

STATEMENT OF CONSIDERATIONS

REQUEST BY SPX COOLING TECHNOLOGIES, INC. FOR AN ADVANCE WAIVER OF DOMESTIC AND FOREIGN INVENTION RIGHTS UNDER DOE COOPERATIVE AGREEMENT NO. DE-FC26-05NT42725; W(A)-06-001, CH-1349

The Petitioner, SPX Cooling Technologies, Inc. (SPX), was awarded a cooperative agreement for the performance of work entitled, "Advanced Technologies and Concepts to Minimize Freshwater Use in Coal-Based Thermoelectric Power Plants." The purpose of the cooperative agreement is the use of petitioner's Air2Air™ cooling technology in an existing evaporative cooling tower operating at a selected coal-fired power plant. Upon installation, water from the normal evaporate of the cooling tower will be recovered to be studied and quantified. Based upon the analysis of the recovered water, performance and operating parameters using Air2Air™ condensing technology in a cooling tower application will be determined. This waiver is only for inventions of SPX made under its cooperative agreement.

The total estimated cost of the cooperative agreement is \$812,633 with the DOE share being \$650,106 or 80%. The remaining cost-share of \$162,527 or 20% will be provided by SPX. The period of performance will be twenty months.

In its response to question 5 of the attached waiver petition, SPX has described its technical competence in the field of cooling technology. SPX designs and manufactures cooling products for global power generation, industrial, refrigeration and HVAC markets. It has offered various water conservation features in its cooling products for the past 30 years. SPX has an extensive intellectual property portfolio which includes over 140 United States patents and numerous technical papers on cooling technology subjects. The patents relating to the Air2Air™ technology, U.S. No. 6,663,087 and 6,663,694, as well as U.S. Application No. 10/689,691, are attached to the waiver petition as Appendix B. SPX's response demonstrates its technical competency in the field of cooling technology.

In its response to question 10 of the attached waiver petition, SPX states the waiver will have little effect on competition and market concentration. Many competitive technologies exist in the current marketplace including coil hybrid evaporative cooling products, two state dry-wet series systems, and parallel cooling systems. 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 SPX 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 SPX agrees to substantial U.S. manufacture of subject inventions (attached hereto). Additionally, SPX 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.


Mark P. Dvorscak
Assistant Chief Counsel
Intellectual Property Law Division

Date March 22, 2006

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:



Victor Der
Office of Clean Energy Systems
Office of Fossil Energy, FE-22

Date 5/26/06

APPROVAL:



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

Date 6-1-06

(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.