

**Virginia Polytechnic Institute and State University  
Intellectual Property Committee Meeting  
April 18, 2012, 12:00-1:00 p.m.  
325 Burruss Hall**

**FULL COMMITTEE**

The Intellectual Property Committee met April 18, 2012.

The following members were present: Bill Knocke (Chair), Robert Broadwater, Laurie Coble, Mark Coburn, Robert Harvey, Kay Heidbreder, Barbara Lockee, Joe Merola, Steve Sheetz. Shelly Key recorded the minutes.

Invited guest members present: Steve Capaldo, Dave McGarry, Kristen Mittelman, Erica Inge (Barbara Lockee's graduate student).

Those members/guests not in attendance: Stephen Edwards, John Jelesko, Ken Miller, Mike Miller, X.J. Meng, Steve Tatum, and Robert Walters.

**Call to Order**

Bill Knocke called the meeting to order at 12:10 p.m.

**Approval of Minutes**

On a motion made by Joe Merola and seconded by Steve Sheetz, the minutes for the February 15, 2012 meeting were unanimously approved.

Dr. Knocke asked that the minutes for today's meeting reflect that Steve Tatum (Staff Senate representative) will be completing his term of service on the committee the end of this year. The Staff Senate has elected a new person to assume this role. Even though Steve was not available to attend the meeting today, his work with the Intellectual Property Committee was acknowledged.

**New Business**

**I. Subcommittee reports**

**Policy 13000 Subcommittee:**

Joe Merola (Chair) reported that the committee discussed many issues; however, the primary issue was to make sure that the Virginia Tech policy was worded in such a way as to avoid the problems encountered by Stanford University in the case of Roche v. Stanford. A copy of the proposed language outlining two specific policy wording changes was provided to the committee (attached). Dr. Merola further reported that the committee also discussed

some changes in IP practices, but that those changes would not need to go into actual policy wording changes.

Dr. Knocke suggested that with the issue of the student IP (specifically the \$5,000 limit in university resources), there should be similar specificity as to what is going into that calculation—e.g. faculty time spent with the student in the development of the IP. Dr. Knocke proposed that over the summer the committee may want to do some tweaking. Dr. Knocke will interact with Tomalei Vess (Director of Undergraduate Research) and Steve Capaldo this summer and look at the language from other places on the student IP issue. He will bring back a menu of options that the committee might pick and choose from to address the issues discussed.

#### Education Subcommittee:

Erica Inge presented the prototype that has been developed for the IP training module. It was suggested that the video could show how a couple of the companies at the Corporate Research Center started and developed down the research spectrum. Another suggestion was to begin by focusing on what we are about—getting the results of research to the market to benefit society—rather than initially talking about financial and ownership considerations.

Mark Coburn reported that the local VT NPR station did a recent radio spot on the new emphasis many universities (Virginia Tech, VCU, and UVA) are putting on Tech Transfer. He will provide the link to the committee.

After today's meeting, Shelly will send the URL for the training video to the committee to review. Erica encouraged committee members to use the evaluation form located in Section 3 to provide feedback.

Dr. Lockee reported that the education subcommittee will be working on the module over the summer to have it ready in the fall.

## **II. Overview /discussion of Webinar held March 21, 2012**

Several committee members viewed the webinar "A New Approach to IP Management: The Penn State University Research Model." The general consensus was that some of the assumptions made may have fit Penn State, but not Virginia Tech.

### **III. IPC Membership**

Dr. Lockee's membership on the IP committee expires this year. Dr. Knocke will check on the membership terms for all committee members.

### **Next Meeting Date**

The IPC will not meet on the next regularly scheduled meeting date of May 16, 2012. The committee will reconvene in the fall.

### **Adjournment**

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

Respectfully Submitted,

Shelly Key  
Administrative Support to the IP Committee

## Final recommendation of IPC Subcommittee on wording of Policy 13000

The following is wording suggested to eliminate the problem encountered by Stanford University in the case of Roche v. Stanford. There are other issues surrounding

### Policy 13000 Current Language, Section 2.4A:

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.

...

3. Student Ownership: ... IPs generated by students not employed by the university and not using university resources of at least \$10,000 in their generation will be owned by the student...

### Policy 13000 Proposed:

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.

...

3. Student Ownership: ... IPs generated by students not employed by the university and

not using university resources of at least \$5,000 in their generation will be owned by the student...

In addition, suitable wording for a resolution for University Council will also need to be drafted.

There are also other issues that the subcommittee discussed in terms of procedures surrounding the policy but do not need to be reflected in the policy itself. The subcommittee is less certain on those issues and does not have as hard a recommendation on those and may require more discussion. These procedural issues are:

1. That a statement of IP obligations be put into the terms of offer for new employees and perhaps be a part of new grant proposals for existing faculty.
2. That a similar statement of IP obligations be signed by students involved in undergraduate research, and other research projects including senior design projects and other class projects. This would involve coordination with the Director of Undergraduate Research for educational activities for students in this regard.