

Request for Proposal (RFP)  
Policy Studies, Conferences, and Development Programs in Support of  
Fair International Protection of Intellectual Property Rights  
RFP Number DOC52PAPT1000017

The United States Patent and Trademark Office (USPTO) is seeking proposals from parties interested in performing policy studies, conferences, and other development programs in support of fair international protection of intellectual property rights.

**SECTION A: BACKGROUND**

The USPTO intends to competitively issue joint project agreements to conduct these programs. Interested parties are advised that information is requested subject to the authority contained in the FY2010 Consolidated Appropriations Act language and no contractual awards subject to the Federal Acquisition Regulation (FAR) will be issued.

On December 16, 2009, the President signed the Consolidated Appropriations Act, 2010 (H.R. 3288) into law (P.L. 111-117). The law, in part, provides that no less than \$4 million of appropriated amounts shall be available only for the United States Patent and Trademark Office (USPTO) contribution in a cooperative or joint agreement or agreements with a non-profit organization or organizations to conduct policy studies, conferences, and other development programs, in support of fair international protection of intellectual property rights.

In accordance with the law, three requirements must be met in order for an organization to be eligible to enter into an agreement with the USPTO. First, the organization must be a non-profit organization. Second, the non-profit organization must have been successfully audited within the previous year. Third, the non-profit organization must have previous experience in such programs.

The text of the relevant provision of P.L. 111-117 reads as follows:

Provided further, That from the amounts provided herein, no less than \$4,000,000 shall be available only for the USPTO contribution in a cooperative or joint agreement or agreements with a non-profit organization or organizations, successfully audited within the previous year, and with previous experience in such programs, to conduct policy studies, including studies relating to activities of United Nations Specialized agencies and other international organizations, as well as conferences and other development programs, in support of fair international protection of intellectual property rights.

The USPTO is interested in entering into Joint Project Agreements as authorized by 15 U.S.C. 1525, which provides that the Department of Commerce may enter into joint projects with nonprofit, research, or public organizations on matters of mutual interest with costs equitably apportioned.

Joint Project Agreements require substantial participation on the USPTO's part as well as an equitable distribution of costs, though the recipient's share of costs may be paid by a third party or parties. Funds provided by the USPTO are to pay for actual costs only; generally, there may be no element of profit in the USPTO's payment to the recipient.

## SECTION B: STATEMENT OF OBJECTIVE

The USPTO, located in Alexandria, Virginia, is an independent operating agency within the Department of Commerce, subject to the policy direction of the Secretary of Commerce. The USPTO is the principal agency in the Executive Branch of the Federal Government responsible for the administration of intellectual property laws, including those relevant to the granting of patents and the registering of trademarks, for the promotion of intellectual property systems as a means of protecting economic prosperity.

The mission of the USPTO is to foster innovation and competitiveness by providing high quality and timely examination of patent and trademark applications, guiding domestic and international intellectual property policy, and delivering intellectual property information and education worldwide.

As part of its mission, one of USPTO's top strategic goals is to "Improve Intellectual Property Protection and Enforcement Domestically and Abroad." The following objectives are key to achieving this strategic goal and to strengthening the nation's ability to compete in an increasingly competitive and globalized business environment.

- Support efforts and initiatives aimed at strengthening intellectual property (IP) protection and curbing theft of IP.
- Continue efforts to develop unified standards for international IP practice.
- Foster innovation and competitiveness by delivering IP information and education worldwide.

The USPTO is seeking proposals as follows:

- Study on Implications of Work-sharing among Patent Offices for Purposes of Securing Timely Rights
  - The study will focus on how work-sharing frameworks can be effectively used by patent offices to decrease pendency and manage examination backlogs, and what the effect of more expeditious prosecution would be for users of the international patent system across various technology sectors. The study will include detailed data- and fact-based analyses of current and proposed work-sharing frameworks (e.g. PCT, PPH, SHARE), as well as other possible approaches to work-sharing. The results of the

study will include recommended best practices in work-sharing for Offices to consider and the implications for users of the patent system. The study should address ways to coordinate the timing of actions done in different countries to (1) maximize the number of applications eligible of work sharing, (2) avoid workload imbalances between countries, and (3) continue to provide timely rights in the requested countries. This should include an analysis of the current and projected timing situation of the top ten cross filing countries with the USPTO. This analysis would take into account the various deferral periods in some countries and, by technology area, at what points in time applicants request examination and how long does it take each country to get the first action completed after examination is requested.

- Delivery Date: February 2011
- Study on the Implementation of the WIPO Internet Treaties, with National Case Studies
  - The WIPO Copyright Treaty (WCT) and the WIPO Performances and Phonograms Treaty (WPPT) establish the international standards for protecting creative works and related rights in the digital age. Although a large majority of WIPO members have joined the WCT and WPPT, and many other countries have implemented the treaty standards in national law, a number of other countries have not yet joined or implemented the WIPO Internet Treaties. The objective of this study is to gain a deeper understanding of the experiences and policies of countries that remain outside of the WCT/WPPT framework. First, the study will develop selected, fact-based national case studies of WCT/WPPT member and non-member countries. Discussion of the prohibitions on circumvention of technological protection measures and trafficking in circumvention devices should include a review of national exception systems as they relate to those prohibitions, including a discussion of the design of such systems to advance national economic, social, cultural and/or information policies. Drawing on the case studies, the study will identify and discuss the advantages and disadvantages of joining the WIPO Internet Treaties. Third, the study will identify and evaluate the principal arguments offered against joining the WIPO Internet Treaties.
  - Delivery Date: November 2010
- Study of the Connection Between Unauthorized Camcording of Cinematographic Works and Internet or Optical Media Piracy
  - The illegal camcording of cinematographic works in cinemas has been found to be a major source of pirated works available on the Internet for illegal downloading and as a source for illegal manufacturing of optical

disc media, both in the United States and abroad. This study will review and analyze the connections and trends in optical media piracy, Internet-based illegal downloading and file-sharing, and P2P file-sharing of downloadable media onto hand-held devices, with a particular focus on the APEC region and economies, and make recommendations as to the most effective legislative and enforcement regimes to address this global problem.

- Delivery Date: January 2011
- Study on the Implications of Patent Application Growth in China on the USPTO
  - The study will focus on the growth of patent application filings at the State Intellectual Property Office (SIPO) in China and how this growth affects the patent process at the USPTO. In the past few years, SIPO has become the fastest growing patent office in the world and is among the largest in terms of the number of patents filed. As patent filings increase in China, a corresponding growth of related applications is expected to impact the USPTO patent workload. The study would include, but not be limited to, gathering data on the number, type, and quality of filings in SIPO, the filings at the USPTO with priority to China, and examination timing differentials between the two offices. The study should also address external factors such as economic conditions and governmental policy decisions that may underlie the growth of patent application filings in SIPO. This study should also analyze the current top twenty filing entities in SIPO and the top twenty filing entities from China at the USPTO. The study can be conducted over an extended time period to provide a time course of the changes in filings as they correlate to different factors. The results of the study will include recommendations for further follow up, and recommendations to consider as ever increasing filings from SIPO impact the patent systems in both the US and China.
  - Delivery Date: July 2011
- Update of Kenan Institute Asia-EPO Study on Asian Patent Offices
  - K. I .Asia (Kenan Institute), in partnership with the International Intellectual Property Institute (IIPI) and the Chulalongkorn University Intellectual Property Institute (CUIPI), conducted a two-year review of the patent environments in ASEAN. The 2007 report is an excellent resource and provides detailed information (e.g. statistics on the number of patents filed/issued and the number of examiners etc.) about patent offices in Asia. The study also provided recommendations for improving national patent office administration and options for moving towards ASEAN regional collaboration and eventual integration of patent management. This project will update the 2007 report.

