



**TECHNICAL SPECIFICATIONS GOVERNING THE FRAMEWORK AGREEMENT
FOR THE APPROVAL OF SUPPLIERS FOR THE CONTRACTING OF THE
SERVICE OF MANAGEMENT OF THE REGISTRATION AND MAINTENANCE OF
PATENTS AND OTHER INDUSTRIAL PROPERTY RIGHTS FOR THE ENTITIES
THAT MAKE UP THE JOINT PURCHASING GROUP**

OPEN PROCEDURE - SUBJECT TO HARMONISED REGULATION

Exp. 01/2022

Description of the Framework Agreement: Framework Agreement: Service
Procedure: Ordinary
Procedure: Open
CPV: 85312320-8 Advisory Services
CPV: 70332300-0 Services related to industrial property
CPV: 79120000-1 Patent & Copyright Consulting Services

In the event of a discrepancy, the Spanish version will prevail.



1. PURPOSE OF THE TECHNICAL SPECIFICATIONS

The purpose of this tender is the regulation of the technical specifications corresponding to the Framework Agreement for the approval of suppliers for the contracting of the management service of the registration and maintenance of patents and other industrial property rights, owned or co-owned, or in those cases where there is a management entrustment.

This object is made up of the following lots:

- **LOT 1 - LIFE SCIENCES AND HEALTH:** Management of industrial property corresponding to the fields of pharmaceutical chemistry, biotechnology, bioengineering, diagnostics, medical devices, medical devices, medical devices, nutrition, health, nanobiotechnology, advanced therapies (stem cells, gene therapy, cell therapy, nanomedicine, regenerative medicine and tissue engineering).
- **LOT 2 - PHYSICAL SCIENCES AND ENGINEERING:** Industrial property management corresponding to the fields of electronic engineering, software, computer-implemented inventions and telecommunications, artificial intelligence, mechanical and industrial engineering, materials, chemical engineering, energy, nanotechnology, instrumentation, optics and photonics, quantum, robotics, food technology and environmental technology.

2. PARTICIPATING ENTITIES

The entities participating in this joint tendering procedure are:

- Centre for Research in Agricultural Genomics (CRAG)
- Centre for Genomic Regulation Foundation (CRG)
- Girona Biomedical Research Institute Dr. Josep Trueta Foundation (IDIBGI)
- Institute for Bioengineering of Catalonia Foundation (IBEC)
- Fundació Institut de Recerca de l'Hospital de la Santa Creu i Sant Pau (FIRHSCSP)
- Catalonia Institute for Energy Research Foundation (IREC)



- Institute of Agrifood Research and Technology (IRTA)
- Josep Carreras Leukaemia Research Institute (IJC)

Each of the participating entities is comprised of it and all the subsidiary entities where it has control. It is thus understood that any procurement based on this Master Agreement will affect the contracting entity and its entire group of subsidiaries.

The entities that may adhere to this Framework Agreement may be those that are recognized as "CERCA" centers, as well as other non-profit research entities, that show their interest in joining. Any adhesion that is intended to be made in this Framework Agreement after its formalization (no new adhesions are contemplated from the publication of the tender notice until its formalization), must be communicated by email to the address purchasing@carrerasresearch.org following the indications provided in the table-summary of characteristics of the Specification of Particular Administrative Clauses.

The award of the Framework Agreement does not give the right to the provision of services. This service will take place in the event that the approved suppliers and successful bidders of the Framework Agreement receive, under a contract based on a based contract, the corresponding orders from the participating entities. These orders will be adapted to the real needs of each of the participating entities and will be processed according to the indications defined in the Specific Administrative Clauses Specifications, as well as in the corresponding documentation for the formalization of the contract based on it.

3. SCOPE OF THE CONTRACT

The service that is the subject of this tender includes advice on protection, analysis and studies of patentability or prior patentability (for other types of Industrial Property, hereinafter "IP"), including the search in payment databases, preparation, preparation and processing of the patent registry, the preparation of administrative documentation, follow-up, notices and those steps that are necessary to ensure the correct registration, as well as the maintenance of patents and other IP rights, owned or co-owned or in those cases in which there is a management entrustment.



The terms used in this document relating to "patent" or "invention" and other related terms in the management of IP should be interpreted broadly to cover all forms of IP protection, as applicable in each case.

The scope of the object of the contract is structured in the lots indicated in **clause 1** of these Specifications and there is no limitation regarding the number of lots to be bid. In other words, each bidder may submit a bid for one or both lots. However, each tenderer may submit only one tender for each of the lots for which it is submitted.

3.1. Scope Exclusions

3.1.1. The following services are excluded from this tender procedure: management of trademarks and trade names, regulatory reports, legal services not expressly described in these Specifications, valuation of intangible technologies, accreditations, infringement (defense against infringements by third parties), IP management software for entities, management of web domains and content management on social networks, press releases or similar.

3.1.2. Also not included in the scope of this tender will be those IP advisory and management services that are in co-ownership with other institutions or companies in which it is required to contract the services of a supplier that has not been approved in this bidding procedure and that the choice of the provider does not depend on the entities participating in this Framework Agreement.

Entities participating in the Framework Agreement that are co-owners with other non-participants shall enter into a contract based on IP advisory and management services within this Framework Agreement, provided that the provider involved is one of the approved providers. It will be at the discretion and decision of the approved supplier whether the rest of the co-owner entities (not participating in the Framework Agreement) can obtain the same awarded contracting conditions that the entities participating in the Framework Agreement will obtain.

3.1.3. The possibility of excluding services resulting from the continuation of another service previously contracted with suppliers not approved in



the Framework Agreement is contemplated. This fact is technically justified because the life of a patent can last around 20 years, within which several procedures and/or processes can take place. In the event that the participating entities must contract these services independently of this Framework Agreement, it will be necessary for them to justify it in the new procurement procedure by including budgets, contracts or any other documentation that justifies the initiation of the procedures prior to the award of this bidding procedure.

3.1.4. Also excluded are those services whose execution has begun and are not completed.

3.1.5. The possibility of contracting the services offered by the Spanish Patent and Trademark Office, O.A. (OEPM) outside this Framework Agreement is contemplated. The SPTO is an Autonomous Body of the Ministry of Industry, Trade and Tourism that is responsible, by virtue of Article 2 of Royal Decree 1270/1997, for the administrative activity that corresponds to the State in the field of Industrial Property, as well as the development of actions aimed at raising awareness, promotion and use of Industrial Property in the different sectors of productive activity. The SPTO is a non-profit government body, whose mission is "To promote innovation and share its results as values and assets for differentiation and technological development", and promotes actions such as the Agreement between the SPTO and the Carlos III Health Institute, O.A., M.P., in the field of industrial property. (2023,2020,2016) which in fact directly affects several entities participating in this Framework Agreement.

In this sense, the possibility of contracting the services of the SPTO will be conditional on the suppliers approved in this Framework Agreement offering a higher amount for the services required. Taking into account that the SPTO has published on its website the rates and prices of its services ([SPTO Prices](#)), each participating entity will request a quote from the approved suppliers for the services to be provided and in the event that the offer is higher than the SPTO's prices, the contracting of these services may be carried out with the SPTO.



4. MINIMUM TECHNICAL REQUIREMENTS OF THE SERVICE

This paragraph applies **to the two lots** included in the tender.

