

Guidebook of IP/Technology Transfer

Track 1

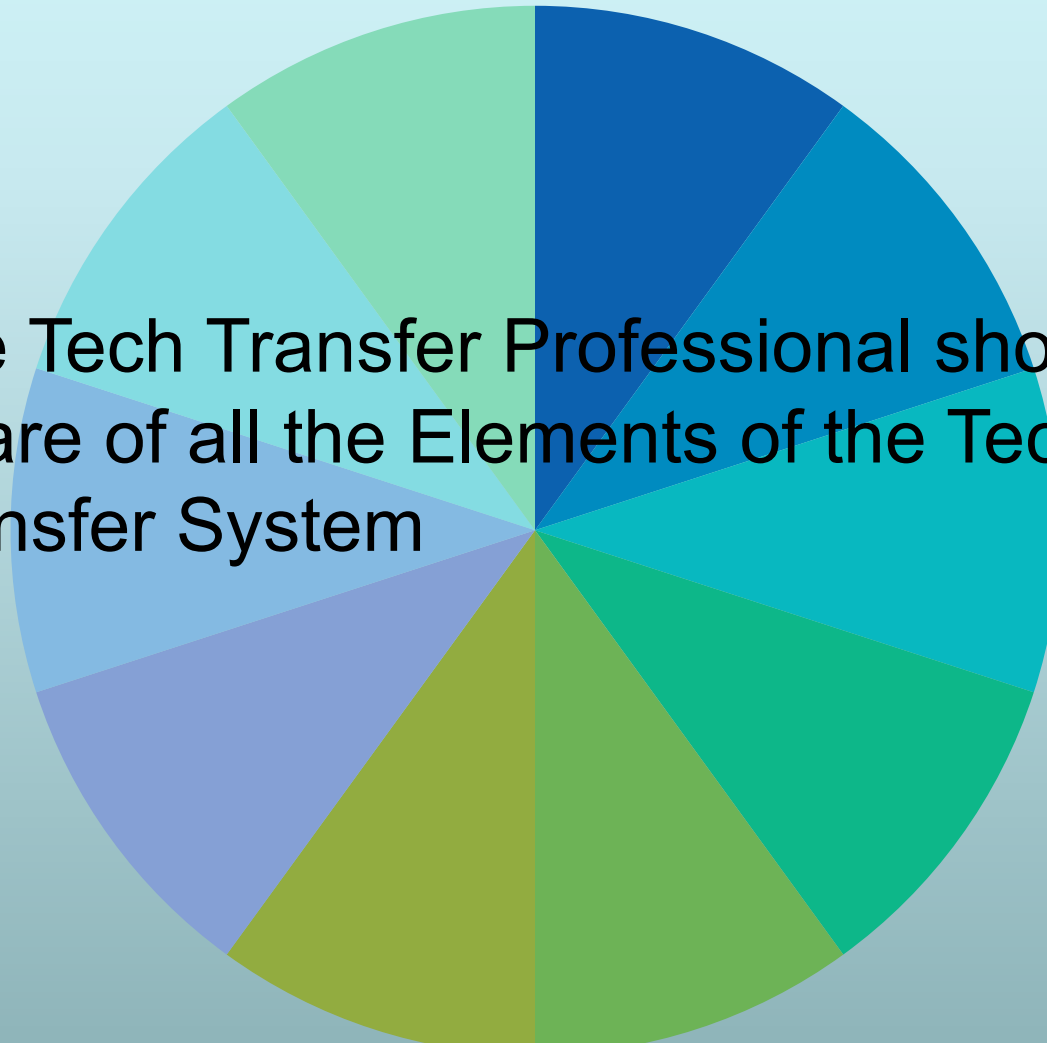
Entry-level Tech Transfer Professional

