1. **PURPOSE**

The University of North Carolina and its constituent institutions, affiliated entities, and affiliated enterprises (University) are soliciting proposals from attorneys and firms to provide intellectual property counsel services, including those services related to patent, trademark, copyright and trade secret issues. The firms appointed under this Request for Proposal (RFP) may be asked to provide a wide variety of legal services relating to intellectual property and technology transfer, such as filing, prosecuting, and maintaining intellectual property protection; licensing; and prosecuting and/or defending claims of infringement.

The University will compile a list of approved firms, which firms will be eligible to provide services for three years, at rates no higher than the stated rates included in the proposals, without requiring further approval by the Attorney General or the Governor. Although each matter or potential transaction requiring legal services must be approved in advance by the institution seeking representation, the University believes that having a preapproved list with established standard rates will expedite the retention of intellectual property counsel.

Firms currently approved under the 2011 RFP must submit a new proposal in order to be considered for selection.

2. **INSTRUCTIONS TO OFFERORS**

2.1 **Submission of Proposals.** Written proposals responding to the needs outlined and in the manner specified in this RFP must be submitted by **July 9, 2014.** Proposals may NOT be mailed or faxed. One copy of the proposal should be submitted as a scanned copy saved in pdf format emailed to **UNCIPRFP@northcarolina.edu.** The cover letter should be addressed to:

The University of North Carolina – General Administration  
Attention: Karin Szypszak, Paralegal  
Legal Affairs – UNC General Administration  
P.O. Box 2688  
Chapel Hill, North Carolina 27515-2688

Submit only one proposal per law firm.

2.2 **Additional Information.** The offeror is responsible for inquiring about and clarifying any aspect of this RFP that is not understood. Questions should be addressed to Karin Szypszak, at karins@northcarolina.edu.

2.3 **Schedule.** Proposals are due on **July 9, 2014.** Thereafter, the selection of the firm(s) will be made as soon as practicable. We anticipate to finalize approval by early fall.

2.4 **Proposal Format.** Proposals should conform to the following specifications:

2.4.1 A cover letter included with the RFP, signed by an authorized person, should be completed and returned as page one of the proposal.

2.4.2 A one-page summary of the proposal should follow the cover letter.

2.4.3 Responses should be provided to each question asked in Sections 4 and 5 of this RFP. All information requested must be submitted.

2.4.4 The proposal should be prepared simply and economically, providing a straightforward, concise description of capabilities to satisfy the requirements of the RFP. Emphasis should be placed on completeness and clarity of content.
2.4.5 The proposal should be organized in the order in which the requirements are presented in this RFP. All pages of the proposal should be numbered. If a response covers more than one page, the paragraph number and subletter should be repeated at the top of the next page. Information which the offeror desires to present that does not fall within any of the requirements of the RFP should be inserted at the end of the proposal and designated as additional material.

2.4.6 The University complies with the North Carolina Public Records Act and proposals will be made available for inspection and copying in response to requests under the Act. N.C.G.S. Chapter 132. The University will, however, to the extent consistent with the Act, withhold proprietary or confidential information that constitutes a trade secret under the North Carolina Trade Secrets Protection Act, N.C.G.S.§ 66-152 et seq. In order to enable the University to make an evaluation of trade secret status of any document request, offerors should stamp each page of the proposal containing confidential or proprietary information, such as client information and liability insurance information, with the word “Proprietary” or “Confidential.” Offerors should be aware that, while essential to establish trade secret status under North Carolina law, such designation is not determinative. The University will determine whether or not disclosure is required under the Public Records Act at the time a public request is received. The University will post all accepted proposals to its public Web site after appointment, with all terms and conditions available for inspection.

3. **Scope of Work**

3.1 **General.** Counsel will assist the University in providing legal advice and services on matters involving intellectual property, including patent, copyright, trademark, and trade secret issues; technology transfer and licensing; and prosecuting and/or defending claims of infringement.

Each institution is responsible for retaining selected firms prior to receiving services. At that time, the institution will propose the scope of services and may provide individual institutional guidelines in addition to the specifications in this RFP.

3.2 **Specification.** The scope of work is expected to include, but is not necessarily limited to, the following types of work.

- Advice and counsel.
- Review of documents and informal advice.
- Drafting patent, trademark, or other intellectual property applications and handling the filing and prosecution of applications.
- Maintenance of U.S. and foreign patents and trademarks.
- Litigation to defend or enforce University intellectual property rights.
- Written opinions regarding inventorship, patentability, and infringement.

