

INTELLECTUAL PROPERTY POLICY

Amended by the Faculty Senate 2/26/02 and the Board of Regents 5/10/02.
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 Disclosure Requirements Imposed by Sponsored Research Agreements

Sponsored research agreements often carry requirements that any inventions or other intellectual property created in the performance of the agreement must be disclosed to the sponsor. Such agreements often also impose other requirements pertaining to commercialization of such intellectual property. Upon execution of any sponsored research agreement, the Office of Research Services, or the HSC Pre-Award Office, as appropriate, shall inform the principal investigator of any such requirements pertaining to intellectual property resulting from the work. In addition to sponsored research agreements from industry and government, other agreements facilitating research may impose intellectual property disclosure requirements, such as grants, equipment loan and transfer agreements, and MTAs.

When UNM IP results from work under an agreement creating disclosure obligations to sponsors or other third parties, then the Principal Investigator shall be responsible for ensuring disclosure of the UNM IP to the Patent Administration Office (PAO). The disclosure shall be made to the PAO as soon as possible (at least within two months of creation). The disclosure shall be made by completing forms promulgated by the PAO.

The PAO shall in turn make such disclosures as required by federal and state laws and regulations, and by third party agreements of which it has been made aware.

2.7.4 Voluntary Disclosure

If the invention is not subject to third party disclosure obligations, then the creators have the choice as to whether to disclose the IP to the PAO. Any disclosures shall be made on forms provided by the PAO. Creators may consult with either PAO or STC as to the advisability of disclosure. Creators who choose not to disclose their UNM IP have no obligation to participate in the commercialization process outlined herein. Creators who choose to disclose thereby agree to participate in the commercialization process outlined herein.

Creators may not commercialize UNM IP created by them except by disclosing to PAO and following the procedures outlined herein.

2.7.5

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 disclosed UNM IP by executing all appropriate legal documents, including assignments, to perfect the University's legal rights.

2.7.5.1 Creators shall make available to the PAO and the STC all Technical Information necessary to support intellectual property protection of disclosed UNM IP.

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

2.7.6

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 pertinent to disclosed UNM IP 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.

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Summary of Proposed Changes to UNM's Intellectual Property Policy

Attached is a line-by-line summary that briefly describes proposed changes to the UNM Intellectual Property Policy ("IPP"). In drafting these changes, the Research Policy Committee did not set out with the goal of completing a comprehensive revision of the IPP. Instead, the focus of the proposed changes falls mainly in two limited areas: 1) changing UNM and STC.UNM procedural matters to match (or optimize) actual practice in IP commercialization as it has evolved in the years since the policy was adopted; and, 2) limiting the role of the Intellectual Property Committee ("IPC") to dispute resolution in the case of inventorship questions between the University and creators. The proposed changes take away the IPC's role in making recommendations about commercialization of UNM IP – a function that it has not done for many years.

The proposed changes to the IPP do not, for instance, include changes to rights in scholarly and artistic works (Article 2) or changes to the definitions of technological works such as software (Section 2.3). Changes to these and other parts of the IPP will be addressed in future revisions.

A few highlights of the proposed changes include:

- Adding the EVP for Health Sciences as the implementing authority on the Health Sciences Center Campus.
- Updates communication and commercialization procedures between STC.UNM and Office of University Counsel.
- Reduces STC.UNM time (after commercialization decision has been made) from 180 days to 90 days for determining level of intellectual property protection.
- Simplifies return of inventions in appropriate circumstances
- *Ad Hoc* nature of the Intellectual Property Committee and streamlined membership selection procedures

For more details, see the attached line-by-line summary of proposed changes.

Foreword – No change

Summary

- Item 7 reference to Executive Vice President for Health Sciences
- Item 10 now refers just to Article 5 rather than Article 5 and 6.

