

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 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>Trademarks Act, RSC 1985, c T-13 [Trademarks Act]</i>	☐ Training ☐ Education		
• <i>Trademarks Regulations, SOR/2018-227 [Trademarks Regulations]</i>	☐ Training ☐ Education		
• <i>Trademarks Examination Manual, RG42-4/1996 [Trademarks Examination Manual]</i>	☐ Training ☐ Education		
• <i>CIPO Trademark Practice Notices, available online</i>	☐ Training ☐ Education		
• <i>CIPO Goods and Services Manual, available online</i>	☐ Training ☐ Education		
• <i>Leading Canadian cases in trademark law</i>	☐ Training ☐ Education		
b) Secondary sources			
• <i>Madrid Agreement Concerning the International Registration of Marks (1891) and the Protocol Relating to that Agreement (1989)</i>	☐ Training ☐ Education		
• <i>Nice Classification (wipo.int)</i>	☐ Training ☐ Education		
• <i>Paris Convention for the Protection of Industrial Property, as amended September 28, 1979</i>	☐ Training ☐ Education		
• <i>Singapore treaty (wipo.int)</i>	☐ Training ☐ Education		
• <i>United Nations Declaration on the Rights of Indigenous Peoples, Articles 24 and 31</i>	☐ Training ☐ Education		
c) Professional sources			
• <i>College of Patent Agents and Trademark Agents Act, SC 2018, c27, s 247 [CPATA Act]</i>	☐ Training ☐ Education		
• <i>College of Patent Agents and Trademark Agents Regulations, SOR/2021-129 [CPATA Regulations]</i>	☐ Training ☐ Education		

• <i>By-laws of the College of Patent Agents and Trademark Agents, SOR/2021-167 [CPATA Bylaws]</i>	☐ Training ☐ Education		
• <i>Code of Professional Conduct for Patent Agents and Trademark Agents [Code of Professional Conduct]</i>	☐ Training ☐ Education		
2) Knowledge Concepts Understand the following foundational concepts:			
• Confusion	☐ Training ☐ Education		
• Definition of a trademark	☐ Training ☐ Education		
• Descriptiveness	☐ Training ☐ Education		
• Depreciation of goodwill	☐ Training ☐ Education		
• Distinctiveness (inherent and acquired)	☐ Training ☐ Education		
• Entitlement to registration	☐ Training ☐ Education		
• Entitlement to use	☐ Training ☐ Education		
• History of the trademark protection system	☐ Training ☐ Education		
• Formal and technical requirements	☐ Training ☐ Education		
• Fundamentals of statutory interpretation	☐ Training ☐ Education		
• Infringement	☐ Training ☐ Education		
• Madrid Protocol in Canada	☐ Training ☐ Education		
• Ownership	☐ Training ☐ Education		
• Passing off	☐ Training ☐ Education		
• Professional responsibilities	☐ Training ☐ Education		
• Prohibited marks	☐ Training ☐ Education		

• Registrability	☐ Training ☐ Education		
• Technical objections	☐ Training ☐ Education		
• Trade names	☐ Training ☐ Education		
• Trademark agent privilege	☐ Training ☐ Education		
• Trademark timelines and deadlines	☐ Training ☐ Education		
• Types of intellectual property protection	☐ Training ☐ Education		
• Types of trademarks	☐ Training ☐ Education		
• Use in association with goods or services	☐ Training ☐ 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	☐ Training ☐ Education		
• Interpret search results	☐ Training ☐ Education		
• Assess distinctiveness	☐ Training ☐ Education		
• Assess likelihood of confusion	☐ Training ☐ Education		
• Assess descriptiveness	☐ Training ☐ Education		
• Assess entitlement to registration	☐ Training ☐ Education		

• Identify, given a set of facts, potential areas of conflict with third parties	☐ Training ☐ Education		
• Identify, given a set of facts, prohibited marks	☐ Training ☐ Education		
• Identify, given a set of facts, potential technical objections	☐ Training ☐ Education		
2) Knowledge concepts In addition to the foundational knowledge concepts, understand the following:			
• Registrable trademarks	☐ Training ☐ Education		
• Searches including trademark status and search result limitations	☐ Training ☐ 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	☐ Training ☐ Education		
• Identify, given a set of facts, available types of intellectual property protection, including types of trademarks	☐ Training ☐ Education		
• Outline, given a set of facts, the costs and benefits of trademark protection	☐ Training ☐ Education		
• Outline, given a set of facts, practical and strategic timelines	☐ Training ☐ Education		
• Analyze situations involving trademark use	☐ Training ☐ Education		
• Analyze situations involving trademark ownership, licensing, or transfer of rights	☐ Training ☐ Education		
• Assess a registration's vulnerability to invalidation	☐ Training ☐ Education		
• Identify, given a set of facts, when a new application or an application to extend a statement of goods or services is advisable	☐ Training ☐ Education		

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

• Respond to an office action	☐ Training ☐ Education		
• Support the preparation and negotiation of consent and co-existence agreements	☐ 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:			
• Application and filing requirements	☐ Training ☐ Education		
• Classifications of good and services (according to Nice Classification)	☐ Training ☐ Education		
• Consent and co-existence agreements	☐ Training ☐ Education		
• Divisional applications and merger of registrations	☐ Training ☐ Education		
• Geographical indications	☐ Training ☐ Education		
• Notification of Third-Party Rights (including process and criteria)	☐ Training ☐ Education		
• Office actions (including deficiencies and objections by the Registrar of Trademarks)	☐ Training ☐ Education		
• Office practice	☐ Training ☐ Education		
• Ownership issues	☐ Training ☐ Education		
• Registration and registered rights	☐ Training ☐ Education		
• Requirements for a statement of goods or services	☐ Training ☐ Education		
• Requirements to be a person entitled to trademark registration	☐ Training ☐ 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			
Assess whether a registration is likely to be expunged or amended for lack of use	☐ Training ☐ Education		
Assess grounds of opposition	☐ Training ☐ Education		
Identify, given a set of facts, deficiencies in evidence	☐ Training ☐ Education		
Prepare formal requests	☐ Training ☐ Education		
Manage the collection, assessment, and preparation of evidence	☐ Training ☐ Education		
Conduct cross-examinations, as appropriate	☐ Training ☐ Education		
Conduct oral hearings, as appropriate	☐ Training ☐ Education		
Prepare representations	☐ Training ☐ Education		
Negotiate settlements, as appropriate	☐ Training ☐ Education		
2) Knowledge concepts In addition to the foundational knowledge concepts, understand the following:			
Cross-examination (including requirements and best practices)	☐ Training ☐ Education		
Elements of a written argument	☐ Training ☐ Education		
Evidentiary rules and requirements	☐ Training ☐ Education		
Extension requests	☐ Training ☐ Education		

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

Date:

Signature: