/Approval of Agenda/Conflicts of Interest

The meeting was called to order at 12:07 ET.

The Chair acknowledged that the meeting was held with directors present across Canada in lands preserved by Canada's indigenous peoples for thousands of years.

The Chair provided an update on the Ministerial appointment of Directors to the Board, noting announcements regarding the two remaining positions are imminent.

No conflicts of interest were declared.

2. Consent Agenda

The Chair noted the items on the consent agenda. Though no request was made to remove an item from the agenda, one director inquired about a note in the Governance Committee report regarding the CEO performance review plan.

The CEO advised the initial work on performance expectations for the new CEO will be carried out as part ROAR's transition work and CPATA will ask Boyden to engage with the Board on a first year performance review in 2024.

The CEO provided an update on the status of the by-law revisions work, noting the schedule for revised by-laws to be approved around March 31, 2023 remains.

It was noted committee reports should be from the committee chair, not the responsible staff support.
On a consensus, the Chair declared the consent agenda approved.

3. **Enhancing CPATA's Governance**

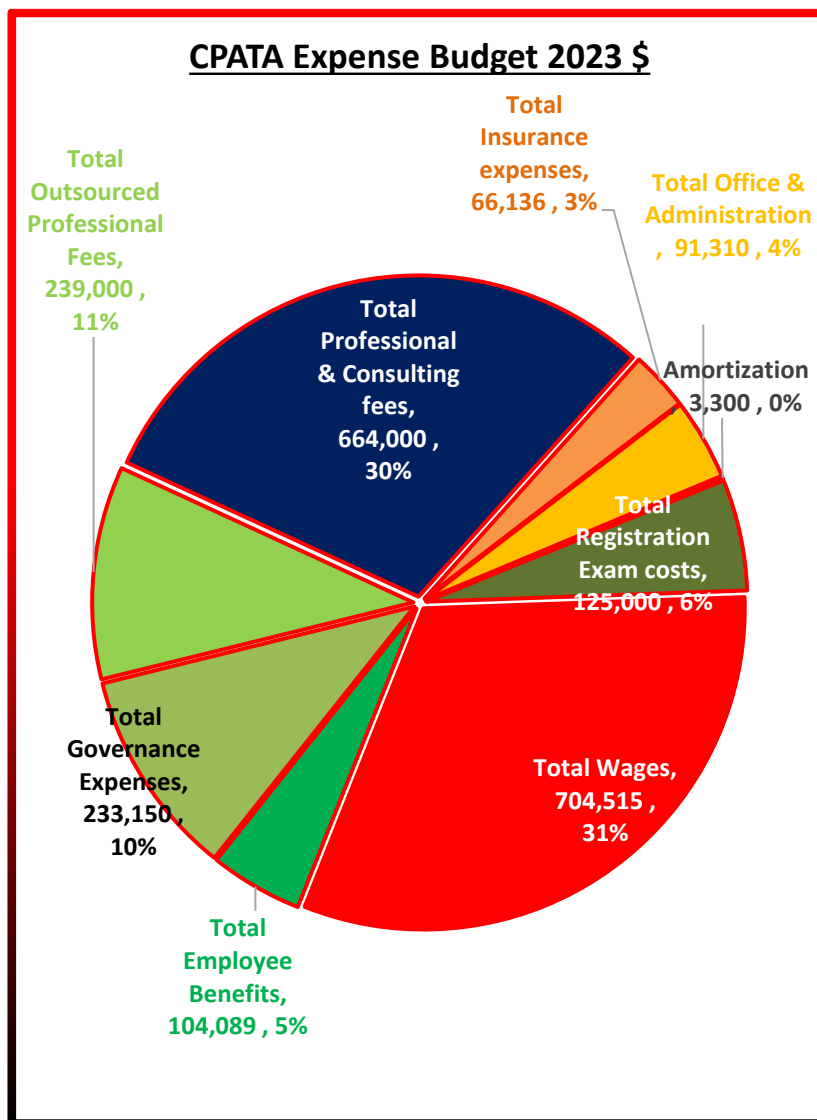
Sean Walker, CPA presented the 2023 operating budget.

He noted the budget is built around an assumption there will be a stable number of licensees in 2023, so there is no growth in revenue anticipated, as 88% of revenue derives from Class 1 fees.

On the expense side, he highlighted these key factors:

- Wages and benefits – the staffing model remains unchanged and the new CEO has been incorporated; Governance – full calendar of board and committee meetings is included with the revised remuneration model to start in Q2; Professional fees – increased for Complaints & Discipline based on current assumptions; Registration and exams – program continues to evolve with numbers reflecting 2022 experience; Insurance – market rates are expected to increase.

Overall the expense budget was summarized with this chart.



Following questions and discussion, it was moved by Ruth McHugh, seconded by Leonora Hoicka – **Be it resolved to approve the 2023 Operating Budget – Approved**

4. **CPATA as a Modern Regulator**

It was noted by the Chair that CPATA has received a brief from IPIC recommending CPATA implement the necessary infrastructure to receive complaints regarding unauthorized practice. The Chair noted this issues was discussed by the CEO at the 2022 IPIC Conference and the stated intention was to develop a policy following consultation.

Following discussion, it was moved by Leonora Hoicka, seconded by Karima Bawa:

Whereas CPATA recognizes that ss. 67 and 68 of the CPATA Act limit the use of the title of Patent Agent' or 'Trademark Agent' or of persons representing themselves as such if they are not licensees of CPATA;

And whereas the Act is not clear on the mandate of CPATA regarding enforcement of these provisions;

And whereas there need to be discussions with ISED regarding the application of these provisions;

Be it resolved the CEO, at the Board's meeting in March 2023, following necessary consultations and study, is to report on progress on all aspects of his work and provide advice to the Board on addressing allegations of unauthorized practice. Approved

Other business

The Board requested that a date for a possible fall in person meeting be scheduled, so dates can be held in director's schedules. It was also requested the date of the IPIC Conference be added to list of meeting dates.

There were some questions about the Investigation Committee procedures which were included in the meeting package.

Adjournment

On a motion made and carried unanimously, it was resolved to end the public meeting at 2:00 ET, and to move in-camera.

The meeting adjourned at 2:00 p.m. ET



Tom Conway

Chairman of the Board of Directors

Minutes approved on (date)

GOVERNANCE COMMITTEE MEETING REPORT – NOVEMBER 17, 2022, AND FEBRUARY 6, 2023

Attendance: Ruth McHugh, Chair, Karima Bawa, Peter Cowan, Amber Batool

Juda Strawczynski, CEO; Jennifer Slabodkin, Deputy Registrar

CEO Performance Review

The Committee discussed the CEO Performance Review process and agreed that it should be right sized to simplify and avoid additional costs and use of staff resources in the first couple of years.

Board Evaluation

The Governance Committee agreed that given the nascency and financial constraints of CPATA, proceeding with an external Board evaluation was not necessary in 2023.

Board Policies

The Committee reviewed Board Policy No. 3 Director's Code of Conduct, and agreed that it should be separated into a Director's Code of Conduct, Conflict of Interest Policy, and Confidentiality Agreement/Policy.

The Committee further agreed to create a single attestation that includes the Code of Conduct, Conflict of Interest and Confidentiality requirements that, on an annual basis, Directors will be asked to read, and attest that they have read and will comply.

Committee Workplans & Macro Agenda

Until all Committees have completed their workplans and presented them to the Board for approval, the Governance Committee cannot formalize its own workplan. Further discussion of the GC workplan was deferred.

Committee Terms of Reference

The Committee discussed amendments to the Terms of Reference for the Audit & Risk Committee and Governance Committee.

The Committee agreed to recommend an amendment to the Terms of Reference for the Audit & Risk Committee, to require at least one (1) and no more than two (2) members be Directors, and with at least two (2) members be independent.

The Governance Committee agreed to recommend an amendment to their Terms of Reference to require the Chair of the Committee be a Director. The Committee agreed to not increase their membership from four (4) to five (5) at this time.

Memorandum

TO	Board of Directors
FROM	Governance Committee
DATE	March 2, 2023
SUBJECT	Amending the Terms of Reference for the Audit and Risk Committee

MOTION: Be it resolved that the Terms of Reference for the Audit and Risk Committee be amended to permit up to two Directors to serve on the Committee.