Article 1 – No change

Section 2.2.1 – No change

2.2.2 – No change

2.3.1 – No change

2.3.2 – No change

2.3.4 – No change

2.3.5 – No change

2.3.6 – Proposed change refers to Article 5 the dispute resolution portion of the policy

2.4 – No change

2.5 – No change

2.6.1 – No change

2.6.2 – proposed wording change to “STC.UNM” – applied throughout the policy

2.6.3 – proposed policy now refers to reimbursement to STC.UNM and not both to the University and STC.UNM. This change reflects the status of STC.UNM as the sole commercializing arm of UNM technologies.

2.6.4 – proposed change to third bullet point - “Vice President for Research (on main campus) or the Vice-President for Translational Research (at the Health Sciences Center (HSC))” to reflect current administrative structure. Also, the proposal clarifies that the split of the University portion will be consistent with the sources of the IP.

2.6.5 – No change other than reference to STC.UNM

2.7.1 - No change

2.7.2 – No change

2.7.3 – proposed change spells out “MTA” as “material transfer agreement”.
Proposed change - disclosure to Office of University Counsel or STC.UNM rather than to the Patent Administration Office.

Proposed change – OUC is responsible for required outside disclosures rather than PAO – These proposed changes clarify and bring the policy into accord with current practice.

2.7.4 – proposed change – voluntary disclosure to either STC.UNM or OUC. It does not change the principle of voluntary disclosure.

2.7.5 – update of OUC and STC.UNM references

2.7.5.1 – update of OUC and STC.UNM references

2.7.5.2 – No change

2.7.6 – no substantive change

3.1 - proposed change – adds the EVP for Health Sciences as implementing on the HSC campus.

“old” 3.2 – proposed change – section detailing the committee scope and status of the IPC moved to section 3.4

“new” 3.2 – Defines the role of the OUC

“old” 3.3 – defines role of PAO (role of PAO is proposed to be encompassed by the OUC)

“new” 3.3 – details role of STC.UNM (formerly in 3.4)

3.3 – proposed change – change in reference to STC.UNM

3.3.1 – proposed change – change word “rewarding” to “facilitating”

3.3.2 – no change

“new” 3.4 – provides revised scope of IPC

3.4.1 – limits scope of IPC to dispute resolution; defines the committee as *ad hoc*.

3.4.2 – The proposal provides for balance appointment to the IPC, three members determined by the Provost/EVP HSC and three members selected by the chair of the RPC in consultation with the President of the Faculty Senate.

In general – proposed changes remove much of the detail regarding IPC meetings (see existing 3.2.5 through 3.2.5.4)

4 - no change

4.1 – proposed change – language regarding the promulgation of regulations

4.1.1 – proposed change – allows STC.UNM to consult with inventor regarding publication for the 90 day period following disclosure – similar to current language that refers just to the university.

4.1.2 – proposed change – updates the communication procedures between STC.UNM and the OUC

“old” 4.1.3 – 4.1.5 – removes outdated language regarding the interaction of the PAO and IPC. The prior art search language is encompassed in the proposed 4.1.4 discussed below.

“new” 4.1.3 – provides a 120 calendar day period for STC.UNM to determine whether or not to commercialize. It incorporates similar wording to that found in current section 4.1.5

4.1.3.2 – proposed change – provides for direct release of technology back to the inventor rather than a second commercialization attempt by the university.

4.1.4 – provides for a 90 day decision regarding IP protection (compared to the current 180 days 4.1.6)

4.1.5 – similar to current 4.1.7

4.1.5.1 – proposed change – conforms reimbursement to that found in 2.6.2 and 2.6.3

4.2 – proposed change – updates to current practice

4.3 – Proposed change – references proposed mediation procedures

4.4.1 – proposed change – updates to current practice placing filing deadline responsibility on STC.UNM

4.4.2 – proposed change – refers to commercialization efforts rather than “licensing negotiations”; simplifies release to creator

Section 5 – limited to appeal of ownership determination between UNM and creator.

