

Guidebook of IP/Technology Transfer

Track 1

Entry-level Tech Transfer Professional

Topic 1.13.2

Initial Contacts & Early Dialogue with Pre-Licensees

Initial contacts and early dialogue with potential licensees

- The first contact
- Setting the framework for discussions
- Information exchange
 - non-confidential
 - confidential
- The TTP orchestrates different communication channels
- Pre-licensing discussion topics

Initial contacts, early dialogue with potential licensees

The first contact (email, then phone)

- You have already identified the contact person
- Usually, this is at the upper management level
Vice President, Manager, Department Head, Director
- Be prepared to state your message quickly
- Be friendly and engaging – but, not too much
- Be professional
- Don't be shy, don't worry,
- Enjoy the adventure of getting to experience the variety of human interactions – most people are very nice to interact with

Initial contacts, early dialogue with potential licensees

The first contact (email, then phone)

- Expect to have around 1 minute to “get your foot in the door” – to grab their attention
- Quick introduction of who you are, who you work for, why you are contacting them
- Explain you are looking for a strategic technology development partner; that your research indicates they might find the technology a good fit for their company
- Practice delivering this entire message in 90 secs or less
- DO NOT mention IP initially (that will send the discussion down the legal sidetrack)

Initial contacts, early dialogue with potential licensees

The first contact (email, then phone)

- Your primary goal is to have them agree to receive non-confidential information about the IP/technology
- Tell them that you have a short, non-confidential summary of the technology to provide them
- You should have non-confidential summary information ready to send right away (i.e., the Tech Brief)
- Send the Tech Brief after the conversation;
- Follow-up in a few days with an email and/or phone call

Initial contacts, early dialogue with potential licensees

The first contact (email, then phone)

- In the follow-up email or call, ask if they are interested in further exploration and discussion;
- If they say “no”, thank them for their time, ask them if they would like to be contacted about future technology opportunities (if so, put them on your company list)
- If they say “yes”, suggest a framework for next steps and a dialogue of information exchange and discussion

Initial contacts and early dialogue with potential licensees

Setting the framework for discussions

- Agree on providing non-confidential information initially
- Agree that in-depth discussions/more details requires a confidentiality agreement be signed by the parties
- Tell them the role the TTP plays in the process; also explain the role the inventors play
- Ask them how their roles will work
- Tell them the TTP is the decision-maker regarding business, contract/licensing, IP

Initial contacts and early dialogue with potential licensees

Setting the framework for discussions

- Tell them the inventor is the technical expert and detailed questions should be directed to them
- Make sure they understand the inventors DO NOT do any negotiations regarding the license or IP
- Explain how the IP process is handled (i.e., TTP/TTO in charge of outside IP service providers)
- Offer to provide all technical and IP details to them under a signed confidentiality agreement
- Offer to arrange a technical meeting with inventor and their technical staff; and a license discussion meeting with TTP/TTO

Initial contacts and early dialogue with potential licensees

Information exchange: Licensor → Licensee

non-confidential

all initial info should be non-confidential

Tech Brief, patent if issued

initial discussion with TTP about the

opportunity – elaboration of Tech Brief

data of results (no trade secret info)

confidential

patent application, patent preparation file and

correspondence with patent lawyer

details of invention

Initial contacts and early dialogue with potential licensees

Information exchange: Licensee → Licensors

non-confidential

- all initial info should be non-confidential
- general discussion of licensee and its business
- discussion of the market of licensee

confidential

- details of licensee's manufacturing, competitive advantages, strategic business objectives, etc.

Initial contacts and early dialogue with potential licensees

TTP orchestrates different communication channels

- TTP sets up all communications between potential licensee and inventors; TTP leads initial meetings
(TTP in first call/meeting, maybe not later)
- TTP sets up all communications between potential licensee and outside IP professional; TTP leads initially
(TTP in first call/meeting, maybe not later)
- TTP sets up and manages all communication between potential licensee, inventors, IP lawyer

Initial contacts and early dialogue with potential licensees

Pre-licensing discussion topics

All aspects of the invention

- Inventiveness
- Market relevance
- Value proposition
- Technology Readiness Level
- Technology hurdles and steps to overcome them

Initial contacts and early dialogue with potential licensees

Pre-licensing discussion topics

All aspects of the invention

- Primary and other applications
- IP situation (current, pending, future)
- Potential applications, products, services
- Possible business models
- Tech Readiness Level and development plans

Initial contacts and early dialogue with potential licensees

Pre-licensing discussion topics

The Licensee, its business, its markets

- History of company
- Ownership of company
- Main products and services
- Competitors
- Geographical markets
- Business model

Initial contacts and early dialogue with potential licensees

Pre-licensing discussion topics

The Licensee, its business, its markets

- Experience with innovation process and managing invention and IP
- Description of the markets licensee is in size, characteristics, dynamics, etc.

Initial contacts and early dialogue with potential licensees

Pre-licensing discussion topics

Potential Collaboration between the Parties

- Considering how to collaborate on R&D effort
- Possibility for licensee to sponsor research in inventor's lab
- Potential for personnel exchanges, both ways
- Licensee's need for consulting by inventor
- Inventor's willingness/interest in consulting

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Thank you