

INTELLECTUAL PROPERTY POLICY

Approved by the Faculty Senate 2/23/99 and the Board of Regents 6/8/99.

Foreword

In the course of conducting their University-administered activities, the faculty, staff, and students often create intellectual property that may be protectable by patent, copyright, or other means. The University wants a policy that encourages the treatment of such property in ways beneficial to the creators of such works, as well as to the University and to the public. To these ends, the University and the creators should assist each other in identifying, evaluating, protecting, and exploiting such property. Such efforts will also help in recognizing the creation of intellectual property as a significant academic achievement.

Accordingly, this Policy seeks to recognize such achievements; to provide advice and assistance to faculty, staff, and students; to promote a clear understanding of legal relationships; and to realize and optimize the benefits of potentially valuable intellectual property to the creators as well as to the University and the public. A feature of this Policy is to encourage creators to perform key roles in the utilization of intellectual property.

This Policy governs the ownership, protection, and transfer of Scholarly/Artistic Works (as defined in Section 2.2) and Technological Works (as defined in Section 2.3) created by University faculty, staff, and students. Inventors and authors are referred to in this Policy as creators. It is the purpose of this Policy to encourage, support, and reward scientific research and scholarship, and to recognize the rights and interests of creators, the University, and the public.

However, the University's commitment to teaching and research is primary and this Policy does not diminish the right and obligation of faculty, staff, and students to disseminate research results for scholarly purposes. The latter is considered by the University to take precedence over the commercialization of Scholarly/Artistic and Technological Works.

Summary

This summary of the Intellectual Property Policy is intended only as an aid to reading the Policy. Wording in the summary should not be relied upon as a substitute for the Policy.

1. The Policy applies to all University faculty, staff, and students, hereafter referred to as creators. (See Article 1.)
2. The University's commitment to teaching and research is primary, and the right and obligation of creators to disseminate research results for scholarly

purposes takes precedence over the commercialization of Scholarly/Artistic and Technological Works.

3. Faculty members working with students on research projects must inform students in advance of the terms of this Policy and of any obligations of nondisclosure or confidentiality.
4. All inventions, tangible research results, and artistic and literary works are subject to this Policy and to federal and state laws and regulations governing intellectual property. (See Sections 2.2 and 2.3.)
5. All Scholarly/Artistic Works are owned by creators unless they were created with substantial directed investment of University facilities or funds or capitalize on affiliation with the University. (See Section 2.2.)
6. Technological Works (inventions and tangible research results) that are owned by the University under this Policy are:
 - those created using University facilities or funds; and
 - those created without University facilities or funds but within the scope of the creators' employment (determined by the creators' recent teaching, research, or other University activities).

Exception is made for inventions and tangible research results that were assigned by creators to an outside entity pursuant to a consulting agreement that is consistent with other University policies (including conflict of interest) and that has received prior approval by the creators' department Chair and Dean or Unit Director. (See Sections 2.3, 2.4 , and 2.5.)

7. The Policy is administered by the Provost or his/her designees. (See Article 3.)
8. Royalties from commercialization by the Science & Technology Corporation @ UNM (STC, the main commercialization arm of the University) of inventions, tangible research results, and other types of intellectual property are allocated (see Section 2.6):
 - 40% equally among the creators
 - 40% to the Science & Technology Corporation @ UNM
 - 20% to the University.

9. Standard procedures for review are described in Article 4.
10. Redress of disputes is covered in Articles 5 and 6.

1 Scope

This Policy applies to all University faculty, staff, and students (hereafter referred to as creators). Reference to this Policy should be made in the University's *Business Policies and Procedures Manual* as well as in the University's *Pathfinder*. Faculty members working with students on research projects must inform students in advance of the terms of this Policy and of any obligations of nondisclosure or confidentiality.

2 Rights in Scholarly/Artistic and Technological Works

2.1 Commercialization

The term Commercialization shall mean the entire process of gaining commercial value for intellectual property, from seeking intellectual property protection to licensure of, granting of access to, or sale of said intellectual property.

