

**Virginia Polytechnic Institute and State University
Intellectual Properties Committee
April 21, 2010**

FULL COMMITTEE

The Intellectual Properties Committee met April 21, 2010.

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

Invited guest members present: Ms. Carol Roberson, Mr. Steve Capaldo, and Ms. Lora Cavuoto.

Invited guests: Dr. Glenn Kraige, Ms. Lisa Cotting

Shelly Key recorded the minutes.

Those members not in attendance were: Dr. Robert Harvey, Dr. Barbara Lockee, and Dr. Robert Walters.

Call to Order

Dr. Inzana called the meeting to order at 12:00 p.m.

A motion was made and passed unanimously to approve the minutes from the last meeting held March 17, 2010.

New Business

Kraige/Wiley Textbook Royalty 10-0397-08 (August 2009):

Dr. Glenn Kraige has been involved in writing a textbook for Wiley and Sons, Inc. (Wiley) for 25+ years. Wiley is to fund buy out time for Dr. Kraige as a sponsored research contract. The issue of ownership of the intellectual property was raised for the committee to review.

Dr. Kraige provided the following background information regarding the Kraige/Wiley buyout contract:

- The textbook (Engineering Mechanics: Statics and Dynamics) started in 1951 by the senior author, Professor Meriam, who is well known around the world for engineering mechanics. Dr. Kraige took over writing the book in 1982 after

Dr. Meriam retired. The textbook is used for sophomore level engineering courses.

- The publisher (Wiley and Sons, Inc.) likes to maintain a five-year cycle between editions. New editions require an immense amount of work. On four previous occasions (1991, 1995, 2000 and 2005), Wiley bought out Dr. Kraige's teaching time for one or two semesters per edition. These four buyouts were under sponsored research contracts. Under the arrangements of the buyout, while Professor Kraige is relieved of his teaching responsibilities, he continues to perform all non-classroom duties, including his service on various department and college committees, and on graduate student thesis committees.

Under the proposed contract, OSP identified a question on ownership of the materials being created by Dr. Kraige. Under the proposed contract, the money comes to Virginia Tech, but the book is owned by Wiley and the royalties go directly to Dr. Kraige under the terms of a royalty agreement between Kraige and Wiley. The issue is that if it goes through OSP, the property becomes University-owned, which complicates royalties going directly to Dr. Kraige. This arrangement had been going on for over twenty years, but was just recently discovered. Kay Heidbreder added that Dr. Kraige has followed all of the rules and been very upfront. In addition, the College of Engineering has been very supportive of this project from the onset.

Dr. Inzana and Kay Heidbreder met with Dr. Ishwar Puri (Department Head) earlier about this situation and Dr. Puri completely supported the project stating that the publicity for the department through these books far outweighed any economic value. The situation has been going on for 20+ years and Dr. Kraige indicated that this is the last time he is going to work on this book before retiring. In light of these facts, it was the decision of the committee by unanimous vote to approve Dr. Kraige's situation as it stands.

In regard to future instances, it was felt that this issue will not come up again since Dr. Kraige's arrangement was an oversight from many years ago. Carol Roberson reported that OSP has alerted pre-award to be aware of any proposals to publishers so that any issues can be caught upfront. Issues resulting from future situations will be handled on a case-to-case basis.

Changes in Brochure:

Carol Roberson provided copies of brochures that the Office of Research has compiled to provide guidance regarding consulting and intellectual property.

The consulting brochure will be updated to include guidance to faculty on what to look for in consulting agreements. Ms. Roberson provided a copy of these proposed changes. Major changes include: (1) The University will not offer any legal advice, (2) VTIP (Virginia Tech Intellectual Properties, Inc.) will talk to anyone who has concerns about IP issues, (3) the brochure should take into account recent changes

to research extended appointments. It was suggested that the following be added to the brochure.

If a substantial amount of your time is devoted to research on externally funded grants, please refer to Policy 6200 or the faculty handbook (Section 6.2) regarding consulting.

The plan is to distribute the completed final brochures to Department Heads, and a suggestion was made that the brochures also should be made available electronically.

A motion was made by Dr. Merola and passed unanimously to approve the proposed revisions to the consulting brochure.

Adjournment

Dr. Inzana advised the committee that effective in June he will no longer serve as the Associate Vice President for Research Programs and, therefore, will not chair the Intellectual Properties Committee.

There being no further new business, the meeting adjourned at 1:00 p.m.