



June 13, 2016

Via email: denis.martel@canada.ca

Denis Martel
Director, Patent Policy, Strategic Policy Sector
Innovation, Science and Economic Development Canada
473 Albert Street
Ottawa, ON K1R 5B4

Dear Mr. Martel:

Re: Consultation on a Governance Framework for IP Agents – Code of Conduct

We write on behalf of the Canadian Bar Association Intellectual Property Section (the CBA Section) about the draft code of conduct circulated as part of the Innovation, Science and Economic Development Canada and Canadian Intellectual Property Office consultation on the regulatory framework for patent and trademark agents. Our comments on the rest of the consultation paper, including the governance model and disciplinary process, will follow at a later date.

The CBA is a national association of 36,000 lawyers, Quebec notaries, law teachers and students with a mandate to promote improvements in the law and the administration of justice. The CBA Section deals with law and practice relating to all forms of ownership, licensing, transfer and protection of intellectual property and related property rights, including patents and trademarks.

In December 2014, the CBA Section made a [submission](#)¹ in response to CIPO's consultation on modernizing the IP community. Then, as now, the CBA Section welcomed a values and ethics framework for registered patent and trademark agents. While lawyers are bound by ethical obligations imposed by their governing law societies, non-lawyer patent and trademark agents are not bound by any code of conduct. The CBA Section is pleased that this deficiency will be addressed. We are also pleased that effort has been made to align with the existing obligations of lawyer patent and trademark agents to avoid the creation of overlapping administrative burdens.

We respond to the two questions posed in the Consultation Paper about the draft code of conduct. We also attach a copy of the draft code of conduct annotated with suggestions for change.

¹ CBA, Consultation on Modernizing the IP Community Report, December 2014:
www.cba.org/CMSPages/GetFile.aspx?guid=4ee17ed4-0bd5-4568-bbd1-9485b466854d

Question 1: Does the draft code cover all the right elements? Are any elements missing? Are any changes necessary before implementation?

The CBA Section has previously registered concerns about the unauthorized practice of law by non-lawyer patent and trademark agents. Examples of these practices were in our December 2014 submission.

We are pleased that the draft code of conduct contains a section on unauthorized practice. As we understand it, the relevant principle is aimed at the duty to prevent both unauthorized practice under intellectual property statutes and the unauthorized practice of law in Canada. However, the drafting is unclear, at least in the English version; the French text is more precise.

The CBA Section recommends that the Principle be redrafted as follows:

An agent owes a duty to assist in preventing the unauthorized practice of persons or entities. This includes practice not authorized under the relevant intellectual property statutes or by laws regulating the provision of legal services in Canada.

For greater clarity of the obligation under section 10, the CBA Section recommends adding a subsection to specifically prohibit the unauthorized practice of law while practicing as a patent or trade mark agent:

An agent must act within the scope permitted under the Patent Act and the Trade-marks Act. An agent must take particular care to avoid providing advice and services that would amount to the practice of law, unless the agent is also authorized to practice law in a province or territory in Canada.

This change is supported by section 15 of the *Patent Act* and subsection 29(2) of the *Trade-marks Act*, which authorizes registered patent and trademark agents to practice before the Patent Office and Trade-marks Office. There is no statutory or common-law authority for patent agents and trademark agents to practice beyond this framework.

For consistency, we propose additional changes to the draft code of conduct in the attached annotated copy. These include:

- Rule 1.1, adding “An agent must not undertake or continue any matter that is beyond the scope of what is permitted under the *Patent Act* and *Trade-marks Act*.”
- Rule 3.3, adding “For greater certainty, “dispute” as used in this Rule does not authorize an agent to act in a dispute in a manner that would amount to the practice of law.”
- Rule 4.1, adding “with respect to patent and trade-mark practice as permitted under the *Patent Act* and the *Trade-marks Act*”

The CBA Section also proposes a change to Rule 9.1 to read “An agent must not advertise services that amount to the practice of law, unless the agent is also authorized to practice law in a province or territory.” The purpose of this change is to protect the public. A review of webpage profiles for some non-lawyer agents includes the following statements:

- “has experience in intellectual property aspects of major business transactions”
- “advising clients on licensing”

- “advice in M&A deals and other commercial transactions”
- “conducting intellectual property due diligence”.

