

**New Mexico Institute of Mining and Technology
Student and Employee Intellectual Property Policy**

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First Draft: July, 2014

Second Revision: 31 July 2017

29 October 2017

I. Values and Objectives

All Intellectual Property (IP) owned by New Mexico Institute of Mining and Technology (New Mexico Tech; NMT) is assigned to the NMT Research Park Corporation (NMTRPC), an entity created by New Mexico Tech under the New Mexico Research Park Act ([21-28-1 NMSA 1978](#)). The primary roles of the NMTRPC are, in conjunction with NMT, to develop and to monetize IP generated on the NMT campus.

As such, the NMTRPC is therefore responsible for managing, patenting and/or licensing of NMT-developed IP. The New Mexico Tech RPC is also responsible for spinoff companies utilizing New Mexico Tech IP. The NMTRPC exists for the benefit of New Mexico Institute of Mining and Technology and the State of New Mexico. As such, the core values of the NMTRPC are:

1. The New Mexico Tech Research Park Corporation recognizes and strongly supports the core importance of a campus research environment where creativity, innovation, and entrepreneurship are encouraged and supported for all students, faculty, and staff.
2. The New Mexico Tech Research Park Corporation values the independence of all NMT researchers in the pursuit of their endeavors.
3. The New Mexico Tech Research Park Corporation is committed to development of intellectual property at New Mexico Tech that will benefit the State of New Mexico and human society.
4. The New Mexico Tech Research Park Corporation is committed to development of intellectual property that has the potential for financial benefit to the Institute and campus innovators.

The NMTRPC recognizes the importance of funding in support of the core values listed above. As such, the central objectives for development of intellectual property (IP) at NMT are:

1. Development of intellectual property, via patents, licenses, business startups, partnerships with outside (of NMT) individuals and firms, and combinations thereof that has the potential to bring financial returns to the Institute and the campus-based sources of the innovation(s).
2. Use of NMT IP policies to preserve faculty and researcher intellectual independence while fostering creativity and financial opportunities for the Institute and innovative faculty, students, and staff.
3. Use of the benefits of IP developed at NMT for the enhancement of the creative and entrepreneurial climate on campus.

What follows in this document is concerned with ownership of IP created on behalf of and/or at NMT. As NMT-owned IP is assigned to the NMTRPC, when an inventor assigns rights to NMT or NMT otherwise has ownership rights they are automatically assigned to the NMTRPC.

II. Definitions

1. “Associate” means any person who is a member of the faculty, staff or student body of New Mexico Tech.
2. “Student” means any full or part-time undergraduate or graduate student at New Mexico Tech.
3. “Invention or Discovery” means creative ideas that could be reduced to written form, whether patentable or patented, etc.
4. “Inventor” means any associate or associates who participated in the development of an invention.
5. “Intellectual Property” means any work or invention protected by law under a patent, copyright, trademark, or trade secret. Only the patent and copyright categories are covered here.

6. “Patent Application” means a formal document describing and claiming rights to an invention, which is formally filed with the United States Patent Office, or the Patent Office of a foreign country.
7. “Patent” means a document issued through the patent application process by the United States Patent Office, or its counterpart in a foreign country.
8. “Copyright” means the exclusive legal right, given to an originator or an assignee to print, publish, perform, film, or record literary, artistic, or musical material, and to authorize others to do the same. Registering a copyright with the US Copyright Office may help in the enforcement of the copyright but is not needed to maintain copyright protection.
9. “Search” means to determine whether patentability is possible by researching prior publications and patents to ascertain if the invention is indeed a new idea.
10. “Disclosure of Information” means disclosing ideas through publications, seminars, symposiums, oral representation in the classroom, or any other form of communication. While publications can be of limited benefit to the researcher and/or inventor, such publications can nullify future patent rights. Therefore, it is suggested that a careful study of patent potential in foreign countries be made before considering publication.
11. “Sponsor” means the person or entity providing funds for the research, i.e., federal and state agencies; private-sponsored research, etc. Many private research contracts are written such that patent rights belong to the sponsor. This also may be the case in many federal and state research grants. Contracts should be carefully reviewed to determine who benefits by inventions and/or patents.
12. “Patent and Copyright Management Agent” means The New Mexico Tech Research Park Corporation, a non-profit corporation approved by action of the NMT Board of Regents.
13. “Patent and Copyright Committee” means a committee appointed by the President from the staff of the Institute to assist and advise the President and the NMT Research Park Corporation concerning patents and copyrights. The committee shall investigate possible patent or copyright value of disclosures made to the Center for Technology Commercialization, and shall act in a general advisory capacity to the NMT Research Park Corporation.
14. “Scholarly, Artistic, Literary, and Musical Works” in any medium are collectively referred to as Scholarly/Artistic Works. This category includes all materials developed by students, faculty, and staff of the University.
15. “Substantial Use of New Mexico Tech Resources” consists of unreimbursed use of Institute human resources, laboratories, or computational facilities in a way that is important for the creation or development of the intellectual property. Use of the NMT Library or office space

