

## STATEMENT OF CONSIDERATIONS

### REQUEST BY GENERAL MOTORS CORPORATION (GM) FOR AN ADVANCE WAIVER OF DOMESTIC AND FOREIGN RIGHTS TO INVENTIONS MADE UNDER COOPERATIVE AGREEMENT NUMBER DE-FC04-03AL67635, DOE WAIVER NO. W(A) 03-019.

The Petitioner, GM, has requested a waiver of all domestic and foreign patent rights to inventions that GM may conceive or first actually reduce to practice in the course of GM's work under Cooperative Agreement Number DE-FC04-03AL67635 entitled "Innovative Emission Control Device." The petition was originally submitted as part of a response to a funding proposal – known at that time as DE-RP04-01AL67057.

The work to be done under the cooperative agreement will be the development of new microwave soot combustion components in compression-ignition, direct-injection (CIDI) diesel engine systems. This work will allow for the improvement of existing particulate traps for diesel engines and vast improvements in passenger car and light-duty vehicle diesel emissions.

The cooperative agreement covers a period from October 1, 2003 through September 30, 2006 at a total estimated cost to DOE of \$2,239,952. GM will provide approximately \$600,000 as a cost share (20%) over the life of this agreement. Government funding is scheduled to be provided as follows: \$500,000 in FY03; \$1.2M in FY04; and \$540,000 in FY05. The government contribution will be made through Budget & Reporting Code EE0503 sponsored by the Office of FreedomCAR and Vehicle Technologies (OFCVT).

GM is a Detroit, MI-based, U.S. corporation with a global research, development and marketing presence. GM is the world's largest automotive company in the world with over 30 years of experience in the development and commercialization of emission-control systems. Since 1990, GM has earned over 100 patents in the field of emission control, diesel and lean-burn engine technology. GM has already invested \$1,000,000 over the last three years in the research of the CIDI-engine technology to be developed under this cooperative agreement. Additionally, once the operational prototype is developed, GM will assume full financial responsibility for further development and the integration of the technology into mass production vehicles. As such, based on the nature of the technology, as well as the research and development being done in this field worldwide, and the existing myriad of competing technologies, it is not foreseen that the grant of this waiver would decrease competition, cause undesirable market concentration, nor place GM in a dominant market position.

GM has agreed to abide by 35 U.S.C. §§ 202, 203 and 204, as well as the provisions of the Standard Patent Rights clause for an Advance Waiver. Additionally, GM has agreed to the provisions of the attached U.S. Competitiveness Clause, which requires Petitioner to substantially manufacture any products embodying or produced through any waived invention in the United States, unless Petitioner can convince DOE it is not commercially feasible to do so (attached). Petitioner agrees to make this condition binding on any

assignee or licensee. GM will abide by the Export Control laws and will require its licensees, if any, to do the same. GM will expend such sums as may be required to maintain the necessary patent protection and provide incentive for commercial development of the invention. Furthermore, GM has affirmatively agreed to the background data rights clause found in 48 CFR 952.227-14, Alternate VI (February 1998) (attached).

Considering GM's status as a global leader in the development and production of diesel engine and emissions reduction systems, it is concluded that the grant of the requested waiver is most likely to achieve commercialization success and actual implementation of cleaner-burning diesel engine systems on both a national and global scale.

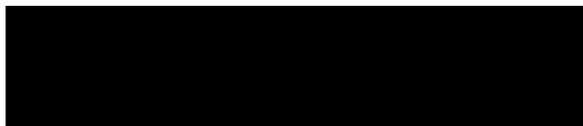
As such, upon evaluation of the Waiver Petition in view of the objectives and considerations set forth in 10 CFR 784.4, all of which have been considered, it is recommended that the requested waiver be granted.



Jim C. Durkis  
Patent Attorney  
NNSA Service Center

Based on the foregoing Statement of Considerations and the representations of 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 shall not apply to a modification or extension of the cooperative agreement where, through such modification or extension, the purpose, scope or DOE cost of the cooperative agreement have been substantially altered.

CONCURRENCE:



Edward J. Wall  
Program Manager  
Freedom Car & Vehicle Technology

Date: 2/12/04



APPROVAL:

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

Date: 2-25-04

DOE Project Manager: Kenneth Howden