

## STATEMENT OF CONSIDERATIONS

REQUEST BY OSRAM SYLVANIA PRODUCTS, INC. FOR AN ADVANCE WAIVER OF DOMESTIC AND FOREIGN PATENT RIGHTS UNDER DOE GRANT NO. DE-FG36-05GO85042 ENTITLED "TUNGSTEN CATHODE FUEL CELL CATALYST PROJECT"; W(A)-05-031; CH-1300

As set out in the attached waiver petitioner, the Petitioner, OSRAM SYLVANIA Products, Inc., has requested an advance waiver of domestic and foreign patent rights for all subject inventions made by its employees under the above-identified award.

Referring to item 2 of the waiver petition, the purpose of this award relates generally to fuel cells and specifically to the design, fabrication and evaluation of the cathodic, catalytic activity of a tungsten-based (platinum-free) material in a prototype membrane electrode assembly at 1/15<sup>th</sup> the output of a comparable platinum containing unit to accomplish a two-fold enhancement in current tungsten-based catalyst performance.

The work under this award is expected to take place over a period of about 11 months at a total cost of \$406,250. Of that amount, the Petitioner is obligated to cost share \$81,250, or 20 percent of the total cost of the project.

Referring to items 5-9 of the waiver petition, the Petitioner manufactures a variety of tungsten and molybdenum products and chemicals, as well as a number of photoluminescent, electroluminescent and cathodoluminescent materials for use in lighting and display technologies. This, coupled with the Petitioner's cost sharing, clearly demonstrates the likelihood that it will continue development and commercialization of the results of this award.

In view of the Petitioner's cost sharing under this award, it is anticipated that waiving the requested patent rights to the Petitioner will facilitate the expeditious development of the technology forming the subject matter of the award. Accordingly, DOE will waive title to all subject inventions made by the Petitioner's employees to the Petitioner.

This advance waiver of the Government's rights in inventions is subject to the usual 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 required products embodying any waived invention or produced through the use of any waived invention be manufactured substantially in the United States unless the Petitioner can show to the satisfaction of DOE that it is not commercially feasible to do so. The Petitioner 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 Petitioner 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.

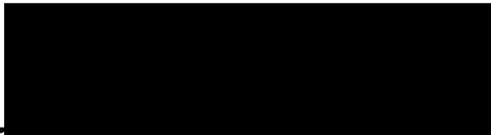
Considering the foregoing, it is believed that granting this waiver will provide Petitioner with the necessary incentive to invest its resources in the commercialization of the results of the agreement in a fashion which will make the technology available to the public in the shortest practicable time. 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 waiver be granted.



Thomas G. Anderson  
Assistant Chief Counsel  
Intellectual Property Law Division

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

CONCURRENCE:



Steven G. Chalk, Program Manager  
Office of Hydrogen, Fuel Cells  
& Infrastructure Technologies  
Program, EE-2H

Date: 10/4/05

APPROVAL:



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

Date: 10-5-05

(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)-05-031 (CH-1300)

REQUESTOR

OSRAM SYLVANIA  
PRODUCTS,INC.

CONTRACT SCOPE OF WORK

TUNGSTEN CATHODE FUEL CELL  
CATALYST PROJECT

RATIONALE FOR DECISION

20% COST SHARING

DISPOSITION