

**EXPRESSION OF INTEREST (EOI) FOR EMPANELMENT OF LAW FIRM(S) FOR HANDLING INTELLECTUAL PROPERTY
AND OTHER RELATED WORKS.**

1. **Title:**

The Indian Council of Medical Research (ICMR) seeks EOI from Law Firms based in Delhi/NCR for empanelment for filing and management of Intellectual Property Rights (IPRs), drafting /vetting of technology licensing and other legal documents for partnerships with other entities and to provide other techno-legal assistance in forming Section-8 Company under Companies Act - 2013 on a case-to-case basis as per instructions given by ICMR, as needed. The agreements could be with other Government/Semi-Government/Statutory & Autonomous Bodies of the Government, Private entities/ Companies in India and also with international bodies.

2. **Need of Legal Firm:**

The Indian Council of Medical Research (ICMR)/Institutes/Centres of ICMR in India requires Legal Firm for securing IP rights and to draft / undertake legal vetting of all documents/Agreements for Transfer of Technology/ Intellectual Property Rights (IPR)/Public Private Partnership (PPP), providing Techno-legal assistance in forming Section-8 Company etc.

3. **Methodology:**

The Indian Council of Medical Research (ICMR) shall select the Legal Firm, after following the procedure laid down as per the terms & conditions of the Expression of Interest (EOI).

- (i) The law firm must be based in Delhi/ NCR along with suitable performance guarantee from IP law firms to be empanelled.
- (ii) The EOI is based on technical bid along with security/declaration form.
- (iii) Every Company/Law Firm has to submit the technical bid in a sealed envelope. The firms got threshold marks i.e. 75 out of 100 marks as mentioned on page no. 4 of EOI, will be called for presentation. If there is large number of applicants the weightage will be given to those who have scored more marks.
- (iv) The maximum marks for Presentation will be 25. The empanelment will be made for the firms who have scored maximum marks in Technical Bid plus presentation.

4. **Experience:**

Minimum 10 (ten) years working experience in the field of preparation of all documents/Agreements for Transfer of Technology/Intellectual Property Rights (IPR)/Public Private Partnership (PPP) etc. with Government/Central Govt./State Govt./Public Sector industry/public sector R&D entities along with annual turnover of not less than Rs 10 Lakh per year.

5. The proposal for technical bid with all the prescribed duly attested enclosures/documents shall be submitted in a separate envelope with the superscript "Tender for Empanelment of IP Law firms for ICMR" on or before 27th Jan. 2022 to:

Assistant Director General (Admn.)
Indian Council of Medical Research
V. Ramalingaswami Bhawan, Ansari Nagar
New Delhi – 110029

EOI No. ICMR / EOI / LEGAL / 2022 Dated: 20th Jan. 2022

Indian Council of Medical Research (ICMR), New Delhi

Invites

Expression of Interest (EOI) for empanelment of law firm(s) for handling intellectual property and other related works

The ICMR seeks EOI from Law Firms based in Delhi/NCR for empanelment for filing and management of Intellectual Property Rights (IPRs), drafting /vetting of technology licensing and other legal documents for Partnerships with other entities and to provide other techno-legal assistance in forming Section-8 Company under Companies Act – 2013 on a case-to-case basis as per instructions given by ICMR, as needed. The agreements could be with other Government/Semi-Government/Statutory & Autonomous Bodies of the Government, Private entities/ Companies in India and also with international bodies.

1. Letter of Invitation:

INVITATION OF EXPRESSION OF INTEREST

Indian Council of Medical Research, New Delhi, invites Expression of Interest (EOI) through sealed cover from minimum 10 (years) experienced LawFirm to prepare all documents for Transfer of Technology/Patent/ Intellectual Property Rights (IPR)/Public Private Partnership (PPP), providing Techno-legal assistance in forming Section-8 Company etc.

