

20 November 2023

Ref: OIA-23-054

Wayne Hudson
By Email: fyi-request-22548-fc53570f@requests.fyi.org.nz

Tēnā koe Mr Hudson,

Official Information Act 1982 request for patent work and patent advice policy

I refer to your email of 27 October 2023 requesting, under the Official Information Act 1982 (the Act), the following information:

“In your letter of 23 May, you said that, “The definition of ‘patents work’ refers to the legislative definition provided in section 274(10) of the Patents Act 2013.”

However that statement is incorrect, as the legislative definition contains as an exception “(other than of a scientific or technical nature)”. That means that lay people are allowed to provide scientific and technical advice in relation to patents.

This is the area in which I am interested as I am trying to find out why Callaghan and certain other government agencies have omitted the words quoted above.

In your letter of 26 October you stated that “The decision to have funding for patent work and patent advice/FTO searches conducted by registered patent attorneys was not taken in relation to this grant, and was already the policy of Callaghan Innovation at the time of the planning of the grant.”

This statement indicates that a decision had previously been made by Callaghan Innovation to introduce a policy that patent work and patent advice/FTO searches should be conducted by registered patent attorneys.

Therefore please provide me with a copy of the original policy and all information (including internal sign-off) relating to the implementation of that policy.”

Context

Policy documentation for all funding products offered by Callaghan Innovation are developed under a Ministerial Direction. Our monitoring agency, the Ministry of Business Innovation and Employment (MBIE) is responsible for the policies. Callaghan Innovation is responsible for the operational administration of the funding products, which includes the development of guidance for Grant applicants and recipients. The documentation you seek in relation to the funding/co-funding of patent advice is therefore not policy, but guidance produced by Callaghan Innovation, which is what we are releasing to you.

Guidance documents

There are two guidance documents that refer to the funding/ co-funding of patent advice, and that it is to be provided by a registered patent attorney. Both of these documents are publicly available, therefore, I am declining your request for copies of these guidance documents in accordance with Section 18(d) of the Act, as the information requested is publicly available.

The first is the [Eligible Activities for the Arohia Full Grant](#) document, where page 7 refers to patent advice. It is noted that you refer to this particular document in your previous correspondence. The second is in the [Eligible Costs for the New to R&D Grant](#) document, where page 4 refers to patent advice.

Introduction of patent advice guidance to Callaghan Innovation guidelines

As you are aware, under the Patents Act 2013 only a registered patent attorney can carry out “patent work” which includes Freedom to operate advice. We understand that freedom to operate advice almost always involves advice on the validity and/or infringement of patents (which is patent work and accordingly should only be provided by registered patent attorneys).

It was brought to our attention that Callaghan Innovation and our Regional Business Partners had been referring New Zealand businesses to persons who were not registered patent attorneys for freedom to operate advice.

In light of this information, Callaghan Innovation implemented guidance for relevant programmes (currently only the two Eligible Activities documents provided in this response), and recommended that staff and Regional Business Partners remind customers to do due diligence on providers and take into account whether they are registered or recognised by an industry body.

The two Eligible Activities documents that specifically refer to patent advice (*the guidance*) were developed to encourage grant recipients to enlist the services of a registered patent attorney to carry out patent related activities funded by the grant.

The wording for the guidance was drafted with reference to section 274(10) of the Patents Act 2013. The wording focuses on advice on the validity and/or infringement of patents and refers customers to the relevant industry body. It does not restrict customers from receiving other innovation or IP consultancy related services (for example scientific and technical advice), as Callaghan Innovation recognises those services are not captured by the Patent Act 2013 and are legitimate services currently provided by other Callaghan Innovation providers (for example in [Beyond IP](#)).

However, by limiting the funding/co-funding for patent advice to registered patent attorneys, Callaghan Innovation is attempting to ensure that grant recipients are engaging with licensed professionals and can therefore receive patent advice that they can rely on. As Callaghan Innovation provides public funding for its grants, Callaghan Innovation has an obligation to the taxpayer to ensure that grant recipients are seeking services from qualified individuals (and accordingly using the funding appropriately).

You have the right to seek an investigation and review by the Ombudsman of this decision. Information about how to make a complaint is available at www.ombudsman.parliament.nz or freephone 0800 802 602.

Nāku noa, nā



Brett Calton
Chief Product Officer
Callaghan Innovation