San José State University Research Foundation

Position: Intellectual Property Specialist

DEPARTMENT: Office of Sponsored Programs

IMMEDIATE SUPERVISOR: Director, Office of Sponsored Programs

POSTING DATE: May 26, 2021

CLOSING DATE: Open Until Filled

SALARY: $80,000 - $100,000 annually

EXEMPT STATUS: Full-time, Exempt, Benefited

GENERAL NATURE OF POSITION

The San José State University Research Foundation (SJSURF) is seeking a self-motivated individual with experience in technology commercialization to join its Innovation team as an intellectual property (IP) specialist. The intellectual property specialist will manage a docket of technologies and will be responsible for all aspects of technology management from invention disclosure to licensing. Work will include building faculty/industry relationships, performing technology assessments, conducting market outreach, negotiating license terms, and finalizing licenses and related agreements. SJSURF invites applications from highly motivated individuals to fill the role of intellectual property specialist. SJSU has a strong commitment to achieving excellence and diversity among its faculty, students, and staff; and strongly encourages candidates to apply who will enrich SJSU’s academic and culturally inclusive environment.

As part of the Commercialization team, this position will report to the director of the Office of Sponsored Programs (OSP) and coordinate closely with the SJSU director of the Office of Innovation, as well as other office staff, to focus on maximizing the impact and value derived from intellectual property developed across the SJSU portfolio of technologies. The successful candidate will help build the SJSU culture of innovation by developing strong and positive relationships with SJSU faculty, staff and students, along with prospective and actual licensees.

ESSENTIAL DUTIES & RESPONSIBILITIES

1. Participates in university outreach to educate inventors about IP and commercialization.

2. Builds industry relationships with the goal of creating research collaboration and licensing SJSU technology.

3. Communicates industry needs to faculty to help them understand where their research fits with these identified needs.

4. Solicits, receives, reviews, and processes invention, creative works, and software disclosures to determine university rights, potential commercial value, and patentability.
5. Determines an invention's current stage of development and its future development path.

6. Evaluates market potential of inventions, including market size, market need, competitive position, and barriers to entering the marketplace.

7. Recommends a technology commercialization path for new disclosures (e.g., patent, waive rights, assign rights to inventors).

8. Coordinates with the inventor, the SJSU Patent Review Board, the Office of Innovation director, and IP counsel to develop and implement IP protection strategies.

9. Develops strategies and plans for marketing inventions and technologies to industry.

10. Performs targeted marketing and outreach to companies to seek potential licensing opportunities.

11. Drafts and negotiates license and other related contracts.

12. Provides ongoing management of license agreements for performance, compliance, and payment of associated fees.

13. Performs other duties within the scope of the position, as required by SJSURF or the Office of Innovation.

INTERPERSONAL CONTACTS

- Reports to OSP director, coordinating closely with Office of Innovation director.
- Develop and maintain effective working relationships with internal staff and departments, principal investigators, SJSU vice president for Research and Innovation, associate vice president for Research, college deans, departmental chairs, and sponsor agencies on a regular basis.

SUPERVISORY RESPONSIBILITIES

No supervisory responsibilities, although may be called upon for consultation and direction by others.

QUALIFICATIONS

Education and Experience

- A Bachelor’s degree in Science, Engineering, or Computer Science.
- Minimum of three (3) years of related licensing or technology commercialization experience with a proven track record in technology transfer, deal structuring, and licensing of intellectual property.
- Advanced degree in Engineering, Computer Science, or Science preferred.
- MBA or JD preferred.
- Working knowledge of software platforms for managing university intellectual property preferred.
- CLP or similar designation preferred.
Knowledge, Skills, Abilities Required

- A working knowledge of intellectual property law, technology licensing, marketing, patent management, and negotiation of license agreements.
- Experience working collaboratively with researchers or technical staff in intellectual property matters.
- Ability to understand complex technologies and perform technical feasibility assessments including competitive landscape and market analysis.
- Ability to handle a wide variety of projects simultaneously to meet deadlines and be productive within a dynamic and ever-changing environment.
- Ability to establish and maintain effective working relationships with management, peers, academics, and other professionals, including external agencies, with varied interests and perspectives.
- Self-starter with ability to work independently, as well as in a team.
- Strong writing, communication, and interpersonal skills.
- A strong orientation toward customer service.