The [Terms of Reference for the Audit and Risk Committee](#) set the Committee's membership at 4 members, one of whom is a Director. Under the current Terms of Reference, the number of Directors is fixed at one.

Current Committee members are:

- Bob Plamondon FCPA – Chair/président (2025)
- Jeff Astle (2024)
- Iris Almeida-Côté (2024)
- Maureen Rogers (2024)
- Staff – Sean Walker CPA, CFO

Iris Almeida-Côté was recently appointed to the Board. There are therefore now two Directors serving on the Board. Under the current Terms of Reference, one of the current Directors on the Committee would need to step off. CPATA would need to recruit an additional non-Director Committee member. While this would maintain the current prescribed Committee composition, it would take staff, Committee and Board time, and costs would likely be incurred.

The Governance Committee, in consultation with the Chair of the Audit and Risk Committee, recommends amending the Terms of Reference to permit up to two Directors to serve on the Committee. This approach balances the Committee between Director and non-Director members. It permits enhanced Board input into the Committee's work and increased alignment between the Committee and Board. It also avoids the need to recruit for the Committee at this time.

Memorandum

TO	Board of Directors
FROM	Governance Committee
DATE	March 2, 2023
SUBJECT	Amending the Terms of Reference for the Governance Committee

MOTION: Be it resolved that the Terms of Reference for the Governance Committee be amended to provide that the Committee Chair is a Director of the Board.

The [Terms of Reference for the Governance Committee](#) provide that the Governance Committee has up to 5 members, at least three of whom are Directors. It also provides that the Chair and members of the Governance Committee are appointed by the Board and that the Committee Chair is a voting member of the Committee.

The Governance Committee recommends that its Terms of Reference be amended to provide that the Governance Committee Chair must be a Director. This facilitates alignment between the Committee and Board.

The Terms of Reference provision under the section describing the Chair will be amended as follows:

The Chair and members of the Governance Committee are appointed by the Board.

The Committee Chair is a Director and is a voting member of the Committee.

Memorandum

TO	CPATA Board
FROM	Victoria Rees, Manager, Professional Responsibility
DATE	February 23, 2023
SUBJECT	Request for Approval of Amended Discipline Committee TOR and Skills Matrix

MOTION: Be it resolved that the Terms of Reference and Skills Matrix for the Discipline Committee be amended as per the attached revised versions at Appendix A and Appendix B to this memo.

Overview

s. 63 of the CPATA Act authorizes the Discipline Committee to make rules respecting the practice and procedure before it, and rules for carrying out its work and for the management of its internal affairs.

Over the past few months, the Discipline Committee has made policy and procedure decisions that impact their Terms of Reference and Skills Matrix. Because the Board approved the original TOR and SM, the Board is now asked to approve the revisions, which are summarized below.

Discipline Committee Terms of Reference

Attached as Appendix A is the revised Terms of Reference for the Discipline Committee.

i. Quorum

The Discipline Committee originally considered delegating authority to the Chair to make certain decisions on their own, for example on preliminary motions, and this was reflected in this Quorum section, where it stated that a quorum of the Discipline Committee will be:

- The Chair, for matters delegated to the Chair under the Policy; or
- A majority of panelists hearing an Application.

The Committee has determined that other than administrative decisions made as a result of Pre-hearing Conferences led by the Committee Chair (enunciated in Policy), all other decisions will be made by the appointed panels. This section therefore has removed reference to decisions made by the Chair alone.

ii. Resources

It has now been determined that the Discipline Committee requires administrative support in order to proceed with upcoming proceedings. The Manager, Professional Responsibility has to date provided and will continue to provide professional support with policy and procedure development. However, the

Investigations Committee has determined that the Manager will also provide instructions on its behalf to College counsel in respect of Applications before the Discipline Committee. Therefore, recognizing the Discipline Committee's independence, the Manager should not concurrently provide administrative support for proceedings while also instructing counsel to a party to the proceedings.

The position of Discipline Proceedings Coordinator has been created, the responsibilities of which will be shared by two existing administrative staff at CPATA. This is a cost-effective and efficient approach that will permit support to be provided in both official languages, and permit adaptability to the ad hoc nature of proceedings.

Skills Matrix

Attached as Appendix B is the revised and reformatted Skills Matrix for the Discipline Committee. The two amendments since this was last approved by the Board in 2021, are to:

- Add "bilingual" to the skills; and
- Add under "Knowledge" reference to the Patent Office and Patent Agent Practice Manuals, the Trademark Office and Trademark Agents Manual of Practice, and International Patent and Trademark systems and practices.

The Discipline Committee has approved these amendments.

DISCIPLINE Committee

Terms of Reference

ROLE

CPATA regulates the profession in accordance with Act, Regulations, by-laws, Registrar's policies, and the Regulatory Objectives, Standards and Principles. This includes setting and enforcing compliance with required ethical and practice standards through a variety of means, and in a manner that is risk focused, fair, transparent, efficient, proactive, proportionate and principled.

For the Discipline Committee, this regulatory approach includes fair, efficient and effective adjudication of applications; adopting a restorative approach that strives to address harm, help agents be accountable for their actions, and, where appropriate in the public interest, foster learning from mistakes rather than merely punishing; and making decisions that are clear, concise, well-supported and balance all relevant interests.

Objects of Complaints Process

The objects of the complaints process are to protect and promote the public interest and preserve the integrity of the patent and trademark profession, in a manner consistent with the College's Regulatory Objectives, Standards and Principles. This includes:

- a. Promoting and ensuring competent and ethical delivery of patent and trademark services by licensees;
- b. Addressing concerns of professional misconduct and professional incompetence, including striving for early resolution of complaints when doing so is consistent with the public interest; and
- c. Enforcing compliance with professional and ethical standards.

Discipline Committee

The Discipline Committee is an essential component of the Complaints Process, which includes the Registrar, the Investigations Committee and the Discipline Committee.

The Discipline Committee supports the mandate of the College to regulate the profession in the public interest by carrying out its assigned¹ responsibilities and advancing the College's Regulatory Objectives, Standards and Principles.

¹ Under ss. 51 – 63, the Regulations, and Registrar's Policies.

RESPONSIBILITIES

In support of the Regulatory Objectives, Standards and Principles the Discipline Committee:

- Hears applications referred by the Investigations Committee;
- Conducts hearings in accordance with principles of fairness and natural justice; and
- Enhances an efficient, effective, fair, transparent and accountable adjudication process by considering, on its own or on request of the Registrar or the Board, revisions to by-laws and policies.

Confidentiality

- Committee members must maintain confidentiality of all information they acquire while discharging their duties, unless disclosure is authorized (s. 65).

**MEMBERSHIP
AND VOTING**

The Discipline Committee will be comprised of at least five individuals, the majority being individuals who are not licensees and are otherwise qualified to serve under s. 21(1) and Regulation 2. The Committee as a whole will possess the knowledge, skills, experience and attributes set out in the Discipline Committee Skills Matrix.

Applications may be heard by panels of three or five Committee members, in the discretion of the Chair.

The Board, by a vote of two-thirds of those present, may at pleasure remove a member of the Committee, but the Board will not consider a motion to remove a Committee member unless the Committee member is given notice of the motion and is provided an opportunity to present to the Board².

