



September 2005

Patent Agents and Trade-mark Agents Act

By-laws and Regulations

Worksheet

The purpose of this worksheet, prepared by IPIC, is to present, in complement to the draft legislation, the proposed operational details of the College that could be included in Regulations or in the College's by-laws.

These regulations and by-laws will be finalized only after the Act is adopted. Accordingly, this is not their final written form and some questions remain. However, the terms for the discipline process and of the Code of Ethics have been written in the proper language. They will also be part of regulations and by-laws but, for now, are presented in separate documents. An illustration of the organizational structure can also be found separately.

Sections in the Act refer to the July 15, 2005 draft legislation.

Head Office (*section 10 of Act*)

1. By-laws should establish location of head office.

Annual meeting / other meetings (*section 11 of Act*)

2. By-laws should establish:

- a) Date of fiscal year;
- b) Notice / publication requirements for annual meeting;
- c) Who can attend / vote;
- d) Business and conduct of AGM (i.e. discuss business and activities of College, conduct elections / appointments of Governors and executive, discuss and vote on motions);
- e) Requirements and procedure for calling a special meeting;
- f) Notice / publication requirements for special meetings;
- g) Conduct of special meetings (i.e. discuss and decide only specified object of meeting).

Structure (*section 14 of Act*)

3. Regulations or by-laws should provide:

- a) Appointment guidelines – e.g. “The Minister shall not appoint a person to the Board of Governors under paragraph 14 (a), or revoke the appointment of a person appointed pursuant to that paragraph, without having first consulted the members of the Board of Governors elected pursuant to paragraph 14(b)
- b) Election procedures – set out when election occurs [at annual meeting; frequency will depend on term]; set out how candidates nominated, who can nominate / be nominated; set out how much of vote needed; specify that members for election need to be agent members [rather than trainee members], in good standing with the College.
- c) Appointment by the Board – specify whether these appointees may / may not be members of the College, and that need majority agreement of Board for appointment.
- d) Tenure – length of term, whether term be repeated – e.g. “A governor shall serve for a period of X years,” or “A governor may serve beyond his or her period of tenure until he or she has been replaced.”
- e) Replacement procedures – specify interim elections for replacement in middle of term [next occurring annual meeting?]; specify if can have acting member appointed by Board until next election [or only if the Board does not have a threshold number of members?]
- f) Revocation procedures – specify procedures for revocation by the Minister (of his appointees) or by the Board of any members of Board, including Minister’s appointees [?].

Executive (*section 15 of Act*)

4. Regulations should provide:

- a) Description of duties and responsibilities of each officer of executive (President, Vice-President and Secretary/Treasurer).

By-laws should provide:

- a) Nomination, election, and appointment process for executive.
- b) Tenure for executive (e.g. one-year non-renewable terms, but may serve beyond term until he or she has been replaced).
- c) Replacement / removal procedures for executive.

Entry on the register: Patent agents: (*sections 12, 19 and 25 of Act*)

5. Regulations and bylaws should establish

either (1)

- a) Canadian resident [*or as per section 15 of the Patent Rules*]; and
- b) University degree in pure or applied science or equivalent university degree (from Cdn university or recognized by ...?); and
- c) Two-year trainee membership in College; and
- d) Two-year full-time apprenticeship or an Examiner with the Patent Office(d) and c) may be concurrent); and
- e) Successfully passing exams on patent law and practice; and
- f) Be a lawyer or pass exam on basic Canadian legal principles; and
- g) Agreement to be bound by Code of Ethics; and
- h) Professional errors and omissions insurance; and
- i) Initial registration fee.

Or (2)

- a) If a resident of another country, be registered and in good standing; (see also 10d)

Entry on the register: Trade-mark agents: (*sections 12, 20 and 25 of Act*)

6. Regulations and bylaws should establish

either (1)

- a) Canadian resident [*or as per section 21 of the Trade-marks Regulations*]; and
- b) University degree(from Cdn university or recognized by ...?); and

- c) Two-year trainee membership in College; and
- d) Two-year full time apprenticeship, or an Examiner with the Trade-marks Office or practicing lawyer (member in good standing of provincial law society?) (d) and c) may be concurrent); and
- e) Successfully passing exams on trade-mark law and practice and, if not a lawyer, on basic Canadian legal principles; and
- f) Agreement to be bound by Code of Ethics; and
- g) Professional errors and omissions insurance; and
- h) Initial registration fee.