These claims could be construed as the practice of law. This would undermine public understanding of the role of patent and trademark agents and mislead clients about the knowledge, skills and accountabilities of non-lawyer agents. If unchecked, these claims will work against our collective efforts to appropriately modernize agent practice.

Question 2: Should the code of conduct or other applicable regulations clearly define what activities qualify as permitted practice in front of the patent or trademarks office?

To protect clients and the broader public, the CBA Section has consistently advocated the importance of clearly defining what activities qualify as permitted practice in front of the Patent Office or Trademarks Office. Many statutes regulating the practice of law in provinces and territories define in detail what constitutes the practice of law. A definition of permitted agent activities would likewise assist agents and encourage greater understanding by the public and by clients about the IP system in Canada.

The framework adopted by the US Patent and Trademark Office – Office of Enrollment and Discipline (USPTO-OED) in Part 11 of Title 37 of the Code of Federal Regulations (CFR) is helpful.

For example, section 11.5 prescribes the nature of work that registered agents and attorneys are permitted to perform in the US:

§11.5 Register of attorneys and agents in patent matters; practice before the Office.

(a) A register of attorneys and agents is kept in the Office on which are entered the names of all individuals recognized as entitled to represent applicants having prospective or immediate business before the Office in the preparation and prosecution of patent applications. Registration in the Office under the provisions of this part shall entitle the individuals so registered to practice before the Office only in patent matters.

(b) Practice before the Office. Practice before the Office includes, but is not limited to, law-related service that comprehends any matter connected with the presentation to the Office or any of its officers or employees relating to a client's rights, privileges, duties, or responsibilities under the laws or regulations administered by the Office for the grant of a patent or registration of a trademark, or for enrollment or disciplinary matters. Such presentations include preparing necessary documents in contemplation of filing the documents with the Office, corresponding and communicating with the Office, and representing a client through documents or at interviews, hearings, and meetings, as well as communicating with and advising a client concerning matters pending or contemplated to be presented before the Office. Nothing in this section proscribes a practitioner from employing or retaining non-practitioner assistants under the supervision of the practitioner to assist the practitioner in matters pending or contemplated to be presented before the Office.

(1) Practice before the Office in patent matters. Practice before the Office in patent matters includes, but is not limited to, preparing and prosecuting any patent application, consulting with or giving advice to a client in contemplation of filing a patent application or other document with the Office, drafting the specification or claims of a patent application;

drafting an amendment or reply to a communication from the Office that may require written argument to establish the patentability of a claimed invention; drafting a reply to a communication from the Office regarding a patent application; and drafting a communication for a public use, interference, reexamination proceeding, petition, appeal to or any other proceeding before the Patent Trial and Appeal Board, or other proceeding. Registration to practice before the Office in patent cases sanctions the performance of those services which are reasonably necessary and incident to the preparation and prosecution of patent applications or other proceeding before the Office involving a patent application or patent in which the practitioner is authorized to participate. The services include:

(i) Considering the advisability of relying upon alternative forms of protection which may be available under state law, and

(ii) Drafting an assignment or causing an assignment to be executed for the patent owner in contemplation of filing or prosecution of a patent application for the patent owner, where the practitioner represents the patent owner after a patent issues in a proceeding before the Office, and when drafting the assignment the practitioner does no more than replicate the terms of a previously existing oral or written obligation of assignment from one person or party to another person or party.

(2) Practice before the Office in trademark matters. Practice before the Office in trademark matters includes, but is not limited to, consulting with or giving advice to a client in contemplation of filing a trademark application or other document with the Office; preparing and prosecuting an application for trademark registration; preparing an amendment which may require written argument to establish the registrability of the mark; and conducting an opposition, cancellation, or concurrent use proceeding; or conducting an appeal to the Trademark Trial and Appeal Board.

Title 11 also specifies that an agent is not permitted to practice law:

§11.505 Unauthorized practice of law.

A practitioner shall not practice law in a jurisdiction in violation of the regulation of the legal profession in that jurisdiction, or assist another in doing so.