² See Registrar's Policy on Committees

CHAIR	The Chair will be appointed by the Board, and will possess the knowledge, skills, experience and attributes set out in the Discipline Committee Chair Skills Matrix.
FREQUENCY OF MEETINGS AND MANNER OF CALL	The Discipline Committee will meet as a whole at least annually, and will meet as needed for purposes of hearing Applications. Meetings of the Committee, and the hearing of applications by a panel of the Committee may be in person, or with the consent of the parties, by audio-visual means.
QUORUM	<p>For purposes of hearing Applications, quorum of the Discipline Committee will be a majority of the panel hearing an application.</p> <p>For purposes of matters arising at meetings of the whole Committee, quorum is most of the Committee members.</p>
RESOURCES	<p>The Discipline Committee will have administrative support provided by the Manager, Professional Responsibility, and the Discipline Proceedings Coordinator.</p> <p>If the Discipline Committee or a panel thereof requires legal advice, the CEO will retain independent counsel for the Committee.</p>
REPORTING	<p>Decisions</p> <p>All decisions of the Discipline Committee and any panels thereof will be prepared in writing and made public by the CEO in accordance with the Act, Regulations, by-laws, and any applicable policies.</p>
DATE	<p>Approved: 2021-07-29</p> <p>Revised: 2022-02-22</p> <p>To be reviewed: 4th Quarter 2024</p>

CPATA Discipline Committee

Skills Matrix

2022-06-27

Introduction

CPATA regulates the patent and trademark profession in accordance with Act, Regulations, By-laws, Registrar's policies, and the Regulatory Objectives, Standards and Principles. This includes setting and enforcing compliance with required ethical and practice standards through a variety of means, and in a manner that is risk focused, fair, transparent, efficient, proactive, proportionate and principled.

For the Discipline Committee, this regulatory approach includes fair, efficient and effective adjudication of applications; adopting a restorative approach that strives to address harm, help agents be accountable for their actions, and, where appropriate in the public interest, foster learning from mistakes rather than merely punishing; and making decisions that are clear, concise, well-supported and balance all relevant interests.

Objects of Complaint Process

The objects of the complaints process are to protect and promote the public interest and preserve the integrity of the patent and trademark profession, in a manner consistent with the College's Regulatory Objectives, Standards and Principles. This includes:

- a. Promoting and ensuring competent and ethical delivery of patent and trademark services by licensees;
- b. Addressing concerns of professional misconduct and professional incompetence, including striving for early resolution of complaints when doing so is consistent with the public interest; and
- c. Enforcing compliance with professional and ethical standards.

The Complaints Process

The Registrar has primary responsibility for regulatory transactions with licensees, trainees and the public, including receiving inquiries about the conduct of licensees. Individuals may either file a complaint directly, or may first complete an Agent Conduct Inquiry Form to help assess whether their questions or concerns can be resolved or addressed at an early stage by the Registrar. If not, the result of the inquiry may be the filing of a complaint for referral to the Investigations Committee for direction, investigation or decision.

The Investigations Committee provides direction respecting investigations. If the Committee decides there is evidence of professional misconduct or incompetence, it must refer the matter to the Discipline Committee. Otherwise, the Committee may dispose of the complaint in accordance with the Act and Registrar's Policy on Complaint Investigations.

Role of the Discipline Committee

The Discipline Committee is an essential component of the Complaints Process, which includes the Registrar, the Investigations Committee and the Discipline Committee.

The Discipline Committee is appointed under s. 21(1) of the Act and supports the College and Board's mandate to protect the public interest, by carrying out responsibilities assigned under ss. 51-63 of the Act, the Regulations, and the applicable Registrar's Policies.

Responsibilities

The Discipline Committee's specific responsibilities include:

- Hearing applications referred by the Investigations Committee in accordance with principles of fairness and natural justice, as well as the Regulatory Objectives, Standards and Principles
- Recommending revisions to by-laws, policies and procedures as needed to support an adjudications process that is efficient, effective, fair, transparent, consistent and accountable

Committee Composition

The Discipline Committee as a whole must possess the required skills, knowledge, attributes and experience to enable it to fulfil its responsibilities in the public interest. Most of the Committee consists of individuals who are not licensees as one means of ensuring the public is intrinsically involved in the College's public interest work. Members of the Committee bring to the table knowledge and experience with the patent and trademark agency professions, the legal profession, as well as perspectives of members of the public whom the system is designed to protect.

All Committee members must complete mandatory training prior to commencement of service, and engage in such ongoing training and education during their term on the Committee as determined to be appropriate by the Chair and the Registrar.

The Committee Chair may require additional specific training to effectively lead the Committee and carry out work delegated by the Discipline Committee to the Chair.

Specific Knowledge, Skills, Attributes and Experience

- i. Identify the specific knowledge, skills, attributes and experience¹ required of the Discipline Committee members and as a whole;
- ii. Facilitate appointments to the Committee that will fill any gaps in the required knowledge, skills, attributes and experience; and
- iii. Assist with identifying training and education needs on an ongoing basis.

Members as a whole must possess the following:

The College is committed to the foundational principles of equity, diversity and inclusion, which are reflected in the composition of committees and the level of cultural competence expected of committee members.

Knowledge	Skills
CPATA Act	Effective oral communications
Patent Act and Rules; Patent Office practice, including the Manual of Patent Examination Practice and Patent Practice Notices; and Patent Agency Practice	Effective, persuasive written communications
Trademarks Act and Regulations; Trademark Office practice, including the Trademark Examination Manual and Trademark Practices Notices; and Trademark Agency Practice	Collaborative and effective decision making and writing in accordance with the Committee’s Guidelines
CPATA By-laws, Pt.5	Adjudicative hearings management
CPATA Code of Professional Conduct	Attention to detail
Registrar’s Policies for Hearing Committee	Organization & time management

¹ Knowledge’ includes understanding how CPATA operates in substance and principle, risk principles, and the prosecution of patent and trademark applications;

‘Skills’ include an ability to use the technology employed by the College, to communicate effectively both orally and in writing, and to discern and analyze ethical and evidentiary issues;

‘Experience’ includes professional discipline, committee or Board work, and engaging in effective debate and decision-making in an in-person and on-line environment;

‘Attributes’ include having a strong ethical foundation, being organized and meeting deadlines, collaborative decision-making, active listening skills, and behaving in a fair, respectful, culturally competent and courteous manner at all times.

Administrative & common law principles relevant to adjudication	Statutory interpretation
Charter & Human Rights and values	Evaluation of factual evidence & credibility
Restorative justice & ADR principles ²	Conflict management
Principles of equity, diversity and access to justice ³	Applying sanctioning principles
CPATA Code of Professional Conduct	Bilingual
General knowledge of relevant international Patent and Trademark systems and practices	
Experience	Attributes
Professional regulation & adjudication	Active listener strong communicator
Federal Court and administrative tribunal procedures	Fair, impartial and open-minded
Law relating to privacy & privilege	Courteous, respectful and patient
Administrative Law	Apply confidentiality and discretion
Patent Agent services	Cultural competence ⁴
Trademark Agent services	Ethical
Community service & volunteer leadership	Strong work ethic
Law of evidence	Professionalism & civility

² Restorative justice and ADR (alternate dispute resolution) principles focus on: early and informal resolution; effective conflict management; understanding context; identifying and addressing actual harms; encouraging accountability; being proactive, principled and proportionate rather than pursuing punishment; avoiding 'naming, shaming and blaming' and instead seeking collaborative solutions where possible and in the public interest

³ 'Equity, diversity, inclusion and access to justice principles' are closely tied to cultural competence, and includes having the knowledge, experience and skills to actively work to protect against and prevent individual and systemic discrimination, to cultivate appropriate attitudes toward cultural differences, and to ensure that the College's processes are open and accessible to all

⁴ interaction; and to acquire and perform the skills necessary to lessen the effect of these influences in order to serve the pursuit of justice. (Rose Voyvodic, "Lawyers Meet the Social Context: Understanding Cultural Competence", (2006) 84:3 The Canadian Bar Review 564 at 564)

Conduct of adjudicative hearings	Competent to use the technology facilitating the Committee's work
Fitness to practice, ⁵ capacity and health impacts on professional practice	Respected by peers
Ability to conduct hearings in both official languages	

⁵ 'Fitness to practice' encompasses knowledge and awareness of a range of factors that may impact or impair a licensee's ability to provide services competently and ethically, including a physical, mental or emotional condition or addiction, and the most effective ways to identify and address such situations in the public interest

The validation surveys solicited perspectives on the criticality² (importance and frequency) of the technical competencies required for Canadian patent and trademark agents. The survey results helped confirm the relative criticality of these competencies and identify gaps. Data for each competency was derived using two distinct approaches:

Direct ratings: On the validation survey, respondents were also asked to rate each high-level competency directly, providing both an importance and a frequency rating for each. This data helps to identify respondents' perceptions as to the relative criticality of each of these high-level competencies.