3.3 **Approval Period.** The firms approved for services will be eligible to provide services at the date of appointment and until terminated. The Attorney General and the University reserves the right to engage other counsel to provide legal advice and to terminate any appointment (including any appointment made pursuant to this RFP) at will at any time.

3.4 **Appointment.** Notwithstanding anything that may appear to be to the contrary, the University further reserves the right to appoint any law firms or individuals it deems most appropriate to represent the University in any engagement. While it is the University's intention to delegate work described above only to the attorneys or firms selected under this RFP, the University retains the right to make a different selection or handle any particular matter in-house if, in its judgment (concurred with by the Attorney General and the Governor, as may be necessary), the needs of the State of North Carolina require. The University makes no guarantee as to any request for representation or volume of work that may be referred under this appointment, only that the appointed firms may be considered approved for representation under the terms of the RFP.
4. **Qualifications of Offeror**

Please respond to all of the following:

4.1 **Primary Contact and Assigned Personnel.** Provide the name of the offeror and firm address and telephone number, and the name, title and e-mail address of the one individual who would be primarily responsible for this engagement. Identify the individuals who would perform the work in this engagement and describe how their responsibilities will be assigned and managed. Provide résumés for each person, including background and experience relevant to this engagement, and each person's capacity to provide advice as quickly as needed if the primary contact for the engagement is not available.

4.2 **Intellectual Property Expertise.** Describe in detail firm expertise with intellectual property law, including federal and state litigation and practice before the United States Patent and Trademark Office, on behalf of institutions of higher education. Include a brief statement of how this expertise has been obtained. Include a description of each participating attorney’s bar admissions and any experience with the University or other institutions of higher education.

4.3 **Other Areas of Expertise and Services.** Describe each attorney's knowledge and experience of other areas which you possess and believe are especially useful in providing advice and representation in intellectual property-related matters or may qualify your firm for this engagement. Include a brief statement of how the proposed individuals acquired this expertise and experience. Because individual University clients may give preference to firms with bundled services, invention commercialization strategies, and budgetary plans that assist the University in making prosecution decisions and reduce portfolio costs, describe any expertise or service strategies that address these areas.

4.4 **Changes in Laws and Regulations.** Briefly describe the offeror's process and resources for keeping abreast of changes in the area of intellectual property law. Please describe services that your firm provides pro bono, if any, to educate your clients in intellectual property law and technology transfer.

4.5 **References.** Please list and describe briefly any relevant engagement that may qualify the offeror for appointment under this RFP. Describe the offeror's role in the engagement and identify the persons who may be contacted as references (include dates, length of engagement, name, title, address, and telephone number for each reference). Please limit the response to no more than three recent engagements.

4.6 **Conflicts.** Any attorney or firm selected for this engagement would be precluded for the duration of the engagement from representing any client in any claim against or matter adverse to the University, including individual institutions and their respective employees in their official capacities. This prohibition will extend to any member of the offeror’s firm. If your firm is representing clients in matters where the exercise of your professional judgment in this engagement might be affected, please identify and describe each situation.

4.6.1 **If you are representing clients in litigation with the University, identify and describe each situation.**

4.6.2 **If you are representing clients in contract or other matters where, in your judgment, the exercise of your professional judgment on behalf of the University might be affected, identify and describe each situation.**

4.6.3 **If any member of, or associate in, your firm serves on any board, commission, committee or other organization related in any way to the University, and has a role in the procurement or contracting authority as it relates to this RFP, identify each such affiliation or membership. If any member of, or associate in, your firm serves in such a capacity, please provide documentary evidence, such as resolutions adopted by the firm, proving that such member or associate did not participate and has no authority to participate on behalf of the firm in the procurement or letting of a contract pursuant to this RFP. General membership in alumni associations, booster clubs, or associated entities, without the authority to influence the contractual relationships of the organization need not be disclosed.**
4.6.4 Please indicate whether any member of or associate in your firm currently serves as a member of the North Carolina General Assembly, or serves as a gubernatorial or legislative appointee to North Carolina boards, commissions, committees, or other organization.

4.7 Professional Liability Coverage. Describe your professional liability coverage for work of this type, including limits of coverage. Please attach a copy of the cover page of your policy.

4.8 Other Disclosures. Describe any investigations by governmental or authoritative bodies or disciplinary actions related to the firm or staff or disclosure of any past or pending matter that may reflect on compliance with laws or professional standards.

4.9 Nondiscrimination policy. The policy of the University prohibits unlawful discrimination because of race, color, religion, national origin, sex, pregnancy, childbirth or related medical conditions, age, marital status or disability. Describe your law firm's policies and practices that are consistent with this nondiscrimination policy, including any relating to attorney/employee hiring and retention.

4.10 Policy against knowing employment of unauthorized aliens. Please include a statement that your firm does not, and shall not during the performance of any contract pursuant to this proposal, knowingly employ an unauthorized alien as defined in the federal Immigration Reform and Control Act of 1986.

4.11 It is the policy of the University to encourage and promote the use of small contractors, minority contractors, physically handicapped contractors, and women contractors. (N.C.G.S. § 143-48).

5. PRICING PROPOSAL

PUBLIC INTEREST CONSIDERATIONS SHOULD PROMPT FIRMS CONSIDERING THIS RFP TO UNDERTAKE SERVICES AT SUBSTANTIALLY LOWER THAN THEIR NORMAL RATES IF THEY WISH TO BE COMPETITIVE FOR THE AWARD OF THIS APPOINTMENT.

5.1 Standard Billing Rates. Please list standard hourly billing rates for offeror and any persons identified in Section 4.1 of this RFP or other timekeepers (including paralegals) who will bill on an hourly basis.

5.2 Proposed Billing Rates and Methods. Please list any discount in hourly billing rates the offeror and any other persons identified in Section 4.1 or other timekeepers (including paralegals) are willing to offer under this proposal. While there are many creative ways in which a firm can supply lower rates, examples of favorable proposals might include: standard hourly rates subject to an agreed upon ceiling rate, standard hourly rates less an agreed upon percentage, flat rate proposals, or other billing methods. This fee structure will be the standard fee that will be available to the University, but it will not preclude the negotiation of a lower fee structure for individual engagements. You should also provide information on how you propose to keep track of, and charge for, any expenses. Incidental office expenses, such as photocopies, facsimiles, mailing postage, courier fees and office supplies will not be reimbursed as they are considered routine firm overhead. Occasional and extraordinary expenses, such as court filing fees, court reporters, expert witnesses and extraordinary photocopy costs, may be reimbursable if itemized with appropriate receipts or other appropriate documentation. No fees or expenses will be paid for travel time or mileage, except in cases when the attorney's travel exceeds 50 miles round-trip. Attorney travel in excess of 50 miles round-trip will be reimbursed if itemized with receipts or appropriate documentation, in accordance with guidelines of the retaining institution.

5.3 Billing and Payments. Selected counsel will bill for legal services under this appointment as required by institutional guidelines and individual retainers. Minimal requirements will include detailed statements that will permit thorough monitoring of legal services. The billing statement for each matter must contain a detailed description of the work performed on a daily basis, identifying all personnel involved, the hourly rates of the personnel involved, the amount of time expended and the authorized expenses and disbursements associated with the work performed. Billing rates set forth in the schedule provided in response to this RFP will remain in effect for the duration of the engagement unless University provides prior written agreement to the contrary. The University will not authorize payment for work that fails to comply with the terms and conditions stated herein, that is excessive or disproportionate in time or task, or that is contrary to any policy, term or condition as may be specified by applicable law, the Attorney General or the Board of Governors of the University of North Carolina system.
6. **Evaluation of Proposals**

   The University will review all proposals received as soon as practicable after receipt. No interviews are planned at this time. The University may, however, determine that interviews should be held with certain offerors, or that additional information may be requested of certain offerors for evaluation. Proposals will be evaluated on the basis of the offeror's qualifications under Section 4, the competitiveness of the firm's billing rates and charges to the University, and other material information contained in the proposal.

7. **Conditions**

   7.1 **Ownership of Proposals.** All proposals become the property of the University.

   7.2 **Adverse Representation.** By responding to this RFP, the offeror expressly agrees that, if appointed under this RFP, the offeror will not represent other parties in any action against or adverse to the University, including individual constituent institutions and their respective employees in their official capacities. This prohibition extends to any member of the offeror's firm. The offeror shall provide a list of all current or pending litigation adverse to the University, and shall be under a continuing duty to update the University with notice of any representation adverse to the University.

