

## STATEMENT OF CONSIDERATIONS

REQUEST BY SPECIALIZED TECHNOLOGY RESOURCES, INC. (STR)  
FOR AN ADVANCE WAIVER OF PATENT RIGHTS UNDER NREL  
SUBCONTRACT NO. NREL-ZDO-2-30628-10 UNDER DOE CONTRACT  
NO. DE-AC36-98GO10337; W(A)-02-050; CH-1122

As set out in the attached waiver petition and in subsequent discussions with DOE Patent Counsel, Specialized Technology Resources, Inc. (STR) has requested an advance waiver of domestic and foreign patent rights for all subject inventions made under the above-identified cooperative agreement by its employees and its subcontractors' employees, regardless of tier, except inventions made by subcontractors eligible to retain title to inventions pursuant to P.L. 96-517, as amended, and National Laboratories. The subcontract was awarded by the National Renewable Energy Laboratory (NREL) under DOE's Photovoltaic Manufacturing Technology (PVMaT) Project.

Referring to item 2 of STR's petition, the purpose of this subcontract encompasses the design, manufacture and evaluation of low-cost encapsulants for photovoltaic (PV) modules. During the course of the subcontract, STR expects to work with various US-based PV module manufacturers with the ultimate goal of having STR's encapsulant/packaging materials being qualified by one or more PV module manufacturers. The work under the subcontract will be done in three phases over a period of 38 months at total cost of \$1,927,325. STR is obligated to cost share \$896,656, or about 46 percent of the total cost of the project.

In view of the cost sharing and other equities between STR 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 STR'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 STR 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 STR'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, subcontractors who receive title under the waiver shall notify DOE Patent Counsel in writing of such disposition of patent rights.

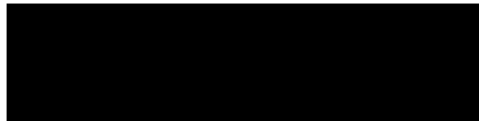
Referring to items 5-8 of STR's waiver petition, STR is a leading manufacturer of PV encapsulant/packaging materials. This, coupled with STR's cost sharing, clearly demonstrates the likelihood that STR will continue development and commercialization of the results of this subcontract.

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 provision 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 9 of the waiver petition, granting this waiver is not anticipated to have any adverse impact on competition. If anything, the development of the technology forming the subject matter of this agreement can be expected to improve U.S. competitiveness relative to off-shore 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 10CFR Part 784, all of which have been considered, it is recommended that the requested waiver be granted.

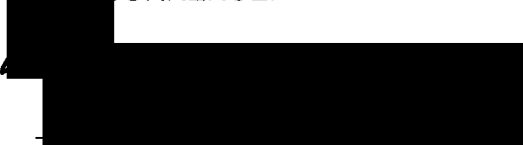


Thomas G. Anderson  
Assistant Chief Counsel  
Intellectual Property Law Division

Date: 1/4/03

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

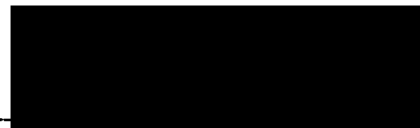
CONCURRENCE:



Raymond A. Sutula, (~~Acting~~) Director  
Office of the Solar Energy Technology  
Program, EE-2A

Date: 03-11-03

APPROVAL:



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

Date: 3-11-03

# WAIVER ACTION - ABSTRACT

W(A)-02-050 (CH-1122)

## REQUESTOR

Specialized Technology  
Resources, Inc.

## CONTRACT SCOPE OF WORK

Development of new low-cost, high-  
performance, PV Module encapsulant/  
packaging materials.

## RATIONALE FOR DECISION

46 % cost sharing

## DISPOSITION

(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.