The USPTO rationale for setting a boundary on what registered agents are permitted to do can be seen in its response to comments on revisions to 37 C.F.R. Part 11 in 2008 (published at 73 FR 47650 and enclosed with Exhibit B of this submission). On the issue of non-lawyers preparing assignment and license agreements, the USPTO noted:

First, there is no requirement that patent agents be trained in contract law to be registered to practice before the Office in patent cases. Absent adequate training, the client may not receive the legal advice and service the client has every right to expect. The possible temporary “convenience” of having a practitioner inadequately trained in the legal service the practitioner provides does not outweigh the need for competence. A practitioner is prohibited from handling a legal matter which the practitioner knows or should know that the practitioner is not competent to handle, without associating with another practitioner who is competent to handle it. See 37 CFR 10.77(b). Therefore, clients represented by a practitioner would be disserved by that practitioner if the practitioner is not competent to provide advice whether multiple inventors living in different states are subject to the contract laws of all the states or one state, whether the inventors are obligated to assign the

invention, whether the inventors should assign as opposed to license the invention absent a legal obligation to assign, and other legal implications of any agreement. Burdens may arise for practitioners and clients when the clients are not competently advised about available legal options, such as licensure or assignment, as well as the benefits, terms and costs of each option. The convenience of having a registered practitioner provide a legal service for which no training is required for registration does not outweigh the benefits of obtaining competent legal advice and assistance.

On the issue of rendering opinions, the USPTO is clearly of the view that non-lawyer agents could only render opinions in very limited circumstances. The USPTO noted:

The suggestion to define practice before the Office as rendering opinions on validity and infringement for clients has not been adopted. Whether a validity opinion involves practice before the Office depends on the circumstances in which the opinion is sought and furnished. For example, an opinion of the validity of another party's patent when the client is contemplating litigation and not seeking reexamination of the other party's patent could not be reasonably necessary and incident to the preparation and prosecution of patent applications or other proceedings before the Office involving a patent application or patent. In such situations, the opinion may constitute unauthorized practice of law. See *Mahoning Cty. Bar Assn. v. Harpman*, 608 N.E.2d 872 (Ohio Bd.Unauth.Prac. 1993). Similarly, a validity opinion for the sale or purchase of the patent is neither the preparation nor the prosecution of a patent application. Likewise, the opinion is not a proceeding before the Office involving a patent application or patent. Registration to practice before the Office in patent cases does not authorize a person to provide a validity opinion that is not reasonably necessary and incident to representing parties before the Office. In contrast, a validity opinion issued in contemplation of filing a request for reexamination would be in contemplation of a proceeding before the Office involving a patent. Due to registration to practice before the Office in patent cases, a practitioner may issue a validity opinion in contemplation of filing a request for reexamination.

In no circumstance would practice before the Office include the rendering of opinions on infringement. Under the law, the Office has no authority to resolve infringement cases. Thus, registration to practice before the Office in patent cases does not include authority to render infringement opinions. See *Mahoning Cty. Bar Assn. v. Harpman, supra*.

These arguments are sound and consistent with the Canadian IP framework. While the scope of practice may be broader in jurisdictions where patent and trademark professionals are all non-lawyers, the regulatory framework in those jurisdictions is not suitable for Canada, which has many IP professionals who are qualified both as lawyers and registered patent or trademark agents.

In conclusion, we thank ISED and CIPO for acknowledging the concerns expressed in our December 2014 submission. We encourage you to strengthen these provisions to ensure that IP clients have the best protections possible in a modern regulatory framework and to advance the interest and understanding of the public in Canada's IP system.

Yours truly,

(original letter signed by Tina Head for Mala Joshi)

Mala Joshi
Chair, CBA Intellectual Property Section

ANNEX A: CBA Comments on Draft Code of Conduct

Suggested changes to the draft code of conduct are highlighted in yellow.

Definitions

(no comment)

Fundamental canon

The most important attribute of an agent is integrity. This principle is implicit in this Code and in each of the Rules and Commentaries thereunder. Over and above the possibility of formal sanction under any of the rules in this Code, an agent must at all times conduct himself or herself with integrity and competence in accordance with the highest standards of the profession so as to retain the trust, respect and confidence of members of the profession and the public.

1. Competence

Principle

An agent owes the client a duty to be competent to perform any agency services and must perform all agency services undertaken on a client's behalf to the standard of a competent agent.

