

CERTIFIED SPECIALIST PROGRAM

Standards for Certification

Intellectual Property Law (Patent/Trademark/Copyright)**Definition of Intellectual Property Law Specialty**

1. The practice of Intellectual Property Law is the practice of law, whether as a solicitor or as a barrister (or both), principally in the areas of Patent Law, Trade-mark Law and/or Copyright Law.
2. The practice of **Patent Law** is the practice of law, whether as a solicitor or as a barrister (or both), that relates primarily to the *Patent Act* and the regulations made thereunder; and may also include experience with the *Industrial Design Act*, *Plant Breeders' Rights Act*, and the *Integrated Circuit Topography Act*. This practice entails giving legal advice concerning the acquisition and maintenance of patent and related rights in the Patent Office, the Canadian Intellectual Property Office and other government agencies; the enforcement of those rights in the courts; and the licensing and assignment of such rights, either standing alone or in the context of larger commercial transactions.
3. The practice of **Trademark Law** is the practice of law, whether as a solicitor or as a barrister (or both), that relates to the acquisition, maintenance, assignment, licensing and enforcement of trade-marks, trade dress and goodwill at common law and/or under the *Trade-Marks Act* and regulations made thereunder. The practice of Trademark Law may include prosecuting trade-mark applications in the Trade-Marks Office, appearing before its hearing officers in the context of opposition or cancellation proceedings; and/or appearing before the courts in the context of infringement, passing off or expungement hearings or appeals from decisions made by the Registrar of Trade-Marks.
4. The practice of **Copyright Law** is the practice of law, whether as a solicitor or barrister (or both), that relates primarily to the *Copyright Act* and regulations made thereunder. The practice of Copyright Law entails giving legal advice concerning the acquisition, maintenance, assignment, licensing, protection and enforcement of copyrights and moral rights. It may include practice before the Copyright Board and/or the Courts.

Designation

5. An applicant who is certified as a specialist in patent law may be identified as a *Certified Specialist (Intellectual Property Law: Patent)*.
6. An applicant who is certified as a specialist in patent and trademark law may be identified as a *Certified Specialist (Intellectual Property Law: Patent/Trademark)*.
7. An applicant who is certified as a patent and copyright law specialist may be identified as a *Certified Specialist (Intellectual Property Law: Patent/Copyright)*.
8. An applicant who is certified as a specialist in trademark law may be identified as a *Certified Specialist (Intellectual Property Law: Trademark)*.
9. An applicant who is certified as a specialist in trademark and copyright may be identified as a *Certified Specialist (Intellectual Property Law: Trademark/Copyright)*.
10. An applicant who is certified as a specialist in copyright law may be identified as a *Certified Specialist (Intellectual Property Law: Copyright)*.
11. An applicant who is certified as a specialist in intellectual property law may be identified as a *Certified Specialist (Intellectual Property Law: Patent/Trademark/Copyright)*.

Achieving Specialist Certification in Intellectual Property Law

12. Applicants must comply with the requirements for certification set out in Policies Governing the Law Society's Certified Specialist Program ("Policies"), particularly those relating to:
 - Minimum Years of Practice and Recent Experience;
 - Substantial Involvement in the Specialty Area;
 - Professional Development;
 - References;
 - Professional Standards; and
 - Application Fee.
13. Applicants must satisfy the following requirements in order to demonstrate their substantial involvement in the area(s) for which application is made.
 - a) Practice concentration requirements:
 - applicants seeking certification in one area of Intellectual Property Law will have devoted at least 33% of their practice concentration to such area or to Intellectual Property Law averaged over the 5 years of their recent experience;
 - applicants seeking certification in 2 areas of Intellectual Property Law will have devoted at least 60% of their practice concentration to such areas or to Intellectual Property Law; averaged over the 5 years of their recent experience; and
 - applicants seeking certification in all three areas of Intellectual Property Law will have devoted at least 90% of their practice concentration to Intellectual Property Law, averaged over the 5 years of their recent experience.
 - b) During the 5 years of their recent experience applicants will have attained broad and varied experience and a mastery of substantive law and procedures in the applicable area(s) and comply with the experience requirements for the applicable area(s) set out below.
14. If applicants do not entirely meet the experience requirements, they may apply to the Society for consideration of their individual circumstances or their related (non-practice) skills. Consideration will be given in circumstances where applicants have:
 - a) limited their practice in recent years to a particular area of intellectual property law or have been involved in matters of extraordinary length and complexity; or
 - b) engaged in advanced course work or performed related activities such as teaching, authoring books or articles for publication, completing post-graduate or other studies, participating in the development and/or presentation of professional development programs, research, participating in the policy development process, drafting legislation and/or instruments, participating as active members on boards or tribunals, or on the executive of any organization related to intellectual property law or any other experience that applicants consider relevant to their application.

