STATEMENT OF CONSIDERATIONS

REQUEST BY OSHKOSH TRUCK CORPORATION FOR AN ADVANCE WAIVER OF PATENT RIGHTS UNDER NREL SUBCONTRACT NO. ZCL-3-32060-03 UNDER CONTRACT NO. DE-AC36-98GO10337; W(A)-04-007; CH-1178

The Petitioner, Oshkosh Truck Corporation (OTC), has requested a waiver of domestic and foreign patent rights for all subject inventions made by its employees under the above-identified subcontract entitled "Advanced Heavy Hybrid Propulsion Systems for Increased Fuel Efficiency and Decreased Emissions". OTC is leading a teaming arrangement including Rockwell Automation, Inc. (Rockwell), and the National Renewable Energy Laboratory (NREL) to develop heavy hybrid propulsion systems. Rockwell has petitioned separately for a waiver of patent rights for all subject inventions its employees may make under Rockwell's lower tier subcontract with OTC.

Referring to item 2 of OTC's waiver petition, the purpose of this subcontract encompasses the development and demonstration of advanced, next generation heavy hybrid truck and bus propulsion technologies and hybrid vehicle systems. This two phase technology development program is intended to design, develop, characterize and show the feasibility of energy and fuel saving heavy vehicle hybrid propulsion technologies.

The work under this subcontract is expected to take place over a period of three years at a total cost of $9,025,822. Of that amount, OTC is obligated to cost share $4,512,911, or 50 percent of the total cost of the subcontract.

Referring to items 5-9 of OTC's waiver petition, OTC is a leading designer, manufacturer and marketer of a wide range of specialty trucks and truck bodies, including concrete mixers, refuse bodies, fire and emergency vehicles and tactical military vehicles. OTC is a technology leader in its field and more specifically, within the heavy duty hybrid vehicle field. This, coupled with OTC's cost sharing, clearly demonstrates the likelihood that OTC will continue development and commercialization of the results of this subcontract.

This advanced waiver of the Government's rights in inventions is subject to the usual advance patent waiver and background data licensing provisions, and the government license, march-in rights, and preference for U.S. industry provisions set out in 35 U.S.C. 202-204. The advanced patent waiver also includes the attached U.S. Competitiveness clause (paragraph t) which requires products embodying any waived invention or produced through the use of any waived inventions be manufactured substantially in the United States unless the participant can show to the satisfaction of DOE that it is not commercially feasible to do so. OTC further agrees to make the above condition binding on any assignee, licensee or other entity acquiring rights to any waived invention, including subsequent assignees or licensees. Should OTC 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 the waived invention is suspended until approved in writing by DOE.

Referring to item 10 of the waiver petition, granting this waiver is not anticipated to have any adverse impact on competition. There are currently numerous other competitive approaches available to competitors to assure the timely development of the various hybrid vehicle technologies.

Considering the foregoing, it is believed that granting this waiver will provide Petitioner with the necessary incentive to invest its resources in the commercialization of the results of the agreement in a fashion which will make the technology available to the public in the shortest practicable time. Therefore, upon evaluation of the waiver petition and in view of the objectives and considerations set forth in 10 CFR part 784, all of which have been considered, it is recommended that the requested waiver be granted.

Thomas G. Anderson
Assistant Chief Counsel
Intellectual Property Law Division

Date: 1-9-04

Based upon the foregoing Statement of Considerations and representations n the attached waiver petition, it is determined that the interest 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. This waiver will not apply to any modification or extension of the cooperative agreement, where through such modification or extension, the purpose, scope or cost of the cooperative agreement has been substantially altered.

CONCURRENCE:

Edward J. Wall
Offce of FreedomCAR
and Vehicle Technologies
EE-2G

Date: 3/25/04

APPROVAL:

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

Date: 3/31/04