Rule 1

1.1 An agent must not undertake or continue any matter without honestly feeling competent to handle it, or able to become competent without undue delay, risk or expense to the client or without associating with another agent who is competent to handle the matter. **An agent must not undertake or continue any matter that is beyond the scope of what is permitted under the Patent Act and Trade-marks Act.** An agent must promptly advise the client whenever it is reasonably perceived that the agent may not be competent to perform a particular task **or where it is beyond the permitted scope of activity** and, whenever practical, provide reference to those known to the agent as likely to have such competence.

1.2 An agent must assume complete professional responsibility for all business entrusted to the agent, maintaining direct supervision over staff and assistants such as trainees, students, clerks and legal assistants to whom particular tasks and functions may be delegated.

1.3 An agent must maintain appropriate office procedures and systems including without limitation, systems for meeting the requirements for all deadlines arising from client matters and for handling and maintaining client affairs without prejudicing client affairs.

1.4 An agent should keep abreast of developments in the branches of patent and trademark practice wherein the agent's practice lies by engaging in study and education.

1.5 An agent conducting agency practice other than for an employer must maintain a professional liability policy from a reputable insurer for at least the amount recommended by the regulator.

Commentary

As a registered agent, an agent is held out as knowledgeable, skilled and capable. Accordingly, the client is entitled to assume that the agent has the ability and capacity to deal adequately with all agency matters to be undertaken on the client's behalf. Competence of an agent is founded upon both ethical and applicable legal principles. This rule addresses the ethical principles. Competence involves more than an understanding of agency legal principles: it involves an adequate knowledge of the practice and procedures by which such principles can be effectively applied. **To accomplish this, the agent should keep abreast of developments in all areas of patent and trade-mark practice, as permitted under the *Patent Act* and the *Trade-marks Act*.**

In deciding whether the agent has employed the requisite degree of knowledge and skill in a particular matter, relevant factors will include:

1. the complexity and specialized nature of the matter;
2. the agent's general experience;
3. the agent's training and experience in the technical field and applicable patent and trademark law;
4. the preparation and study the agent is able to give the matter; and whether it is appropriate or feasible to refer the matter to, or associate or consult with, an agent of established competence in the field in question.

An agent who practices alone or operates a branch or a part-time office should ensure that all matters requiring an agent's professional skill and judgment are dealt with directly by an agent qualified to do the work.

2. Confidentiality

(no comments)

3. Conflicts

Principle

In each matter, an agent's judgment and fidelity to the client's interest must be free from compromising influences.

Rule 3

Conflict of Interest

3.1 An agent must not act for a party where there is a substantial risk that an agent's loyalty to or representation of a party would be materially and adversely affected by the agent's own interest or the agent's duties to another client, a former client or a third person, except as permitted under this Code (hereinafter a "conflict of interest").

Commentary

As defined in these rules, a conflict of interest exists when there is a substantial risk that an agent's loyalty to or representation of a client would be materially and adversely affected by the agent's own interest or the agent's duties to another client, a former client or a third person. The risk must be more than a mere possibility; there must be a genuine, serious risk to the duty of loyalty or to client representation arising from the retainer. A client's interests may be seriously prejudiced

unless the agent's judgment and freedom of action on the client's behalf are as free as possible from conflicts of interest.

A client may legitimately fear that the agent will not pursue the representation out of deference to the other client, and an existing client may legitimately feel betrayed by the agent's representation of a client with adverse legal interests. The prohibition on acting in such circumstances except with the consent of the clients guards against such outcomes and protects the agent client relationship.

Accordingly, factors for the agent's consideration in determining whether a conflict of interest exists include:

1. the immediacy of the legal interests;
2. whether the legal interests are directly adverse;
3. the temporal relationship between the matters;
4. the significance of the issue to the immediate and long-term interests of the clients involved; and
5. the client's reasonable expectations in retaining the agent for the particular matter or representation.

Examples of Conflicts of Interest

1. An agent acts against a person in one matter when the agent represents that person in some other matter.
2. An agent, an associate, a firm partner or a family member has a personal financial interest in a client's affairs or in a matter which the agent is requested to act for a client, such as a partnership interest in some joint business venture with a client **or an invention marketing relationship under which the agent seeks to market the patent or trademark rights in exchange for consideration from the client.**

An agent owning a small number of shares of a publicly traded corporation would not necessarily have a conflict of interest in acting for the corporation because the holding may have no adverse influence on the agent's judgment or loyalty to the client.

