

## EDUCATION, SCIENCE AND TRAINING

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

**Outcome:** CSIRO  
**Output Group:** CSIRO

#### **DEST Question No. E1045-07**

Senator Carr provided in writing.

#### **Question:**

It has been suggested that one, if not both, of these two researchers emailed Michael Edwards in CSIRO during September 2003 outlining concerns.

Is that the case?

Please provide a copy of the relevant email(s)?

#### **Answer:**

CSIRO has provided the following response.

#### *G-bIRD*

Yes, there are emails on 22 and 23 September 2003 between Dr Prata and Mr Edwards. The messages are in relation to the content of the Provisional patent application named "AN ALARM SYSTEM FOR REMOTE SENSING EQUIPMENT" that was filed on 29 September 2003; whether the proposed content of the provisional patent disclosure was adequately complete; and whether the inclusion of the information in that patent application would confound a separate patent application that was planned to be submitted later (known within the team as the "G-bIRD system patent").

The context of the emails was that Dr Prata was overseas and there was a presentation to a scientific meeting planned for 29 September 2003. Before his departure overseas, Dr Prata had prepared a description of the invention for inclusion in the patent application; however he had not forwarded this to the patent attorney (who needed this to be able to prepare the patent application). If patent protection was to be sought, it needed to be applied for prior to any disclosure of the invention at that meeting (i.e. before 29 September). If patent protection were not sought, it was likely that the meeting presentation would either be cancelled or else not disclose the invention. The patent application was prepared by the patent attorney and lodged on 29 September 2003. A further provisional application named "AN INFRARED DETECTION APPARATUS" and having different text to the "ALARM SYSTEM" provisional patent application of September was filed on 16 January 2004. On 29 September 2004 two PCT Patent Applications, each claiming priority from both of the 29 September 2003 and 16 January 2004 provisional applications but having all or most of the text of the application derived from the 16 January 2004 provisional application, were lodged. Dr Prata was consulted on the content of these PCT Patent Applications.

The relevant emails are copied below. A mobile telephone number has been redacted from the attached email.

-----Original Message-----

From: Prata, Fred (AR, Aspendale)  
Sent: Tuesday, 23 September 2003 5:50 PM  
To: Edwards, Michael (AR, Aspendale)  
Subject: RE: G-bIRD Provisional Patents - URGENT.

Dear Mike

Very well. Here it is but I strongly object to this and would like it noted that I do not agree with this decision.

Please note my comments below before filing.

This kind of dumbing down of our science is exactly what we should be avoiding and I am surprised and disappointed that you feel you must support Tenix on this and not a CSIRO scientists' judgement. Nick Mountford (who is a patent attorney) said (at a meeting that you missed) he did not believe there was enough information on the alarm for a patent and that it should be part of the G-bIRD system patent. I agree with him. I would also point out that I raised IP issues several times with both you and Matt and no action was taken. Now everything seems to be in a hurry - that's when mistakes are made. If you read this document carefully you will see that it discloses how the G-bIRD system works and hence may cause us some problems with the far more important G-bIRD system patent. We are also disclosing that in Toulouse (actually we have already in a PPT that Matt asked me to send to Boulder and for which he was unconcerned about disclosure - story has changed now).

Despite our differences on this I believe there is a sensible, workable way forward. Allow me the time to do a good job (not the best possible) and I think everyone will benefit. Check with Nick about whether he still believes the alarm patent will stand by itself (can you tell me what is novel?) Check with Nick whether we have a period of grace after public disclosure, there may be some time allowed for us to file after disclosure. I realise Tenix call the shots and I am saddened that we have to compromise our science in this way.

Regards,

Fred

-----Original Message-----

From: Edwards, Michael (AR, Aspendale)  
To: Prata, Fred (AR, Aspendale)  
Sent: 9/23/2003 12:09 PM  
Subject: RE: G-bIRD Provisional Patents - URGENT.

Fred,

This is becoming a real issue. I am still not sure why you feel you cannot pass on the documentation that you very diligently prepared before you left for Sicily. Despite the further development you are doing in Sicily I am sure those documents already have enough substance for the provisional patenting phase.

I have read your note below and recognise that some of the technical issues are still evolving with the work that you are doing in Sicily. I also agree that the G-bIRD system patent is less well defined at this point and the concepts could still change quite significantly from here. But that is exactly what a the 12 month "provisional" patent phase is all about, ie. submitting broad patentable concepts from which detailed claims can be drafted during the 12 month provisional phase. In short I think we have enough to submit provs for at least the SO2 and alarm IP,

and probably also the G-bIRD system, but this is not quite as clear. I believe the patent attorneys are well versed in guiding us through this provisional phase with just the right amount of broad protection for this stage with a view to following up on the detailed claims and fine tuning in the coming months.

As part of our License Agreement to Tenix we also have a pretty clear obligation to secure new IP when appropriate (see below). The so-called Tenix 'Grey Team' have clearly identified this area of IP protection for attention and enhancement in their prior review, and are looking to review progress in the milestone 1 meeting earmarked for 13/10/03. I am worried that the project could be exposed to criticism in this area if we choose not to act on their prior recommendation to have provisionals around new IP prior to public discussions, including the Toulouse meeting.

I understand you may be able to present something at Toulouse without specifically disclosing the "how we do it", but I am still unsure why we just wouldn't put provisionals in anyway? What is there to lose? Ultimately I think we need to put provisionals around at least the S02 and alarm IP before Toulouse which requires the patent attorney(s) getting something from me now. Will you pass on what you have already drafted as a prompt for provisional patent drafts?

