

**Virginia Polytechnic Institute and State University
Intellectual Properties Committee
October 17, 2007**

FULL COMMITTEE

The Intellectual Properties Committee met October 17, 2007.

The following members were present: Dr. Tom Inzana, Ms. Kay Heidbreder, Dr. Elizabeth Grabau, Dr. Barbara Lockee, Dr. Steve Sheetz, Mr. Ken Miller, Ms. Christa Thomas, Dr. Robert Broadwater, Ms. Cindy Wilkinson, and invited guests, Ms. Carol Roberson, Dr. Tim Pickering, Ms. Denisa Olteanu, Mr. Steve Capaldo, Mr. Greg Hess. Shelly Key recorded the minutes.

Those members not in attendance were: Dr. Robert Walters, Mr. Mark Coburn, Dr. Robert Harvey, Dr. Stephen Boyle, Dr. Jack Lesko.

Call to Order

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

Dr. Inzana called for a motion to approve the minutes from the last meeting on December 20, 2006. The motion was made by Ms. Heidbreder, seconded by Dr. Lockee and the motion was unanimously passed.

Dr. Inzana opened the meeting stating that there were no particular issues to discuss and that today's meeting is a new meeting for the new group of members and to review IP policies and procedures. Introductions followed.

Tim Pickering passed out information and stated that he would present an overview of the IP process at Virginia Tech, what the responsibilities and duties of the committee members are, and general information on how we operate.

Overview: The IP process is a sequential process beginning with the faculty members who have ideas, get sponsorship, and conduct research. If they find something that they feel may have commercial value, they submit a disclosure which comes in to this committee. When the committee during the process determines that the IP is university-owned, our vehicle for examining the commercial exportation of intellectual property is to transfer it to a separate and independent organization from Virginia Tech – Virginia Tech Intellectual Properties (VTIP). VTIP has recently considerably expanded their staff with licensing associates so we now have greater capability to really make some diligent pursuits of a lot of the IP that is developed here at Virginia Tech.

Typically, we will have 120-130 disclosures from university faculty during the year. Of these, approximately 100-110 will be judged as premature to go out and try to license them because they are in early stage development. Maybe 25-30 might be licensable and so the licensing associates will pursue likely candidates. The idea is to sign up licensees so we can generate revenue. We might have 1-3 million dollars worth of revenue per year from all licenses. VTIP has a revenue sharing agreement back with the university so they take off some administrative costs off the top and take the rest of the revenues—50% comes back to the inventors and 50% comes back into the university and is divided up equally within departments and other entities.

Policy on Intellectual Properties: Dr. Pickering provided the annotated version with commentary. The officially approved version doesn't have the annotations in it. This policy is a part of the employee's contract of employment with the university. If you signed an employment agreement with VT, you are governed by the IP policy. Ms. Heidbreder pointed out that it is actually a State law that you are bound to this policy when you accept your paycheck. The Policy on Intellectual Properties combines both policy and administration and was developed in 1991. The committee structure and organization in the first part of the policy would probably not need to be in the policy because they are more about how the group administers the policy rather than what the actual policy is. Regarding the information on Authority and Responsibility of the Committee, some of these we don't observe too closely anymore in the way we operate but they are still enforced and perhaps done by a different method. The main responsibility with the way we are operating now is to evaluate disputes as they come about issues related to IP or to consider whether or not we need to make changes or recommendations to university administration about better ways to deal with intellectual property issues. The committee use to meet monthly and review all the invention disclosures and everybody had to write up reports and send them out to VTIP. At this time VTIP only had two people working for them so this was an effort to help VTIP get a handle on what the commercial potential might be. Since the staff and their capabilities at VTIP have increased, the committee has gone out of the business of trying to do evaluations of the disclosures. That's why we don't necessarily meet on a monthly basis anymore and only on an as-needed basis. We do ask that you hold the monthly meeting date (third Wednesday of each month), but we are not going to have a meeting unless we send you a notice to confirm that there will be a meeting. Dr. Inzana asked if the policy should be updated to reflect this. Dr. Pickering suggested that when a major change needs to be made, then that would be a good time to make this relatively minor change due to the process involved in making changes.

Dr. Pickering reviewed the Policy Guidelines as outlined in Section 2.4:

- A. Ownership: There are two types of intellectual property: academic scholarship (owned by author) and research (owned by university). Dr. Pickering then

- reviewed special exception areas: Sponsor Rights, Federal Agency Rights, Student Ownership, Joint Inventorship, special situations).
- B. Obligation to Disclose: Covers all employees.
 - C. Revenue Sharing
 - D. Management Responsibility
 - E. Right of Appeal

Intellectual Property Committee Practices: This hand-out is a thumbnail description of cases that have come up in the past and how the committee has determined the application of the policies to those particular cases. One area that comes up quite frequently and our university policy is vague on is how to deal with is consulting. For example, if you are a faculty member and you want to either consult or go on sabbatical, what happens to any intellectual property that you develop under those agreements? If you are on unpaid sabbatical, the university has no ownership. If on paid sabbatical, there is university ownership.

