

TENDER No°AO/014/20

Collection of National Key Enforcement Judgments related to IPR TECHNICAL SPECIFICATIONS

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1. Background

One of the main tasks entrusted to the EUIPO by Regulation (EU) No 386/2012 is to enhance knowledge of intellectual property rights (IPR) infringements in the Member States. Article 5(1) of the Regulation, on information obligations, sets out that ‘... Member States shall, at the request of the Office or on their own initiative: [...] (c) inform the Office of important case-law’.

As indicated in the European Commission's Communication: A balanced IP enforcement system responding to today's societal challenges (COM(2017) 707 final), ‘transparency about judgments on IPR enforcement is an essential pre-requisite for knowledge exchanges across the single market’. Therefore, Member States are encouraged to systematically publish judicial decisions in proceedings relating to IPR infringement. In this context it was announced in the Communication that the Commission, together with the EUIPO and the European Observatory on Infringements of Intellectual Property Rights (the Observatory), will step up work on the case-law collection database to make it as comprehensive and as user-friendly as possible. In Council Conclusions on the enforcement of IP rights in the EU (6681/18, 1 March 2018) the Member States are invited to consider, in cooperation with the Observatory, the systematic publication of judgments in IPR enforcement cases. The activity is included in the Observatory's Work Programme 2020 and is expected to contribute to a more efficient and predictable judicial enforcement regime in the EU.

2. Project Context

In 2014 the EUIPO started a collection of national key enforcement judgments from the Member States that are related to IPR. The activity is implemented in cooperation with participating IP offices (IPOs) in the Member States.

The participating IPOs identify and provide to the EUIPO key enforcement-related case-law rendered by the national courts, together with a summary of each judgment and indexed metadata (such as keywords and legal norms). The initial submissions contained a back file covering the period from 2006 when Directive 2004/48/EC on the enforcement of IPR was implemented into the national legislation. Once the initial backlog has been dealt with, the

information is updated by the participating IPOs annually. Cases related to plant variety rights are collected in cooperation with the Community Plant Variety Office. The information gathered is made available in the eSearch Case Law database, 'National court judgments' section¹.

Since 2014, a substantial number of Member States have joined the project. However, despite repeated efforts to engage further countries, it has not been possible to involve new participants in the activity. Moreover, some of the Member States that initially joined the project were not able to continue their involvement and provide updates. This situation leaves important gaps in the project.

3. Objective

The EUIPO is awarding a contract to consolidate and expand the collection of national key enforcement judgments related to IPR. For this to be achieved, the gaps in the activity need to be filled and a process for systematic updates needs to be ensured. A direct contract with a duration of 4 years is envisaged.

The objectives of the activity are the following:

- **first**, provide **key enforcement judgments** from the EU Member States currently not participating in the project;
- **second**, provide **key enforcement judgments** from participating Member States that are no longer able to provide them;
- **third**, check and provide **updates** of key enforcement judgments from non-participating EU Member States collected internally by the EUIPO.

¹ Judgments collected in the scope of the project are retrievable by selecting 'Only Key Enforcement decisions'.

4. Scope of the activity

4.1. Approach for selecting the judgments

The contractor should assist the EUIPO in collecting **key judgments** related to the enforcement of IPR rendered at national level to be included in the EUIPO's eSearch Case Law database.

A key enforcement judgment is to be understood as a judgment in relation to the application of an enforcement-related measure or procedure in an IPR infringement case that provides a new trend in jurisprudence, or reinforces or further explains an existing trend.

The criteria for selecting key enforcement judgments are the following:

- Decisions related to the application of measures and procedures foreseen in the Enforcement Directive 2004/48/EC² will be considered a priority;
- Decisions not related to the application of measures and procedures foreseen in the Enforcement Directive 2004/48/EC may be included, provided they constitute a new development in jurisprudence from an enforcement perspective.

IPR to be included in the scope of the activity:

- European Union trade marks;
- trade marks;
- Community designs (registered and unregistered);
- designs (registered and unregistered);
- domain names;
- copyright and related rights;
- patents;
- utility models;
- supplementary protection certificates;
- geographical indications;

² Corrigendum to Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (OJ L 157, 30.4.2004), OJ L 195, 2.6.2004, p. 16-25.

