



# FICPI CANADA

## President's Report

April, 2006

I am pleased to report that FICPI Canada has been active over the past year, continuing to grow in size, and to work for the benefit of its members and the patent profession in Canada.

Let me introduce the members of Council of FICPI Canada.

Edwin J. Gale of Kirby Eades Gale & Baker, in Ottawa is our Past President, and has been a member of Council for several terms. Ingrid Schmidt of Gowlings (Hamilton) is our Vice-President. Michael I. Stewart of Sim & McBurney in Toronto is the Treasurer. Robert Storey of Bereskin & Parr is our Secretary. Our council members are Alain Leclerc of Goudreau Gage Dubuc/Fasken Martineau Walker in Montreal, and John Knox of Smart & Biggar in Vancouver.

These council members will hold office until the Paris Congress in June 2006. A Nominating Committee of Past Presidents has been formed and will be responsible for presenting a slate of Council members, both new and old, for election at our annual general meeting which will take place during the Congress.

### **Membership and Associate Members**

As you know, our constitution permits (with some restrictions on relative numbers) both registered patent agents and registered trade-mark agents in private practice to join as members of FICPI Canada and thereby become members of the international organization.

About 2 - 3 years ago, we amended our constitution to permit persons who are in training to write the patent agent or trade-mark agent qualifying examinations to become associates of FICPI Canada. It is our hope that by providing this opportunity, we will encourage these people to become involved with FICPI at a relatively early stage in their careers.

We have welcomed several new members of FICPI Canada in the last several months. Please welcome **Alexandra Daoud**, of Ogilvy Renault; **Judy Errat** of Gowlings; **Sean Zhang** of Blake, Cassels & Graydon; **Jennifer Jannuska** of Deeth Williams Wall LLP; **Robert G. Hirons**, who has rejoined FICPI Canada after a few years absence; **Dennis Leung** of Shapiro Cohen; **Geoffrey de Kleine** of Perry & Partners; **Nicolas Pellemans** of Ogilvy Renault (also rejoining after a short absence); **Keith Bird** of Lang Michener; **Bayo Odutola** of Odutola Professional Group; **Toni Ashton** of Sim & McBurney; **Steven Leach** of Ridout & Maybee; **Jung-Kay Chiu** of Ogilvy Renault; **Armand Benitah** of Fasken Martineau DuMoulin; **France Cote** of Bereskin & Parr; **Hetal Kushwara** of Marks & Clerk; and **Christine Hicks** of Hicks & Penman.

Please encourage your colleagues to consider joining, and your junior colleagues and trainees to consider becoming associates of, FICPI Canada.

### **Self- Governance and Privilege**

FICPI has long supported, and been a strong advocate for, the self-regulation of the patent agent profession in Canada, and for codification of the right of a client to assert privilege in communications with a patent agent. FICPI Canada has made submissions in support of these recommendations to a number of government bodies. Two of our members, Robert Mitchell and Joan van Zant, have been at the forefront of this issue and have been strongly supported by other members of FICPI Canada.

FICPI is also concerned that the present arrangement of reciprocity between the patent agent registers of Canada and other countries is seen by others to benefit Canadian patent agents unfairly. While foreign (including U.S.) patent agents can be listed on the register of Canadian patent agents, they cannot effectively practice before the Canadian Patent

Office because they are not residents of Canada. This “residence requirement” may be incompatible with NAFTA, although there is presently a reservation covering this under Chapter 12 of NAFTA.

FICPI Canada continues to be concerned that this reservation might not survive, and that attorneys from other countries might be able to practice before the Canadian Patent Office directly from their home countries. One solution that FICPI has advanced would be to change the rules to require anyone to sit the Canadian qualifying exams before being added to the register, regardless of whether they are registered in a foreign country. This may lead to similar requirements in other countries, particularly the USA, but it may be a small price to pay to protect the Canadian profession.

#### **Ontario’s Bill 14**

The Ontario Government has introduced Bill 14, which is intended to amend the Law Society Act and other statutes, to provide, inter alia, for the regulation of all persons providing “legal services” in the Province of Ontario.

The Law Society Act currently provides for the qualification and regulation of lawyers practising law in Ontario. Bill 14 provides for the qualification and regulation of persons, other than lawyers, who provide legal services in Ontario. The types of conduct and activities that constitute the provision of legal services are set out in the new subsections 1 (5), (6) and (7) of the Act. These include:

1. [Giving] a person advice with respect to the legal interests, rights or responsibilities of the person or of another person.
2. [Selecting, drafting, completing or revising],
  - i. a document that affects a person's interests in or rights to or in real or personal property,

- vi. a document that affects the legal interests, rights or responsibilities of a person, other than the legal interests, rights or responsibilities referred to in subparagraphs i to v, or
- 3. [Representing] a person in a proceeding before [any body that, after the presentation of evidence or legal argument by one or more persons, makes a decision that affects a person's legal interests, rights or responsibilities, including, without limitation, ...a tribunal established under an Act of Parliament].
- 4. [Negotiating] the legal interests, rights or responsibilities of a person.

