

Office of Research

Minutes of the

ADVISORY COMMITTEE ON PATENTS AND COPYRIGHTS

The Patents and Copyrights Committee met on Tuesday, October 11, 2005, at 11:00 a.m., in the Deans' Conference Room, Derryberry Hall Room 200, with Dr. Mohamed Abdelrahman, Chairperson, presiding.

Present

Mr. Mohamed Abdelrahman
Dr. Douglas Airhart
Dr. Ali Alouani
Dr. Douglas Airhart
Mr. Michael Baswell
Dr. Robert Clougherty
Mr. Robert Cravens
Ms. Nancy Mielke
Dr. Christine Miller
Dr. Francis Otuonye, Executive Officer
Dr. Jan Turner

Absent

Dr. Shelia Green
Dr. Glen Johnson
Dr. Scott Northrup

Also present: Mr. Mark Lynam and Mr. Louis Svendsen.

Dr. Alouani called the meeting to order. The agenda was as follows (see Attachment A):

1. Approval of the agenda.

The agenda was approved as distributed.

2. Approval of the Minutes of the September 13, 2005, meeting.

The minutes of the meeting on September 13, 2005, were approved as distributed.

3. Louis Svendsen, TBR Assistant Attorney General, regarding his responsibilities at TBR and how he can assist TTU in marketing the IP in TTU's portfolio.

Mr. Svendsen told the committee about his background and that he had been with TBR for about two months. He stated he will assist TTU and other TBR institutions in finding potential licensees for IP developed by the University. Based on the field to which an invention applies, Mr. Svendsen will attempt to identify appropriate companies that may be interested in licensing patents or other intellectual property in TTU's portfolio.

Dr. Otuonye stated that Mr. Svendsen was on campus last week and met with him and Mark. They went through the process and procedures for filing of patents. He stated

Mr. Svendsen was provided a list of the invention disclosures and that he has that information. Mark stated that TTU has all the prior art searches that Joe Giampapa sent TTU and, if needed, provide this list to Mr. Svendsen.

4. Approved an agreement between TTU and San Diego State University (SDSU) to license a technology developed by Stephen Robinson.

Mark distributed information related to Dr. Robinson's request, which stated that Dr. Robinson has been the subcontractor for San Diego State University (SDSU) on the "Constructing Physics Understanding" award. SDSU is the awardee on this NSF sponsored project. The original subcontract agreement was silent on IP (patents and copyrights), but it was agreed that SDSU would be assigned all rights in data. As a result of the collaboration, a joint creation has been made "Physics for Elementary Teachers (PET). SDSU now wishes to license PET. SDSU will be responsible for the administration and marketing of PET. Expenses will be recovered from the Net Royalties. Once expenses are recovered, remaining Net Royalties will be shared evenly (twenty (20) percent each among SDSU, TTU, Dr. Robinson, and two other collaborators. If SDSU fails to find a licensee within five years, the parties will consult and determine another mutually agreeable course of action. If SDSU finds licensee, but the licensee terminates its agreement, SDSU will attempt to find another licensee for a period of five years. If unsuccessful at this point, the parties will consult and decide on a mutually agreeable course of action.

Dr. Robinson was present and stated that he has been working on this project with colleagues at San Diego State University and the University of Colorado at Boulder for the last four years. The project has been administered through San Diego State University. A publisher has been identified according to Dr. Robinson, and the result is the agreement distributed.

Dr. Deivy stated that as far as the system in general, he thought textbooks and scholarly work did not require this committee's approval.

According to Dr. Otuonye, if university resources are used, TTU should be made aware of it before faculty get to the point of marketing the work. He stated this is TBR policy.

Mark stated that because the royalty arrangement (as above stated) is different in this case, it needed the committee's approval.

Motion. Dr. Airhart moved approval of the request. Dr. Abdelrahman seconded. The motion carried.

5. Information on patents in TTU's portfolio.

Mark stated that we discussed in the prior meeting that we do have provisional patents for one year protection. We currently have two provisional patents that have not expired. We also have the current patent application of Dr. Martha Wells and Dr. Glenn Cunningham for "Optically Based Instrument to ID Organic Matter in Water Solution" that has not expired. The following are pending patent applications:

1. Multiple Description Coding using Transform and Data Fusion (Tian/Rajan)

2. Optically Based Instrument to ID Organic Matter in Water Solution (Wells/Cunningham)
3. Flexible AC Current Meter using Integrated Magnetic Fields (Mahajan/Ingram (TVA))
4. Automatic Prescription Verification System (Alouani/Currie)
5. Automatic Prescription Verification System Continuation-in-Parts (Additional matter for consideration disclosed by Currie/Renfro/Rhodes)
6. A Compliant Parallel-Gravity Suspension System for a Tracked, Climbing Robot (Canfield/Beard)
7. Non-optical Explosive Sensor Based on Two-track Piezoresistive Microcantilever (Hawk, Pinnaduwege, Thundat (ORNL); Yi (TTU)). From the patent application filed by UT-Batelle
8. Capacitance-Based Device for Sand-mold Characterization (Abdelrahman, Vaidyanathan, Baswell)

Mark stated that Jessica Costa has been handling these for us, but he does not know if she will continue to do so. Several provisional patents have already expired according to Mark.

Mr. Svendsen stated that it usually takes about eighteen months to get something processed through the patent office. He stated that he has been working with one provider whose firm does these matters on a flat fee basis.

Dr. Otuonye stated that for the benefit of Dr. Miller, we have three patents in the history of Tennessee Tech. We have eight that are pending within the past two or three years. We have five provisional patents that have expired. We have two provisional patents that are pending, and one invention disclosure with prior art search. He stated one of the problems we have is that we do not have anybody to look at provisional patents and make a decision about commercial viability and whether the invention has any value. He stated that we have been relying on prior art search from NERAC. He does not want to accumulate all of these if we are not going to do anything with them. We need someone to evaluate them and make sure they are economically viable before going through with them according to Dr. Otuonye. Someone is needed to do the first office evaluation and file the application. The inventions can be returned to the inventor if we do not do anything with them.

6. Such other matters.

There were no such other matters.

7. Adjournment.

There being no further business, a motion was made, seconded, and passed to adjourn the meeting at 11:55 a.m.

Respectfully submitted,


Sue Smith, Secretary