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Senate Economics Legislation Committee
ANSWERS TO QUESTIONS ON NOTICE
Industry, Tourism and Resources Portfolio
Budget Estimates 2004-2005, 31 May 2004 to 2 June 2004

AGENCY/DEPARTMENT: IP AUSTRALIA
TOPIC: BLUE CYPRESS OIL - BITTER BLUE
REFERENCE: WRITTEN QUESTIONS ON NOTICE

QUESTION No.63
(Written QON)

Senator Carr asked:

Reference: article in The Age on 21 April 2004 entitled Bitter Blue. Is IP Australia familiar with this case?

ANSWER

Vincent and Maryann Collins have applied for two patents and one petty patent. The current status of these is:

1. 742711 Standard Patent. Granted. Term expires 8 July 2018. Annual renewal fee paid up to 8 July 2004.
2. 723540 Petty Patent. Granted, term extended until 8 July 2004. [Application filed as a divisional application from 742711.] Patent surrendered 28 Oct 2002 to allow the grant of the Standard Patent to proceed.
3. 33005/02 Application for a standard patent. Lapsed. [Application filed as a divisional application from 742711.]

The Petty Patent system required a patentee, at the end of 11 months from grant of the patent, to apply for an extension of the term of the patent. The request to extend the term of Petty Patent 723540 was objected to by a Mr William McGilvray. The normal process for dealing with such objections entails the filing of evidence by the objector, the filing of evidence in response by the patentee, and a hearing before the Commissioner. In this case Mr McGilvray filed further evidence after the evidence in response was filed.

The objection to the extension of term of the Petty Patent was heard on 15 January 2002. The decision was issued on 6 June 2002; it found the grounds of objection unsubstantiated, and extended the term of the Petty Patent.

Mr Collins spoke to staff in IP Australia on a number of occasions. He had a particular concern about a particular item of evidence supplied by Mr McGilvray. Under a declaration Mr McGilvray exhibited a document said to have been produced by "The Australian Essential Oil Company" that allegedly anticipated the invention. The problem is that the document contained phone numbers that only came into existence well after the alleged publication date. The difficulty is that the evidence did not necessarily assert that it was the 'whole' document that was published, as distinct from the textual content on the document - that was perhaps held in a word-processor, and printed out on current letterhead. In either event, the Commissioner's delegate attached little significance to this document as it was insufficient to establish anticipation.

Throughout the proceedings before the Commissioner, Mr Collins has 'expressed concern' about this document, alleging that there has been a fraud committed. IP Australia initially advised Mr Collins to contact the police if he wished to pursue the fraud matter. In Sept. 2001, the police advised that they did not intend to pursue the matter of fraud. On 27 Sept 2001, following a telephone call from Mr Collins, a letter to Mr Collins records *inter alia* concern about the nature of the allegations being made by him; the role of the Commissioner of Patents in resolving the dispute, and the requirements to accord each party natural justice. Various file notes indicate that there is a long-running dispute between Mr Collins and Mr McGilvray, which is of a much broader nature than the patent hearing issue.

QUESTION No.64

(Written QON)

Senator Carr asked:

Was the oil the official essence of the Sydney Olympic Games and was it used as part of the marketing for those games?

ANSWER

IP Australia cannot comment on whether or not the oil was the 'official essence of the Sydney Olympic Games' or whether it was used as part of the marketing for those games. However, Jurlique International Pty Limited, the company reported in The Age as having marketed Blue Cypress, was listed in the SOCOG Register of Licensed Users as licensed to use the Sydney 2000 Games Logo for burners, candles, evaporators, pomanders, pot pourri and pillows.

QUESTION No.65

(Written QON)

Senator Carr asked:

Did Mr Vince Collins file an application for a patent over the extraction process for the oil?

ANSWER

Yes - this was the subject of the three patent applications.

QUESTION No.66

(Written QON)

Senator Carr asked:

Was Vince Collins granted a petty patent in 2002?

ANSWER

Petty Patent 723540 was granted on 31 August 2000. The decision to extend the term of this petty patent was issued on 6 June 2002.

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QUESTION No.67

(Written QON)

Senator Carr asked:

Was Vince Collins granted an Australian patent in 2002?

ANSWER

Standard Patent 742711 was granted on 7 Nov 2002.

QUESTION No.68

(Written QON)

Senator Carr asked:

Under Australian IP law, can you patent a process? Did Mr Collins receive a patent over a process?

ANSWER

Applicants can obtain patent protection for processes. The same patent could also claim the product of the process. Mr Collins' patent was for "A method of producing a blue, guiazulene-containing oil comprising", which is a form of process claim. The standard Patent includes a claim to the oil that is produced by the process.

QUESTION No.69

(Written QON)

Senator Carr asked:

Has an official dispute ensued over the patent held by Vince Collins? Who are the parties to this dispute?

ANSWER

Yes. See response to Question 63 above.

QUESTION No.70

(Written QON)

Senator Carr asked:

What are the main areas of contention over this patent?

ANSWER

Yes. See response to Question 63 above.

QUESTION No.71

(Written QON)

Senator Carr asked:

Has another company or individual been infringing the patent held by Mr Collins?

ANSWER

The responsibility for monitoring for infringement of patents resides entirely with the patentee. If court action for infringement is brought in the Federal Court, the patentee is required (under Order 58 of the Federal Court Rules) to serve a copy of the court application on the Commissioner. The files of these patents do not contain any copies of court applications for infringement, which implies that no infringement action is before the Federal Court.

Correspondence on the file of Petty Patent 723540 includes a query from the Northern Territory Department of Infrastructure, Planning and Environment, stating that they were responsible for the management of a number of former Cypress plantations, and consideration was being given to making that resource available by tender for Commercial use for distilling oils from the pines. They indicated that Mr Collins was a potential tenderer who claimed he had a patent which prevents the Government from licensing anyone else to utilise the trees for this purpose. They sought the Commissioner's advice on 'whether Mr Collins has such a patent and if so, does it provide him with the exclusivity he claims'.

QUESTION No.72

(Written QON)

Senator Carr asked:

How long has the dispute been going?

ANSWER

Certain documents alleged to anticipate the invention (including a document signed by Mr McGilvray) were filed on 22 July 1999 in respect of the application for the standard patent. The 'dispute' formally ended on 6 June 2002, when the Commissioner determined that the term of the Petty Patent could be extended. However the file of the Petty Patent records a telephone call from Mr Collins on 4 November 2002, with Mr Collins asserting that "there has been a major crime committed against IP Australia, you must do something about it - and I have the evidence you need."

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QUESTION No.73

(Written QON)

Senator Carr asked:

What is IP Australia's role in the dispute?

ANSWER

The Commissioner of Patents was required to determine in accordance with law whether the term of the Petty Patent should be extended. In this case, the primary issue in dispute was whether the invention was novel, and involved an inventive step. The procedure involves receiving evidence from both parties, an oral hearing - following which a written decision is issued. That decision can be appealed to the Federal Court.

In this case, the Commissioner's delegate found the objection to the extension of the term of the petty patent failed, and extended the term of the Petty Patent. No appeal was filed with the Federal Court. No opposition to the grant of the Standard Patent was filed.

QUESTION No.74

(Written QON)

Senator Carr asked:

Does IP Australia have the power to enforce a patent?

ANSWER

No. IP Australia administers the Australian patents legislation providing a process for the examination of patent applications and the granting of patents. However, once a patent has been granted, the patent owner is responsible