2.2 Scholarly/Artistic Works

2.2.1

Scholarly, artistic, literary, and musical works in any medium are collectively referred to as Scholarly/Artistic Works. This category includes all materials developed by faculty and other personnel directly involved in instruction.

2.2.2

All rights in Scholarly/Artistic Works are owned by the creators, with three exceptions:

- Works created by pre-arranged contractual obligation with substantial directed investment of University facilities or funds (exclusive of creators' salary) or in the performance of a written university work assignment or commission to create such a work. All rights in such works are owned by the University.
- Works that capitalize on an affiliation with the University by explicit labeling of the work to gain a market advantage, beyond the noting of the creator's affiliation. Such uses of the University's name, seal, or logo are regulated by Section 1010 of the University *Business Policies and Procedures Manual* (see also Section 2.5). All rights in such works are owned by the University.
- Works created under a sponsored agreement that requires rights to be relinquished to the sponsor.

2.3 Technological Works and Technical Information

2.3.1

The term Technological Works means all inventions, discoveries, and other innovations that are protectable by patents, copyrights, mask works, or other means. Innovations include, for example, computer programs, integrated circuit designs, databases, and other technical creations.

2.3.2

The term Technical Information means all tangible and intangible research results, including data, graphs, charts, lab notebooks, technical drawings, biogenic materials, and samples.

2.3.3

All rights in Technological Works and Technical Information created by University creators with the use of University facilities or funds administered by the University are owned by the University, with income from commercialization of Technological Works distributed in accordance with this Policy.

2.3.4

All rights in Technological Works and Technical Information created by creators without the use of University facilities (with the exception of the University libraries) or funds administered by the University, but that fall within the creators' scope of employment (see Section 2.3.5) at the University are owned by the University. However, the University ordinarily will assert no ownership rights or interests in the following two instances:

- Technological Works and Technical Information created pursuant to outside employment (see the *Faculty Handbook*) under a consulting agreement between a faculty member and an outside entity in which Technological Works and Technical Information are assigned to said entity. The consulting agreement must be consistent with University policies, including conflict of interest policies, and must be disclosed in writing and agreed to by the creators' Chair and Dean or Unit Director in advance of execution of the consulting agreement. (Contracts in existence at the time of adoption of this Policy must be disclosed within sixty (60) calendar days.)
- Technological Works and Technical Information created pursuant to independent research or other outside activity that is consistent with University policies, including conflict of interest policies, and that was disclosed in writing and agreed to by the creators' Chair and Dean or Unit Director at the beginning phase of this research activity.

2.3.5

For purposes of this Policy, factors considered in determining the scope of a creator's employment normally shall include the relationship of the Technological Works and Technical Information to that creator's recent teaching, research, and other University activities, as well as activities stipulated in any appointment contract.

2.3.6

Disagreements concerning ownership and other matters regarding this Policy can be appealed to the Intellectual Property Committee. (See Sections 3.2, 4.1, 4.3, and 5.)

2.4 UNM Intellectual Property (UNM IP)

For purposes of this Policy, UNM IP means Scholarly/Artistic Works, Technological Works, or Technical Information deemed to be owned by the University. (See Sections 2.2 and 2.3.)

2.5 Use of UNM Name, Logos, or Trademarks

Commercial use of the University's name, seal, logos, or trademarks requires prior written approval from the Office of the Vice President for Institutional Advancement or (for the logo) the Director of Marketing and Licensing in the Athletic Department. (See Section 1010 in the University *Business Policies and Procedures Manual*.)

2.6 Costs, Royalties, and Other Commercialization Income

2.6.1

In the case of collaborations between the University and outside entities, the provisions of Section 2.6 are applicable only to the ownership interests of the University.

2.6.2

The University and/or the Science & Technology Corporation @ UNM (STC) shall normally bear the costs they have elected to incur in securing protection for intellectual property (including evaluation, prior art searches, preparation, filing, and prosecution of any patent application, and issuance and maintenance of patents issuing therefrom) and commercializing said property, until said property is licensed, assigned, or otherwise commercialized.

