STATEMENT OF CONSIDERATIONS

REQUEST BY INVENTOR FOR THE WAIVER OF DOMESTIC AND FOREIGN RIGHTS TO AN IDENTIFIED INVENTION ENTITLED "RESONANT-CAVITY APPARATUS FOR CYTOMETRY OR PARTICLE ANALYSIS" USP 5,793,485, DEVELOPED UNDER DOE CONTRACT NO. DE-AC04-94AL85000; DOE INVENTION DISCLOSURE NO. S-85,819 (SD-5797); DOE WAIVER NO. W(I) 2011-003; rv3

The Petitioner, Paul L. Gourley (Inventor), has requested a waiver of the Government's domestic and foreign patent rights in a subject invention entitled "Resonant-Cavity Apparatus for Cytometry or Particle Analysis." The invention was conceived by the Inventor while an employee of the Sandia Corporation (Sandia). Sandia is the M&O contractor for the Sandia National Laboratories (SNL), a government-owned, contractor-operated (GOCO) facility, subject to DOE contract number DE-AC04-94AL85000 at the time the invention was made.

The subject invention relates to a resonant-cavity apparatus and method for optical microscopic and spectroscopic analysis of biological cells or dielectric particles. Sandia returned title to DOE by an Assignment of Patent executed May 3, 2010. Furthermore, Sandia, in an Authorization to DOE dated May 3, 2010, supports the Petitioner's request for title of this invention.

This invention was developed under a SNL Laboratory-Directed Research and Development (LDRD) award. Federal expenditures in this subject invention were approximately $300,000. In order to preserve patent rights, a patent application was filed by Sandia Corp on January 13, 1997 and issued on Aug 11, 1998 as US Patent 5,793,485. An assignment by Inventor Paul L Gourley to Sandia executed January 13, 1997 was recorded in the USPTO on September 12, 1997. No further program funding, other than approximately $5750 paid in US Patent Maintenance Fees by SNL, for or related to this technology has been approved nor is anticipated. On the other hand, Petitioner, since leaving SNL in 2009, has and shall spend his own funds (approximately $30,000 to date) to commercialize and further develop this invention should he be granted title. Petitioner will also expend such sums as may be required to maintain the necessary patent protection as well as provide incentive for commercial development of the invention.

This technology is not export controlled. Furthermore, the technology 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 has agreed to abide by 35 U.S.C. §§ 202, 203 and 204. Petitioner, as part of this petition, has agreed to the provisions of the U.S. Competitiveness Clause, which reads as follows: "The Petitioner agrees that any product embodying any waived

invention or produced through the use of any waived invention will be manufactured substantially in the United States, unless Petitioner can show to the satisfaction of DOE that it is not commercially feasible to do so. In the event 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 Government investment, etc." Furthermore, Petitioner has agreed to make this condition binding on any assignee or licensee. Petitioner will also abide by the Export Control laws and will require its licensees, if any, to do the same.

Granting the waiver is the only way to promote prompt commercial utilization and development of this invention. Petitioner Paul L. Gourley was a Distinguished Member of the Technical Staff in Biomolecular Materials and Interfaces Department at Sandia National Laboratories until he left to start a company in 2009 to commercialize this technology. He has considerable experience in this technology field, including multiple patents and scientific papers. Gourley is a nationally and internationally recognized scientist and the recipient of many awards from DOE, scientific and technological societies, and industrial organizations. Petitioner Gourley has experience with other technical ventures, including spinning off semiconductor laser technology he invented to MODE (later EMCORE). He intends to develop and market this and other health care-related technologies. He has currently invested about $30,000 to further develop this technology. The Petitioner's interest in obtaining title and actively seeking commercialization sufficiently satisfies DOE/NNSA's technology transfer mission without the need to expend additional government funds.

New biotechnologies are being introduced to the market place at a very fast pace. Advances in this technological field can become obsolete within months. Based on this, it is not foreseen that the grant of this specific waiver would in any way cause a decrease in competition, cause an undesirable market concentration, nor place Petitioner in a dominant market position.

As such, upon evaluation of the Waiver Petition and 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.

[redacted]

Arthur N. Trausch
Patent Attorney, NNSA

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:

[redacted]

Aaron Perea
LDRD Program Manager
Sandia Site Office
National Nuclear Security Administration

Date: 4/30/2012

APPROVAL:

John T. Lucas
Assistant General Counsel
For Technology Transfer and
Intellectual Property (GC-62)

Date: _____

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.

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Date: _____

APPROVAL:

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John P. Lucas
Assistant General Counsel
For Technology Transfer and
Intellectual Property (GC-62)

Date: 4/23/2012