**COEP Technological University Pune**

(A Unitary Public University of Govt of Maharashtra)

Shivajinagar, Pune 411005, Maharashtra, India

**Board of Research, Innovation, Incubation and Linkages**

Email- director-research@coeptech.ac.in

COEP Tech /RIIL/IPR Work 2024/ Date:

Request for proposal for Empanelment of

**LEGAL SERVICE FOR IPR WORK**

COEP Technological University is a Unitary Public University of the Government of Maharashtra with effect from June 21, 2022, vide Government Gazette MAHARASHTRA ACT No. XXXV of 2022 dated 10 May 2022.

Request for Proposal (RFP) for empanelment of legal services for IPR Work is invited from the firms having relevant experience in providing IPR legal services at various Govt. / Public/ Commercials offices or places etc. and who are permitted to do business with Government, Government funded educational and research institutes, PSUs, autonomous bodies in India.

1. **SCOPE OF WORK**

The applying Firm/ Attorney should be able to provide services for:

Filing, prosecution, maintenance, opposition, litigation, number of inventors and applicants, revocation, restoration and any other proceedings in respect of patent applications/ patents and for registration /securing of other forms of IP in India and International patents and other IPR.

All other forms of IP and related work comprising services for any IP related work, copyright matters, design, trademark, layout design, geographical locations, opposition, litigation, revocation, restoration, representation before Appellate Board in India, ownership of patents, sharing of fees & earnings with respect to commercialization of patents, miscellaneous actions under the relevant Act and any other proceedings in India.

Other IP related work comprising of drafting of agreements, negotiations, MOUs, Freedom to operate searches, assistance in licensing and other IP Management matters like IP audit, IP valuation, commercialization strategy and opinion/advice relating to IP matters.

The Firm/ Attorney should possess professional expertise especially in handling patent applications in the field of Science, Technology and Engineering. The Firm/ Attorney must have the requisite infrastructure and be financially sound. The Firm/ Attorney should have a local office in Pune/Mumbai, and an established network of top leading foreign attorney firms worldwide who can handle the assigned work.

COEP Tech is planning to empanel IPR attorneys. The university reserves the right to empanel one or more attorneys depending upon the report of evaluation committee. Ultimately, faculty members (Inventors) have the option to choose any approved empaneled Attorney. Concerned Attorney must coordinate with concerned faculties in person meeting in campus for all activity including process of bills.

1. **QUALIFICATION / ELIGIBILITY CRITERIA**

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| **Sr. No** | **Description** | **Eligibility Criteria** | **Supporting Documents****Required** |
| 01. | General and experience | 1. The Firm/ Attorney should have at least a period of 5 years’ experience in relevant IPR field including its dispute/court case management.
2. The Firm/Attorney must have worked with elite education institutes for at least for consecutive 3 years.
3. The Law Firm should have a valid PAN and GST Number.
4. The Firm/ Attorney must have a local office in India
5. Other Specific details as mentioned in the technical bid.
6. The bidder Law Firm should not have been Blacklisted/debarred by any Institution of the Central or State Government, Govt.

Departments/PSUs/Autonomous Bodies or concerned Bar Council in the last Five years and no bankruptcy/liquidation proceedings have been initiated against it by any entity/government or quasi- government agency of PSU.1. The rate should be quoted with all legal advice to be given till the completion of the process. In case anything thing relevant is not asked by COEP Tech and you would like to mention it then please quote it in financial bid’s other items column.
 | Relevant documents in support of claim with self-certification to be submitted. |
| 02. | Capability | 1. The firm must have filed at least 50 patent applications (including 5 PCTapplications: Patent Cooperation Treaty – International and 5 International patents) for clients based in India and abroad handled in the last 5 calendar years(2019-2024). | Relevant documents in support of claim with self-certification to be submitted. |
| 03 | Financial Standing | 1. The bidder Law Firm should have a minimum Average Turnover of Rs. Twenty Lakhs from legal services in the last five preceding financial years.  | Relevant Copies of audited Balance sheet, Profit & Loss and certificate issuedby C.A. to be enclosed. |

