

REQUEST FOR COMMENTS ONLY - The United States Patent and Trademark Office (USPTO) is preparing to offer the opportunity for partnerships with industry to stimulate electronic filing and correspondence in regard to patent and/or trademark application filing with the release of PTO's first Request for Agreements (RFA). The USPTO would like to receive advance comments on the draft RFA from Industry. Comments may be submitted to the USPTO through e-mail at the following address: RequestforAgreement@uspto.gov. Written comments should be mailed to U.S. Patent and Trademark Office, Information Technology Contracts Office, Box 14, 2011 Crystal Drive, Suite 804, Washington, DC 20231, Att.: Anice Ogden 703-305-4176.

REQUEST FOR AGREEMENT (RFA)
60-PBPT-0-00001
for the
USPTO ELECTRONIC FILING
PARTNERSHIP (EFP)

RFA Solicitation No.: 60-PBPT-0-00001

Title: Project 1, Cooperative Marketing to Promote
Electronic Patent and Trademark Application Filing

Issued: TBD

Proposals Due: XXXXX ##, ####

See Section 3.0, Delivery of Proposal/Project Plan for Delivery
Instructions

Questions: call Anice Ogden, Contracting Officer at (703) 305-4175

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1.0 INTRODUCTION

The United States Patent and Trademark Office (USPTO) has established a strategic information technology goal of conducting business electronically with its customers over the Internet. Current plans call for expanding its electronic commerce offerings by adding electronic filing and communication with customers. USPTO is offering the opportunity for partnerships with industry to stimulate electronic filing and correspondence in regard to patent and/or trademark application filing with the release of USPTO's first Request for Agreements (RFA). This is a solicitation of proposals for non-monetary agreements only. No proposal for funding will be considered. In general, "agreements" are defined as non-monetary arrangements between two parties (commercial firm, not-for-profit organization, or any federal agency) and the USPTO. In this instance, any commercial or not-for-profit organization or federal, state or local government may submit proposals. Internal Revenue Service RFA for Electronic Filing was used as a model for this RFA.

1.1 Background

The PTO is one of the world's largest Intellectual Property Offices, processing in excess of 400,000 patent and trademark applications and in excess of 1,600,000 transactions in connection with these applications in 1999. These largely paper-based transactions include receiving and processing applications, responses to office actions, amendments, petitions, status inquiries, payments and other correspondence.

While some of the transactions are electronic, the PTO still devotes significant resources to convert much of the information provided by its customers and partners into an electronically processable format. There were 272,221 patent applications, 295,165 trademark applications, and 501,052 assignments of intellectual property rights filed in 1999. A total of 20,610 electronically filed trademark applications and a small number of patent applications were received in 1999. The USPTO Office is experiencing tremendous growth in application filings for both patents and trademarks. The patent filing growth rate for the previous five years has been 8 percent annually. In fiscal year 1999, however, PTO experienced almost a 13 percent growth rate. Similarly, the growth rate in the trademark area for the previous few years has been about 12 percent annually. Then, in fiscal year 1999, trademark filings went up over 25 percent. For 2001, the PTO is forecasting utility, plant, and reissue patent applications of 335,400 and trademark applications of 363,700. If these forecasts are realized, they will mean that patent applications have increased by more than 75 percent in five years and that trademark applications have more than doubled in six years. Such growth rates have presented challenges as well as opportunities to the USPTO and will continue to do so.

The USPTO has undertaken a number of pilot projects related to electronic filing of patent and trademark application information. The Electronic Application System (EASY) project was an early effort to implement the use of specific data tags and structured formats at the point of patent and trademark application creation and to submit structured patent application information in electronic form to USPTO using portable media (i.e. diskette). Based on USPTO customer response to the EASY pilot, the USPTO revised its electronic filing strategy to define "what" data as defined in Document Type Definitions (DTD) - must be filed and not the "how," thus avoiding a system that requires proprietary hardware and software to operate. Many USPTO customers use commercial-off-the-shelf (COTS) intellectual property (IP) management software products. The USPTO goal is for vendors of COTS IP management software products to

enhance their offerings with tools that will enable IP practitioners to prepare electronic applications and other correspondence that can be accepted by USPTO.

USPTO has implemented electronic filing over the Internet for trademark applications and has also implemented an Electronic Filing System (EFS) pilot for patent applications. USPTO can share the electronic filing approach and provide assistance to the COTS IP management software vendors for integrating these features into their products.

1.1.1 USPTO Electronic Filing Initiatives

1.1.1.1 Trademark Filing

The USPTO has implemented the Trademark Electronic Application System (TEAS). TEAS allows the applicant to complete a Trademark application, check it for completeness, and submit the completed validated application directly to the USPTO over the Internet. The applicant may pay the necessary fee(s) using an on-line credit card transaction or a USPTO deposit account. The USPTO plans to add additional business transactions to TEAS in April 2000 and implement electronic correspondence using e-mail in the summer of 2000. XML DTD's have been defined for the 7 most common Trademark transactions. These are listed in Appendix 1. TEAS is available at <http://www.uspto.gov/web/menu/tmebc/index.html>

1.1.1.2 Patent Filing

Currently four projects, in various states of development, are designed to accept Patent related electronic materials in a manner that can be used by the USPTO's offices.

