Virginia Polytechnic Institute and State University
Intellectual Property Committee Meeting
February 15, 12:00-1:00 p.m.
210 Burruss Hall – President's Boardroom

FULL COMMITTEE

The Intellectual Property Committee met February 15, 2012.

The following members were present: Bill Knocke (Chair), Robert Broadwater, Laurie Coble, Robert Harvey, Kay Heidbreder, John Jelesko, Barbara Lockee, X.J. Meng, Joe Merola, Ken Miller, Steve Sheetz, Steve Tatum. Shelly Key recorded the minutes.

Invited guest members present: Steve Capaldo, Stephen Edwards, Mike Miller, and Erica Inge (Barbara Lockee's graduate student).

Those members/guests not in attendance: Mark Coburn, Kristen Mittelman, and Robert Walters.

Call to Order

Bill Knocke called the meeting to order at 12:05 p.m. Dr. Knocke introduced Laurie Coble who is a new member of the IPC, replacing Cindy Wilkinson as the A/P faculty representative.

Approval of Minutes

On a motion made by Steve Sheetz and seconded by Joe Merola, the minutes for the November 16, 2011 meeting were unanimously approved.

New Business – Subcommittee reports

Policy 13000 Subcommittee:

Joe Merola (Chair) distributed a handout (attached) outlining the four recommendations of the subcommittee. A summary of the subsequent discussion is as follows:

1) The attached handout contains the proposed change of language in Policy 13000 that will hopefully avoid any future issues such as what was encountered in the Stanford v. Roche situation. Basically the proposed change points out that the IP rests specifically with the university.

2) Bill Knocke shared information he received from Eastman Chemical regarding their interest in a new IP arrangement that has been put in place by the

University of Minnesota. The university is taking payment upfront (thought to be 10% of the total cost of a research contract) and turning over all IP associated with a specific contract back to the industrial sponsor. Kay Heidbreder stated that there would be tax implications not only for the 10%, but also for the whole value of the research. The committee agreed that as updates to Policy 13000 are discussed some of the issues on where industry wants us to go in order to be viewed as user-friendly should be considered. Kay further added that Virginia Tech should reserve the maximum flexibility because the reality is that on each research grant or contract each faculty member has a little different interest in the ultimate fate of any IP generated

3) Knowledge of Policy - A specific acknowledgment of Policy 13000 should be required in faculty and staff Terms of Offer (TFO) documents or employment letters rather than the blanket "refer to all policies." Steve Capaldo reported that a number of universities are moving in the direction of having an additional IP agreement as part of the employment process. Laurie Coble pointed out that we need to reach people broadly and since not all research comes through the Office of Sponsored Programs (OSP), putting it solely on an OSP form will not be sufficient.

4) In the area of students and other non-paid individuals, it was deemed to be more of an education issue. Tomalei Vest, University Director of Undergraduate Research, is willing to work on an educational piece about intellectual property. It was suggested that in the educational training we should definitely focus on undergraduate students directly. The faculty training should remind them that they are working with undergraduate students and this issue needs to be addressed. Joe Merola will work with Tomalei Vest on creating a web-based education/acknowledgement form.

5) Use of University Resources - The subcommittee is recommending lowering the threshold from $10,000 to $5,000.

Bill Knocke stated that the goal will be to meet again in April to look at a final policy document and then hopefully be ready to move into broader consideration of the draft with relevant commissions and key entities in the fall. Steve Capaldo agreed to get more information/details on what the University of Minnesota is doing.

Education Subcommittee:

Barbara Lockee (Chair) reported that her subcommittee is currently developing the education module. Barbara introduced Erica Inge, a graduate student in Curriculum and Instruction, who is the lead on the project. Barbara also inquired as to the timeline for the Policy 13000 revision and Bill Knocke stated that he envisioned the policy moving through University governance sometime in the fall and then going before the Board of Visitors possibly in March 2013.

The project is currently in the design phase and it was suggested that the subcommittee could demo some aspects of the project at the next IPC meeting in April.

Next Meeting Date

The IP committee will not meet on the next regularly scheduled meeting date of March 21, 2012 unless an issue comes up requiring the committee to meet. The next meeting will be held April 18, 2012.

Adjournment

There being no further new business, the meeting adjourned at 1:10 p.m.

Respectfully Submitted,

Shelly Key
Administrative Support to the IP Committee

Recommendations of IPC Subcommittee on Policy 13000

Issue 1. Language of Policy section 2.4 A Ownership of IPs

Policy 13000 Current Language: In the second group, the strong presumption of ownership is to the university (with the originator having a right to share in the benefits derived therefrom). Thus unless there is convincing and explicit evidence that the IP was developed without the use of university resources and/or facilities (which may include but is not limited to any of the following: use of equipment, lab or office space, university time of originator and/or personnel under his/her control, funds supplied by the university and/or funds originating from sponsored research projects and/or donations to university/affiliated companies, etc.), ownership of the IP rests with the university and the originator(s) are obliged to sign the appropriate legal assignment documents upon request.

Policy 13000 Proposed Draft: In the second group, as a condition of employment or other involvement in research and/or related activities using University Resources, the ownership is to the university (with the originator having a right to share in the benefits derived therefrom in accord with university sharing guidelines). Thus unless there is convincing and explicit evidence that the IP was developed without the use of university resources and/or facilities (which may include but is not limited to any of the following: use of equipment, lab or office space, university time of originator and/or personnel under his/her control, funds supplied by the university and/or funds originating from sponsored research projects and/or donations to university/affiliated companies, etc.), ownership of the IP rests with the university and the originator(s) do hereby assign ownership, right, title, and interest in any IP, discovery, or invention the university.

University Resource is defined as research and related activities by any person a) which are related in any way to duties or responsibilities for which he has been compensated either by or through the University or b) for which equipment or facilities owned, operated, or controlled by the University or services provided by the university are used.

Issue 2. Knowledge of Policy

A specific acknowledgment of Policy 13000 should be required in terms of offer or other circumstances to be discussed.

Intellectual Property Agreement and Assignment
As a condition of employment or other involvement in research and/or related activities using University facilities and resources ("University Activities"), I acknowledge my acceptance of Virginia Tech Policy No. 13000, Policy on Intellectual Property and do hereby assign to Virginia Polytechnic Institute and State University all of my ownership, right, title, and interest in any discovery or invention that is the product of my University Activities, including without limitation any patent and other intellectual property rights, whether before or hereinafter accrued, arising under U.S. or any other law. I further agree to fulfill in the future my obligations of disclosure and cooperation in the

intellectual property protection of any such discovery or invention that is the product of University Activities. I am now under no consulting or other obligations to any third party, organizations, or corporation in respect to rights in intellectual property which are, or could be reasonably construed to be, in conflict with this agreement. I will not enter into any agreement creating intellectual property obligations in conflict with this agreement or University policy.

Issue 3. Students/other non-paid individuals involved in IP generation

Recommendation: In consultation with Tomalei Vest, University Director of Undergraduate Research, this was deemed to be more of an issue where education is required. She has offered that her office could coordinate that education. In addition, the new wording of parts of the policy is clearer on University resources. Form will be devloped

Issue ~~5~~ 4. $10,000 threshold for use of university resources

Recommendation: The threshold will be lowered to $5,000 to match the lower threshold required by NIH to trigger a conflict of interest. It was decided that some threshold number was warranted to avoid quite a number of issues of assuming university ownership for insignificant uses of resources or resources to which the student may be entitled normally (e.g. library resources.)