Topic 1.3

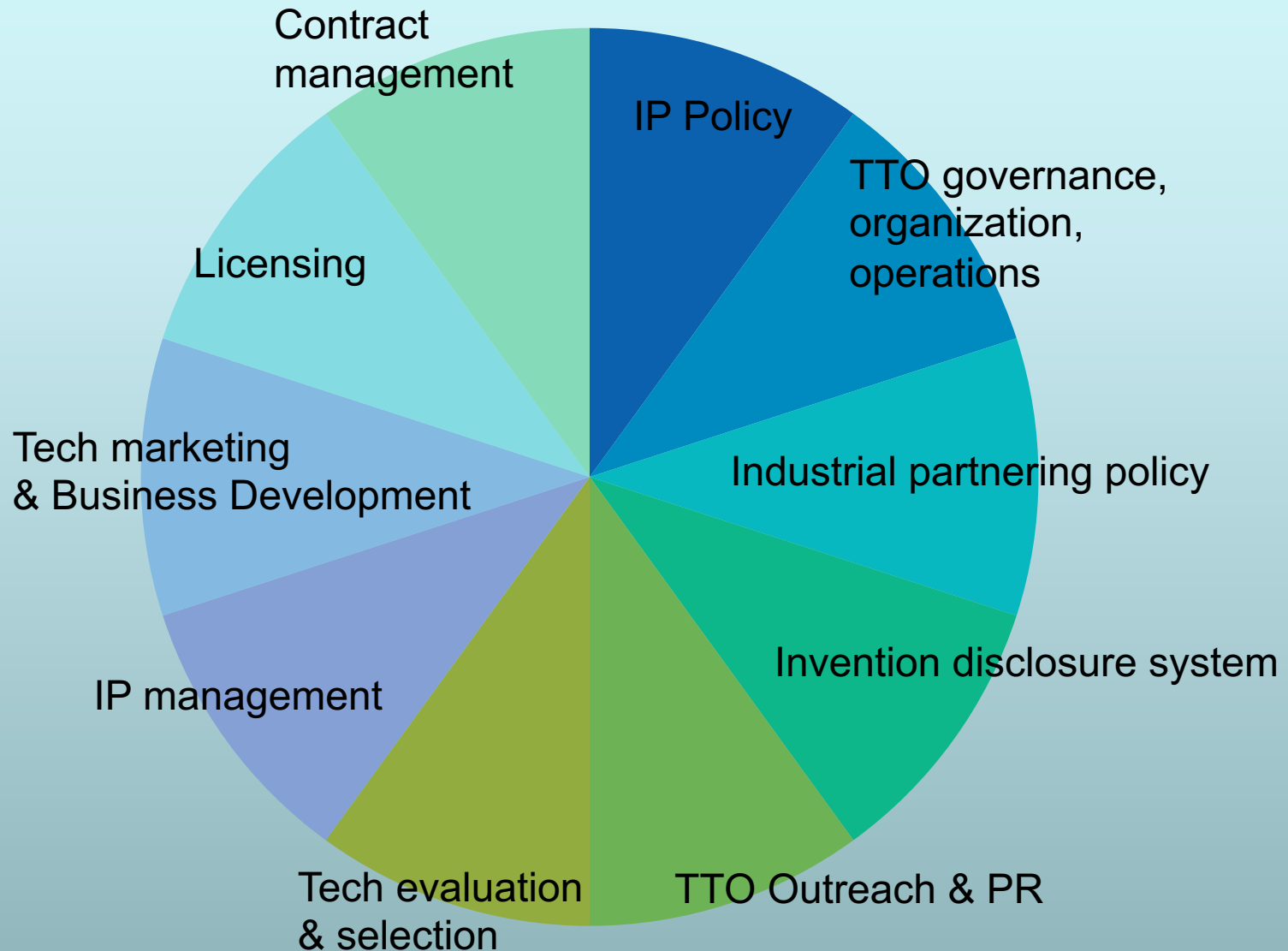
Responsibilities of The Technology Transfer Professional

