

## STATEMENT OF CONSIDERATIONS

REQUEST BY OSRAM SYLVANIA DEVELOPMENT, INC. FOR AN ADVANCE WAIVER OF DOMESTIC AND FOREIGN INVENTION RIGHTS UNDER DOE COOPERATIVE AGREEMENT NO. DE-FC26-04NT42274; SUBCONTRACT NO. QZ001; W(A)-04-073; CH-1251

The Petitioner, Osram Sylvania Development, Inc. (Osram), was awarded subcontract for the performance of work entitled, "Development of White-Light Emitting Active Layers in Nitride Based Heterostructures for Phosphorless Solid State Lighting." In this program, Osram will explore the feasibility of new LED architecture for white light emission using thin films of nitride-based luminescent semiconductor alloys of GaN, AlN, and InN doped with suitably chosen activator ions. The goal is to develop a thin film that can be used as an active layer in designing double heterojunctions for solid-state lighting applications. Osram is a subcontractor to the University of California, San Diego (UCSD). UCSD may retain title to subject inventions pursuant to P.L. 96-517, as amended.

The total estimated cost of the cooperative agreement is \$1,200,929. The value of Osram's subcontract is \$709,912, with Osram cost sharing \$155,680, or 22%; DOE is providing \$554,232 (78%) toward this subcontract. The period of performance is from October 1, 2004 through September 30, 2007.

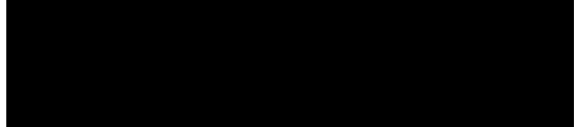
In its response to questions 5 and 6 of the attached waiver petition, Osram has described its technical competence in the field of phosphor LED lighting materials. Osram is a major manufacturer and has a long tradition of research in the area of lighting materials. This project will use principals having substantial expertise in phosphor spectroscopy, modeling of luminescence processes, and chemical vapor deposition (CVD) coatings. Resumes of the three principals are attached to Osram's waiver petition; and these resumes include a listing of substantial papers, presentations, patents, and invention disclosures that these principals have authored. Osram's response demonstrates its technical competency in the field of phosphor LED lighting material.

In its response to question 10 of the attached waiver petition, Osram states that grant of the waiver will have a negligible effect on competition and market concentration. Several major companies participate in the LED market. Lighting technologies such as existing LED and fluorescent lighting technologies, and developing organic electroluminescent (OLED) technologies, compete with any of the products that might be developed as a result of this subcontract. Thus, grant of the waiver should have a positive effect on competition and market concentration.

The subject subcontract will be modified to add the Patent Rights--Waiver clause in conformance with 10 CFR 784.12, wherein Osram has agreed to the provisions of 35 U.S.C §§ 202, 203, and 204. This waiver clause will also include a paragraph entitled U.S. Competitiveness, in which Osram agrees to substantial U.S. manufacture of subject inventions (attached hereto). Additionally, Osram agrees not to transfer subject inventions to any other entity unless that other entity agrees to these same requirements.

Considering the foregoing, it is believed that granting the waiver will provide the Petitioner with the necessary incentive to invest resources in the commercialization of the results of the subcontract in a fashion which will make the subcontract's benefits available to the public in the shortest practicable time. In addition, it would appear that grant of the above requested waiver

would not result in an adverse effect on competition nor result in excessive market concentration. Therefore, in view of the objectives and considerations set forth in 10 CFR 784, all of which have been considered, it is recommended that the requested waiver, as set forth above, be granted.



Mark P. Dvorscak  
Assistant Chief Counsel  
Intellectual Property Law Division

Date: Dec 21, 2004

Based on the foregoing Statement of Considerations and the representations in the attached waiver petition, it is determined that the United States and the general public will best be served by a waiver of rights of the scope described above, and therefore the waiver is granted. This waiver shall not apply to any modification or extension of this subcontract, where through such modification or extension, the purpose, scope, or cost of the subcontract is substantially altered.

CONCURRENCE:



Michael J. McCabe  
Program Manager  
Building Technologies Program  
Energy Efficiency and Renewable  
Energy

Date: 1/15/05

APPROVAL:



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

Date: 1-28-05

(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)-04-073 (CH-1251)

## REQUESTOR

Osram Sylvania  
Development, Inc.  
Under DOE Contract  
No. DE-FC26-04NT42280  
Subcontract No.  
QZ001

## CONTRACT SCOPE OF WORK

Development of White-Light  
Emitting Active Layers in Nitride  
Based Heterostructures for Phosphorless  
Solid State Lighting

## RATIONALE FOR DECISION

22 percent cost sharing

## DISPOSITION