1) Electronic Filing System (EFS): The USPTO has introduced a pilot for the receipt of specially authored XML electronic versions of patent applications from participating applicants. EFS is designed to create an XML encoded document for the USPTO. EFS uses another USPTO software application, the Electronic Packaging and Validation Engine (EPAVE), which is supported by the PTO's Public Key Infrastructure that grants filers digital certificates to secure the filings. EFS relies on the EPAVE secure delivery software for the submission of the XML document to the USPTO over the Internet. The submission of biotechnology sequence information is also supported by EFS and EPAVE.

2) Sequence Listings on CD: Submission of large biotechnology sequence listings on compact disks instead of paper, to avoid the printing, scanning, storing and transporting of these potentially very large patent application files. The USPTO has developed standards for the format of such submissions and hopes to move submission to electronic communication.

3) Computer Program Listings on CD: Large computer programs are currently submitted on a microfiche that are not printed with the patent. We will require these submissions to be on CD in compliance with USPTO standards and hope to move submission to electronic communication.

4) Electronic Filing System - Pre-Grant Publication (EFS- PG Pub): In support of Pre-Grant Publication of patent applications, the USPTO is planning for electronic receipt, for the purpose of application publication, of resubmissions of amended versions of patent applications, of redacted versions of patent applications, of applications requested to be published early, and of applications specially requested to be published. Current plans will require mandatory electronic submission of these four classes of applications.

1.1.1.3 Assignments of interests in Patents and Trademarks

A patent or trademark is personal property and may be sold to others or mortgaged; it may be bequeathed by a will, and it may pass to the heirs of a deceased owner. The USPTO records and acknowledges assignments of interest, a security interest, a merger, a lien or a free-format explanation that describes the transfer. The assignment documents along with a recordation cover sheet are scanned or faxed into the Patent and Trademark Assignment System (PTAS) and then stored (no paper is handled for faxed-in documents) until they are ready to be mailed back to the customer with either a notice of recordation or a notice of non-recordation. In 1999 USPTO conducted a pilot test for electronic submission of assignments and plans to implement a production system in September 2000. XML DTDs are being defined to support electronic filing of assignments. They are listed in Appendix 1

1.1.2 Statutory Changes- General

Recent changes in the statutes have specifically enabled the USPTO to accept and promulgate documents in electronic form.

Public Law 106-113, known as the American Inventors Protection Act of 1999, included specific language in Section 4804 to authorize the electronic means of filing documents and issuing publications by electronic means. Specifically, §4804 (a) changed 35 USC §22 to read:

The Director may require papers filed in the Patent and Trademark Office to be printed, typewritten or on an electronic medium.

Section §4804(b) of the same law change 35 USC §11(a) to read:

The Director may publish in printed, typewritten or electronic form . . .

Title 17 of the Public Law 195-277 is known as The Government Paperwork Elimination Act, enacted on October 21, 1998. In that title, §1707 read as follows:

SEC. 1707. ENFORCEABILITY AND LEGAL EFFECT OF ELECTRONIC RECORDS.
Electronic records submitted or maintained in accordance with procedures developed under this title, or electronic signatures or other forms of electronic authentication used in accordance with such procedures, shall not be denied legal effect, validity, or enforceability because such records are in electronic form.

These laws form a statutory framework authorizing the promulgation of regulations to facilitate electronic receipt and publication of patent applications, patents and related materials.

Because the participation in agreements will not entail the expenditure of appropriated funds, the agreements do not meet the definition of "acquisition" in Federal Acquisition Regulation (FAR) 2.101. Therefore, the FAR does not apply to this RFA or the resulting agreements.

1.1.3 USPTO Electronic Filing and Communication Goals

Electronic filing and correspondence over time will include the two-way electronic exchange of information that the USPTO has with individual inventors, corporate filers, registered patent attorneys and agents, legal representatives, and government entities.

The USPTO has based its electronic filing and business communication initiatives on Extensible Markup Language (XML)-tagged documents and has developed standard formats for applications and most correspondence received and sent by the USPTO during the prosecution of a patent as well as post grant correspondence. Similarly, the USPTO has developed XML DTDs for trademark applications and for required post application and post registration filings. At this time some 23 patent related and 8 trademark XML documents have been defined of which a smaller number have been validated through use. The list of Trademark and Patent XML DTDs appears in Appendix 1.

The focus of this USPTO program is to encourage COTS IP software management companies to include the ability to produce the XML encoded application documents. The USPTO also solicits proposals that focus on the implementation of the full range of XML DTDs supporting two-way correspondence as well as proposals including secure electronic delivery to the PTO. (Note: Secure electronic delivery is not requirement for trademark correspondence and, for other than credit card transactions, currently trademark Internet communications are not encrypted or otherwise secured.) The USPTO includes solicitation of proposals from corporate customers and consortia that involve the addition of the ability to produce XML encoded applications to planned or existing corporate or consortia software.