Technology Transfer system

The Tech Transfer Professional should be aware of all the Elements of the Tech Transfer System



Technology Transfer system



**The Tech Transfer Professional
should understand the basic
Tech Transfer Office functions**

Technology Transfer Office responsible for:

- All IP Policy implementation
- Manage Invention Disclosure process
- Relationship management with inventors
- Invention evaluation & triage
- Patent filing, prosecution, maintenance
- Other IP management
- Technology Marketing, proactive “partnering”
- License negotiation, drafting, signing
- Contract monitoring and management
- Revenue collection and distribution
- IP Policy “troubleshooting”

Key role of “Tech Manager”

In a typical model, the Technology Manager:

- Has “turn-key” responsibility for each assigned invention disclosure
- Responsible for shepherding invention through entire process
- Primary relationship with inventor(s)
- Actively markets technology
- Primary contact with potential licensees
- Negotiates and drafts license contract
- Remains “ombudsman” for relationship and contract

The TTP should understand how best to allocate their time on a weekly, monthly basis

Some important tasks:

- technology analysis, triage, selection
- outreach to internal and external constituents
- commercialization/business development
- technology marketing & business development
- inventor relationships
- license and other contract negotiation
- relationship management with licensees, joint owners
- entrepreneurship recruitment and support
- etc

TTP Responsibilities

- Requires careful thinking about where time is invested
(invention analysis vs. marketing)
- Work towards efficiency
- Never forget key relationships
(inventors, potential/existing licensees
– make them feel most valued)

- Careful attention to any Invention Disclosure
- Relationship between the TTO and inventors
- Technology evaluation and selection
- No accidental loss of any IP rights
- Managing the IP of assigned inventions
- Pre-negotiation valuation
- Developing a vision for invention commercialization
- Finding quality licensees
- Drafting Term Sheets, negotiating licenses
- Drafting license agreements
- Maintaining relationship with licensees
- Managing relationships with joint IP owners and research sponsors

Technology Transfer System



TTP Responsibilities

Communicate value of TTO to faculty, staff, and administrators

Reaching out to faculty, staff, and students to increase awareness of IP/tech transfer

Increasing awareness of TT by potential industrial partners, govt partners, local government, alumni

Look for and promote good PR for TTO and university for tech transfer activities and successes