The minimum services required in this area and to be provided by the successful bidders include the following matters:

4.1. Initial analysis and protection strategy:

Included are the minimum services in which the successful bidder evaluates the results of research, advises and provides support in the search for information related to the state of the art and the possibilities of protection. These minimum services are:

4.1.1. Potential Protection Analysis

The successful bidder will provide initial advice upon receipt of a new proposal for an invention or other types of IP (protection analysis) to decide whether there is subject matter that can be protected and/or transferred. In the case of an invention, it will advise whether it may make sense to register a patent and proceed with the patentability study. The successful bidder will prepare a report with the main conclusions of the analysis carried out. It is possible that the participating entity, at the time of managing a contract based on a based contract, expressly requests that such a report not be prepared and only an email with the details of the results of the analysis is necessary. If this is the case, a discount of at least 50% of the amount awarded for the non-preparation of the report must appear in the offer of the approved suppliers.

Deadlines: Within a period of no more than twenty (20) business days from the sending of the information by the participating entities, the successful bidder must provide a written response on the feasibility of the protection and the advisability or otherwise of proceeding with the study of prior or patentability based on the preliminary results analyzed.

4.1.2. Drafting of patentability studies

In the case of possible inventions, the successful bidder will prepare a report detailing the analysis of the patentability requirements in terms



of novelty, inventive step and industrial application, carrying out an exhaustive analysis of the state of the art (including both patents and scientific publications) in relation to the corresponding invention. In the case of other IP titles, the successful bidder shall prepare a report detailing the analysis of the validity and registrability requirements of the relevant IP title. The report shall include, at a minimum, an exhaustive analysis of the prior art in relation to the invention in question, the most important features of the proposal to be analysed and a summary of conclusions. This report may be modified or repeated up to two times if it is determined, by the participating entity, that it is not comprehensive enough to assess the totality of the relevant state of the art. If the successful bidder and/or the participating entity deem it appropriate, face-to-face meetings or teleconferences may be arranged between the patent technician and the inventors.

Deadlines: The successful bidder must issue the prior/patentability report within a period of no more than thirty (30) business days from the written request of the participating entities and the delivery of the necessary documentation so that the work can be carried out.

4.1.3. International Strategy Report

Preparation of a report analysing the countries in which it is recommended to protect the invention, in order to achieve the best possible protection based on the data obtained, the state of the art and the needs of the institution. It is possible that the participating entity, at the time of managing a contract based on a based contract, expressly requests that such a report not be prepared and only an email with the details of the results of the analysis is necessary. If this is the case, a discount of at least 50% of the amount awarded for the non-preparation of the report must appear in the offer of the approved suppliers.

Deadlines: The successful bidder must issue the report within a period of no more than fifteen (15) business days from the written request of the participating entities.



4.2. Drafting of memorandums or minutes, application, registration, extension, processing and renewal of IP title protection

Minimum services related to the drafting and management of IP registrations are included. These minimum services are:

4.2.1. Drafting of the protection and application reports for each invention

Preparation of the technical reports and documents required by the patent offices, complying with the technical requirements established by these offices, in order to submit the application for protection and achieve the best possible protection taking into account the data obtained, the state of the art and the needs of the institution. At a minimum, it should include:

- Preparation of the technical reports of priority patent applications and their submission to the corresponding offices. Processing during the priority year will include the overall management of the application.
- Possible formatting corrections and others arising after the presentation.
- Management of patent application abandonment.
- Protection by means of titles other than patents (know-how, copyright).

Deadlines: The successful bidder undertakes to draft the document within a period of no more than forty-five (45) business days from the express request for written drafting by the participating entities and the delivery of the necessary documentation for drafting.

4.2.2. International Extension Strategy Analysis and Report

Preparation of a report to evaluate and analyze the search reports (EESR, IBI, ISR, among others) issued by the patent office of the priority country and propose an international extension strategy ensuring that the written claims protect the invention that they want to introduce into the market.



Inform the participating entity, client or whoever corresponds, about the deadlines for the extension depending on the market of interest.

It is possible that the participating entity, at the time of managing a contract based on a based contract, expressly requests that such a report not be prepared and only an email with the details of the results of the analysis is necessary. If this is the case, a discount of at least 50% of the amount awarded for the non-preparation of the report must appear in the offer of the approved suppliers.

