

**RESOLUTION FOR REVISION OF UNIVERSITY POLICY 13000:  
POLICY ON INTELLECTUAL PROPERTIES**

**WHEREAS**, scholarly activities in a university setting create Intellectual Properties (IPs) and the university's mission includes the protection of the ownership rights of both the individual and the university; and

**WHEREAS**, the existing policy does not reflect the current operating procedures of the Intellectual Properties Committee (IPC) nor address Virginia Tech Intellectual Properties (VTIP) as the primary review mechanism for IP disclosures; and

**WHEREAS**, concerns exist regarding current policy language in light of the U.S. Supreme Court decision of *Stanford v. Roche*; and

**WHEREAS**, concerns that ambiguity exists associated with IP generated by unfunded students, student membership on the IPC and "Commissioned Works"; and

**WHEREAS**, the proposed revised policy has been endorsed by the Commission on Faculty Affairs, Commission on Undergraduate Studies and Policies, Faculty Senate, Commission on Administrative & Professional Faculty Affairs, Commission on Graduate Studies and Policies, and Staff Senate;

**NOW, THEREFORE, BE IT RSOLVED**, that Policy 13000 be revised to reflect Code of Virginia requirements of state employees regarding disclosure, to provide language about student IP, reflect current operating procedures of the IPC, and address "Commissioned Works".

**RECOMMENDATION:**

That the attached revision to Policy 13000 on Intellectual Properties be approved, effective immediately.

June 3, 2013

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**Subject: Policy on Intellectual Property**

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## **1. Purpose**

Publicly (state) supported universities have the multiple missions of teaching, research, support of the public interest and fostering of economic development of the area/state in which they are located.

Scholarly activities in a university setting create Intellectual Properties (IPs). IPs include research papers, books, software programs, new inventions, journal articles, etc.

The university's mission includes dissemination of IPs in the most efficient and effective manner possible. The identification and optimization of opportunities for the industrial/commercial utilization of some IPs is also part of this mission, as is the protection of the ownership rights of both the individuals and the university.

While many IPs are best disseminated by publication and placing in the public domain, there are a significant number that are most effectively handled by protection under the IP laws (i.e., patenting and copyright) and licensing (or other transfer) to private sector entities, with attendant financial considerations.

This Policy is designed to establish the rationale and the mechanisms to:

1. Establish ownership criteria and resolve ownership questions if such arise.
2. Define the responsibilities, rights and privileges of those involved.
3. Develop basic guidelines for the administration of the IP Policy.

## **2. Policy**

### **2.1 Organization**

The Intellectual Properties Committee membership shall be as stated in the By-Laws of University Council.

### **2.2 Authority and Responsibility of the Committee**

The IPC shall have the following authority and responsibility with respect to Intellectual Property:

- A. To develop and recommend university policy and policy changes dealing with IP to the Commission on Research.
- B. To review all disputed invention disclosures submitted by Virginia Tech faculty, staff and/or students for:

1. Complete and appropriate disclosure of individuals involved in the invention and/or creation of the IP.
  2. Confirm the determination of IP ownership by university, originating individuals, research sponsors and/or governmental agencies.
  3. Examination and recommendation to the Provost for disposition of (1) and/or (2) above in those cases where a dispute remains.
  4. Coordination of evaluation and recommendation to Virginia Tech Intellectual Properties, Inc. (VTIP) of technical merit, economic potential and protection/marketing priority as needed.
- C. To make recommendations to the Provost for the sharing of royalties between the university and the authors or inventor(s) of the IPs owned by the university.
- D. To promulgate such guidelines and procedures as may be necessary for the implementation of this Policy.

Much of the work of the IPC as defined above will be addressed through the normal business of the full committee. However, it may be prudent in the review of certain disputed invention disclosures to have a subgroup of the entire IPC to more fully consider all necessary aspects of the dispute. This shall be the role of the Ownership Review Group, which will be composed of three at-large members of the IPC (selected by the IPC Chair) and be chaired by the IPC Chair. This group shall meet as needed with the following agenda:

1. Review all disclosures submitted that have ownership in dispute.
2. Confirm university ownership as necessary for those disclosures in which originator(s) have indicated Virginia Tech ownership.
3. Review disputes involving sponsor ownership/rights.
4. Review, discuss and reach preliminary conclusions on ownership disputes and forward recommendations to the full IPC.

## **2.3 Policy Guidelines**

This section outlines the criteria to be used by the IPC and its working groups in their deliberations, findings and recommendations. To the extent that individual questions are not specifically addressed, these guidelines will, at the least, give a general indication of intent and philosophy and allow proper interpretation.

