

STATEMENT OF CONSIDERATIONS

REQUEST BY DOW CORNING CORPORATION FOR AN ADVANCE WAIVER OF DOMESTIC AND FOREIGN INVENTION RIGHTS UNDER DOE COOPERATIVE AGREEMENT NO. DE-FC26-05NT42344; W(A)-05-002, CH-1266

The Petitioner, Dow Corning Corporation (Dow), was awarded this cooperative agreement for the performance of work entitled, "Thin Film Packaging Solutions for High Efficiency OLED Lighting Products." The waiver will apply to inventions made by Dow employees and its subcontractors' employees, regardless of tier, except inventions made by subcontractors eligible to retain title to inventions pursuant to P.L. 96-517, as amended, and National Laboratories.

The purpose of the cooperative agreement is to develop novel substrate and packaging technology for solid state lighting devices that use Organic Light Emitting Diodes (OLEDs) as the emission source.

The total estimated cost of the cooperative agreement is \$5,015,746 with the DOE share being \$2,414,450 or 48.1%, while the remaining cost share of 51.9%, or \$2,601,296, will be provided by Dow. The period of performance is from December 1, 2004 through November 30, 2007.

In its response to question 5 of the attached waiver petition, Dow has described its technical competence in the field of OLED Lighting Products. It has developed core technology that represents background capability for this cooperative agreement in four relevant areas. Dow has also provided representative examples of technical papers it has published in this technical area as Appendix A.

In its response to question 10 of the attached waiver petition, Dow states that the areas of OLED device packaging and low cost substrates are attracting much interest by various domestic and global firms, all of whom are developing alternative technologies to what Dow is proposing. It is unlikely that grant of the waiver would concentrate the activity or reduce the competitiveness of the marketplace, but would rather serve to allow Dow to compete with the firms with a specific technology solution. Thus grant of the waiver will not place Dow in a preferred or dominate position in this field, and is likely to have a positive effect on competition and market concentration.

The subject cooperative agreement will be modified to add the Patent Rights--Waiver clause in conformance with 10 CFR 784.12, wherein Dow 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 Dow agrees to substantial U.S. manufacture of subject inventions (attached hereto). Additionally, Dow 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.

[REDACTED]

Mark P. Dvorscak
Assistant Chief Counsel
Intellectual Property Law Division

Date: May 4, 2005

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]

Michael McCabe
Office of the Building
Technologies Program
Energy Efficiency and Renewable
Energy, EE-2J

Date: June 10, 2005

APPROVAL:

[REDACTED]

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

Date: 6-13-05

(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)-05-002 (CH-1266)

REQUESTOR

Dow Corning
Corporation
Under DOE Cooperative
Agreement No. DE-FC26-05NT42344

CONTRACT SCOPE OF WORK

Thin Film Packaging Solutions For
High Efficiency OLED Lighting Products

RATIONALE FOR DECISION

51.9% cost sharing

DISPOSITION