

**Virginia Polytechnic Institute and State University
Intellectual Properties Committee
August 17, 2005**

FULL COMMITTEE

The Intellectual Properties Committee met August 17, 2005. The following members present: Dr. Jim Blair, Dr. Tim Pickering, Dr. Joe Falkinham, Ms. Carol Roberson, Dr. Tom Caruso, Ms. Kay Heidbreder, Dr. Tom Sherman, Mr. Mark Sumner, Mr. Ryan Lanham, and Ms. Debbie Nester. The following members were absent: Mr. Ken Miller, Mr. Kevin Sullivan, Dr. Robert Sturges, Dr. Al Wicks, Dr. Craig Nessler, Mr. and Michael Borzilleri. There were two guests from VTIP.

Call to Order

Dr. Blair called the IP Committee meeting to order at 12:06 p.m.

Approval of Minutes

Dr. Blair called for a motion to approve the minutes of June 15, 2005 and July 20, 2005. Dr. Pickering made the motion to accept the minutes from both meetings, seconded by Dr. Falkinham and the motion was unanimously passed.

Disclosures

Dr. Blair reported that Disclosures 05.044, 05.045, 05.046, and 05.048 were unofficially recommended to be accepted as university owned. Dr. Sherman moved to accept these disclosures as university owned, seconded by Dr. Pickering and the motion was unanimously passed.

Discussion on new process for technology transfer and role for IP Committee

Dr. Blair reported changes are taking place with VTIP. He mentioned that there are four people who are going to be hired in four areas of specific areas to help faculty with submitting disclosures. Dr. Blair reported that all disclosures are coming through the Office of Associate Vice President for Research and Interdisciplinary Programs. Dr. Blair reported that we are trying to speed up the process of return on disclosures and a way that this could happen would be for Dr. Pickering and he to review the disclosure and if the inventor has signed ownership to the university that those disclosures be automatically accepted. The committee discussed this. Dr. Pickering moved that all disclosures assigned to the university for ownership will automatically be accepted, seconded by Dr. Falkinham and the motion was unanimously passed.

Dr. Blair reported there were two disclosures 05.049 and 05.050 which signed ownership to the university and were accepted.

Dr. Blair reported that the committee would only need to meet when there is a dispute resolution or policy discussion. There will be a set of notes/guidelines that can go along with the policy. The committee discussed getting reports on disclosures. Dr. Blair said the committee could meet once each semester and get a report at those meetings. Other meetings could be set as needed.

Discussion of the new disclosure form

Dr. Blair informed the committee that he had not received any comments from the new disclosure form that was passed out at the last meeting. Dr. Falkinham reported that he felt the statement should be changed where the inventor signs the form. Dr. Blair reported that he feels there should be a section on the form where it states classified staff royalties in the case there would be classified staff involved. The form will be sent out electronically to the committee to review and suggestions.

Dispute Resolution

Dr. Blair brought a dispute resolution to be discussed on disclosure 03.118. The dispute is an inventor was left off of the form and one that has royalty share problems. The committee discussed how this should be handled. Dr. Caruso moved that there be an ad hoc committee including a graduate student, undergraduate student, faculty member and one member from the Research Division, seconded by Dr. Falkinham and the motion was unanimously passed. The ad hoc committee will report back to the full IP Committee.

Ms. Heidbreder said she would be willing to help the ad hoc committee interpreting policy.

Adjournment

Dr. Blair announced the meeting adjourned at 1:14 p.m.

**Virginia Polytechnic Institute and State University
Intellectual Properties Committee
November 16, 2005**

FULL COMMITTEE

The Intellectual Properties Committee met November 16, 2005. The following members present: Dr. Jim Blair, Dr. Tim Pickering, Dr. Joe Falkinham, Ms. Carol Roberson, Dr. Tom Caruso, Dr. Tom Sherman, Mr. Mark Sumner, Dr. Craig Nessler, Mr. Ken Miller. Ms. Debbi Lucas attended as a guest and Ms. Debbie Nester recorded the minutes.

Call to Order

Dr. Blair called the IP Committee meeting to order at 12:05 p.m. Dr. Blair mentioned that it was not a real heavy agenda he would like to add one thing to it an update on policy 13000. He will report back to the Commission on Research on that. It was added to the bottom of the agenda.

Approval of Minutes

Dr. Blair called for a motion to approve the minutes of August 17, 2005. Dr. Nessler made the motion to accept the minutes, seconded by Dr. Pickering and the motion was unanimously passed.

