

# **Guidebook of IP/Technology Transfer**

# **Track 1**

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

### **Topic 1.7.5**

#### **IP Management and Interaction with Potential/Existing Licensees**

# **IP Management & Interaction with Potential/Existing licensees**

## **Marketing & pre-licensing**

- Use NDAs carefully
  - no need for NDA for patent information that will be published in the mid-to-short term
- Don't share claim language strategy without NDA
- Provide non-confidential Tech Brief and (maybe) patent Abstract prior to NDA
- Signing the NDA allows full patent application disclosure

# **IP Management & Interaction with Potential/Existing licensees**

## **Licensing discussions**

- Under an NDA, and for reliable, and viable candidates for a license, provide full disclosure of the patent application and claims
- Discussion of potential applications of importance to the company are important

# **IP Management & Interaction with Potential/Existing licensees**

## **Licensing negotiations**

- Under an NDA, and for reliable, and viable candidates for a license, provide full disclosure of the patent application and claims
- Discussion of potential applications of importance to the company are important
- Authorize and orchestrate discussions between potential licensee and outside IP Professionals (e.g., patent lawyer)

# **IP Management & Interaction with Potential/Existing licensees**

## **Licensing negotiations**

- TTO/TTP must make it clear that the PSRI will remain the owner of its IP..... and that
- The potential-licensee will NOT be an owner of the IP – only licensee
- The TTO/TTP must make it absolutely clear that patent decisions lie solely with the PSRI TTO
- The TTO/TTP will also make it clear that any and all input by the licensee to any patent decision will be welcomed and utilized, to the extent reasonably possible
- All this to be made clear to the outside IP Professional

# IP Management/Interaction with licensees

## Managing the Relationship between Licensee & Outside Patent Professional

- TTO/TTP makes clear (verbally & writing) that TTO is owner and final decision-maker on all IP decisions where PSRI is sole owner
- TTO/TTP authorizes licensee and IP Professional to communicate directly on all IP matters, with copy to TTO
- TTO/TTP to include licensee in all significant patent decision-making
- TTO/TTP to accommodate licensee's patent input as much as reasonably possible

# IP Management/Interaction with licensees

## **Managing the Relationship between Licensee & Outside Patent Professional**

- TTO/TTP makes clear that IP Professional will send all IP invoices to the TTO – not licensee
- If invoices sent directly to licensee, TTO will begin to lose control of the IP management
- TTO will pay IP Professional invoice and subsequently bill licensee for reimbursement of these expenses
- DO NOT allow licensee to pay directly or TTO's management control of IP will erode over time



# IP Management/Interaction with licensees

## **Managing the Relationship between Licensee, Outside Patent Professional, & Inventor**

- TTO/TTP makes clear that TTO must be “in the loop” on all communications regarding current and future patent filings
- TTO/TTP must make it very clear to inventors that they go through the TTO on IP issues, NOT the licensee
- Inventors must submit any and all future invention disclosures to the TTO/TTP prior to informing the licensee verbally or in writing
- The TTO/TTP will notify the licensee of future invention disclosures that are relevant to the license agreement, or research agreement (if any)

# IP Management/Interaction with licensees

## **Managing the Relationship between Licensee, Outside Patent Professional, & Inventor**

- TTO/TTP and licensee should agree on the following ownership rules for any future inventions relevant to the license agreement:
- Ownership directly tied to inventorship
- Any inventions made solely by personnel of one party, are owned solely by that party;
- Any invention made jointly by both parties, are owned jointly/equally by the parties
- TTO and licensee should agree on how to manage jointly owned IP

# IP Management/Interaction with licensees

## **Managing the Relationship between Licensee, Outside Patent Professional, & Inventor**

TTO and licensee should agree on how to manage jointly  
-owned IP:

- Who is responsible for taking lead in patent management?
- How and when will patent-related communications be routed between the parties and patent offices?
- How will the costs be handled?
- How will decisions be made?
- How will jointly-owned patents be handled, regarding the existing license agreement?

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**Thank you**