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## MIT Job Description

<b>MIT Job Title: Patent Portfolio Associate</b>	<b>Position Title: IP Portfolio Manager</b>
<b>Reports to: Associate Director, IP</b>	<b>% Effort or Wkly Hrs.: 100% / 40</b>
<b>Department: Technology Licensing Office</b>	<b>Prepared by:</b>
<b>Date: December 2024</b>	

### **Technology Licensing Office Overview:**

In the spirit of MIT's mission to advance knowledge, the TLO moves innovations and discoveries from the lab to the marketplace for the benefit of the public and to amplify MIT's global impact. We cultivate an inclusive environment of scientific and entrepreneurial excellence, and bridge connections from MIT's research community to industry and startups, by strategically evaluating, protecting, and licensing technology.

The MIT Technology Licensing Office is recognized as a global leader in technology transfer. We are extremely excited to announce some changes to our office to allow greater focus of our licensing team on finding and executing licensing deals and increasing engagement with faculty and MIT leadership, streamlining key activities, and encouraging more cross team collaboration. You will be able to contribute to building this new organizational structure at MIT's Technology Licensing Office, we welcome applications from qualified individuals.

### **Position Overview:**

Reporting to the Associate Director, IP, the IP Portfolio Manager provides timely, subject matter expert patent advice, guidance and insights to the Associate Directors, Licensing and Licensing and Business Development Managers (Licensing Team) on patent management matters. The role assumes a wide range of responsibilities related to the filing, prosecution, maintenance and defense of MIT's patent portfolio.

### **Principal Duties and Responsibilities (Essential Functions\*\*):**

#### **IP Portfolio Management/Support**

- Support the Licensing Team at the direction of the Associate Director, IP.
- Research, compile, organize and present information and recommendations regarding specific patent portfolios, to the applicable Licensing Manager.
- Responsible for liaising with outside patent counsel to implement the timely filing of patent applications, office action responses and other necessary activities consistent with established strategy set by the Licensing Team to ensure a strong IP portfolio for commercialization.
- Analyze recommendations provided by MIT's outside patent counsel (and inventors and licensees, as applicable) on patent actions, and provide expert advice about such to the responsible Licensing Manager to ensure the proposed patent strategy aligns with the overall case commercialization strategy.
- Review MIT IP assets, highlighting opportunities for optimizing portfolio protection including recommendations for abandonment of pending patent applications and issued patents.
- As requested by Licensing Managers or Senior Leadership, perform in depth review of IP assets or portfolio (such as by investigator or technology or market) that may support patent management and targeted marketing to potential commercial licensees.
- In coordination with Licensing Managers, meet with inventors and licensees to solicit, compile and synthesize IP asset information and insight as it relates to active patent prosecution activity, issued patent assets, portfolio reviews and potential enforcement activity.

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- Coordinate and collaborate closely with IP Paralegals and Technology Licensing Associates on all IP Portfolio Management activity.

### **Quality Control**

- Responsible for allocation of work to approved law firms, including review of work estimates, management of patent portfolio budgets, and providing support to the Finance department for review of and approval of legal bills.
- As requested by Associate Director, IP, assess quality of patent filings and produce data on specific law firm performance.
- Provide expert advice on patentability, white space analysis, and patent family mapping for complex and high-potential patent portfolios.

### **Other**

- At the request of Licensing Managers, communicate with inventors, sponsors, patent attorneys, various members of the MIT innovation community and other TLO staff about portfolio related IP matters.
- Develop and maintain strong relationships with other university, research institutions or joint owners' technology transfer or IP organizations to ensure appropriate protection of MIT jointly owned IP.
- Ensure appropriate documentation, records and notes related to IP strategy, are maintained and appropriately stored in database systems, workflow and document management systems.
- Other duties as assigned.

### **Supervision Received:**

Associate Director, IP

### **Supervision Exercised**

None

### **Qualifications & Skills:**

- Must be a Registered Patent Practitioner
- Minimum Bachelor's degree in science (physical or life sciences).
- Minimum of 7 years of relevant experience, including managing or advising on large patent portfolios
- Exceptional and deep knowledge of patent law, experience filing and prosecuting patents required, preferably at a company or university managing patent portfolios.
- Superior verbal and written communications skills and ability to interact capably with a variety of stakeholders.
- Strong organizational skills, attention to detail and ability to manage multiple projects simultaneously.
- Excellent problem-solving and decision-making skills.
- Strong interpersonal skills that reflect courtesy, diplomacy, and a collaborative approach to develop and maintain effective working relationships.
- Ability to work independently, and as a member of a team, and to exercise good judgment and discretion in the performance of all work assignments.
- Ability to work in a fast-paced, deadline-oriented, matrix like environment and manage a large workload.
- U.S citizenship or legal permanent resident status required.

### *PREFERRED EDUCATION AND EXPERIENCE*

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- Advanced technical degree preferred.
  - Demonstrated maturity and sensitivity to the needs of multiple stakeholders in a complex academic environment.
  - Detailed understanding of nuanced issues related to the protection of IP and enforcement of patents owned by an academic institution.
  - The TLO values respect for the educational and research mission of MIT, and collegiality.

\*\* To comply with regulations by the American with Disabilities Act (ADA), the principal duties in job descriptions must be essential to the job. To identify essential functions, focus on the purpose and the result of the duties rather than the manner in which they are performed. The following definition applies: a job function is essential if removal of that function would fundamentally change the job.