Performance criteria data: The weights for the performance criteria assigned to each high-level competency were summed. This data helps to identify the relative criticality of each high-level competency, based on the number and criticality of performance criteria for that area.

Using these two approaches supports a balanced view of the high-level competencies, considering both perceptions of overall criticality and the fact that different competencies reflect a different number of performance criteria of varying significance.

Key themes from the qualitative review noted the following potential omissions from the competency profile:

- **Professional foundations.** Multiple respondents identified as a possible omission various "professional foundations."
- **Underlying concepts.** Several respondents identified, as a possible omission, knowledge related to some underlying concept (i.e. administrative law, law of evidence, fundamentals of the Canadian legal system etc.).

The comments were reviewed by registration staff and the Registration Committee prior to finalizing the competency profile. CPATA will revisit some of these comments when developing the professional foundations profile (as appropriate) and when reviewing and revalidating the technical competency profile (which is recommended every 5 to 7 years).

Registration Committee Approval

The College By-laws³ require the Registration Committee to "approve standards for the evaluation of the competencies that are to be assessed by the qualifying examinations".

Accordingly, at the December 14, 2022, meeting, the Registration Committee received and reviewed the following materials:

² **Importance** (How important is this competency for safe and effective practice as a Patent Agent/Trademark Agent?) and **frequency** (How often do you use this competency in your current work as a Patent Agent/Trademark Agent?)

³ Section 2 Competence Standards <https://laws-lois.justice.gc.ca/eng/regulations/SOR-2021-167/FullText.html>

User	Expected uses
	Develop training and development plans Manage performance, compensation, and succession
Current IP agents	Support self-assessment and professional development Recognize transferable competencies Coach and mentor others in the profession
Prospective IP agents	Develop awareness of a profession or area of practice Support self-assessment and professional development Recognize transferable competencies
Others ⁴	Develop awareness of a profession or area of practice Compare different professions or areas of practice

⁴ Others may include those in future IP sectors, ISED, other jurisdictions, and members of the public.

College of Patent Agents & Trademark Agents

TECHNICAL COMPETENCIES

2022

COLLEGE OF PATENT AGENTS AND TRADEMARK AGENTS – TECHNICAL COMPETENCIES

This document outlines the technical competencies (knowledge, skills, and attributes) Canadian Patent Agents and Canadian Trademark Agents (together, intellectual property (IP) agents) need to practise safely, effectively, and sustainably.

It includes information about the purpose of these competencies, how they were developed, key competencies, and more detailed competency information.

For more information about the College of Patent Agents and Trademark Agents or its examinations, contact:

College of Patent Agents and Trademark Agents
400–411 Roosevelt Avenue, Ottawa, ON K2A 3X9

registration-inscription@cpata-cabamc.ca

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About CPATA's Competency Initiative

CPATA's competency initiative is one of the most significant projects undertaken in Canada to modernize, define and standardize qualifications within the IP profession. This ambitious venture provides assurance that the competencies assessed during the training and examination processes are empirically linked to future agents' ability to provide quality services to the public.

The first step in this process was the creation of technical competency profiles, descriptions of the knowledge and skills agents need to provide competent IP services to their clients. The establishment of clear expectations for practitioners will protect the public interest by ensuring that all new and current licensees have the skills necessary to serve their clients in a competent and ethical manner. The new competency profiles represent an important first step towards competency-based licensure in the intellectual property profession.

This document represents the technical competency profiles for patent agents and for trademark agents approved by CPATA's Registration Committee in December 2022 and by CPATA's Board of Directors in March 2023.

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Purpose

The College of Patent Agents and Trademark Agents (CPATA) intends its competency framework to:

- Establish the entry-level competencies for IP assessments, including for entry-to-practice examinations and other parts of the IP agent licensing process
- Guide Canadian IP agents in understanding the competencies associated with safe, effective, and sustainable practice
- Support Canadian IP agents in their self-assessment and ongoing learning, including their identification of priorities for professional development
- Define 'competence' in a manner that guides future regulatory and educational activities
- Inform intellectual property educators about priorities for learning
- Guide employers and training supervisors to develop experiences and practices that support competence training
- Advance CPATA's Regulatory Objective that licensees deliver ethical and competent services

CPATA does not intend for this profile to:

- Include every competency that an IP agent in Canada might need
- Create any obligations or requirements of IP agents in Canada with respect to any third party

This competency framework and related documentation are intended to be "living documents"; they will evolve and change as the practices of IP agents in Canada evolve and change.

Development

To develop these competencies, CPATA engaged a wide range of professionals. Key steps in the competencies' development included:

- **Background research.** Preliminary background research included semi-structured interviews and desk research (Canadian and international) relevant to the competencies of IP agents. The research provides a foundation for future activities.
- **Legacy mapping.** Two groups of subject matter experts (legacy mapping groups) reviewed 6 years of qualifying examinations to document the competencies each examination tested, at what cognitive levels, and in what proportions. This supplied a starting point for competency development.
- **Concept specification.** A concept specification for competency development and a vision for a longer-term assessment regime provided clarity on some key policy decisions.
- **Competency development.** Two groups of subject matter experts (competency development working groups) proposed draft technical competencies, performance criteria, and knowledge concepts. Each group met for 5 two-hour sessions and completed multiple between-session surveys to construct draft technical profiles.
- **Translation and translation review.** A professional translation team translated the draft technical profiles into French. Because the initial development process had taken place in English, CPATA recruited two additional groups of Francophone subject matter experts to provide feedback on the bilingual profiles.
- **Stakeholder consultation.** CPATA conducted additional stakeholder consultation, considering feedback from CPATA's Board of Directors, Registration Committee,

Investigations Committee, Discipline Committee, Audit & Risk Committee, Governance Committee, Nominating & Board Development Committee, the Patent Agent Legacy Mapping Group, and Trademark Agent Legacy Mapping Group.

- **Large-scale validation.** Under the oversight of a professional competence consultant and a PhD-level psychometrician, CPATA's consultant conducted large-scale validation surveys of the profession (one for Patent Agents and one for Trademark Agents) to gather and analyze criticality evidence.

CPATA is grateful to the contributors to this work, including:

- The Patent Agent Legacy Mapping Group comprising Dr. Philippe Couture, Leonora Hoicka, Alain Leclerc, Louis Martineau, and Matthew Powell
- The Trademark Agent Legacy Mapping Group comprising Meghan Dillon, Roger Hollett, Timothy Stevenson, and Richard Whissell
- The Patent Agent Competency Development Working Group comprising Jeffrey Astle, Dr. Houston Brown, Anthony (Tony) Creber, Erin Engelhardt, Jim Hinton, Leonora Hoicka, Jennifer Jannuska, Haya Shehab, and Gavin Zealey
- The Trademark Agent Competency Development Working Group comprising Steven Andrews, Enid Goldberg, Madeleine Hodgson, Paul-André Mathieu, Evan Reinblatt, Heather Robertson, Andrea Rush, and Richard Whissell
- The Patent Agent Translation Review Group comprising Nicholas Bertram, Alessandro Colonnier, and Denis Keseris
- The Trademark Agent Translation Review Group comprising Philippe Brouillette, Sarah Hebert-Tremblay, Marie Lussier, and Johanne Muzzo
- The Board of Directors, Registration Committee, Investigations Committee, Discipline Committee, Audit & Risk Committee, Governance Committee, Nominating & Board Development Committee and, specifically, Jenna Wilson, Leonora Hoicka,

Richard Whissell, and Heidi Jensen who provided feedback and additional review support

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CPATA also retained a professional translation team, Nations Translation Group, to provide translation and linguistic services.

Terminology

In this document, certain words and phrases have specific meanings. For clarity, this information is available in the footnotes.

In addition to these clarifications, the following terms (which appear in multiple sections) signify the following:

As appropriate (in the context of a performance criterion) appears when consideration of whether to conduct the activity is a significant part of the performance criterion.

CIPO means the Canadian Intellectual Property Office.

Necessary domain knowledge refers to knowledge of any relevant underlying technology, discipline, or industry that is needed for competent practice, beyond the technical competencies and professional foundations.