- trade secrets.

Only key enforcement judgments related to civil proceedings will be collected in the scope of the project. Judgments related to criminal proceedings are outside the scope of the activity. The decisions adopted by higher instance courts (e.g. the Supreme Court) will be considered a priority to be included in the collection. However, the judgments may come from the competent instances at any level provided they have not been repealed or amended by a higher instance court. If a judgment is pending appeal, it will be included in the collection once the judgment is final.

4.2. Jurisdictions and time frame

Since the project started in 2014, 15 Member States have joined it in the framework of cooperation with the national IPOs³. All the information collected is available in the EUIPO eSearch Case Law database, 'National court judgments' section.

The main purpose of this activity is to expand and update the collection of key enforcement judgments from EU Member States not participating in the EUIPO project, as well as to establish a process of systematic updates. The contractor should be able to coordinate the collection of case-law from different EU Member States and to provide a consolidated contribution to the EUIPO.

The volumes indicated in the tables below in this section are estimates based on the constraints and assumptions described in each sub-section. The total estimated volume for each deliverable is to be considered as a maximum in terms of pricing and contractual obligations. The Office expects the contractor to deliver up to that maximum volume. If external factors, such as the lack of availability of judgments, lead to the impossibility of reaching those levels, the Office considers the minimum acceptable volume to be no less than 70% of the maximum yearly volume. In any case, any reduction in volume must be duly justified by the contractor and accepted by the Office.

³ Czechia, Denmark, Ireland, Greece, Spain, France, Italy, Latvia, Lithuania, Hungary, Austria, Romania, Slovenia, Slovakia, Sweden.

4.2.1. Deliverable Year 1

During the first year of the contract, the contractor must submit Deliverable Year 1 consisting of the following information:

i) Key enforcement judgments from the EU Member States not participating in the project

Currently 12 EU Member States are not participating in the project⁴. For those EU Member States the backlog of information since 2006 needs to be covered, with the exception of those for which information has been gathered internally by the EUIPO (see table in point 4.2.1(ii) for details).

ii) Key enforcement judgments from participating EU Member States that are no longer able to provide them

For some EU Member States that initially joined the project, providing key enforcement judgments on an annual basis is no longer possible⁵. Therefore, the key enforcement judgments need to be provided from those originally participating EU Member States that are not able to continue their involvement in the project.

The information concerning the timeframe, the Member States to be covered and the estimated number of judgments to be included in this Deliverable is specified in the table below.

EU Member State	2006-2015	2016	2017	2018	2019	2020	Number of judgments
Austria			x	x	x	x	15
Belgium				x	x	x	7

⁴ Belgium, Bulgaria, Germany, Estonia, Croatia, Cyprus, Luxembourg, Malta, Netherlands, Poland, Portugal and Finland.

⁵ For Austria information since 2017 needs to be provided; for Romania, since 2016.

Bulgaria				x	x	x	4
Croatia	x	x	x	x	x	x	17
Cyprus	x	x	x	x	x	x	15
Estonia	x	x	x	x	x	x	13
Finland	x	x	x	x	x	x	24
Germany		x	x	x	x	x	90
Luxembourg	x	x	x	x	x	x	14
Malta	x	x	x	x	x	x	14
Netherlands				x	x	x	15
Poland		x	x	x	x	x	15
Portugal	x	x	x	x	x	x	17
Romania		x	x	x	x	x	20
							Total: 280

x – Key enforcement judgments to be provided by the contractor

It is estimated that, for Deliverable Year 1, the contractor will submit 280 judgments. This number includes judgments both from EU Member States not participating in the project, as well as from those Member States no longer participating in the project. The number of judgments per EU Member State is estimated on the basis of the historical data of the project and the size of the country by population; this number may be adjusted between the EU Member States according to the availability of judgments and other relevant considerations.

4.2.2. Deliverables Years 2 to 4

In the subsequent 3 years of the contract, the contractor will submit the following deliverables (i.e. one deliverable per year) consisting of the following information:

i) Key enforcement judgments from EU Member States not participating in the project and from participating EU Member States that are no longer able to provide the information

The deliverable for EU Member States not participating in the project and for participating EU Member States that are no longer able to provide the information will consist of the case-law collected in that particular year, i.e. a yearly contribution.

