



# Intellectual Property Policy

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NMT Faculty, Staff, and Students

New Mexico Tech Office of Innovation Commercialization

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## **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 monetize IP generated on the NMT campus.

The NMTRPC is 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 the New Mexico Institute of Mining and Technology and the State of New Mexico.

### **A. Core Values of the NMTRPC**

- Recognize and support the importance of a campus research environment where creativity, innovation, and entrepreneurship are encouraged and supported by all students, faculty, and staff.
- Value the independence of all NMT researchers in the pursuit of their endeavors.
- Commitment to the development of the intellectual property at New Mexico Tech that will benefit the State of New Mexico and human society.
- Commitment to the development of intellectual property that has the potential for financial benefit to the Institute and campus innovators.

### **B. Objectives of the NMTRPC**

- To develop intellectual property, via patents, licenses, business startups, partnerships with outside (of NMT) individuals and firms, and combinations thereof that have the potential to bring financial returns to the Institute and the campus-based sources of the innovation(s).
- Use 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.
- Use the benefits of IP developed at NMT for the enhancement of the creative and entrepreneurial climate on campus.

The NMT IP Policy will address ownership of IP created on behalf of and/or at NMT. 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 in this policy.
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.

## II. Definitions

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 to assist and advise the Office of Innovation Commercialization concerning patents and copyrights. The committee may investigate possible patent or copyright value of disclosures made to the Office of Innovation 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. Intellectual Property 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.

#### A. Scholarly and/or Artistic Works

Copyrightable material owned by the University must be disclosed to NM Tech's Office of Innovation Commercialization (OIC). Copyrights to Scholarly/Artistic Works created at the University are owned by the creators, with the following exceptions:

- 1) Works created by a pre-arranged contractual obligation with a 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.
- 2) Works created under a sponsored agreement that requires rights to be relinquished to the sponsor.

#### B. Inventions Created by NMT Students

New Mexico Tech Students may determine ownership of any invention they have created by answering the following questions:

	Scenario A	Scenario B	Scenario C	Scenario D
Did the invention occur as part of a class and/or class assignment – including engineering design clinics?	Yes*	No	Yes*	No
Did the invention occur with substantial use of NMT resources?	No	No	Yes**	Yes**
Did the invention occur as part of formal employment (as governed by graduate research or teaching assistant contract, student work authorization, or being hired on an emergency basis)?	No	No	Yes	Yes
* Section III C. <i>Inventions created as part of a faculty member and/or NMT employment.</i> ** Section II 15) <i>Substantial Use of New Mexico Tech Resources</i>	IP belongs to the student/creator		IP belongs to New Mexico Tech	

**III. Intellectual Property Policies****C. Inventions Created Outside of an NMT Employment Contract**

Inventions created by an 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 the 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, as is developed outside of normal working hours.
- 2) Non-substantial resources were used to develop the invention, and
- 3) The Inventor discloses the invention to NMT. Submit your invention disclosure using the form located at [www.nmt.edu/OIC](http://www.nmt.edu/OIC)

The invention disclosure and any supplementary documentation should be included. A decision on final ownership decisions will be made within 30 days of receipt of the invention disclosure form.

**D. Inventions Created as Part of Faculty Member and/or NMT Employment Contract**

Patents and inventions resulting from work performed at the Institute of New Mexico Tech, 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 patents 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) 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 Office of Innovation Commercialization (OIC), 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 the invention has commercial potential that could benefit the Institute and the creator/inventor(s), the NMT internal patent process will continue as shown in Section IV.

**III. Intellectual Property Policies**

NMT Inventors agree to assist NMT in the 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 results in NMT taking full responsibility for the 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 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).

NMT Inventions are commercialized successfully, the Research Park Corporation may accrue royalties and other directly-related cash flows. The Research Park Corporation will share net benefits of invention-related benefits with Inventors on an equal (50/50) basis after all expenses are reimbursed. Expenses include but are not limited to patent costs, research expenses funded by the NMTRPC, etc.