3. An agent has a sexual or close personal relationship with a client.

Such a relationship may conflict with the agent's duty to provide objective, disinterested professional advice to the client. The relationship may obscure whether certain information was acquired in the course of the agent and client relationship and may jeopardize the client's right to have all information concerning his or her affairs held in strict confidence. The relationship may in some circumstances permit exploitation of the client by his or her agent. If the agent is a member of a firm and concludes that a conflict exists, the conflict is not imputed to the agent's firm, but would be cured if another agent in the firm who is not involved in such a relationship with the client handled the client's work.

4. An agent or his or her firm acts for a public or private corporation and the agent serves as a director of the corporation.

These two roles may result in a conflict of interest or other problems because they may:

- a. affect the agent's independent judgment and fiduciary obligations in either or both roles;

- b. obscure advice given in one role versus the other;
 - c. disqualify the agent or firm from acting for the corporation.
5. Sole practitioners who practice with other agents in cost-sharing or other arrangements represent clients on opposite sides of a dispute.

The fact or the appearance of such a conflict may depend on the extent to which the agents' practices are integrated, physically and administratively, in the association.

Conflict of Interest Exception

3.2 An agent must not represent a client in a matter where there is a conflict of interest unless there is express or implied consent from all clients and the agent reasonably believes that he or she is able to represent each client without having a material adverse effect upon the representation of or loyalty to the other client.

1. Express consent must be fully informed and voluntary after disclosure;
2. In order for consent to be implied and need not be in writing where all of the following apply:
 - a. the client is a government, financial institution, publicly traded or similarly substantial entity;
 - b. the matters are unrelated; and
 - c. the agent has no relevant confidential information from one client that might reasonably affect the other.

Commentary

Disclosure and Consent

Disclosure is an essential requirement to obtaining a client's consent. Where it is not possible to provide the client with adequate disclosure because of the confidentiality of the information of another client, the agent must decline to act.

The agent should inform the client of the relevant circumstances and the reasonably foreseeable ways that the conflict of interest could adversely affect the client's interests. This would include the agent's relations to the parties and any interest in or connection with the matter.

Consent in Advance

An agent may be able to request that a client consent in advance to conflicts that might arise in the future. As the effectiveness of such consent is generally determined by the extent to which the client reasonably understands the material risk that the consent entails, the more comprehensive the explanation of the types of future representations that might arise and the actual and reasonably foreseeable adverse consequences of those representations, the greater the likelihood that the client will have the requisite understanding. A general, open-ended consent will ordinarily be ineffective because it is not reasonably likely that the client will have understood the material risks involved. If the client is an experienced user of the agent services involved and is reasonably informed regarding the risk that a conflict may arise, such consent is more likely to be effective, particularly if, for example, the client is independently represented by other counsel in giving consent and the consent is limited to future conflicts unrelated to the subject of the representation.

While not a prerequisite to advance consent, in some circumstances it may be advisable to recommend that the client obtain independent legal advice before deciding whether to provide consent. Advance consent must be recorded, for example in a retainer letter.

Implied Consent

In some cases consent may be implied rather than expressly granted. The concept of implied consent is applicable in exceptional cases only. Governments, chartered banks, and entities that might be considered sophisticated consumers of agent services may accept that agents may act against them in unrelated matters where there is no danger of misuse of confidential information. The more sophisticated the client as a consumer of agent services, the more likely that an inference of consent can be drawn. The mere nature of the client is not, however, a sufficient basis upon which to assume implied consent; the matters must be unrelated, the agent must not possess confidential information from one client that could affect the other client, and there must be a reasonable basis to conclude that the client has commonly accepted that agents may act against it in such circumstances.

Dispute

3.3 An agent must not advise or represent both sides of a dispute or potential dispute. For greater certainty, "dispute" as used in this Rule does not authorize an agent to act in a dispute in a manner that would amount to the practice of law.

Commentary

If an agent were permitted to act for opposing parties in a dispute even with consent, the agent's advice, judgment and loyalty to one client would be materially and adversely affected by the same duties to the other client or clients.

