



**Kerala State Council for Science, Technology &
Environment**
Sasthra Bhavan, Pattom, Thiruvananthapuram

CALL FOR EXPRESSION OF INTEREST

**Call for Expression of Interest for the empanelment of Intellectual
Property Firms for KSCSTE**

Empanelment of IP Firms for KSCSTE

Kerala State Council for Science, Technology & Environment (KSCSTE) invites Expression of Interest (EOI) for the empanelment of Intellectual Property Firms to execute the required services, as described below in this document. The interested firms fulfilling the eligibility conditions have to submit the bids in two stages (viz. Technical Bids and Financial Bids). Initially, the Technical Bids only are invited from the Intellectual Property Law Firms. The Expression of Interest shall include the Profile and Competence of the Firm in the prescribed format, supported by necessary relevant documents. The Financial Bids will be invited later from the technically qualified firms based on the technical bid evaluation.

All the documents shall be prepared in English. They must be duly signed by the authorised signatory of the firm. Additional material and/or brochures/promotional material, may be appended at the end of the proposal.

Competent Service Providers capable of undertaking this task and having excellent track record and expertise in the drafting, filing and prosecution of IP applications may submit their offers with the accompanying documents. The sealed envelope superscribed '**Technical Bid for the empanelment of IP Firms for KSCSTE**' should reach the undersigned on or before **15.07.2022**, in the below address.

The Member Secretary

Kerala State Council for Science, Technology & Environment
Sasthra Bhavan, Pattom P.O,
Trivandrum – 695 004, Kerala, India
Tel: 0471 2548220, 2548316

The details can be downloaded from the websites www.kscste.kerala.gov.in. Any further clarification on EOI can be had from KSCSTE (e-mail: iprick.kscste@kerala.gov.in, Tel: 0471 2548252). KSCSTE also reserves the right to reject any proposal without prior correspondence, and/or without assigning any reason.

A. General Information

1. Background

The Kerala State Council for Science, Technology and Environment (KSCSTE) is an autonomous body under the Department of Science & Technology, Govt. of Kerala, constituted as an Agency for change and development in the State through science and technology. KSCSTE prepares the road map for development through scientific research and innovation in technologies. Intellectual Property Rights Information Centre – Kerala (IPRIC-K) functioning in Kerala State Council for Science, Technology & Environment (KSCSTE) is the Nodal Agency of the Kerala State for all the Intellectual Property Rights (IPR) related services and matters. IPRIC-K has been providing IPR related services to all the Departments, Organizations, Institutions, Scientists, Researchers, Academicians, Individual Innovators, etc, in the State of Kerala. IPRIC-K has been conducting IPR awareness programmes throughout the State to generate awareness about IPR among the people from different walks of life. IPRIC-K drafts the Govt. policies/rules on IPR related matters and acts as the Advisory Centre to the Govt. on such matters. IPRIC-K has been providing services on all forms of IPR including Patents, Copyrights, Trademarks, Industrial Designs, Geographical Indications, Traditional Knowledge, etc. IPRIC-K has been facilitating the filing of IPs generated from the State.

KSCSTE invites Expression of Interest (EOI) for the empanelment of IP Firms for KSCSTE for facilitating the drafting, filing and prosecution of IP applications including Patents, Trademarks, Copyrights, Industrial Designs, Geographical Indications, IC Layout Designs, Protection of new plant varieties, Trade secrets, etc, referred by KSCSTE. The Firm shall provide Advisory support to KSCSTE on all the matters related to IPR and IP Management. The Firm shall provide services with regard to the drafting, filing and prosecution of IP applications referred by KSCSTE, in India and abroad. They should lodge and defend oppositions, objections, rectifications and invalidation proceedings for all types of IPR. The Firm shall also support the inventors in preparing the Technology Transfer/Licence Agreements, if required.

2. Eligibility Criteria:

- ❖ The Firm responding to this Expression of Interest must be registered under the Indian Law.
- ❖ The Firm should have good standing for at least 5 years in the field of IPR and must have atleast 7 Patent Agents and 3 Trademark Agents on the roll.
- ❖ The Firm shall have adequate resources and necessary technical experts in all areas of specialization in Science, Engineering & Technology.
- ❖ The Firm must presently be in contract with any Central/ State Govt. Organizations/ Institutions/ Departments/ Universities/R&D Institutions/Industries, for facilitating the protection of IPs of such Organizations.
- ❖ The Firm must have excellent track record in the areas of IP filing, prosecution and litigation, in India and abroad.
- ❖ The Firm should have filed at least 100 patent applications in the last five years.