Applicants applying for consideration under this paragraph must, in addition to the brief description of their practice required pursuant to paragraph 12, include with their application

 - c) a detailed description of their individual circumstances or related (non-practice) skills; and
 - d) references from the institutions or organizations from which their experience is drawn, references from peers, samples of writing and/or research, and a complete list of publications.
15. All applicants must include a brief description (no more than 100 words) of the nature of their practice in relation to the specialty area(s) for which application is made.

Intellectual Property Law Experience

16. During the 5 years of their recent experience, applicants must have complied with the experience requirements for the applicable specialty area(s).
17. Applicants are asked to place a check mark (✓) next to the tasks they are selecting from the categories below to demonstrate their patent law and/or trademark law and/or copyright law experience and submit the completed Standards with the application package, along with any supplementary information required in the Standards.
18. Applicants must provide a case/matter analyses for 10 cases or matters which demonstrate the applicant's broad and varied experience and mastery of substantive law and procedures in intellectual property law. Information must be presented in a manner consistent with the ethical obligation of confidentiality.

(a) Patent Law Experience

19. Applicants have 3 routes to meet the experience requirements:

Route 1: Applicants must have performed all the tasks in Category 1;

Route 2: Applicants must have performed all the tasks in any 2 of Categories 2, 3 or 4.

Route 3: Applicants who do not meet the Requirements in routes 1 and 2 may be considered for certification on a case-by-case basis. Applicants applying under this route must indicate which of the task requirements in any or all the categories they have completed and provide a brief description of the tasks so as to demonstrate expertise in the field of Patent Law and related rights including Industrial Design, Integrated Circuit Typography, Trade Secrets and Plant Breeders Rights.

Category 1: Patent Prosecution

- (a) Registration as a Patent Agent:

- Has successfully written and passed the Canadian Patent Agents Examination and is currently and has been continuously, for the previous 5 years, a registered Canadian Patent Agent in good standing with the Canadian Commissioner of Patents;

- (b) Direct Prosecution

- Had carriage of the drafting and filing of 20 originating applications;
- Had primary responsibility for or supervised the preparation and filing of at least 20 responses to formalities requests;
- Had primary responsibility for or supervised the preparation and filing of at least 10 substantive office action responses;

- (c) Prosecution of Foreign Patent Applications Corresponding to a Canadian Patent Application

- Managed the filing of at least 20 applications;
- Supervised the reporting and recommendations for action on at least 10 substantive foreign office action responses;

Category 2: Patent Licensing

- Had primary responsibility for or supervised the preparation of at least 10 licences involving either domestic or foreign pending patents, issued patents, know how, or improvements;
- Acted as patent counsel in at least 4 commercial transactions;

Category 3: Patent Opinions

- Had primary responsibility for or supervised the preparation of at least 5 substantial infringement opinions;
- Had primary responsibility for or supervised the preparation of at least 5 substantial validity opinions;

