

STATEMENT OF CONSIDERATIONS

REQUEST BY SHELL SOLAR INDUSTRIES, LP FOR AN ADVANCE
WAIVER OF DOMESTIC AND FOREIGN PATENT RIGHTS UNDER NREL
SUBCONTRACT NO. ZDJ-2-30630-16 UNDER DOE CONTRACT NO.
DE-AC36-98GO10337; W(A)-03-010; CH-1136

As set out in the attached waiver petition and in subsequent discussions with DOE, Shell Solar Industries, LP (SSI) 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.

Referring to item 2 of SSI's waiver petition, the purpose of the subcontract encompasses the development of thin-film module processing and cell and module reliability. As a result of this agreement, DOE expects to accelerate the commercialization of thin-film photovoltaics as the resulting technologies should significantly reduce the cost of manufacturing photovoltaic products..

The work under this subcontract is expected to take place over a period of about 3 years at a total cost of \$7,290,123. SSI is obligated to cost share \$4,192,036 or 58% of the total cost of the project.

In view of the cost sharing and other equities between SSI 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 SSI'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, and National Laboratories, to SSI 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 SSI'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 this waiver shall notify DOE Patent Counsel in writing of such disposition of patent rights.

Referring to items 5-9 of SSI's waiver petition, SSI is a world leader in the production of photovoltaics products. This coupled with SSI's cost sharing, clearly demonstrates the likelihood that SSI will continue development and commercialization of the results of the subcontract.

This advance waiver of the Government's rights in inventions is subject to 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 as there are a variety of competing technologies in the relevant market.

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 waived be granted.


Thomas G. Anderson
Assistant Chief Counsel
Intellectual Property Law Division

Date: 8/5/05

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 contract, where through such modification or extension, the purpose, scope or cost of the contract has been substantially altered.

CONCURRENCE:

PK
9/8/05

Raymond Sutula, Program Manager
Office of Solar Technologies, EE-2A

JAM
09/08/2005
Date: 9/8/05

APPROVAL:


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

Date: 9-23-05

WAIVER ACTION - ABSTRACT

W(A)-03-010 (CH-1136)

REQUESTOR

Shell Solar Industries, LP
under DOE Contract
No. DE-AC36-98GO10337
and NREL Subcontract
No. ZDJ-2-30630-16

CONTRACT SCOPE OF WORK

Process R&D for CIS-based Thin-Film PV

RATIONALE FOR DECISION

58% cost sharing

DISPOSITION