Appendix 2 to the ToR

Case no.: **DZ.271.11.2024**

**Description of the subject of the Contract (Contract Subject Description, CSD)**

**“Provision of patent attorney services for Łukasiewicz – PORT within the Virtual Research Institute”.**

I. The Subject of the Contract is the provision of legal services in the field of intellectual property protection, in particular obtaining patent protection and know-how protection, as well as the provision of strategic advisory services in the field of intellectual property protection in domestic and foreign markets for the Virtual Research Institute managed by the Contracting Authority – Sieć Badawcza Łukasiewicz – PORT Polski Ośrodek Rozwoju Technologii (Łukasiewicz Research Network – PORT Polish Centre for Technology Development in the field of Medical Biotechnology with particular emphasis on mRNA technology. The Contracting Authority performs the Subject of the Contract as the Managing Entity acting for and on behalf of the State Treasury – the Minister of Education and Science on the basis of the contract for the management of the Virtual Research Institute (*Wirtualny Instytut Badawczy*, WIB).

The objective of the Contract is to provide legal support to the Contracting Authority in the development of a strategy for the protection of individual Intellectual Properties (IPs) created under the projects of the Virtual Research Institute, to obtain optimum patent protection for them on selected domestic and foreign markets (e.g. the United States, China, Japan, Germany, France, Italy, the United Kingdom), including advising the Contracting Authority on the selection of optimum protection and advising on tasks performed in the area of commercialisation and other forms of transfer of research and development results to the economy in the field of Medical Biotechnology with particular emphasis on mRNA technology.

The Subject of the Contract includes services of patent attorneys in conducting new and continuing ongoing patent proceedings before the Patent Office of the Republic of Poland and before foreign patent offices, including the European Patent Office (EPO), the United States Patent and Trademark Office (USPTO), for inventions applied for under national, international PCT and European procedures.

By IP, the Contracting Authority means intellectual property, which it ultimately wants to cover with the broadest possible protection of intellectual property rights and know-how.

