

# **Guidebook of IP/Technology Transfer**

# **Track 1**

## **Entry-level Tech Transfer Professional**

### **Topic 1.5**

#### **Tech Transfer Professional's Basic Skills**

# Tech Transfer Professional's Basic Skills

- Technology familiarity and awareness
- Working knowledge of IP
- Understanding of business, market, and product analysis
- Understanding of and capability of implementing technology marketing methods
- Knowledge of the key contracts of Tech Transfer
- Ability to formulate a negotiating position and to negotiate terms and conditions of an IP agreement
- Written and spoken communication
- Small meeting management
- Document management

# Tech Transfer Professional's Basic Skills

## Technology familiarity and awareness

- TTP ***does not*** need to be a technical expert
- TTP ***does*** need to understand the basics of an invention:
  - what it is, how it works, what makes it unique, how it compares with existing, what problem(s) does it solve
- Appreciation for process of inventing, nature of invention
- Ability to learn quickly about an invention, and the technical environment it operates in
- TTP should cultivate an inherent and constant curiosity regarding each invention they manage
- The TTP may have technical expertise in the invention area but should stay in the TTP role – not a co-inventor

# Tech Transfer Professional's Basic Skills

## Working Knowledge of IP

- Facility with managing confidential information
- Knowledge of what a patent is and isn't; how to obtain, manage, and license a patent
- Ability to conduct a prior art search and patentability analysis on an invention
- Capability of managing outside IP professionals
- An understanding of how to create, manage, and transfer:
  - a trade secret,
  - copyrights
  - trademarks
- Skill in designing and strategically managing an “IP Suite” of different IP that cover an invention/technology

# Tech Transfer Professional's Basic Skills

## Understanding business, market, and product analysis

- Basic understanding of competitive analysis of an invention and existing technologies/solutions
- Understanding, qualifying and quantifying the link between inventiveness of an invention, its market applications, and the economics of the superiority or advantages of the inventiveness
- Capable of determining the applications of an invention
- Ability to develop a quantified “Value Proposition” for an invention
- Ability to do assessments of market characteristics and size

# Tech Transfer Professional's Basic Skills

## Understanding business, market, and product analysis

- Understanding and ability to calculate:  
Cost-of-Goods-Sold, Pricing, Gross Profit Margins
- Working knowledge of the concepts of:  
market share and penetration  
manufacturing, distribution, and sales costs
- Ability to conduct pre-negotiation valuation of inventions using different methods, such as  
Income projection (NPV)  
Comparables, Active Market, Replication Cost,  
Willing Buyer/Willing Seller

# Tech Transfer Professional's Basic Skills

## Understanding and ability to implement technology marketing methods

- Determine an invention's most valuable market applications
- Identify markets and companies in those markets that are likely targets as potential licensees
- Conducting research into specific companies to determine their suitability as licensees, and for key contact info
- Develop means of communicating the technical, and commercial values of an invention to potential partners
- Facility with managing contacts and communications, and information exchanges with potential partners
- Develop creative, multifaceted tech marketing approaches



# Tech Transfer Professional's Basic Skills

## Knowledge of the key contracts of Tech Transfer

- The TTP does not need to be a lawyer
- The TTP should understand all aspects of the key contracts of Tech Transfer:
  - Confidentiality/Non-disclosure Agreements
  - Material Transfer Agreements
  - Option Agreements
  - License Agreements (exclusive, non-exclusive, etc.)
  - Joint IP Ownership Agreements
- TTP knows when to use which Agreement
- TTP should understand which provisions are under TTO control vs. those under legal office authority

## Tech Transfer Professional's Basic Skills

### **Ability to formulate a negotiating position and to negotiate terms and conditions of an IP agreement**

- Ability to establish and justify a pre-negotiation valuation of an invention
- Understanding of how to capture the pre-negotiation value range of the IP/invention through license provisions
- Capability of entering into a professional dialogue with a negotiating counterpart to establish a win-win negotiated agreement based on pre-negotiation valuation and licensee's expectations and market realities

## Written and spoken communication

- Ability to write concise and clear explanations of technical, legal, and business issues and content
- Capability of clear verbal, and written letters, emails to inventors, outside IP professionals, colleagues, potential licensees, entrepreneurs, and others
- Talent to simplify and communicate complex technical, legal, and business topics in verbal, and written forms
- Capability of creating technology marketing materials suitable for promoting commercialization of inventions and recruiting potential partners and entrepreneurs
- Public speaking

## Small meeting management

- Ability to plan and lead small meetings with various combinations of the following groups:
  - inventor teams
  - potential licensees
  - inventors and potential licensees
  - entrepreneurs
  - investors
  - inventors and entrepreneurs
  - entrepreneurs and investors
  - entrepreneurs, investors, and inventors
  - etc., etc.

## Document management

- Ability to organize, locate, collate, and use various combinations of the following documents:

Invention Disclosure and related technical notes

Prior art searches and patentability analyses

Patent application draft

Communications to/from inventors

Technical articles

meeting notes, memos, letters, emails

Term Sheet drafts,

Agreements and Agreement drafts

communications to/from potential licensees/licensees

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**Thank You**