

STATEMENT OF CONSIDERATIONS

Request by GE Global Research for an Advance Waiver of Domestic and Foreign Invention Rights under DOE Contract No. DE-OE0000593, W(A) 2012-033, CH-1676

The Petitioner, GE Global Research (GE) was awarded the subject cooperative agreement with DOE for the performance of work entitled, "Smart Grid Enable Electric Vehicle Charging Station (EVSE)". The scope of work under this contract includes development of a low cost electric vehicle charging station (EVSE) with enhanced Smart Grid features. The target market for the EV charging system will be for commercial sites where multiple units are to be installed, such as parking lots or retail stores or fleet carriers. GE is subcontracting with Consolidated Edison, and Federal Express is offering its labor and facilities for use in the final demonstration. This waiver will apply to GE and its subcontractor inventions, except inventions made by subcontractors eligible to retain title pursuant to P.L. 96-517, as amended, or National Laboratories.

The work under this agreement is expected to take place from April 16, 2012 through October 15, 2014. The total amount of the contract is \$2,221,831, with GE and its subcontractor Consolidated Edison cost-sharing 40% or \$879,248. DOE is thus providing the remaining 60% or \$1,342,583.

In its response to question 5 of the attached waiver petition GE has provided relevant background for it and its subcontractors. GE states it has been a pioneer in electrification technologies applied to the transportation sector for more than two decades. It has several million dollars of research applied to electric vehicle charging, and has projects underway studying distribution grid impact through sophisticated power systems, advanced model based controls for load management of electric vehicles, forward-thinking customer services offered through a sophisticated server network, and advanced vehicle hybrid technologies. GE further states that it has teamed with utilities worldwide to execute successful turnkey programs and deliver innovative solutions, including AEP, FP&L, Austin Energy, Sempra Energy, and Maui Electric. GE has also listed several relevant U.S. and European patents. With respect to GE's subcontractors, ConEd operates one of the largest and most complex electric power systems in the world; and FedEx is heavily engaged in reducing its carbon footprint and looking to expand its all-electric vehicular fleet. GE has demonstrated its technical competency in the field of electric vehicle and electric vehicle support components.

In its response to question 10 of the attached waiver petition, GE states that EV charging is a very new market. There are many vendors and technologies that address the EV charging market. As new technologies enter the market the impact is to increase the overall penetration of electric vehicles, which will have a far-reaching and positive effect on the U.S. economy.

The subject contract will be modified to add the Patent Rights--Waiver clause in conformance with 10 CFR 784.12, wherein GE 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 GE agrees to substantial U.S. manufacture of subject inventions (attached hereto). Additionally, GE agrees not to transfer subject inventions to any other entity unless that other entity agrees to these same requirements.

In view of the cost sharing and other equities between GE and its subcontractors, it is anticipated that the parties will develop an appropriate allocation of patent rights among the participants to facilitate the expeditious development of the technology forming the subject matter

of the agreement. Accordingly, DOE will waive title to all subject inventions made by GE's employees and its subcontractors' employees, regardless of tier, except inventions made by subcontractors eligible to retain title pursuant to P.L. 96-517, as amended, or National Laboratories, to GE or its subcontractors, as mutually agreed by the parties. Except as otherwise approved in writing by DOE Patent Counsel, a party's acceptance of a subcontract under this agreement, at any tier, shall constitute GE's certification that it has provided that party with a copy of this Statement of Considerations and that party's notice to DOE that it accepts the terms and conditions of this advance waiver. Furthermore, a subcontractor has the right to request a waiver from DOE in its own right, rather than having to pass through the contractor to acquire title to subject inventions. Additionally, subcontractors who receive title under this waiver shall notify DOE Patent Counsel in writing of such disposition of patent rights.

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.

[REDACTED]

Mark P. Dvorscak
Deputy Chief Counsel
Office of Intellectual Property Law
Date: February 20, 2013
Amended: April 2, 2013

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, 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]

Dan Ton, OE-10
Office of Electricity Delivery
and Energy Reliability

APPROVAL:

[REDACTED]

John T. Lucas, GC-62
Assistant General Counsel
for Technology Transfer
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(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., recoument 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.