

STATEMENT OF CONSIDERATIONS

REQUEST FOR ADVANCE WAIVER OF PATENT RIGHTS BY WEH GMBH, VERBINDUNGSTECHNIK/PRECISION CONNECTORS ("WEH") UNDER DOE AWARD NO. DE-EE0008817; W(A) 2020-005

WEH has requested a waiver of patent rights of the United States of America for all subject inventions arising from its participation under the above referenced award entitled "High Pressure, High Flow Rate Dispenser and Nozzle Assembly for Heavy Duty Vehicles" to Electricore, Inc. WEH is a sub-awardee to Electricore, Inc. This waiver applies only to subject inventions made by WEH.

According to the waiver petition, "[t]he objective of the program is to develop a high pressure, high flow (HF) dispenser and nozzle assembly (consisting of a nozzle, receptacle, hose, and breakaway) for heavy-duty (HD) hydrogen vehicles. This proposed project will incorporate a new high flow rate nozzle with a specialized dispenser for a complete, integrated, high throughput fueling solution. The dispensing system will also integrate controls, safety, and retail sales subsystems for interfacing with hydrogen station and the driver. The research project addressed the need for HD fueling components that do not currently exist for a rapidly emerging medium duty (MD) and HD hydrogen vehicle market."

The total anticipated cost of the award is \$3,749,225, including \$2,999,037 of federal funds and \$750,188 cost share. WEH's budget for the project is \$1,067,707 including WEH's providing \$267,606 or 25% cost share. The waiver is contingent upon WEH maintaining, in aggregate, a cost share percentage of least 20% over the course of the award.

The anticipated period of performance for the award is May 1, 2020 through April 30, 2022.

Based on the waiver petition, WEH is a world leader in the field gas dispensing. It has more than 30 years of research, development and manufacturing experience. It has supplied over 3,000 hydrogen nozzles in the field including a commercially available H70 LDV nozzle with hydrogen and pressure certifications (SAE J2600) for light-duty fueling and a H35 HF nozzle that is used on medium and HD vehicle stations for fueling buses and other large vehicles. WEH has a significant patent portfolio on dispensing systems including related to hydrogen refueling.

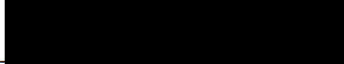
WEH is based in Germany and does not have any manufacturing capability in the U.S. Therefore it is not feasible for it to comply with the standard U.S. competitiveness provision. Instead of the U.S. competitiveness provision and after negotiating with the funding program, EERE Fuel Cell Technologies Office, WEH has agreed to the following in exchange for a patent waiver:

- a. By the end of the award project period, WEH will create and maintain at least five (5) U.S. jobs to provide technical and maintenance support for WEH hydrogen fueling nozzles in the U.S.

- b. All maintenance work for WEH hydrogen fueling nozzles deployed in the U.S. will be conducted in the U.S. in perpetuity.
- c. In the event that WEH, its affiliates or licensees are not manufacturing hydrogen fueling nozzles in the U.S. cost competitively, WEH agrees to give a single, non-transferable license for any waived subject invention from this project, under commercially reasonable terms, to any third party deemed qualified and capable to manufacture hydrogen fueling nozzles in the U.S.
- d. If any waived subject invention results in a patent that must be used to comply with an industry standard or code, such as a standard or code from Society of Automotive Engineers (SAWE) or the Canadian Standards Association, WEH will license the patent to others under fair, reasonable, and non-discriminatory (FRAND) terms.

Referring to item 10 of the waiver petition, WEH does not believe the waiver would place it in a dominant position due to competing technologies being developed by different companies.

Considering the foregoing, it is believed that awarding this waiver will provide WEH with the necessary incentive to invest its resources in commercializing the results of the award 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 granted.



Glen Drysdale
Patent Attorney
Golden Field Office

Date: 5/13/20


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 be best served by a waiver of patent rights of the scope determined above, and therefore the waiver is granted. This waiver shall 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:


Dr. Sunita Satyalpal
Director
Fuel Cell Technologies Office

Date: 5/13/2020

APPROVAL:


Brian Lally
Assistant General Counsel for Technology
Transfer and Intellectual Property

Date: 5.19.2020