

STATEMENT OF CONSIDERATIONS

Request by Lumination, LLC for an Advance Waiver of Domestic and Foreign Invention Rights under DOE Cooperative Agreement No. DE-EE0003232, W(A) 2010-034, CH-1571

The Petitioner, Lumination, LLC. was awarded the subject cooperative agreement with DOE for the performance of work entitled, "Development of Advanced Manufacturing Methods for Warm-White LEDs for General Lighting." The objective of the work is the development of precise and efficient manufacturing techniques for its "remote phosphor" platform of warm-white LED products. In volume, this project will drive significant materials, labor and capital productivity to achieve significant reduction in overall cost compared to current baseline. In addition, the typical total color variation from these white LEDs in production will be well within the ANSI bins and as low as a 4-step MacAdam ellipse centered on the black body curve. Achievement of both of these objectives will be demonstrated while meeting a performance target of >75lm/W for a warm-white LED and a reliability target of <30% lumen drop /<2-step MacAdam ellipse shift, estimated over 50,000 hours. The waiver will apply only to inventions made by Lumination employees.

The work under this agreement is expected to take place from April 1, 2010 through December 31 2011. The total amount of the contract is \$1,097,648, with Lumination and DOE each cost-sharing \$548,824 or 50%.

In its response to questions 5 and 6 of the attached waiver petition Lumination has described its technical competence in the field of LED lighting. Lumination states that it is a pioneer and worldwide leader in designing novel lighting technologies and, in particular, has significant technical competence in the field of LED technology. It states that it has been working in the field of LED technologies for over 12 years, and has over 133 issued U.S. patents, a representative sampling which are listed in appendix A of the petition. Lumination states that it has a commercial product named Vio® that is being covered by the scope of this contract. New manufacturing methods developed in this contract will enable cost reduction of this product. Lumination's response demonstrates its technical competency in the field of LED lighting.

In its response to question 10 of the attached waiver petition, Lumination states that as energy demands and prices continue to rise, there is an increasing global effort to develop new technologies to reduce overall energy consumption. This will create a highly competitive environment for lighting products that have significant improvements versus current technologies. Lumination states that it will be able to further establish a solid commercial position in solid-state lighting, and further advance the U.S. as a leader in the global lighting industry. 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 Lumination 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 Lumination agrees to substantial U.S. manufacture of subject inventions (attached hereto). Additionally, Lumination 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
Deputy Chief Counsel
Office of Intellectual Property Law

Date June 22, 2010

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, 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:


James Brodrick
Office of Energy Efficiency and
Renewable Energy
Office of Building Technology, EE-2J

Date September 14, 2010

APPROVAL:


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

Date 9/17/10

(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.