

STATEMENT OF CONSIDERATIONS

REQUEST BY ALSTOM ENVIRONMENTAL CONTROL SYSTEMS FOR AN ADVANCE WAIVER OF PATENT RIGHTS TO INVENTIONS MADE UNDER SUBCONTRACT QZ001 UNDER COOPERATIVE AGREEMENT DE-FC26-03NT41986; W(A) 05-004 ; CH-1268

As set out in the attached waiver petition and in subsequent discussions with DOE Patent Counsel, Alstom Environmental Control Systems (Alstom) has requested an advance waiver of domestic and foreign patent rights for all subject inventions made under the above subject subcontract. The waiver will apply only to inventions made by Alstom employees under the subcontract.

Alstom is a subcontractor to ADA Environmental Solutions (ADA-ES) under the subject cooperative agreement. ADA-ES is eligible to retain title to its inventions pursuant to P.L. 96-517.

Referring to item 2 of Alstom's petition, the purpose of the subcontract is to evaluate full-scale performance of sorbent injection on different applications of utility coal-fired boilers to control mercury emissions.

The work under this agreement is expected to take place from December 2003 to March 2007. The value of the subcontract is \$480,000 of which Alstom is cost-sharing \$200,000 or, 41.5% of the total cost of the project, as stated in the attached e-mail from Alstom dated August 23, 2005.

Referring to items 5-9 in Alstom's waiver petition, Alstom has been involved in the design and supply of combustion boilers and air pollution control systems serving the utility industry for over 50 years. Included in Alstom's waiver petition is a technical paper describing its technical competence in the field of combustion boilers and air pollution control systems. Alstom also states that it has hundreds of patents in the field of air pollution control. This, coupled with Alstom's cost sharing, clearly demonstrates the likelihood that Alstom will continue development and commercialization of the results of this subcontract.

Referring to item 10 of the waiver petition, granting this waiver is not anticipated to have any adverse impact on competition as there are a variety of competing technologies in the market to control mercury emissions.

This advance waiver of the Government's rights in inventions is subject to the usual advance patent waiver licensing provisions, and the 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 the attached U.S. Competitiveness clause (paragraph t) which requires 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, licensee or other entity acquiring rights to any waived invention, including subsequent assignees or licensees. Should the Contractor or other such entity receiving rights in any waived 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 DOE.

Considering the foregoing, it is believed that granting this waiver will provide Petitioner with the necessary incentive to invest its resources in the commercialization of the results of the agreement in a fashion which will make the technology available to the public in the shortest practicable time. Therefore, upon evaluation of the waiver petition and in view of the objectives

and considerations set forth in 10 CFR Part 784, all of which have been considered, it is recommended that the requested waiver be granted.

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Mark P. Dvorscak
Assistant Chief Counsel
Intellectual Property Law Division

Date: Dec 27, 2005

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

CONCURRENCE:

[Redacted signature area]

George Rudins
Deputy Assistant Secretary
Office of Fossil Energy
Coal and Power Systems

Date: _____

APPROVAL:

[Redacted signature area]

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

Date: 2-9-06

(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)-05-004 (CH-1268)

REQUESTOR

Alstom Environmental
Control Systems
under Subcontract QZ001
under DOE Cooperative
Agreement No.
DE-FC26-03NT41986

CONTRACT SCOPE OF WORK

Evaluation of Sorbent Injection for
Mercury Control

RATIONALE FOR DECISION

41.5% cost sharing

DISPOSITION