These activities clearly encompass the normal activities of patent and trade-mark agents in Canada and elsewhere. Sections 26.1 and 26.2 of the amended Law Society Act prohibit a person from practising law or providing legal services unless he or she is a licensee whose licence is not suspended, and then only to the extent permitted by his or her licence. The Law Society is authorized to make by-laws specifying classes of persons who are permitted to practise law or provide legal services without a licence, the circumstances in which they may do so and the extent to which they may do so. It will be an offence to provide legal services without a license.

There has been substantial opposition to the legislation from other professional groups. The Bill has passed second reading and has been send to the Legislature's Standing Committee on Justice Policy. This legislation is the subject of a short letter being sent to you separately.

### **Proposed Revisions to the Trademark Law Treaty (TLT)**

The Government of Canada participated in a Diplomatic Conference for the Adoption of a Revised Trademark Law Treaty (TLT), which is being held under the auspices of the General Assembly of WIPO in Singapore from March 13 to 31, 2006. In response to a request from CIPO for the views of FICPI and others on the "basic proposal" that the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) agreed to present at the Diplomatic Conference, we have prepared

submissions on those aspects of the TLT which, if the TLT is signed by Canada, would be likely to affect our members and their clients in any significant way.

As you are likely aware the Trademark Law Treaty of 1994 aims to streamline and simplify administrative procedures worldwide relating to national and regional trade-mark applications and the maintenance of trade-mark registrations. Canada is not yet a member of the TLT.

The proposed revisions to the TLT envisage the inclusion into the treaty of provisions on electronic filing of trade-mark applications and associated communications, the formalities concerning the representation of all types of marks, including visible signs as well as non-visible signs, provisions concerning the recording of trade-mark licenses, and relief measures when certain time limits have been missed.

For further details of the proposals, please follow the attached links:

[http://www.wipo.int/meetings/en/doc\\_details.jsp?doc\\_id=52094](http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=52094)

[http://www.wipo.int/meetings/en/doc\\_details.jsp?doc\\_id=52095](http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=52095)

[http://www.wipo.int/meetings/en/doc\\_details.jsp?doc\\_id=52096](http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=52096)

### **Peter Kirby Award**

One of the principal objectives of FICPI Canada is to advance and promote the patent agent profession in Canada. To recognize those who have made a significant contribution to the advancement of the profession, FICPI Canada established, a few years ago, the Peter Kirby award, in memory of Peter, who was one of the founding members of FICPI Canada and a pre-eminent member of the patent profession in Canada. The first recipient of this award, for outstanding contribution to the patent agent profession in Canada, was the late Chris Scott, who was dedicated to the training and mentoring of patent agents. In 2004, the award was presented by Ed Gale, a former partner of Peter's, to Robert Mitchell.

It is not intended that the award need be presented every year. However, FICPI Canada would like to receive your nominations of those who you feel have done much to advance

the patent agent profession in Canada. You can address those nominations to any member of Council.

## **MEETINGS**

### **Congress**

Many of you will be attending the Congress in Paris next month. Please remember that only members of FICPI can attend a Congress. If other colleagues at your firm are hoping to attend the next FICPI Congress, they should take steps to apply for membership in FICPI Canada. Membership application forms may be downloaded from the [www.ficpi.ca](http://www.ficpi.ca) website .

### **Forum**

In addition to Congresses, FICPI holds a Forum in years when there is no Congress. The emphasis at these Forums is on education and training, offering the IP practitioner a wide choice of topical subjects relevant to their day-to-day practice combined with an enjoyable social programme.

Forums are open to non-members of FICPI. Many of our members attended the recent Forum in Lisbon, Portugal in early November. The next Forum will be held in the autumn of 2007.

### **Exco meetings**

FICPI holds international Executive Committee (ExCo) meetings every 9 months or so. FICPI Canada, like other member countries, sends a Delegate (usually the president of FICPI Canada) and a Sub-Delegate (another council member) to sit on the Executive Committee, and to provide a Canadian say in the decisions of the international group.

Other members of FICPI Canada attend these meetings as members of various committees and commissions of FICPI.

Traditionally, Exco meetings were held in Europe, where FICPI has the bulk of its members. In the last few years, though these meetings have also been held outside Europe to encourage the development of the profession, and the growth of FICPI, in those areas. Meetings have recently been held in Singapore, Seoul, Korea, and Lisbon, Portugal. In addition to the Exco that will be held together with the Paris Congress, an Exco meeting is planned for Chile in December, 2006.

### **Annual General Meeting**

FICPI Canada is required by its Constitution to hold an annual general business meeting of its members. This meeting has often been held in conjunction with a forum or a congress, or an ABC meeting if one is held in Canada. Most recently, an AGM was held in conjunction with the ABC meeting in Quebec City.

