

**Virginia Polytechnic Institute and State University
Intellectual Properties Committee
August 20, 2008**

FULL COMMITTEE

The Intellectual Properties Committee met August 20, 2008.

The following members were present: Dr. Tom Inzana, Ms. Kay Heidebreder, Dr. Steve Sheetz, Mr. Ken Miller, Dr. Elizabeth Grabau. Invited guests present were Ms. Carol Roberson, Mr. John Geikler, Ms. Denisa Olteanu, Mr. Steve Capaldo. Shelly Key recorded the minutes.

Those members not in attendance were: Dr. Stephen Boyle, Dr. R.J. Harvey, Dr. Robert Broadwater, Dr. Robert Walters, Ms. Cindy Wilkinson, Dr. Barbara Lockee, Ms. Christa Thomas.

Call to Order

Dr. Inzana called the meeting to order at 12:05 p.m.

Dr. Inzana called for a motion to approve the minutes from the last meeting held on March 19, 2008. The motion was made, seconded, and unanimously carried.

One issue that needs to be addressed concerns intellectual property rights for people who are converting from classified positions to AP faculty. Guidance is needed as to whether, in the furtherance of their job duties, royalty rights to an invention at Virginia Tech are allowed for classified employees. Dr. Inzana referenced the IP Policy under Revenue Sharing, where it states that "Tasks and/or activities specifically and explicitly assigned to employees by an administrative unit of the university, or activities and or tasks clearly defined in the written, university approved, policy of an administrative unit of the university" are excepted from sharing in revenues. The question raised is if one develops this property on their own initiative and it benefits their job and many others', are they eligible for royalty sharing?

Carol Roberson provided background information on this issue. An IT person in the Research Office along with others has developed a limited submission software program to handle limited submissions electronically within universities. The IT person is a classified employee and the others involved are AP faculty. Since the IT employee is a classified employee and this was an assigned task, he would be the only one not entitled to share in revenues. His supervisor feels that this potentially could create future problems because we anticipate developing a lot more software programs that other sponsored research offices will want to use and license. There

is some potential for commercial use. His concern is that his employee, who was the one who did the majority of the work on this, will not be able to share in the revenues.

John Geikler (VTIP) stated that from an intellectual property protection standpoint we have determined that patenting this will probably not make sense so it will be protected using copyright law. This is not so much an issue of inventorship which would have gone primarily to the AP faculty individuals, but a matter of authorship which tends to go to the person who wrote the code.

Carol Roberson added that this classified IT employee will be converted to AP faculty in the fall, and then he will be entitled to share.

Dr. Inzana questioned the rationale that if you are classified staff you are not eligible, but if you're AP faculty you are eligible. His understanding of the policy is that you are not eligible if it is assigned to you and the policy does not discern between classified and AP staff. Carol Roberson stated that The Intellectual Property Committee Practices document has a section (#7) that just deals with classified employees. When the Invention Disclosure form was revised, we implemented this section and limited it to classified employees that cannot participate in revenue sharing.

Kay Heidbreder stated that the reality is that if a task or activity is specifically assigned, it doesn't matter whether you are a faculty member, teaching faculty member, research faculty member, AP or classified employee, the intellectual property belongs to the university and you don't get to share in the royalties.

Carol Roberson suggested that the Invention Disclosure form should be modified to be more consistent with our IP policy. Kay Heidbreder said that the policy itself doesn't specify classified employees.

Another question raised is if someone comes up with an invention that is not assigned to them, but it does benefit their job are they eligible for royalties? Both Dr. Inzana and Ms. Heidbreder agree that the policy allows this individual eligibility for royalties. John Geikler stated that as a practice we grant the department head a wide berth to determine what fits and what does not. In this case before the committee regarding the sharing of royalties, the IT employee's supervisor needs to determine whether or not this was an assigned task.

The committee discussed the many interpretations of what is assigned. The Intellectual Property Committee Practices are the group's working understanding/interpretations of the policy. The committee agreed that there is definitely room for clarification.

Ms. Roberson suggested that we have a determination with all the authors as to whether it was an assigned task and if any of them disagree with the interpretation

from their department head and then it will come before the committee at which time they will be given an opportunity to present their case.

Dr. Inzana asked Ms. Roberson to revise the disclosure form. Ms. Roberson stated that she and Mr. Geikler will work together on the modifications to the form and Dr. Inzana will send it to the committee to review.

It was also agreed that the Intellectual Property Committee Practices document should be changed by deleting #7 concerning classified employees. A motion was made by Kay Heidbreder to delete Section 7 of the Intellectual Property Committee Practices. It was seconded by Carol Roberson and unanimously carried.

Although not yet finalized, Dr. Inzana announced that Dr. Joe Merola will replace Dr. Jack Lesko on the committee.

Adjournment

There being no other business, the meeting adjourned at 12:55 p.m.