Deadlines: The successful bidder must issue the report within a period not exceeding thirty (30) business days from the written request of the participating entities.

4.2.3. Adaptation of memories

According to the needs of the participating entities, the successful bidder will rewrite the technical report and adapt it depending on the office where the extension of the technical report is to be deposited. Likewise, if required, the appropriate translations will also be carried out by the winning company, as indicated in section 6 of these specifications.

Deadlines: The successful bidder must comply with the deadlines stipulated by the office where the extension of the technical report is to be deposited, provided that it receives, from the participating entity, the necessary documentation for the drafting.

4.2.4. Extension of protection (PCT or others).

Processing of the extension of protection. All necessary actions will be taken to extend protection in the relevant patent office, including the drafting of supplementary letters (such as PCT direct letters). It must include at least:

- Full PCT International Patent Prosecution
- PCT Drafting and Filing
- PCT Direct Commentary Writing



- Communication of formal official action, preparation and submission of response in PCT
- Communication of the International Search Report (IBI)
- Application for and preparation for the International Preliminary Examination
- Communication from IPER.

Deadlines: The successful bidder will inform the participating entities in writing in sufficient time of the actions to be carried out for the correct maintenance of the industrial property titles. In the case of preparation and drafting, the maximum period will be twenty-five (25) business days. When there is a deadline for executing an action, the communication shall be made at least two (2) months in advance, except in the case where the official communication of the patent offices does not allow it. In this case, the delay must be justified.

4.2.4.1. Management of the International Preliminary Examination Report (IPER):

The management of the IPER will be considered a service in itself due to its high cost in fees and the low frequency of its use.

It should include at least a thorough analysis of the report, a summary of the main findings and a proposal for action.

The successful bidder will prepare a report with the main conclusions of the analysis carried out. It is possible that the participating entity, at the time of managing a contract based on a based contract, expressly requests that such a report not be prepared and only an email with the details of the results of the analysis is necessary. If this is the case, the offer of the approved suppliers must include a discount of at least 15% of the amount awarded for the non-preparation of the report.

Deadlines: The successful bidder must issue the report within a period not exceeding thirty (30) business days from the written request of the participating entities.



4.2.5. Patent applications in national phases

Processing of the extension of protection in national phases. All the necessary actions will be carried out to submit the application for protection, extension and/or defense in international protection examination processes before the corresponding patent office.

At a minimum, the successful bidder must comply with the following requirements and deadlines: inform of the formalities necessary for entry into national phases sufficiently in advance (at least two (2) months prior to the expiry of the deadline for entry into the particular national phase) to be able to make decisions on applications and countries.

At a minimum, it should include:

- Filing the patent with the appropriate offices
- Search Reports Communications and Official Actions
- Modifications to the report to adapt them to local practice
- Operating Declarations
- Concessions
- Validation management in Europe
- Opt-out management
- Unitary Patent Management
- IDS Preparation & Submission
- Drafting and filing of divisional patents
- Closure of Files and/or Transfer of Files
- Post-grant opposition procedures
- Resources
- Comments to third parties before the European Patent Office or similar proceedings in other jurisdictions



4.2.6. Procedures related to the follow-up and defence of the file until its concession and maintenance are achieved

The successful bidder will respond to all communications from the office where the procedure was initiated, subject to the agreement of the participating entity, in cases where the need for prior compliance is justified. This will include the response to official actions and all the necessary procedures, among others: study, preparation and drafting of replies to official actions, reports on the state of the art, examination reports and competitions, adaptation of technical reports to the requirements of the different national or regional offices.

The necessary actions and procedures will be carried out to keep the patents in force and to make the payment of the fees that are required by the patent offices and according to the technical requirements established by said offices.

Any response provided by the successful bidder that does not have the written agreement (for example, by email) of the participating entity and involves an error, incident, sanction or similar, will be the responsibility of the winning company, which must assume the corresponding damages, as well as any timely management for its resolution and/or correction.

At a minimum, it should include:

- Management of annuities necessary to keep the file in force
- Transfer of Rights, Licenses and Ownership Management
- Management of change of name owner or inventor
- Communications Management
- Oral hearings, both in examination and competition (study, preparation, and related procedures)

Deadlines: The successful bidder will inform the participating entities, in writing and with sufficient time, of the actions to be carried out for the correct maintenance of the industrial property titles. When there is a deadline for executing an action, the communication shall be made at least two (2) months in advance. In addition, the successful bidder must



notify the participating entities of any communication received from the patent offices within a period not exceeding thirty (30) days.

4.3. Writing Freedom to Operate (FTO) Reports and similar studies

The successful bidder will draft reports that, for a given technology, will allow the assessment of whether the use or commercialization of the technology infringes the Industrial Property rights of third parties and other legal restrictions that may exist around the Industrial Property. It includes, among others: freedom of operation reports, preparation of written observations on own or third-party IP titles, studies on the invalidity of IP titles.

Deadlines: The report will be delivered within a period of no more than forty-five (45) business days from the written request by the participating entities and the delivery of the necessary documentation for the drafting.

4.4. Other special conditions

- The successful bidder must meet with representatives of the participating entity that formalizes a contract based on this Framework Agreement, either electronically and/or in person at the participating entity's premises.

Preferably telematic meetings will be held, but for those cases where the matters to be discussed in these meetings cannot be carried out through telematic procedures, the meeting must be held in person.

In cases of conflicting interests, the request for a meeting by the participating entity will prevail. In the case of any face-to-face management that is required within the framework of the services specified above, no additional or extraordinary cost will be accepted to the prices awarded. The telematic format will prevail for meeting requests ahead of the face-to-face one.

- The successful bidder must comply with the maximum delivery times established in these technical specifications, as well as with the reduced delivery times offered as an improvement, if any. In case of delay, the participating entity may apply the pertinent penalties that are defined in the Specification of Particular Administrative Clauses and, in accordance with the provisions of the Public Procurement Law.



- At any time that a participating entity requires it, the issuance of a report may be requested with the data of all the patents managed by the successful bidder, including the bibliographic data, the status of each patent, the actions that are pending to be carried out, and the corresponding deadlines: This report must be delivered by the successful bidder. at no additional cost, within one (1) month from the day following receipt of the request. A maximum of two (2) annual reports may be requested from each successful bidder.
- Once the Framework Agreement or the contracts based on this tendering procedure have been finalised, the successful bidder must ensure, in proactive collaboration with all the parties involved, the correct transfer of the service, as indicated in **clause 6** of these specifications; consequently, of the active files and the various relevant information, to the new successful bidder in the event that it is different. This collaboration will continue for as long as necessary until the transfer of the service is successfully completed under the agreement of the IJC contract manager.
- The successful bidder will carry out the translations of documents that may be requested by the industrial property offices for the correct processing of IP rights. These translations will be made in the languages required by the corresponding industrial property offices. The cost of these translations must be established in the contract based on the amounts awarded.
- All reports, studies, reports or other documents will be written in English by default, and may alternatively be required to be written in Spanish or Catalan.
- For the resolution of computer incidents, the successful bidder will have the obligation to inform within a period of no more than one working day (from the moment the incident occurs) and by email to the contact person of the participating entity that has formalized a contract based on it, communicating the incident that occurred in the development of the contractual services. indicating, at least, the time at which the incident occurred, what type of incident, description of it, reason why it occurred and estimated time of resolution.



- On a quarterly basis, successful bidders must submit to the person responsible for the IJC detailed information on the volume of purchases made from their company, indicating the participating entity that has made them, the services contracted, the dates of formalization of the contracts based, as well as their duration (in months), prices or discounts formalized and the total amount of the contract based. This information will be sent to the following e-mail addresses:
 - innovation@carrerasresearch.org
 - Purchasing@carrerasresearch.org

5. MINIMUM REQUIREMENTS OF THE TECHNICAL OFFER

This paragraph applies **to the two lots** included in the tender.

For each lot for which a bid is submitted, the tenderer must attach a **service organisation report** describing the methodology to be used and allowing the correct execution of the object of the service to be contracted. This report must include, at least, the following sections and information:

- **Work plan:** Description of the methodology for organizing the work, which at least includes the procedure for designating the responsible personnel, schedules, personnel who will be part of the work team, technological resources and monitoring indicators.
- **Contingency plan:** Description of the tenderer's responsiveness in the event of:
 - i. Need to reinforce the workforce or make substitutions due to absence, holiday periods or, in extraordinary or unforeseen situations, indicating how the transfer of knowledge and functions will be carried out to ensure that the service will continue to be provided correctly.
 - ii. Need to replace a member of the work team at the request of the participating entity when, at the request of the latter, it is requested in writing and justifying the reason or causes of the request for substitution, such as, for example, the adequate achievement of objectives.



- **Control and monitoring plan:** Description of the process of monitoring the files, work meetings, communication mechanisms with the participating entity and periodic reports made by the winning company.
- **Quality plan:** Description of the processes and measures in place to guarantee the quality of the provision of the service, both in terms of the work of studying, drafting and defending patents and the work of managing files and controlling deadlines.

6. RETURN AND TRANSFER OF SERVICE

This paragraph applies **to the two lots** included in the tender.

Before the end of the term of the services formalized in the contracts based on this Framework Agreement, the successful bidder must proceed to the return and transfer of the service of all those files that have been processed during the term of the contract or are in progress and pending completion.

These tasks will be at the request of each participating entity and the successful bidder must attend and carry out the appropriate actions to ensure the correct transfer of the service. It is possible that the successful bidder must collaborate together with the new companies awarded the new contracts based on the formalized contracts and guarantee that all the information (such as, for example, documentation, files or files, degrees, among others) has been transferred to allow the correct transition and continuity of the service.

At least the bibliographic data of the patents in each country, the actions and deadlines to be carried out, the text files of the reports as submitted, as well as the modifications made in the European Office or the Spanish Office or other offices of other countries, will be transferred to the new successful bidder. and data from correspondents in each country. For patent applications that have not yet been published, all documents submitted and all notifications received, and reports that have been made, will also be transferred.

Once this information and documentation has been transferred, the successful bidder will await the agreement of the participating institution and the new successful bidder before proceeding to transfer responsibility to the new successful bidder through the change of representative to the European Bureau,



as well as to the different offices in other countries and with correspondents. Once the agreement of both parties has been received, it will proceed to make the change of representative by sending the change communications to the European Office and the correspondents, within three (3) working days.

In order to validate this process, it will be necessary for the successful bidder to issue a report (or return certificate) at the end of the transfer process, where at least it will indicate the information, data, files that have been transferred, and attach a copy of the change of representative made to the European Office and to the correspondents.

This return certificate (or report) will be sent to the participating entity and the new successful bidder, on the same day that the change of representative is completed, and on the same day the responsibility for the files will pass to the new successful bidder.

- The participating entity, or whoever it designates, will be responsible for coordinating or supervising the return of the entire contract, managing this activity with the incoming and outgoing service provider and must give its approval to terminate the contract.

1. Data portability

Portability means that the provider must be obliged, when the contract can be terminated or at the end of the service, to deliver to each participating entity, together with the service return plan, all the bibliographic data of the files (numbers, dates, owners, inventors, etc.) as well as the actions and deadlines, in editable format, for example, an Excel-like spreadsheet.

In Badalona, 22 March 2024

Evarist Feliu Frasnedo

Contracting Authority