

The University of Texas at San Antonio

Job Description

Job Title: Technology & Intellectual Property Management Specialist

Code: 19156

Salary Grade: 61

FLSA Status: Exempt

Department/Division: Office of Commercialization and Innovation

Reports To: Director Technology Transfer and Commercialization

Summary

- **Function:** To manage UTSA's intellectual property portfolio, including patents, trademarks, and copyrightable works as per policies and procedures. Seeks protection of approved innovations by drafting, filing and prosecuting patent applications or applications for copyright protection on intellectual property under the guidance of the Director of Technology Transfer and Commercialization ensuring compliance with OCI procedures and policies. Oversees patent application drafting between inventors and attorneys, coordinates with licensees on desired filings, develops strategies for office action responses, evaluates unlicensed patents prior to maintenance fee authorizations, ensures patent budget resources are used effectively, and reviews and approves attorney's invoices for payment. Bills licensees and tracks revenue received from UTSA licensees.
- **Scope:** Responsible for IP capture, protection, and data tracking including copyrights, patents, trademarks, and trade secret for commercialization of university technologies. Oversees the implementation, configuration, integration and data integrity of the technology database for intellectual property assets. Recommends outside counsel for the prosecution of approved filings, implements approved recommendations and monitors billing for compliance with contract terms.

Duties

- **Typical:**
 1. Receives initial technology disclosures and ensures completeness of the required information from the creators. Engages with creators, university administrators, and OCI team members regarding the disclosed creations.
 2. Supports departmental workflow and efficiency through identification and configuration of technology management solutions. Oversees the implementation, configuration and integration of technology solutions for the OCI.
 3. Populates, organizes, monitors and maintains the technology solutions for all IP which includes submission and reporting for disclosures, patent

applications, and patent prosecution capture and tracking, improving OCI customer services.

4. Supports the management decision-making of the OCI Director and the Chief Commercialization Officer by providing data to support the preparation of OCI's internal and external reporting and planning requirements. Creates and runs reports to support OCI Director budget decision making and budget tracking and forecasting for outside counsel and other related expenses.
5. Assists in the commercialization of innovations by conducting patent searches associated with UTSA intellectual property and oversees the filing and prosecuting patent applications or applications for copyright protection on approved intellectual property.
6. Captures, tracks, and communicates approved outside counsel communications and confirms OCI decisions are implemented.
7. Coordinates the timely execution of legal documents for IP matters with United States Patent and Trademark Office (USPTO), Copyright Office and external legal counsel.
8. Reviews outside counsel invoices to ensure compliance with UT Office of General Counsel (OGC) policies and recommends approval for payment to Director. Negotiates resolution of OGC policy cost compliance issues including cost revisions.
9. Manages the intake and oversight of the Venture Incubator Tenants. Ensures procedures are followed and assists clients in completing compliance requirements and other contractual obligations and rental payments.
10. Prepares invoices and tracks revenue received from licensees.
11. Prepares materials and initial drafts as necessary for provisional patent applications for new technologies based on disclosures by creators. Reviews drafts with the creators and OCI colleagues. Finalizes drafts and sends to outside counsel for review and approval. Prepares and files copyright applications.
12. Drafts and negotiates Material Transfer Agreements (MTA) and Confidentiality Disclosure Agreements (CDA) for relevant intellectual property when working with a third party (i.e., another business).
13. Evaluates software disclosures for patentability and/or copyright protection. Prepares, recommends appropriate licensees and negotiates licenses for software and other copyrightable works developed at UTSA.
14. Performs other duties as assigned.

- Periodic:

1. Oversees and evaluates law school interns from St. Mary's Law School Intern Program.

Education

| Required | Preferred |
|--|--|
| Bachelor's degree in science, engineering or business. | Master's degree in science, engineering or business or JD. |

Other Requirements

| Required | Preferred |
|---|------------------|
| Ability to meet deadlines, define, prioritize and direct own activities to meet critical objectives. | N/A |
| Ability to converse on scientific and technical matters in a variety of disciplines with investigators, outside counsel and non-scientists. | |
| Ability to problem solve, work with details and excellent decision making skills. | |
| Excellent oral and written communication, negotiation and presentation skills. | |
| Criminal Background Check (CBC). | |

Experience

| Required | Preferred |
|---|--|
| Minimum of 4 years of direct experience in research, technology development and/or business analysis. Knowledge of intellectual property development, patent, copyright and trademark law, and business incubation. | Experience of 3 or more years working with outside counsel on patent prosecution and review of invoices. |
| | Experience of 3 or more years with Intellectual Property Management databases. Negotiation experience. |
| | Knowledge of United States Patent and Trademark Office (USPTO) and Copyright Office. |

Equipment

| Required | Preferred |
|---|---|
| PC's. Knowledge of all Microsoft Office software and ability to learn and use institutional software systems. | Sophia or Inteum experience, i-Edison reporting experience Knowledge of and experience with online IP references resources (PAIR, EPAS, TESS, TSDR) preferred. Knowledge of IP Docketing. |

Working Conditions

| Usual | Special |
|------------------------------|--------------------------------------|
| Standard office environment. | Occasional evening and weekend work. |

Supervision

| Received | Given |
|---|---|
| Director of Technology Transfer and Commercialization | St. Mary's University law school interns. |

Accuracy

Proficiency in all phases of the duties performed.

Security Sensitive

Specific job requirements or physical location of some positions allocated to this classification may render the position security sensitive, and thereby subject to the provisions of section 51.215 Texas Education Code.

Internal Control

Within the scope of position duties, responsible for seeing that operations are effective and efficient, assets are safeguarded, reliable financial data is maintained, and applicable laws, regulations, policies, and procedures are complied with.