

STATEMENT OF CONSIDERATIONS

REQUEST BY RONALD CLAGHORN FOR WAIVER OF U.S. AND FOREIGN RIGHTS IN AN IDENTIFIED INVENTION, DOE DOCKET NO. S-116,868 MADE UNDER CONTRACT NO. DE-AC27-01RV14136 WITH BECHTEL NATIONAL INC. THE REQUEST INCLUDES THE RIGHT TO ASSERT COPYRIGHT IN ASSOCIATED SOFTWARE.
W(I)-08-006; CH-1439.

The Petitioner, Ronald Claghorn (the inventor), has requested a waiver of domestic and foreign patent rights in S-116,868, "Document Development and Maintenance System." The subject invention facilitates the development and maintenance of related documents that form a technical baseline so that analysis and handling of changes in project documentation will appropriately update the technical baseline. Appendix A includes a publicly releasable abstract. Bechtel National Inc. (Bechtel) has decided not to petition the Government for title to the invention and informed DOE by email on January 18, 2008. Therefore, the Petitioner has requested to elect title by the attached petition.

The Bechtel contract is for the design, construction, and commissioning of a nuclear treatment plant at the Hanford Site in the State of Washington. Referring to Appendix C, The Petition, item 4, the inventor made the invention without Government funding. The Invention Disclosure states that the project the inventor was working on required the "identification and placement of design criteria into a searchable database." The commercial option chosen performed badly. The inventor worked at home and "performed some research, evaluated alternatives, and developed a prototype for a better system." Although the Government didn't fund this work directly, the invention falls under 42 USC 5908 where the inventor was performing similar work under the Government contract; and therefore, title to the invention vests with the Government. The purpose of this waiver is to vest the Petitioner with clear title to the invention to enable him to commercialize the subject invention.

Referring to Petition items 10 and 11, the inventor has worked for Hanford Site contractors for 27 years and has extensive experience in the development of

documents. The Petitioner expects that the invention and associated software reduce the work required, and improve the quality of documents that are generated and maintained by an organization.

In addition to receiving title to the invention, the Petitioner also requires the right to assert copyright in the associated software to this invention. Under FAR 52.227-14 Rights In Data, the contractor (or in this case the inventor) must request to assert copyright in software. If granted, the Government will retain a royalty-free narrow license to use the software for Government purposes. This license permits the "Government and others acting on its behalf, a paid-up nonexclusive, irrevocable worldwide license in such copyrighted computer software to reproduce, prepare derivative works, and perform publicly and display publicly by or on behalf of the Government." The authorization is usually granted for five-year-renewable periods. Renewal is customary if the software is being commercialized and the public's needs are being met. This license also extends to improvements to the software during the period of narrow license. At the end of the renewable periods, the Government's license broadens to include the right to "distribute copies to the public." The Petitioner will be required to file the appropriate form and software code with the Office of Scientific and Technical Information (OSTI). The Government and its contractors will continue to use the software invention under its Government Use License.

The grant of this waiver should effectively promote the continued development and commercial utilization of the subject invention since the inventor plans to form a limited liability corporation (LLC). See Petition Item 8. Either the Petitioner or the LLC will further develop the intellectual property, for example, seeking patent protection of the invention and seeking copyright registration of the software, at the expense of either the Petitioner or LLC without Government funding. The LLC intends to contact companies that maintain large numbers of documents such as permits, grants,

procedures, journal articles, legal briefs, etc. The inventor believes it possesses all skills and facilities needed to commercialize the subject technology and that commercial deployment would make it available to a much larger range of applications. See Petition item 9.

The inventor, a Bechtel employee, reported the invention to Bechtel in August 2006. The inventor was instructed that he needed to contact DOE to pursue ownership of the invention. Unfortunately, Bechtel's communications with the inventor didn't provide adequate information for contacting DOE at that time. The issue was raised with a new Bechtel attorney that followed through and contacted Gary Drew, DOE Patent Counsel, to get the correct forms to start the petition process. Although there have been delays in getting this waiver approved, it is in the best interest of the Government to approve the waiver in order to commercialize the technology.

The Petitioner has agreed that this waiver will be subject to the march-in and preference for U.S. industry provisions, as well as the U. S. Government license, set out in 35 U.S.C. 202-204. Further, Petitioner has agreed to the attached U.S. Competitiveness provision in Appendix B. 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. However, this invention pertains to software for document production maintenance; therefore, substantial manufacturing is moot. The Petitioner has further agreed to make the above conditions binding on any assignee or licensee or any entity otherwise acquiring rights in the waived inventions, including subsequent assignees and licensees. Should the Petitioner or other such entity receiving rights in the 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.


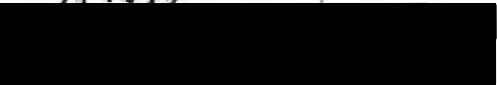
Considering the foregoing, it is believed that granting this waiver will provide Petitioner with the necessary incentive to invest its resources in the commercialization of the subject invention in a fashion which will make the technology available to the public in the shortest practicable time. Therefore,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

Date: July 18, 2008


Gary Drew
Assistant Chief Counsel
Intellectual Property Law Division


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.

CONCURRENCE:



John R. Eschenberg
Supervisory General Engineer
Waste Treatment & Immobilization Plant Project

Date: 7/30/08

APPROVAL:


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

Date: 8/18/08

APPENDIX A

WAIVER ACTION - ABSTRACT
W(1)-08-006

<u>REQUESTOR</u>	<u>CONTRACT SCOPE</u>	<u>RATIONALE FOR DECISION</u>
Ronald Claghorn	A method facilitates the development and maintenance of related documents that form a technical baseline so that analysis and handling of changes in project documentation will appropriately update the technical baseline.	The Inventor will form an LLC to partner with companies to find commercial markets. The grant of this waiver will help ensure commercialization.

APPENDIX B

U. S. Competitiveness

The Petitioner 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 Petitioner 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 Petitioner 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 Petitioner 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.