Thanks,  
Michael.

From the Tenix Technology License Agreement:

9 SECURING INTELLECTUAL PROPERTY PROTECTION

9.1 CSIRO will, subject to this clause 9, be responsible for applying for, securing and maintaining any patents and other Intellectual Property Rights registration in relation to the Technology.

9.2 The Licensee will reimburse CSIRO for all future costs and expenses (including patent attorney and legal costs) incurred during the Term and associated with applying for, securing and maintaining any patents and other Intellectual Property Rights registration associated with the Technology and any past and present costs which the Licensee agrees to reimburse CSIRO. All such reimbursement will be paid on the basis that:

(a) CSIRO will promptly forward to the Licensee an invoice for costs and expenses incurred by CSIRO; and

(b) the Licensee will reimburse CSIRO for all such costs and expenses within thirty (30) days after receipt of the invoice.

-----Original Message-----

From: SIMMONS Matthew [<mailto:Matthew.Simmons@Tenix.com>]  
Sent: Tuesday, 23 September 2003 7:25 AM  
To: Fred.Prata@csiro.au; Michael.Edwards@csiro.au  
Subject: RE: G-bIRD Provisional Patents - URGENT.

Michael,

We should cancel the VAAC paper if we cannot file the patent on the alarm this week.

Matt Simmons

-----Original Message-----

From: Fred.Prata@csiro.au [<mailto:Fred.Prata@csiro.au>]  
Sent: Monday, 22 September 2003 9:05 PM  
To: Michael.Edwards@csiro.au  
Cc: SIMMONS Matthew  
Subject: RE: G-bIRD Provisional Patents - URGENT.

Dear Michael

The patent material is still not ready to be sent. Recall that all 3 patents must be submitted simultaneously so it might not be prudent to send stuff out now without my input. It is my judgement that it is better to get all 3 right and then send them out, this may take a little longer but will prove worthwhile in the long run. One problem I am having is that the GbIRD system patent is still evolving as we learn here how to operate the camera. Also, we are now getting our first really good SO2 images and can see that the alarming method needs some (minor) work. For example we are finding that the images are rather noisy ( a consequence of ICC dumbing down the detector for export), thus we have now implemented another step in the processing to remove the noise. This changes the alarm method. I am not concerned at all about disclosure at the Toulouse meeting as we dont need to tell them how we are doing things.

As for contacting me. The hotel have given me no messages at all and I am in contact with family, Matt and Nigel by my mobile phone or text messaging without problem. The mobile seems to work fine here from anywhere. In case you dont have the number it is .

Will head off to Stromboli tomorrow to see if we can find some ash.

Regards,

Fred.  
cc. Matt Simmons

-----Original Message-----

From: Edwards, Michael (AR, Aspendale)  
To: 'SIMMONS Matthew'; scott.berggren@sprusons.com.au  
Cc: Prata, Fred (AR, Aspendale); Turner, Peter (AR, Aspendale)  
Sent: 22/09/2003 13.02  
Subject: RE: G-bIRD Provisional Patents - URGENT.

Matt and Scott,

Unfortunately I do not have the required information here in Australia, it is ONLY with Fred in Sicily. He knows that it is needed asap in order to put together the required Provisionals within the next week or so. Fred originally promised to leave a copy of his draft so far with me before he left for overseas but didn't. I have tried contacting Fred about this via email and telephone last week and again over the weekend with no luck. There is a message at his hotel for him to contact me urgently about this. I have not been able to get a connection to his mobile phone.

Unless he sends me/us the files that have been developed so far we will simply have to file against the more basic information that is already known from Scott's previous discussions with Fred. I do not believe we have any further information here at Aspendale to add since it resides with Fred.

I will obviously keep doing my best to contact Fred and try to get him

to respond with his patent information files asap.

Regards,  
Michael.

PS. Matt - you told me that you spoke to Fred late last week. Was that at his hotel, or do you have another contact for him - Mike Burton perhaps??

-----Original Message-----

From: SIMMONS Matthew [<mailto:Matthew.Simmons@Tenix.com>]  
Sent: Monday, 22 September 2003 11:14 AM  
To: scott.berggren@sprusons.com.au  
Cc: Michael. Edwards (E-mail); Fred. Prata (E-mail)  
Subject: RE: G-bIRD

Scott,

Please call Michael Edwards to make sure you get the required info early this week.

Matt Simmons

-----Original Message-----

From: sdb [<mailto:scott.berggren@sprusons.com.au>]  
Sent: Tuesday, 16 September 2003 11:20 AM  
To: SIMMONS Matthew  
Subject: G-bIRD

Dear Matt,

Thanks for the update. What do you want me to do about the provisional application for the alarm patent? Is there any chance Fred will be able to get the additional disclosure to me? I can prepare a patent specification from the information you gave me, but I am concerned that it will be insufficient without Fred's contribution about the algorithm details. Alternatively, is there any possibility of deferring disclosure of the alarm until a later date, so that a provisional application can be filed beforehand?

I'd gratefully appreciate your reply, as I am prepared to proceed with the application at your convenience.

On a related note, I will be in the U.S. from 7 to 19 October 2003, inclusive.

I am contactable throughout by email and cell phone.

Obviously, it would be best to file the patent application before then, if possible, and still better before 29 September 2003. There are less than 2 weeks remaining before the proposed disclosure, so things will be tight but still do-able.

Regards,  
Scott Berggren  
SPRUSON & FERGUSON

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V 9 April