

Guidebook of IP/Technology Transfer

Track 1

Entry-level Tech Transfer Professional

Topic 1.3.3

The TTP's Role with Inventors & Research Teams

TTP's Role with Inventors

& Research Teams

- Treat every inventor as if their invention is the most important in the TTP's portfolio
- Always timely responsiveness to inventors
- Try to maintain semi-regular contact with inventors, especially for the most active cases – but even for low-activity cases, stay in-touch
- From initial receipt of the Invention Disclosure, throughout the entire IP management/tech transfer process, **BE CURIOUS!**
- Remain interested in the invention and its applications – until it is abandoned – **remain curious**

TTP's Role with Inventors

& Research Teams

Know the TTP's role:

- Knowledgeable about: the invention disclosure process,
- IP creation and management,
- market relevance assessments,
- tech marketing and business development, start-ups and entrepreneurship,
- agreements
- The advisor on all things related to:
 - inventiveness,
 - IP (particularly patents)
 - market applications
 - Value Proposition development
 - when to use certain agreements (NDA, MTA, etc)

TTP's Role with Inventors & Research Teams

Be sure inventors and research teams know their role in IP management and tech transfer

- TTP is **sole negotiator** of financial/license terms with outside parties
- Inventors & TTP work “behind the scenes” to agree on tech marketing and licensing strategy – inventors **DO NOT** take the lead in license/IP/business discussions with potential licensees
- TTP **DOES NOT** take the lead in any technical issues, leaving that role for inventors.
- Although it is good practice for the TTP to be an interested and enthusiastic part of the invention team (as manager of IP, commercialization, licensing aspects) – the TTP **SHOULD NOT** become too involved in the technical work of the team.
- The TTP should avoid becoming a co-inventor!! (very problematic)

TTP's Role with Inventors & Research Teams

Be sure inventors and research teams know their role in IP management and tech transfer

- TTP coordinates communication between inventors and outside IP service professionals
- TTP makes it clear that the final decisions on patent preparation and filing are for the TTO/TTP
- TTP assures inventors that they are the primary decision-maker regarding technical decisions during the patent application preparation process
- TTP's role in patent application preparation is to facilitate dialog between inventors & IP lawyers or agents; TTO/TTP controls work of the IP lawyer or agent

TTP's Role with Inventors

& Research Teams

Know the TTP's role:

- Leads the tech marketing campaign strategy, design, and implementation
- The primary connector with companies that are potential licensees
- Orchestrates the communications between potential licensee companies and the inventor(s)

TTP's Role with Inventors & Research Teams

Inventors and research teams' role in IP management and tech transfer

- Inventors must be willing to assist the TTP in the design and implementation of a tech marketing campaign
- Inventors and research teams should provide advice to TTP in developing tech marketing materials
- Inventors and research teams should be willing to meet with potential licensee company representatives, under the instigation and direction of the TTP
- Inventors should NEVER take the lead in developing a working relationship with a potential licensee without the knowledge of the TTP

TTP's Role with Inventors

& Research Teams

Know the TTP's role:

- Responsible for developing and implementing the IP management and licensing strategy
- Responsible for leading all discussions related to IP, confidentiality, material transfer, option, or licensing, or commercialization-related
- TTP can facilitate, but generally not take the lead in, discussions related to research support/contracts between companies and inventors

TTP's Role with Inventors & Research Teams

- TTP and inventors work collaboratively to develop an overall understanding of the commercialization/licensing strategy to be implemented.
- The mutually-agreed commercialization strategy to be led by the TTP and fully supported by the inventors
- If the TTP and inventors don't agree on the IP commercialization strategy – they need to work it out until they do agree
- A failure to agree on IP/commercialization strategy by TTP and inventors is a recipe for failure – not acceptable!
- It is the TTP's responsibility to persuade inventors to change their mind, if necessary; otherwise TTP must adapt – or the IP/technology will not successfully proceed to commercialization

TTP's Role with Inventors

& Research Teams

The TTP's role:

- Sole drafter and proposer of Term Sheets to potential licensees
- Term Sheet discussion and negotiation with potential licensee strictly and solely done by TTP – ***NO back-channels*** between inventors and potential licensee
- TTP should always act in best interest of the inventors and the institution – never take the side of the company/licensee against the inventors or institution**

** TTP can act informally, behind the scenes, to solve certain problems encountered by the licensee – but allegiance is always with institution and inventors.... In that order

TTP's Role with Inventors & Research Teams

- TTP always keeps inventors informed about negotiation status, and strives to NOT surprise inventors with significant changes in negotiation strategy or tactics.
- Although TTP makes it clear to potential licensee that it is the TTP/TTO that is lead negotiator and final decision-maker on the terms and conditions of any and all agreements....
 - the TTP also makes it clear that the inventors need to be generally in agreement with the terms and conditions too
- A license agreement signed against the wishes and desires of inventors is almost always destined to fail.
- The TTP strives to act in the best interest of the inventors, as much as is reasonably possible

TTP's Role with Inventors

& Research Teams

The TTP's role:

Although the inventors are clearly one of the most important clients of the TTP (also the institution), there is one client that the TTP should consider as primary.....

the IP/technology

If the TTP acts in the best interest of successful commercialization of the IP/technology

everyone (inventors, institution, TTO, etc.)
will be happy

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Thank You