



**Annex "A"**

**TECHNICAL SPECIFICATIONS**

**ITEM NO. 1 - INTELLECTUAL PROPERTY (IP) AND TECHNICAL RESEARCH SERVICES OF PRELIMINARY COMMERCIALIZATION / TECHNOLOGY TRANSFER AND MARKET STUDY FOR THREE (3) DOST-ASTI TECHNOLOGIES**

Patent IP Filing inclusive of Prior Art Search (PAS), Patent Report Drafting and final acknowledgement from IPOPHL

**1. BACKGROUND AND OBJECTIVES**

- 1.1. DOST-ASTI is seeking IP and Technical Research Service for the Patent and IP Filing of DOST-ASTI technologies for commercialization.
- 1.2. The service provider must conduct a comprehensive prior art search, draft claims, and file a patent/UM for three (3) technologies.
- 1.3. The Approved Budget for the Contract (ABC) is inclusive of all applicable government taxes and service charges.

**2. TECHNICAL SPECIFICATIONS**

**2.1. Comprehensive PAS**

2.1.1 PAS report to be generated shall include the following:

2.1.1.1. Published pending and valid granted local and foreign patent, utility model applications and industrial design applications of similar and closely related or counterpart technologies.

2.1.1.2 Search pool in a table form including:

- 2.1.1.2.1 Keywords used;
- 2.1.1.2.2 Number of Hits;
- 2.1.1.2.3 Number of documents considered; and
- 2.1.1.2.4 Number of relevant document/s.

2.1.2 PAS report will be prepared wherein the search will be based on the relevant technical features of the technology, and;

2.1.3 PAS recommendation on the technology for IP protection.

2.1.4 Submit PAS report and updated data/disclosures as evidenced by an e-mail or any form of communications sent by DOST-ASTI Technology Licensing Office (TLO) to the contractor, and such disclosure was acknowledged as complete by the contractor.

**2.2. Patent/UM Drafting and Filing – Non-Chemical**

- 2.2.1. Drafting and filing to IPOPHIL of technology for patent/utility model application – Non-Chemical
- 2.2.2. Submit patent / utility model application and disclosures for the technology as evidenced by an email or any form of communication sent by DOST-ASTI TLO to the contractor, and such disclosure was acknowledged as complete by the contractor.
- 2.2.3. In case technology to be filed for patent protection (or UM) cannot be pursued, DOST-ASTI TLO may submit a new disclosure of another technology for IP filing
- 2.3. Non-acknowledgment of DOST-ASTI TLO's e-mail in seven (7) calendar days would deem the disclosed data as complete
- 2.4. Conduct at least two (2) face-to-face or virtual meetings and/or interviews (at the option of the TLO) with any or a combination of the following internal stakeholders: researchers, TLO, and management representatives.
- 2.5. Conduct at least one (1) face-to-face or virtual (at the option of TLO), eight (8) hours session/orientation/workshop/learning activity relevant to Prior Art Search, Invention Disclosure Form preparation or any seminar/workshop which would encourage researchers to disclose their inventions that will be used for patent filing.
- 2.6. Inclusive of communications and other related expenses
- 2.7. Inclusive of professional fees, administrative fees, taxes other services, government charges, and other applicable filing fees until issuance of letters of patent / UM certificate.
- 2.8. Inclusive of a conclusive report of all outputs, and presentation to the DOST-ASTI TLO and/or a representative from the management.

### **3. DELIVERY AND PAYMENT TERMS**

- 3.1. Payment shall be made through progress billings, which shall be proportionate to the following milestones:
  - 3.1.1. Submission of all PAS reports within thirty (30) calendar days from the said date of receipt of complete and updated data/disclosures – Forty percent (40%) payment
  - 3.1.2. Submission of draft application within fifteen (15) calendar days upon the submission of PAS reports - Thirty percent (30%) payment
  - 3.1.3 Filing and acknowledgment Receipt from IPOPHIL, with complete accompanying/supporting documents, must be submitted to DOST-ASTI within fifteen (15) calendar days upon submission of draft applications - Thirty percent (30%) payment
- 3.2. The billing shall be accompanied by an acknowledgment document/ certification issued by an authorized officer of DOST-ASTI TLO certifying the percentage of

actual and acceptable works accomplished and that the amount being claimed by the Contractor is based on the percentage of accomplishment of the Contractor for the delivery period.

