



**NOTES**

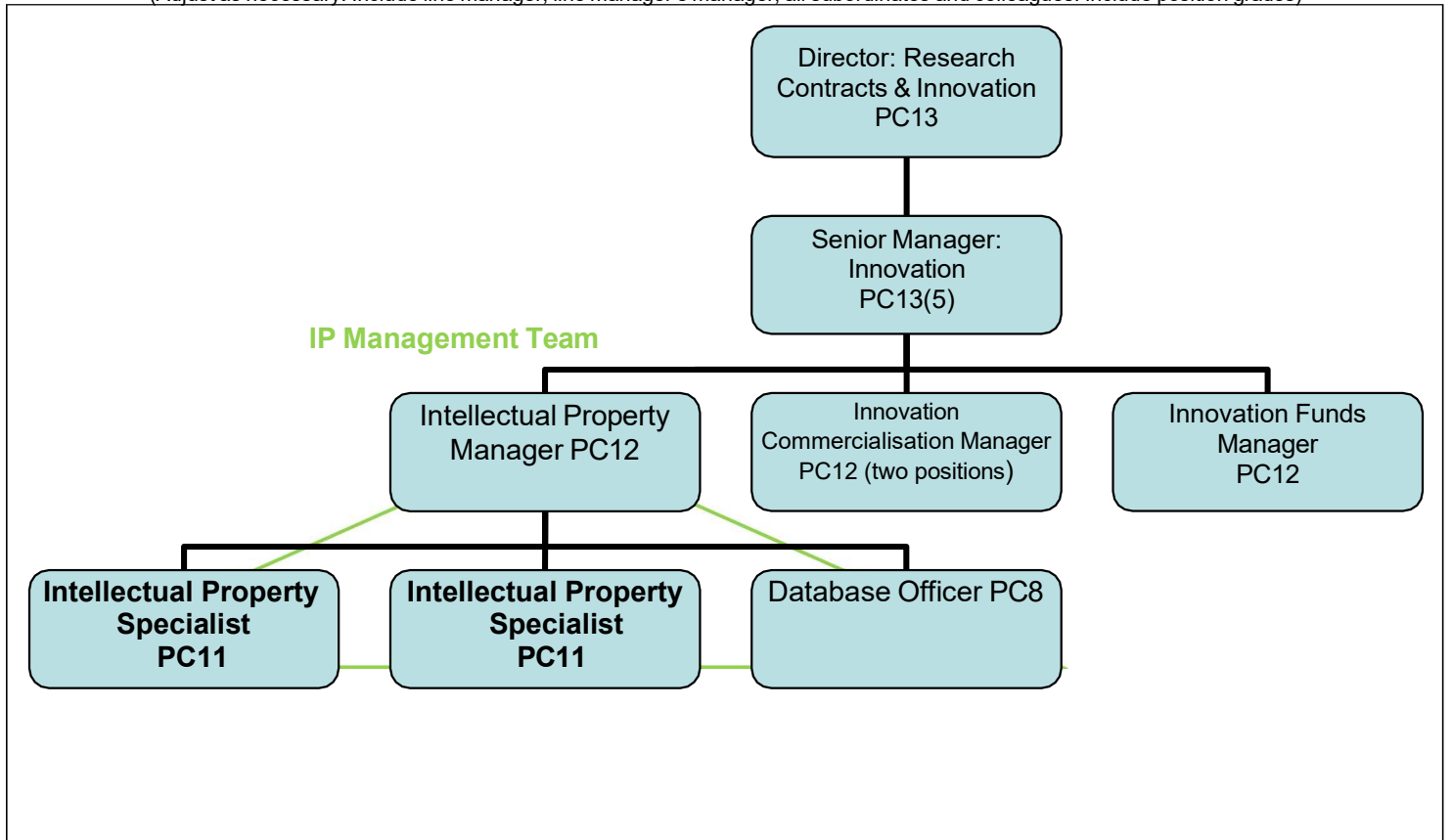
- Forms must be downloaded from the UCT website: <http://forms.uct.ac.za/forms.htm>
- This form serves as a template for the writing of position descriptions.
- A copy of this form is kept by the line manager and the position holder.