5.1 – no change other than updated for OUC and STC.UNM wording (also term “Works”)

5.1.2 – no change from current 5.1.1 (updated for OUC and STC.UNM wording)

“old” 5.1.2 through 5.1.2.2 – proposed change revises this portion of IPC dispute

resolution

“new” 5.1.3 – proposes a timeframe and general procedures for the IPC in reviewing the appeal.

5.1.4 – proposed change – includes the EVP for Health Sciences in appeals from HSC (see current 5.1.3)

5.1.4.1 – no substantive change from current 5.1.3.1

5.1.4.2 – no substantive change from current 5.1.3.2

5.1.4.3 – no substantive change from current 5.1.4

5.1.5 – no substantive change

5.2 – The proposed revision conforms the policy to current practice at STC.UNM. Inventorship is a legal question. STC.UNM currently relies on outside patent counsel to assess claims. A further dispute between creators would fall outside the University’s policy.

5.2.1 – Deleted

5.2.2 – Deleted

5.2.3 – proposed change – puts disagreement with IPC’s determination into arbitration process discussed in 5.1.3

6 – no substantive change

7.1 – Renumbered as 6.1 - no substantive change

7.2 – Renumbered as 6.2 - no substantive change

Intellectual Property Policy Draft Update 4/16/2009

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 the Executive Vice President for Health Sciences for their, respective, reporting units. (See Article 3.)

8. Royalties from commercialization by STC.UNM (formerly known as Science & Technology Corporation @ UNM) (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 STC.UNM.

20% to the University.

9. Standard procedures for review are described in Article 4.

10. Redress of disputes is covered in Article 5.

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:

- 1) 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.
- 2) 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.
- 3) 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:

- 1) 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.)
- 2) 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 can be appealed to the Intellectual Property Committee. (See Article 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 STC.UNM 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.UNM for a license of UNM IP, but does not include payments for research, development, or reimbursement of patent costs),

the STC.UNM shall be reimbursed for all unreimbursed or non-contractually reimbursable costs incurred in securing intellectual property protection and any litigation costs.

2.6.4

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

Forty percent (40%) to be divided equally (unless unanimously agreed to and represented on the submitted invention disclosure form) among the creators;

Forty percent (40%) to the STC.UNM; and

Twenty percent (20%) to the University to be invested and administered by the Vice President for Research (on main campus) or the Vice-President for Translational Research (at the Health Sciences Center (HSC)), generally, in amounts consistent with the source(s) of the UNM IP. 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.UNM and managed by them. At the discretion of the managing unit (the University or the STC.UNM), 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 Disclosure Requirements Imposed by Sponsored Research Agreements

Sponsored research agreements often carry requirements that any inventions or other intellectual property created in the performance of the agreement must be disclosed to the sponsor. Such agreements often also impose other requirements pertaining to

commercialization of such intellectual property. Upon execution of any sponsored research agreement, the Office of Research Services, or the HSC Pre-Award Office, as appropriate, shall inform the principal investigator of any such requirements pertaining to intellectual property resulting from the work. In addition to sponsored research agreements from industry and government, other agreements facilitating research may impose intellectual property disclosure requirements, such as grants, equipment loan and transfer agreements, and material transfer agreements.

When UNM IP results from work under an agreement creating disclosure obligations to sponsors or other third parties, then the Principal Investigator shall be responsible for ensuring disclosure of the UNM IP to the Office of University Counsel (OUC) or specifying such reporting requirements on the Copyright or Invention Disclosure Form submitted to STC.UNM. Such disclosures shall be made to the OUC or STC.UNM as soon as possible and at least within one month of creation. The disclosure shall be made by completing forms generated by the OUC.

The OUC shall in turn make such disclosures as required by federal and state laws and regulations, and by third party agreements of which it has been made aware.