Technology Transfer System



**Tech Evaluation & Triage,
Pre-negotiation valuation**

TTP Responsibilities

Technology assessment & characterization

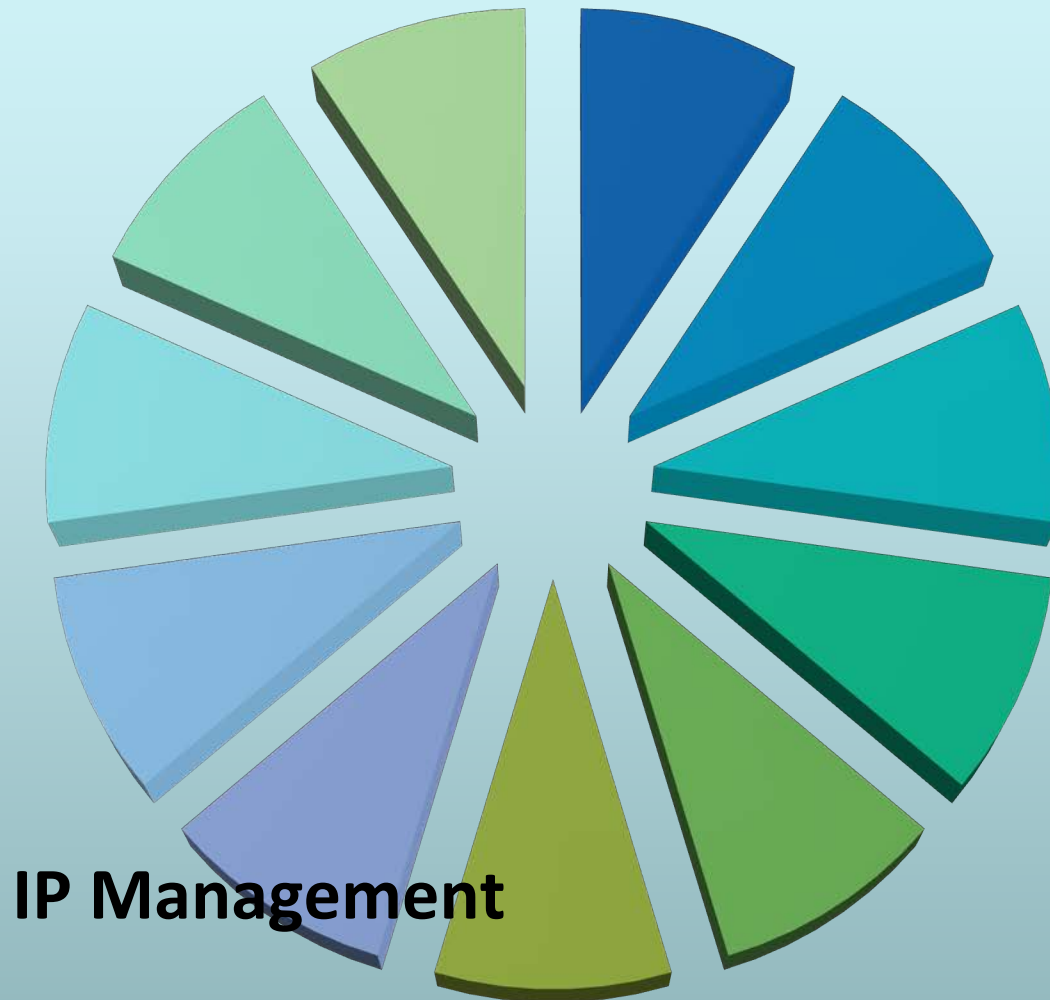
Market applications and potential competitive advantages

Effective patentability (other IP/bioproperty)

The key decision: file or not to file?

Preliminary valuation as basis for negotiating position

Technology Transfer System



TTP Responsibilities

NEVER lose IP rights by accident – only by choice!

Non-disclosure procedures

Property control position assessment

patentability, copyright, PBR, bioproperty, tradesecret(?)

