

FORM PTO-1619A
Expires 06/30/99
OMB 0651-0027

01-09-2002

U.S. Department of Commerce
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Name (line 1) Westinghouse Savannah River Company

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U.S. Department of Commerce
Patent and Trademark Office

PATENT

Correspondent Name and Address

Area Code and Telephone Number 864 271 1592

Name J. Bennett Mullinax

Address (line 1) Dority & Manning, PA

Address (line 2) P O Box 1449

Address (line 3) Greenville, SC 29602

Address (line 4)

Pages

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Application Number(s) or Patent Number(s)

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Enter either the Patent Application Number or the Patent Number (DO NOT ENTER BOTH numbers for the same property).

Patent Application Number(s)

5,411,928

Patent Number(s)

If this document is being filed together with a new Patent Application, enter the date the patent application was
signed by the first named executing inventor.

Month Day Year

Patent Cooperation Treaty (PCT)

Enter PCT application number
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1

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Fee Amount for Properties Listed (37 CFR 3.41): \$ 40.00

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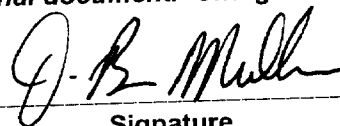
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J. Bennett Mullinax

Name of Person Signing



Signature

10/24/2001

Date

STATEMENT OF CONSIDERATIONS

REQUEST BY THE WESTINGHOUSE SAVANNAH RIVER COMPANY FOR THE WAIVER OF DOMESTIC AND FOREIGN RIGHTS TO AN IDENTIFIED INVENTION ENTITLED "COMPOSITION FOR ABSORBING HYDROGEN" DEVELOPED UNDER DOE CONTRACT NO. DE-AC09-89-SR18035; INVENTORS: LEUNG HEUNG AND GEORGE WICKS; DOE INVENTION DISCLOSURE NO. S-76,156 DOE WAIVER NO. (WI) 98-082

The Petitioner, Westinghouse Savannah River Company, has requested a waiver of the Government's undivided interest in the domestic and foreign patent rights in an invention entitled "Composition for Absorbing Hydrogen." The subject invention was conceived by Leung Heung and George Wicks, employees of Westinghouse Savannah River Company under Petitioner's contract for the operation of the Savannah River Site (SRS), a government-owned, contractor-operated (GOCO) facility. U.S. Patent 5,411,928 was issued on 5/2/95 for the subject invention (S-76,156). At the request of DOE, the Petitioner prepared and prosecuted the patent application at the expense of the Petitioner; however, DOE paid all Patent and Trademark Office fees.

The subject invention relates to the field of material technology and is a method to combine the properties of a catalyst with a porous glass to produce a matrix with an improved ability to store and recover hydrogen.

The source of funding, under which the invention was made, is Budget & Reporting code DP0401291. The total expenditure at SRS on research in the area of technology of the invention was approximately \$300,000 over a two year period.

The invention has been reviewed for Export Control and Classification, and has been determined to be unclassified and not controlled or sensitive under Section 148 of the Atomic Energy Act. Furthermore, the invention does not apply to the Naval Nuclear Propulsion Program or to the nuclear weapons programs or other nuclear or atomic energy defense activities of DOE.

The Petitioner as the management and operating (M&O) Contractor for the Savannah River Site, has technical competence in the areas of research and development. The Petitioner has an approved Technology Transfer Program under which the technology resulting from research and development under its M&O Contract may be licensed for commercial development. Petitioner has not only the authority; but, importantly, the responsibility to transfer technology arising from its M&O Contract. The Petitioner does not itself engage in commercial development of the inventions that result from its research; however, under its technology transfer program, the Petitioner, consistent with Fairness of Opportunity and avoidance of Conflicts of Interest, seeks out industrial concerns that will commit the time and investment of money to bring the invention to the point of commercial practicality and commercialize such inventions for the benefit of the public. The Petitioner has substantial experience and has had very substantial success in obtaining licensees for inventions made at SRS.

The Petitioner has agreed to comply with the clause governing technology transfer activities under Contract No. DE-AC09-96-SR18500 and the applicable law and regulations.

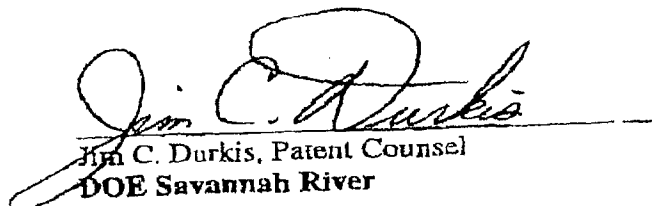
A substantial investment of time and money will be required by any licensee to achieve commercialization of the invention. There are a number of technical issues to be resolved by potential licensees before the invention can be made available to the commercial market, and it is unlikely that an industrial concern would be willing to commit the substantial time and sums of money required in the absence of patent protection and an appropriate license to practice the invention. Petitioner will expend such sums as may be required to maintain the necessary patent protection and provide incentive for commercial development of the invention. Granting the requested waiver is necessary if the Petitioner is to consummate an agreement and attract venture capital for commercial development of the invention. It is further noted that DOE has had title to this invention for several years and has been unsuccessful in licensing the technology despite widely advertising it as available for such.

The Petitioner has a portfolio of intellectual property in the field of material science technology. Recent developments in such technology have increased the importance of this invention to the Petitioner's patent portfolio. The addition of this invention to the Petitioner's portfolio would promote the full commercialization of this invention and also enhance the commercialization opportunities of Petitioner's related material science technology.

The timeliness of the Petition for Waiver is excused as Petitioner, at the time of the invention, did not have a technology transfer clause in its management and operating contract; did not have a technology transfer mission; and did not have a DOE-approved technology transfer program.

Granting the waiver will not have an undue effect on competition or market concentration. The Petitioner has an approved technology transfer program, which will allow for commercialization of the invention. Petitioner will initially attempt to license the technology to several firms, however, it may well be found necessary to grant an exclusive license in order to bring this invention to commercial practicality and benefit the public. It does not appear that grant of the waiver will result in an increase of market concentration or decrease in competition.

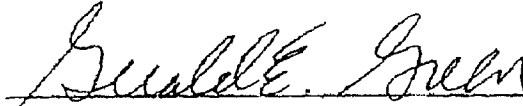
Upon evaluation of the Waiver Petition in view of the objectives and considerations set forth in 10 CFR 784, all of which have been considered, it is recommended that the requested waiver be granted.



Jim C. Durkis, Patent Counsel
DOE Savannah River

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 general public will best be served by a waiver of patent rights of the scope described above and, therefore, the waiver is granted.


CONCURRENCE:


Gerald E. Green, Director
Office of Defense Programs Laboratories and Reimbursable
Programs (DP-26)

Date:

8/27/01

APPROVAL:


Paul A. Gottlieb
Assistant General Counsel
for Technology Transfer and
Intellectual Property (GC-62)

Date:

8.27.01

DOE Headquarters Program Manager: Maurice J. Katz