

# 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.

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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

To complete this work, CPATA was supported by an independent social enterprise (Principia Assessments Ltd.). The project team was led by Jennifer Flynn, with support from Craig Edhart, Daniel García, and Dr. Michaela Geddes, with Karen Luker (of CAMPROF Canada).

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](http://wipo.int))
- Leading Canadian cases<sup>1</sup> and seminal international cases<sup>2</sup> 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](http://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]

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<sup>1</sup> 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).

<sup>2</sup> 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 patentee<sup>3</sup>
- Patent claims, namely:
  - Claim types<sup>4</sup>
  - Claim construction principles<sup>5</sup>
- 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 requirements<sup>6</sup>
- Patent process, namely:
  - Inventorship and ownership<sup>7</sup>
  - Claim construction (including *Improver* criteria)
  - Patent application requirements for Canada and Patent Cooperation Treaty (PCT) practice
  - Key patent office activities and statutory deadlines for Canadian and PCT practice
  - Effect of key patent treaties and international programs<sup>8</sup>
  - Applicable courts and appeal routes
- Registration and recording of documents and events affecting title
- Professional responsibilities<sup>9</sup>

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<sup>3</sup> 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.

<sup>4</sup> 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).

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

<sup>6</sup> 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.

<sup>7</sup> 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*.

<sup>8</sup> 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).

<sup>9</sup> 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 strategy<sup>10</sup> [Strategy]

### Performance criteria

1. Identify a client's needs and goals<sup>11</sup>
2. Assess the innovation context<sup>12</sup>
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 timelines<sup>13</sup>
9. Plan strategies for protection outside of Canada
10. Identify, given a set of facts, limits on patent agent privilege<sup>14</sup>

### 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 analysis<sup>15</sup>
- Detectability of innovation
- Benefits of available protection<sup>16</sup>
- Costs, including patent application and maintenance fees
- Searches, including search result limitations<sup>17</sup>
- Risks of patent protection<sup>18</sup>

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<sup>10</sup> 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.

<sup>11</sup> Needs and goals include general, commercial, financial, legal, and innovation needs and goals.

<sup>12</sup> 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.

<sup>13</sup> 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).

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

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

<sup>16</sup> 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.

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

<sup>18</sup> 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 objectives<sup>19</sup>
2. Draft claims, of multiple claim types,<sup>20</sup> with proper scope, characteristics, and structure<sup>21</sup>
3. Describe an invention,<sup>22</sup> 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

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

<sup>20</sup> 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).

<sup>21</sup> 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.

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



## D. Prosecute<sup>23</sup> a patent application [Prosecution]

### Performance criteria

1. Analyze a patent family file history<sup>24</sup>
2. Assess the citability of prior art for anticipation and obviousness
3. Respond to an office action<sup>25</sup>
4. Prepare substantive submissions to CIPO other than in response to an office action<sup>26</sup>
5. Amend<sup>27</sup> independent or dependent claims, as appropriate
6. Manage Canadian prosecution in the context of a global portfolio

*Knowledge concepts appear on the next page.*

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

<sup>24</sup> 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.

<sup>25</sup> 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.

<sup>26</sup> 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.

<sup>27</sup> 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 CIPO<sup>28</sup>
- Deemed expiry and reversal
- Disclosure of prior art
- Divisional practice
- Due care
- Examiner interview process
- Expediting or advancing examination<sup>29</sup>
- Fee payment requirements, including small entity, claims, and maintenance
- Filing electronically with CIPO and WIPO
- Final action practice
- Patent prosecution process<sup>30</sup>
- Patent Register listing requirements
- PCT filing and prosecution procedure<sup>31</sup>
- Post grant prosecution<sup>32</sup>
- Priority<sup>33</sup>
- Protests and filings of prior art prior to grant
- Registration of documents<sup>34</sup>
- 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

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<sup>28</sup> 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.

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

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

<sup>31</sup> PCT filing and prosecution procedure includes both International and National Phases.

<sup>32</sup> 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*.

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

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

## E. Assess validity<sup>35</sup> [Validity]

### Performance criteria

1. Identify, given a set of facts, validity issues beyond claim validity issues<sup>36</sup>
2. Construe<sup>37</sup> 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

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<sup>35</sup> 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.

<sup>36</sup> 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).

<sup>37</sup> 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),<sup>38</sup> potential defendants, and onus of proof<sup>39</sup>
- Patent term and extension<sup>40</sup>
- Patented medicines regime<sup>41</sup>

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

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

<sup>40</sup> Patent term and extension includes maintenance and restoration of expired patents and intervening rights.