The goal is to provide the mechanisms to companies, independent inventors, patent and trademark practitioners, and other information exchange partners to file applications, make payments, record assignments of patents and trademarks, exchange office actions and other correspondence, and retrieve forms, publications, and other information from the USPTO with a minimum reliance on paper.

The goal of the USPTO is to improve customer service, improve quality of our work products, reduce cycle time for examining patent and trademark applications, and lower costs. Strategies include:

- Making electronic filing of applications and correspondence, payment, and communication so simple, inexpensive, and trusted that customers will prefer these to calling or filing paper documents and mailing;
- Providing through RFAs for private sector XML encoding software to facilitate preparation of documents and methods for electronic filing, payment, as well as support for the full range of two way communication with the USPTO;
- Aggressively protecting transaction integrity, authenticity and confidentiality where appropriate and required by law;
- Substantially reducing electronic filing processing costs;
- Seeking the best people, ideas and partners to assure our success; and,
- Delivering the highest quality products and services as promised.

The USPTO faces the challenge of eliminating barriers by providing incentives and using competitive market forces to make progress towards: 1) USPTO's goal to electronically transact 80% of USPTO business by the year 2003; and, 2) the interim goal that, to the extent practicable, most applications prepared electronically without complex work units should be filed electronically by the year 2002. Currently 68% of published patent applications have no complex work units so that these applications can be rendered as text only documents. About 40 percent of Trademark applications typically include a single image illustrating the mark while patent applications may include multiple sheets of drawings.

1.2 Scope of Request for Agreement (RFA)

The USPTO includes in the scope of this RFA the full range of two-way communication with the USPTO in support of USPTO business. For the purposes of this RFA, the Government will focus on the following program needs:

- Patent and Trademark application, assignment and correspondence preparation and output as an XML document complying with the appropriate USPTO's XML DTD's (8 Trademark related and 23 Patent related and 2 Assignment related) focused on the independent inventor, trademark owner, corporate patent and trademark practitioner and patent and trademark attorneys using a personal computer which may be in a networked environment.
- RFAs may be limited, in the case of patent applications, to production of XML patent applications that do not have complex work units (CWU) but the PTO solicits proposals that deal with some or all of the listed CWU. It should be noted that USPTO does not consider drawing figures to be CWUs and that 80% of Patent applications and nearly 100% of Trademark applications have drawing figures and that RFAs must address the incorporation of drawings as tiff images.

To further define what PTO considers a CWU and the quantities of CWUs to be expected the following list is provided:

Aver no. patents with CWUs	-	32%
Aver no. of items in a CWU patent	-	9.29
Aver no. Tables per CWU patent	-	3.82
Aver. no. Equations per CWU patent	-	1.36
Aver no. Chemicals per CWU patent	-	3.88
Aver no. T/R's per CWU patent	-	0.23
Aver no. pages per CWU item	-	1.08

T/R's are tables containing other CWUs, i.e., equations, chemical formulas.

- RFAs may include electronic filings of assignments and other documents that transfer or grant interests in patents and trademarks in image form in fax format that feed into the recently implemented PTAS workflow system that automates the flow of assignment documents through the Assignment Services Program.
- RFAs may include payment solutions and document and product ordering that integrate with the USPTO's Revenue Accounting and Maintenance (RAM) system and the Order Entry Management System (OEMS)
- RFAs proposing electronic filing and communication programs supporting two-way communication with the USPTO using technical solutions other than the USPTO EPAVE delivery engine are solicited if coupled with support of creation of the XML filing and correspondence DTDs. It should be noted that the PTO, in support of the confidentiality and authentication needs associated with Patent application filing and correspondence, has implemented an Entrust based solution with USPTO required and supported identity proofing and grant of USPTO Certificates to authorized parties. Thus RFAs should address the use of the USPTO granted Certificates or otherwise leverage the Certificate grant to avoid the need for duplicating identity-proofing steps. This requirement applies only to Patent application and correspondence related communication RFAs.
- RFAs may address all or only one type of the three major filing categories, i.e., patents, trademarks, and/or assignments.
- RFAs addressing trademark filing should use the current TEAS application as the benchmark for proposals.

Details of the above mentioned systems and information technology programs are available in the USPTO Strategic Information Technology Plan which may be found at <http://www.uspto.gov/web/offices/cio/sitp/index.html>

Offerors are invited to propose a cooperative development and marketing campaign to communicate key messages to the public concerning the USPTO electronic filing programs stated above and to publicize and encourage the use of electronic filing products in return for whatever the Offeror may suggest. The USPTO will consider all suggestions, including financial incentives or changes to Rules of Practice, that are supported with convincing analysis and that credibly demonstrate the likelihood of increased volumes of electronic filings of patent and trademark applications for the USPTO.