2.7.4. Voluntary Disclosure

If the invention is not subject to third party disclosure obligations, then the creators have the choice as to whether to disclose the UNM IP. Any disclosures shall be made on forms provided by the OUC. Creators may consult with either OUC or STC.UNM as to the advisability of disclosure. Creators who choose not to disclose their UNM IP have no obligation to participate in the commercialization process outlined herein. Creators who chose to disclose thereby agree to participate in the commercialization process outlined herein.

Creators may not commercialize UNM IP created by them except by disclosing to OUC or STC.UNM and following the procedures outlined herein.

2.7.5

During as well as after their association with the University, creators shall assist and cooperate with the OUC's and the STC.UNM's efforts to secure intellectual property protection and pursue commercialization of disclosed UNM IP by executing all appropriate legal documents, including assignments, to perfect the University's legal rights.

2.7.5.1 Creators shall make available to the OUC and the STC.UNM all Technical Information necessary to support intellectual property protection.

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

2.7.6

In the event the University or the STC.UNM takes legal action against a creator who refuses to execute necessary documents pertaining to disclosed UNM IP or otherwise fails to act in accordance with this Policy, any costs reasonably and necessarily incurred by the University and/or the STC.UNM 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 and Executive Vice President for Health Sciences

The Provost, or designee, shall be responsible for the interpretation, implementation, and enforcement of this Policy on main campus; the Executive Vice President for Health Sciences shall be responsible for the interpretation, implementation and enforcement of this Policy on the Health Sciences Center campus. The Provost and/or Executive VP for Health Sciences 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 Office of University Counsel (OUC)

3.2.1

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

3.2.2

The member of the OUC charged with patent administration duties, hereafter the Patent Administrator, is authorized with the approval of the Provost, Executive Vice President for Health Sciences and the RPC, to promulgate and publish information and procedures to implement this policy.

3.3 STC.UNM (formerly known as Science & Technology Corporation @ UNM) (STC.UNM)

The STC.UNM 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.UNM, for the purpose of active support by the STC.UNM for commercialization of UNM IP.

The STC.UNM, 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.

3.3.1

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

3.3.2

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

3.4 Intellectual Property Committee (IPC)

3.4.1

The IPC serves as an *ad hoc* committee whose purpose is to arbitrate any intellectual property rights disputes arising under this policy. (See Article 5)

3.4.2

The IPC shall comprise three members appointed by the Provost or Executive Vice President for Health Sciences (based on the department of the creator(s)), and three members appointed by the chair of the Research Policy Committee in consultation with the President of the Faculty Senate. Each appointing party shall designate a co-chair for the IPC. The Senior Associate Counsel for Research & Technology Law, and the President of the STC.UNM, or their designees respectively, are nonvoting members *ex officio*.

4. Review of Disclosures and Commercialization

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

4.1 Review of Disclosures

The specific implementation of the items under Article 4 will be determined under written regulations agreed upon by STC.UNM and the OUC.

4.1.1

The University or STC.UNM may require creators to consult with STC.UNM prior to 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 or STC.UNM to evaluate a UNM IP and determine whether to pursue any form of intellectual property protection. In some cases, STC.UNM may require creators to refrain from publishing certain materials within the said 90-day period. The University and the STC.UNM 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 OUC has accepted an appropriately completed disclosure as specified in Section 2.7.3, the OUC shall forward a copy to the STC.UNM within one (1) week. The creators may submit disclosures directly to STC.UNM, in which case STC.UNM shall forward a copy to OUC within one (1) week of receipt.

4.1.3

STC.UNM shall make a written determination as to whether or not commercialization is to be pursued within 120 calendar days from the date of disclosure.

(a) The STC.UNM 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.UNM 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.UNM 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.UNM may delay processing the disclosure for up to nine (9) months, or even longer with the consent of the creator(s).

4.1.3.2

If no determination is made by the STC.UNM within the deadline, the creator(s) shall have the option of extending the deadline or of sending a written letter to the STC.UNM requesting a determination within ten (10) UNM business days. If the STC.UNM does not respond within this period or responds that it will not pursue commercialization the University shall release the intellectual property to the creator pursuant to Section 4.4.2.

