

STATEMENT OF CONSIDERATIONS

ADVANCE WAIVER TO MODIFY THE STANDARD PROPRIETARY USER AGREEMENT BETWEEN INTEL CORPORATION AND LAWRENCE BERKELEY NATIONAL LABORATORY DOE WAIVER NO. W(A)-04-060

Lawrence Berkeley National Laboratory (LBNL) has designated the Molecular Foundry as a User Facility. There is present interest in further designating it as also a Proprietary User Facility, which is being considered by DOE Program. LBNL is planning on entering into a modified Proprietary User Facility Agreement with Intel Corporation (Intel User Agreement). Since an official approval from DOE Program for pre-approved types of user agreements to be used at this Molecular Foundry may take several months, LBNL requests a waiver on behalf of Intel to approve this Intel User Agreement for only this project, which will begin by November 1, 2004. An advance waiver petition is not required in this case, because this waiver is considered as a substitute for a waiver under a User Facility agreement.

The Proposed Project

For this project, the primary focus is the synthesis and characterization of small organic molecules, polymers and oligomers at the Organic, Polymer and Biopolymer Nanostructures Facility of the Molecular Foundry. The Foundry provides state-of-the-art instruments, as well as expert, dedicated staff proficient in the newest, often unpublished, techniques that make use of those instruments. In addition, Professor Jean Frechet, the Organic, Polymer and Biopolymer Nanostructures Facility Director, is world-renowned for his work in this area.

The Foundry has put together a unique set of capabilities for the rational design, synthesis and characterization of organic thin films with nanometer-precise structure. Therefore, the Foundry presents a unique environment within which to design, synthesize, characterize and develop advanced lithographic materials and self-assembly technology for the 32nm, 20nm and beyond ITRS nodes. The Foundry proximity to the ALS enables rapid at-wavelength proof of concept testing of integrated materials systems with rapid feedback to design and synthesis. The concentration of additional capabilities including the imaging, characterization and theory of nanostructures similarly is expected to catalyze this work. In particular, computational methods could provide significant enhancement to the selection of design targets for synthesis. Thus, this set of enabling capabilities at and through the Foundry provides an attractive platform upon which to establish this research program.

The Allocation of Patent Rights

The proposed Intel User Agreement will include a provision for joint inventions. Under this project, LBNL employees may be assisting Intel with the work being performed. Intel has agreed that LBNL employees may be joint inventors of Subject Inventions and that LBNL could retain joint title to these inventions. For the purposes of this waiver only, LBNL proposes a

disposition of rights to inventions that would result if the definition of Subject Invention were modified to mean "any invention or discovery of the User conceived or first actually reduced to practice in whole or in part by User in the course of or under this Agreement" (the modification is underlined). Then, under the title to inventions, the following two sentences are added:

"For any Subject Invention conceived or first actually reduced to practice jointly by employees of both Parties, the Subject Invention will be jointly owned by both Parties, with each Party having an undivided one-half interest. Each Party's undivided interest shall be available for use and licensing by each Party without any obligation to account to the other Party."

The designation of User Facilities was initially intended to allow a User's employees to perform work and experiments on lab facility equipment. However, there are projects where Laboratory employees also assist in the work being performed. In these cases, there is a question of what types of Agreements are allowed. A Work-For-Others Waiver and both the User Facility and Proprietary User Facility Waivers grant all patent rights to the Sponsor/User. However, CRADA legislation allows the Laboratory to retain title to its own inventions created by its employees. Therefore, the proposed Intel User Agreement doesn't completely comply with any of these prior waivers or statutes. It will take time for DOE Program and LBNL to officially determine what types of Agreements will be appropriate at the Molecular Foundry. However, LBNL is ready to work with Intel on this project soon and DOE Program is fully aware of the situation. Therefore, DOE will allow the LBNL to retain joint ownership rights in its joint inventions with Intel for only this Intel User Agreement.

The Allocation of Rights in Data

Under the Proprietary User Facility Waiver, the User pays full cost and can mark all of its data generated at the User Facility as proprietary. The Government does not retain any right in this data. As Laboratory policy, LBNL does not generate proprietary information except for rare specific projects. In this case, LBNL has informed Intel to not share any proprietary data with LBNL employees. Apparently, the Laboratory can perform its portion of the work without this information. Intel has agreed not to provide proprietary information, either orally or in writing, to LBNL employees for this project. Therefore, the Laboratory will add the following provision to the data rights clause:

"Notwithstanding the above, the Contractor does not want User to disclose either verbally or in writing any proprietary information to Contractor's employees. The Contractor shall treat all information provided to it by User as if delivered with unlimited rights."

DOE agrees to this provision being added to the Intel Agreement. Intel can still mark its generated data as proprietary. Intel is also aware of the risks of delivering data to laboratory employees.

Conclusion

The two changes to the standard Proprietary User Agreement are only approved for this project with Intel.

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Date: Oct. 14, 2004

for Gary Drew
Counsel for Intellectual Property
DOE, Chicago Office at Berkeley, CA

Based on the foregoing Statement of Considerations, it is determined that the interests of the United States and the general public will best be served by granting this waiver for this project at LBNL. Therefore, the waiver is granted. This waiver shall not apply to a modification or extension of the Intel User Agreement where, through such modification or extension, the purpose, scope or cost of the project has been substantially altered. This waiver shall not affect any waiver previously granted.

CONCURRENCE:

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Date: 10/25/2004

Patricia M. Dehmer
Associate Director
Office of Basic Energy Sciences (SC-10)
Office of Science

APPROVED: [Signature]
[Redacted signature block]

Date: 10-25-04

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