2.6.3

Prior to distribution of royalties (which, for purposes of this policy, are deemed to mean all income received by the University or the STC for a license of UNM IP, but

does not include payments for research, development, or reimbursement of patent costs), the University and the STC shall be reimbursed for all costs incurred in securing intellectual property protection, all out-of-pocket commercialization costs, and any litigation costs.

2.6.4

Royalties received by the University from commercialization of UNM IP by the STC shall be divided as follows:

- Forty percent (40%) to be divided equally (unless unanimously agreed to the contrary by them) among the creators;
- Forty percent (40%) to the STC; and
- Twenty percent (20%) to the University to be invested and administered by the Associate Provost for Research (on main campus) or the Vice-President for Health Sciences (at the Health Sciences Center). Accrued revenues will be used, in consultation with faculty, to support University units involved in ongoing research and educational pursuits relevant to commercialization efforts or will otherwise be administered as required by sponsor(s).

2.6.5

In any case where royalties shall be represented by shares of stock or other intangible assets, these assets shall be held in the name of the University or the STC and managed by them. At the discretion of the managing unit (the University or the STC), such stock or other intangible assets may be divided prior to liquidation and distributed in the proportions specified in Section 2.6.4.

2.7 Duties of Creators

2.7.1

All provisions of Section 2.7 apply to individual efforts of creators and to collaborative efforts with outside entities.

2.7.2

The University's commitment to teaching and research is primary, and the right and obligation of creators to disseminate research results for scholarly purposes take precedence over the commercialization of Scholarly/Artistic and Technological Works.

2.7.3

Notwithstanding, each UNM IP, including those created in collaborative efforts with outside entities, shall be reported by the creators in writing to the Patent Administration Office (PAO) on forms provided by it as soon as possible (preferably within two months after conception). The PAO shall in turn make such disclosures as required by federal and state laws and regulations.

2.7.4

During as well as after their association with the University, creators shall assist and cooperate with the PAO's and the STC's efforts to secure intellectual property protection and pursue commercialization of Scholarly/Artistic and Technological Works, including executing appropriate assignments to perfect the University's legal rights.

2.7.4.1 Creators shall make available to the PAO and the STC all Technical Information necessary to support intellectual property protection.

2.7.4.2 Creators may, at their discretion, retain a copy of any Technical Information to use in scholarly pursuits.

2.7.5

In the event the University or the STC, in consultation with the Intellectual Property Committee (IPC), takes legal action against a creator who refuses to execute necessary documents or otherwise fails to act in accordance with this Policy, any costs reasonably and necessarily incurred by the University and/or the STC as a direct result thereof shall be deducted from that creator's share of royalties.

3 Administration of the Intellectual Property Policy

3.1 Provost of the University

The Provost, or designee, shall be responsible for interpretation, implementation, and enforcement of this Policy. The Provost shall be responsible for University relations in areas where this Policy affects the University community, governmental authorities, private research sponsors, industry, and the public.

3.2 Intellectual Property Committee (IPC)

3.2.1

The IPC is a Faculty Senate committee. The purpose of the IPC is to provide faculty oversight of intellectual property management by the University and the STC. It does so by:

3.2.1.1 Making recommendations about pursuit of intellectual property protection for particular Scholarly/Artistic and Technological Works, and making recommendations about commercialization of UNM IP.

3.2.1.2 Adjudicating and mediating intellectual property rights. (See Articles 5 and 6.)

3.2.2

The IPC shall comprise one faculty representative from each College, including the General Library, and two faculty representatives from among the Level II and Level III Centers that report to the Associate Provost for Research. The Associate Provost for Research, the Vice-President for Health Sciences, the Patent Administrator, and the President of the STC, or their designees respectively, are nonvoting members *ex officio*. At all times, the IPC shall include at least three faculty members who are creators of Technological Works.

3.2.2.1 Two thirds of the voting members shall constitute a quorum.

3.2.2.2 Initially, one third of the faculty members of the IPC will have a one-year term, one-third a two-year term, and one-third a three-year term, as determined by the IPC Chair. After the initial term, new members of the Committee will be named for three-year terms. In the event that a member is appointed in middle of a term, he/she will fill the remainder of that term.