- July 2011
- Roundtable Program and Study on the Use of Alternative Dispute Resolution in IPR Litigation
  - This study, and a follow along symposium program, will review the current trends in use of ADR and mediation in commercial IPR infringement and related disputes, and will analyze and evaluate the effectiveness and value of various ADR mechanisms in IPR commercial dispute resolution. A follow-up symposium will highlight those findings and provide a forum for experts and practitioners in the field to discuss experiences and recommendations for improvements in the use of ADR in the context of IPR disputes.
  - Delivery Date: January 2011 (Study); May 2011 (Symposium)
- Study on the Connection Between Counterfeit Hard Goods and Public Health/Safety
  - This study will review the literature, laws, and regulations concerning the connections between counterfeit hard goods and public health and safety threats and concerns; analyze and evaluate the scope of the problem and the effectiveness of existing approaches to deal with this increasingly global problem; and make recommendations on legislative, regulatory, and enforcement steps governments can take to prevent public health and safety incidents as a result of counterfeit hard goods finding their way into trade and commerce. The results of the study will form the basis for the development of both a course curriculum for "train the trainers" and a web-based interactive learning module.
  - Delivery Date: March 2011 (Study); June 2011 (Course curriculum, learning module)
- Study on Connections Between Governmental Technical Assistance and Capacity-Building in Foreign Markets and the Growth of Exports by IP Rights Holder Businesses
  - The United States Government, through the USPTO and other agencies, provides substantial technical assistance, training, and capacity-building activities to foreign governments and trading partners in the area of improving intellectual property rights legal regimes and enforcement environments. This study would analyze whether there is a correlation between such technical assistance and capacity-building activities and the growth of exports and other business activity, including licensing and franchising, by U.S. IP rights holder businesses in those economies, and

what types of IP-reliant American businesses, goods, and services are most impacted and benefit from this type of activity by the U.S. Government. In addition, a survey of actual and potential exporters should, among other things, examine the correlation between USPTO technical assistance and both the exporters likelihood of exporting to a particular country as well as its level of exportation.

- Delivery Date: January 2011
- Study on the economic impact of “TRIPs plus” Free Trade Agreements on IP enforcement
  - The United States over the past decade has entered into a number of Free Trade Agreements (FTAs) which contain a substantial chapter and numerous obligations in the area of IP protection and enforcement. This study would review and analyze, through use of case studies in each of the FTA partners, whether there is actual evidence of the economic impact, positive or negative, resulting from the implementation of these protection standards and enforcement obligations by the trading partners of the United States with whom we have FTAs.
  - Delivery Date: January 2011
- Comparative Study of Patent Quality Issues in Major International IP Offices
  - The issuance of high quality patents is an essential element of a well functioning patent system. Patents of questionable quality create mistrust amongst the public and stakeholders, may unnecessarily increase the cost of products and services to consumers, and inhibit marketplace competition. Each of the major IPOs measures the quality performance of its patent examination process and issued patents. The outcomes of these quality performance measures are typically reported in each IPO annual report; however, there appear to be significant differences amongst the major IPOs with regard what, when and how quality is measured. A better understanding of these differences is needed to facilitate policy and decision-making, especially with regard to building confidence in work-sharing efforts.
  - Delivery Date: January 2011
- Study and Update of the 2005 International Bar Association Survey on Specialized IPR Courts
  - The 2005 International Bar Association IP and Entertainment Committee's International Survey of Specialized IP Courts and Tribunals Survey is the most comprehensive survey done on specialized IPR courts done to date;

however, given various global developments in this area, there is a need for it to be updated and the issue of the role and effectiveness of specialized IPR courts in adjudicating both criminal and civil IP infringement cases needs to be revisited and documented. The study should investigate the effects of functioning IP courts or tribunals in producing consistent case outcomes in similar factual situations, study the effect of specialized IP courts or tribunals on the level of IP expertise in a nation's judiciary, and study the effect of such courts or tribunals on the conduct of commerce in IP-dependent industry sectors.

- Delivery Date: January 2011 (Study and Update); May 2011 (Seminar).
- Comparative Study on Intellectual Property Management in Standard-Setting Organizations and in Government Mandated or Approved Standards
  - The United States has a voluntary consensus standardization system, one in which the government plays a minimal role. By contrast, in many other countries, the government itself is the coordinator of standards or plays a major role in the financing or control of that nation's standards systems. Moreover, intellectual property and anti-competition issues are playing an increasingly significant role in the balancing of interests among producers and between producers and consumers in the standardization process, whether that process is government-driven or private sector, consensus-driven. This can be seen, for instance, in the adoption by several standard setting bodies of disclosure policies regarding patented technologies that may have a bearing on a standard under development. This study should identify up to 6 countries or regions with robust standards setting systems, conduct a comparative analysis of the various intellectual property policies of standard setting organizations in those countries or regions, and summarize the findings, including relative advantages and disadvantages of each approach, in terms of how those systems attempt to maintain an appropriate balance of interests between producers of technology and consumers.
  - Delivery Date: July 2011 (Study)

The delivery dates listed above are necessary to meet the needs of the agency. In addition to the enumerated projects above, other proposals will be accepted and evaluated in accordance with Section D below.

