

## STATEMENT OF CONSIDERATIONS

### REQUEST BY PPG INDUSTRIES FOR AN ADVANCE WAIVER OF PATENT RIGHTS TO INVENTIONS MADE UNDER COOPERATIVE AGREEMENT DE-EE0003209; W(A)-2010-032 ; CH-1565

PPG Industries requests an advance waiver of domestic and foreign patent rights for all subject inventions made under the referenced cooperative agreement, entitled, "Recovery Act: Low Cost Integrated Substrate for OLED Lighting Development". The purpose of the cooperative agreement is to develop a new low-cost glass substrate product that is suitable for OLED lighting manufacture and is compatible with PPG's existing flat glass and transparent glass coating technologies and high volume glass manufacturing methods. Ultimate commercialization of a substrate product by PPG is expected to meet the future solid state lighting cost goals set out in the 2009 DOE Solid State Lighting (SSL) Multi-Year Program Plan (PYPP). PPG is teamed with Universal Display Corporation (UCD), a small business eligible to elect title to its inventions under the Bayh-Dole Act pursuant to P.L. 96-517, as amended. UCD will demonstrate OLED performance using the integrated substrate with a consistently reproducible OLED. This waiver is for inventions made by PPG employees only.

The work under this agreement is expected to take place between April 1, 2010 and March 31, 2011. The total amount of the award is \$2,140,040. PPG is cost-sharing \$467,968 or 21.2% non-DOE cost share. DOE is providing the remaining 79.8% (\$1,672,072).


With respect to its technical competency in the field of films and coatings for glass, PPG states that its Glass Technology Center in Pittsburgh has a long and continuing history of developing competencies in the areas of glass melting and forming, properties control through glass chemistry, functional coatings, coatings design and fabrication for optics and solar control, lamination, tempering, complex bending, insulated glass unit technology, and surface treatments for hydrophobic and hydrophilic functionality. PPG also states it has nearly thirty years of experience in depositing functional coatings with both chemical vapor deposition and magnetron sputtered vapor deposition technologies. PPG holds many patents in the areas of glass, glass manufacturing and coatings for glass, and has listed a representative sample in response to question 5 of its petition. PPG has demonstrated its technical competency in the field of films and coatings for architectural glass.

PPG states that any anti-competitive effects of this waiver will be reduced by competitive technologies. PPG states it may be able to improve the marketplace economics and spur the development of similar and competing technologies. It has made new technologies available to the marketplace through licensing, partnering, vertical integration, and working with suppliers, customers and competitors. Thus grant of the waiver will not place PPG in a dominant position and should have a positive effect on competition and market concentration.

This advance waiver of the Government's rights in inventions is subject to the usual advance patent waiver licensing provisions, and the 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 requires products embodying any waived invention or produced through the use of any waived invention be manufactured substantially in the United

States unless the participant can show to the satisfaction of DOE that it is not commercially feasible to do so. The contractor 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 Contractor 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.

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.

  
Mark P. Dvorscak  
Deputy Chief Counsel  
Intellectual Property Law Division

Date: June 8, 2010

Based upon 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 cooperative agreement, where through such modification or extension, the purpose, scope or cost of the cooperative agreement has been substantially altered.

CONCURRENCE:


  
~~P. Marc LaFrance~~ JAMES R BRUDRICK  
Building Technologies Program

Office of Energy Efficiency and  
Renewable Energy

~~FE-221~~ EE-23

Date September 15, 2010

APPROVAL:

  
John F. Lucas, Acting  
Assistant General Counsel for  
Technology

Transfer and Intellectual Property,  
GC-62

Date 9/7/10

(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.