3.2.2.3 If at any time there are fewer than three IPC members who are creators of Technological Works, the Faculty Senate, in consultation with the Research Policy Committee (RPC), will appoint additional members to the IPC as needed to fulfill this requirement.

3.2.2.4 The Chair will be elected annually by the IPC from among its voting members.

3.2.3

The Chair may call upon experts from inside or outside the University to help in reviewing invention disclosures and to provide informal advisory opinions.

3.2.4

A quorum of the full voting membership of the IPC is required for adjudication of intellectual property rights, whereas a simple majority of those present suffices for deciding other committee business. The IPC's determinations may be appealed to the Provost, with notification to the RPC.

3.2.5

The IPC shall meet at least monthly during the academic year.

3.2.5.1 Due to the confidential and proprietary subject matter, IPC meetings are closed to all except members, creators whose work is under discussion, the creators' representatives, and experts consulted under Section 3.2.3.

3.2.5.2 Mechanical recording devices will be used to record hearings and proceedings. These recordings or the transcripts thereof shall be treated as confidential information by all parties involved, until intellectual property protection is secured or all parties agree to the disclosure.

3.2.5.3 Minutes shall be kept of all IPC meetings and IPC Subcommittee meetings, recording actions, determinations, and topics of discussion. The minutes are public records. Minutes shall not contain any confidential information.

3.2.5.4 The PAO is the office of record for IPC minutes, recordings, transcripts, and accompanying documentation.

3.3 Patent Administration Office (PAO)

3.3.1

The PAO shall provide legal advice and support to the faculty, staff, students and administration in the areas of copyright, trademark, patent, material transfer agreements, federal statutory compliance and any other intellectual property matters; and assist the University's sponsored research services to ensure that the intellectual property provisions of sponsored research agreements are consistent with this Policy. Consistent with its University role, the PAO may also assist the STC with other matters from time to time.

3.3.2

The head of the PAO, hereafter the Patent Administrator, is authorized with the approval of the Provost and the RPC, to promulgate and publish information and procedures to implement this policy.

3.4 Science & Technology Corporation @ UNM (STC)

The STC was granted by the University a right to take assignment of UNM IP pursuant to a Memorandum of Agreement (MOA) between the University and the STC, for the purpose of active support by the STC for commercialization of UNM IP. The STC, among other duties as described in the MOA, shall pursue the licensing of UNM IP by assessing the market for same, selecting the means by which they shall be commercialized, negotiating commercialization agreements, overseeing

commercialization activity, and receiving and distributing royalties to creators and the University in accordance with this Policy.

3.4.1

The mission of the STC is to serve the University of New Mexico by rewarding University inventors, increasing the University's non-governmental sponsored research, and contributing to economic development in New Mexico.

3.4.2

The full text of the MOA can be obtained from the STC or the PAO.

4 Review of Disclosures and Commercialization

The University and the STC shall expedite processing of reviews of disclosures and commercialization decisions.

4.1 Review of Disclosures

4.1.1

The University may require creators to refrain from publishing for a reasonable period not to exceed ninety (90) calendar days from the date of disclosure, in order to enable a sponsor or the University to evaluate a UNM IP and determine whether to pursue any form of intellectual property protection. The University and the STC shall cooperate in accelerating commercialization review to enable creators to publish their work in theses and dissertations or to pursue patent protection in cases of statutory bars.

4.1.2

When the PAO has accepted an appropriately completed disclosure as specified in Section 2.7.3, the Patent Administrator shall forward a copy to the STC within one (1) week.

4.1.3

The STC shall determine whether to obtain a prior art search. If a prior art search is obtained, it shall be submitted to the PAO and the creator(s) who shall be asked to provide written comments on the search. Results of the search, or a decision not to conduct one) shall be submitted within sixty (60) calendar days of disclosure.

4.1.4

The PAO shall forward copies of all materials to the IPC and the STC upon receipt of the creator(s)'s comments, or as soon as notification is received that no prior art search is requested.