Prior art search and patentability decisions

Patent filing and prosecution

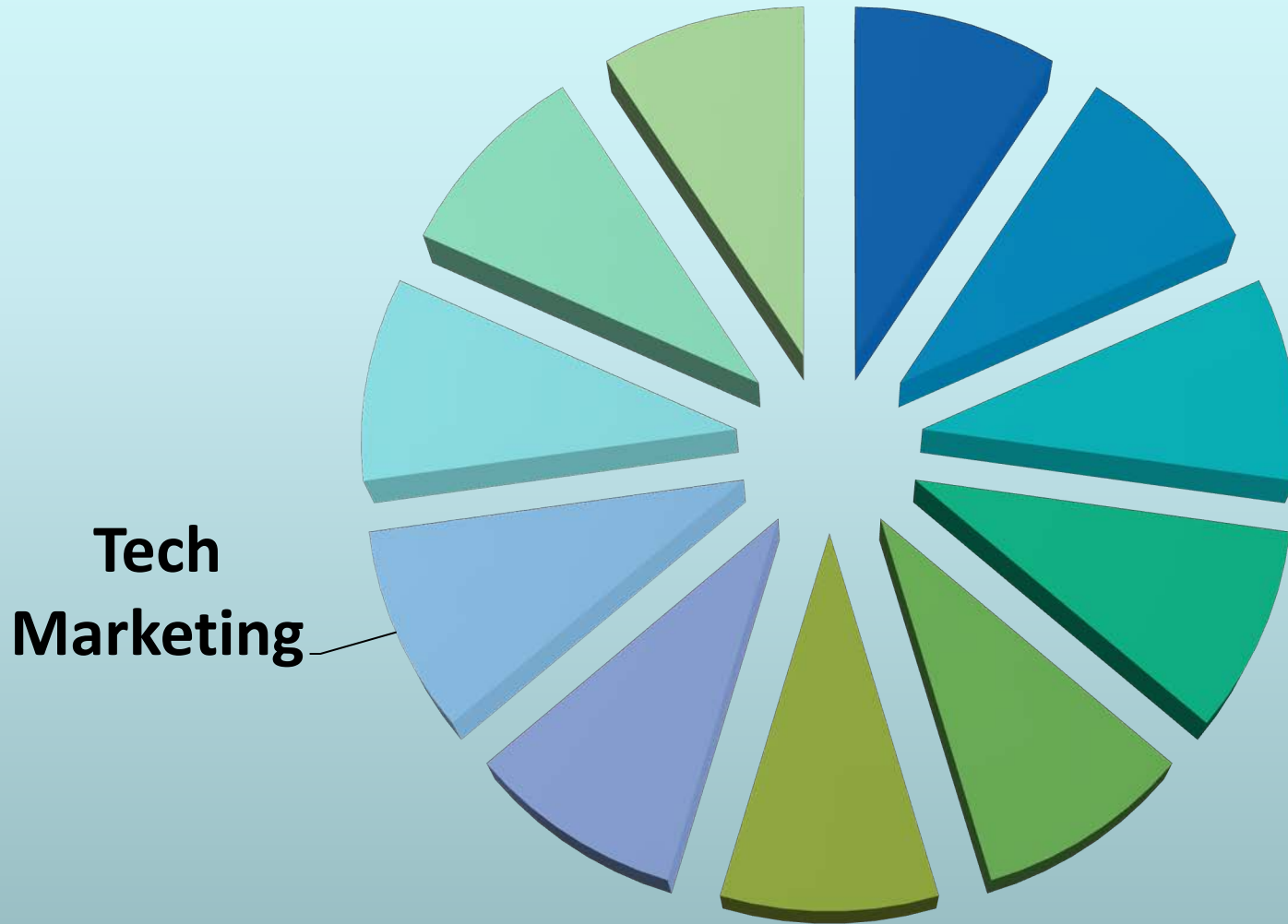
PCT and foreign filing decisions

Enforcement

Cost/benefit of filing decisions

Relationships with law firms

Technology Transfer System



TTP Responsibilities

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- Finding commercial partners
- Market application(s)
- Research into companies in industry
- Identification of potentially suitable partners
- Marketing tools: passive & active
- Contacts and follow-ups
- Web-based tech marketing
- Professional networking
- Showcasing events

