

STATEMENT OF CONSIDERATIONS

REQUEST BY ELECTRICORE INC. (ELECTRICORE) FOR AN ADVANCE WAIVER OF DOMESTIC AND FOREIGN PATENT RIGHTS UNDER DOE COOPERATIVE AGREEMENT NO. DE-EE0005968; W(A) 2013-027

ELECTRICORE has requested a waiver of domestic and foreign patent rights for all subject inventions arising from the participation of its OEM partners under the above-referenced cooperative agreement entitled "Light Duty Fuel Cell Electric Vehicle Validation Data." The OEM partners are Honda R&D Americas ("Honda"), Toyota Motor Engineering & Manufacturing North America, Inc. ("Toyota") and Nissan Technical Center North America ("Nissan"). Under this patent waiver, these OEM partners will be able to elect to retain title to any subject inventions it makes under the cooperative agreement. This waiver does not apply to subject inventions made by ELECTRICORE or other subcontractors not identified as an OEM partner in this waiver.

The cooperative agreement was made under the Light-Duty Fuel Cell Electric Vehicle Validation Data Announcement (DE-FOA-0000625). The objective is to collect and submit vehicle data from the OEM partners' fuel cell electric vehicles (FCEVs) to NREL. This cooperative agreement is part of a large project by DOE to collect FCEV data from multiple sources and have NREL analyze the collected data to demonstrate the reliability and performance of FCEVs.

Considering that the project is mostly a data collection effort on the parts of the OEM partners, subject inventions made by the OEM partners are not anticipated. However, the OEM partners have made significant investments in FCEVs and want to ensure the maximum protection for their investments including obtaining a patent waiver.

The total anticipated cost of the cooperative agreement is \$474,048.00. Each OEM partner is providing at least 50% cost share. The application of this waiver to an OEM partner is contingent upon that OEM partner providing, in aggregate, a cost share percentage of 50% or more over the course of the cooperative agreement. The failure of one OEM partner to comply with this cost share requirement does not impact the application of this waiver on the other OEM partners who met the cost share requirement.


As set forth in its petition, each of the OEM partners has developed FCEVs which are commercially available or no more than one generation from commercial production. For example, Toyota introduced its first fuel cell vehicle in 2002, Honda introduced its first fuel cell vehicle in 2003 and Nissan has been testing its first fuel vehicle since 2006. Each of the OEM partners has the type of data and the ability to generate more data necessary to make the overall project a success. Moreover, each of the OEM partners has demonstrated the ability and desire to commercialize fuel cell technology.

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, each of the OEM partners 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, Electricore 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.

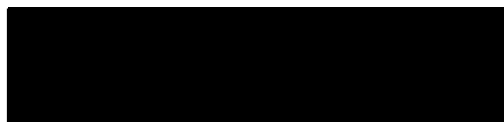
Considering the foregoing, it is believed that granting this waiver will provide the OEM partners with the necessary incentive to participate in the project and invest its resources in commercializing the results of the cooperative agreement in a manner that will make the above technology available to 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: 11/30/14

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.

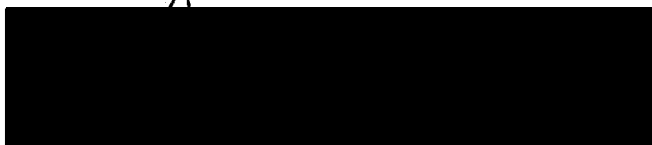
CONCURRENCE:



Sunita Satyapal
Director
Fuel Cell Technologies Office

Date: 3/26/14

APPROVAL:



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

Date: 3/31/14

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.