

STATEMENT OF CONSIDERATIONS

ADVANCE WAIVER OF PATENT RIGHTS TO OSRAM SYLVANIA (OSRAM)
UNDER DOE PRIME CONTRACT NO. DE-FC26-06NT42935 FOR "WHITE LED
WITH HIGH PACKAGE EXTRACTION EFFICIENCY"; CH-1406; W(A)-06-016

Osram Sylvania (Osram), has petitioned for an advanced waiver of domestic and foreign patent rights to inventions conceived or first actually reduced to practice under DOE Contract No. DE-FC26-06NT42935. This advanced waiver is intended to apply to all subject inventions of Osram's employees and those of its subcontractors, regardless of tier, except subcontractors eligible to obtain title pursuant to P. L. 96-517 as amended, and National Laboratories.

As brought out in its waiver petition, Osram will design a multilayer thin film with selective reflecting properties. These thin films will be deposited on substrates using a physical vapor deposition reactor.

In response to question 3, the total dollar amount of the contract is \$603,705 with Osram's portion \$120,741 for a cost share of 20%.

Osram has produced lighting, optical quality, translucent and transparent ceramics for several decades.

In response to question 9, this waiver will enable Osram to combine core technologies to develop new methods, technologies, and products.

This advance waiver of the Government's rights in inventions is subject to the usual advance patent waiver conditions. Those terms include the usual Government license, march-in rights, and preference for U.S. industry provisions set out in 35 U.S.C. 202-204. The advance patent waiver also includes a U.S. Competitiveness clause, (paragraph t), which requires that products embodying any waived invention or produced through the use of any waived invention be manufactured substantially in the United States unless the participant can show to the satisfaction of DOE that it is not commercially feasible to do so. The Contractor further agrees to make the above condition binding on any assignee or licensee or any entity otherwise acquiring rights to any

waived invention, including subsequent assignees or licensees. Should the Contractor or other such entity receiving rights in any waived inventions 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 DOE.

The grant of this waiver is not expected to have any adverse effects on competition or market concentration. In response to Question 10, the market is highly competitive. Several other LED-based companies are actively pursuing their own innovative methods for increasing LED efficiency for favorable position in the emerging LED replacement and new installation markets. Granting of this waiver will provide Osram with the incentive to promote the development and commercialization of inventions made under this contract.

Considering the foregoing, and in view of the statutory objectives to be attained and the factors to be considered, it has been determined that this advance waiver of patent rights will best serve the interest of the United States and the general public. Subject to Osram providing at least 20% cost sharing, in aggregate over the term of this, and subsequent phases of the agreement, it is recommended that the waiver be granted.

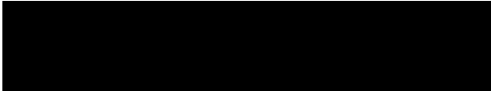


Joy Alwan
Acting Assistant Chief Counsel
Intellectual Property Law Division

Date: 24 Aug 07

Based on the foregoing Statement of Considerations, it is determined that the interest of the United States and the general public will be best served by a waiver of the United States and foreign rights as set forth therein, and therefore the waiver is granted. This waiver shall not affect any waiver previously granted.

CONCURRENCE:



Jerome Dion
Acting Program Manager
Office of Building Technology
EE-2J/FORS

Date: 9/24/07

APPROVAL:



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

Date: 9/26/07

WAIVER ACTION - ABSTRACT

REQUESTOR: Oscram Sylvania
Under DOE Contract NO. DE-FC26-06NT42935

CONTRACT SCOPE OF WORK: Design a multilayer thin film with selective reflecting properties by thin film modeling work.

RATIONAL FOR DECISION: Granting of the waiver will provide the incentive to commercialize the invention in a fashion which will benefit the public in the shortest practical time.

DISPOSITION: