

CANADIAN PATENT AGENT QUALIFYING EXAMINATION

GUIDE TO WRITING THE PATENT AGENT EXAM

PAPER D – PATENT INFRINGEMENT

These guidelines describe in a general manner the contents and criteria for the Patent Agent Examination - Paper D. Specific content and rating is the responsibility of the Examining Board, based on their considered judgement.

The actual contents of the Examination may change without notice and may differ from the contents of this general guidance document.

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1.0 Introduction

Paper D (Infringement) of the Patent Agent Examination measures the basic competencies necessary for a patent agent to deal with the legal issues related to the infringement of claims in Canadian patents and basic skills for patent agency practice.

The examination is four (4) hours in length.

2.0 Examination Content

The examination consists of two (2) parts:

PART A consists of “long answer questions” and tests a candidate’s ability to provide reasoned opinions on claim infringement issues (legal, analytical, knowledge).

PART B consists of “short answer questions” and tests a candidate’s general patent practice-based knowledge necessary to practice as a patent agent.

2.1 PART A – Long Answer Questions

What is tested and rated:

IN PART A, candidates are rated on three categories of competencies:

- (1) Legal competencies that require the candidate to exhibit understanding of Canadian patent law, including case law, on the issue of infringement and more specifically on the various types of infringement, and grounds for defense, as well as the types of remedies available, for example: infringement by importation, inducement to infringe, infringement by repair, Gillette defense, injunctive relief, accounting of profits, limitation period, etc.;
- (2) Analytical competencies that require the candidate to (a) exhibit an understanding of the inventive subject matter, claim construction and claim scope and to identify analytical issues which need to be addressed, for example the effect of minor modifications on infringement, (b) exhibit an understanding of the invention claimed and why a feature must be considered essential, (c) explain and predict given the fact patterns how the specific infringement situation will be dealt with by law; and
- (3) Knowledge competencies that require candidates to recall and explain how specific sub-issues of infringement will be dealt with by law.

Contents of PART A

Part A contains questions relating to specific infringement issues or scenarios. Questions elicit responses that require demonstration of the above three competencies.

All questions will be framed around a single patent, but may be related to different products/processes, different designs, or different manufacturers/users.

Questions can be set in the context of an opinion provided to a client. If so, candidates are specifically asked to provide recommendations and strategic advice whenever appropriate. The client may be the patentee/licensee or the manufacturer/user/importer. Scoring is based on the degree to which the candidate arrives at reasoned opinions and conclusions properly supported by applicable statutory or case law, provides suitable recommendations for further analysis as required (such as suggestions or options for design-around to avoid infringement) and discusses and provides strategic options. No points will be awarded for a dissertation on statutory or case law (Boilerplate) provided without any relation to a specific question.

INSTRUCTIONS TO CANDIDATES

You will be asked to prepare a response to each question/issue. Consider each question separately and independently of the other questions. Do not provide extraneous commentary if not directly relevant to the question. Statements regarding the pertinent law, analysis and argument are required to adequately address each issue. A separate treatise of the law applicable to infringement is not required and will not be scored. Case law should be cited only in support of an analytical reasoning, argument or position. Do not import your own technical knowledge into the response. Use only the technical data provided in the documentation provided.

Appendix A provides a list of examples of issues that may be tested.

Appendix A is **NOT** comprehensive.

2.2 PART B – Short Answer Questions

What is tested and rated:

For the short answers component, the examination tests knowledge-based issues that are not linked or associated with the long answers component. Consider each question separately and independently of the other questions. Candidates are rated on the correctness and clarity of the answer and appropriate statutory or case law citation, when appropriate to the answer.

3.0 Mark Distribution

PART A The long answer component represents 70-80% of the overall grade.

PART B The short answer component represents 20-30% of the overall grade.

4.0 Scoring

PART A

Candidates are awarded marks for:

- dealing correctly with key issue(s)
- dealing correctly with all other issues
- clarity of response/answers
- organization and appropriate presentation of arguments, and
- appropriate statutory or case law citation.

PART B

Candidates are rated on the correctness and clarity of the answer and appropriate statutory or case law citation, when appropriate to the answer.

APPENDIX A

Examples of Legal, Analytical and Knowledge Issues

The following are examples of issues that may be tested.
Appendix A is NOT comprehensive.

ISSUE
Construction of Claims
Infringement
Patent in Force
Gillette Defense
Limitation period
Inducement to Infringe
Import and Export
Remedies
Parts and Repair
Prior User Rights (S.56)
Process for new product
Exceptions (S. 52.2)