

UNITED STATES DEPARTMENT OF ENERGY

**PETITION FOR WAIVER OF RIGHTS TO
AN IDENTIFIED INVENTION UNDER 10 C.F.R. PART 784**

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

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

Notice: If you need help in completing this form, contact the DOE Patent Counsel assisting the activity that issued 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, they may elect to retain title to subject inventions.

Title of Contract: _____

Contract No.: _____

Title of
Subject Invention: _____

Petitioner's Identification No.: _____

(Name and Address of 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 America 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 204, as well as other provisions that may be required in accordance with 10 C.F.R. 784.5(m), 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 in the Subject Invention. (Field of use, geographic area, exclusivity, term, etc.)

2 Give a brief description of the Subject Invention. Specify any known or potential weapons fields of use, or weapons applications, or naval nuclear propulsion use or application, or use in the production or utilization of special nuclear material or atomic energy 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 the 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. (Laboratory operators furnish B&R code, if available).

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 Governmental funding anticipated in the development of the invention? Describe any continuing Government funding of the development of the invention (including investigation of materials 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 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 field 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 is sufficient.)

7 What is the financial and technological investment that has been made by the Petitioner with regard to the field of technology in which the 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 which will directly assist the further development and promote the commercial utilization of the Subject invention? Summarize Petitioner's plans, intentions and ability in developing the Subject Invention to a point of commercialization. This should include a description of the technical steps required, funds necessary therefor and associated time periods necessary to develop the invention to the point of readiness for commercialization, and a statement by 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 commercial utilization of the Subject Invention? Specifically, identify any potential licensees or joint ventures interested in further development of the invention to commercialization. If the invention will be commercialized by a licensee, summarize the licensee's plans and intentions to develop the invention to a point of 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 or which deal with the field of technology in which the Subject Invention lies or to which it relates?

12 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?

13 If this request for waiver has not been submitted to the Patent Counsel within the time frames specified in 10 C.F.R. 784.8 (c), and if the period for submission has not already been extended by the Patent Counsel for good cause in writing, provide a statement of the reasons why the petition was not timely filed.

14 Is the Petitioner aware of any governmental regulations which require or which might require the use of the subject matter of the Subject Invention by the general public or a segment thereof? (If yes, explain.)

15 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.

16. If the 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; 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.

17. State below the name, address and telephone number of the person to whom correspondence is to be directed.

18. If a patent application has not yet been filed, provide information on any statutory bar to the patenting of the invention under 35 U.S.C. 102, or confirm that no bar is known to exist.

19. Where the Petitioner is the inventor, provide written authorization from the applicable contractor or subcontractor permitting the inventor to request a waiver.

20. 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.*?

21. Give any other facts 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 subsections (c) and (e) 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 will rely on them in reaching the waiver determination.

Respectfully submitted,

(Signature) (Name and title of authorized representative)

Date submitted: _____

Public reporting burden for this collection of information is estimated to average 7.7 hours per response, including the time for reviewing instructions, searching existing data sources, gathering and maintaining the data needed, and completing and reviewing the collection of information. Send comments regarding this burden estimate or any other aspect of this collection of information, including suggestions for reducing this burden, to Office of the Chief Information Officer, Records Management Division, IM-23, Paperwork Reduction Project OMB control number 1910-0800, U.S. Department of Energy, 1000 Independence Ave SW, Washington, DC, 20585-1290; and to the Office of Management and Budget (OMB), OIRA, Paperwork Reduction Project OMB control number 1910-0800, Washington, DC 20503.