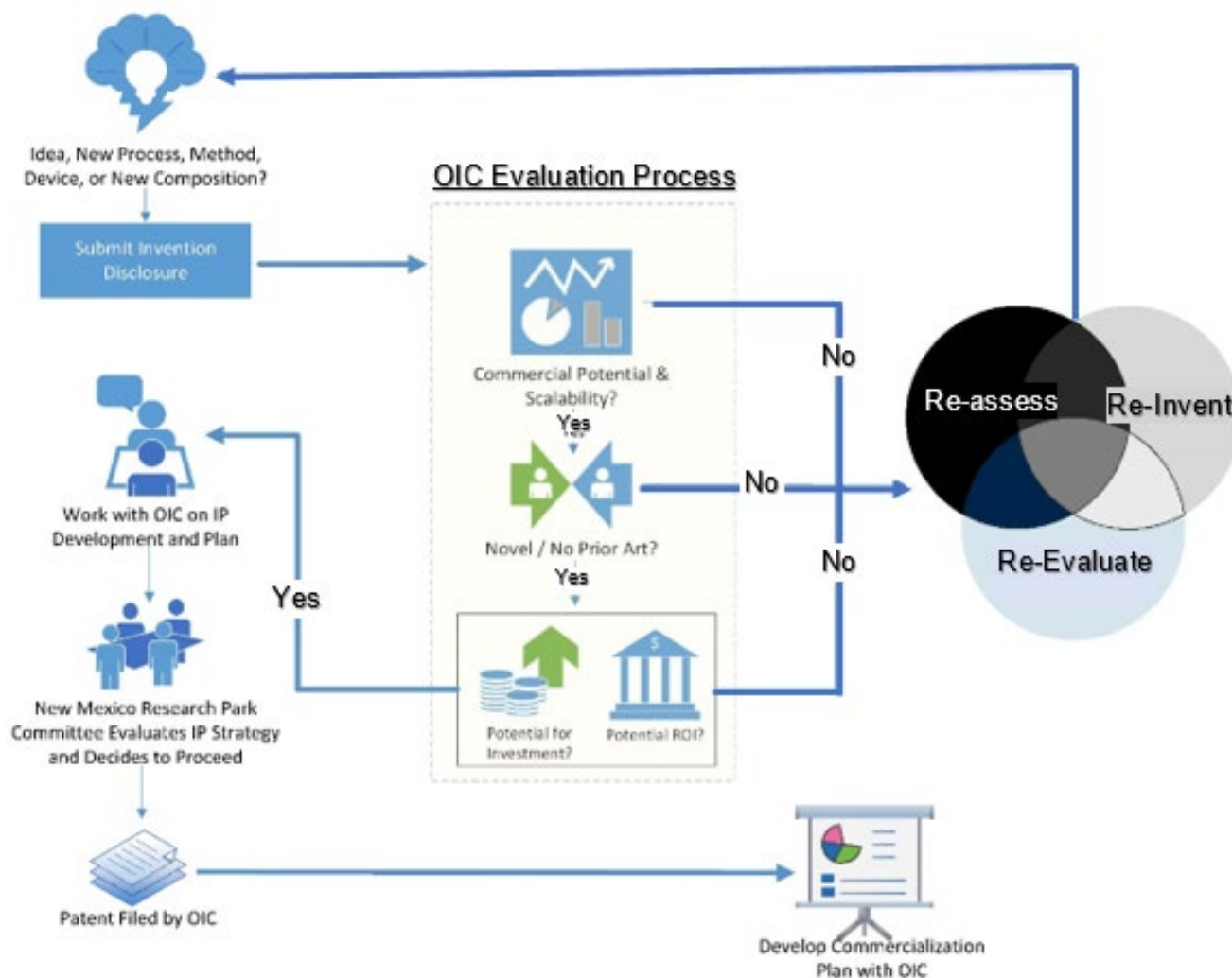
**E. Inventions Created at NMT by Non-Associates**

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 OIC – to resolve any conflicts between this policy and their employer policy.



#### IV. Invention Disclosure, Patent Evaluation, and Application Process

The NMT Invention Disclosure, Patent Evaluation, and Application Process provide NMT Associates with a transparent and defined path to protect and possibly monetize NMT intellectual property (IP) created. Below is a step-by-step schematic of the OIC's process.



Inventors with an idea, new process, method, device, or new composition shall submit an invention disclosure to the Office of Innovation Commercialization prior to giving any public presentations or publications. The invention disclosure is the first step in the protection and commercial exploration of an invention developed on the NMT campus.

OIC will evaluate the invention disclosure and make recommendations based on the invention's commercial potential and scalability, novelty, and the benefits the innovation brings to NMT, the OIC, and the New Mexico Tech Research Park Corporation. Inventions that do not meet the evaluation process guidelines will be returned to the researcher.

**IV. Invention Disclosure, Patent Evaluation, and Application Process**

Members of the NMT Patent and Copyright Committee may consist of the Executive Director of the Office of Innovation Commercialization Office, The NMT Vice President for Research, and one member from the NMTURP board.

Invention disclosures that meet the OIC evaluation process will move to the next step, where the OIC and the inventor meet to discuss IP development and strategy. The IP development strategy and the final decision will be presented to the NMTRPC board and the NMTRPC board will make the final decision to proceed with the patent prosecution process based on the overall innovation impact, existing NMT patent prosecution commitments, and budget constraints. If the NMTRPC Corporation decides not to pursue prosecution of a patent, the inventor will have the opportunity to take full ownership of the invention, whereby NMT will not be involved in any aspect of financing or commercializing the invention.

If the NMTRPC decides to move forward with patent prosecution, the inventor and the OIC will work to develop a commercialization plan that identifies the value for a potential customer, user, startup formation, licensee, buyer, or partner that will turn into revenues for both the inventor and New Mexico Tech. This process of IP development and prosecution is ongoing and will require input from inventors, subject-matter experts, the New Mexico Tech Research Park Legal Team (as needed), and the OIC. It is at this stage that the invention becomes part of the NMTRPC's intellectual property portfolio. New Mexico Tech along with the inventor's input will manage the process of development of the intellectual property into an entity.

**V. Dispute Resolution**

Disputes will be resolved in accordance with existing NMT Policies.

**VI. Effective Date**

The policy will be effective upon ratification by the NM Board of Regents.

**VII. Amendments to NMT IP Policy**

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

**VIII. Conflict of Interest Policy**

Conflict of interest will be resolved in accordance with existing NMT Policies.

**IX. Consulting Policy**

The Consulting Policy is defined within existing NMT Policies.