

## STATEMENT OF CONSIDERATIONS

REQUEST BY MOTOROLA LABS FOR AN ADVANCE WAIVER OF DOMESTIC AND FOREIGN INVENTION RIGHTS UNDER PROPOSED SUBCONTRACT WITH ARGONNE NATIONAL LABORATORY, RFP NO. BAA-N66001-03-X-6010, UNDER M&O CONTRACT W-31-109-ENG-38; W(A)-05-015, CH-1278

The Petitioner, Motorola Labs (Motorola) will be entering into a subcontract with Argonne National Laboratory (ANL) for the performance of work entitled, "Co-integration of Multi-functional Diamond MEMS (Micro-Electro-Mechanical Systems) Technology." The waiver will apply to inventions made by Motorola 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 purpose of the subcontract is to demonstrate the co-integration of a diamond-based MEMS technology with high-performance CMOS for applications ranging from DC to GHz frequencies, resulting in low cost, highly flexible, and physically compact systems.

The total estimated cost of the subcontract is \$1,296,463 with Motorola cost sharing \$401,463 or 31%. ANL will be providing the remaining \$895,000 or 69%. The source of the funding is the Defense Advanced Research Projects Agency (DARPA), with no cognizant DOE program director. Attached is an e-mail from Clark Nguyen, DARPA program manager, indicating DARPA's concurrence in this waiver request. The period of performance is expected to be three (3) years beginning July 2005.

In its response to question 5 of the attached waiver petition, Motorola has described its technical competence in the field of semiconductor fabrication. Motorola's lab in Tempe Arizona has developed modules or entire flows in support of Motorola's Semiconductor Product Sector for over fifteen years. For several years Motorola has worked on RF MEMS technology, and more details of Motorola's expertise are provided in response to this question 5.

In its response to questions 9 and 10 of the attached waiver petition, Motorola states that the area of RF MEMS is an unproven technology, and that external funding is required to develop technologies that are not part of Motorola's core technologies. Motorola further states that most of the MEMS R&D is performed in Asia and Europe, and that this area of technology is crucial to the U.S. economy. Granting of the waiver will assist U.S. companies, like Motorola, to assist other U.S. companies, to compete in this global market against foreign companies. Thus grant of the waiver will not place Motorola in a preferred or dominate position in this field, and is likely to have a positive effect on competition and market concentration.

The subject cooperative agreement will be modified to add the Patent Rights--Waiver clause in conformance with 10 CFR 784.12, wherein Motorola 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 Motorola agrees to substantial U.S. manufacture of subject inventions (attached hereto). Additionally, Motorola 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 agreement in a fashion which will make the agreement'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.

[Redacted signature]

Mark P. Dvorscak  
Assistant Chief Counsel  
Intellectual Property Law Division

Date: May 25 2005

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 agreement, where through such modification or extension, the purpose, scope, or cost of the agreement is substantially altered.

CONCURRENCE:

[Redacted signature]

Robert C. Wunderlich  
Site Manager  
Argonne Site Office  
Contracting Officer

Date: 5/25/05

APPROVAL:

[Redacted signature]

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

Date: 6-7-05

(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., recoument 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.

17. State the name, address and telephone number of the person to whom correspondence is to be directed.

The facts set forth in this request for waiver are within the knowledge of the requestor and are submitted with the intention that the Secretary or his designee rely on them in reaching the waiver determination.

Respectfully submitted,



(Signature)

Date submitted to DOE

4/28/05

VIDA WOODRUM, VP ESPS

(Name and title of authorized representative)

# ***WAIVER ACTION - ABSTRACT***

**W(A)-05-015 (CH-1278)**

## REQUESTOR

Motorola Labs under  
Proposed Subcontract  
with Argonne National  
Laboratory RFP No.  
BAA-N66001-03-X-6010  
Under M&O contract W-31-109-ENG-38

## CONTRACT SCOPE OF WORK

Co-integration of Multi-functional  
Diamonds MEMS (Micro-Electro-  
Mechanical Systems) Technology

## RATIONALE FOR DECISION

31% cost sharing

## DISPOSITION