Types of intellectual property protection include copyright, patents, trademarks, trade secrets, industrial designs, integrated circuit topographies, plant breeders' rights, and Certificates of Supplementary Protection.

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. **Patent Agent (Technical)**. A Canadian Patent Agent can:

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

B. **Trademark Agent (Technical)**. A Canadian Trademark Agent can:

- A. Demonstrate foundational knowledge (Trademarks)
- B. Assess the registrability of a trademark
- C. Develop a client-centred trademark strategy
- D. Prosecute a trademark application
- E. Represent a client before the Trademarks Opposition Board

In addition to the technical domains, CPATA plans to develop a competency domain to cover IP Professional Foundations. Once this third domain is complete:

- The Patent Agent (Technical) competencies, the Intellectual Property (IP) Professional Foundations, and necessary domain knowledge would form the competency profile for Patent Agents (Canada); and
- The Trademark Agent (Technical) competencies, the Intellectual Property (IP) Professional Foundations, and necessary domain knowledge would form the competency profile for Trademark Agents (Canada).

For more information about the IP Professional Foundations, which CPATA expects to develop as part of a future project, see the note on the next page.

Intellectual Property (IP) Professional Foundations

The IP Professional Foundations are expected to capture the universal professional competencies that a range of professionals (including both Patent and Trademark Agents) require. These *may* include the ability of an agent to:

- *Act professionally.* This might include general ethical decision-making capabilities, general professional requirements (e.g., to know one's client), and the ability to recognize the limits of one's competence.
- *Learn and develop.* This might include the ability to be an effective self-directed learner, to keep up to date with changes (e.g., legal, procedural, practical, contextual), and continually improve.
- *Work with information.* This might include the ability to locate and access data, construct meaning, evaluate information, synthesize information, and leverage information technology.
- *Communicate effectively.* This might include the ability to elicit information from others, develop and express ideas, communicate as and when needed, and customize communications to different audiences.
- *Collaborate with others.* This might include the ability to develop interpersonal relationships, work cross-culturally, manage conflict, work with groups and teams, and build networks.
- *Solve problems.* This might include the ability to define a problem or task, assess a situation, generate options, make decisions, and evaluate.
- *Manage work.* This might include the ability to plan, organize, lead, and oversee work, including managing time, managing a workload, meeting deadlines, and completing work in a timely and efficient manner.

This list is for illustrative purposes only and is expected to change.

Patent Agent (Technical)

Definition

The Patent Agent (Technical) competencies set out the discipline-specific competencies that patent agents practising in Canada are expected to have. These competencies, together with the IP professional foundations and domain-specific technical knowledge, form the core competencies of patent agents in Canada.

Description

Patent agents should be knowledgeable about patents and patent practice and be able to develop a client-centred patent strategy, draft a patent application, prosecute a patent application, assess patent validity, and assess patent infringement.

The degree to which patent agents use these different competencies, and the complexity of the related tasks they perform, will inevitably differ depending on the type of work undertaken, the practice context, the types of clients served, and other factors. Many patent agents will have other competencies that they bring to their practices, not listed here. Nonetheless, all patent agents should have entry-to-practice competence in each of the listed competencies.

For more information about these competencies, refer to the following pages, which outline specific behaviours that an individual must engage in to show their competence in the relevant area (performance criteria) and related knowledge concepts.

Knowledge

Knowledge relevant to this domain includes familiarity with key sources, plus awareness and understanding of specific concepts. Prerequisite knowledge, which is relevant to a range of core patent competencies, is listed separately as “underlying knowledge.” In addition, there are key knowledge concepts associated to specific competencies. These major knowledge concepts also appear in the pages that follow.

A. Demonstrate foundational knowledge [Knowledge]

Sources

Demonstrate familiarity with the following sources:

Primary sources

- *Patent Act*, RSC 1985, c P-4 [Patent Act]
- *Patent Rules*, SOR/2019-251 [Patent Rules]
- *Manual of Patent Office Practice* [MOPOP]
- *Patent Cooperation Treaty*, June 19, 1970, [1990] Can. T.S. No. 22 [PCT] and *Regulations* SOR/89-453
- PCT Applicant's Guide: The PCT Applicant's Guide (wipo.int)
- Leading Canadian cases¹ and seminal international cases² in patent law

Secondary sources

- *Paris Convention for the Protection of Industrial Property*, as amended September 28, 1979
- *Patent Law Treaty (PLT)*, as adopted by the Diplomatic Conference on June 1, 2000
- 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
- PCT Receiving Office Guidelines (wipo.int)
- CIPO Patent Practice Notices, available [online](#)
- *United Nations Declaration on the Rights of Indigenous Peoples*, Articles 24 and 31

Professional sources

- *College of Patent Agents and Trademark Agents Act*, SC 2018, c 27, s 247 [CPATA Act]
- *College of Patent Agents and Trademark Agents Regulations*, SOR/2021-129 [CPATA Regulations]
- *By-laws of the College of Patent Agents and Trademark Agents*, SOR/2021-167 [CPATA Bylaws]
- *Code of Professional Conduct for Patent Agents and Trademark Agents* [Code of Professional Conduct]

¹ Leading Canadian cases refer to Canadian court cases that people regard as having settled a particular point of law and which give guidance for future cases; typically, but not always, such cases are decided by a court of last resort (e.g., the Supreme Court of Canada).

² Seminal international cases refer to highly influential, leading cases decided by courts outside of Canada (e.g., the United Kingdom, the United States) that influence Canadian practice; typically, but not always, such cases are decided by a court of last resort.

Knowledge concepts

Understand the following foundational concepts:

- Types of intellectual property protection
- Scope of the monopoly granted under a patent, i.e., exclusive rights granted to a patentee³
- Patent claims, namely:
 - Claim types⁴
 - Claim construction principles⁵
- Patent requirements, namely:
 - 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 requirements⁶
- Patent process, namely:
 - Inventorship and ownership⁷
 - 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 programs⁸
 - Applicable courts and appeal routes
- Registration and recording of documents and events affecting title
- Professional responsibilities⁹

³ Exclusive rights granted to a patentee refer to the exclusive right to make, use, offer to sell, and sell a patented article or the product/result of a patented process.

⁴ Claim types include both independent and dependent claims, as well as those of different categories, including product claims, apparatus claims, method claims, process claims, use claims, and others (e.g., improvement claims, picture claims, selection claims, Markush Group claims).

⁵ Claim construction principles include purposive construction, use of proper secondary sources (and when to use), doctrine of equivalents, and other relevant construction doctrines.

⁶ Disclosure and enablement requirements include, for example, requirements related to sufficiency, support, best mode, sound prediction, overbreadth, duty to disclose the invention, and other domestic and foreign requirements.

⁷ Inventorship and ownership concepts include an understanding of those who have contributed to the creation of an invention (inventorship) and those who own the proprietary rights of the invention concepts (ownership), as well knowledge of, for example, concepts of first applicant and the *Public Servants Inventions Act*.

⁸ Key patent treaties and international programs include the Paris Convention, the Patent Cooperation Treaty, Budapest Treaty on Biological Deposits, and the Patent Prosecution Highway Program (PPH).

⁹ Professional responsibilities include responsibilities specific to the practices of a trademark agent or patent agent, including those outlined in the *Code of Professional Conduct* and concepts of privilege.

B. Develop a client-centred patent strategy¹⁰ [Strategy]

Performance criteria

1. Identify a client's needs and goals¹¹
2. Assess the innovation context¹²
3. Identify, given a set of facts, available types of intellectual property protection
4. Plan a patent search
5. Interpret search results
6. Define the scope and breadth of protection available in view of the prior art
7. Outline, given a set of facts, the costs and benefits of patent protection
8. Outline, given a set of facts, practical and strategic timelines¹³
9. Plan strategies for protection outside of Canada
10. Identify, given a set of facts, limits on patent agent privilege¹⁴

Knowledge concepts

In addition to the foundational knowledge concepts, understand the following:

- Issues in patentability requirements in different countries (especially in the United States)
- Commercially valuable claims
- Actor analysis¹⁵
- Detectability of innovation
- Benefits of available protection¹⁶
- Costs, including patent application and maintenance fees
- Searches, including search result limitations¹⁷
- Risks of patent protection¹⁸

¹⁰ Patent strategy refers to a strategy to maximize the client's position to achieve its goals and objectives by protecting the innovations supporting those goals and objectives and the client's freedom to operate, given the client's business strategy, financial ability, and marketplace realities.

