

**Virginia Polytechnic Institute and State University  
Intellectual Properties Committee  
March 17, 2010**

**FULL COMMITTEE**

The Intellectual Properties Committee met March 17, 2010.

The following members were present: Dr. Tom Inzana, Dr. Stephen Boyle, Dr. Robert Broadwater, Dr. Elizabeth Grabau, Ms. Kay Heidbreder, Dr. Joe Merola, Mr. Ken Miller, Dr. Steve Sheetz, Ms. Cindy Wilkinson.

Invited guest members present: Ms. Carol Roberson, Mr. Steve Capaldo, Mr. John Geikler. Shelly Key recorded the minutes.

Those members not in attendance were: Mr. Mark Coburn, Dr. Robert Harvey, Dr. Barbara Lockee, Mr. Steve Tatum and Dr. Robert Walters.

**Call to Order**

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

A motion was made and passed unanimously to approve the September 23, 2009 minutes.

**New Business**

Dr. Inzana advised the committee that he will be stepping down as Associate Vice President for Research Programs effective this summer. He will, however, still serve as the University's Research Integrity Officer.

VTIP My IPWidget: John Geikler, Senior Licensing Associate with VTIP, briefed the committee on a widget being developed for faculty to use on their web pages, email signatures, Facebook, etc. that will link to the technologies they have available for licensing on the VTIP website. An intern will be putting this together and sending it out to faculty over the next month. Initially the focus will be on specific faculty members, but there's also an opportunity to associate this with any group of technologies that we have—i.e. any research center, department or any ad hoc bundle of intellectual property. It was also suggested that this be done on a departmental level since people may not know a specific faculty member, but would come to the department.

Mr. Geikler reported that VTIP has started doing Google analytics on their website. A lot of people ping their website looking for (1) specific technologies and technology phrases or keywords and (2) specific faculty members.

Dr. Boyle stated that he teaches a scientific integrity course at the graduate level and issues that always come up are conflict of interest and conflict of effort that are generated as a result of pushing intellectual property as one of the engines of the university community. Virginia Tech has pushed the intellectual property side as a way of generating revenues and in turn faculty have taken advantage of it as much as possible. A number of issues are raised that faculty are being faced with in terms of development of intellectual property relative to their teaching, research, and normal service responsibilities. The university needs to be more proactive in terms of educational workshops addressing these different issues.

Mr. Geikler stated that the concern they see more from a VTIP standpoint is once a technology is licensed there are potential conflicts of interests for a number of researchers because of the relationship they then have with a licensee who may have an exclusive patent right. The researchers have to be careful that they don't infringe in doing research, especially for another third party, where they might be utilizing their own prior work to develop new opportunities they may be setting up a research sponsor for potential infringement.

Faculty Consulting Agreements: Carol Roberson stated she receives requests from faculty members routinely asking that she review their consulting agreements. She is not sure what the university's position is and felt that the committee should discuss this issue. Kay Heidbreder stated that consulting is a private activity the individual is engaged in and the university makes it very clear that it is not responsible for these private activities.

Faculty are allowed one day a week not to exceed five days in any five week period to consult. Consulting is a personal activity and the money received while faculty are consulting does not come back to the university.

It was suggested that the university could be proactive and put out guidelines to the faculty to educate them on what their limits are in the intellectual property field in terms of how far they can go and what the boundaries are.

The committee discussed information that could be included in these guidelines.

- Faculty are responsible for hiring their own attorney to review consulting agreements; however, the university could provide a "do and do not" list. For example, one of the "do not's" is to not encumber any university IP. There could be basic information on this list without stepping into terms and conditions.
- The university will not sign consulting agreements.
- Background IP should be not encumbered – VTIP could provide advice as to whether or not there is background IP

- It was suggested that case-based learning be utilized in a course or workshop.
- The Department Heads Council that meets monthly would be a good venue for disseminating information.

### **Action Items**

- Carol Roberson and John Geikler will come up with a “do not” list for the committee to review. Steve Capaldo will review the first draft.
- A consulting brochure currently exists and could be modified to include an “issues to consider” section.

### **Adjournment**

There being no further new business, the meeting adjourned at 1:05 p.m.