**II. The Subject of the Contract includes, in particular:**

1. Development of a strategy for the protection of intellectual property, including an analysis of possible scenarios and selection of the optimal protection path for the Contracting Authority, taking into account the market situation, together with the financial and legal consequences. By intellectual property rights protection strategy, the Economic Operator means receiving a developed action plan aimed to obtain the widest possible protection for intellectual property rights and know-how and to enforce them, taking into account geographical and technological aspects and cooperating with the Economic Operator on an ongoing basis in order to deliberately obtain the widest possible protection for intellectual property rights. The strategy should outline, inter alia, an analysis of possible means of protection, identification of optimal solutions, cost estimates, identification of jurisdictions, etc.
2. Preparation of a state of the art research report containing an analysis of the solutions given in the qualified patent descriptions together with an opinion on the patentability of the solution.
3. Preparation of “freedom to operate” (FTO) analyses for selected IPs or IP families created in WIB projects in order to, inter alia, determine whether it is possible to place a given solution on the market (e.g. manufacture, use, sell) without infringing on others' intellectual property rights and to assess barriers to implementation of inventions in countries indicated by the Contracting Authority.
4. Consultancy on intellectual property issues including interpreting applicable legislation in accordance with the current needs of the Contracting Authority.
5. Consultation and other activities in the field of obtaining intellectual property rights (e.g. indicating possible paths of action, providing answers with outlining financial, legal and substantive consequences).
6. Consultation on legal opinions and contracts in particular concerning: commonality of rights, licence agreements, agreements for the transfer of intellectual property rights and other agreements concerning the dissemination and use of protected and non-protected solutions and the confidentiality and secrecy of know-how.
7. Representation of the Contracting Authority by the Economic Operator, including a patent attorney, in judicial, administrative or administrative-court proceedings in the field of intellectual property law (e.g. in cases of infringement of intellectual property rights or invalidation of intellectual property rights, in particular patent or opposition cases in European countries and outside Europe).
8. Substantive participation in thematic online meetings with IPs Creators, i.e. scientists working in Virtual Research Institute projects, and the entity managing the IP, i.e. the Contracting Authority.
9. Preparing full application dossier, filing the application for a solution and handling applications in the phase one (international) of the Patent Cooperation Treaty (PCT) through correspondence with the relevant patent office within the framework of both new and continuing applications, forwarding correspondence, preparing and submitting replies to letters, including drafting patent descriptions, claims, sending documentation, submitting translations, etc., including replies to objections to the solutions put forward by the Contracting Authority, correspondence with foreign law firms acting as patent attorneys and, if necessary, ongoing correspondence directly with the creator of the solution. Handling of the application also includes monitoring and informing the Contracting Authority of time limits and the amount of official fees in the framework of PCT international patent procedures. As part of handling of the applications, **necessary expert consultations** will be provided by a professional attorney authorised to represent the Contracting Authority before patent offices in such countries as, inter alia, the United States, China, Japan, including consultancy on intellectual property law and industrial property law, in particular on assessing the patentability and patent purity of solutions, advice on optimising the costs of patent protection, as well as ad hoc consultations on legal opinions and commonality of rights agreements, licence agreements, agreements for the transfer of intellectual property rights and other agreements on the dissemination and use of protected and non-protected solutions, know-how agreements and other agreements on protection, as well as participation in mediation and negotiations with counterparties in intellectual property matters. The handling of the national phases of PCT applications will be carried out as part of the consultations described in sections II.12 and II.13 of the ToR.
10. Preparing full application dossier, filing the application for a solution and handling applications in the regional procedure before the European Patent Office (EPO) or in the continuation of the international PCT procedure through correspondence with the relevant patent office within the framework of both new and continuing applications, forwarding correspondence, preparing and submitting replies to letters, including drafting patent descriptions, claims, sending documentation, submitting translations, etc., including replies to objections to the solutions put forward by the Contracting Authority, correspondence with foreign law firms acting as patent attorneys and, if necessary, ongoing correspondence directly with the creator of the solution. Handling of the application also includes monitoring and informing the Contracting Authority of time limits and the amount of official fees in the framework of PCT international patent procedures and European procedures before the EPO.As part of handling of the applications, necessary expert consultations will be provided by a professional attorney holding the title of a patent agent and/or European patent agent, including consultancy on intellectual property law and industrial property law, in particular on assessing the patentability and patent purity of solutions, advice on optimising the costs of patent protection, as well as ad hoc consultations on legal opinions and commonality of rights agreements, licence agreements, agreements for the transfer of intellectual property rights and other agreements on the dissemination and use of protected and non-protected solutions, know-how agreements and other agreements on protection, as well as participation in mediation and negotiations with counterparties in intellectual property matters.
11. Preparing full application dossier, filing the application for a solution and handling applications in the unitary European patent system through correspondence with the EPO within the framework of both new and continuing applications, forwarding correspondence, preparing and submitting replies to letters, including drafting patent descriptions, claims, sending documentation, submitting translations, etc., including replies to objections to the solutions put forward by the Contracting Authority, and, if necessary, ongoing correspondence directly with the Creator of the solution. Handling of the application also includes monitoring and informing the Contracting Authority of time limits and the amount of official fees in the context of the European unitary patent procedure before the EPO.As part of handling of the applications, necessary expert consultations will be provided by a professional attorney holding the title of a patent agent and/or European patent agent, including consultancy on intellectual property law and industrial property law, in particular on assessing the patentability and patent purity of solutions, advice on optimising the costs of patent protection, as well as ad hoc consultations on legal opinions and commonality of rights agreements, licence agreements, agreements for the transfer of intellectual property rights and other agreements on the dissemination and use of protected and non-protected solutions, know-how agreements and other agreements on protection, as well as participation in mediation and negotiations with counterparties in intellectual property matters.
12. Continuation / taking over of intellectual property rights proceedings in the Contracting Authority's designated Office or body that are pending with the Contracting Authority or for which the Contracting Authority already has rights, as required by the Contracting Authority (settlement on the basis of the unit price from Sections 7-8 of the quotation form depending on the order placed).
13. Consultation on new and subsequent patent applications for the invention (PCT/national/ pre EPO mode) according to the Contracting Authority's needs, taking into account existing state of the art reports and new research results (in case additional research has been done since the first international applications that could strengthen the patent application).
14. In exceptional cases, for substantively difficult cases, at any stage of the procedure related to a given invention, the Contracting Authority may propose to engage an additional external expert, and the Economic Operator shall be obliged to cooperate with this expert. The employment of an 'extra expert' shall be the responsibility of the Contracting Authority.

**III. Option clause pursuant to Article 441 of the PPL**

The Contracting Authority stipulates that the estimated maximum quantities of the Subject of the Contract are specified in Appendix 10 to the ToR – Quotation Form. The estimated values are maximum values and the Contracting Authority has the possibility to adjust the number of orders within the above-mentioned categories to its current needs, taking into account the provisions of the model agreement on the basis of orders placed.