Update on Conflicts

Dr. Blair reported that he wanted to give an update on one issue that we had from the last meeting. We had complaints from students that were named as co-inventors on a disclosure that ended up not going in as co-inventors on actual patent filing. It was from a course they taught and used the course to further develop some intellectual property and put all of the student's names on these and when it went to a lawyer with written a description of what each student had contributed. The lawyer interpretation was that not all students contributed as inventors by the legal definition and that only those meeting that standard were included in the full patent applications. However, we have had contacts from at least three of the students that don't like being left off or don't like the royalty sharing suggested. Dr. Blair met with the patent attorney, Mr. Mike Whitham, to confirm a plan. Mr. Whitham provided sheet that describes inventorship. Dr. Blair will send out a letter to everyone involved including all students. The letter would explain what was done and the process by which the inventors were identified and a copy of this description of the inventors and contributions to the inventors. If they still have any objection to the assignment then they should notify us on these bases. Mr. Whitham says that if they still challenge this we can make a ruling but the ruling has no legal standing. The students would have to go out and get their own lawyers and sue in court for

some kind of action out of this. If there is something we certainly need to have documented that this group has looked at that. Then we may have to make some decisions to royalty sharing. It is moving slowly we are not really ready to come back to the committee.

We had another issue that we thought was going to come to this committee which may be resolved by the inventors involved and assistance of the patent attorney. Two patent applications were submitted by VTIP with overlapping claims but different inventors. After discussion with the attorney, all involved agreed that the first attempt should be to clarify the claims on each of the applications to the patent office and clearly show the distinction of the two applications. Mr. Whitham felt this approach should work but will come back to the inventors if another solution is needed. Currently, no action by the IP Committee will be needed.

VTIP Director

We are in the final stages of negotiating to get someone here as the VTIP director.

Copyrights

Dr. Blair reported that he is getting a lot of questions whether to disclose copyright materials. Much of this falls into the gray area of software/computer code which might be best released under open source criteria. In general, faculty have been advised to disclose things which were supported by university resources or which they felt needed protection as a Virginia Tech copyright. In most cases, those copyrights disclosed assigning ownership to the university will be accepted on behalf of the university by the IPC (by the same standards as invention disclosures). If questions arise concerning ownership or whether a disclosure represents a traditional form of scholarship, the IPC will assist with that determination and will require a disclosure. Ms. Roberson raised the question whether we should be turning copyrights accepted for the university over to VTIP? Dr. Blair was not sure. Ms. Roberson said that the issue that VTIP faced recently was that a disclosed copyright was assigned to VTIP. However, when it was reviewed by VTIP with the faculty members they wanted to keep it as open source. There was no commercial value and VTIP agreed to let them do it as open source. But the authors also wanted to be able to disseminate the material and credit it to Virginia Tech and their department. Dr. Blair read from Policy 13000 section D: All IPs assigned to the university shall flow to VTIP by assignment for operational management. However, he noted that the university does retain the right to use for research or educational purposes any IP turned over to VTIP. The committee agreed that copyright material accepted by the IPC on behalf of Virginia Tech should be transferred to VTIP and that authors of those materials will have rights to use that material for research and educational purposes.

Discussion of the new disclosure form

Dr. Blair informed the committee that we need to move ahead and get the new disclosure form implemented. He reminded them that they were sent another version. We have received several editorial comments. Ms. Roberson reported that she sent the form out to two patent attorneys. One patent attorney responded that this is one of the better ones he has seen. Ms. Roberson mentioned a list of changes that she received. Ms. Roberson has asked a patent attorney if the record of invention page needs to be added to our form? She has not received an answer. Dr. Blair recommended to incorporate it only if the patent attorney tells us that it really is necessary. Ms. Roberson mentioned that no other universities have that. Dr. Nessler made the motion to approve and allow minor corrections, seconded by Dr. Falkinham and the motion was unanimously passed.

New Items

Dr. Blair presented our progress on Policy 13000 as well as the Practices document that we are starting to generate. He thinks that the next step is that we go out on the road in public forums across the university to present where we are. The policy needs to go through the board of visitors which will probably be a non-controversial issue. Before we do that, the changes and interpretation should be made public and feed back from faculty entertained.

