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**TERMS OF REFERENCE FOR CONSULTANCY SERVICE TO PROSECUTE  
INTELLECTUAL PROPERTY OF UNIVERSITY OF KELANIYA**

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Accelerating Higher Education Expansion and Development (AHEAD) operation  
University Business Linkage Cell (UBL Cell)  
University of Kelaniya

**Procurement No: AHEAD/RA3/UBL/KLN/CON/01**

## **1. BACKGROUND**

### **1.1. About the Sector Strategy**

The development of the higher education sector is of central importance to enable Sri Lanka to develop from a Lower-Middle Income Country (LMIC) to an Upper Middle-Income Country (UMIC). Recognizing this, the Government of Sri Lanka (GoSL) and the World Bank have agreed, as part of the Bank's Country Partnership Strategy (CPS) FY17-FY20, to support the higher education sector through a Bank funded Accelerating Higher Education Expansion and Development (AHEAD) operation.

### **1.2. Brief Description of the Project**

Accelerating Higher Education Expansion and Development (AHEAD) operation is organized into two components. The first is a Program Component that supports the national Higher Education Development Program (HEDP). The second is a system strengthening, capacity building and technical assistance component that will assist GoSL to strengthen the higher education sector and achieve the objectives of the AHEAD program component. This second component will also cover monitoring and evaluation, policy analyses, program coordination and communication.

The implementing agency is the Ministry of Education (MOE). The MOE will be assisted at the national level by the University Grants Commission (UGC) and the Sri Lanka Institute for Advanced Technological Education (SLIATE). The Operations Monitoring and Support Unit (OMST) of the MOE will coordinate and support all AHEAD activities between the MOE, UGC, SLIATE, Universities and Advanced Technological Institutes (ATIs) and all non-state Higher Education Institutions under the MOE.

Under the Research, Development and Innovation Results Area of the AHEAD program there will be different types of support: (a) Development Oriented Research (DOR) grants for research activities leading to publication and dissemination of research; (b) Research, Innovation and Commercialization (RIC) grants for research and innovation activities leading to intellectual property (IP) such as patents and copyrights, and the promotion of university-business linkages for the commercial development of these IPs by private sector firms and companies; (c) Innovation Commercialization Enhancement Grants (ICE); and (d) development of the policy and enabling environment for research, innovation and commercialization activities by universities and research institutions.

A Consulting Firm with a track record on undertaking protection of intellectual property is required to enhance the patent portfolio of universities under the AHEAD operation.

## **2. OBJECTIVE OF THE ASSIGNMENT**

The main objective of the assignment is to provide the consultancy service to the University of Kelaniya to prosecute Intellectual Property of University of Kelaniya arising from the research conducted by the University researchers. A Consulting Firm with a proven track record on undertaking protection of intellectual property is required to provide the necessary support for the researchers to protect their innovative research work.

## **3. SCOPE OF THE ASSIGNMENT**

The consultant in consultation with the University Business Linkage Cell of University of Kelaniya should draft and file the patents for novel innovations at National Intellectual Property of Sri Lanka and/or draft and submit the responses for the Office-actions requested by the National Intellectual Property of Sri Lanka for already filed patents by the University of Kelaniya.

## **4. DURATION OF THE ASSIGNMENT**

The duration of the contract will be 34 weeks commencing from 22.09.2022.

## **5. KEY TASKS AND RELATED ACTIVITIES**

A. The consultant should perform the following as the tasks of the assignment.

- I. Filing New Patents
  - i. Search on novelty and patentability
  - ii. Patent drafting, with complete specifications, patent drawings/illustration
  - iii. Filing of a Patent Corporation Treaty at WIPO if applicable

iv. Responding to Office-actions and other Patent prosecution matters

II. Responding to Office-actions and other prosecution matters for already filed patents at National Intellectual Property Office (NIPO)

B. The consultant should follow up until the relevant IP is obtained or a final decision given by the relevant authority, and it should inform to the University of Kelaniya.

