

## STATEMENT OF CONSIDERATIONS

REQUEST BY SANDIA CORPORATION FOR THE WAIVER OF DOMESTIC AND FOREIGN RIGHTS TO AN IDENTIFIED INVENTION ENTITLED "MIS-BASED SENSORS WITH HYDROGEN SELECTIVITY" DEVELOPED UNDER DOE CONTRACT NO. DE-AC04-94AL85000; DOE INVENTION DISCLOSURE NO. S-106,223; DOE WAIVER NO. W(I) 08-2008.

The Petitioner, Sandia Corporation, has requested a waiver of the Government's domestic and foreign patent rights in an invention entitled "MIS-Based Sensors with Hydrogen Selectivity." The subject invention was conceived by employees of the Petitioner. The Sandia Corporation is the M&O contractor for the Sandia National Laboratory, a government-owned, contractor-operated (GOCO) facility, subject to DOE contract number DE-AC04-94AL85000. Petitioner, as part of this petition, has affirmatively agreed to the standard U.S. Competitiveness Clause.

The subject invention relates to a hydrogen sensor for electrical transmission. The hydrogen sensor comprises a polyimide layer on a metal-insulator-semiconductor for detecting hydrogen in electric transformers.

This invention was developed under funding from Petitioner's LDRD funding and partially from a WFO funded by the Electric Power Research Institution (EPRI). The WFO project was entitled "Continued Development of Sensors for Transformer Gas Analysis," WFO FI-087030213. Federal expenditures in this subject invention are limited to the salary of the Petitioner's employees when working on this concept. These federal expenditures are considered minimal. Petitioner received a patent for this invention, issued on March 11, 2008, and given number 7,340,938. Patent expenses were paid by University of Colorado. Maintenance fees will be paid by CU or are allowable costs under Petitioner's M&O contract.

The invention has been reviewed for Export Control and Classification, and has been determined to be unclassified and not controlled or sensitive under Section 148 of the Atomic Energy Act. Export Control and Classification reviews were conducted on May 4, 2005. Furthermore, the invention does not apply to the Naval Nuclear Propulsion Program or to the nuclear weapons programs or other nuclear or atomic energy defense activities of DOE. Petitioner's M&O Contract (DE-AC04-94AL85000, Mod. M202), in Section I, paragraph 907 (DEAR 970.5227-12, paragraph (b)(5)(ii)(C)), specifically lists inventions funded by EPRI are considered exceptional circumstance inventions. An identified waiver is the only method by which Petitioner may properly obtain title to this invention. This Petition has been filed in a timely manner.

Granting the waiver will promote the effective commercial utilization of this invention. Petitioner shall partner with EPRI, utilizing Petitioner's established technology transfer program to commercialize the invention. Petitioner seeks title through this identified

waiver petition in order to properly partner and work with EPRI to market this invention to others outside EPRI's membership.

As an EPRI joint funded invention, EPRI, EPRI member utilities incorporated, organized or constituted in the US, and other US utilities shall receive an irrevocable, non-exclusive, royalty-free license in connection with the research, development, production or supply of commercial electric power to make, use and sell by or on their behalf this invention and covered by the pending patent, and to have made on their behalf such invention as may be covered by a foreign patent in support of use by them within the US. EPRI's foreign member utilities are to receive a license for use or in support in their respective countries.

As such, upon evaluation of the Waiver Petition 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 be granted.



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Arthur N Trausch  
Patent Attorney, NNSA-SC

Based on the foregoing Statement of Considerations and the representations of 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:



Richard Farmer  
Program Manager, Office of Hydrogen,  
Fuel Cells and Infrastructure Technologies  
EE-2H

Date: 3-8-10

APPROVAL:



Paul A. Gottlieb  
Assistant General Counsel  
For Technology Transfer and  
Intellectual Property (GC-62)

Date: 3-10-10