

# Patent and Trade-mark Agents — Privilege Protection and Self-Regulation

## BACKGROUND

- Under the *Patent Rules*, every applicant for a patent who is not the inventor must appoint a patent agent to bring an application before the Patent Office. Some patent agents are also lawyers, while others are non-lawyers with a specialized knowledge in relevant technical areas such as engineering. Both lawyers and patent agents must pass qualifying examinations to be registered with the Patent Office.
- The majority of patent and trade-mark agents, be they lawyers or not, are voluntary members of the Intellectual Property Institute of Canada (IPIC).
- Solicitor-client privilege does not extend to clients of non-lawyer agents. In the event of litigation, communications of a confidential nature between clients and non-lawyer agents may be admissible as evidence. IPIC contends that *the Patent Act* and *Trade-marks Act* should be amended to create a statutory privilege for certain communications between clients and their patent and trade-mark agents, similar to solicitor-client privilege.
- The lack of the privilege protection, IPIC contends, is contrary to the public interest. Patent and trade-mark agents carry out work similar to that of lawyers but without the same protection for clients who communicate with agents. IPIC also argues that Canadian IP rights holders face a competitive disadvantage compared to their competitors in other countries where privilege for non-lawyer agents is recognized.
- In 1998, the National Intellectual Property Law Section developed a discussion paper on the issue of the extension of privilege to patent and trade-mark agents. In April 1998, the National Executive Committee was of the view that the issue would be best considered in the broader context of the future of the legal profession.
- The CBA membership is divided over whether such privilege should be extended to patent and trade-mark agents.

## CURRENT STATUS

- In November 2003, IPIC proposed legislative changes to the *Patent Act* and *Trade-marks Act*, to grant privilege to and establish self-regulation for Canadian patent and trade-mark agents. Industry Canada called for comment as such changes would require amendments to the *Patent Act* and *Trade-marks Act*.
- IPIC proposes giving the authority to regulate the patent and trade-mark agent profession to a new "College of Patent and Trade-mark Agents" (the College). No single regulatory body in Canada governs the practice of agents. They are presently governed by statutes, rules, case law, and the Canadian Intellectual Property Office (CIPO) practice.
- IPIC believes the current system does not provide sufficient agent training, supervision or discipline. IPIC's proposal for self-regulation calls for a new regulatory regime to better license agents, institute a comprehensive complaint and disciplinary process and control

unauthorized practice. The College would assume responsibility for agent conduct and discipline. It would also oversee entrance examinations and set agent qualification requirements.

- The National Intellectual Property Law Section submitted that there is no need to extend privilege to patent and trade-mark agents. In its February 2004 [submission](#), the IP Section concluded that the current jurisprudence strikes the proper balance between protecting private communication and the need to disclose information in litigation. As well, the Section argued there is no public outcry to extend privilege to the clients of patent or trade-mark agents.
- The Section did not take a position on whether patent and trade-mark agents should be self-regulated.
- In May 2004, the Intellectual Property Policy Directorate of Industry Canada held a stakeholder meeting on the issue of extending privilege to patent and trade-mark agents. The IP Section Chair and another Section member attended the meeting. There was no subsequent feedback from Industry Canada.
- In July 2006, IPIC sent a proposal for self-regulation and privilege to the federal government.
- The Federation of Law Societies of Canada has not endorsed IPIC's proposal.
- CBA engaged Professor Adam Dodek to prepare a discussion paper on the current state of Solicitor-Client Privilege in Canada, and published Professor Dodek's paper, entitled *Solicitor-Client Privilege in Canada: Challenges for the 21st Century* in February 2011.
- The paper identifies issues likely to arise as other professionals (such as paralegals, tax accountants, patent agents or immigration consultants) seek a class privilege. It addresses the difficulties for lawyers to oppose that extension on principled grounds and proposes future action for the CBA on behalf of the profession. ([see separate note](#))

## **NEXT STEPS**

- The Intellectual Property Section will continue to liaise with the Federation of Law Societies of Canada, IPIC and Industry Canada.