Procurement and Contracting Services

Request for Proposals for Legal Services for Intellectual Property

ADDENDUM #2

Please mark all proposal submission Envelopes with the following information

Sealed RFP # L192009
Due on February 14, 2020 no later than 2:00 PM, MST
The following questions were received before the technical question/inquiry due date of February 4, 2020 at 12:00PM MST:

1. In reviewing this RFP, I noticed that the Certification of Proposal in Section 6.1 refers to # L051411 – it seems like the Certification should refer to # L192009?

   The correct RFP in section 6.1 should be L192009, feel free to cross through the old number and write in the correct RFP number.

2. Regarding the minimum insurance requirement in section 4.19 of the RFP, does the insurance policy need to be a “commercial general liability” policy? More specifically, does clause 18A in the Legal Services Agreement require the Successful Vendor to have four different insurance policies (i.e., one for general commercial liability, one for automobile liability, one for worker’s compensation/employers’ liability, and one for professional liability)? Under “Commercial General Liability” section, what is meant by “general aggregate”?

   The University will require Commercial General Liability (CGL) and Professional Liability or a hybrid policy that covers both.

   Commercial Auto Liability will not be required for this RFP.

   Workers’ Compensation is a requirement by the State of Arizona (please see A.R.S. §23-901, §23-902).

   General Aggregate is the maximum amount of money that the insurer will pay out during a policy term.

3. The insurance requirements between these two sections differ (e.g., Commercial General Liability Insurance in Paragraph 18 of the ALS requires $1,000,000 for each occurrence while Section 4.19 of the RFP requires $2,000,000 each occurrence). Of the two, please confirm which controls.

   The requirements are as follows:

   CGL Limits are $1 million each occurrence/$2 million general aggregate.

   Professional Liability/E&O is $1 million each claim/$2 million annual aggregate.

4. As a law firm, the products are legal work products, which are covered by our malpractice insurance. Thus, would the malpractice insurance policy cover the “Products-Completed Operations Aggregate” requirement? Also, under insurance, please clarify what is meant by the “Blanket Contract Liability”? Would our malpractice insurance cover this as well?
In general, malpractice insurance is analogous to Professional Liability/Errors & Omissions coverage, any certificate provided to meet the Agreement for Legal Services will be reviewed.

The Products-Completed Operations coverage is a standard component of a CGL policy, even if the primary business of the policyholder does not include a Products-Completed Operations exposure

CGL should include coverage for Blanket Contractual Liability if the contract is an “insured contract.” You will want to ensure that the coverage is part of your CGL.

5. Finally, as a law firm, we do not have a company vehicle. Thus, do we have to have a separate automobile liability policy? Any clarification regarding the specific insurance requirements for law firms bidding for this specific RFB for legal services would be appreciated.

Commercial Auto Liability will not be required for this RFP.

6. Which indemnity clause, section 4.18 of the RFP or clause 19 of the Agreement for Legal Services, applies to this RFP for legal services? If both are intended to apply, which one takes precedence when there is an inconsistency? If the ALS controls, could the indemnification language in Section 4.18 of the RFP be supplemented with the ALS Provision?

The language in the Agreement for Legal Services will apply.

7. Our firm has some concerns with the “Agreement Terms and Conditions” (Section 4.0) incorporated into the AGREEMENT FOR LEGAL SERVICES (MSA). As an example of a concern, in the indemnity language (Section 4.18), we can agree only to an indemnity that is limited to the negligence of our attorneys. We cannot indemnify for any claims arising from our work and cannot indemnify for the acts of third parties (subcontractors). Should these be addressed before submitting a response or incorporated into our response along with proposed changes to the MSA?

The Agreement for Legal services will be the governing document. Any changes to the MSA can be submitted with the RFP Response.

8. Under Section 4.20, please clarify what is included in the “all forms of legally protectable intellectual property…” (e.g., does this include IP litigation, opinion work, post-grant proceedings with the USPTO). The defined scope will likely affect the service accounts and key personnel we highlight in our response.

Almost all the work assigned is for patent filing and patent prosecution. Occasionally, Purchasing Parties will ask for opinion work on patentability, inventorship, ability to operate, etc. Thus far, Purchasing Parties have not been
involved in post-grant proceedings with the USPTO or litigation. Over the past 5 years, Purchasing Parties did have one case where a patent was opposed by a third party in a foreign jurisdiction. Purchasing Parties have a very limited number of Trademark cases under the RFP for IP Legal Services – typically, the University OGC office handles Trademarks for the University using attorneys qualified under a separate RFP. Purchasing Parties typically do NOT register copyrights but may.

9. Throughout the duration of this engagement, of the following IP specialties, where does the Arizona Board of Regents anticipate their legal counsel will provide the most support? Please identify the top three (3) in numerical order of priority and legal need:

   a. Patent Preparation, Patent Prosecution, Post-grant Proceedings with the USPTO, Trademark, Copyright, IP Litigation

      See # 8 above.