## SECTION C: INSTRUCTIONS TO OFFERORS

The following information is requested:

1. A statement describing how the organization meets or intends to meet the initial eligibility requirements (e.g. non-profit status, successful audit, previous

experience). Proof of eligibility should be attached or described in sufficient detail. Such description is limited to one (1) page plus any necessary attachments.

Audit is herein defined as an independent assessment of your financial records in accordance with Generally Accepted Auditing Standards (GAAS) or Generally Accepted Government Auditing Standards (GAGAS).

Offerors must demonstrate their non-profit status by proving exclusion from U.S. federal taxes or foreign equivalence.

2. A description of the programs (i.e. policy study, symposium, conference, other development program) that the organization has an interest in conducting. Summaries should include as much of the following information as possible: The program type, topic, purpose, audience, objective, measurements for success, and price. Such summaries are limited to three (3) pages each. The program type should be identified as a joint project agreement.
3. A price breakdown for each program in sufficient detail to allow the USPTO to assess cost reasonableness. Such price breakdowns are limited to one (3) pages per program. In addition proposals should address the shared contribution the offeror's organization will provide for the joint project agreement.
4. A description of a maximum of three past projects where the offeror has provided similar services, including contacts/references. Include the company/agency name, point of contact, telephone number, and a description of the project, fax number and e-mail address. If the offeror does not have information on at least 2 projects that it can submit, the recipient is required to state this circumstance clearly in its proposal. The offeror shall also include a brief description of the services performed and price magnitude.

#### Oral Presentations

Offerors are advised that the Government may choose to conduct oral presentations as part of the evaluation process. This decision will be made subsequent to receipt of proposals.

#### Basis of Award

Offerors are advised that the Government intends to make award on the basis of initial proposals without conducting discussions of such proposals. However, the Government reserves the right to conduct discussions if determined to be useful by the selection committee. Therefore, offerors are advised to submit their most favorable terms and conditions in their initial proposal.

#### Period of Performance

The offeror shall indicate and fully explain the period of performance for each program/project suggested. The Government reserves the right to negotiate the period of performance for any proposed program or project.

### Proposal Submissions

Proposals shall be submitted electronically no later than 5:00 PM Eastern Standard Time (EST) April 16, 2010. Questions from prospective offerors shall be submitted in writing to the Point of Contact noted below no later than 5:00PM EST March 26, 2010. Questions received after 5:00 PM EST March 26, 2010 will not be considered nor receive a response. USPTO will provide responses to the questions by 5:00 PM EST April 7, 2010.

Questions and proposal submissions regarding this Request for Proposal should be sent electronically to the following Point of Contact:

John Bardwell  
Office of Procurement, USPTO  
John.Bardwell@USPTO.gov  
(571) 272-6567 (Office)

### SECTION D: EVALUATION OF PROPOSALS

Proposals will be evaluated based on the following criteria, listed in descending order of importance.

- *Relevance* - Offerors must explain how the proposed project(s) relate(s) to the Agency's mission, strategic vision, and goals, as listed above. The project(s) that is/are most relevant will most likely received shared project funding from the Government. The projects enumerated under section B are considered highly relevant.
- *Value* - The Agency is looking to receive the greatest value for its money. Programs that deliver the greatest results for the lowest price will be considered the highest value. This is not to imply that the Agency is not looking to fund agreements with large dollar values, only that the results gained should relate positively to the price.
- *Experience* - Offerors with more experience performing relevant projects will be rated higher than offerors with less experience. Often confused with past performance, experience is what an offeror has done, while past performance is how well an offeror has done it.
- *Past Performance* - Offers will be evaluated on the relevance and quality of the past performance and experience of the offeror as it relates to the probability of

successful accomplishment of work in accordance with the RFP. The Agency reserves the right to contact references provided as well as any other source for information pertaining to an offeror's past performance.

Finally, all prices will be examined to ensure that they are fair and reasonable. They will also be reviewed to ensure that the project can be performed for the proposed price given and that the offeror truly understands the task it is proposing.