The EOI Document containing the details of qualification criteria, submission details, brief objective & scope of work and evaluation criteria etc. can be downloaded from <https://main.icmr.nic.in/>, www.eprocure.gov.in & www.gem.gov.in

Schedule for the Proponents is as under:

EOI Document Number	ICMR / EOI / LEGAL / 2022 dated 20 Jan., 2022
Date of Publication	20 th Jan. 2022
Last date/Time of submission	27 th Jan. 2022; 5.00 pm

ICMR reserves the right to cancel this request for EOI and/or invite afresh with or without amendments, without liability or any obligation for such request for EOI and without assigning any reason. Information provided at this stage is indicative and ICMR reserves the right to amend/add further details in the EOI.

2. Background:

The Indian Council of Medical Research (ICMR), New Delhi, the apex body in India for the formulation, coordination and promotion of biomedical research, is one of the oldest medical research bodies in the world. The ICMR has always attempted to address itself to the growing demands of scientific advances in biomedical research on the one hand and to the need of finding practical solutions to the health problems of the country, on the other. The ICMR has come a long way from the days when it was known as the IRFA (Indian Research Fund Association), but the Council is conscious of the fact that it still has miles to go in pursuit of scientific achievements as well as health targets.

3. Broad Scope of Work:

Subject to the terms and conditions of an Agreement, ICMR seeks EOI from Law Firm(s) based in Delhi/NCR for empanelment for

- a. filing and management of Intellectual Property Rights including drafting, filing, prosecution, opposition and maintenance of IP in India and Abroad.
- b. The Law Firm shall be responsible for drafting/vetting of all kinds of documents/Agreements whatsoever required, in consultation with the ICMR and/or the concerned Institute/Centre of ICMR, as the case may be. Securing registration

credentials and maintenance of records of patents, industrial designs, trademarks, copyrights and Semiconductor Integrated Circuits Layout Design.

- c. Patent Searches including Patentability search, FTO, Patent landscape, Invalidity/validity and State of the Art Search.
- d. Handling aspects such as renewal, opposition, revocation and restoration of IP and any other proceeding under relevant IP Act/Law including IP management matters in India and Abroad.
- e. Maintenance and handling of foreign patent application (including PCT) for filing/IP securing.
- f. Interaction (if required) with inventors/ principle investigators (PIs) and applicants.
- g. IP infringement cases, representation in India and miscellaneous actions under the relevant Act.
- h. Assisting in formation of Section 8 company and paper work related to the company
- i. To draft/ undertake legal vetting of all documents/Agreements for Transfer of Technology /Intellectual Property Rights (IPR)/Public Private Partnership (PPP) etc. to be executed between Indian Council of Medical Research (ICMR)/Institutes of ICMR/Centres of ICMR and other Government/Semi-Government/Statutory & Autonomous Bodies of the Government and Private Organizations/ Companies in India, as per the Rules/Regulations of the Ministry of Law & Justice, Govt. of India. The Law Firm shall be responsible for drafting/vetting of all kinds of documents/Agreements whatsoever required, in consultation with the ICMR and/or the concerned Institute/Centre of ICMR, as the case may be, and after approval of the competent authority in ICMR, the Law Firm shall further file/submit the requisite documents before the respective forums/Institutes and obtain the registration / transfer documents from those competent approving forums/Institutes.

4. Tenure of engagement:

The tenure of engagement shall be initially for a period of one year, extendable further up to 03 years on yearly basis with same terms and conditions, depending upon the satisfactory performance of the Law Firm. The engagement shall be only as per the terms & conditions of the Agreement.

5. Eligibility criteria:

The firms should fulfil the following criteria and should produce documentary evidences wherever applicable, including the experience projected:

- Firms should be a legal entity registered under statutes of India.
- Firm should have an established office in Delhi/NCR
- Firm should be of good standing with minimum experience of 10 years with some working experience with public sector R & D entities/organizations dealing with all types of IP including services for Patents, Designs, Copyrights, Integrated circuits layouts, Trademarks & Service Marks.
- Firm should have annual turnover not less than 10 lakhs per year and should not have registered any loss during any of the last three years.
- The firm should not be black listed by any Central/State Government/ Public Sector Undertaking, Govt. of India and should not have litigation that may have an impact on the delivery of services.

6. Instructions to Proponents:

6.1 Documents to furnish:

Proponents are requested to go through all pre-qualification requirements, scope of work for execution & requirements w.r.t. technical/financial capabilities and submit all relevant documents.

ICMR reserves the right to call for any clarifications as required to assess the company for eligibility

6.2 Rejection Criteria:

The application is liable to be rejected if:

- a. The proposal is not submitted as per the requirements indicated in the EOI.
- b. Not in the prescribed format.
- c. Not properly signed as per requirements.
- d. Received after the expiry of due date and time.
- e. All relevant supporting documents are not furnished.
- f. The proposal shall be substantially responsive without any material deviation from the terms and conditions of EOI. The proposal should be submitted strictly as per the requirements of Technical of EOI, failing which the proposal shall be summarily rejected.

6.3 Disclaimer:

- a) ICMR shall not be responsible for any late receipt of applications for any reasons whatsoever.
- b) ICMR reserves the right to reject any or all applications without assigning any reasons thereof.
- c) ICMR may relax or waive any of the conditions stipulated in this document as deemed necessary in the best interest of the ICMR, without assigning any reasons thereof.
- d) To include any other item in the scope of work at any time, in consultation with proponents or otherwise.

7. Evaluation Methodology / Pre-Qualification Criteria:

S.No.	Criteria	Max. Marks (%)
	Pre-Qualification Criteria Supporting copy of documents required (All documents must be self-attested by the applicant or person authorized by the Applicant).	
1.	The proponent shall be a legal entity registered under the respective laws in India. Requisite documents as mentioned in para 5 above	NA
2.	The proponent must be registered in India with taxation and other administrative authorities. - PAN Card/ GST Registration	
3.	The proponent should have practised for at least 10 (years) in the profession in the relevant field. - Relevant documents	
4.	The proponent should not have been black-listed by any Central /State Government / Public Sector Undertaking, Govt. of India, at least in three (3) immediately preceding years (2017-2020). - Undertaking on the Letter Head of the Proponent duly signed & Stamped by Authorized Signatory (As per Format –1).	
5.	The proponent should not be involved in any major litigation that may have an impact of affecting or compromising the conditions required under this EOI and in the Agreement. - Undertaking on Proponent’s Letter Head, duly signed and stamped (As per Format –2).	NA
6.	Recommendations/testimonials from Present and Past Client of last 10 years	
7.	Sound Financial standing of the Applicants/ Firms in terms of annual turnover, during the last three financial years (relevant certificate from Auditor must be	

	appended) As per Format -3	
8	The Law Firms shall be on the panel of at least one Central or State Govt. organization /PSU/Govt. Autonomous Organization/ Govt. Institution at the time of submitting of EOI.	
TECHNICAL BID (Max. Marks – 100)		
1	Past Experience of the firm (Max Marks – 55)	55
1.1	Number of years of experience in Life Sciences, drugs & pharmaceuticals, vaccine candidate, composition, formulation, phytochemical, bio-larvicides and Medical Device & Diagnostics Sector (10 years or more experience in filing and prosecution of IP, more particularly in patents.) (Max Marks – 08) (10 to 15 Years – 05 Marks) (16 to 20 Years – 06 Marks) (21 Years & Above - 08 Marks)	8
1.2	Number of patents drafted, filed, prosecuted and granted in India and Foreign jurisdictions; and the ratio in Indian & Foreign jurisdiction preferably 3:1 (Max Marks – 15) (Up to 100 – 5 Marks) (From 101 to 500 – 10 Marks) (501 & above – 15 Marks)	15
1.3	Number of countries where the firms have capability to represent. (Max Marks – 10) (Up to 50 Countries – 5 Marks) (51 to 100 Countries – 8 Marks) (101 & above – 10 Marks)	10
1.4	Number of Patents drafted/ filed in last 5 years period in the following sectors: (Max Marks – 15) a) Life sciences sector b) Medical device and Diagnostics Sector c) Drugs & pharmaceuticals, vaccine candidates, compositions, formulations, phytochemicals, bio-larvicides (Details to be provided in annex) (Up to 500 – 5 Marks) (From 501 to 1000 – 10 Marks) (1001 & above – 15 Marks)	15
1.5	Experience of filing and prosecution of Copyright, Trademark and Design applications (Max Marks – 4) (10 to 15 Years – 2 Marks) (16 Years & above – 4 Marks)	4
1.6	Experience of Providing Techno-Legal Assistance to Govt./ Society in forming Section-8 Company in Medical Healthcare.	3
2	Experience of Key Personnel Qualifications (Max Marks – 30)	30

