

Docket Number: _____
Completed Disclosure Date: _____

Prior or Pending Publication: _____
Sponsor: Gov't _____ Non-Gov't _____

CONFIDENTIAL

THE UNIVERSITY OF NEW MEXICO

INVENTION DISCLOSURE FORM

NOTES:

- 1) There are TWO (2) sections to this form: 1) an Invention Disclosure Form (IDF) and 2) an Assignment Document. Both must be completed before processing can begin.
- 2) For questions or assistance please contact:

**The University of New Mexico
 Research & Technology Law (R&TL)
 1800 Roma NE, Room 208
 MSC05 3440
 University Counsel Office, UNM1
 Albuquerque, NM 87131
 Phone: (505) 272-7646 Fax: (505) 272-7883**

SECTION ONE (1)

I. LEAD INVENTOR: (Lead Inventor is not a legal designation but is merely an STC heading assigned to an inventor who agrees to be the primary contact for additional information and for all correspondence. However, the Lead Inventor must still satisfy the inventor requirements described in Section III.)

Last Name: _____

First Name: _____

The Lead Inventor is responsible for:

- (1) communicating with joint inventors, Science & Technology Corporation @ UNM (STC), R&TL, and patent attorney/law firm personnel;
- (2) providing requested documents to R&TL, STC and the patent attorney/law firm personnel ; and,
- (3) notifying STC and the patent attorney of changes in invention status.

I understand and agree to comply with the responsibilities set forth above as Lead Inventor for this invention.

Signature

Date

II. INVENTION TITLE:

III. INVENTORS: (All individuals who contributed to the conception of the invention should be listed below, whether or not they are affiliated with The University of New Mexico. A person who directs another to solve a problem or make an invention is not an inventor, unless he/she also told the other how to do it, as well. Parties working together on a problem will be *joint inventors* if each makes a mental contribution to the final invention concept. It is not necessary that their contributions be equal or that they be made simultaneously, as long as the parties were collaborating with one another. Please note that a patent can be rendered invalid by including as an inventor an individual who did not contribute to the conception of the invention. Please ensure that the sum of the individuals' contributions total 100%. Attach additional pages if needed.)

A. University of New Mexico Inventors

1) Salutation: _____ First Name: _____ Middle Initial: _____
Last Name: _____ Suffix: _____
UNM Department: _____
Campus Address: _____

Work Phone: _____ Fax: _____ E-mail _____
Residential Address: _____

Country of Citizenship: _____
Contribution of Inventor: _____ %

2) Salutation: _____ First Name: _____ Middle Initial: _____
Last Name: _____ Suffix: _____
UNM Department: _____
Campus Address: _____

Work Phone: _____ Fax: _____ E-mail _____
Residential Address: _____

Country of Citizenship: _____
Contribution of Inventor: _____ %

3) Salutation: _____ First Name: _____ Middle Initial: _____
Last Name: _____ Suffix: _____
UNM Department: _____
Campus Address: _____

Work Phone: _____ Fax: _____ E-mail _____
Residential Address: _____

Country of Citizenship: _____
Contribution of Inventor: _____ %

B. Non-University of New Mexico Inventors

1) Salutation:____First Name:_____Middle Initial:_____
Last Name:_____Suffix: _____
Business/University Address:_____

Work Phone:_____Fax:_____E-mail_____

Residential Address:_____

Country of Citizenship:_____

Contribution of Inventor: _____%

2) Salutation:____First Name:_____Middle Initial:_____
Last Name:_____Suffix: _____
Business/University Address:_____

Work Phone:_____Fax:_____E-mail_____

Residential Address:_____

Country of Citizenship:_____

Contribution of Inventor: _____%

IV. FUNDING OR SPONSORSHIP:

- A. Is this invention directly related to your UNM research duties? Y__ N__
- B. Did this invention result from research or other work performed with significant use of UNM funds or facilities? Y__ N__
- C. Did this invention result from research or other work performed on your own time, AND is it unrelated to your UNM research duties? Y__ N__
- D. Sources of Funding or Sponsorship Leading to Invention

1. Federal or State Sponsorship

a. Agency Name: _____
Contract or Grant No. _____
Principal Investigator: _____
Department: _____
Start Date: mm/dd/yyyy End Date: mm/dd/yyyy

b. Agency Name: _____
Contract or Grant No. _____
Principal Investigator: _____
Department: _____
Start Date: mm/dd/yyyy End Date: mm/dd/yyyy

2. Private Sponsorship

- a. Company Name _____
Contract or Grant No. _____
Principal Investigator _____
Department _____
Start Date: mm/dd/yyyy End Date: mm/dd/yyyy
- b. Company Name _____
Contract or Grant No. _____
Principal Investigator _____
Department _____
Start Date: mm/dd/yyyy End Date: mm/dd/yyyy

3. University Sponsorship

- a. Department _____
Contract or Grant No. _____
Department Head _____
Start Date: mm/dd/yyyy End Date: mm/dd/yyyy
- b. Center or Institute _____
Contract or Grant No. _____
Director _____
Start Date: mm/dd/yyyy End Date: mm/dd/yyyy
- c. Special Program (e.g., Distinguished Scientist Program or
Collaborating Scientist Program) _____

- d. Other _____

4. Other Sponsorship

- a. _____
- b. _____

E. Did you use any material in the development of this invention that was acquired from a third party and was subject to a Material Transfer Agreement? Y__ N__
If yes, please attach a copy of such agreement.