Practices Pertaining to Transfer of Ownership and Role of the Governor: This was developed by Dr. Fenwick when he was VP for Research with involvement from Kay Heidbreder and Carol Roberson. This covers the legal background that encompasses what the university can and cannot do in terms of IP issues. Our position is that in general the university puts resources into sponsored work and even if the sponsor pays for the work, he normally doesn't pay the full cost, so the university usually has an interest. We are reluctant to give away the ownership of our intellectual properties when it has been developed here and it could be declared university owned.

Information on the Office of the Vice President for Research: Most of this info is available on the web (OVPR home page), but can be hard to locate. Go to search box and enter research/formsandpolicies/index and under Intellectual Properties you will find most of the handouts that were given out today. Also posted there is the Invention Disclosure form which you can use to fill out and send to OVPR. After review, required signatures are obtained and then they go out to VTIP usually within a week or two.

Adjournment

Dr. Inzana asked for any other business. There being no other business, a motion was made and unanimously passed to adjourn. The meeting adjourned at 12:40 p.m.

**Virginia Polytechnic Institute and State University
Intellectual Properties Committee
March 19, 2008**

FULL COMMITTEE

The Intellectual Properties Committee met March 19, 2008.

The following members were present: Dr. Tom Inzana, Ms. Kay Heidbreder, Dr. Steve Sheetz, Mr. Ken Miller, Dr. Robert Broadwater, Ms. Cindy Wilkinson, Dr. R.J. Harvey, Dr. Stephen Boyle, and invited guests, Ms. Carol Roberson, Mr. Mark Coburn, Ms. Denisa Olteanu, Mr. Steve Capaldo. Shelly Key recorded the minutes.

Those members not in attendance were: Dr. Robert Walters, Dr. Jack Lesko, Dr. Barbara Lockee, Dr. Elizabeth Grabau, Ms. Christa Thomas.

Call to Order

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

Dr. Inzana called for a motion to approve the minutes from the last meeting on October 17, 2007. The motion was made by Ms. Heidbreder, seconded by Dr. Stephen Boyle and the motion was unanimously passed.

Introductions were done. Dr. Inzana stated that one member has been missing and that is Jack Lesko who asked to step down earlier this year. Dr. Inzana stated he would check on the status of finding a replacement for Dr. Lesko

Dr. Inzana opened the meeting stating that there have been some minor changes made to Policy 13000. A major procedure change that actually is not reflected in the policy is that instead of disclosures coming to the Research office first and then being transferred to VTIP, Mark Coburn had requested that they go to VTIP first for approval in order to speed up the process. Mr. Coburn provided history stating that approximately 20 years ago, invention disclosures actually did go directly to VTIP. At that time, there was the thought that VTIP had lost its entire professional staff and resources weren't there to process these disclosures correctly and this review task was turned over to the Research division. This past January, the final two licensing associates of a five licensing associate hire were hired. A new IP coordinator was hired and is up to speed. This review process is now handled by VTIP and a pdf copy of the disclosure is sent to the Research division. It has improved customer service and invention disclosures have doubled in the first three months since this change on January 1, 2008. There have been 48 invention disclosures in the first three months of this year.

Minor changes proposed to Policy 13000 include:

- 1) Date to be revised.
- 2) Starting on page 2 and throughout, Dr. Inzana's title as Associate Vice President for Research Programs updated. Under Section 2.1 Organization, Associate General Counsel should be changed to General Counsel; Executive Vice President of Virginia Tech Intellectual Properties should be changed to President.
- 3) Under Section 2.2, B (2), the term "Confirmation" to be changed to "Confirm the determination."
- 4) Under Section 2.2, B (4), "as needed" to be added to statement regarding coordination of evaluation and recommendation to Virginia Tech Intellectual Properties, Inc. (VTIP) of technical merit, economic potential and protection/marketing priority.
- 5) Under Section 3. Procedures and Section 4. Definitions, the word "reserved" to be added indicating these areas are intentionally left blank.
- 6) References to "See Committee Practices" throughout the Policy should be deleted.

After changes are made, a copy will be put on the OVPR website. Ken Miller pointed out that it needs to be put on the University website as well where all the official policies are along with the date of revisions and approval. These policy changes will go through the Provost's office. Mark Coburn reported that the policy is accessible through the VTIP website, as well as announcements about the change in invention disclosures and information about technology transfer, as well as the staff's pictures and contact information.

Carol Roberson stated that things are going well working together with VTIP. In the near future, the plan is to develop an Intellectual Property site on the University website. The research office is in the process of hiring a person to do web design, so hopefully this person will be able to assist in developing this site.

Based on the changes discussed for Policy 13000, Dr. Inzana asked for a motion to approve the document. A motion was made by Dr. Stephen Boyle, seconded by Dr. Steve Sheetz and unanimously passed.

Adjournment

Following the updates and discussions on negotiating intellectual property terms in research agreements, Dr. Inzana asked for any other business. There being no other business, a motion was made and unanimously passed to adjourn. The meeting adjourned at 12:55 p.m.