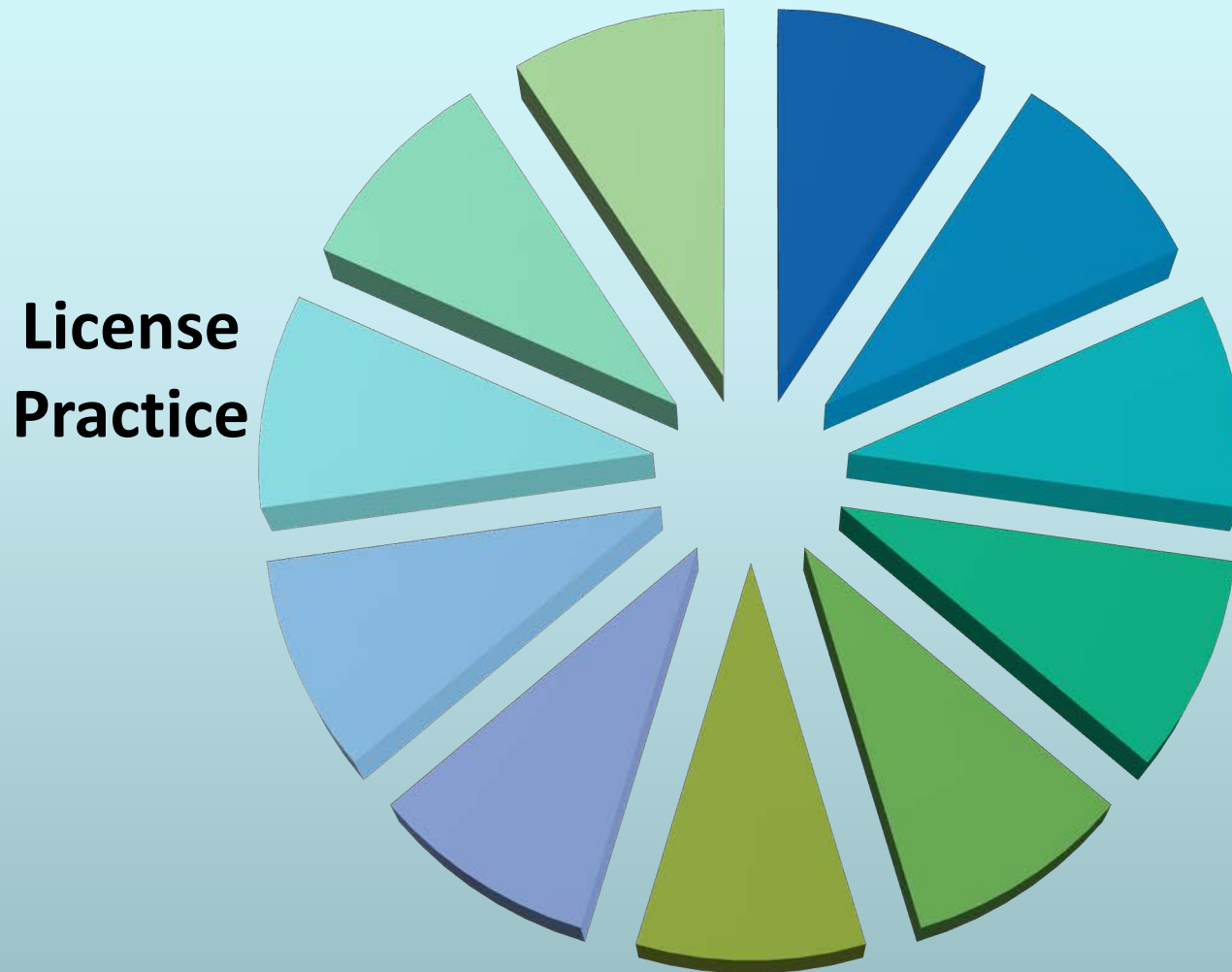
TTP Responsibilities: Technology Marketing

Without marketing.....

technology is rarely transferred

Always be marketing your technologies!

Technology Transfer System



TTP Responsibilities

Thoroughly understand the institutions agreement templates
non-disclosure, material transfer, inter-institutional, option,
non-exclusive license, exclusive license,