Or (2)

- a) If a resident of another country, be registered and in good standing;

Exam Boards: *(sections 12, 20 and 25 of Act)*

7. Establish Examining Boards for setting and marking exam;

- a) Selecting members of board;
- b) Select format of exam;
- c) Date of exam;
- d) Set fee for exam;
- e) Provide notice of exam;
- f) Establish location(s) of exam;
- g) Publish results of exam;
- h) Appeal process.

Trainee Members *(section 24 of Act)*

8. Regulations and bylaws should establish

- a) Trainees apply with mentor to the College at the beginning of their apprenticeship
- b) Mentor ensures that the apprentice will meet the College training guidelines.
- c) Student members are bound by the Code of Ethics.

Maintenance on register - Members: *(sections 12, 19, 20 and 25 of Act)*

9. Regulations and bylaws should establish

- a) annual fee (proposed: \$350)
- b) comply with [or agreement to be bound by] Code of Ethics
- c) errors and omissions insurance (maintain and provide proof; possible exceptions for in-house agents)
- d) filing of annual report of funds held in trust
- e) subject to outcome of disciplinary proceedings
- f) mandatory continuing education (subject to transitional provisions)

Maintenance on register - Foreign Agents: *(sections 12, 19, 20 and 25 of Act)*

10. Regulations and bylaws should establish

- a) annual fee
- b) Proof of entitlement to practice before the Intellectual Property Office of their resident country.
- c) Comply with Code of Ethics
- d) Must appoint an associate Canadian agent

CIPO Notification: *(sections 19 and 20 of Act)*

11. Regulations should establish

- a) CIPO to be notified of changes to the Registers
- b) If an application is filed by an agent, or communication is made to an agent from CIPO, and the agent is removed from the register – effect?

Continuing Education: *(sections 19 and 20 of Act)*

12. Regulations and bylaws should establish

- a) Continuing Education (CE) will be on a voluntary basis (the “honour system”) for a transition period and slowly ramp up to mandatory once courses have been evaluated and accredited by the College. This will allow also time to determine what the appropriate and feasible requirements are.
- b) The College will set the standards and accredit the organizations (IPIC and others including universities, other associations, private organizations and in-house programs within firms) that will deliver the education but will not supply training.

Suspension: (*sections 19 and 20 of Act*)

13. Regulations and by-laws should establish mechanism to suspend name from the register, in addition to those provided under the disciplinary process (see ___):

- a) Agent may be suspended from the register for failure to meet administrative requirements.
- b) Agent may be removed from register for failure to rectify underlying cause of administrative suspension within one year of deadline.

Reinstatement: (*sections 19 and 20 of Act*)

14. Regulations and by-laws should establish mechanism to reinstate name on register:

- a) Reapply within one year of removal;
- b) Pay a fee (reinstatement + regular fee);
- c) Meet all other requirements;
- d) To be reinstated after one year off the register, applicants will need to meet additional requirements, which could include continuing education or passing exams. This would be determined by a committee of the College.

Public registers (*section 21 of Act*)

15. Regulations should establish:

- a) what information goes on the public registers;
- b) any fees, restrictions, etc. on this right.

Committees (*section 22 of Act*)

16. Regulations should establish that the College may create the following committees:

- a) Admissions Committee (trainee education requirements, exams including examination board, and initial qualifications);
- b) Professional Standards Committee (maintenance of registers, insurance requirements and CLE);
- c) Professional Conduct Committee (Code of Ethics and discipline process; comprises 10 members, one of whom is past president who does not serve as chair);
- d) Discipline Tribunal (includes 15 members, a particular tribunal[panel?] comprising of 3 members including one lay person; retired judge who acts as chair);
- e) Appeal Tribunal (3 members appointed by the Board, one of which may be a retired judge);
- f) Liaison Committee (for relations with CIPO, IPIC, Law Societies, Engineering Societies and foreign organizations);
- g) Elections Committee (3 members, including immediate past president, responsible for nomination of Board members);
- h) Any other committee that the Board of Governors may decide to create.