¹¹ Needs and goals include general, commercial, financial, legal, and innovation needs and goals.

¹² Innovation context refers to the technical field or area, scope, state of the art, environment, business climate, and business context in which an invention will be publicly used, including any constraints, appreciation of which supports an agent's ability to recognize an inventive step and produce practical advice.

¹³ Practical and strategic timelines, in the context of developing a patent strategy, include prescribed time limits (e.g., for national phase entries of PCT applications) as well timelines that support other client goals and objectives (e.g., staging of separate or related inventions to optimize timing of a client's schedule expenses).

¹⁴ Patent agent privilege refers to the form of privilege specified in section 16.1 of the *Patent Act*.

¹⁵ Actor analysis refers to an analysis of who is likely to infringe and what claims would cover such infringement.

¹⁶ Benefits of available protection include benefits related to patent protection, but also related to, for example, protection via trade secret or protection through intentional disclosure to prevent a third party from obtaining patent protection.

¹⁷ Search result limitations include risks, constraints, and unknowns relevant to a patentability search.

¹⁸ Risks of patent protection might include, for example, those related to the requirement to disclose the invention and the client's own use, consequences of disclosing an invention in a published patent application, and potential pitfalls of design around.

C. Draft a patent application [Drafting]

Performance criteria

1. Identify, given a set of facts, claim drafting objectives¹⁹
2. Draft claims, of multiple claim types,²⁰ with proper scope, characteristics, and structure²¹
3. Describe an invention,²² including its embodiments and alternatives
4. Plan the drawings that illustrate the features of an invention

Knowledge concepts

In addition to the foundational knowledge concepts, understand the following:

- Application of actor and jurisdictional analysis to draft claims
- Cascading claim scope
- Disclosure elements, including title, background, summary, brief description of the drawings, detailed description, and abstracts
- Formal rules of claim drafting
- Mirroring of claim language in disclosure
- Practice for drafting claims of multiple claim types
- International drafting requirements
- Procedural rules respecting acceptable drawings and labels

¹⁹ Claim drafting objectives, which reflect the innovation context and a client's goals and objectives, aim to clarify the breadth of protection sought.

²⁰ Claim types include both independent and dependent claims, as well as those of different natures, including product claims, apparatus claims, method claims, process claims, use claims, and others (e.g., improvement claims, picture claims, selection claims, Markush Group claims).

²¹ Proper scope, characteristics, and structure, in the context of claims drafting, require that claims meet the requirements of the *Patent Act* (e.g., section 27) and the *Patent Rules* (e.g., section 60), reflect claim drafting objectives (including consideration of the prior art), and have a logical organization.

²² Invention has the meaning specified in section 2 of the *Patent Act*, and, in this document, specifically includes its embodiments and alternatives.

D. Prosecute²³ a patent application [Prosecution]

Performance criteria

1. Analyze a patent family file history²⁴
2. Assess the citability of prior art for anticipation and obviousness
3. Respond to an office action²⁵
4. Prepare substantive submissions to CIPO other than in response to an office action²⁶
5. Amend²⁷ independent or dependent claims, as appropriate
6. Manage Canadian prosecution in the context of a global portfolio

Knowledge concepts appear on the next page.

²³ Prosecution, in this context, includes preparing, filing, advancing, and maintaining applications or registrations.

²⁴ Patent family file history refers to the global collection of patent filings that are linked by at least one common priority. For greater certainty, in this document a patent family file history includes both Canadian and U.S. documents and maintenance fee payment history.

²⁵ Respond to an office action, in a patent context, includes preparing a complete response to correct a defect, to challenge an examiner's improper objection, or to appeal a final refusal, having considered the examiner's arguments, file history, cited or prior art, and the client-centred patent strategy, and without unnecessarily conceding valuable patentable subject matter or rights.

²⁶ Substantive submissions to CIPO other than in response to an office action include oral or written submissions related to, for example, notice of allowance practices, accelerated examination or expedited prosecution, voluntary amendments, and other such matters.

²⁷ Amend (in the context of claims) means to modify only to the extent necessary, without unnecessarily conceding valuable patentable subject matter or rights and taking into consideration the client-centred patent strategy.

Knowledge concepts

In addition to the foundational knowledge concepts, understand the following:

- Abandonment and reinstatement
- Affidavit practice
- Allowance, final fee, and issuance
- Appeals, including Patent Appeal Board
- Authorized representative and common representative
- Best practice in making submissions to CIPO²⁸
- Deemed expiry and reversal
- Disclosure of prior art
- Divisional practice
- Due care
- Examiner interview process
- Expediting or advancing examination²⁹
- Fee payment requirements, including small entity, claims, and maintenance
- Filing electronically with CIPO and WIPO
- Final action practice
- Patent prosecution process³⁰
- Patent Register listing requirements
- PCT filing and prosecution procedure³¹
- Post grant prosecution³²
- Priority³³
- Protests and filings of prior art prior to grant
- Registration of documents³⁴
- Request for Examination
- Requirements for CIPO communications
- Requirements to obtain a filing date
- Third party rights
- Transfers and changes of name
- Verification of the administrative status of a patent application or a patent

²⁸ Best practice in making submissions to CIPO includes knowledge of good faith practice and the effect on file history estoppel (also known as file wrapper estoppel) in other jurisdictions.

²⁹ Expediting or advancing examination includes knowledge of the tools for accelerating (or decelerating) prosecution in Canada and knowledge of the Patent Prosecution Highway (PPH).

³⁰ Patent prosecution process includes knowledge of patent practice formalities. For greater certainty, this includes knowledge of streamlined examination rules.

³¹ PCT filing and prosecution procedure includes both International and National Phases.

³² Post grant prosecution includes disclaimer, re-examination, re-issue, dedication to the public, and other post-grant corrections under the *Patent Rules* and the *Patent Act*.

³³ Priority includes knowledge of requests for priority and rectification of priority; see section 73 of the *Patent Rules*.

³⁴ Registration of documents includes knowledge of transfers, ownership, and assignment (see sections 124 to 127 of the *Patent Rules*).

E. Assess validity³⁵ [Validity]

Performance criteria

1. Identify, given a set of facts, validity issues beyond claim validity issues³⁶
2. Construe³⁷ claim terms for the purpose of assessing validity
3. Assess the citability of a document or disclosure event for anticipation and obviousness
4. Assess whether a claim is anticipated, given the prior art
5. Assess whether a claim is obvious, given the prior art
6. Assess the validity of a claim, for reasons other than anticipation or obviousness

Knowledge concepts

In addition to the foundational knowledge concepts, understand the following:

- Claim dates
- Effect of representations in prosecution or in the petition
- Proper forums for impeaching a patent
- Re-examination, disclaimer, and reissue

³⁵ Validity, in the context of a claim, includes the grounds for attacking or defending the validity of claims. For greater certainty, in this document validity extends to concepts related to, for example, citability of prior art, anticipation, obviousness, indefiniteness, ambiguity, and support in the disclosure.

³⁶ Validity issues beyond claim validity issues refer to issues related to, for example, maintenance history, representations in prosecution or in the petition (e.g., related to inventorship or in prosecution affidavits), sufficiency of disclosure, the patent's relationship to its other family members (e.g. valid divisional status, valid claim of priority), term and in-force status of patents and patent applications, and other transactional aspects (e.g., due diligence factors when a patent is an asset a transaction, or how to register a transfer of ownership or a security interest).

³⁷ Construe (in the context of claim terms) may include mapping a claim term to parts or features, explaining an element's function or purpose, citing an essential element, and providing relevant support.

