

# **Guidebook of IP/Technology Transfer**

# **Track 1**

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

### **Topic 1.15**

#### **Post-signing license management: TTP's ombudsman role**

# Post-signing license management:

## TTP's ombudsman role

- Licenses are like marriages:
  - The real work of the relationship begins on signing
- Once the license is signed, the implementation of the agreed development plan begins
- Issues about the technology *per se* will naturally arise which will require attention and mutually agreeable resolution by licensee and licensor
- Issues regarding license terms and/or conditions will almost certainly surface
- The licensor and licensee must stay in close contact regarding management of, and decisions related to, the IP

# Post-signing license management:

## TTP's ombudsman role

- There are numerous issues that naturally arise in the typical course of a license agreement
- Some of these issues can, and will, be easily remedied by the contract administrators of licensee and licensor
- However, there issues will arise which require the special touch and expertise of the TTP
- The TTP negotiated the license, and so has a unique relationship with the counterpart negotiator, and the licensee
- This relationship can be THE key to resolving problems between licensee and licensor
- This is when the good rapport between the license negotiators – pays off

# Post-signing license management:

## TTP's ombudsman role

- Dictionary meaning of *ombudsman*:
  - “one that investigates, reports on, and helps settle complaints”
- Be aware: to the licensee, the PSRI is a large and bureaucratic organization
- The licensee knows only the TTP and inventor
- The inventor is NOT the person to handle issues regarding the license
- The TTP is the natural person for the licensee to contact if the contract administrator can't solve the problem

# Post-signing license management:

## TTP's ombudsman role

- Since the TTP negotiated the details of the license, had various conversations with the licensee, he or she understands the intent of the parties
- At the conclusion of the license signing, the TTP should make it clear to the licensee that he/she will remain as a contact point at the PSRI, for the licensee, for the life of the agreement
- However, the formal Licensor contact in the Agreement should probably not be the TTP  
otherwise, they may get bogged down with minutiae  
it's best for TTP to play a "behind the scene" role
- The TTP will take the lead in writing and negotiating and Amendments to the license agreement

# Post-signing license management:

## TTP's ombudsman role

- When a representative of the licensee calls the TTP, the TTP should take responsibility to resolve the problem in a timely manner
- This may require TTP contacting the inventor, the contract administrator, the accounting or legal department, or others
- The TTP often must orchestrate and manage complex and tricky situations – requires significant interpersonal skill, diplomacy, and good judgement
- Sometimes, the licensee's problem lies with the inventor – this requires very careful balancing of all aspects of the problem, excellent judgement, solid ethical foundation, and the backing of management

# Post-signing license management:

## TTP's ombudsman role

### In summary:

- A signed license agreement is the ONLY reliable mechanism for achieving the primary goal of the PSRI licensor: development and dissemination of the IP
- Therefore, it is in the TTO's and TTP's best interest to take an interest in the success of the license/licensee
- As a result, the TTP role as license ombudsman makes perfect sense and is one of the essential roles they play in the overall success of IP/technology commercialization

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**Thank you**