By-laws should establish quorum, tenure, composition, qualifications and remuneration of committees and members, including the composition indicated in parentheses above where applicable.

Members / Trainees (*sections 23 and 24 of Act*)

17. Regulations should define good standing.

Code of Ethics (*section 28 of Act*)(*see also separate document with proposed Code of Ethics*)

18. By-laws should establish:

- a) Publication by the Board of a current version of the Code of Ethics both in printed form and on a website maintained by the College;
- b) Provision of a printed copy of the current Code of Ethics to each new trainee and each new agent at no additional charge to the trainee or agent;
- c) Making copies of the Code of Ethics available to members of the public by means of printed versions at a reasonable cost and through the Internet;
- d) Providing notices to agents and trainees of any proposed changes or revisions to the Code of Ethics and notices of any actual changes to the Code of Ethics.

Discipline (*section 29 of Act*)(*see also separate document with proposed discipline by-laws*)

19. By-laws should provide:

- a) Procedures for the discipline of agents and trainees;
- b) Establishment of Disciplinary Tribunal;
- c) Right to appeal.

Sanctions (*section 30 of Act*)(*see also separate document with proposed discipline by-laws*)

20. By-laws should provide sanctions.

Indemnification Fund established (*section 31 of Act*)

21. By-laws should establish:

- a) Amount of fund [\$50,000 but subject to change] and source
- b) Rules & procedures relating to the fund.

Liability insurance required(*section 32 of Act*)

22. Professional liability insurance is not required for:

- a) non-practicing members;
- b) members who practice exclusively as instructors;
- c) members who practice exclusively as an employee of one of:
 - i) the Government of Canada or a province;
 - ii) a University;
 - iii) a corporation other than a professional corporation of agents;
- d) non-resident members who provide services that are within the practice of patent agency and/or trade-mark agency exclusively to clients outside of Canada.

(2) Every member who is required to carry professional liability insurance in accordance with the Act and these Regulations, shall at the request of the College provide proof of said insurance.

Transitional Provisions (*sections 39 and 40 of Act*)

23. Regulations or by-laws should establish:

For resident and foreign registered patent and trade-mark agents:

- a) All patent and trade-mark agents registered to practice before CIPO at the date that the new Act comes into force remain registered patent and trade-mark agents, respectively, on the roster of the College.
- b) All former patent and trade-mark agents that have interrupted their practice, will be bound by the new Act of the College as far as questions of reinstatement are concerned if they decide to apply for reinstatement after the date of the new Act. If a former agent wishes to be reinstated according

to the pre-Act reinstatement rules, reinstatement proceedings should be undertaken prior to the new Act coming into force.

For trainees:

- a) All trainees that have been training to become patent or trade-mark agents at the date the new Act comes into force, may file within a set period of time, for example between the date when the new Act comes into force and up to twelve months after the new Act comes into force, a declaration signed by a registered agent stating that they have accomplished, at the date the new Act comes into force, a training program in patents and/or trade-marks, and stating the equivalent full-time training program duration that they have accomplished at the date the new Act comes into force;
- b) All trainees filing a declaration under point (a) will be considered trainees under the College Act, but will be bound by the pre-Act admission rules to become a registered patent or trade-mark agent, i.e.: no need to meet the new academic requirements to sit the exams;
- c) All patent agent trainees having passed part of the patent agent exams according to the CIPO examination regulations prior to the College becoming active, will be credited for those exams under the new College rules. However, these credits will be applicable only within X years after the College begins operations.
- d) Any trainee not filing the declaration under point (a) above within the set period of time, will be bound by the new rules pertaining to admission for trainees under the College; and
- e) A training program is defined under the present paragraph as equivalent full-time work accomplished in the field of patents and/or trade-marks under the direct supervision of a registered patent or trade-mark agent (as the case may be), or as a patent or trade-mark examiner at CIPO.

Note: Apart from the exams, mentorship requirements and training period, the trainee would be part of the College as any other member, so the code of ethics and other College rules such as maintenance rules would apply.

Entry into Force (*section 52 of Act*)

24. Order in Council will fix day(s) of entry into force.