



CALL FOR TENDERS

Open Procedure

JRC/BRU/2016/I.4/5002/OC

Patent annuities and trade mark renewal services

Tender specifications

Part 2- Technical Specifications

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1. INTRODUCTION

In 2001, the European Commission entrusted DG Joint Research Centre (JRC) with the overall administrative management of European Union IPR. It also became responsible for the provision of support and advice in relation to IP issues and raising awareness on IP with Commission staff. These related tasks are carried out in the “Intellectual Property and Technology Transfer” (IP&TT) unit. In 2012, the Commission established its Central IP Service, located in the IP&TT unit, which serves Commission DGs and Services and, to a lesser extent, EU Institutions, bodies and agencies.

The European Union's IPR assets are being created in all EU-policy areas, from agriculture to transport. In particular intellectual creations are produced in the fields of Information and Communication Technology, Life sciences, Environment, Energy and Nuclear technologies.

The IPR portfolio of the Union comprises of 90 families of patents, corresponding to about 800 patent files; 200 trademarks families, corresponding to nearly 600 trade mark applications/registrations; and a few design registrations. The assets originate from different Directorates General (DG) of the European Commission, in particular from the JRC, and to a lesser extent from other European Institutions, Agencies and bodies.

The European Union is the source of some 10 new inventions every year. On average, five patent applications are filed per year. Protection is generally sought in EU countries, US, Canada, Japan, China, the Russian Federation and India.

The objective of this call for tender is the conclusion of a framework service contract for the renewal of trade mark and design registrations, the filing of declarations of use, and the payment of patent annuities for IPR owned by the EU, the executive agencies and European Union agencies and bodies. It does not include the management of the IP portfolio.

Trademarks are renewable every ten years against a renewal fee, established by the competent authority of the country (or territory) concerned. There is no maximum duration for trade mark registrations. In some jurisdictions a declaration of use must be filed, usually every five years. The filing of declarations of use is included in this tender.

In general, the maximum duration for a design is twenty-five years. Mostly, designs are renewable every five years against a renewal fee, established by the competent authority of the country (or territory) concerned.

The maximum duration for a patent is twenty years. In order to keep a patent in force, annuities are to be paid yearly. The official annuity fee is established by the competent authority of the country (or territory) concerned.

The estimated consumption during the execution of this contract is forecasted to be some 2850 annuity payments, some 550 trade mark renewals and 15 declarations of use over its maximum duration of four years.

The overall consumption during the execution of this contract is forecasted at 2 300 000,00 EURO (Two millions three hundred thousand,00). This amount includes official fees and relevant third parties' costs and travel costs and subsistence expenses related to the execution of tasks.

2. SERVICE REQUIREMENTS

The purpose of this call for tender is to provide a business service related to the renewal of trademarks and design registrations and declarations of use, as well as the payment of patent annuities in the jurisdictions where these are applied for c.q. registered.

The selected contractor will provide these services under instructions from the European Commission through the JRC:

- Payment of patent annuities
Deliverable: Official confirmation of payment issued by the relevant IP Office.
- Renewal of design registrations
Deliverable: Renewal certificate issued by the relevant IP Office.
- Renewal of trade mark registrations
Deliverable: Renewal certificate issued by the relevant IP Office.
- Filing of declarations of use
Deliverable: Confirmation of registration issued by the relevant IP Office.
- Provision of electronic access to the patent trade mark and design portfolio
Deliverable: 24 hour electronic access.

The above list is not exhaustive and the contracting authority may request the contractor to propose supplementary services of the same type as those listed above. These supplementary elements may not depart from the essential terms fixed in the FWC and may be requested only if they are absolutely necessary for the execution of the service.

While carrying out these tasks, the contractor must:

- Ensure timely execution of the provided services thus safeguarding the European Union's IP rights.
- Ensure value for money while dealing with external service providers or local agents in different parts of the world.
- Keep the Commission informed in a timely manner of these activities, asking for instructions whenever appropriate.
- Keep confidential all facts, information, knowledge, documents and other matters communicated to it or which may come into its possession during the performance of the contract and after its expiry (see Article II.9 of the draft Framework Contract)
- Provide the contracting authority with regular follow-up statistics concerning incurred expenditures and number of cases handled by the contractor without extra expenses.

3. ORDERING PROCEDURE

Principle

The rendering of services covered by the Framework Contract will be the subject of Specific contracts that will define the extent of the service and delimit its overall budget. There can be no provision of services without such a Specific contract. The contractor will be responsible for all the services specified.

Ordering process

1. From the signature of the contract, at the end of every quarter Q, the contractor will send a detailed report on all renewal payments pending from quarter Q+3 (i.e. starting 6 months later). By means of example, by end of December Year N, the contractor will send a report containing an overview of all payments necessary to maintain the rights that are due between 01/07/Year N +1 and 30/09/ Year N +1. The report shall be ordered by due date of the payment and specify the IP right to be renewed and in which country. Moreover, for each IP right the report must detail the cost for its renewal broken-down by official fees and contractor's fees.
2. Following the reception of the report the contracting authority will decide which of the IP rights listed in the report must be maintained and thus a payment of the fee required. The contracting authority will inform the contractor of its decision and issue a specific contract for the renewal of the confirmed IP rights no later than four month from the reception of the above mentioned report.
3. The contractor shall deliver the service timely, avoiding penalties for late payment.
4. In case there is no time for the contractor to seek confirmation of a payment or renewal without loss of rights, the contractor shall pay the annuity or renewal.
5. The quoted price must be established on the basis of the unit prices indicated in the financial offer and attached to the framework contract and thus include overhead, internal financial administration and internal administrative support. Therefore any administrative costs, such as secretarial and administrative handling shall be included in the contractor's fees.
6. Extra fees encountered during service delivery but are outside of the control of the contractor (such as changes in official fees or fluctuations in the conversion rates) shall be reimbursed on presentation of documents accrediting these changes.

4. OTHER GENERAL MODALITIES AND RESPONSIBILITIES

Principal place of work

The principal place of work will be the contractor's premises.

- In the performance of the contract, the contractor shall be accurate, punctual and professional. The contractor must guarantee availability in urgent cases.
- One team member shall be available for telephone calls within 4h from commission request (office hours).

- Receipt of written request from the Commission shall be acknowledged in written within maximum 1 working day.

Submission of deliverables and more generally communication

Deliverables may be submitted by e-mail and/or postal delivery at the address indicated in Article I.8 of the framework contract. In case of a very sensitive case is being handled, the deliverables shall always be sent by secure mail following the terms that will be specified by the contracting authority.

Formats

The Contractor shall provide all deliverables in the form and formats specified in the technical specifications of the specific contract.

All Contractors' documents shall be made available as Microsoft Office or Open Office compatible documents (or equivalent) and in a PDF electronic format. All documents transmitted by the Contractor must contain, at least, the Commission's references (framework contract number, specific contract and activation reference), the type of document and revision history.

Quality assurance and control

Upon signature of the framework contract, the contracting authority and the contractor will meet to agree on the practicalities concerning the performance of the contract, quality assurance and control.

The contracting authority and the contractor will meet once a year to assess the performance of the contract. The expenses incurred by the contractor for participation to the meetings are to be borne by the contractor.

Property and Confidentiality of the Data, Tools and Results and their publication

The data, results delivered under this contract are confidential and remain the exclusive property of the EU, as specified on Articles I.10 and II.13. of the framework contract.

5. PAYMENT

Once the service described in the specific contract have been achieved ensuring no loss of right, the contractor will issue an invoice following the terms of Article I.6 of the framework contract.

Every invoice must be accompanied by a report justifying every expenses incurred by the contractor and, where possible, the proof that an IP right has been renewed.

In case of payments incurred by the contractor in a non-Euro currency, the conversion shall be made according to the official EU rate of the day the invoice has been issued by the third party (as published in the InforEuro¹ by the European Commission).

Pre-financing

At the same time as a Specific Contract is issued; the contracting authority will pre-finance to the

¹http://ec.europa.eu/budget/contracts_grants/info_contracts/inforeuro/inforeuro_en.cfm

contractor the amount of official fees that will have to be paid for the renewals approved by the Specific Contract.

Performance guarantee:

No performance guarantee will be required.