- ❖ The Firm should be able to provide services with regard to the filing, prosecution, maintenance, opposition, litigation, revocation, restoration and any other proceedings in respect of all forms of IPR, in India and abroad.
- ❖ The Firm should be able to provide services on the matters including drafting of various Agreements, MOUs, Assistance in licensing matters, IP Auditing, IP Valuation, Commercialization Strategy and Opinion/ Advice related to various matters pertaining to IPR.
- ❖ Only Indian IP Law Firms can submit the Expression of Interest. Response from Individual IPR Experts/ Non IPR law firms will not be considered.
- ❖ The Firm should have counterpart IP Firms in other countries for providing services with regard to the protection of IPs abroad and the details of such firms shall be included in the EoI.

3. Selection Criteria

KSCSTE will initially evaluate and assess the Technical bids from the Firms. The financial bids will be invited only from the technically qualified firms based on the technical bid evaluation. The final selection will be done based on the evaluation of the financial bids. IP Firms responding to this Expression of Interest must offer complete services in relation to the searching, drafting, filing and prosecution of all IP applications. The list of services required from the Firm for each type of IPR are as follows;

3.1 Patents:

- ❖ Assistance to the innovators in developing the strategy for protecting their patents.
- ❖ Advisory support through Expert opinion on Patentability, Freedom-To-Operate (FTOs), Invalidity, Infringement and Due diligence.
- ❖ Conducting Patentability search, Freedom to Operate search, Patent validity/ invalidity search, Patent Landscape, Patent Analysis, Patent Mapping, Patent Infringement, etc.
- ❖ Drafting of Patent Specifications (Provisional/ Complete/ Divisional/ Patent of Addition/ PCT applications) in all technical fields.
- ❖ Filing of Indian Patents, PCT applications, Patent applications in foreign countries.
- ❖ Prosecution of Patent applications including processing of all office actions arising between filing and grant stages;
- ❖ Litigations including Oppositions, Revocation proceedings, Infringement actions, Appeal before the High Court.
- ❖ Post Registration services related to Renewal and Maintenance of patents.
- ❖ Services related to Licensing and Assignment Agreements, Due Diligence and all other related activities.

3.2 Copyrights:

- ❖ Preparing and filing Copyright applications in India and foreign countries.
- ❖ Infringement and validity advice to the applicants of Copyrights.
- ❖ Services related to opposition, rectification and cancellation of copyrights.
- ❖ Services associated with Transmission and Franchisee Agreements, Licensing and Transfer of Copyrights.
- ❖ Post Registration assistance and Anti-piracy measures for safeguarding assignments.

3.3 Trademarks:

- ❖ Trademark availability search.
- ❖ Drafting, Filing and Prosecution of Trademark applications at the Trademark Registry.
- ❖ Drafting, Filing and Prosecution of Trademark applications through Madrid Protocol.
- ❖ Journal Watch and Post-Registration services
- ❖ Services related to Opposition Proceedings, Rectification and Cancellation proceedings.
- ❖ Renewal of Trademarks and Post Registration Services.
- ❖ Licensing, Assignment, Registered user; Transmission and Franchisee Agreements, Due Diligence and Investigations.

3.4 Industrial Designs:

- ❖ Local and International prior art search.
- ❖ Drafting, Filing and prosecuting the applications for Design Registration.
- ❖ Infringement and Validity opinion services.
- ❖ Registration and Post Registration services.
- ❖ Litigation: Cancellation proceedings, Appeals, Civil suits for infringement.
- ❖ Journal watch and Post Registration Services.
- ❖ Renewal and Maintenance of Industrial Designs.
- ❖ Assignment and Licensing services.
- ❖ Service related to Portfolio Management.

3.5 Geographical Indications (GI):

- ❖ Drafting and Filing applications for Registration of GI.
- ❖ Due Diligence prior to filing of GI Application.
- ❖ Opposition Proceedings before the GI Registry.
- ❖ Rectification and Cancellation Proceedings before High Court and the GI Registry.
- ❖ Prosecution of GI applications including attending to Consultative Group discussions.
- ❖ Authorized User Agreements, Filing of authorized user requests at GI Registry.
- ❖ Post Registration assistance of Name/Address change of Registered Proprietor.
- ❖ Regular monitoring of GI Journal.
- ❖ Renewal and Maintenance of GI Registrations.