## **ITEM NO. 2 - IP AND TECHNICAL RESEARCH SERVICES FOR TECHNOLOGY COMMERCIALIZATION PLAN AND INNOVATION STRATEGY**

Research Report on Freedom-to-Operate/Technology due diligence, inclusive of a written report with advice and recommendations

### **1. BACKGROUND AND OBJECTIVES**

- 1.1. DOST-ASTI is seeking IP and Technical Research Service for the Freedom-to-Operate (FTO) report of DOST-ASTI technologies.
- 1.2. The service provider must submit a complete FTO Report for three (3) technologies.
- 1.3. The ABC is inclusive of all applicable government taxes and service charges.

### **2. TECHNICAL SPECIFICATIONS**

- 2.1. FTO should be drafted in accordance with the acceptable standards that analyzes the risk of potential infringement, comprising but not limited to the following:
- 2.2. Conduct at least two (2) face-to-face or virtual meetings and/or interviews with any or a combination of the following internal stakeholders: researchers, TLO, and management representatives.
- 2.3. Conduct at least one (1) face-to-face or virtual (at the option of the TLO), minimum of half-day session/orientation/workshop/meeting on any of the following topics:
  - 2.3.1. Importance of conducting an Intellectual Property (IP) infringement study or freedom to operate report for commercialization and public good purposes;
  - 2.3.2. Basic IP enforcement and avoiding infringement cases; or
  - 2.3.3. Any relevant topics on IP enforcement, FTO for Commercialization and Public Good purposes, any topic that avoids future litigation (infringement cases).
- 2.4. Comprehensive FTO search of similar, equivalent or closely related technology/system using databases such as IPOPHL, Espacenet and Patentscope as minimum, with the following scope:
  - 2.4.1. Published pending Philippine patent, utility model applications and industrial design applications of similar and closely related or counterpart technologies.
  - 2.4.2. Valid Philippine granted patents, utility model applications and industrial design registrations if applicable; and

- 2.4.3. Valid foreign patent applications or registrations that may enter the Philippines through the Patent Cooperation Treaty.
- 2.4.4. Search pool in the table containing the following information:
  - 2.4.4.1. Keywords used;
  - 2.4.4.2. Number of hits;
  - 2.4.4.3. Number of documents considered; and
  - 2.4.4.4. Number of relevant document/s.
- 2.5. Each FTO report will be prepared based on the final R&D output basis (not just one technology), which may be comprised of at least one (1) IP protection or more, wherein the search will be based on the relevant technical features of the technology using the above-mentioned prior art search tools.
- 2.6. FTO analysis, opinion and recommendation on the technology being rolled out for commercialization (e.g., licensing purposes or spin-off purposes).
- 2.7. Non-acknowledgement of DOST-ASTI TLO's email in seven (7) calendar days would deem the disclosed data as complete.
- 2.8. Inclusive communications and other related FTO services expenses.
- 2.9. Inclusive of administrative fees, taxes and other services, and government charges.
- 2.10. Inclusive of conclusive report of all outputs, and presentation to the DOST-ASTI Management.

### **3. DELIVERY AND PAYMENT TERMS**

- 3.1. Payment shall be made through progress billings, which shall be proportionate to the following milestones:
  - 3.1.1. Submission of FTO first draft within thirty (30) calendar days after Patent filing and acknowledgment from IPOPHIL – Twenty percent (20%) payment
  - 3.1.2. Delivery of all presentation/meeting/orientation/workshop/ discussion within thirty (30) calendar days upon submission of FTO first draft - Twenty percent (40%) payment
  - 3.1.3. Receipt of final draft with inputs from meetings/workshops/discussions of FTO within fifteen (15) calendar days upon delivery of all presentation/meeting/orientation/workshop/ discussion – Forty percent (40%) payment
- 3.2. The billing shall be accompanied by an acknowledgment document/ certification issued by an authorized officer of DOST-ASTI TLO certifying to the percentage of actual and acceptable works accomplished and that the amount being claimed by the Contractor is based on the percentage of accomplishment of the Contractor for the delivery period.

3.3. Final Payment shall be made upon the submission of the Final Billing together with certification/acceptance/by the end-user that the services are delivered in accordance with the terms of this Contract and are duly inspected and accepted.