

Federal Court of Australia
District Registry: New South Wales
Division: General

No. NSD 527 of 2024

FORTESCUE LIMITED (ACN 002 594 872) and others

Applicants

ELEMENT ZERO PTY LIMITED (ACN 664 342 081) and others

Respondents

Fortescue's submissions on the admissibility of the affidavit of Dr Grant Jacobsen (for hearing on 17 September 2025)

1. For the reasons below, the Court ought to reject the Respondents' objections to the affidavit of Dr Grant Jacobsen, affirmed 20 August 2025 for (a) relevance, (b) s 79 of the Evidence Act (**EA**), (c) s 135/136 of the EA, and (d) case management principles.

Relevant issue in Interlocutory Application dated 17 June 2025 (IA)

2. By prayer 1 of the IA, Fortescue seeks leave to inspect the materials seized under the search orders. The Court may grant such leave for the purposes of ensuring that the proceeding be adequately and properly prepared, and to test whether the discovery that has been given was adequate.¹ Prayer 3A of the proposed Amended Interlocutory Application seeks further discovery with a focus on categories 11(e) and (f).
3. The standard for determining insufficiency of discovery is whether there are reasonable grounds for being fairly certain that there are other relevant documents.² Insufficiency might appear from the discovered documents and "any other source that constituted an admission of the existence of a discoverable document".³ Fortescue contends that the Respondents' patents and discovered documents admit the existence of other documents which have not been discovered.

Deficiencies in dispute – 26 February 2025 order, schedule 1 categories 11(e) and 11(f)

4. Category 11(e) is: "All versions, including drafts, of ... documents recording or evidencing the "retirement 'project'", the "work with nickel [and] iron", and the "work that eventually led to the creation of Element Zero", referred to in paragraph 40 of "Dr Winther-Jensen's affidavit. Fortescue contends deficiency of discovery of substantive, technical documents disclosing this work."⁴
5. Category 11(f) is: "documents recording the research and development of the "Element Zero Process" [as pleaded in the defences], during the period from January 2022 to February 2024". Fortescue contends deficiency of discovery:

¹ *Metso Minerals v Kalra* [2009] FCAFC 57 at [16]-[17] (Emmett J, Jacobson and Perram JJ agreeing); *Rauland v Johnson (No 2)* [2019] FCA 1175 at [55] (Stewart J).

² *Procter v Kalivis* [2009] FCA 1518 at [33] (Besanko J); *Watson v Kriticos (Further Discovery and Adjournment)* [2023] FCA 793 at [18]-[21] (Perram J).

³ *Procter* at [32]; *Mulley v Manifold* (1959) 103 CLR 341 at 343 (Menzies J).

⁴ *Dewar 10*, PAD-45, pp 159 #4, 179 #462.

- (a) in relation to experiments in the examples in the Respondents' patents;⁵
- (b) in relation to specific R&D and testing referred to in discovered documents;⁶
- (c) in relation to R&D occurring in 2022.⁷

Relevance of Dr Jacobsen's evidence to alleged deficiencies in discovery

6. Dr Jacobsen's evidence is relevant if it "could rationally affect (directly or indirectly) the assessment of the probability of the existence of" other relevant documents: EA s 55(1). There can be no serious suggestion that Dr Jacobsen's evidence fails to meet this threshold.
7. It is necessary to understand the scientific content of the Respondents' patents and other discovered documents in order to engage with Fortescue's contentions as to the deficiencies in the Respondents' discovery. A proper understanding of these documents requires knowledge of chemistry, especially electrochemistry. It is entirely commonplace and appropriate for the Court to derive assistance from expert evidence from a person skilled in the relevant art to understand what these documents disclose, including whether they admit the existence of other relevant documents. Dr Jacobsen's affidavit seeks to assist the Court in this task.
8. In **Part C [47]-[94] (Pre-Provisional discovered documents)**, Dr Jacobsen addresses the Respondents' discovered documents dated 1 January 2022 to 20 October 2022, that is, before the filing of the Respondents' 2022 provisional patent (**2022 Provisional**).
9. At [85], Dr Jacobsen gives evidence of experimental records in the Pre-Provisional period which are not contained in Dr Winther-Jensen's notebook. He refers at [85](a)-(c) to: (i) an email discussing "*first measurements*" pre-dating the first record in the notebook; (ii) "*example*" typed summaries of experiments in 2022-2023 attached to an email in 2024, which experiments are not described in the notebook and must have been based on original experimental records; and (iii) experiments described in the 2022 Provisional that are not contained in the notebook or any other Pre-Provisional discovered document.
10. In **Part D [95]-[121] (2022 Provisional)**, Dr Jacobsen reviews Examples 1–3 of the 2022 Provisional and explains why he considers that complete records of the experiments in those Examples should be, but are not, contained in the Pre-Provisional discovered documents, see in particular at [101], [103], [107], [109], [111], [114], [116] and [118].
11. At [121], when summarising his views concerning the 2022 Provisional, Dr Jacobsen notes that he has reviewed each of the Pre-Provisional discovered documents provided to him. Having reviewed those documents, at [122] Dr Jacobsen is asked to comment on whether *the documents* reflect documents that he would expect to have been created during the initial process of R&D. At [124] Dr Jacobsen explains that the

⁵ Dewar 10, PAD-45, p 160 #14, #15; PAD-46 pp 186-187 #496-#499.

⁶ Dewar 10, PAD-45, pp 170-175, 180 #389, #390-#395, #400-#403, #405-#406, #413, #419-#424, #426, #428-#429, #436, #474; PAD-46, pp 187-190 #504-#505, #513-#515, #518, #521, #523, #526-#529, #533, #534-#536.

⁷ Dewar 10, PAD-45, p 160 #13.

email discussions, principally between Dr Winther-Jensen and Dr Kolodziejczyk, do not constitute experimental records of the experiments discussed therein, and concludes at [125] that the documents discovered by the EZ Respondents therefore do not represent a complete set of the documents that must exist concerning those experiments.

12. In **Part E [122]-[129] (Completeness of records in 2022)**, Dr Jacobsen reviews all the R&D documents from 2022 discovered by the Respondents and explains why he considers that they are an incomplete set of records. At [123]-[125] Dr Jacobsen observes that the EZ Respondents have not discovered formal experimental records in 2022. At [128]-[129], Dr Jacobsen explains why the Pre-Provisional discovered documents are insufficient to draft the 2022 Provisional.
13. In **Part F [130]-[154] (PCT and 2023 Provisional)**, Dr Jacobsen conducts a review similar to Part D but in relation the Respondents' PCT patent (**PCT**) and 2023 provisional patent (**2023 Provisional**). He explains why he considers that complete records of the experiments in Examples 1–3, 6, 8–10 of the PCT and Examples 2–3 of the 2023 Provisional are not in the documents discovered by the Respondents dated up to the respective filing dates of those patents.
14. In **Part G [155]-[267] (Specific documents)**, Dr Jacobsen explains why he expects there to be experimental records for the experiments referred to in specific discovery documents in sections G.2 to G.22.
15. At [157]-[159], Dr Jacobsen explains why documents recording the *testing of ores using the EZ process* are documents recording the *research and development* of the EZ process (Category 11(f)). The purpose of this evidence is to directly address a matter put in issue by the EZ Respondents by way of G+T's 24 July 2025 letter (p 3).
16. At [166]-[170], Dr Jacobsen reviews various documents in which Element Zero represents to third parties that the EZ process had been tested on iron ore containing 30% iron. Dr Jacobsen therefore considers that there would have been records of experiments on iron ore containing 30% iron; Element Zero would have kept those records; and those records form part of the R&D of the EZ process: [168]-[170]. (No such experimental records were discovered.⁸)
17. The Court ought to reject the threshold objection that such evidence is not relevant to the issue it has to determine, that is, whether there are reasonable grounds for being fairly certain that there are other relevant documents.

Section 79 objection

18. Dr Jacobsen is an experienced industrial chemist, with a PhD in electrochemistry and 24 years of postdoctoral R&D experience in academy and industry between 1982 and 2006: [9](b)-(c), [11], [13]-[22]. His experience in electrochemistry, is comparable to Dr Winther-Jensen⁹ and the EZ Respondents' expert Prof Andrew Abbott,¹⁰ who gave evidence in answer to Fortescue's original discovery application.

⁸ Dewar 10 [197].

⁹ Huber 1, AH-10.

¹⁰ Dunn 4, RMD-2, pp 7-9.

19. Since 2007, Dr Jacobsen has also had 18 years of experience as a patent attorney in chemistry related fields, including on the electrodeposition of metals and metal leaching from ores, advising a range of companies from start-ups to multi-nationals: [9](f), [23]-[25].
20. In support of his opinion as to what further R&D records are likely to exist, Dr Jacobsen identifies the basis for his opinion by reference to his experience in chemical R&D projects, including their typical stages ([27]-[32]), their record-keeping practices including the types of documents kept, the nature of laboratory notebooks, and usual data retention ([33]-[42]). He also opines on the basis of his experience as to which records are kept for drafting patent applications ([43]-[46]).
21. The Respondents cannot seriously argue that Dr Jacobsen is not qualified to explain *what is disclosed* in the discovered R&D documents and whether *what is disclosed* supports the existence of other documents. Likewise, they cannot seriously argue that Dr Jacobsen is not a “person skilled in the art” for the purpose of reading the 2022 Provisional, the PCT and the 2023 Provisional.

E. Objection under ss 135/136 and case management principles

22. The probative value of Dr Jacobsen’s evidence outweighs any prejudice to the Respondents or time taken up by the affidavit.
23. The Respondents make a bare assertion of prejudice. Dr Jacobsen’s affidavit was served **35 calendar days** before the hearing of the IA, well beyond the usual time required under the Rules for evidence in support of an interlocutory application (3 days, FCR 17.01(2)) or even summary judgment (14 days, FCR 26.01(3)). No real prejudice arises from the fact it was filed 6 calendar days after the due date agreed between the parties. In any event, the Respondents refused Fortescue’s offer for an extension of time.
24. If there were any good reason for Dr Winther-Jensen or Prof Abbott to contradict Dr Jacobsen’s evidence as to what is disclosed by the Respondents’ discovered documents and patents, they have had ample time to do so.
25. As to the length of Dr Jacobsen’s affidavit, except for GPN-EXPT, his CV, the patents and a table of document dates (GJ-14), all other annexures to his affidavit are the Respondents’ own discovery documents to which he refers to explain his opinions.
26. The just resolution of the dispute over prayer 1 of the IA favours admission of Dr Jacobsen’s affidavit. His affidavit helps the Court understand *what is disclosed* in the documents discovered and whether *what is disclosed* admits the existence of other documents. Requiring the Court to undertake this analysis without the assistance of Dr Jacobsen’s expert electrochemical evidence, by reference only to the bare documents and patents, would be an inefficient use of the Court’s resources and contrary to the just determination of the proceeding according to law under s 37M of the *Federal Court of Australia Act 1976*.