

UNIVERSITY OF LOUISVILLE®

PROCUREMENT SERVICES ADDENDUM

Date of Notice:	7/8/2024
Solicitation No.:	RFP330-PSC
Title:	Legal Services - Intellectual Property and Research Compliance
Addendum No.:	2

The following shall clarify and/or modify the original bid document(s) as issued by the University of Louisville.

- University response to questions received by June 13, 2024 at 12:00 PM EST. See attached for responses.

Bidder must acknowledge receipt of this and any addenda either with bid or by separate letter. Acknowledgement must be received in the Department of Procurement Services, Service Complex Building, University of Louisville no later than **07/12/2024 at 2:00PM, EST**. If by separate letter, the following information must be placed in the lower left-hand corner of the envelope:

Solicitation No.:	RFP330-PSC
Title:	Legal Services – Intellectual Property and Research Compliance
Due Date:	FRIDAY JULY 12TH at 2:00 PM

Authorized By:

Procurement Services	
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Receipt Acknowledged:

Company	
Signature	
Name (print)	
Date	

1. For USPTO-related representation, do you have required (or example) categories and titles of tasks you use for patent and trademark filing/prosecution, so that we can conform our proposed flat fees accordingly?

University response: *Trademark filings/registrations/prosecution for all marks and can be in various categories in both goods and services. Patent filings/patent review and research/prosecution.*

2. Do you have Outside Counsel Guidelines and/or standard procedures for outside counsel? If so, could you please provide them?

University response: *We are updating standard procedures for outside counsel and how we engage with them. Additionally, we have rules around travel (must abide by UofL travel policy and cannot bill any hours for travel), must get written permission for use of associate/assistant attorneys on work, must have written approval for any travel/meetings on behalf of UofL, etc.*

3. Do you have a general sense of volume of work total for this project, and/or by category (e.g., for invention assessments, patent filing/prosecution, trademark counseling, trademark prosecution/filing, research compliance counseling/policies, conflicts/misconduct/non-compliance investigations, IP licensing, etc.?)

University response: *UofL has 50 to 150 new disclosures annually with new patent filings on about half of these disclosures. Ongoing patent prosecution on patent applications follows at a rate of about seventy five percent of cases. UofL files in the US and in foreign jurisdictions via the USPTO, the PCT/ EPO, and ultimately validates about five to ten percent of our patent portfolio in non-US countries.*

Trademark counsel – usually about 10 hours/month depending on what is going on with any infringements or filings. Research compliance – 5-10 hours/month depending on whether we have any active investigations. After the last investigation wrapped, I have not had any communication with outside counsel on any compliance, policy, conflicts, etc. so it's all dependent on what is happening at the time. However, the last investigation averaged out to about 10-15 hours/month. And I have several one-off questions that can take anywhere from .5-2 hours per month based on various federal regulation changes.

4. To help us understand scope of need for research non-compliance issues, we would like to understand a little more of your experiences recently. Have you faced any litigation, investigations, or proceedings stemming from alleged or actual research non-compliance? If so, what was the general scope/nature of the instances (e.g., response to a Federal agency, litigation, internal investigation, etc.) and for how long did legal involvement take place (e.g., resolved within a few weeks? Months? years?)

University response: *Yes, we faced an investigation into false claims with NIH and DoD. The internal and external investigations took 13 months and is currently on hold due to the need for updating the money to be paid back to NIH and DoD for the past 12 months. Outside counsel engagement was 13 months, internal engagement has been since June of 2022 and is continuous.*

Additionally, we often have general compliance considerations for research due to new regulations from the various federal agencies.

5. We plan to elaborate on our IP and Research Compliance expertise and qualifications, but in describing our firm's "overall qualifications," are there any specific legal disciplines of particular interest? For example, in the domain of research compliance are you particularly interested in data privacy, HIPAA compliance, Bayh-Dole compliance, federal grant award regulations, human subjects/IRB requirements?

University response: *Particular interests would be in federal regulations for research compliance to include NSPM-33, export controls, proposal and award compliance, false claims, research misconduct, research related misconduct, data privacy, Bayh-Dole compliance, recharge centers for research.*

6. Do you anticipate trademark representation to include the University's fundamental marks (e.g., name, university logo, athletics, etc.)? Or, would this be more limited to trademarks pertaining to proprietary technologies developed at the University?

University response: *Trademark representation is for all marks pertaining to the University.*

7. Does our firm need to apply to the Kentucky Secretary of State as an out of state corporate contractor?

University response: *Yes, but not until the contract has been awarded. This is not necessary to submit your RFP response.*

8. Do we need to fill out this “University of Louisville Purchasing Department State Contract For Personal Services” form? If yes, do you have the form as a Word document without the “Sample” watermark?

University response: *Yes, but not until the contract has been awarded. This is not necessary to submit your RFP response.*