F. During the period of time that this technology was being developed, did any of the inventors receive salary support from the Department of Veterans Affairs (“VA”)? Y__ N__
If yes, please provide (attach) details.

Were any VA funds or facilities used in the course of work which led to this invention? Y__ N__
If yes, please provide (attach) details.

V. INVENTION DETAILS

A. Date of conception of the invention: (This is the date of the mental conception of the invention in its present manifestation.) mm/dd/yyyy

B. How was this documented (e.g., lab notebook, photograph, computer file)?

C. Summary and utility of the invention: (Please provide a structural and functional description of the invention as well as the problem(s) it will solve. If possible, attach manuscripts, drawings, abstracts or any other materials that would assist in the understanding of the invention.)

D. Has the invention been reduced to practice (e.g., prototypes, proof of principle, experiments, animal studies, clinical trials)? Y__ N__
If yes, when and how?

VI. DISCLOSURE (In order to obtain valid patent protection on an invention in the United States, a patent application must be filed with the United States Patent and Trademark Office within one (1) year after the invention is first described in a printed publication anywhere in the world and within one (1) year after the invention is first available for sale or in public use in the United States. To preserve patent rights in many foreign countries, a United States patent application must be filed before any public disclosure in any form anywhere in the world and an application must be filed in the foreign country within one (1) year from the U.S. filing date. If these deadlines are not met, the invention is deemed no longer “new” for patent purposes and therefore not patentable.)

A. **Journals:** (Include all manuscripts describing the invention that have been published, those that have been accepted but not yet published, and those that have simply been submitted but not yet accepted or rejected. Also include any manuscripts that you intend to submit within the next six (6) months. In that case, give the best information that you have at the present time. Please note that authors of the manuscript may not necessarily qualify as inventors.)

1. Name of Journal: _____
Title of Manuscript: _____

Author(s): _____

Date of submission/acceptance/publication: mm/dd/yyyy.

2. Name of Journal: _____
Title of Manuscript: _____

Author(s): _____

Date of submission/acceptance/publication: mm/dd/yyyy.

- B. **Conferences:** (Include conferences at which any presentation concerning the invention has been made, as well as conferences which have not yet occurred but for which a manuscript or abstract has been submitted. Also include any conferences at which you intend to disclose information concerning the invention within the next six (6) months.)

1. Title of the Conference: _____

Date: dd/mm/yyyy Location: _____

Title of Abstract or Manuscript Submitted: _____

Is (or was) the abstract or manuscript distributed prior to the conference? Y__ N__ If yes, when? mm/dd/yyyy

2. Title of the Conference: _____

Date: dd/mm/yyyy Location: _____

Title of Abstract or Manuscript Submitted: _____

Is (or was) the abstract or manuscript distributed prior to the conference? Y__ N__ If yes, when? mm/dd/yyyy.

- C. **Theses and Dissertations:** (Include any thesis or dissertation describing the invention that has been submitted to satisfy graduation requirements. Also include any thesis or dissertation that may be submitted within the next six (6) months.)

1. Title of Thesis or Dissertation: _____

Author: _____

Author's Anticipated Graduation Date: mm/dd/yyyy

2. Title of Thesis or Dissertation: _____

Author: _____

Author's Anticipated Graduation Date: mm/dd/yyyy

D. Offer of Sale or Public Use:

1. Has the embodiment of this invention been offered for sale or licensing? Y__ N__

If yes, when? mm/dd/yyyy

To whom and under what circumstances? _____

2. Has any embodiment of this invention been used publicly?

Y__ N__

If yes, when? mm/dd/yyyy

Under what circumstances? _____

E. Other:

Has any other disclosure of the invention (written or oral) been made to a third party who was not bound by a written obligation of confidentiality?

Y__ N__

If yes, when? mm/dd/yyyy

To whom and under what circumstances? _____

SECTION TWO (2)

INVENTOR ASSIGNMENT TO UNM

ASSIGNMENT from _____ whose addresses are set forth on the signature page hereof (the "Inventors"), to the University of New Mexico, an educational institution of the State of New Mexico, whose address is c/o Research & Technology Law, 801 University Blvd. SE, Suite 104, Albuquerque, NM 87106 (the "University").