2.1	Academic Qualification (Max Marks – 5)	
2.2	Activities carried out in last 5 years, particularly regarding Life Science /drug & pharmaceuticals diagnostic, vaccine candidate, composition, formulation, photochemical, bio larvicides and Medical Device and Diagnostics Sector a) Drafting/ Filing of Patents b) Drafting/ vetting of Agreement(s) - License Agreement/ Collaboration Agreement/ IP Assignment/Non-Disclosure agreements (NDA)/ Material Transfer Agreements (MTA)/ contract research agreements, etc. c) Trademark/ copyright applications /Design applications	
2.3	(Up to 100 – 5 Marks) (From 101 to 500 – 10 Marks) (501 & above – 15 Marks) No. of employees with PhDs in life sciences with Legal Degree. (Up to 5 Employees – 5 Marks) (More than 5 Employees – 10 Marks)	
3.	Financial strength of the Firm (Max Marks – 15) Annual turnover figure for last three years (minimum annual turnover of Rs. 10 lakhs) (Rs. 10 to 20 Lakhs – 7 Marks) (Rs. 21 to 30 Lakhs – 10 Marks) (31 Lakhs & Above – 15 Marks)	15
	TOTAL	100

ICMR shall evaluate the firms for short listing, inter-alia based on their past experience of handling similar types of work, strength of their man power and financial strength of the firm. ICMR will assign scores to the response of each firm based on weightage assigned to each of the criteria under different categories mentioned in Section 7 above. If there is large number of applicants the weightage will be given to those who have scored more marks.

No travelling charges or other related charges would be paid by ICMR for presentation before expert committee.

8. Conflict of Interest:

1. Where there is any indication that a conflict of interest exists or may arise, it shall be the responsibility of the bidder to inform ICMR, detailing the conflict in writing as an attachment to this Bid.
2. ICMR will be the final arbitrator in cases of potential conflicts of interest. Failure to notify ICMR of any potential conflict of interest will invalidate any verbal or written agreement.
3. A Conflict of Interest is where a person who is involved in the procurement has or may be perceived to have a personal interest in ensuring that a particular Bidder is successful. Actual and potential conflicts of interest must be declared by a person involved in a Bid process.

9. Technical Bid Criteria:

Proponents are required to submit their proposals in writing providing their credentials and requests for empanelment. Details are to be given as per the format enclosed in Annexure 1.

The followings documents are required to be submitted alongwith the proposal to support the Technical Bid:

S. No.	Broad Criteria
1.	The proponent should have practised for at least 10 (years) in the profession in the relevant field.
2.	Number of Patents drafted/ filed in last 5year period in the following sectors:

	<p>a) Life sciences sector, drugs & pharmaceuticals, vaccine candidate, compositions, formulations, phytochemicals, bio-larvicides and</p> <p>b) Medical device and Diagnostics Sector</p>
3.	Number of qualified Lawyers engaged by the firm, having experience of more than 05 years in providing legal services.
4.	Experience of Providing Assistance to Govt./ Society in forming Section-8 Company
5.	Level of Client Satisfaction-Number of patent filing, number of patent granted, time taken to file new patent application, number of patent refused.
6.	The Firm shall furnish copies of certificate of registration/ agreement/ articles of association, as the case may be, as service firm and PAN, and GST Registration
7.	Presentation supporting Technical Strength

