

CANADIAN PATENT AGENT QUALIFYING EXAMINATION

GUIDE TO WRITING THE PATENT AGENT EXAM

PAPER B – PATENT VALIDITY

These guidelines describe in a general manner the contents and criteria for the Patent Agent Examination - Paper B. 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 B (Validity) of the Patent Agent Qualifying Examination measures the basic competencies necessary for a patent agent to deal with the legal issues of validity in respect to issued 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 validity 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 claim validity and more specifically on the various grounds for attacking or defending the validity of claims, for example: reference applicability, anticipation, obviousness, indefiniteness, ambiguity, support by disclosure, etc.;

(2) Analytical competencies that require the candidate to (a) exhibit understanding of the invention subject matter, claim construction and claim scope, to identify analytical issues necessary to deal with, for example: analyzing the effect of prior art on claim validity issues, (b) exhibit understanding of the disclosure content of prior art patents and explain how and why the prior art documents can be considered prior art (c) explain and predict given the fact patterns how specific sub-issues of claim validity will be dealt with by law; and

(3) Knowledge competencies that require candidates to recall and explain how specific sub-issues of claim validity will be dealt with by law.

Contents of PART A

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

All questions are framed around a single patent under validity inquiry. A sampling of documents (which may or may not constitute applicable prior art) is also provided.

The patent under scrutiny can contain more than one (1) independent claim.

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. Scoring is based on the candidate's reasoned opinions, suitable recommendations for further analysis as required (such as obtaining expert reports or reports from typical persons of skill in the art) as well as the discussion and strategic options provided.

INSTRUCTIONS TO CANDIDATES

You will be asked to prepare an appropriate 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 question. For example, if the question requires a determination as to novelty, do not comment on other criteria such as utility, obviousness, etc. Note that statements of the pertinent law, analysis and argument are required to adequately address each issue. You may cite case law to support your 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
Prior Art – Citeability of references
Construction of Claims
Prior Art – Obviousness
Prior Art – Anticipation/Novelty
Erroneous small entity status
Case Law
Statutory subject matter
Claim covering inoperable emdodiments
Claim overly broad in view of disclosure
Claim indefinite
Improper inventorship
Lack of unity of invention