Category 4: Patent Litigation

- Had carriage of the drafting or supervised the drafting of pleadings (excluding Notices of Appearance) in 5 legal proceedings;
- Acted as first counsel on at least 4 interlocutory motions (e.g. motions to strike, motions for particulars, motions to compel or resist production of documents; and motions to compel answers to disputed questions asked at out-of-court examinations) or supervised such appearances by second counsel;
- Acted as first counsel or second counsel (provided second counsel examined or cross-examined at least one witness or made written and/or oral submissions on one or more discrete issues) in at least 3 trials, applications or appeals; or argued all or part of 3 substantive motions (e.g. a motion for a pre-trial injunction, summary judgment or summary trial);
- Had primary responsibility for or supervised the preparation of at least 3 affidavits of documents;
- Conducted at least 3 examinations for discovery and/or 6 substantive cross-examinations upon affidavits served under the Patented Medicines (Notice of Compliance) Regulations;
- Had primary responsibility for the preparation of 4 expert reports and defended any cross-examination thereon;
- Acted as first counsel or second counsel (provided second counsel made written and/or oral submissions) in at least 2 dispute resolution conferences.

(b) Trademark Law Experience

20. Applicants have 2 routes to meet the experience requirement:

Route 1: Applicants must have performed all the tasks in any 3 of the 4 Categories.

Route 2: Applicants who do not meet the experience requirements in Route 1 may be considered for certification on a case-by-case basis. Applicants applying under this Route must indicate which of the task requirements in any or all the categories they have completed and provide a brief description of the tasks so as to demonstrate expertise in the field of Trademark Law and related rights including domain names.

Category 1: Trademark Prosecution

(a) Registration as a Trademark Agent

- Has been continuously for the previous 5 years a registered Canadian trademark agent in good standing with the Canadian Registrar of Trademarks;

(b) Direct Prosecution

- Had carriage of the drafting or supervised the drafting and filing of 75 or more trademark applications;
- Had primary responsibility for or supervised the preparation and filing of at least 100 substantive office action responses;
- Had primary responsibility for or supervised the preparation and filing of at least 10 statements of opposition;

- Had primary responsibility for or supervised the preparation and filing of evidence in at least 10 opposition proceedings or section 45 proceedings and conducted or defended any cross-examination upon such evidence;
- Had primary responsibility for or supervised the preparation of at least 10 written arguments in either opposition proceedings or section 45 proceedings;
- Conducted at least 3 hearings, either orally or in writing, in opposition proceedings or section 45 proceedings;

Category 2: Trademark Licensing

- Had primary responsibility for or supervised the preparation of at least 10 licences involving domestic or foreign trademarks, trade dress, goodwill or related rights;
- Acted as trademark counsel in at least 4 commercial transactions;

Category 3: Trademark Opinions

- Had primary responsibility for or supervised the preparation of at least 8 substantial infringement opinions involving trademark, trade dress, goodwill or related rights under the *Trademarks Act* or at common law;
- Had primary responsibility for or supervised the preparation of at least 8 substantial validity opinions involving trademark, trade dress, goodwill or related rights under the *Trademarks Act* or at common law;
- Had primary responsibility for or supervised the preparation of at least 20 registrability opinions;

Category 4: Trademark Litigation

- Had carriage of the drafting or supervised the drafting of pleadings (excluding Notices of Appearance) in 5 legal proceedings;
- Acted as lead counsel on at least 4 interlocutory motions (e.g. motions to strike, motions for particulars, motions to compel or resist production of documents, and motions to compel answers to disputed questions asked at out-of-court examinations) or supervised such appearances by second counsel;
- Acted as first counsel or second counsel (*provided* second counsel examined or cross-examined at least one witness or made oral and /or written submissions on one or more discrete issues) in at least 3 trials, applications or appeals; or argued all or part of 3 substantive motions (e.g. a motion for a pre-trial injunction, summary judgment or summary trial);
- Had primary responsibility for or supervised the preparation of at least 3 affidavits of documents;
- Conducted at least 3 examinations for discovery or 6 substantive out-of-court cross examinations;
- Acted as first counsel or second counsel (*provided* second counsel made written or oral submissions) in at least 2 dispute resolution conferences.

(c) Copyright Law Experience

21. Applicants have 2 routes to meet the experience requirement:

Route 1: *Applicants must have performed all the tasks in any 2 of the 3 Categories.*

Route 2: Applicants who do not meet the experience requirements may be considered for certification on a case-by-case basis. Applicants applying under this Route must indicate which of the tasks requirements in any or all the categories they have completed and provide a brief description of the task so as to demonstrate expertise in the field of Copyright Law and related rights including Industrial Design and Integrated Circuits Typography.