For example, an Offeror may suggest the inclusion of the PTO electronic filing logo on software packaging, message boards, educational material, or links from the PTO WWW site to the Offerors WWW site or other USPTO notification that the Offeror provides USPTO XML compliant electronic filing services or XML conversion tools. An example of this is the IRS e-file program. See http://www.irs.gov/elec_svs/partners.html

The USPTO encourages Offerors to submit any and all suggestions for consideration. To facilitate this effort, USPTO will provide results from the following market research: demographic and attitudinal studies, and focus group results as well as the XML DTD's and other information developed in support of electronic filing of patent and trademark applications and the full range of two way correspondence with our customers both for US national filings and for application filings under the Patent Cooperation Treaty (PCT).

1.3 Existing PTO Programs Customers

Following is a brief synopsis of the customer groups that this RFA focuses on:

1.3.1 The Independent Inventor or Trademark Owner

The independent inventor or trademark owner is an individual who may choose to prepare his patent or trademark application himself using commonly available personal computing equipment. They may be inexperienced in the legal requirements for the preparation of a patent or trademark application and thus may require more assistance to prepare their application.

1.3.2 Trademark Attorney or Patent Attorney or Agent

The Intellectual Property practitioner, the patent attorney or agent or attorney filing trademarks may work in organizations ranging from a sole practitioner with little technical support or minimal background in the details of patent or trademark practice to a law firm or corporate environment providing a high degree of technical support with substantial knowledge of USPTO practice. Typically these environments will support personal computers in a networked environment.

1.3.3 Filers of Patent Cooperation Treaty Applications

The Patent Cooperation Treaty permits a single application to be filed which may lead to patent rights in over 100 countries. Such PCT applications are usually prepared in the corporate or law firm environment. The option to create national applications for filing with the USPTO and other nations at the same time as creating the PCT application has been an expressed desire of the USPTO customers for some time. XML DTDs defining the PCT application have been developed and will be made available. The USPTO functions as a Receiving Office for patent applications filed under the PCT. In 1999 the USPTO Receiving Office processed 29,463 international Applications, which was 39.8% of the world total. In 1999, there were 74,023 international applications filed with PCT receiving Offices worldwide, which is 7,016 (10.5%) more than in 1998. The number of international applications received has increased significantly each year since 1978.

The following table shows the country of origin and quantity of the worldwide PCT filings:

**PCT filings
by country of origin (1999)**

<i>Country of origin</i>	<i>Applications received</i>	<i>% of total</i>
US	29,463	39.8
DE	10,897	14.7
JP	7,255	9.8
GB	4,741	6.4
FR	3,633	4.9
SE	2,619	3.5
NL	2,153	2.9
CH (incl. LI)	1,564	2.1
CA	1,398	1.9
FI	1,269	1.7
Other countries	9,031	12.3
	74023	100.00

Comprehensive information regarding PCT filings statistics and practice is to be found at www.wipo.int , the web site of the World Intellectual Property Organization.

1.3.4 Highlights of Current and Planned Product Developments

1.3.4.1 Electronic Filing System

Currently, the USPTO's customers submit paper copies of patent applications. A crucial goal of the Patent Business is to receive these applications electronically. In order to accomplish this goal, the Patent Business plans to implement an Electronic Filing System (EFS). The Electronic Filing System will be one of several Electronic Commerce automated services provided to patent business customers.

The current approach to supporting electronic filing for the applicant community derives from several research and demonstration efforts that the USPTO engaged in the last six years. The USPTO initiated the Electronic Filing System (EFS) project in July 1998 to provide a means for patent applicants or their representatives to submit patent applications and related papers to the USPTO using the Internet. EFS is designed around a common "submission engine" EPAVE that presents an electronic form to the applicant to collect bibliographic data and allow the applicant to attach the specification, claims, drawings and other files needed to complete the application as well as submit fees by credit card. The submission engine combines the files into a single compressed file, encrypts and digitally signs the file, and transmits the file to the USPTO over the Internet. The electronic filer will be able to develop the complex parts of the application using an authoring tool based on commercially available software products and then attach those files to create a submission package. Genetic sequence data files authored using PatentIn or other acceptable sequence listing authoring editors can be attached to the patent application submission package and submitted along with the application related electronic files using the EFS submission engine known as the electronic packaging and validation engine.

The longer term goal is to implement the 24 XML DTDs defining the correspondence and assignment with the USPTO and supporting a full range of two way business communication with the USPTO.

1.3.4.2 Trademark Electronic Application Submission (TEAS)

This Trademark Electronic Application Submission (TEAS) project provides for the implementation of an electronic communication capability with trademark customers using the Internet. The final system is intended to support the receipt of all Trademark forms electronically through standardized transactions using XML.

The initial focus of the project was on the submission of application data to the USPTO. Future operations will include electronic submission of forms required to complete intent-to-use processing and post registration processing. The USPTO will implement a program in the summer of 2000 that will provide for data transmission from the USPTO to customers for Office actions created during the prosecution of a case and post-registration actions using e-mail for the transmission and receipt of documents. The USPTO is currently completing work on a new system that will allow all electronic correspondence, including e-mail correspondence, to be linked to the basic application or registration. This project is the first step towards a complete electronic workflow solution for Trademark prosecution.

