STATEMENT OF CONSIDERATIONS

REQUEST BY BP SOLAR INTERNATIONAL LLC FOR AN ADVANCE WAIVER OF DOMESTIC AND FOREIGN PATENT RIGHTS UNDER NREL SUBCONTRACT ZDJ-2-30630-10 ENTITLED "RESEARCH ON AMORPHOUS SILICON PHOTOVOLTAIC MODULES FOR LARGE-AREA BUILDING-INTEGRATED APPLICATIONS"; UNDER DOE PRIME CONTRACT NO. DE-AC36-98GO10337 W(A)-02-034; CH-1111

Referring to item 2 in BP Solar's waiver petition, the purpose of this subcontract is to develop technology to produce large-size amorphous silicon (a-Si) photovoltaic modules with high disposition rates and 7-8 percent stabilized conversion efficiency.

The work under the subcontract is expected to take place over a period of three years at a total cost of $5,567,036. BP Solar is obligated to cost share $2,950,529 or about 53% of the total cost of the project.

In view of the cost sharing and other equities between BP Solar and its subcontractors, it is anticipated that the parties will develop an appropriate allocation of patent rights among the participants to facilitate the expeditious development of the technology forming the subject matter of the agreement. Accordingly, DOE will waive title to all subject inventions made by BP Solar's employees and its subcontractors' employees, regardless of tier, except inventions made by subcontractors eligible to retain title pursuant to P.L. 96-517, as amended, or National Laboratories, to BP Solar or its subcontractors , as mutually agreed by the parties. Except as otherwise approved in writing by DOE Patent Counsel, a party's acceptance of a subcontract under this agreement, at any tier, shall constitute BP Solar's certification that it has provided that party with a copy of this Statement of Considerations and that party's notice to DOE that it accepts the terms and conditions of this advance waiver. Additionally, the subcontractors who receive title under this waiver shall inform the DOE Patent Counsel in writing of such disposition of patent rights.

Referring to items 5-8, BP Solar and its predecessor organizations were pioneers in the development of photovoltaics. These companies invented, developed and commercialized solar cells manufactured from semi-crystalline silicon and thin films of amorphous silicon and cadmium telluride. BP Solar is currently one of the largest manufacturers of photovoltaic cells and modules in the world. This, coupled with BP Solar's cost sharing, clearly demonstrates the likelihood that BP Solar will continue development and commercialization of the results of this subcontract.

This advance waiver of the Government's rights in inventions is subject to the usual advance patent waiver and background data licensing provisions, and the government license, march-in rights, and preference for U.S. industry provisions set out in 35 U.S.C. 202-204. The advance patent waiver also includes the attached U.S. Competitiveness clause (paragraph t) which requires products embodying any waived invention or produced through the use of any waived invention be manufactured substantially in the United States unless the participant can show to the satisfaction of DOE that it is not commercially feasible to do so. The contractor further agrees to make the above condition binding on any assignee, licensee or other entity 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 the waived invention is suspended until approved in writing by DOE.

Referring to item 10 of the waiver petition, granting this waiver is not anticipated to have any adverse impact on competition.

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

[redacted]

Thomas G. Anderson
Assistant Chief Counsel
Intellectual Property Law Division

Date 10/28/02

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 described above, and therefore the waiver is granted. This waiver will not apply to any modification or extension of the agreement, where through such modification or extension, the purpose, scope or cost of the agreement has been substantially altered.

CONCURRENCE:

[redacted]

Raymond Sutula, Program Manager
Solar
EE-2A

Date: 1/14/03

APPROVAL:

[redacted]

Paul A. Gottlieb
Assistant General Counsel for Technology Transfer and Intellectual Property,
GC-62

Date: 1-16-03

(t) 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 the DOE that it is not commercially feasible to do so. In the event the 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 agrees that it will not license, assign or otherwise transfer any waived invention to any entity unless that entity agrees to these same requirements. Should the Contractor or other such entity receiving rights in the invention undergo a change in ownership amounting to a controlling interest, then the waiver, assignment, license, or other transfer of rights in the waived invention is suspended until approved in writing by the DOE.

WAIVER ACTION - ABSTRACT

W(A)-02-034 (CH-1111)

REQUESTOR	CONTRACT SCOPE OF WORK	RATIONALE FOR DECISION	DISPOSITION
BP Solar International LLC	Research on amorphous silicon photovoltaic modules for large-area building-integrated applications	53% cost sharing	