

STATEMENT OF CONSIDERATIONS

REQUEST BY GENERAL ELECTRIC GLOBAL RESEARCH CENTER FOR AN ADVANCE WAIVER OF PATENT RIGHTS TO INVENTIONS MADE UNDER ITS SUBCONTRACT WITH DELPHI AUTOMOTIVE SYSTEMS UNDER COOPERATIVE AGREEMENT DE-FC26-07NT43121; W(A)-09-012 ; CH-1475

General Electric Global Research Center (GE-GRC), requests an advance waiver of domestic and foreign patent rights for all subject inventions made under the above subcontract. Under the cooperative agreement, Delphi is leading a teaming arrangement that includes General Electric. Delphi has applied for an advance waiver for its own inventions (W(A)-07-030). The purpose of the cooperative agreement is to develop, test and demonstrate a cost-effective, compact, lightweight, and scalable high temperature propulsion inverter for Hybrid Electric Vehicles (HEV), Plug-in Hybrid Electric Vehicles (PHEV), and Fuel Cell Vehicles (FCV). For this subcontract, GE-GRC will develop advanced capacitor technology. A new design of high temperature high energy density capacitors will be prototyped and evaluated for use in the inverters developed by Delphi. This waiver is for inventions of GE-GRC only.

The work under this subcontract is expected to take place between October 1, 2007 and September 30, 2010, at a total cost of \$1,200,000. GE-GRC will provide 40% cost share or \$490,000. DOE will provide the remaining 60% or \$710,000.

With respect to its technical competency in the field of capacitor technology, in response to question 4 of its waiver petition, GE-GRC states that it has over 50 years of experience. GE-GRC states that it has filed patent applications in the area of high temperature dielectric films and for the use of these films in high temperature high energy density capacitors. Several examples of GE patents in this area are listed in response to this question 4. GE-GRC further states that it reinvests a large portion of its corporate profits into Research And Development. GE-GRC has demonstrated its technical competency in the field of capacitor technology.

GE-GRC states that the hybrid vehicle and power generation markets are highly competitive, with multiple players. All manufacturers are constantly striving to improve their products to better serve these customer needs, and there are expected to be competing approaches. Therefore grant of the waiver will have a positive effect on competition and market concentration.

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.



Mark P. Dvorscak
Deputy Chief Counsel
Intellectual Property Law Division

Date: Feb 20, 2019

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 cooperative agreement, where through such modification or extension, the purpose, scope or cost of the cooperative agreement has been substantially altered.

CONCURRENCE:



Patrick Davis
Office of the FreedomCAR and Vehicle
Technologies Program, Office of Energy
Efficiency and Renewable Energy, EE-2G

Date 5/17/10

Date: _____

APPROVAL:



~~Paul A. Gottlieb~~ John T. Lucas, Acting
Assistant General Counsel for Technology
Transfer and Intellectual Property, GC-62

Date 5/21/2010

Date: _____

(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.