

STATEMENT OF CONSIDERATIONS

REQUEST FOR ADVANCE WAIVER OF PATENT RIGHTS BY
WESTINGHOUSE ELECTRIC COMPANY, LLC,
UNDER DOE AWARD NO. DE-NE0008853; W(A)-2020-004, CH-1817

Petitioner, the Westinghouse Electric Company, LLC (Westinghouse), requested a waiver of domestic and foreign patent rights on behalf of itself and subrecipients for all subject inventions arising under the above referenced award. The award is entitled “U.S. Industries Opportunities for Advanced Nuclear Technology Development.” This waiver will not impact the rights of those parties subject to Public Law 96-517, as amended, nor shall it grant any rights in inventions made by employees of the National Laboratories.

The objective of Petitioner’s award is to develop a conceptual design of the eVinci Micro-Reactor product, that enables integrated system engineering to progress into preliminary design and to address the significant technical uncertainties of the eVinci Micro-Reactor designs through tests, modeling, and simulation to provide evidence for licensing basis claims. Subsequent phases and awards of the project will include further work to complete the product conceptual and basic design, testing, Nuclear Demonstration Unit (NDU) Detailed Design and Evaluations, Licensing, and Program Administration of the eVinci Micro Reactor.

The total anticipated cost of the award is \$25,760,000.00 including the Petitioner’s contribution of \$12,880,000.00, or about fifty percent (50%) of the total cost of the work under the award. This waiver is contingent upon Petitioner maintaining, in aggregate, the above cost sharing over the course of the award.


As noted in its waiver petition, Petitioner has been actively pursuing the development of advanced reactor technologies since the mid-1980s when Petitioner began introducing various advanced reactor technology developments and investing a total estimated to just over sixteen million dollars in the design and testing of the heat pipe reactor components and its supporting systems as well as the development of the processes required for the manufacture of them. Based upon this background, Petitioner’s aim is to execute the engineering and testing toward the demonstration of a new nuclear reactor technology, the eVinci Micro-Reactor and the subject of this award, to support its commercial licensing.

Petitioner has agreed that this 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. Further, Petitioner has agreed to the U.S. competitiveness provisions as attached to this Statement. In brief, Petitioner has agreed that products embodying a waived invention or produced through the use of a waived invention shall be substantially manufactured in the United States, and that Petitioner will not license, assign or otherwise transfer any waived invention to any entity unless that entity agrees to these same requirements.


As set out in the attached waiver petition, Petitioner has requested rights in the subject inventions of its employees and its subrecipients not subject to Public Law 96-517. It is believed that this approach will facilitate timely commercialization of the technology by furthering the establishment of business and technical relationships between the parties and providing a mechanism for obtaining meaningful cost sharing between the parties. This waiver contemplates that the parties will allocate title or other rights to inventions among themselves as they deem appropriate during the course of their association consistent with the terms of this waiver. Accordingly, title may be waived directly to a subrecipient upon mutual agreement of the Petitioner and the subrecipient. However, this waiver will only apply to such subrecipient(s) who provide a letter to DOE acknowledging their right to ask for a waiver and agreeing to the terms of this waiver. There is no intention that this waiver should impact the rights of those parties subject to Public Law 96-517, and any subcontracts with such parties must include appropriate Bayh-Dole patent clauses.

Referring to item 10 of the waiver petition, granting this waiver is not expected to have an adverse impact on competition. Petitioner cites to the early stage of development in the technology where commercial success is uncertain. Both domestic and foreign based competitors are already present in the market and investing in various attributes, applications, and benefits of similar advanced reactor technologies. Thus, granting this Petition is not expected to 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 award 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.


 Felisa L. Leisinger
 Patent Attorney
 Intellectual Property Law Division
 DOE SC

Date: 11/30/2020


 Daniel D. Park
 Assistant Chief Counsel
 Intellectual Property Law Division
 DOE SC

Date: 11/30/20

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:



Alice Caponiti
Deputy Assistant Secretary for
Reactor Fleet and Advanced Reactor
Deployment
NE-5

Date: _____

APPROVAL:



Brian J. Lally
Assistant General Counsel for
Technology Transfer and Intellectual Property
GC-62

Date: 12.28.2020