In other years, we have often held a separate annual general meeting, with a business or educational program of particular interest to our members.

Our last stand-alone meeting was held in March, 2004 at the Hotel St. Sulpice in Montreal. Organized by Alain Leclerc, the program, entitled “Designing the Perfect Patent Agency Practice” featured panel discussions and presentations on such topics as managing growth, finding, training and retaining qualified people, and promoting and building a patent practice.

These meetings demonstrate that despite the friendly competition between our members, they remain willing to share their knowledge and experience with others in FICPI Canada and the profession as a whole.

Although our formal AGM will be held at the Congress, consideration is being given by Council to a Canadian meeting in late 2006 or early 2007. Your thoughts and suggestions would be appreciated.

## **ABC Meeting**

In June, 2005 FICPI Canada organized and hosted the most recent ABC meeting in Québec City. The organizing committee of Robert Storey, Ingrid Schmidt and Doug Deeth put together a meeting with an all time high attendance that was a great mixture of educational and social programs, with speakers from all three national groups and representatives of the Canadian and US patent offices. FICPI UK has the responsibility for organizing the next ABC meeting which will be held in 2007. (No ABC meeting is held in a Congress year).

## **Salary Survey**

For several years now, FICPI Canada has conducted a survey among its member firms of the salaries and other benefits paid to those training as patent agents and trade mark agents. The results of the survey are made available to the members of FICPI Canada. The 2005 survey was sent to participating firms a few weeks ago, and included information on hourly rates charged for the work of associates and trainees. (The information gathered in our surveys is compiled in confidence and is made available only in summary form to members participating in the survey.)

If your firm did participate in the survey, we thank you. If not, we would encourage you to participate in future years to ensure that the survey is as meaningful as possible for our members.

During our AGM in Québec City, there was some support for extending the survey to include such things as standard charges and firm profitability. Council will consider this and expand the survey if we determine that there is sufficient support from our members for this extended survey.

## **FICPI and FICPI Canada Websites**

Thanks to the efforts of Ed Gale, who was instrumental in establishing and maintaining the FICPI Canada website, [www.ficpi.ca](http://www.ficpi.ca) is now online. That website, and the FICPI website at [www.ficpi.org/ficpi](http://www.ficpi.org/ficpi) contains reports of developments, archives of the



*Newsletters*, other information of interest to FICPI members, including dates and details of upcoming meetings.

## **EDUCATION & TRAINING**

### **Claim Drafting Clinic**

For the past few years, FICPI Canada has offered a two day claim drafting clinic to patent agent trainees. These clinics, organized by Ingrid Schmidt, Joan Van Zant and Robert Mitchell, with the assistance of tutors recruited by them from our members, have become very popular; the most recent clinic was held in November, 2005 in Kingston, Ontario.

We appreciate the time and efforts that our tutors contribute to make these tutorials a success, and would like to extend our thanks to Joan Van Zant, Ingrid Schmidt, Stephen Beney, James Anglehart, Jennifer Jannuska, Joachim Fritz, Konrad Sechley, Peter Hammond, and Robert Storey.

At our AGM in Québec City we discussed the possibility of holding an opinion drafting clinic as well. The consensus at that time was to offer this as an immediate sequel to the claim drafting clinic, but on the advice of those responsible for the claim drafting clinic, it was decided that this would not be feasible for either the instructors or the students. We have tentatively scheduled an opinion drafting clinic for Kingston in late November, 2006. We hope to discuss this with you at the AGM in Paris.

### **Training**

Most of our members have experienced the difficulties inherent in the recruitment and training of patent agents, particularly in specialized technical fields. The training of a patent agent in Canada remains an expensive and time-consuming "on-the-job" apprenticeship system. FICPI Canada continues to look for new solutions for training new candidates for patent agents, and innovative ways of conducting training for young recruits in this field.

## **OTHER LEGISLATIVE DEVELOPMENTS**

### **Madrid Protocol**

FICPI Canada filed submissions to CIPO on its proposals to “modernize” Canadian trademark law by implementing the Madrid Protocol, and on the Trademark Law Treaty (“TLT”), which are viewed by CIPO as key components of CIPO's work related to the modernization of the Canadian Trade-mark Act. Ingrid Schmidt was responsible for preparing those submissions. FICPI Canada will continue to be involved to support our members’ interests.

### **Dutch Industries and Small Entity Status**

CIPO also held meetings on the implementation of Bill C-29, *An Act to amend the Patent Act*, which is intended to provide relief to patent holders and applicants who have incorrectly paid certain patent fees and who find the validity of their patents jeopardized in view of the decision in Dutch Industries. Mike Stewart and I attended one of those meetings on behalf of FICPI Canada.

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If you have any suggestions or comments for FICPI Council, please send them to me or to any other member of Council

Douglas N. Deeth  
President, FICPI Canada  
c/o Deeth Williams Wall LLP  
400 – 150 York Street  
Toronto, M5H 3S5  
  
ddeeth@dww.com