Category 1: Copyright Licensing

- Had primary responsibility for or supervised the preparation of at least 10 licences involving domestic or foreign copyright rights;
- Acted as copyright counsel in at least 4 commercial transactions involving copyrights and/or moral rights;

Category 2: Copyright Opinions

- Had primary responsibility for or supervised the preparation of at least 15 substantial infringement opinions involving rights under the *Copyright Act*;
- Had primary responsibility for or supervised the preparation of at least 15 substantial opinions regarding the, authorship, ownership and/ or validity of copyrights and/or moral rights;

Category 3: Copyright Litigation

- Drafted or supervised the drafting of pleadings in 4 court proceedings (excluding Notices of Appearance) or drafted or supervised the drafting of four proposed tariffs or objections thereto in proceedings before the Copyright Board;
- Acted as lead counsel on at least 4 interlocutory motions (e.g. motions to strike, motions for particulars, motions to compel or resist the production of documents, motions to compel answers to disputed questions asked at out-of-court examinations) or supervised such appearances by second counsel;
- Acted as first counsel or second counsel (*provided* second counsel examined or cross-examined at least one witness or made oral or written submissions in respect to one or more discrete issues) in at least 3 trials, applications or appeals before the courts, or in at least 3 Copyright Board hearings; or argued all or part of 3 substantive motions before the courts (*e.g.* a motion for a pre-trial injunction, summary judgment or summary trial);
- Had primary responsibility for or supervised the preparation of at least 3 affidavits of documents in court proceedings, or at least 3 witness statements or statements of case in proceedings before the Copyright Board;
- Conducted at least 3 examinations for discovery in court proceedings or prepared at least 3 sets of written interrogatories or responses thereto in proceedings before the Copyright Board;
- Acted as first counsel or second counsel (*provided* second counsel made written or oral submissions) in at least 2 dispute resolution conferences.

Professional Development

22. Applicants must attest to the completion of not less than 50 hours of self-study.
23. The 50 hour self-study requirement may be met through methods such as, but not limited to:
 - a. teaching or being guest lecturer on a course in the specialty area;
 - b. writing and editing of published books or articles relating to the specialty area;
 - c. graduate or post-graduate studies in the specialty area;
 - d. involvement in the development and/or presentation of professional development;
 - e. programs related to the specialty area;
 - f. involvement in the development of policy related to the specialty area.

References

24. Applicants must submit 4 references from legal practitioners eligible to practise law in Ontario who have direct knowledge of the applicant's work in the specialty area in the 5 years of the applicant's recent experience and can attest to the applicant's competent performance of the tasks outlined under Patent Law Experience and/or Trademark Law Experience and/or Copyright Law Experience. Applicants must provide to the referees a copy of the completed Standards to let them know which categories they have selected to demonstrate their experience.
25. Applicants should not include as reference: judges, partners, associates, co-workers, employers, counsel to their firm, employees, relatives, 3rd party neutrals (i.e. persons, such as adjudicators, arbitrators, mediators, or any statutory decision maker, whose knowledge of the applicant's practice is derived solely from the applicant's appearance before the person while acting as an impartial decision maker), members of the Certified Specialist Board, benchers or employees of the Law Society.
26. The Statements of Reference must be submitted directly to the Law Society Certified Specialist Program via email to: certspec@lso.on.ca (*preferred method*), or via mail to: 130 Queen St W., Toronto ON, M5H 2N6.

Application Assessment

27. The Society will consider the totality of an applicant's practice in the relevant specialty area(s), the applicant's professional development report and references.
28. Applicants should not assume that completion of all the enumerated practice concentration and experience requirements will automatically entitle them to certification as a specialist.
29. Applicants may be required to provide additional information to the Society facilitate the assessment process.
30. The Society may make discreet inquiries, as it deems appropriate, to determine the applicant's eligibility and suitability for certification as a specialist.

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