

First name: _____

Last name: _____

Prior Experience Assessment Form Patent 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 Patent Agent can:

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

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 through your portal. 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>Patent Act, RSC 1985, c P-4 [Patent Act]</i>	☐ Training ☐ Education		
• <i>Patent Rules, SOR/2019-251 [Patent Rules]</i>	☐ Training ☐ Education		
• <i>Manual of Patent Office Practice [MOPOP]</i>	☐ Training ☐ Education		
• <i>Patent Cooperation Treaty, June 19, 1970, [1990] Can. T.S. No. 22 [PCT] and Regulations SOR/89-453</i>	☐ Training ☐ Education		
• <i>PCT Applicant's Guide: The PCT Applicant's Guide (wipo.int)</i>	☐ Training ☐ Education		
• <i>Leading Canadian cases and seminal international cases in patent law</i>	☐ Training ☐ Education		
b) Secondary sources			
• <i>Paris Convention for the Protection of Industrial Property, as amended September 28, 1979</i>	☐ Training ☐ Education		
• <i>Patent Law Treaty (PLT), as adopted by the Diplomatic Conference on June 1, 2000</i>	☐ Training ☐ Education		
• <i>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</i>	☐ Training ☐ Education		
• <i>PCT Receiving Office Guidelines (wipo.int) (wipo.int)</i>	☐ Training ☐ Education		
• <i>CIPO Patent Practice Notices, available online</i>	☐ Training ☐ Education		
• <i>United Nations Declaration on the Rights of Indigenous Peoples, Articles 24 and 31</i>	☐ Training ☐ Education		

c) Professional sources			
College of Patent Agents and Trademark Agents Act, SC 2018, c27, s 247 [CPATA Act]	☐ Training ☐ Education		
College of Patent Agents and Trademark Agents Regulations, SOR/2021-129 [CPATA Regulations]	☐ Training ☐ Education		
By-laws of the College of Patent Agents and Trademark Agents, SOR/2021-167 [CPATA Bylaws]	☐ Training ☐ Education		
Code of Professional Conduct for Patent Agents and Trademark Agents [Code of Professional Conduct]	☐ Training ☐ Education		
2) Knowledge concepts			
Understand the following foundational concepts:			
Types of intellectual property protection	☐ Training ☐ Education		
Scope of the monopoly granted under a patent, i.e., exclusive rights granted to a patentee	☐ Training ☐ Education		
- Patent claims, namely: - Claim types - Claim construction principles	☐ Training ☐ Education		
- 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	☐ Training ☐ Education		
- Patent process, namely: - Inventorship and ownership - 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 - Applicable courts and appeal routes	☐ Training ☐ Education		

• Registration and recording of documents and events affecting title	☐ Training ☐ Education		
• Professional responsibilities	☐ Training ☐ Education		

B. Develop a client-centered patent 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	☐ Training ☐ Education		
• Assess the innovation context	☐ Training ☐ Education		
• Identify, given a set of facts, available types of intellectual property protection	☐ Training ☐ Education		
• Plan a patent search	☐ Training ☐ Education		
• Interpret search results	☐ Training ☐ Education		
• Define the scope and breadth of protection available in view of the prior art	☐ Training ☐ Education		
• Outline, given a set of facts, the costs, and benefits of patent protection	☐ Training ☐ Education		
• Outline, given a set of facts, practical and strategic timelines	☐ Training ☐ Education		
• Plan strategies for protection outside of Canada	☐ Training ☐ Education		
• Identify, given a set of facts, limits on patent agent privilege	☐ Training ☐ Education		
2) Knowledge concepts In addition to the foundational knowledge concepts, understand the following:			

• Issues in patentability requirements in different countries (especially in the United States)	☐ Training ☐ Education		
• Commercially valuable claims	☐ Training ☐ Education		
• Actor analysis	☐ Training ☐ Education		
• Detectability of innovation	☐ Training ☐ Education		
• Benefits of available protection	☐ Training ☐ Education		
• Costs, including patent application and maintenance fees	☐ Training ☐ Education		
• Searches, including search result limitations	☐ Training ☐ Education		
• Risks of patent protection	☐ Training ☐ Education		

C. Draft a patent application [Drafting]

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, given a set of facts, claim drafting objectives	☐ Training ☐ Education		
• Draft claims, of multiple claim types, with proper scope, characteristics, and structure	☐ Training ☐ Education		
• Describe an invention, including its embodiments and alternatives	☐ Training ☐ Education		
• Plan the drawings that illustrate the features of an invention	☐ Training ☐ Education		
2) Knowledge concepts In addition to the foundational knowledge concepts, understand the following:			