   7.3 **Changes in Personnel.** The University retains the right to approve or disapprove any proposed changes in the attorneys and personnel who may serve as counsel or who may provide services under this RFP, including any subcontractors. If counsel wishes to substitute personnel, counsel shall provide the University with a résumé of any proposed substitute, the opportunity to interview the proposed substitute and an explanation of the reason the substitution is necessary. Billings of any unauthorized personnel will not be paid.

   7.4 **Identification.** Any individual sole practitioner appointed under this RFP shall provide his or her social security number, and any proprietorship, partnership or corporation appointed under this RFP shall provide its federal employer identification number.

   7.5 **Subcontractors** (court reporters, expert witnesses, for example). All counsel awarded an appointment under this RFP shall be obligated as follows:

   7.5.1 Either to (i) pay any authorized subcontractor within fourteen (14) days of the selected firm's receipt of payment from the University for the proportionate share of the payment received for work performed by such authorized subcontractor under the contract; or (ii) notify the University and such authorized subcontractor, in writing, of any intention to withhold payment and the reason.

   7.5.2 These provisions apply to each subcontractor performing under the primary contract. Counsel's obligation to pay an interest charge to a subcontractor shall not be construed to be an obligation of the University.

   7.5.3 No work performed on behalf of the University may be subcontracted without prior written approval of the relevant University client.

   7.6 **Rejection of Offers.** The University reserves the right to reject any and all offers.

   7.7 **Fair Employment.** The offeror certifies compliance with federal and state laws regarding equal employment opportunity and agrees that the following clauses will be part of any contract for the services described in this RFP.
7.7.1 The contractor will not discriminate against any employee or applicant for employment because of race, religion, color, sex, national origin, age, veteran’s status, disability or any other basis prohibited by federal and state law except in those instances where the contractor establishes that an individual’s religion, sex, age or national origin is a bona fide occupational qualification, reasonably necessary to the normal operation of the contractor’s particular business or enterprise. The contractor agrees to post in conspicuous places, available to employees and applicants for employment, notices setting forth the provisions of this nondiscrimination clause.

7.7.2 The contractor will, in all solicitations or advertisements for employees placed by or on behalf of the contractor, state that such a contractor is an equal opportunity employer; provided that notices, advertisements and solicitations placed in accordance with federal law, rules or regulations shall be deemed sufficient for the purpose of meeting the requirements of this Section 7.7.2 and Section 7.7.1 of this RFP.

7.7.3 The contractor will include the provisions of the foregoing Sections 7.7.1 and 7.7.2 in every subcontract or purchase order over $10,000, so that the provisions will be binding upon each subcontractor or vendor.

7.8 Governing Law and Courts. Any contract resulting from this RFP will be governed in all respects, whether as to validity, construction, capacity or otherwise, by the laws of the State of North Carolina, without regard to its conflict of laws rules. Any litigation with respect to this RFP and any resulting contract shall be brought only in the state courts of North Carolina.

7.9 Termination. The University reserves the right to terminate any resulting contract without cause or liability of any kind.

7.10 Compliance with Laws and Regulations. Counsel shall comply with all applicable federal, state and local laws and regulations. Counsel shall also comply with such policies, procedures or guidelines issued now and in the future by the University (including those of the retaining institutions) for providing the services contemplated by this RFP.

7.11 Confidentiality. All work product prepared hereunder shall constitute confidential work product of the University and shall not be publicly disseminated or otherwise released without the express written approval of the University.

7.12 No Restrictions. There shall be no copyright, trade secret, or other restrictions upon the uses to which the University may put work product delivered to it.

7.13 No Consultation Fee. There shall be no fee for consultations regarding fees, costs, development of budgets, and feasibility.

8. SUMMARY OF RESPONSES. Using the sample chart below, summarize your responses to the RFP.

<table>
<thead>
<tr>
<th><strong>Firm</strong></th>
<th><strong>Contact/Location</strong></th>
<th><strong>Fee</strong></th>
<th><strong>Areas of Specialty/Comments</strong></th>
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<tr>
<td>Jones &amp; Smith, PA</td>
<td>Robert Jones, Esq., 123 Smith Road</td>
<td>University rate-5% of standard rate:</td>
<td>Experience in academic IP</td>
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<td></td>
<td>Charlotte, North Carolina</td>
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<td>licensing, copyrights, etc.</td>
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<td></td>
<td></td>
<td>Flat fees rates for preparation</td>
<td>Proposes 10% discount off standard rates; provides fixed-fees for certain services</td>
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