### **A. Ownership of IP**

For purposes of this policy creations are divided into two groups:

1. The traditional results of academic scholarship, i.e. textbooks, literary works, artistic creations and artifacts.
2. The novel results of research such as products, processes, machines, software, biological technology, etc.

Intellectual properties in the first (traditional) group are considered to make their full contribution to the university's benefit by their creation and by continued use by the university in teaching, further development, and enhancement of the university's academic stature; the presumption of ownership is to the author(s). Thus, unless there is explicit evidence that the work was specifically commissioned by the university, the IP rights remain with the author(s) and the university rights are limited to free (no cost) use in teaching, research, extension, etc. in perpetuity.

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 to the university.

Within the above general guidelines, the following situations are more specifically defined:

1. **Sponsor Rights:** In the case in which an IP is generated as a result of research funded by a private sector company under a sponsored research project, the IP rights of the sponsor as defined in the applicable clauses ("Patents & Copyrights," "Intellectual Properties," "Inventions," etc.) of the Sponsored Research Agreement (as approved by the Vice President for Research or their designee and signed by an authorized officer of the university) shall take precedence over the rights of the university/inventor(s). Any residual rights not accruing to the sponsor shall be as defined in the general guidelines above.
2. **Federal Agency Rights:** Research projects sponsored by an agency of the federal government have statutory IP rights that are limited (in almost all cases) to a non-exclusive non-transferrable royalty-free license to any patent generated by the research, provided the inventor(s)/university advise the agency in a timely manner of their intent to retain their rights and provide for legal protection (i.e. patenting). It is the responsibility of the researcher to advise the agency of the creation of the IP and (with the assistance of the university IP manager, VTIP) advise of the protection steps being undertaken. The residual rights not belonging to the sponsoring agency shall be as defined in the general guidelines above.
3. In the event the following condition(s) apply, students, visiting scholars, and volunteers do hereby assign any IP rights to the University when:
  - (a) working on a research project funded by Virginia Tech or an entity outside of Virginia Tech sponsoring the research through Virginia Tech from which the IP was created; or,
  - (b) employed or receiving payment from Virginia Tech related to a project from which the IP was created; or,
  - (c) university resources not typically available to the public are used in the creation of the IP.
4. **Joint Inventorship:** For IPs generated by a team of inventors in which one or more are not members of the faculty/staff/supported students, each inventor is usually entitled (by law) to shared ownership of the entire right. The university's claim to the shares of university-associated inventors will be as outlined in these guidelines. Ownership of outside inventors will vest in them or their assignees.
5. **Special Situations:** In the event that an IP ownership situation arises which is not addressed in either the general or specific guidelines outlined above, the IPC shall make a recommendation based on the spirit of the guidelines. A record of the rationale used to arrive at their recommendation shall be kept and used as a precedent for the handling of future special situations if applicable.
6. **Commissioned Works:** There are times when the university will choose to enter into a contractual arrangement to commission a specific work or undertaking. The university, as the commissioning party, may be expected to maintain certain rights of third parties. These rights are negotiable on a case by case basis, but generally the university expects, at a minimum:
  - a) Exclusive right to give premiere performances of the commissioned work; and,
  - b) Exclusive performance rights for a limited period of time; and,

- c) Exclusive right to give premieres in other venues; and,
- d) Right to make the first commercial recording of the work; and,
- e) The right to be credited as the commissioner of the work in published editions, recordings, and programs for all future performances; and,
- f) The nonexclusive right to use the commissioned work, without cost, in teaching, research, outreach, etc., in perpetuity.

## B. Obligation to Disclose

While it is recognized that faculty and staff mission and expertise is concentrated and directed in areas other than commercial utilization, originators of new technology shall submit a disclosure when any IP is developed. Timely (i.e., before publication or other enabling non-confidential disclosure) submission of a disclosure to VTIP may also be critical to the value of the IP.

To the extent (and as soon as) the researcher/inventor/creator obtains research results that may be considered an IP and recognizes that they may have potential for commercial utilization there exists an obligation to bring these results to the attention of VTIP in the form of a disclosure.

If, in the absence of a timely disclosure, commercial utilization of a technology takes place with the direct or indirect involvement of the originator(s) but without involvement by the university it will be deemed that the originator(s) have not fulfilled their obligation to disclose and the university may:

1. Take whatever legal and/or business action is necessary to protect its rights and rightful share of financial benefits and ownership.
2. Deny to originator(s) any share of revenues which would otherwise accrue to them under this policy.