## 6. DATA, SERVICES AND FACILITIES TO BE PROVIDED BY THE CLIENT

The required data including experimental results, prior publications, analysis of the cited prior arts and other technical details, when necessary, will be provided by the client. And the documentation including preparing the cover letter, consent letter and the application forms will be done by the UBL Cell. When the new patent specification or the amended patent specification is completed by the consultancy firm, filing of new applications and amendment to NIPO with the required filing fees will be directly handled by the UBL Cell.

## 7. DELIVERABLE AND TIME FRAME

I. Filing New Patents

<b>Related Task &amp; Activity No.</b>	<b>Required Deliverable</b>	<b>Time frame (after signing the contract)</b>
i	<u>Inception Report along with the Work Plan</u> including the schedule of meetings and zoom discussions to be held with the research teams.	One (01) week
ii	Novelty and patentability search report	Two (02) weeks
iii	<u>Copy of the IP application</u> certified by the relevant researcher along with other relevant documents	During the six (06) weeks
iv and v	Original Documents sent by the relevant authority related to the decision and all other documents related to prosecution of IP	Twelve (12) weeks

II. Responding to Office-actions and other prosecution matters for already filed patents at National Intellectual Property Office (NIPO)

<b>Required Deliverable</b>	<b>Time frame (after signing the contract)</b>
<u>Inception Report along with the Work Plan</u> including the schedule of meetings and zoom discussions to be held with the research teams.	One (01) week
Copy of the Response for office-action certified by the relevant researcher along with other relevant documents	During the four (04) weeks
Original Documents sent by the relevant authority related to the decision and all other documents related to prosecution of IP	During the eight (08) weeks

## **8. REPORTING THE DELIVERABLES**

The consultant shall closely coordinate and report to the Director/University Business Linkage cell – University of Kelaniya.

## **9. PROCEDURE FOR REVIEW OF DELIVERABLES**

The deliverables of each assignment will be reviewed by a committee (not exceeding three in number) appointed by the Director OTS including the Director/UBL Cell and the principal investigator of the research. The payment will be made upon the recommendation of the committee.

## **10. EXPECTED QUALIFICATION OF THE CONSULTANT**

- 1) The Consultant should have at least 10 years' experience and track record on filing Patents, Industrial designs, Trademarks and copyrights successfully. State any international filing entities such as at USPTO, EPO, JPO, KIPO and filing of PCTs.
- 2) Consultant should identify a team consisting of key personnel from a wide variety of disciplines under STEM (Science, Technology, Engineering, Mathematics) research areas, the team members should have the following qualifications, relevant skills and experience.

### Educational

A Bachelor's degree in Biological Science (Chemistry, Zoology, Botany, Microbiology) or equivalent qualifications related to the field from a recognized university/institution.

- I. A Bachelor's degree in Physical Science, Engineering, Computer Science, Information Technology or equivalent qualifications related to the field from a recognized university/institution.

### Experience

- I. At least 5 years of experience in patent drafting.

### Additional Qualifications

- I. Proficiency in handling correspondence and writing reports in English.

## **11. PAYMENT SCHEDULE**

Consultant should have to propose unit rates for separate steps of the IP life cycle of each assignment such as;

- Patentability and novelty searches,
- Preparation of patent draft including claims,
- Office action responses and other IP support services catering to the needs.

The payments will be released based on the satisfactory completion of the related tasks and activities.

## **12. OWNERSHIP OF THE ASSIGNMENT**

This assignment is based on the research and innovations of the University of Kelaniya and therefore, the Consultant should have to maintain high level of professionalism and confidentiality during the prior and post stages of the assignment. In any grounds, the Consultant will have no rights to disclose or use research findings or inventions and related Data and Information gathered through the assignment for other purposes without written permission from the University of Kelaniya.

The assignment will be funded by the University of Kelaniya, and therefore it shall be the owner of the assignment and the University of Kelaniya will reserve the Intellectual Property Rights for all the selected research under the assignment.

## **13. METHOD OF SELECTION**

### **Consultant's Qualification Selection (CQS)**

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