* 1. **Number of IP Applications handled in last five calendar years (2019-2024)**

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| --- | --- | --- | --- | --- |
| **Sr. No.** | **Intellectual Property Form** | **Number of Applications Filed** | **Number of Applications Prosecuted** | **Number of Granted IP** |
| **1.** | **Patents** |  |  |  |
| i. Indian |  |  |  |
| ii. PCT |  |  |  |
| iii. Foreign |  |  |  |
| **2.** | **Trademarks** (in India) |  |  |  |
| **3.** | **Copyrights** (in India) |  |  |  |
| **4.** | **Designs** (in India) |  |  |  |
| **5.** | **New Plant Variety** (in India) |  |  |  |

1. **Schedule of Govt and Professional Fee (INR) inclusive of all.**

**Section- I Patent**

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| --- | --- | --- | --- |
| **Sr. No.** | **Application** | **Professional fee, Rs** | **Govt Fee** **Rs** |
| 1. | Drafting and filing of patent application with provisional specification, complete specification, divisional application and/or patent of addition. This includes filing of all necessary forms irrespective of time of filing. |  |  |
| 2 | Drafting and filing of complete specification after filing provisional specification with all necessary forms. |  |  |
| **3** | **Making request for filing patent outside India (Form 25)** |  |  |
| 3.1 | Seeking permission from National Biodiversity Authority (NBA) for filing IP application under section 6 of The Biological Diversity Act including filing Form-III etc. with NBA and related action till NBA permission is obtained |  |  |
| 3.2 | Discussion with inventor in university premises  |  |  |
| **4** | **Extension of time where Government Fees is also applicable** |  |  |
| **5** | **Prosecution** |  |  |
| 5.1 | Reporting official action including FER, SER etc., amending specification and re-filing in response to FER, SER etc. (one-time billing irrespective of iterations) including reporting and providing certificate of **Patents** |  |  |
| 5.2 | Discussion/ hearing at Patent Office during prosecution of application per appearance |  |  |
| **6** | **Attending to renewals and sending renewal certificate per year** |  |  |
| 6.1 | Attending to restoration of lapsed patent, filing petition and attending to payment of fees (Form 15) |  |  |
| **7** | **Working of patents: each report of working under section 146 (Form 27)** |  |  |
| **8** | **Assignment and Licenses** |  |  |
| 8.1 | Drafting assignment deed form |  |  |
| 8.2 | Filing application for registration for assignment /license (Form 16) |  |  |
| (a) One patent |  |  |
| (b) each additional patent included at the same time in the same deed |  |  |
| **9** | **Opposition** |  |  |
| 9.1 | Drafting and Filing pre-grant opposition (for or against) |  |  |
| 9.2 | Drafting, Filing and prosecuting Post Grant opposition (for or against) |  |  |
| 9.3 | Attending hearing per day at patent office in the city of the attorney’s office |  |  |
| 9.4 | Attending hearing per day at patent office not in the city of attorney’s office |  |  |
| **10** | **Patent revocation/infringement** |  |  |
| 10.1 | Drafting of infringement/revocation suit (initiating revocation/infringement or defending revocation/infringement one time billing other than hearing) |  |  |
| 10.2 | Representation charges (In Court) |  |  |
| 10.3 | Any other charges, if any (like legal opinion etc.) |  |  |
| **11** | **Consultation charges each hour or part** |  |  |
| **12** | **Prior art search report for novelty, inventiveness and utility** |  |  |
| **13** | **Filing of foreign patent applications** |  |  |
| 13.1 | Filing of a patent application in each country patent (can be as a percentage of foreign associates bills) |  |  |
| 13.2 | Charges for prosecuting each application till grant of patent including all desired action (can be as a percentage of foreign associates bills) |  |  |
| **14** | **Charges for renewal each year (can be as a percentage of foreign associates bills)** |  |  |
| **15** | **Filing of PCT application** |  |  |
| 15.1 | Preparing and filing a new PCT application and all necessary actions including amendment etc under article 19 / Preliminary examination. |  |  |
| 15.2 | Filing national phase applications including changes in the claims if necessary. Charges application as per item 9 only. |  |  |
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**Section II: Designs**

