

EDUCATION, SCIENCE AND TRAINING

SENATE LEGISLATION COMMITTEE - QUESTIONS ON NOTICE 2006-2007 ADDITIONAL ESTIMATES HEARING

Outcome: CSIRO
Output Group: CSIRO

DEST Question No. E1041_07

Senator Carr provided in writing.

Question:

Dr Steele has stated that the patent position requires inventors to 'stand behind' the patent applications.

Can CSIRO confirm that, in this instance:

- The inventors do not stand behind the applications, and
- That they instead written to both Australian and US patent attorneys advising them of that fact?

Answer:

CSIRO has provided the following response.

G-bIRD

The inventors signed the forms assigning to CSIRO ownership of the inventions that were described in the provisional patent applications that were filed in September 2003 and January 2004 (see answer to E1043_07), and in March, May and October 2004.

In 2006, the inventors were requested to execute additional forms as part of the national phase applications proceeding before the US PTO for two of these inventions. The assignment document is similar to the deeds of assignment that had already been signed by the inventors in 2004, except they were not in the format prescribed by the US PTO. The inventors advised CSIRO in a letter dated 6 June 2006, that was copied to CSIRO's attorneys, (and a copy of which was provided to the Standing Committee on Employment, Workplace Relations and Education Estimates Committee at Additional Estimates on 14 February 2007) that they had concerns about signing these assignment forms, on the basis that:

- (1) they had not had sufficient opportunity to read and review the US patent applications;
- (2) that the description of the invention in the patent applications contained "invalidating" errors in the data and analyses (however, without providing specific details of such errors. Dr Prata subsequently stated that the errors had been his); and
- (3) as they were concerned that there may be prior art and inventiveness issues in relation to the applications.

Dr Prata has acknowledged that the inventions are owned by CSIRO and stated that he is keen to assign the patent applications to CSIRO, but has objected to their validity in general terms without, however, providing to CSIRO details of relevant errors in the patent application.

CSIRO has:

- regarding item (1) above, provided copies of the application to the inventors and asked them to review it in order to execute the US PTO assignment forms; and offered to remunerate them for their time in conducting the review;
- regarding item (2) and (3) above, advised the inventors that CSIRO will make their 6 June 2006 letter available to the US PTO for consideration during the patent examination process; and
- regarding item (3) above, advised the inventors that the assignment document does not require the inventor (or CSIRO) to express an opinion upon whether or not the subject matter of the application is patentable as that is a matter for the US PTO to determine.