In case of any clarification required, please contact:

Sh. Jagdish Rajesh, ADG (A) ICMR, New Delhi (011- 26589402/ext 256) E-mail: rajeshj.hq@icmr.gov.in

Mrs. Anurag Wason, AO, ITR, ICMR, New Delhi, (011- 26589753/ext 395) E-mail: wasona.hq@icmr.gov.in

Dr. Sadhana Srivastava, Scientist 'F, ITR, New Delhi (011- 26589745/Ext. 372)

COVER LETTER

Expression of Interest

(To be submitted on Letter Head)

To,

The Director General
Indian Council of Medical Research,
Ansari Nagar, New Delhi.

Subject: Submission of Expression of Interest (EOI) for engagement of Legal Firm.

Ref: EOI No. ICMR / EOI / LEGAL / 2022 dated --....., 2022.

Sir,

The undersigned having read and examined in detail all the EOI documents pertaining to engagement of Legal Firm, do hereby express the interest to undertake the assignment/scope of work as mentioned in the EOI document. The details of the Legal Firm and contact person are given below:

1	Name of the Proponent	
2	Address	
3	Name, designation & address of the person to whom all references shall be made	
4	Telephone No. (with STD code)	
5	Mobile No. of the contact person	
6	Email ID of the contact person	

The following documents are enclosed:

- i. Pre-qualification Documents
- ii. Technical Bid (in separate sealed envelope)

I/we hereby declare that the information furnished is true and correct to the best of my/our knowledge and belief.

Thanking you,

Yours faithfully,
(Signature of the Authorised signatory)

TECHNICAL BID

PROFORMA FOR APPLICATION FOR EMPANELMENT OF LEGAL FIRMS

1. Name of the Firm
2. Address
3. PAN of the Firm
4. GST Registration No
5. Date of registration of the Firm
6. Details of the Experience /Practice/achievements
7. Details of manpower structure and their expertise
8. Details of Penalty imposed on the firm, if Any
9. Details of Firm's policy on confidentiality and conflict of interest
10. Annual Income Tax return filed with the Income Tax Authorities for the last three Years
11. Information along with documentary proof for each of the parameter in Pre-qualification criteria of the EOI document. Documentary proof to be attached in support of credentials mentioned by firm.
12. Details as per below table of Technical Bid

S. No.	Criteria	Supporting documents
1.	The proponent should have practised for at least 10 (years) in the profession in the field of Life sciences inventions drugs & pharmaceuticals, vaccine candidate, compositions, formulations, phytochemicals, bio-larvicides and Medical device and Diagnostics Sector	Annexure2
2.	Number of Patents drafted/ filed in last 5years period in the following sectors: <ul style="list-style-type: none"> • Lifesciences sector, drugs & pharmaceuticals, vaccine candidate, compositions, formulations, phytochemicals, bio-larvicides • Medical device and Diagnostics Sector 	Please provide the details in Annexure 3
3.	Number of qualified Lawyers engaged by the firm, having experience of more than 05 years in providing legal services.	The firms to furnish CV's of the Lawyers/ Legal consultants engaged in the firm and details as per Annexure 4
4.	Level of Client Satisfaction	Recommendations/testimonials
5.	Experience of providing Techno-Legal Assistance in forming Section-8 Company to Govt./Society	Please provide details Annexure 3
6.	Certificate of registration/ Agreement/ Articles of Association, as the case may be, as service firm and PAN, and GST Registration	Copy of Certificate of registration/ Article of Association and PAN and GST Registration

DECLARATION

I/We hereby declare that the information provided for empanelment is factually correct.

Date:

Place

Authorized Signatory
(Representative of the Law Firm)

(Complete postal address with mobile number and Email ID)

(Office Seal/Stamp)

Undertaking with regard to blacklisting (On Rs.100/- Non-Judicial Stamp Paper)

(To be submitted on Agency's Letter Head)

To,

The Director General,
Indian Council of Medical Research,
Ansari Nagar, New Delhi.