WHEREAS, the Inventors, while employed by the University, conceived and/or reduced to practice one or more inventions which are described both in the disclosure described below and in other materials associated with the disclosure, including materials prepared after the date of this Assignment. The disclosure is identified as:

| <u>UNM Docket No.</u> | <u>Title</u> |
|-----------------------|--------------|
|-----------------------|--------------|

(both the disclosure and the associated materials are collectively referred to herein as the "Invention Disclosure");

WHEREAS, one or more patent application(s) either have been or may be filed in the future in the United States Patent and Trademark Office and other patent offices covering the invention or inventions described in the Invention Disclosure (collectively, the "Patent Application(s)"). Any such patent application(s) filed as of the date hereof are described below:

| <u>Patent App. Serial No.</u> | <u>Country</u> | <u>Date of Filing</u> | <u>Title</u> |
|-----------------------------------|----------------|-----------------------|--------------|
|-----------------------------------|----------------|-----------------------|--------------|

and

WHEREAS, the University is legally entitled to obtain a formal assignment from the Inventors of their entire right, title, and interest in and to invention(s) and related technology created by Inventors during their employ by the University.

NOW, THEREFORE, the Inventors do hereby assign and transfer unto the University all their right, title, and interest in and to: (a) the invention(s) described in the Invention Disclosure and/or Patent Application(s); (b) any technical information, know-how, trade secret, process, procedure, composition, biological materials, device, method, formula, protocol, technique, software, design, tradename, trademark, copyright, copyrightable material, drawing or data which is related to the aforesaid invention(s) and/or that is included in the Invention Disclosure, whether or not covered by the Patent Application(s); (c) all rights of the Inventors in the Patent Application(s) including but not limited to all divisions, reissues, continuations, continuations-in-part, continuing patent applications, substitutions, renewals, extensions filed and all patent(s) issuing thereon in the United States and all foreign countries; and (d) to the extent the University owns the same under its policies and practices, all improvements to the invention(s) described in the Invention Disclosure and/or Patent Application(s) hereafter made or invented by any of the Inventors (all of the foregoing, (a), (b), (c), and (d) being collectively referred to hereafter as the "Invention"); and (e) the right to assert claims and

bring lawsuits for any violation or infringement of any of the intellectual property rights assigned hereby, including all patents issuing on the Patent Applications.

THE INVENTORS FURTHER ACKNOWLEDGE AND AGREE AS FOLLOWS:

1. In accordance with the University's policies and practices, all net revenues from the Invention (all income received by the University, or its assignee, from commercialization of the Invention, not including payments for research, development or reimbursement of certain costs), shall be divided as follows: forty percent (40%) equally to the Inventors (unless the Inventors have otherwise agreed in writing and so notified the University), forty percent (40%) to the Science & Technology Corporation @ UNM, and twenty percent (20%) to the University.
2. For the purpose of enabling the University, its successors and assigns, to obtain, defend and enforce all United States and foreign intellectual property rights in the Invention, the Inventors shall timely communicate all information, execute all documents, testify in all legal proceedings and take all such other actions necessary or desirable to accomplish such purpose.
3. The Inventors authorize the attorneys of record for the Patent Application(s) to insert in this Assignment where indicated above, or in an Addendum to be attached hereto, the filing date, country where filed, title and serial number of such Patent Application(s) filed hereafter as they become officially known.
4. The Inventors authorize and request all domestic and foreign patent office officials to issue all patents, when granted, to the University, its successors and assigns.
5. The Inventors warrant and represent that no assignment, sale, agreement or encumbrance has been or will be made or entered into by them which would conflict with this assignment.
6. If there shall only be one Inventor, all references herein to Inventors shall be deemed to refer to said Inventor. If there shall be more than one Inventor, this assignment may be signed in multiple counterparts and all such counterparts shall be deemed to constitute a single instrument.

7. THE UNDERSIGNED INVENTORS ACKNOWLEDGE BY THEIR RESPECTIVE SIGNATURES HERETO THAT THEY HAVE READ THE FOREGOING, UNDERSTAND ITS CONTENTS AND HAVE HAD THE OPPORTUNITY TO CONSULT LEGAL COUNSEL OF THEIR CHOOSING CONCERNING THEIR RIGHTS AND OBLIGATIONS HEREUNDER.

Assignor #1: Date
Address:

STATE OF NEW MEXICO)
)
COUNTY OF BERNALILLO) ss.

The foregoing instrument was subscribed and acknowledged before me, this
_____ day of _____, _____ by
_____.

My Commission Expires: Notary Public
Seal:

Assignor #2: Date
Address:

STATE OF NEW MEXICO)
)
COUNTY OF BERNALILLO) ss.

The foregoing instrument was subscribed and acknowledged before me, this
_____ day of _____, _____ by
_____.

My Commission Expires: Notary Public
Seal:

Assignor #3:
Address:

Date

STATE OF NEW MEXICO)
)
COUNTY OF BERNALILLO) ss.

The foregoing instrument was subscribed and acknowledged before me, this
_____ day of _____, _____ by
_____.

Notary Public

My Commission Expires:

Seal:

Assignor #4:
Address:

Date

STATE OF NEW MEXICO)
)
COUNTY OF BERNALILLO) ss.

The foregoing instrument was subscribed and acknowledged before me, this
_____ day of _____, _____ by _____.

Notary Public

My Commission Expires:

Seal:
