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Position #: (NUNC)..........
Developed by:QT, JT, DS,JP
Reviewed by:......SG
Approved by:......LK
Date:10/00, 12/00, 1/09; 06/12
12/12:10/14

UNIVERSITY OF RHODE ISLAND Position Description

TITLE: Director, Intellectual Property and Commercialization

DIVISION: Division of Research and Economic Development

REPORTS TO: Associate Vice President for Research, Intellectual Property Management and

Commercialization

GRADE: 15

SUPERVISES: Support staff

BASIC FUNCTION:

In consultation with the Associate Vice President for Intellectual Property and Economic Development, advise faculty and students regarding intellectual property (IP) agreements; evaluate, protect, and license IP agreements, and evaluate the IP provisions of sponsored research agreements. Provide technical/legal expertise to the Executive Director of the URI Research Foundation in commercializing IP agreements.

ESSENTIAL DUTIES AND RESPONSIBILITIES:

Advise faculty and students regarding IP agreements, including awareness of the URI technology transfer program, encouraging faculty, staff and students to participate therein, via oral presentations and written materials.

Review, revise and negotiate the following: confidential disclosure agreements (CDAs), non-disclosure agreements (NDAs), material transaction agreements (MTAs), and IP provisions of sponsored research agreements with federal and non-profit organizations.

Evaluate and/or draft licensing and research agreements, if necessary with outside counsel, including patent, trademark and copyright license agreements, inter-institutional agreements, and sponsored research agreements.

Negotiate licensing and research agreements with third parties and execute agreements, pending approval by the Associate Vice President for Research.

Monitor and track licensees to determine if they are complying with license terms, such as required reports and payment of royalties, fees and other licensing revenues, and, if needed, take action to bring them into compliance.

Identify potential IP infringers, investigate alleged infringement and, if needed, take action to end the infringement.

Work with the Office of Research Integrity to evaluate conflict of interest for faculty, staff and students.

Assist in the formation of companies, including drafting corporate legal documents and working with

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outside counsel under the direction of the Executive Director of the URI Research Foundation.

Establish and maintain a service-oriented working relationship with customers, including URI administrators, URI creators of IP, and potential partners in businesses or in other institutions.

Work with the Associate Vice President for Research, as needed, to protect new inventions and innovations produced by faculty and students. Act as the lead for copyrights and trademarks protection.

Work with the Associate Vice President for Research and Executive Director of the URI Research Foundation and outside counsel on the formation of companies, including corporate formation documents.

Responsible for reviewing contract and research agreements for URI Research Foundation, including alias for Polaris MEP.

Work to support the Rhode Island Small Business Development Center in providing information to clients on legal, trademark, and copyright questions.

Represent URI on IP matters to corporate partners, government agencies, and other organizations.

Update Vice President for Research on progress.

OTHER DUTIES AND RESPONSIBILITIES:

Perform other duties as assigned.

LICENSES, TOOLS AND EQUIPMENT:

Personal computers, printers; word processing, database management and spreadsheet software.

ENVIRONMENTAL CONDITIONS:

This position is not substantially exposed to adverse environmental conditions.

QUALIFICATIONS:

Required: Registered attorney; a degree in a life or physical science; registered to practice before the United States Patent and Trademark Office (USPTO) for a minimum of two years; minimum of two years of experience in drafting and prosecuting patent applications in life or physical sciences; minimum of two years of experience in drafting intellectual property agreements for licensing intellectual property, including CDA, NDA, MTA research and licensing agreements; minimum of one year of experience negotiating intellectual property licensing agreements in either academic or corporate settings; demonstrated strong verbal and written communication skills; demonstrated strong interpersonal skills; demonstrated ability to organize intellectual property documents in an effective manner; demonstrated ability to organize, coordinate and supervise support staff; demonstrated proficiency in using database management, spreadsheet and word processing software; demonstrated commitment to diversity.

Preferred: PhD in a life or physical science; demonstrated experience in negotiating federal contract agreements.

ALL REQUIREMENTS ARE SUBJECT TO POSSIBLE MODIFICATION TO REASONABLY ACCOMMODATE INDIVIDUALS WITH DISABILITIES.