Complexity of Duties

- Works on a variety of problems of complex scope where analysis of data or solutions requires an evaluation of intangible, variance factors. Exercises independent judgment in developing methods and evaluating criteria for achieved results.
- Must be able to act on critical issues in an independent manner.
- Erroneous decisions or recommendations, or failure to get results would cause additional costs and personnel, and serious delays in overall schedule.

Physical Requirements

- Must be able to operate a PC including mouse and keyboard.
- Must be able to operate a ten-key adding machine.
- Must be able to operate general office equipment.
- Must be able to sit for extended periods of time.
- Visual acuity associated with concentrated computer use.

NOTE: This position description intends to describe the general nature and level of work being performed by people assigned to this job. It is not intended to include all duties and responsibilities. The order in which duties and responsibilities are listed is not significant.

BENEFITS

SJSURF provides excellent benefits package to benefited employees. The comprehensive benefit package includes:

- Ten company subsidized CalPERS health insurance plans to choose from (employee contributions differ according to plan and level of coverage).
- Employer paid dental and vision for both employee and eligible dependents.
- Life, AD&D, LTD with supplemental coverage opportunities.
- 13 paid federal and state holidays.
- Retirement Plan: 403 (b) employee contribution plan component and a 403 (b) employer contribution component, which vests immediately.
- Vacation hours accruals and separate sick hours accumulations.
APPLICATION PROCEDURE
To apply for this position, an applicant must submit a formal application for employment, as well as a resume and a cover letter. The applicant may do this via e-mail. The formal employment application is located on the SJSURF website on the Forms page. Due to the COVID-19 health crisis, all candidates must submit their application materials to foundation-jobs@sjsu.edu.

Please address your formal application, your resume, and your letter of interest directly to:

San José State University Research Foundation
Attn: HR/Job Code: IP SPECIALIST CO
Email: Foundation-jobs@sjsu.edu

A background check (including a criminal records check) must be completed satisfactorily before any candidate can be offered a position with the SJSURF. Failure to satisfactorily complete the background check may affect the application status of applicants or continued employment of current SJSURF employees who apply for the position.

REASONABLE ACCOMMODATION
The San José State University Research Foundation (SJSURF) is committed to providing access, equal opportunity and reasonable accommodation for individuals with physical or mental disabilities in the employment, recruitment, examination, hiring and interviewing processes. If you are a job seeker with a physical or mental disability and require a reasonable accommodation to search, apply, or interview for a job opening or otherwise need a reasonable accommodation during the application and hiring process, please contact us at foundation-jobs@sjsu.edu. In the email message, please indicate your full name, phone number and the type of assistance required. You must not reveal the underlying medical reason for your needed reasonable accommodation or otherwise disclose confidential medical information.

ABOUT THE SJSU RESEARCH FOUNDATION
SJSURF employment is separate and distinct from San José State University or state of California employment. SJSURF employees are not employees of SJSU or of the state of California.

SJSURF is a non-profit auxiliary of San José State University. SJSURF is totally self-supported. The majority of the organization’s funding comes from the federal government, and other public and private entities. With annual revenues totaling over $65 million, programs managed through SJSURF cover a rich diversity of applied research, public services, and educational related activities.

SJSURF is an equal opportunity employer and does not discriminate on the basis of race, color, creed, gender, religion, marital status, registered domestic partner status, age, national origin, ancestry, physical or mental disability, medical condition, sex, genetic information, sexual orientation, military and veteran status or any other consideration made unlawful by federal, state, or local laws. It also prohibits unlawful discrimination based on the perception that anyone has any of those characteristics, or is associated with a person who has or is perceived as having any of those characteristics.