3.6 Layout Design of Integrated Circuits:

- ❖ Drafting and Filing of Layout Design of Integrated Circuits applications under Semiconductor Integrated Circuit Layout Design Act, 2000 (SICLDA).
- ❖ Services related to the opposition proceedings of layout design registration.
- ❖ Cancellation, Rectification and Restoration services

3.7 Protection of new plant varieties:

- ❖ Advising and assisting the applicants in determining the availability of a variety for registration, seeking clearance from Plant Variety Registry, searches in the Official Journal of Plant Varieties, Denomination clearance, fulfillment of registrability criteria.

- ❖ Gene and protein sequence searches.
- ❖ Filing Notices of opposition/cancellation against any application/registration of infringing varieties.
- ❖ Assisting applicants in enforcement of their rights in their registered plant varieties
- ❖ Assisting applicants in research and commercialization of registered plant varieties.

3.8 Trade Secrets:

- ❖ Preparing invention assignment deeds, research and manufacturing agreements, technical cooperation agreements, technical know-how transfer agreements, Employment Agreements, Non-disclosure Agreements related to confidential and proprietary information.
- ❖ Injunction service for preventing a licensee, employee, vendor or other party from disclosing a trade secret.
- ❖ Filing compensation application for any losses suffered due to the disclosure of trade secrets.

3.9 Other Services:

- ❖ Provide legal assistance to KSCSTE on the formulation of policies, rules and other documents with regard to IPR and IP Management.
- ❖ Provides technical and legal advice to KSCSTE on IPR related matters, as and when required.
- ❖ Provides technical support for generating IPR awareness in the State by deputing Experts as Resource Persons.

4. Period of Execution

Empanelment of Intellectual Property Firms will be for a period of 5 years. KSCSTE reserves the right to issue other Expressions of Interest, at any point of time it deems appropriate, in order to continuously update the number of Firms in the panel. KSCSTE also reserves the right to remove a Firm from the Panel at any point of time, with one month notice period, if the performance of the Firm is not satisfactory.

B. Terms and Conditions:

IP Firms must confirm that, in the event that they would be put on KSCSTE's Panel list, they would be ready to abide with the conditions detailed hereunder: -

1. Expression of Interests shall be evaluated according to the selection criteria outlined in this document and will be done by a Technical/Expert Committee constituted by KSCSTE for the purpose. The Committee may invite the Firms for presentations on their capability and competence and their proposals during the course of process of Empanelment and participation of Firms in such meetings is mandatory for considering in the selection process.
2. IP Firms expressing their interest must be willing to work on per - case – basis.
3. The Firm shall take it upon itself to offer the best possible services and to draft IP applications and other documents in a professional manner, in order to increase the chances of getting the IPs granted.
4. KSCSTE and the Firm shall treat all the documents and information received in connection with the Expression of Interest, project proposal and any agreements as private and confidential. The Parties shall not, save in so far as may be necessary for the purpose of the contract's execution, publish or disclose any particulars of the contract without the prior consent in writing of the other Party.
5. The working language for contracts, proposals and all communication shall be English.
6. The Firm will keep the contact person at KSCSTE informed throughout the application process.
7. The Firm shall depute their Technical Experts as Resource Persons for handling the technical sessions on IPR in the awareness Seminars/Workshops/Webinars/Conferences organized by KSCSTE, throughout the State of Kerala. The Resource Persons deputed will be provided with Honorarium, Travel Expenses, Local hospitality and Logistics, as per the norms of KSCSTE.
8. KSCSTE retains the right to remove the Firm from the panel, with one month notice period, in the case that any of the Terms and Conditions listed here are not adhered to. In the event that the firm is in breach of any obligations arising of these Terms and Conditions and/or any subsequent agreement that may be signed, it reserves the right to rescind the agreement, without prejudice to its right to claim damages at law
9. Any dispute arising out of the terms and conditions shall be subject to Trivandrum/ Kerala.
10. KSCSTE reserves the rights to reject any or all the Expression of Interests, if it does not suit the specified requirements. KSCSTE reserves the right to issue further conditions that may be necessary, to ensure the optimum deal and benefits for KSCSTE. No appeal can be made against the decision of KSCSTE.