**POSITION DETAILS**

Position title	Intellectual Property Specialist		
Job title (HR Practitioner to provide)			
Position grade (if known)	PC11	Date last graded (if known)	2021
Academic faculty / PASS department	Research & Innovation Department		
Academic department / PASS unit	n/a		
Division / section	Innovation Services		
Date of compilation	May 2021		

**ORGANOGRAM**

(Adjust as necessary. Include line manager, line manager's manager, all subordinates and colleagues. Include position grades)



## PURPOSE

This incumbent reports to the Intellectual Property Manager (PC 12). The IP Management Team, a sub-team within the Innovation Services in the Research Contracts & Innovation (RC&I) Department, that is responsible for screening, assessing, protecting, and maintaining Intellectual Property (IP) associated with inventions emanating from UCT research.

The incumbent works independently with UCT Inventors, who are research staff and postgraduate students, to identify and assess potentially protectable Intellectual Property (IP) arising from their research. Due diligence is conducted on the IP to select the best mode of IP protection, establish inventorship, external parties involved and UCT ownership and funder requirements, as well as assessing its commercial potential or societal benefit. The latter is conducted in conjunction with an Innovation Commercialisation Manager.

Once approval of the Director / Senior Manager: Innovation has been obtained, an appropriate patent attorney is appointed and an application for the IP protection made. The incumbent manages the IP/patent prosecution of a portfolio of cases that they are responsible for through the RC&I Stage-Gate process, contributing to and preparing documentation on which Gate Review decisions (team input and approval by the Director) are based.

The incumbent works with the Innovation Commercialisation Manager assigned to a particular case who evaluates the commercial potential of the IP and actively commercialises it. In certain circumstances where commercialisation is less complex, the incumbent may be directly responsible for managing the commercialisation of the IP. The incumbent receives administrative assistance from the Database Officer (PC8) for routine database logging and the processing of invoices.

The incumbent also needs to carry out additional duties or responsibilities, which may fall reasonably within the ambit of the position description, or in accordance with operational requirements.

**CONTENT**

Key performance areas	% of time spent	Inputs (Responsibilities / activities / processes/ methods used)	Outputs (Expected results)
E.g.  General and office administration	25%	<p>Takes, types up and distributes minutes and agendas for monthly departmental meeting.</p> <p>Greets visitors, enquires as to the nature of their visit and directs them to the appropriate staff member.</p>	<p>All staff members receive an electronic copy of accurate minutes and agendas, in the departmental template/format, a week before the meeting.</p> <p>Visitors are directed to appropriate staff member in a professional and efficient manner.</p>
1  Identification, Screening and Initial Protection of Intellectual Property	30%	<ul style="list-style-type: none"> <li>• Screen UCT research proactively to identify new IP protection opportunities, for example, by actively scouting UCT departments for potential new IP.</li> <li>• Interact with Inventors to guide their preparation of an Invention Disclosure Form (IDF), explain IP protection procedures, establish inventorship and determine whether external partners (Inventors) and funders are involved.</li> <li>• Train and assist Inventors with a review of patent literature (Prior Art Search).</li> <li>• Assess the IDF and Prior Art Search and select the best mode(s) of IP protection, establish UCT ownership of the IP and funder requirements (which may extend to commercialisation restrictions, permissions, or reporting), as well as a preliminary assessment of the IP's commercial potential or societal benefit. Record the findings and decisions on an Assessment Form.</li> <li>• Work with Innovation Commercialisation Manager(s) (ICM) to assess commercial application of new invention disclosures and the ICM will record their view on the Assessment Form.</li> <li>• Make recommendations to the IP Manager, Senior Manager: Innovation, Director and seek permission for the protection of IP.</li> <li>• Appoint an appropriate IP attorney, approved by the IP Manager, to assist with the protection of the IP. Link the attorney to the Inventors and monitor the drafting of the specification, ensuring that publication / presentation deadlines are clear. Ensure that a new RIO number is obtained for the patent fund.</li> <li>• Ensure that the appropriate information to support the filing is conveyed to the attorneys.</li> <li>• Create a new Technology Record on IP Management Database, with assistance of the Database Administrator, ensuring that the information is complete and accurate for NIPMO reporting purposes (IP7, etc.).</li> <li>• Ensure compliance with the IPR Act.</li> </ul>	<ul style="list-style-type: none"> <li>• Group targets relating to invention disclosure and screening met.</li> <li>• Invention Disclosure Assessment Form with sound recommendations regarding appropriate IP protection and reasoned initial filing strategy or rejection.</li> <li>• Invention Disclosure Form providing clarity on UCT's right to ownership and any funder requirements.</li> <li>• Timous IP protection.</li> <li>• Inventors well supported through the application process, with clear communication and timeline expectations.</li> <li>• Comprehensive and timely reporting to NIPMO.</li> </ul>

2	IP Portfolio Management	40%	<ul style="list-style-type: none"> <li>• Be responsible for the management of a portfolio of technologies.</li> <li>• Capture relevant IP information on the Intellectual Property Management Database and check entries made by the Database Officer.</li> <li>• Understand and assess the feedback received from patent attorneys during patent prosecution, adhering to and managing any associated deadlines for response.</li> <li>• Office (Official) Actions (OAs): request guidance from the patent attorney regarding how issues raised in OAs can be overcome and what specific assistance they need from the Inventors. Clarify examination outcomes for Inventors and input required from them, collate their responses, and then respond to the attorney. Involve the ICM where claims are being amended to determine the impact on commercialisation.</li> <li>• During technology development liaise with the ICM and Inventors to assess the scope of IP protection relative to technology development to ensure "scope creep" is effectively managed.</li> <li>• Develop Value Propositions for the cases in conjunction with the ICM.</li> <li>• Implement the RC&amp;I Stage-Gate Process (1) Co-ordinate the timely review of cases (2) Prepare a Gate Review Report in conjunction with the relevant ICM, taking responsibility for the following sections / activities: technology overview; summary of written opinions and strategy to overcome the examiner's objections (argument / claim amendment, with the strategy being developed by the patent attorney with Inventor input, within a month of a receiving a written opinion); analysis of top 10 filers in the area and the top 10 countries in which filings are made; recommendations for filing and cost estimates. (3) Following the review, record the outcomes and implement decisions taken.</li> <li>• Participate in and contribute to other Gate Review meetings.</li> <li>• Provide input for budgeting exercises relating to the patent portfolio based on upcoming events in the portfolio being managed.</li> </ul>	<ul style="list-style-type: none"> <li>• Gate Review documentation, thorough and distributed timeously (i.e. two working days prior to the Review).</li> <li>• Gate Reviews held 3 months before the deadline to permit NIPMO referral if required unless a different timeline has been approved by the IP Manager.</li> <li>• Cases managed well in terms of prosecution (i.e. deadlines met, and sound decisions made with regard to prosecution), responsive to attorneys and clear interaction with Inventors.</li> <li>• A clear IP strategy available for each technology that is appropriate for the particular stage of IP protection.</li> <li>• ICM briefed on scope of protection as patent examination progresses and technology development monitored for additional IP protection.</li> </ul>
---	-------------------------	-----	--	---

3	IP Commercialisation / Legal	15%	<ul style="list-style-type: none"> <li>• Take responsibility, when assigned by the IP Manager, for "clear-cut" commercialisation of IP, e.g. simple route to market such as when an established licensee elects to license additional IP, or the IP co-owner is commercial lead.</li> <li>• Develop suitable material to support marketing activities.</li> <li>• Provide information to Due Diligence teams assessing investments by the UCT Evergreen Fund or the University Technology Fund (UTF) into UCT's spin-off companies, as well as to support the drafting of IP transactions.</li> <li>• Recommend projects for Pre-Seed, Innovation Builder, UTF and other funding instruments to further technology development, market research and commercially oriented activities</li> <li>• Liaise frequently with the ICM to learn about commercialisation progress and convey information about patent prosecution and technology development.</li> <li>• Identify the need for the drafting of legal agreements, e.g. Inter-Institutional Agreements, etc. and alert the IP Manager.</li> <li>• Apply the UCT IP Policy, understand relevant IP legislation and ensure that cases are managed and commercialised in compliance with the IP Rights from Publicly Financed Research &amp; Development Act (IPR Act), and answer general queries relating to IP received from UCT staff and students.</li> </ul>	<ul style="list-style-type: none"> <li>• Commercialisation activities executed timeously.</li> <li>• Strong communication regarding technology development funding needs.</li> <li>• Effective collaboration with the ICMs to ensure successful commercialisation of UCT IP.</li> <li>• NIPMO reporting deadlines met and reports accurate, and referrals managed timeously.</li> <li>• IPR Act compliance.</li> <li>• Appropriate legal contracts in place.</li> <li>• Sound advice provided to UCT community on the IP Policy, IPR Act, IP rights.</li> </ul>
4	Promotion and Communication	10%	<ul style="list-style-type: none"> <li>• Participate in Expos and Events where UCT technology is promoted, as well as events such as Inventor Evenings, Catalyst Lunches and/or any other stakeholder engagements.</li> <li>• Assist with identifying and arranging suitable speakers for RC&amp;I seminars, hosting the event, and presenting IP-related training or awareness raising seminars and webinars.</li> <li>• Generate new material for the RC&amp;I website or assist with writing / providing material for news articles, especially on technologies being managed, in collaboration with Marketing Specialist</li> <li>• Participate in IP Scouting and "Help Desk" initiatives run in various departments.</li> </ul>	<ul style="list-style-type: none"> <li>• Effective communication, advice, and training.</li> <li>• IP and innovation awareness in UCT community.</li> </ul>
5	Reporting	5%	<ul style="list-style-type: none"> <li>• Prepare reports on RC&amp;I's activities and the patent portfolio for internal and external purposes in collaboration with Database Officer where necessary.</li> <li>• Provide reports to support licensing activities and cost analyses in collaboration with Database Officer where necessary.</li> </ul>	<ul style="list-style-type: none"> <li>• Appropriate, comprehensive, and accurate reports produced.</li> </ul>

