

# **Guidebook of IP/Technology Transfer**

# **Track 1**

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

### **Topic 1.7.3**

#### **Working with Patent Searchers, Agents, IP Lawyers, and Law Firms**

# **Working with patent searchers, agents, IP lawyers, and law firms**

- The TTO should have a standard set of operational policies regarding how outside IP service providers interact with TTPs and inventors
- If possible, the TTO should interview potential IP service provider candidates to determine which ones will abide by the TTO's policies
- When engaging with an outside IP professional, enter into a letter-agreement in which the ground rules for engagement are laid out
- “Shop around” to find the IP service providers that are the best fit for your TTO

# Working with outside IP Professionals

## Suggested Rules of Engagement

- Establish agreed-upon hourly rates for services
- Mutually agree on a process where “not-to-exceed” cost thresholds are established for various tasks

Examples of such cost thresholds:

prior art search = \$500

patentability opinion = \$500

1<sup>st</sup> draft of patent application = \$5,000

response to patent office action = \$2,000

- Service provider to obtain TTO prior approval before proceeding beyond threshold

# **Working with outside IP Professionals**

## **Suggested Rules of Engagement**

- Establish hourly rates for services
- Hourly rates should be broken down by specialist and seniority
- TTO and IP Professional should have an understanding of how junior versus senior professionals will be used on TTO cases, and how such will be billed

# Working with outside IP Professionals

## Suggested Rules of Engagement: pricing

- Consider “fixed price” arrangements for routine tasks (e.g., search/opinion, patent filing, etc)
- Consider “bulk pricing” arrangements in which the TTO agrees to a certain number of cases submitted annually, in exchange for discounted prices

# **Working with outside IP Professionals**

## **Suggested Rules of Engagement: billing**

- The TTO and IP Professional to agree on the form and content of billing invoices.
- TTO should designate someone to review and approve invoices – review to include involvement of the managing TTP

# Working with outside IP Professionals

## Suggested Rules of Engagement:

- It must be absolutely clear to IP Professionals that the TTO is the client – not the inventor
- IP service providers must always take direction from the TTO, not inventors
  - (but, must treat inventors with utmost respect and professional courtesy)
- IP Professionals must understand that the TTP is the representative of the TTO – and therefore, the key decision-maker



# Working with outside IP Professionals

## Suggested Rules of Engagement:

- IP Professionals will assume that the TTO and TTP are the manager of the entire IP process
- The TTP will orchestrate all meetings between IP Professionals and inventors  
(although the TTP need not be at each meeting, or intervening in each communication)
- Under no circumstances will the IP Professional act or communicate “behind the back” of the TTO/TTP

# Working with outside IP Professionals

## TTO Operations

- Although the TTO will naturally develop very good working relationships with a few select firms/individuals.....
- The TTO should have a portfolio of IP Professionals  
for technical and/or legal specialization  
as a risk management tactic
- The TTO should always be on the lookout for new IP Professional talent/expertise/experience  
(and be willing to give them a try)

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**Thank you**