F. Assess infringement [Infringement]

Performance criteria

1. Construe claim terms for the purpose of assessing infringement
2. Identify, given a set of facts, potential acts of infringement
3. Analyze a claim to determine infringement
4. Identify, given a set of facts, who can or must assert infringement
5. Assess whether one or more parties are liable for infringement
6. Assess whether a party is liable for inducing infringement
7. Identify, given a set of facts, defenses to an allegation of infringement
8. Outline potentially available remedies for infringement

Knowledge concepts

In addition to the foundational knowledge concepts, understand the following:

- Acts of infringement, including:
 - Making, using, or selling
 - Importation, *Saccharin* doctrine
 - Repair or remanufacture
 - Contributory infringement
 - Inducing infringement
- Exceptions and defenses to infringement, including:
 - 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
- Proper plaintiff(s),³⁸ potential defendants, and onus of proof³⁹
- Patent term and extension⁴⁰
- Patented medicines regime⁴¹

³⁸ Proper plaintiff(s) refer to a recognition of potential joint owners or licensees.

³⁹ Onus of proof refers to the legal burden to prove infringement (which typically rests on the patentee).

⁴⁰ Patent term and extension includes maintenance and restoration of expired patents and intervening rights.

⁴¹ Patented medicines regime knowledge, other than for those who practise in this area, is limited to basic awareness (e.g., of the *Patented Medicines (Notice of Compliance) Regulations* regime, of the existence of certificates of supplementary protection). See, in particular, subsections 4(2) and 4(6) of the *Patented Medicines (Notice of Compliance) Regulations*.

- Remedies⁴²
- Limitation periods

Trademark Agent (Technical)

Definition

The Trademark Agent (Technical) competencies set out the discipline-specific competencies that trademark agents practising in Canada are expected to have. These competencies, together with the IP professional foundations, form the core competencies of trademark agents in Canada.

Description

Trademark agents should be knowledgeable about trademarks and trademark practice and be able to assess the registrability of a trademark, develop a client-centred trademark strategy, prosecute a trademark application, and represent a client before the Trademarks Opposition Board.

The degree to which trademark agents use these different competencies, and the complexity of the related tasks they perform, will inevitably differ depending on the type of work undertaken, the practice context, the types of clients served, and other factors. Many trademark agents will have other competencies that they bring to their practices, not listed here. Nonetheless, all trademark agents should have entry-to-practice competence in each of the listed competencies.

For more information about these competencies, refer to the following pages, which outline specific behaviours that an individual must engage in to show their competence in the relevant area (performance criteria) and related knowledge concepts.

Knowledge

⁴² Remedies include, for example, damages, accounting of profits, reasonable compensation, injunction, delivery-up, costs, interest, and punitive damages, and includes the effect of laches and acquiescence.

Knowledge relevant to this domain includes familiarity with key sources, plus awareness and understanding of specific concepts. Prerequisite knowledge, which is relevant to a range of core trademark competencies, is listed separately as “underlying knowledge.” In addition, there are key knowledge concepts associated to specific competencies. These major knowledge concepts also appear in the pages that follow.

A. Demonstrate foundational knowledge [Knowledge]

Performance criteria

Demonstrate familiarity with the following sources:

Primary sources

- *Trademarks Act*, RSC 1985, c T-13 [Trademarks Act]
- *Trademarks Regulations*, SOR/2018-227 [Trademarks Regulations]
- *Trademarks Examination Manual*, RG42-4/1996 [Trademarks Examination Manual]
- CIPO Trademark Practice Notices, available [online](#)
- *CIPO Goods and Services Manual*, available [online](#)
- Leading Canadian cases⁴³ in trademark law

Secondary sources

- Madrid Agreement Concerning the International Registration of Marks (1891) and the Protocol Relating to that Agreement (1989)
- *Nice Classification* (wipo.int)
- *Paris Convention for the Protection of Industrial Property*, as amended September 28, 1979
- *Singapore treaty* (wipo.int)
- *United Nations Declaration on the Rights of Indigenous Peoples*, Articles 24 and 31

Professional sources

- *College of Patent Agents and Trademark Agents Act*, SC 2018, c 27, s 247 [CPATA Act]
- *College of Patent Agents and Trademark Agents Regulations*, SOR/2021-129 [CPATA Regulations]
- *By-laws of the College of Patent Agents and Trademark Agents*, SOR/2021-167 [CPATA Bylaws]
- *Code of Professional Conduct for Patent Agents and Trademark Agents* [Code of Professional Conduct]

Knowledge concepts appear on the next page.

⁴³ Leading Canadian cases refer to Canadian court cases that people regard as having settled a particular point of law and which give guidance for future cases; typically, but not always, such cases are decided by a court of last resort (e.g., the Supreme Court of Canada).

Knowledge concepts

Understand the following foundational concepts:

- Confusion
- Definition of a trademark
- Descriptiveness
- Depreciation of goodwill⁴⁴
- Distinctiveness (inherent and acquired)
- Entitlement to registration⁴⁵
- Entitlement to use
- History of the trademark protection system
- Formal and technical requirements
- Fundamentals of statutory interpretation
- Infringement⁴⁶
- Madrid Protocol in Canada
- Ownership
- Passing off⁴⁷
- Professional responsibilities⁴⁸
- Prohibited marks⁴⁹
- Registrability
- Technical objections⁵⁰
- Trade names
- Trademark agent privilege
- Trademark timelines and deadlines⁵¹
- Types of intellectual property protection
- Types of trademarks⁵²
- Use in association with goods or services

⁴⁴ Depreciation of goodwill has the meaning set out in section 22 of the *Trademarks Act*.

⁴⁵ Entitlement to registration refers to who may register a mark, as set out in section 16 of the *Trademarks Act*, with consideration of prior rights and priority claims established under section 34 of the *Trademarks Act*.

⁴⁶ Infringement has the meaning set out in sections 19 and 20 of the *Trademarks Act*.

⁴⁷ Passing off refers to both the common law tort and/or section 7 of the *Trademarks Act* that protects the goodwill of businesses by preventing competitors from deceptively representing or marketing goods or services in a manner that confuses or is likely to confuse consumers.

⁴⁸ Professional responsibilities include responsibilities specific to the practices of a trademark agent or patent agent, including those outlined in the *Code of Professional Conduct* and concepts of privilege

⁴⁹ Prohibited marks refer to any mark prohibited by the *Trademarks Act*, including those listed in sections 9, 10, and 10.1.

⁵⁰ Technical objections refer to barriers to registrability that can be remedied without substantial amendment to the application or the filing of submissions.

⁵¹ Trademark timelines and deadlines includes trademark-specific rules and requirements regarding dates, deadlines, extensions, default periods, and days when CIPO is closed.

⁵² Types of trademarks include standard character trademarks, design marks, non-traditional marks, certification marks, official marks, geographical indications, and unregistered trademarks.

B. Assess the registrability of a trademark [Registrability]

Performance criteria

1. Plan a trademark search
2. Interpret search results
3. Assess distinctiveness
4. Assess likelihood of confusion
5. Assess descriptiveness⁵³
6. Assess entitlement to registration⁵⁴
7. Identify, given a set of facts, potential areas of conflict with third parties
8. Identify, given a set of facts, prohibited marks⁵⁵
9. Identify, given a set of facts, potential technical objections⁵⁶

Knowledge concepts

In addition to the foundational knowledge concepts, understand the following:

- Registrable trademarks⁵⁷
- Searches,⁵⁸ including trademark status⁵⁹ and search result limitations⁶⁰

⁵³ Descriptiveness (in the context of assessment thereof) includes assessment of mis-descriptiveness.

⁵⁴ Entitlement to registration refers to who may register a mark, as set out in section 16 of the *Trademarks Act*, with consideration of prior rights and priority claims established under section 34 of the *Trademarks Act*.

⁵⁵ Prohibited marks refer to any mark prohibited by the *Trademarks Act*, including those listed in sections 9, 10, and 10.1.

⁵⁶ Technical objections refer to barriers to registrability that can be remedied without substantial amendment to the application or the filing of submissions and include deficiencies related to formalities.

⁵⁷ Registrable trademarks are defined by section 12 of the *Trademarks Act*.

⁵⁸ Search-related knowledge includes, for example, awareness of the parameters and processes of searching, where and how to obtain quality search reports and how to interpret them, how to use online databases, what fields are searchable, and how to use and combine Boolean operators and wildcards to construct multi-level search strings.

