

Section 7. Terms of Reference

Consultancy services to identify potentially valuable intellectual property arising from research conducted by universities and higher education institutions under Accelerating Higher Education Expansion and Development (AHEAD) operation

1. BACKGROUND

The development of the higher education sector is of central importance to enable Sri Lanka to develop from a Lower-Middle Income Country (LMIC) to an Upper Middle-Income Country (UMIC). Recognizing this, the Government of Sri Lanka (GoSL) and the World Bank have agreed, as part of the Bank's Country Partnership Strategy (CPS) FY17-FY20, to support the higher education sector through a Bank funded Accelerating Higher Education Expansion and Development (AHEAD) operation.

2. THE AHEAD PROGRAM

Accelerating Higher Education Expansion and Development (AHEAD) operation is organized into two components. The first is a Program Component that supports the national Higher Education Development Program (HEDP). The second is a system strengthening, capacity building and technical assistance component that will assist GoSL to strengthen the higher education sector and achieve the objectives of the AHEAD program component. This second component will also cover monitoring and evaluation, policy analyses, program coordination and communication.

The implementing agency is the Ministry of Higher Education, Technology and Innovation (MHETI). The MHETI will be assisted at the national level by the University Grants Commission (UGC) and the Sri Lanka Institute for Advanced Technological Education (SLIATE). The Operations Monitoring and Support Unit (OMST) of the MHETI will coordinate and support all AHEAD activities between the MHETI, UGC, SLIATE, Universities and Advanced Technological Institutes (ATIs) and all non-state Higher Education Institutions under the MHETI.

Under the Research, Development and Innovation Results Area of the AHEAD program there will be different types of support: (a) Development Oriented Research (DOR) grants for research activities leading to publication and dissemination of research; (b) Research, Innovation and Commercialization (RIC) grants for research and innovation activities leading to intellectual property (IP) such as patents and copyrights, and the promotion of university-business linkages for the commercial development of these IPs by private sector firms and companies; (c) Innovation Commercialization Enhancement Grants (ICE); and (d) development of the policy and enabling environment for research, innovation and commercialization activities by universities and research institutions.

A Consulting Firm with a track record on undertaking protection of intellectual property is required to enhance the patent portfolio of universities under the AHEAD operation.

3. OBJECTIVE OF THE ASSIGNMENT

To support Sri Lankan researchers at Universities governed by the University Act No. 16 of 1978 and any other higher education institution supported for research and innovation by AHEAD to identify the intellectual property arising from their research.

4. SCOPE OF THE CONSULTANCY

The consultant should identify, select and recommend potentially valuable intellectual property arising from research conducted at universities and higher education institutions under the AHEAD. The research outcomes will be from AHEAD funded and non-AHEAD funded research work.

5. KEY TASKS AND RELATED ACTIVITIES

A. Preparation of the inception report and scheduling the meetings

The consultant should schedule the meetings and/or skype discussions covering all the research teams at universities and higher education institutions under the AHEAD in coordination with the OMST.

B. Identification of potentially valuable intellectual property arising from research to proceed with intellectual property rights protection

Accordingly, the consultant should visit and discuss or arrange skype sessions with all the research teams and interview Director UBL Cell, Coordinators & research teams of ICE/RIC/DOR grants to identify potential intellectual property/ies which is worth protecting.

The discussion should be conducted with at least 10 research teams (this number may vary in different quarters as it depends on the research and innovation outcomes) from different universities/higher education institutions per quarter and the consultant should have to select and recommend suitable researches which will have good commercialization potential and suitable for obtaining intellectual property rights out of the 10 teams reviewed. This activity should be repeated in every quarter with different teams (B-1 to B-8) during the first year of the consultancy. Note that some discussion can go to the second year of the consultancy depending on the time frame of generating research and innovation outcomes.

The OMST will instruct the UBL cells and researchers to conduct a patentability search before these meeting and facilitate consultant to identify the “Research Teams” based on the performance of the grants and availability of technologies and their research findings.

The consultant should conduct an independent patentability search and select suitable researches from Universities or Non-state HEIs which will have good potential for intellectual property rights (Patents, Industrial designs, Trademarks and copyrights).

C. Identification of suitable jurisdiction to protect the invention after discussing with the research team and their commercial partners if relevant.

D. Submission of the final report including brief description of the whole process conducted, identified and processed IP including novelty and patentability search reports, total no. of IPs recommended and any guidance etc.

6. DELIVERABLE AND TIME FRAME

Related Task & Activity No.	Required Deliverable	Time frame (after signing the contract)
A	<u>Inception Report along with the Work Plan</u> including the schedule of meetings and skype discussions to be held covering all the research teams at 15 universities and higher education institutions and UBLs and HEI-SL Cells.	First month year 1
B	A report including details of: <ul style="list-style-type: none"> visits, discussions and skype sessions held during the quarter, list of research teams reviewed and list of identified and selected technologies along with the recommendation on suitable IP including novelty and patentability search reports. (B-1) 	Quarter 1 year 1
	Same deliverable as above with respect to the reviews conducted during the 2 nd quarter of the 1 st year (B-2)	Quarter 2 year 1
	Same deliverable as above with respect to the reviews conducted during the 3 rd quarter of the 1 st year (B-3)	Quarter 3 year 1
	Same deliverable as above with respect to the reviews conducted during the 4 th quarter of the 1 st year (B-4)	Quarter 4 year 1
C	Recommendation given to the OMST during each quarter, along with the potential for commercialization	Each quarter (4 recommendation reports)
D	Final report	During quarter 4 of year 1

7. REPORTING THE DELIVERABLES

The consultant shall closely coordinate and report to the Lead Academic Expert (Research and Innovation) at the OMST.

8. EXPECTED QUALIFICATION OF THE CONSULTANT

1. The Consultancy firm should have at least 3 years' experience and track record on evaluation of Intellectual Property such as Patents, Industrial designs, Trademarks and copyrights successfully. State any prior art search reports generated and any International filing at entities such as USPTO, EPO, JPO, KIPO and filing of PCTs.
2. The firm must have a team of professional with the relevant skills required. Provide proof of availability of key professionals (CVs with signature & date and their confirmation letter) and availability of resources (hardware, software and logistics) for conducting this task. Consultant should also have access to professionals from a wide variety of disciplines under STEM (Science, Technology, Engineering, Mathematics, Medicine, Agriculture) research areas as well as HEMS (Humanities, Education, Management and Social Sciences) research areas.

The consultant team should include the following team at the minimum

- Team Leader
- Expert for generating novelty and patentability search reports
- Expert for patent filing in different Jurisdictions inclusive of PCT applications
- Expert for identifying copyright/Trademark filing/Industrial design and any other IP
- Expert to liaise with researchers in Science (such as Agriculture, Biology, Chemistry, Physics, Medicine)
- Expert to liaise with researchers in Engineering, Technology & ICT
- Expert to liaise with researchers in Bio-Technology & Molecular Biology
- Expert to liaise with researchers in HEMS (Humanities, Education, Management and Social sciences)

Generally, all staff members shall have a University Degree or relevant Higher Education qualification in the respective field of expertise required for this consultancy. The same expert can contribute to more than one task however the CV of the person should reflect that the person can contribute to all tasks assigned.

The Team leader shall have at least 3 years of experience in managing project teams in relation to IP protection. He or She should have sufficient time to manage the activities and staff for this task. This includes coordinating with AHEAD/OMST and relevant state Universities and non-state Higher Education Institutions. Excellent communication and reporting skills are required.

The team leader should be stationed in Sri Lanka or should be able to attend meeting in Sri Lanka at short notice.

The **Expert for generating novelty and patentability search reports** shall have at least 2 years of experience in using non-commercial and commercial patent databases and generating reports. He or She should have sufficient time to conduct the searches.

The **Expert for filing in different Jurisdictions inclusive of PCT applications** with LL. B. or equivalent qualifications and shall have at least 3 years of experience in filing IP applications, should be very conversant with the subject. Good communication and reporting skills are required.

The **Expert for filing of copyright/Trademark filing/Industrial design and any other IP** shall have at least 3 years of experience in the field. Good communication and reporting skills are required.

