

U.S. DEPARTMENT OF ENERGY

**PETITION FOR WAIVER OF
DOMESTIC AND FOREIGN RIGHTS TO AN IDENTIFIED INVENTION
UNDER 48 C.F.R. § 927.300(b)**

DOE WAIVER NO.:

DOE Contract No.:

Title of Invention:

Title of Patent Application:

Serial No.

Filed:

Inventor(s):

DOE S-Number:

Petitioner Case No.:

Petitioner, _____, does hereby petition the Secretary of the United States Department of Energy for waiver of domestic and foreign rights of the United States of American to the Subject Invention which was made in the performance of work under the above-identified contract. It is understood that any waiver of rights shall be subject to the government license, march-in rights, and preference for U.S. industry set forth in 35 U.S.C. § 202, 203 and 205, under any circumstances. It is also understood that this waiver is contingent on the following U.S. Competitiveness Provision:

The Inventor 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 Inventor 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 technology be recognized in some appropriate manner, e.g., recoupment of Government investment, etc. The Inventor further agrees to make the above condition binding on any assignee or licensee or any entity otherwise acquiring rights to any waived invention, including subsequent assignees or licensees. Should the Inventor or other such entity receiving rights in any waived invention undergo a change in ownership amounting to a controlling interest, then the waiver, assignment, license or other transfer of rights in any waived invention is suspended until approved in writing by DOE.

Petitioner (is)/(is not) a small business as defined by 27.301 FAR. Petitioner (is)/(is not) a non-profit educational institution.

In support of this petition and at the request of Department of Energy, the following information has been provided:

- 1. Identify the specific rights which the Petitioner desires to obtain in the Subject Invention. (Field of use, geographic area, exclusivity, term, etc.)**

2. Give a brief description of the purpose and nature of the Subject Invention.

Specify any known or unknown or potential weapons fields of use or weapons applications or naval nuclear propulsion use or application of the Subject Invention. To your knowledge, are any fields of use or applications of the invention classified or controlled or sensitive under Section 148 of the Atomic Energy Act (dealing with unclassified, sensitive nuclear information)?

3. Give a brief description of the scope of work of the above contract.

Specifically describe the source of funding, including the name of the specific project under which the Subject Invention was made and the name of the cognizant DOE program director.

4. What is the dollar amount and period of performance of this contract and the amount specifically expended in making the Subject Invention?

Is there further Government funding anticipated in the development of the subject invention (including investigation of material or processes for use therewith), from whatever Government source whether direct or indirect, and to the extent known by Petitioner, any anticipated future Government funding to further develop the Subject Invention?

5. Briefly describe the Petitioner's technical competence in the field of technology in which the Subject Invention lies or to which it relates in terms of prior experience, know-how, and patent position. (Attach exhibits to substantiate your technical competence, e.g., patents, technical publications, etc. If these are voluminous, a representative sample is sufficient.)
6. Briefly describe the Petitioner's established non-governmental commercial position in the field of technology in which the Subject Invention lies or to which it relates. (Discuss in terms of selling goods or providing services in such fields outside of sales to the U. S. Government. Attach exhibits to substantiate your commercial position, e.g., sales brochures, etc. If these are voluminous a representative sample will be sufficient.)
7. What is the financial and technological investment that has been made by the Petitioner with regard to the field of the technology in which the subject Invention lies or to which it relates and with regard to the making and developing of the Subject Invention?

8. **To what extent will the Petitioner make a substantial investment of financial resources or technology that will directly assist the further development and promote the commercial utilization of the Subject Invention?**

Summarize Petitioner's plans, intentions, and ability to develop the Subject Invention to a point of commercialization. This should include a development of the technical steps required, funds necessary therefore, and associated time necessary to develop the Subject Invention to the point of readiness for commercialization, and a statement by the Petitioner that either it or its present or prospective licensee will expend the necessary capital and resources.

9. **Why will the grant of the above-requested waiver more effectively promote the development and the commercial utilization of the Subject Invention? Specifically identify any potential licensees or joint ventures interested in further development of the Subject Invention to commercialization.**

If the Subject Invention will be commercialized by a licensee, summarize the licensee's plans and intentions to develop the Subject Invention to a point of commercialization.

10. **What will be the effect on competition and market concentration if the above mentioned waiver request is granted? Describe any competitive technologies or other factors which would reduce any anti-competitive effects of granting the waiver. Would the acquisition of the waiver rights requested be likely to place the Petitioner in a preferred or dominant position in this field? Give reasons for your conclusion.**
11. **Under what other contracts has the Petitioner worked or what other contract has the Petitioner had with any Branch or Agency of the U. S. Government which include all or a part of the scope of work covered by this contract or which deal with the field of technology in which the Subject Invention lies or to which it relates?**
12. **Has a patent application been filed on the Subject Invention? If so, include with this waiver request a copy of such application or, if not filed, include a complete description of the Subject Invention.**
13. **If a patent application has not been filed, is Petitioner aware of any information which may indicate a potential statutory bar to the patenting of the invention under 35 U.S.C. 102?**
14. **If the Government has already prepared a patent application, is Petitioner willing to reimburse the Government for its expended costs if any in the preparation, filing, and prosecution of patent application(s) on the Subject Invention?**
15. **Is the Petitioner aware of any governmental regulations which require or which might require use of the subject matter of the Subject Invention by the general public or a segment thereof? (If yes, explain.)**

16. **If applicable, provide a statement of reasons why the petition was not timely filed or why a request for an extension of time to file the petition was not filed in a timely manner.**

17. **Does the Subject Invention lie in or relate to a field of technology which concerns the public health, safety, or welfare? (For example, the development of drugs, medical or safety instruments, anti-pollution devices, or such other products that may have a bearing on health, safety, or welfare of the general public.) If yes, explain.**

18. **Give any other information the Petitioner believes will establish that the interests of the United States and the general public will best be served by the granting of this waiver. Sufficient information is required so that the Secretary can consider specifically each of the areas and objectives covered in Sec. 9(c), 9(d), and 9(e) of P.L. 93-577.**

If the Subject Invention was made in the course of or under a contract or subcontract of the Naval Nuclear Propulsion Program or the weapons programs or other atomic energy defense activities of the Department of Energy, the considerations of paragraph (b) of Section 3131 of the 1987 Defense Authorization Act shall also be addressed. These are as follows:

- (a) **Whether national security will be compromised;**

 - (b) **Whether sensitive technical information (whether classified or unclassified) under the Naval Nuclear Propulsion Program or the nuclear weapons programs or other atomic energy defense activities of the Department of Energy for which dissemination is controlled under Federal statutes and regulations will be released to unauthorized persons;**

 - (c) **Whether an organizational conflict of interest contemplated by Federal Statutes and regulations will result;**

 - (d) **Whether waiving such rights will adversely affect the operation of the Naval Nuclear Propulsion Program or the nuclear weapons programs or other atomic energy defense activities of the Department of Energy.**
19. **State the name, address, and telephone number of the person to whom correspondence is to be directed.**

The facts set forth in this request for waiver are within the knowledge of the requester and are submitted with the intention that the Head of the Agency or his designee rely on them in reaching the waiver determination.

Respectfully submitted,

[Inventor]

Date submitted to DOE _____