

## STATEMENT OF CONSIDERATIONS

Request by General Electric Global Research for an Advance Waiver of Domestic and Foreign Invention Rights under DOE Cooperative Agreement No. DE-EE0003251, W(A) 2010-035, CH-1572

The Petitioner, General Electric Global Research (GE) was awarded the subject cooperative agreement with DOE for the performance of work entitled, "Optimized Phosphors for Warm White LED Engines". Under this agreement, GE will develop new phosphor materials and optimized LED packages. The waiver will apply only to inventions made by GE employees.

The work under this agreement is expected to take place from March 16, 2010 through March 15, 2012. The total amount of the contract is \$2,480,393, with GE cost-sharing \$744,121 or 30%, and DOE providing the remaining cost-share of \$1,736,272 or 70%.

In its response to questions 5 and 6 of the attached waiver petition GE has described its technical competence in the field of LED lighting. GE states that it is a world leader in the development and commercialization of LED lighting products and phosphor materials. GE has commercialized phosphor compositions developed at GE Global Research, and if the phosphors and packages developed in this program meet the performance requirements required by DOE, GE plans to take appropriate steps to implement these materials into LED based lighting applications. A representative list of patents and peer reviewed publications are provided in an attached appendix. GE's response demonstrates its technical competency in the field of LED lighting.

In its response to question 10 of the attached waiver petition, GE states that as energy demands and prices continue to rise, there is an increasing global effort to develop new technologies to reduce overall energy consumption. This will create a highly competitive environment for lighting products that have significant improvements versus current technologies. Lumination states that it will be able to further establish a solid commercial position in solid-state lighting, and further advance the U.S. as a leader in the global lighting industry. Therefore grant of the waiver will have a positive effect on competition and market concentration.

The subject contract will be modified to add the Patent Rights--Waiver clause in conformance with 10 CFR 784.12, wherein GE 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 GE agrees to substantial U.S. manufacture of subject inventions (attached hereto). Additionally, GE 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]  
Mark P. Dvorscak  
Deputy Chief Counsel  
Office of Intellectual Property Law

Date June 25, 2010

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, 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]

James Brodrick  
Office of Energy Efficiency and  
Renewable Energy  
Office of Building Technology, EE-2J

Date September 13 2010

APPROVAL:

[REDACTED]

John T. Lucas, Acting  
Assistant General Counsel for  
Technology Transfer and  
Intellectual Property, GC-62

Date 9/17/10

(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.