4.1.5

At its next meeting, the IPC shall provide advisory comments to the STC. Within ninety (90) calendar days of receiving the comments from the IPC, the STC shall make a written determination as to whether or not commercialization is to be pursued.

(a) The STC may find the work described in the disclosure to be of significant interest, but insufficiently developed or documented for commercialization. In that case, the STC may recommend that the disclosure be returned to the creator(s), with suggestions for further development or requests for additional documentation. The creator(s) may then submit a new disclosure on the more fully developed or documented work.

(b) In certain cases, the STC may determine that a disclosure should be held in abeyance because further similar inventions are anticipated within nine (9) months. In such cases, the STC may delay processing the disclosure for up to nine (9) months, or even longer with the written consent of the creator(s).

4.1.5.2 If no determination is made by the STC within the deadline, the creator(s) shall have the option of extending the deadline or of sending a registered letter to the STC requesting a determination within ten (10) UNM business days. If the STC does not respond within this period or responds that it will not pursue commercialization, responsibility for commercialization shall shift to the University and the creator(s). The University and the creator(s) will attempt to commercialize the UNM IP within a mutually agreeable period; if these efforts are unsuccessful, the creator(s) may require that the UNM IP be released to them, subject to sponsor approval.

4.1.6

Once the STC has determined to pursue commercialization, it will make a decision about intellectual property protection within one hundred and eighty (180) calendar days, not to exceed nine (9) months from the date of disclosure.

4.1.7

If, at any step during the process, both the PAO and the STC determine not to pursue the commercialization of a particular UNM IP, the University shall give the creator(s) the option of ownership, subject to sponsor approval.

4.1.7.1 If the University or the STC shall have expended funds for prior art search and patent prosecution, the creator(s) shall be required to reimburse such expenses only from income received from commercialization of the UNM IP.

4.2 Reporting

Within twelve (12) months of disclosure, and every six (6) months thereafter, the STC shall provide to the PAO and to each creator whose disclosure is in the hands of the STC a report detailing the current state of commercialization of the disclosure, including all steps taken in patenting, marketing, and licensing efforts.

4.3 Commercialization

In the event the STC has not made a reasonable effort to commercialize the UNM IP within two (2) years of its decision to commercialize (as per Section 4.1.5), the University or the creator(s) may request the STC to return the UNM IP to the University. If the STC decides to remain in charge of commercialization, the University or the creator(s) may petition in writing the IPC to determine whether the STC has been and is making a reasonable effort to commercialize. Appeals of the IPC's decision will follow the procedure defined in Sections 5.1.3 and 5.1.4 . If the UNM IP is returned to the University, the University and the creator(s) will attempt to commercialize the UNM IP within a mutually agreeable period; if these efforts are unsuccessful, the creator(s) may require that the UNM IP be released to them, subject to sponsor approval.

4.4 Filing Deadlines

4.4.1

At least one hundred twenty (120) calendar days in advance, the PAO shall advise the STC and the creator(s) of Technological Works of the following three deadlines:

- A statutory bar to filing a U. S. patent application or provisional application;
- Initiation of filing for foreign patent rights under the Paris Cooperation Treaty (PCT); and
- Entry into national status under the PCT.

4.4.2

Within thirty (30) calendar days after the notification from the PAO, the STC shall notify in writing the PAO and the creator(s) whether or not it intends to continue licensing negotiations or is committing itself to meeting the above deadlines; in the event the STC does not intend to continue licensing negotiations and does not

commit itself to meeting the deadlines, the University shall release the rights to the creator(s), subject to sponsor approval.

5 Adjudication

5.1 Determination of Rights

See Sections 2.2 and 2.3 governing ownership rights. In the event a creator does not believe the University is entitled to the rights in Scholarly/Artistic and Technological Works, the creator may seek a determination or a waiver of the University's interests in said Works. The PAO will provide the creator with a Determination of Rights Form which must then be completed and returned to the PAO, with all documents supporting the creator's claim. The PAO will forward a copy of the Form and supporting documentation to the STC for comments.

