

Section 7. Terms of Reference

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

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 protect and maintain the intellectual property arising from AHEAD funded or non-AHEAD funded research.

4. SCOPE OF THE CONSULTANCY

The consultant should protect potentially valuable intellectual property arising from research conducted at universities and higher education institutions under the AHEAD in different jurisdictions and should proceed to support to maintain the intellectual property rights at relevant national or international authorities on behalf of the Universities and Higher Education Institutions. (NOTE: However securing IP depends on whether the application satisfy the criteria for the protection)

5. KEY TASKS AND RELATED ACTIVITIES

A. Scheduling the meetings, studying the prior art search reports and work on claims

The consultant should schedule the meetings and/or skype discussions with identified research teams at universities and higher education institutions under the AHEAD in coordination with the OMST. Thereafter the consultant will study the produced prior art search reports and work on the claims.

B. Finalization of the claims and identification of suitable jurisdiction to protect the invention after discussing with the research team and their commercial partners if relevant and proceed with the application/s.

C. Submission of Applications for a Patent Corporation Treaty (PCT) as appropriately.

D. Prosecution of the intellectual property rights.

The consultant should follow up until the relevant IP is obtained or a final decision given by the relevant authority and it should inform to the relevant authorities with the consultation of the coordinator of the consultancy contract.

E. Providing guidance to the owners of IP

Provide guidance to the owners of IP on how to renew the IP protection every year and entering into licensing agreements.

F. Submission of the final report including brief description of the whole process conducted, identified and processed IP, total no. of IPs processed and obtained, recommendations and guidance on improvements and renewal etc.

6. DELIVERABLE AND TIME FRAME

Related Task & Activity No.	Required Deliverable	Time frame (after signing the contract)
A	Meeting minutes and the draft claims (if confidential a letter from the team to support the completion of this task)	First month
B	A copy of the final claims along with the final application recommended by the research team (if confidential a letter from the team to support the completion of this task)	Second month
C & D	Copy of the IP application or submitted PCT Certified by the relevant researcher along with other relevant documents sent by the relevant authority related to the decision and all other documents related to prosecution of IP	Any time within the year
E	Recommendation letter provided by the Director UBL or coordinator ICE/RIC/DOR mentioning that the firm has provided necessary guidance on entering into licensing agreements and renewal.	Any time within the year
F	Final report	Any time within the year

If any research will be identified as non-patentable at any stage, the Consultant shall agree with the Client to discontinue the task of the contract mutually. The payment only for the services done will be settled according to the signed contract.

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 filing Patents, Industrial designs, Trademarks and copyrights successfully. State any International filing entities such as at 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 patent filing at NIPO and in Jurisdictions outside Sri Lanka inclusive of PCT applications
- Expert for filing of 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 large 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 meetings in Sri Lanka at short notice.

The **Expert for patent filing at NIPO and in Jurisdictions outside Sri Lanka** inclusive of PCT applications shall have LL. B. or equivalent qualifications and at least 5 years of experience in the field. 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 and help to translate the new finding to patent claims.

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 and help to translate the new finding to patent claims.

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 and help to translate the new finding to patent claims.

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 and help to protect any IP related to the field.

3. The consultant should be able to draft relevant documentation to protect and maintain IP in Sri Lanka and other jurisdictions as required.

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 protect 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 Consultancy fee and Reimbursable expenditure separately.

1. Consultancy fee will be paid for completion of Key tasks A, B, E and F within the given period as tabled in the “**DELIVERABLE AND TIME FRAME**”.

However, if research teams do not respond on time, period can be extended.

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 F and overall coordination	36
Expert for patent filing in NIPO and in Jurisdictions outside Sri Lanka inclusive of PCT applications		Discussions with research teams to perform tasks A-E	164
Expert for filing of copyright/Trademark filing/Industrial design and any other IP		Discussions with research teams to perform tasks C, D and E	12
Expert to liaise with researchers in Science (such as Agriculture, Biology, Chemistry, Physics, Medicine)		Tasks A and B	44
Expert to liaise with researchers in Engineering, Technology & ICT		Tasks A and B	44
Expert to liaise with researchers in Bio-Technology & Molecular Biology		Tasks A and B	44
Expert to liaise with researchers in HEMS (Humanities, Education, Management and Social sciences)		Tasks A and B	8
Total			352

*number of hours given above are indicative numbers which will vary depending on the IP application.

2. The Reimbursable expenditure will be paid for completion of Key tasks C, and D. Therefore, the Consultant should have to propose unit rates for
- Filing a Patent application/ design application/trademark application/ copyright application for software, artistic work, literary work, cinematograph film, sound recording in Sri Lanka
 - Filing of a Patent Corporation Treaty at WIPO
 - Filing an application in other Jurisdictions
 - Charges for patent prosecution and Renewal etc.,

An example of a list is given in **Annex 1**.

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

- 20% of the consultancy fee will be paid upon signing of the contract and completion of Key task A for a particular IP protection.
- 60% of the consultancy fee will be paid for completion of Key task B for a particular IP protection.
- 10% of the consultancy fee will be paid upon completion of key task E for a particular IP protection.
- 10% of the total consultancy will be paid upon completion of key task F at the end of the consultancy contract.

- Expenditure for Key tasks C and D will be reimbursed.

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.

Annex 1

Your financial proposal will also be evaluated based on the rates given for the following items. State attorney charges and government charges separately.

However, this is not an exhaustive list. The consultant may add extra items to cover the scope of the consultancy.

Patents (State attorney fee in SL Rupees, Government fees will come separately from the grants)

- Search on novelty and patentability
- Patent drafting (State additional charges if the charges vary depending on the number of claims)
- Filing an application in Sri Lanka
- Filing of a Patent Cooperation Treaty at WIPO
- Filing of formal documents with or without petitions (State the jurisdictions and the charges separately)
- Filing request for examination
- Receiving and reporting examination reports
- Preparing and filing response to the examination reports
- Appearing for hearing before the IP office
- Receiving and forwarding the patent certificate
- Charges for patent prosecution
- Renewal of patent per year (For key task E)
- Any additional charges involved

Industrial designs (State attorney fee in SL Rupees, Government fees will come separately from the grants)

- Search on novelty and freedom to operate
- Filing the design application
- Prosecution of the design application
- Renewal
- Any additional charges involved

Trade marks (State attorney fee in SL Rupees, Government fees will come separately from the grants)

- Conducting trademark search on novelty and rendering opinion
- Drafting and filing the trademark application
- Prosecution of the trademark application
- Renewal of trademark
- Any additional charges involved

Copyright registration ((State attorney fee in SL Rupees, Government fees will come separately from the grants)

- Filing a copyright application for software
- Filing a copyright application for artistic work
- Filing a copyright application for literary work
- Filing a copyright application for cinematograph film
- Filing a copyright application for sound recording
- Any additional charges involved

Note: It is impossible for the AHEAD operation to estimate the total number of IP which will be generated during this consultancy period. However, based on the performance indicators given by the researchers, operation expects 5 national patent applications, 3 international patents, 2 industrial designs, 1 international copyrights, 1 international trademarks and 3 PCTS. However, the actual number will vary, and the cost will be reimbursed based on actual expenditure.