or other facilities available to the NMT Community does not constitute use of facilities important for creation or development of IP. Use of facilities will be considered “Substantial” if the outside-NMT cost of access to comparable facilities by the inventor is in excess of \$5,000 in year-2000 dollars (about \$7,000 in 2017 dollars).

III. IP Policies

These policies are designed to provide guidance on ownership, protection, and – where appropriate – monetization of Intellectual Property developed by NMT Associates and Non-Associates on the NMT Campus.

Scholarly and/or Artistic Works

Copyrights to Scholarly/Artistic Works created at the University 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). 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. 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.

Copyrightable material owned by the University must be disclosed to the New Mexico Tech Center for Technology Commercialization (CTC).

Inventions Created by NMT Students

New Mexico Tech Students may determine ownership of any invention they have created by answering the following Yes/No questions:

1. Did the invention occur as part of a class and/or class assignment – including engineering design clinics?
2. Did the invention occur with substantial use of NMT resources?
3. Did the invention occur as part of formal employment (as governed by a graduate research or teaching assistant contract, student work authorization, or being hired on an emergency basis)?

If the answer to question 1 is yes, and the answers to questions 2 and 3 are no, the IP belongs to the student/creator. Note that creating an invention as part of a class is not by itself a guarantee of student ownership. If the student utilizes substantial NMT resources in development of the invention, NMT will own part of the invention and will negotiate ownership shares with the student.

Furthermore, IP created as part of a class by a student employee, who then develops the IP as part of their student employment will be partly owned by NMT subject to ownership-share negotiations.

OR

If the answers all to all 3 questions are no, the IP belongs to the student/creator.

OTHERWISE the IP belongs to NMT via the RPC. See the section entitled Inventions Created as Part of Faculty Member and/or Institute Employee NMT Employment.

Inventions Created Outside the Scope of a NMT Employment Contract

Inventions created by the NMT Faculty Member or NMT Employee are the property of the creator if:

1. The Invention is created in an area of business not covered by Faculty Member and/or NMT Employee's affiliation agreement, is not in an area for which the Faculty Member or NMT Employee receives Institute support, and is developed outside of normal working hours as defined in the section entitled "Work Week and Hours",
2. Non-substantial NMT resources were used to develop the invention, and
3. The Inventor discloses the invention to NMT.

Documentation about the development of the invention should be included in the disclosure form. The NMT Patent Committee will make the final ownership decision within 30 days of receipt of the disclosure form.

Inventions Created as Part of Faculty Member and/or Institute Employee NMT Employment

Patents and inventions resulting from work performed at the Institute, with Institute funds, or Institute equipment and/or supplies shall be owned by New Mexico Tech Research Park Corporation but may be assigned to the inventor at the NMT Research Park Corporation's sole discretion. Governmental, industrial or other projects, which have different contractual patent clauses, will be treated accordingly. In the case where there is negotiable ownership of patents and inventions resulting from governmental or industrial projects and/or the possibility of

assigning patent and inventions resulting from government or industrial projects, such patents and inventions shall be assigned to and owned by the New Mexico Tech Research Park Corporation.

The patent process (see Section IV below) essentially begins with the NMT Invention Disclosure form. New Mexico Tech personnel should disclose all discoveries developed as a result of work performed at the Institute or with Institute Funds or Institute equipment and supplies.

If it is determined that the idea or invention is of small or no economic benefit, the Center for Technology Commercialization, in consultation with the NMT Patent Committee shall return the rights to the researcher who in turn may proceed with the patent application at his/her own expense. The return of rights will come with the condition that, if the inventor realizes financial benefits from the invention as a result of omissions in or other issues with the disclosure, NMT will have the right to a share of those benefits in the 20-25% range.

If, on the other hand, the creation appears to have commercial potential that could benefit the Institute and the creator/inventor(s), the NMT internal patent process will continue as shown in Figure 1 and briefly described below in the Process section of this document.

