

PETITION FOR ADVANCE WAIVER OF PATENT RIGHTS (Sept 2009)

Offerors have the right to request a waiver of all or any part of the rights of the United States in inventions conceived or first actually reduced to practice in performance of the contract that may be awarded as a result of this solicitation, in advance of or within 30 days after the effective date of contracting. Even where such advance waiver is not requested or the request is denied, the contractor will have a continuing right under the contract to request a waiver of the rights of the United States in identified inventions, i.e., individual inventions conceived or first actually reduced to practice in performance of the contract. Domestic small businesses and domestic nonprofit organizations normally will receive the patent rights clause at Exhibit 1C which permits the contractor to retain title to such inventions, except under contracts for management or operation of a Government-owned research and development facility or under contracts involving exceptional circumstances or intelligence activities. Therefore, small businesses and nonprofit organizations normally need not request a waiver. See the patent rights clause in the draft contract in this solicitation. See DOE's patent waiver regulations at 10 CFR part 784.

You must request waivers by using the attached DOE form. You should mail the form and its attachments to:

Ms. Emily G. Schneider
Assistant Chief Counsel for Intellectual Property
Oak Ridge Office

U. S. Department of Energy
Post Office Box 2001
Oak Ridge, Tennessee 37831

If you need further information, you may call Ms. Schneider at (865) 576-1077.

So that we may know if you have requested a waiver, please include a copy of the form (attachments are not necessary) in your proposal or send it to the Company's Subcontract Administrator.

UNITED STATES DEPARTMENT OF ENERGY

PETITION FOR ADVANCE WAIVER OF PATENT RIGHTS UNDER 10 C.F.R. PART 784

DOE WAIVER NO. _____
(To be supplied by DOE)

Notice: If you need help in completing this form, contact the DOE Patent Counsel assisting the activity that is issuing your award or the Assistant General Counsel for Technology Transfer and Intellectual Property in the Office of General Counsel in DOE Headquarters. Unless exceptional circumstances have been determined to exist, parties which qualify as Bayh-Dole entities under 35 U.S.C. 201 (h) or (i). are not required to petition for title. Rather, their agreement with DOE will automatically allow them to elect to retain title to inventions they make.

Title of Contract or Proposal _____

Number of Contract or Proposal _____

(Name and Address of Petitioner)

does hereby petition the Secretary of the U.S. Department of Energy for waiver of patent rights of the United States of America to any invention(s) that may be 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 204, as well as other provisions that may be required in accordance with 10 C.F.R. 784.4(n), regardless of whether the Petitioner is a small business or nonprofit organization.

In support of this petition, answers to the following questions are submitted as an appendix hereto:

1. Identify the specific rights which the Petitioner desires to obtain (field of use, geographic area, exclusivity, term, etc.)
2. Give a brief description of the scope of work of the above contract. Specifically, describe the source of funding and the name of the cognizant DOE program director.
3. What is the dollar amount and period of performance of this contract?
4. To what extent is the work to be performed under the above identified contract useful in the production or utilization of special nuclear material or atomic energy?
5. Briefly describe Petitioner's technical competence in the field of technology covered by the scope of work of this contract in terms of prior experience, know-how and patent position. (Attach exhibits to substantiate Petitioner's 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 covered by the scope of work of the above contract. (Discuss in terms of selling goods or providing services in such field outside of sales to the U.S. Government. Identify the proportion of sales to the Government. Attach exhibits to substantiate your commercial position, e.g., sales brochures, etc. If these are voluminous, a representative sample is sufficient.)
7. What is the financial and technological investment that has been made by Petitioner directly related to the work to be performed under this contract?
8. To what extent will the Petitioner make a substantial investment of financial resources or technology which will directly assist and promote further development of the work to be performed under the contract?
9. Why will the grant of the above-requested waiver more effectively promote the development and commercial utilization of any invention made under this contract? Specifically, identify any potential licensees or joint ventures interested in further development and commercialization of the work to be performed under the contract. If such commercialization is to be performed by licensee, summarize the licensee's plans and intentions to effect such commercialization.
10. What will be the effect on competition and market concentration if the above-requested waiver is granted? Describe any competitive technologies or other factors which would reduce any anticompetitive 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 conclusions.
11. Under what other contracts has the Petitioner worked or what other contracts 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?
12. Is the Petitioner aware of any governmental regulations which require or which might require the use of the contract subject matter by the general public or a segment thereof? (If yes, explain.)
13. Does the work under the contract require an exploration into the fields which concern 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.)
14. If the work is 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 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; and
 - (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.

15. (a) Have you within the past 6 months assigned or conveyed an interest to a party other than DOE in any patent or patent application covering a subject of the work to be performed under the contract or entered into negotiations concerning such assignment or conveyance?
- (b) Do you plan to do so prior to contracting? (If yes, give details.)
16. If this Petition is not being submitted within the time frames specified in 10 C.F.R. 784.8(b), and if the period for submission has not already been extended by the Patent Counsel for good cause shown in writing, provide a statement of the reasons why the Petition was not timely filed.
17. State below the name, address, and telephone number of the person to whom correspondence is to be directed.
18. Is the Petitioner a small business or nonprofit organization not eligible to elect title to subject inventions under the provisions of 35 U.S.C. 200 *et seq.*?
19. Give any other facts that 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 subsections (c) and (d) of 42 U.S.C. 5908.

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

Respectfully submitted,

(Signature)

Printed name and title of authorized representative

Date submitted to DOE

(An executed original of this document must be submitted to DOE or its Contractor.)