Concurrent Representation

(no comment)

Joint Representation

(no comment)

Acting against former clients

(no comment)

Conflicts Arising from Transfer between Firms

(no comment)

Business Transactions with Clients

(no comment)

4. Quality of service

Principle

An agent must be both honest and candid when advising clients and must inform the client of all information known to the agent that may affect the interests of the client in the matter.

Rule 4

4.1 The agent must give the client competent advice and service based on a sufficient knowledge of the relevant facts, an adequate consideration of the applicable law with respect to patent and trademark practice as permitted under the *Patent Act* and the *Trade-marks Act*, and the agent's own experience and expertise.

4.2 The agent's advice must be open and undisguised, and must clearly disclose what the agent honestly thinks about the merits and probable results.

Commentary

Occasionally, an agent must be firm with a client. Firmness, without rudeness, is not a violation of the rule. In communicating with the client, the agent may disagree with the client's perspective, or may have concerns about the client's position on a matter, and may give advice that will not please the client. This may legitimately require firm and animated discussion with the client. The agent must not keep the client in the dark about matters he or she knows to be relevant to the retainer.

4.3 If it should become apparent to the agent that the client has misunderstood or misconceived the position or what is really involved, the agent must use reasonable efforts to explain to the client, the agent's advice and recommendations.

Commentary

An agent has a duty to communicate effectively with the client. What is effective will vary depending on the nature of the retainer, the needs and sophistication of the client and the need for the client to make fully informed decisions and provide instructions.

4.4 An agent must reasonably promptly act on the client's instructions and must reply to all client inquiries.

4.5 An agent must take reasonable steps to advise the client of the costs of obtaining or seeking any intellectual property protection in Canada or elsewhere recommended by the agent.

Commentary

An agent should provide to the client in writing, before or within a reasonable time after commencing a representation, as much information regarding fees and disbursements as is reasonable and practical in the circumstances, including the basis on which fees will be determined. An agent should confirm with the client in writing the substance of all fee discussions that occur as a matter progresses, and an agent may revise an initial estimate of fees and disbursements.

4.6 An agent must communicate in a timely and effective manner at all stages of the client's matter or transaction.

Commentary

The requirement of conscientious, diligent and efficient service means that an agent should make every effort to provide timely service to the client. An agent should meet deadlines, unless the agent is able to offer a reasonable explanation and ensure that no prejudice to the client will result. Whether or not a specific deadline applies, an agent should be prompt in prosecuting a matter, responding to communications and reporting developments to the client. In the absence of developments, contact with the client should be maintained to the extent the client reasonably expects.

4.7 An agent should not undertake to act for a client if he or she is not comfortable, for justifiable reasons, with undertaking the requested task or job for that particular client or he or she does not agree with the instructions from the client to such an extent that the instructions will impair the agent's ability to perform his or her services in accordance with this Code or under the *Patent Act* or the *Trade-marks Act*.

4.8 An agent must reasonably promptly inform the client of any material error or omission with respect to the client's matter.

Commentary

When, in connection with a matter for which an agent is responsible, an agent discovers an error or omission that is or may be damaging to the client and that cannot be rectified readily, the agent must:

- a. promptly inform the client of the error or omission without admitting legal liability;
- b. recommend that the client obtain independent advice concerning the matter; and
- c. advise the client of the possibility that, in the circumstances, the agent may no longer be able to act for the client.

5. Fees

Rule 5

(no comment)

6. Withdrawal of services

(no comment)

7. Duties to the regulator, members and others

Principle

An agent must assist in maintaining the standards of the profession in dealings with the regulator and the profession generally. An agent's conduct toward other agents must be characterized by courtesy and good faith.

Rule 7

7.1 An agent must conduct himself or herself in a professional manner.

7.2 An agent must refrain from conduct that brings discredit to the profession.

7.3 An agent must respond promptly and in a complete and appropriate manner to any communication from the regulator relating to the agent's conduct.

7.4 An agent has a professional duty to meet financial obligations in relation to the agent's practice.

7.5 An agent must report to the regulator any conduct of which the agent has personal knowledge and which in the agent's reasonable opinion, acting in good faith, raises a serious question of whether another agent is in breach of this Code **or any other applicable laws**.

7.6 An agent must encourage a client who has a claim or complaint against an apparently dishonest agent to report the facts to the regulator as soon as reasonably practicable.