NMT Inventors agree to assist NMT in preparation and execution of any documents that must be prepared to evidence NMT's ownership of any IP right that the inventor has or will convey to NMT. The inventor also hereby agrees to assist NMT in the procurement or defense of any IP right, for example, patents that arise from IP rights that the inventor, through his or her affiliation with NMT, has or will assign to NMT.

Assignment of IP rights to NMT means that NMT will take full responsibility for development of IP protection and marketing strategies, and will reasonably act to execute those strategies. If NMT elects to either abandon protection and marketing of IP, or the NMT Patent Committee (see below) in conjunction with the NMT Research Park Corporation decides not to pursue protection and development of the IP, the rights to the Invention will be returned to the Inventor(s).

As NMT Inventions are commercialized successfully, royalties and other directly-related cash flows may accrue to the Research Park Corporation. The Research Park Corporation will share net benefits of invention-related benefits with Inventors on an equal (50/50) basis.

Inventions Created at NMT by Non-Associates

Inventions created at NMT, using NMT resources, by non-Associates belong to NMT. In the case where non-associates working on IP at NMT are bound by provisions of IP agreements with their employers (as in the case of non-NMT faculty working on campus as part of a sabbatical at another university), it is the responsibility of the non-Associate – in consultation with the NMT Center for Technology Commercialization – to resolve any conflicts between this policy and their employer policy.

IV. Disclosure and Patent Evaluation and Application Process

The overall goal of the NMT Disclosure and Patent Evaluation and Application Process is to provide NMT Associates with a transparent and defined path to protection and possible monetization of NMT IP that they created. The overall approach to developing patentable IP is to create invention disclosures that are broad in scope and also detailed with regard to invention details. These will lead to broad patent applications and/or licensing agreements that are attractive to potential commercialization partners.

Initialization: Steps One and Two:

The steps in seeking a patent, which are summarized here, are also shown below in Figure 1. They represent a road map that campus innovators and entrepreneurs can use. The entire process starts with an idea (Step 1), which must then be described in a coherent and organized way via a flowchart, design, or other method (this is called “conception”, and is Step 2). In the case of biochemical discoveries, a prototype compound or other substance must also be produced to complete this process.

Finalizing the Intent of the Parties and Formal Disclosure of Discovery (Steps Three and Four):

Step Three: Statement of Intent

Once an idea is conceptualized, an inventor may be interested in exploring protection and commercial exploitation options for the potential invention. If that is the case, the inventor should, via a short written correspondence, notify the NMT Center for Technology Commercialization (CTC) of her/his intent to initiate protection and exploitation.

The CTC will respond in a timely fashion and may request additional information from the creator/inventor.

Step Four: Invention Disclosure

The disclosure of an invention to the CTC begins the intellectual property protection process. The key question for the inventor and CTC at this point is: given the values and objectives driving the IP-protection and commercialization process, does the invention/idea have the potential to become valuable intellectual property for New Mexico Tech Research Park Corporation? If the answer to this question is yes, then the CTC and Research Park Corporation will proceed with the process. If the answer is no, then rights to the invention shall be returned to the researcher as indicated above.

The formal disclosure of the invention should only occur after the innovation is specified with regard to function and performance as well as design. The process of development of the

invention should be outlined, and the inventor should have a good initial idea of potential future commercial uses of the invention. Inventions in this stage can be discussed with CTC, and CTC will work with inventors to develop the most-informative and useful (for future filings) disclosure possible.

This may result in an iterative and interactive process in which the inventor, the CTC, and NMT's patent lawyers are involved. The objective of this part of the process is, as noted above, development of the most comprehensive and commercially-attractive disclosure possible given the information at hand.

The New Mexico Tech Invention Disclosure Form is attached to this document as Appendix A.

Steps to Assess Viability and Proceed with the Patent Evaluation (Steps Five - Eight)

Step Five: Assessment of Financial and Commercial Viability

The CTC may conduct an assessment of the commercial viability of the invention. This will be done in consultation with the inventor, and, depending on the nature of the invention in question, may involve the following activities:

- Initial, preliminary patent search.

- Interviews with the inventor and the inventor's research team to help understand advantages vis-à-vis existing intellectual property and/or art.

- Preliminary conversations with potential commercialization partners.

- Preliminary conversations with potential customers to assess the potential initial market for the invention.

If the assessment of financial and commercial viability of the disclosure is favorable, the CTC may request a formal presentation to itself and/or the Patent and Copyright Committee.

In order to have the best possible picture of the potential of an innovation, the inventor should submit, in a separate document, a summary of a potential intellectual property development strategy. The purpose of this document is twofold: first, the contents of the document may be useful for the Patent and Copyright Committee and the CTC in their evaluation of alternative strategies regarding the invention in question. Second, this document will serve as the basis for an informal agreement between the CTC and the inventor regarding potential courses of action to realize benefits for both New Mexico Tech Research Park Corporation and the inventor. Items to address in the intellectual property development strategy document might include, but may not be limited to:

Type of Initial Patent Filing: A wide range of initial filing opportunities exist. The Research Park Corporation, in consultation with the CTC and with the inventor(s), may elect to initially file a relatively simple provisional patent, an approach with relatively low cost. The Research Park Corporation may instead elect to opt for a very detailed provisional that is filed with possible changes and additions (and additional disclosure forms) associated with the invention. The Research Park Corporation may also elect to immediately file a utility patent, likely the most costly alternative, if the invention has proven, documented capabilities that need to be protected along with the invention itself.

Detail about the Value Proposition Associated with the Invention: Section 2d of the disclosure form (attached as Appendix A) is concerned with eventual marketability of the intellectual property disclosed in the form. As a supplement to this information, general information about why the proposed invention would add value for a potential customer, licensee, buyer, partner, or any other individual or entity should be provided.

Plans for Further Development of the Innovation that May Require Protection: Many inventions are the basis for additional creative work. Some of the work grounded in protected intellectual property may have the potential for commercialization and therefore may require additional protection. The inventor should disclose prospective “children” of the current invention so that the CTC, in conjunction with the inventor, may formulate an initial strategy for protecting and monetizing the innovation.

Step Six: Evaluation of the Disclosure Form by the NMT Patent and Copyright Committee

New Mexico Tech has a Patent and Copyright Committee whose role is evaluation of disclosure forms and making recommendations to the CTC and Research Park Corporation with regard to the disclosures. The Patent and Copyright Committee, which meets as needed on an ad-hoc basis, may ask inventors for clarifications or other information to assist with their disclosure evaluations.

Members of the NMT Patent and Copyright Committee are appointed by the Institute President. Currently (as of October, 2017), Membership of this committee is as follows:

The NMT Associate Vice President for Academic Affairs

The Executive Director of the NMT Center for Technology Commercialization

The NMT Vice President for Research and Economic Development

One member from the New Mexico Tech Research Park Corporation

Step Seven: Evaluation of the Disclosure Form and Final Decision by the NMT Research Park Corporation

Once the NMT Patent and Copyright Committee has issued an opinion, the final decision to proceed with a patent prosecution will be made by the Research Park Corporation. The Research Park Corporation, via email and/or at periodic meetings, will deal with issues such as the relative merits of different innovations that are candidates for patent prosecution (including prioritization of prosecutions in light of budgetary constraints), the timing of the initiation of the process, and the impact of the disclosed innovation on the New Mexico Tech Research Park Corporation intellectual property portfolio. In the event that New Mexico Tech Research Park Corporation decides not to pursue prosecution of a patent, the inventor will have the opportunity to take full ownership of the invention in the manner described above in this document. Full ownership means that New Mexico Tech will not be involved in any aspect of financing or commercializing the invention.

All decisions will be made in a timely fashion, and inventors will be kept informed about the approval process.

Step Eight: Begin Process of Prosecuting the Patent and Commercialization of the Intellectual Property

Once the appropriate protection measures are either taken or initialized, implementation of the intellectual property development strategy can begin. This may involve many different, technology-specific activities. Actions taken should reflect the initial Value Proposition, which should also drive development of a Business Model for the invention – essentially, an argument summarizing how value for a potential customer, user, licensee, buyer, or partner will turn into revenues for both the inventor and New Mexico Tech.

This critical process will be dynamic and ongoing, and it is critical that commercialization efforts begin as early in the intellectual property protection process as possible and feature input from inventors, subject-matter experts, the New Mexico Tech Research Park Corporation Legal Team (as necessary), and the Center for Technology Commercialization. The key point is that at this stage, the invention becomes part of the NMT Research Park Corporation intellectual property portfolio, and the New Mexico Tech will, with creator/inventor input, manage the process of development of the intellectual property into a beneficial entity.

