

First Name: \_\_\_\_\_

Last Name: \_\_\_\_\_

## Prior Experience Assessment Form

### Trademark Agent (Technical)

#### Overview

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

A Canadian Trademark Agent can:

- A. Demonstrate foundational knowledge
- 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

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

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

## A. Demonstrate foundational knowledge [Knowledge]

Competencies	I have received training and/or education in this competency	Sources (i.e transcript courses, letter of attestation...)	Please indicate if any areas were partially, and not completely, covered
1) Sources Demonstrate familiarity with the following sources:			
a) Primary sources			
• <i>Trademarks Act, RSC 1985, c T-13 [Trademarks Act]</i>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• <i>Trademarks Regulations, SOR/2018-227 [Trademarks Regulations]</i>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• <i>Trademarks Examination Manual, RG42-4/1996 [Trademarks Examination Manual]</i>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• <i>CIPO Trademark Practice Notices, available <a href="#">online</a></i>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• <i>CIPO Goods and Services Manual, available <a href="#">online</a></i>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• <i>Leading Canadian cases in trademark law</i>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
b) Secondary sources			
• <i>Madrid Agreement Concerning the International Registration of Marks (1891) and the Protocol Relating to that Agreement (1989)</i>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• <i>Nice Classification (<a href="#">wipo.int</a>)</i>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• <i>Paris Convention for the Protection of Industrial Property, as amended September 28, 1979</i>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• <i>Singapore treaty (<a href="#">wipo.int</a>)</i>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• <i>United Nations Declaration on the Rights of Indigenous Peoples, Articles 24 and 31</i>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
c) Professional sources			
• <i>College of Patent Agents and Trademark Agents Act, SC 2018, c27, s 247 [CPATA Act]</i>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• <i>College of Patent Agents and Trademark Agents Regulations, SOR/2021-129 [CPATA Regulations]</i>	<input type="checkbox"/> Training <input type="checkbox"/> Education		

<ul style="list-style-type: none"> <li>• <i>By-laws of the College of Patent Agents and Trademark Agents, SOR/2021-167 [CPATA Bylaws]</i></li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <li>• <i>Code of Professional Conduct for Patent Agents and Trademark Agents [Code of Professional Conduct]</i></li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<b>2) Knowledge Concepts</b> Understand the following foundational concepts:			
<ul style="list-style-type: none"> <li>• Confusion</li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <li>• Definition of a trademark</li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <li>• Descriptiveness</li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <li>• Depreciation of goodwill</li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <li>• Distinctiveness (inherent and acquired)</li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <li>• Entitlement to registration</li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <li>• Entitlement to use</li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <li>• History of the trademark protection system</li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <li>• Formal and technical requirements</li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <li>• Fundamentals of statutory interpretation</li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <li>• Infringement</li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <li>• Madrid Protocol in Canada</li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <li>• Ownership</li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <li>• Passing off</li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <li>• Professional responsibilities</li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <li>• Prohibited marks</li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		

• Registrability	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Technical objections	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Trade names	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Trademark agent privilege	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Trademark timelines and deadlines	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Types of intellectual property protection	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Types of trademarks	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Use in association with goods or services	<input type="checkbox"/> Training <input type="checkbox"/> Education		

## B. Assess the registrability of a trademark [Registrability]

Competencies	I have received training and/or education in this competency	Sources (i.e transcript courses, letter of attestation...)	Please indicate if any areas were partially, and not completely, covered
1) Performance criteria			
• Plan a trademark search	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Interpret search results	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Assess distinctiveness	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Assess likelihood of confusion	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Assess descriptiveness	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Assess entitlement to registration	<input type="checkbox"/> Training <input type="checkbox"/> Education		



• Identify, given a set of facts, potential areas of conflict with third parties	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Identify, given a set of facts, prohibited marks	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Identify, given a set of facts, potential technical objections	<input type="checkbox"/> Training <input type="checkbox"/> Education		
2) Knowledge concepts In addition to the foundational knowledge concepts, understand the following:			
• Registrable trademarks	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Searches including trademark status and search result limitations	<input type="checkbox"/> Training <input type="checkbox"/> Education		

### C. Develop a client-centred trademark strategy [strategy]

Competencies	I have received training and/or education in this competency	Sources (i.e transcript courses, letter of attestation...)	Please indicate if any areas were partially, and not completely, covered
1) Performance criteria			
• Identify a client's needs and goals	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Identify, given a set of facts, available types of intellectual property protection, including types of trademarks	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Outline, given a set of facts, the costs and benefits of trademark protection	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Outline, given a set of facts, practical and strategic timelines	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Analyze situations involving trademark use	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Analyze situations involving trademark ownership, licensing, or transfer of rights	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Assess a registration's vulnerability to invalidation	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Identify, given a set of facts, when a new application or an application to extend a statement of goods or services is advisable	<input type="checkbox"/> Training <input type="checkbox"/> Education		

• Identify, given a set of facts, strategies for rendering a mark registrable	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Identify, given a set of facts, practical ways to manage a portfolio for domestic and international protection	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Identify, given a set of facts, limits on agent privilege	<input type="checkbox"/> Training <input type="checkbox"/> Education		
2) Knowledge concepts In addition to the foundational knowledge concepts, understand the following:			
• Rights that exist in the absence of registration	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Cross-border intellectual property fraud and cross-border protection resources	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Official fees and fee structure	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Licensing and licensed use	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Marking (e.g., TM, MC, ®, MD), including on labeling and packaging	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Monitoring and enforcing trademark rights and use	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Other trademark-related limitations	<input type="checkbox"/> Training <input type="checkbox"/> Education		

#### D. Prosecute a trademark application [Prosecution]

Competencies	I have received training and/or education in this competency	Sources (i.e transcript courses, letter of attestation...)	Please indicate if any areas were partially, and not completely, covered
1) Performance criteria			
• Analyze a trademark file history	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Classify goods and services	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Draft a statement of goods and services	<input type="checkbox"/> Training <input type="checkbox"/> Education		

• Respond to an office action	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Support the preparation and negotiation of consent and co-existence agreements	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Manage Canadian prosecution in the context of a global portfolio	<input type="checkbox"/> Training <input type="checkbox"/> Education		
2) Knowledge concepts In addition to the foundational knowledge concepts, understand the following:			
• Application and filing requirements	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Classifications of good and services (according to Nice Classification)	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Consent and co-existence agreements	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Divisional applications and merger of registrations	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Geographical indications	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Notification of Third-Party Rights (including process and criteria)	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Office actions (including deficiencies and objections by the Registrar of Trademarks)	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Office practice	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Ownership issues	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Registration and registered rights	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Requirements for a statement of goods or services	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Requirements to be a person entitled to trademark registration	<input type="checkbox"/> Training <input type="checkbox"/> Education		

## E. Represent a client before the Trademarks Opposition Board [Opposition and s. 45 proceedings]

Competencies	I have received training and/or education in this competency	Sources (i.e transcript courses, letter of attestation...)	Please indicate if any areas were partially, and not completely, covered
1) Performance criteria			
<ul style="list-style-type: none"> <li>Assess whether a registration is likely to be expunged or amended for lack of use</li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <li>Assess grounds of opposition</li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <li>Identify, given a set of facts, deficiencies in evidence</li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <li>Prepare formal requests</li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <li>Manage the collection, assessment, and preparation of evidence</li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <li>Conduct cross-examinations, as appropriate</li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <li>Conduct oral hearings, as appropriate</li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <li>Prepare representations</li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <li>Negotiate settlements, as appropriate</li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
2) Knowledge concepts In addition to the foundational knowledge concepts, understand the following:			
<ul style="list-style-type: none"> <li>Cross-examination (including requirements and best practices)</li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <li>Elements of a written argument</li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <li>Evidentiary rules and requirements</li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		
<ul style="list-style-type: none"> <li>Extension requests</li> </ul>	<input type="checkbox"/> Training <input type="checkbox"/> Education		

• Grounds of opposition	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Interlocutory ruling requests	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Opposition strategy	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Requirements for filing a Statement of Opposition or preparing a counterstatement (including amendments)	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Service rules and requirements	<input type="checkbox"/> Training <input type="checkbox"/> Education		
• Summary cancellation (s. 45) proceedings and related law and procedure	<input type="checkbox"/> Training <input type="checkbox"/> Education		

Date:

Signature: