

STATEMENT OF CONSIDERATIONS

ADVANCE WAIVER OF PATENT RIGHTS TO GENERAL ELECTRIC COMPANY (GE) UNDER DOE PRIME CONTRACT NO. DE-AC36-04GO116034 FOR "DESIGN AND DEVELOPMENT OF HIGH PERFORMANCE POLYMER FUEL CELL MEMBRANES"; CH-1372; W(A)-06-018

General Electric (GE), through its GE Global Research Center, 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-FC36-04GO16034. This advanced waiver is intended to apply to all subject inventions of GE'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, GE will design and develop new polymer-based membranes for use in high temperature, low humidity hydrogen fuel cells.

As indicated in its response to Question 3 in its waiver petition, the total value of this agreement is expected to be about \$2,029,454.00. with GE's cost share of \$507,363.50 approximately 25% of the total cost. The performance period for this agreement is expected to be from April 6, 2006 to March 31, 2011.

In response to Question 7 of the waiver petition, GE will provide the laboratory facilities and equipment resources for the work.

As brought out in Question 5, GE is a world leader in the development and commercialization of high performance engineering polymers.

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, granting of this waiver will provide GE 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 GE providing at least 25% 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: 28 AUGUST, 2006

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:

[Redacted signature]

JdAnn Milliken
Program Manager (Acting)
Hydrogen, Fuel Cells &
Infrastructure Technology *ies*
EE-2H/FORS

Date: 9/29/06

APPROVAL:

[Redacted signature]

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

Date: 10/4/06

(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)-06-018 (CH-1372)

REQUESTOR
GENERAL ELECTRIC
COMPANY

CONTRACT SCOPE OF WORK
DESIGN AND DEVELOPMENT
OF HIGH PERFORMANCE
POLYMER FUEL CELL
MEMBRANES

RATIONALE FOR DECISION
25% COST SHARING

DISPOSITION