

PETITION FOR ADVANCE WAIVER OF PATENT RIGHTS (Aug 2002)

Offerors have the right under 10 CFR 784 to request that DOE waive all or any part of the rights of the United States under any invention that may be conceived or first actually reduced to practice in the course of or under the subcontract resulting from this solicitation.

You may request waivers anytime before award of the subcontract, within 30 days thereafter, or within a longer period that may be authorized by the DOE Patent Counsel.

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 Operations 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 (nonprofit or small business) 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.)
 - (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.
2. (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.)
3. 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.
4. State below the name, address, and telephone number of the person to whom correspondence is to be directed.
5. 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.?
6. 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.)