The **Expert to liaise with researchers in Science** (such as Agriculture, Biology, Chemistry, Physics, Medicine) shall have at least a masters degree in the relevant field of expertise. He or she should have at least 3 years of experience in the respective field. Being able to conduct novelty search and patentability search in the field would be an additional advantage. He or she should be able to work closely with the researchers to understand the outcome of research and innovations.

The **Expert to liaise with researchers in Engineering, Technology & ICT** shall have at least a masters degree in the relevant field of expertise. He or she should have at least 3 years of experience in the respective field. Being able to conduct novelty search and patentability search in the field would be an additional advantage. He or she should be able to work closely with the researchers to understand the outcome of research and innovations.

The **Expert to liaise with researchers in Bio-Technology & Molecular Biology** shall have at least a masters degree in the relevant field of expertise. He or she should have at least 3 years of experience in the respective field. Being able to conduct novelty search and patentability search in the field would be an additional advantage. He or she should be able to work closely with the researchers to understand the outcome of research and innovations.

The **Expert to liaise with researchers in HEMS** (Humanities, Education, Management and Social sciences) shall have a Ph. D. or equivalent degree in a relevant field. He or she shall have at least 3 years of experience in the field of expertise. The expert should be able to work closely with the researchers to understand the outcome of research and innovation.

9. DURATION OF THE ASSIGNMENT

The duration of the contract will run for 1 year from the date of signing the contract.

Over a period of one year the consultant helps to identify intellectual property/ies (such as Patents, Industrial designs, Trademarks and copyrights) from all AHEAD supported universities and higher education institutions.

10. MODE OF PAYMENT

Your financial proposal should include the consultancy fee. It will be paid for completion of Key tasks A, B, C and D within the given period as tabled in the “**DELIVERABLE AND TIME FRAME**”.

However, if research teams are not ready the time period can be extended beyond 1 year. Further during each quarter, the number of meetings may not be exactly equal to 10 and the payment will be on pro-rata basis.

Please provide payment rates requested in the following table for the evaluation.

Team member	Hourly rate	Expect task	Number of hours
Team Leader		Tasks A and D and overall coordination	50
Expert for generating novelty and patentability search reports		Tasks B1-B4 and C	550
Expert for filing in different Jurisdictions inclusive of PCT applications		Tasks B1-B4 and C	30
Expert for filing of copyright/Trademark filing/Industrial design and any other IP		Tasks B1-B4 and C	05
Expert to liaise with researchers in Science (such as Agriculture, Biology, Chemistry, Physics, Medicine)		Tasks B1-B4	120
Expert to liaise with researchers in Engineering, Technology & ICT		Tasks B1-B4	80
Expert to liaise with researchers in Bio-Technology & Molecular Biology		Tasks B1-B4	80
Expert to liaise with researchers in HEMS (Humanities, Education, Management and Social sciences)		Tasks B1-B4	05
Total			920

*number of hours given above are only for the calculation of consultancy fee which will be used in the evaluations.

Release of consultancy fee will be made in installments as follows:

- 5% of the consultancy fee will be paid upon signing of the contract and completion of Key task A
- 80% of the consultancy fee will be paid as follows
20% x 4 (total of 80%) payment will be made for completion of tasks B-1 to B-4.
(If the required number is not met, payment will be made on pro rata basis)
- 10% of the contract amount will be paid upon completion of key task C.
- 5% of the contract amount will be paid upon completion of key tasks D.

11. OWNERSHIP OF THE ASSIGNMENT

This assignment is based on the research and innovations of the Universities and Higher Education Institutions and therefore, the Consultant should have to maintain high level of professionalism and

confidentiality during the prior and post stages of the assignment. In any grounds, the Consultant will have no rights to disclose or use research findings or inventions and related Data and Information gathered through the assignment for other purposes without written permission from the Secretary of the Ministry of Higher Education, Technology and Innovation.

Therefore, the selected firm should have to enter into a Non-Disclosure Agreement (NDA) with the Project before commencement of the consultancy services.

The assignment will be funded by the Ministry of Higher Education, Technology and Innovation (MHETI) via OMST and it therefore shall be the owner of the assignment and relevant Universities and Higher Education Institutions will reserve the Intellectual Property Rights for all the selected research under the assignment.