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By Email: krista.pearce@ic.gc.ca

Krista Pearce
Senior Legislation and Patent Policy Analyst
Canadian Intellectual Property Office
Patent Branch
50 Victoria Street
Gatineau, Québec
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Dear Ms. Pearce:

**Re: Proposed Amendments to the Patent Rules and
Trade-marks Regulations - Agents Qualifying Examinations**

FICPI Canada wishes to thank the Canadian Intellectual Property Office for the opportunity to comment on the proposed amendments to the Patent Rules and Trade-Marks Regulations: Patent and Trade-Marks Agents Qualifying Examinations.

As you may know, FICPI (the Federation Internationale des Conseils en Propriété Industrielle), comprises more than 3500 intellectual property attorneys in private practice in 86 countries. FICPI Canada is a self-governing national association of FICPI and represents the interests of Canadian patent and trade mark professionals. Our membership includes senior professionals at most major Canadian intellectual property firms. Our clients span all types and sizes of businesses, including multi-national corporations, small and medium size enterprises, and individuals.

Experience required to sit for the Patent Agent Exam

FICPI Canada agrees with the proposed amendment to section 12 of the *Patent Rules* to increase the length of the working/training requirement from at least 12 months to at least 24. FICPI Canada shares CIPO's belief that prospective agents will benefit from the increased minimum working term by providing them

with a more substantive foundation in Canadian patent law and practice prior to sitting for the exams.

Experience required to sit for the Trade-Marks Agent Exam

FICPI Canada is in agreement with the proposed changes to the Trade-marks Regulations that would allow persons employed by the Office of the Registrar who have the requisite experience, to sit the examination.

FICPI Canada also agrees with the proposal to amend Section 18 of the *Trade-marks Regulations* so as to require all individuals – Barristers and Solicitors included – to obtain 24 months of experience and pass the qualifying examination prior to having their name entered on the list of Trade-mark agents. FICPI Canada does however consider it important to preserve the ability for those currently qualified to have their name included on the list of agents to continue to do so without having to meet the requirement for experience or sit the exam.

Date of the Agent Qualifying Examinations

FICPI Canada understands CIPO's need to provide more flexibility in controlling the exam process timeline, and conditionally supports the proposed amendment to section 14 of the *Patent Rules* and section 20 of the *Trade-marks Regulations* provided the timing of the examinations does not interfere with a candidate's ability to write the examinations within a reasonable period of time, taking into consideration the increased working time requirement proposed in the amendment to section 12 of the *Patent Rules*. For example, if the examinations were held in January of one calendar year, they should be held no later than January of the following calendar year. Otherwise, a candidate having completed his/her working term in time to write an anticipated January examination date would have to wait a further year before sitting the examinations.

Communications with Candidates

FICPI Canada agrees with the proposed amendments to subsections 4(11), 14(2) and 14(3) of the *Patent Rules* and subsections 20(2), 20(3) and 21 of the *Trade-Marks Regulations*.

Refund of the Patent Agent Qualifying Examination Fee

FICPI Canada agrees with the proposed amendments to subsection 4(11) of the *Patent Rules*.

Names Entered on the List of Trade-Mark Agents and Transitional Provision

As suggested above, FICPI Canada agrees with the proposed amendment to henceforth require all newly qualified Agents to have passed the qualifying exam prior to having their names entered on the list of Trade-mark Agents regardless of whether an individual is a Barrister and Solicitor. FICPI Canada is also in agreement with the proposed transitional provision.

Patent Agents Register and Trade-Mark Agents List to be publicly Available

FICPI Canada has no objection to the lists of qualified Patent and Trade-mark Agents to be made publically available.

Removal from the List of Trade-Mark Agents When They Fail to Pay the Renewal Fee or No Longer Meet the Requirements and Reinstatement

FICPI Canada takes the view that while revisions to section 22(2) of the Regulations are acceptable, the proposed provisions to Section 23 are not, inasmuch as these appear to require an Agent to pass the examination in order to be reinstated. As the proposed Section 23 wording calls for the agent to meet the requirements of section 21, i.e. pass the qualifying examination, the proposed provision does not contemplate the scenario whereby an Agent who had previously qualified by virtue of being a Barrister and Solicitor and having the requisite experience, must now for the first time pass the examination to continue practice. Our concern is that someone with years of experience and qualification would, for what might have been a technicality such as having moved firms and missed the notice, would be required to pass the examination to be reinstated. This is a very harsh punishment for what it likely to have been mere inadvertence and for this reason the proposed S. 23 is, in FICPI Canada's view, unacceptable.

We encourage CIPO to delete proposed Section 23(b) thereby permitting reinstatement upon reconciliation of the deficiency comprising failure to make the requisite payment and/or failure to file the necessary statement.

FICPI Canada wishes to thank the Canadian Intellectual Property Office for the opportunity to provide comments. If CIPO has any comments about our submissions, please do not hesitate to contact the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'R. Storey', with a long horizontal stroke extending to the right.

Robert B. Storey, President - FICPI Canada
Coleen Morrison, Secretary
Stephen Perry, Member of Council