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

D. Prosecute a patent 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 patent family file history	☐ Training ☐ Education		
• Assess the citability of prior art for anticipation and obviousness	☐ Training ☐ Education		
• Respond to an office action	☐ Training ☐ Education		
• Prepare substantive submissions to CIPO other than in response to an office action	☐ Training ☐ Education		
• Amend independent or dependent claims, as appropriate	☐ Training ☐ Education		
• Manage Canadian prosecution in the context of a global portfolio	☐ Training ☐ Education		

2) Knowledge concepts In addition to the foundational knowledge concepts, understand the following:			
• Abandonment and reinstatement	☐ Training ☐ Education		
• Affidavit practice	☐ Training ☐ Education		
• Allowance, final fee, and issuance	☐ Training ☐ Education		
• Appeals, including Patent Appeal Board	☐ Training ☐ Education		
• Authorized representative and common representative	☐ Training ☐ Education		
• Best practice in making submissions to CIPO	☐ Training ☐ Education		
• Deemed expiry and reversal	☐ Training ☐ Education		
• Disclosure of prior art	☐ Training ☐ Education		
• Divisional practice	☐ Training ☐ Education		
• Due care	☐ Training ☐ Education		
• Examiner interview process	☐ Training ☐ Education		
• Expediting or advancing examination	☐ Training ☐ Education		
• Fee payment requirements, including small entity, claims, and maintenance	☐ Training ☐ Education		
• Filing electronically with CIPO and WIPO	☐ Training ☐ Education		
• Final action practice	☐ Training ☐ Education		
• Patent prosecution process	☐ Training ☐ Education		
• Patent Register listing requirements	☐ Training ☐ Education		
• PCT filing and prosecution procedure	☐ Training ☐ Education		

• Post grant prosecution	☐ Training ☐ Education		
• Priority	☐ Training ☐ Education		
• Protests and filings of prior art prior to grant	☐ Training ☐ Education		
• Registration of documents	☐ Training ☐ Education		
• Request for examination	☐ Training ☐ Education		
• Requirements for CIPO communications	☐ Training ☐ Education		
• Requirements to obtain a filing date	☐ Training ☐ Education		
• Third party rights	☐ Training ☐ Education		
• Transfers and changes of name	☐ Training ☐ Education		
• Verification of the administrative status of a patent application or a patent	☐ Training ☐ Education		

E. Assess validity [Validity]

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, given a set of facts, validity issues beyond claim validity issues	☐ Training ☐ Education		
• Construe claim terms for the purpose of assessing validity	☐ Training ☐ Education		
• Assess the citability of a document or disclosure event for anticipation and obviousness	☐ Training ☐ Education		
• Assess whether a claim is anticipated, given the prior art	☐ Training ☐ Education		

Assess whether a claim is obvious, given the prior art	☐ Training ☐ Education		
Assess the validity of a claim, for reasons other than anticipation or obviousness	☐ Training ☐ Education		
2) Knowledge concepts In addition to the foundational knowledge concepts, understand the following:			
Claim dates	☐ Training ☐ Education		
Effect of representations in prosecution or in the petition	☐ Training ☐ Education		
Proper forums for impeaching a patent	☐ Training ☐ Education		
Re-examination, disclaimer, and reissue	☐ Training ☐ Education		

F. Assess Infringement [Infringement]

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			
Construe claim terms for the purpose of assessing infringement	☐ Training ☐ Education		
Identify, given a set of facts, potential acts of infringement	☐ Training ☐ Education		
Analyze a claim to determine infringement	☐ Training ☐ Education		
Identify, given a set of facts, who can or must assert infringement	☐ Training ☐ Education		
Assess whether one or more parties are liable for infringement	☐ Training ☐ Education		
Assess whether a party is liable for inducing infringement	☐ Training ☐ Education		
Identify, given a set of facts, defenses to an allegation of infringement	☐ Training ☐ Education		

• Outline potentially available remedies for infringement	☐ Training ☐ Education		
2) 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	☐ Training ☐ Education		
- 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	☐ Training ☐ Education		
• Proper plaintiff(s), potential defendants, and onus of proof	☐ Training ☐ Education		
• Patent term and extension	☐ Training ☐ Education		
• Patented medicines regime	☐ Training ☐ Education		
• Remedies	☐ Training ☐ Education		
• Limitation periods	☐ Training ☐ Education		

Date:

Signature: