

STATEMENT OF CONSIDERATIONS

REQUEST FOR ADVANCE WAIVER OF PATENT RIGHTS BY UTRC,
UNDER DOE AWARD NO. DE-AC02-06CH11357 SUBAWARD NO. 3F-
31981; W(A)-2014-007, CH-1705

The Petitioner, United Technologies Research Center (UTRC) has requested a waiver of domestic and foreign patent rights for all subject inventions conceived or reduced to practice by UTRC employees arising under the above referenced subaward.

The objective of UTRC's award is to develop high-performance polymer electrolyte fuel cells (PEFC) cathodes with high-performance and low catalyst loadings. The project is led by DOE's Argonne National Laboratory (ANL).

The total anticipated cost of the subaward with UTRC, the subawardee, is \$1,064,651 including UTRC's contribution of \$319,395, or about twenty-nine percent (29%). This waiver is contingent upon the Petitioner maintaining, in aggregate, above twenty percent (20%) cost sharing percentage over the course of the subaward.

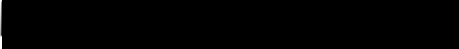
Referring to items 5-9 of the waiver petition, the Petitioner has extensive expertise with fuel cells, with specific expertise in PEFC fuel cells. United Technologies Corporation's (UTC) is a United States based, global corporation having UTRC as its central research and development center, supporting all of the UTC business units. UTRC employees have co-authored more than 50 publications on fuel cells and are listed inventors in numerous patent applications. For example, the Principal investigator alone has been listed on 40 patent applications on fuel-cell technology.

The Petitioner has agreed that this waiver will be subject to the march-in and preference for U.S. industry provisions, as well as the U.S. Government license, set out in 35 U.S.C. 202-204. Further, Petitioner has agreed to the attached U.S. Competitiveness provision (paragraph (t)). In brief, Petitioner has agreed that products embodying a waived invention or produced through the use of a waived invention will be manufactured substantially in the United States unless the Petitioner can show to the satisfaction of the DOE that it is not commercially feasible to do so. The Petitioner has further agreed to make the above conditions binding on any assignee or licensee or any entity otherwise acquiring rights in the waived inventions, including subsequent assignees and licensees. Should the Petitioner or other such entity receiving rights in a 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 inventions is suspended until approved in writing by DOE.

Referring to item 10 of the waiver petition, granting this waiver will not have an adverse impact on competition. Numerous companies are researching various fuel cell technologies, including PEFCs. Therefore, as this is one of many efforts to develop a breakthrough technology for cost-effective energy, the grant of this waiver will only help

encourage competition in the market. The ability to license any intellectual property developed during the performance of this subaward enables the Petitioners full participation in the work, including contribution to the potential inventions by its engineers and scientist. This will enhance the likely commercial success of this technology by enabling the team to develop and commercialize the best performing product possible.

Considering the foregoing, it is believed that granting this waiver will provide the 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 784, all of which have been considered, it is recommended that the requested waiver be granted.


Michael J. Dobbs
Patent Attorney
Intellectual Property Law Division

Date: 12/22/2014

Based upon the foregoing Statement of Considerations and representations in the attached waiver petition, it is determined that the interests of the U.S. 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 award, where through such modification or extension, the purpose, scope or cost of the award has been substantially altered.

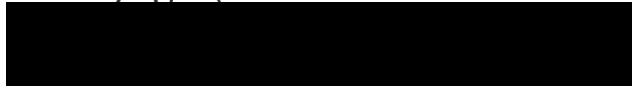
CONCURRENCE:



Sunita Satyapal
Director
Fuel Cells Technology Office
EE-3F

Date: 3/7/16

APPROVAL:



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

Date: 3/15/2016