Subject: Undertaking regarding Blacklisting / Non-Debarment

Ref. No. Ref: EOI No. ICMR / EOI / LEGAL / 2022 dated 2022.

Sir,

It is hereby confirmed and declared that _____ is not blacklisted/debarred by any Government Department/Public Sector Undertaking/PrivateSector/or any other agency for which works/assignments/services have been executed / undertaken.

Yours faithfully,

(Signature of the Authorised signatory)

Name:

Designation:

Seal:

Date:

Place:

Undertaking with regard to Non-Litigation (On Firm's Letter Head)

(To be submitted on Agency's Letter Head)

To,

The Director General,
Indian Council of Medical Research,
Ansari Nagar, New Delhi.

Subject: Undertaking regarding Litigation

Ref. No. Ref: EOI No. ICMR / EOI / LEGAL / 2022 dated --....., 2022.

Sir,

It is hereby confirmed and declared that -----, does not have any litigation / arbitration history with any Government department/ Public Sector Undertaking / or any other public authority, with which any MoU/Agreement was / has been executed / undertaken.

Yours faithfully,

(Signature of the Authorised signatory)

Name:

Designation:

Seal:

Date:

Place:

Financial Strength of the Firm					
Annual turnover for last three Financial Years					
S.No.	Financial Year	Whether Profitable (Yes/No)	Annual net profit (in Lakhs of Rs.)	Overall annual turnover (in Lakhs of Rs.)	Annual turnover from only Consultancy services rendered in India (in Lakhs of Rs.)
1	2018-19				
2	2019-20				
3	2020-21				
<p>Note: Please attach auditor's certificate (Certified copy) in support of your claim.</p>					
<p>Signature of the applicant</p> <p>Full name of applicant Stamp & Date</p>					

Experience in Related Fields				
Overview of the Patent cases, Copyright and Industrial Designs dealt in the area of Life Sciences and Medical Device & Diagnostics Sector				
S.No.	Items	Number of Assignments undertaken during last 5 years	Order Value of each assignment in Lakhs of Rs. (Enclose copy of each order)	Mention the name of Client/ Organization (Enclosed completion certificates)
1	Experience of filing patents in India			
2	Experience of filing patents in Foreign Jurisdictions			
3	Experience of filing Copyright application in India and foreign			
4	Experience of filing Industrial Design application in India and foreign			
5	Experience of Drafting License Agreements/ Assignment Deeds/ Collaboration Agreements			
6	Experience of vetting of Legal Agreements			
Decision of Evaluating Committee in ascertaining "similar nature" and "similar assignment" will be final.				
Signature of the applicant Full name of applicant Stamp & Date				

Note: Please attach the List as Annexure

I. Details of Patents, Copyright and Industrial design Filed/ Drafted in Life sciences inventions, drugs & pharmaceuticals, vaccine candidate, compositions, formulations, phytochemicals, bio-larvicides, Medical device and Diagnostics Sector in the last 5 Years

Title of the Application/ Patent	Sector	Year of Filing

- I. Please provide details of experience of Providing Assistance to Govt./ Society in forming Section-8 Company, if any:**

Experience of Key Personnel

Overview of the qualification and past experience of the key personnel Name:

Designation:

Date of Birth:

Qualifications:

Experience:

(Activities carried out in last 5years)

Note: Information regarding best ten key personnel may be provided. They should be on the payroll of the applicant. Separate sheet may be used for each individual. Each individual will be evaluated separately and then averages of the all personnel will be taken for final evaluation.

List of abbreviations

EOI: Expression of Interest

GST: Goods and Services Tax

ICMR: Indian Council of Medical Research

ITR: Innovation and Translation Research

IPR: Intellectual Property Rights

IRFA: Indian Research Fund Association

IP: Intellectual Property

MTA: Material Transfer Agreements

NDA: Non Disclosure agreements

PAN: Permanent Account Number

PPP: Public Private Partnership