The information concerning the time frame, the EU Member States to be covered and the estimated number of judgments to be collected for Deliverables Years 2 to 4, is specified in the table below.

EU Member State	Year 2	Year 3	Year 4	Number of judgments/year
Austria	x	x	x	4
Belgium	x	x	x	6
Bulgaria	x	x	x	3
Croatia	x	x	x	4
Cyprus	x	x	x	3
Estonia	x	x	x	3
Finland	x	x	x	7
Germany	x	x	x	34
Luxembourg	x	x	x	2

Malta	x	x	x	2
Netherlands	x	x	x	7
Poland	x	x	x	14
Portugal	x	x	x	4
Romania	x	x	x	7
				Total/year: 100

x – Key enforcement judgments to be provided by the contractor

It is estimated that, for Deliverables Years 2 to 4, the contractor will submit 100 judgments per year (i.e. a total of 300 judgments for Deliverables Years 2 to 4) from EU Member States not participating in the project and from participating EU Member States that are no longer able to provide the information.

The number of judgments per EU Member State is estimated on the basis of the historical data of the project and the size of the country by population; this number may be adjusted between the EU Member States according to the availability of judgments and other relevant considerations.

ii) Updates on key enforcement judgments from non-participating EU Member States collected internally by the EUIPO

Although the backlog of information for 5 non-participating EU Member States⁶ was covered using internal EUIPO resources, it was not possible to provide the updates. In addition, the EUIPO regularly receives from the German Supreme Court potentially relevant judgments that need to be checked in view of their potential inclusion in the collection. Therefore, for

⁶ Belgium, Bulgaria, Germany, Netherlands and Poland.

those EU Member States where the case-law has been gathered internally, the information needs to be checked and supplemented as required.

It is estimated that, for Deliverables Years 2 to 4, the contractor will check 80 judgments collected internally by the EUIPO per year (i.e. a total of 240 judgments for Deliverables Years 2 to 4). The contractor must update the information if it is incomplete and gaps need to be filled. The information concerning the time frame, the EU Member States to be covered and the number of judgments to be checked and updated for Deliverables Years 2 to 4, is specified in the table below:

EU Member State	2006-2015	2016	2017	2018	2019	2020	Number of judgments /year
Belgium	o	o	o				4
Bulgaria	o	o	o				2
Germany	o		o	o	o	o	55
Netherlands	o	o	o				4
Poland	o						15
							Total/ year: 80

o – Information to be checked and updated by the contractor

The number of judgments per EU Member State is calculated on the basis of the historical data of the project. This number may be adjusted between the EU Member States according to the availability of judgments and other relevant considerations.

4.2.3. Summary of Deliverables Years 1 to 4

A summary of the tasks to be performed for the duration of the contract, as well as the maximum total number of judgments to be provided and checked, is described in the table below:

Deliverable	Task	Number of judgments
Deliverable Year 1	Kick-off meeting minutes	280
	Key enforcement judgments from the EU Member States not participating in the project	
	Key enforcement judgments from participating EU Member States no longer able to provide the information	
Deliverable Year 2	Key enforcement judgments from EU Member States not participating in the project and from participating EU Member States no longer able to provide the information	180
	Updates of key enforcement judgments from non-participating EU Member States collected internally by the EUIPO	
Deliverable Year 3	Key enforcement judgments from EU Member States not participating in the project and from participating EU Member States no longer able to provide the information	180
	Updates of key enforcement judgments from non-participating EU Member States collected internally by the EUIPO	
Deliverable Year 4	Key enforcement judgments from EU Member States not participating in the project and from participating EU Member States no longer able to provide the information	180
	Updates of key enforcement judgments from non-participating EU Member States collected internally by the EUIPO	
		Total: 820

4.3. Information to be provided

The contractor will be required to submit the following information using the template provided (see Annex II.1). Tenderers should note that the contractor will be responsible for anonymising all personal data, as detailed in point 9.