Dr. Blair mentioned one issue that came up and not sure if it was from the Virginia Tech Foundation or internal that wanted Kevin Sullivan added as ex officio. The old policy said the director of business affairs and controller for Virginia Tech Foundation. We took care of it and we just identified the university controller. The president's office said to add Kevin Sullivan to the list. Mr. Sullivan is the legal counsel for VT Foundation not the university. Dr. Blair asked if there was any reason that someone from VT Foundation should be on this board. Dr. Blair reported that there is no sense of the committee that we really think it's important that that position be added – they can be invited if they want to come. Dr. Blair will go back through Kevin Sullivan and then maybe have him go to the President or to Ms. Kim O'Rourke. Dr. Blair reported that the board will have to approve the changes. We will keep the way it is. Dr. Blair will pursue the matter with Kevin Sullivan and whether they just are invited we'll put them on the mailing list and invite them to join. Dr. Blair said we'd be adding another voting member if we put it on in that fashion and I don't think that was the intent.

Dr. Blair said we need to set up a schedule and list of groups – who do you think we should do presentations to? Dr. Blair said we can ask specifically to get on the faculty senate agenda. Dr. Blair said given the issues previously with the engineering faculty group there will be enough interest there that we would set it up. Dr. Falkinham said going to engineering faculty because they have shown an interest before and secondly, going to faculty senate and leave it at that until the individuals who are there on faculty senate if they think their department or whatever administrative unit they are representing would be interested then we could do

something individually maybe members of the committee. Dr. Blair said but we still have a responsibility to make generally known. Dr. Falkinham suggested putting it on the web page. Dr. Blair said he was thinking more of a newsletter article – here's the general sense. Go to the web page to read the draft document on that. Dr. Blair said that he wants them to be aware of the changes in policy and maybe some discussion on the things we would like to see happen. Dr. Blair said he would probably ask somebody out of the faculty side to go and stand up – maybe not have to do any presentation – at least say this was not an administrative decision and that it really did come to the committee. There is no change in policy.

Adjournment

Dr. Blair announced the meeting adjourned at 1:07 p.m.

**Virginia Polytechnic Institute and State University
Intellectual Properties Committee
January 18, 2006**

FULL COMMITTEE

The Intellectual Properties Committee met January 18, 2006. The following members present: Dr. Jim Blair, Dr. Tim Pickering, Dr. Joe Falkinham, Ms. Carol Roberson, Dr. Tom Caruso, Dr. Tom Sherman, Mr. Mark Sumner, Dr. Craig Nessler, Mr. Ken Miller, Mr. Ryan Lanham. Ms. Debbie Nester recorded the minutes.

Call to Order

Dr. Blair called the IP Committee meeting to order at 12:04 p.m.

Approval of Minutes

Dr. Blair called for a motion to approve the minutes of November 16, 2005. Dr. Falkinham made the motion to accept the minutes, seconded by Dr. Sherman and the motion was unanimously passed.

Update/Discussion

Dr. Blair reported that there were 87 disclosures in calendar year 2005, which is down from last year. He asked the committee to get word out to faculty in their areas. Dr. Blair reported that a new executive director for VTIP has been hired. Ms. Roberson reported the director's name is Mr. Mark Coburn and he will begin April 1 or before. It was also reported that there is money in the proposed budget next year for the positions that were discussed in VTIP. VTIP has received an Economic Development grant award and there will be some money from that for a position as well. These individuals will work with faculty to develop disclosures and to think about marketing strategies. Dr. Blair thinks this will help increase the quality of the disclosures received.

Dr. Blair reported on three disclosures that were received. He reported that disclosure 05.084 was not assigned as university owned because it was scholarly work. It was not accepted by the committee on behalf of the university. He reported on disclosure 03.118 that has student disputes with respect to royalty sharing. The committee discussed this and recommended that Dr. Blair talk with Ms. Kay Heidbreder. Dr. Blair reported on disclosure 06.001 as an example of faculty who do not understand how to complete the intellectual property forms. Dr. Blair said the disclosure is an idea for something which would be copyrighted but is not yet written. Dr. Blair asked the committee how they could help faculty to better understand intellectual property and educate them on the process. They discussed it. A frequently asked questions section that could be integrated into the VTIP web site

was recommended as one means of communicating the sense of the committee. Dr. Blair agreed to look into implementing this recommendation.

Policy 13,000

Dr. Blair reported the ground has shifted relative to revision of the IP policy. New legislative action involving IP is being considered by the general assembly. He wants to get some input and advice from the committee on what we do. He had been thinking of giving FYI presentations on the intellectual properties policy to various groups. He is now hesitating because of the recent actions in the general assembly. They are considering changing the IP policy for the state and requiring that universities have their own policy. If this passes it will come back to the Board of Visitors. They may say we have to develop a policy which we already have. Dr. Blair feels there might be a clash in going forward with this current policy for minor changes or practices. What should we do? The committee discussed this. It was suggested that highlights of our practices document be put on the awards newsletter and maybe on the opportunities update website. We can then wait until March to learn what legislative action will be taken.