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| **Sr. No.** | **Application** | **Professional fee, Rs** | **Govt Fee****Rs** |
| 1. | Application for registration per class based with all essential form including (Form 1, Form 2 and Form 21) |  |  |
| 1.2 | Prosecution of design application till registration certificate is provided to applicant |  |  |
| 1.3 | Restoration of lapsed design (Form 4) |  |  |
| 1.4 | Notice of opposition (Form 19) |  |  |
| **2** | **Request for any Action such as correction of clerical errors (Form 14)** |  |  |
| **3** | **Request for any Action such as certified copies (Form 15 and Form 16)** |  |  |
| **4** | **Appearance any Action such as charges per appearance before patent office** |  |  |
| 4.1 | Any Action such as inspection of registered design (Form 5) |  |  |
| 4.2 | Filing of foreign design applications |  |  |
| 4.3 | Charges for prosecuting each application till registration of design (can be as a percentage of foreign associates bills) |  |  |
| **5** | **Charges for renewal each year** |  |  |

**Section III: Copyright**

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| **Sr. No.** | **Application** | **Professional fee, Rs** | **Govt Fee****Rs** |
| 1 | Application for registration of copyright(Form IV) |  |  |
| 2 | Prosecution and obtaining certificate of copyright |  |  |
| 3 | Drafting of any specific forms such as NOC. |  |  |
| 4 | Per action (any other action outside the process of filing and obtaining copyright |  |  |

**Section IV: Trademarks**

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| **Sr. No.** | **Application** | **Professional fee, Rs** | **Govt Fee****Rs** |
| 1 | Application for registration of trademark including certification trademark (Forms TM 1, TM 4, TM 8, TM 51, TM 52) |  |  |
| 2 | Notice of opposition and related actions, till disposal(TM 5, TM 6, TM44) |  |  |
| 3 | Request for search and prosecution till issuance of certificate(TM 11)) |  |  |
| **4** | **Restoration & renewal of trademark****(TM 13)** |  |  |
| 5 | Application filing in other countries (should be shown as percentage of the associate’s charges) or appearance in hearing etc. |  |  |

**Section V: Geographical Indications**

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| **Sr. No.** | **Application** | **Professional fee, Rs** | **Govt Fee****Rs** |
| 1.1 | Drafting & filing in India in single class |  |  |
| 1.2 | Prosecution charges till registration |  |  |
| **2** | **Renewal of GI** |  |  |
| 2.1 | Drafting and filing of counter statement to the opposition |  |  |
| 2.2 | Attending hearing at GI Registry or another place designated by GI Registry |  |  |

**Section–VI: Protection of IC Layout Design**

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| **Sr. No.** | **Application** | **Professional fee, Rs** | **Govt Fee****Rs** |
| 1 | Application for registration along with necessary forms |  |  |
| 2 | Handling Prosecution till Registration |  |  |
| **3** | **Application for Renewal of Registration** |  |  |

**Section -VII New Plant Variety**

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| **Sr. No.** | **Application** | **Professional fee, Rs** | **Govt Fee****Rs** |
| 1 | Application for registration along with necessary forms |  |  |
| 2 | Handling Prosecution till Registration |  |  |
| 3 | Application for Renewal of Registration |  |  |
| 4 | Any Other Charges |  |  |

**Section - VIII Any Other Item/Charges not mentioned above**

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| **Sr. No.** | **Application** | **Professional fee, Rs** | **Govt Fee****Rs** |
| 1 |  |  |  |
| 2 |  |  |  |

**4. Firm/ Patent Attorney to specify prior experience in following domain**

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| --- | --- | --- |
| **Sr. No.** | **Experience**  |  |
| A | Automotive  |  |
| B | Biomedical |  |
| C | Electronics |  |
| D | Chemical |  |
| E | Softwares |  |

**Sign & Stamp of the Patent Attorney/ Firm**