i) Texts of key judgments related to the enforcement of IPR

A digital file with the full text of the judgment must be provided in PDF format. The digital file must be inserted into the template provided according to the instructions. The digital file containing the judgment should be named as follows: year of collection_number of the case_ISO 2 code of the country, e.g. 2016_ 28079370282010200044_ES.pdf'. The text of judgments will be provided in the original language.

ii) Summary of each judgment

The summary of the judgment should briefly describe the main facts of the case, the key legal issues related to the enforcement of IPR and the conclusions reached by the competent authority, as well as the relevance and importance of the judgment from the IPR enforcement perspective, e.g. what new trend in the jurisprudence is established by the judgment. The length of the summary must not exceed 2 500 characters (including spaces). The summary must be provided in English.

iii) Indexation of judgments with metadata

Indexation must include the following metadata: country, case number, ECLI, parties, date, court name, instance, nickname, language, keywords, IP rights, EU norms, other (national and international) norms, damages. Full instructions on how to provide metadata are available in Annex II.1 (Sheet 1 – Overview and Explanations).

4.4. Structure of the Deliverables

The contractor must submit all the deliverables using the Excel template provided by the EUIPO, which is available in Annex II.1.

The Excel template should be filled in strictly in accordance with the defined requirements (see Sheet 1 – Overview and Explanations). Any deviation from the requirements will make the table unsuitable to be uploaded in the eSearch Case Law database. The contractor should follow the requirements strictly (e.g. citation of EU and other - national and international - norms, indexation with keywords, etc.) and should not modify the template.

The deliverables must be technically accepted by the EUIPO's Project Manager.

5. Project calendar

The main deliverables per year of the activity are set out below. The timing is indicative and depends on the date of conclusion of the contract. The total duration of the tasks is 48 months from the signature of the contract.

Meetings and deliverables are described in the following table:

No	Meetings & deliverables	Timeline
1	On-line kick-off meeting between the EUIPO and the contractor to discuss the details of the activity. Submission of kick-off meeting minutes.	10 working days after the signature of the contract 10 working days after the kick-off meeting
2	Interim on-line meetings between the EUIPO and the contractor to discuss the progress of Deliverable Year 1.	Every two months until the completion of Deliverable Year 1
3	Deliverable Year 1 submitted to the EUIPO.	8 months after the kick-off meeting
4	Annual online meeting between the EUIPO and the contractor to discuss the launch and implementation of Deliverable Year 2.	To be defined by the EUIPO. The contractor will be notified at least 2 weeks in advance.
5	Interim online meetings between the EUIPO and the contractor to discuss the progress of Deliverable Year 2.	Every two months until the completion of Deliverable Year 2
6	Deliverable Year 2 submitted to the EUIPO.	6 months after the annual meeting specified in line 4
7	Annual online meeting between the EUIPO and the contractor to discuss the launch and implementation of Deliverable Year 3.	To be defined by the EUIPO. The contractor will be notified at least 2 weeks in advance.
8	Interim online meetings between the EUIPO and the contractor to discuss the progress of Deliverable Year 3.	Every two months until the completion of Deliverable Year 3
9	Deliverable Year 3 submitted to the EUIPO.	6 months after the annual meeting specified in line 7

10	Annual online meeting between the EUIPO and the contractor to discuss the launch and implementation of Deliverable Year 4.	To be defined by the EUIPO. The contractor will be notified at least 2 weeks in advance.
11	Interim online meetings between the EUIPO and the contractor to discuss the progress of Deliverable Year 4.	Every two months until the completion of Deliverable Year 4.
12	Deliverable Year 4 submitted to the EUIPO.	6 months after the annual meeting specified in line 10.

6. Payment

The payments will be linked to the EUIPO's approval of each annual Deliverable, with the exception of an interim payment which will be paid after the kick-off meeting.

- Interim payment of 10% of price for Deliverable Year 1 - after the kick-off meeting, upon approval of the kick-off meeting minutes.
- Payment 1 of 90% of price for Deliverable Year 1 – approval of Deliverable Year 1.
- Payment 2 of 100% of price for Deliverable Year 2 – approval of Deliverable Year 2.
- Payment 3 of 100% of price for Deliverable Year 3 – approval of Deliverable Year 3.
- Payment 4 of 100% of price for Deliverable Year 4 – approval of Deliverable Year 4.