The current strategy is to leverage the technologies and capabilities of mainstream World Wide Web browsers and e-mail as a means for interacting with Trademark customers. The final goal is to make all transactions and interactions with Trademark customers electronic. Near term steps involve implementation of the 8 XML DTDs defining various post examination and post registration filings to the USPTO and support of the full range of two-way business communication with the USPTO using e-mail.

1.3.4.3 PatentIn

The USPTO receives about 6,000 initial submissions annually of nucleic and amino acid sequence data as part of biotechnology patent applications. This data is required to be submitted as a Sequence Listing in both paper and computer readable form and must conform to current sequence submission rules pertaining to accepted values and data format. The PatentIn software program provides an efficient and convenient means through which applicants may create the Sequence Listings to comply with U.S. and international filing requirements for biotechnology patent applications containing nucleic and amino acid sequence information.

Following the initial deployment, the PatentIn 3.0 software will be enhanced to support the Electronic Filing System (EFS) project to support the secure electronic submission of the Sequence Listings over the Internet to the USPTO Electronic Mailroom

1.3.4.4 Patent and Trademark Office Assignment System

During 1999, the USPTO improved PTAS electronic workflow software, incorporated automated processing of fax submissions, and conducted a pilot electronic submission of assignments over the Internet. In 2000 the USPTO plans to implement Internet submission for Assignments. XML DTDs have been defined for registering assignments of patent and trademark rights.

1.3.4.4 PCT EASY; Electronic Filing of patent Applications filed under the PCT

PCT EASY is a program that assists in the completion of validated Applications in compliance with the formalities required of such applications. In 1999, of the 74,023 international applications received, 9,610 (13%) were prepared using the PCT-EASY software. There was an increasing share of filings containing a PCT-EASY request as the year progressed, and in the second half of the year, such filings accounted for 18.8% of all PCT filings. Currently, the applicant submits a paper application with a diskette. Future plans call for electronic submission over the Internet.

1.3 USPTO Media Plans for 2000 and forward.

USPTO's communication goals are to increase awareness and appeal of electronic application filing with the ultimate goal of creating positive intent-to-use and actual usage. In order to generate customer interest for the product; raise awareness of the product and make it desirable; satisfy customer need via product attributes and product developments; reach people in such a way that they are receptive to our message and take advantage of enhanced USPTO customer service orientation, the USPTO has enhanced its approach to marketing and promotional plans including expanded public meeting presentations, print and media buys.

The best media fit that USPTO will pursue in 2000 and forward includes:

- Print (General, Intellectual Property Practitioner and Inventor Magazines)
- National meetings attended by independent inventors and patent practitioners.
- Use of the USPTO World Wide Web site

2.0 PROPOSAL REQUIREMENTS

The USPTO anticipates entering into agreements for FY 2000 and beyond. The agreements will have a three-year duration with an option to renew for an additional 2 years.

Offerors interested in proposing several different solutions shall submit separate proposals for each and shall not combine them into one proposal. There are no restrictions on the number of proposals submitted by any Offeror for the RFA.

Proposals shall clearly state the implementation milestones and associated time frames for the proposed solution, for both the Offeror and the USPTO. If the USPTO determines that the proposal cannot be accomplished in a reasonable time then the proposal will be rejected.

2.1 Project Plan

All proposals submitted in response to this RFA shall be submitted in the form of a project plan. The format for the project plan is as follows:

2.1.1 Introduction

- Briefly describe your understanding of the objectives and scope of the proposed Agreement.
- State the proposed duration of your proposal.
- Include Point of Contact (POC) information (name, address, phone number, e-mail address and fax number) for discussion and negotiation of your proposal. The point of contact shall have decision making (commitment) authority for the Offeror.

2.1.2 Description of Solution and Proposed Agreement

- Identify the mechanism you plan to use in order to reach that market segment by describing the incentives, discounts, offers, benefits to the market segment or other specific approaches to increase electronic filing volumes.
- Identify the market segment you are trying to reach; describe your solution's impact on the segments (target population) and the electronic filing volume goals. Include the impact, if any, on complicated applications with and without complex work units (CWU) such as mathematical formulas, chemical formulas and the like.
- Describe the attention that will be given to this project, the resources that you will allocate, and your plan for managing and implementing the Agreement.
- Describe the definition of success for your solution and means of measuring quantifiable

- benefits for evaluating that success.
- Describe the duties and responsibilities of the USPTO in fulfilling the proposed Agreement.
- Describe the duties and responsibilities the Offeror will assume as an industry partner to the USPTO in fulfilling the proposed Agreement.
- Describe the USPTO resource requirements if required. Include the required: type of support, number of personnel, time frames for personnel, and supplies or equipment.
- Include Point of Contact (POC) information (if different from above) for management of the Agreement. Describe the POC's scope of authority and the resources available to the POC for ensuring the performance of the Agreement.
- Describe the milestones and time frames associated with implementation including all deliverables. Clearly delineate the milestones and timeframes associated with each participant, the Offeror and USPTO.
- Describe how the Offeror will track and report the number of unique applicants that use the Offeror's USPTO electronic filing XML product as a result of the marketing campaign.
- Return the Model Electronic Filing Memorandum of Agreement (Attachment 2 to this RFA) with any proposed additional content for negotiation, including dispute resolution and any remedies other than termination for the failure of either party to perform. Offerors are free to describe the respective duties and responsibilities either in the Agreement Requirements section of the project plan or in items 7 and 8 of the Model Electronic Filing Memorandum of Agreement.