PROFILE AND COMPETENCE OF THE FIRM

1. Name of the Firm:
2. Full Address of Head Office and Branch Offices with contact details:
3. Year of Establishment and Registration No:
(Attach copy of the Registration Certificate)
4. Legal Status of the Firm (Privately Owned, Ltd., PLC, LLP, etc.) :
5. Particulars of the Memberships/Partnership, if any :
6. Areas of Specialisation:
(Patents/Copyrights/Trademarks/Industrial Designs/GI/other IP Forms/
Litigations/Oppositions/Contracts)
7. GST Number:
8. Details of PAN and TAN :
9. Name and Designation of the Head of the Organization:
10. Contact details of the Head of Organization (Tel No, Mob No, Email, Fax) :
11. Organizational Structure of the Firm:
12. Accreditation Details of the Organization:
13. Name and Designation of the Contact Person in the Firm:
14. Contact details of Contact Person (Tel No, Mob No, Email) :
15. Business details of the Firm:
(List the services provided)
16. Is the Firm part of a Group? If so, Name of Group: (please send details of Group structure):
17. Audited Accounts Statements for the last 2 financial years, along with Annual Turnover of the Firm:

18. Indicate the Range of Services provided by the Firm (Cross out whichever does not apply)

Form of IPR	Prior art/ FTO/ Clearance / Availability Search (YES/NO)	Assistance for Drafting and Filing (YES/NO)	Prosecution and Processing Assistance (YES/NO)	Litigation Assistance/ Service (YES/NO)	Post Registration Service (YES/NO)
Patents					
Copyrights					
Trademarks					
Industrial Designs					
Geographical Indications					
Layout Design of IC					
Protection of Plant varieties & Farmers' Rights					
Trade Secret					

19. Details of Human Resources in the Firm:

Sl No	Head	Number
1	No. of Patent Agents/ Attorneys	
2	No. of Trademark Agents/ Attorneys	
3	Other Staffs	
	Total	

20. Details of the Professionals presently employed with the firm and their profiles

Sl No	Name of Professional	Designation	Qualification	Area of Specialisation	Experience (in years)	No. of cases handled (specific whether it is for Patent, Copyright, Trademark, or any other IP form, litigation/ opposition)

Note: Attach the brief profiles of all Patent/ Trademark Agents in the Firm.

21. Provide the details of IP applications handled by the Firm during the last 5 years.

Form of IPR	No. of Applications Filed in India	No. of Applications granted	No. of Applications filed outside India	No. of Applications granted
Patents				
Copyrights				
Trademarks				
Industrial Designs				
Geographical Indications				
Layout Design of ICs				
Protection of Plant varieties				

22. Please furnish the details of Patents filed during the last 5 years including Application Number, Date of Filing, Title of the Invention, Name of the Applicant, Present Status, etc. (Please attach as Annexure)

23. Please furnish the number of Litigations/Opposition proceedings handled by the firm with respect to Patents, Copyrights, Trademarks, Industrial designs and other IPs during the last 5 years and the success rate of decided cases in favour of the client(s) during the period:

24. Number of Indian Patent applications and Foreign Patent applications filed on behalf of Govt.Organizations/ Departments/Institutions/Industries and the name of these Organizations:

25. Furnish the names of the Foreign Partnering IP Firms (Associates) who are handling the cases in various Countries, along with the names of the Countries

26. Testimonials /References from the present clients (Central/State Govt. Organizations, R&D Institutions, Universities, Public Sector Undertakings, etc) in their letter head including the period of service.

27. Time frame for filing an application (including discussing with inventors, conducting search (if applicable), drafting the application and file in IP Office):

SI No	Form of IPR	Time Frame (in days)
1	Patents	
2	Copyrights	
3	Trademarks	
4	Industrial Designs	
5	Geographical Indications	
6	Layout Design of ICs	
7	Protection of Plant varieties	

28. Mode of filing the Applications, Responses and other documents in the IP Office (Online/Offline):

29. Maximum Number of IP applications which can be processed in a month:

SI No	Form of IPR	No. of applications
1	Patents	
2	Copyrights	
3	Trademarks	
4	Industrial Designs	
5	Geographical Indications	
6	Layout Design of ICs	
7	Protection of Plant varieties	

Declaration:

1. I/We hereby certify that all the statements made and information provided is true and correct.
2. I/We will make detailed presentation before KSCSTE at various stages to explain the functioning and other matters necessary for the empanelment of the IP Firms.
3. I/We submit the following documents in support of our suitability, technical know how and capability for having successfully completed the following assignments.
4. I/We abide with the conditions laid out in the EoI document. I/We understand that the provision of inaccurate or misleading information in this declaration may lead to my organization being excluded from participation in this Expression of Interest.

Signature:

Name and Designation:

Date: