

Invitation for
Expression of Interest (EOI)

for

Empanelment as Intellectual Property Rights (IPR) Consultant

With

Indian Institute of Technology Hyderabad



[This document is meant for the exclusive purpose of submission of EOI and shall not be transferred, reproduced or otherwise used for purposes other than that for which it is specifically issued].

Indian Institute of Technology Hyderabad (IITH), located in Kandi, Sangareddy, Telangana - 502284, is an Institute of National Importance, incorporated under the Institutes of Technology Act, 1961 (Act 59 of 1961), as amended by the Institutes of Technology (Amendment) Act, 1994. It is a leading technical institute in India

1. INVITATION OF EXPRESSION OF INTEREST

IITH is in the process of forming a Panel of Consultants and inviting applications from the IP consultant firms meeting requirements prescribed in **3.1** for providing “**IPR Consultancy Services**” on case-to-case basis.

2. SCOPE OF WORK

IITH is pursuing R&D activities through reputed organizations/laboratories in India/abroad in various Thrust Areas. The ongoing R&D Projects are at various stages of execution and the options to secure IPR are being evaluated at different stages.

IITH seeks to engage a specialized IP firm to provide comprehensive consultancy services for securing intellectual property rights (IPR) across its ongoing and upcoming R&D projects, covering patents, trademarks, copyrights, and other related IPR areas

The scope of work (SOW) for the consultant will include the following

a. Patent Search and Analysis:

- Conduct thorough prior art searches to identify existing patents, publications, and any other relevant information.
- Provide a detailed patentability analysis and opinion based on search results.
- Perform landscape analysis to understand the existing patents in the field of interest.

b. Patent Drafting:

- Draft patent specifications, including detailed descriptions, claims, drawings, and abstracts.
- Ensure the patent draft is in compliance with the relevant patent office guidelines.
- Revise and refine drafts based on feedback from the client and patent office.

c. Patent Filing:

- File patent applications (provisional, complete, PCT, or national phase) with the relevant patent offices.
- Handle all formalities related to patent filing, including preparing and submitting required documents.
- Monitor deadlines for filing patent applications and ensure timely submissions.

d. Patent Prosecution:

- Respond to office actions and objections raised by patent examiners.
- Provide strategic advice on overcoming rejections and objections.
- Attend hearings and represent the client before the patent office if required.
- Regularly update the client on the status of the application.

e. Patent Portfolio Management:

- Assist in developing and managing a robust patent portfolio strategy.
- Conduct periodic reviews of the patent portfolio to assess the strength and relevance of patents.
- Provide recommendations for maintaining, licensing, or abandoning patents.

f. Patent Infringement Analysis:

- Conduct infringement analysis to determine if a third party is infringing on the client's patents.
- Provide advice on enforcement strategies, including potential litigation or alternative dispute resolution.
- Assist in drafting cease and desist letters if necessary.

g. Freedom to Operate (FTO) Analysis:

- FTO searches to assess the risk of infringing on existing patents before launching a product.
- Provide a detailed FTO opinion and suggest strategies to mitigate any risks identified.

h. Patent Commercialization:

- Provide advice on strategies for monetizing patents through licensing, sale, or partnerships.

- Assist in drafting and negotiating licensing agreements and other related contracts.
- Evaluate potential licensing opportunities and partners.
- i. **Training and Advisory:**
 - Conduct training sessions for the client's team on patent-related matters, including patent laws, procedures, and best practices.
 - Provide ongoing advisory services on patent strategy and management.
- j. **Regular Reporting and Communication:**
 - Provide periodic reports on the status of patent applications and other ongoing activities.
 - Maintain regular communication with the client, including meetings and updates on key developments.
 - Ensure confidentiality and security of all client information and documents.

Deliverables

1. **Patent Search Reports:**
 - Detailed reports on prior art searches, landscape analysis, and patentability assessments.
2. **Drafted Patent Applications:**
 - Complete drafts of patent specifications ready for client review and filing.
3. **Filed Patent Applications:**
 - Copies of all filed patent applications, along with acknowledgment receipts from the patent office.
4. **Response to Office Actions:**
 - Written responses to office actions, including legal arguments and amendments to claims.
5. **Infringement and FTO Opinions:**
 - Comprehensive infringement analysis and FTO opinions with strategic recommendations.
6. **Portfolio Review Reports:**
 - Periodic reports on the status and strength of the patent portfolio, with recommendations for action.

7. Commercialization Strategy Documents:

- Strategy documents and agreements related to patent commercialization efforts.

8. Training Materials:

- Materials and presentations used in training sessions provided to the client's team.

9. Regular Progress Reports:

- Monthly or quarterly reports detailing the progress of all ongoing patent-related activities.

10. Meeting Minutes and Communication Logs:

- Detailed records of all meetings, communications, and actions taken during the engagement.

Additional Requirements

- **Compliance:** The IP consultant firms must ensure that all deliverables comply with the relevant laws, regulations, and guidelines of the patent offices in which applications are filed.
- **Timeline:** Each deliverable must be completed within the specified time frame as agreed upon in the contract.
- **Confidentiality:** The IP consultant firms must adhere to strict confidentiality agreements regarding all client information.

3. MINIMUM QUALIFYING REQUIREMENTS

This empanelment is open to eligible IP Consultant Firms that fulfill the following minimum qualifying requirements and provide satisfactory evidence in support of the same.

3.1 Qualifying Requirements for Consultants:

Sl. No.	Minimum requirement for submission of Expression of Interest	Remarks
A	Should have Company/LLP/Firm registered with Govt. India or respective state govts.	Please mention registration number and date (please attach a copy of the Registration/Incorporation Certificate)

Sl. No.	Minimum requirement for submission of Expression of Interest	Remarks
B	Experience in IP Field	A minimum of 20 years as of 31-03-2024, including experience in IP litigation, IP commercialization, and handling IP-related legal proceedings.(Annexure-II)
C	Employees in Organization	50+ Across all domains. please attached a proof of document. Submit the Annexure V.
D	Area of expertise	Mechanical, Biomedical, Biochemistry, Civil, Electrical, Electronics, Computer Science, Mathematics, Chemical, AI & ML (Annexure V)
E	Empaneled with minimum two other IITs	Please submit proof of empanelment with IIT. (In case of no empaneled letter, then must be filed 40 patent application for each IIT after 2021 January to current date) Annexure VI, VII
F	Time Duration	Drafting of an application needs to complete within 20 days from date of sharing the Invention Disclosure Form
G	Must have patent searching software	Please submit valid proof
H	IP Should have a Functional office in Delhi/ NC/ Hyderabad / Aboard	Please submit details of offices at different locations (address along with designation of the person in charge visiting card, contact details) and Certificate from Authorized Signatory as per the Format attached at Annexure- IV.

4. CRITERIA FOR EMPANELMENT

The minimum eligibility criteria outlined in para 3.1 will serve as the primary basis for empanelment. Each submission will be evaluated based on the quality, relevance, and depth of experience in the specified domains

5. Price Listing for each Stage/Activity

Please note that the listed fees are subject to periodic review and adjustment in accordance with changes in the legal landscape, inflation, or mutual agreement between IITH and the engaged IP firm.

The Charges are exclusive of GST or corresponding taxes.

PARTICULARS	PROFESSIONAL FEES in INR
Patentability Search	8,000/-
Invalidity/Validity opinion	25,000/-
FTO/Clearance Opinion	25,000/-
Infringement Opinion	35,000/-
Patent Landscape Study	40,000/-
Provisional Specification	9,000/-
Complete Specification after Provisional	14,000/-
Complete Specification (No Limit on Pages & Claims)	18,000/-
Filing as-is basis (Provisional or Complete)	7,000/-
Preparing Flowchart Drawings	No Charges
Preparing Schematic Drawings	No Charges
Proof of Right	No Charges
Power of Attorney	No Charges
Request for Examination	1500/-
Request for early Publication	1500/-
Reporting of Examination Report with our comments, preparing and filing of Response thereof	12,000/-
Request for Extension of Time maximum of 3 months	1500/-
Adjournment of Hearing	1500/-
Attending Hearing and filing of Written Submission	12,000/-
Amendment of a Patent application with respect to change of name, address, nationality and/or address of service	2000/-
Amendment of specification before Grant	3000/-
Amendment of specification after Grant	3000/-
Request for rectification of clerical error	3000/-

Substitution of Applicant(s) before grant	3000/-
For entry/alternation of Entry in the patent register	3000/-
For changing of address of service or entry of additional address of service	1000/-
Request for inspection of register	1000/-
Submitting details of corresponding applications (Form – 3)	1000/-
Submitting copies of foreign search/examination reports	1000/-
Request for a duplicate Patent Certificate	2000/-
Preparing a Petition not otherwise provided for	2000/-
Checking and reporting of Publications	
Application for Post Dating	2000/-
Request for Obtaining Certified Priority Document up to 30 pages	2000/-
Request for Obtaining Certified Priority Document beyond 30 pages	2000/-
Request for certifying office copies	2000/-
Petition for late filing of documents	2000/-
Stamping and Notarization of documents	1000/-
Executing abandonment instructions	No Charges
Filing a request not otherwise provided for	2000/-
Reviving a Patent under Restoration period when prior instructions were towards abandonment.	1000/-
Application to add/modify inventors in the Application OR in the patent Certificate (before grant)	2000/-
Application to surrender a Patent	2000/-
Preparing and Filing a PCT Application	15,000
Handling the PCT application from entering the National Phase till grant	5,000
Reviewing Written Opinion of International Searching Authority (WO-ISA), providing comments and filing Informal comments and/or Article 19 amendments	12,000/-

Preparing and filing Demand for International Preliminary Examination (IPE), along with Article 34 amendments	10,000/-
Preparing of supporting documents and filing of Industrial Design	4000/-
Responding to Office actions- Industrial Design (FER Reply or Hearing)	4000/-
Preparing of supporting documents and filing of Trademark	4000/-
Responding to Office actions- Trademark (FER Reply or Hearing)	4000/-
Preparing of supporting documents and filing of Copyright	4000/-
Responding to Office actions- Copyright (FER Reply or Hearing)	4000/-

6. GENERAL INFORMATION

- a) The submission of an application, even if all eligibility criteria are met, does not guarantee empanelment with IITH. The final selection will be based on a detailed evaluation of the application, the firm's capabilities, and their strategic fit with IITH's IP objectives
- b) IITH reserves the right to modify/relax the eligibility criteria in its sole discretion.
- c) IITH reserves the right to summarily reject the Applications at its sole discretion without assigning any reason.
- d) Application may be rejected for any of the reasons (i) not submitted in the prescribed format or (ii) do not meet any of the eligibility criteria or (iii) not accompanied with requisite documents/information or (iv) incomplete in any respect.
- e) IITH reserves the right to verify/cross check the information furnished/ submitted by the applicant.
- f) Panel may be reviewed after three years from the date of order as per the requirement at the discretion of the IITH subject to approval of competent authority.
- g) Empanelment of the IPR Firms would serve in all IPR related matters.
- h) Mere empanelment of the Consultants in IITH does not guarantee any award of work/assignment by IITH.
- i) IITH reserves the right to categorize the IP Consultant Firms in different categories depending on its requirement and the profiles of the Resolution

Professional and no request shall be entertained from any IP to be part of any particular category.

