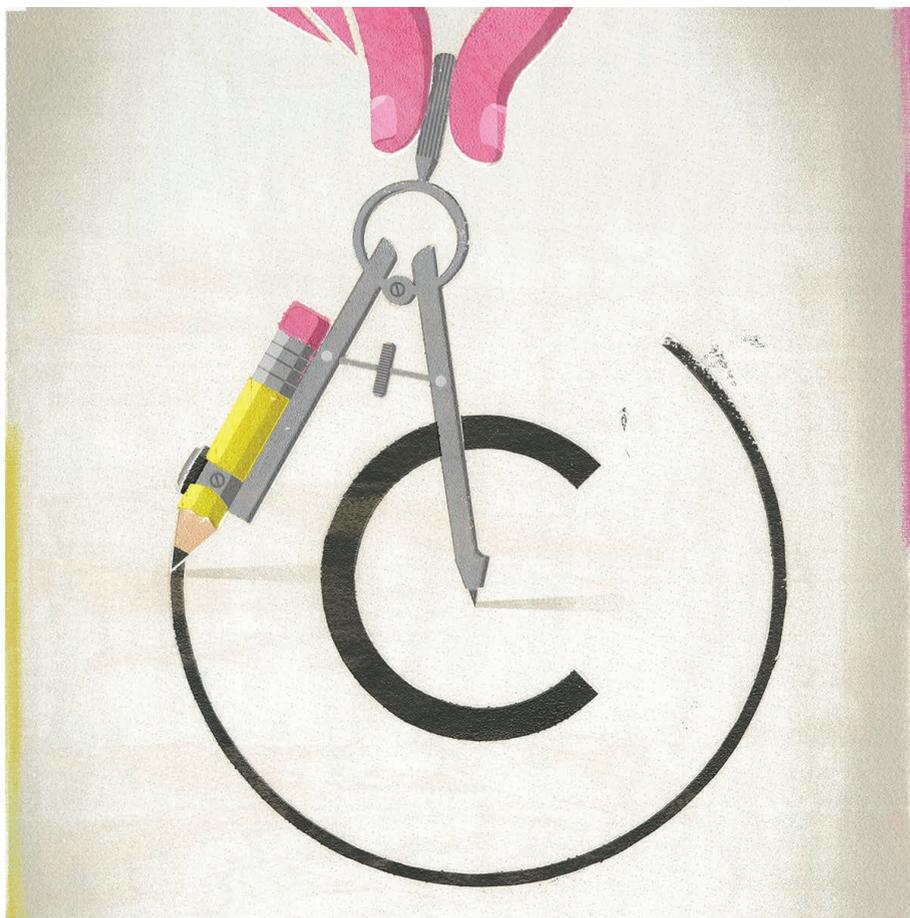


The modern IP family

Is it the dawning of a new age for patent and trademark agents?

By Jennifer Brown



Trademark and patent agents often work side by side with their lawyer colleagues in intellectual property practices and law firms, but unlike lawyers they are not self-regulated. While patent and trademark agents often have scientific backgrounds or professional designations as engineers, they aren't bound by the same requirements for continuing professional development and other professional and ethical regulations as lawyers are.

Instead, patent and trademark agents answer to a federally regulated body — the

Canadian Intellectual Property Office. To address this difference, a “Modernizing the IP Community” initiative was launched in June 2013 as a collaborative effort between CIPO and representatives from the IP community. Over several months, working groups of CIPO officials and members of the IP profession undertook an in-depth analysis of issues related to:

- Improving the maintenance and oversight of the register/list of patent and trademark agents;
- Improving the qualification and maintenance of patent and trademark agents on the register to ensure only the most

prepared candidates write the qualifying exams and that successful agents continue to update their skills throughout their careers; and

- Creating a values and ethics framework for IP agents to support the IP profession and ensure the highest value of service to innovators and businesses.

The result was a final report and 11 recommendations designed to enable CIPO to improve services to its clients and ensure patent and trademark agents are equipped to address the needs of Canadian businesses and innovators.

CIPO closed its consultation on the issues in December and while it's unknown what they will ultimately do with the comments they've received, most involved agree it's time to update, while others say some aspects of change are still missing.

Some of the proposals would require regulatory amendments, which might be difficult to accomplish in an election year, but IP professionals are watching the developments closely. “I think generally, an overhaul of the patent and trademark agent qualification and maintenance procedures is long overdue,” says Jenna Wilson, a partner with IP boutique Dimock Stratton LLP.

Wilson practises primarily as a patent agent and was a member of the IP modernization group working with CIPO. If the recommendations were implemented she would be dealing with the professional obligations of both the Law Society of Upper Canada and CIPO (or whatever the regulator would be). A past member of the Canadian Patent Agent Examining Board, she currently serves as its liaison with the Intellectual Property Institute of Canada.

While the idea to revamp the patent and trademark agent register and list with more useful information for the public seems an obvious improvement, bigger changes, however, would be the introduction of

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continuing professional development and a code of values and ethics for agents. “Right now, CPD and code of ethics are only voluntary on the part of non-lawyer agents,” says Wilson. “Those agents who are already lawyers are bound by their own rules of professional conduct and to a great extent those rules will overlap those being proposed for agents.”

Wilson says the fact is despite patent and trademark agents engaging in quasi-legal work, their ongoing training and maintenance of their level of competence has “kind of fallen by the wayside.”

Currently, IPIC, which participated in the modernization project, is the main source of ongoing professional development and a code of ethics for patent and trademark agents, whether they are lawyers or not. However, membership is voluntary. “For a lot of lawyers who practise as patent and trademark agents, the additional CPD requirements are not going to add a significant burden,” says Wilson.

While the implementation details aren’t available yet, what’s intended is for the CPD subject matter suitable for patent and trademark agents to overlap what a lawyer practising in those fields would normally take as CPD. It will, however, create new requirements for non-lawyer agents. “One of the steps to put agents in a position to govern themselves does require ongoing CPD and maintaining a level of quality — all of this is viewed as assisting in those goals.”

While the report from CIPO makes it clear it isn’t intended to move towards self-regulation, there certainly have been voices within the agent community championing the idea of self-regulation and

those in favour of establishing some kind of privilege similar to the privilege enjoyed by lawyers and their clients. “Privilege and self-governance have been long-term goals of IPIC,” says Wilson.

The idea of having regulation just to “modernize” the IP system is great, but part of modernization should be dealing with the rationale for some of these changes and privilege was certainly part of the rationale, says Cynthia Rowden, of Bereskin & Parr LLP. Rowden, who is a lawyer and a trademark agent, says the rationale for CIPO’s review wasn’t to respond to widespread concerns about competency, it was that the profession was willing to sit down and talk to CIPO about some kind of regulation. “It was all done with a view to a *quid pro quo* and that is not mentioned in the consultation document, but the *quid pro quo* is that agents in Canada in their capacity as trademark or patent agents, whether or not they are lawyers, do not clearly have privilege and that is a situation where Canada stands separate from most other countries,” she says.

IPIC and its members have been trying to persuade the government to adopt practices that are in line with our major trading partners and ensure privilege attaches to the confidential work that patent and trademark agents do. Rowden says the issue of privilege has been a “long standing goal” of IPIC and a topic on the back burner with CIPO for more than a decade. It has never really fully responded to it in terms of why agents in Canada don’t have it, she says.

Privilege and self-regulation aside, what CIPO is ultimately trying to do is look at the requirements of other professions to realize there are elements to becoming

a professional and maintaining professional designation that the agent community doesn’t have — continuing education being a big one. “Doctors and accountants have continuing education, why don’t agents have it? I think that’s just a sensible update to give confidence to people that has the hallmarks of professionalism,” says Andrew Skodyn, a partner with Lenczner Slaght Royce Smith Griffin LLP.

Skodyn does trademark and patent litigation and says he doesn’t think CIPO is looking to fix a problem but rather establish a framework. He has handled some patent agent negligence files but says they are not as common as medical, legal, or accounting cases. He notes that right now there isn’t a formal process by which complaints to CIPO are handled.

Where the report is silent is on what the intent is with respect to lawyer agents, says Rowden. “The way this consultation is drafted one would think that there is no oversight for people practising intellectual property law; that they are primarily non-lawyer agents and that something needs to be done,” says Rowden. “A very significant majority I would think, of people who practise in the intellectual property field, are lawyers and are already regulated by provincial law societies.”

Rowden’s colleague Stephen Beney is a registered Canadian patent and trademark agent but not a lawyer. “I would say it’s a good thing in general. It would ensure the agents who aren’t perhaps members of firms as I am, do have regular training sessions to keep abreast of what’s going on in the profession. That’s good for the public.” **CL**