5.1.1

The Patent Administrator shall forward the Determination of Rights Form with attachments and the PAO's and the STC's written comments (the "Record") to the IPC.

5.1.2

The IPC shall review the Record and prepare a written determination within sixty (60) calendar days, a copy of which will be sent to the creator(s). If any creator disagrees with the determination, that creator may appeal the determination in the following manner:

5.1.2.1 Within ten (10) UNM business days of receipt of the determination, the creator may request of the Chair of the IPC, in writing, the opportunity to make an oral presentation before the IPC. The IPC shall schedule the earliest possible date available for the oral presentation and shall notify the creator. The creator shall submit to the PAO (which will forward a copy to the STC) any supplementary documentary materials to be entered into the Record prior to the date established by the IPC for the oral presentation. The PAO and the STC may then add responsive written comments to the Record.

5.1.2.2 The IPC, according to Section 3.2, shall consider only the Record and the proceedings of the hearing in making a final determination. The IPC shall make its final determination in writing, to include its rationale, within twenty (20) UNM business days of the hearing and communicate it to the creator within a week thereafter.

5.1.3

The creator, the PAO, or the STC may appeal the IPC's final determination to the Provost by written request to the Provost within ten (10) UNM business days of receiving notice of the IPC's final determination. The Provost shall notify the RPC, and meet with or solicit written arguments on the matter from all interested persons and the University. Within sixty (60) calendar days of receiving the creator's written request, the Provost shall make a final decision.

5.1.3.1 If the dispute involves rights in Scholarly/Artistic or Technological Works being claimed by the Provost, only the President shall have authority to review the IPC's final determination and make a final decision.

5.1.3.2 If the dispute involves rights in Scholarly/Artistic or Technological Works being claimed by the President, only a designee of the Board of Regents shall have authority to review the IPC's final determination and make a final decision.

5.1.4

Nothing in this section is in derogation of the Regents' discretionary right of review.

5.1.5

All materials produced by the creator and the University under this section shall be retained as a permanent University record. This record shall be made available by the PAO to any party upon consent of the owners of the intellectual property.

5.2 Determination of Inventorship or Authorship among Creators

In the event individuals believe they are creators of Scholarly/Artistic or Technological Works, and have not been acknowledged as such at any point in the protection and commercialization process, they may petition the PAO to correct the omission. The PAO will provide the petitioners with a Determination of Inventorship/Authorship Form which must be completed and returned to the PAO with any relevant attachments for processing.

5.2.1

Upon receipt and review, the Patent Administrator shall inform the acknowledged creators, send them Determination of Inventorship/Authorship Forms, and solicit their written comments. The Patent Administrator shall make a determination within thirty (30) calendar days based on all information received.

5.2.2

Should there be disagreement with the PAO's determination, the PAO shall forward these comments, the Determination of Inventorship/Authorship Forms and attachments, with the Patent Administrator's comments (the "Record") to the IPC.

The IPC will review the Record and prepare a written determination within sixty (60) calendar days, a copy of which shall be sent to all parties.

5.2.3

Should any party disagree with the IPC's determination, that party shall submit the issue to binding arbitration as provided by the Determination of Inventorship/Authorship Forms as executed.

6 Mediation of Disputes among Creators

It is the University's policy that the creators share equally in division of royalties and other commercialization income unless otherwise agreed to by them in writing. (See Section 2.6.4.) In order to assist creators, the IPC may, at its discretion, provide creators with informal mediation and an advisory opinion about such matters. The PAO will provide a Co-Inventors Agreement Form upon request.

7 Related Provisions

7.1 Flexibility

The University may accept, on terms beneficial to the University, a voluntary assignment of a Scholarly/Artistic or Technological Work. It may waive, assign or grant (subject to the MOA with the STC) all or part of its rights in any Scholarly/Artistic or Technological Work under terms and conditions deemed appropriate and beneficial for the University.

7.2 Legal Actions

The University may take such action as it deems appropriate to defend or enforce any patent, copyright, or other intellectual property right. In the case of claims against the University, settlement of a claim or conduct of litigation shall be within the exclusive control of the University.