## C. Revenue Sharing

Revenues generated by the successful commercialization of IPs owned by the university (whether or not protected by patent and/or copyright) shall be shared equally between the university and the originator(s) of the IP, subject to the conditions and exceptions outlined below.

1. Revenues subject to sharing include royalties, licensing fees, incentives, etc. received by the assignee licensor organization, less the costs/expenses described below. Specifically excepted from sharing are payments received and designated for specific purposes such as sponsored or unrestricted research grants, services to the university, research equipment and/or materials, consulting fees to researchers, etc. These payments will go directly to the designated entity and purpose.
2. Also excepted from sharing are revenues resulting from:
  - a. Tasks and/or activities specifically and explicitly assigned to employees by an administrative unit of the university, or
  - b. Activities and/or tasks clearly defined in the written, university approved, policy of an administrative unit of the university.

Such revenues, flowing through the university assignee organization, will accrue to the originating administrative unit of the university net of development costs.

3. Expenses to be subtracted from gross revenue before sharing shall be limited to documented direct and indirect costs for protection (patenting), marketing and development of the IP. Specifically excluded are costs incurred in the generation of the IP (i.e. research costs). Development costs shall include (but not be limited to) payments made to (or retained by) non-affiliated organizations (e.g. Research Corp. Technologies, CIT, etc.) involved in the process of commercializing the IPs owned by the university.
4. Non-cash compensation for rights to an IP may be accepted but only with the informed consent of the originator(s) of the IP. The share of net revenue not paid to the originator(s) (50 percent) shall be applied as follows:
  - a. A portion equivalent to at least 10 percent of total net revenue may be distributed to the originator(s)' primary unit(s) (e.g. Departments, Centers, etc.).
  - b. The remainder to the university assignee organization (VTIP).

#### **D. Management Responsibility**

Virginia Tech Intellectual Properties, Inc. (VTIP), a non-profit corporation affiliated with the university, has been established and charged with the mission of protecting and utilizing IPs for the benefit of the university.

All IPs assigned to the university shall flow to VTIP by assignment for operational management. The IPC should make appropriate inputs and recommendations as to disposition and priority of individual IPs. Originator(s)' inputs/suggestions to VTIP are also appreciated.

#### **E. Right Of Appeal**

The originator(s) of an IP covered by this Policy shall have the right to appeal application of the policy to the IPC.

The IPC will formulate recommendations relative to each such appeal, and will forward both the appeal and its recommendations to the Office of the Senior Vice President and Provost in a timely manner. The Provost will determine the university's response to each appeal, and will so notify the originator(s) and the IPC.

If the originator(s) disagree with the IPC recommendation regarding ownership, a written appeal to the Provost must be filed within (30) thirty days of receipt of notification of the IPC recommendation. This appeal should contain an exposition of the facts as seen by the originator(s), any information they deem pertinent to the case, as well as any applicable citations of policy guidelines. A copy of the appeal document should be sent to the IPC via its Chair.

Upon receipt of the appeal, the Provost may elect to consult with any and all concerned prior to reaching a decision in the case.

In the event that any member of the university (faculty, staff or student) perceives and/or becomes aware of any irregularity in the inventorship/authorship of an IP disclosed (or about to be disclosed) to VTIP or the IPC he/she should bring it to the attention of the other inventors/authors involved and/or the Department Chair(s) (or the director or unit leader in situations outside the traditional academic departments) concerned in an attempt to resolve the conflict equitably and amicably. Failing such resolution, the facts of the cases should be submitted in writing within (30) thirty days to the Vice President for Research (with copy to the Chair of the IPC) with a request for review by the Ownership Review Group of the IPC.

Upon receipt of such a request, the Ownership Review Group shall review the facts of the case, convene a hearing for all concerned parties, reach a conclusion and present a synopsis of the case and a recommendation to the full IPC who will, in turn, make a recommendation to the Provost.

### **3. Procedures**

### **4. Definitions**

### **5. References**

[Policy Memorandum No. 73, "Policy on Intellectual Properties,"](#) issued March 4, 1987.

[Policy Memorandum No. 121, "Policy on Intellectual Properties,"](#) issued December 9, 1991.

### **6. Approval and Revisions**

- Revision 0

Approved by University Council, November 17, 1986.

Approved by the President, November 17, 1986.

Approved by Board of Visitors, December 5, 1986.

- Revision 1

Approved by University Council, December 2, 1991.

Approved by the President, December 2, 1991.

- Revision 2

August 31, 1999: Revised membership titles to reflect changes in titles, responsibilities, and University Council By-laws.

- Revision 3

April 15, 2008: Revised membership titles to reflect changes in titles and responsibilities.

- Revision 4