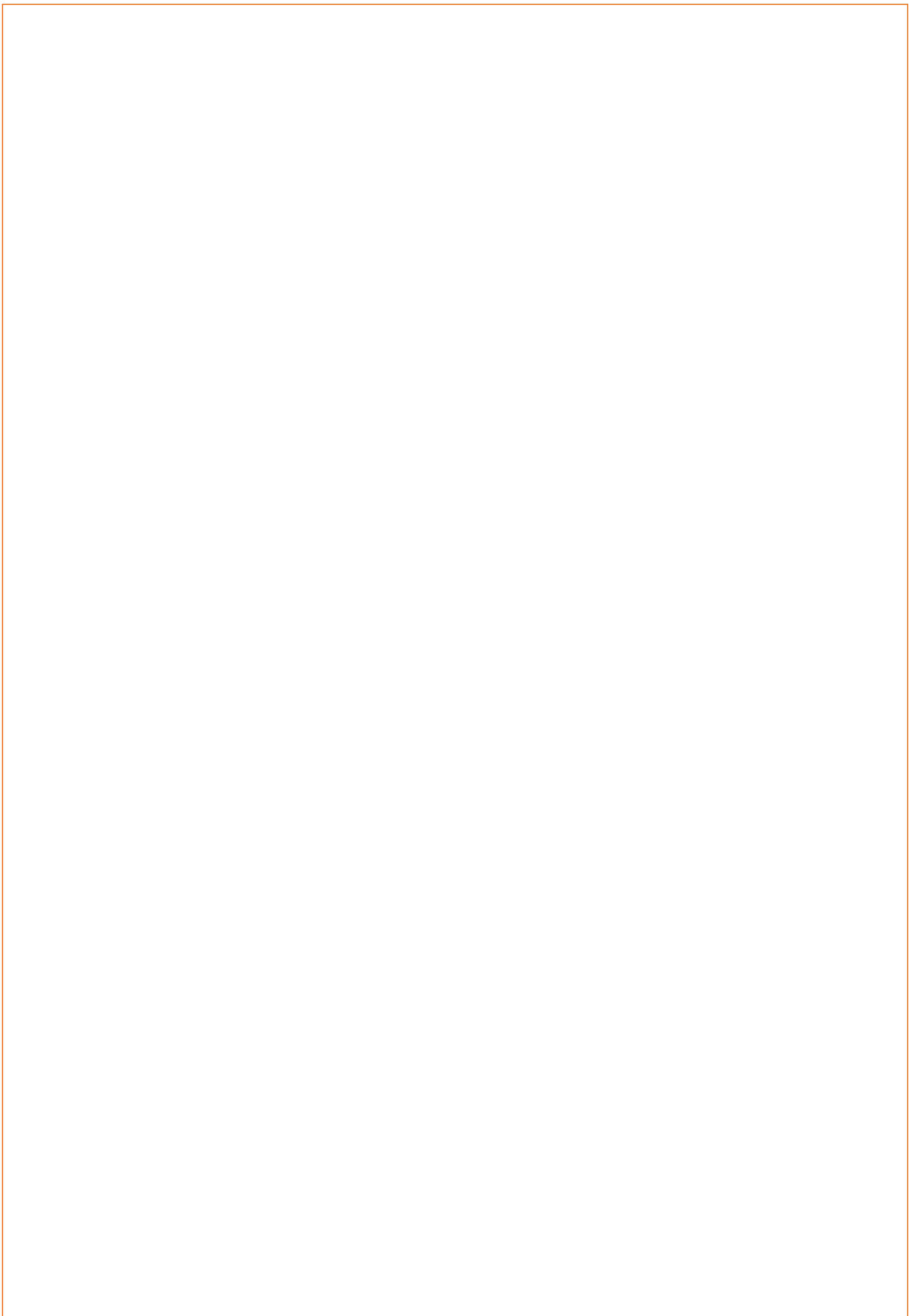
- j) Any change which is material to the empanelment criteria, shall be immediately informed to IITH and IITH reserves the right to review any empaneled IP subsequently in case any Managing Partner/IP(s)/associated firm moves/ leaves/withdraws association with IPE/firm.
- k) Within the tenure of panel, if any IP Consultant Firm found to be blacklisted by any IIT or any other organization where he was empaneled, he would be deemed blacklisted from that moment and would not be considered for fresh empanelment.
- l) The Consultant shall furnish any information as required by IITH regarding selection within 7 days of such demand including during the tenure of empanelment.
- m) The IP Consultant Firms is expected to carry out its assignment with due diligence and in accordance with prevailing standards of professional ethics in all respects, related other laws and enrolling/registering Authority. IITH may, however, prescribe other liabilities depending on the requirement in each case without any restriction on their liability as per the applicable law.
- n) The prices offered and agreed by both the parties shall be valid for a period of two years. No price escalation shall be entertained by the Client for any reasons, whatsoever, it may be, during the currency of the contract.
- o) The Contractor shall raise invoice by referring the purchase/work order of the IITH after successful delivery of the ordered material. IITH shall make all endeavors to make payment as early possible from the date of receipt of such invoice.
- p) All fields are mandatory to be filled and self-attested supporting documents should also be provided.

7. HOW TO APPLY:

Interested and eligible IP Consultant Firms may submit their Application Form for the empanelment with IITH as Consultant to provide “IPR Consultancy Services”.

- a) The Consultant/IP Firm abide by and meet all the above criteria minimum qualifying requirements, along with the profiles of the Partner, IP(s) and other team members clearly specifying the names of the projects handled.
- b) The Consultant/Firm has not been blacklisted due to deficiency of services by any of the IIT or any other Institutions.

The Application Form duly filled in, along with all supporting documents/information should be submitted through e-mail i.e. fic.ipfc@iith.ac.in by looping office.ip@iith.ac.in superscribing as “Expression of Interest for Empanelment with IITH as **“IPR Consultant Services”**”



APPLICATION:

To
The Director,
Indian Institute of Technology Hyderabad
Kandi, Sangareddy, Telangana
PIN-502284

Dear Sir,

With reference to the advertisement dated _____ and EOI placed on IITH website we wish to apply for empanelment with Indian Institute of Technology Hyderabad as IP matters with _____. The information sought for empanelment is given below.

A. Details of the IP Firm

- a) Name of the Firm
- b) Address:
- c) Point of Contact for Services:
- d) Contact No(s):
- e) E-Mail
- f) Alternative E-Mail:
- g) Number of Partner in the firm as per Annexure V.

Other Details (In case of IP the following details may be given with respect to the firm whose support has been identified at B2 above.

1. Details of the Work Experience in terms of number of cases for the following (In the format mentioned in Annexure II):
2. Names of the IITs or other Institutions where Empaneled as IP. Letters or any other confirmation (ensuring appointment) by the empaneling authority are to be enclosed as per Annexure VI.
3. Details of Functional offices at different locations as per (Annexure IV).
4. Details of following (If applicable): GST No: PAN:

C. Certification

We accept all the terms and conditions mentioned in the invitation of EOI as per certificate placed at Annexure I.