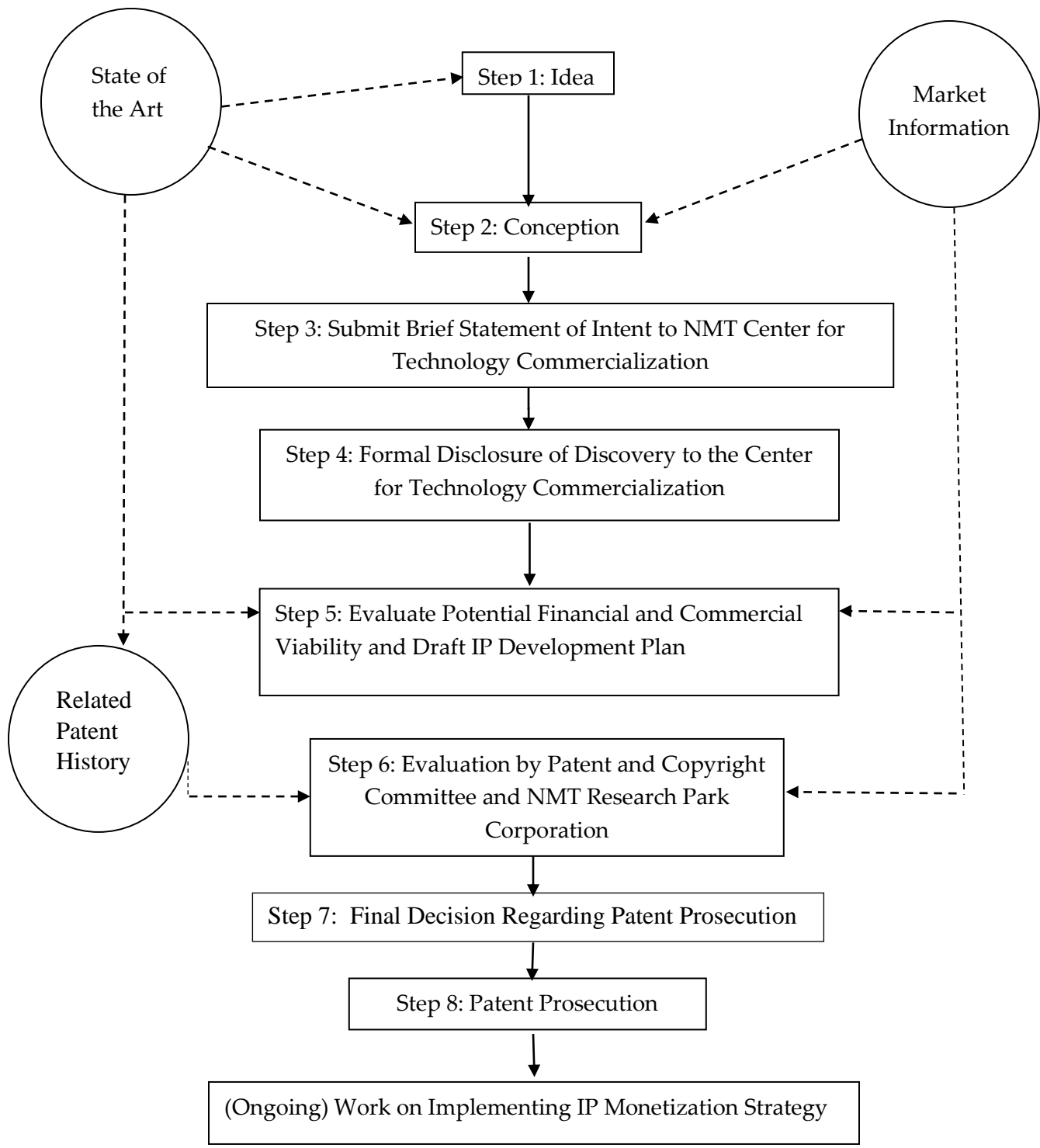


Figure 1. A general outline of the New Mexico Tech Patent Process for internally-generated innovations. Solid arrows represent summaries of sequential steps in a successful patent process, and dashed lines represent sources of input to the process. Note the importance of market information throughout the process.

V. Dispute Resolution

Disputes will be resolved in accordance with existing NMT Policy.

VI. Effective Date

This Policy will be effective upon ratification by the NMT Board of Regents.

VII. Amendments to NMT IP Policy

Amendments to this policy may be made from time to time in accordance with the NMT Policy on Policies.