

Job Description

Job Title:	Commercialization Officer – Information Technology
Department:	Office of Research
Reports To:	Director, Commercialization
Jobs Reporting:	
Salary Grade:	USG 13
Effective Date:	May 2018

Primary Purpose

The Waterloo Commercialization Office (WatCo), is a functional group within the Office of Research that reports to the Director, Commercialization.

The Commercialization Officer will provide intellectual property management services consistent with the provisions of UW Policy. The Commercialization Officer plays an active role in the identification, protection and commercial exploitation of intellectual property (IP) developed by University researchers through a variety of commercial arrangements including licensing and start-up company creation. To achieve these goals, the Commercialization Officer interacts with university researchers to provide assistance and guidance in identifying, protecting, and commercializing IP discoveries in a variety of technical disciplines related to information technology (IT) & electrical and computer engineering (ECE), with a specific focus on supporting software related innovations.

It is anticipated that the Commercialization Officer shall by necessity be expected to undergo a period of mentorship with the Director and Technology Transfer Managers in order to develop the requisite skill sets to achieve a higher degree to autonomy to fulfill the full expectations of the role.

Key Accountabilities

Intellectual Property Assessment

- Reviews Technology Disclosure documents and convenes interview with relevant IP creators to get further details including clarification of information in the Technology Disclosure document.
- Conduct prior art patent and literature search to form an opinion on IP patentability and freedom-to-operate.
- Completes assessments of technology in various potential market application spaces. This includes searching publically available sources and securing direct feedback about the opportunity from companies in the identified markets. Completes and submits a recommendation and justification report to be presented to Director, Commercialization for decision making purposes.
- Independently manages all communications with the IP creators regarding the assessment and decisions made.

Intellectual Property Management

- In consultation with the Director and Technology Transfer Manager colleagues,, develop an IP strategy for accepted projects. Identify appropriate patent agent (if needed) and retain to handle the formalities of drafting, filing, and prosecuting the patent.
- Management of the relationship with the patent agent including ensuring that the IP creator is adequately engaged with the patent drafting process in a cost effective manner.

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- Review and provide first-level approval of all IP management invoices prior to submitting to the Director for final payment approval
- Ensure all relevant information for their IP portfolio is entered into the Inteum (IP database software) and proactively monitor the overall status of their IP portfolio to ensure timely decisions related to costs and actions.

Technology De-risking Support

- Work with IP creator team to prepare and submit funding proposals for prototype development projects that serve to advance the commercial readiness of the IP opportunity. Meeting with private companies to get market feedback and securing support letters are typically required as part of such business case and proposal preparation activities.
- Marketing of prototype or demonstration project results to prospective private sector company licensing targets and/or start-up company investors.

Commercialization Support

- Initiate proactive marketing strategies to target potential industry licensees (or investors in the case of startup company opportunities) may include. Working in consultation with the Director and/or Technology Transfer Manager(s), develops a commercialization plan for each technology in the assigned portfolio. Thereafter undertake requisite research and business analysis (eg. spreadsheet projections) as supporting information and input to developing a negotiation strategy in close consultation with the Director. Provide support to Director in negotiation discussions and, in collaboration with OR Legal Counsel, manage preparing the necessary related legal documents to formalize fully negotiated agreements. .

Other

- Assistance with a range of activities that may result in special projects being assigned, such as IP - awareness workshops to campus audiences or presentations on UW commercialization activities to foreign delegations or to provide input/support to other Office of Research groups or broader UW functional groups.

Required Qualifications

Education

- Bachelor's degree in Computer Science, Software Engineering, Electrical and Computer Engineering, or other related technical discipline.
- MBA (or other business diploma\degree) would be an asset.

Experience

- 5+ years of progressive experience in the private sector in a software development, systems integration, or wireless technology company in one or more of product management, technical sales\marketing, or operational management roles.

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- Full life cycle software development experience from inception to the market, experience writing software code (e.g. C++) or experience with software architecture design, implementation and testing would be an asset.
- Any experience in university technology transfer, commercialization, intellectual property management or research partnership development would also be an asset.

Knowledge/Skills/Abilities

- **Strong Interpersonal Skills:** Must be comfortable with technical and scientific themes in order to effectively communicate with academic faculty in developing IP and commercialization strategies. Further, must be skilled at facilitating business discussions that bridge the gap between the academically- oriented nature of a University and bottom-line driven entrepreneurial goals of business sector partners and venture investors. Must possess a high degree of maturity, competence, and professionalism appropriate for interacting with senior industry partners, investors and members of the University administration
- Demonstrated leadership ability to engage multiple stakeholders to work collaboratively to build consensus in a complex environment characterized by competing priorities is essential
- Excellent oral and written communication skills, including a comfort level and proficiency in public speaking and the ability to write effectively, authentically, and in a manner consistent with the quality and standard expected of University-level communications
- Demonstrated knowledge and experience in negotiating commercialization deals (i.e., Licensing, startup formation), including managing the development of associated documentation to formalize such deals (i.e., term sheets, license agreements, incorporation, etc.) (preferred but not mandatory)
- Demonstrated project - management skills including financial management of project budgets
- Some demonstrated understanding of the patent prosecution process and how patents are classified and cited in order to undertake meaningful patent prior art search strategies

Nature and Scope

Contacts: Internally, the incumbent will be expected to maintain a high degree of connectivity with uW faculty and their supporting Department management as well as WatCo colleagues and senior management within the OR. Externally, the incumbent will be required to manage an extensive range of contacts from government (e.g., funding agencies), other Universities (e.g., partner institutions, incubator facilities), financial institutions (venture investors), and corporations (established and start-up companies).

Level of Responsibility: The position manages a functional process that is highly specialized and that draws on collaborative leadership skills to secure consensus and influence action to support the achievement of goals and objectives. Further, the incumbent will often be required to seek out direction from the Director regarding the formation of commercialization and negotiation strategies.

Decision-Making Authority: The incumbent will manage decision making by balancing the needs and aspirations of a challenging range of internal and external stakeholders including faculty members from

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Waterloo and other academic institutions, industry partners, and government program staff. For instance, the incumbent may periodically face challenges making partnership selection or commercialization deal decisions amongst conflicting or competitive overlaps of technology creator team members. The incumbent is expected to take the lead in resolving such conflicts and to enlist assistance from the Director, Commercialization in the event of an impasse that needs additional support for resolution. The incumbent will face a challenging range of project management activities across disparate technology themes which will require careful attention to detail in order to make proper decisions to advance the uniqueness of every IP opportunity in the portfolio. The position will involve reviewing and assessing the impact of a variety of legal documents, and as such the incumbent will be expected to learn basic legal concepts and to work closely with the Director and/or Office of Research legal counsel to ensure sound due diligence oversight in all negotiated agreements. To be successful in this role, the incumbent shall be self motivated and able to work inter-dependently on multiple tasks, whilst exercising independent judgement to manage decision with moderate supervision input.

Physical and Sensory Demands: The position requires a significant level of attention to detail in concurrently managing complex projects with multiple stakeholders. The position is office - oriented with extensive sitting, the effects of which can be ameliorated by utilizing a standing keyboard desk which is provided to each staff member. The position also involves numerous meetings, and thus there is a requirement for walking across campus to meet with various internal and external stakeholders.

Working Environment: The position is office - based with some minimal expectation to participate in offsite meetings that may require use of personal vehicle for travel purposes. The incumbent may also from time- to- time be expected to undertake extended travel, domestically and internationally, that may involve air flights and time away from home, possibly extending into personal time (e.g., travel over weekends).