2.1.3 Request for Patent Application Information (as applicable)

- Address the appropriate privacy and security safeguards as necessitated by the proposed Agreement.
- Describe the measures taken to guard against unauthorized disclosure in violation of the Patent Law 35 USC 122 when proposing solutions which require or contemplate release of information by the USPTO to other parties.

All of the elements and contents of the project plans may not be selected for inclusion in the resulting Non-Monetary Agreement. A project plan may include some information that the Offeror considers being proprietary and confidential and protected from Disclosure under the Freedom of Information Act (FOIA).

2.2 Agreement Deliverables

On the last day of each month of the agreement following implementation, the Offeror shall submit a project performance report. This report shall contain narrative describing accomplishments and any difficulties in performance of the agreement, and measurement of the success of the Partner's efforts including the number of unique customers that actually prepares and electronically files their application or payment as a result of the company's campaign. The final project performance report shall be submitted on May 15 of each calendar year during the term of the agreement to the USPTO Point of Contact. This report shall be used as a means to determine whether the Offeror has successfully performed the agreement. This report is subject to inspection/verification and approval by the USPTO and will be used to determine whether any option to extend the Agreement is exercised.

3.0 DELIVERY OF PROPOSALS/PROJECT PLAN

3.1 Proposal Submission

Offerors shall submit proposals to the following address:

If mailed:

U.S. Patent and Trademark Office
Information Technology Contracts Office
Box 14
2011 Crystal Drive, Suite 804
Washington, DC 20231

If hand delivered:

U.S. Patent and Trademark Office
Information Technology Contracts Office
2011 Crystal Drive, Suite 804
Arlington, VA 22202

3.2 Format for Proposals

3.2.1 Offerors shall submit proposals in paper format.

3.2.2 Proposals shall not exceed 100 pages.

3.2.3 Size: Proposal must be submitted on standard 8-1/2" by 11" paper, single-spaced. If foldouts are included, they must be folded to page size, with each leaf counting as a single page.

Type: Type must not exceed twelve (12) character or pitch per linear inch or six (6) lines per vertical inch.

3.2.4 In addition, Offerors shall submit proposals on a 3-1/2" diskette in Microsoft Word 97 or lower version or WordPerfect 6.1 or lower version.

3.3 While brochures, and other literature will be accepted, please note that extraneous narratives, elaborate brochures, uninformative Public Relations (PR) material and so forth not related to the proposal will not necessarily be considered.

4.0 EVALUATION PROCESS AND ASSESSMENT CRITERIA

The Offerors' proposals will be evaluated using the three-step process and the factors described below.

4.1 Step 1

The first step of the evaluation entails an assessment of the Project Plan to determine: (1) the Offeror's adherence to the scope of the RFA (see 1.2 above); and (2) realism of the Offeror's proposal for accomplishment of the project proposed. The USPTO will make this determination on a pass/fail basis. Proposals that pass by complying with adherence to the scope and proposing Agreements that are achievable in time will move to the next step.

4.2 Step 2

The USPTO will review the Project Plan and communicate to the Offeror uncertainties that are found in the proposal. Such communications will be for the purpose of minimizing the uncertainties. They will not be used to cure significant omissions in the proposal, materially alter the proposal, or otherwise elicit significant revisions to the proposal. Any proposals whose project plans contain significant omissions or ambiguities will no longer be considered. Offerors who submit project plans that are clear or whose uncertainties have been removed, may be required

to conduct an oral presentation of the proposed Agreement (project plan) and participate in a question and answer session. The oral presentation and project plan will be evaluated using the evaluation factors below:

Factor 1 - Soundness of Approach

- Are success factors and a success measurement methodology described and reasonable?
- Does the Offeror promise appropriate management attention and resources?
- Are duties, responsibilities, and milestones clearly stated for both the Offeror and the USPTO? Are they reasonably achievable?
- Manageability, i.e., is the burden to the USPTO in allocating the resources, providing any of the services, or in granting administrative relief or other consideration requested by the Offeror acceptable?
- Does the Offeror clearly articulate how it will communicate either existing USPTO key messages or relevant new key messages?

Factor 2 - Impact on Underrepresented Market Segments

Are positive impacts anticipated on any of the following:

- On complicated applications containing complex work units?
- On simple patent and trademark applications and assignments?
- On filings under the Patent Cooperation Treaty?

Estimates provided for the impact on Underrepresented Market Segments should be supported by market research.

Factor 3 – Impact on Filer

Does the proposal demonstrate reduction in any of the following:

- Cost to the filer?
- Time spent preparing an application?

Empirical data is needed to support marketing claims on burden/time reduction to filers, where available.

This evaluation will result in a pass/fail determination. Any uncertainties in the Offeror's proposal identified by the USPTO will be communicated to the Offeror for clarification and possible negotiation. Offerors' proposed Agreements that pass the Step 2 evaluation will continue to the next step.

4.3 Step 3

The third step will focus on the proposed Agreements' impact on the USPTO. This assessment will include a comparison of the Offerors' proposed Agreements using the following discriminators:

- value of benefits offered,
- creativity of approach to communicating key messages,
- consideration requested of the USPTO, for example, the extent to which USPTO's management, technical and financial resources and support services are required.

The USPTO will rank the proposed Agreements in descending order, beginning with the one with the greatest benefit and least burden offered.

Issuance will be made of approximately five Agreements that the PTO deems manageable considering the above discriminators. As a result of this assessment, any, all /or none of the proposed Agreements may be selected.

The USPTO may make a downselect to what it determines to be a reasonable number of proposals at this time, in order to facilitate oral presentations, if they are held.

4.4 Oral Presentation

The USPTO may elect to conduct oral presentations. In the event oral presentations are held, each Offeror's presentation will not exceed two hours in duration. A USPTO Contract Specialist will schedule the oral presentations and will notify each Offeror of the date, time, and location. The oral presentation will take place at the Government's facility in the Washington, DC metropolitan area. The Government reserves the right to reschedule an oral presentation at the discretion of the USPTO Contracting Officer. If the Offeror is unable to travel to the location where the oral presentation is to occur, then a teleconference will be arranged for the scheduled date and time.

The Offeror shall present their proposed solution following the same general format required for the Proposal/Project Plan (See 2.1 above). The purpose of the oral presentation is to ensure a thorough understanding of the Offeror's proposed Agreement.

The Contracting Officer will strictly enforce the two-hour time limit. The Offeror's oral presentation must be made by one or more of the persons whom the Offeror will actually employ under the proposed Agreement. Following the oral presentation, each Offeror shall participate in a question and answer session held by the Government. The presenters must be able to answer technical, business and project management questions regarding the proposed Agreement. The oral presentation will be evaluated as stated in Section 4.2 Step 2. The Government may audio or videotape the Oral Presentation.

4.5 Legal Review

The Offeror's project plan will be reviewed by the USPTO Solicitors Office. This review will address fraud prevention and detection implications of the proposal. Also, the USPTO will assess the proposal to assure the proposed Agreement does not disrupt other planned activities. These reviews will be conducted on a pass/fail basis

5.0 ISSUANCE OF AGREEMENTS

The USPTO anticipates issuing Agreements about 120 days after submission of proposals.

**Attachment 1
List of Trademark, Patent, and Assignment DTDs**

The following DTDs are in development or use in the PTO's electronic filing initiatives:

Trademark Transaction DTDs:

1. Trademark/Service mark Application, Principal Register
2. Statement of Use/Amendment to Allege Use for Intent-to-Use Application
3. Request for Extension of Time to File a Statement of Use
4. Declaration of Use of a Mark under Section 8
5. Declaration of Incontestability of a Mark under Section 15
6. Combined declaration of use in commerce/application for renewal of registration of mark under Sections 8 & 9
7. Combined declaration of use & incontestability under Sections 8 & 15

Patent Transaction DTDs:

1. Amendment
2. Appeal Brief
3. Change Of Correspondence Address
4. Continued Prosecution Application
5. Declaration For Utility Application
6. Exceptional Correspondence
7. Express Abandonment
8. Fee Transmittal
9. Information Disclosure Statement
10. Notice Of Appeal
11. Oral Hearing Request
12. Patent Disclaimer
13. Power Of Attorney
14. Petition For Time (A)
15. Petition For Time (B)
16. Revoke Power Of Attorney
17. Small Entity Claim B
18. Small Entity Claim C
19. Small Entity Claim D
20. Small Entity Claim Non-Inventor
21. Specification
22. Terminal Disclaimer
23. Transmittal

Assignment DTDs

1. Patent Assignment (Certificate under 37 CFR 3.73 (B))
2. Trademark Assignment

Attachment 2

**MODEL
ELECTRONIC FILING
MEMORANDUM OF AGREEMENT
BETWEEN THE UNITED STATES PATENT AND TRADEMARK OFFICE AND
[INSERT PARTICIPANT' S NAME]**

1. INTRODUCTION:

This Memorandum of Agreement (“Agreement”) between the US Patent and Trademark Office (“USPTO”) and [insert name of company or organization] (“Participant”) sets forth the complete agreement of the parties with regard to participation in the [insert name of project] for electronically filed patent and trademark applications during the period of [insert dates]. Also, except as provided below, the parties agree to comply with all relevant statutory, regulatory, and administrative requirements relating to the electronic filing program.

1. AUTHORITY:

(A) This Agreement is entered into pursuant to the authority vested in the Director of the PTO by Public Law **106-113**, known as the American Inventors Protection Act of 1999, which included specific language in Section 4804 to authorize the electronic means of filing documents and issuing publications by electronic means.

(B) This Agreement is not an “acquisition” as that term is defined in the Federal Acquisition Regulation (“FAR”) 2.101; therefore, the FAR does not apply to this Agreement.