7.7 An agent has complete professional responsibility for all business entrusted to him or her and must directly supervise staff and assistants to whom the agent delegates particular tasks and functions.

7.8 An agent acting as a supervisor to a trainee must provide the trainee with meaningful training and exposure to and involvement in work that will provide the trainee with knowledge and experience of the practical aspects of patent agency or trade-mark agency, together with an appreciation of the traditions and ethics of the profession.

7.9 In connection with an agent's practice, an agent must not discriminate against any person.

7.10 In connection with an agent's practice, an agent must not sexually harass or engage in any other form of harassment of any person.

7.11

- a. When an agent ("transferring agent") transfers from a firm ("former firm") to a new firm, neither the agent nor the former firm must exercise or attempt to exercise undue influence or harassment upon clients of the former firm whose work was done by the transferring agent to influence the decision of the client as to who will represent the client.
- b. While an agent is employed, the agent must not solicit business from the agent's employer's clients or prospective clients on his or her account, without the knowledge of the agent's employer.

8. Communications to the regulator, CIPO and others principle

(no comment)

9. Advertising

Principle

An agent may advertise service and fees, or otherwise solicit work, provided that the advertisement is:

1. *neither false or misleading, confusing, or deceptive, nor likely to mislead, confuse or deceive;*
2. *in good taste;*
3. *not likely to bring the profession into disrepute; and*
4. *demonstrably true, accurate and verifiable.*

Rule 9

9.1 An agent must not use any description that falsely suggests that the agent or another person in his or her firm has academic or professional qualifications that such agent or person does not possess. An agent must not advertise services that amount to the practice of law, unless the agent is also authorized to practice law in a province or territory.

Commentary

Clients often seek an agent with certain background or skills. Such clients should not be misled by an agent holding out himself or herself or other members of his or her firm as having skills that they do not possess.

9.2 The Agent's advertisements may be designed to provide information to assist a potential client to choose an agent who has the appropriate skills and knowledge for the client's particular matter. The agent may indicate that his or her practice is restricted to a particular area, or may indicate that the agent practices in a certain area if such is the case. In all cases, the representations made must be accurate (that is, demonstrably true) and must not be misleading.

9.3 The agent must not indicate by way of advertisement, letterhead, or otherwise, that he or she has a professional office at a named location when in fact such is not the case.

9.4 An agent may advertise fees charged for their services provided that:

- a. the advertising is reasonably precise as to the services offered for each fee quoted;
- b. the advertising states whether other amounts, such as disbursements and taxes, will be charged in addition to the fee; and
- c. the agent strictly adheres to the advertised fee in every applicable sense.

Commentary

The use of phrases such as "John Doe and Associates", or "John Doe and Company" and "John Doe and Partners" is improper unless there are in fact, respectively, two or more other agents associated with John Doe in practice or two or more partners of John.

10. Unauthorized practice

Principle

An agent owes a duty to assist in preventing the unauthorized practice of persons or entities. This includes practice not authorized under the relevant intellectual property statutes or by laws regulating the provision of legal services in Canada.

Rule 10

10.1 An agent must act within the scope permitted under the *Patent Act* and the *Trade-marks Act*. An agent must take particular care to avoid providing advice and services that would amount to the practice of law, unless the agent is also authorized to practice law in a province or territory in Canada.

10.2 An agent should not, without the express approval of the regulator, retain, occupy office space with, use the services of, partner or associate with, or employ in any capacity having to do with the practice of Patent or Trade-mark agency or both, an agent who is under suspension as a result of

disciplinary proceedings, or a person who has been struck from the Register or has been permitted to resign while facing disciplinary proceedings and has not been reinstated.

10.3 An agent must not aid or assist a person who is practicing as a patent agent or trade-mark agent in an unauthorized manner.

10.4 An agent who is under suspension as a result of disciplinary proceedings, or a person who has been struck from the Register or has been permitted to resign while facing disciplinary proceedings and has not been reinstated, shall not:

- a. practice as a patent or trademark agent, as applicable, or
- b. represent or hold himself or herself out as a person entitled to practice as a patent or trademark agent, as applicable.

Commentary

It is in the interest of the public and the profession that persons who are not properly qualified, and who are immune from control or management or discipline, not be permitted to offer patent and trade-mark agency services to members of the public.