



Request for Proposals
Patent Portfolio Management Services
0007

Published: January 2022

Deadline: open

Applications will be reviewed on a rolling basis as they are received, until the deadline date.

Request for Proposal

1.0 About IAC

The Innovation Asset Collective (“IAC”) is a membership based registered not-for-profit organization with the mandate of assisting Canadian small and medium-sized enterprises (SMEs) in the data-driven clean technology (DDCT) sector to leverage intellectual property (IP) to compete and scale. Specifically, IAC’s core program offering for member companies (“Members”) includes assembling promising portfolios of patents to secure freedom to operate; providing Members with IP education and support in building their IP strategy to drive revenue growth through ownership of market differentiating innovation; granting funds to Members in support of implementing their IP strategy; and providing Members access to IAC’s market and patent research to inform strategic decisions. The goal for IAC is for Canadian cleantech SMEs is to be capable of maximizing the value of their intangible assets to succeed in Canada and beyond.

IAC is funded through a Contribution from Innovation, Science and Economic Development Canada (ISED) to support innovation and the protection of Canadian IP.

2.0 Background

As IAC grows its collective of patent assets for the purpose of supporting its members in technology areas which provide them a level of clearance and in some instances a defensive value, IAC will require patent portfolio management services to ensure proper transfer of assets, timely payment of maintenance fees, filing of continuations, and the prosecution of any pending applications. Given the assets may span across diverse technologies both in and out of the cleantech space, it is important that respondents include indicators of their respective areas of technical expertise, in addition to the below items listed in section 3.

3.0 Scope of Work

The scope of work for the management of IAC owned assets is for the purpose of maintaining and growing the value of the assets for the benefit of IAC members. In that effort, while the following responsibilities are to be expected, the list is not exhaustive, and more could arise over time as the portfolio grows and requests occur in relation to the asset(s):

- Ensure proper chain of title and file assignments with respective Patent Offices.
- Make sure all the necessary Maintenance Fees are paid in time.
- Provide timely notices to IAC regarding upcoming deadlines pertinent to any asset.
- Make recommendations regarding Re-Issue, Re-examination, and/or Opposition proceedings, if any.
- For pending applications, ensure proper requests for examination, responses to Office Actions, requests for continued examination, payment of issue fees, filing and drafting of continuations, and any other related actions are properly performed to maintain or increase the value for IAC members.

4.0 Proposal Information

Proposals to IAC in response to this RFP should include the following:

- Company name and address.
- Key Contact Information, including name(s), email, and phone number.
- Budget formula for completing deliverables listed in Scope of Work. This can take the form of an hourly rate range, or a fix price for performing a list of actions.

- A summary of the applicant's background and qualifications as it relates to the Scope of Work as well as prior demonstrated experience in relation to IP and the IAC mandate (if applicable). If multiple individuals are likely to work on this project, please provide a list, with all relevant background and qualifications information.
- Resume or CV of Key Contacts listed above.
- The names and contacts of two references who can testify to the quality of work related to the Scope of Work.

5.0 Timeline

IAC will be requesting portfolio management work on a regular basis as asset acquisitions ramp up. Patent portfolio management services should commence as soon as the assets are transferred to IAC. Any relevant timelines will thus be agreed upon once a service provider is retained, and subsequently for every relevant action.

6.0 Evaluation Criteria

Submissions will be evaluated on the following criteria:

- **Patent Portfolio Management Services.**
- **Prior relationship with IAC.** We value relationships with individuals and firms who have supported our work in the past, but we are also committed to growing the IP ecosystem in Canada, and therefore also seeking to build our network of vendors and specialists across the country.
- **Budget** IAC will assess value for money of all projects. As IAC is funded by the Ministry of Innovation, Science and Economic Development, we have a responsibility to Canadian taxpayers in awarding contracts to maximize the value to IAC and its Members.

If you have questions about the process or any of the content in this RFP, please contact ckibjis@ipcollective.ca. IAC will respond to all questions received and share responses back with all interested applicants within 3 business days.

7.0 How to submit

Please submit your full applications by email to Colin Kibjis at ckibjis@ipcollective.ca by the deadline listed on the coversheet. Applications will be reviewed on a rolling basis until an applicant is selected or the deadline.