7. Location of work

The activity will be implemented offsite, that is, not on the EUIPO premises.

8. Quality assessment of deliverables

The deliverables must be prepared in strict compliance with the quality requirements defined in these Technical Specifications. The summaries must be short and clear, with clearly indicated facts, substance and conclusions, as well as brief comments on the importance of the decisions from an enforcement perspective. The texts of the summaries must be proof-

read by a native English speaker before they are submitted to the EUIPO for comments and approval. The metadata must be provided strictly following the requirements defined in these Technical Specifications (Annex II.1), for example, following the list of keywords and defined structure for citation of legal norms.

The EUIPO will appoint a Project Manager to oversee this activity with respect to quality, completeness and timeliness. All deliverables must be submitted to the EUIPO's Project Manager.

Each deliverable will be subject to a quality assessment by the EUIPO according to the following grid:

Criteria	Very Poor	Poor	Good	Very Good	Excellent
Relevance	1	2	3	4	5
Compliance	1	2	3	4	5
Clarity	1	2	3	4	5
Completeness	1	2	3	4	5
Technicality	1	2	3	4	5

If the EUIPO finds that any of the quality criteria do not meet level 4, it will address this in writing to the contractor with a clear explanation of the result of the quality assessment. Unless a different date is indicated by the EUIPO, the contractor will have 10 working days from receiving the notification to propose a solution to the issues identified. The EUIPO has 10 working days from receiving the contractor's proposed solution to react on the acceptance or rejection of the deliverables in relation with the requested modifications. The contractor will then have 10 working days from receiving the EUIPO's feedback to submit an improved version of the deliverable.

The final quality assessment score, as fixed after the improvement process described in the previous paragraph, if relevant, may lead to a reduction in price in application of Articles II.17.5 and II.17.6 of the contract. The application of this mechanism is explained in the following table.

Final quality assessment score of the deliverable (based on the numerical average of the individual criteria scores)	Reduction in price
4 points (included) to 5 points	No reduction will be applied. The whole contractual amount for the relevant deliverable will be paid.
3 points (included) to 4 points (excluded)	5% will be deducted from the total price of the relevant deliverable.
2 points (included) to 3 points (excluded)	20% will be deducted from the total price of the relevant deliverable.
Under 2 points	50% will be deducted from the total price of the relevant deliverable*.

* Tenderers should note that the non-provision of a deliverable will not be subject to the quality assessment mechanism and, without prejudice to Articles II.17 and II.19 of the contract, will lead to non-payment of the full amount of the price of that deliverable. The Office reserves the right to consider that a deliverable given a quality score of below 1 point is assimilable to non-provision of that deliverable, if the latter is considered impossible to use in accordance with the requirements of these Technical Specifications.

The detailed quality assessment form with the guidelines for scoring is available in Annex II.2.

9. Requirements

The business language for this activity is English. The deliverables must be compliant with the characteristics defined in the previous sections, delivered according to the fixed deadlines and provided in English, except the texts of judgments which will be provided in the original language. All other documents will be in English.

The information collected will be made available in the EUIPO's eSearch Case Law database, 'National court judgments' section. The contractor must ensure that the content provided is not subject to any restrictions deriving from the rights of third parties, that is to say, that the judgments from national courts can be made publicly available in the EUIPO's eSearch Case Law database.

The content provided must comply with all applicable laws and regulations, such as personal data protection, copyright, publication of official documents, etc. The contractor will be responsible for anonymising all personal data if and when required, that is, relevant parts of the judgments containing sensitive personal or company data must be anonymised when required by the national legislation of a particular Member State. If the tenderer intends to use data which should not be published, this must be explicitly mentioned in the offer.

The intellectual property rights related to the information provided (such as the summaries of the judgments) will be considered to be the property of the EUIPO. The EUIPO will have all rights to use the information collected for the purposes related to the EUIPO's activities.

ANNEX II.1: TEMPLATE NATIONAL KEY ENFORCEMENT JUDGMENTS

(see separate file)

ANNEX II.2: QUALITY ASSESSMENT FORM

(see separate file)