6. HANDOVER OF THE FILES – BEGINNING AND ENDING OF THE CONTRACT
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The contracting authority will ensure that IPR portfolio will be available to the contractor within one month from the signature of the contract.

– The takeover of IPR-files shall be provided for by the contractor free of charge.

The new contractor will take responsibility the payments of the annuities and the renewals that become due as of the first of April 2017.

The previous contractor will remain responsible for the payments of the annuities and the renewals that are due until that date.

At the termination of the contract the contractor shall transfer the provision of services to the next contractor free of charge during a handover period of three months.

The contractor will record the transfer of the European Union's IPR-files at the end of the handover and takeover by listing all the IPR-files transferred, indicating their status and the deadline of next actions to be taken.

7. INFORMATION ON THE OVERALL CONSUMPTION FOR THE CONTRACT

The actual portfolio of the EU and ECHA (only trade marks) has been taken as a reference in the calculation of the overall consumption during the coming four years. Annuities are to be paid yearly, design renewals every five years, and trade mark renewals every ten years. Only the designs and trademarks that will expire during the validity of this framework contract will be taken into account for the execution of the contract.

During the execution of the contract:

Annuities may have to be paid in the following countries:

Argentina	Austria	Belgium
Brazil	Canada	Switzerland
China	Germany	Denmark
European Patent Office	Spain	Finland
France	United Kingdom	Greece
Hong Kong	Indonesia	Ireland
Israel	India	Italy
Japan	South Korea	Luxembourg
Monaco	Mexico	Malaysia
Netherlands	Norway	New Zealand
Philippines	Portugal	Sweden
Singapore	Taiwan	United States of America
Venezuela	South Africa	

Trade marks may be renewed nationally, at EUIPO or at the Benelux Office (BOIP) in the following countries:

France (2)	Germany (1)	Spain (3)
Portugal (1)	Ireland (3)	Benelux (33)
Greece (2)	United Kingdom (5)	Italy (3)
EU (85)	Slovakia (1)	Czech Republic (1)
Hungary (1)	Estonia (1)	Poland (1)
Romania (1)	Bulgaria (1)	Lithuania (1)
Slovenia (1)	Israel (5)	Brazil (13)
India (10)	Canada (10)	Chile (2)
Lebanon (2)	Bosnia Herzegovina (2)	Mexico (6)
South Africa (13)	Kosovo (1)	Andorra (2)
Tunesia (1)	African IP Organisation (2)	Jordania (9)

Trade marks may be renewed via WIPO in the following countries:

Turkey (18)	Croatia (14)	Iceland (15)
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Switzerland (29)	China (16)	Norway (25)
United States of America (16)	South Korea (5)	Russian Federation (7)
Japan (9)	Lichtenstein (12)	Macedonia (14)
Serbia (11)	Egypt (1)	Azerbaijan (3)
Montenegro (10)	Syria (2)	Armenia (3)
Australia (1)	EU (13)	Singapore (1)
Albania (8)	Kazakhstan (2)	Bosnia Herzegovina (6)
Monaco (2)	San Marino (2)	Georgia (2)
Belarus (1)	Algeria (1)	Morocco (1)
Moldavia (1)	Madagascar (1)	Ukraine (1)
Germany (2)	Spain (2)	France (2)
Italy (2)	Portugal (2)	Austria (1)
Bulgaria (1)	Czech Republic (1)	Hungary (1)
Slovakia (1)		

Declarations of use are mainly due in the US.

As the EU only owns three EU Designs, eventual renewal will be at EUIPO.

EU patent portfolio

On the basis of the actual patent portfolio, a total of 2848 annuities are expected to have to be paid between 2016 and 2020.

EU trade mark portfolio

Some 550 trade marks will be up for renewal in the next four years. Fifteen declarations of use are expected to be due in this period.

EU designs portfolio

The EU owns only two design registrations which are due to be renewed during the period of the new frame work contract.

ECHA trade mark portfolio

On the basis of their calculation, ECHA estimates that between 30.000 and 50.000 EUR will be spent on trade mark renewals during the period of the new frame work contract.

Please note that the following estimates are for information purposes only and do not bind the contracting authority to renew any or all the above described during the validity of the framework contract.