

Virginia Polytechnic Institute and State University

Intellectual Property Committee Meeting

October 21, 2015, 12:00-1:00p.m.

325 Burruss Hall

Full Committee

The Intellectual Property Committee (IPC) met on October 21, 2015.

The following members were present: Srinath Ekkad, Dennis Dean, Wendy Vaughn, Ken Miller, Mark Coburn, Rafael Davalos, Katrina Loan, Ed Dorsa, Steve Capaldo, Justin Barone, Willard Eyestone, Gail McMillan, Frank Fitzgerald, Laurie Coble, and Mike Badzmierowski.

Guest(s): Mike Miller, Scot Ransbottom, and John Rudd.

Call to Order

Srinath Ekkad called the meeting to order at 12:00p.m. Introductions were made of our three guests Mike Miller (VTIP), John Rudd (OSP), and Scot Ransbottom (VP Information). There are a few issues that have come up and the committee needs to address. Discussion was made regarding crowdfunding and the article from U.C. Berkley that was shared with the committee. The Development Office and their view on crowdfunding will need to be discussed. Srinath suggested that the committee minutes be approved electronically in the future. Wendy Vaughn will send out the minutes to the committee members. No response will be considered a positive vote.

Mike Miller from VTIP shared a product with the committee that one of our VT faculty invented, and hoped to mass produce and share with high schools in the Commonwealth to encourage students in STEM. The faculty member filed an invention disclosure, unfortunately there is a company who already has a patent on this type of invention. The background IP seemed to be infringing, so VTIP contacted a local attorney to do a background search on the patent situation. The attorney went over the particulars and stated what the faculty could and could not do. VTIP contacted the company who hold the patent and asked if they could get a non-commercial educational license to allow him to produce his version of the product and give them to high school students to include their company logo. The company said that they have infringing products from Asia flooding the market, and they are spending time and money fighting off those infringers. As a rule, they do not license intellectual property. As a Virginia Tech employee, there is not a way to go forward to do this, as it would open up the university to liability.

Technology Fee

John Rudd and Frank Fitzgerald discussed technology fee with the committee. John explained a situation where Virginia Tech is competing with other institutions for research dollars are offering

innovation and creative solutions for private sector sponsors. Virginia Tech will need to do the same thing to compete, and Virginia Tech has piloted something over the last few years. Sponsored Programs are looking to have a consistent policy so that the same approach is followed in the future. This will allow a more rapid approach for faculty dealing with industry projects. The IP policy allows for this under the current policy, and Sponsored Programs Office is seeking input from the Intellectual Property Committee when developing this procedure so that the sponsors can have this information upfront. There are standard IP options, a non-exclusive license, an exclusive license, or an option period (6 month) to exclusively negotiate IP. Sponsored Programs has been piloting the exclusive license to the project IP and the right to sublicense to others. Typically the charge is 10 to 20 percent. There are some issues that will need to be addressed on the exclusive license. An example shared was regarding a company that paid 15 percent upfront and recently asked to extend their agreement by a year and a half and was not interested in paying another fee. A per project year condition in the policy is suggested for this kind of instance. A question was asked regarding background IP, and it is disclosed in the agreement, and will be included in the procedures.

Internet2 Tier MOU

Scot Ransbottom discussed with the committee regarding seeking to pay to participate in a consortium which is developing the tools used for federated login. There are terms in the MOU that are not favorable, and negotiations are being discussed. The consortium is an evolution of which allows local researchers at different institutions to sign in with their local credentials. The language in the MOU indicates that they will own the IP that is developed in the dialogue states that they will release it open source back to Virginia Tech, however there is a clause in there saying third party (they may) release open source. These are the main issues with the MOU. The risk of not being at the table for these discussions, as Virginia Tech has been a long term leader in developing identity management, and losing a seat at that table would be of significant concern.

Scot handed out copies of the MOU, and legal agreement. He specifically noted paragraph (5) stating the participant agrees that all IP will be owned by Internet2 or the designated holder. The IP committee is being asked for support to move forward to request an exemption from President Sands. A motion was made to approve, and seconded. The motion passed unanimously.

With no further business the meeting was adjourned at 1:12p.m.

Respectfully submitted,
Wendy Vaughn
OVPR Support