

STATEMENT OF CONSIDERATIONS

REQUEST BY JOHNSON MATTHEY FUEL CELLS LIMITED (JMFCL) FOR WAIVER OF DOMESTIC AND FOREIGN PATENT RIGHTS IN AN IDENTIFIED INVENTION, DOE INVENTION NO. S-140,372 MADE UNDER DOE CONTRACT NO. DE-EE0000458; W(D)2015-010 MODIFICATION #1

JMFCL has requested a modification or clarification regarding the U.S. competitiveness provision for its DOE patent waiver. The patent waiver is W(D)2015-010 for DOE Invention No. S-140,372 made under DOE contract number DE-EE0000458. The patent waiver is conditioned on the standard U.S. competitiveness provision that states the following:

The waiver recipient 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 waiver recipient 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 waiver recipient agrees that it will not license, assign or otherwise transfer any waived invention to any entity unless that entity agrees to these same requirements. The waiver recipient further agrees that in the event a controlling interest is to be acquired by a foreign entity in the waiver recipient or in any assignee or licensee of a waived invention, then in that case any rights in the waived invention to be acquired by the foreign entity will be subject to the written approval of the DOE.

JMCL cannot agree to the above language that any products embodying the waived invention, which is a catalyst, will be manufactured in the U.S. because JMCL will sell the catalyst to global customers who will use the catalyst in fuel cells, stacks, stationary devices, portable devices and other products. JMCL does not control where its customers products will be made. Also, JMCL plans to utilize its own existing facility in the United Kingdom to manufacture electrodes or membrane electrode assemblies that will include using the U.S. made catalyst. Therefore, JMCL requests to change the above U.S. competitiveness provision to read as follows:

The waiver recipient agrees that any ~~products-catalysts~~ embodiment embodying any waived invention or produced through the use of any waived invention will be manufactured substantially in the United States unless the waiver recipient 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 waiver recipient agrees that it will not license, assign or otherwise transfer any waived invention to any entity unless that entity agrees to these same requirements. The waiver recipient further agrees that in the event a controlling

interest is to be acquired by a foreign entity in the waiver recipient or in any assignee or licensee of a waived invention, then in that case any rights in the waived invention to be acquired by the foreign entity will be subject to the written approval of the DOE.

Except for the change to the U.S. Competitiveness Provision above, the remaining terms and conditions of the patent waiver will remain the same. In view of all the objectives and consideration set forth in 10 CFR 784, all of which have been considered, it is recommended that the requested modification to patent waiver W(I)2015-010 be granted.

[Redacted Signature]

Glen R. Drysdale
Patent Attorney
EERE

Date: 10/25/16

CONCURRENCE:

APPROVAL:

[Redacted Signature]

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Date: 11/12/16

Date: 11/29/16