### MINIMUM REQUIREMENTS

Minimum qualifications	<ul style="list-style-type: none"> <li>An Honours in Science or 4 years Bachelors in Engineering degree (NQF 8)</li> </ul>			
Minimum experience (type and years)	<ul style="list-style-type: none"> <li>Two years' relevant experience in a Technology Transfer Office or in a new product commercialisation environment.</li> <li>Experience and demonstrated expertise in intellectual property protection in the areas of patents, trademarks and copyright.</li> </ul>			
Skills	<ul style="list-style-type: none"> <li>Excellent communication skills (oral and written) and interpersonal skills</li> <li>Ability to work independently and as part of a team</li> <li>Organisational and self-management skills</li> </ul>			
Knowledge	<ul style="list-style-type: none"> <li>Knowledge of the requirements of business plans, technology development, route to market and commercialization.</li> <li>General knowledge of business practices and laws relating to the protection of intellectual property and its commercialization; an understanding of the types of contracts involved in IP transactions; strong familiarity and working knowledge of the IPR Act and institutional IP Policies</li> </ul>			
Professional registration or license requirements	None			
Other requirements (If the position requires the handling of cash or finances, other requirements must include 'Honesty to handle cash or finances'.)	Recommended: <ul style="list-style-type: none"> <li>Registered Technology Transfer Professional</li> <li>MSc</li> </ul>			
Competencies (Refer to <a href="#">UCT Competency Framework</a> )	Competence	Level	Competence	Level
	Formal presentation	2	Coaching / Developing Others	2
	Information Management	2	Building Relationships	2
	Professional knowledge and skill	2	Adaptability	2
	Initiating Action / initiative	2	Continuous Learning	2
	Teamwork	2	Communication	2
	Analytical thinking/problem solving	2	Stress tolerance	2

### SCOPE OF RESPONSIBILITY

Functions responsible for	<p>Monitoring and managing deadlines relating to IP filing and prosecution, ensuring IP official actions are attended to ahead of official deadlines.</p> <p>Interaction with patent attorney(s).</p> <p>Assessment of protectability of inventions.</p> <p>Preparation of and submission of referrals to NIPMO.</p> <p>Routine reporting to NIPMO on incumbent's portfolio of cases.</p>
Amount and kind of supervision received	Periodic meetings (~weekly or biweekly frequency) to discuss key issues and tasks and to review plans and workload. Review of gate review reports prior to circulation. Review of selection of attorney and readiness to proceed with a provisional patent application.
Amount and kind of supervision exercised	None
Decisions which can be made	Responding to official actions during patent prosecution and renewals, once the ICM has been consulted to determine commercialisation progress.
Decisions which must be referred	Abandoning of a patent(s), non-standard IP protection expenses, proceeding to the next stage of patenting, associated legal agreements (Inter-Institutional / IP transactions), commercialisation and licensing.

### CONTACTS AND RELATIONSHIPS

Internal to UCT	<p>Students, postgraduate students, research staff of all levels – associated with IP protection and screening of research outputs, awareness raising, advice, etc.</p> <p>Interaction with other in RC&amp;I team relating to IP commercialisation, legal requirements or financial administration.</p>
-----------------	--