

## STATEMENT OF CONSIDERATIONS

### REQUEST BY GENERAL MOTORS LLC (GM) FOR AN ADVANCE WAIVER OF DOMESTIC AND FOREIGN PATENT RIGHTS UNDER DOE COOPERATIVE AGREEMENT NO. DE-EE0005969; W(A) 2013-008

GM has requested a waiver of domestic and foreign patent rights for all subject inventions arising from its participation under the above-referenced cooperative agreement entitled "GM Light-Duty Fuel Cell Electric Vehicle Validation Data." The cooperative agreement was made under the Light-Duty Fuel Cell Electric Vehicle Validation Data Announcement (DE-FOA-0000625).

The objective of the project funded through the cooperative agreement is to generate fuel cell system and vehicle data that demonstrates the current state of the art of fuel cell durability in light-duty vehicles. The project has two phases. The first phase of the project will gather data from fuel cell electric vehicles driven on the roads by fleet customers or GM employees and will utilize publicly accessible hydrogen fueling stations. The second phase of the project will gather data from accelerated durability testing of fuel cell systems tested in prototype vehicles on various proving grounds and accelerated durability testing conducted on fuel cell systems operated in test labs.

The total anticipated cost of the cooperative agreement is \$3,998,603. GM is providing \$1,999,302 of cost share funds for a cost share percentage of 50%. This waiver is contingent upon GM maintaining, in aggregate, a cost share percentage of 50% or more over the course of the cooperative agreement.

As set forth in its petition, GM is one of the largest automotive companies in the world. It is a leader in fuel cell technology. It has successfully demonstrated over 100 fuel cell electric vehicles in its Project Driveway demonstration and has accumulated over 2.5 million miles to date on its Chevrolet Fuel Cell Electric Vehicles. GM is currently developing the next generation of fuel cell electric vehicles for the U.S. market. GM has invested approximately \$1.5 billion on fuel cell research and development, has extensive hydrogen fuel cell research and development facilities worldwide and has over 700 patents and patent applications related to fuel cell technologies.

The waiver shall be subject to the march-in and preference for U.S. industry provisions, as well as the U.S. Government license, comparable to those set out in 35 U.S.C. 202-204. Furthermore, the waiver shall be subject to the U.S. competitiveness provisions attached to this Statement. In brief, GM and its licensees and assignees will substantially manufacture in the United States products that embody any waived invention or are made through the use of any waived invention.

Referring to item 10 of the waiver petition, GM does not believe that the granting of this patent waiver will have any significant anti-competitive effects. The technology that is subject to this project must compete against numerous other technologies being considered for use in

automotive propulsion in attempts to improve energy efficiency. The numerous competing technologies should prevent any significant anti-competitive effect from this waiver.

Considering the foregoing, it is believed that granting this waiver will provide GM with the necessary incentive to invest its resources in commercializing the results of the cooperative agreement in a manner that will make the above technology available to the public in the shortest time. Therefore, upon evaluation of the waiver petition and 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 be approved.



Glen R. Drysdale  
DOE Patent Counsel

Date: 4/3/13

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 determined above, and therefore the waiver is approved. This waiver shall 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:



Sunita Satyapal  
Director  
Fuel Cell Technologies Office

Date: 5/3/13

APPROVAL:



John D. Lucas  
Assistant General Counsel for Technology  
Transfer and Intellectual Property

Date: 5/6/2013

## **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 DOE that it is not commercially feasible to do so. In the event 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 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 invention undergo a change in ownership amounting to a controlling interest, then the waiver, assignment, license, or other transfer of rights in any waived invention is suspended until approved in writing by DOE.