Procurement and Contracting Services

Request for Proposals for
Legal Services for Intellectual Property

Addendum #1

Please mark all proposal submission envelopes with the following information

Sealed RFP # L051411
Due on February 14, 2014 no later than 2:00 PM MST
This addendum is issued to answer questions received prior to the February 4\textsuperscript{th} deadline.

1. Please provide us with a detailed description of the Xcel spreadsheet required for the RFP. Please clarify whether the spreadsheet should be really detailed regarding areas of expertise or just a brief overview for each professional.

A simple Excel spreadsheet is requested from each firm with the following columns:

Attorney name / City / Direct Phone # / email address / attorney’s web page address / Position (e.g. Partner, Associate, Of Counsel) / Specialty: a SHORT description using key words, which will be used for searching for counsel on specific matters. This should be no more than 50 words and use common phrases for areas of practice, e.g. prosecution, litigation, chemical, software, medical devices, trademark, copyright, etc.

2. We have reviewed the RFP No. L051411 and the Agreement and have a question on insurance coverage. The State of Wisconsin does not require as high of coverage as are listed in the University of Arizona requirements. Would we be able to keep our insurance coverage as it is or do we need to change our insurance to the higher amounts if accepted as a law firm representing the University of Arizona?

The required coverage limits for professional liability insurance are reduced to $1,000,000 per occurrence, $2,000,000 annual aggregate (see also Addendum item 14.) The requested limits are typical for public entity contracts in Arizona.

3. Section 5.2.4 asks us to provide information on our ability to perform work “in regard to Scope of Work”. Could you provide further clarification on the Scope of Work?

To the extent that it’s defined, the scope of work is what’s defined in Section 5.1.

4. In Section 5.2.4 of the RFP, the “Scope of Work” is mentioned, and this term is capitalized. This makes me think that there should be another section within the RFP entitled “Scope of Work,” which describes the specific types of work you are seeking from firms such as mine. However, we don’t see any description of “Scope of Work” elsewhere in the RFP.

To the extent that it’s defined, the scope of work is what’s defined in Section 5.1.

5. Should the RFP place a particular emphasis on any particular industry?

No.

6. How many other firms are competing?

The Request for Proposal was emailed out to approximately 80 firms, was advertised in a regional newspaper and posted online at the UofA Procurement website.

7. Is preference given to Arizona-based firms?
8. **What is your annual IP budget?**

Budgets vary by University and will vary from year to year.

9. **The award of the RFP is through March 31, 2019. Over the course of five years many firms will increase their hourly rates. Will the rates we propose in our response be frozen until 2019, or will we be able to adjust as our rates increase over the next five years?**

Rates may vary over the course of five years with sufficient notice. As described in Exhibit A, Individual Project Descriptions (IPDs) will be created for discrete efforts. IPDs will include a description of services, the effective date and the total amount of fees and expenses, any excess of which will require written approval.

10. **How many firms were selected as an IP legal provider during your last IP RFP?**

Approximately 20, but that was a one year contract for the University of Arizona only.

11. **The proposal states that “specific matters will be assigned by each University on a case-by-case basis.” Who makes the decision to select which law firm will receive specific matters?**

The Office of the General Counsel and the university department initiating the matter.

12. **Are there any special circumstances or “hot buttons” that we should be aware of?**

No.

13. **Who is responsible for managing the competition process? Who else will be involved in making the decision?**

The RFP process is being managed by the University of Arizona Procurement and Contracting Services. A committee will be established to review the responses to the RFP and issue award(s).

14. **The following question is in regard to Section 6.2 (Legal Worker Certification) of RFP #L051411, due on February 14th at 2:00 pm, MST. Section 6.2 refers to immigration laws and regulations, specifically with regards to the employment verification pilot program (ARS 23-214A). If an offeror is not covered by ARS 23-241A either due to non-state licensee status and/or because it does not employ Arizona workers, will its proposal still be deemed responsive if it states that it is exempt and provides the basis for the exemption?**

Proposer should consult with counsel and review the applicable statutes.

15. **The second question relates to the professional liability insurance limits in Section 17(A)(4), which require coverage of “minimum combined single limit of $1,000,000 for each occurrence and $3,000,000 aggregate…” In speaking with my malpractice insurance agent,
he has indicated to me that the only policies that are traditionally sold are either 2 million aggregate/1 million per occurrence or 4 million aggregate/2 million per occurrence. In obtaining the previous contract (which also had the 3 million aggregate requirement at the end), ABOR counsel waived that requirement for me as I currently have 2 million aggregate/1 million per occurrence insurance. Are the Purchasing Parties willing to clarify this requirement in this document to reflect either 2 million aggregate/1 million per occurrence or 4 million aggregate/2 million per occurrence?