Know the limits of negotiable terms and conditions

Know the standard provisions, and non-negotiable terms

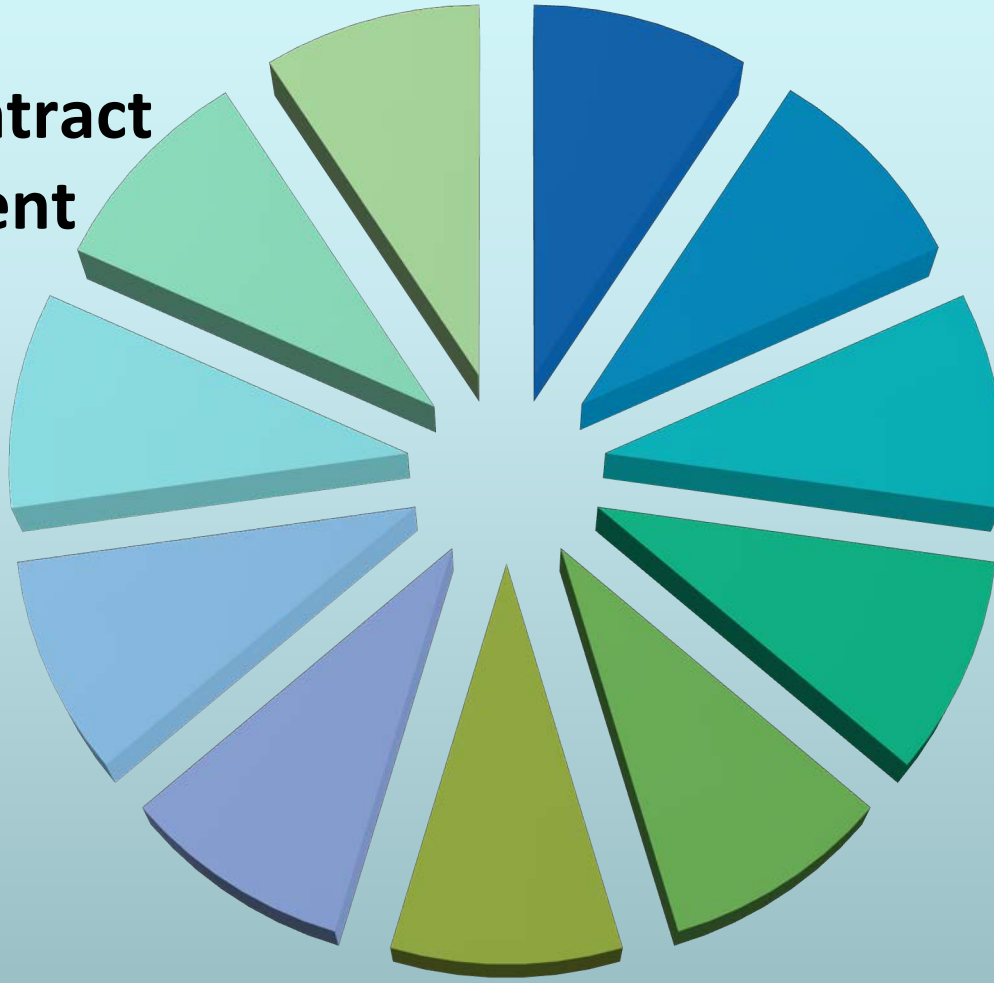
Understand the acceptable forms of financial mechanisms

Signature authority; get decision-maker commitment
before negotiations

Know institutional policy on exclusive licenses vs. non-
exclusive

Technology Transfer System

**License Contract
Management**



Post-signing management, proper hand-off to contract management

Aware of on-going monitoring of compliance

Managing problem contracts

Aware of accounts receivable relevant to negotiated contracts

Always looking for Viable Technology

Novel, unique, and inventive (not obvious)