New Items

Ms. Roberson gave the committee something to be thinking about and put on the agenda for the next meeting. She reported that Dr. Fenwick asked should the disclosure form be revised to indicate inventors willingness to transfer know-how to licensing companies.

Adjournment

Dr. Blair announced the meeting adjourned at 1:05 p.m.

**Virginia Polytechnic Institute and State University
Intellectual Properties Committee
April 19, 2006**

FULL COMMITTEE

The Intellectual Properties Committee met April 19, 2006. The following members present: Dr. Jim Blair, Dr. Tim Pickering, Ms. Carol Roberson, Dr. Tom Caruso, Mr. Mark Sumner, Mr. Ken Miller, Mr. Mark Coburn, Kay Heidbreder.

Call to Order

Dr. Blair called the IP Committee meeting to order at 12:04 p.m.

Approval of Minutes

Approval of Minutes postponed until next meeting.

Discussion

The committee had discussions about intellectual properties. Most significant discussion was an intellectual property disclosure submitted by Daniel Post, Professor Emeritus. The disclosure form was deemed inventor owned.

Mr. Mark Coburn was introduced as the new Executive Vice President for VTIP. Mr. Coburn addressed the committee, giving an outline of his vision for VTIP and interactions with VT faculty. Committee members present ask Mr. Coburn several questions and a good discussion was had.

Dr. Blair and Kay Heidbreder gave an update on the legislative effort to amend the state's approach to intellectual property authority and responsibility at academic institutions.

Adjournment

Dr. Blair announced the meeting adjourned at 1:05 p.m.

Virginia Polytechnic Institute and State University
Intellectual Properties Committee
June 21, 2006

FULL COMMITTEE

The Intellectual Properties Committee met June 21, 2006. The following members present: Dr. Jim Blair, Dr. Tim Pickering, Ms. Carol Roberson, Dr. Tom Caruso, Dr. Tom Sherman, Dr. Craig Nessler, Mr. Ken Miller, Ms. Kay Heidbreder, and a guest, and Debbie Nester recorded the minutes.

Call to Order

Dr. Blair called the IP Committee meeting to order at 12:10 p.m.

Approval of Minutes

Dr. Blair called for a motion to approve the minutes of January 18, 2006 and April 19, 2006. Kay Heidbreder made the motion to accept the minutes, seconded by Dr. Pickering and the motion was unanimously passed.

Disclosures Discussion

Dr. Blair informed the committee that the set up of the practices has helped with the submission of disclosures. The practices have help resolve questions before disclosures are submitted.

Dr. Blair brought to the attention of the committee that a group of undergraduate students have submitted an incomplete disclosure, which he is scheduled to meet with later to discuss, that have submitted as inventor owned. The students used \$2000 of a parent fund to do the project and he wanted to know if that should be inventor or university owned. The parent fund does not want any revenue. The committee discussed and said that it should be inventor owned.

Dr. Blair charged the committee to work on a statement to practices about students as inventors.

Dr. Blair brought to the committees attention that an email went out to the students that had a complaint on the IP Disclosure number 03.118 with information on the disclosure and the information provided by Mr. Mike Whitham. He said that there is still a possibility that it could come back to the committee. He wanted them to know what had been done and to be aware.

Future Meetings

Dr. Blair reported that he will be retiring as of August 1, 2006. There are no plans for replacing him. He discussed with the committee who could chair the committee at future meetings. Dr. Sherman made a motion that Dr. Pickering convene the committee and handle the disclosures on behalf of the IPC, seconded by Dr. Nessler and the motion was unanimously passed. Dr. Pickering recused himself.

VTIP Business

VTIP will be getting positions that will help with the completing of disclosures. They should be there by July 1. They will be hired by Virginia Tech but housed at VTIP.

Ms. Roberson asked the committee if anyone is interested in being on the search committee for these positions to inform Mr. Coburn.

Dr. Blair said that these positions should help faculty with the completing of the disclosures and the committee can focus on the policy issues.

Dr. Blair asked Ms. Heidbreder if she has heard any updates from the Board of Visitors. She said that the Board has not made any new members yet and she has not heard any new updates.

Ms. Heidbreder had an update to the question that Mr. Coburn had about the Patent office accepting electronic signatures. She said that the patent office can accept electronic signatures but the notary public still needs to witness the electronic signature and electronically sign at the same time.

Adjournment

Dr. Sherman made the motion to adjourn at 12:46, seconded by Tom Caruso and the motion was unanimously passed.