4.1.4

Once the STC.UNM has determined to pursue commercialization, it will make a decision about intellectual property protection within 90 days from the date of disclosure.

4.1.5

If, at any step during the process, both [either] the OUC [or] and the STC.UNM determine not to pursue the commercialization of a particular UNM IP, the University shall release the intellectual property to the creator, subject to sponsor approval.

4.1.5.1

If the University or the STC.UNM shall have expended funds for prior art search and patent prosecution, reimbursement shall be in the manner described in Section 2.6.2 and 2.6.3 .

4.2 Reporting

Within twelve (12) months of a complete disclosure, and at 18 months and 24 months, respectively thereafter, the STC.UNM shall provide to the OUC and to each creator whose disclosure is in the hands of the STC.UNM a report detailing the current state of commercialization of the disclosure, including patenting, marketing, and licensing efforts. The OUC and creators are encouraged to obtain up-to-date information on any disclosures by accessing STC.UNM's on-line "My Technologies" section. Any UNM creator may request on-line access from STC.UNM to view current activity of those disclosures for which he or she is the creator or co-creator.

4.3 Commercialization

In the event the STC.UNM has not made a reasonable effort to commercialize the UNM IP within two (2) years of its decision to commercialize (as per Section 4.1.3), the University or the creator(s) may request the STC.UNM to return the UNM IP to the University. 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 90 calendar days in advance, STC.UNM shall advise the OUC 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 Patent Cooperation Treaty

(PCT); and Entry into national status under the PCT. Any exceptions in meeting the 90-day deadline shall be promptly communicated by STC.UNM to OUC and the creators.

4.4.2

In the event STC.UNM does not intend to continue commercialization efforts and does not commit itself to meeting the above deadlines, the University shall release the intellectual property rights to the creator(s), subject to sponsor approval, within 30 days of STC.UNM's notification to the University.

5 Appeal of Ownership Determination

5.1

In the event a creator does not believe the University is entitled to the rights in a Work, the creator may seek a determination or a waiver of the University's interests in said Work. The OUC will provide the creator with a Determination of Rights Form which must then be completed and returned to the OUC, with all documents supporting the creator's claim. The OUC will forward a copy of the Form and supporting documentation to the STC.UNM for comments.

5.1.2

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

5.1.3

The IPC shall endeavor to review the Record and hear all evidence within thirty (30) calendar days of receipt of the Record and shall issue a written decision within thirty (30) calendar days of hearing the last evidence. The IPC shall keep written minutes of all its meetings.

Participation in an appeal to the IPC does not close off other available remedies. The IPC shall keep written minutes of all its meetings, and its final decision shall be in writing.

5.1.4

The creator or the OUC may appeal the IPC's determination to the Provost or Executive Vice President for Health Sciences (based on the department of the creator(s)) by written request to the Provost or Executive Vice President for Health Sciences within ten (10) UNM business days of receiving notice of the IPC's determination. The Provost/EVP HSC shall notify the RPC, and meet with all interested persons. Within sixty (60) calendar days of receiving the appealing party's written request, the Provost/EVP HSC shall make a final decision.

5.1.4.1

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

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

5.1.4.3

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 OUC 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 UNM IP, and have not been adequately acknowledged as such at any point in the protection and commercialization process, they may petition the OUC or STC.UNM to assess their claim. The OUC will provide the petitioners with a Determination of Inventorship/Authorship Form which must be completed and returned with any relevant attachments for review. The OUC or STC.UNM will seek the opinion of outside patent counsel for determination. Any further inventorship or authorship dispute among creators shall fall outside the scope of this policy.

6 Related Provisions

6.1 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.UNM) all or part of its rights in any Scholarly/Artistic or Technological Work under terms and conditions deemed appropriate and beneficial for the University.

6.2 Legal Actions

The University or STC.UNM 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 .

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