

June 13, 2016

VIA EMAIL – [denis.martel@canada.ca](mailto:denis.martel@canada.ca)

Denis Martel  
Director of Patent Policy  
Strategic Policy Sector  
Innovation, Science and Economic Development Canada  
235 Queen Street  
Ottawa, Ontario K1A 0H5

Dear Mr. Martel:

**RE: Comments on Draft Code of Conduct for Patent and Trade-mark Agents**

The Advocates' Society (the "Society") is a not-for-profit association of over 5,500 lawyers throughout Ontario and the rest of Canada. The mandate of the Society includes, amongst other things, making submissions to governments and other entities on matters that affect access to justice, the administration of justice and the practice of law by advocates. As courtroom advocates, the Society's members have a keen interest in the effective judicial resolution of legal disputes and the preservation and protection of the relationship between a client and his or her lawyer.

The Society acknowledges that the provisions of Bill C-59 that grant a statutory privilege to protect communications between patent and trade-mark agents and their clients (appended to this letter) will come into force this month. The Society's members, as advocates who provide legal advice to their clients on a daily basis, take the protections surrounding solicitor-client privilege very seriously. The Society's members are also attuned to the professional and ethical obligations of a lawyer that underpin solicitor-client privilege – those obligations which are essential to maintaining public confidence in an honest, candid discussion between client and lawyer.

The enactment of a statutory privilege to protect the communications between patent and trade-mark agents and their clients must be accompanied by essential safeguards that govern the professional conduct of patent and trade-mark agents. Without these safeguards, litigants will be reluctant to share essential information about their cases.

The Society writes this letter to provide comments on the Draft Code of Conduct for Patent and Trade-mark Agents. While the Society has had only a short period of time to review the Draft Code of Conduct, the Society's members feel it is necessary to provide the following views in light of the importance of solicitor-client privilege to the legal profession.

With this backdrop, the Society provides the following answers to the questions posed in the Government Consultation Paper:

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

In order to protect legal communications by a client as much as possible, the Society believes the following elements form a necessary part of the Code of Conduct that will govern patent and trade-mark agents:

- Confidentiality: This element is of tantamount importance to the enactment of a statutory privilege. Agents must be aware that their ethical obligations to not disclose communications between themselves and their clients extend to implementing safeguards into the administrative and organizational aspects of their practices.
  - Avoidance of Conflicts of Interest: Clients need to be assured that agents will avoid conflicts of interest and will immediately advise their clients of any potential conflict that could have an adverse impact on the relationship between client and agent.
  - Competence: Clients need to be assured that in the communications they have with their agents, agents are relying on their specialized knowledge and training to provide advice.
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?*

Yes. In light of the importance of the statutory privilege, the permissible scope of practice of patent and trade-mark agents should be clearly defined. Appropriate delimitations are essential for providing direction to both agents and clients as to the nature of the representation that agents can provide.

Thank you for providing The Advocates' Society with the opportunity to make these submissions. I would be pleased to discuss these submissions with you at your convenience.

Yours very truly,



Martha McCarthy  
President

**Task Force Members:** Andrew Bernstein, *Torys LLP*  
J. Thomas Curry, *Lenczner Slaght Royce Smith Griffin LLP*  
J. Sheldon Hamilton, *Smart & Biggar*  
Dominique T. Hussey, *Bennett Jones LLP*  
J. Scott Maidment, *McMillan LLP*  
Helder Travassos, *Shibley Righton LLP*

## **Amendments to the *Patent Act* Arising from Bill C-59**

**16.1** (1) A communication that meets the following conditions is privileged in the same way as a communication that is subject to solicitor-client privilege or, in civil law, to professional secrecy of advocates and notaries and no person shall be required to disclose, or give testimony on, the communication in a civil, criminal or administrative action or proceeding:

(a) it is between an individual whose name is entered on the register of patent agents and that individual's client;

(b) it is intended to be confidential; and

(c) it is made for the purpose of seeking or giving advice with respect to any matter relating to the protection of an invention.

(2) Subsection (1) does not apply if the client expressly or implicitly waives the privilege.

(3) Exceptions to solicitor-client privilege or, in civil law, to professional secrecy of advocates and notaries apply to a communication that meets the conditions set out in paragraphs (1)(a) to (c).

(4) A communication between an individual who is authorized to act as a patent agent under the law of a country other than Canada and that individual's client that is privileged under the law of that other country and that would be privileged under subsection (1) had it been made between an individual whose name is entered on the register of patent agents and that individual's client is deemed to be a communication that meets the conditions set out in paragraphs (1)(a) to (c).

(5) For the purposes of this section, an individual whose name is entered on the register of patent agents or an individual who is authorized to act as a patent agent under the law of a country other than Canada includes an individual acting on their behalf and a client includes an individual acting on the client's behalf.

(6) This section applies to communications that are made before the day on which this section comes into force if they are still confidential on that day and to communications that are made after that day. However, this section does not apply in respect of an action or proceeding commenced before that day.

## Amendments to the *Trade-marks Act* Arising from Bill C-59

**51.13** (1) A communication that meets the following conditions is privileged in the same way as a communication that is subject to solicitor-client privilege or, in civil law, to professional secrecy of advocates and notaries and no person shall be required to disclose, or give testimony on, the communication in a civil, criminal or administrative action or proceeding:

(a) it is between an individual whose name is included on the list of trade-mark agents and that individual's client;

(b) it is intended to be confidential; and

(c) it is made for the purpose of seeking or giving advice with respect to any matter relating to the protection of a trade-mark, geographical indication or mark referred to in paragraph 9(1)(e), (i), (i.1), (i.3), (n) or (n.1).

(2) Subsection (1) does not apply if the client expressly or implicitly waives the privilege.

(3) Exceptions to solicitor-client privilege or, in civil law, to professional secrecy of advocates and notaries apply to a communication that meets the conditions set out in paragraphs (1)(a) to (c).

(4) A communication between an individual who is authorized to act as a trade-mark agent under the law of a country other than Canada and that individual's client that is privileged under the law of that other country and that would be privileged under subsection (1) had it been made between an individual whose name is included on the list of trade-mark agents and that individual's client is deemed to be a communication that meets the conditions set out in paragraphs (1)(a) to (c).

(5) For the purposes of this section, an individual whose name is included on the list of trade-mark agents or an individual who is authorized to act as a trade-mark agent under the law of a country other than Canada includes an individual acting on their behalf and a client includes an individual acting on the client's behalf.

(6) This section applies to communications that are made before the day on which this section comes into force if they are still confidential on that day and to communications that are made after that day. However, this section does not apply in respect of an action or proceeding commenced before that day.