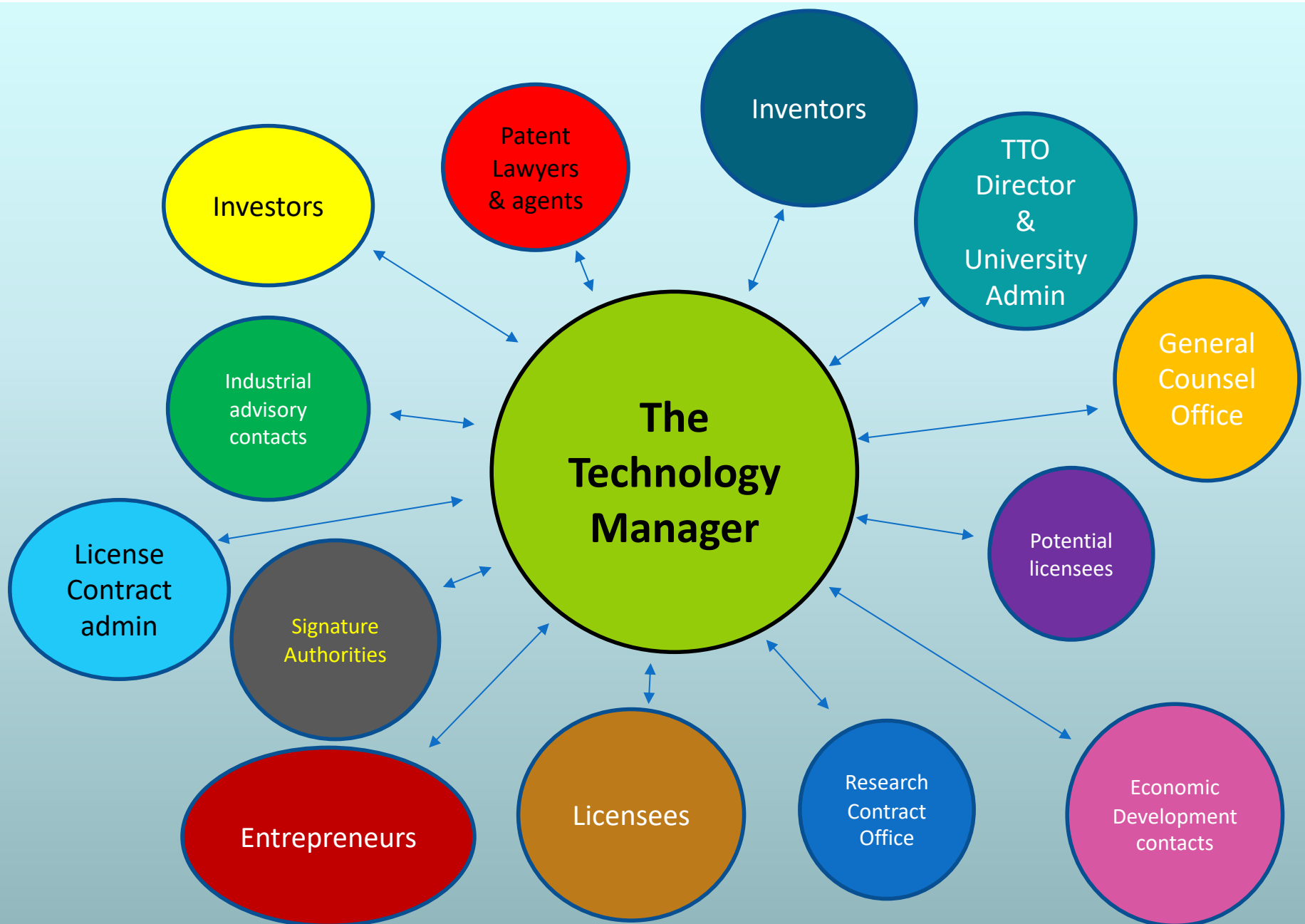
Commercially relevant, economically significant
(don't forget philanthropic applications)

Significant advantage over alternatives

Protectable with effective property right mechanisms

Be on lookout for technologies with local/regional impact

Creation, building, and maintenance of good working relationships with many different constituents:



TTP Responsibilities & Duties:

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- Operate at the highest ethical and professional standards
- Honesty and transparency
- Always do the right thing
- Protect the institution's reputation – and your own
- No self-dealing
- Avoid gossip and detrimental talk of others
- Avoid your own conflicts of interest
- Be responsive
- Be optimistic and positive
- Avoid complaining
- Appreciate the honor of working with inventors and their inventions
- Stay curious
- Use your positive sense of humor and enjoyment of life

Track 1

Entry-level Tech Transfer Professional

Topic 1.1.3

Responsibilities of The Technology Transfer Professional

Thank you