The Contracting Authority stipulates that the guaranteed value that the Contracting Authority will use during the term of the Agreement is 20 % of the gross remuneration of the Agreement. The subject of the Agreement will be performed on the basis of orders placed by e-mail by the authorised person in accordance with the Agreement. The remaining 80 % of the gross remuneration under the Agreement may be used as required by the Contracting Authority under the option clause, many times, according to the Contracting Authority's needs. The right of option shall be exercised on the basis of a declaration of intent by the Contracting Authority (in writing, by e-mail or in electronic form bearing a qualified electronic signature) executed by the Contracting Authority no later than by the end of the 46th month of the term of the Agreement and the Economic Operator shall be obliged to undertake its exercise under the Agreement. After the expiry of the period referred to in the preceding sentence, the option clause shall expire. The option shall be exercised on the basis of the unit prices (rates) specified in the Quotation Form (Appendix 10 to the ToR) and in the Agreement and on the terms and conditions specified in the Agreement. Failure to exercise the right of option by the Contracting Authority shall not give rise to any claim on the part of the Economic Operator against the Contracting Authority.

**IV. The subject of the contract shall be carried out in particular in the following forms:**

a) preparing legal opinions and information, including a description of the factual state of affairs and indicating legal findings and recommendations or strategies;

b) drafting documents, patent applications, internal regulations, contracts, annexes, arrangements, reports, proposals for legal action scenarios, proposals for resolution of a case, with indication of the legal basis;

c) participation in internal and external meetings, negotiations, meetings of bodies, proceedings before administrative authorities related to the implementation of the entrusted services

d) preparing, in the form of a report, an assessment of the compatibility of the measures taken, including carried out projects or documents prepared, with the applicable legal provisions;

e) telephone and e-mail consultations.

Court and patent fees shall be paid by the Contracting Authority. Services should not include official fees (the Economic Operator will call on the Contracting Authority to pay the required official fees or these will be re-invoiced by the Economic Operator to the Contracting Authority). The Contracting Authority therefore reserves the option for the Economic Operator to pay fees on behalf of the Contracting Authority.

**V. Time limits for completion of the Subject of the Agreement:**

48 months, with the timing of individual orders for Services placed according to the needs of the Contracting Authority to be carried out as follows:

1. The Economic Operator undertakes to provide the Contracting Authority with all confirmations documenting the progress of proceedings before the patent offices (official confirmations, copies of correspondence with the patent offices, analyses carried out and other documentation) related to the provision of Services under this Agreement. The documents referred to in the preceding sentence shall be forwarded to the Contracting Authority at the indicated e-mail address of the Contracting Authority in electronic form or in electronic format (depending on the form in which the document is produced) as soon as they are received by the Economic Operator or the relevant documents are generated, but no later than within **10 working days** of the date on which each individual operation is performed.
2. Each consultation referred to in the CSD, including in particular the provision of advice, analyses or opinions, should take place **within 2 weeks** of each request being made by the Contracting Authority. The consultations should take place in the manner and at the place indicated by the Contracting Authority, i.e. in a non-stationary manner (using electronic means of communication) or in a stationary manner (at the registered office of the Contracting Authority or of the Economic Operator or at another place indicated by the Contracting Authority). In the case of an assignment involving an analysis, opinion or other such document to be prepared by the Economic Operator, the form of performance of the assignment shall be indicated by the Contracting Authority in each case.
3. The time limit for the performance of a lot of the subject of this Agreement indicated in Section 1 or 3 of the CSD shall be **20 working days** from the day on which the Economic Operator is provided by the Contracting Authority with the materials concerning a given order.
4. The time limit for the performance of individual lots of the subject of this Agreement indicated in Section 2of the CSD, shall be **10 working days** from the date of delivery to the Economic Operator by the Contracting Authority of complete materials concerning a given order.
5. The time limit for the preparation of the patent description and the patent application referred to in Sections 9-11 of the CSD shall in each case be **20 working days** from the date on which the Economic Operator is provided by the Contracting Authority with complete materials relating to the order in question.
6. The time limits for the appointment of consultations or meetings/consultancy shall not exceed **3 working days** from the date of receipt of the order by the Economic Operator. The time limit for the preparation of relevant opinions or analyses shall be agreed between the Parties, taking into account the needs of the Contracting Authority.

The time limits for the remaining tasks are determined by the national and foreign regional industrial property offices. The Economic Operator undertakes to comply with all time limits imposed by the various authorities at each stage of the application and to ensure that these time limits are met by the agents in the countries where the procedures will be conducted.

Time limits not specified in the CSD shall be specified in the order placed by the Contracting Authority.