STATEMENT OF CONSIDERATIONS

REQUEST BY GENERAL MOTORS CORPORATION FOR AN ADVANCE WAIVER OF DOMESTIC AND FOREIGN INVENTION RIGHTS UNDER DOE COOPERATIVE AGREEMENT NO. DE-FC26-04NT42278; W(A)-04-070, CH-1248

The Petitioner, General Motors Corporation (GM) was awarded this cooperative agreement for the performance of work entitled, "Develop Thermoelectric Technology for Automotive Waste Heat Recovery". The project will address a wide range of crucial economic, engineering and scientific questions to bring this nascent technology from laboratory to market place. This will be a team effort focusing on utilizing the latest materials research breakthrough: incorporating these innovations into thermoelectric modules and subsystems, and integrating them into vehicles. The goal of the program is to achieve and demonstrate a 10% improvement over current brake efficiency without increased emissions and in a cost-effective way. The project team includes General Electric Company (GE), Research Triangle Institute, University of Michigan, University of South Florida, Oakridge National Laboratory, and MIT-Lincoln Laboratory. With the exception of (GE), all subcontractors qualify as universities or small business and are entitled to elect title to their subject inventions pursuant to Bayh-Dole (P.L. 96-517). With respect to the subcontractor GE, GE states that it intends to file its own separate patent waiver petition. Thus, this waiver is only for inventions of GM made under this cooperation agreement.

The total estimated cost of the agreement is $12.78 million with the DOE share being $7.03 million or 55%. GM's cost share is $4.17 million (33%) while the remaining cost share of 12%, or $1.58 million, will be provided by GE. The period of performance is sixty months from January 1, 2005.

In its response to question 5 of the attached waiver petition, GM has described its technical competence in the field of automotive technologies. The largest automotive company in the world, it designs, manufactures, assembles and sells cars and trucks, including automotive powertrain systems and components. It has a long history of industry leadership in the development of environmentally friendly automotive innovations. It states that its catalytic converter is recognized as the most effective piece of emission-control hardware ever developed to reduce hydrocarbons and carbon monoxide. GM scientists and engineers have been awarded over 960 patents related to automotive engine technology since 1991. A listing of these patents is included as Attachment A to the waiver petition. GM's response demonstrates its technical competency in the field of automotive technologies.

In its response to questions 9 and 10 of the attached waiver petition, GM states that it has a long history of making available to other automotive manufacturers the environmentally friendly products that GM has developed, such as the catalytic converter. In addition, GM states that the subject of this project must also compete against numerous other technologies being considered for use in automotive propulsion in pursuit of greater energy efficiency. These technologies include more highly efficient and clean burning diesel engines, hybrid propulsion, displacement on demand gasoline engines, fuel cells, and hydrogen combustion. Competitive pressures in a robust automotive market with numerous automotive manufacturers amid a wealth of competing technologies will necessarily mitigate any significant anti-competitive effect that might possibly be created if this waiver petition is granted. Therefore grant of the waiver will have a positive effect on competition and market concentration.

The subject contract will be modified to add the Patent Rights--Waiver clause in conformance with 10 CFR 784.12, wherein GM has agreed to the provisions of 35 U.S.C §§ 202, 203, and 204. This waiver clause will also include a paragraph entitled U.S. Competitiveness, in which GM agrees to substantial U.S. manufacture of subject inventions (attached hereto). Additionally, GM agrees not to transfer subject inventions to any other entity unless that other entity agrees to these same requirements.

Considering the foregoing, it is believed that granting the waiver will provide the Petitioner with the necessary incentive to invest resources in the commercialization of the results of the agreement in a fashion which will make the agreement's benefits available to the public in the shortest practicable time. In addition, it would appear that grant of the above requested waiver would not result in an adverse effect on competition nor result in excessive market concentration. Therefore, in view of the objectives and considerations set forth in 10 CFR 784, all of which have been considered, it is recommended that the requested waiver, as set forth above, be granted.

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Mark P. Dvorscak
Assistant Chief Counsel
Office of Intellectual Property Law

Date_____

Based on the foregoing Statement of Considerations and the representations in the attached waiver petition, it is determined that the United States and the general public will best be served by a waiver of rights of the scope described above, and therefore the waiver is granted. This waiver shall not apply to any modification or extension of this agreement, where through such modification or extension, the purpose, scope, or cost of the agreement is substantially altered.

CONCURRENCE:

[redacted]

John Fairbanks
Office of the FreedomCAR
And Vehicle Technology Program
Secretary for Energy Efficiency
And Renewable Energy, EE-2G

Date: 01/09/06

APPROVAL:

[redacted]

Paul A. Gottlieb
Assistant General Counsel
for Technology Transfer and
Intellectual Property, GC-62

Date: 1-10-06

(t) U. S. COMPETITIVENESS The Contractor agrees that any products embodying any waived invention or produced through the use of any waived invention will be manufactured substantially in the United States unless the Contractor can show to the satisfaction of the DOE that it is not commercially feasible to do so. In the event the DOE agrees to foreign manufacture, there will be a requirement that the Government's support of the technology be recognized in some appropriate manner, e.g., recoupment of the Government's investment, etc. The Contractor agrees that it will not license, assign or otherwise transfer any waived invention to any entity unless that entity agrees to these same requirements. Should the Contractor or other such entity receiving rights in the invention undergo a change in ownership amounting to a controlling interest, then the waiver, assignment, license, or other transfer of rights in the waived invention is suspended until approved in writing by the DOE.

WAIVER ACTION - ABSTRACT

W(A)-04-070 (CH-1248)

REQUESTOR	CONTRACT SCOPE OF WORK	RATIONALE FOR DECISION	DISPOSITION
General Motors Corporation under DOE Contract No. DE-FC26-04NT42278	Develop Thermoelectric Technology for Automotive Waste Heat Recovery	33% cost sharing	