<sup>41</sup> 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*.

- Remedies<sup>42</sup>
- 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

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<sup>42</sup> 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 cases<sup>43</sup> 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](http://wipo.int))
- *Paris Convention for the Protection of Industrial Property*, as amended September 28, 1979
- *Singapore treaty* ([wipo.int](http://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.*

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<sup>43</sup> 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 goodwill<sup>44</sup>
- Distinctiveness (inherent and acquired)
- Entitlement to registration<sup>45</sup>
- Entitlement to use
- History of the trademark protection system
- Formal and technical requirements
- Fundamentals of statutory interpretation
- Infringement<sup>46</sup>
- Madrid Protocol in Canada
- Ownership
- Passing off<sup>47</sup>
- Professional responsibilities<sup>48</sup>
- Prohibited marks<sup>49</sup>
- Registrability
- Technical objections<sup>50</sup>
- Trade names
- Trademark agent privilege
- Trademark timelines and deadlines<sup>51</sup>
- Types of intellectual property protection
- Types of trademarks<sup>52</sup>
- Use in association with goods or services

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

<sup>45</sup> 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*.

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

<sup>47</sup> 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.

<sup>48</sup> 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

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

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

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

<sup>52</sup> 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 descriptiveness<sup>53</sup>
6. Assess entitlement to registration<sup>54</sup>
7. Identify, given a set of facts, potential areas of conflict with third parties
8. Identify, given a set of facts, prohibited marks<sup>55</sup>
9. Identify, given a set of facts, potential technical objections<sup>56</sup>

### Knowledge concepts

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

- Registrable trademarks<sup>57</sup>
- Searches,<sup>58</sup> including trademark status<sup>59</sup> and search result limitations<sup>60</sup>

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<sup>53</sup> Descriptiveness (in the context of assessment thereof) includes assessment of mis-descriptiveness.

<sup>54</sup> 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*.

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

<sup>56</sup> 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.

<sup>57</sup> Registrable trademarks are defined by section 12 of the *Trademarks Act*.

<sup>58</sup> 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.

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

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

## C. Develop a client-centred trademark strategy<sup>61</sup> [Strategy]

### Performance criteria

1. Identify a client's needs and goals<sup>62</sup>
2. Identify, given a set of facts, available types of intellectual property protection, including types of trademarks<sup>63</sup>
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 use<sup>64</sup>
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 registrable<sup>65</sup>
10. Identify, given a set of facts, practical ways to manage a portfolio<sup>66</sup> for domestic and international protection
11. Identify, given a set of facts, limits on agent privilege<sup>67</sup>

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

<sup>62</sup> Needs and goals include general, commercial, financial, legal, and innovation needs and goals.

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

<sup>64</sup> 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.

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

<sup>66</sup> 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.

<sup>67</sup> 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 resources<sup>68</sup>
- Official fees and fee structure
- Licensing and licensed use<sup>69</sup>
- Marking (e.g., TM, MC, ®, MD), including on labeling and packaging
- Monitoring and enforcing trademark rights and use
- Other trademark-related limitations<sup>70</sup>

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<sup>68</sup> 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.)).

<sup>69</sup> 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.

<sup>70</sup> 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 action<sup>71</sup>
5. Support the preparation and negotiation of consent and co-existence agreements
6. Manage Canadian prosecution in the context of a global portfolio<sup>72</sup>

### Knowledge concepts

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

- Application and filing requirements<sup>73</sup>
- 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 issues<sup>74</sup>
- Registration<sup>75</sup> and registered rights<sup>76</sup>

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<sup>71</sup> 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.

<sup>72</sup> 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.

<sup>73</sup> 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.

<sup>74</sup> 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.

<sup>75</sup> 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.

<sup>76</sup> 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 use<sup>77</sup>
2. Assess grounds of opposition
3. Identify, given a set of facts, deficiencies in evidence<sup>78</sup>
4. Prepare formal requests<sup>79</sup>
5. Manage the collection, assessment, and preparation of evidence<sup>80</sup>
6. Conduct cross-examinations, as appropriate
7. Conduct oral hearings, as appropriate
8. Prepare representations<sup>81</sup>
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 requirements<sup>82</sup>
- Extension requests
- Grounds of opposition<sup>83</sup>
- Interlocutory ruling requests
- Opposition strategy
- Requirements for filing a Statement of Opposition or preparing a counterstatement (including amendments)

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

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

<sup>79</sup> 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*).

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

<sup>81</sup> Representations refer to written representations, oral representations, or both.

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

<sup>83</sup> 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