

## STATEMENT OF CONSIDERATIONS

### **Request by Eastman Kodak Company for an Advance Waiver of Domestic and Foreign Invention Rights under DOE Cooperative Agreement No. DE-FC26-06NT42933, W(A)-07-001; CH-1394**

The Petitioner, Eastman Kodak Company, (Kodak) was awarded this cooperative agreement for the performance of work entitled, "OLED Lighting Device Architecture." The purpose of the cooperative agreement is to utilize a system approach to develop and co-optimize four key technologies in parallel to bring about a significant advancement in the power efficiency and lifetime of OLED based white-light illuminating devices. The four key areas are: light extraction efficiency enhancement, low operating voltage materials and structure, high quantum efficiency and stable white emitters, and stacked architecture. This waiver is for inventions of Kodak only under the cooperative agreement.

Although this work is funded under DOE's Solid State Lighting Program (SSL), it is funded under the product development portion of the program. Therefore, the licensing requirements under the Exceptional Circumstances determination do not apply to inventions developed under this cooperative agreement.

The total estimated cost of the cooperative agreement is \$1,945,473, with the DOE providing \$1,167,283 or 60%, while the remaining cost share of 40%, or \$778,190, will be provided by Kodak. The period of performance is from October 1, 2006 through September 30, 2008.

In its response to questions 5 and 6 of the attached waiver petition, Kodak has described its technical competence in the field of light emitting diodes. Kodak scientists invented organic light emitting diodes (OLEDs) in the early 1980s. Since then, Kodak has been issued over 200 patents for OLED technology and material. Kodak states it has a significant number of pending U.S. applications. Kodak states it has an extensive history of partnership and licensing arrangements with companies in other commercial markets (including the lighting and display industries). Further, Kodak is a member of the Next Generation Lighting Industry Alliance. Kodak's response demonstrates its technical competency in the field of organic light emitting diodes.

In its response to question 10 of the attached waiver petition, Kodak states that since it does not market or manufacture products in the solid state lighting industry, it does not have a preferred or dominant position in the field. To the extent that Kodak inventions have applications in the solid state lighting field, Kodak has and will continue to license its technology to commercial entities interested in utilizing the technology. Grant of the waiver will 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 Kodak has agreed to the provisions of 35 U.S.C §§ 202, 203, and 204. Further, Petitioner has agreed to the attached U.S. Competitiveness provision paragraph (t). In brief, Petitioner has agreed that products embodying a waived invention or produced through the use of a waived invention will be manufactured substantially in the United States unless the Petitioner can show to the satisfaction of the DOE that is not commercially feasible to do so.

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

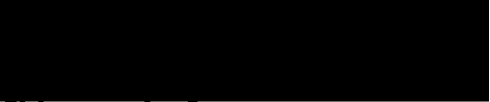
shortest practicable time. In addition, it would appear that grant of the above requested waiver would not result in an adverse effect on competition nor result in excessive market concentration. Therefore, in view of the objectives and considerations set forth in 10 CFR 784, all of which have been considered,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

  
Brian J. Lally  
Assistant Chief Counsel  
Intellectual Property Law Division

Date: 9/10/07


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:

  
Jerome P. Dion, EE-2J  
Office of Building Technologies  
Office of Energy Efficiency and  
Renewable Energy

Date: 9/17/07

APPROVAL:

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

Date: 9/17/07

WAIVER ACTION - ABSTRACT  
W(A)-07-001

REQUESTOR

Eastman Kodak  
Company

CONTRACT SCOPE

Development of inorganic light emitting  
diodes (product development)

RATIONALE FOR DECISION

40% Cost Sharing

(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.