The University would be fine with a modification of the required professional liability limits to be $1 million per occurrence, $2 million aggregate.

16. Does the University have a policy about its counsel representing startups that license technology from the University?

The University has a conflict of interest policy and counsel are governed by applicable conflict of interest rules. Waivers of Conflict are available in specific circumstances.

17. Would the University consider a practitioner with a Ph.D. or other advanced technical degree who is currently attending law school and assisting the firm in patent prosecution matters relevant to their technical expertise to demonstrate the five years of relevant experience required in section 5.2.4?

No.

18. Although our firm represents a wide variety of clients, we are wondering whether, in the event that we are not able to provide information regarding five service accounts that are universities, but rather are only able to provide information regarding clients that are other than universities, will this fact alone automatically preclude our firm from being selected to represent the Arizona state universities, or substantially reduce our firm’s chances of being selected as a result of this RFP process?

We will take all relevant experience into account in evaluating the proposals. Not having five university clients would not automatically preclude a firm from being selected.

19. Given that our firm has been and continues to represent you (we of course appreciate this ongoing relationship very much), is there any specific information we should provide about this relationship as part of our RFP submission, and can information regarding this relationship serve as a sufficient basis for allowing our firm to have a chance of being selected via this RFP process, even if we are not able to provide information about other service accounts involving other universities?

Please provide any information you deem relevant.

20. There is a request for an Excel spreadsheet with each attorney’s expertise described in key words. Does “each attorney” refer to all attorneys in our firm or to just those attorneys
identified as key personnel in our submission to the RFP?

Just those identified as key personnel.

21. Is there a page limit for the submitted proposals? If so, will the Excel spreadsheet count towards the page limit?

No.

22. The model contract provided seems to have many contract terms especially pertinent to a subcontractor performing on-site work. Does the University have flexibility in its negotiation of the terms in the model contract?

There may be limited flexibility. Please submit any edits to the Agreement with your proposal response.

23. Certification 6.2 appears to require the Firm to certify (1) compliance with A.R.S. § 23-214(A); (2) compliance with all applicable federal immigration laws and regulations; and (3) use of E-verify for all employees hired after December 31, 2007.

Certification of item 2 does not present a problem. This question pertains to certification of items 1 and 3.

The Firm is a nationally-based firm with its principal office in Detroit, Michigan, and it has offices in Michigan, Tennessee, Nevada, Ohio, Washington D.C., and Arizona, as well as Toronto, Canada. Because this proposal seeks the provision of services related to intellectual property law, which primarily involves federal law, it is likely that services under any contract awarded may be provided by attorneys in any of the Firm's United States offices, not just Arizona. Only Arizona (as required by state law) and Tennessee use E-Verify in their hiring. Although this fact is not relevant to the question being presented, we note that it is also likely that some, if not many, of the services to be provided under any contract awarded would be provided by members of the Firm, who are not employees and not subject to employment eligibility standards in any event.

Item 1 (certification of compliance with A.R.S. § 23-214(A)): As we understand the referenced statute, it requires the use of E-verify only for employees who are to be employed, and provide services, in Arizona. We thus believe that certifying compliance with A.R.S. § 23-214(A) would not mean, or require, that the Firm use E-Verify in offices where it currently is not used, even if attorneys in those offices may provide services under the contract. Kindly confirm that our understanding on this point is correct.

Item 3 (certification of the use of E-verify for all employees hired after December 31, 2007). As set forth above, only two of the Firm's United States offices use E-verify. We believe that this part of certification 6.2 is designed to enforce A.R.S. § 23-214(A), and not to require the use of E-Verify in offices outside of Arizona. For the reasons stated above, the Firm cannot certify the use of E-Verify, during the referenced period of time required by Arizona law, in offices other than Arizona. Kindly confirm our understanding of this point is correct, and let
us know if any revisions may be made to this part of the certification to clarify that the Firm does not certify the use of E-Verify, during the referenced period of time, outside of Arizona.

Proposer should consult with counsel and review the applicable statutes.

24. The scope of work requested is very broadly defined as provided below:

“1.1 Summary. The Arizona Board of Regents (ABOR), on behalf of the University of Arizona, Arizona State University and Northern Arizona University (Universities), is soliciting proposals from interested vendors to furnish the Universities with legal services for intellectual property matters through the Universities’ respective Offices of the General Counsel (OGC) on an as-needed basis. The University of Arizona (UA) will administer this RFP.”

Our firm provides complete services in the intellectual property areas of: patents, trademarks, copyrights, litigation in all three of these areas and clearance opinions in all three areas. To allow us to provide the most complete response please clarify which of these areas you are requesting legal services for and to the extent possible the expected volume of requests reasonably expected in each area per year.

See answer to #8 above for volume of requests. Each University will vary in it’s budget and the volume of requests in any given year. AUTM information may provide an idea of past years activities. The vast majority of expenses were for patent prosecution. See also #25, #26, #27.

25. For legal services in patent prosecution and patent litigation please identify the areas of technology for which you expect to request legal services. In addition, please provide the volume of reasonably expected requests in each area of technology.

Large research institutions inherently cover a wide breadth of topic areas. Each University will have a wide range of technology areas, including but not limited to pharmacology, medical devices, bio-med, engineering (of all varieties), optical science, software and more. More specific information is not available.

26. To allow for the most accurate response possible please provide the intellectual property budgets for each University for the past 5 years and the number of matters by category of patent prosecution, patent litigation, trademark filing, trademark litigation, and copyright matters. This may allow for the possible calculation of a flat rate proposal.

We do not have this information available.

27. With respect to patent matters will you require patentability opinions and/or clearance opinions? Similarly, will you require trademark clearance searches and/or opinions?

In general in a University setting, opinions and clearances are rare. The majority of interaction is related to patent drafting and filing, with occasional forays into other areas. At the University of Arizona, for instance, trademark clearance searches and/or opinions are very infrequent and patentability opinions and/or clearance opinions are even more rare.
28. According to the “Agreement for Intellectual Property legal Services” the following will apply

“For each patent project bearing a TTA (Tech Transfer Arizona) file number, TLA will prepare and transmit to Legal Services Provider an Individual Project Description that will include the description of services, the effective date, and the total amount of fees and expenses, any excess of which will require written approval by Tech Transfer Arizona.”

Will the Individual Project Description include an invention disclosure or will the Legal Services Provider be permitted to meet with the inventors to obtain the invention disclosure? In addition, will the Legal Services Provider be permitted to meet with inventors as required during preparation of the patent application?

This is specific to the University of Arizona. While an invention disclosure will be provided (along with other available and appropriate materials), discussions with inventors are also a potential avenue. All such interaction will be coordinated and approved through TTA. Other Universities may have similar processes.

29. I note that the workers Comp requirement includes a policy limit of $1,000,000 for disease.

My office is in Oregon, where the statutory limit requirement is a $500,000 across the Board, and I cannot understand why in a law office there would be a need for a disease insurance component anyway. Can I simply provide the Oregon legal limit?

Worker’s Compensation insurance and limits for Employer’s Liability and Policy Disease limits that comply with the offerer’s home state laws will be acceptable to the UA.

30. (My firm has) adequate professional liability insurance to satisfy the RFP and contract, and I have a general personal liability policy. However, I do not carry general commercial liability insurance. Given that my only work product is legal services and that my professional liability policies cover contractual as well as tort liability, I believe that a general commercial insurance policy is an expense that is unnecessary to protect me or the University of Arizona. Is there any basis for exempting me from that requirement?

Based on the described scope of work, the University is OK with approving a waiver of the requirement for CGL insurance coverage, and relying on the professional liability policy.

31. Is it possible to provide more detail regarding the types of intellectual property counseling involved in the RFP (for example, are you looking for assistance with patent prosecution, licensing and technology transfer, patent enforcement)?

The overwhelming majority of the work envisioned under this RFP is for patent prosecution. Is it possible to provide more detail the regarding the types of technology involved in the matters handled through the University of Arizona’s, Arizona State University’s and Northern Arizona University’s respective Offices of the General Counsel?
Information about technologies coming from each of the Universities is available on their respective websites or may be viewed on the USPTO’s website by looking at patents assigned to each University. (See also Q. #24)

32. Regarding Section 5.2.4, could you please advise if you have a specific excel format that you would like us to follow for this question? Also, could you expand on the types of “key words” that you would like highlighted for each proposed attorney?

See answer to question #1.

33. In 3.6.2 regarding the submission process, the University requests a copy of the RFP response in electronic form in Microsoft Word. However, in section 5.2.4 under Proposer Qualifications, the RFP requests a Microsoft Excel sheet with each proposed attorney’s qualifications described in keywords. Would you prefer this table be included in the electronic MS Word document response? Or should we include the MS Excel sheet in addition to the MS word document as part of the electronic files submitted?

We would prefer that the excel spreadsheet be submitted along with the MS Word document response.

34. The RFP requests descriptions of knowledge, technical expertise and broad experience in intellectual property law, preferably involving the representation of universities or similar entities. Are there any particular technological areas or issues in which the university is interested in engaging counsel?

In general, no specific areas. Universities have strength across a wide breadth of technology areas, and any of them may result in intellectual property that the University wishes to protect. (See also question #24)

35. Clarification: Contracts issued to firms or counsel under RFP #071203 (issued by ASU in FY 11-12) shall remain in full force and effect, pursuant to the terms of such contracts, and shall not be amended, altered or terminated by any award of a contract pursuant to this RFP #L051411.

All else remains the same.