10. For customer references (section 5.2.2 of the RFP), do the client references have to be clients that have been clients continuously from 2014 to present, or are client references established after 2014 to present acceptable?

    Client references established after 2014 to present acceptable.

11. Please confirm that clause 28 of the Agreement for Legal Services applies to this specific RFP for intellectual property legal services. If it does apply, please explain what PHI the law firm would be exposed to and if the law firm could expressly decline to receive any PHI.

    Clause 28 would apply in the event PHI is provided. Selected vendor may decline to provide services at the time it is requested.

12. 5.2.4 requests a list of “patent attorneys” on the attached Excel spreadsheet. Is this list limited to only patent attorneys as defined with respect to “proposer's attorneys”, or is it intended to include patent agents and technical specialists?

    Patent Agents and Technical Specialists may be included on the Excel spreadsheet. Purchasing Parties expect attorney overview and approval for all work performed by the firm.

13. For not-to-exceed (NTE) pricing, is ABOR asking about openness to using NTE models or should specific figures for work items be included?

    Purchasing Parties are asking about openness to using NTE models. Almost all work is done on a not-to-exceed (NTE) basis, including all costs expected within a defined period of time (e.g. within one year of filing a provisional or US Utility patent; prior to national stage for a PCT; within the shortened time frame for an Office
Action). Firm, fixed prices for standard actions may be defined on a case-by-case basis. Hourly rates have not been authorized in the past.

14. Will you clarify the definition of intellectual property services the RFP covers? Does the RFP cover all aspects of intellectual property or is the RFP related to specific intellectual property areas (i.e. patent prosecution, patent litigation, licensing, copyrights, trademarks, trade secrets, etc.)?

See #8 above.

15. Are there specific technical areas for which the University of Arizona and Northern Arizona University (“Universities”) are seeking legal assistance and expertise?

See #8 above.

16. Do the Universities have a maximum limit on the number of attorneys, agents, advisors, paralegals, and technical advisors for the team that will handle the matters awarded to a particular law firm?

No. Attorney overview and approval is expected for all patent matters handled.

17. Under Section 3.7.8, pricing information is not considered confidential. Will you provide examples of the types of information that will meet the definition of confidential in section 3.7.8 of the RFP?

The University can generally keep references and proprietary business practices confidential.

18. From Section 5.2.2, we understand that we must provide five (5) service accounts represented and that those service accounts should be for universities or similar entities. Will you provide examples of similar entities that meet this qualification?

University entities are preferred. Other entities will be considered – the firm can provide a very short description of similarity. Some examples might include patent filing or prosecution work for the National Institutes of Health or the Department of Veteran Affairs.

19. From Section 5.3.1, we understand that the Universities most often use not-to-exceed pricing for a defined scope but may also consider firm, fixed pricing or other alternative fee schedules. Can you provide examples of the types of alternative fee agreements that are acceptable by the Universities?

Under past proposals, not-to-exceed pricing and firm, fixed pricing have been the sole methods used, but the Universities may consider other alternatives provided by a firm.
20. Is there a preferred format for firms to submit their proposal?

There is no particular format required for the response other than what is specified in section 3.5-3.6.

21. Is there a preferred format for firms to provide resumes of the patent attorneys submitted with the proposal? Are their firm biographies sufficient?

A link to the firm’s website is permissible. Firm biographies are sufficient.

22. If we have an existing pricing arrangement with the Arizona Board of Regents (including an ongoing freeze), should we use that pricing arrangement as the basis of our fee proposal for this engagement, or are we permitted to propose a different fee arrangement that would be in effect for the five-year term of this engagement?

Firms are not locked into existing price arrangements. Most pricing is done on a not-to-exceed basis for each individual scope of work proposed over the course of this RFP (e.g. each new patent application to be filed or office action with a response due) and pricing is not locked in or frozen except as it applies to that particular matter. Firm-fixed prices for particular types of work may be locked in for a defined period of time if agreed to by both the firm and the Universities but need not be locked in for the entire 5-year term of the RFP.

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.)

23. Does the scope of work referenced in the RFP include patent services only, or does it also encompass other areas of intellectual property law? Can you provide a description of the scope of IP services the Universities are seeking?

See #8 above.

24. Section 5.2.4 of the RFP states, “Detailed resumes of key personnel will be required to demonstrate at least five (5) years of recent relevant experience.” Does this mean that each of our proposed team members, including all attorneys, patent agents, scientists, and engineers, must have 5 or more years of experience? If so, may we count relevant technical or other work experience in addition to law firm experience?

Attorneys who will oversee and approve work by the firm should meet the 5-year requirement.

25. Could you please clarify if we are to submit the signed MSA with our response, or would we do so upon award?
If the Agreement for Legal Services (MSA) is acceptable, please fill out as appropriate and return the MSA executed on page 9 and Exhibit A. Please be sure to leave the effective date blank as that will be added when countersigned by the University.

End of addendum, all else remains the same.