⁵⁹ Trademark status includes whether a trademark is pending, registered, abandoned, expunged, cancelled, or withdrawn.

⁶⁰ Search result limitations include risks, the limits of the scope search, and unknowns relevant to a trademark search.

C. Develop a client-centred trademark strategy⁶¹ [Strategy]

Performance criteria

1. Identify a client's needs and goals⁶²
2. Identify, given a set of facts, available types of intellectual property protection, including types of trademarks⁶³
3. Outline, given a set of facts, the costs and benefits of trademark protection
4. Outline, given a set of facts, practical and strategic timelines
5. Analyze situations involving trademark use⁶⁴
6. Analyze situations involving trademark ownership, licensing, or transfer of rights
7. Assess a registration's vulnerability to invalidation
8. Identify, given a set of facts, when a new application or an application to extend a statement of goods or services is advisable
9. Identify, given a set of facts, strategies for rendering a mark registrable⁶⁵
10. Identify, given a set of facts, practical ways to manage a portfolio⁶⁶ for domestic and international protection
11. Identify, given a set of facts, limits on agent privilege⁶⁷

⁶¹ Trademark strategy refers to a strategy to adopt, use, register, or protect a trademark to assist a client to achieve its goals and objectives.

⁶² Needs and goals include general, commercial, financial, legal, and innovation needs and goals.

⁶³ Types of trademarks include standard character trademarks, design marks, non-traditional marks, certification marks, official marks, geographical indications, and unregistered trademarks.

⁶⁴ Use has the meaning set out in section 4 of the *Trademarks Act* and analysis thereof includes consideration of use by both the owner of the trademark and others, taking into account who, how, when, and in association with what goods and services use is made.

⁶⁵ Strategies for rendering a mark registrable include, for example, adding design elements, removing goods and services, and commencement of use to obtain distinctiveness.

⁶⁶ Practical ways to manage a portfolio include ways to use a trademark as registered, ways to properly mark a trademark; and ways to monitor and enforce trademark use.

⁶⁷ Trademark agent privilege refers to the form of privilege specified in section 51.13 of the *Trademarks Act*.

Knowledge concepts

In addition to the foundational knowledge concepts, understand the following:

- Rights that exist in the absence of registration
- Cross-border intellectual property fraud and cross-border protection resources⁶⁸
- Official fees and fee structure
- Licensing and licensed use⁶⁹
- Marking (e.g., TM, MC, ®, MD), including on labeling and packaging
- Monitoring and enforcing trademark rights and use
- Other trademark-related limitations⁷⁰

⁶⁸ Cross-border protection resources include systems and tools to protect IP rights from cross-border fraud (i.e., CBSA's IPR Program, filing RFAs) and relevant organizations (e.g., Canadian Anti-Fraud Centre, the Canadian Anti-Counterfeiting Network, Homeland Security Investigations Global Trade Investigations Division (U.S.), National IP Rights Coordination Centre (U.S.)).

⁶⁹ Licensing and licensed use includes requirements for licensing trademarks in Canada, sections 50 and 51 of the Trademarks Act, effects of improper licensing (i.e., depreciation of goodwill), key elements of a valid license, advantages of a written license agreement, and licensing agreement best practices.

⁷⁰ Other trademark-related limitations (in the context of knowledge thereof) include general awareness of, for example, the exception for trademarks registered in a language other than French under Quebec language laws; the local presence requirement for ".CA" domain names (other than for trademarks registered in Canada); and the unauthorized use or registration of terms prohibited by the *Bank Act*, the *Olympic and Paralympic Marks Act*, the *Precious Metals Marking Act and Regulations*, the *Canada Post Corporation Act*, and the *Canada-European Union Comprehensive Economic and Trade Agreement (CETA)*.

D. Prosecute a trademark application [Prosecution]

Performance criteria

1. Analyze a trademark file history
2. Classify goods and services
3. Draft a statement of goods and services
4. Respond to an office action⁷¹
5. Support the preparation and negotiation of consent and co-existence agreements
6. Manage Canadian prosecution in the context of a global portfolio⁷²

Knowledge concepts

In addition to the foundational knowledge concepts, understand the following:

- Application and filing requirements⁷³
- Classifications of good and services (according to Nice Classification)
- Consent and co-existence agreements
- Divisional applications and merger of registrations
- Geographical indications
- Notification of Third-Party Rights (including process and criteria)
- Office actions (including deficiencies and objections by the Registrar of Trademarks)
- Office practice
- Ownership issues⁷⁴
- Registration⁷⁵ and registered rights⁷⁶

⁷¹ Respond to an office action, in a trademark context, includes preparing submissions, allowable amendments, and proper evidence (e.g., related to distinctiveness, public authority) to respond to and overcome objections.

⁷² Manage a Canadian prosecution in the context of a global portfolio includes working with international associates to prosecute (as well as maintain) trademark rights inside or outside of Canada.

⁷³ Application and filing requirements include, but are not limited to, requirements set out in section 30 of the *Trademarks Act* for Canadian trademark applications, and requirements set out in sections 98 and 99 of the *Trademarks Regulations* for applications for international registration filed under the Madrid Protocol.

⁷⁴ Ownership issues include knowledge of chain of title, name changes, and transfer of trademark rights set out in section 48 of the *Trademarks Act*, as well as relevant knowledge of recordation or registration process and procedure.

⁷⁵ Registration (in the context of knowledge thereof) includes knowledge of the effect of registration (both risks and benefits), the registration process, potential hurdles (e.g., possibility of rejections or a potential third-party opposition), allowable amendments to the register (what, when, and how amendments can be made post-filing), maintenance of registrations, renewal (before both CIPO and WIPO), vulnerabilities, and other considerations uniquely affecting registered trademarks.

⁷⁶ Registered rights (in the context of knowledge thereof) includes knowledge of the rights conferred by registration.

- Requirements for a statement of goods or services
- Requirements to be a person entitled to trademark registration

E. Represent a client before the Trademarks Opposition Board

[Opposition and s. 45 proceedings]

Performance criteria

1. Assess whether a registration is likely to be expunged or amended for lack of use⁷⁷
2. Assess grounds of opposition
3. Identify, given a set of facts, deficiencies in evidence⁷⁸
4. Prepare formal requests⁷⁹
5. Manage the collection, assessment, and preparation of evidence⁸⁰
6. Conduct cross-examinations, as appropriate
7. Conduct oral hearings, as appropriate
8. Prepare representations⁸¹
9. Negotiate settlements, as appropriate

Knowledge concepts

In addition to the foundational knowledge concepts, understand the following:

- Cross-examination (including requirements and best practices)
- Elements of a written argument
- Evidentiary rules and requirements⁸²
- Extension requests
- Grounds of opposition⁸³
- Interlocutory ruling requests
- Opposition strategy
- Requirements for filing a Statement of Opposition or preparing a counterstatement (including amendments)

⁷⁷ Lack of use is assessed by reference to section 4 of the *Trademarks Act*.

⁷⁸ Evidence includes affidavits, statutory declarations, exhibits, certified copies of registrations, and other forms of evidence accepted by the Registrar of Trademarks.

⁷⁹ Formal requests include requests for an interlocutory ruling (e.g., a request for a ruling striking all or any part of the opponent's statement of opposition under subsection 38(6) of the *Trademarks Act*), leave to amend a statement of opposition or counter statement (i.e., section 48 of the *Trademarks Regulations*), leave to submit additional evidence (i.e., section 55 of the *Trademarks Regulations*), and extension requests (both administrative and under section 47 of the *Trademarks Act*).

⁸⁰ Evidence includes affidavits, statutory declarations, exhibits, certified copies of registrations, and other forms of evidence accepted by the Registrar of Trademarks.

⁸¹ Representations refer to written representations, oral representations, or both.

⁸² Evidentiary rules and requirements include rules and requirements related to the filing of evidence and of formalities in swearing, commissioning, or notarizing.

⁸³ Grounds of opposition include procedural, registrability, non-entitlement, non-distinctiveness, bad faith, and non-use, outlined in subsection 38(2) of the *Trademarks Act*.

- Service rules and requirements
- Summary cancellation (s. 45) proceedings and related law and procedure