

## STATEMENT OF CONSIDERATIONS

REQUEST BY PETITIONER AUBURN UNIVERSITY TO AMEND THE WAIVER OF  
DOMESTIC AND FOREIGN RIGHTS TO THE IDENTIFIED INVENTION ENTITLED:

**DEWATERING GELS AND VISCOUS LIQUIDS WITH PRESSURIZED CARBON DIOXIDE**

TO INCLUDE

**CONTINUOUS DEWATERING OF AQUEOUS SLURRIES**

THIS SECOND SUBJECT INVENTION WAS ALSO DEVELOPED UNDER DOE BLANKET PURCHASE AGREEMENT DE-FE0022594 UNDER A US GENERAL SERVICES ADMINISTRATION (GSA) CONTRACT AND ASSIGNED DOE INVENTION DISCLOSURE No.: S-174,900-1.

### BACKGROUND

The second subject invention was conceived and arose during performance of the work that resulted in the subject invention described in the original waiver. All other aspects of this Petition to Amend W(I) 2022-001 (Petition to Amend) remain the same as the initial Petition, and Petitioner incorporates by reference in their entirety its responses submitted with the initial Petition. The details of the second subject invention are disclosed in provisional patent application 63/399,027 filed 2022-08-18, which is attached with the Petition to Amend.

### SUMMARY OF THE INVENTION

The subject invention of the Petition to Amend is an improvement to the original subject invention, in that it introduces a soaker hose to pump supercritical carbon dioxide through a high slurry to extract water from it. All other aspects of the Petition to Amend remain the same as in the Petition originally submitted for Identified Patent Waiver W(I) 2022-001, which was approved September 7, 2022.

### COMMERCIALIZATION PLAN

There are no changes to the commercialization plan included in the package originally submitted for Identified Patent Waiver W(I) 2022-001.

### ANALYSIS AND RECOMMENDATION

As with the initial subject invention, DOE has no plans to develop this invention further. For the same reasons discussed in the original Statement of Considerations, granting the Petition to Amend will allow Petitioner to promote development and commercialization of the second subject invention. Amending Identified Patent Waiver W(I) 2022-001 to include this subject invention will also likely increase competition and reduce market concentration in the dewatering industry. Petitioner remains unaware of any competitive technologies or other factors which would reduce any anticompetitive effects of granting the amended waiver. Moreover, Petitioner would not likely be in a preferred or dominant market position as there are

multiple companies in the dewatering industry, and Petitioner would likely need to partner with one or more of those companies to commercialize this subject invention as well.

Petitioner also agrees to abide by the provisions of 35 U.S.C. §§ 202 and 203. Further Petitioner agrees to abide by the preference for U.S. Industry standards as presented in 35 U.S.C. § 204, the requirements of which are set forth in the U.S. Competitiveness Clause. Petitioner also agrees that it shall share royalties for this subject invention with the inventors as if Petitioner were a nonprofit organization subject to the terms and conditions of 48 CFR §§ 52.227-11 (i)(1) – (5).

As such, the Petitioner agrees to the following:

Petitioner agrees that any products embodying any subject invention or produced using any subject invention will be manufactured substantially in the United States unless the Petitioner can show to the satisfaction of DOE that it is not commercially feasible. If 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., alternative binding commitments to provide an overall net benefit to the U.S. economy.

Petitioner also agrees that it will not license, assign, or otherwise transfer any subject invention to any entity, at any tier, unless that entity agrees to these same requirements. Should the Petitioner or other such entity receiving rights in the invention(s): (1) undergo a change in ownership amounting to a controlling interest, or (2) sell, assign, or otherwise transfer title or exclusive rights in the invention(s), then the assignment, license, or other transfer of rights in the subject invention(s) is/are suspended until approved in writing by DOE. The Petitioner and any successor assignee will convey to DOE, upon written request from DOE, title to any subject invention, upon a breach of this paragraph.

Petitioner also agrees to shall share royalties for any subject invention with the inventors as if Petitioner were a nonprofit organization subject to the terms and conditions of 48 CFR §§ 52.227-11 (i)(1) – (5).

As such, granting this Petition to Amend would promote commercialization of both the first and second subject inventions. Further, the Petitioner's desire to obtain title and actively seek the commercialization of the subject matter technology satisfies the objectives of the DOE technology transfer mission.

Thus, upon the evaluation of the present Petition to Amend in view of the objectives and considerations as set forth in 10 CFR 784, it is recommended that the Petition to Amend W(I)2022-001 to include the invention titled Dewatering Gels and Viscous Liquids with Pressurized Carbon Dioxide be granted.

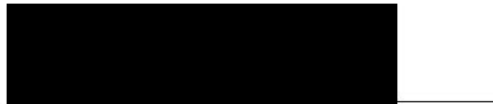
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Based on the foregoing Statement of Considerations and the representations of the attached Waiver Petition, it is determined that the interests of the United States and the public will best be served by a waiver of patent rights of the scope described above and, therefore, the waiver is granted.

CONCURRENCE:



Jennifer Wilcox  
Principal Deputy Assistant Secretary  
Office of Fossil Energy and Carbon Management

APPROVAL:



Brian Lally  
Assistant General Counsel for  
Technology Transfer and Intellectual Property  
U.S. Department of Energy