3. BACKGROUND AND PURPOSE:

(A) This Agreement results from the evaluation and selection by the USPTO of one or more proposals received in response to a solicitation or Request for Agreements (“RFA”) for ETA Partnerships in the form of Non-Monetary Agreements.

(B) The purpose of this Agreement is to cooperatively market USPTO electronic filing and correspondence in a mutually beneficial manner. USPTO will provide [to be included as necessary] in exchange for agreed services by the Industry Partner to promote electronic filing.

4. DEFINITIONS:

[TO BE INCLUDED AS NECESSARY]

5. APPLICABLE DOCUMENTS:

[TO BE INCLUDED AS NECESSARY. IN THE EVENT THAT “OFFICIAL USE ONLY” INFORMATION MUST BE PROVIDED BY THE PTO TO THE PARTICIPANT FOR PERFORMANCE OF THE AGREEMENT, THEN THE AGREEMENT WILL INCLUDE THE FOLLOWING PTO ACQUISITION PROCEDURE CLAUSES, AS APPICABLE: “DISCLOSURE OF INFORMATION – SAFEGUARDS”; “DISCLOSURE OF ‘ OFFICIAL USE ONLY’ INFORMATION SAFEGUARDS”; “ DISCLOSURE OF INFORMATION CRIMINAL/CIVIL SANCTION”; AND “DISCLOSURE OF INFORMATION OFFICIAL USE ONLY”.]

6. AUTHORIZED REPRESENTATIVES:

[CONTACT POINTS FOR EACH PARTY TO BE INCLUDED]

7. DUTIES AND RESPONSIBILITIES OF THE PTO:

[STATEMENT OF WORK (SOW) TYPE LAYOUT OF USPTO' S COMMITMENTS TO BE INCLUDED]

8. DUTIES AND RESPONSIBILITIES OF THE PARTICIPANT:

[SOW TYPE LAYOUT OF PARTICIPANT' S COMMITMENTS TO BE INCLUDED]

9. LIABILITY:

Each party to this Agreement shall be liable for the acts and omissions of its own employees. The USPTO shall not be liable for any injury to the Participant' s personnel or damage to the Participant' s property unless such injury or damage is due to negligence on the part of the Government and is recoverable under the Federal Tort Claims Act {28 U.S.C. 1346(b)}, or pursuant to other statutory authority.

10. THIRD PARTY RIGHTS:

This Agreement does not confer any rights or benefits on any target population or any other third party.

11. PERIOD OF PERFORMANCE AND TERMINATION:

(A) This Agreement shall be in effect from the date of signature for the USPTO for a period of one year, renewable for one additional one-year option period by mutual consent.

(B) This Agreement may be terminated by either party upon 30 days after receipt of written notice signed by either of the signatories to this Agreement or by their successors or designees. The Participant understands that in the event the USPTO terminates this Agreement, the Participant has no right to any claim against the Government, including a claim for termination costs.

12. MODIFICATION OF AGREEMENT:

This Agreement may be modified by either party, but only upon mutual agreement. All modifications must be in writing and signed by both of the signatories to this Agreement or by their successors.

13. INSPECTION RIGHTS:

(A) The USPTO may inspect the work performed by the Participant upon reasonable notice to the Participant' s Authorized Representative and in a manner that will not interfere with the Participant' s performance of this Agreement. The Participant shall provide access for this purpose to the USPTO' s Authorized Representative(s) to the location where the work is being performed. The USPTO shall also have the right to inspect the Participant' s Report(s) of the work performed as a result of this Agreement. The USPTO' s Authorized Representative shall provide the results of any inspections to the Participant' s Authorized Representative for any necessary resolution.

(B) The USPTO may evaluate the Participant' s performance of this Agreement and may provide the results of this evaluation to the Participant, in writing, on a quarterly basis for written comment and return to the USPTO. The evaluation, including the Participant' s comments, may be used by the USPTO in considering the Participant for future Agreements or Contracts.

14. REMEDIES:

[ANY REMEDIES FOR NON-PERFORMANCE BY EITHER PARTY, IF ANY ARE TO BE INCLUDED OTHER THAN "TERMINATION" AS STATED IN 11(B), MAY BE INSERTED SUBJECT TO MUTUAL AGREEMENT. IF REMEDIES ARE TO BE PROVIDED, THEN THE UNILATERAL TERMINATION PROVISION IN 11(B) SHALL BE DELETED.]

15. LIMITATIONS:

The terms of this Agreement are not intended to alter, modify, or rescind any current Agreement or provision of Federal law now in effect. Any provision of this Agreement which conflicts with

Federal law will be null and void.

16. DISPUTE RESOLUTION:

[THE CONTRACT DISPUTES ACT DOES NOT APPLY. UNDER 41 U.S.C. 605(d), USPTO AND THE PARTICIPANT MAY AGREE TO ALTERNATIVE DISPUTE RESOLUTION OR OTHER MUTUALLY AGREEABLE PROCEDURES.]

17. SIGNATURES:

[TO BE SIGNED AND DATED WITH THE NAMES AND TITLES OF EACH SIGNATORY INSERTED.]