Declaration

I hereby declare that I have verified the details indicated above and also confirm that all the information submitted is true to the best of my knowledge.

(Signature _____)

Name: _____)

(Authorised Signatory)

(With seal)

On the letter head of the applicant

ANNEXURE I

Letter of Acceptance

To

The Director,

Indian Institute of Technology Hyderabad.

Kandi, Sangareddy, Telangana State

PIN-502284

Dear Sir,

- 1) We hereby propose to offer ourselves for Empanelment as Consultant with IITH as outlined in your invitation for Expression of Interest.
- 2) we have understood the instructions, minimum qualification and empanelment eligibility criteria and the terms and conditions mentioned in the Expression of Interest furnished by you and have thoroughly examined the detailed scope of work laid down by you and are fully aware of nature and scope of work required.
- 3) We hereby confirm our acceptance and compliance to the provisions and terms and conditions contained in the invitation for Expression of Interest.
- 4) We certify that all the information provided in our Application along with annexures, including the information regarding the partner(s), IP(s) and other members, is true. We understand that any misstatement in the Application (even if found later) may lead to disqualification or removal from the Panel. We also understand that in such a case we may be debarred for future assignments with IITH for a period which may be deemed necessary by IITH in its absolute discretion.

Yours faithfully,

Signature.....

Name.....

Designation.....

Date.....

Place.....

On the letter head of the applicant

Annexure II

Details of the Work Experience

Sl. No.	Name of the IIT or any other Institute/Organizations	No. of Applications filed since engaged by IIT or any other Institute	Attach copy of letter from the appointing Authority regarding award of the assignment(If any)
1			
2			
3			
4			
n			

Copy of letter from the appointing Authority regarding award of the assignment must be attached

On the letter head of the applicant

(Annexure IV)

Certificate regarding functional offices

To

The Director,

Indian Institute of Technology Hyderabad.

Kandi, Sangareddy, Telangana State

PIN-502284

Dear Sir,

Dear Sir(s),

I/We certify that we have a functional office at Delhi /NCR as per the details given below:

Sr. No.	Location/ city	Address	Name of Incharge	Designation of In-charge	Visiting cards attached
1					Yes/NO
2					Yes/NO
3					
N					

Yours faithfully,

Signature.....

Name.....

Managing Partner/Authorised Officer

(With Seal)

Date:

Place:

On the letter head of the applicant

Annexure V

Duly self-certified (by Managing Partner/Authorized Signatory) of the Firm giving support to the IP

To
The Director,
Indian Institute of Technology Hyderabad.
Kandi, Sangareddy, Telangana State
PIN-502284

Dear Sir(s),

- 1) I/We certify that we as a firm will provide the support required for carrying out the “IPR Consultant Services”.
- 2) The support will continue during the continuity of the empanelment with IITH.
- 3) I/We undertake that after IITH empanels the applicant IPR we shall not withdraw the above support without prior permission of IITH.
- 4) We agree that IITH may at its discretion permit, depending upon the status of engagement as a Consultant for any specific assignment, any modification in the above support with condition(s).
- 5) Details of the Partners/IP experts associated with our Firm are as follows:

Sr. No	Name of the Partner/IP Expert	Relevant field of Partner/IP Expert	Years of Association of the Partner/IP Expert with the Firm	Total Experience of Partner/IP Expert	Highest Qualification of Partner/IP Expert
1					
2					
3					
n					

Yours faithfully,

Signature.....

Name.....

Managing Partner/Authorised Officer

(With Seal)

Date:

Place:

On the letter head of the applicant

Annexure VI

Duly self-certified by the IP as the case may be applicable

Details of the Empanelment/Appointment by IIT or Others.

Sr. No.	Name of the Institution	Whether IIT or Other Institute	Year of empanelment/appointment	Self-attested copy of the empanelment letter or any other letter/ written confirmation by the empaneling/appointing authority attached
1				Yes/No
2				Yes/No
3				Yes/No
n				

Yours faithfully,

Signature.....

Name.....

Managing Partner/Authorised Officer

(With Seal)

Date:

Place:

On the letter head of the applicant

Annexure VII

Details of the Application filed for IIT/IISC in case of No Empanelment

Sr. No.	Name of the IIT	Application Number	Year of Filing
1			
2			
3			
n			

Yours faithfully,

Signature.....

Name.....

Managing Partner/Authorised Officer

(With Seal)

Date:

Place: