

STATEMENT OF CONSIDERATIONS

REQUEST FOR ADVANCE WAIVER OF PATENT RIGHTS BY GENERAL ELECTRIC COMPANY, ACTING IN PERFORMANCE OF A SUBCONTRACT TO ENERGY INDUSTRIES OF OHIO, INC., UNDER DOE AWARD NO. DE-FE0025064; W(A)2016-012, CH-1769

Petitioner, General Electric Company (GE), has requested a waiver of: (a) domestic and foreign patent rights for all subject inventions conceived solely by Petitioner and (b) Petitioner's undivided interest, based on its employee's contributions, to joint domestic and foreign patent rights for all subject inventions conceived, arising under the above referenced award. Petitioner is performing work under a subcontract to Energy Industries of Ohio, Inc. (EIO). As the prime award DE-FE0025064 is through a Determination of Non-competitive Financial Assistance (sole-source) funding, there is no applicable class waiver.

The objective of the award is to perform front end engineering design studies on Advanced Ultra-supercritical (AUSC) components. In particular, the aim of the award is component design and testing of steam turbines, steam superheaters, superheated steam tube to pipe headers, thick-walled cycling header, steam piping, shutoff and flow control valves for the superheated 760°C steam, and other ancillary equipment such as the boiler feedwater heater needed for an AUSC Component Test facility. The scope of work in Phase I includes front end engineering design and environmental permitting work for the construction and operation phase.

The total anticipated cost of the award is \$74,995,687.00 including a cost share contribution of \$18,768,615.00, or about twenty-five percent (25%) of the total cost of the work under the award. With respect Petitioner's portion of the award, the total cost is \$5,023,504.00, including Petitioner's cost share of \$1,004,700.00, or about twenty percent (20%) of the total cost of the award. This waiver is contingent upon Petitioner maintaining, in aggregate, the above cost sharing percentage over the course of the award. The period of performance is from 1 November 2015 to 30 September 2016.

Referring to items 5-9 of the waiver petition, Petitioner has engaged in several decades of research and development of steam driven power production. Petitioner has previously performed as a subcontractor in two DOE cost share programs directly related to the present award, including providing more than \$1,000,000 in cost share. Petitioner has noted that granting of the petition will more effectively promote the continued development and utilization of any subject inventions. Accordingly, Petitioner has significant experience in developing technology within this field and will continue to further develop the contracted work.

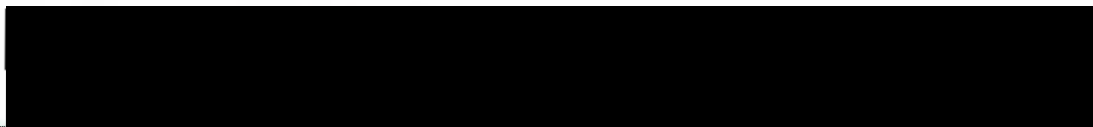
Petitioner has agreed that this waiver will be subject to the march-in and preference for U.S. industry provisions, as well as the U.S. Government license, set out in 35 U.S.C. 202-204. Further, Petitioner has agreed to the attached U.S. Competitiveness provision (paragraph (t)). The Petitioner further has agreed to the attached revised paragraph (h) to submit annual reports on the utilization of a subject invention or on efforts at obtaining such utilization that are being

made by Petitioner and any of its licensee or assignees. If sold or transferred this reporting obligation will pass on to the buyer or transferee.


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. 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 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 participated in the initial multiple competitive award, indicating competitive interest in the specific research and design aim of this award. Additionally, the steam driven power production field as a whole is the focus of significant research from competitors of Petitioner. Thus, granting the Petition will not hinder competition in the field.

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 784, all of which have been considered, it is recommended that the requested waiver be granted.


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Date: 6/30/16



Brian J. Lally
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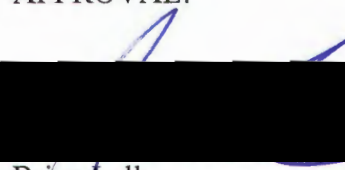
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Based upon the foregoing Statement of Considerations and representations in the attached waiver petition, it is determined that the interests of the U.S. and the general public will best be served by a waiver of patent rights of the scope described 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:

APPROVAL:


Regis Conrad
Director
Division of Advanced Energy Systems, FE-221
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Brian Lally
Acting Assistant General Counsel
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Date: 11/18/2016

Date: 11/29/16